

Examiners' Report Paper C 2016

1. Introduction

This year's paper focused on novelty, inventive step argumentation and added subject matter. The paper also required dealing with the public availability of, in this case, a package insert of a product.

The patent to be opposed (Annex 1) claims priority.

It was necessary to carefully consider the client's letter and apply it to the Notice of Opposition.

The client's letter gives information about two important topics. Firstly, it describes the relationship of the patent, the application as originally filed and the priority document. Secondly, it provides details about the prior disclosure of Annex 5.

Claim 1 of Annex 1 is directed to a reusable therapeutic device comprising a thermally active composition. The subject-matter of claim 1 is then restricted in dependent claims 2, 3 and 4. Claims 5 and 6 are both independent claims and relate to a thermally active composition.

2. General Comments

Analysis of the effective dates of the claims and the relevance of the cited documents in relation to these effective dates was required.

It is necessary to identify other relevant information in addition to claim features, such as technical effects, problems and hints in the Annexes, and use that information to develop convincing arguments. The specific reference in the relevant document (e.g. paragraph or figure or reference number, as appropriate) needs to be cited.

All the information necessary to oppose the patent is to be found in the Annexes (including Annex 1) and the client's letter. If the prior art uses a different terminology

to the feature in the claim, it should be explained why it has the same meaning, on the basis of the information provided in the Annexes. The candidate's own knowledge of the technical field of the invention shall not be used. For example, in this year's paper the information that a pouch in Annex 2, §5 is the same as a closed envelope is given in Annex 3, §4.

The problem-solution approach requires identification of the closest prior art for each inventive step attack. A reasoning for the choice of the closest prior art should include the identification of the purpose of the subject-matter to be attacked and of the selected prior art document over and above the disclosure of the other documents. General statements such as "Annex X is the most promising springboard to the invention because it has the most features in common" or "Annex X relates to the same general purpose and therefore is the closest prior art" are not considered as convincing reasoning for selecting the closest prior art.

In this year's paper, all of Annexes 2, 3 and 5 provided, relate to a therapeutic device, so a more specific reasoning is required. For example, a motivation for choosing Annex 3 as the closest prior art against claim 1 may be that it has the same purpose of being reusable, whereas starting with Annex 5 would not lead to a device which is reusable.

The feature(s) distinguishing the claim from the closest prior art should be identified. Any associated technical effect(s) as set out in the patent has/have to be identified and the appropriate basis must be cited. The objective technical problem to be solved has to be established based on the technical effect. This applies to both independent and dependent claims.

A comprehensive answer includes specific reasons explaining why the skilled person would combine documents, e.g. by pointing to a specific part of the other document that is related to the same purpose or the same objective technical problem. In this year's paper, a substantiated argument against inventive step of claim 4, when discussing why a skilled person would consult Annex 6, would be to point to specific issues in Annex 6 which are also identified in the closest prior art, Annex 2, e.g. avoiding pressure points.

General statements (i.e. “The skilled person would combine the teaching of the documents without any technical hindrance”) are not considered as convincing reasoning for combining features of specific documents.

In addition to the attacks set out in the “possible solution”, marks were awarded for other plausible, well-reasoned attacks. The marking sheet gives information on the categories of novelty, inventive step and other aspects. Typically, marks are awarded for correct use of information and argumentation. The marks given for a candidate in the respective categories may not correspond exactly to the approach taken by the candidate; the marks indicate to which extent the candidate's answer matches the preferred approach.

For the opposition to be admissible, it is required that the patent to be opposed as well as the opponent are identified. Payment of the opposition fee should be indicated. It should be borne in mind that the opponent is generally the company and not the person signing the client's letter. Use of the pre-printed opposition form is not required, but can be helpful.

3. Notice of opposition

Effective dates of the claims and the prior art; added subject-matter

The information provided in the client's letter and in Annex 7 was to be used for this analysis. For claims 4 and 6 an argumentation was expected that their technical content is not disclosed in the priority document including aspects of the description that relate to those claims.

A full assessment of the time rank of Annex 2 requires the details of its status under Art. 54 (2) and (3) EPC. A2 is prior art under Art. 54 (3) EPC for claims 1, 3 and 5 of Annex 1 because it is a published European patent application having a priority date that is earlier than the effective date of those claims.

