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**Datasheet for the decision  
of 23 August 2022**

**Case Number:** T 2239/18 - 3.2.06

**Application Number:** 10707629.1

**Publication Number:** 2395957

**IPC:** A61F13/00, A61F13/36,  
A61L15/42, A61M15/00

**Language of the proceedings:** EN

**Title of invention:**  
WOUND PACKING

**Patent Proprietor:**  
Smith & Nephew PLC

**Opponent:**  
KCI Licensing, Inc.

**Headword:**

**Relevant legal provisions:**  
EPC Art. 54, 84  
RPBA Art. 12(4), 12(2)  
RPBA 2020 Art. 13(1), 13(2)

**Keyword:**

Novelty - main request (no) - auxiliary request 1 (no)  
Claims - clarity - auxiliary request 2 (no)  
Amendment to appeal case - justification by party (no)  
Amendment after summons - exceptional circumstances (no) -  
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**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 2239/18 - 3.2.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.06**  
**of 23 August 2022**

**Appellant:** KCI Licensing, Inc.  
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**Respondent:** Smith & Nephew PLC  
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**Representative:** HGF  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
6 July 2018 concerning maintenance of the  
European Patent No. 2395957 in amended form.**

**Composition of the Board:**

**Chairman** M. Harrison  
**Members:** T. Rosenblatt  
W. Ungler

## Summary of Facts and Submissions

- I. The appellant (opponent) filed an appeal against the interlocutory decision of the opposition division in which the opposition division found that European patent No. 2 395 957 in an amended form met the requirements of the EPC.
- II. With its statement of grounds of appeal the appellant maintained its novelty objection (Article 54(1) and (2) EPC) against the subject-matter of claim 1 in view of  
  
D3 : US 5 080 661.
- The appellant also raised novelty and inventive step objections against *inter alia* dependent claims 14 and 15.
- III. With its letter of 18 March 2019 the respondent (patent proprietor) replied to the statement of grounds of appeal, requested dismissal of the appeal (main request) and further submitted three sets of amended claims corresponding to auxiliary requests 1 to 3.
- IV. In its rejoinder of 1 May 2019 the appellant raised *inter alia* objections under Articles 84, 123(2) and 56 EPC against the claims of auxiliary requests 1 to 3.
- V. With the respondent's letter of 24 December 2019 a new version of auxiliary request 1 was filed to replace the previously submitted version, as well as new auxiliary request 4 to 6.
- VI. By letter dated 16 June 2020 the appellant requested *inter alia* that the auxiliary requests 1 and 4 to 6 not

be admitted into the proceedings.

- VII. The parties were summoned to oral proceedings. The Board subsequently issued a communication under Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA 2020) in which it opined that the subject-matter of claim 1 of the main request appeared to lack novelty in view of D3. In regard to auxiliary request 1 of 24 December 2019 the Board questioned how the amendment to claim 1 further distinguished its subject-matter over D3 in terms of (implied) structural features. The objection raised under Article 84 EPC against *inter alia* claim 1 of auxiliary request 2 of 18 March 2019 was provisionally considered to have merit. Concerning the added features to claim 1 of auxiliary request 3, the Board noted that the respondent had not refuted the appellant's arguments. In regard to auxiliary requests 4 to 6 submitted on 24 December 2019, the Board stated that it intended not to admit these requests into the proceedings, considering *inter alia* that no reason was indicated upon their submission why these requests were filed only at this late stage of the procedure, nor why the objections raised by the appellant in regard to the subject-matter of the corresponding dependent claims forming the basis for the amendments would be overcome.
- VIII. With a further letter dated 5 August 2022 the respondent submitted an extract from Wikipedia relating to the expression "parallel" in geometry.
- IX. Oral proceedings before the Board took place on 23 August 2022.
- X. The appellant requested that the decision under appeal be set aside and the European patent be revoked.

XI. The respondent requested that the appeal be dismissed (main request), auxiliarily that the patent be maintained in amended form on the basis of one of auxiliary requests 1 to 6, auxiliary requests 1 and 4 to 6 filed with letter of 24 December 2019 and auxiliary requests 2 and 3 filed with letter of 18 March 2019.

