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File Number: T 931/90 - 3.2.2

Application No.: 82 402 254.5

Publication No.: 0 081 438

Title of invention: Adhesive bandage

Classification: A61F 13/02, A61L 15/06

D E C I S I O N
of 20 February 1992

Proprietor of the patent: NIPPON ZOKI PHARMACEUTICAL CO. LTD.

Opponent: Aso Pharmaceutical Co., Ltd.

Headword:

EPC Articles 100(c) and 123(2)

Keyword: "Added subject-matter"

Headnote

Summary of Facts and Submissions

- I. European patent No. 0 081 438 was granted on the basis of European patent application No. 82 402 254.5. Claim 1 as granted reads as follows (indication of the features added):

"An adhesive bandage comprising

- a) an adhesive tape (1),
- b) an absorbent pad (2) carried by the tape and
- c) a release sheet (4) releasably attached to the tape on the side of the adhesive,
- d) wherein said absorbent pad (2) is smaller in its length than the tape (1) and
- e) said release sheet (4) is overlaying the whole pad, said bandage further comprising
- f) a blister portion (6) formed on the release sheet with an open side facing the pad,
- g) a medicine (3) contained in the blister, and
- h) a medicine covering film (5) interposed between the medicine and the pad for sealing the medicine in the blister, said film being rupturable under pressure,

characterised in that

- i) the absorbent pad (2) is smaller in width than the tape (1) and that
- k) the blister (6) has a V or U shaped recess in its top,
- l) the film (5) being rupturable by said V or U shaped recess."

- II. The opposition filed by the Appellant was rejected by the Opposition Division since the claimed subject-matter was deemed to be novel and based on an inventive step.

With respect to the question of added subject-matter under Article 100(c) EPC, the Opposition Division came to the conclusion that although the last feature (1) was not explicitly disclosed in the application as filed, the passage on page 7, lines 1 to 7 of the description could only be interpreted in the sense that it was the V or U shaped recess itself which ruptured the film, since no other meaning could have made technical sense.

III. The Appellant lodged an appeal against this decision, paying the appropriate fee in due time. In the Statement of Grounds, received on 12 February 1991, it was argued that there was no basis for the introduction of the feature (1) in Claim 1 since the particular functioning of the recess was neither explicit nor implicit to the person skilled in the art i.e. directly and unambiguously derivable from the information previously presented by the application as filed. Thus, the requirements of Article 100(c) EPC had not been met.

The Respondent (Proprietor of the patent) replied that the feature in question was sufficiently disclosed and that, even without looking at Figure 4 which represented only one embodiment among many other possible ones, the skilled person would have understood that the aim of the recess was to come into contact with the film under the pressure of the finger to facilitate its rupturing. There was no need for the recess to be deep to achieve the expected result. Further, the description had not to describe a feature in all details and dimensions.

V. The Appellant requests that the patent be revoked.

The Respondent requests that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.
2. According to the two last features set out in Claim 1

the blister (6) has a V or U shaped recess in its top (feature k) and, the film (5) is rupturable by said V or U shaped recess (feature l).

The feature (k) is clearly supported by the original disclosure made in the application as filed, in particular on page 7, lines 1 to 3 and in original Claim 6.

3. The feature (l) as referred to in the granted patent specification, (cf. column 2, lines 31 to 33), was introduced in the course of the examining procedure. However, it has no counterpart in the originally filed application. The incorporation of feature (l) in the description was allowed in accordance with Article 84 and Article 123(2) EPC and thereafter maintained in the patent specification because both the Examining and the Opposition Divisions were convinced that the contribution of the V or U shaped recess provided in the top of the blister was such as to cause rupturing of the medicine covering film.

The wording of feature (l) indicates clearly that the rupturing of the film is achieved directly by the recess itself in consequence of the pressure exerted on the blister, as was also asserted by the Respondent in his response of 20 June 1991, on page 2, last paragraph: "the subject-matter of the invention is the idea of providing a projection on the top of the blister in the direction of

the film to rupture it by being pushed by finger and get in touch with it" and on page 3, second paragraph: "the skilled person will understand that the aim of the recess is to come into contact with the film ... to facilitate its rupturing".

