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**Datasheet for the decision  
of 30 October 2008**

**Case Number:** T 1584/05 - 3.2.02

**Application Number:** 99917582.1

**Publication Number:** 1071374

**IPC:** A61B 17/12

**Language of the proceedings:** EN

**Title of invention:**

Movable ligating band dispenser and method

**Applicant:**

Ensurg, Inc.

**Opponent:**

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**Headword:**

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**Relevant legal provisions:**

EPC Art. 123(2)

**Relevant legal provisions (EPC 1973):**

EPC Art. 54(1)(2), 84

**Keyword:**

"Clarity and non-extension (yes, after amendments)"  
"Novelty (yes)"

**Decisions cited:**

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**Catchword:**

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Case Number: T 1584/05 - 3.2.02

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.02  
of 30 October 2008

**Appellant:** Ensurg, Inc.  
65 Fairhaven Road  
South Bristol ME 04568 (US)

**Representative:** UEXKÜLL & STOLBERG  
Patentanwälte  
Beselerstrasse 4  
D-22607 Hamburg (DE)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 28 July 2005  
refusing European application No. 99917582.1  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** T. Kriner  
**Members:** M. Noel  
A. Pignatelli

## Summary of Facts and Submissions

I. European patent application No. 99917582.1 was refused by decision of the examining division dated 28 July 2005 on the basis of Article 84 EPC (lack of clarity), Article 123(2) (extended subject-matter), and on the basis of Article 54 EPC 1973 on the ground of lack of novelty vis-à-vis the prior art document

D1: US-A-5507797.

II. The appellant (applicant) lodged an appeal by notice received on 28 September 2005 and paid the appeal fee on the same day. A statement setting out the grounds of appeal was filed on 24 November 2005.

III. Oral proceedings were held on 30 October 2008, at the end of which the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 21 filed during the oral proceedings

IV. Claim 1 at issue reads as follows:

"A ligating band dispensing device (100) adapted for movement from a retracted position to a dispensing position on an endoscope, said device having:

- a proximal end (108) adapted to be received at a distal end of an insertion portion of an endoscope (10), and

- a distal end (106), where for the dispensing position the distal end of the dispensing device is spaced from the distal end of the endoscope, creating a

volume (112) substantially defined by the dispensing device, sufficient to perform a ligation procedure;

- a dispensing member (102) slidably received on a sleeve (104);

**characterized in that** said sleeve (104) is adapted to directly fit about the insertion tip (16) of the endoscope (10), and said sleeve (104) includes a region, which carries a plurality of ligating bands (110);

- the ligating band dispensing device (100) further comprises a sealing member (118) established between the insertion tip (16) of the endoscope (10) and the sleeve (104), which sealing member slidably engages an exterior surface of the endoscope (10) throughout the motion of the sleeve (104) to seal said volume (112) between the sleeve (104) and the endoscope."

## **Reasons for the Decision**

1. The appeal is admissible.

2. *Amendments*

The features contained in the pre-characterising portion of claim 1 are all fairly supported, though arranged in a different way, by the features forming the subject-matter of claim 1 as originally filed.

The last feature incorporated in the preamble of claim 1, which relates to a dispensing member 102 slidably received on a sleeve 104, is taken from the passage on page 10, lines 4 to 6 of the application as filed.

The characterising portion of claim 1 is also fairly supported by the application as filed as explained hereinafter:

The first characterising feature according to which the sleeve 104 is adapted to directly fit about the insertion tip 16 of the endoscope, is supported by the passage on page 10, lines 6 to 7, and is also illustrated in Figures 4a to 4c.

The next feature according to which said sleeve 104 includes a region which carries a plurality of ligating bands 110 is supported by the passage on page 10, lines 27 to 30.

The further feature that the ligating band dispensing device 100 further comprises a sealing member 118 established between the insertion tip 16 of the endoscope and the sleeve 104 to seal said volume 112 between the sleeve 104 and the endoscope (end of claim 1), is supported by the passage on page 12, lines 14 to 20.

The last, remaining feature that the sealing member slidably engages an exterior surface of the endoscope 10 throughout the motion of the sleeve 104, results from the incorporation of original claim 2.

Dependent claims 2 to 21 all originate from the claims as originally filed with the following correspondence, respectively: claims 4, 16, 24, 2 to 3, 7 to 15, 35 to 38, 40 to 41.

Therefore, the requirements of Article 123(2) EPC are met.

Furthermore, the clarity objections raised by the first instance have been removed by the amendments of the claims.

3. *Novelty*

Claim 1 as amended has been delimited with respect to document D1. This latter discloses, with reference to the embodiment shown in Figures 2A/2B, a double slidable structure comprising an inner cylinder 1, a slide cylinder 2 and an outer cylinder 3. The outer cylinder and the inner cylinder are firmly secured together and made to stay stationary, whereas the slide cylinder 2 is reciprocally slidable in the axial direction (see column 11, lines 29 to 33), thereby protruding from the forward end of the inner cylinder so as to form with the end of the endoscope 6 a suction hole inside the protruded slide cylinder 2 (see column 12, lines 21 to 24 and Figure 2B).

A seal ring 12 is provided at the rear side of the slide cylinder 2 and is in contact with the inner periphery of the outer cylinder 3 and the outer periphery of the inner cylinder 1, thereby sealing not only an hermetic space 17 for the actuating fluid but also, simultaneously, the suction space formed inside the protruded slide cylinder (see column 11, lines 39 to 42). Further, a ligating band dispensing member in the form of the second slide cylinder 2' is slidably received on the first slide cylinder 2.

Following the terminology used in claim 1, D1 shows all the pre-characterizing features, however fails to disclose that the slidable sleeve 2 thereof is directly fitted about the insertion tip 6 of the endoscope and that the sealing member 12 slidably engages the exterior surface of the endoscope 6 through the motion of the sleeve 2. Therefore, the sealing member 12 of D1 is not in contact with the insertion tip of the endoscope but with the intermediate inner cylinder 1.

It results therefrom that the subject-matter of claim 1 is novel over the disclosure of D1.

4. *Remittal*

The European application was refused on objections based on Articles 84, 123(2) and 54 EPC 1973, now removed. Since the subject-matter of claim 1 was substantially amended at the appeal stage, the Board finds it appropriate to remit the case to the first instance for further prosecution, in particular on the substantive issue of inventive step with respect to the prior art documents.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution on the basis of claims 1 to 21 as filed at the oral proceedings on 30 October 2008.

The Registrar:

The Chairman:

V. Commare

T. Kriner