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**Datasheet for the decision  
of 14 June 2024**

**Case Number:** T 0165/22 - 3.2.07

**Application Number:** 08851713.1

**Publication Number:** 2214610

**IPC:** A61F13/02, A61F13/00, A61M1/00

**Language of the proceedings:** EN

**Title of invention:**  
VACUUM ASSISTED WOUND DRESSING

**Patent Proprietor:**  
Smith & Nephew PLC

**Opponent:**  
KCI Licensing Inc.

**Headword:**

**Relevant legal provisions:**  
EPC Art. 111(1), 113(1), 116(1), 123(2)  
RPBA 2020 Art. 11, 12(6) sentence 1, 12(8), 15(1)

**Keyword:**

Decision taken in written proceedings - (yes)

Main request - amendments - allowable (no)

First auxiliary request - admitted (no)

Second auxiliary request - admitted (yes) - amendments - allowable (yes)

Remittal - (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 0165/22 - 3.2.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.07**  
**of 14 June 2024**

**Appellant:** Smith & Nephew PLC  
(Patent Proprietor) 15 Adam Street  
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**Representative:** HGF  
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**Respondent:** KCI Licensing Inc.  
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**Representative:** Simmons & Simmons  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 15 November  
2021 revoking European patent No. 2214610  
pursuant to Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** G. Patton  
**Members:** A. Beckman  
Y. Podbielski

## **Summary of Facts and Submissions**

- I. An appeal was filed by the patent proprietor against the decision of the opposition division revoking European patent No. 2 214 610.
- II. The opposition was directed against the patent in its entirety and was based on the grounds for opposition pursuant to Article 100(a) to (c) EPC (novelty and inventive step, sufficiency of disclosure and added subject-matter).

The opposition division found that the then main request and the auxiliary requests were either not allowable under Article 123(2) EPC or not admissible and the patent was revoked.

- III. In preparation for oral proceedings the Board gave its preliminary assessment of the case by means of a communication pursuant to Article 15(1) RPBA dated 10 April 2024, which took into account the patent proprietor's grounds of appeal and submissions of 9 November 2022 as well as the reply to the appeal submitted by the opponent.

The Board indicated in its preliminary opinion that the appeal was likely to be partly allowed and that the case was likely to be remitted to the opposition division for further prosecution.

- IV. On 22 April 2024 the patent proprietor submitted a response to the Board's communication and conditionally withdrew their request for oral proceedings such that a final decision on the appeal may be issued under Article 12(8) RPBA.

The opponent submitted a response with letter dated 23 May 2024 and agreed to a decision in written proceedings which was aligned with the Board's preliminary opinion.

Thus, the oral proceedings scheduled on 8 July 2024 were cancelled.

V. The requests of the parties are as follows:

The patent proprietor (appellant) requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of one of the sets of claims filed as main request and first and second auxiliary request with the statement setting out the grounds of appeal, wherein the main request corresponds to the third auxiliary request underlying the decision under appeal, the first auxiliary request corresponds to the fourth auxiliary request underlying the decision under appeal, and the second auxiliary request corresponds to the fifth auxiliary request underlying the decision under appeal.

The opponent (respondent) requested that the appeal be dismissed.

VI. Claim 1 according to the main request reads as follows:

"Apparatus for the application of topical negative pressure therapy to a wound site (10), the apparatus comprising:

a wound contacting element (14) for retaining wound exudate fluid therein, wherein the wound contacting element comprises an absorbent material configured to absorb wound exudate;

a wound covering element (18) that provides an airtight seal over the wound contacting element (14) and wound site (1);

a cup-shaped connection member (30) having a flange portion (34) which is configured to seat onto an upper surface (36) of the wound covering element (18) and seal therewith;

a vacuum connection tube (28) connecting a wound cavity to a vacuum source via an aperture (20) in the wound covering element (18) wherein the cup-shaped connection member (30) comprises an aperture therein which is configured to accept an end of the vacuum connection tube (28) and wherein the aperture in the wound covering element has a pressure-sensitive valve;

and a vacuum source connected to a distal end of the vacuum connection tube (28); wherein the wound contacting element (14) is configured to block liquid transport beyond itself under pressures between atmospheric pressure and 200 mmHg below atmospheric pressure."