Answers were expected to include a discussion of the relevance of Annex 5. Annex 5 is a package insert of a product which was bought in 2010, before the priority date of Annex 1. The printing date on the insert suggests the availability to the

public before the priority date, but further evidence like the receipt of the purchase should be offered. Thus, Annex 5 is valid prior art according to Art. 54 (2) EPC for all the claims.

An objection of subject-matter extending beyond the content of the application as filed on claim 2 was expected. A complete reasoning required a consideration of the information available in the application as filed, and why this was not sufficient basis for the claim. In particular, in this year's paper, page 5 of the application as filed (Annex 7) was provided in order to facilitate arguing the lack of direct and unambiguous teaching in the application as filed for a device, which is shaped for the hock and the hoof simultaneously.

Claim 1

It was expected to argue for lack of novelty based on Annex 2 as prior art under Article 54 (3) EPC.

An inventive step argument was also expected based on Annex 3, because in this case it is a good ground of opposition. Annex 3 is the closest prior art because it concerns a reusable therapeutic device and thus has the same purpose. Annex 2 is not available for claim 1 for inventive step, Annex 4 does not disclose a device, Annex 5 would not result in the claimed invention as it would not be reusable, and Annex 6 is directed to a protective gaiter.

Fully reasoned inventive step arguments included a discussion of:

- why a skilled person would be motivated to modify the closest prior art (for example Annex 3 states that improved treatment can be achieved by alternating with a cold-water bandage);
- why a skilled person could include a thermally active composition in the device of Annex 3 (because Edgalase is already contained within the pouches, and adding Ahlericheon would be technically feasible); and
- why a combination of Annex 3 and Annex 4 would be compatible (Annex 4 shows that the Totilasen is compatible because it does not affect the cooling properties of the composition).

Claim 3

Claim 3 has two alternative embodiments (hock and hoof), which needed to be dealt with separately.

Each alternative has two distinguishing features over the closest prior art, with separate and unrelated technical effects; a thermally active composition which upon activation with water provides a cooling action and the shape of the device. Thus, an attack based on partial problems (Guidelines, G-VII, 5.2 or 6) was expected, with the combination of Annex 3, Annex 4 and Annex 6.

It is noted that the first difference regarding the thermally active composition, and the associated technical effect, between claim 3 and Annex 3 was not the same as for claim 1, because it further required a cooling action upon activation with water.

Claim 4

An inventive step attack based on the combination of Annex 2 and Annex 6 was expected. Annex 2 is the closest prior art, rather than Annex 3, since Annex 3 states that other fastening means are unsuitable. It was sufficient to refer to the argumentation given for claim 1 concerning the common features.

Claim 5

An inventive step attack based on the combination of Annex 5 as closest prior art with Annex 4 was expected. Annex 5 is a more suitable starting point than Annex 4, since Annex 4 does not explicitly disclose Lesmorsase and Ahlericheon together, and does not disclose the claimed range 20-40%. Annex 2 is not available for claim 5 for inventive step. Annex 3 discloses only Edgalase. Annex 6 has no composition at all.

Fully reasoned inventive step arguments included a discussion of:

- why a skilled person would be motivated to modify the closest prior art (because Annex 5 warns that Pageatase is toxic to aquatic organisms); and
- why a skilled person could replace Pageatase with Lesmorsase without any

detrimental consequences (because Annex 4 states that Lesmorsase and Pageatase are both members of the EKLAG class of activators and that they all produce the same cooling effect).

Claim 6

Claim 6 was anticipated by Annex 2, which discloses a composition that inherently has the claimed properties. No further attack was expected.

Possible solution – Paper C 2016

Obtainable marks for "Use of Information" and "Argumentation" are indicated in parentheses in each section's heading.

Notice of opposition (in combination with filled in Form 2300).

Total marks for "Use of Information" / Total marks for "Argumentation": (45/55)

Effective dates of the claims and prior art; added subject-matter (8/6)

Effective dates

Annex 1 was filed on 22/11/2011 and claims priority to FR1104119, which was filed on 22/04/2011.

