

**Internal distribution code:**

- (A) [ - ] Publication in OJ  
(B) [ - ] To Chairmen and Members  
(C) [ - ] To Chairmen  
(D) [ X ] No distribution

**Datasheet for the decision  
of 15 September 2015**

**Case Number:** T 0085/14 - 3.2.02

**Application Number:** 07854640.5

**Publication Number:** 2083723

**IPC:** A61B17/72, A61B17/86

**Language of the proceedings:** EN

**Title of invention:**

INTRAMEDULLARY NAIL INCLUDING STABLE LOCKING BOLTS

**Patent Proprietor:**

Synthes GmbH

**Opponent:**

DMV Marketing+Vertriebs GmbH

**Headword:**

**Relevant legal provisions:**

EPC Art. 111(1), 113(1)

EPC R. 117

RPBA Art. 12(2), 12(4)

**Keyword:**

Taking of evidence - hearing witness

Taking of evidence - public prior use

Appeal decision -

remittal to the department of first instance (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern  
Boards of Appeal  
Chambres de recours**

European Patent Office  
D-80298 MUNICH  
GERMANY  
Tel. +49 (0) 89 2399-0  
Fax +49 (0) 89 2399-4465

Case Number: T 0085/14 - 3.2.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.02**  
**of 15 September 2015**

**Appellant:** DMV Marketing+Vertriebs GmbH  
(Opponent) Postfach 10 08  
85663 Hohenbrunn (DE)

**Representative:** Parker, Andrew James  
Meissner Bolte & Partner GbR  
Widenmayerstraße 47  
80538 München (DE)

**Respondent:** Synthes GmbH  
(Patent Proprietor) Eimattstrasse 3  
4436 Oberdorf (CH)

**Representative:** Lusuardi, Werther  
Dr. Lusuardi AG  
Kreuzbühlstrasse 8  
8008 Zürich (CH)

**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 14 October 2013  
rejecting the opposition filed against European  
patent No. 2083723 pursuant to  
Article 101(2) EPC.**

**Composition of the Board:**

**Chairman** E. Dufrasne  
**Members:** D. Ceccarelli  
C. Körber

## **Summary of Facts and Submissions**

- I. The opponent has appealed the Opposition Division's decision, dispatched on 14 October 2013, to reject the opposition against European patent No. 2 083 723.
- II. In particular, the Opposition Division decided to disregard the following documents filed with the notice of opposition:

- D1: "TriGen Stable-Lok Nut & Washer", Smith & Nephew;
- D2: "TriGen IM Nail System - Knee Nail for Retrograde Femoral Mode", T A Russell and R W Sanders, Smith & Nephew.

It held that in particular an affidavit by Mr Ferrante, a Vice President of one of the divisions of Smith & Nephew, did not prove that these documents were comprised in the state of the art. The prior use of the product to which D1 and D2 related, alleged in the affidavit, was disregarded as late-filed. Since the arguments presented in support of the opposition all depended on D1 or D2 being comprised in the state of the art, the grounds for opposition were not substantiated if these documents were not to be considered.

- III. The notice of appeal was received on 20 December 2013. The appeal fee was paid on the same day. The statement setting out the grounds of appeal was received on 24 February 2014.

With the statement of grounds the appellant filed a further document - D4 - allegedly providing a statement of sales of the TriGen Stable-Lok Nut and Washer as

disclosed in D1 and affidavits by Mr Krech, a Group Product Manager of one of the divisions of Smith & Nephew, and Mr Russell, an author of D2, in order to prove the prior art nature of D1 and D2 and the prior use of the product to which they related. It argued that D1 and D2, as well as the product to which they related, should be entered into the proceedings as prior art, if necessary after hearing as witnesses Mr Ferrante, Mr Krech and Mr Russell.

The appellant requested that the decision be set aside and the patent be revoked in its entirety or, in the alternative, that oral proceedings be held. It further requested that Mr Ferrante's affidavit be entered into the proceedings in full.

- IV. The respondent filed a reply to the statement of grounds with letter received on 3 July 2014.

It requested that the appeal be dismissed or, in the alternative, that the patent be maintained on the basis of one of the first to tenth auxiliary requests filed with the reply. In the event that the Board were to decide not to dismiss the appeal, the respondent requested oral proceedings.

- V. With communication dated 29 April 2015 the Board expressed its intention to remit the case to the department of first instance for further prosecution.

In response to the Board's communication both parties withdrew their requests for oral proceedings on condition that it was decided to remit the case.

VI. Claim 1 of the patent as granted reads as follows:

"A device for securing an intramedullary implant (11) within a bone (14), comprising a bolt (1;6) having a first portion extending proximally from a distal end (3) of the bolt and a second portion extending proximally from a proximal end (4) of the first portion to a proximal end (7) of the bolt (1;6), the length of the bolt being selected to substantially match a thickness of a portion of bone through which it is to be inserted and the length of the second portion being selected to substantially equal the distance from a point on an outer surface of the bone through which the bolt is to be inserted into the bone to an outer surface of the implant so that, when the bolt is fully inserted into the bone, the distal end of the second portion abuts an outer surface of the implant; and wherein the second portion of the bolt (1;6) is provided with a substantially helical exterior thread (9), characterized in that the bolt (1;6) comprises a first elongate member (1) including a first thread (2) extending along an exterior thereof and - as said second portion - a second elongate member (6) including a lumen (16) extending therein from an opening in a distal end thereof, the lumen (16) including a second thread (10) extending along an inner wall thereof, the first and second threads (2,10) and the diameters of the first and second members (1,6) cooperating so that a proximal portion of the first member (1) is threadably coupleable within the lumen (16), a distal portion of the first member (1) extending distally beyond a distal end of the second member (6) to form the said first portion of the bolt (1;6)."

