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**Datasheet for the decision
of 6 December 2011**

Case Number: T 1049/08 - 3.2.08

Application Number: 99943570.4

Publication Number: 1105073

IPC: A61F 5/00

Language of the proceedings: EN

Title of invention:
Food intake restriction device

Patent Proprietor:
Obtech Medical GmbH

Opponent:
EndoArt S.A.

Headword:

-

Relevant legal provisions:
EPC Art. 54, 56, 84, 87, 114(2), 123(2)

Relevant legal provisions (EPC 1973):

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Keyword:

"Admissibility of late field documents - partly"
"Admissibility of late filed request - yes"
"Allowability of a new ground of opposition - no"
"Validity of priority - main request - no"
"Novelty - main request - no"
"Validity of priority - auxiliary request - yes"
"Clarity - auxiliary request - yes"
"Allowability of amendments - auxiliary request - yes"
"Inventive step - auxiliary request - yes"

Decisions cited:

G 0001/03, G 0002/10, G 0010/91

Catchword:

-



Case Number: T 1049/08 - 3.2.08

D E C I S I O N
of the Technical Board of Appeal 3.2.08
of 6 December 2011

Appellant: EndoArt S.A.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 18 February 2008
rejecting the opposition filed against European
patent No. 1105073 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: T. Kriner
Members: P. Acton
D. T. Keeling

Summary of Facts and Submissions

- I. The appellant (opponent) filed a notice of appeal, received at the EPO on 25 April 2008, against the opposition division's decision posted on 18 February 2008 rejecting the opposition against the European patent EP 1 105 073. The appeal fee was paid simultaneously and the statement of grounds was received on 30 June 2008.
- II. Oral proceedings took place before the board of appeal on 6 December 2011.

The appellant requested that the decision under appeal be set aside and that European patent 1 105 073 be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed or, that the patent be maintained on the basis of the First Auxiliary Request filed during the oral proceedings.

- III. Independent claim 1 as granted reads:

"A food intake restriction device for forming a stoma opening in the stomach or esophagus of a patient, the device comprising:

A) an elongated restriction member (2, 48, 60, 62, 88, 110, 122, 126, 128, 130),

B) forming means (10, 94, 106, 108, 118, 132) for forming the elongated restriction member into at least a substantially closed loop around the stomach or

esophagus, said loop defining a restriction opening
(3);

C) an adjustment means (12, 52, 66, 90, 92, 104, 110)
for adjusting the restriction member in said loop to
change the size of said restriction opening,

C1) wherein the adjustment means is designed to
mechanically adjust the restriction member

C2) in a non-invasive manner to allow post operation
non-invasive adjustment of the restriction member;

D) an implantable signal receiving means (334, 338)
comprising a control unit for controlling the
adjustment means in response to signals from a wireless
remote transmitting means; and

E) an implantable energizer unit for providing energy
to energy consuming components of the device,

characterised in that:

E1) the energizer unit is capable of being provided
with energy via wireless energy transfer from the
signal transmitting means."

Claim 1 according to the First Auxiliary Request
differs therefrom by the following additional after
feature B:

F) "there is no liquid directly involved in the
elongated restriction member itself for providing
inflation thereof".

The designation of features A to F has been introduced by the board.

IV. The following document filed within the opposition period was relevant for this decision:

E3a: GB-A-1 174 814.

Following documents were filed by the opponent during the opposition proceedings after the opposition period:

E10: Important information for Patients Considering an Acticon Neosphincter, American Medical Systems Inc., Order no. 23600030B (05/00); and Activon Neosphincter Operation Room Manual, American Medical Systems Inc., Order no. 22000026B (01/02)

E11: Obtech Swedish Adjustable Gastric Band (SAGB) Quick Close, Obtech Medical AG, 2003

E12: Développement d'une gastroplastie avec stoma de vidage variable, Etude expérimentale faisant appel aux sphincters artificiels, Helv. chir. Acta 58, 789-793 (1991).

