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D E C I S I O N
of 4 November 2004

Case Number: T 1248/01 - 3.4.1

Application Number: 93917327.4

Publication Number: 0650383

IPC: A61N 1/378

Language of the proceedings: EN

Title of invention:

Dual battery system for implantable cardioverter defibrillator

Patentee:

ANGEION CORPORATION

Opponent:

Biotronik GmbH & Co. KG

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

EPC R. 67

Keyword:

"Added subject-matter (yes)"

"Substantive procedural violation (no)"

"Reimbursement of the appeal fee (no)"

Decisions cited:

T 0075/91

Catchword:

-



Case Number: T 1248/01 - 3.4.1

D E C I S I O N
of the Technical Board of Appeal 3.4.1
of 4 November 2004

Appellant:
(Opponent)

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Representative:

Eisenführ, Speiser & Partner
Patentanwälte Rechtsanwälte
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Respondent:
(Proprietor of the patent)

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Representative:

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 8 November 2001
rejecting the opposition filed against European
patent No. 0650383 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: M. G. L. Rognoni
Members: H. K. Wolfrum
H. Preglau

Summary of Facts and Submissions

- I. The appellant (opponent) lodged an appeal against the decision of the opposition division, dispatched on 8 November 2001, rejecting the opposition against European patent No. 0 650 383. The notice of appeal was received on 23 November 2001 and the prescribed fee was paid on the same day. On 13 March 2002 a statement of grounds of appeal was filed.
- II. The opposition had been based on the grounds of Articles 100(a) (substantiated on the grounds of lack of novelty and inventive step (Articles 52(1), 54(1) and (2) and 56 EPC)) and 100(c) EPC.

Reference had been made *inter alia* to the following documents:

E1: US-A-4 548 209;

E3: US-A-4 416 282; and

E4: US-A-4 345 604.

- III. In response to a communication of the Board of 23 July 2004 summoning the parties to oral proceedings, the respondent (patent proprietor), by letter of 8 September 2004, informed the Board that it would not attend the oral proceedings and that no response to the Board's annex to the summons was intended.

By letter dated 1 October 2004, the appellant informed the Board that it would not be represented at the oral proceedings as well.

- IV. Oral proceedings were held on 4 November 2004 in the absence of both parties.
- V. The appellant has requested in writing that the decision under appeal be set aside and the European patent be revoked in its entirety. Moreover, the appellant has alleged a deficiency of the contested decision and has requested the refund of the appeal fee.
- VI. The respondent (patent proprietor) has requested in writing that the appeal be dismissed and the patent maintained as granted.
- VII. Independent claim 1 of the patent as granted reads as follows:

"1. A power system for an implantable cardioverter defibrillator that is a self-contained human implantable device having monitoring means (34;54) for detecting myocardial arrhythmias in a human patient and output means (38,62) for selectively determining an appropriate electrical pulse therapy to be delivered in response to a myocardial arrhythmia detected by the monitoring means, and delivering the appropriate electrical pulse therapy to two or more implanted electrodes, comprising:

first battery means (111,112) for providing electrical power primarily to the monitoring means;

second battery means for providing substantially all of the electrical power to the output means; characterized by

backup means (150) for allowing the second battery means (121,122) to provide electrical power to the monitoring means (34;54) in the event that the first battery means (111,112) can no longer provide electrical power to the monitoring means."

Claims 2 to 8 are dependent claims.

VIII. The appellant essentially relied on the following submissions:

A substantial procedural violation had occurred in that the decision under appeal had not been adequately reasoned. In particular, in the context of deciding on inventive step and the relevance of the teachings given by documents E1 and E3, two key questions raised by the opponent had not been addressed in the reasons of the decision, namely that the skilled person was an electrical engineer and not a layman, and that it would have been a normal incentive for such a skilled person to keep the expenses for the circuit and its elements as low as possible. The appellant was thus not in a position to understand whether the contested decision was justified or not.

As regards substantive matters, claim 1 of the patent as granted contained subject-matter which was not originally disclosed, because the amendments made to claim 1 in examination comprised the deletion of limiting features from the wording of originally-filed claim 1, for which omission the application documents as filed did not provide a basis. Whereas originally-filed claim 1 was directed to a power system with two battery means having clearly separated functions,

wherein in particular the function of the first battery means was limited to the provision of power "*primarily only*" to the monitoring means as an indispensable prerequisite for a reliable prediction of the minimum expected life span of the first battery, claim 1 as granted comprised power systems without such a strict separation of functions of the two battery means.

