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**Datasheet for the decision
of 2 August 2007**

Case Number: T 1180/05 - 3.2.02

Application Number: 99926285.0

Publication Number: 1087723

IPC: A61F 5/445

Language of the proceedings: EN

Title of invention:

A collecting bag for human body wastes

Patentee:

COLOPLAST A/S

Opponent:

Hollister Incorporated

Headword:

-

Relevant legal provisions:

EPC Art. 123(2), (3)

Keyword:

"Extension beyond the content of the application as filed - (yes) "

"Extension of the protection conferred - (yes) "

"Use of a disclaimer in order to circumvent the potential conflict between Article 123(2) and (3) EPC - refused (see Reasons for the decision 4 and 6) "

Decisions cited:

G 0001/93, G 0001/03, T 0390/90

Catchword:

The deletion of a feature in a granted claim, which feature extends beyond the content of the application as filed, and its reintroduction in the form of a disclaimer, so that the

subject-matter of the claim remains the same, is not suitable to overcome the potential conflict between Articles 123(2) and (3) EPC.



Case Number: T 1180/05 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 2 August 2007

Appellant I:
(Patent Proprietor)

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Appellant II:
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Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted
30 June 2005 concerning maintenance of the
European Patent No. 1087723 in amended form.**

Composition of the Board:

Chairman: T. Kriner
Members: D. Valle
E. Dufrasne

Summary of Facts and Submissions

- I. The patent proprietor (appellant I) lodged an appeal on 12 September 2005 against the decision of the opposition division posted on 30 June 2005 maintaining the European patent 1 087 723 in amended form. The fee for the appeal was paid simultaneously and the statement setting out the grounds for appeal was received on 10 November 2005.
- II. The opponent (appellant II) lodged an appeal on 9 September 2005. The fee for appeal was paid on the same day and the statement setting out the grounds for appeal was received on 10 November 2005.
- III. Oral proceedings took place on 2 August 2007.

The appellant I requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or, in the alternative, on the basis of one of the first or second auxiliary request both filed with letter dated 29 June 2007 or of a third or fourth auxiliary request both filed at the oral proceedings.

In case that the first to fourth auxiliary requests were considered not allowable, as fifth auxiliary request it was submitted to refer the following question to the Enlarged Board of Appeal:

"Under which circumstances, if any, does an amendment to a European patent made during opposition proceedings comply with the provisions of Articles 123 (2) and 123 (3) EPC, if the amendment consists in:

- a) the removal of subject-matter included in the claim as allowed by the Examining Division but not disclosed in the application as filed, and
- b) the introduction of a disclaimer excluding embodiments of the invention not incorporating such a subject-matter from protection?"

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

IV. Claim 1 as granted reads as follows:

"A collecting bag for human body wastes comprising a bag member (1) formed by two film blanks (2, 3) with joined edges, an inlet opening (5) provided in one (3) of said film blanks (2, 3), connecting elements (6) surrounding said inlet opening for connection of the bag to a body orifice, a narrowed, elongated discharge portion (8) starting at a proximal end at a distance from the inlet opening (5) and extending between two end sections of said film blanks (2, 3) to a distal end, a discharge opening (9) formed in said discharge portion (8) in the vicinity of said distal end, said discharge portion (8) being foldable and unfoldable by at least one folding in a longitudinal direction thereof between said distal and proximal ends to bring the discharge portion from an open unfolded condition to a sealingly closed folded condition and vice versa, and a locking device (10 - 13) being provided at the discharge portion for locking the bag in said closed folded condition of the discharge portion, characterized in that at least one resilient seal member (35b; 35b') is attached to at least one film blank (2, 3; 2', 3') of the discharge portion (8; 8';

8'') at or near the discharge opening (9) and comprises a resiliently compressible sealing plate (35b, 35b'), said seal member having greater rigidity than said film blanks and extending transversely to said longitudinal direction of the discharge portion (8; 8'; 8'') throughout the width of the discharge opening (9), and that a contact surface having greater rigidity than said film blanks (2, 3) is provided by the other film blank, said contact surface being engageable by said resilient seal member by said at least one folding to provide a substantially fully sealed closure of the discharge opening."

