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**Datasheet for the decision
of 28 February 2019**

Case Number: T 1582/17 - 3.2.08

Application Number: 09715869.5

Publication Number: 2259751

IPC: A61F2/32, A61F2/36, A61F2/00,
A61B19/00

Language of the proceedings: EN

Title of invention:

SYSTEM OF MAPPING FEMORAL HEAD FOR ACETABULAR PROSTHESIS
ALIGNMENT

Patent Proprietor:

Smith & Nephew, Inc.

Opponents:

DePuy International Ltd
Implantech Medizintechnik Ges.M.B.H.

Headword:

Relevant legal provisions:

EPC R. 99(2), 101(1)
EPC Art. 114(2), 100(b), 111(1)
RPBA Art. 12(4)

Keyword:

Admissibility of the appeal
Insufficiency of disclosure
Remittal to the opposition division

Decisions cited:

Catchword:



Beschwerdekammern

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Chambres de recours

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Case Number: T 1582/17 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 28 February 2019

Appellant:
(Patent Proprietor)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 15 May 2017
revoking European patent No. 2259751 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairwoman P. Acton
Members: M. Alvazzi Delfrate
 Y. Podbielski

Summary of Facts and Submissions

- I. The patent proprietor (appellant) lodged an appeal against the decision posted on 15 May 2017 by which the opposition division revoked European patent No. 2 259 751.
- II. In the appealed decision the opposition division found that the main request and auxiliary requests 1-4 then on file did not meet the requirements of sufficiency of disclosure (Articles 83 and 100(b) EPC). Auxiliary request 5 was not admitted into the proceedings. Auxiliary request 6 was found to contravene the requirements of Article 123(2) EPC (and, in an *obiter dictum*, also those of Article 84 EPC).
- III. At the oral proceedings before the Board of Appeal, held on 28 February 2019, the requests of the parties were as follows:

The appellant requested that the decision under appeal be set aside and the patent be maintained as granted (main request) or, as an auxiliary measure, that the patent be maintained on the basis of one of auxiliary requests 1-8 filed with the grounds of appeal on 22 September 2017. The appellant also requested that the case be remitted to the opposition division for further prosecution should any of the requests be held to comply with the requirements of Article 83 EPC.

Respondent 1 (Opponent 1) requested that the appeal be held inadmissible. Respondent 1 and respondent 2 (Opponent 2) requested that the appeal be dismissed. Respondents 1 and 2 requested that the case not be remitted to the opposition division, but that the Board decide on the remaining grounds of opposition should

any of the requests be held to comply with the requirements of Article 83 EPC.

IV. Claim 1 of the **main request** reads as follows:

"An apparatus for orienting a prosthetic femoral head relative to an acetabulum, comprising:

a. a femoral stem (10,100) configured to be received within the intramedullary canal of a femur; and

b. a femoral head member (20,200) configured to couple to the femoral stem and further configured to be received in the acetabulum, the femoral head member further comprising an indicia,

characterised in that the indicia is configured to orient a relative position of the prosthetic femoral head to the acetabulum such that the indicia signifies proper relative position of the prosthetic femoral head in the acetabulum."

V. The following document played a role in the present decision:

A1: declaration of C. Allen (with CV).

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

Admissibility of the appeal

The statement of grounds of appeal explained in detail why the claimed invention was sufficiently disclosed. It referred to the incorrect parts of the decision under appeal, the relevant passages of the patent and

the common general knowledge of the person skilled in the art. Thus, it enabled the Board and the respondents to understand why and on the basis of which facts the decision of the opposition division was incorrect. Therefore, the appeal was admissible.

Admission of A1 into the proceedings

The submission of A1 with the statement of grounds of appeal was to be considered a reaction to the decision of the opposition division. This document was relevant because Mr. Allen, being one of the few experts in the field, could provide evidence of the common general knowledge of the person skilled in the art. It should thus be admitted into the proceedings.

Main request - sufficiency of disclosure

The claimed invention concerned an apparatus. The characterising part of the claim stipulated that the indicia had to be visible when the femoral head was in a proper position relative to an acetabulum, which could also comprise an acetabular cup. The natural acetabulum exhibited natural features which could be used as reference relative to the indicia for orienting the femoral head to its proper position. Since the anatomy of the natural acetabulum could vary, the configuration of the majority population was to be considered for this purpose. The surgeon could decide what was the proper position, if necessary by means of trial and error, as was standard in the art.

Thus, the scope of the claim could be determined by the person skilled in the art. Moreover, Figure 2 showed an embodiment of the claimed invention which could be put into practice without any difficulty.

Therefore, the patent sufficiently disclosed the invention of claim 1.

Remittal to the opposition division

Since the appealed decision dealt only with the ground of opposition under Article 100(b) EPC remittal to the opposition division to consider the other grounds raised in the opposition proceedings was appropriate. The efficiency of the overall proceedings was not an obstacle to the remittal since the present appeal proceedings had been dealt with in a timely manner.