If however, by applying a more generous standard for disclosure, the original application documents were considered to implicitly disclose the more general idea of the invention as specified by claim 1 of the patent, then this idea would have to be compared with the teaching of the prior art to the interpretation of which the same generous standard would have to be applied.

- IX. With respect to the issue of added subject-matter, the respondent as well as the opposition division have held that the subject-matter of claim 1 as granted was properly disclosed by originally-filed claim 3 being dependent on original claim 1. As regards the omission of the word "*only*" after "*primarily*", the original term "*primarily only*" was not considered more limiting than the present expression "*primarily*" in claim 1 as granted. Both terms encompassed the possibility of delivering electrical power to means other than the monitoring means. Thus, the deletion of "*only*" was merely a clarification which had no bearing on the scope of the claim. Moreover, the omitted result concerning the predictability of a minimum expected lifespan of the first battery means was also implicit to the subject-matter of patent claim 1. There was no contradiction to the added feature from original

claim 3 because the fact that the second battery means supported the first battery means did not prevent the minimum expected lifetime of the latter to be accurately determined.

As regards the issue of inventive step, document E1, being the only document on file which concerned an implantable cardioverter defibrillator, did not deal with the problem of depletion of the battery supplying the monitoring circuit. Moreover, there was no mentioning of a backup circuit for an exhausted battery. Document E3 related to a pacemaker having an emergency system for backing up the main battery powering the pacer. There was no suggestion to replace the emergency system with a cardioverter power battery.

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. *Amendments (Articles 100(c) and 123(2) EPC)*
 - 2.1 Claim 1 as granted is based on originally-filed claim 3, to which the following substantive amendments have been made:
 - (i) from the expression "*primarily only*" in the definition of the first battery means the word "*only*" has been omitted;

(ii) the phrase "*such that a minimum expected lifespan of the first battery means is predictable regardless of the electrical pulse therapies delivered by the implantable cardioverter defibrillator*" has been deleted.

2.2 The Board does not agree with the respondent and the judgement of the opposition division that the subject-matter of claim 1 as granted is identical to that of originally-filed claim 3.

As regards the distribution of labour between the two battery means for providing electrical power to the monitoring means, on the one hand, and the output means, on the other hand, originally-filed claim 3 requires a quasi-strict separation of functions with the first battery means providing power "primarily only" to the monitoring means and the second battery means providing "substantially all" of its power to the output means. Whereas the expression "primarily only" as such allows for the first battery means to serve to some extent further functions than powering the monitoring means, the functional definition provided by aforementioned feature (ii) implies that the extent of such further functions has to be limited so as not to jeopardize the predictability of the minimum expected lifespan of the battery. As a matter of fact, a minimum expected lifespan of the first battery means is predictable only if its current drain on demand of the circuitry to be supplied is known. This is in fact the case for the demand of the monitoring circuit, which is a known parameter, whereas the demand of the circuits of the output means is unpredictable as it depends on

the varying condition of the heart of a patient and the respective amount of therapy to be delivered.

Hence, by deleting the term "only" from the expression "primarily only" and abandoning the requirement for a predictable minimum expected lifespan of the first battery means, as in claim 1 of the patent as granted, the situation is changed. Now the claim wording covers circumstances for which the first battery means to a considerable extent take on further supply functions provided that the demand of further supply is lower than the demand of supply by the monitoring means. A predictability of the minimum expected lifespan is no longer required and would demand specific circumstances which are not the subject-matter of the claim under consideration. Thus the claim wording covers power systems the structure of which does not fall under the terms of originally-filed claim 3.

- 2.3 The question thus arises whether the subject-matter of claim 1 as granted would find support by other elements of the original disclosure.

In this context, it is noted that the amendments under consideration have no precedent in any of the other claims as originally filed.

As regards the description and figures of the original application, two examples of dual-battery systems are discussed which differ in the functions served by the battery means.