The precharacterising portion of claim 1 of all present auxiliary requests corresponds to the one of claim 1 of the main request.

The characterising portion of claim 1 of the first auxiliary request reads as follows (the additions with respect to the main request are underscored, the deletions struck through):

"...characterized in that ~~at least one~~ resilient seal member (35a; 35a'; 35b; 35b') is attached to ~~at least one~~ each film blank (2, 3; 2', 3') of the discharge portion (8; 8'; 8'') at or near the discharge opening (9) and comprises a resiliently compressible sealing plate (35a; 35a'; 35b, 35b'), said seal members having greater rigidity than said film blanks and extending transversely to said longitudinal direction of the discharge portion (8; 8'; 8'') throughout the width of the discharge opening (9), ~~and that a contact surface having greater rigidity than said film blanks (2, 3) is provided by the other film blank, said contact surface~~

said resilient seal members being engageable with each other by ~~said resilient seal member by~~ said at least one folding to provide a substantially fully sealed closure of the discharge opening."

The characterising portion of claim 1 of the second auxiliary request reads as follows (the additions with respect to the main request are underscored, the deletions struck through):

"...characterized in that ~~at least one~~ resilient seal member (35a; 35a'; 35b; 35b') is attached to ~~at least one~~ each film blank (2, 3; 2', 3') of the discharge portion (8; 8'; 8'') at or near the discharge opening (9) and comprises a resiliently compressible sealing plate (35a; 35a'; 35b, 35b'), said seal member having greater rigidity than said film blanks and extending transversely to said longitudinal direction of the discharge portion (8; 8'; 8'') throughout the width of the discharge opening (9), and that one of the resilient seal members (35a, 35a') provides a contact surface of the film blank (2) to which it is attached, the contact surface having greater rigidity than said film blanks (2, 3) ~~is provided by the other film blank,~~ said contact surface being engageable by ~~said the~~ resilient seal member (35b, 35b') attached to the other film blank (3) by said at least one folding to provide a substantially fully sealed closure of the discharge opening."

The characterising portion of claim 1 of the third auxiliary request reads as follows (the additions with respect to the main request are underscored, the deletions struck through):

"...characterized in that at least one resilient seal member (35b; 35b') is attached to at least one film blank (2, 3; 2', 3') of the discharge portion (8; 8'; 8'') at or near the discharge opening (9) and comprises a resiliently compressible sealing plate (35b, 35b'), said seal member having greater rigidity than said film blanks and extending transversely to said longitudinal direction of the discharge portion (8; 8'; 8'') throughout the width of the discharge opening (9), and that a contact surface ~~having greater rigidity than said film blanks (2, 3)~~ is provided by the other film blank, said contact surface being engageable by said resilient seal member by said at least one folding to provide a substantially fully sealed closure of the discharge opening, except collecting bags, wherein said contact surface does not have the same or greater rigidity than said film blanks (2, 3)."

Claim 1 of the fourth auxiliary request differs from claim 1 of the third auxiliary request by the following additional feature (added between the last feature of the claim and the disclaimer):

"and that one of the film blanks (3) is formed at the distal end of the discharge portion (8) with an extension (3a) beyond a distal edge of the other film blank, said discharge opening (9) being formed between said extension and said distal edge of the other film blank and that said at least one resilient seal member (35b) is provided on said extension (3a)."

V. Appellant I argued as follows:

The feature of claim 1 of the main request according to which "a contact surface having greater rigidity than said film blanks (2, 3) is provided by the other film blank" was clearly derivable from the combined statements of the sentence bridging pages 5 and 6 and of the paragraph on page 7, lines 20 to 25 of the originally filed description published in WO - 99/66859. These statements made it clear that the two sealing plates shown in Figures 6 and 7 could be replaced by a single sealing plate on one of the film blanks which inevitably required that the other film blank had to provide a contact surface having the same rigidity as the sealing plates. Hence, the subject-matter of claim 1 of the main request did not extend beyond the content of the application as filed.

The deletion of the feature: "a contact surface having greater rigidity than said film blanks is provided by the other film blank" according to claim 1 of the first auxiliary request did not imply an extension of the protection conferred. Since the second seal member defined in this claim formed part of the other film blank, it was obvious that the surface of the second sealing plate was also the surface of the other film blank.

