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**Datasheet for the decision
of 14 November 2023**

Case Number: T 2881/19 - 3.2.01

Application Number: 15201538.4

Publication Number: 3025680

IPC: A61F2/24

Language of the proceedings: EN

Title of invention:

COLLAPSIBLE AND RE-EXPANDABLE PROSTHETIC HEART VALVE CUFF
DESIGNS AND COMPLEMENTARY TECHNOLOGICAL APPLICATIONS

Patent Proprietor:

St. Jude Medical, LLC

Opponents:

1. Boston Scientific Corporation
2. Symetis SA
3. Edwards Lifesciences Corporation
4. BIOTRONIK AG

Headword:

Relevant legal provisions:

EPC Art. 76(1)

Keyword:

Divisional application - subject-matter extends beyond content of earlier application (yes)

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 2881/19 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 14 November 2023

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 13 August 2019
revoking European patent No. 3025680 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman G. Pricolo
Members: V. Vinci
O. Loizou

Summary of Facts and Submissions

- I. The appeal was filed by the patent proprietor against the decision of the opposition division to revoke the European patent N°3 025 680. The contested patent is based on the European patent application N° 15 201 538.4 filed as a divisional application of the parent international application WO 2010/008548 (D1b).

In the decision under appeal the opposition division found that the ground for opposition under Article 100(c) in combination with Article 76(1) EPC prejudiced the maintenance of the patent as granted. Furthermore, the opposition division found that also the auxiliary request 1 filed during oral proceedings did not fulfil the requirements of Article 76(1) EPC and decided not to admit the late filed auxiliary request 2.

- II. With the communication pursuant to Article 15(1) RPBA dated 20 June 2023, the Board informed the parties of its preliminary, non-binding assessment of the case according to which the appeal was likely to be dismissed.

Oral proceedings pursuant to Article 116 EPC were held before the Board on 14 November 2023.

- III. The appellant (patent proprietor) requested that the decision of the opposition division be set aside and the patent be maintained as granted (main request) or, in the alternative, that the patent be maintained in amended form according to one of the auxiliary requests 1a, 1b, 1c and 2 to 13 filed with the statement of grounds of appeal. Should the Board find any request to be compliant with Articles 76(1) and 123(2) EPC the

appellant (patent proprietor) requested the remittal of the case to the opposition division for assessing novelty and inventive step.

The respondents 1 to 3 (opponents 1 to 3) requested that the appeal be dismissed. Respondents 1 and 2 (opponents 1 and 2) further requested that the auxiliary requests 1c and 2 to 13 not be admitted. Respondent 3 (opponent 3) requested that the auxiliary requests 1a, 1c and 2 not be admitted.

The opponent 4 (party as of right) did not attend the oral proceedings as announced with letter dated 7 July 2023.

- IV. Independent claim 1 as granted as well as the identical claim 1 according to the auxiliary requests 1a and 3 to 13 contains in particular feature F3.4 reading:

"...the first wall extends distally beyond the second wall."

In independent claim 1 according to the auxiliary requests 1b and 1c, feature F3.4 of independent claim 1 as granted has been amended to read (emphasis added):

"...the first wall extending distally beyond the at least one second wall."

In independent claim 1 according to the auxiliary request 2, feature F3.4 of independent claim 1 as granted has been amended to read (emphasis added):

"...the first wall extending distally beyond the second walls."

Reasons for the Decision

MAIN REQUEST - PATENT AS GRANTED

1. The patent as granted does not meet the requirements of Article 76(1) EPC as correctly found by the opposition division in the decision under appeal.

1.1 It is uncontested that feature F3.4 of independent claim 1 as granted reading

"...the first wall extends distally beyond the second wall."

is not literally disclosed in the parent application as originally filed.

1.2 The appellant (patent proprietor) asserted that according to established case law of the Boards of Appeal it is in principle possible to extract features from the figures and introduce them in the claims. It was argued that the claimed relative arrangement of the first and second walls of the prosthetic heart valve recited in feature F3.4 of independent claim 1 as granted was directly and unambiguously derivable from Figure 10 of the international parent application as filed (D1b), and this despite the poor quality of the image provided and of the viewing angle under which the prosthetic heart valve was displayed.

1.3 The Board does not agree for the following reasons:

1.4 First of all, the Board has no doubt that the expression *"extends distally beyond"* refers to the extension of the walls in the longitudinal direction of

the prosthetic valve, i.e from the proximal to the distal end thereof, whereby feature F3.4 requires an overlapping of the first and second walls in said direction. This is confirmed by the wording of antecedent feature F1.1 as correctly observed by the opposition division in the contested decision (see point 3.4). This interpretation was not longer contested during the oral proceedings.

- 1.5 The Board agrees with the appellant (patent proprietor) that it is in principle not prohibited to amend the claims on the basis of information presented in the originally filed figures. However, as in this case, it is, in order to comply with the provisions of Articles 76(1) and 123(2) EPC, mandatorily required that the amendment at stake is directly and unambiguously derivable for the person skilled in the art from the original disclosure (so called "*gold standard*"). In absence of any hint in the whole parent application as filed (D1b) and in particular in paragraph [0070] describing the specific embodiment of Figure 10 which was cited as basis for the amendments in claim 1, pointing to the claimed relative arrangement of the first and second wall and/or to any technical effect linked thereto, the Board, in agreement with the opposition division and the respondents (opponents), does not see how it can be directly and unambiguously derived from the grossly unclear representation in Figure 10 that in the prosthetic heart valve according to the contested patent the first wall purposively extends distally beyond the second wall. The requirement of a "*direct and unambiguous*" disclosure in the originally filed parent application which has to be met in order for an amendment to comply with Article 76(1) EPC is not fulfilled.

AUXILIARY REQUESTS

2. The same issue applies for the same reasons to the identical independent claim 1 of the auxiliary requests 1a and 3 to 13. Regarding auxiliary requests 1b, 1c and 2, the Board is the opinion that the amendments introduced in feature F3.4 of the respective independent claim 1 do not overcome the objection raised above under Article 76(1) EPC against claim 1 of the main request. This has not been contested by the appellant (patent proprietor) as they did not submit any further comments at the oral proceedings in this regard.

3. In conclusion, irrespective of the admissibility issues and of the further objections raised by the respondents (opponents), none of the requests filed in appeal by the appellant (patent proprietor) meets the requirements of Article 76(1) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



A. Voyé

G. Pricolo

Decision electronically authenticated