XII. **Claim 1 of the main request** has the following wording:

"A wound packing material comprising a body of a porous material, the body comprising frangible regions defining a plurality of portions, the frangible regions allowing the portions to be selectively removed from the body, wherein the frangible regions are defined by partial pre-cuts formed in the body, wherein the body comprises: a first set of substantially parallel planar partial pre-cuts in a first orientation; a second set of parallel planar partial pre-cuts in a second orientation which is substantially perpendicular to the first orientation; and a third set of parallel planar partial pre-cuts in a third orientation which is substantially perpendicular to both the first and second set of pre-cuts."

The only amendment to **claim 1 of auxiliary request 1** is the following (underlining added by the Board):

"A wound packing material for shaping to fit a wound to be filled, comprising a body..."

Compared to claim 1 of the main request, **claim 1 of auxiliary request 2** comprises the following feature added at its end:

", wherein the portions are cubes having dimensions of between 10 to 20 mm."

Again compared to claim 1 of the main request, **claim 1 of auxiliary request 3** comprises the following feature added at its end (instead of the feature added in auxiliary request 2):

", wherein the body is entirely comprised of selectively removable cuboidal portions interconnected by frangible regions, wherein the cuboidal portions are cubic and have an edge length of from 10 to 20 mm."

**Claim 1 of auxiliary request 4** comprises in addition to the amendment made in auxiliary request 1 ("...for shaping to fit a wound to be filled...") the following feature added at its end:

", wherein each set of substantially parallel planar partial pre-cuts comprises a plurality of planar partial pre-cuts spaced from one another by a spacing, each planar partial pre-cut comprising a series of individual pre-cuts, each individual pre-cut being spaced from the adjacent pre-cut by a gap."

Compared to claim 1 of auxiliary request 2, **claim 1 of auxiliary request 5** comprises additionally the feature added in auxiliary request 4.

Compared to claim 1 of auxiliary request 3, **claim 1 of auxiliary request 6** also comprises additionally the feature added in auxiliary request 4

All requests further include independent method claims, the wording of which is not relevant to the present decision and is consequently not reproduced here.

XIII. The arguments of the appellant may be summarised as follows.

*Main request*

The subject-matter of claim 1 lacked novelty over D3. The reasoning in the impugned decision as well as the arguments by the respondent were based on an overly narrow interpretation of the wording of claim 1.

*Auxiliary request 1*

The expression "for shaping to fit a wound to be filled" introduced in claim 1 had to be interpreted as referring to the suitability for such a purpose. The wound dressing of D3 was suitable for shaping to fit a wound to be filled, because it was capable of being torn apart at any number of predetermined zones of separation with little or no fragmentation or free particle release (see D3 column 1, lines 62-67).

*Auxiliary request 2*

Claim 1 of auxiliary request 2 lacked clarity, because it was unclear what dimension of the cubes was being defined.

*Auxiliary request 3*

In writing, the appellant argued that the edge length of the cuboidal portions would have been an obvious/arbitrary design choice with no unexpected technical effect. In regard to the new line of arguments submitted by the respondent during the oral proceedings, based on the technical effects mentioned



in paragraph 29 of the patent in suit, the appellant argued that it had raised its objection of lack of inventive step already two months after the submission of this auxiliary request by the respondent and that the reasoning presented for the first time only at the oral proceedings before the Board could not be dealt with without taking further advice. In particular, D3 was silent about the dimensions of the removable portions and it was not clear which range of dimensions was considered to be common for the specific dressings known from D3.

*Auxiliary requests 4 to 6*

Auxiliary requests 4 to 6 were only filed in December 2019, thus after the respondent's reply to the grounds of appeal. The requests were filed without any justification for the amendment to the respondent's appeal case, in particular without any reasons for submitting the amendment at that stage of the appeal proceedings. The amendments in claim 1 of all auxiliary requests 4 to 6 gave rise to new objections under Article 123(2) and 84 EPC, due to the use of the expression "each set of...". This amendment was not derivable from the originally filed claims but was seemingly also based on the description as originally filed. It was not apparent that the passages on page 6 and 7 thereof disclosed the resulting subject-matter. Also, new auxiliary requests 4 to 6 did not overcome the objections of lack of novelty and inventive step raised in the appeal proceedings. Claim 1 of auxiliary request 5 furthermore lacked clarity for the same reason as auxiliary request 2.

