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Datasheet for the decision of 20 January 2025

Case Number: R 0014/23

Appeal 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:
Petition for review

Relevant legal provisions:
EPC Art. 54(2), 112a(2)(c), 113(1)
RPEBA Art. 13, 14(2)
RPBA 2020 Art. 15(1)

Keyword:
Petition for review - clearly unallowable - fundamental violation of the right to be heard (no)

Decisions cited:
R 0003/15, R 0025/22

Catchword:
-

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Große Beschwerdekammer

Enlarged Board of Appeal

Grande Chambre de recours

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Case Number: R 0014/23

D E C I S I O N
of the Enlarged Board of Appeal
of 20 January 2025

Petitioner: (Patent Proprietor)	Covidien LP 15 Hampshire Street Mansfield, MA 02048 (US)
Representative:	Bardehle Pagenberg Partnerschaft mbB Patentanwälte Rechtsanwälte Prinzregentenplatz 7 81675 München (DE)
Other party: (Opponent)	Phenox GmbH Lise-Meitner-Allee 31 44801 Bochum (DE)
Representative:	Schneiders & Behrendt Bochum Gerard-Mortier-Platz 6 44793 Bochum (DE)
Decision under review:	**Decision of the Technical Board of Appeal 3.2.02 of the European Patent Office of 9 March 2023.**

Composition of the Board:

Chairman	I. Beckedorf
Members:	T. Bokor
	E. Bendl

Summary of Facts and Submissions

I. The patent proprietor (hereinafter: "petitioner") in case T 450/20 has filed a petition for review under Article 112a EPC against the decision of Technical Board of Appeal 3.2.02 (hereinafter: "Board") dated 9 March 2023 allowing the opponent's appeal and revoking European patent No. 2254485.

II. The Board's decision based the revocation essentially on the ground that claim 1 of all admitted requests lacked novelty over the disclosure of document D4 (US 2005/0209678 A1), in particular because the feature "permanently attached" was also considered disclosed in D4.

III. The invention concerns an apparatus for restoring blood flow in occluded blood vessels, such as cerebral arteries occluded by a thrombus. Such devices are commonly called stents. As best seen in Figure 1 of the patent, the stent is self-expandable and put into place by a push or guide wire. The stent has a mesh structure with a tapering portion, which is permanently attached to the guide wire at a connection point. The crucial issue of the petition is the Board's interpretation of the feature "permanently attached".

IV. The other features of the claim and generally the conduct of the proceedings by the Board are not relevant for the petition.

Overview of the opposition-appeal proceedings

V. In the proceedings before the Opposition Division the patent was maintained as granted. The Opposition

Division also acknowledged novelty over D4, specifically establishing that the feature "permanently attached" was not disclosed. The opponent appealed. Among other objections against the patent, the opponent presented a novelty attack based on document D4. The Board issued a communication under Article 15(1) RPBA, in which it indicated its preliminary opinion that the subject-matter of claim 1 of all the claim requests lacked novelty over D4.

VI. Oral proceedings before the Board were held on 9 March 2023, in the form of joint proceedings together with case T 1494/21. The contested decision by the Board was announced at the end. The minutes were posted on 17 March 2023 and do not contain any technical details of the arguments relied on for the various issues discussed. The only substantive issue discussed was the novelty attack based on D4. The Board announced at the oral proceedings that the patent lacked novelty over D4.

VII. The Board's decision was posted on 12 July 2023. The Board justified the revocation of the patent in suit essentially on account of a lack of novelty, for most requests. The non-admittance of an auxiliary request and a refusal to refer questions to the Enlarged Board of Appeal is not relevant for the petition. The Board's substantive reasoning on the issue of novelty, and in particular the interpretation of the feature "permanently attached", is set out Reasons in 2.1 to 2.33. The Board ultimately concluded that D4 also disclosed a stent that was "permanently attached" to the guide wire (see in particular Reasons 2.32).

