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**Datasheet for the decision
of 20 September 2007**

Case Number: T 0037/05 - 3.2.02

Application Number: 98201833.5

Publication Number: 0867148

IPC: A61B 17/00

Language of the proceedings: EN

Title of invention:

Devices for endoscopic vessel harvesting

Applicant:

Datascope Corp., et al

Opponent:

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Headword:

-

Relevant legal provisions:

EPC Art. 76(1), 123(2)

Keyword:

"Divisional application - extended subject-matter (no)"

Decisions cited:

-

Catchword:

-



Case Number: T 0037/05 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 20 September 2007

Appellant: Datascope Corp.
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Montvale NJ 07645 (US)

Representative: Mercer, Christopher Paul
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 27 July 2004
refusing European application No. 98201833.5
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: T. Kriner
Members: M. Noel
M. Vogel

Summary of Facts and Submissions

I. European divisional application No. 98201833.5 was refused by decision of the examining division dated 27 July 2004 on the basis of Article 76(1) EPC.

The first instance considered that the omission of the term "transparent" in the definition of the spoon-shaped head in claim 1 extended the subject-matter of this claim beyond the content of the earlier application as originally filed.

II. The appellant (applicant) lodged an appeal against this decision, by notice received on 1 October 2004 and paid the appeal fee on the same day. A statement setting out the grounds of appeal was filed on 6 December 2004 along with various sets of amended claims according to a main request and auxiliary requests 1 to 7.

III. As a result of a communication of the Board sent on 4 July 2007, the appellant requested, by letter dated 30 August 2007, that the case be remitted to the examining division for further prosecution on the basis of the seventh auxiliary request.

IV. The two claims of this request read as follows:

"1. A device (20) for retracting tissue comprising:
an elongated platform (21);
a transparent, concave head (26) connected to a distal end of the platform (21), the head (26) having a spoon-shape and defining a cavity (28) that provides a working space for permitting an instrument (30; 40; 50) to be inserted therein; and

means (22) for connecting an endoscope (5) to the platform (21) for visualisation of the cavity (28), wherein said means (22) for connecting an endoscope (5) to said platform (21) comprises a shaft (22) connected at an underside (21a) of said platform (21), said shaft (22) having a lumen (23) extending therethrough."

"2. A device (20) for retracting tissue comprising:
a transparent, working head (26) having a spoon-shape and defining a cavity (28) therein for providing a working space for accommodating an end effector (32, 34) of an instrument (30;40;50); and
means (11) for detachably connecting one end (19) of the head (26) to a distal end (6) of an endoscope (5)."

Reasons for the decision

1. The appeal is admissible.
2. *Article 76(1) EPC*

According to Article 76(1) EPC a European divisional application may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed.

As referred to in the EPO form "Request for Grant of a European Patent" dated 2 June 1998 and the accompanying letter from the appellant, the application was filed as a divisional application No. 98201833.5 with a description, claims and drawings which were all identical to those of the earlier application

No. 96307590.8. Therefore, at the time the divisional application was filed, the requirements of Article 76(1) EPC were met.

Once the conditions of Article 76(1) EPC have been met, the divisional application is to be examined as an application quite separate from the parent application and has itself to comply independently with all the various requirements of the EPC. With respect to amendments made to the claims after the filing date a divisional application therefore has to meet the requirements of Article 123(2) EPC.

3. *Article 123(2) EPC*

Independent claim 1 at issue refers to a device for retracting tissue. It is supported by claim 9 of the divisional application as filed, supplemented by features drawn up from the description.

In particular, in the second feature of claim 1, the expression "that provides a working space" is taken from the application as filed on page 8, line 29. The expression "for visualisation of the cavity (28)" in the third feature can be derived from the passage from page 8, line 26 to page 9, line 4 and Figures 5 and 9. The remainder of the third feature "wherein said means (22) for connecting an endoscope (5) to said platform (21) comprises a shaft (22) connected at an underside (21a) of said platform (21), said shaft (22) having a lumen (23) extending therethrough" is fairly supported by page 8, lines 16 to 19 of the divisional application as filed.

Consequently, the amendments to claim 1 do not extend its subject-matter beyond the content of the divisional application as filed, in accordance with the requirements of Article 123(2) EPC.

4. *Formal aspects*

In the extent that the term "transparent" was reintroduced in claim 1 in order to specify the essential nature of the concave head of the retracting device with the view to improve the visibility and illumination in the region of operation, the subject-matter of claim 1 is also clear and complete with respect to the problem set and satisfies the requirements of Article 84 and Rule 29(1) and (3) EPC.

Claim 2 defines the retracting device of the application in other words and in a broader form. However, a second independent claim of the same category as claim 1 does not appear to be justified in the present case (see Rule 29(2) EPC). For the subsequent prosecution of the case it would be appropriate, therefore, to render this claim dependant to claim 1 so as to restrict its subject-matter to additional features only, i.e. to an end effector (32, 34) and connecting means (11) (see Rule 29(4) EPC).

5. *Remittal*

Since the decision under appeal was exclusively based on the grounds of Article 76(1) EPC, and since the claims presently on file have been substantially amended, the Board finds it appropriate to remit the

case to the first instance for further prosecution, as requested by the appellant.

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 on the basis of claims 1 and 2 of the seventh auxiliary request submitted with the appellant's letter dated 6 December 2004.

The Registrar:

The Chairman:

V. Commare

T. Kriner