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**Datasheet for the decision
of 11 March 2008**

Case Number: T 1210/06 - 3.2.02

Application Number: 95916920.2

Publication Number: 0754016

IPC: A61F 2/06

Language of the proceedings: EN

Title of invention:
Self-expandable stent and stent-graft

Patentee:
Gore Enterprise Holdings, Inc.

Opponent:
Boston Scientific Corporation

Headword:
-

Relevant legal provisions:
EPC Art. 100(c), 123(2)

Keyword:
"Amendments - added subject-matter (no)"

Decisions cited:
-

Catchword:
-



Case Number: T 1210/06 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 11 March 2008

Appellant: Gore Enterprise Holdings, Inc.
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Representative: Shanks, Andrew
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Respondent: Boston Scientific Corporation
(Opponent) One Boston Scientific Place
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Representative: Vossius & Partner
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 30 May 2006
revoking European patent No. 0754016 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: T. Kriner
Members: S. Chowdhury
M. J. Vogel

Summary of Facts and Submissions

I. The appellant (patent proprietor) lodged an appeal against the decision of the opposition division to revoke European patent No. 0 754 016.

II. The opposition was filed against the whole patent and based on Article 100(a) EPC (lack of novelty and inventive step) and Article 100(c) EPC.

With its decision posted on 30 May 2006 the Opposition Division held that the claims on file did not meet the requirement of Article 123(2) EPC, and revoked the patent on the basis of Article 100(c) EPC.

III. A notice of appeal against this decision was filed on 3 August 2006 and the appeal fee was paid on the same day. The statement of grounds was submitted on 6 October 2006.

IV. Oral proceedings were scheduled for 11 March 2008 but were cancelled after the respondent stated its intention of not attending (see letter of 13 February 2008), and the appellant stated its wish to withdraw the request for oral proceedings if the Board intended to decide in its favour as regards Article 123(2) EPC (see letter of 27 February 2008). The following requests were made in writing:

The appellant implicitly requested that the decision under appeal be set aside and that the Board decide that claim 1 as granted meets the requirement of Article 123(2) EPC.

The appellant also filed auxiliary requests 1-16.

The respondent (opponent) requested that the appeal be dismissed.

V. Independent claim 1 as granted reads as follows: -

"A device comprising: a tubular self-expanding stent (122) defined by a helically wrapped undulating member (100) containing multiple turns about a common longitudinal axis, said undulating member containing a plurality of undulations, each undulation having an apex (104), two arms (106) and an amplitude; and a flexible linkage (124) weaved to extend through the undulations of adjacent turns from one turn of the helix to the other and maintaining an undulation of one helical turn in phase with an undulation in an adjacent helical turn; characterised in that said undulations are open or unconfined at their apex such that the flexible linkage (124) may move unconstrainedly away from each apex, and said apex (104) does not have any means in that apex that would tend to inhibit the movement of the flexible linkage (124) down between the arms of the undulations."

Claims 2 to 12 are dependent claims.

VI. The parties argued as follows:

Appellant

The formulation of the two features of the characterising part of claim 1 was directly equivalent to the formulation in the description as filed and

consistent with page 17, lines 24 to 27, for example. It was clear to the person skilled in the art that a helically wrapped undulating member would be subject to twisting when the member was distorted, so reference to twisting in claim 1 was superfluous.

Respondent

During the examination procedure claim 1 was amended to include two features related to the performance of the stent during compression thereof, and these features became clear only after reference to the description. However, the entire disclosure of the application relating to the shape of the apex and the possibility of movement was restricted by the limitation on page 17, lines 21 to 27 of the application as originally filed, according to which this function was clearly linked to the compression of the stent. Deletion of this text added subject-matter which extended the scope of the application as filed.

Moreover, at least two features of original claim 1, which were described as essential to the invention, were missing from claim 1 as granted. These were that the stent had a generally cylindrical form, and the stent comprised at least one assembly comprising at least one torsion member being situated so that when the assembly was distorted the torsion member was twisted. There was no basis in the application as originally filed for deletion of these essential features from claim 1.

Reasons for the decision

1. The appeal is admissible.
2. *Article 100(c) EPC*
 - 2.1 The feature: "generally cylindrical form with two ends and a passageway" in original claim 1 has been replaced in granted claim 1 by "a tubular stent defined by a helically wrapped undulating member containing multiple turns about a common longitudinal axis". This latter form necessarily has a generally cylindrical form with two ends and a passageway so that this feature of original claim 1 is implicit in granted claim 1.
 - 2.2 A torsion member is a member which is susceptible of twisting when the stent is compressed so that the structure may be folded to a small diameter (see page 17, lines 8-11 and page 29, lines 6-14 of WO 95/26695). The application defines a torsion member as an undulating member (page 26, lines 18-20), which in practice is formed from a wire and is inherently susceptible of twisting. This feature is also implicit in granted claim 1, accordingly.
 - 2.3 The opponent has argued that movement of the flexible linkage in the undulations and away from the apex is linked to compression of the stent since the passage on page 17, lines 24-27 of the application talks of this unrestricted movement of the linkage during compression. This argument is incorrect since the application is clearly not restricted to this, it also covers movement of the linkage owing to other forces, see page 28, lines 14-16, for example.

2.4 The opponent's arguments that the characterising features of claim 1 are of uncertain scope is somewhat contrived. The Board considers the wording "the flexible link may move unconstrainedly" to be fully equivalent to "the flexible link is free to move unconstrainedly". The claim and supporting disclosure clearly mean that the linkage may move away from any apex when there is a force on the linkage. For example, page 28, lines 14-16 says that the flexible linkage (124) is free to move away from the apex at the end members (104) without constraint.

2.5 Therefore, claim 1 meets the requirement of Article 123(2) EPC.

3. The opposition division has not yet given a decision with respect to Article 100(a) EPC so it is appropriate to remit the case for further processing.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of the first instance for continuation of the opposition procedure on the basis of the patent as granted.

The Registrar

The Chairman

V. Commare

T. K. H. Kriner