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**Datasheet for the decision
of 4 June 2013**

Case Number: T 0233/11 - 3.2.08

Application Number: 99956343.0

Publication Number: 1128788

IPC: A61F 2/30, A61F 2/46

Language of the proceedings: EN

Title of invention:
BONE PLUG

Patent Proprietor:
Spierings, Petrus Tarasius Josephus

Opponent:
Bradnock, Brian Robert Denis Peter

Headword:
-

Relevant legal provisions:
EPC Art. 100(c)
RPBA Art. 15(3)
EPC R. 115(2)

Keyword:
"Claim 1 as granted; extension of the subject-matter (yes)"

Decisions cited:
-

Catchword:
-



Case Number: T 0233/11 - 3.2.08

D E C I S I O N
of the Technical Board of Appeal 3.2.08
of 4 June 2013

Appellant: Spierings, Petrus Tarasius Josephus
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Respondent: Bradnock, Brian Robert Denis Peter
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Representative: Lichota, Catherine Margaret Timmis
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted 1 December 2010
revoking European patent No. 1128788 pursuant
to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman: T. Kriner
Members: R. Ries
D. T. Keeling

Summary of Facts and Submissions

I. European patent No. 1 128 788 was opposed by the present respondent (opponent) inter alia on the grounds of Article 100(c) EPC (extension of the claimed subject matter beyond the content of the application as filed).

In its decision, the opposition division held that the amended wording of claim 1 was not disclosed in the application as originally filed and revoked the patent on the ground in that it contained subject matter which extended beyond the content of this document (Article 100(c) EPC)

II. On 31 January 2011, the appellant (patent proprietor) lodged an appeal against the decision of the opposition division, paying the appeal fee on the same date. The statement setting out the grounds of appeal was received on 1 April 2011.

III. In an official communication annexed to the summons for oral proceedings, which were requested by the parties, the Board gave its provisional view on the case. With respect to the ground of opposition under Article 100(c) EPC, the Board entertained doubts on the appellant's position that the contested amendment to granted claim 1 could be clearly and unambiguously derived from the application as originally filed. Neither the appellant nor the respondent submitted statements or counterarguments in response to the Board's provisional opinion.

Rather, both parties informed the Board by letters dated 17 April 2013 and 3 May 2013, respectively, that

they would not attend the oral proceedings, which took place on 4 June 2013. In accordance with Rule 115(2) EPC and Article 15(3) RPBA, the proceedings were continued without the parties.

IV. In the written proceedings, the following requests were made:

The appellant requested that the decision under appeal be set aside and the patent be maintained as granted or, alternatively, that the case be remitted to the first instance and that the appeal fee be reimbursed.

The respondent requested that the appeal be dismissed.

V. Claim 1 as granted reads as follows:

"Bone plug (1; 43; 61), for blocking of a canal (3) in a bone (5), comprising a radially expandable blocking element (13; 63) which comprises an at least nearly solid body (15; 65), which at axial compression expands in radial direction, and which is provided with a continuous axial opening (17), and has a height and an average wall thickness along said height, which bone plug (1; 43; 61) comprises means to keep the body (15; 65) in expanded condition locked in the axial direction, which means comprise two locking elements (19; 21; 67; 75) which can be fixed on various distances to each other, in between which the body (15; 65) with its axial boundaries is positioned, of which a first locking element (19; 67) comprises a stem (25; 71) which is provided with a number of radial protrusions (27; 73) which are positioned next to each other in axial direction on the stem, which stem (25; 71)

protrudes through the axial opening (17) of the body, whereby the second locking element (21; 75) is positioned around the stem (25; 71) and can lock behind the protrusions (27; 73), which body (15; 65) will expand in radial direction while solely being compressed in axial direction, characterized in that the height of the body (15; 65) is at most 8 times the average wall thickness of the body and radial expansion of the body (15; 65) will be caused by thickening of the wall of the body."

VI. The appellant's written arguments relevant to the present decision are summarized as follows:

During substantive examination the word "solely", which was not comprised in the text of the original application, was introduced by the appellant into claim 1 to overcome the examiner's novelty objection raised with respect to the technical disclosure of D1 (GB-A-2 324 731). The examining division agreed that introducing this term did not contravene Article 123(2) EPC and granted the patent. In contradistinction thereto, the opposition division held that the amendment was not supported by the application as originally filed and revoked the patent since it failed to satisfy the requirements of Article 100(c) EPC. This meant two opposite decisions which were reached by the examining division and the opposition division on the basis of the same facts.

Contrary to the assessment of the opposition division, the skilled person understood on the basis of the claims, description and figures of the application as filed that, when the body expanded in radial direction

while being compressed in axial direction, only axial compression caused radial expansion. Not the slightest indication was given anywhere in the application as filed that radial expansion of the bone plug could be caused by something other than axial compression. In technical teachings, it was common practice to describe only the cause of an effect without, however, mentioning that this cause was the only one.

Moreover and contrary to the opposition division's interpretation, figures 11 and 12 depicted clearly and unambiguously that the disc 23 and ring 31 shown in Figures 1 and 3 to 7 were flat. It was not at all necessary for radial expansion, solely because of axial compression, that the ring and disc should be flat, as erroneously purported by the opposition division in its decision. The surface of the disc and ring could be, for example, wavy. Therefore, limiting the scope of protection to a flat surface of the disc and ring was not necessary.

The decision to revoke the patent was not based on arguments filed by the opponent, but on new arguments which were introduced by the opposition division and on which the appellant was not given an opportunity to react. This represented a procedural violation which justified the remittal of the case to the first instance department and the reimbursement of the appeal fee.