Following documents were filed by the opponent together with the grounds of appeal

E13: US-A-4 592 339

E14: EP-A-0 611 561

E15: WO-A- 94/27501

E16: US-A-5 152 770

E17: US-A-5 509 888

E18: WO-A-01/47 431

E19: US-A-4 711 231

E20: WO-A-98/23 232

E21: WO-A-95/28 127 & WO-A-95/28 185.

Following documents were filed by the appellant during the appeal proceedings with letter of 19 October 2011

E22: EP-A-1 113 767

E23: EP-A-1 554 996.

V. The appellant's arguments can be summarised as follows:

(a) Admissibility of the late filed documents

Documents E10 to E12 were filed during the opposition proceedings as a reaction to the provisional opinion issued by the opposition division questioning whether a sphincter could be used as a gastric band. Since these documents provided a link between gastric bands and sphincters, they should have been introduced into the opposition proceedings and should therefore be admitted into the appeal proceedings.

Documents E13 to E21 were filed together with the grounds of appeal, and therefore at the earliest possible time during the appeal proceedings. They have been cited in reaction to the argumentation set forward in the decision of the opposition division and addressed specifically the topic of gastric bands and of their link to sphincters.

E22 and E23 were filed only six weeks before the oral proceedings since the appellant's representative had not realised their importance until that time. They should be admitted into the proceedings since they were

highly relevant for the assessment of novelty. Moreover, they could not surprise the respondent since E22 was cited by him as prior art in parallel opposition proceedings and E23 was a divisional application of the patent in suit.

(b) Main request

Allowability of the amendments

The appellant put forward that claim 1 as granted contained subject matter which extended beyond the content of the application as filed.

He acknowledged that the ground of opposition according to Article 100(c) EPC had not been raised in the notice of opposition. However, he wished to pursue it since this ground had already been addressed during the opposition proceedings.

Validity of the priority

Claim 1 as granted did not relate to the same invention disclosed in the priority document US 09/133 320.

This application related exclusively to a food intake restriction device with a restriction member which was non-inflatable. The feature according to which the restriction member was non-inflatable was present in claim 1 as well as throughout the whole description of this document and the US-application did not disclose any inflatable restriction members.

The invention as described in claim 1 as granted, however, did not specify the type of restriction member, hence comprising inflatable restriction members as well. Claim 1 as granted specified merely that the adjustment means were designed to mechanically adjust the restriction member. However, this feature was not equivalent to a non-inflatable restriction member and did not imply its presence.

Moreover, the invention according to the previous application described the control unit exclusively in combination with an electric motor which was not comprised in claim 1 as granted.

Furthermore, in the device according to the priority document the signals were transmitted from the control means to the power unit and the motor was powered via the control unit (see claim 16 and on page 11, lines 19 to 24, page 12, lines 20 to 24 and page 13, lines 5 to 7). Thereby, the control unit was described as being inextricably linked structurally and functionally to these features as shown in Figures 34 and 35 and in the corresponding passages of the description (page 27, lines 12 to 16). However, claim 1 as granted did not describe the transmission of signals and power according to the priority document.

Therefore, claim 1 was not entitled to the priority date of 13 August 1998.

Novelty

E22 disclosed all features of claim 1.

Particularly, the receiving means according to E22 comprised means 29 for controlling the adjustment means (see page 12, lines 8 to 10) which carried out the same tasks as the control unit described in feature D of claim 1.

Moreover, E22 disclosed a condenser 39 which represented an energizer in the sense of feature E of claim 1 (see page 12, lines 28 to 29).

Therefore, the subject matter of claim 1 was not novel.

(c) Auxiliary request

Admissibility

The auxiliary request should not be admitted into the proceedings since it was filed at a very late stage of the proceedings and contained a feature extracted from the description.

Validity of the priority

The feature introduced into claim 1 was not sufficient to re-establish the validity priority of claim 1.

