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**Datasheet for the decision
of 1 February 2022**

Case Number: T 1691/16 - 3.2.06

Application Number: 06770227.4

Publication Number: 1893145

IPC: A61F13/00, A61F13/02

Language of the proceedings: EN

Title of invention:

WOUND DRESSING

Patent Proprietor:

BSN medical GmbH

Opponent:

Schmitt-Nilson, Gerhard, /Waibel, Stefan

Headword:

Relevant legal provisions:

EPC Art. 100(c), 123(2)

RPBA 2020 Art. 13(2)

Keyword:

Grounds for opposition - added subject-matter (yes)
Amendment after summons - taken into account (no) -
exceptional circumstances (no)

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 1691/16 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 1 February 2022

Appellant:

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 18 May 2016
revoking European patent No. 1893145 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman

M. Harrison

Members:

P. Cipriano

W. Ungler

Summary of Facts and Submissions

- I. An appeal was filed by the patent proprietor (appellant) against the decision of the opposition division revoking European patent No. 1 893 145. It requested that the decision under appeal be set aside and the patent be maintained as granted (main request) or, as an auxiliary measure, that the patent be maintained in amended form according to one of auxiliary requests I to VII.
- II. The respondent (opponent) requested that the appeal be dismissed.
- III. With its letter dated 27 November 2017, the appellant filed auxiliary request VIII.
- IV. The Board issued a summons to oral proceedings and a subsequent communication containing its provisional opinion, in which it indicated *inter alia* that the ground of opposition under Article 100(c) EPC was prejudicial to maintenance of the patent as granted and that the subject-matter of claim 1 of auxiliary requests I to VIII did not fulfil the requirement of Article 123(2) EPC.
- V. With its letter dated 15 October 2020, the appellant filed auxiliary request IX.
- VI. Oral proceedings were held by videoconference before the Board on 1 February 2022.

The final requests of the parties were as follows:

The appellant (patent proprietor) requested that the decision under appeal be set aside and the patent be maintained as granted (main request), or that the patent be maintained in amended form on the basis of one of the auxiliary requests I to VII filed with letter dated 26 September 2016, or on the basis of auxiliary request VIII filed with letter dated 27 November 2017, or on the basis of auxiliary request IX filed with letter dated 15 October 2020.

The respondent (opponent) requested that the appeal be dismissed.

VII. Claim 1 of the main request reads as follows:

"1. A wound dressing (20, 40, 50, 60, 70, 93, 110), comprising:

a vapor-permeable backing layer (22, 23, 42, 52, 62, 72, 95, 112, 228) having first and second surfaces, the backing layer (22, 23, 42, 52, 62, 72, 95, 112, 228) defining a center portion (32, 39, 90, 111, 132) and a border portion (34, 41, 92, 113, 134) surrounding the center portion (32, 39, 90, 111, 132);

a first skin-adherent facing layer (29) connected to the border portion (34, 41, 92, 113, 134) along the first surface of the backing layer (22, 23, 42, 52, 62, 72, 95, 112, 228);

an absorbent core (24, 25, 44, 54, 64, 74, 97, 114, 224) having first and second surfaces, the second surface of the absorbent core (24, 25, 44, 54, 64, 74, 97, 114, 224) connected to the first surface of the backing layer (22, 23, 42, 52, 62, 72, 95, 112, 228);
and

a perforated silicone sheet formed by a cured silicone elastomer mixture having first and second surfaces, the first surface adjacent to the second surface of the absorbent core (24, 25, 44, 54, 64, 74, 97, 114, 224);

wherein the second surface of the silicone sheet is generally not adherent to skin."

VIII. The arguments of the appellant relevant to this decision may be summarised as follows:

Main request - Article 100(c) EPC

Claim 24 as originally filed and the passage from page 10, last paragraph to page 11, third paragraph of the application as filed (hereinafter also referred to as the "variation 1" embodiment) provided a basis for claim 1 of the main request.

A "variation" embodiment did not include all the non-changed features of the embodiment, from which the variation stemmed.

Since the "variation 1" embodiment was the only embodiment of the description disclosing the feature "perforated silicone sheet", the skilled person recognized there was a direct link between original claim 24 and this embodiment. The feature "free standing" of claim 25 (which was dependent on claim 24) was also only mentioned in the "variation 1" embodiment, and was also optional.

The passage on page 8, lines 3-8, disclosing a "discrete sheet of silicone gel" and a "plurality of apertures" did not use the same specific wording and was concerned with the embodiment of Figures 1 to 4,

such that the skilled person would link it to claim 17 as originally filed.

Further, there was no intermediate generalization and the feature "at least one side of the silicone sheet is treated with a talcum powder or similar substance to mitigate or minimize the tackiness of such side" (hereinafter also referred to as the "talcum powder" feature) did not need to be added to claim 1.