VII. The respondent's arguments are summarized as follows:

The decision of the opposition division to revoke the patent at issue was based on argument presented in the

opponent's statement of grounds, to which the appellant had full opportunity to respond.

The appellant itself admitted that the term "solely" was not present anywhere in the text of the application as filed. Rather, it was introduced into claim 1 to overcome the novelty objection raised by the examining division during substantive examination. The word "solely" thus included the functional limitation that the body will expand in radial direction while solely being compressed in axial direction and, therefore, represented an essential technical feature as to delimit the claimed subject-matter from the teaching of D1 showing that cylinder 1 may be expanded in response to radial compression also. Even if the skilled person understood from Figures 6, 11 and 12 of the application as filed that the surfaces of the disc and ring were flat, as alleged by the appellant, the skilled person would not derive clearly and unambiguously from those figures the technical teaching of the essential feature of claim 1 as granted that the "body will expand in radial direction while solely being compressed in axial direction. This was all the more true since the passage on page 10, lines 11 to 14 of the original application reflected that the claimed invention was not limited to the embodiments shown in the drawing, but extended "to all from the drawing deviant embodiments within the area defined by the claims".

Revoking the patent on the basis of 100(c) EPC was therefore justified.

Reasons for the Decision

1. The appeal is admissible.
2. Procedural matter
- 2.1 The appellant objected to the fact that, based on the same facts and evidence, the examining division and the opposition division took opposite decisions and concluded that in both cases the EPO made a serious mistake.

Contrary to the appellant's view, it is not at all unusual for the examining division and the opposition division to arrive at a different conclusion with regard to a specific issue. On the contrary, the opposition division is frequently called upon to decide on the same issue as the examining division and is in no way bound by the findings of the examining division. It is precisely for this reason that Article 19(2) EPC requires that at least two members of the opposition division "shall not have taken part in the proceedings for grant of the patent to which the opposition relates". The fact that based on the same evidence, the examining division and opposition division came to opposite conclusions does not represent a procedural violation.

3. Amendment to claim 1; Article 100(c) EPC, added subject matter
- 3.1 The appellant disputed the assessment of the opposition division that the term "solely" was not supported by the application as originally filed and argued that the

contested amendment could be derived from the original application as a whole and the embodiments shown in Figures 6, 11 and 12.

As admitted by the appellant in its written submissions dated 1 April 2011, page 1, first paragraph, the contested term "solely" was not contained in the text of the application as originally filed. It is therefore undisputed that a direct basis providing support for the introduction of the feature "solely being compressed in axial direction" does not exist in the application as filed.

The application merely states on page 7, lines 17 to 18 and page 8, lines 11 to 14 that body 15 forming the blocking element will expand in radial direction while being compressed in axial direction. The application as filed does not, however, exclude at all any other means which could induce a radial force to the body as well. In studying the application as a whole and contrary to the appellant's view, the skilled person has no reason for concluding or implying that exclusively axial compression will cause radial compression, as shown in the drawings and described in the accompanying detailed description. This is all the more true since the passage on page 10, lines 11 to 13 states that *"although the invention is explained in the aforementioned by means of the drawings, it has to be stated that the invention is in no way limited to the embodiments shown in the drawings"*.

As already indicated in the Board's provisional view given in the official communication, compression of the blocking element (15) exclusively in the axial

direction would be obtainable only if the first locking element (19) comprises a flat disc (23), (69) and the second locking element comprises an interrupted ring (31) and a flat annular ring (79) or annular shaped plate which is placed between the body and the interrupted ring as depicted in the in Figures 6, 10 to 12. It may be true, as mentioned in the appellant's written submissions, that the surfaces of the ring and disc could be also wavy, but nothing is found in the application as filed in support of this argument. The appellant has dispensed with discussing the matter at the oral proceedings and with submitting a revised set of claims comprising the features referred to above.

In conclusion, due to the addition of the term "solely" to claim 1 as granted, the subject matter of the patent in suit extends beyond the application as filed (Article 100(c) EPC).

4. Reimbursement of the appeal fee

The notice of appeal includes a request for reimbursement of the appeal fee on the ground that a procedural violation occurred during the opposition proceedings.

The ground of opposition under Article 100(c) EPC was addressed by the respondent (opponent) in points 3 and 5.1.1, penultimate paragraph of its statement of grounds of opposition, and the appellant responded to this objection in its letter dated 23 July 2010.

Since no oral proceedings were requested, the opposition division was entitled to decide the case on

the basis of the written submissions made by the parties. As already pointed out in the Board's official communication, the reasoning of the opposition division in the impugned decision is regarded as being based essentially on the arguments presented in the opponent's ground of opposition under Article 100(c) EPC. Thus, the Board cannot see any reason to consider that a substantial procedural violation occurred in that the opposition division based its reasoning on new grounds, facts and evidence unknown to the appellant. The Board's finding set out in the official communication annexed to the summons for oral proceedings was not disputed by the appellant.

The reimbursement of the appeal fee under Rule 103(1)(a) EPC is subject to three conditions:

- i. the Board of Appeal considers the appeal to be allowable;
- ii. a substantial procedural violation occurred during the proceedings before the first instance department;
- iii. the reimbursement is equitable.

As has been shown above, the Board itself could not see any reasons why the opposition division's decision should be incorrect and that a substantial procedural violation occurred during the proceedings before the first instance department. Hence, conditions i. and ii. are not satisfied in the present case.

Consequently there is no legal basis justifying the reimbursement of the appeal fee.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

V. Commare

T. Kriner