It was extracted from the second paragraph of page 3 of the priority document, where it was presented as a result of the mechanical adjustment means. Since this cause-effect link was not present in claim 1 according to the auxiliary request, its subject matter related to a different invention than the priority document.

Moreover, the priority document disclosed only non-inflatable restriction members, while claim 1 according to the auxiliary request excluded only liquids while the use of gases for the inflation of the restriction member was still comprised by its subject matter. Hence, for this reason as well, the subject matter of claim 1 related to a different invention than the previous US-application.

Clarity

The feature introduced into claim 1 according to which "there is no liquid directly involved in the elongated restriction means itself for providing inflation thereof" was not clear in the sense of Article 84 EPC.

Since no clear difference existed between a "direct" and an "indirect" usage of a liquid in a device, the wording "directly involved" was a relative term and hence introduced an unclarity into the claim

The term "itself" in combination with the restriction means was unclear as well since it was not evident where the boundaries of the restriction member "itself" lie.

Finally it was not evident how to determine whether a substance was a liquid or not, especially since the state of a material depended amongst other things from its pressure and temperature.

Allowability of the amendments

Feature F represented a disclaimer and as such it was allowable only under the conditions set out in G 1/03 (see headnote, point 2.3). However, since this disclaimer was relevant for the assessment of inventive step, it was not allowable (see G 1/03, headnote 2.3 in conjunction with G 2/10, page 29, last paragraph).

Moreover, the fact that no liquid was directly involved in the elongated restriction member was originally described on page 3, lines 24 to 29 of the original application as a direct consequence of the mechanical adjustment of the adjustment means, thereby disclosing a cause-effect link between the mechanical adjustment and the absence of liquid. Since this link was not present in claim 1 according to the auxiliary request, it did not comply with the requirements of Article 123(2) EPC for this reason as well.

Inventive step

The food intake restriction device according to E13 represented the closest pre-published prior art. It disclosed a gastric band with the features A, B and C and differed from the subject matter of claim 1 by features C1 to F.

The problem to be solved by the device according to claim 1 was the provision of a food intake restriction device which did not require the use of an injection needle for accomplishing post-operation adjustment of the stoma opening.

E3a related to a sphincter and addressed the same problem as the patent in suit (see column 1, lines 32 to 39). It disclosed a mechanical sphincter which was controlled by remote control means according to the features C1 to E1 of claim 1 of the auxiliary request. Since the circuit according to Figure 5 of E3a did not exclude the possibility of a partial occlusion of the sphincter, its features could be applied directly to the gastric band according to E13 thereby arriving at a gastric band which could be adjusted without the need of an injection needle. Moreover, since E3a described the use of a mechanical occluding member in general terms (see page 1, line 64 and page 2, lines 13 to 26), the skilled person would apply any mechanical restriction member to the gastric band according to E13, hence arriving to the subject matter of claim 1 without the need of any inventive skill.

The subject matter of claim 1 did not involve an inventive step over the combination of E13 with E17 either. The latter disclosed a device for regulating the fluid flow within the human body by changing the shape of restriction means containing magneto-rheological fluid. This fluid consisted of a liquid part (paraffin-based solution, column 4, line 39) carrying solid particles of magnetically responsive materials. By activating electromagnetic devices, the solid particles moved towards the internal part of the restriction member and the viscosity of the fluid was enhanced causing a restriction of the restriction member. Since the restriction was caused by the solid particles in the liquid suspension and not by the liquid itself, the latter was not directly involved in

the elongated restriction member in the sense of feature F.

Since the device according to E17 solved the problem addressed by the invention in suit, the skilled person would apply it to the gastric band according to E13 hence arriving to the subject matter of claim 1 without the need of any inventive skill.