Claims 1, 3 and 5:

Independent claims 1 and 5 and dependent claim 3 were disclosed in the priority document and in the application as filed. Therefore the claimed priority for those claims is valid: the effective date for claims 1, 3 and 5 is 22/04/2011.

Claims 4 and 6:

Dependent claims 4 and 6 were filed with the European application.

The application as originally filed discloses a fastening means with two elastic straps (Annex 7, §25), which is the same as the priority document for this paragraph, whereas only one of the straps of the fastening means of claim 4 is elastic. Thus, claim 4 is entitled to the filing date i.e. 22/11/2011.

Annex 1, §11, which is the same as the application as filed, discloses the composition of claim 6, was not present in the priority document and thus there is no support for the composition of claim 6. Thus, claim 6 is entitled to the filing date i.e. 22/11/2011.

Prior Art

Annex 2 is a European application filed on 05/12/2009, published on 06/06/2011. Thus, Annex 2 is prior art according to Article 54(2) and Article 56 EPC for claims 4 and 6, and according to Article 54(3) EPC for claims 1, 3 and 5.

Annex 3, Annex 4 and Annex 6 were all published before the priority date of Annex 1, i.e. 22/4/2011. Each document is therefore prior art according to Article 54(2) and Article 56 EPC for all claims.

Annex 5 is a package insert of the product Therapack bought in 2010 and therefore available to the public before the priority date of Annex 1. The printing date on the insert strongly suggests the availability of the product to the public before the priority date, and, if contested further evidence will be provided, for example a copy of the receipt of the purchase or testimony from the purchaser. Thus, Annex 5 is prior art available under Article 54(2) and Article 56 EPC for all claims.

Added subject-matter – Article 100(c) EPC

Dependent claim 2 was added to the application during examination. According to claim 2, the device is shaped to simultaneously conform to both the contours of the hock and the hoof of a horse. The application as filed discloses (Annex 7, §22) a device, which is shaped for either the hock or the hoof. There is no direct and unambiguous teaching in the application as filed for a device which is shaped for the hock and the hoof simultaneously. Claim 2 thus extends beyond the content of the application as filed under Article 100(c) EPC.

Claim 1 [Independent] – Lack of novelty (8/4)

A2 discloses a reusable (Annex 2, §8) therapeutic device (Annex 2, §3) comprising: a closed envelope (Annex 2, §5, a pouch is a closed envelope according to Annex 3, §4);
the envelope being partitioned into at least two rows (Annex 2, §5, “one or more rows” thus more than one must be at least two) each comprising at least two non-

communicating pockets (Annex 2, §6, "isolated within each compartment") positioned side by side (figure 1 shows at least two pockets side by side);
each pocket comprising a thermally active composition (the composition disclosed in Annex 2, §4 fulfils the definition of thermally active composition given in Annex 1, §2, "a composition which, as a result of a chemical reaction, is able to actively produce either cold or heat");
and integrated fastening means (Annex 2, §7) for providing temporary fastening of the device to a patient (Annex 2, §8).

Thus, Annex 2 discloses all the features of claim 1, which contravenes Article 54(1), (3) EPC.

Claim 1 [Independent] – Lack of inventive step (8/9)

Annex 3 is the closest prior art for claim 1; it is the only available prior art disclosing a thermotherapeutic device, which has the purpose of being reusable.

Annex 3 discloses a reusable (Annex 3, §10) therapeutic device (Annex 3, §2) comprising:
a closed envelope (Annex 3, §4);
the envelope being partitioned into at least two rows, each comprising at least two non-communicating pockets positioned side by side (Annex 3, §5);
each pocket comprising a composition (Annex 3, §5);
and integrated fastening means (reference sign 80, figure 1) for providing temporary fastening of the device to a patient (Annex 3, §10).

The subject-matter of claim 1 differs from the disclosure of Annex 3 in that the composition is thermally active.

This has the effect of accelerating the healing process (Annex 1, §2) and solves the objective technical problem of providing a therapy to improve the healing process.

Annex 3 motivates the skilled person to combine a cooling treatment with a medicinal treatment to accelerate the healing process (Annex 3, §10).

The skilled person would have consulted Annex 4 because it relates to thermotherapy as cold therapy (Annex 4, §7).

