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**Datasheet for the decision
of 9 March 2023**

Case Number: T 0450/20 - 3.2.02

Application Number: 09711843.4

Publication Number: 2254485

IPC: A61B17/22

Language of the proceedings: EN

Title of invention:
APPARATUS FOR FLOW RESTORATION

Patent Proprietor:
Covidien LP

Opponent:
Phenox GmbH

Headword:

Relevant legal provisions:

EPC Art. 54, 112
RPBA 2020 Art. 13(2)
EPC R. 124

Keyword:

Novelty - main request (no) - auxiliary requests (no)
Claim interpretation in the light of the description (yes)
Referral to the Enlarged Board of Appeal - (no)
Amendment after summons - exceptional circumstances (no)
Minutes of oral proceedings - request to record statement in
the minutes (refused)

Decisions cited:

G 0001/12, R 0007/17, R 0019/11, T 0212/97, T 0642/97,
T 1721/07, T 0263/05, T 0468/99, T 1646/12, T 1354/18,
T 1473/19, T 1891/20

Catchword:

Under Article 69(1) EPC the description and the drawings can only be used for interpreting features which are already present in the claims, but not for adding further - positive or negative - claim features or for replacing existing claim features by others (Reasons 2.15). The application as filed usually cannot provide guidance for interpreting the claims of the patent as granted (Reasons 2.16). A board of appeal is not limited to the claim interpretations advanced by the parties but may also adopt a claim interpretation of its own (Reasons 3.4.2). Relying on documentary evidence is not a precondition for the adoption of a certain claim interpretation by a board of appeal (Reasons 3.4.3).



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Case Number: T 0450/20 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 9 March 2023

Appellant:

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 13 December
2019 rejecting the opposition filed against
European patent No. 2254485 pursuant to Article
101(2) EPC.**

Composition of the Board:

Chair

M. Alvazzi Delfrate

Members:

S. Böttcher

N. Obrovski

Summary of Facts and Submissions

- I. The opponent filed an appeal against the decision of the opposition division to reject the opposition against European patent No. 2 254 485.

- II. In order to help the parties to concentrate on essential points during the oral proceedings, the board issued a communication under Article 15(1) RPBA 2020, in which it indicated its preliminary opinion that the subject-matter of claim 1 of all claim requests lacked novelty over D4. Oral proceedings before the board took place on 9 March 2023. In those oral proceedings, the case T 1494/21 relating to European patent No. 3 266 391 was also heard (joint hearing).

- III. The opponent (appellant) requested that the decision under appeal be set aside and the patent be revoked.

The patent proprietor (respondent) requested that the appeal be dismissed and the patent be maintained as granted (main request) or, alternatively, that the patent be maintained on the basis of auxiliary request 1a filed during the oral proceedings or on the basis of one of auxiliary requests 1 to 3 filed with the reply to the statement of grounds of appeal. The patent proprietor withdrew its request that document D10 should not be admitted into the appeal proceedings.

- IV. By letter of 29 March 2023 the respondent requested that the minutes of the oral proceedings be amended. The appellant replied to this request by letter of 21 April 2023.

V. The following documents are relevant to the present decision.

D3 US 2003/0212430

D4 US 2005/0209678

D6 US 2006/0058836

D7 EP 1 437 097

D8 US 6,514,273

D9 US 2007/0208367

D10 H. Henkes et al., "A Novel Microcatheter-Delivered, Highly-Flexible and Fully-Retrievable Stent, Specifically Designed for Intracranial Use", *Interventional Neuroradiology* 9: 391-393, 2003

D11 US 6,458,139

D12 US 2005/0267491

D13 A. Doerfler et al., "A Novel Flexible, Retrievable Endovascular Stent System for Small Vessel Anatomy: Preliminary In Vivo Data", *AJNR Am J Neuroradiol* 26: 862-868, 2005

VI. Claim 1 of the patent as granted (main request) reads as follows.

"A self-expandable apparatus for removal of a thrombus in a blood vessel, comprising:
a push or guide wire (7);
a mesh structure comprising a first plurality of mesh cells, the mesh structure having a proximal end (3) and a distal end (2) wherein said distal end (2) of the mesh structure is configured to engage at least a portion of the thrombus to form a removable, integrated apparatus-thrombus mass;
a tapering portion comprising a second plurality of mesh cells, the tapering portion disposed toward the proximal end (3) of the mesh structure; and
a connection point (9), at which the tapering portion

converges, located at a proximal end (3) of the tapering portion, the tapering portion permanently attached to the push or guide wire (7) at or adjacent to the connection point (9); wherein the apparatus is pre-formed to assume a volume-enlarged form and, in the volume-enlarged form, takes the form of a longitudinally open tube tapering toward the connection point (9)."

VII. Claim 1 of auxiliary request 1a is based on claim 1 of the main request and further includes the term

"not releasably"

after the term "permanently".

VIII. Claim 1 of auxiliary request 1 is based on claim 1 of the main request and further includes the feature

"wherein further at least a portion of the mesh structure is expandable into penetrating contact with the thrombus, exerting an outward radial force on the thrombus, reducing the cross-sectional area of the thrombus and establishing blood flow through the blood vessel past the thrombus".

IX. Claim 1 of auxiliary request 2 is based on claim 1 of the main request and further includes the feature

"wherein further the apparatus is deliverable to a site that is radially adjacent to the thrombus by a microcatheter (8) having a distal tip (16) that is placeable beyond the distal end of the thrombus".

X. Claim 1 of auxiliary request 3 is based on claim 1 of the main request and further includes the feature

"of interconnected strings or filaments or struts"

after the term "a mesh structure".

XI. The appellant's arguments relevant to the present decision can be summarised as follows.

Main request - novelty in view of D4

The discussion of whether or not D4 was novelty-destroying for the subject-matter of claim 1 focused on the question of whether D4 disclosed a permanent attachment of the tapering portion to the push or guide wire. It was undisputed that the remaining features of claim 1 were disclosed in D4.