XIV. The arguments of the respondent may be summarised as follows.

*Main request*

Based on the wording of claim 1 itself, the skilled person would have understood that it was necessary for the pre-cuts to be separated by a gap forming the frangible regions. Since the wording of claim 1 required "partial pre-cuts", i.e. in the plural, the absence of a gap would actually only result in a single, continuous cut. Moreover, it was also clear from the wording of claim 1 that the pre-cuts of each set were arranged in parallel, spaced apart planes. This understanding of the specific wording of claim 1 was reinforced by the teaching of the patent as a whole, such as by paragraphs 14, 15 and, for example, Figures 2 and 3.

Based on the correct construction of claim 1, it was thus clear that D3 did not disclose at least second or third sets of parallel planar partial pre-cuts.

*Auxiliary request 1*

The additional specification in claim 1 provided by the amendments reinforced the link between the ability to shape the wound packing material in three dimensions due to the selectively removable portions based on the presence of frangible regions in three dimensions.

*Auxiliary request 2*

Amended claim 1 complied with the clarity requirement since the use of the plural form for the term "dimensions" indicated to the skilled person that diagonal dimensions were excluded.

*Auxiliary request 3*

In the written procedure no arguments were submitted. During the oral proceedings, the respondent argued that D3 neither disclosed selectively removable, i.e. individually removable portions, nor the dimensions of the cuboidal portions. These distinguishing features provided the effects disclosed in paragraph 29 of the patent and involved an inventive step.

The submission of these arguments should be admitted into the proceedings due to the following exceptional circumstances: the specification of the patent was short and the amended claim wording was present throughout the entire proceedings. This could not be seen to present the appellant with a difficult situation which could not be resolved during the oral proceedings. Moreover, D3, which was anyway from a distant technical field, was a self-contained document which did not require any further consultation of the appellant.

*Auxiliary requests 4 to 6*

As far as the convergency of the requests was concerned, though not strictly convergent with the immediately preceding auxiliary request 3, auxiliary request 4 was nevertheless convergent with auxiliary request 1, auxiliary request 5 with auxiliary request 2 and auxiliary request 6 with auxiliary request 3. The amendments were straightforward and the appellant had had sufficient time to prepare for the discussion of the amendments. Moreover, the auxiliary requests 4 to 6 were filed before entry into force of the revised Rules of Procedure before the Boards of Appeal. The then applicable provisions had less strict requirements, in

particular in regard to the requirement for substantiation when filing amended requests. Moreover, it was clear from the letter accompanying their submission that the auxiliary requests were intended to reply to statements made by the appellant in regard to the main request on page 2 of its letter of 1 May 2019.

In regard to the substance of the amendments, the respondent indicated that those made in auxiliary request 4 were based on originally filed claims 8 and 15 to 18. The introduction of the term "each" was further supported by the Figures, as well as by page 6, lines 18 to 22 and the second full paragraph on page 7 of the originally filed description. These amendments served to help further clarify how the frangible regions were defined by the pre-cuts (and gaps between pre-cuts) in the three mutually perpendicular directions. Such cuts were clearly not present in the cited prior art.

In regard to auxiliary request 5, the added features in claim 1 (the same as in auxiliary request 4) resolved the clarity issue.

In regard to auxiliary request 6, the resulting feature combination of claim 1 was not disclosed by or derivable from D3.

## **Reasons for the Decision**

### *Main request*

1. The subject-matter of claim 1 of the main request lacks novelty in regard to the wound packing material

disclosed in Figures 1 and 3 of D3 (Article 54(1) and (2) EPC).