VII. Claim 1 according to the first auxiliary request reads as follows:

"Apparatus for the application of topical negative pressure therapy to a wound site (10), the apparatus comprising:

a wound contacting element (14) for retaining wound exudate fluid therein, wherein the wound contacting element comprises an absorbent material configured to absorb wound exudate;

a wound covering element (18) that provides an airtight seal over the wound contacting element (14) and wound site (1) wherein the wound covering element (18) is liquid impermeable and water vapour permeable;

a cup-shaped connection member (30) having a flange portion (34) which is configured to seat onto an upper surface (36) of the wound covering element (18) and seal therewith;

a vacuum connection tube (28) connecting a wound cavity to a vacuum source via an aperture (20) in the wound covering element (18) wherein the cup-shaped connection member (30) comprises an aperture therein which is configured to accept an end of the vacuum connection tube (28) and wherein the aperture (20) in the wound covering element has a pressure-sensitive valve; and

a vacuum source connected to a distal end of the vacuum connection tube (28); wherein the wound contacting element (14) is configured to block liquid transport beyond itself under pressures between atmospheric pressure and 200 mmHg below atmospheric pressure."

VIII. Claim 1 according to the second auxiliary request reads as follows:

"Apparatus for the application of topical negative pressure therapy to a wound site (10), the apparatus comprising:

a wound contacting element (14) for retaining wound exudate fluid therein, wherein the wound contacting element comprises an absorbent material configured to absorb wound exudate;

a wound covering element (18) that provides an airtight seal over the wound contacting element (14) and wound site (1);

a cup-shaped connection member (30) having a flange portion (34) which is configured to seat onto an upper

surface (36) of the wound covering element (18) and seal therewith;  
a vacuum connection tube (28) connecting a wound cavity to a vacuum source via an aperture (20) in the wound covering element (18) wherein the cup-shaped connection member (30) comprises an aperture therein which is configured to accept an end of the vacuum connection tube (28) and wherein the aperture (20) in the wound covering element comprises a one-way valve configured to allow air to be extracted from the wound site;  
and a vacuum source connected to a distal end of the vacuum connection tube (28); wherein the wound contacting element (14) is configured to block liquid transport beyond itself under pressures between atmospheric pressure and 200 mmHg below atmospheric pressure."

- IX. The arguments of the parties relevant to the decision are dealt with in detail in the reasons for the decision.

## **Reasons for the Decision**

### *1. Decision in written proceedings*

The present decision is taken in written proceedings without holding oral proceedings in accordance with Article 12(8) RPBA and with Articles 113 and 116 EPC.

The Board communicated its preliminary assessment of the case to the parties by means of the communication pursuant to Article 15(1) RPBA, according to which the appeal was likely to be partly allowed and the case was likely to be remitted to the opposition division for further prosecution.

Given the parties agreement to a decision in written proceedings which is aligned with the Board's preliminary opinion in the communication pursuant to Article 15(1) RPBA (see the appellant's letter dated 22 April 2024 and the respondent's letter dated 23 May 2024), the parties' auxiliary requests for oral proceedings filed with the statement setting out the grounds of appeal and the reply thereto are no longer relevant.

The case is ready for decision on the basis of the parties' written submissions and the decision under appeal.

For this reason, the issuing of the decision in written procedure without holding oral proceedings is in compliance with the requirements of Articles 113(1) and 116(1) EPC. The summons to oral proceedings were therefore cancelled.

The reasons for the decision given below substantially correspond to the Board's preliminary opinion provided in the communication pursuant to Article 15(1) RPBA. Said opinion was neither commented on in substance nor contested by the parties. Therefore, the Board after having reviewed all relevant facts sees no reason to deviate from its preliminary opinion and confirms it.

2. *Main request - Amendments (Article 123(2) EPC)*

- 2.1 The appellant contested the reasoned finding of the decision under appeal that the features of claim 1 "a cup-shaped connection member (30) having a flange portion (34) which is configured to seat onto an upper

*surface (36) of the wound covering element (18) and seal therewith" and "wherein the cup-shaped connection member (30) comprises an aperture therein which is configured to accept an end of the vacuum connection tube (28)"* contravene Article 123(2) EPC, since these features are an unallowable generalization of the specific combination of features of the embodiment disclosed on page 13 and figure 1 of the application as filed. In particular, the "one-way valve", which is an explicit technical feature of the specific embodiment of the apparatus disclosed on page 13 and figure 1, is not incorporated into claim 1.

As the one-way valve is inextricably linked to the apparatus embodied on page 13 and figure 1, the incorporation of a pressure-sensitive valve in claim 1 is an undue generalization of the original teaching of the specific embodiment on page 13 and figure 1 (see decision under appeal, points II.22, II.24, II.37 and II.39).

- 2.2 The appellant argued that the decision was incorrect as the original application encompasses a generalized teaching of pressure-sensitive valves and as the one-way valve was not essential for the apparatus of page 13 and figure 1.