The present patent did not include a definition of the term "permanent attachment", which was used only one single time (column 5, lines 17 to 18) without any further explanations.

The device of D4 was suitable for removal of a thrombus in a blood vessel, as acknowledged by the present patent (paragraph [0002], column 5, lines 18 to 22, paragraph [0032]). In order to be used for this purpose, the guide wire had to be permanently attached to the implant such that tractive and shear forces could be transmitted. If this were not the case, it would not be possible to move the device of D4 back into the catheter, as mentioned in paragraphs [0009] and [0013].

The fact that the device of D4 was suitable to be used for thrombus removal was also disclosed in D10 (Figures 1 to 3). D10 mentioned that, for this purpose, the

stent was firmly attached to its delivery system (page 393, left column, last paragraph).

The connection between the guide or push wire and the mesh structure according to D4 could be detached by applying electrical energy to an electrolytically corrodible separating element (paragraph [0016]). Paragraph [0058] mentioned steel - which was clearly a permanent material - as being suitable for the separating element. Releasing this attachment required additional measures and equipment, in particular a power source and an electrode, which was to be placed on the surface of the body. Hence, the connection between the guide wire and the stent of D4 was permanent for as long as these additional measures were not taken and no electric current was applied to the connection. When using a device as claimed or as described in D4 for removal of a thrombus it was not necessary to connect a power source for electric current to the separating element or to place an electrode on the surface of the body. Hence, during the whole procedure of thrombus removal the connection between the guide wire and the device would be unaffected and would remain intact. Therefore, the connection had to be considered to be permanent.

Although a connection might, in principle, be destructible, it could still be regarded as a permanent connection. Hence, "permanent" could not be regarded as contrary to "releasable".

Even in the patent in suit it was pointed out, in paragraphs [0030] and [0031], that the connection between the push wire and the distal segment might be released if it were determined that removal from the patient was not possible. Furthermore, paragraph [0010]

of the patent referred to Figures 10 to 12 showing embodiments with a releasable guide wire. Hence, the invention also covered releasable connections.

In summary, claim 1 was not novel in view of D4.

Referral of questions to the Enlarged board of Appeal

Contrary to the appellant's allegation, it was not true that the appellant had not provided any evidence in support of its claim interpretation. Reference had been made, for example, to the description of the patent or D4. In any case, the questions formulated by the appellant concerned the interpretation of technical features of claim 1 of the specific patent in suit. These questions did not concern a point of law of fundamental importance and it was not necessary to answer them in order to ensure uniform application of law.

The interpretation of claim features formed part of the standard tasks of a board of appeal, and it was also a standard situation that a board might deviate in its claim interpretation from that of the department of first instance.

Therefore, the request for referral of the questions to the Enlarged board of Appeal had to be rejected.

Auxiliary request 1a - admittance

Auxiliary request 1a, which had been filed during the oral proceedings before the board, should not be admitted into the appeal proceedings since there were no exceptional circumstances justifying its late filing.

The argument that a releasable connection could be regarded as permanent had already been put forward during the opposition proceedings.

Furthermore, in the statement of grounds of appeal (pages 8 and 9), it had already been mentioned that paragraphs [0030] and [0031] of the patent referred to an embodiment according to the invention in which the connection between the guide wire and the mesh structure was releasable.

Hence, the request could and should have been filed earlier in the proceedings.

Auxiliary requests - novelty in view of D4

As previously discussed in detail and as acknowledged in the patent in suit itself, the device of D4 was suitable for the purpose of the apparatus in the present case. The apparatus of D4 and the apparatus of the patent in suit were structurally identical. Hence, since claim 1 of the main request was not new in view of D4, the same held automatically for claim 1 of auxiliary requests 1 and 2.

Request for amendment of minutes of oral proceedings

The request of the respondent should be rejected because

1) it was not in line with the opponent's recollection, and because

2) barring errors arising, neither party should influence the board, after the hearing, in deciding

what should, or should not, be part of the minutes.

The request by the patent proprietor did not correspond to the opponent's recollection. After the chair had announced the board's conclusion that the subject-matter of claim 1 of the main request was not new in view of D4, the representative of the proprietor asked for an explanation of the decision. However, this was not done to ensure that the decision was not based on new facts and arguments that were not part of the proceedings or to ensure that the right to be heard was not violated. Instead, the question was raised as to whether the decision was based on arguments allegedly presented in the oral proceedings for the first time. This was different from ensuring the right to be heard because, even if an argument had been presented in the oral proceedings for the first time (which was not the case), the patent proprietor would have had the opportunity to comment thereon. Consequently, after an interruption of the proceedings and deliberation, the chair announced that it was not necessary to explain the basis for the decision at that time, but pointed out that paragraph [0010] of the patent had not been of particular importance for the decision and that it was the view of the board that a release mechanism was not inconsistent with a permanent attachment. Anyway, paragraph [0010], as well as several other parts of the patent, and D4 had been discussed at length in written submissions of the parties and in the oral proceedings; hence, this was not a question of Article 113 EPC. The board had given both parties ample time to present their comments.

According to Rule 124 EPC and also in accordance with Article 6(4) RPBA, the preparation of the minutes should be the responsibility of the board, not the

responsibility of the parties, let alone one of the parties. Submissions of the parties were not typically summarised in the minutes but in the written decision (T 1721/07). The minutes did not seem to include any errors and the question of which statement by each of the parties should be included in the minutes was left to the discretion of the board. The board should not be influenced by either party's post-hearing request - that would subvert the fairness of the procedure. In particular, the request of the patent proprietor during the oral proceedings for an explanation of the reasons for the decision was not important for the decision itself.