The solution to the objective technical problem is found in Annex 4. Annex 4 explains that all compositions with Ahlericheon and at least one activator of the class EKLAG, when placed in contact with water, produces a cooling effect as a result of a chemical reaction. Thus, the composition provides active thermotherapy (Annex 4, §3).

Annex 4 states that Totilasen does not interfere with the cooling effect of such a composition (Annex 4, §6), hence such a composition is compatible for a device according to Annex 3, and would solve the problem of accelerating the healing process (Annex 4, §8).

A4 specifically mentions that Edgalase and Ahlericheon can be used together (Annex 4, §9). Thus, a skilled person would add Ahlericheon to the composition of Edgalase already present in the device of Annex 3 without requiring an inventive step.

Thus, the subject-matter of claim 1 is not inventive over Annex 3 in the light of the teaching of Annex 4 and claim 1 contravenes Article 56 EPC.

Claim 3 [dependent on claim 1] – Lack of inventive step (6/14)

Annex 3 is the closest prior art; it is the only available prior art which deals with a reusable therapeutic device for horses with the purpose of cooling.

The disclosure of Annex 3 is a reusable therapeutic device having some of the features defined in claim 1 (cf. argumentation against claim 1 above).

The subject-matter of claim 3 differs from the disclosure of Annex 3 in that the composition is a thermally active composition which upon activation with water provides a cooling action (first difference) and in that the device is shaped to conform to the contours of the hock or the hoof of a horse (second difference).

The first difference has the effect of providing a therapeutic effect (Annex 1, §9).

The second difference comprises two alternatives.

The second difference, first alternative is a device shaped to conform to the contours of the hock which has the effect to avoid abrasions due to rubbing (Annex 1, §22).

The second difference, second alternative is a device shaped to conform to the contours of the hoof (Annex 1, §22) with the same effect as the one linked to the second difference, first alternative.

The first and second differences do not mutually influence each other and have no synergistic effect. They solve two separate partial problems and can therefore be treated separately, Guidelines, G, VII, 5.2.

The first difference solves the first partial objective technical problem of improving the healing process.

The second difference, first and second alternatives, solves the partial objective technical problem of avoiding abrasions.

First difference

All the compositions disclosed in Annex 4 are only activated upon contact with water and produce a cooling action (Annex 4, §3).

Thus, the solution to the first partial objective technical problem is the same as for claim 1.

Second difference, first alternative

The skilled person would have consulted Annex 6 as it relates to a gaiter for horses, and thus belongs to the same field (Annex 6, §1).

Annex 6 discloses a device, which is specially shaped for the hock (Annex 6, §8) in order to avoid abrasions (Annex 6, §3).

Furthermore, Annex 3 motivates the skilled person to modify the device for other parts of the legs (Annex 3, §11). Thus, the skilled person would apply this particular

shape of the garment of Annex 6 in the device of Annex 3 to provide a device, which avoids abrasions, without requiring an inventive step.

Second difference, second alternative

The skilled person would have consulted Annex 6 for the same reasons as those given for the second difference, first alternative.

Annex 6 discloses a device with is specially shaped for the hoof (Annex 6, §11 and §12) in order to avoid abrasions (Annex 6, §3). Thus, the skilled person would apply this particular shape of the garment of A6 in the device of A3 to provide a device, which avoids abrasions, without requiring an inventive step.

Therefore, the subject-matter of claim 3 is not inventive over Annex 3 in the light of the teachings of Annex 4 and Annex 6 and claim 3 contravenes Article 56 EPC.

Claim 4 [dependent on claim 1] – Lack of inventive step (6/9)

Annex 2 is the closest prior art because it is the only available prior art document with the purpose of being reusable and having the most features in common with the subject-matter of claim 4.

The disclosure of Annex 2 has all the features of claim 1 (cf. argumentation against claim 1 novelty above).

The subject-matter of claim 4 therefore differs from the disclosure in Annex 2 in that the fastening means have the additional features of claim 4.

This has the effect of obtaining an even pressure distribution and of avoiding any pressure points (Annex 1, §19) and solves the objective technical problem of avoiding pressure points.