- 1.1 It is undisputed that the wound packing material shown in for example Figure 1 of D3 comprises a body (11) of a porous material, the body comprising frangible regions (septum 19) defining a plurality of portions (segments 10a-10e), the frangible regions allowing the portions to be selectively removed from the body, wherein the frangible regions are defined by partial pre-cuts (16, 17) formed in the body. It is also undisputed that the body comprises a first set of substantially parallel planar partial pre-cuts (16, 17) in a first orientation.
- 1.2 The Board finds that the body (11) of the wound packing material of D3 also comprises the second and third sets of parallel planar partial pre-cuts according to claim 1, as explained below.
  - 1.2.1 As a preliminary remark it is noted that the terms "parallel", "planar" and "partial" are all adjectives qualifying the "pre-cuts", as also argued by the appellant. The skilled person would thus understand the complete expression "parallel planar partial pre-cuts" to mean within the broadest technically meaningful sense that the individual pre-cuts of each set must have a partial extension through the body, rather than extending entirely through it, that they are required to be "planar" rather than being, for example, curved, and within each of the sets they shall be "parallel" to each other albeit in an undefined direction. The Board cannot see any explicit or implicit definition in the wording of claim 1 excluding the partial pre-cuts from lying close to each other without any material or any spacing inbetween them. Nor does the wording of claim 1

exclude that the planar partial pre-cuts can extend in one and the same plane (see also below).

1.2.2 Based on this interpretation of the wording of claim 1, the second set of pre-cuts according to claim 1 is then considered to be embodied in D3 by the set of pre-cuts extending in Figure 1 downward from the top face (13) of the illustrated body to underneath the longitudinal midline (14) or the cross-slit (15), so as to constitute cuts of limited width in the longitudinal direction (which all together may be considered to add up in the longitudinal direction to correspond to the length of the longitudinal slit 12). More precisely, the second set of pre-cuts are considered to correspond to the five downward extending sections of the primary slit (12) separating each of the segments 10a to 10e into the respective two upper cuboidal sub-segments to the left and to the right of the primary slit and which each end below the midline. The third set of pre-cuts is embodied by the sections of the cross slit (15) extending to the respective left and right hand side of the longitudinal midline (14) in the longitudinal direction (y; 14) through the thickness of the segments, similar to the pre-cuts of the second set and in a perpendicular direction thereto.

In both the second and third sets, the pre-cuts are also partial pre-cuts, as defined in the claim, since they do not extend entirely through the material of the body. A different definition of a pre-cut is not given.

It is uncontested that in the wound packing material known from D3, the first, second and third sets of partial pre-cuts extend in the directions of the respective three Cartesian coordinate axes so that the sets meet the further requirement of the mutual

perpendicular orientations defined in the claim.

All pre-cuts of the second and third sets, like those of the first set, would be understood by the skilled person to be planar (rather than bent or curved). At least this has not been contested by the respondent.

Finally the Board considers also the (planar partial) pre-cuts of the second set, as well as those of the third set, to be parallel. For example, the five pre-cuts of the previously identified second set which in Figure 1 of D3 extend downwards through each of the segments 10a-10e to below the central line 14, can be considered parallel in regard to the orientation of their downward extending sides, like two (very close) rails, despite lying in the same plane.

Consequently, all features of claim 1 are disclosed by the wound packing material of D3 so that the subject-matter of claim 1 lacks novelty (Article 54(1) and (2) EPC).

2. The respondent's arguments were unconvincing because they were essentially based on a narrow interpretation of the claim, which is unwarranted. According to the respondent the claim would be understood by the skilled person to mean that the three sets of parallel planar partial pre-cuts implied an arrangement of the partial pre-cuts in different parallel planes which were spaced apart from each other, and that the partial pre-cuts in each plane were additionally separated from each other by a gap (constituted by body material) so as to form the frangible regions.

- 2.1 On the one hand the respondent based this understanding on the wording of the claim itself, i.e. independent of

the remaining parts of the patent. The way in which claim 1 was drafted - starting with a rather broad definition of the frangible regions defined by partial pre-cuts in a first part, which was subsequently getting narrower by the definition of the three sets of parallel planar partial pre-cuts - implied a clear link between the frangible regions defined in the first part of the claim and the constitution of the sets of pre-cuts defined subsequently. The definition of the frangible regions by partial pre-cuts would thus imply the presence of frangible regions between all the pre-cuts of each set.