In order to further clarify this fact claim 1 of the second auxiliary request contained a feature according to which one of the seal members provided a contact surface of the film blank.

The third and fourth auxiliary requests, both contained the same disclaimer introduced to overcome the trap constituted by the concurring requirements of Article 123(2) and (3) EPC (see G 1/93). By deleting the feature that "the contact surface has greater rigidity than said film blanks" and contemporarily introducing into the claim the disclaimer "except collecting bags, wherein said contact surface does not have the same or greater rigidity than said film blanks" the so amended claim had the same extent of subject matter as before the amendments. However, by deleting a feature which was not originally disclosed, the requirements of Article 123(2) EPC were met, and by reintroducing this feature in negative form, the requirements of Article 123(3) EPC were met. Hence, in accordance with G 1/03, the reintroduction of a deleted feature which was not directly supported by the original disclosure in order to overcome formal hurdles in a claim should be allowable.

VI. The appellant II contested the statements of the appellant I and argued essentially as follows:

The feature of claim 1 of the main request: "a contact surface having greater rigidity than said film blanks (2, 3) is provided by the other film blank" was not originally disclosed. The sentence bridging pages 5 and 6 referred to the rigidity of the sealing plates or of the seal members and not to the rigidity of the contact surface of the blank. A contact surface was only mentioned on page 7, lines 21 to 25, in connection. However, there was no hint concerning the rigidity of this surface.

The deletion of the feature: "a contact surface having greater rigidity than said film blanks is provided by the other film blank" according to claim 1 of the first auxiliary request did not comply with Article 123(3) EPC, since that it meant that the contact surface could be provided not only by the other film blank, but also, for example, by the second seal member.

The subject-matter of claim 1 of the second auxiliary request did not comply with Article 123(2) EPC, since it contained the feature that the contact surface of the other film blank was provided by the second seal member, which was not disclosed in the originally filed application.

The subject-matter of claim 1 of the auxiliary requests 3 and 4 did not comply with Article 123(2) EPC either and should also not be allowed. This was evident, since the subject-matter of claim 1 of the auxiliary request 3 corresponded to that of claim 1 of the main request and claim 1 of the auxiliary request 4 merely contained a further feature which could not overcome the Article 123(2) problem.

The auxiliary request 5 should be refused, since G 1/93 already listed all cases where a disclaimer was allowable.

Reasons for the Decision

1. *The appeal is admissible.*

2. *Main request*

The feature of claim 1 of the main request: "a contact surface having greater rigidity than said film blanks (2, 3) is provided by the other film blank" is not disclosed in the originally filed application as published under WO-A-99/66839.

The original disclosure contains the following relevant pieces of information:

- at least one resilient seal member having greater rigidity than the film blanks is attached to at least one film blank to engage a contact surface of the other film blank (paragraph bridging pages 2 and 3);
- two resilient seal members in the form of sealing plates having a greater rigidity than the film blanks are provided on the film blanks (paragraph bridging pages 5 and 6);
- only one resilient seal member is provided on only one of the film blanks to engage with a non-resilient contact surface on the other film blank (page 7, lines 20 to 25 and claim 1);

Hence, in case where the claimed collecting bag comprises only one seal member, the originally filed documents disclose exclusively that

- a resilient seal member having greater rigidity than the film blanks is provided on one film blank, and
- a non-resilient contact surface is provided on the other film blank.

However, there is no disclosure in the original application that a contact surface having greater rigidity than the film blanks is provided by the other film blank.

Contrary to the argumentation of the appellant I there is no basis in the originally filed documents that, in the case where a sealing member is provided only on one of the film blanks, the contact surface of the other film blank should have the same characteristics as the sealing member, in particular a greater rigidity than the film blanks. Furthermore, there is no teaching that this contact surface is provided by the other film blank itself. When reading the paragraph bridging pages 2 and 3 in combination with the disclosure on page 7, lines 20 to 25 the contact surface unequivocally has to be provided on the other film blank.

Accordingly the ground for opposition based on Article 100 c) is well founded and claim 1 of the main request does not comply with Article 123(2) EPC.

