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**Datasheet for the decision
of 25 June 2013**

Case Number: T 1740/11 - 3.2.08

Application Number: 98906213.8

Publication Number: 1003440

IPC: A61F 2/00

Language of the proceedings: EN

Title of invention:

Radially expandable tubular polytetrafluoroethylene grafts

Patent Proprietor:

Bard Peripheral Vascular, Inc.

Opponent:

Boston Scientific Corporation

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

EPC R. 99

Keyword:

"Admissibility of the appeal - yes"

"Allowability of the amendments - yes"

Decisions cited:

-

Catchword:

-



Case Number: T 1740/11 - 3.2.08

DECISION
of the Technical Board of Appeal 3.2.08
of 25 June 2013

Appellant: Bard Peripheral Vascular, Inc.
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Respondent: Boston Scientific Corporation
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 27 June 2011
revoking European patent No. 1003440 pursuant
to Article 101(3)(b) EPC.

Composition of the Board:

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

Summary of Facts and Submissions

I. The appellant (patent proprietor) filed a notice of appeal received at the EPO on 15 July 2011 against the opposition division's decision posted on 27 June 2011 revoking European patent No. EP 1 003 440. The appeal fee was paid simultaneously and the statement of grounds was received on 7 November 2011.

II. The opposition division was of the opinion that the main request and the first auxiliary request, both filed during to oral proceedings, did not comply with the requirements of Article 123(2) EPC. With respect to the auxiliary request, the opposition division held that the feature introduced into the preamble of claim 1 according to which the continuous tubular structure is

"capable of being delivered intraluminally into a body in a relatively small diameter and radially expanded in vivo to act as an intraluminal liner or as bypass grafts to carry body fluids around an obstructed flow path" (**Feature A** - definition of the feature introduced by the Board)

solved an additional and entirely independent technical problem compared to the technical features of original claim 1 and therefore, contravened the requirements of Article 123(2) EPC.

III. Oral proceedings took place before the Board of Appeal on 25 June 2013.

As announced in its letter dated 17 June 2013 the respondent (opponent) did not attend the oral proceedings.

IV. The appellant requested that the decision under appeal be set aside, and that the Board acknowledge that the claims of the Main Request filed at the oral proceedings are in compliance with Article 123(2) EPC and remit the case to the Opposition Division for further prosecution. In the alternative, the Board was requested to remit the case on the basis of one of the Auxiliary Requests 1 to 4, all filed on 23 May 2013, or to maintain the patent on the basis of the Main Request or the Auxiliary Requests 1 to 4.

The respondent requested, in its written observations, that the appeal be dismissed.

V. Independent claim 1 according to the main request (corresponding to claim 1 according to the auxiliary request underlying the appealed decision) reads:

"A continuous ePTFE tubular structure

which is capable of being delivered intraluminally into a body in a relatively small diameter and radially expanded in vivo to act as an intraluminal liner or as bypass grafts to carry body fluids around an obstructed flow path (Feature A),

comprising an expanded polytetrafluoroethylene material having a microstructure characterized by a plurality of nodes interconnected by fibrils, the fibrils having an orientation substantially parallel to the longitudinal axis of the polytetrafluoroethylene tubular material and the nodes having a longitudinal axis substantially perpendicular to the longitudinal axis of the polytetrafluoroethylene material, the polytetrafluoroethylene tubular material being capable of undergoing radial deformation under the influence of a positive pressure applied through the lumen of the polytetrafluoroethylene tubular material and radially outward therefrom which causes a plurality of the nodes in the microstructure to undergo elongation along the longitudinal axis of the nodes,

while substantially retaining an average internodal distance throughout the microstructure of the section of polytetrafluoroethylene tubular material which is radially deformed, and

characterised in that

the expanded polytetrafluoroethylene tubular material is radially deformable to at least 50% its original diameter at applied positive pressures less than about 6 atm, wherein the expanded polytetrafluoroethylene tubular material is radially deformable between about 50% to 700% its original diameter without loss of structural integrity".

The auxiliary requests are not relevant for the present decision.