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

Admissibility of the appeal

Although the statement of grounds of appeal was quite lengthy, it was not sufficient to understand the appellant's case without further investigations. It did neither explain why the decision was incorrect nor cite any relevant passage of the description. Moreover, it did not provide any evidence for the alleged common general knowledge. Therefore, the appellant's case on Article 83 EPC was not sufficiently substantiated and the appeal was not admissible.

Admission of A1 into the proceedings

There was no reason for the delay in the submission of A1, since a negative opinion of the opposition division in respect of Article 100(b) EPC was already present in the annex to the summons. Therefore, A1 should not be admitted into the appeal proceedings.

Moreover, A1 was not suitable as a proof of common general knowledge because it was a declaration of one of the co-inventors of the patent.

Hence, A1 should not be admitted into the proceedings.

Main request - sufficiency of disclosure

The patent in suit only disclosed the positioning of an acetabular component relative to a femoral head which had been previously located in a so-called "neutral position". Claim 1 by contrast did not mention any acetabular component, but only an acetabulum, which could only be a natural acetabulum. As a consequence, the patent did not disclose how to orient the femoral head relative to the natural acetabulum. Nor was it possible to perform the claimed orientation on the basis of the common general knowledge, since the anatomy of the acetabulum varied from patient to patient and the proper position was something that was decided in detail by the surgeon. Therefore, the limitation of claim 1 was not clear and it was not possible to carry out the invention.

As to the embodiment of Figure 2, it was still indicated to be in accordance with the invention merely because, although the application had been amended deleting the invention to which Figure 2 related, the description had not been adapted. In reality Figure 2 was not in accordance with claim 1, because other elements such as the femoral stem had to be acted upon in order to orientate the femoral head. Hence, Figure 2 did not provide a guidance to realise the invention of claim 1.

Hence, the claimed invention was not sufficiently disclosed.

Remittal to the opposition division

The Board should not remit the case but deal also with the grounds of opposition under Articles 100(c) and 100(a) EPC because the interpretation of the claim followed by the Board for considering Article 100(b) EPC played role also for novelty and inventive step. Moreover, remitting the case would be contrary to an efficient procedure.

Reasons for the Decision

1. Admissibility of the appeal

According to Rule 99(2) EPC the appellant shall indicate in the statement of grounds of appeal the reasons for setting aside the decision impugned, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based. If the appeal does not comply with this requirement, the Board of Appeal shall reject it as inadmissible (Rule 101(1) EPC).

In the present case the statement setting out the grounds of appeal extensively explain (over more than five pages) why, in the appellant's view, the claimed invention was, contrary to the findings of the opposition division, sufficiently disclosed. It is true that the length of a submission does not render it automatically relevant. However, the statement setting out the grounds of appeal is not only extensive but addresses specifically the points of the appealed decision which, in the appellant's view, were not

correct (see, as far as the main request is concerned, points 3.15, 3.17, 3.21 to 3.23 of the statement of grounds). Moreover, it describes what is considered to represent the common general knowledge to be considered for the sufficiency of disclosure and refers to some passages of the description which in the appellant's view are relevant in this respect.

In summary, the submissions presented in the statement of grounds of appeal enabled the Board to understand why the decision is alleged to be incorrect, and on what facts the appellant bases its arguments, without first having to make investigations of its own.

Whether or not the common general knowledge and the cited passages of the description are indeed sufficient to carry out the invention or whether the common general knowledge is considered as established is part of the examination of the merits of the appeal and not of its admissibility.

Therefore, the appeal is admissible.

2. Admission of A1 into the proceedings

Document A1 was submitted for the first time together with the statement setting out the grounds of appeal. Hence, it was late-filed and its admission into the proceedings was at the discretion of the Board (Article 114(2) EPC and Article 12(4) RPBA).

A1 is intended to represent evidence of the common general knowledge, in order to counter the attack of insufficiency of disclosure. This attack was already raised at the beginning of the opposition proceedings. Moreover, the opposition division, in the annex to the

summons issued some 8 months prior to the oral proceedings gave a provisional opinion according to which the invention did not seem to be sufficiently disclosed. Hence, A1 could and should have been submitted in opposition without waiting for the decision of the opposition division.

Moreover, a declaration of one of the co-inventors of the patent, i.e. somebody whose knowledge of the claimed invention is not limited to the disclosure of the patent, is unsuitable to prove that the person skilled in the art would be able to carry out the invention only on the basis of the disclosure of the patent and his common general knowledge. Thus, A1 lacks also *prima facie* relevance.

Under these circumstances, the Board decided not to admit A1 into the proceedings.

