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DECISION
of 9 September 1994

Case Number: T 0469/92 - 3.2.2

Application Number: 87306595.7

Publication Number: 0255310

IPC: A61F 5/448

Language of the proceedings: EN

Title of invention:
Ostomy coupling

Patentee:
E.R. Squibb & Sons, Inc.

Opponent:
Laboratoires Merck-Clevenot

Headword:

Relevant legal norms:
EPC Art. 54, 56, 87, 88, 123
EPC R. 67

Keyword:
"Novelty - state of the art"
"Inventive step - (no)"
"Priority - previous application without claims"
"Reimbursement of appeal fees - substantial procedural violation (no)"

Decisions cited:
T 0560/89, T 0039/82, T 0081/87, T 0184/84, T 0176/84

Catchword:
Rule 67 EPC applies only to a procedural violation by the instance whose decision is under appeal (point 6 of the decision).



Case Number: T 0469/92 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 9 September 1994

Appellant: Laboratoires Merck-Clevenot
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Respondent: E.R. Squibb & Sons, Inc.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 8 April 1992
rejecting the opposition filed against European
patent No. 0 255 310 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: H. Seidenschwarz
Members: P. Dropmann
J. Van Moer

Summary of Facts and Submissions

- I. A Notice of Appeal was filed against the decision of the Opposition Division dated 8 April 1992 rejecting the opposition against patent No. 0 255 310.

The Opposition Division held that the grounds of opposition mentioned in Article 100(a), (b) and (c) EPC did not prejudice the maintenance of the patent unamended. In its decision it considered, among others, documents

D1: GB-A-2 121 902, and

D4: EP-A-0 286 501.

During the appeal proceedings, the Appellant (Opponent) introduced two further documents together with French translations:

D19: JP-U-55-181089 "Tomioka", and

D20: JP-U-57-11390 "Kurata".

- II. Oral proceedings were held on 9 September 1994.
- III. The Appellant requested that the decision under appeal be set aside and the patent revoked. Furthermore, it requested reimbursement of appeal fees and, as an auxiliary request, referral of three questions to the Enlarged Board of Appeal.
- IV. The Respondent (Proprietor of the patent) requested that the appeal be dismissed and the patent maintained as granted.

V. Claim 1 as granted reads as follows:

"A three-part ostomy coupling which has a first part (10) having a flange (16), a central chute (18), and an array of spaced projections (20); a second part (12) having a peripheral seal (36) for engaging and surrounding the outer wall of the chute and an outwardly-projecting rim (32) capable of a snap-fit with the spaced projections; and a third part (14) which has a central hole bounded by a wall having first and second portions located alternately in a circumferential sense, the first portions being spaced from the radially outer surfaces of the projections of said array and the second portions (30) being so located that in one rotational position of the third part they preclude outward movement of said projections and so effect a positive lock between the rim and the projections."

VI. The Appellant essentially argued as follows:

Claim 1 as granted contained subject-matter which extended beyond the content of the application as originally filed, thus contravening the provision of Article 123(2) EPC.

Furthermore, the subject-matter of Claim 1 was not entitled to priority as claimed, since the first priority document containing no claims did not specifically disclose certain features of Claim 1 (Article 88(4) EPC). As a consequence, document D4 enjoying the priority date of 10 April 1987 constituted, for most of the Contracting States designated in the contested patent, prior art in accordance with Article 54(3) and (4) EPC. This prior art anticipated the subject-matter of the granted Claim 1 which thus lacked novelty (Article 54(1) EPC).

Additionally, the subject-matter of the patent did not involve an inventive step (Article 56 EPC) in the light of the problem to be formulated over document D1, which problem was to provide assurance for the wearer that the coupling parts would not become accidentally separated, and in the light of document D20 or D19, each of these documents disclosing a cam ring having a locking function.

The Appellant's request for reimbursement of appeal fees was based on the arguments that substantial procedural violations had occurred because

- (i) two patents (the present contested patent No. 0 255 310 and its divisional No. 0 313 175) directed to the same invention were granted to the same applicant,
- (ii) the Opposition Division took the decision before the Opponent could present its arguments on the grounds referring to Article 100(c) EPC, and
- (iii) a failure to comply with Article 123(2) EPC had not been recognised by the first instance.