VI. The respondent's arguments can be summarised as follows:

(a) Admissibility of the late filed documents

Since E10 and E11 were not prior art in the sense of Article 54(2) or (3) EPC and E12 was not more relevant for the assessment of the patentability of the patent in suit than the documents filed within the opposition period, the opposition division exercised their judgement correctly by not admitting these documents into the proceedings.

E13 to E21 which were filed together with the grounds of appeal did not add any further information with respect to the documents filed during the opposition period.

E22 and E23 were filed only six week before the oral proceedings, hence at a very late stage in the proceedings despite of the fact that the appellant had been aware of these documents already for some years.

Therefore, E10 to E23 should not be admitted into the appeal proceedings.

(b) Main request

Allowability of the amendments

The respondent did not give his agreement to the introduction of the new ground of opposition according to Article 100(c) EPC in the appeal proceedings.

Validity of the priority

The feature according to which the adjustment means are designed to mechanically adjust the restriction member (feature C1) had to be understood as meaning that the restriction means was non-inflatable. When interpreting feature C1 the whole teaching of the application had to be taken into account, in particular paragraph [0011] which specified that no liquid is directly involved in the elongated restriction member. Moreover, since exactly the same wording of paragraph [0011] of the patent in suit was used in the priority document on page 3, lines 13 to 16, the subject matter of claim 1 represented the same invention described in the previous US-application with respect to the type of the restriction member.

The term "motor" as used in the previous application had to be interpreted in a broad way as a device which imparts motion and it did not relate exclusively to electrical motors. Therefore, the mechanical adjustment means described in feature C1 of claim 1 as granted represented a "motor".

Moreover, Figure 34 of the priority document disclosed a food intake restriction device according to the

invention where no signals were send from the control unit to the energizer unit and where the latter provided directly power to the motor and not via the control unit (see also page 24, line 13 to page 26, line 4). From these passages it was clear that the verb "to power" as used in claim 16 of the previous application when describing the relationship between the control unit and the motor should be understood in the sense of "to control" and not of providing power. Therefore, the food intake restriction device according to claim 1 as granted related to the same invention as the US-application with respect to these features as well and, as a consequence, the priority was validly claimed for the subject matter of claim 1.

Novelty

E22 did not disclose features D and E of claim 1.

It was clear from the description of the patent in suit (see paragraph [0075] in combination with [0085]) that the control unit according to the invention (feature D) was a device comprising a microprocessor able to receive signals, to decode and understand them, and depending on their meaning to control the adjustment means. The device described in Figure 5 of E22 on the contrary was only able to receive the open-close signals emitted by the remote control and to transmit them without any further treatment to the motor. Therefore, E22 did not disclose a control unit in the sense of the claim 1 of the patent in suit.

Moreover, E22 did not disclose an energizer unit according to feature E. As shown in Figure 5, the

condenser 39 did transfer energy only to the motor 21 but not to the further energy consuming elements of the device and hence, contrary to the requirements of claim 1, not to all energy consuming components of the device.

Therefore, the subject matter of claim 1 was novel with respect to E22.

(c) Auxiliary request

Admissibility

The request should be admitted into the proceedings since it represented a reaction to the board's opinion about the validity of the priority of claim 1 as granted, which was expressed for the first time during the oral proceedings.

Validity of the priority

Feature F was derived literally from page 3, lines 13 to 16 of the previous application. In that context it was related to further features such as adjustment means being designed to mechanically adjust the restriction member and non-invasive post-operative adjustment thereof which were present in claim 1 according to the auxiliary request.

Since no gas was ever used in gastric bands, the feature stating that no liquid is used for inflation of a restriction member corresponded to stating that the restriction member is non-inflatable.

Therefore, the subject matter of claim 1 related to the same invention as the previous application and the priority was validly claimed.

Clarity

The feature relating to the direct involvement of the liquid in the restriction member itself could only be understood as meaning that the restriction member was not inflated by a liquid but that a liquid could be used to convey forces to the mechanical restriction member.

Moreover, it was evident how to ascertain whether a substance used in the restriction member of a gastric band was liquid or not given the temperature and pressure at stake in a gastric band.