Auxiliary requests I to VIII - Article 123(2) EPC

The appellant did not bring forward any arguments regarding auxiliary requests I to VIII.

Auxiliary request IX - Article 13(2) RPBA 2020

There were exceptional circumstances as stipulated in Article 13(2) RPBA 2020. The respondent had presented five different objections regarding Article 100(c) EPC but the opposition division was not convinced by any of them. It was unreasonable to file requests addressing all the possible combinations of the five objections in reply to the respondent. It was only procedurally economical to file requests after the preliminary opinion of the Board was known.

IX. The arguments of the respondent relevant to this decision may be summarised as follows:

Main request - Article 100(c) EPC

The subject-matter of claim 1 was an inadmissible intermediate generalization of the Fig. 12 embodiment described in the application as filed.

The reference embodiment was described on page 10, paragraphs 4-5 of the application as filed with respect to Fig. 12, which constituted an introductory general section of the embodiment of Fig. 12. The "variation 1" passage was not disclosed independently of the introductory general section of the Fig. 12 embodiment or the description of the embodiments in Figs. 1-4.

At least the feature "talcum powder" was directly and unambiguously disclosed in combination with the other features of the "variation 1" embodiment and had not been included in claim 1.

There was no direct link between claim 24 and the "variation 1" embodiment, since several other embodiments also comprised a perforated silicone sheet. For example, the "second facing layer 36", which was the wound-facing layer applied to the absorbent core in the embodiment of Figs. 1-4 was a "discrete sheet of silicone gel", which included "a plurality of apertures 38" (see page 8, lines 3-8 of the published application). Original claim 24 simply covered various embodiments of the original application.

Auxiliary requests I to VIII - Article 123(2) EPC

The amendments to auxiliary requests 1 to 8 did not overcome the objections under Article 123(2) EPC made under Article 100(c) EPC above, since the feature "talcum powder" was not defined in any of the respective independent claims.

Auxiliary request IX - Article 13(2) RPBA 2020

Auxiliary request 9 should not be taken into account in the appeal proceedings. The objection under Article

100 (c) EPC had been filed as far back as the notice of opposition. There were no exceptional circumstances justified with cogent reasons for filing the request after the notification of the summons to oral proceedings.

Also, the reply to the grounds of appeal did not contain a simple repetition of the arguments brought during the opposition proceedings. Quite the opposite, it addressed the decision and developed the arguments regarding the talcum powder feature further.

Reasons for the Decision

1. Main request - Article 100(c) EPC
- 1.1 The ground for opposition under Article 100(c) EPC prejudices maintenance of the patent as granted.
- 1.2 The appellant argued that claim 24 as originally filed and the passage from page 10, last paragraph to page 11, third paragraph of the published application (the "variation 1" embodiment) provided a basis for claim 1 of the main request.
- 1.3 According to the appellant, a "variation" embodiment did not include all the remaining and non specifically mentioned features of the embodiment from which the variation stemmed.
- 1.3.1 The Board does not accept this argument. The description is structured such that the embodiment of Figs. 1-4 is described in full detail on pages 7 and 8, with the embodiments of Figs. 10-12 being described as

variations of this wound dressing (see page 9, first two lines of the second complete paragraph) and the "variation 1" embodiment being referred to as a variation of the embodiment of Fig. 12 on page 10, first two lines of the last paragraph.

Specifically, the second paragraph on page 9 of the description states that the variations of the wound dressing according to Figs. 1-4 that follow will either have no second facing layer or have a second facing layer different from the second facing layer according to the embodiment of Figs. 1-4. On page 10, the third full paragraph then states that "Fig. 12 shows another embodiment wherein the center portion of the absorbent core 24 is covered along its proximal side with a perforate covering layer 45". The skilled person reading the description understands that "the" absorbent core 24 is the same as absorbent core 24 from the previous embodiments whereas "a" perforate covering layer 45 (n.b. using a new reference numeral) is a different second facing layer than the one referred to on page 9.

In a similar fashion, the "variation 1" embodiment starting on page 10, last paragraph, describes that "the layer" (referring to the perforate covering layer mentioned immediately before) comprises a perforated silicone sheet and then goes on to describe only how "such" silicone sheet might be obtained.

The skilled person reading the description thus understands that all the other features of the wound dressing in the "variation 1" embodiment remain as disclosed before in the embodiment of Fig. 12 or even earlier in the embodiment of Figs. 1-4. Nothing indicates the contrary.

- 1.4 The appellant also argued that the "variation 1" embodiment was the only embodiment described which disclosed the feature "perforated silicone sheet" and that, due to this, the skilled person recognized a direct link between original claim 24 and this embodiment, claim 24 being the generic version of this "variation 1" embodiment. Since both original claim 24 and the added feature "formed by a cured silicone elastomer mixture" belonged to the "variation 1" embodiment, the added feature could thus allegedly be combined with original claim 24.