XII. The respondent's arguments relevant to the present decision can be summarised as follows.

Main request - novelty in view of D4

D4 disclosed a medical implant that was introduced into the vasculature by a guide wire. Since the implant had to stay inside the body of the patient, it was essential for the connection between the guide wire and the implant to be detachable (paragraphs [0020] and [0016]).

The literal meaning of "permanently attached" was that the parts were attached in a permanent manner, i.e. the attachment was configured to last forever without already including means for ending it. Unlike the releasable attachment of D4, a permanent attachment was not configured - if used for the intended purpose - to be released.

The person skilled in the art was aware of the distinction between permanent and releasable

attachments, as - in the technical field of treating blood vessels - releasable devices were known requiring means for disconnecting the treatment device (stent) from the positioning device (guide wire) (D4, D13) and, in contrast, permanently attached devices not comprising such disconnecting means (D3, D6, D7, D8, D9, D11, D12) were also known. Furthermore, the meaning of "attached" and different ways of attaching the treatment device to the positioning device were disclosed in D3 (paragraph [0059]) and in D9, distinguishing between permanent and releasable attachments (paragraphs [0026] and [0027]).

Moreover, using "permanently" together with "attached" only made sense if the term "permanently" further specified the properties of the attachment such that certain attachments were thereby excluded.

Also, the description of the present patent defined the terms "permanent" and "releasable" as mutually exclusive. In column 1, lines 33 to 35, it was stated that the connection in D4 was releasable, while the connection according to the invention was described as permanent in column 5, lines 16 to 18. Furthermore, the releasable connection shown in Figures 19a and 19b was disclaimed as not in accordance with the invention (column 15, lines 44 to 48). On page 7, lines 25 to 26, the patent application as originally filed distinguished between a permanent attachment and a non-permanent attachment, which included means for releasing the connection.

Figures 10, 11 and 12, referred to by the appellant, showed implantation methods which required the distal segment to be released from the guide wire on different occasions. However, such methods were not covered by

claim 1. Hence, the statement in paragraph [0010] that the drawings "illustrate exemplary embodiments of the invention" did not apply to these figures.

As a consequence, the person skilled in the art learned from the present patent as well as from the prior art that a permanent attachment could be distinguished from a non-permanent attachment by the way in which the attachment was achieved. If the device did not contain means for releasing the attachment, the attachment was configured to last forever and was therefore specified as being configured "permanently". However, if the connection contained means for releasing the attachment, such as in D4, the connection would last until the user activated the means for releasing the attachment, i.e. not necessarily forever. Therefore, this was not a permanent attachment, but a releasable attachment, which did not fall under claim 1.

Moreover, the person skilled in the art was aware that a permanent connection was more secure as it was mechanically more stable. The release mechanism of D4 weakened the connection and rendered the device less secure.

It could be derived from Figures 8a and 8b of D4 that the purpose of the separating element was to allow the stent to be detached from the guide wire. Therefore, the person skilled in the art would recognise that the attachment disclosed in D4 was not permanent. Moreover, the term "permanent" was not used in D4 for the connection between the stent and the guide wire.

Since D4 did not disclose that the tapering portion of the implant was permanently attached to the guide wire, the subject-matter of claim 1 was novel over D4.

Referral of questions to the Enlarged Board of Appeal

In order to ensure uniform application of the law, in particular in view of decision T 1473/19, it was requested that the following questions concerning claim interpretation be referred to the Enlarged Board of Appeal.

1. When interpreting a claim for assessing its compatibility with Article 54 EPC (Novelty) and the parties have presented (at least) two distinguishing alternatives, could the Board select one of these alternatives without any evidence?

2. In case that the originally filed application contained disclosure for two alternatives, the applicant selected one of the two alternatives to limit the claim and deleted the non-selected alternative to align the description with amended claims, is it a reasonable claim interpretation that the term used for the selected alternative is interpreted to cover also the non-selected alternative?

3. In case that neither the description nor the drawings of the granted patent contain support for one of the alternatives, would a prior art document of an unrelated applicant form evidence for the understanding of the person skilled in the art in the relevant technical field?

The phrase "two distinguishing alternatives" in question 1 meant two alternative claim interpretations. In the present case, claim 1 had seemingly been interpreted by the board on the basis of the wording of

the claim alone, without reference to the description. This contradicted T 1473/19. Moreover, the board's claim interpretation did not make sense, either technically or linguistically. Only the respondent's claim interpretation, but not the appellant's claim interpretation, had been supported by evidence in the form of prior-art documents. This prevented the board from deviating from the respondent's interpretation without relying on any evidence of its own. T 1473/19 also referred to using evidence in claim interpretation.

Auxiliary request 1a - admittance

Auxiliary request 1a was filed as a reaction to the appellant's argumentation, based on paragraph [0031] of the patent, that a releasable connection was covered by the present invention. The appellant had put forward this argument for the first time during the oral proceedings. The appellant had also interpreted paragraph [0031] of the patent specification differently in the oral proceedings before the board from its interpretation in the written proceedings.

The written submissions did not include any reasons as to why a releasable connection could be regarded as permanent. Hence, there were exceptional circumstances that justified the filing of auxiliary request 1a.

Auxiliary request 1 - novelty in view of D4

D4 did not teach an apparatus configured to interact with a thrombus in order to establish blood flow past a thrombus and to form a removable, integrated apparatus thrombus mass.

Hence, the subject-matter of claim 1 of auxiliary request 1 was novel in view of D4.

Auxiliary request 2 - novelty in view of D4

D4 did not teach an apparatus that was deliverable by a microcatheter in the manner claimed in claim 1 of auxiliary request 2.

Hence, the subject-matter of claim 1 of auxiliary request 2 was novel in view of D4.

Auxiliary request 3 - novelty in view of D4

No arguments were put forward by the respondent with regard to this issue.