3. Main request - sufficiency of disclosure

3.1 The invention of claim 1 does not concern a method but an apparatus. Therefore, in order to carry out the invention it is not necessary to actually "orient a relative position of the prosthetic femoral head to the acetabulum such that the indicia signifies proper relative position of the prosthetic femoral head in the acetabulum". What is necessary instead is to produce a device according to the claim.

3.2 It is undisputed that the person skilled in the art could produce without difficulty a femoral stem configured to be received within the intramedullary canal of a femur and a femoral head member configured to couple to the femoral stem and further configured to

be received in the acetabulum, the femoral head member further comprising indicia.

The contentious issue is whether, on the basis of the information in the patent in suit and his common general knowledge, the person skilled in the art would be able to produce a device wherein the indicia "is configured to orient a relative position of the prosthetic femoral head to the acetabulum such that the indicia signifies proper relative position of the prosthetic femoral head in the acetabulum". To answer this question it is necessary to consider which product limitation, if any, is defined by this wording.

3.3 First of all the Board shares the respondents' view that the acetabulum mentioned in claim 1 and relative to which the femoral head has to be oriented can only be the natural acetabulum. This is made clear by the fact that an acetabulum component (or acetabulum cup), which is a prosthetic component, is introduced in claim 2.

The claim does also not define the anatomy of the acetabulum, which may vary from patient to patient (see paragraph [0076] of the patent). Hence, contrary to the appellant's view, it is not limited to the configuration of the majority population but covers the orientation in relation to any possible acetabulum.

Moreover, as agreed by the parties, the precise "proper relative position" is a decision of the surgeon in the particular case. For instance the proper positions considered in Figure 3 and 7a-7b are different (see also column 8, lines 46-48 and column 10, lines 46-48). Hence, since the claim does not define which of the various possibilities is to be

understood as "proper relative position" for the claimed device, the claim covers all the positions that may be regarded as "proper relative position" by a surgeon.

Therefore, the limitation expressed in the characterising portion of the claim is vague (due to the reference to an acetabulum of unspecified anatomy and to an undefined "proper relative position") and extremely broad. The vagueness and the breadth of this definition are a matter of clarity and possibly of support by the description (Article 84 EPC), and affect the assessment of novelty. Since claim 1 of the main request is the claim as granted, its clarity cannot be examined in opposition/appeal proceedings, but could only have been considered in the examination proceedings.

For the examination of the ground of opposition under Article 100(b) EPC the vagueness has to be lived with and the claim has to be interpreted. For the reasons given above, the only possible limitation which can be seen in the characterising portion of the claim is that the indicia must be visible in a position which may be regarded as a proper position relative to an acetabulum for at least one patient. In other words, the only indicia excluded by the claim are those visible only in positions which no surgeon could possibly consider as a proper position for any possible anatomy of an acetabulum.

There is no evidence that, also in the absence of detailed instructions in the patent, it would be problematic for the person skilled in the art to realise indicia of that type. Indeed, Figure 2, showing a femoral head with indicia which undisputedly can be

produced by the person skilled in the art without problems, relates, according to the first sentence of paragraph [0047], to a femoral head in agreement with the claimed invention.

The patent comprises only one independent claim, which corresponds to the sole independent product claim of the application as filed. Hence, there is no reason to assume, as submitted by the respondents, that the statement in paragraph [0047], and with it the embodiment shown in Figure 2, does not relate to the presently claimed invention.

The fact that other components, such as the femoral stem, have to be acted upon in order to orientate the femoral head does not lead to a different conclusion, because an action on these other components is not excluded by the claim. Hence, at least on the basis of Figure 2 the person skilled in the art would be able to carry out the claimed invention.

Therefore, the patent discloses the invention of claim 1 in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

4. Remittal to the opposition division

In the decision which is the subject of the present appeal the opposition division considered only the ground of opposition under Article 100(b) EPC. The other grounds of opposition raised in the opposition proceedings (Articles 100(c) and 100(a) EPC) were not decided upon.

It is true that the interpretation of the claim (which is made available to the parties and the opposition

division with the present decision) may play a role also for the assessment of novelty and inventive step. However, a decision in respect of Articles 100(c) and 100(a) EPC is not limited to the interpretation of the claim but involves also assessing the disclosure of the application as filed and the prior art, which in the present case comprises seventeen allegedly novelty-destroying documents. None of this has been considered in the decision of the opposition division.

As to the efficiency of the whole proceedings, the Board points out that the present appeal proceedings (for which no acceleration was requested) have been dealt with in a timely manner (the statement of grounds of appeal having been filed on 22 September 2017), so that no unusual delay is caused by a remittal.

Under these circumstances the Board considers it appropriate, in line with the primary object of the appeal proceedings to review the decision under appeal in a judicial manner, to remit the case to the opposition division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairwoman:



I. Aperribay

P. Acton

Decision electronically authenticated