Allowability of the amendments

Feature F comprised a negative formulation, however, it did not represent a disclaimer let alone a non-disclosed disclaimer -for which the ruling of G 1/03 would apply- since it derived literally from page 3, lines 26 to 29 of the original application.

Therefore, feature F complied with the requirements of Article 123(2) EPC.

Inventive step

Even if the skilled person took the teaching of E3a in consideration for solving the problem underlying the patent in suit, he would apply the concept of remote

control disclosed in E3a to the gastric band disclosed in E13, thereby arriving at a gastric band with an inflatable restriction member whose dimension could be altered by remote control. Since such a device already solved the problem posed, the skilled person would not have any reason to replace in a further step the inflatable restriction member of E13 by a non-inflatable one.

Since E17 disclosed a device for regulating the fluid flow within the human body whereby a fluid was present within the restriction member, it directly involved the inflation thereof. Therefore, its combination with a gastric band would not lead at all to the subject matter of claim 1 according to the auxiliary request.

Therefore, the subject matter of claim 1 involved an inventive step over the combination of E13 either with E3a or with E17.

Reasons for the Decision

1. The appeal is admissible.
2. Admissibility of the late filed documents
 - 2.1 Documents E10 to E12, which had been filed during the opposition proceedings but after the opposition period, were not admitted by the opposition division.

If an opposition division did not consider late filed documents under Article 114(2) EPC, during the appeal proceedings it has only to be assessed whether the opposition division exercised their discretion correctly or not.

In the present case, the opposition division had not considered E10 and E11 since they do not represent prior art under Article 54(2) or (3) EPC. E12 was not introduced into the proceedings since this document did not disclose any non-invasive transcutaneous signal transfer in the sense of claim 1 and was not prima facie relevant.

Since these findings are correct, the opposition division exercised its discretion in a non objectionable way. Therefore, E10 to E12 are not admitted into the appeal proceedings either.

- 2.2 E13 to E21 have been filed together with the grounds of appeal, therefore at the earliest point in time in the appeal proceedings and as a reaction to the argumentation set out in the decision of the opposition

division. Since filing new documents reinforcing the line of attack already made before the department of first instance has to be considered as the normal behaviour of a losing party, the filing of these documents does not constitute an abuse of procedure. Therefore, E13 to E21 are admitted into the proceedings.

2.3 E22 and E23 have been filed six weeks before the oral proceedings, and therefore within the time period stipulated in the communication accompanying the summons to oral proceedings. These documents had been known to the respondent for some time since E23 is a divisional application of the patent in suit and E22 was cited by the proprietor in a parallel opposition proceedings. Moreover, both documents are prima facie of crucial relevance for the assessment of the novelty of patent in suit. Therefore, they are admitted into the proceedings.

3. Main request

3.1 Allowability of the amendments

According to G 10/91 a fresh ground of opposition can be considered in the appeal proceedings only with the approval of the patent proprietor.

In the present case the ground of opposition according to Article 100(c) EPC had not been raised in the notice of opposition. This ground was addressed by the appellant only during the opposition proceedings. However, it was not admitted by the opposition division. Therefore, the Article 100(c) EPC objection must be considered as a new ground.

Since the respondent did not give its consent to the introduction of the ground of opposition according to Article 100(c) EPC, it is not considered in the appeal proceedings.

3.2 Validity of the priority

The patent in suit claims the priority of the US application No. 09/133 320. In order for the priority of a claim to be valid it must, amongst other conditions, relate to the same invention as the previous application (see Article 87(1)(b) EPC).

- 3.2.1 The US-application relates to a food intake restriction device comprising a restriction member which is non-inflatable. This characteristic of the restriction member is present throughout the whole application (both in claim 1 and in the description, see e.g. page 3, lines 13 to 16) and must be considered as a crucial aspect of the invention underlying the priority document. Therefore, the presence of this feature is essential in an independent claim of a further application to ensure that it relates to the same invention.