VII. The appellant's arguments may be summarised as follows:

D1 and D2 were commercial brochures each bearing a production date anterior to the priority date of the patent. In the proceedings at first instance the appellant had already filed an affidavit by Mr Ferrante stating that D1 and D2 had been sent to prospective clients and that the product to which they related had been released on the market prior to the priority date of the patent. At the oral proceedings the Opposition Division decided that the affidavit was not sufficient to prove the publication date of D1 and D2 and refused a following request to hear Mr Ferrante as a witness.

However, Mr Ferrante's statement in the affidavit was quite clear, and the appellant had been taken by surprise when told for the first time at the oral proceedings that the affidavit did not prove the relevant prior art nature of D1 and D2. The affidavit had then become central to the appellant's case, so the request to hear Mr Ferrante himself as a witness should have been admitted.

Moreover, since establishing the prior art nature of D1 and D2, and the product to which they related, was crucial for the appellant's case, D4 and the affidavits presented with the statement of grounds should be duly considered, or, at least, the requests to hear Mr Krech and Mr Russels as witnesses should be admitted.

VIII. The respondent's arguments may be summarised as follows:

Neither the affidavits nor document D4 provided a basis for the alleged dating of D1 and D2 and the product to which they related. Moreover, the affidavits by

Mr Krech and Mr Russell were late-filed.

### **Reasons for the Decision**

1. The appeal is admissible.
2. The claimed invention relates to a device for securing an intramedullary implant within a bone.

Intramedullary implants are used in the treatment of fractures of bone shafts. Generally, they are in the form of nails to be introduced within the intramedullary canal on the fractured bone to stabilise it. As also stated in the description of the patent (paragraph [0002]), some intramedullary nails include holes close to their ends, through which locking bolts can be inserted, perpendicularly to the nail, "to improve the rotational stability of the fracture and to avoid undesirable bone shortening at the fracture site".

The claimed device includes such a bolt comprising a first elongate member with an external thread and a second elongate member with a lumen including an internal thread, such that a portion of the first elongate member can be screwed inside the lumen of the second elongate member. As a consequence, the resulting length of the bolt can be adjusted according to the specific need.

3. D1 and D2 are commercial brochures relating to a similar device for securing an intramedullary implant, comprising a two-part bolt, made up of two threaded elongate members which can be screwed one into the



other.

If it was established that these documents and/or the product to which they relate belonged to the state of the art, their technical disclosure would appear prima facie relevant for an assessment of novelty and inventive step of the subject-matter of claim 1 of the patent as granted.

4. In the impugned decision, the Opposition Division held that it was unproven that D1 and D2 belonged to the state of the art.

In particular, it considered that Mr Ferrante's affidavit did not provide clear and unambiguous evidence that this was the case, and decided not to summon him to give oral evidence.

5. In the statement of grounds, in compliance with Rule 117 EPC, the appellant formally requested to hear Mr Ferrante, Mr Krech and Mr Russell as witnesses about the availability to the public of documents D1 and D2 and the products to which they relate.

The Board considers at least the request to hear Mr Krech and Mr Russell as a justified reaction to the Opposition Division's finding in the impugned decision, which could not have been reasonably presented at first instance. In view of Article 12(2) and (4) RPBA, this request is therefore admissible.

As explained above, establishing whether D1 and D2 and the product to which they relate belong to the state of the art for the claimed invention can be crucial for an assessment of novelty and inventive step, which was not carried out by the Opposition Division.

Moreover, for that purpose, the appellant's written submissions in the form of affidavits alone cannot be as detailed as an oral testimony, especially as far as the features of the product are concerned.

Therefore, the Board concludes that it is necessary to hear those witnesses for compliance with Article 113(1) EPC.

In order to further clarify any possible outstanding points, and considering that a summons to give evidence will have to be issued anyway, the Board also admits the request to hear Mr Ferrante, even though it was not admitted at first instance (Article 12(4) RPBA). Under these circumstances it is not necessary for the Board to decide on the appellant's request to enter Mr Ferrante's affidavit into the proceedings in full.

Hence, Mr Krech, Mr Russell and Mr Ferrante should be summoned to give oral evidence before the Opposition Division, so that it can be established whether D1 and D2 and the product to which they relate belong to the state of the art.

6. Depending on the outcome of the oral testimony, a new assessment of novelty and inventive step of the claimed invention, not yet performed at first instance, might have to be carried out.

Under Article 111(1) EPC it is left to the Board's discretion to either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.

Under the present circumstances the Boards finds it appropriate to remit the case in order for the parties to have the outstanding matters examined by two degrees of jurisdiction.

## 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.

The Registrar:

The Chairman:



D. Hampe

E. Dufrasne

Decision electronically authenticated