VII. In contesting the Appellant's arguments, the Respondent argued that the requirements of Article 123(2) EPC were met and that the priority date of 31 July 1986 could be accorded to the contested patent. Thus, document D4 did not represent prior art falling under Article 54 EPC and did not take away novelty from the subject-matter of the patent in suit.

As regards inventive step, the Respondent essentially submitted that documents D19 "Tomioka" and D20 "Kurata" were totally irrelevant to the invention. The teachings of these documents were of interest to a plumber and to

engineers concerned with tube coupling, but were remote and unhelpful to an ostomy appliance designer seeking to improve the design according to document D1. Both documents D19 and D20 were addressing a problem completely different from that of the patent in suit. The inventors were faced with a triple problem, namely to provide an ostomy coupling easily coupled and uncoupled, with good security of attachment and sealing and with a flat design. This triple problem did not lead a skilled person to make a survey in the field of mechanical engineering pipe or tube couplings which field is neither a neighbouring nor a broader general field to ostomy appliances and couplings. In this context, the Respondent referred to decisions T 560/89 (OJ EPO 1992, 725) and T 39/82 (OJ EPO 1982, 419). Furthermore, the Respondent argued that, in view of the substantial force needed to couple and uncouple the couplings known from D19 and D20, the skilled person would rather have been deterred from applying the teachings of D19 or D20 in the field of ostomy couplings. The subject-matter of the patent thus involved an inventive step.

Reasons for the Decision

1. The appeal is admissible.
2. *Articles 100(c) and 123(2) EPC*

A comparison of Claim 1 as granted with the application as originally filed leads to the following result:

The features of Claim 1 that the three-part ostomy coupling has a first part having a flange, a central chute and an array of spaced projections; a second part

having a peripheral seal for engaging and surrounding the outer wall of the chute and an outwardly-projecting rim capable of a snap-fit with the spaced projections; and a third part which is rotatable to effect a positive lock between the rim and the projections, are disclosed in Claim 1 of the application as originally filed.

According to original Claim 4 the third part is formed by a cam ring. The function of the cam ring, which is also called "locking ring" in the application, is described at page 3, last paragraph and page 4, first paragraph of the application as filed in connection with one example (cf. page 2, second paragraph) which, according to original Claims 4 and 5, represents a particular embodiment of the invention (cf. Rule 29(3) EPC) depicted in the figures of the application as filed. In this embodiment the cam surface of the cam ring is formed by cylindrical surfaces alternating with flat surfaces.

It is clear from this disclosure, and the fact that the first part of the coupling has a plurality of projections, that the third part (cam ring) must have the following features specified in Claim 1, namely a central hole bounded by a wall having first and second portions located alternately in a circumferential sense and that the second portions are so located that in one rotational position of the ring they preclude outward movement of the projections of the first part in order to effect the wanted positive lock.

Thus, the question arises whether the remaining feature of Claim 1 that the first portions of the third part are spaced from the radially outer surfaces of the projections is derivable directly and unambiguously from the disclosure of the application as originally filed. The Board is convinced that this question has to be

answered in the affirmative, since, in view of the fact that coupling of the first and second parts is to be achieved by a snap-fit (cf. Claim 1) between the projections and the outwardly-projecting rim, the first portions of the ring must be spaced from the radially outer surfaces of the projections in order to permit outward movement of the projections during coupling and separating of the first and second parts of the coupling.

Furthermore, in the Board's judgment, it was not necessary to incorporate into Claim 1 the feature that the cam surface of the cam ring is formed by cylindrical surfaces alternating with flat surfaces. As pointed out above, this particular form of the cam surface is merely one example and a particular embodiment of the invention. A restriction of Claim 1 to this particular embodiment was not justified in the light of the general disclosure in Claims 1 and 4 of the application as originally filed.

It follows from the statements in the preceding paragraphs that the subject-matter of Claim 1 is directly and unambiguously derivable from the disclosure of the application as originally filed and thus does not extend beyond the content of the application as filed. The requirements of Article 123(2) EPC are accordingly satisfied.