Proceedings before the Enlarged Board of Appeal

VIII. The reasoned petition was filed on 15 September 2023, and the prescribed fee was paid on the same day. The petitioner contends that a fundamental violation of its right to be heard, namely a violation of Article 113(1) EPC, occurred in the appeal proceedings, on two counts. The petition is based on two arguments: first, that the Board gave an unexpected new interpretation of the feature "permanently attached" in points 2.7 and 2.9 of the decision, on which the parties were unable to comment (first petition ground), and second, that the Board gave no reasons in the decision "for the Board's view" on the new interpretation (second petition ground). At the same time, the petitioner's arguments on claim interpretation had not been properly dealt with in the decision.

IX. In the context of the first petition ground, the petitioner submitted that it had set out its interpretation, based on the patent and various other pieces of evidence, that the term "permanently attached" was meant to exclude a releasable mechanism, in particular the release mechanism of D4. The Opposition Division had also accepted this interpretation. By contrast, the interpretation asserted by the opponent and the Board was that a connection was permanent as long as it was not released. In its communication the Board did not explain how it had arrived at this interpretation. The petitioner was aware of this proposed interpretation and had provided arguments and evidence that the skilled person would not understand "permanently attached" in this manner.

X. In contrast to this line of argument submitted by the petitioner, the decision had surprisingly held that a permanent connection was meant to last a certain amount of time and the skilled person would regard an attachment as permanent depending on how long the attachment would last. The question was no longer the presence or absence of a release mechanism but the duration of the attachment and the mechanical suitability of the device for extracting a thrombus. In particular, the durability, i.e. the mechanical strength of the attachment, now also became the decisive criterion for determining whether or not an attachment was permanent. This interpretation could not be deduced from the parties' arguments and had not been put to the parties beforehand by the Board. Not only did this interpretation come as a surprise to the petitioner, but also the written reasons of the Board's decision did not give any explanation as to how the Board had arrived at this interpretation. The Board had also ignored or at least misjudged the petitioner's argument that the claimed device had to possess a mechanically stronger attachment between the guide wire and the stent than the device of D4.

XI. Concerning the second petition ground, the petitioner submitted that the Board's decision was not reasoned because in the written reasons of the decision the Board had not presented any reasons as to how it had come to the contested interpretation of the feature "permanently attached" set out in respect of the first petition ground. The Board had also failed to properly take into account the petitioner's arguments as to why the feature "permanently attached" was not disclosed in D4. The petitioner's arguments that the Board did address had not been correctly dealt with.

XII. The Enlarged Board of Appeal (in its present composition pursuant to Rule 109(2)(a) EPC, hereinafter also: "EBA") issued a communication pursuant to Articles 13 and 14(2) of the Rules of Procedure of the Enlarged Board of Appeal (RPEBA) and summoned the petitioner to oral proceedings. The communication stated that the petition appeared to be clearly unallowable. The EBA gave its view on the reasons for the Board's decision, concluding that the allegedly new and surprising reasons in the Board's decision, in particular the arguments in support of D4's disclosure of the feature "permanently attached", had already been brought up by the opponent in its submissions on appeal. There were numerous arguments on file as to the significance of the releasable nature of the device of D4 and why this did not prevent the device of D4 from also being a permanent attachment. The petitioner did not react further in writing to the EBA's communication.

XIII. The oral proceedings before the EBA were held on 20 January 2025. At the oral proceedings, the petitioner argued that the petition was not clearly unallowable. It clarified that the main objection with respect to the first petition ground not only concerned the Board's assessment of "how long an attachment may last" as the decisive criterion for the "permanent attachment" feature. Rather, the core objection was directed at the Board's more specific finding that it was the attachment's ability to extract a thrombus that made it a permanent attachment. There had been a shift in the arguments from the Board, so the petitioner had been objectively surprised by the Board's reasons as to how it had arrived at its conclusion. Even if such arguments had been part of the opponent's case, the petitioner could not have foreseen, in the absence of

any indication from the Board, that this aspect would turn out to be decisive among a multitude of arguments. As a result, the petitioner had not had an effective opportunity to comment on this decisive reason given by the Board. On the second ground, the petitioner referred to its written submissions without any further oral arguments.

