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D E C I S I O N
of 13 April 2005

Case Number: T 0530/03 - 3.2.2

Application Number: 98116421.3

Publication Number: 0876793

IPC: A61B 17/00

Language of the proceedings: EN

Title of invention:
Septal Defect Closure Device

Applicant:
REGENTS OF THE UNIVERSITY OF MINNESOTA

Opponent:

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Headword:

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Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"Added subject-matter (claim 1) no"

Decisions cited:

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Catchword:

-



Case Number: T 0530/03 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 13 April 2005

Appellant:

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Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 19 December 2002
refusing European application No. 98116421.3
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: T. K. H. Kriner
Members: S. S. Chowdhury
E. J. Dufrasne

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division dated 19 December 2002 to refuse European patent application No. 98 116 421.3. This application was divided out of the parent application 93 903 592.9 (WO-A-93/13712).

The application was refused on the grounds that claim 1 of the main request and the three auxiliary requests contained subject-matter extending beyond the content of the originally filed parent application, contrary to Article 76 EPC.

II. On 21 February 2003 the appellant (applicant) lodged an appeal against the decision and paid the prescribed fee on the same date. On 28 April 2003 a statement of grounds of appeal was filed.

III. The appellant requests that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution on the basis of claims 1 to 30 submitted by telefax dated 12 April 2005.

IV. Claim 1 reads as follows:

"A septal closure device (10) comprising first and second occluding discs (20, 30) which include a biologically compatible membrane, and optionally a frame about its periphery which, in use, pulls the membrane taut, characterised in that when the discs include a frame, the membrane and/or frame is formed from a superelastic material, or when the discs do not include a frame, the membrane is formed from a

superelastic material such that each disc is capable of being collapsed for passage through a catheter and elastically returning to a predetermined shape and wherein a central portion of the membrane of each disc is affixed to a corresponding portion of the other disc to define a central conjoint disc."

Reasons for the Decision

1. The appeal is admissible.

2. *Article 76(1)*

2.1 Following a communication from the Board to the effect that the objections of the first instance, regarding the omission of certain features from claim 1 of the parent application as filed appeared to be justified, the appellant filed the above set of claims in which the omitted features were re-instated. The omitted features concern the centrally conjoined disks, the biocompatibility of the membranes, and the collapsible nature of the frame.

The appellant thereby overcame the objections that led to the decision to refuse the application. However, the appellant has introduced new features into claim 1, and it remains to be examined whether these meet the requirements of Article 76(1) EPC.

2.2 The main amendment to present claim 1 arises from the fact that the appellant defines the frame as an optional feature, and the properties of the frame and

membrane when the frame is present and absent from the claimed closure device, respectively.

In this respect, the following features, which were not present in original claim 1, are defined in new claim 1:

- (a) An optional frame
- (b) when the disks include a frame, the membrane and/or frame is formed from a superelastic material
- (c) or when the disks do not include a frame, the membrane is formed from a superelastic material.

2.3 The claim no longer defines a flexible membrane, which was in original claim 1, but this is an implicit feature of the membrane since this must be collapsable for passage through a catheter.

2.4 Feature (a) is supported by the parent application as originally filed, the description makes it clear that the frame is optional, see page 7, lines 15 to 17 of WO-A-93/13712.

Feature (b) is similarly supported since there is disclosure of the frame or membrane being of superelastic material (page 7, lines 15 to 17 and page 9. last paragraph), and also of the frame and membrane being of superelastic material (see page 6, lines 28 and 29, and page 9, lines 26 and 27 for example).

Feature (c) is also supported by page 7, lines 15 to 17.

- 2.5 All the amendments to claim 1 meet the requirements of Article 76(1) EPC, accordingly. The description of the daughter application as filed is identical with the original description of the parent application. Therefore, Article 123(2) EPC is also satisfied .
3. The above comments concern only claim 1. It is noted that some of the dependent claims on file (for example, claims 5 and 6) do not have a counterpart in the original claims of the parent application, and an examination of these claims for compliance with Article 76(1) EPC and Article 123(2) EPC is still pending.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of claims 1 to 30 submitted by telefax dated 12 April 2005.

The Registrar:

The Chairman:

V. Commare

T. K. H. Kriner