

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [-] To Chairmen
- (D) [X] No distribution

**Datasheet for the decision
of 6 July 2023**

Case Number: T 1452/20 - 3.2.06

Application Number: 14752356.7

Publication Number: 3021806

IPC: A61F13/00

Language of the proceedings: EN

Title of invention:
APPARATUS FOR WOUND THERAPY

Patent Proprietor:
Smith & Nephew PLC

Opponent:
KCI Licensing Inc.

Headword:

Relevant legal provisions:

EPC Art. 54
RPBA 2020 Art. 13(2)

Keyword:

Novelty - main request (no)
Amendment to appeal case - taken into account (no)

Decisions cited:

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1452/20 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 6 July 2023

Appellant: KCI Licensing Inc.
(Opponent) P.O. Box 659508
San Antonio , TX 78265 (US)

Representative: Simmons & Simmons
City Point
One Ropemaker Street
London EC2Y 9SS (GB)

Respondent: Smith & Nephew PLC
(Patent Proprietor) 15 Adam Street
London WC2N 6LA (GB)

Representative: HGF
HGF Limited
1 City Walk
Leeds LS11 9DX (GB)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 16 April 2020
rejecting the opposition filed against European
patent No. 3021806 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman M. Harrison
Members: M. Hannam
W. Ungler

Summary of Facts and Submissions

- I. An appeal was filed by the appellant (opponent) against the decision of the opposition division rejecting the opposition to European patent No. 3 021 806. It requested that the decision under appeal be set aside and the patent be revoked.
- II. In its reply to the appeal, the respondent (patent proprietor) requested that the appeal be dismissed or, in the alternative, that the patent be maintained according to one of four auxiliary requests.
- III. The following documents are relevant to the present decision:
- D1 WO-A-2010/092334
- 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 subject-matter of claim 1 of the main request lacked novelty over D1 and that, being unsubstantiated, the auxiliary requests might not be admitted.
- V. With letter of 16 June 2023 the respondent filed a new auxiliary request replacing all auxiliary requests previously on file.
- VI. Oral proceedings were held before the Board on 6 July 2023, at the end of which the requests of the parties were as follows:

The appellant requested that the decision under appeal be set aside and the European patent be revoked.

The respondent requested that the appeal be dismissed (main request), or in the alternative that the patent be maintained in amended form on the basis of the auxiliary request filed with letter of 16 June 2023.

VII. Claim 1 of the main request reads as follows (with feature annotation as used by the appellant in its grounds of appeal):

"a A wound treatment apparatus comprising:
b a body of a porous material, the body comprising
c frangible regions defining a plurality of
portions,
d the frangible regions allowing the portions to be
selectively removed from the body so as to form a
recess in the body,
e the recess being bound by a bottom surface and a
wall portion; and
f a secondary wound filler
g for positioning within the recess in the body."

The wording of claim 1 of the auxiliary request is not relevant for the decision taken on the request.

VIII. The appellant's arguments relevant to the present decision may be summarised as follows:

The subject-matter of claim 1 lacked novelty over the Fig. 4 embodiment of D1. The 'secondary wound filler' of claim 1 could be any additional wound filler, even one of the same material as the main body of porous material. A primary wound filler was not claimed, yet the skilled person would view the large body of Fig. 4 as the claimed 'body of porous material', and being larger it would be considered the 'primary' portion of

the claimed apparatus, the block 12, being smaller, reasonably being the secondary wound filler. Block 12 was certainly suitable for positioning with the recess in the body. It was irrelevant from where the parts anticipating claim 1 came; the claim was to a product so D1 simply had to disclose features complying with the claim.

No exceptional circumstances could be recognised justifying that the auxiliary request be taken into account. The novelty objection had been raised with the grounds of appeal so no new issue had arisen for the first time with the Board's preliminary opinion which might have justified admittance of the new auxiliary request.

IX. The respondent's arguments relevant to the present decision may be summarised as follows:

The opposition division's conclusion on novelty with respect to the Fig. 4 embodiment of D1 was entirely correct. D1 (see page 15, first paragraph) failed to disclose a secondary wound filler. D1 disclosed just a single body, albeit with a small block removed i.e. seen in total, a single entity. The portion 12 removed from body 10 was still a portion of the block. In contrast, claim 1 defined a secondary body in addition to a first body of porous material.

The auxiliary request should be taken into account since exceptional circumstances existed to warrant its admittance. A broad view of the 'exceptional circumstances' should be considered, such as the auxiliary request simplifying the case relative to the previous auxiliary requests on file, thus allowing a decision to be taken without remittal to the opposition

division. The Board had also referred to paragraph [0020] of D2 for the first time and placed particular emphasis on the drape of D1, which issues had not been raised by the appellant. Therefore an opportunity to overcome these new issues was justified.

Reasons for the Decision

1. *Main request*

Novelty

1.1 The Board finds, and both parties concurred, that D1 disclosed features a to e of claim 1. The Board further finds that D1 discloses a secondary wound filler (e.g. portion 12 of D1) for positioning within the recess in the body (body 10 of D1). The body of porous material and the secondary wound filler are shown side-by-side in Fig. 4.