Claim 1 as granted refers to a gastric band with a restriction member comprising adjustment means designed to mechanically adjust the restriction member. The respondent argued that such adjustment means intrinsically required the presence of a non-inflatable restriction member and that this was confirmed by the description of a non-inflatable restriction member on page 3, lines 13 to 16 of the patent in suit.

However, what is relevant for the assessment of the validity of the priority of a claim is the subject matter of the claim and not the content of the whole patent. It is correct that the patent describes a non-inflatable restriction member on page 3, lines 13 to 16, however, this does not limit the claimed invention exclusively to non-inflatable restriction members. Therefore, the question to be answered is whether or not the presence of adjustment means which mechanically adjusts the restriction member stringently implies that the restriction member is non-inflatable.

Since it is possible to mechanically adjust an inflatable restriction means (for example by a cylinder-piston assembly), the use of adjustment means which mechanically adjust the restriction member does not imply the presence of a non-inflatable restriction member. Hence, with respect to this feature, the claimed subject matter does not correspond to the same invention as the previous application.

3.2.2 The term "motor" as used in the priority document is to be understood generally as a device which imparts motion and hence does not need to be an electrical motor. A motor in this general meaning is present in claim 1 in form of the mechanical adjustment means (see feature C1). Therefore, the omission of the term "electric motor" in claim 1 cannot affect the validity of the claimed priority.

3.2.3 Figure 34 of the US-application shows in combination with page 24, lines 13 to page 26, line 4 that the energizer unit provides power directly to the motor. Therefore, the control unit according to the invention

of the previous application does not provide the motor with power but only controls the energizer unit and hence the adjustment means. Therefore, the term "to power" as used in the previous application has not to be understood as meaning the provision of power but as "to control the provision of power". Since claim 1 as granted claims that the control unit is for controlling the adjustment means, it corresponds to the same invention as the previous application with respect to this feature.

3.2.4 With respect to the above findings, in particular those in section 3.2.1, the subject matter of claim 1 does not correspond to the same invention as the priority document. Therefore, priority of 13 August 1998 is not valid and E22 is comprised in the state of the art according to Article 54(3) EPC.

3.3 Novelty

E22 undisputedly discloses (see particularly Figures 1 to 5):

A food intake restriction device for forming a stoma opening in the stomach or esophagus of a patient, the device comprising:

an elongated restriction member (12),

forming means (13, 17) for forming the elongated restriction member into at least a substantially closed loop around the stomach or esophagus, said loop defining a restriction opening;

and an adjustment means (3) for adjusting the restriction member in said loop to change the size of said restriction opening,

wherein the adjustment means is designed to mechanically adjust the restriction member

in a non-invasive manner to allow post operation non-invasive adjustment of the restriction member,

comprising an implantable energizer unit capable of being provided with energy via wireless energy transfer from the signal transmitting means (see the paragraph bridging pages 11 and 12).

E22 further discloses an implantable signal receiving means (11) comprising a control unit (29) for controlling the adjustment means in response to signals from a wireless remote transmitting means. The term "control means" is a well established expression which describes a part of a device which controls the operation of the other units of the device. Contrary to the respondent's submissions, the concept of controlling does not inherently comprise the step of decoding and understanding the signals before forwarding them to the entity which has to be controlled as it is described in the patent in suit. Therefore, E22 discloses feature D as well.

Furthermore, E22 discloses an implantable energizer unit (the electro-chemical condenser 39) for providing energy to energy consuming components of the device (see page 12, line 36 to page 13, line 3). Since feature E does not require that the energizer unit

provides energy to all consuming components of the device, E22 discloses feature E as well.

Therefore E22 discloses all features of claim 1 and its subject matter is not novel.