However, the Board concludes that claim 1 according to its first part, which is directed to features of the body ("comprising a body of a porous material, the body comprising...") to only require that the body must comprise some frangible regions (which define a plurality of selectively removable portions) which are defined by partial pre-cuts. This however does not exclude that other partial pre-cuts may be present which do not define frangible regions and which may serve a different function than allowing selective removability of body portions. The second part of the claim is also directed to (other) features of the body ("wherein the body comprises:..."), rather than clearly further specifying the previously defined ensemble of its features (frangible regions, removable portions, pre-cuts). A clear link between the partial pre-cuts defining the frangible portions in the first part of the claim and the pre-cuts constituting the three sets according to the second part of the claim is missing. It is not even defined that any (at all) of these sets of pre-cuts necessarily defines the previously mentioned frangible regions, let alone that these mutually perpendicularly oriented sets of pre-cuts are



linked to the selectively removable portions.

Thus, on the basis of its very wording, claim 1 does not define or imply the presence of gaps, let alone gaps constituted by pieces of material, or indeed of frangible regions between the parallel planar partial pre-cuts of the three sets, nor does it define or imply the arrangement of these planar partial pre-cuts in spaced apart parallel planes.

- 2.2 In support of its interpretation, the respondent referred additionally to several parts of the description and to Figures 2 and 3, arguing that taking the teaching of the patent as a whole the above given interpretation was reinforced.

Irrespective of the fact that there is no reason to adopt a limited interpretation of the claim language in the light of the description, the description in paragraphs 15 or 16, referred to by the respondent, anyway does not comprise any definition of the terms employed in the claim indicating a specific meaning given to them throughout the patent. Although paragraph 15 mentions *inter alia* a spacing between planes, there is no indication that "parallel planar partial pre-cuts" is synonymous to partial pre-cuts arranged in parallel planes. The entire passage of paragraphs 14 to 16 contains a more detailed description of the (first) set of parallel planar partial pre-cuts, disclosing features which are not defined, either explicitly or implicitly, by claim 1. Similarly, no different conclusion can be drawn when considering the drawings.

- 2.3 Finally, the respondent's argument that the pre-cuts embodied by the slits 12 and 15 in the wound packing material according to Figure 1 of D3 are continuous,

forming a single cut, without any separation or gap constituted by material between pre-cuts, does not alter the Board's conclusion. Claim 1 is directed to a product, so that it is irrelevant how the pre-cuts are produced, i.e. whether the pre-cuts are formed by a single cutting operation or by multiple cuts. Moreover, as explained above, the claim does not require the pre-cuts of the three sets to be formed between gaps made of severable material or frangible regions. The pre-cuts in Figure 1 of D3 identified above and equated with those of the second and third sets are anyway also discontinuous, since each pre-cut extends in the body material between the vertical surfaces delimiting the individual segments 10a-10e. And last but not least, there is no requirement for a non-zero distance between pre-cuts in order for them to be parallel pre-cuts. For example, two rails having straight edges could be arranged at a distance so that their edges are parallel. The distance between them could then be reduced, keeping them parallel, until they touch. The rails would still be parallel, with no distance between them. The same applies to the partial pre-cuts embodied by the sections of the slits 12 and 15 in Figure 1 of D3. The article on the meaning of "parallel" in geometry from Wikipedia, submitted with its letter of 5 August 2022, also does not contradict the interpretation adopted by the Board.

3. Since the subject-matter of claim 1 of the main request lacks novelty over D3 (Article 54(1) and (2) EPC), the patent cannot be maintained on the basis of the main request.

*Auxiliary request 1*

4. The subject-matter of claim 1 of auxiliary request 1 also lacks novelty over D3 (Article 54(1) and (2) EPC).
- 4.1 The only amendment of claim 1 of auxiliary request 1 is the insertion of the purpose "for shaping to fit a wound to be filled" in the designation of the subject-matter. As already indicated in the Board's preliminary opinion, it is not recognisable how the added definition further distinguishes the subject-matter of claim 1 over D3 in terms of (implied) structural features. The respondent's argument submitted during the oral proceedings, that the added purpose reinforced the arguments on the presence of frangible regions between all partial pre-cuts of the three sets, allowing the removability of the portions so as to shape the body in three dimensions, is unconvincing. The claim establishes no link between the added purpose or suitability and the remaining features of the claim. The wound dressing of D3 is suitable for shaping to fit a wound to be filled, because it is capable of being torn apart at any of a number of predetermined zones of separation with little or no fragmentation or free particle release (see D3, column 1, lines 62-67), as also argued by the appellant and not refuted by the respondent.
- 4.2 Irrespective of the question of whether auxiliary request 1 should be admitted into the proceedings, the request for maintenance of the patent on the basis of auxiliary request 1 is anyway not allowable since the subject-matter of claim 1 still lacks novelty over D3 (Article 54(1) and (2) EPC).

