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Datasheet for the decision of 7 February 2008

Case Number: T 1080/05 - 3.2.02

Application Number: 03076758.6

Publication Number: 1340465

IPC: A61B 17/28

Language of the proceedings: EN

Title of invention:
Surgical device with malleable shaft

Applicant:
Allegiance Corporation

Opponent:
-

Headword:
-

Relevant legal provisions (EPC 1973):
EPC Art. 56

Keyword:
"Inventive step (no)"

Decisions cited:
T 0056/87

Catchword:
-

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Case Number: T 1080/05 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 7 February 2008

Appellant: Allegiance Corporation
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Representative: Dee, Ian Mark
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 27 April 2005 refusing European application No. 03076758.6 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: T. Kriner
Members: M. Noël
A. Pignatelli

Summary of Facts and Submissions

I. European patent application No. 03076758.6 was refused by decision of the examining division dated 27 April 2005 on the ground that the claimed subject-matter lacked inventive step under Article 56 EPC vis-à-vis the prior art documents:

D1: US-A-4483562, and
D2: US-A-3858578.

II. The appellant (applicant) lodged an appeal on 14 June 2005 and paid the appeal fee on 16 June 2006. A statement setting out the grounds of appeal was filed on 18 August 2005.

The appellant requested that the application be allowed on the basis of the set of claims filed with the letter dated 10 September 2004. Auxiliarily he requested oral proceedings.

III. In consequence of a communication of the Board annexed to the summons to oral proceedings dated 15 November 2007, the appellant informed the Board by letter of 18 January 2008 that he would not be attending the oral proceedings.

Instead he requested that a decision on the state of the file as it stands, be issued.

IV. Claim 1 reads as follows:

"A surgical device (10) having a longitudinal axis extending between a proximal end and a distal end, comprising:

tissue engaging means (16) including first and second opposed jaws (246,248) for grasping, securing, and occluding body tissue and conduits, the tissue engaging means further including a hinged end (250) at which the jaws are hinged together;

a shaft member (214) operatively coupled to the tissue engaging means, the shaft member being capable of being placed in different curvatures and comprising a series of interconnected segments (38), each segment comprising a socket section and a ball shaped member that cooperate with a ball shaped member and a socket section on adjacent segments;

a handle assembly (12) operatively coupled to the shaft member and to the tissue engaging means; and

a jaw actuating means (231) for actuating the jaws of the tissue engaging means (16) between an open position and a closed position, the jaw actuating means extending through the shaft member and being operatively connected to the tissue engaging means and to the handle assembly."

V. In its written submissions the appellant asserted that the device as disclosed in D1 would not actually work. The skilled person, therefore, would have disregarded this deficient document as an invalid prior art. D2 was not related to the problem addressed by the present invention and did not appear to be suitable for insertion into small incisions. The choice of D2 to be

combined with D1, therefore, was influenced by the use of hindsight.

Reasons for the Decision

The Board draws the attention of the party to the fact that, since this decision is issued after the entry into force of the EPC 2000 on 13 December 2007, the transitional provisions according to Article 7 of the Act revising the EPC of 29 November 2000 and the Decisions of the Administrative Council of 28 June 2001 and of 7 December 2006, Article 2, have been applied. When Articles or Rules of the old version of the EPC (1973) are cited, the year is indicated.

1. The appeal is admissible.

2. *Closest prior art*

2.1 D1 represents the state of the art coming closest to the invention. Following the wording of claim 1 in suit, D1 discloses (see Figures 1 to 4):

a surgical device 1 having a longitudinal axis extending between a proximal end and a distal end, comprising:

tissue engaging means 5 including first and second opposed jaws 12, 14 for grasping body tissue and conduits, the tissue engaging means further including an end 96 at which the movable jaw 12 is hinged (see Figure 4);

a shaft member 2 operatively coupled to the tissue engaging means 5, the shaft member being capable of being placed in different curvatures (see column 5, lines 39 to 53) and comprising a series of interconnected segments 3, each segment comprising a socket section 31 (spacer) and a ball shaped member 33 (sphere) that cooperate with a ball shaped member and a socket section on adjacent segments (see Figures 1 and 2 and column 3, lines 63 to 68);

a handle assembly 7,59 operatively coupled to the shaft member 2 and to the tissue engaging means 5; and

a jaw actuating means 10,64 (articulation member) for actuating the jaw 12 between an open position and a closed position, the jaw actuating means extending through the shaft member 2 and being operatively connected to the tissue engaging means 5 and to the handle assembly (see column 4, lines 23 to 32).

