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**Datasheet for the decision
of 21 March 2024**

Case Number: T 1278/21 - 3.3.10

Application Number: 07758643.6

Publication Number: 2010236

IPC: A61L24/04, A61L24/10

Language of the proceedings: EN

Title of invention:

METHODS FOR MAKING SUPERABSORBENT, FREEZE DRIED HYDROGELS FOR
MEDICAL APPLICATIONS

Patent Proprietor:

Incept, LLC

Opponent:

HGF Limited

Headword:

Relevant legal provisions:

EPC Art. 123(2), 111(1)

RPBA 2020 Art. 11

Keyword:

Amendments - allowable (yes)

Appeal decision - remittal to the department of first instance
(yes)

Decisions cited:

Catchword:



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Case Number: T 1278/21 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 21 March 2024

Appellant: Incept, LLC
(Patent Proprietor) 6 Porter Lane
Lexington MA 02420 (US)

Representative: Marks & Clerk LLP
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London EC4A 1BW (GB)

Respondent: HGF Limited
(Opponent) 1 City Walk
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 26 May 2021
revoking European patent No. 2010236 pursuant to
Article 101(2) and 101(3)(b) EPC.**

Composition of the Board:

Chairman A. Zellner
Members: M. Kollmannsberger
F. Blumer

Summary of Facts and Submissions

I. The patent proprietor appealed the Opposition Division's decision to revoke the patent under Articles 101(2) and 101(3)(b) EPC.

II. Claim 1 of the patent as granted reads as follows:

"A method for making superabsorbent hydrogel, comprising:

forming a mixture by combining precursor components to initiate covalent crosslinking of the precursor components, which are a first electrophilic precursor and a second nucleophilic precursor;

freezing the mixture after the covalent crosslinking of the precursor components has begun and before the covalent crosslinking of the precursor components is complete, wherein between 15% and 90% of the crosslinking is completed prior to freezing the mixture; and

freeze drying the frozen mixture to form the hydrogel;

optionally conditioning the hydrogel after freeze drying."

Amendments with respect to claim 1 as originally filed are marked by underlining and ~~striketrough~~.

III. The patent had been opposed under Articles 100(a)(b)(c) EPC for lack of inventive step (Article 56 EPC),

insufficient disclosure (Article 83 EPC) and unallowable amendments (Article 123(2) EPC). The Opposition Division decided that claim 1 of the granted patent extended beyond the originally filed disclosure, Articles 100(c) and 123(2) EPC. In particular, the introduction of the feature "*wherein between 15% and 90% of the crosslinking is completed prior to freezing the mixture*" into claim 1 during the examination phase resulted in a method that had no basis in the application as filed.

The claims of all auxiliary requests pending before it either also contravened Article 123(2) EPC or extended the patent protection beyond the granted version, Article 123(3) EPC.

- IV. In its statement setting out the grounds of appeal the appellant disputed the Opposition Division's finding. The feature "*wherein between 15% and 90% of the crosslinking is completed prior to freezing the mixture*" did have a basis in the application as filed.

The appellant requested to set aside the impugned decision and to maintain the patent on the basis of the claim set labelled "main request", i. e. in the granted form. As auxiliary request it requested to maintain the patent in amended form on the basis of the claim sets labelled auxiliary requests 2-14, 1B-14B, 1C-14C, 1D-14D, 1E-14E, all being already part of the opposition proceedings, or 15, 15B-15E, filed together with the statement setting out the grounds of appeal.

- V. The respondent neither filed arguments nor made any requests in appeal proceedings.

VI. Summons to oral proceedings under Article 116 EPC were issued on 14 July 2023. The date foreseen for the oral proceedings was the 2 February 2024. A communication under Article 15(1) RPBA was issued on 25 September 2023, informing the parties that the issue of unallowable amendments would have to be discussed during oral proceedings. Regarding the other grounds of opposition a remittal to the Opposition Division had to be expected.

VII. No further substantive submissions were filed by the parties. On 20 December 2023 the appellant informed the Board that it would not attend the scheduled oral proceedings and requested a decision to be taken based on its written submissions. Likewise, the respondent informed the Board on 24 January 2024 that it would not attend the oral proceedings. Thus, the Board cancelled the oral proceedings and notified the parties accordingly.

Reasons for the Decision

1. The appeal is admissible.

2. This decision can be taken in written proceedings.

The appellant initially filed a request for oral proceedings under Article 116 EPC should its main request, i. e. the maintenance of the patent as granted, not be allowed. However, this request was

withdrawn later by announcing not to attend the oral proceedings and asking for a decision to be made in writing.

The respondent did not request oral proceedings to be held.

