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**Datasheet for the decision
of 14 January 2010**

Case Number: T 1020/07 - 3.2.02

Application Number: 01923193.5

Publication Number: 1301135

IPC: A61B 18/14

Language of the proceedings: EN

Title of invention:

Bipolar electrosurgical forceps with non-conductive stop members

Appellant (patentee):

Covidien AG

Respondent (opponent):

KLS Martin GmbH + Co. KG

Headword:

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Relevant legal provisions:

EPC Art. 56, 123

Relevant legal provisions (EPC 1973):

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Keyword:

"Extended subject-matter (no)"

"Inventive step (yes, after amendments)"

Decisions cited:

-

Catchword:

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Case Number: T 1020/07 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 14 January 2010

Appellant: Covidien AG
(Patent Proprietor) Victor von Bruns-Strasse 19
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Representative: HOFFMANN EITLE
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Respondent: KLS Martin GmbH + Co. KG
(Opponent) Am Gansacker 1b
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Representative: Maucher, Wolfgang
Patent- und Rechtsanwaltssozietät
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
4 May 2007 concerning maintenance of European
patent No. 1301135 in amended form.

Composition of the Board:

Chairman: D. Valle
Members: S. Chowdhury
J. Geschwind

Summary of Facts and Submissions

I. The appellant (patentee) lodged an appeal on 20 June 2007 against the decision of the opposition division posted on 4 May 2007 to maintain the patent in amended form. The fee for the appeal was paid simultaneously and the statement setting out the grounds for appeal was received on 30 August 2007.

II. The following document is relevant for the decision:

D5 = WO - A - 00/24 330.

III. Oral proceedings took place on 14 January 2010.

The appellant (patentee) requested that the decision under appeal be set aside and that the patent be maintained according to the following version:

- claims 1 and 2 filed during the oral proceedings;
- description columns 1 to 17 filed on 23 April 2007;
- figures 1 to 16G as in the patent specification.

Subsidiarily, he requested that the patent be maintained in the version maintained by the opposition division. This second request was however not necessary, since the version maintained by the opposition division has not been challenged by an appeal of the opponent nor can it be challenged by the Board (*no reformatio in peius*) and therefore it is not object of the present appeal.

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

IV. Claim 1 of the main request reads as follows:

"A bipolar forceps (200), comprising: at least one elongated shaft (212a, 212b) having opposing jaw members (280, 282) at the distal end (214a, 214b) thereof, the jaw members being movable relative to one another from a first position wherein the jaw members are disposed in spaced relation relative to one another to a second position wherein the jaw members cooperate to grasp tissue (150) therebetween; a source of electrical energy connected to each jaw member such that the jaw members are capable of conducting energy through tissue held therebetween; and a stop member (239) disposed as a raised lip along the periphery of an inner facing surface of at least one jaw member and extends from a proximal end (243) to a distal end (245) of the at least one jaw member (282) for controlling the distance between the jaw members when tissue is held therebetween."

Claim 2 is the same as maintained by the opposition division, having merely a reference number deleted.

Reasons for the Decision

1. The appeal is admissible.
2. *Formal matters*

The subject-matter of claim 1 complies with Article 123(2) EPC.

The respondent argued that the feature of claim 1:

"a stop member disposed as a raised lip along the periphery of an inner facing surface"

was not originally disclosed. In the original disclosure it was said that a stop member was designed as a raised lip extending along the peripheral edge of a jaw member (see WO - A - 02/07627, page 25, last paragraph).

The Board cannot agree with this objection since in WO - A - 02/07627, page 7, last paragraph, is written that:

"a raised lip acts as a stop member which projects from the inner-facing surface and extends about the outer periphery of the jaw member".

This wording is practically identical to the wording of the claim and supports the claim adequately.

3. *Inventive step*

D5 is indisputably considered as the closest state of the art.

D5 discloses a bipolar forceps, comprising at least one elongated shaft having opposing jaw members (electrodes 110, 120; see Figures 2, 5 and 7) at the distal end thereof, the jaw members being movable relative to one another from a first position wherein the jaw members are disposed in spaced relation relative to one another to a second position wherein the jaw members cooperate to grasp tissue therebetween; a source of electrical energy connected to each jaw member such that the jaw members are capable of conducting energy through tissue held therebetween; and a stop member (106, Figures 2, 5 and 7) disposed along the periphery of an inner facing surface of at least one jaw member for controlling the distance between the jaw members when tissue is held therebetween. See also page 17, last paragraph, page 18, second paragraph, page 26, second paragraph.

However, D5 does not disclose that the stop member is a raised lip and extends from a proximal end to a distal end of the at least one jaw member.

The appellant argues that D5 does not disclose a stop member disposed along a periphery of an inner facing surface of a jaw member.

However, the inner facing surfaces of the jaw member are the surfaces facing each other and designed to hold the tissue therebetween. Referring to Figure 5 and to page 16, first paragraph of D5, the opposing face 115

corresponds to the facing surface of the jaw member since this surface is designed to "conduct an electrosurgical current to a tubular vessel or tissue 150 when it is held thereagainst". Stop member 106 is disposed along a periphery of this surface 115, precisely along the proximal side of the surface, and therefore D5 discloses the claimed feature. Extension 155 does not belong to the facing surface as is clear from the wording on page 16: "conductive seal surface 116 includes an extension 155 ... Seal surface 116 also includes an opposing face 115 ...".

Starting from D5, the problem to be solved by the claimed device is seen in enhancing the manipulation and gripping of tissue during the sealing process, see patent specification, paragraph [0001]. This is achieved by the distinguishing feature of claim 1. the fact that the stop member is designed as a raised lip and extends from a proximal end to a distal end of the at least one jaw member makes it possible that the gripping effect is always achieved independently of the particular position of the tissue or vessel to be sealed along the jaw member, see Figure 11 of the patent specification.

Neither D5 alone nor in combination with the teaching of the other prior art cited can lead the skilled person to the claimed invention since the distinguishing feature is nowhere disclosed nor hinted at.

The respondent argued that D2 also disclosed a raised lip consisting of the side of the stop member 106 of Figure 5 adjacent to the electrode 115. Furthermore D5

disclosed on page 18, first full paragraph, that the stop member can be positioned at a various points along the disposable electrode assembly. That means that it can also be positioned from a proximal end to a distal end of the at least one jaw member.

However, this general disclosure is not sufficient to make obvious the invention because the choice of the specific form and position of the stop member is not hinted at by the opposed prior art.

Accordingly, the subject-matter of claim 1 involves an inventive step.

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 with the order to maintain the patent in the following version:
 - claims 1 and 2 filed during the oral proceedings;
 - description columns 1 to 17 filed on 23 April 2007;
 - figures 1 to 16G as in the patent specification.

The Registrar:

The Chairman:

R. Schumacher

D. Valle