The subject-matter of claim 1 differs from the disclosure of D1 in that:

– both jaws are hinged together at hinged end (see Figure 6a), whereas in D1 only one jaw 12 is pivotably connected to the end 96, while the other jaw 14 is stationary (see Figure 4);

– each segment of the shaft member (see Figures 7c to 7e) comprises a socket section and a ball shaped member formed integrally, whereas in D1 the shaft members 3 include a plurality of separate and alternating spacers and spheres.

2.2 The appellant submitted that D1 should be disregarded as not being a valid prior art because of a deficient disclosure. According to him, any attempt to apply tension to the tensioning member 8 (wire 9) of D1 would inevitably result in a straightening of the device. That is, as soon as tension is applied to the wire, the shaft 2 would automatically return to a straightened configuration and would not be actually capable of being placed at different curvatures.

The Board does not share this view since D1 clearly discloses (see column 5, lines 39 to 53) that after the shaft has been placed in the desired shape, the tensioning member 8 is biased so as to force the shaft members 3 (spacers 31 and spheres 33) into frictional contact with each other, thereby to rigidly retain the shaft in the desired shape. Therefore, any configuration can be obtained by the plurality of shaft members which are free to move relative to each other and then rigidly locked in the desired position.

Contrary to the appellant's contention, it is not justified to arbitrary derive from a document a technical information which would be distinct from or even in contradiction with the integral teaching of the document. In this respect, a schematic representation of a technical feature is not determinative (see T 56/87).

As suggested by the appellant, when tension is applied to the tensioning member 8 of the device of D1, the latter is likely to return to a straightened configuration. However, the same is true for the device of the present application. When axial compression is

applied by means of the tightening means 42 to the segments 38 placed e.g. in the curved configuration of Figure 7e, straightening of the shaft is likely to occur. Nevertheless the segments are locked in the desired shape as reported in paragraph [18] of the application as published. Therefore, the arguments set forth by the appellant are not convincing and D1 is not regarded as a technically deficient disclosure.

3. *Inventive step*

The first distinguishing feature of claim 1 reported in point 2.1 above, represents a mere design option which may be provided by the skilled person without the exercise of inventive step. As a matter of fact, hinging together a pair of jaws as shown in Figure 6a of the present application instead of providing a stationary jaw and a movable jaw on a common attachment element 88 as shown in Figure 4 of D1, is considered as a matter of a normal design procedure.

The second distinguishing feature (interconnected segments) answers the general problem underlying the present application, which is to provide a surgical device with a malleable (flexible) shaft that allows the surgeon to bend it in the desired shape so as to achieve proper positioning (see application, paragraphs [7] and [18]). This problem, however, has already been solved by D1 with similar means (see column 1, lines 6 to 11) including a plurality of alternating spacers 31 and spheres 33, the spacers having at both ends a generally hemispherical indentation 36 which mates with a surface 40 of an adjacent sphere (Figure 4 and column 3, lines 63 to 68).

The objective problem, therefore, is more specific and must be restricted to the provision of an alternative constructional embodiment for the interconnected segments of the shaft member.

A shaft member comprising a series of interconnected segments, each segment comprising, in a one-part-form, a socket section and a ball shaped member that cooperate with a ball shaped member and a socket section on adjacent segments, is known from document D2 (see Figure 2 and column 2, lines 4 to 20). Like the present application, the purpose of such a flexible structure is to control the rigidity of the shaft member (retaining arm B in D2) when placed in a desired position (see column 1, "Summary"). The skilled person, therefore, will consider D2 as a relevant prior art. The other features disclosed by D2 are not to be considered because the skilled person who is starting from the closest prior art D1 and who is only looking for an alternative for making the interconnected segments will immediately find in D2, which belongs to the same technical field, a suitable solution.

Therefore, the subject-matter of claim 1 is obvious for the skilled person. As a consequence, the requirements of Article 56 (1973) EPC are not met.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

V. Commare T. Kriner