According to the appellant the use of a pressure-sensitive valve in the wound covering element together with an elastomeric cup was disclosed on page 7, lines 23 to 26, of the application as filed. There was no specific requirement in this passage for a particular type of valve or a one-way valve. The reference to a one-way valve on page 11, lines 1 to 5, was presented in a similar technical context to the pressure-

sensitive valve referred to earlier in the disclosure on page 7, lines 23 to 32. The skilled reader would immediately derive therefrom that the broader scope embodied by the term pressure-sensitive valve was intended to encompass the valve employed in the apparatus of figure 1. The disclosures in both page 7, line 25, and page 11, line 21, provided basis for the use of a generic pressure-sensitive valve in the wound covering element together with a cup-shaped connection member. Moreover, original claim 11 recited a pressure-sensitive valve such that the skilled reader would appreciate that the particular type of valve was not restricted.

The opposition division wrongly attributed the specific function of protecting the wound from access of bacteria to the particular valve employed on page 13 / figure 1 of the apparatus. This functionality was not exclusive to the particular one-way valve employed for the embodiment on page 13 and figure 1. The use of a one-way valve in the wound covering element was provided as an example of how the appropriate sealing mechanism could be achieved (see page 11, lines 5 to 11). There was no indication that such an effect could not be provided by another valve arrangement or alternative configuration (see page 11, lines 19 to 26). The disclosure immediately following the discussion of the embodiment on page 13, highlighted that the specified valve was not to be construed in a limited context (see page 14, lines 11 to 13).

The skilled person was therefore taught that the one-way valve in figure 1 could be replaced by other valve systems and would therefore conceive of different pressure-sensitive valves that could be employed in such embodiments.

2.3 The Board does not find the appellant's arguments convincing and concurs with the reasoned finding in the decision under appeal.

None of the disclosures of pressure-sensitive valves in the application as filed relates or is linked to the specific embodiment of the apparatus disclosed on page 13 / figure 1, comprising a cup-shaped connection member with a flange portion, as claimed in claim 1 (see point 2.1 above).

The one-way valve in this specific embodiment, which embodiment provides the only direct and unambiguous basis of the contested features according to point 2.1 above, is also essential for the specific apparatus to prevent access of bacteria to the wound (see page 14 of the application as filed). By contrast, a pressure-sensitive valve encompasses a valve that may not have this function, *i.e.* protecting the wound from outside pathogens.

The general disclosure in the application as filed, as outlined by the appellant, does not provide a generalized teaching of a pressure-sensitive valve together with a cup-shaped connection member as claimed in claim 1. Thus, the skilled person would not derive directly and unambiguously from the application as filed that the one-way valve of page 13 / figure 1 could be replaced by a pressure-sensitive valve.

Hence, the amendment in claim 1 which replaced the feature "one-way valve", disclosed in a clearly recognisable functional relationship with the embodiment of page 13 / figure 1 and the features mentioned under point 2.1. above, by the more general

term "pressure-sensitive valve" is not allowable under Article 123(2) EPC.

- 2.4 The appellant brought forward also that, contrary to the respondent's view and the corresponding finding in the decision under appeal (see decision under appeal, point II.22), the primary starting point for basis was the originally filed claims and the general disclosure outlined in the application as filed with reference to, for example, page 7, lines 17 to 20, such that the embodiment described on page 13 was an exemplification of the generalized disclosure expressed earlier in the description (*i.e.* on pages 7 and 11) and in the originally filed claims.

The Board does not find the appellant's arguments convincing for the reasons given under point 2.3 above.

- 2.5 Thus, claim 1 of the main request does not fulfil the requirements of Article 123(2) EPC.

3. *First auxiliary request - Admittance*

- 3.1 The appellant brought forward that the opposition division was incorrect to not admit the first auxiliary request into the proceedings because the inclusion of "a pressure-sensitive valve" in claim 1 was considered to contravene Article 123(2) EPC. For the reasons outlined in respect of the main request under point 2.2 above, claim 1 of the first auxiliary request complied with Article 123(2) EPC and should have been admitted into the proceedings.

- 3.2 Claim 1 of the first auxiliary request comprises the feature "pressure-sensitive valve" as claim 1 of the main request. Thus, claim 1 of the first auxiliary

request contravenes Article 123(2) EPC for the corresponding reasons as given under point 2.3 above.

3.3 Hence, the Board does not admit the first auxiliary request into the appeal proceedings for the reasons given under point II.40 in the decision under appeal and in compliance with the respondent's request (Article 12(6), first sentence, RPBA).

4. *Second auxiliary request - Admittance*

4.1 Claim 1 of the second auxiliary request defines "a one-way valve configured to allow air to be extracted from the wound site".

4.2 The opposition division found that this definition was different from the teaching on page 13, lines 6 to 9, of the application as filed defining "a one-way valve ... to permit fluid in the form of air to be extracted from the wound cavity", as there was no clear *prima facie* equivalence from "air" to "fluid in the form of air". There was no direct and unambiguous basis for the definition added to claim 1. Since the criterion of clear allowability was not met, the second auxiliary request was not admitted into the proceedings.