3. *First and second auxiliary requests*

The deletion of the feature: "a contact surface having greater rigidity than said film blanks is provided by the other film blank" with respect to the granted version, according to claim 1 of the first and second auxiliary requests does not comply with Article 123(3) EPC, since it results in an extension of the protection sought.

The embodiments of the claimed collecting bag covered as a result of the above deletion are no longer restricted to those bags where the contact surface is provided by the other film blank.

The argumentation of the appellant I that this finding is not correct, since the second seal member formed part of the other film blank is not convincing. Figures 6 and 7 as well as the corresponding description clearly show that the seal members are separate elements attached to and arranged on the film blanks. Hence, the surfaces of the seal members cannot be considered as surfaces of the film blanks.

Contrary to the assertion of the appellant I the deleted feature does also have a technical meaning and represents a technical contribution to the invention, since it contributes to the definition of the embodiments of the invention and implies a specific design of the claimed collecting bag.

Accordingly claim 1 of the first and second auxiliary requests contains an amendment to the granted version which results in an extension of the protection conferred, contrary to the requirements of Article 123(3) EPC.

4. *Third auxiliary request*

- 4.1 Claim 1 of the third auxiliary request is derived from the granted version (main request) by:

- (a) deleting the feature according to which a contact surface has greater rigidity than said film blanks and by
- (b) adding the feature: "except collecting bags, wherein said contact surface does not have the same or greater rigidity than said film blanks."

4.2 The assumption that the feature of step b) covers the same content as the feature a) is not correct. According to the feature of step a) the rigidity of the contact surface (r_{cs}) has to be greater than the rigidity of the film blanks (r_{fb}), in other words $r_{cs} > r_{fb}$. The second portion of the feature of step b) (starting with "wherein") requires that the rigidity of the contact surface is less than the rigidity of the film blanks, $r_{cs} < r_{fb}$. In conjunction with the first portion of the feature of step b) ("except collecting bags") this means that the rigidity of the contact surface of the claimed bag has to be the same as or greater than the rigidity of the film blanks, $r_{cs} \geq r_{fb}$.

Consequently the replacement of the feature according to step a) by the feature according to step b) results in an extension of the protection conferred, so that claim 1 of the third auxiliary request does not comply with Article 123(3) EPC.

4.3 Under consideration of only the second alternative of the feature of step b) ("the rigidity of the contact surface is greater than the rigidity of the film blanks"), the two steps a and b cancel each other out, so that the final result of the amendments according to the third auxiliary request - second alternative - is a

claim covering exactly the same extent of subject-matter as the granted claim 1.

Since claim 1 as granted has been found not to be allowable on the basis that the feature that "a contact surface having greater rigidity than said film blanks is provided by the other film blank" was not originally disclosed, and since the subject-matter of claim 1 of the third auxiliary request without the first alternative of the feature of step b) is identical with the one of claim 1 as granted, such a claim 1 of the third auxiliary request inevitably has to share the fate of claim 1 as granted. Therefore, under the assumption that the steps a) and b) cancel each other out, claim 1 of the third auxiliary request does not comply with Article 123(2) EPC.

5. *Fourth auxiliary request*

Claim 1 of the fourth auxiliary request is based among other things on the same deletion (step a) and addition (step b) as claim 1 of the third auxiliary request. Therefore, for the same reasons, claim 1 of the fourth auxiliary request does not comply with Article 123(2) EPC.

6. *Fifth auxiliary request - Referral to the Enlarged Board of appeal*

- 6.1 Under Article 112(1)a) EPC, the Board of Appeal may, during proceedings on a case, refer any questions to the Enlarged Board of Appeal if
- (a) it considers that a decision is required in order to ensure uniform application of the law, or

(b) if an important point of law arises.

6.2 A referral to ensure uniform application of the law is required if the board intends to depart from an interpretation of the EPC in an earlier decision of the boards of appeal.