3. Amendments, Article 100(c) EPC

The disputed issue is whether the introduction of the feature "*wherein between 15% and 90% of the crosslinking is completed prior to freezing the mixture*" into claim 1 results in the claim defining a process that was not disclosed in the application as filed.

3.1 Claim 1 as filed defines a process for making a superabsorbent hydrogel comprising three steps. A mixture of precursor components is formed to initiate crosslinking of the precursor components. This mixture is frozen before cross-linking is complete. The third step then is to freeze dry the mixture to form the hydrogel.

3.2 The disputed feature relates to the point in time at which the degree of crosslinking is obtained. This feature is taken from paragraph [0031] of the description, although not literally. In this paragraph of the description it is stated that the degree of crosslinking is obtained "*before initiating the freeze drying process*", whereas in amended claim 1 the degree of crosslinking is obtained "*prior to freezing the mixture*".

3.3 The Opposition Division argued that the terms "*freeze drying*" and "*freezing*" were not synonyms. In particular it was apparent from optional step 127 that further cross-linking might occur between the time of freezing and the time of freeze drying (i. e. applying a vacuum to the frozen mixture), as stated in paragraph [0041] of the description. Thus, the percentages of crosslinking defined in paragraph [0031] "*before initiating the freeze drying process*" did not relate to the point in time where the mixtures were started to be frozen, but to the beginning of freeze drying. At least if step 127 was present in the process these values differed, so that the crosslinking degree before initiating the freeze drying process could not form the basis for the disputed feature. This crosslinking degree in the claim clearly related to a point in time before the freezing of the mixture began.

3.4 The appellant argued essentially that it was clear from the context of paragraph [0031] that the percentages of crosslinking described in this passage related to the point in time where the mixture is frozen. Thus, although the disputed feature was not taken up literally, a skilled person would have derived the claimed method directly and unambiguously from the original disclosure.

3.5 The Board agrees with the appellant.

3.5.1 Paragraph [0031] is embedded in the context of the detailed description of the process depicted in figure 2. This description starts on page 6 in paragraph [0019] with the description of step 112.

3.5.2 Paragraph [0030], i. e. the paragraph immediately preceding paragraph [0031], describes step 119 of the

process where the combined precursor solutions are allowed to sit for a predetermined crosslinking duration to at least partly crosslink. In figure 2, this process step is named "*allow time for combined precursor solutions to at least partially crosslink*" and is clearly carried out at ambient temperature, since cooling starts only during the later process steps depicted in figure 3 and being described in paragraphs [0035] to [0049].

- 3.5.3 Paragraph [0031] then defines the details of the step described in paragraph [0030], namely how long the crosslinking duration at step 119 may be and what percentage of crosslinking may be achieved during this time period. It is clear from the wording used ("*This step may allow the combined precursor solutions (...)*") that the explanations in paragraph [0031] relate to step 119 described in paragraph [0030].
- 3.5.4 Thus, although the percentages of crosslinking are described as being achieved "*before initiating the freeze drying process*" a skilled person would derive directly and unambiguously that this crosslinking percentage is obtained before freezing the mixture. "*Before initiating the freeze drying process*" in this passage does not define the second part of a two-step process, i. e. the application of a vacuum to an already frozen mixture, but relates to the point in time before carrying out the complete freeze drying process which itself is depicted in figure 3, comprising steps 122 to 129, inter alia steps 126 ("freeze") and 128 ("freeze dry"), which are part of step 120 according to Figure 1.
- 3.5.5 It is correct that the process described in the application allows for further crosslinking to happen

in the frozen state, see step 127 in figure 3, see also paragraphs [0041] or [0049], before a vacuum is applied. However, this does not change the meaning of the percentages of crosslinking in paragraph [0031]. This passage refers to the degree of crosslinking obtainable at ambient temperature before the mixture is frozen.

3.5.6 Thus, the process defined in amended claim 1, requiring a certain degree of crosslinking to be completed prior to freezing the mixture, is exactly what is disclosed in the description as filed, although in different words.

3.6 The other objections raised under Articles 100(c) and 123(2) EPC were dismissed by the Opposition Division. No arguments have been filed to the contrary in appeal and the Board does not see any reason to differ from the Opposition Division's assessment.

3.7 Thus, claim 1 of the granted patent does not contravene the provisions of Article 123(2) EPC. The patentee's auxiliary requests need not be considered.

4. Remittal

The Opposition Division did not decide on any of the other grounds of opposition invoked under Articles 100(a) and 100(b), namely lack of inventive step, Article 56 EPC, and insufficiency of disclosure.

The Board considers this to be a special reason according to Article 11 RPBA 2020 and decides to remit the case to the Opposition Division for further prosecution under Article 111 EPC.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The case is remitted to the Opposition Division for further prosecution.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

A. Zellner

Decision electronically authenticated