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**Datasheet for the decision
of 17 May 2011**

Case Number: T 0382/08 - 3.4.01

Application Number: 00979895.0

Publication Number: 1244922

IPC: G01R 33/28

Language of the proceedings: EN

Title of invention:
Magnetic resonance imaging device

Applicant:
Topspin Medical (Israel) Limited

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 123(2)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Added subject-matter"

Decisions cited:
-

Catchword:
-



Case Number: T 0382/08 - 3.4.01

D E C I S I O N
of the Technical Board of Appeal 3.4.01
of 17 May 2011

Appellant: Topspin Medical (Israel) Limited
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 2 October 2007
refusing European patent application
No. 00979895.0 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: B. Schachenmann
Members: H. Wolfrum
G. Assi

Summary of Facts and Submissions

- I. European patent application 00 979 895.0 (publication No. WO 01/42807) was refused by a decision of the examining division dispatched on 2 October 2007 for various reasons, including the ground of added subject-matter in all requests then on file.
- II. The applicant lodged an appeal against the decision on 30 November 2007. The prescribed appeal fee was paid on the same day. A statement of grounds of appeal was filed on 12 February 2008, accompanied by a set of amended claims 1 to 27.
- III. On 9 February 2011 the appellant was summoned to oral proceedings to take place on 17 May 2011.

In an annex accompanying the summons pursuant to Article 15(1) RPBA the Board commented on the issues to be addressed during the oral proceedings. In this context, the Board noted that for the request pursued with the appeal questions of added subject-matter (Article 123(2) EPC) and clarity of wording (Article 84 EPC 1973) had to be addressed first.

- IV. The appellant did not comment on the Board's observations but informed the Board by letter of 26 April 2011 that it would not attend the oral proceedings. Moreover, the appellant requested that a decision based on the documents on file be issued.
- V. Oral proceedings were held on 17 May 2011 in the absence of the appellant.

VI. The appellant has requested in writing that the decision under appeal be set aside and a patent be granted on the basis of the set of amended claims 1 to 27 filed with the statement of grounds of appeal on 12 February 2008.

VII. Independent claim 1 of the appellant's request reads as follows :

"1. A vascular imaging system for imaging a portion of a blood vessel to determine vessel wall morphology, comprising:

a controller; and

an intra-vascular catheter with MRI imaging capabilities for generating MRI data for MRI imaging, the catheter comprising:

a sheath;

an elongate shaft portion having an axis defining one direction in a coordinate system; and

an MRI module carried at a distal end of the shaft portion, the module comprising:

a) a magnetic field forming assembly (15, 16, 17) that produces a primary static magnetic external field that varies radially outward from the axis at the module;

characterized in that the MRI module includes:

b) a transceiver unit comprising least one [sic] RF coil (19), the transceiver unit being operative to transmit an RF pulse sequence selectively from the module, in a direction perpendicular to the axis, when activated by the controller and capable of detecting NMR signals produced by excitation of nuclei within the at least one region (33) by an RF pulse; and further characterized by:

the controller receiving the NMR signals and produces an image responsive to the signals; and means for rotating the at least one RF coil with respect to the axis of the elongate shaft portion within the blood vessel such that rotation of the RF coil produces rotation of the region about the axis without rotating the sheath."

Further independent claims are directed to a "*method of medical imaging from within a blood vessel*" (claim 19), a "*method of operating a system*" (claim 22) and a "*method of medical imaging*" (claim 27).

Claims 2 to 18, 20, 21 and 23 to 26 are dependent claims.

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rule 64 EPC 1973 and is, therefore, admissible.
2. Amendments
 - 2.1 In its communication annexed to the summons to oral proceedings, the Board informed the appellant that some of the amendments made to the claims on file did not appear to have a proper basis of disclosure in the application documents as originally filed.
 - 2.2 Claim 1 on file is directed to a vascular imaging system with an intra-vascular catheter that is required

to comprise a sheath, an elongate shaft portion and an MRI module.

- 2.2.1 However, the application documents as originally filed do not refer to any of the items "sheath", "elongate shaft portion" or "MRI module".

The appellant considers a "sheath" to constitute a standard element of an intra-vascular catheter and sees Figure 1 as the basis of disclosure for such a catheter consisting of an outer "sheath" and an inner elongate element (cf page 8, last paragraph to page 9, first paragraph of the statement of grounds of appeal). Figure 1 is also considered to show the claimed "elongated shaft portion" (cf page 5 of the statement of grounds of appeal).

- 2.2.2 According to established case law (cf for instance T 169/83 (OJ 1985, 193), T 523/88, T 818/93), amendments to claims by including features which are recognizable only in drawings are allowable, provided such features are clearly, unmistakably and fully derivable from the drawings by a skilled person in terms of structure and function.

This condition is not met in the present case. In particular, it is impossible to identify in Figure 1 a "sheath" (in the meaning of a separate envelope or hull of the imaging probe or catheter) or an "elongate shaft portion". A comparison of Figures 1 and 2A of the application as well as a recourse to the corresponding description (cf page 11, line 19 to page 14, line 10) reveals that the cylindrical outer surface of the MR imaging probe 3 is in fact composed of the respective

outer surfaces of two permanent magnets 15 and 16 which, together with a common magnetic core 17, make up the "magnetic field forming assembly". Similarly, a "shaft", let alone an "elongated portion" thereof, is also not identifiable in Figure 1 or the remainder of the application documents as originally filed. What is actually shown in Figure 1 (and is referred to in the corresponding description) are a "guide-wire 4C", on which the intra-vascular catheter with imaging probe 3 is said to "ride", and "leads 7" (which appear to be surrounded by a cable coating).

Likewise, there is no justification for the change in terminology from an "MR imaging probe" to an "MRI module", in particular since the term "module" is already used for identifying a "spectrometer module 9" (cf page 12, lines 20 to 26) that forms an exterior part of the vascular imaging system.

2.3 Moreover, there is no basis of disclosure of a *"magnetic field forming assembly (15, 16, 17) that produces a primary static magnetic external field that varies radially outward from the axis at the module"* (emphasis added), insofar as this definition implies the presence of a static primary magnetic field also inside the said field forming assembly.

2.4 Already for these reasons, the appellant's request on file comprises subject-matter which has not been disclosed in the originally-filed application documents. The Board has thus come to the conclusion that the appellant's sole request does not comply with the requirement of Article 123(2) EPC.

The appellant's request is therefore not allowable.

3. Although having been informed about the above deficiencies, the appellant did not offer any further explanations nor propose further amendment.

Given the fact that already a single deficiency renders a request unallowable, there is no need, for the purpose of the present decision, to study other matters concerning claim 1 or the further claims of the appellant's request on file.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

R. Schumacher

B. Schachenmann