VI. The respondent argued as follows:

(a) Admissibility of the appeal

Since Feature A was missing from all independent claims filed together with the grounds of appeal, the appellant's statement that the set of claims attached to the grounds of appeal corresponded to the auxiliary request in the opposition proceedings was not correct.

Moreover, since the claims attached to the grounds of appeal were not dealt with by the Opposition Division, the appeal was inadmissible

(b) Allowability of the amendments

The paragraph bridging pages 5 and 6 did not provide a direct and unambiguous disclosure of Feature A.

Feature A of claim 1 according to the main request did not specify where in the human or animal body the ePTFE member should be used as an intraluminal liner and hence it encompassed its use in any part of the body. However, that generic use was not disclosed in the original application since the passage bridging pages 5 and 6 provided an exhaustive list of specific examples of locations where the ePTFE member could be used as an intraluminal anatomical liner, namely exclusively in the vasculature, the alimentary tract, biliary ducts and hepatic-portal vein shunts.

Moreover, since feature A failed to specify that the tubular structure is an "intraluminal anatomical liner", the claimed tubular structure could be used

outside of the human/animal body as well. However, such a use of the ePTFE member was not envisaged by the application as originally filed.

Finally, there was no link between the first paragraph of the "Summary of the Invention" section and the following passage starting on page 5, line 24 - from which Feature A had been allegedly extracted. The latter beginning with "another primary objective of the present invention" made it clear that it had a different objective than the one mentioned in the paragraph before, which related to the original objective problem to be solved by the invention. Since the two objectives were not linked together, the introduction of Feature A into claim 1 lead to the introduction of subject matter which extended beyond the application as filed.

For all the reasons set out above, claim 1 according to the main request did not comply with the requirements of Article 123(2) EPC.

VII. The appellant argued as follows:

(a) Admissibility of the appeal

It was clear from the argumentation set forward in the statement of the grounds of appeal that the main request in the appeal proceedings was to maintain the patent according to the auxiliary request filed during the opposition proceedings and that the set of claims filed together with the grounds of appeal was wrong, since it was obviously intended to contain Feature A as well.

Therefore, the set of claims according to the main request had indeed been dealt with by the opposition division and the appeal was admissible.

(b) Allowability of the amendments

Claim 1 according to the main request was based on claims 1 to 3 as filed and on the original passage, page 5, line 24 to page 6, line 5 of the description.

The passage bridging pages 5 and 6 described the use of the ePTFE member as an intraluminal anatomical liner. The list of potential applications, in the vasculature, the alimentary tract, the biliary ducts and the hepatic-portal vein shunts, represented merely a non-exhaustive list of examples of the liner's use and did not represent a limitation to these applications.

It was correct that the term "anatomical" in combination with the intraluminal liner was omitted from Feature A. However, since the term "intraluminal liner" in the context of the whole of the claim clearly pointed to an anatomical use of the ePTFE member, omitting the adjective "anatomical" was allowable.

Finally, the opposition division came to the conclusion that the added features solved an additional and entirely independent technical problem compared to the technical features of original claim 1 and hence the amendments were not allowable. However, it was irrelevant for assessing whether or not the amendments comply with the requirements of Article 123(2) EPC,

whether the newly introduced features solve an entirely independent technical problem.

Hence claim 1 according to the main request was directly and unambiguously derivable from the application as originally filed and complied with the requirements of Article 123(2) EPC.

Reasons for the Decision

1. Admissibility of the appeal

In its notice of appeal, the appellant clearly stated that he requested the maintenance of the patent as granted or according to the amendments filed during the opposition proceedings.

In the statement of grounds of appeal, the appellant modified his requests basing them on the sets of claims filed together with the grounds of appeal and stating that his new main request corresponded to the auxiliary request of the opposition proceedings.

It is correct that claim 1 of the main request filed together with the grounds of appeal did not correspond to claim 1 according to the auxiliary request filed during the opposition procedure since Feature A was missing.

However, in the arguments referring to the main request the appellant repeatedly argues about the admissibility of the amendments introduced by Feature A. Therefore, it is clear from the grounds of appeal that the appellant intended indeed to request the maintenance of the patent according to the auxiliary request filed during the opposition procedure.