By mentioning that pressure points should be avoided (Annex 2, §7), Annex 2 already motivates the skilled person to look for a solution to the objective technical problem.

The skilled person would have consulted Annex 6 as it has to do with pressure distribution in gaiters (Annex 6, §5).

Annex 6 discloses fastening means with two straps, only one of which is elastic, and wherein the straps are fixed to opposing sides of the envelope, along the entire length of the edge of each side (Annex 6, §10) and wherein the straps have complementary securing means. In fact, the “hook & loop” means defined in Annex 6, §10 fulfil the definition of the complementary securing means given in Annex 1, §25.

These fastening means of Annex 6 can be applied to other gaiters (Annex 6, §15) and solve the problem stated above (Annex 6, §5).

Furthermore, those fastening means do not interfere with the shape of gaiters in general (Annex 6, §5), so that they are compatible with the special shape of the pad disclosed in Annex 2.

Therefore, the teaching of Annex 6 prompts a skilled person to replace the fastening means of Annex 2 with the fastening means of Annex 6.

Thus, the subject-matter of claim 4 is not inventive over Annex 2 in the light of the teaching of Annex 6, and claim 4 contravenes Article 56 EPC.

Claim 5 [Independent] – Lack of inventive step (7/10)

The closest prior art for claim 5 is Annex 5. Annex 5 deals with the same purpose as claim 5, i.e. providing a cooling effect and it has more features in common than Annex 4.

Annex 5 discloses a composition comprising 35% by weight of Ahlericheon and Pageatase (lines 15 and 16). Annex 5 does not explicitly state that the composition is responsible for the observed cooling effect. However, it is explained in Annex 4, §3, that such a composition always produces a cooling effect upon activation with water. Thus, the composition disclosed in Annex 5 inevitably produces a cooling effect and is a thermally active composition in the sense of Annex 1, §2.

Furthermore, the value 35% by weight is within the range of 20-40% by weight, so that the specific disclosure of Annex 5 anticipates the claimed range.

The subject-matter of claim 5 differs from the disclosure in Annex 5 in that the composition comprises Lesmorsase instead of Pageatase.

This difference has the effect of providing a non-toxic composition (Annex 1, §12) and solves the objective technical problem of providing a water activated non toxic cooling composition.

Annex 5 already warns that Pageatase is toxic to aquatic organisms (lines 19-20). Thus, the skilled person is motivated to search for a solution and would consult Annex 4 because it relates to water-activated cooling compositions (Annex 4, §8).

A4 provides the solution in that it explains that Lesmorsase is a non-toxic activator (Annex 4, §9). Lesmorsase belongs to the EKLAG class of activators (Annex 1, §12) and Annex 4 states that all the EKLAG activators are useful for cold therapy (Annex 4, §3), so that the skilled person would expect the same cooling effect as Pageatase with a composition using Lesmorsase.

Thus, the skilled person would replace Pageatase with Lesmorsase to obtain a non-toxic composition.

Hence, the subject-matter of claim 5 is not inventive over Annex 5 in the light of the teaching of Annex 4 and claim 5 contravenes Article 56 EPC.

Claim 6 [Independent] – Novelty (2/3)

Annex 2 discloses a composition comprising Ahlericheon, Lesmorsase and Edgalase (Annex 2, §4).

Annex 4 states that Ahlericheon always produces a cooling effect when in presence of at least one activator of the class EKLAGE and water (Annex 4, §3). Furthermore, Lesmorsase and Edgalase belong to the class of EKLAGE activators (Annex 1, §12). Thus, in the presence of water, activation of the composition disclosed in Annex 2 occurs to produce a cooling effect.

Although Annex 2 does not explicitly state that the disclosed composition produces a cooling effect upon activation with water, it is inherent.

Thus, the subject-matter of claim 6 lacks novelty over Annex 2, and claim 6 contravenes Article 54(1), (2) EPC.

EXAMINATION COMMITTEE II

Paper C - 2016 - Marking Sheet

Category		Maximum possible
Novelty	Novelty Use	10
	Novelty Argumentation	7
Inventive step	Inventive Step Use	27
	Inventive Step Argumentation	42
Other	Other Use	8
	Other Argumentation	6
Total		100