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D E C I S I O N
of 31 July 2002

Case Number: T 0167/01 - 3.2.2

Application Number: 97917917.3

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IPC: A61B 17/32

Language of the proceedings: EN

Title of invention:
Surgical Instrument

Applicant:
SMITH & NEPHEW, INC.

Opponent:

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Headword:

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Relevant legal provisions:

EPC Art. 52, 56

Keyword:

"Novelty and inventive step (yes, after amendments)"

Decisions cited:

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Catchword:

-



Case Number: T 0167/01 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 31 July 2002

Appellant: SMITH & NEPHEW, INC.
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Memphis, Tennessee 38116 (US)

Representative: Draggett, Peter Thornton
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 21 November 2000
refusing European patent application
No. 97 917 917.3 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: W. D. Weiß
Members: D. Valle
J. C. M. De Preter

Summary of Facts and Submissions

I. The appellant (applicant) filed an appeal against the decision of the Examining Division to refuse the application for lack novelty having regard to the document D1 = EP-A-609 084. The Examining Division found also that the term "rotatably locked" employed in claim 1 was not originally disclosed and in any case known from document D1.

II. Following the communication of the Board of 20 March 2002 the applicant filed with letter of 10 May 2002 amended claims 1 to 16 and requested that the decision under appeal be set aside and a patent be granted on the basis of these claims, an amended description (amended pages 2a, 13, 26 and 35 as filed with letter of 10 February 1998 and amended pages 2, 2a, 6 and 18 as filed with letter of 10 May 2002) and drawings as originally filed.

III. Claim 1 as filed with letter of 10 May 2002 reads as follows:

"A surgical instrument (400) comprising a first member (412) extending distally from a proximal end and having an opening (413) in a distal region for admitting tissue, a second member (416) disposed within said first member for moving a cutting implement and causing it to cut tissue that is exposed to said implement through said opening, a hub (432) and a knob (430) attached to said proximal end of said first member (412) to rotate said first member (412) and selectively change a rotational orientation of said opening with respect to said hub (432) characterized in that said knob (430) is axially movable from a first position in

which said knob (430) is mounted in a rotatable engagement with said hub (432) to a second position in which said knob (439) engages with and is rotatably locked with respect to said hub (432)."

- IV. The appellant argued that the pivotal issue in the case concerned the meaning of the term "rotatably locked". "Lock" meant to fasten, to make secure or unaccessible by or as if by means of locks; "rotatably locked" meant that the rotation was prevented under all normal conditions, that is, unless the lock was destroyed. In the case of document D1 the ratchet-like means could be opened by direct application of force in the direction of rotation. On the contrary in the case of a door latch, the lock could not be opened by direct application of force in the direction of opening of the door. Locks were designed to prevent that a device could be opened by direct application of force in the usual direction of opening. There were no degrees of locking but only 2 discrete states: locked or unlocked. The ratchet-like means of document D1 was not a lock: its function was to allow and not to prevent rotation. To be "locked" did not mean that there was merely a stable position but that the movement in a predetermined direction was actually prevented as long as the lock was in place.

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments*

The amended claim 1 is derived from the original claim

together with the description, page 35, last paragraph, and Figures 15 to 20. The dependent claims 1 to 15 correspond to the respective originally filed claims. Claim 16 originates from original claim 31

Contrary to the point II.5 of the decision, the clause "rotatably locked" is originally disclosed in the original claim 1, lines 14 and 15.

3. *Novelty*

Document D1 discloses a surgical instrument comprising a first member (12) extending distally from a proximal end and having an opening (13) in a distal region for admitting tissue, a second member (14) disposed within said first member for moving a cutting implement (15) and causing it to cut tissue that is exposed to said implement through said opening, a hub (56) and a knob (86) attached to said proximal end of said first member, said knob being mounted in a rotatable engagement with said hub to rotate said first member and selectively change a rotational orientation of said opening with respect to said hub.

Claim 1 differs therefrom in that said knob is axially movable from a first position where it is rotatably engaged with said hub to a second position in which said knob engages with and is rotatably locked with respect to said hub (see Figures 16 and 17, tabs 474, 476 and boss 478).

Contrary to the findings of the decision under appeal the expression: "rotatably locked" in claim 1 does not extend to cover also the ratchet-like connection of document D1, which allows selective rotation in

recesses and avoids accidental rotation by requiring the application of a predetermined force in the direction of rotation in order to rotate the device. Rotatably locked means that the rotation is prevented independently of the force applied: in order to allow rotation the removal of the lock is necessary. On the contrary, a ratchet-like connection has no lock.

4. *Inventive step*

The problem to be solved by the invention is therefore to be seen in allowing the user to temporarily and reliably define the direction of the opening for admitting tissue on the outer tube, so as to avoid accidental rotation of it relative to the grip, see page 30 of the description, from line 22. The problem of the invention is not disclosed by the available prior art.

The available state of the art contains no hints which can lead the person skilled in the art to the invention as claimed. Even if the person skilled in the art would come across the problem of reliably avoiding rotation of the opening of the device of document D1, he would not arrive to the invention in an obvious way because he would more likely use a typical locking mechanisms consisting of a latch-slot coupling, instead of providing an axially movable knob like the claimed invention.

Accordingly, the subject-matter of claim 1 involves an inventive step.

5. Claim 1 and claims 2 to 16 appended thereto meet therefore the requirements of the EPC.

6. It still remains to be examined whether the amended description and the figures meet the requirements of the EPC (see e.g. points I and V of the reasons of the decision under appeal and Guidelines Part C, Chapter II, 4.18). In this respect, the Board intends to make use of the power conferred to it by Article 111(1) EPC and to remit the case to the Examining Division for further prosecution.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:

A. Counillon

W. D. Weiß