4.3 The appellant contested non-admittance of the second auxiliary request into the proceedings and submitted that claim 1 of the second auxiliary request complied with the requirements of Article 123(2) EPC.

4.4 Claim 1 of the second auxiliary request was filed for the first time in opposition proceedings during the oral proceedings, *i.e.* after the expiry of the date set according to Rule 116(1) EPC and thus considered as

being late filed, so its admittance into the proceedings was at the discretion of the opposition division.

- 4.5 It is established case law that, on appeal against a decision taken by a department of first instance in exercise of its discretion, it is not for the board to review all the facts and circumstances of the case as if it were in that department's place and decide whether or not it would have exercised discretion in the same way. The board should overrule the way in which that department exercised its discretion in reaching a decision in a particular case only if they conclude that it did so in accordance with the wrong principles, without taking the right principles into account or in an arbitrary or unreasonable way, thereby exceeding the proper limits of its discretion.

However, the boards' review of an exercise of discretion has to include checking any underlying *prima facie* examination, for example as to whether it was vitiated by manifest errors (see Case law of the Boards of Appeal (CLB), 10th edition 2022, V.A.3.4.1.c).

- 4.6 The Board follows the appellant's view that no difference can be seen in the technical information derived from the wording "to allow air to be extracted from the wound site" used in claim 1 and from the wording "to permit fluid in the form of air to be extracted from the wound cavity" disclosed on page 13, lines 6 to 9. From the wording "fluid in the form of air" the disclosure of "air" can be derived directly and unambiguously. The wording "one-way valve configured to allow air to be extracted from the wound site" is directly and unambiguously derivable from the application as filed on page 13, lines 6 to 9.

Thus, the opposition division's *prima facie* assessment for not admitting the second auxiliary request was erroneous.

4.7 Hence, the Board overrules the opposition division's discretionary decision and admits the second auxiliary request into the proceedings (Article 12(6), first sentence, RPBA).

5. *Second auxiliary request - Amendments (Article 123(2) EPC)*

5.1 The respondent submitted that claim 1 of the second auxiliary request did not comply with Article 123(2) EPC.

The respondent argued that the added definition did not find basis on page 13, lines 6 to 8, because that text required a one-way valve "positioned in the aperture", whereas the amendment to claim 1 required "the aperture in the wound covering element comprises a one-way valve". The claim required the one-way valve to be part of the wound covering element, whereas the description required the valve to be a discrete element in the aperture.

5.2 The Board does not follow the respondent's line of argument, but the argument of the appellant. The requirement in claim 1 that the "aperture ... comprises a one-way valve" finds basis in the application as filed on page 13, lines 6 to 9, according to which the one way valve is positioned in the aperture. Thus, the Board is convinced that the definition added to claim 1 is directly and unambiguously derivable from the application as filed on page 13, lines 6 to 9.

Hence, claim 1 of the second auxiliary request meets the requirements of Article 123(2) EPC.

6. *Remittal for further prosecution*

6.1 The respondent requested that the case was remitted to the opposition division for further prosecution, if the second auxiliary request was admitted and found to comply with the requirements of Article 123(2) EPC.

6.2 Under Article 11 RPBA the Board shall not remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so.

6.3 The Board follows the respondent's view that the features added to claim 1 of the second auxiliary request were first added to claim 1 during the oral proceedings from the description which could not be foreseen when preparing the opposition. The patentability of the claimed subject-matter has not yet been examined and decided on by the opposition division. Indeed, objections of lack of novelty and inventive step were not dealt with for any requests in the decision under appeal.

6.4 Since the main purpose of appeal proceedings is to give a losing party an opportunity to challenge a decision on its merits, remittal could normally be considered by the boards in cases where a first-instance department has issued a decision against a party based solely on one particular issue which was decisive for the case, but left other essential issues outstanding. This practice is in keeping with the primary object of appeal proceedings of reviewing the decision under

appeal in a judicial manner (Article 12(2) RPBA) (CLB, *supra*, V.9.3.2).

6.5 As the patentability of the claimed subject-matter was not considered in opposition proceedings, the Board finds that there are special reasons justifying remittal. In the present case, to consider novelty and inventive step objections for the first time in appeal proceedings to the proceedings would constitute an undue burden and be counter to the purpose of appeal proceedings as a judicial review within the meaning of Article 12(2) RPBA 2020.

6.6 Therefore, the Board exercises its discretion under Article 11 RPBA to remit the case to the opposition division for further prosecution (Article 111(1) EPC).

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



G. Nachtigall

G. Patton

Decision electronically authenticated