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**Datasheet for the decision  
of 26 January 2010**

**Case Number:** T 0337/08 - 3.3.10

**Application Number:** 99938676.6

**Publication Number:** 1075843

**IPC:** A61L 17/00

**Language of the proceedings:** EN

**Title of invention:**

Surgical thread for plastic surgery operations

**Patentee:**

Sulamanidze, Marlen Andreevich, et al

**Opponent:**

Quill Medical, Inc.

**Headword:**

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**Relevant legal provisions:**

EPC Art. 100(c), 123(3)

RPBA Art. 13(1)

**Keyword:**

"Main request and auxiliary requests 1 to 3: added subject-matter (yes) - no explicit or implicit disclosure of added feature in application as filed"

"Auxiliary request 4: not admitted into the proceedings; late filed; not clearly allowable; extending protection conferred by patent as granted"

**Decisions cited:**

T 0153/85

**Catchword:**

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Case Number: T 0337/08 - 3.3.10

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.10  
of 26 January 2010

**Appellant:** Quill Medical, Inc.  
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**Representative:** Rutetzki, Andreas  
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**Respondent:** Sulamanidze, Marlen Andreevich  
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**Representative:** Hano, Christian  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 11 December 2007  
rejecting the opposition filed against European  
patent No. 1075843 pursuant to Article 102(2)  
EPC.

**Composition of the Board:**

**Chairman:** R. Freimuth  
**Members:** P. Gryczka  
J.-P. Seitz

## Summary of Facts and Submissions

I. An opposition was filed in which entire revocation of European patent 1 075 843 based on the international patent application PCT/RU99/00263 was requested, *inter alia*, on the ground that the subject-matter of the granted claims extended beyond the content of the application as filed (Article 100(c) EPC).

Claim 1 of the granted patent (present main request) reads as follows:

"1. A surgical thread (1) for use in plastic surgery operations, the thread being formed of metallic, polymeric or biological material, the thread havin [*sic*] a needle (4) at one end thereof and a sequence of protruding, conical barbs (2,5) with sharpened flexible and elastic ends arranged along its length, a first plurality of the barbs (2) being inclined in a direction away from the needle-end of the thread to permit the thread to be drawn by the needle through a patient's tissue but resist sliding of the thread through the tissue in the opposite direction, and a second plurality of the barbs (5) being inclined in a direction towards the needle-end of the thread;  
characterised in that:  
the thread is devoid of a needle at its free end opposite the needle end;  
the first plurality of the barbs is arranged along a substantially greater proportion of the length of the thread than the second plurality of the barbs; and  
the second plurality of the barbs, not less than three, is grouped adjacent the free end of the thread to

resist entry of the free end of the thread into the tissue."

- II. In an decision issued in writing on 11 December 2007, the Opposition Division rejected the opposition. The Opposition Division came to the conclusion that the granted claims did not extend beyond the application as filed and defined a novel and inventive subject-matter.
- III. The Opponent (Appellant) lodged an appeal against the above decision.
- IV. With a letter dated 10 December 2009 the Respondent (Proprietor of the patent in suit) filed three amended sets of claims as auxiliary requests 1 to 3.

Claim 1 of the auxiliary requests 1 and 2 read as follows:

"1. Surgical thread (1) for use in plastic surgery operations, wherein the thread is formed of metallic, polymeric or biological material and comprises:

- a needle (4)
- a sequence of protruding, conical barbs (2,5) with sharpened flexible and elastic ends arranged along its length,
- a first plurality of the barbs (2) being inclined in a direction away from the needle-end of the thread (1) to permit the thread (1) to be drawn by the needle (4) through a patient's tissue but resist sliding of the thread (1) through the tissue in the opposite direction, and
- a second plurality of the barbs (5) being inclined in a direction towards the needle-end of the thread (1)

characterised in that:

- the thread (1) has unidirectional penetrability, and is fixed to the needle (4) at one end thereof, wherein
- the first plurality of the barbs (2) is arranged along a substantially greater proportion of the length of the thread (1) than the second plurality of the barbs (5); and
- the second plurality of the barbs (5), not less than three, is grouped adjacent the free end of the thread (1) to resist entry of the free end of the thread (1) into the tissue."

Claim 1 of the auxiliary request 3 differs from claim 1 of the auxiliary requests 1 and 2 by the addition at the end of the claim of the feature "wherein the barbs (2,5) are provided by needles (9) projecting from collars (10) fixed to the thread (1)".

- V. At the oral proceedings held before the Board on 26 January 2010 the Respondent filed an amended set of claims as auxiliary request 4.

Claim 1 of the auxiliary request 4 differs from claim 1 as granted in essence by the deletion of the feature requiring that "the first plurality of the barbs is arranged along a substantially greater proportion of the length of the thread than the second plurality of the barbs".