*Auxiliary request 2*

5. Claim 1 of auxiliary request 2 does not meet the clarity requirement of Article 84 EPC.
  - 5.1 The feature added at the end of claim 1 refers to the (selectively removable) portions being cubes which have dimensions in a certain range of values. It is unclear if the dimension is the edge length, a diagonal of a face, or an internal/body diagonal; all of which are "dimensions", but with different values. The Board is not convinced by the respondent's argument provided only during the oral proceedings that the use of the plural form "dimensions" made it clear to the skilled person that only the length of the cube edges could be meant. The Board cannot see any reason for which the simple use of the plural necessarily excludes the other possible meanings of "dimension".
  - 5.2 Since claim 1 does not meet the clarity requirement of Article 84 EPC, the patent can also not be maintained on the basis of auxiliary request 2.

*Auxiliary request 3*

6. The Board exercised its discretion to exclude auxiliary request 3 from the proceedings under Article 12(4) RPBA 2007 for the following reasons.
  - 6.1 Article 12(2) RPBA 2007 (which essentially corresponds to Article 12(3) RPBA 2020) requires inter alia that the appeal grounds and the reply shall contain a party's complete case. They shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on.

According to Article 12(4) RPBA 2007, which is applicable according to Article 25(2) RPBA 2020 to the present case, without prejudice to the power of the Board to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first instance proceedings, everything presented by the parties under Article 12(1) RPBA 2007 shall be taken into account by the Board if and to the extent it relates to the case under appeal and meets the requirements in Article 12(2) RPBA 2007.

6.2 On page 11 of its statement setting out the appeal grounds, novelty and inventive step objections were raised against the subject-matter of all dependent claims, including claims 14 and 15.

6.3 Auxiliary request 3 was filed together with the respondent's reply to the appellant's statement containing the grounds of appeal. The features added to claim 1 are based on dependent claims 14 and 15 of the main request.

When filing auxiliary request 3, the respondent made only a brief reference to an earlier version of this request submitted during the proceedings before the opposition division. However, no substantiation for the amendments, in particular why they would overcome the outstanding objections raised by the appellant in the grounds of appeal can be found, either in the respondent's letter accompanying the submission of auxiliary request 3, or in any of its subsequent letters.

It is noted that the appellant had also filed a reply shortly (less than two months) after the submission of auxiliary request 3, maintaining and repeating the

objections raised against the subject-matter of the amended claim 1 of this request.

- 6.4 Only at the oral proceedings before the Board did the respondent reply for the first time to the objections against claim 1 of auxiliary request 3.
- 6.4.1 The respondent made submissions relying on new factual elements intended to prove the presence of an inventive step based essentially on the edge length of the cubes ranging from 10 to 20 mm, as defined in the final feature of claim 1 which is based on dependent claim 15 of the main request. The respondent contested in particular the appellant's central arguments, according to which the mentioned distinguishing feature was based on an arbitrary selection. To the contrary, the defined range of the cube's edge length would rather contribute to the effects mentioned in paragraph 29 of the description of the patent in suit. Such effects could not be derived in an obvious manner from D3 which was silent about the dimensions of corresponding features.
- 6.4.2 These new submissions cannot be considered to represent just a development of an argument presented earlier in the procedure. Instead they rather rely on new facts brought to the attention of the Board and the appellant, and would moreover involve the exercise of further fact finding, for example with respect to the question of which edge length of the removable portions in a wound packing material according to D3 the skilled person would normally consider as required.
- 6.4.3 Consequently the substantiation in regard to the question of why the amended claim 1 of auxiliary request 3 would overcome the outstanding novelty and inventive step objections, filed for the first time

during the oral proceedings, represents an amendment to the respondent's appeal case (see above item 6.1) within the meaning of Article 13 RPBA 2020. More particularly, since the amendment was made after the notification of a summons to oral proceedings, it shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned (Article 13(2) RPBA 2020, which is applicable in the present case according to Article 25(3) RPBA 2020).

6.4.4 In the present case the Board cannot see any exceptional circumstances, justified with cogent reasons for taking the new submissions into account. The respondent pointed in essence to the relatively short specification and the technical simplicity of the issues to be considered. Besides being questionable whether these aspects (length of specification, technical complexity) could be considered as indicators of exceptional circumstances at all - see also the explanatory remarks on Articles 12(4), 13(1) and 13(2) RPBA 2020 and the intention to establish a three level convergency approach for amendments of a party's case, pages 56 to 60 of the Supplementary publication 2, OJ EPO 2020 - it remains unanswered why such allegedly simple considerations could not have been made earlier in the written procedure in response to the appellant's early and repeated objections. It was not alleged and the Board also does not consider it to be the case that the appellant or the Board itself had introduced in the written procedure any new considerations which could possibly justify the submissions relying on new factual elements at this late stage of the procedure. Nor had any new considerations arisen during the oral proceedings.

Consequently the Board exercised its discretion not to take into account the respondent's submissions directed to the issue of substantiation of auxiliary request 3 made for the first time in the oral proceedings before the Board under Article 13(2) RPBA 2020.

- 6.5 As a result, auxiliary request 3 cannot be considered to be substantiated, meaning that the respondent failed to comply with the requirements of Article 12(2) RPBA 2007 (which essentially corresponds to Article 12(3) RPBA 2020) so that the sanction in Article 12(4) RPBA 2007 becomes applicable. The Board thus decided to exclude auxiliary request 3 from the proceedings under Article 12(4) RPBA 2007.

*Auxiliary requests 4 to 6*

7. The Board exercised its discretion not to admit auxiliary requests 4 to 6 into the proceedings (Article 13(1) RPBA 2020).
- 7.1 Auxiliary requests 4 to 6 were submitted after the respondent's reply to the grounds of appeal and contain substantive amendments, and therefore constitute an amendment to its appeal case.
- 7.2 According to Article 13(1) RPBA 2020, which is applicable to the present case pursuant to Article 25(1) RPBA 2020, these amendments are subject to the party's justification for its amendment and may be admitted only at the discretion of the Board.

Article 12, paragraphs 4 to 6, shall apply *mutatis mutandis*.

The party shall provide reasons for submitting the



amendment at this stage of the appeal proceedings.

The Board shall exercise its discretion in view of, inter alia, the current state of the proceedings, the suitability of the amendment to resolve the issues which were admissibly raised by another party in the appeal proceedings or which were raised by the Board, whether the amendment is detrimental to procedural economy, and, in the case of an amendment to a patent application or patent, whether the party has demonstrated that any such amendment, prima facie, overcomes the issues raised by another party in the appeal proceedings or by the Board and does not give rise to new objections.

- 7.3 The Board does not accept the respondent's argument that the corresponding criteria for the submission and admittance of auxiliary requests in view of the required substantiation was "more relaxed" under the old version of Article 13(1) RPBA 2007. First, this is actually irrelevant, since when the RPBA 2020 came into force, the criteria under Article 13(1) RPBA 2020 became applicable and not those under Article 13(1) 2007 (see Article 25(1) RPBA 2020). Nevertheless, for completeness the Board has considered its submissions. Even though it may be perceived that the wording of Article 13(1) RPBA 2020 imposes more hurdles on the parties which make amendments to their appeal case, at least in as far as the requirements for substantiation are concerned, this was also previously considered by the established case law to be necessary to a similar extent as now explicitly required in the revised provision. For the sake of brevity, reference is only made to section V.A.4.12.5 of the Case Law of the Boards of Appeal in the 9th Edition from 2019 (see also section V.A.4.4.4 of the 10th Edition from 2022), i.e.

the version available in the year in which auxiliary requests 4 to 6 were filed (in fact, the requests were submitted only one week before the entry into force of the revised version). The respondent also did not identify any particular additional requirement which it could not have been expected to comply with upon submission of its requests or give any reason why this might be the case.