XIV. The petitioner requests that:
- the decision under review be set aside;
- the proceedings before the Board of Appeal be re-opened;
- the fee for the petition for review be reimbursed.

Reasons for the Decision

Reference to the parallel case R 13/23

1. The appeal case on which this petition is based concerns an application which served as the parent application for a divisional application. The divisional application was dealt with in appeal case T 1494/21, also assigned to the Board. The Board did not formally consolidate it with the appeal in this case but held joint oral proceedings in the two cases. Both cases turned on the same issue, and the Board came to a similar decision in both. Appeal case T 1494/21 is the subject of the parallel petition for review case R 13/23. As also confirmed by the petitioner, there is no relevant substantive difference between the two petition cases. The Board's reasoning, the corresponding petition grounds and the petitioner's arguments are all similar. The Enlarged Board's findings are equally similar.

Admissibility

2. The petition is reasoned and was filed in a timely manner, and the fee was paid (Rule 107(1) and (2) EPC). The petitioner is adversely affected by the decision.

3. The EBA is satisfied that the petition is not clearly inadmissible under Rules 106 and 109(2)(a) EPC. The EBA sees no reason to question that the petitioner could not have realised until receipt of the written decision that it contained the contested interpretation, which according to the petitioner was not foreseeable, and that some other reasons were missing. The objections could not have been raised in the appeal proceedings.

4. Therefore, the petition is considered not to be clearly inadmissible.

Allowability of the petition
First petition ground, violation of the right to be heard

5. The EBA considers it undisputed that the substantive core of the Board's impugned decision is wholly dedicated to the interpretation of the feature "permanently attached". It is clear and was also undisputed that the importance of this feature had been known to the petitioner and that the petitioner had had the opportunity to present its own interpretation and submit all the supporting evidence and arguments. The significance of this feature for the question of novelty over D4 was also clear from the very beginning for all parties and the Board. The petitioner was at no point prevented from presenting its arguments.

6. According to the established case law of the EBA, the rights stipulated by Article 113(1) EPC, as an

expression of the right to be heard, do not go so far as to impose a legal obligation on a board to disclose in advance to the parties, how and why, on the basis of the decisive issues under discussion – or at least those foreseeable as the core of the discussion – it will come to its conclusion. This is part of the reasoning given in the written decision. Reference is made to the Case Law of the Boards of Appeal (CLBA), 10th edition, 2022, chapter V.B.4.3.5, and the cited decisions.

7. This is particularly true for issues of claim interpretation, notwithstanding the findings of R 3/15, Reasons 4.5.11, cited by the petitioner in support of its argument that it had also been confronted with a surprising new interpretation in the case in hand. The EBA notes that claim interpretation and examination of a claim for the purposes of determining novelty over a piece of prior art within the meaning of Article 54(2) EPC is a question of law and as such always incumbent on the Board, even if none of the parties present any arguments. Thus, the Board was fully entitled to rely on its own interpretation of the facts.

8. This principle was already confirmed in an earlier decision of the Enlarged Board. Recently, in case R 25/22, the Enlarged Board stated that claim interpretation, being a question of law, is an issue that falls within the exclusive competence of the competent board. A board may adopt the interpretation proposed by one or more parties but is in no way bound to the submissions by any party in this regard. It is at liberty to determine the most appropriate interpretation according to its own conviction, having considered all the relevant facts, in particular the

patent itself. The board's final conclusion on the correct interpretation of a claim is typically reached during its final deliberations, when all pertinent facts and arguments are on the table. For this reason alone, it is questionable to what extent parties can expect to know the board's opinion on claim interpretation in advance, as an aspect of their right to be heard (R 25/22, Reasons 12). In this respect, a party can only have a limited legitimate expectation that the board's final interpretation will not come as a surprise, contrary to what may possibly be inferred from the cited Reasons 4.5.11 of R 3/15.