According to a first example as illustrated by Figures 2 and 3, the first battery means connects to and powers a monitoring circuit only, whereas the second battery means connects to and powers an inverter/output circuit only (see page 6, lines 26 to 29; and page 7, lines 5 to 8; of the published application). No backup means are foreseen. On the other hand, the life of the first battery means is independent upon the amount of therapy which may be delivered and thus the minimum effective life of the battery means is known and calculable, as specified in claim 1 as originally filed (see also page 9, lines 3 to 7, and 18 to 29).

The power system according to the embodiment of Figures 5a, 5b, and 6 comprises "first battery means" 111, 112 linked to a low voltage (3V) "main system power", and "second battery means" 121, 122 connected to a 5V to 6.5V bus for the pacing circuits and a 12V to 18V bus for an inverter gate drive.

As specified in the description of the originally filed application (page 12, line 29 to page 13, line 1), the main system power bus is supplied by the first battery means, *"unless the current draw on the Main System Power exceeds about 10 μ A"*. In the event of a current overdraw situation, such as when the microprocessor in the inverter/output circuitry 38 responds to a wake-up condition, the output of the second battery means is added to the output of the first battery means to generate the required current. Thus, the "main system power" bus provides electrical power not only to the monitoring means for detecting cardiac arrhythmias but

also to a microprocessor in the inverter/output circuitry 38.

In other words, the power system according to the embodiment of Figures 5a and 5b comprises first battery means for supplying a **limited amount of current to a low voltage main system power bus** which feeds **both** monitoring means and a microprocessor in the inverter/output circuit. If the current draw on the main system power **exceeds** the predetermined threshold of 10 μ A, the second battery means supplies additional current to the 3V bus. Hence, the "backup means" supporting the first battery means according to the embodiment of Figures 5a and 5b are quite different from backup means according to claim 1 under consideration, which become operative in the event that the first battery means can **no longer** provide electrical power, ie at the end-of-life of the first battery means.

As there is no disclosure in the application as originally filed of a power system comprising first battery means "for providing electrical power primarily to the monitoring means" and "backup means for allowing the second battery means to provide electrical power to the monitoring means in the event that the first battery means can no longer provide electrical power to the monitoring means", claim 1 under consideration contains subject-matter which extends beyond the content of the application as filed.

2.4 Therefore, claim 1 of the patent as granted does not comply with the provision of Article 123(2) EPC and the ground of opposition pursuant to Article 100(c) EPC is prejudicial to the maintenance of the patent.

3. *Alleged procedural deficiency - reimbursement of the appeal fee*

3.1 The appealed decision deals with the issue of inventive step in point 3.2 of the reasons. In this context, the teaching of document E1 and the problem arising therefrom is discussed in point 3.2.2. In point 3.2.3, a reasoning is given, why the invention was not rendered obvious by E1 and common considerations made by a skilled person. In point 3.2.4, the opposition division addresses the combination of the teachings of documents E1 and E3. In this context, the opposition division observes that neither E1 nor E3 (nor any of the other documents cited in the opposition) provided a clear teaching as to the characterising feature of claim 1 as granted.

3.2 Notwithstanding the fact that the reasons do not extensively discuss the "key questions" addressed by the appellant, the Board has no difficulty in understanding why the opposition division considered the invention to be novel and to involve an inventive step. Although the reasoning may be perceived as being short, the division's point of view becomes apparent, in particular from the finding in point 3.2.4, that, in the absence of any indication as to the characterising feature of claim 1 as granted, the respective expert would not have arrived at the claimed subject-matter without the exercise of inventive skill.

In the given circumstances, the Board cannot identify any relevant fact or argument which has been ignored by the opposition division. Moreover, the Board does not see any reason why the opponent would not have been in a position to understand the reasons for rejecting the opposition and to properly prepare its appeal. Whether the impugned decision is found convincing in the appeal is a matter of judgement and not a procedural issue (cf T 75/91, Case Law of the Boards of Appeal of the European Patent Office, 4th edition 2001, page 559).

3.3 For these reasons, the Board comes to the conclusion that the impugned decision is sufficiently reasoned and that the proceedings before the opposition division does not suffer from any procedural deficiency.

3.4 According to Rule 67 EPC reimbursement of the appeal fee shall be ordered by a board in the event where the board deems an appeal allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

As follows from the above, none of these prerequisites for reimbursement of the appeal fee is met in the present case.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

R. Schumacher

M. Rognoni