4. Auxiliary request

4.1 Admissibility of the auxiliary request

The request was filed as a reaction to the board's opinion on the validity of the priority of claim 1 according to the main request, which was expressed for the first time during the oral proceedings. The feature introduced into the claim was indeed extracted from the description but since it had been the subject of long discussions already in the written proceedings, its introduction into the claim could not be surprising for the appellant. Therefore, the request is admitted into the proceedings.

4.2 Validity of the priority

Feature F is derived literally from page 3, lines 13 to 16 of the previous application. The paragraph comprising this feature describes further features of the gastric band, such as adjustment means being designed to mechanically adjust the restriction member and non-invasive post-operative adjustment thereof. Claim 1 according to the auxiliary request comprises all these features even though not in immediate succession. Therefore, it claims the same device described on page 3 of the previous application. It is irrelevant whether or not any cause-effect link between

the different features is specified, since the introduction of such a combination would not change the subject matter of the claim.

It is correct that in principle the wording of claim 1 would encompass the use of a gas for inflating the restriction means while the priority document related exclusively to non-inflatable restriction means. However, due to the application of the restriction means within a gastric band the use of a gas for inflation is excluded as a matter of fact. Therefore, in the present context, feature F according to which no liquid is involved in the restriction member for providing inflation thereof corresponds to the feature according to which the restriction member is non-inflatable.

Hence, the invention defined in claim 1 of the auxiliary request is the same as that of the priority document and the priority is validly claimed.

4.3 Clarity

The feature introduced into claim 1 according to which "there is no liquid directly involved in the elongated restriction member itself for providing inflation thereof" is clear.

In the context of the present claim, the wording "directly involved" can only be interpreted as meaning that no liquid is used in the restriction member for changing its dimension by inflation. It is correct that the feature introduced into the claim allows a liquid to be used for conveying forces to the restriction

means, i.e. the liquid can be involved indirectly, e.g. in the form of a hydraulic actuator, however this does not render the wording unclear.

The term "itself" as used in feature F only stresses the fact that no liquid is involved in the elongated restriction member. The fact that the boundaries of the restriction member are not specified in the claim is not linked to the term "itself" and does not render it unclear. If at all the absence of a definition of the boundaries might become relevant for ascertaining the novelty and inventive step of the subject matter of the claim. Moreover, since the sentence would have exactly the same meaning if the term "itself" was left out, this term cannot introduce any unclarity or vagueness into the feature.

In contradiction to the appellant's opinion, the term "liquid" has a clear and well known physical meaning. As for example described in Collins English Dictionary, Fourth Edition, 1998, a liquid is "a substance in a physical state in which it does not resist change of shape but does resist change of size". Therefore, this term per se is clear. It is correct that the state of a substance changes depending on its temperature and pressure and that a liquid may become a solid or a gas. However, in the present case, claim 1 refers exclusively to a liquid and not to a solid or a gas.

Therefore, feature F complies with the requirements of Article 84 EPC as well.

4.4 Allowability of the amendments

By stating that no liquid is involved in the elongated restriction member for providing inflation thereof, feature F comprises a negative formulation and disclaims the use of liquids for inflation of the restriction member.

However, it is permissible to restrict the subject-matter using a negative limitation i.e. a disclaimer if -as in the present case- adding positive features to the claim either would not define more clearly and concisely the subject-matter still protectable or would unduly limit the scope of the claim.

The decision G 1/03 cited by the appellant refers to so-called "undisclosed disclaimers", i.e. to disclaimers which do not have any basis in the application as filed. It is correct that such disclaimers are only allowable if they meet the conditions set out in G 1/03. However, since the limitation introduced by feature F is derived literally from page 3, lines 26 to 29 of the original application it has a basis in the original application and does not represent an undisclosed disclaimer but a disclaimer for a disclosed subject matter. Hence G 1/03 is not relevant in the present case.

