

Internal distribution code:

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

**Datasheet for the decision
of 30 July 2007**

Case Number: T 1208/05 - 3.2.02

Application Number: 03008319.0

Publication Number: 1329196

IPC: A61B 17/12

Language of the proceedings: EN

Title of invention:

Endovascular electrolytically detachable guidewire tip

Applicant:

The Regents of the University of California

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 76(1)

Keyword:

"Allowability of a European divisional application - (yes)"

Decisions cited:

G 0001/06

Catchword:

-



Case Number: T 1208/05 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 30 July 2007

Appellant: The Regents of the University of California
1111 Franklin Street, 12th Floor
Oakland
CA 94607-5200 (US)

Representative: Price, Nigel John King
J.A. Kemp & Co.
14 South Square
Gray's Inn
London WC1R 5JJ (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 29 April 2005
refusing European application No. 03008319.0
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 29 April 2005 to refuse European patent application no. 03 008 319.0, which is divided from European patent application no. 99 101 348.3 (published as EP-A-0 914 803), which itself is a third generation divisional application.

The application was refused, after the applicant had requested a decision based on the state of the file, on the grounds that claim 1 contained subject-matter extending beyond the content of the originally filed parent application, contrary to Article 76(1) EPC, which objection had been expressed in the communications from the examining division dated 6 February 2004 and 10 February 2005.

II. On 29 June 2005 the appellant (applicant) lodged an appeal against the decision and paid the prescribed fee on the same date. On 2 September 2005 a statement of grounds of appeal was filed.

III. The appellant requests that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution on the basis of claims 1 to 22 submitted with its letter dated 18 November 2004 (main request), or on the basis of claims 1 to 22 filed with the grounds of appeal (auxiliary request).

IV. Claim 1 of the main request reads as follows:

"A combination of a guidewire and a voltage source, the guidewire being connected to the voltage source and being for use with a microcatheter, the guidewire being suitable for use in the formation of a thrombus following the application of electric current to the guidewire by the voltage source, the guidewire comprising:

a core wire terminating at a distal end; and

a tip portion for endovascular insertion within a vascular cavity, said tip portion comprising a coil comprised of material not susceptible to electrolytic disintegration in blood and being coupled to said distal end of said core wire via a connecting segment at least one portion of which segment is susceptible to electrolytic disintegration in blood to detach the tip portion from the core wire;

the guidewire being so constructed and arranged that, on the application of electric current to the guidewire when said tip portion is endovascularly disposed in the vascular cavity, said at least one portion of said connecting segment is electrolytically disintegrated and said tip portion detached from said core wire to enable the removal of the core wire whilst leaving the detached tip portion within the vascular cavity."

Claim 1 of the auxiliary request includes minor editorial changes to the above claim.

Claims 2 to 22 of both requests are dependent claims.

Reasons for the Decision

1. The appeal is admissible.

2. *Main request*

In substance the definition of the guidewire according to claim 1 of the main request differs from the corresponding definition according to claim 1 of the parent application essentially by the replacement of the features:

the coil tip which is not susceptible to electrolytic disintegration in blood being coupled to the main body of the core wire via a distal portion of the core wire, the distal portion being susceptible to electrolytic disintegration in blood (claim 1 of parent EP-A-0 914 803)

by the features:

the coil tip which is not susceptible to electrolytic disintegration in blood being coupled to the core wire via a connecting segment and at least one portion of which segment is susceptible to electrolytic disintegration in blood (claim 1 of the main request).

The examining division objected that this was an unallowable broadening of the claim.

According to the appellant claim 1 of the main request is supported by the embodiment described with reference to Figure 2 of the parent application, modified as indicated in paragraph [0037] of that application. In

order to decide whether this argument is correct it is necessary to examine the disclosure of the parent application, the scope of claim 1 of the parent application, and claim 1 of the main request in light of this disclosure.

3. *The parent application*

3.1 The parent application describes different embodiments of the invention thereof, of which the first one is described with reference to Figure 1 and includes a guidewire (10) comprising a core wire having a main body (12, 14) and a distal portion (18) which is susceptible to electrolytic disintegration in blood (column 7, lines 23 to 33), and a tip portion (28, 30) for insertion within a vascular cavity and comprising a coil coupled to the main body via said distal portion (18) and comprised of material (Pt) not susceptible to electrolytic disintegration in blood. An intermediate stainless steel coil (26) is provided between the Pt coil and the (threadlike) distal portion (18) of the core wire.

When the Pt coil is disposed in the vascular cavity and an electric current is applied to the guidewire endovascular electrothrombosis can be performed in the cavity by said tip portion coil and at least one portion of the distal portion disintegrates electrolytically to detach the tip portion coil from the main body to enable the removal of the main body of the core wire whilst leaving the detached tip portion coil within the vascular cavity. In column 7, lines 28 to 30 of EP-A-0 914 803 is stated that ultimately, both the threadlike distal portion of the core wire and the

stainless steel coil will be completely disintegrated at least at one point, thereby allowing the wire to be withdrawn from the vascular space while leaving the tip portion coil embedded within the thrombus formed within the aneurysm. Thus detachment of the coil occurs by corrosion of both the distal threadlike portion of the wire as well as of the stainless steel coil.

