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**Datasheet for the decision
of 22 June 2010**

Case Number: T 2287/08 - 3.3.10

Application Number: 03078948.1

Publication Number: 1407726

IPC: A61F 2/06

Language of the proceedings: EN

Title of invention:

Local delivery of rapamycin for treatment of proliferative sequelae associated with PTCA procedures, including delivery using a modified stent

Applicant:

Cordis Corporation

Headword:

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Relevant legal provisions:

EPC Art. 111(1)

Keyword:

"Remittal to first instance - fresh case"

Decisions cited:

T 0063/86, T 0047/90

Catchword:

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Case Number: T 2287/08 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 22 June 2010

Appellant: Cordis Corporation
14291 N.W. 60th Avenue
Miami Lakes
Florida 33014 (US)

Representative: Fisher, Adrian John
Carpmaels & Ransford
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 4 July 2008
refusing European application No. 03078948.1
pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: R. Freimuth
Members: P. Gryczka
F. Blumer

Summary of Facts and Submissions

- I. The present appeal lies from the decision of the Examining Division posted on 4 July 2008 refusing European patent application No. 03078948.1 filed as a divisional application to the European patent application No. 99302918.0.
- II. The decision under appeal was based on the claims according to the then pending main request and auxiliary request comprising a claim 1 which was directed to a stent having a coating containing rapamycin or its analogs, said coating formed from a polymer mixed carrier containing the rapamycin or said analogs.
- III. The Examining Division found that the subject-matter claimed in both requests then pending lacked inventive step (Article 56 EPC) when combining the teaching of document
- (1) US-A 5 288 711
- with the passage in column 2, lines 30 to 40 of document
- (3) US-A 5 624 411,
- since that passage disclosed that a coating including a polymer and a therapeutic substance was suited for slow administration of the substance.
- IV. At the oral proceedings before the Board held on 22 June 2010 the Appellant (Applicant) no longer

maintained the former requests. He submitted a fresh main request of 7 claims superseding any previous request.

The sole independent claim of that request read as follows:

"1. A stent having a coating containing rapamycin or macrocyclic lactone analogs of rapamycin, said coating formed from a polymer mixed carrier containing the rapamycin or said analogs; and said coating applied to said stent, wherein a polymer is mixed with the rapamycin or its analogs."

- V. The Appellant argued that the objection of lack of inventive step raised in the decision under appeal was overcome since independent claim 1 was now restricted to a stent where a polymer was mixed with rapamycin or its macrocyclic lactone analogs. This feature was neither disclosed in document (1) which did not disclose polymers, nor in document (3) which required that a porous polymer overlayer covered the layer including the therapeutic substance.
- VI. The Appellant requested that the decision under appeal be set aside and that the case be remitted to the Examining Division for further prosecution on the basis of claims 1 to 7 of the main request as filed during the oral proceedings before the Board.
- VII. At the end of the oral proceedings the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.
2. *Ground for refusal*

The decision under appeal exclusively dealt with lack of inventive step of the independent claim 1 of the then pending requests which was directed to a stent having a coating containing rapamycin or its analogs, said coating being characterised in that it was formed from a polymer mixed carrier containing the rapamycin or said analogs, without any restriction with regard to the form under which the polymer and the rapamycin or its analogs were present in the coating. Thus, claim 1 then pending covered a stent wherein the rapamycin or its analogs is entrapped on the surface of the stent by a polymer, this particular embodiment being the subject of the then pending dependent claim 7. This embodiment is disclosed in document (3) (column 2, lines 30 to 43; claim 1, paragraph (b); claim 19, steps (b), (c) and (d)) which was combined with document (1) to object to inventive activity in the appealed decision.

3. *Remittal*
 - 3.1 The amendments made to the claimed subject-matter in the fresh request restrict the subject-matter claimed to the different embodiment of original claim 5 and requires now that the polymer is mixed with rapamycin or its analogs.

Thus, the Board considers that the amendments made by the Appellant are substantial in the sense that in the

present case the examination has to be done on a new basis, the amended claim 1 generating fresh issues not yet addressed in examination proceedings constituting a "fresh case" (see e.g. decisions T 63/86, OJ EPO 1988, 224; T 47/90, OJ EPO, 1991, 486).

3.2 Under these circumstances, the examination not having been concluded, the Board considers it appropriate to exercise its power conferred on it by Article 111(1), second sentence, second alternative, EPC to remit the case to the Examining Division for further prosecution. The remittal of the present case to the Examining Division ensures that the Appellant is given the opportunity to present any comment on any possible fresh objection or document which might become relevant as a consequence of that amendment, if he so wishes, in conformity with his right to be heard pursuant to Article 113(1) EPC.

3.3 The Board considers that the issue below merits consideration when resuming examination proceedings on the basis of the fresh main request. The amended claim 1 and the dependent claims 2 to 7 define a stent requiring combinations of technical features which need to be examined as to their support in the parent application (Article 76 (1) EPC) and in the present application as filed (Article 123 (2) EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance for further prosecution on the basis of claims 1 to 7 of the main request as filed during the oral proceedings before the Board.

The Registrar:

The Chairman:

C. Rodríguez Rodríguez

R. Freimuth