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**Datasheet for the decision
of 2 March 2010**

Case Number: T 1716/06 - 3.2.02

Application Number: 98920272.6

Publication Number: 0983022

IPC: A61B 17/00

Language of the proceedings: EN

Title of invention:

Apparatus and method for developing an anatomic space for laparoscopic procedures

Applicant:

GENERAL SURGICAL INNOVATIONS, INC.

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 52, 54, 56, 123(2)

Relevant legal provisions (EPC 1973):

-

Keyword:

"Extended subject-matter (no)"

"Novelty (yes)"

"Inventive step (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 1716/06 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 2 March 2010

Appellant: GENERAL SURGICAL INNOVATIONS, INC.
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Norwalk, CT 06856 (US)

Representative: Viering, Jentschura & Partner
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 28 April 2006
refusing European patent application
No. 98920272.6 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: M. Noel
Members: P. L. P. Weber
M. J. Vogel

Summary of Facts and Submissions

I. The appeal is directed against the decision of the Examining Division dated 28 April 2006 to refuse the European patent application because of lack of inventive step of the subject-matter of claim 1 according to the main request and because claim 1 according to the auxiliary request contravened Article 123(2) EPC.

The appeal was filed on 5 July 2006 and the appeal fee was paid on the same day.

The statement setting out the grounds of appeal was filed on 4 September 2006.

II. The relevant prior art is represented by:

D1 : US-A-5540711

III. Oral proceedings were held on 2 March 2010.

The appellant requested that the decision under appeal be set aside and that a patent be granted in the following version:

- claims 1-7 as filed during the oral proceedings
- description:
pages 2,3,6,7,9,12,14-23 as originally filed,
pages 1,5,8,10,11,24 as filed on 4 September 2006,
pages 4,13 as filed during the oral proceedings;
- drawings sheets 1/5, 3/5-5/5 as originally filed
and sheet 2/5 as filed on 10 October 2005.

IV. Claim 1 according to the only request reads as follows:

" A laparoscopic apparatus for creating an anatomical working space between tissue layers in a body, said apparatus comprising:

a tunneling member (20) comprising a rigid shaft (22) having open proximal (24) and distal (26) ends, and having a passage (28) extending therethrough between said proximal and distal ends (24, 26), said passage being adapted to receive a laparoscope therein, said distal end (26) including a retaining lip (30) thereon adapted to retain the laparoscope from extending beyond said distal end (26), said lip (30) extending radially inwardly from a part of the perimeter of said shaft (22) around said distal end and partially defining an opening (32) adjacent the axis of the shaft (22), the opening (32) defining an oblique edge when seen in a plan view of the shaft (22); and

a balloon (40) having an inflatable space and being capable of assuming collapsed and inflated conditions, said balloon (40) having a proximal sleeve for receiving said distal end (26) of said tunneling member (20) therein,

characterized in that

the distal end (26) is truncated perpendicularly (Fig.2A) to the axis of the tunneling member(20) to provide a blunt distal edge (34) of said lip (30), thereby extending the opening (32) by an axially recessed center area (36) of the lip (30), partially surrounded by the distal edge (34) in a U-shaped manner,

to allow a straight laparoscope to be used to view axially out of the distal end (26) of the shaft (22) through said center area (36)."

V. The arguments of the appellant can be summarised as follows:

Contrary to the opinion of the Examining Division the skilled man reading the originally filed application and seeing in particular Figures 2A and 2B would understand that the improvement of the invention over the prior art resided in the additional central recess around the axis of the tunneling member, which allowed an enhanced field of view in the direction of the axis of the tunneling member. The skilled man understood that the U-shape of the lip provided the enlargement of the central area of the opening at the distal end of the tunneling member and that this U-shape was obtained by the truncation of the distal end, as could be seen from the vertical line in Figure 2A.

The subject-matter of claim 1 was thus directly and unambiguously derivable from the originally filed application documents, so that it fulfilled the requirements of Article 123(2) EPC.

The subject-matter of claim 1 was novel as none of the prior art documents cited in the search report disclosed a recessed center area partially surrounded by the distal edge in a U-shaped manner. It was also inventive since the skilled man who had numerous other possibilities at his disposal for enlarging the central part of the distal end of the tunneling member choose

the solution proposed by the invention, which was surprisingly simple and efficient.