1.2 As to the respondent's contention that the 'secondary wound filler' must be distinctly different to the 'body of a porous material', this is not accepted. Paragraph [0095] of the patent indicates that any additional wound filler, wound packing member, wound support member, stabilizing structure and/or wound closure device can be located in the recess of the porous material and that these are generally referred to as 'secondary wound fillers'. The term 'secondary wound filler' is thus a broad term and can, for example, be a filler of the same material as the 'body of porous material' (that it could even be of the same material was not disputed). There is also no limitation inherent in the term 'secondary wound filler' as to how, or from where, the secondary wound filler is provided. In view

of such interpretation of what the claimed secondary wound filler can be, portion 12 of D1 anticipates this: it meets the 'definition' of a secondary wound filler given in paragraph [0095] of the patent and is suitable for positioning within the recess 22 in the body, not least since this is where it came from.

1.3 The respondent's argument that D1 disclosed just a single body whilst claim 1 defined a secondary body in addition to a (first) body of porous material is not accepted. It is immaterial from where the portion 12 depicted in Fig. 4 of D1 was taken, since claim 1 is directed to a product; the features simply have to be unambiguously disclosed. D1 unambiguously discloses a body of porous material (body 10) and additionally a secondary body (portion 12) satisfying the definition of a secondary wound filler. The term 'secondary' puts no further limitation on the structural features of the wound filler. Indeed, the block 10 in D1 can be referred to as a primary block and the portion 12 in D1, not least due to it being smaller, can be termed a secondary component.

1.4 The respondent's reference to the opposition division's decision does not allow novelty of the subject-matter of claim 1 to be recognised. The opposition division found that claim 1 defined two separately identifiable entities, one being the porous body and one being the secondary filler which had to be identifiable 'from the very beginning'.

The Board does not accept the 'from the very beginning' limitation read into claim 1 regarding the separately identifiable entities. Claim 1 is directed to a wound treatment apparatus, and physical features of this apparatus are claimed. How these physical features came

into being, or from where they came, is immaterial and not defined in the claim. Even if the Fig. 4 embodiment of D1 discloses a body 10 and a portion 12 which were 'at the very beginning' part of a single entity, this is irrelevant as regards the scope of claim 1. The wound packing disclosed in the Fig. 4 embodiment of D1 comprising the body 10 and portion 12 thus anticipate the claimed body of porous material and the secondary wound filler.

- 1.5 The respondent's further argument that the features of claim 1 had to be understood in the context of a product before use, which the respondent then ascribed to the entire block 10 (including the subsequently extracted portion 12), is also not convincing. When extracting the portion 12 from the block, the block has still not been used; the situation shown in Fig. 4 is that before the body 10 is used for filling any wound.
- 1.6 The subject-matter of claim 1 thus lacks novelty over D1. Hence, the ground for opposition under Article 100(a) in conjunction with Article 54 EPC prejudices maintenance of the patent as granted.

2. *Auxiliary request*

- 2.1 According to Article 13(2) RPBA 2020, any 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.
- 2.2 The auxiliary request was filed after notification of the summons to oral proceedings, such that the

provisions of Article 13(2) RPBA 2020 apply.

2.3 The respondent maintained that the Board had preliminarily decided on the novelty objection with reference to a particular passage in D2 which had not been included in the appellant's grounds of appeal. Irrespective of the fact that the objection based on D2 has not been relied upon in the final decision regarding the main request, the respondent's contention regarding D2 is true only insofar as reference was explicitly made by the Board to paragraph [0020] which had only implicitly been referred to by the appellant. Nonetheless, the fundamental novelty objection based on D2 was identical in both the appellant's grounds of appeal (cf. in particular point 7.2.1 and 7.2.2 of the statement of grounds of appeal as regards the covering sheet 13 ('drape')) and in the Board's preliminary opinion (cf. point 1.3 of the Board's communication) such that the explicit reference to paragraph [0020] introduced no new factual situation which the respondent had been unable to address in its reply to the grounds of appeal. Indeed, in the feature-by-feature analysis used by the appellant (see item 7.1.1 of the grounds of appeal), the reference in D2 for 'feature a' is Figures 5a and 5b, to which paragraph [0020] is directed. The Board thus fails to see any exceptional circumstances justifying a new request being taken into account.

2.4 The Board providing a preliminary opinion on an objection can also not be seen as having resulted in an exceptional circumstance. In contentious *inter partes* proceedings, finding against one of the parties is necessarily the norm such that appropriate fall-back positions should normally always be filed already as part of the respondent's complete appeal case (see

Article 12(2) RPBA 2020), when responding to the appeal. Nothing in the present case justifies diverging from that normal situation.

2.5 In the present case, therefore, the Board's preliminary opinion concurring with the objection raised by the appellant cannot be seen as an exceptional circumstance justifying the auxiliary request being taken into account.

2.6 The respondent's alternative arguments, that broad 'exceptional circumstances' should be considered, such as the single auxiliary request simplifying the case relative to the four previous auxiliary requests on file, thus allowing a decision to be taken without remittal to the opposition division, are also not accepted. At the final level of the convergent approach to amendments to a party's appeal case, Article 13(2) RPBA 2020 considers solely the presence of exceptional circumstances justifying such amendment. Furthermore, it should be noted that the filing of a new auxiliary request, which replaces several auxiliary requests, does not necessarily lead to a simplification of the procedure anyway, since with regard to the added features, technical aspects would have to be taken into account which were not the subject of the procedure so far and which would have had to be discussed for the first time in the oral proceedings. As indicated above, no such exceptional circumstances are seen to justify the consideration of the auxiliary request.

2.7 In conclusion, therefore, in the absence of exceptional circumstances, the auxiliary request is not taken into account.

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