Request to amend minutes of oral proceedings

According to Rule 124(1) EPC, the minutes of oral proceedings had to contain the essential points of the oral proceedings.

In the oral proceedings, after the chair had announced the board's conclusion that the subject-matter of claim 1 of EP 2 254 485 B1 was not new in view of D4, the respondent's representative asked the board to explain the basis for that decision. The representative explained the reason for that question as a precautionary measure in order to ensure that the decision was not based on new facts and arguments that were not part of the proceedings. He stated that, otherwise, there would be the danger that the right to be heard may be violated. The board interrupted the proceedings to deliberate on this question and subsequently announced that there was no need to

explain the basis for the decision at that time and that the decision was based on the subject-matter submitted with the briefs and discussed in the oral proceedings.

Since that discussion between the board and the respondent's representative was considered to be an essential part of the proceedings, the following section should be added in the minutes after the paragraph containing the announcement that claim 1 of the main request was not new:

"The patent proprietor asked the board to indicate the reason for this conclusion in order to prevent the decision from containing new considerations on which the parties were not heard. After deliberation, the board asserted that the decision is based solely on the parties' submissions, but did not explain the reasons for the decision."

Reasons for the Decision

1. The patent

The claimed subject-matter relates to an apparatus for restoring blood flow in occluded blood vessels, particularly occluded cerebral arteries. The apparatus (shown in Figure 1 of the patent, reproduced below) is self-expandable and comprises a push or guide wire (7) and a mesh structure. The mesh structure has a proximal end (3) and a distal end (2) and a tapering portion disposed toward the proximal end. The distal end (2) is configured to engage at least a portion of the thrombus to form a removable, integrated apparatus-thrombus

mass. The apparatus further comprises a connection point (9) located at the proximal end of the tapering portion. The tapering portion is permanently attached to the wire (7) at or adjacent to the connection point. The apparatus is pre-formed to assume a volume enlarged form in which it takes the form of a longitudinally open tube tapering toward the connection point.

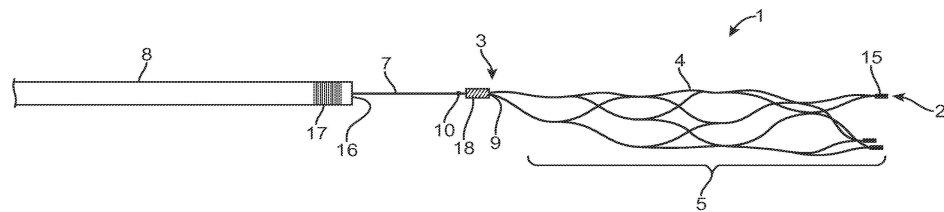


FIG. 1

- 2. Main request (patent as granted) - novelty in view of D4
 - 2.1 It is undisputed that D4 discloses a mesh structure forming a medical implant (stent) 1 with a tapering portion that is connected to a guide wire 21 (Figure 5), and that the mesh structure is suitable to engage at least a portion of the thrombus to form a removable, integrated apparatus-thrombus mass. It is mentioned in paragraphs [0014] and [0032] of the present patent that the apparatus of US 7,300,458, which is the granted patent to published application D4, may be employed for the methods described in the patent.
 - 2.2 As acknowledged by both parties, the discussion of whether or not D4 is novelty-destroying for the subject-matter of claim 1 solely concerns the question of whether D4 discloses a tapering portion of the implant 1 which is "permanently attached" to the push or guide wire 21, in particular in view of the fact

that in the apparatus according to D4 the implant can be detached from the push or guide wire.

- 2.3 According to the established case law, patent claims must be interpreted through the eyes of the person skilled in the art, who should try - with synthetical propensity - to arrive at an interpretation of the claim which is technically meaningful and takes into account the whole disclosure of the patent (see Case Law of the Boards of Appeal, 10th edition 2022, II.A. 6.1, first paragraph).
- 2.4 In the present case, both parties took the description of the patent into account to arrive at their differing interpretations of the expression "permanently attached". This is in line with the approach taken by the present board in a different composition in decision T 1473/19, Reasons 3.15, according to which the principles of claim interpretation as set out in Article 69 EPC and Article 1 of the Protocol on the Interpretation of this provision are to be applied in proceedings before the EPO.
- 2.5 Claim 1 itself neither defines nor specifies the term "permanently attached" further, either in terms of constructional features or in terms of the conditions under which the attachment is maintained. This matters insofar as the primacy of the claims under Article 69(1), first sentence, EPC, limits the extent to which the meaning of a certain claim feature may be affected by the description and the drawings (T 1473/19, Reasons 3.16.1).
- 2.6 Having said this, Article 69(1), second sentence, EPC, requires that the description and the drawings be taken into account when interpreting a patent claim. In the

present case, the description of the patent does not provide a definition of the term "permanently attached" either. The Board understands a definition as a statement which explains the meaning of a term used in the patent in a lexicographic and general manner (i.e. not only in the context of a certain embodiment), for example by specifying necessary and sufficient conditions for when that term should be used. In the description, reference to the feature "permanently attached" is only made in paragraph [0014] (column 5, lines 17 to 18) thereof: "In one embodiment, the distal segment 1 has a tapering structure at its proximal end 3 where the strings or filaments or struts converge at a connection point 9. The push wire 7 is preferably attached at or adjacent to the connection point 9. Such attachment 10 is permanent in accordance with the invention."

2.7 In the board's view, the person skilled in the art understands the term "permanently" in claim 1 as characterising the attachment of the tapering portion of the implant to the push or guide wire with regard to how long this attachment will last. Therefore, this feature is arguably limiting to the extent that it requires the attachment to last a certain amount of time. However, as explained above, the required duration or durability of the attachment is not specified further anywhere in the patent, either in the claims or in the description.

