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**Datasheet for the decision  
of 28 March 2019**

**Case Number:** T 0861/17 - 3.3.10

**Application Number:** 10185203.6

**Publication Number:** 2305321

**IPC:** A61L27/04, A61L27/54, A61F2/06

**Language of the proceedings:** EN

**Title of invention:**  
Device for in vivo delivery of bioactive agents and method of  
manufacture thereof

**Applicant:**  
Advanced Bio Prosthetic Surfaces, Ltd.

**Headword:**  
Device for delivery of bioactive agents/Advanced Bio  
Prosthetic Surfaces

**Relevant legal provisions:**  
EPC Art. 54, 123(2)  
RPBA Art. 12(4)

**Keyword:**

Main request: amendments - added subject-matter (yes)

Novelty - main request (no)

Late-filed auxiliary requests 1 to 4 - requests could have been filed in first instance proceedings (yes)

**Decisions cited:**

**Catchword:**



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Case Number: T 0861/17 - 3.3.10

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.10**  
**of 28 March 2019**

**Appellant:** Advanced Bio Prosthetic Surfaces, Ltd.  
(Applicant) Suite 1500  
2100 McKinney  
Dallas TX 75201-6928 (US)

**Representative:** Michalski Hüttermann & Partner  
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Speditionstraße 21  
40221 Düsseldorf (DE)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 2 November 2016  
refusing European patent application No.  
10185203.6 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** P. Gryczka  
**Members:** J. Schmid  
W. Van der Eijk

## **Summary of Facts and Submissions**

- I. The appeal lies from the decision of the Examining Division refusing European patent application No. 10 185 203.6.
- II. According to the Examining Division, claim 1 of the sole pending request filed on 22<sup>nd</sup> December 2015 infringed the requirement of Article 123(2) EPC. Furthermore the subject-matter of claim 1 lacked novelty over document  
  
(10) US-A-6 063 101.
- III. With the statement of grounds of appeal dated 11 March 2017, the Appellant (applicant) maintained its request filed on 22<sup>nd</sup> December 2015 before the examining division (main request), and furthermore filed fresh auxiliary requests 1 to 4.
- IV. In the communication dated 10<sup>th</sup> July 2018 accompanying the summons to oral proceedings, the Board informed the Appellant that the main request might be rejected, since the Appellant did not provide any argument against the examining division's reasoning of the contested decision and that auxiliary requests 1 to 4 might not be admitted into the appeal proceedings in accordance with Article 12(4) RPBA.
- V. With a letter dated 1<sup>st</sup> March 2019, the Appellant withdrew its request for oral proceedings and requested decision according to the state of file.
- VI. The Appellant requested in writing that the decision under appeal be set aside and that a patent be granted on the basis of the main request filed on 22<sup>nd</sup> December

2015, or subsidiarily on the basis of auxiliary requests 1 to 4, filed on 11<sup>th</sup> March 2017 with the statement of grounds of appeal.

VII. At the end of the oral proceedings held on 28<sup>th</sup> March 2019 in the absence of the Appellant the decision of the Board was announced.

### **Reasons for the Decision**

1. The appeal is admissible.

2. *Main request*

The Examining Division refused the application since the subject-matter of claim 1 of this request extended beyond the content of the application as filed due to the feature "metal tubular elements", and since the subject-matter of claim 1 lacked novelty with respect to document (10).

The Appellant did not provide any argument in the appeal proceedings against this decision. It merely stated that the observations on file are being maintained. However, these observations filed during the examining proceedings had already been considered by the examining division in the contested decision.

Accordingly, the Appellant provided no reason why the Board should deviate from the reasoning and conclusion of the examining division that claim 1 of the main request has been amended in such a way that it contains subject-matter extending beyond the application as filed, contrary to the requirement of Article 123(2) EPC, and that the subject-matter of claim 1 lacks novelty with respect to document (10) (Article 54 EPC).

Hence, the main request is rejected.

3. *Auxiliary requests 1 to 4*

Article 12(4) RPBA stipulates that the Board has the discretion to hold inadmissible requests filed during appeal proceedings which could have been presented in the first instance proceedings.

3.1 This application had been filed as a divisional application, the description, claims and figures being identical to those of the published parent application. In the written opinion accompanying the search report, novelty objections against the claimed subject-matter had been raised. In response to this opinion, the Appellant introduced the feature "metal tubular structural elements" in the claims filed on 4<sup>th</sup> October 2011, which claims were found by the Examining Division to contravene Article 123(2) EPC, as stated in the communications dated 2<sup>nd</sup> November 2012 and 23<sup>rd</sup> June 2015. The Applicant was invited to file new claims to overcome this objection.

On 22<sup>nd</sup> December 2015, the Appellant filed new claims 1 to 13, but still comprising the feature "metal tubular structural elements".

In the communication dated 5<sup>th</sup> February 2016 accompanying the summons to oral proceedings to be held on 23<sup>rd</sup> November 2016, the Examining Division highlighted the parts of claim 1 which had no basis in the application as filed. Furthermore, the Appellant was informed that document (10) was novelty destroying for claim 1.

With a letter dated 17<sup>th</sup> October 2016, the Appellant withdrew its request for oral proceedings and requested a decision according to the state of the file.

- 3.2 The Appellant did not follow the invitation of the Examining Division to file new claims to overcome the outstanding objection with respect to added matter, but instead requested a decision on the state of the file. In appeal proceedings it is therefore expected that the Appellant primarily intends to defend the grant of the patent on the basis of claims already pending before the examining division, unless there are compelling reasons not to do so.

However, in the appeal proceedings the Appellant did not bring any arguments in favour of its main request (see point 2 above). Instead it filed auxiliary requests 1 to 4. As compared to the main request, the Appellant dropped the contested feature "metal tubular elements", which had always been objected to contravene Article 123(2) EPC. The Appellant had already been confronted with the objection concerning this feature from the beginning of the examination proceedings. This objection was recurrent in every communication of the Examining Division. Under these circumstances, the Board considers that amended claims, possibly in the form of auxiliary requests, should have been submitted in the examining proceedings, all the more because the Appellant was invited by the examining division to do so.

In the appeal proceedings, the Appellant maintained the request filed on 22<sup>nd</sup> December 2015 which was rejected by the Examining Division in the contested decision without providing any explanation, thus impeding *de facto* the Examining Division to proceed to an

interlocutory decision pursuant to Article 109 EPC. The Appellant also did not give any reasons why it had awaited the stage of the appeal proceedings to remedy the examining division's objections by filing amended claims.

If the Board were to admit auxiliary requests 1 to 4, this would run counter to the main purpose of appeal proceedings which is primarily to examine the correctness of the first instance decision. It would also substantially lengthen the proceedings and thus be contrary to procedural efficiency. Indeed, by admitting auxiliary requests 1 to 4 into the appeal proceedings, a "fresh case" would result, requiring complete novel examination.

Under the present circumstances, the Board decides not to admit the auxiliary requests (Article 12(4) RPBA).



**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated