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**Datasheet for the decision
of 18 January 2023**

Case Number: T 2091/19 - 3.2.08

Application Number: 09807104.6

Publication Number: 2349107

IPC: A61F2/28, A61L27/16, A61L27/56

Language of the proceedings: EN

Title of invention:
CUSTOMIZED IMPLANTS FOR BONE REPLACEMENT

Patent Proprietor:
Oxford Performance Materials, Inc.

Opponent:
Solvay Specialty Polymers USA, LLC

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
Amendments - allowable (no)



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Case Number: T 2091/19 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 18 January 2023

Appellant: Solvay Specialty Polymers USA, LLC
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
21 May 2019 concerning maintenance of the
European Patent No. 2349107 in amended form.**

Composition of the Board:

Chairman C. Schmidt
Members: G. Buchmann
C. Vetter

Summary of Facts and Submissions

- I. With the decision posted on 14 May 2019 the opposition division decided to maintain the patent based on the then valid auxiliary request 5 (filed during the oral proceedings in opposition at 11:12).
- II. The opponent filed an appeal against that decision.
- III. The appellant (opponent) requested that the decision under appeal be set aside and the patent be revoked.

The respondent (proprietor) requested that the patent be maintained on the basis of auxiliary request 5 as filed during the oral proceedings in opposition at 11:12 (main request), or alternatively on the basis of the auxiliary request as filed with the reply to the appeal.

Furthermore, the respondent requested oral proceedings.

However, with letter dated 19 December 2022 the respondent announced not to attend the oral proceedings scheduled for 16 March 2023.

IV. Claims

Claim 1 of the main request reads:

"A customized implant or scaffold for bone replacement comprising selective laser sintered poly(ether ketone ketone) (PEKK) capable of ongrowth/ingrowth of tissues and with a substantially uniform cross-sectional morphology, which has a porosity greater than 35%."

Claim 2 of the main request reads:

"The customized implant or scaffold of claim 1 modified to add at least one feature selected from the group consisting of

- (a) openings to encourage bone, vascular and nerve ingrowth,
- (b) adding surface pores to hold therapeutic agents, and
- (c) adding surface anchors and/or threaded holes."

In the auxiliary request, the words "or scaffold" have been deleted from all claims.

- V. The arguments of the respondent can be summarised as follows:

From paragraphs [0006] and [0028] of the A1 publication of the application, it became clear that the subject-matter of claim 2 was not restricted to any specific embodiment. Also paragraph [0020] mentioned the subject-matter of claim 2 without limitation to any embodiment. Therefore, claim 2 fulfilled the requirements of Article 123(2) EPC.

- VI. The arguments of the appellant can be summarised as follows:

During the opposition proceedings, claim 1 had been restricted to the second embodiment of the application.

However, dependent claim 2 contained features which were disclosed only for the first embodiment. Hence, present claim 2 contravened Article 123(2) EPC.

Reasons for the Decision

1. Main request

1.1 Amendments in claim 2 - Article 123(2) EPC

1.1.1 The application as originally filed describes two embodiments of the implant: A low porosity implant (Al publication of the application, paragraphs [0015]-[0017] and [0039]-[0040]) and a high porosity implant, having a porosity of more than 35% (paragraphs [0018] and [0041]-[0042]). The paragraphs [0020] and [0043] are regarded as referring to both embodiments.

During the opposition proceedings, claim 1 was restricted to the second embodiment which is the high porosity implant.

1.1.2 Dependent claim 2 specifies, among other features, a) openings to encourage bone, vascular and nerve ingrowth.

1.1.3 The wording of feature a) is disclosed in paragraph [0040] which refers, however, explicitly to the implants of the first embodiment only.

Paragraph [0020] which is regarded as referring to both embodiments, mentions "open cell regions for scaffolding". This wording can not form a basis for feature a) which requires "openings to encourage bone, vascular and nerve ingrowth".

Paragraph [0006] represents only a general reference to further manufacturing steps to facilitate fixation of

the implant. Paragraph [0028] describes parts of the numeric algorithms used to manufacture the implant. No reference is made to openings to encourage bone, vascular and nerve ingrowth.

Therefore, the application as originally filed does not disclose an implant having a porosity of more than 35% (claim 1) and having openings to encourage bone, vascular and nerve ingrowth (claim 2 a)).

- 1.1.4 Therefore, the subject-matter of claim 2 which depends on amended claim 1, goes beyond the content of the application as originally filed and contravenes Article 123(2) EPC.

2. **Auxiliary request**

The amendment made in the auxiliary request does not have any effect on the above deficiency.

3. The patent is therefore to be revoked.

This decision could be taken in writing because the respondent's announcement not to attend the oral proceedings scheduled for 16 March 2023 is treated as equivalent to a withdrawal of the request for oral proceedings (see Case Law of the Boards of Appeal of the European Patent Office, 10th edition 2022, III.C. 4.3.2 and the decisions cited there).

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:



C. Moser

C. Schmidt

Decision electronically authenticated