6.2.1 In the present case, the first part of the question:

"Under which circumstances, if any, does an amendment to a European patent made during opposition proceedings comply with the provisions of Articles 123 (2) and 123 (3) EPC, if the amendment consists in:

a) the removal of subject-matter included in the claim as allowed by the Examining Division but not disclosed in the application as filed",

has been essentially answered in the decision of the Enlarged Board of Appeal G 1/93 to the effect that:

"If a European patent as granted contains subject-matter which extends beyond the content of the application as filed within the meaning of Article 123(2) EPC and which also limits the scope of protection conferred by the patent, such patent cannot be maintained in opposition proceedings unamended, because the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent. Nor can it be amended by deleting such limiting subject-matter from the claims, because such amendment would extend the protection conferred, which is prohibited by Article 123(3) EPC. Such a patent can, therefore, only be maintained if there is a basis in the application as

filed for replacing such subject-matter without violating Article 123(3) EPC" (see G 1/93, Order, 1.),"

and the board does not intend to depart from this interpretation.

6.2.2 Regarding the second part of the question of the allowability of the amendments if they consist in:

"b) the introduction of a disclaimer excluding embodiments of the invention not incorporating such a subject-matter (i.e. claimed but not disclosed) from protection",

the board has reached the following conclusions:

On the basis of decision G 1/03, point 2 of the reasons, the board considers the term "disclaimer" as meaning an amendment to a claim resulting in the incorporation therein of a "negative" technical feature, typically excluding from a general feature specific embodiments or areas. That decision deals with the allowability of disclaimers which have not been disclosed in the application as filed.

In the present case, the feature:

"except collecting bags, wherein said contact surface does not have the same or greater rigidity than said film blanks",

contained in the claim 1 of the third and fourth auxiliary requests, if taken at its face value, appears

to be a "disclaimer" with respect to claim 1 as granted.

However, it is not completely convincing that the "disclaimer" *per se* deserves this name, since, even if it is introduced by the word "except", it contains a double negative in the form: "except... does not have", the result of which is not to disclaim, but to claim additional subject-matter. Furthermore, the board wants to emphasize that the only reason for introducing the "disclaimer" is to reintroduce into the claim a deleted feature. Therefore the present approach results in nothing more than an artificial and editorial rewording of the claim without modification of its technical content.

Putting aside these considerations and accepting that the feature in question is a disclaimer, the board is not aware of any decision which has allowed this kind of disclaimer in order to overcome the conflict between Articles 123(2) and (3) EPC, nor could the appellants cite such a decision.

In particular, in its decision G 1/03, the Enlarged Board of Appeal has not allowed the use of an undisclosed disclaimer in the specific situation of potentially conflicting requirements under Article 123(2) and (3) EPC already dealt with in its former decision G 1/93 (see above, 6.2.1).

Accordingly, the Board has reached the conclusion that a decision of the Enlarged Board of Appeal is not required in order to ensure uniform application of the law.

6.3 Turning to the second alternative for referral to the Enlarged Board of Appeal, it remains at the discretion of the Board whether or not to refer a question to the Enlarged Board, even if it concerns an important point of law (see T 390/90, OJ EPO 1994, 808).

In the present case the board decides not to refer this question to the Enlarged Board of Appeal, since it does not consider this question to be an important point of law. Decision G 1/93 clearly pointed out that a granted patent which contains subject-matter which extends beyond the content of the application as filed within the meaning of Articles 123(2) EPC can only be maintained if there is a basis in the application as filed for replacing such subject-matter without violating Article 123(3) EPC (see order, part 1 as above cited). Moreover, decision G 1/03 gives a clear indication that a disclaimer may be allowable to restore novelty or to disclaim subject-matter which, under Articles 52 to 57 EPC, is excluded from patentability for non-technical reasons (see order, point II.1). However, there is no basis in G 1/03 for allowing a disclaimer for resolving the potential conflict between Articles 123(2) and (3) EPC.

The board is aware that in other judicial systems the conflicting provisions of Article 123(2) and (3) EPC have been dealt with more liberally in favour of the patent proprietor allowing the use of a disclaimer or - to the same effect - even of a declaration outside the claim disclaiming the subject-matter claimed but not disclosed (see for example: Schulte, Patentgesetz, 7. Aufl., 2005, § 21, Rdnr. 4.4.1, 4.4.2). However this

solution is not contemplated in the case law of the boards of appeal, see decision G 1/93.

- 6.4. Accordingly, the request to refer two questions to the Enlarged Board of Appeal is rejected.

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:

V. Commare

T. Kriner