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**Datasheet for the decision
of 14 September 2011**

Case Number: T 0012/09 - 3.2.02

Application Number: 99937310.3

Publication Number: 1104260

IPC: A61B 17/58

Language of the proceedings: EN

Title of invention:
Systems for placing materials into bone

Patentee:
Kyphon SÀRL

Opponent:
Kühn, Armin

Headword:
-

Relevant legal provisions:
EPC Art. 100(c), 123(2), 111

Relevant legal provisions (EPC 1973):
-

Keyword:
"Extension of subject-matter (no, after amendment)"
"Remittal (yes)"

Decisions cited:
-

Catchword:
-



Case Number: T 0012/09 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 14 September 2011

Appellant: Kyphon SÀRL
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 3 November 2008
revoking European patent No. 1104260 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: M. Noël
Members: P. L. P. Weber
M. J. Vogel

Summary of Facts and Submissions

- I. The appeal of the patentee is against the decision of the Opposition Division dated 3 November 2008 to revoke the European patent because the claims on file contained subject-matter which extended beyond the content of the application as originally filed, contrary to the provision of Article 123(2) EPC.
- II. The notice of appeal was filed on 29 December 2008 and the appeal fee was paid on the same day. The statement setting out the grounds of appeal was filed on 11 March 2009.
- III. The appellant requested that the patent be maintained in amended form on the basis of the sets of claims 1 to 16 according to either a main request or an auxiliary request, both filed with the statement setting out the grounds of appeal of 11 March 2009.

In response to the provisional opinion of the Board forwarded to the parties on 12 July 2011, the appellant conditionally withdrew its previous request for oral proceedings by letter dated 29 August 2011, should the Board consider that at least one of the sets of claims filed with the appeal met the requirements of the Article 123(2) EPC and intend to remit the case to the first instance for further prosecution.

- IV. The respondent (opponent) requested that the appeal be dismissed.

Following the Board's communication of 12 July 2011, the respondent withdrew its previous request for oral

proceedings by letter dated 28 July 2011, should the matter decided upon in the present appeal be restricted to the requirements of Article 123(2) EPC, as suggested by the Board.

V. Claim 1 of the main request reads as follows:

"1. Apparatus for introducing material (170) that sets to a hardened condition into a human vertebral body comprising:
a cannula (30, 184) for establishing a subcutaneous path through soft tissue into the human vertebral body;
a cavity forming instrument capable of advancement through the cannula to a location inside the human vertebral body to form a cavity in the human vertebral body;
an instrument for delivering the material into the cavity formed in the interior region of the human vertebral body comprising a nozzle component (106, 180) that is sized to be advanced through the cannula after withdrawal of the cavity forming instrument and that includes an interior bore for containing and conveying the material, the instrument also including a stylet component (182) that is sized to be advanced through the interior bore of the nozzle component containing the material."

Claim 1 of the auxiliary request reads as follows:

"1. Apparatus for introducing material (170) that sets to a hardened condition into a human vertebral body comprising:
a cannula (30, 184) for establishing a subcutaneous path through soft tissue into the human vertebral body;

a cavity forming instrument capable of advancement through the cannula to a location inside the human vertebral body to form a cavity in the human vertebral body *by compressing cancellous bone* ;
an instrument for delivering the material into the cavity formed in the interior region of the human vertebral body comprising a nozzle component (106, 180) that is sized to be advanced through the cannula after withdrawal of the cavity forming instrument and that includes an interior bore for containing and conveying the material, the instrument also including a stylet component (182) that is sized to be advanced through the interior bore of the nozzle component containing the material *to close the interior bore and together with the nozzle component form a tamping instrument.*"

VI. The arguments of the appellant can be summarised as follows:

The section on page 40, lines 20 to 25 of the application as filed indicated that a stylet could be used, if required, to reclaim material from the nozzle of the material introducing instrument, this section further indicated that a separate tamping instrument could be used. Thus, there was no mandatory requirement for the stylet to close off the bore of the nozzle. The opinion of the Opposition Division that the stylet had to be sized so as to close off the bore to form a tamping instrument with the nozzle was therefore incorrect.

Page 11, lines 4 to 7 and page 16, line 35 to page 17, line 4 of the application as filed referred explicitly to a cavity forming instrument that was usable to

create a cavity in cancellous bone without requiring that the cavity be formed by compressing the cancellous bone. The opinion of the Opposition Division that only an instrument capable of forming a cavity by compressing cancellous bone was disclosed, was therefore incorrect.

Thus, claim 1 according to the main request did not contain added subject-matter.

VII. The arguments of the Respondent can be summarised as follows:

On page 4, line 32 to page 5, line 15 and claim 50 of the originally filed application, the stylet was only disclosed in connection with the nozzle instrument as forming a tamping instrument, which implied that it was sized to close the nozzle bore. This could also be taken from the text on page 39, line 8 to page 40, line 25 where it was indicated that the stylet was sized to close the interior bore of the nozzle.