- VI. According to the Appellant, claim 1 as granted and claim 1 of the auxiliary requests 1 to 3 extended beyond the application as filed since, *inter alia*, the feature "the first plurality of barbs is arranged along a substantially greater portion of the thread than the

second plurality of barbs" had no explicit nor implicit basis in the originally filed application, whether this application was considered as being the PCT application in Russian language, the corresponding published European application in English or the corrected version of the translation filed by the Respondent. Thus, these requests should be refused on the basis of Article 100(c) EPC. The fourth auxiliary request was late filed, i.e. at the end of the oral proceedings in front of the Board and was not clearly allowable, claim 1 thereof extending the protection conferred by the patent as granted contrary to the requirements of Article 123(3) EPC since the feature "the first plurality of barbs is arranged along a substantially greater portion of the thread than the second plurality of barbs" required by the claims as granted has been deleted. Therefore, this request should not be admitted into the proceedings.

VII. According to the Respondent, the feature introduced in claim 1 as granted and in claim 1 of the auxiliary requests 1 to 3 requiring that "the first plurality of barbs is arranged along a substantially greater portion of the thread than the second plurality of barbs" although not being explicitly disclosed in the application as filed could nevertheless be deduced from the five figures of the patent application. In addition, claim 1 and the description of the application as originally filed described that the second plurality of barbs, not less than three, was located at the "end" of the thread, the end meaning a smaller portion of the thread than the portion on which was located the first plurality of barbs. Furthermore, the function of the thread, i.e. the unidirectional

penetrability and the resistance of the free end of the thread to enter into the tissue, implied automatically that the first plurality of barbs penetrating into the tissue was arranged along a substantially greater portion of the thread than the second plurality of barbs resisting to penetrate into the tissue. Thus, claim 1 as granted and claim 1 of the auxiliary requests 1 to 3 did not extend beyond the application as filed. Claim 1 of the fourth auxiliary request did not extend the protection conferred by the patent as granted since the feature requiring that "the first plurality of barbs is arranged along a substantially greater portion of the thread than the second plurality of barbs" although being deleted was nevertheless fulfilled in view of the feature remaining in the claim and requiring that "the second plurality of the barbs, not less than three, is grouped adjacent the free end of the thread to resist entry of the free end of the thread into the tissue". The fourth auxiliary request was thus clearly allowable and should be admitted into the proceedings although having been filed at a late stage of the proceedings.

VIII. The Appellant requested that the decision under appeal be set aside and that the patent be revoked.

IX. The Respondent requested that the appeal be dismissed (main request), or auxiliarily that the decision under appeal be set aside and that the patent be maintained on the basis of either one of the auxiliary requests 1 to 3 filed with a letter dated 10 December 2009, or auxiliary request 4 filed during the oral proceedings held before the Board.

- X. At the end of the oral proceedings the decision of the Board was announced.

## **Reasons for the Decision**

1. The appeal is admissible.

### *Main request and auxiliary requests 1 to 3*

2. *Amendments (Article 100(c) EPC)*

2.1 Claim 1 as granted as well as claim 1 of the auxiliary requests 1 to 3 comprise the substantial amendment requiring that in the claimed thread "the first plurality of barbs is arranged along a substantially greater portion of the thread than the second plurality of barbs". According to the Respondent this amendment although not being disclosed explicitly in the application as filed finds nevertheless an implicit support therein. This was contested by the Appellant.

2.2 In the following, the first translation into English of the Russian PCT application, translation filed with the letter dated 31 October 2000 when entering the European regional phase, is assumed to be identical in content to the application as filed, i.e. the PCT application in Russian language. As acknowledged by both parties, the corrected translation filed by the Respondent with the letter dated 10 December 2009, introduces no modification whatsoever with respect to the objected amendment.



2.3 It is established jurisprudence of the Boards of Appeal that a ground for opposition under Article 100(c) EPC is justified if the amendments introduced in the granted claims are not directly and unambiguously derivable from the application as filed. In the present case, it is not disputed that the feature "the first plurality of barbs is arranged along a substantially greater portion of the thread than the second plurality of barbs" is not disclosed explicitly in the application as filed. In these circumstances, the question arises whether a thread including this feature can implicitly be derived from the application as filed. In this context, the term "implicitly" does not imply merely that the thread defined in the amended claim 1 was encompassed by the application as filed but requires that this thread although not being explicitly disclosed in the application as filed is nevertheless directly and unambiguously derivable therefrom.

2.3.1 As support for the amendment introduced in claim 1 specifying that "the first plurality of barbs is arranged along a substantially greater portion of the thread than the second plurality of barbs" the Respondent cited figures 1 to 5 in the application as filed from which in his opinion this feature could be taken.

However, figures 1 to 5 are merely schematic illustrations of a thread which are not true to scale as recognised by both parties, the diameter of the thread being obviously too large when compared to its length. In addition, it is not clear whether the figures represent a whole thread or only a part of it. Both parties had divergent views on that issue in

particular since the left part of at least figures 4 and 5 is drawn in a manner so as to convey the impression that the thread continues in that direction. Nevertheless, even when assuming at the benefit of the Respondent that the figures could represent a whole thread, it cannot be excluded that they could also represent only a part of it with the consequence that no quantification of the length of different portions of the thread can be taken from these schematic figures. Due to this ambiguity, two sensible interpretations being possible, the figures of the application as filed do not satisfy the criteria of disclosing directly and unambiguously, whether explicitly or implicitly, this specific feature, i.e. that "the first plurality of barbs is arranged along a substantially greater portion of the thread than the second plurality of barbs".