4. The Board cannot accept the Respondent's interpretation for the following reasons.

According to the passage on page 7, lines 1 to 3 of the application as filed, "the rupturing of the medicine covering film can also be facilitated if the blister is provided with a V or U shaped recess at its top as shown in Figure 4, ...".

Here it is indicated that the rupturing is facilitated (and not caused) by the recess. No indication is made in this respect as to how the recess operates.

Further, there is an explicit reference to Figure 4 which, therefore, has to be considered. Now, Figure 4 obviously represents a blister 6 filled with a medicine and having a shallow U-shaped recess at its top with the bottom of the recess being positioned far away from the film 5. Even when a finger pressure is to be applied on the top of the blister it is highly questionable whether the tip of the recess could contact the film to rupture it. In the Board's view it cannot be derived from the drawings with certainty that the film is rupturable by said recess as suggested by feature (1).

5. In this respect the Board observes that although features contained in the drawings may in principle be included in the claims (cf. T 169/83, OJ EPO 1985, 193, in particular page 202, point 3.5), it is necessary that the features are expressly shown in the drawings or are

clearly, unmistakably and fully derivable by a person skilled in the art from the drawings as originally filed in terms of structure and function, and must in no way contradict the other parts of the disclosure, so as to enable him to recognise these features as forming part of the invention when considering the content of the description as a whole. In the Board's view the conditions are not satisfied in the present case.

6. According to another previous passage of the description (cf. page 6, lines 7 to 9) rupturing of the film is said to be caused principally by applying pressure of a finger to the blister i.e. regardless of the presence or absence of a recess at the top of the blister. Therefore, it seems to the Board that rupturing of the film is rather simply due to the increase of the liquid pressure inside the blister in consequence of it being squashed by a finger and also of the fact that, according to the originally filed but later deleted independent Claim 25, feature (f) was specified as "the blister is more rupture-resistant than is the film such that application of pressure on the outside of the blister causes the film to rupture ...", i.e. in this way a point of weakness in the medicine covering film has been provided. However, nowhere in the application is an indication that would suggest to the skilled person that the film is to be ruptured by the recess itself.

7. It results from the foregoing that more than one interpretation can be made as to how the recess can facilitate the rupturing of the film (cf. point 4, second paragraph) since it is insufficiently described. As was rightly submitted by the Appellant in his Statement of 12 February 1991, page 8, at least three different ways had been given in which the recess might affect the rupturing of the film. The Board considers that a feature

which is subject to several and even contradictory interpretations, i.e. which is neither explicit to the person skilled in the art nor directly and unambiguously derivable from the originally filed application, cannot be presented in the course of the proceedings as an essential feature to form a new main claim. When viewed in accordance with the novelty test, the feature (1) of Claim 1 is novel with respect to the originally filed description, claims and drawings. Inadmissible subject-matter has accordingly been added by the amendment. The present Claim 1 is therefore not allowable under Article 123(2) EPC.

8. Since the grounds for appeal are based first of all on the requirements of Article 100(c) EPC and since both parties have presented their comments in detail in accordance with Article 113(1) EPC, the Board is justified to issue the present decision on the grounds of Articles 100(c) and 123(2) EPC alone, regardless of other patentability requirements. Further, since no other requests have been made by the Respondent it follows that revocation of the patent must be decided on the basis of the file as it stands.

Order

For these reasons, it is decided that:

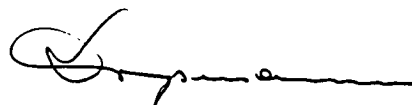
The patent is revoked.

The Registrar:



S. Fabiani

The Chairman:



P. Dropmann

R. Wol. 1. 4. 92

DM 1-4-92