2.8 The respondent argued that an attachment was only permanent within the meaning of claim 1 if it was configured to last forever. The board does not consider this line of argument persuasive since the term "forever" indicates an endless period of time and is therefore not appropriate to specify the duration of a

connection which is part of a physical object. In the physical world, nothing lasts forever in its current form. Furthermore, a physical connection can always be detached if an appropriate external force is applied.

2.9 Against this background, the board considers the intended use of the claimed apparatus according to the patent to be the appropriate criterion for determining the required duration or durability of the attachment. The board thus construes the term "permanently" in claim 1 to mean that the attachment must last long enough to allow reliable extraction of a thrombus by pulling on the guide wire (see paragraph [0003] of the patent). Contrary to the respondent's allegation, this meaning does in the board's view not already follow from the word "attached" itself, since it is possible - if a use according to the patent is not intended - to realise an attachment that does not last long enough to allow reliable extraction of a thrombus by pulling on the guide wire. However, even if the meaning as described above already followed from the word "attached" itself, it would not change the board's interpretation of claim 1, as it is - contrary to the respondent's assertion - quite possible that a certain word in a claim does not have any limiting effect of its own.

2.10 This understanding of a "permanently attached" tapering portion does not exclude that the same tapering portion may - under certain conditions, for instance under the effect of corrosion caused by an electric current - be released from the push or guide wire.

2.11 The respondent disagreed with this understanding, arguing that the description of the present patent defined "permanent" as the opposite of "releasable".

- 2.12 The board cannot concur with this view. In paragraph [0002] (column 1, lines 33 to 35), which is part of the section "Background of the invention", a brief description of D4 is given, and it is mentioned in this context that in D4 the connection between the stent and the guide wire is releasable, since the stent is permanently implantable. However, the mere fact that D4 is referred to in this section of the patent does not automatically exclude it from falling under the invention "as described in claim 1" (paragraph [0003], first sentence). Acknowledging a document in the description as a prior-art document is not sufficient to render the claimed subject-matter novel in view of this document.
- 2.13 As to the meaning of "permanent", it is merely stated in paragraph [0014] of the description (column 5, lines 16 to 18) that the connection at or adjacent to the connection point is "permanent in accordance with the invention". As explained above (see point 2.6), this does not involve a definition of the term "permanent" or "permanently attached", and - even less - a statement to the effect that "permanent" has to be understood as the opposite of "releasable".
- 2.14 The respondent also referred to paragraph [0062] of the description, stating that Figures 19a and 19b - which depict an apparatus essentially corresponding to the releasable device depicted in Figures 8a and 8b of D4 - show "two variations of a separating arrangement by which the distal segment 1 according to an example not in accordance with the invention is detachably connected to a guide wire". However, it cannot be concluded from this statement that the example referred to in this paragraph is considered not to be in

accordance with the invention on account of its specific separation arrangement. In any event, paragraph [0062] does not define the term "permanently attached". At most, this paragraph can be understood as an attempt to exclude from the claims, i.e. disclaim, the particular arrangement shown in Figures 19a and 19b by an amendment to the description.

2.15 Taking account of the description and the drawings when interpreting a feature which is present in a claim is quite different from reading into a claim a - positive or negative - feature which is only present in the description or the drawings. As explained in T 1473/19, Reasons 3.11 to 3.15, the principles of claim interpretation set out in Article 69 EPC and Article 1 of the Protocol on the Interpretation of this provision are to be applied when determining a patent claim's subject-matter in proceedings before the EPO. According to Article 69(1), first sentence, EPC, only the claims determine the extent of protection. The description and the drawings have no such function, and must only be used to interpret the claims. This means that the description and the drawings can only be used for interpreting features which are already present in the claims, but not for adding further claim features or for replacing existing claim features by others. In the present case, the exclusion of the releasable device depicted in Figures 19a and 19b is only present in the description, but not in the claims. Assigning to the term "permanently attached" in claim 1 the meaning - on account of paragraph [0062] of the description - that it excludes any releasable device as depicted in Figures 19a and 19b would go beyond the mere interpretation of this claim feature in light of the description. It would, in fact, amount to adding a further limitation to the claim which is only present

in the description - and this would not be in line with the principle of primacy of the claims (see T 1473/19, point 3.16.1). Hence, claim 1 of the patent as granted cannot be understood, on the basis of paragraph [0062] of the description, as excluding an arrangement as depicted in Figures 19a and 19b of the drawings.

- 2.16 The respondent further argued that the description of the application as originally filed states that the attachment at the connection point might be permanent or a releasable mechanism (page 6, lines 25 to 26). However, unlike the description of the patent, the application as filed is not referred to in Article 69(1), second sentence, EPC as part of what must be taken into account when interpreting a patent (T 1473/19, Reasons 4.4). The application as filed often, and also in the present case, differs from the patent as granted, both regarding the claimed invention and the contents of the description, and it usually cannot, for this reason alone, provide guidance for interpreting the claims of the patent as granted.
- 2.17 In any case, in view of the reasons set out above for the board's interpretation of claim 1 as granted, the board does not consider the incidental statement in the application as filed, according to which the attachment "may be permanent or a releasable mechanism", to be a sufficient reason to interpret claim 1 as granted such that it excludes an attachment involving a releasable mechanism.
- 2.18 In conclusion, the description of the patent does not teach that any attachment that can potentially be released by the user must not be regarded as permanent. In other words, it does not follow from the description that the absence of the possibility of releasing the

attachment is a prerequisite for the attachment being permanent within the meaning of claim 1.