9. In the case in hand, the EBA understands that the petitioner's main complaint is that it was unable to comment on the Board's allegedly new interpretation, namely that the term "permanent" does not imply an essentially "forever lasting" attachment, accepting that any attachment can be destroyed by sufficient force and obviously cannot be expected to be truly everlasting (see Reasons 2.8 in the impugned decision). Instead, the criterion is now the suitability of the attachment to extract a thrombus: "*… 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 for a thrombus to be reliably extracted by pulling on the guide wire …*" (Reasons 2.9).

10. According to the petitioner, these aspects of the claim interpretation were new and therefore surprising for the petitioner. The Board's communication pursuant to Article 15(1) RPBA only addressed the question of

whether a permanent attachment could also be releasable, but not the issue of whether the attachment was strong enough and lasted long enough to extract a thrombus, as required by the claim.

11. The EBA considers that these aspects of the claim interpretation were not new and therefore objectively should not have been surprising.

12. The Board's disputed claim interpretation, regardless of the reasons given in support of it, is the same as that argued by the opponent and was as such known to the petitioner. In its grounds of appeal dated 22 April 2020, the opponent had already argued that the feature "permanently attached" was disclosed in D4 and had explained why this was the case. Reference is made to the passage from page 8, paragraph 5 to page 9, paragraph 1, where the opponent set out its interpretation of feature (i) of the claim ("the tapering portion is **permanently attached** to the push or guide wire …", emphasis added by the EBA). It argued that the presence of a releasable connection did not necessarily conflict with an attachment also being considered permanent. The opponent specifically stated that the guide wire of the device of D4 was not detached during thrombus removal and therefore the connection had to be considered permanent; page 8, third paragraph, second sentence.

13. It is true that the opponent placed great emphasis on the argument that a connection is permanent as long as no measures are taken to destroy it, e.g. page 9, first paragraph. However, this was not the only aspect of the opponent's claim interpretation. In the discussion of D4's disclosure of feature a) ("… apparatus **for removal of a thrombus** in a blood vessel", emphasis added by the

EBA), the opponent had already argued that the device of D4 was also suitable for this procedure; page 7, first and second paragraphs. Indeed, the issue of the suitability of the device of D4 for thrombus removal was also explicitly addressed in the discussion of the crucial feature (i); see page 9, first paragraph: "… *There is no fundamental structural or functional difference* [between a permanent and releasable connection]*. The only difference may the purpose* [sic]*: Whereas in using the device for thrombus removal as described in the patent releasing the connection is the exception, in using the device as an implant it may be the rule. However, as already explained above the purpose is not relevant for an apparatus claim as long as the apparatus as such is suitable for the purpose, which in turn is even acknowledged by the patent in suit itself*". The argument that the patent itself acknowledges the suitability is a clear reference to the opponent's earlier argument set out in the context of feature a) on page 7, second paragraph, mentioned above, namely that in paragraph 0002 the patent itself explains, by way of a direct reference to US Patent Application 2005/209678 (D4), that the device of D4 can be used for thrombus removal.

14. These arguments by the opponent may not correspond verbatim to the Board's reasoning as set out in points 2.7 and 2.9 of the decision under review, but in the EBA's view they effectively address the same issue, namely the physical suitability of the device of D4 to perform thrombus removal in the same way as taught by the patent and consequently D4's disclosure of a permanent attachment within the meaning of the claim. Both the Board and the opponent raised the issue of suitability as an aspect of the interpretation of the feature "permanently attached". The fact that

mechanical stability as an aspect of the term "permanent" was then discussed between the Board and the parties also appears to be supported by Reasons 2.28 and 2.29 of the contested decision, to which the petitioner did not specifically object in the petition.

15. The EBA points out that, when a board accepts a party's argument, it is not obliged to follow exactly the same structure of arguments or use exactly the same wording as the party. This also follows from the established case law that a board is not obliged to consider each and every argument raised by the parties (see CLBA as above, V.B.4.3.10(b), and the cited decisions). Therefore, there is no expectation that an argument addressed by the board, even if originally raised by a party, will simply appear in the decision as an easily identifiable formal repetition of the argument in the same form as originally presented.