According to the appellant, because the passage on page 8, lines 3-8, disclosing a "discrete sheet of silicone gel" and a "plurality of apertures" did not use the same specific wording and referred to the embodiment of Fig. 4, the skilled person would link it to claim 17 as originally filed and not to claim 24.

- 1.4.1 The Board does not find this argument convincing. Whilst the exact wording "perforated silicone sheet" only appears on the last paragraph of page 10 in the context of the "variation 1" embodiment, which is a variation of the embodiment of Fig. 12, there are other embodiments described in the application that also comprise a silicone sheet with perforations. For example, in the first complete paragraph on page 8 referring to the embodiment of Fig. 4, the second facing layer 36 is also described as being a discrete sheet of silicone gel including a plurality of apertures 38. The Board notes that page 11, line 5, also describes the perforated silicone sheet of the "variation 1" embodiment as having apertures, i.e. the terms "apertures" and "perforations" are also used synonymously in the context of the patent.

Furthermore, the wound dressing defined in claim 24 as originally filed also encompasses the embodiment of Fig. 4. It is self-evident that the claims may cover several embodiments of the description since claims are, by their very nature, attempts to encompass the invention in broad terms in order to define the matter for which protection is sought and often encompass several, if not all, embodiments of the invention.

Similarly, claim 17 defines a "discrete layer of silicone gel" using the same words as page 8, but, since this layer may also be a "perforated silicone sheet", and it is not excluded that such a layer comprises a second surface that is generally not adherent to skin (as defined in claim 24 and described in the "variant 1" embodiment), there is an overlap between the scope of the two claims and neither of them is distinctly supported only by a single separate embodiment of the description.

The Board thus finds that the skilled person reading the application would not directly and unambiguously derive an exclusive correspondence between the "variation 1" embodiment of the description and claim 24 as originally filed.

1.5 The appellant also argued that there was no intermediate generalization and the "talcum powder" feature did not need to be added to claim 1, since:

- treating the perforated silicone sheet with talcum or a similar substance, and/or the presence of such substances (or residues thereof) on the sheet surface were only optional features of "variation 1". The skilled person knew that a cured elastomer mixture,

such as that mentioned on page 11, i.e. MED-4905 (see e.g. D18), was implicitly non-tacky and did not require a treatment with talcum powder or similar substance,

- the skilled person reading the description understood that the passage referring to a treatment with talcum powder or similar substance referred directly to the last sentence of page 10.

The Board does not find these arguments persuasive. The person reading the description understands that the sentence "[a]t least one side of the silicone sheet is treated with a talcum powder or similar substance to mitigate or minimize the tackiness of such side" refers to the silicone sheet formed from a cured silicone elastomer mixture described immediately before. Also, the use of the present tense "is treated" in the sentence "At least one side of the silicone sheet is treated with a talcum powder or similar substance to mitigate or minimise the tackiness of such side." cannot be interpreted as representing a conditional event. It is also not a description of an optional possibility, but something which is stated for the specific purpose of overcoming the tackiness of the side in question.

In addition, the Board does not find any reason to acknowledge that MED-4905 is implicitly a non-tacky material. D18 does not describe any surface property of the material, and from the way that the first paragraph of page 11 is constructed, the skilled person reading the description would understand that a treatment with talcum powder or similar substance is required to mitigate or mitigate or minimize the tackiness of the treated side. This implies conversely that the treated

surface was indeed tacky before being subjected to the treatment.

- 1.6 The appellant also added that the "treated with talcum powder" feature was a product-by-process feature that did not result in a distinguishable product property of the sheet such that its inclusion would not actually limit the claim, or that in any case, the result was already defined in claim 1 by the feature "generally not adherent to skin".

The Board does not accept this argument either. Treating a surface with talcum powder would make the powder adhere to the adhesive and would leave at least traces of the substance on it. The Board also finds that *similar* substances refers to substances that would work similarly in the sense that they would also be held by the adhesive and leave a trace on the surface. The Board thus finds that the treatment would lead to a distinguishable product and thus identifiable structural features.

- 1.7 Additionally, according to the appellant, page 11, second paragraph, described multiple ways for the perforated silicone sheet to be secured, such as by placing the tacky side towards the core, by lamination, or by methods described in US application 10/725,574. Since more than two ways to secure the sheet were described in the "variation 1" embodiment, the skilled person would allegedly have understood that the specific securing method using talcum powder or a similar substance was not indispensable.

The Board does not accept this argument. The first paragraph on page 11 deals with the production of the silicone sheet and not the ways of securing the sheet

according to the application as does the second paragraph. The talcum powder or similar substance is not used to secure the silicone sheet but to reduce the tackiness on at least one side. The skilled person reading the description therefore derives that one or more sides can be made tacky and applied to the core through different methods but the application as a whole only discloses the treatment with talcum powder or similar substance to mitigate or minimize the tackiness of a side of a silicone sheet.