According to page 5, line 34 to page 6, line 2 and claims 16, 21, 23, 34, 43 as originally filed, a cavity forming instrument was an instrument that formed a cavity in the human vertebral body by compressing cancellous bone. This is the only kind of instrument disclosed in the originally filed application, so that the omission in claim 1 of "by compressing cancellous bone" was an unjustified generalisation of the disclosed cavity forming instrument.

Thus, the subject-matter of claim 1 according to the main request went beyond the content of the original disclosure.

Reasons for the Decision

1. The appeal is admissible.
2. Amendments - Article 123(2) EPC
- 2.1 Main request

Two features of claim 1 according to the main request were objected to by the Opposition Division and the respondent.

They considered that the two following features were missing in claim 1:

(i) *The stylet closes the nozzle bore and, with the nozzle instrument, forms a tamping instrument.*

(ii) *The cavity forming instrument forms a cavity in the human vertebral body by compressing cancellous bone.*

2.1.1 Concerning feature (i):

The wording of Claim 1 requires that "the instrument also includes a stylet component (182) that is sized to be advanced through the interior bore of the nozzle component containing the material.". As far as the stylet is concerned this means that it can have any

size and shape as long as it can be advanced through the bore of the nozzle.

The Appellant considers that this broad feature is disclosed in the passage on page 40, lines 20 to 25 of the originally filed application: "*Alternatively, a single-piece tamping instrument, separate from the nozzle 180, can be provided, downsized to fit through the reduced-diameter cannula instrument 184. In this embodiment, the stylet 182 is not necessary, unless it is desired to reclaim material from the nozzle.*"

According to the understanding of the Board, however, this passage only means that a tamping instrument separate from the nozzle can be provided. It does not mean that when a nozzle is provided, it can be provided without a stylet that closes the nozzle bore to form a tamping instrument.

On the contrary, in the paragraph preceding the paragraph mentioned above it is clearly stated in lines 10 to 12 that "*Nested together, the nozzle 180 and stylet 182 form a tamping instrument.*". The above paragraph cited by the appellant, therefore, is not able to reverse this statement.

2.1.2 Concerning feature (ii)

The wording of claim 1 further requires that the apparatus comprises "a cavity forming instrument capable of advancement through the cannula to a location inside the human vertebral body to form a cavity in the human vertebral body".

The appellant considers that this broad feature is disclosed in the following passages:

Page 11 lines 4 to 7:

"The second group 16 (which Fig. 4 shows outside the kit 12) comprises an instrument whose function is to create a cavity in cancellous bone."

Page 16 line 35 to page 17, line 4:

"As Fig. 4A shows, the group 16 includes an instrument 76, which is deployed through the cannula instrument 30 to a location inside bone (see Fig. 20). When so deployed, the instrument 76 serves to form a cavity in cancellous bone."

As can be understood from both passages the cavity is formed in cancellous bone, which means that the instrument must be suitable to form the cavity in the cancellous bone. However, this feature is not actually mentioned in claim 1, thus, for this reason alone, the subject-matter of claim 1 is an intermediate generalisation not disclosed in the originally filed application.

In addition, numerous passages of the originally filed application make it clear that the cavity is actually formed by compression of the cancellous bone, i.e. page 41, lines 3,4 : *"...compacts cancellous bone and forms the cavity."*; page 33, lines 25 to 29: *"Expansion of the structure 86 compresses cancellous bone 152 in the vertebral body 148. The compression forms an interior cavity 168 in the cancellous bone 152."*; see also originally filed claims 16, 21, 23, 34, 43, which all recite the feature of compressing cancellous bone.

Hence, a generalisation to an instrument suitable for forming a cavity anywhere and in any manner, as

presently results from the wording of claim 1, is not disclosed in the originally filed application.

2.1.3 The Board therefore shares the opinion of the Opposition Division that claim 1 according to the main request contravenes Article 123(2) EPC.

2.2 Auxiliary request

Claim 1 according to the auxiliary request removes the objections raised by the first instance in that it is now specified that the stylet component closes the nozzle bore and, with the nozzle component, forms a tamping instrument, and in that the cavity forming instrument forms a cavity in the human vertebral body by compressing cancellous bone.

In its reply of 29 July 2009 the respondent did not make any objections under Article 123(2) EPC against the subject-matter of claim 1 according to the auxiliary request.

Since the Board also does not have any objection, claim 1 according to the auxiliary request fulfils the requirements of Article 123(2) EPC.

3. Remittal

Since the objection upon which the impugned decision is based has been removed and the other grounds of opposition have not yet been decided upon by the Opposition Division, remittal of the case to the department of first instance for further prosecution

pursuant to Article 111(1) EPC, as submitted by the appellant, is justified.

Order

For these reasons it is decided that:

1. The decision is set aside.
2. The case is remitted to the department of the first instance for further prosecution on the basis of claims 1 to 16 according to the auxiliary request filed on 11 March 2009.

The Registrar:

The Chairman:

D. Sauter

M. Noël