- 2.19 As stated by the respondent, some prior-art documents (D4, D13) relate to systems for delivering stents which are releasable from the guide wire, whereas others (D3, D6, D7, D8, D9, D11 and D12) relate to systems for capturing a thrombus by means of a filter or basket which is not releasable from the guide wire. The board also acknowledges that, in D3 and D9, a distinction is made between permanent connections and releasable connections.
- 2.20 As set out in point 2.3 above, patent claims must be interpreted through the eyes of the person skilled in the art. This includes taking account of the skilled person's common general knowledge. The prior art documents invoked by the respondent are, however, not suitable evidence for proving the skilled person's understanding of the term "permanently attached" according to common general knowledge. Rather, this would have required evidence such as a textbooks or technical lexica (see T 1354/18, Reasons 11).
- 2.21 The board also notes that the material to be taken into account for claim interpretation under Article 69 EPC - in addition to the claims themselves - is limited to the description and the drawings (T 1473/19, Reasons 3.18). Prior-art documents are not part of the material referred to in this provision.
- 2.22 Furthermore, it cannot be assumed that a technical term, which is used in a certain prior-art document and has a certain meaning in this document, has the same meaning in the patent claim to be interpreted merely because that claim uses the same term. Any text must

interpreted in its context (see T 1646/12, Reasons 2.1), and different documents, such as the patent under consideration on the one hand and a prior-art document like D3 or D9 on the other hand, necessarily provide different contexts for the terms contained therein and subject to interpretation.

- 2.23 While parties and the deciding body are not prevented from referring to prior-art documents in support of their understanding of a certain technical term used in the claims, account must be taken of the above limitation when proceeding in this manner. In the present case this means that, even if one acknowledges that a distinction between permanent connections and releasable connections is made in certain prior art documents, this distinction cannot simply be transferred and applied to the patent as granted and claim 1 thereof, which itself does not contain any indication of being based on such a distinction.
- 2.24 Having set out how the expression "permanently attached" in claim 1 has to be interpreted, it must now be considered whether the tapering portion of the apparatus of D4 is "permanently attached" within the meaning of the claimed invention.
- 2.25 In D4, the implant is connected to the guide wire by a separating element 23 in such a manner as to be detachable by electrolytic corrosion. Paragraph [0058] mentions a steel material for the separating element, which material is susceptible to corrosion in an electrolyte under the influence of electrical energy. This means that, without electrical energy being provided to the separating element (which would require additional measures and equipment), the connection between the guide wire and the implant will remain

intact.

- 2.26 The patent itself acknowledges in paragraph [0014] (column 5, lines 18 to 22) that the apparatus of D4 can be used to restore localised blood flow to an occluded vascular site. The patent does not indicate any need to modify the apparatus of D4 to achieve this. When the apparatus of D4 is used for the purpose of removing a thrombus as described in the patent, there is evidently no reason to apply an electrical voltage to the separating element, which would destroy the connection and make the removal of the thrombus impossible. When removing a thrombus, the user will therefore refrain from doing this, and the attachment will last long enough to allow reliable extraction of the thrombus by pulling on the guide wire.
- 2.27 Claim 1 is an apparatus claim, and the mere existence of the possibility of terminating the attachment of the implant to the guide wire in the apparatus of D4 does not, in itself, have any impact on the duration of this attachment. Instead, the separating arrangement in the apparatus of D4 only provides the *potential* to terminate the attachment. The realisation of this potential requires a deliberate choice and action on the part of the user in order to provide electrical energy to the separating element of the apparatus of D4, which in turn requires the use of external equipment. In the absence of such user choice and action, the connection in the apparatus of D4 remains intact without any inherent limitation in time caused by the provision of the separating arrangement.
- 2.28 The respondent also argued that a permanent attachment was mechanically more stable and secure, and that

therefore the person skilled in the art would not consider the connection of D4 as permanent.

- 2.29 The board considers that in D4 the provision of a separating element which is made of corrodible steel does not, in itself, weaken the connection and does not therefore render the device less stable or secure. It is, in fact, mentioned in paragraph [0058] that a structural or chemical weakening "may be beneficial" as an optional, additional measure.
- 2.30 Furthermore, contrary to the respondent's view, Figures 8a and 8b do not reveal that the dumb-bell-shaped element 23 allows the implant to be separated from the guide wire. Instead, it follows from the description of D4 that further means, such as a power source or electrical contacts, are needed to apply current to the dumb-bell to detach the implant from the guide wire. No such means are disclosed in Figures 8a and 8b.
- 2.31 Moreover, none of the prior-art documents referred to by the respondent suggest that the presence of an electrolytically corrodible element in a steel connection as in the apparatus according to D4 renders such an attachment non-permanent within the meaning of claim 1.
- 2.32 In conclusion, the person skilled in the art understands the connection in D4 by the dumb-bell-shaped element made of corrodible steel as a permanent one within the meaning of claim 1, i.e. as a form of attachment which lasts long enough to allow reliable extraction of a thrombus by pulling on the guide wire. Hence, the attachment provided in the apparatus of D4 is permanent within the meaning of claim 1.

- 2.33 Consequently, the subject-matter of claim 1 of the main request lacks novelty over D4.
3. Referral of questions to the Enlarged Board of Appeal
- 3.1 The respondent requested that the questions on claim interpretation mentioned under point IX above be referred to the Enlarged Board of Appeal. The board refused this request for the following reasons.
- 3.2 Under Article 112(1)(a) EPC, a board of appeal refers a question to the Enlarged Board of Appeal if it considers that a decision is required in order to ensure uniform application of the law or because a point of law of fundamental importance arises. A board can refer questions either of its own motion or following a request from a party.
- 3.3 The issue of whether or not to refer a question is a discretionary decision by the board (see Case Law of the boards of Appeal, 10th edition 2022, V.B.2.3.2). In order for a referral to be admissible, the referred question must be relevant for deciding the case in question (see Case Law of the Boards of Appeal, 10th edition 2022, V.B. 2.3.3).
- 3.4 The first question formulated by the respondent essentially concerns whether a board of appeal may - in the event of parties presenting two conflicting alternatives concerning how to interpret a claim - adopt one of these claim interpretations "without any evidence". During the oral proceedings before the board, the respondent made reference to T 1473/19 and stated that this decision required the use of evidence in claim interpretation.