Therefore, the set of claims underlying the main request had been dealt with in the opposition proceedings and all conditions set out in Rule 99 EPC are fulfilled by the notice and the statement of grounds of appeal. Hence the appeal is admissible.

2. Allowability of the amendments

Claim 1 according to the main request is based on the combination of claims 1 to 3 as filed and on the original passage, page 5, line 24 to page 6, line 5 of the description. While the original disclosure with respect to the combination of claims 1 to 3 is undisputed, it remains to be assessed whether the introduction of Feature A (which was based on the passage extracted from the description) complied with the requirements of Article 123(2) EPC when taken in combination with the remaining features of claim 1.

2.1 The passage bridging pages 5 and 6 of the description sets out that the ePTFE tubular member can be delivered intraluminally into the body and be radially expanded *in vivo* so as to act as an intraluminal anatomical liner or as a bypass graft to carry body fluids around an obstructed flow path. In this context, some possible applications of the liner are listed as examples, namely in the vasculature, the alimentary tract, the biliary ducts and the hepatic-portal vein shunts.

Feature A, as introduced into claim 1, does not comprise these examples. The respondent argues that this omission leads to the broadening of the subject matter of the passage bridging pages 5 and 6 and hence to an intermediate generalisation.

The list of organs where the ePTFE tubular member can be used as an intraluminal anatomical liner which starts on the beginning of page 6 represents merely some examples (it starts with the wording "for

example") of the possible application of the ePTFE tubular member and cannot be considered as being an exhaustive list of all applications which can be foreseen for the liner. Therefore, the passage bridging pages 5 and 6 discloses an ePTFE tubular member which can be radially expanded *in vivo* to act as an intraluminal anatomical member without any restriction as to its specific place of use. Hence, omitting the list of exemplary positions where the ePTFE tubular member can be used as a liner in Feature A does not lead to an intermediate generalisation.

- 2.2 It is correct that the passage bridging pages 5 and 6 refers to the use of the ePTFE tubular member as an "intraluminal anatomical liner" and that Feature A only refers to an "intraluminal liner" without the adjective "anatomical".

However, it is clear from the introduction of the claim which refers to a tubular structure to be "delivered intraluminally into a body" and then "radially expanded *in vivo*" as well as from the whole context of the description, that the only use envisaged for the claimed ePTFE tubular member is in the human or animal body, i.e. that the liner is supposed to be "anatomical".

Therefore, the omission of the adjective "anatomical" in the context of an intraluminal liner does not change the meaning of the paragraph bridging pages 5 and 6.

- 2.3 Finally, it was argued that the insertion of Feature A into claim 1 did not comply with the requirements of Article 123(2) EPC since the objective problem solved

by it was not linked to the objective problem solved by the original claim 1.

However, for assessing whether amendments comply with the requirements of Article 123(2) EPC, the question to be answered is whether or not the features of the claim, in combination with each other, are directly and unambiguously derivable from the application as originally filed. Whether the newly introduced features solve a technical problem which is not linked to the one solved by the originally filed claim is irrelevant.

On the contrary, it is normal practice to reformulate the objective technical problem solved by the claimed invention with respect to the closest prior art during the different stages of the examination, opposition or appeal procedure, thereby taking into consideration the different features added to the claim during the procedure and the prior art at hand. Moreover, since different features of a claim may solve different partial objective problems with respect to the closest prior art, which do not need to be linked in any way with each other but may even relate to different technical areas, the addition of a feature which was originally disclosed and which modifies the objective technical problem to be solved by the claimed invention alone cannot give rise to an unallowable amendment

- 2.4 Therefore, since claim 1 according to the main request is directly and unambiguously derivable from the application as originally filed, it complies with the requirements of Article 123(2) EPC.

3. Since the decision of the opposition division dealt only with the Article 123(2) EPC, and since the appellant requested remittal to the first instance, should the main request be in compliance with Article 123(2) EPC, the Board considers it equitable to remit the case to the opposition division.

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 the Main Request filed at the oral proceedings.

The Registrar:

The Chairman:

V. Commare

T. Kriner