- 3.2 Figure 2 illustrates a second embodiment of a guidewire, whereby it is stated (column 7, lines 35 to 39) that in the form illustrated in Figures 2 and 2A, this embodiment is not in accordance with the invention as claimed in the parent application owing to the absence from the guidewire of a tip portion in the form of a detachable coil not susceptible to electrolytic disintegration in blood.

However, paragraph [0037] of the parent application states as follows: "It is expressly understood that the helical secondary coil tip of the embodiment of Figure 1 could similarly be attached to stainless steel coil 36 of the embodiment of Figure 2. When the guidewire of the second embodiment of Figures 2 and 2A is modified in this way (not shown), to have a tip portion in the form of a detachable coil, it becomes in accordance with the present invention."

- 3.3 Therefore, claim 1 of the parent application, the solitary independent claim to the guidewire, includes within its scope both the embodiments of Figures 1 and 2 (the latter after modification as indicated in paragraph [0037]). These embodiments have slightly different means of detachment of the distal tip portion. In the first one the tip detaches by corrosion of the

distal portion of the core comprising a stainless steel coil attached thereto (the stainless steel coil, however, not being part of the claimed device). In the second embodiment the tip detaches by corrosion of the stainless steel coil.

In general terms, the step of electrolytically detaching the distal tip is referred to as the step of electrolytically detaching at least one portion of a connecting segment extending between the main body of the and the distal tip (paragraph [0055]).

That claim 1 of the parent application was intended to embrace the modified embodiment of Figure 2 is indicated not only by the explicit statement to this effect in paragraph [0037], but also by the use of reference numerals in this claim. This claim defines a distal portion (18, 26; **36**, 46, 52) [emphasis added] susceptible to electrolytic disintegration in blood, and goes on to say that the tip portion comprising a coil is coupled to said main body (12, 16, **32**) via said distal portion (18, 26, **36**, 46). Reference numeral 36 is used in Figures 2 and 2A only. Moreover, this usage of the reference numerals also indicates that the coil (36) was meant to form the distal portion of the core wire in this embodiment. Furthermore, paragraph [0020] states explicitly that the distal portion preferably comprises an exposed stainless steel segment in the form of a coil connected at its proximal end to the core wire and at its distal end to the tip portion coil.

4. *The present application*

Claim 1 of the main request of the present divisional application reads on to the modified embodiment of Figure 2 of the parent application which, as discussed above, was an invention within the scope of claim 1 of the parent application.

Thus, using the wording of claim 1 of the main request, the modified embodiment of Figure 2 comprises a combination of a guidewire and a voltage source, the guidewire being connected to the voltage source and being for use with a microcatheter, the guidewire being suitable for use in the formation of a thrombus following the application of electric current to the guidewire by the voltage source, the guidewire comprising:

a core wire (32) terminating at a distal end (34); and

a tip portion for endovascular insertion within a vascular cavity, said tip portion comprising a coil comprised of material not susceptible to electrolytic disintegration in blood (see paragraph [0037]) and being coupled to said distal end (34) of said core wire via a connecting segment (36) at least one portion of which segment is susceptible to electrolytic disintegration in blood to detach the tip portion from the core wire;

the guidewire being so constructed and arranged that, on the application of electric current to the guidewire when said tip portion is endovascularly disposed in the vascular cavity, said at least one portion of said

connecting segment is electrolytically disintegrated and said tip portion detached from said core wire to enable the removal of the core wire whilst leaving the detached tip portion within the vascular cavity.

5. Therefore, the wording of claim 1 of the present divisional application is fully compatible both with claim 1 of the parent application and the modified embodiment of Figure 2 of the parent application, and it does not include any impermissible generalisations objectionable under Article 76(1) EPC.

According to the decision G 1/06 of the Enlarged Boards of Appeal it is a necessary and sufficient condition for a divisional application to comply with Article 76(1), second sentence, EPC that anything disclosed in that divisional application be directly and unambiguously derivable from what is disclosed in the preceding applications as filed. This does not mean that the subject-matter of a divisional application must not extend beyond the content of the independent claims of the earlier applications, but that it must not extend beyond the content of the complete disclosure of the earlier applications.

Claim 1 of the main request is, therefore, allowable under Article 76(1) EPC in view of its parent application, EP-A-0 914 803.

6. Since the application has not been examined as to the remaining requirements of the EPC the appellant's request to remit the case to the examining division is justified.

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 to 22 of the main request submitted by letter dated 18 November 2004

The Registrar

The Chairman

V. Commare

T. K. H. Kriner