- 3.4.1 The first question suggested by the respondent appears to be based on several erroneous assumptions. Firstly, the respondent appears to assume that a board of appeal is prevented from adopting a claim interpretation of its own, i.e. a claim interpretation which differs from the claim interpretation(s) presented by the parties in *inter partes* appeal proceedings (or, for that matter, by the applicant in *ex parte* appeal proceedings). Secondly, the respondent appears to assume that T 1473/19 requires, without exception, the use of evidence in claim interpretation and that a board of appeal is limited - when selecting one of the claim interpretations provided by the parties - to claim interpretations which have been supported by evidence. Thirdly, the respondent seems to assume that the appellant did not rely on any evidence in support of its claim interpretation. None of these assumptions are correct.
- 3.4.2 The board concurs with the statement in T 1473/19, Reasons 3.17, that claim interpretation is, overall, a question of law which must, as such, ultimately be answered by the deciding body, and not by linguistic or technical experts. This being so, a board of appeal is not limited to the claim interpretations advanced by the parties but may also adopt a claim interpretation of its own (for the evaluation and interpretation of evidence, compare R 19/11, Reasons 2.2, in which the Enlarged Board held that a board may deviate in its interpretation of a prior-art document from the interpretations provided by the parties). In *inter partes* proceedings it will, however, be the exception rather than the norm that a board will deviate from the views of all parties. In the present proceedings the board did not see any need to adopt a claim

interpretation deviating from the views of both parties either.

- 3.4.3 In T 1473/19, Reasons 3.17, the statement about claim interpretation being a question of law is followed by the statement that claim interpretation also involves the appraisal of linguistic and technical facts "which may be supported by evidence submitted by the parties". However, not preventing the parties from relying on evidence in the context of claim interpretation has, contrary to the respondent's view, nothing to do with making such evidence a precondition for the adoption of a certain claim interpretation. The board notes in this context that evidence can only be relied upon to prove facts, such as how the person skilled in the art understood a certain technical term in a certain prior-art document at a certain point in time, but not to ultimately ascertain whether a certain claim interpretation is correct or not. As explained above, the latter is a question of law.
- 3.4.4 In any case, the appellant actually did rely on documentary evidence in support of its claim interpretation, in particular on the patent itself and on prior-art documents. This is not changed by the fact that the respondent disagreed with the appellant's reading of these documents.
- 3.4.5 In conclusion, the first question is based on an erroneous factual assumption (see point 3.4.4 above) and is therefore not relevant for deciding the case. To the extent that it is also based on erroneous legal assumptions, it can be answered by the board itself without doubt.

- 3.5 The second question formulated by the respondent essentially concerns whether the interpretation of a certain claim feature is "a reasonable claim interpretation" against the background of a specific prosecution history.
- 3.6 While the respondent tried to draft the question in an abstract way, the board considers that it cannot be answered without assessing the specific circumstances of the present case, such as the specific prosecution history and the wording of claim 1 as granted. The link to the specific circumstances of the case at hand is, *inter alia*, created by the reference in the question to "the term used for the selected alternative", which refers to the wording of claim 1 as granted. The second question does not, therefore, concern a "point of law of fundamental importance" within the meaning of Article 112(1) EPC, which would be "relevant to a large number of similar cases" (G 1/12, Reasons 10). In addition, the assertion that "the applicant selected one of the two alternatives to limit the claim" indicates that the second question starts from the assumption that claim 1 as granted indeed excludes releasable mechanisms. Taking this limitation as a fact and then going on to ask whether it is "reasonable" to adopt a claim interpretation which does not reflect it is circular in that the implied conclusion (i.e. that such a claim interpretation would be unreasonable) relies on its own premise - which is, according to the board's analysis set out above, incorrect in the first place.
- 3.7 The third question formulated by the respondent essentially concerns whether, and if so, under which conditions, a prior-art document can be used as

evidence for the understanding of the person skilled in the art in a certain technical field.

- 3.8 This question could be answered by the board itself without doubt. As explained in point 3.4.3 above, parties are not prevented from relying on prior-art documents as evidence for the skilled person's understanding of a certain technical term in a certain document at a certain point in time. This, however, does not mean that this understanding must then automatically be applied to the interpretation of a patent claim in a different document for the sole reason that the same term is used therein.
- 3.9 The board also disagrees with the respondent's assertion that the board in the present case deviated from decision T 1473/19 in that it allegedly did not take the patent specification into account when interpreting claim 1 as granted. As is apparent from the board's reasoning given above, the present decision is fully in line with the principles of claim interpretation set out in decision T 1473/19, and the description was taken into account accordingly. The board further notes that the need to take account of the description was not disputed in the present case, as both parties relied on the description of the patent for the interpretation of claim 1 as granted.
- 3.10 In conclusion, the board rejected the appellant's request to refer questions to the Enlarged Board of Appeal.
4. Auxiliary request 1a - admittance

- 4.1 During the oral proceedings before the board, the respondent amended its case by filing auxiliary request 1a.
- 4.2 The admittance of this request is subject to the conditions set out in Article 13(2) RPBA 2020. According to that provision, amendments to a party's appeal case are not, in principle, to be taken into account unless there are exceptional circumstances which have been justified with cogent reasons.
- 4.3 In the board's view, there are no such exceptional circumstances. In the statement of grounds of appeal, the appellant stated that "the fact that a connection may in principle be destructible cannot be a reason for negating a permanent connection". To corroborate this statement, the appellant referred to the patent disclosing in paragraphs [0030] and [0031] an embodiment with a releasable connection which allowed the mesh structure to be left *in situ* when it was no longer retrievable. The appellant further referred to claim 8 as granted showing that such an embodiment was considered by the patent proprietor to be part of the patent. Hence, the appellant had already submitted in the statement of grounds of appeal that claim 1 as granted covered releasable connections and that a releasable connection could be regarded as permanent.
- 4.4 The appellant's line of argument as referred to above was taken up in the board's communication under Article 15(1) RPBA 2020, in which the board had indicated its preliminary opinion that the subject-matter of claim 1 of all claim requests lacked novelty over D4 because the "connection between the guide wire and the stent can be regarded as permanent [...] as long as it is not released".