16. At the oral proceedings before the EBA, the petitioner acknowledged that the objection that the device of D4 might be suitable for thrombus removal may have been raised in passing by the opponent. However, this alone could not have prepared the petitioner for the argument's later significance. Moreover, the petitioner could not have been expected to raise more of its own arguments as to why the device of D4 was not suitable for thrombus removal given that it could not have known beforehand that this aspect was going to be decisive for claim interpretation and consequently the issue of novelty.

17. The EBA does not question that it may indeed be difficult for parties to foresee precisely which of a plethora of arguments will be decisive for a board when

it decides on a particular issue. However, the Board cannot be expected to completely eliminate this difficulty. The petitioner's apparent expectation that the Board will clearly articulate all of its relevant arguments in advance only makes sense with the implied additional expectation that the parties are also given a further opportunity to comment on those "final" arguments. This, in turn, would require the Board to take those comments into account and would inevitably lead to further arguments from the Board. In effect, this boils down to the completely unrealistic expectation that the discussion between the parties and the Board can and indeed must take several turns until it becomes clear to all parties what the Board's final position will be and until all parties declare that they will not present any further arguments against the Board's position. Such an expectation is unrealistic even if oral proceedings are held and the discussion may, but need not, be more interactive than in a purely written procedure.

18. The petitioner also submits that the opponent did not return to the issue of the interpretation of the "permanent attachment" feature after receiving the petitioner's counterarguments (petition point 6). That may be so, but the opponent's argument was not abandoned. In its letter of 16 January 2023, the opponent clearly maintained its novelty attack against D4, even explicitly stating that it turned on the feature "permanently attached"; see page 8, first paragraph of chapter II (Inventive step in view of D4).

19. Accordingly, the petitioner had to be prepared for the Board to endorse the opponent's interpretation, including the opponent's arguments as to why it was an

acceptable interpretation. The petitioner could have commented on this interpretation and had been free to argue that this and the suitability of the device of D4 for performing thrombus removal were not supported by evidence. There was no need for the Board to set out in advance the contested interpretation as its "own"; in particular, it was not obliged to inform the parties in advance which aspects it would ultimately consider to be decisive for the contested interpretation, especially where those aspects were also on file.

20. The petitioner also argued that the proper interpretation was to be derived from the patent because it taught that a permanent attachment was the opposite of an attachment with a releasable mechanism. The Board did also take the patent into account, as is apparent from points 2.11 to 2.18 of the Reasons. This is not changed by the fact that the Board also explains why, in its view, there are limits to deriving an interpretation from the description; see e.g. Reasons 2.15.

21. The petitioner also argued that in relation to the new interpretation it had been further surprised by the finding that the claim as interpreted by the Board was not novel over D4 (petition point 20). As already stated in its communication, the EBA does not see what could have caused the further surprise (acknowledging that there was an understandable initial surprise on the petitioner's part upon learning of the Board's allegedly new interpretation, or at least of the allegedly new aspect of the interpretation). It had been clear to all parties throughout the proceedings that the issue was novelty over D4 and that the interpretation of the "permanently attached" feature was being discussed precisely for the purpose of

determining whether the releasable connection of D4 could be considered a permanent attachment as claimed in the patent, including the issue of whether the device of D4 was suitable for performing thrombus removal.

22. In summary, the EBA sees no reason for surprise on the petitioner's part. Nor is it apparent that any of the petitioner's relevant arguments on the interpretation of the feature "permanently attached" were not heard or properly considered. Accordingly, no fundamental violation of Article 113 EPC is apparent. The EBA holds that the first petition ground is clearly unfounded and as such clearly unallowable within the meaning of Rule 109(2)(a) EPC.

Second petition ground, violation of the right to be heard

23. In view of the fact that the petitioner relied upon its written submission in its petition for review for the second petition ground and did not submit any additional arguments in response to the EBA's communication pursuant to Articles 13 and 14(2) RPEBA in writing or at the oral proceedings before the EBA, the EBA confirms its preliminary opinion set out in said communication and considers that the petition is clearly unfounded in respect of the second petition ground too.

