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**D E C I S I O N**  
**of 20 January 2005**

**Case Number:** T 0109/02 - 3.2.2

**Application Number:** 95302708.3

**Publication Number:** 0679372

**IPC:** A61B 19/00

**Language of the proceedings:** EN

**Title of invention:**  
Radiopaque stent markers

**Patentee:**  
ADVANCED CARDIOVASCULAR SYSTEMS, INC.

**Opponents:**  
1. C.R. BARD INC.  
2. William Cook Europe ApS

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 84, 54

**Keyword:**  
"Lack of novelty - main and auxiliary requests 1, 2 and 4"  
"Unsupported claim - third auxiliary request"

**Decisions cited:**  
T 0917/95

**Catchword:**  
-



Case Number: T 0109/02 - 3.2.2

**DECISION**  
of the Technical Board of Appeal 3.2.2  
of 20 January 2005

**Appellant 1:**  
(Opponent 1)

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**Representative:**

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**Appellant 2:**  
(Proprietor of the patent)

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**Representative:**

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**Decision under appeal:**

Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
23 November 2001 concerning maintenance of  
European patent No. 0679372 in amended form.

**Composition of the Board:**

**Chairman:** T. K. H. Kriner  
**Members:** M. G. Noël  
U. J. Tronser

## **Summary of Facts and Submissions**

- I. Following two oppositions filed by opponents 01 and 02 against European patent No. 0 679 372, the opposition division decided by interlocutory decision dated 23 November 2001 to maintain the patent in a form amended during oral proceedings.
- II. The opponent 01 and the patent proprietor each lodged an appeal against this decision, on 23 January 2002 and 31 January 2002, respectively. The corresponding statements of grounds were filed in the prescribed time-limits, on 25 March 2002 and 2 April 2002, respectively. Opponent 02 having withdrawn its opposition during the opposition proceedings, it is not a party in the present appeal.
- III. The Board summoned the parties to oral proceedings with letter dated 6 July 2004. By letter dated 20 December 2004 the patentee informed the Board that its previous request for oral proceedings was withdrawn and that, therefore, it would not be represented at these oral proceedings. It further submitted new sets of claims according to four auxiliary requests, in addition to the version as granted presented as the main request in its statement of grounds.
- IV. Oral proceedings were held on 20 January 2005, in the absence of the patentee.

The appellant 1 (opponent) requested that the decision under appeal be set aside and that the European patent be revoked.

The appellant 2 (patentee) requested in its writings that the patent be maintained with a set of claims according to the main request or either one of the four auxiliary requests.

- V. At the oral proceedings the appellant 1 objected to the main claims according to all present requests formally (Article 83 and 123(2) EPC), and with respect to the main request, the first, second and fourth request also substantially (Article 54 EPC). In particular the novelty of the independent claims was contested vis-à-vis the prior art document:

E1: WO-A1-95/03010.

As to claim 1 according to the third auxiliary request, the appellant 1 pointed out that this request could not be accepted for lack of adequate support by the description, this latter having not been adapted correspondingly. Therefore, the requirements of Article 84, second sentence EPC were not met.

- VI. Claims 1 according to the different requests read as follows:

Main request:

"An expandable stent (12) for implantation in a blood vessel or artery having a generally cylindrical configuration and comprising a radiopaque material (10) affixed to said stent (12) so that said radiopaque material (10) is visible under fluoroscopy and can be easily located in the blood vessel or artery where said stent (12) is being implanted, characterised in that

said stent (12) further comprises a deforming portion (20) and a non-deforming portion (18), and said radiopaque material (10) is affixed only to at least a part of said non-deforming portion (18)."

First auxiliary request:

"An expandable stent (12) for implantation in a blood vessel or artery having a generally cylindrical configuration and comprising a radiopaque material (10) affixed to said stent (12) so that said radiopaque material (10) is visible under fluoroscopy and can be easily located in the blood vessel or artery where said stent (12) is being implanted, said stent (12) further comprising a deforming portion (20) and a non-deforming portion (18), and said radiopaque material being affixed as a plating or a coating on a surface of only at least a part of said non-deforming portion (18)."

Second auxiliary request:

The content of claim 1 of this request corresponds to the content of claim 1 of the first auxiliary request, wherein the expression "a plating or a coating on a surface" is replaced by "a plating or a coating on an exterior surface".

Third auxiliary request:

The content of claim 1 of this request corresponds to the content of claim 1 of the main request and the following additional feature: "such that said radiopaque material extends a full circumference of a part of said stent (12)".

Fourth auxiliary request:

The content of claim 1 of this request corresponds to the content of claim 1 of the main request, wherein the word "curved" is introduced before "portion (20)" and the word "straight" before "portion (18)".