8. Contrary to the provisions of Article 13(1) RPBA 2020, the respondent gave no reason for submitting auxiliary requests 4 to 6 only at this stage of the appeal proceedings, as argued by the appellant in its letter dated 16 June 2020.
  
9. In claim 1 of auxiliary request 4 the features previously added in auxiliary request 3 are replaced by a different feature, allegedly based on only originally filed dependent claims. The request is thus at least not convergent with auxiliary request 3 and rather would redirect the case in a different direction. The amendment in auxiliary request 4 is therefore considered detrimental to procedural economy. The fact that auxiliary request 4 was based on auxiliary request 1 and thus should be considered convergent with this request, as argued by the respondent during the oral proceedings, does not change the Board's conclusion on lacking convergency. The order of the requests was determined by the respondent. It was confirmed at the beginning of the oral proceedings. The order in which the auxiliary requests were asked to be considered involved the consideration of auxiliary requests 2 and 3 before addressing auxiliary request 4. Both of these intermediate auxiliary requests were directed to different amendments, which the Board and the appellant had to address. Consequently, within the sequence of

requests chosen by the respondent, auxiliary request 4 is not convergent.

Taking into account all circumstances, including the lack of any reason for its late submission (see point 8. above), the Board exercised its discretion according to Article 13(1) RPBA 2020 not to admit auxiliary request 4 into the proceedings.

10. Claim 1 of auxiliary request 5 comprises the same feature introduced into auxiliary request 2 and which the Board considered not to comply with the clarity requirement of Article 84 EPC in regard to the question of which dimensions of the cubes were referred to. The respondent considered the further feature introduced at the end of claim 1 to clarify the preceding unclear feature. However, the details pertaining to the constitution of the sets of pre-cuts together with the definition of a gap, does not clarify the open question. In other words, the additional definition of gaps can not answer the question of which dimension (facial or spatial diagonals or along edges) of the cubes is being referred to. The Board therefore considers that, *prima facie*, the clarity objection under Article 84 EPC is not overcome and exercised its discretion according to Article 13(1) RPBA 2020 also not to admit auxiliary request 5 into the proceedings.
11. In claim 1 of auxiliary request 6 the unclear feature present in claim 1 of auxiliary request 5 is replaced by the features added in auxiliary request 3.
  - 11.1 Compared to claim 1 of auxiliary request 4, the feature concerning the suitability of the wound packing material for shaping to fit the wound, is again deleted. This indicates already a lack of convergency

of auxiliary request 6 with the higher ranking requests.

11.2 Moreover, the basis indicated for the amendments in auxiliary request 6 in the respondent's letter of 24 December 2019 does not appear to be complete. As became apparent during the discussions in the oral proceedings in regard to an objection under Article 123(2) EPC raised by the appellant previously in writing, further basis is taken from the description of the application as filed (on pages 6 and 7 thereof). Further discussion would thus have been required concerning the disclosure of the claimed subject-matter in the application as filed.

11.3 Finally, no substantiation was given why the amendments to claim 1 of auxiliary request 6 could overcome the outstanding issues, in particular why the resulting subject-matter involved an inventive step.

The only motivation for the introduction of the final feature into claim 1 of auxiliary request 6 was given by reference to auxiliary request 4 in which this feature had been introduced for the first time. It was argued that this feature helped to further clarify how the frangible regions are defined by the pre-cuts (and gaps between pre-cuts) in the three mutually perpendicular directions, and that such cuts were clearly not present in the cited prior art. The Board considers this rather general statement insufficient since it cannot be inferred which particular aspect of the cuts was considered to entail novelty, let alone which technical problem might be solved by such potentially differentiating feature.

11.4 It is thus questionable whether the amendment is *prima facie* allowable, in the sense that it would overcome the outstanding objection (inventive step, see point 11.3) raised by the appellant without giving rise to new objections (Article 123(2) EPC, see point 11.2).

11.5 Taking into account all circumstances accompanying the submission of auxiliary request 6, the Board exercised its discretion according to Article 13(1) RPBA 2020 not to admit the request into the proceedings.

12. Absent any set of claims complying with the requirements of the EPC, the patent has to be revoked (Article 101(3) (b) EPC).

## Order

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

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



D. Grundner

M. Harrison

Decision electronically authenticated