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

Case Number: T 0069/03 - 3.2.2

Application Number: 97940999.2

Publication Number: 0948732

IPC: A61M 25/01

Language of the proceedings: EN

Title of invention:

Single operator exchange biliary catheter

Applicant:

BOSTON SCIENTIFIC CORPORATION

Opponent:

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Headword:

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Relevant legal provisions:

EPC Art. 54

Keyword:

"Novelty (yes, after amendments)"

Decisions cited:

-

Catchword:

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Case Number: T 0069/03 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 4 May 2004

Appellant:

BOSTON SCIENTIFIC CORPORATION
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Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 29 July 2002
refusing European application No. 97940999.2
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: W. D. Weiß
Members: D. Valle
E. DufRASne

Summary of Facts and Submissions

I. The appellant (applicant) filed an appeal against the decision of the examining division to reject the application for lack of novelty on the basis of the documents:

D3: EP-A-0 388 112, or:

D1: US-A-5 540 236.

II. The following document, cited in the description of the application, is further relevant for the decision:

Dc1: US-A-5 397 302.

The appellant filed with letter of 5 April 2004 the further document:

Dc2: US-A-5 599 299,

which however does not belong to the state of the art for the application in suit, having been published after the priority date of the application in suit.

III. The board found it suitable to summon for oral proceedings, which were held on 4 May 2004.

IV. At the end of the oral proceedings the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims 1 to 10 of the main request as filed during the oral proceedings. Auxiliarily he requested that the decision under appeal be set aside and the case be

remitted to the examining division for further prosecution.

V. Claim 1 of this request reads as follows:

"A rapid exchange catheter for use in a biliary procedure endoscope (150), the catheter including: a shaft (38) having a proximal end (40) and a distal end (46), a guide wire lumen (60) carried by the shaft (38) extending longitudinally between the proximal end (40) and the distal end (46) of the shaft (38); a channel (42) for accessing the guide wire lumen (60) from a location exterior to the shaft (38), wherein the channel (42) extends longitudinally along the shaft (38) from a first end (54) to a second end (52), the first end (54) being located between 10 and 40 cm from the distal end (46) of the shaft (38) and the second end (52) of the channel (42) being located proximal of the first end (54); characterized in that the channel (42) length from the first end (54) to the second end (52) is such that when the shaft (38) is inserted through an endoscope being at least 150 cm long, during a biliary treatment of a patient performed by access via the alimentary canal, the channel (42) extends out of the patient, while the distal end (46) of the shaft (38) extends out of a distal opening of the endoscope."

VI. The appellant argued essentially that the last amendments had been made in order to overcome the objection of clarity against claim 1 and to better delimit the invention against the disclosure contained in the documents D1 and D3. Documents D1 and D3

belonged to a different field than that of the invention, namely that of the angioplasty catheters, whereas the invention dealt with catheters to be used in biliary procedures in connection with an endoscope. The closest state of the art should be therefore rather represented by the document Dc1.

Reasons for the Decision

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

The new set of claims is based on the original claims and on the original description, paragraph bridging pages 2 and 3; page 10, line 27; page 17, first full paragraph; paragraph bridging pages 17 and 18, and Figures 7, 7a.

3. *Clarity*

After the last amendments carried out during the oral proceedings the board has no objections any more against the clarity of the claims.

4. *Novelty*

Document D1, which was considered novelty destroying in the decision under appeal, discloses a rapid exchange catheter (10) for use in angioplasty, the catheter including a shaft having a proximal end and a distal end, a guide wire lumen carried by the shaft extending longitudinally between the proximal end and the distal

end of the shaft; a channel (62) for accessing the guide wire lumen from a location exterior to the shaft, wherein the channel extends longitudinally along the shaft from a first end to a second end, the first end being located between 10 and 40 cm from the distal end of the shaft (column 7, line 47: 20-30 cm) and the second end of the channel being located proximal of the first end.

The subject-matter of claim 1 differs from this state of the art by the features that the catheter is for use in a biliary procedure endoscope and that the channel (42) length from the first end (54) to the second end (52) is such that when the shaft (38) is inserted through an endoscope being at least 150 cm long, during a biliary treatment of a patient performed by access via the alimentary canal, the channel (42) extends out of the patient, while the distal end (46) of the shaft (38) extends out of a distal opening of the endoscope.

Document D3, which also has been considered as novelty-destroying by the decision under appeal, discloses a rapid exchange catheter (10) for use in angioplasty, the catheter including a shaft having a proximal end and a distal end, a guide wire lumen (18) carried by the shaft extending longitudinally between the proximal end and the distal end of the shaft; a channel (26) for accessing the guide wire lumen from a location exterior to the shaft, wherein the channel extends longitudinally along the shaft from a first end to a second end.

The subject-matter of claim 1 differs therefrom by the features that the catheter is for use in a biliary

procedure endoscope, that the first end of the channel is located between 10 and 40 cm from the distal end (46) of the shaft (38), and that the channel (42) length from the first end (54) to the second end (52) is such that when the shaft (38) is inserted through an endoscope being at least 150 cm long, during a biliary treatment of a patient performed by access via the alimentary canal, the channel (42) extends out of the patient, while the distal end (46) of the shaft (38) extends out of a distal opening of the endoscope.

The further available documents of the state of the art are farther away from the invention as claimed in claim 1. Document Dc1 discloses a catheter for use in a biliary procedure similar to the invention, but does not comprise any channel.

Accordingly the subject-matter of claim 1 is novel.

5. Since the grounds of the decision under appeal do not apply to the claims as presently amended, but further requirements for the patentability, in particular inventive step, have not yet been commented upon by the examining division, the board exercises its power and remits 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:

V. Commare

W. D. Weiß