4.5 In view of the above, the board cannot concur with the respondent's view that this argument was raised for the first time in the oral proceedings before the board, and that this constituted exceptional circumstances justifying the filing of a new claim request in response thereto.

4.6 As to the respondent's argument that the appellant had interpreted paragraph [0031] of the patent specification differently in the oral proceedings before the board from its interpretation in the written proceedings, the board notes that a party may refine an objection within the previously established framework without this automatically constituting an amendment of its appeal case which could justify the filing of a new claim request. This also applies to a board taking up and refining arguments introduced by a party (T 1891/20, Reasons 4.1.4). In any case, it is apparent from the board's reasoning given above on the interpretation of claim 1 as granted that the interpretation of this claim does not depend on the contents of paragraph [0031] of the patent.

4.7 In conclusion, the board decided not to admit auxiliary request 1a into the proceedings.

5. Auxiliary requests - novelty in view of D4

5.1 According to claim 1 of auxiliary request 1, the mesh structure is "expandable into penetrating contact with the thrombus, exerting an outward radial force on the thrombus, reducing the cross-sectional area of the thrombus and establishing blood flow through the blood vessel past the thrombus".

- 5.2 The present patent mentions (column 5, lines 18 to 22) that the methods disclosed therein can be performed with the apparatus of D4. Hence, the mesh structure of D4 has to be considered to be expandable in the manner defined in claim 1.
- 5.3 Therefore, the subject-matter of claim 1 of auxiliary request 1 lacks novelty over D4.
- 5.4 According to claim 1 of auxiliary request 2, the apparatus is "deliverable to a site that is radially adjacent to the thrombus by a microcatheter (8) having a distal tip (16) that is placeable beyond the distal end of the thrombus".
- 5.5 The present patent mentions (column 5, lines 18 to 22) that the methods disclosed therein can be performed with the apparatus of D4. Hence, the apparatus of D4 has to be considered to be deliverable in the manner defined in claim 1.
- 5.6 Therefore, the subject-matter of claim 1 of auxiliary request 2 lacks novelty over D4.
- 5.7 According to claim 1 of auxiliary request 3, the mesh structure consists of interconnected strings or filaments or struts.
- 5.8 The abstract of D4 mentions that the implant has a mesh structure of interconnected strings or filaments. In addition, paragraph [0010] mentions that the implant has the form of a longitudinally open tube with interconnected strings or filaments forming a mesh structure. Such a mesh structure is further disclosed in Figures 1 to 3 and 5.

- 5.9 Therefore, the subject-matter of claim 1 of auxiliary request 3 lacks novelty over D4.
6. Since none of the requests on file is allowable, the patent has to be revoked.
7. Request for amendment of minutes of oral proceedings
- 7.1 By its submission dated 29 March 2023, the respondent requested a correction of the minutes as indicated in point XII. above.
- 7.2 Pursuant to Rule 124(1) EPC, minutes of oral proceedings are to be drawn up, containing the essential points of the oral proceedings and the relevant statements made by the parties.
- 7.3 Under Article 6(4) RPBA 2020, the minutes of oral proceedings are to be drawn up by a member of the deciding board or the registrar, as designated by the chair. According to the travaux préparatoires to this provision, "the minutes drawn up by the board record the essential procedural acts, for example the parties' requests and the submission of documents during the oral proceedings. However, arguments presented by the parties during the oral proceedings are not generally included in the minutes, although they may form part of the board's written decision" (CA/3/19, page 22).
- 7.4 As explained in T 1891/20, Reasons 2.3, it is at the discretion of the minute-taker what to consider "essential" or "relevant" (T 212/97, Reasons 2.2; T 642/97, Reasons 9.3; R 7/17, Reasons 23). A summary of the arguments made by the parties during the oral proceedings is not usually included in the minutes (T 1721/07, Reasons 17; see also T 263/05, Reasons

8.7). The minutes do not normally record any questions posed by the parties to the board either. Moreover, the board is responsible for deciding on what needs to be recorded in the minutes, not the parties (T 468/99, Reasons 1.5; T 1721/07, Reasons 15).

7.5 According to the unanimous recollection of all three members of the board, after the chair had announced the board's conclusion in the oral proceedings that the subject-matter of claim 1 of the patent as granted lacked novelty over D4, the respondent asked for the board's reasons for this conclusion, and in particular whether paragraph [0010] of the patent had been decisive. After deliberation, the chair had informed the parties that the board considered the feature "permanently attached" in claim 1 not to exclude a release mechanism as in D4 and that paragraph [0010] of the patent had not been of particular importance for the board's conclusion. The chair further stated that the details of the board's reasoning would be contained in its written decision.

7.6 According to the unanimous recollection of all three members of the board, the respondent did not refer at any time in the oral proceedings to a potential violation of its right to be heard.

7.7 The respondent is thus requesting the insertion of a paragraph into the minutes which is - according to the unanimous recollection of all three members of the board and the representative of the appellant - factually incorrect. Moreover, as explained above, the minutes do not normally record any questions posed by the parties to the board, as such questions do not usually - and also in the present case - form part of the essential issues of the oral proceedings. As an

aside, the board also notes that parties are not entitled to receive advance indications of the reasons for a decision (see, for example, R 19/11, Reasons 2.2).

7.8 The request for amendment of the minutes of the oral proceedings is therefore refused.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chair:



C. Moser

M. Alvazzi Delfrate

Decision electronically authenticated