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D E C I S I O N
of 9 March 2005

Case Number: T 0346/04 - 3.2.2

Application Number: 98906608.9

Publication Number: 0966231

IPC: A61B 17/32

Language of the proceedings: EN

Title of invention:
Endoscopic surgical instrument

Applicant:
SMITH & NEPHEW RICHARDS, INC.

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 54

Keyword:
"Novelty (yes, after amendments)"

Decisions cited:
-

Catchword:
-



Case Number: T 0346/04 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 9 March 2005

Appellant: SMITH & NEPHEW RICHARDS, INC.
1450 Brooks Road
Memphis, TN 38116 (US)

Representative: Boakes, Jason Carrington
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 20 October 2003
refusing European application No. 98906608.9
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: T. K. H. Kriner
Members: D. Valle
U. J. Tronser

Summary of Facts and Submissions

I. The appellant (applicant) lodged an appeal, on 18 December 2003, against the decision of the examining division posted on 20 October 2003 refusing the European patent application No. 98906608.9. The fee for appeal was paid simultaneously and the statement setting out the grounds of appeal was received on 27 February 2004.

II. The examining division held that the application did not meet the requirements of Article 52(1) EPC in conjunction with Article 54 EPC, having regard to the document D1 = EP-A-0 286 415.

III. The following further documents have been cited in the search report:

D2 = US-A-5 403 276

D3 = US-A-4 678 459

D4 = WO-A-96/32894

D5 = US-A-5 312 327

D6 = WO-A-92/03099.

IV. The appellant requested that the decision under appeal be set aside and a patent be granted on the basis of claims 1 to 11 filed with letter of 27 February 2004.

With letter dated 28 February 2005, the appellant withdrew his request for oral proceedings and requested that a decision on the present case be issued in writing.

V. Claim 1 reads as follows:

"An endoscopic surgical instrument (10) comprising a surgical implement (17) disposed at a distal region of the surgical instrument (10), and a device associated with the surgical implement in a manner to define a path for conveying irrigation fluid from a proximal region of the surgical instrument to said surgical implement and removing fluid, tissue and bone debris from said surgical implement to said proximal region of said surgical instrument, wherein said surgical instrument comprises an outer tube (12) surrounded by an irrigation sheath (20) and fluid is conveyed to said surgical implement through a passage (22) located between said irrigation sheath (20) and said outer tube (12), said surgical instrument also comprising an inner tube (16) within said outer tube (12) and fluid is removed from said surgical implement through said inner tube (16) characterized in that the outer tube (12) has an opening (14) at the distal region of the surgical instrument and said irrigation sheath (20) surrounds said surgical implement (17) and has an opening (23) at its distal region that is in communication with the opening (14) in said outer tube."

VI. In support of his request, the appellant relied essentially on the following submissions:

As acknowledged by the examining division, D1 did not disclose an opening in the outer tube at the distal region of the surgical instrument. Moreover, in D1 the outer irrigation sheath (42) terminated near the cutter blade (see Figure 3). Hence, D1 did not disclose an irrigation sheath that surrounded the surgical

implement, and had an opening at its distal region that is in communication with an opening in the outer tube. Consequently the subject-matter of claim 1 was novel.

Reasons for the Decision

1. The appeal is admissible

2. *Amendments*

The features of claim 1 are disclosed in claims 1 - 4, 18, and in the description, page 4, lines 10 - 13, page 6, lines 5 - 8 of the published application (WO-A-98/36695). Claims 2 to 11 are based on claims 5 to 14 of WO-A-98/36695.

Accordingly, the present claims meet the requirements of Article 123(2) EPC.

3. *Novelty*

3.1 D1 discloses, in particular in its Figure 1, an endoscopic surgical instrument comprising a surgical implement (cutter 20) disposed at a distal region of the surgical instrument, and a device associated with the surgical implement in a manner to define a path for conveying irrigation fluid from a proximal region of the surgical instrument to said surgical implement and removing fluid, tissue and bone debris from said surgical implement to said proximal region of said surgical instrument, wherein said surgical instrument comprises an outer tube (18) surrounded by an irrigation sheath and fluid is conveyed to said

surgical implement through a passage located between said irrigation sheath and said outer tube (see column 1, lines 52 - 56; and column 5, lines 28 - 31), said surgical instrument also comprising an inner tube (16) within said outer tube and fluid is removed from said surgical implement through said inner tube (see column 1, lines 45 - 47, column 3 lines 42 - 44), the outer tube having an opening at the distal region of the surgical instrument (for the passage of the inner tube 16, see Figure 1) and said irrigation sheath having an opening at its distal region.

However, D1 does not disclose that said irrigation sheath surrounds said surgical instrument, and that the opening of the irrigation sheath is in communication with the opening in said outer tube.

In the embodiment of Figure 3 of D1 the surgical instrument (35) is on the edge of the distal end of the irrigation sheath (42). That means that - even if the skilled person considered this arrangement of the irrigation sheath for the surgical instrument shown in Figure 1 of D1 - this would not result in an embodiment wherein the irrigation sheath surrounds the surgical instrument. Moreover, since the opening in the outer tube is obstructed by the inner tube, the opening cannot be in communication with the opening in the outer tube.

3.2 The documents D2 to D6 are less relevant than D1.

D2 discloses an endoscopic surgical instrument comprising a surgical implement (85, Figure 3) disposed at a distal region of the surgical instrument, an outer

(15) and an inner (78) tube (see Figure 3). However, D2 does not disclose that the instrument comprises an irrigation sheath, that the fluid is conveyed to said surgical implement through a passage located between said irrigation sheath and said outer tube, and that fluid is removed from said surgical implement through said inner tube (according to D2 the fluid is conveyed through the hollow inner tube and removed through the passage between the inner and outer tube).

D3 discloses an endoscopic surgical instrument comprising a surgical implement (cutting edges 44, 48) disposed at a distal region of the surgical instrument, an outer (16) and an inner (42) tube, wherein that fluid is removed from said surgical implement through said inner hollow tube. However D3 does not disclose that the instrument comprises an irrigation sheath and that the fluid is conveyed to said surgical implement through a passage located between said irrigation sheath and said outer tube.

D4, D5 and D6 do not disclose an irrigation sheath.

- 3.3 With respect to the above findings, the subject-matter of claim 1 is novel.
4. Since the further requirements for patentability have not yet been examined by the first instance, the board finds it appropriate to remit the case to the first instance 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 first instance for further prosecution on the basis of the following documents:

Claims: 1 to 11 filed with letter of
27 February 2004

Description: pages 1 to 7 as published in
WO-A-98/36695

Drawings: Figures 1 to 5 as published in
WO-A-98/36695.

The Registrar:

The Chairman:

V. Commare

T. Kriner