3. *Priority and novelty*

It has been shown in point 2 above that the subject-matter of Claim 1 is directly and unambiguously derivable from the disclosure of the application as originally filed, in particular Claims 1 and 4, page 2, second paragraph, page 3, last paragraph, page 4, first paragraph and the figures. These parts of the

application as filed correspond, partly identically, to page 1, line 10 onwards, page 2, last paragraph to page 3, line 14 and the figures of the first application GB 8 618 693 filed in the British Patent Office on 31 July 1986, from which application priority is claimed. Thus, the subject-matter of Claim 1 is also directly and unambiguously derivable from the disclosure of the invention in the first priority document.

It is true that, as argued by the Appellant, this priority document does not include any claims. However, this does not mean that the conditions of Article 88(4) EPC are not fulfilled. Article 88(4) EPC cannot be construed as meaning that a priority document must comprise claims in order to form a regular national filing (as defined by Article 87(3) EPC) which can give rise to a right of priority. Article 88(4) EPC rather indicates that for the grant of priority it is sufficient that the documents of the previous application as a whole specifically disclose the elements of the invention, which means that the features of the invention have to be directly and unambiguously derivable from the priority document (cf. T 81/87, OJ EPO 1990, 250 and T 184/84, dated 4 April 1986, unpublished). As shown above, this is clearly the case. Thus, the priority date of 31 July 1986 can be accorded to the subject-matter of Claim 1 of the patent in suit.

Hence, document D4 claiming the priority date of 10 April 1987 does not form state of the art according to Article 54(3) EPC. It therefore cannot destroy novelty of the subject-matter of Claim 1.

The other documents cited during the proceedings do not anticipate the claimed subject-matter because none of these documents discloses an ostomy coupling comprising all the features mentioned in Claim 1.

4. *Inventive step*

4.1 As agreed by the parties, document D1 represents the state of the art which is closest to the subject-matter of Claim 1 of the contested patent. This document discloses a two-part ostomy coupling comprising the following features of said Claim 1, namely a first part having a flange, a central chute and an array of spaced projections, and a second part having a peripheral seal for engaging and surrounding the outer wall of the chute and an outwardly-projecting rim capable of a snap-fit with the spaced projections.

4.2 In the light of the state of the art known from document D1, the objective technical problem underlying the subject-matter of the contested patent can be seen as providing a positive assurance that the parts of the coupling cannot be separated except when desired by the wearer (cf. column 3, lines 1 to 4 of the patent specification of the patent in suit). The Board cannot accept the Respondent's argument that the inventors were faced with a triple problem, namely to provide an ostomy coupling easily coupled and uncoupled, with good security of attachment and sealing and with a flat design, since all aspects of the triple problem, except the partial problem concerning the security of attachment, have already been solved by the ostomy coupling known from document D1.

4.3 The technical problem is solved by providing the known two-part ostomy coupling with a third part (called "locking ring" or "cam ring") having the features specified in Claim 1 of the patent in suit. This solution provides assurance for the user of the ostomy coupling that the coupling parts will not become accidentally uncoupled.

- 4.4 According to the established case law of the Boards of Appeal (T 176/84, OJ EPO 1986, 50; T 560/89, OJ EPO 1992, 725), the state of the art in the specific field of the invention as well as the state of any relevant art in neighbouring and/or broader general fields in which the same problem or one similar to it arises and of which the person skilled in the art of the specific field must be expected to be aware, has to be considered when assessing the existence of any inventive step.
- 4.5 In the present case, the inventor sought to provide assurance that the two parts of the snap-fit ostomy coupling known from D1 cannot be separated except when desired by the wearer. The problem of avoiding undesired uncoupling of two coupling parts also arises in the general field of engineering elements (classified in F16 of the International Patent Classification), in particular in field F16L "Pipes, joints or fittings for pipes" and especially in F16L 37/00 "Couplings of the quick-acting type" and F16L 37/08 "Couplings of the quick-acting type in which the connection is maintained by locking members". The skilled person faced with the problem underlying the present invention must be expected to be aware of this general field of engineering elements. Indeed, the Appellant has shown by citing documents EP-A-0 461 007 and US-A-4 460 363 that searches for ostomy couplings are often carried out in field F16L.
- 4.6 Document D20 "Kurata" classified in F16L 37/12 deals with the problem of increasing the reliability of couplings for flexible tubes and avoiding separation of the coupling parts during use (cf. French translation of D20, page 2, left column, lines 10 to 11 and right column, lines 6 to 8; page 3, left column, lines 29, 30, 41 and 42; and page 4, left column, lines 10 and 11).