### **Reasons for the Decision**

1. The appeals are admissible.

2. *Formal aspects*

The opponent's formal objections based on Articles 83 and 123(2) EPC, to the current versions of the claims, need not be considered, since the requests are anyway unallowable on other grounds, as set out hereinafter.

3. *Novelty (main request, first, second and fourth auxiliary requests)*

3.1 Document E1 is a state of the art according to Article 54(3), (4) EPC and, as such, is to be considered only against novelty of the claims in suit. It discloses all the features forming the preamble of claim 1 of the main request, namely an expandable stent for implantation in a blood vessel or artery, having a generally cylindrical configuration (cf. Figure 1). Moreover, a radiopaque material 41, 42 is affixed to the stent so as to be visible under fluoroscopy and easily located in the blood vessel or artery where said

stent is being implanted (cf. page 5, lines 10 to 12 and page 13, lines 7 to 12).

Furthermore, the stent disclosed in E1 comprises a deforming portion (circumferentially and laterally extending segments 24-26) and a non-deforming portion (longitudinally extending reinforcing member 14), as better seen when comparing the stent before and after radial expansion (cf. Figures 1 and 3 or Figures 5 and 7, respectively). Moreover the radiopaque material (marker 41, 42) is affixed only to at least a part of said non-deforming portion.

As a result, the subject-matter of claim 1 according to the main request lacks novelty with respect of the teaching of document E1.

- 3.2 Claim 1 according to the first auxiliary request differs from the main request only in that the radiopaque material being affixed to a part of said non-deforming portion "as a plating or a coating on a surface" thereof.

According to the present patent (column 8, lines 3 to 18) "plating" is the process by which the metallic "coating" (of radiopaque material) is deposited on a surface of the stent. "Plating" is also used within the meaning of a means for affixing or **similarly affixing** the radiopaque material to the stent (column 6, lines 5 to 11), from which other conventional means of affixing such as sewing or bonding are excluded.

Document E1 discloses (page 13, lines 7 to 12) that the radiopaque markers are preferably affixed by a melting

process. But other alternative processes are equally considered, such as crimping or **any other well-known fastening method.**

Taking into account that claim 1 at issue is so generally worded that no distinction can be made between the affixing process (plating) and the result to be obtained (coating) and considering further that both the patent and document E1 generally contemplate the use of similar affixing or fastening means, the Board is convinced that the expression "as a plating or a coating", i.e. at least one of these alternatives is disclosed by the teaching of document E1.

As a consequence, the subject-matter of claim 1 according to the first auxiliary request is not novel, either.

- 3.3 In claim 1 according to the second auxiliary request, it is specified that the plating or coating operation is performed on an "exterior" surface of said non-deforming portion. As to claim 1 to the fourth auxiliary request, it is specified that the deforming portion is "curved" and that the non-deforming portion is "straight".

All those additional features are also known from document E1, as can be immediately derived from Figure 1.

Consequently, the subject-matter of claim 1 according to both, the second and the fourth auxiliary request is also lacking novelty.



4. *Support by the description (third auxiliary request)*

4.1 The proprietor's request that the patent be maintained in amended form is based on claims filed with its last letter of 20 December 2004 and either on the description as granted, or on the description and drawings as previously amended in the interlocutory decision now under appeal. Apart from the first auxiliary request which corresponds to the version of the claims as amended, none of the descriptions cited above is consistent with the independent claims according to the other requests.

Each of the granted description and the description underlying the decision under appeal contain a statement, according to which the radiopaque marker may be positioned anywhere on the non-deforming portion of the stent (see column 2, lines 42 to 43 of both versions), and a further statement, according to which only in a preferred embodiment the entire circumference of the stent is plated with a radiopaque material (see column 3, lines 14 to 16). However, claim 1 of the third auxiliary request requires that the radiopaque material does extend a full circumference of a part of said stent. Hence the description (column 2, lines 20 to 30) is not adapted to this claim now considered as the solution and therefore fails to appropriately support this claim, as required by Article 84 EPC.

4.2 Since the appellant 2 (proprietor) was not represented at the oral proceedings, he has abandoned the last possibility to adapt the description to the various sets of claims. Consequently, the patent could not be

maintained also in the form amended by the third auxiliary request.

As pointed out in decision T 917/95, 1 August 2001 (unpublished), a patentee who is filing new claims but no description adapted correspondingly before oral proceedings, and who is not represented at the oral proceedings, may not reasonably rely on the Board postponing its final decision at the end of the oral proceedings, in order to offer him an extra possibility to adapt the description to the claims.

Therefore, even if the set of claims according to the third auxiliary request had met the requirements of the EPC, the appellant's request would have been rejected for lack of adequate support by the description under Article 84, second sentence, EPC.

## **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