

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

**Datasheet for the decision
of 26 September 2006**

Case Number: T 0801/04 - 3.2.02

Application Number: 98308192.8

Publication Number: 0916315

IPC: A61B 17/84

Language of the proceedings: EN

Title of invention:

Orthopaedic wires and cables and methods of making same

Applicant:

Howmedica Osteonics Corp.

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 84, 123(2)

Keyword:

"Main request: Clarity (yes)"
"New subject-matter (no)"
"Remittal to the first instance"

Decisions cited:

-

Catchword:

-



Case Number: T 0801/04 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 26 September 2006

Appellant: Howmedica Osteonics Corp.
325 Corporate Drive
Mahwah, NJ 07430 (US)

Representative: Liebetanz, Michael
Isler & Pedrazzini AG
Patentanwälte
Gotthardstrasse 53
Postfach 6940
CH-8023 Zürich (CH)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 13 January 2004
refusing European application No. 98308192.8
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: T. Kriner
Members: S. Chowdhury
E. Dufrasne

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division dated 13 January 2004 to refuse European patent application No. 98 308 192.8.

The grounds of refusal were that the subject-matter of claim 1 of the main and auxiliary requests (both device claims) then on file lacked novelty.

On 15 March 2004 the appellant (applicant) lodged an appeal against the decision and paid the prescribed fee on the same day. On 11 May 2004 a statement of grounds of appeal was filed.

II. Oral proceedings were held on 26 September 2006. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the main request (claims 1 and 2) or, in the alternative, on the basis of the first auxiliary request filed as the main request with letter dated 6 May 2006, or the second or third auxiliary requests, both filed with letter dated 25 August 2006.

III. Claims 1 and 2 of the main request read as follows:

"1. A method of making an orthopaedic cable comprising a plurality of filaments wherein the filaments are of chromium-cobalt alloy, the filaments being fully annealed followed by cold working to decrease the diameter between 5% and 38% wherein the resulting filaments having a tensile strength between 175 and 280 ksi (1207 to 1930 MPa) and twisting the filaments together to form said cable.

2. Method according to claim 1, wherein the diameter is decreased by 18% by the cold working step."

Reasons for the Decision

1. The appeal is admissible.

Main request

2. Amendments

New claim 1 is based on original claims 9 and 15 (the latter being a product-by-process claim), which claims are based on the "Cold Working Experiments" described on page 8 of the application (EP-A-0 916 315). These parts of the application disclose both a method of making an orthopaedic cable comprising a plurality of filaments and such a cable.

These parts of the application do not disclose filaments of chromium-cobalt alloy, but the tenor of the entire application is that this is the material of interest, and this is the only material mentioned in the examples disclosed. Therefore, its inclusion in the context of original claims 9 and 15 is allowable.

The step of twisting the filaments together to form a cable is supported by original claim 17, which refers back to the cable of claim 9.

Claim 2 is supported by original claim 16.

Therefore, new claims 1 and 2 are fully supported by the original disclosure and are in accordance with Article 123(2) EPC.

3. The Board also considers the claims to be clear.
4. From the foregoing it is evident that the main request is formally allowable. However, method claims did not form part of the decision under appeal so that it is appropriate to remit the case to the first instance to complete the examination of the main request, particularly as to the requirements of Article 52(1) EPC.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of claims 1 and 2 of the main request filed at the oral proceedings.

The Registrar

The Chairman

V. Commare

T. K. H. Kriner