G 2/10 which deals with the allowability of disclosed disclaimers exclusively states that an amendment to a claim by the introduction of such a disclaimer infringes Article 123(2) EPC if the subject-matter remaining after the introduction of the disclaimer is not disclosed in the application as filed

(see headnote 1a). Moreover, G 2/10 points out that G 1/03 refers exclusively to undisclosed disclaimers (see G 2/10, section 3, in particular 3.9). Consequently, G 2/10 has to be considered in the present case. Since the subject matter remaining after the introduction of feature F is clearly disclosed in the originally filed application (see arguments brought forward under 4.2 above in the context of validity of the priority which apply to the allowability of the amendments as well), a fact which has not been challenged by the appellant, the amendments introduced into claim 1 are allowable under Article 123(2) EPC.

4.5 Inventive step

4.5.1 E13 discloses:

A food intake restriction device for forming a stoma opening in the stomach or esophagus of a patient, the device comprising:

an elongated restriction member (12),

forming means (16) for forming the elongated restriction member into at least a substantially closed loop around the stomach or esophagus, said loop defining a restriction opening.

Claim 1 according to the auxiliary request undisputedly differs therefrom by features C1 to F.

Starting from E13, the technical problem to be solved by the device according to claim 1 is the provision of a gastric band which does not require the use of an

injection needle for accomplishing post-operation adjustment of the stoma opening (see [0008] of the patent in suit).

- 4.5.2 E3a discloses a device for occluding and releasing ducts in the human body which can be operated from the outside (see page 1, lines 33 to 40) and would be taken into consideration by the skilled person in order to solve the problem posed. For changing the size of the duct, the device according to E3a comprises an occluding body which can be operated pneumatically, hydraulically, mechanically or electrically and is connected with operating means for closing or releasing the occluding body operated by remote control (see page 1, lines 32 to 70).

When applying the teaching of E3a to the gastric band of E13, the skilled person would apply the concept of the remote control to the restriction means of E13 thereby arriving at a gastric band with an elongated restriction member which is inflated by the direct involvement of a liquid, whereby the degree of inflation is controlled by remote control means. Such a device would still differ from the gastric band according to claim 1 in that a liquid is directly involved in the inflation of the elongated restriction member. Moreover, since this device already solves the problem posed, the skilled person would not have any reason for further modifying it by replacing the inflatable restriction means of E13 by a mechanical one wherein no liquid is directly involved. Such a modification would be based on hindsight knowledge of the invention.

Therefore, the subject matter of claim 1 is not rendered obvious by the combination of E13 and E3a.

4.5.3 D17 discloses a device for regulating the fluid flow within the human body. This device consists of an annular ring having a chamber filled with magnetorheological fluid surrounding the duct to be restricted. The device changes its shape due to the change of the viscosity and apparent density of the magnetorheological fluid caused by electromagnetic induction devices. The activation of the electromagnetic induction devices is controlled from outside the body (see column 6, lines 58 to 61).

The combination of the device according to E17 with the gastric band of E13 would lead to a gastric band which can change its shape through a remote control and thereby solves the problem posed. However, also this gastric band would still comprise a restriction member where a liquid is directly involved in the inflation thereof.

The appellant argues that since in a magnetorheological fluid the particles and not the liquid are responsible for the change in shape of the device, the liquid is not directly involved in the restriction means. However, the means for changing the shape of the chamber consist of a mixture of the solid particles and the liquid and, without the liquid part, the solid particles alone would not be able to change the shape of the restriction member. Hence the liquid is directly involved in the inflation of the chamber and the combination of the teaching of E13 and E17 does not

lead in an obvious way to the subject matter of claim 1.

4.5.4 Therefore, the subject matter of claim 1 according to the auxiliary request involves an inventive step with respect to the prior art cited by the appellant.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The case is remitted to the opposition division with the order to maintain the patent on the basis of the following documents:

claim 1 as filed during the oral proceedings;
claims 2 to 54 as granted; and
a description and drawings to be adapted.

The Registrar:

The Chairman:

V. Commare

T. Kriner