- 1.8 Thus, even if the skilled person would recognize a direct link between original claim 24 and the "variation 1" embodiment (which the Board does not accept), at least the omission of the "talcum powder" feature from claim 1 results in its subject-matter being an unallowable intermediate generalisation of the original disclosure.
- 1.9 Summarising all of the above, the subject-matter of claim 1 of the main request extends beyond the content of the application as originally filed. The ground for opposition under Article 100(c) EPC therefore prejudices maintenance of the patent as granted. The main request is thus not allowable.
2. Auxiliary requests I to VIII - Article 123(2) EPC
3. The wording of claim 1 of the auxiliary requests I to VIII also does not comprise the feature "talcum powder" nor does the Board find that any of the amendments to these claims overcomes the intermediate generalisation objection resulting from the omission of this feature, as made against claim 1 of the main request. The appellant also did not make any arguments that they did overcome this objection.

3.1 Therefore, the Board finds that the subject-matter of claim 1 of the auxiliary requests I to VIII does not meet the requirement of Article 123(2) EPC and that these requests are not allowable.

4. Auxiliary request IX - Article 13(2) RPBA 2020

4.1 Auxiliary request IX was filed after notification of the summons to oral proceedings.

4.2 According to Article 13(2) RPBA 2020, "[a]ny amendment to a party's appeal case made ... after notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned".

4.3 The appellant argued that there were exceptional circumstances as stipulated in Article 13(2) RPBA 2020. The respondent had presented five different objections regarding Article 100(c) EPC but the opposition division was not convinced by any of them. According to the appellant, it was unreasonable to file requests addressing all the possible combinations of the five objections in reply to the respondent and it was only procedurally economical to file requests after the preliminary opinion of the Board was known.

The Board does not find these arguments persuasive. The respondent objected and further developed its arguments regarding the "talcum powder" feature in its reply to the appeal (see e.g. the paragraph bridging pages 4 and 5). However, the Board notes that the appellant did not file a single request addressing this issue nor did it even discuss any possible amendments when filing its

reply dated 27 November 2017 that could possibly overcome this objection. The appellant instead chose to rely simply on arguments as its defence.

In this respect, the appellant argued only that original claim 24 already defined features resulting from this method step (fourth complete paragraph on page 3 to the third complete paragraph on page 4).

By choosing this course of action, the Board finds that the appellant made a clear and deliberate choice to simply defend its stance that adding the "talcum powder feature" was not required under Article 123(2) EPC when adding the feature "formed by a cured silicone elastomer mixture" to claim 24 as originally filed. This can only be understood as an expression of its intention not to concede on this issue, not even as fallback position. Indeed this choice may have been made for many reasons, all unknown to the Board, such as for example that the addition of further features would not provide useful patent protection.

It was only after receiving the (negative) preliminary opinion of the Board that the appellant considered any amendment to its requests at all. It is evident from the RPBA 2020 that waiting for a Board's provisional opinion before making appropriate amendments is not commensurate with the purpose of the Rules of Procedure. Instead, the RPBA 2020 is set up such that the Board takes into account the written submissions of the parties and, to prepare parties for oral proceedings, then indicates the matters to be discussed which appear important for the decision to be taken. In the words of Article 15(1) RPBA 2020 this is expressed as follows: "In order to help concentration on essentials during the oral proceedings the Board shall

issue a communication drawing attention to matters that seem to be of particular significance for the decision to be taken".

The strict nature of the requirement for exceptional circumstances to exist, as in Article 13(2) RPBA 2020, is simply because the case of the party/parties is expected to have been made already. It would be clearly contrary to this if the Board's communication were to be foreseen as an opportunity for a party to react to a provisional opinion of the Board by filing amendments to its appeal case, at least in those cases where a Board has not raised any new issue but has merely expressed an opinion in agreement with one party's arguments.

4.4 Regarding the appellant's argument concerning the number of possible combinations and the number of auxiliary requests that it would have had to make, the Board notes first that the appellant made no suggestion of this when filing its response to the Article 100(c) EPC objections. Also, it is for the party to decide how best to defend its case and for a proprietor to determine what protection it wishes to have. There may thus be cause for filing a larger number of requests in certain situations to take account of multiple objections. Thus, no exceptional circumstances can be recognised as a result of the respondent having made several objections.

4.5 The Board therefore does not find any exceptional circumstances justifying the amendment of the appellant's appeal case and the filing of an auxiliary request addressing this issue only after the preliminary opinion of the Board.

4.6 For the above reasons, the Board exercised its discretion under Article 13(2) RPBA 2020 not to take into account auxiliary request IX.

4.7 In the absence of any allowable request the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



D. Grundner

M. Harrison

Decision electronically authenticated