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments*

The amendments made to claim 1 concern mainly the following features:

- i) the opening (32) defining an oblique edge when seen in a plan view of the shaft (22)
- ii) the distal end (26) is truncated perpendicularly (Figure 2A) to the axis of the tunneling member(20) to provide a blunt distal edge (34) of the lip (30)

Feature i) is in the first part of claim 1. Nowhere in the description is the word "oblique" used. However Figure 2A, which is a plan view of the distal end of a tunneling member in accordance with the invention (see page 11, lines 4-6), clearly shows the oblique edge which is meant. The reader of the patent application as a whole would also expect such an oblique edge as it corresponds to the cut according to the state of the art described on page 3, lines 8 to 13, of the originally filed application. The present invention is an improvement over said prior art in that it aims at avoiding the problems mentioned on page 4 of the same originally filed description. Consequently although this oblique edge is only visible in Figure 2A, it is in line with the teaching of the application as the

invention unmistakably starts from a distal end of the tunneling member having such an oblique edge.

Feature ii) is in the characterising portion of claim 1 and thus more directly concerned with the improvement made over the prior art. Starting from the prior art tunneling member having a portion cut away at an angle of, for example, 45° (as described in the application as filed on page 3, lines 8 to 13), the present invention provides in addition to the known cut a truncation made perpendicularly to the tunneling member's axis, as generally indicated on page 5 lines 18, 19 of the application as filed and more explicitly shown in Figure 2A. This truncation perpendicular to the axis of the tunneling member represents unambiguously the cut which allows the recessed center area of the lip to be obtained for enhancing the axial field of view through the distal end of the tunneling member in accordance with the invention. Therefore, feature ii) is directly and unambiguously derivable from the application as filed.

The description has been brought into conformity with amended claim 1 and the relevant prior art.

The Board is thus satisfied that the requirements of Article 123(2) EPC are met.

3. *Novelty*

It is not disputed that the most relevant document on file is D1, which discloses a laparoscopic apparatus according to the preamble of claim 1.

In the apparatus according to D1, see Figures 88, 92, the end of the tunneling member is partially cut off to allow visualisation with a laparoscope. The cut is made at approximately 45° (see col.44, lines 43-47) and Figures 88 and 92 show the position of the cut. Since the cut partly cuts a cylindrical part (the tubular body 915 of the tunneling member 913) and a spherical part (the distal end part of the lip 918), in the plane of the cut, the cut has a circular part (where the sphere is cut) and an elliptical part (where the cylinder is cut). When seen from the front of the tunneling member, the cut thus has an upper circular shape and a lower elliptical shape, thus with the central part being lower than the two extremities.

However there is no recessed center area of the lip, partially surrounded by a blunt distal edge in a U-shaped manner, for extending the opening defined by the oblique cut in order to allow a straight laparoscope to be used to view axially out the distal end of the shaft through said center area.

The subject-matter of claim 1 is thus new.

4. *Inventive step*

Considering the differentiating features over D1 mentioned above, the objective problem can be seen in the provision of a laparoscopic apparatus allowing a better view in the axial direction while retaining the laparoscope in the tunneling member in order to avoid any damaging of the balloon.

With a minimal amendment of the prior art device - an additional cut at the distal end perpendicularly to the axis of the tunneling member - the cut at 45° according to the prior art is completed in order thereby to extend the previous opening and free the very centre area of the distal end of any part of the lip otherwise present and thus allow a better view in the direction of the axis of the tunneling member, while at the same time keeping the essential and functional part of the retaining lip, which avoids the laparoscope extending out of the tunneling member and damaging the balloon.

This solution is particularly simple and is suggested neither by D1 nor by any of the other documents cited in the search report.

The subject-matter of claim 1 thus involves an inventive step pursuant to Article 56 EPC.

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 first instance with the order to grant a patent on the basis of the following documents:
 - claims 1-7 as filed during the oral proceedings of 2 March 2010
 - description: pages 2,3,6,7,9,12,14-23 as originally filed, pages 1,5,8,10,11,24 as filed on 4 September 2006, pages 4,13 as filed during the oral proceedings of 2 March 2010;
 - drawings sheets 1/5, 3/5-5/5 as originally filed and sheet 2/5 as filed on 10 October 2005.

The Registrar:

The Chairman:

D. Sauter

M. Noel