24. The EBA finds no basis for the objections asserted by the petitioner. The petitioner alleges that the Board did not provide "any reasons" for its interpretation of the claim as set out in point 2.7 of the Reasons. In the EBA's view, this statement is clearly incorrect and does not correspond to the facts. The Board set out all the arguments for and against the petitioner's desired

interpretation in great detail. It also explained why it found the petitioner's interpretation not to be supported and explained the Board's interpretation, over eight (8) whole pages of the decision; Reasons 2.8 to 2.32. In particular, the Board also explained how it understood the duration of the permanent attachment, namely that it should be sufficient to perform the intended thrombus removal; Reasons 2.9.

25. It may be that the petitioner finds the Board's reasons unconvincing or even incomplete, but that does not mean that no reasons were given. It is true that there is no further explanation in the criticised point 2.7 of the decision, but the subsequent points provide a full and very detailed explanation.

26. Here, the petitioner appears to be arguing that there is no reasoning by the Board in the sense that the reasons are considered satisfactory from the petitioner's perspective. The EBA also points out that a party is not entitled to receive a particularly structured statement of reasons to the extent that the Board has to follow the logical structure of the arguments put forward by the parties or address every issue raised; see point 15 above. Moreover, the Board is by no means required to present its reasons in a way that the parties will immediately find conclusive and convincing.

27. The petitioner also submitted that the Board had not correctly dealt with its asserted interpretation because the Board had ignored the fact that the petitioner's reading of permanent as "forever lasting" also included other qualifying statements, namely "without already including means for ending it" (point 37 of the petition).

28. The EBA is aware that under certain circumstances the absence of reasons in a decision addressing an important argument may constitute a violation of the right to be heard, if the absence of reasons does not make it possible to conclude that the right has been respected (see CLBA as above, V.B.4.3.10(a), and the cited decisions).

29. However, in the case in hand, the EBA cannot see that the Board has overlooked, distorted or misinterpreted an important part of the petitioner's argument on the "permanent attachment" feature. A party's submissions and arguments are not distorted or misinterpreted merely because the Board did not spell them out exactly as submitted.

30. The asserted missing part is properly addressed in points 2.11 to 2.31 of the Reasons, where the Board explains in great detail why the presence or absence of the releasable mechanism does not affect the interpretation of "permanently attached" or at least does not lead to the petitioner's desired interpretation. The EBA is of the opinion that an objective reader of the petitioner's case and the Board's decision will immediately see that the asserted "means for ending the attachment", which the petitioner perceives to be missing from the Board's reasoning, was meant to refer to the releasable mechanism mentioned in the description of the patent and was intended to be a counter-example to a permanent attachment, as repeatedly argued by the petitioner.

31. Contrary to the petitioner's assertion (petition point 40), the Board did also consider the argument

that the skilled person would derive an interpretation from the prior art (Reasons 2.19 and 2.20).

32. In summary, the EBA is of the opinion that the petitioner has concentrated on presenting its own lines of argument in great detail in the petition but, beyond picking out certain parts of the decision, does not seem to have taken into account the Board's reasons in their entirety. The reasoning given by the Board clearly takes account of all the essential elements of the petitioner's arguments. The fact that the Board ultimately accepts the opponent's arguments is not in itself objectionable.

33. Considerations worded similarly to those in points 24 to 32 above were set out in the EBA's communication (see point XII. above). The petitioner did not comment on these reasons any further. Having reviewed these considerations, the EBA confirms them as set out in its communication.

34. In summary, the second petition ground is also manifestly unfounded, so the petition as a whole is clearly unallowable and is to be rejected as such under Rule 109(2)(a) EPC.

Order

For these reasons it is decided that:

The petition for review is unanimously rejected as clearly unallowable.

The Registrar: The Chairman:

N. Michaleczek I. Beckedorf

Decision electronically authenticated