2.3.2 According to the Respondent, the objected feature specifying that "the first plurality of barbs is arranged along a substantially greater portion of the thread than the second plurality of barbs" could also be implicitly derived from claim 1 and the description of the application as originally filed on page 2, lines 18, 22 and 27 and at page 3, line 29 which described that the second plurality of barbs, not less than three, was located at the "end" of the thread, the end meaning a smaller portion of the thread than the portion on which was located the first plurality of barbs.

However, the term "end" indicates a location on the thread from which the relative portions of the thread occupied by the two types of barbs cannot be derived, let alone that the first plurality of barbs is on "a

substantially greater portion of the thread". In fact, even if it could be assumed that the barbs at the "end" of the thread are present in a limited number since they are placed at the "end", it cannot be derived therefrom a *contrario* that the other type of barb is "arranged along a substantially greater portion of the thread". In addition, the fact that the application as filed describes in the passages cited by the Respondent that "not less than three barbs" of the second plurality of barbs were located at the end of the thread, gives no information *vice versa* on the portion of the thread occupied by the first plurality of barbs. Consequently, no implicit disclosure of the added feature can be found in the passages of the application as filed describing the "end" of the thread.

2.3.3 Finally, according to the Respondent the function of the thread, i.e. the unidirectional penetrability and the resistance of the free end of the thread to enter into the tissue, implied automatically that the first plurality of barbs penetrating into the tissue was arranged along a substantially greater portion of the thread than the second plurality of barbs resisting to penetrate into the tissue, the function providing thus an implicit disclosure of the feature added to the claim.

However, the function of the thread merely describes the aim to be achieved by it and not the technical features of the claimed thread to achieve this aim. In the present case these technical feature introduced in the claim, namely that "the first plurality of barbs is arranged along a substantially greater portion of the thread than the second plurality of barbs" cannot

directly and unambiguously be derived from that aim, i.e the function of the thread, since that feature has nowhere been disclosed as being mandatory for achieving this function. No convincing reason has been presented rendering a thread having other distributions of the portions of the barbs on the thread completely unsuited for that function. Therefore, the function of the thread does not implicitly disclose directly and unambiguously the feature added to claim 1.

- 2.4 Therefore, the amendment to claim 1 as granted (main request) and present in claim 1 of the auxiliary requests 1 to 3, specifying that "the first plurality of barbs is arranged along a substantially greater portion of the thread than the second plurality of barbs" cannot, directly and unambiguously, be derived from the passages of the application as filed on which the Respondent relied. The Board on its side is not aware of an adequate support for this amendment. Thus, the opposition ground under Article 100(c) EPC is justified with the consequence that the main request and the auxiliary requests 1 to 3 have to be refused.

#### *Auxiliary request 4*

### 3. *Admissibility*

The fourth auxiliary request was filed just before closing the debate at the oral proceedings before the Board as an attempt to overcome the objection under Article 100(c) EPC already raised in front of the opposition division. According to the Rules of Procedure of the Boards of Appeal (RPBA) published in the OJ EPO 2007, 536, any amendment to a party's case

after it has filed its grounds of appeal may be admitted and considered at the Board's discretion and is not a matter as of right (Article 13(1) RPBA). For exercising due discretion in respect of the admission of such a lately filed request, it is established case law of the Boards of Appeal that one crucial criterion is whether or not the amended claims of this request are clearly allowable (see for example T 153/85 OJ EPO 1988, 1, points 2.1 and 2.2 of the reasons for the decision), otherwise violating the principle of procedural economy.

In claim 1 of the fourth auxiliary request the feature required by the claims of the patent as granted specifying that "the first plurality of barbs is arranged along a substantially greater portion of the thread than the second plurality of barbs" has been deleted. The suppression of this feature results, *a priori*, in an extension of the protection conferred by the patent as granted since threads with other distributions of barbs which were excluded by the patent as granted are now encompassed by the amended claim 1.

According to the Respondent the feature requiring that "the first plurality of barbs is arranged along a substantially greater portion of the thread than the second plurality of barbs" although being deleted was nevertheless fulfilled in view of the feature remaining in the claim and requiring that "the second plurality of the barbs, not less than three, is grouped adjacent the free end of the thread to resist entry of the free end of the thread into the tissue".

However, this argument must be rejected since the feature remaining in the claim concerns the second plurality of barbs and thus, *a priori* cannot give any indication on the portion of the thread occupied by the first plurality of barbs as defined in the deleted feature.

Hence, the amendment of claim 1 represents subject-matter which does not clearly fulfil the requirements of Article 123(3) EPC.

Therefore, claim 1 is not clearly allowable. In view of the state of the proceedings at which the request was filed, i.e. just before closing the debate at the end of the oral proceedings before the Board, the fourth auxiliary request is not admitted into the proceedings for reasons of procedural economy (Article 13(1) RPBA).

## **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

C. Rodríguez Rodríguez

R. Freimuth