In view of the similarity of the problems underlying the invention and document D20 and the general field in which this document is classified, the Board cannot accept the Respondent's argument that this document is irrelevant to the invention and remote and unhelpful to an ostomy appliance designer. Rather, following the established case law, the state of the art according to document D20 has to be considered when examining whether the subject-matter involves an inventive step.

4.7 Document D20 discloses a snap-fit coupling for a flexible tube. The object of avoiding separation of the coupling parts during use is achieved by providing a sleeve or ring 9 which, in one rotational position, exerts a locking function between rim 2 and lugs 5,6 and, in another position, allows the disengagement of the two parts of the coupling. The sleeve has, as admitted by the parties, both the same function and the same structural features as the third part (locking or cam ring) mentioned in Claim 1 of the contested patent (cf. D20, in particular Figures 4 and 6 and page 2, right column and page 3, left column).

4.8 As the skilled person is expected to take into account material taken from the broader general field where he can expect to find a solution to his problem, document D20 does belong to such broader field, and the problems are similar, the Board is convinced that it is obvious to a skilled person to solve the problem he is confronted with by transferring to the ostomy coupling known from D1 the principle of locking a snap-fit coupling by using a cam ring as known from document D20.

The Board does not accept the Respondent's argument that, due to the substantial force needed to couple and uncouple the coupling according to document D20, the skilled person would have been deterred from applying

the principle of locking taught by D20 in the field of ostomy couplings. The asserted substantial coupling force, if it is really needed, is due rather to the particular form of the coupling than to the principle of locking by means of a cam ring. It is pointed out in D1, page 2, lines 101 to 105 that connecting the ostomy coupling parts according to document D1, from which the invention starts, does not require a substantial force.

Furthermore, the Board does not accept the Respondent's argument that the skilled person would not consider D20 because axial movement of the locking ring would be necessary before the ring can be rotated. First, Figure 11 of D20 shows an embodiment in which ring 9 is not movable axially as is the case in Figure 6. Secondly, an axial movement is not excluded in the contested patent.

Decision T 39/82 (OJ EPO 1982, 419) to which the Respondent referred deals with the question of whether the application of a measure known in the **same** specialist field is obvious. It does not relate to the problem of another specialist field. It has, therefore, only minor relevance to the present case.

4.9 It is apparent from the preceding points that the subject-matter of Claim 1 of the contested patent does not involve an inventive step (Article 56 EPC) and is thus not patentable under Article 52(1) EPC.

5. *Referral to the Enlarged Board*

Since the Board is in a position to grant the Appellant's main request, it is not necessary to consider its auxiliary request concerning referral of three questions to the Enlarged Board of Appeal.

6. *Reimbursement of appeal fees*

According to Rule 67 EPC, reimbursement of appeal fees can only be ordered by a Board of Appeal if a substantial procedural violation has occurred. As Rule 67 is concerned with the reimbursement of an appeal fee, i.e. a fee paid in an appeal against a decision of the first instance, it follows that the procedural violation, if any, must be found in the procedure followed by that instance, and not any other.

The alleged double patenting referred to in point VI(i) above was not an act of the Opposition Division, whose decision is the subject of this appeal, but instead that of the Examining Division. Such an act, even if it were to be in breach of the procedural requirements of the EPC, would not fall within the powers of a Board of Appeal to order reimbursement given by Rule 67.

As to the second asserted substantial procedural violation (cf. point VI(ii) above), the Board takes the view that the issue under Article 100(c) EPC was thoroughly discussed during the written opposition proceedings. The Appellant's contention is therefore without substance.

Finally, as reasoned in point 2 above, Article 123(2) EPC has not been infringed, contrary to the Appellant's assertion set out in point VI(iii) above.

In the absence of any substantial procedural violation according to Rule 67 EPC, the reimbursement of appeal fees is refused.

Order

For these reasons it is decided that:

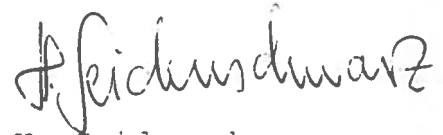
1. The decision under appeal is set aside.
2. The patent is revoked.
3. The reimbursement of appeal fees is refused.

The Registrar:



S. Fabiani

The Chairman:



H. Seidenschwarz



