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Datasheet for the decision of 10 September 2010

Case Number: T 0015/08 - 3.2.02

Application Number: 01979991.5

Publication Number: 1326528

IPC: A61B 5/00

Language of the proceedings: EN

Title of invention:
Torsionally compensated guidewire

Applicant:
Micro Therapeutics, Inc.

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 54(1)(2), 123(2), 111(1)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Novelty (yes - after amendments)"
"Remittal for further prosecution"

Decisions cited:
-

Catchword:
-

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Case Number: T 0015/08 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 10 September 2010

Appellant: Micro Therapeutics, Inc.
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Representative: Wibblemann, Jobst
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 19 July 2007 refusing European application No. 01979991.5 pursuant to Article 97(1) EPC 1973.**

Composition of the Board:

Chairman: M. Noël
Members: C. Körber
A. Pignatelli

Summary of Facts and Submissions

I. By its decision posted on 19 July 2007 the Examining Division refused European patent application No. 01979991.5 for lack of novelty vis-à-vis the teaching of document D1.

II. An appeal was lodged against this decision by the applicant by notice received on 17 September 2007 with the appeal fee being paid on the same day. The statement setting out the grounds of appeal was received on 15 November 2007.

III. With letter dated 16 August 2010, the appellant withdrew his former main and first auxiliary requests and requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution on the basis of claims 1 to 17, filed as second auxiliary request on 15 November 2007, and auxiliarily, on the basis of either one of the set of claims filed as third and fourth auxiliary requests on 15 November 2007. Further auxiliarily, oral proceedings were requested in the event that the decision of refusal was not redressed in its entirety.

IV. The following documents are of importance for the present decision:

D1: US-A-4 619 274

D3: EP-A-0 720 838.

V. Claim 1 of the main request reads:

"A guidewire (10) for use in tortuous regions of a vasculature, comprising:

a core (12) having a proximal region (14) having an outside diameter and a distal region (16);

the distal region includes a flattened end (32) and tang (36)

a single coil (18) wound about and attached to the distal region (16), the coil having a uniform outside diameter, a proximal end (22), a distal end (24) and a length (25) extending between the proximal end and the distal end; and

the coil and the distal region being sized to fit within tortuous regions of the vasculature;

whereby the ratio of the core proximal region outside diameter to the coil outside diameter is at least 1.4 to 1 to optimize torsional efficiency of the guidewire when the guidewire is used within the tortuous regions of the vasculature."

VI. The arguments of the appellant can be summarized as follows:

The guidewire of D1 differed from that according to claim 1 in that the coil (16) of D1 was wound on the entire core element and not on the distal region only, in that it comprised three coils (26, 16 and 23) instead of a single one, in that the coil (16) did not have a

uniform outside diameter, and in that the ratio of the outside diameter of the coil in the proximal region (16a) to the outside diameter of the coil in the distal region (16c) was 1.95 to 1 and thus much higher than the claimed ratio of 1.4 to 1. The outside diameter of the proximal end (12a) of the core element, taken into consideration for the calculation of the ratio by the Examining Division, was of no relevance since this end was covered by the coil and the person holding the guidewire would thus not be holding the core element. Moreover, D1 failed to disclose that the distal region of the core included a flattened end and tang.

Reasons for the Decision

1. The appeal is admissible.

2. *Amendments*

The subject-matter of claim 1 is based on original claim 1 and features taken from original claim 4 (see also page 2, lines 23 to 24 and page 5, lines 13, 14 and 18 of the description as originally filed). The fact that the guidewire comprises a **single** coil results clearly from Figures 2 and 3. Accordingly, the amendments do not extend beyond the content of the application as filed and are thus allowable under Article 123(2) EPC.

3. *Novelty*

3.1 Document D1

Document D1 discloses a guidewire 11 for use in tortuous regions of a vasculature, comprising:

a core 12 having a proximal region 12a having an outside diameter and a distal region 12g;

a coil 23 wound about and attached (column 4, lines 12 to 16) to the distal region 12g, the coil having a uniform outside diameter (Figure 7), a proximal end, a distal end and a length extending between the proximal end and the distal end; and

the coil 23 and the distal region 12g being sized to fit within tortuous regions of the vasculature (column 1, lines 21 to 23);

whereby the ratio of the core proximal region outside diameter (e.g. 0.025 inches, see column 2, lines 1 to 3) to the coil outside diameter (0.018 inches, see Figure 7 and column 3, line 23) is 1.4 (rounded) to 1, thus anticipating the lower limit value of the claimed range of at least 1.4 to 1, to optimize torsional efficiency of the guidewire when the guidewire is used within the tortuous regions of the vasculature (the optimized torsional efficiency is an inherent consequence of the disclosed ratio of diameters).

Accordingly, the guidewire according to claim 1 is distinguished over the disclosure of D1 in that it

comprises a single coil and that the distal region includes a flattened end and tang.

3.2 Document D3

Document D3 discloses a guidewire (Figures 2 and 4) for use in tortuous regions of a vasculature, comprising:

a core 7 having a proximal region 5 having an outside diameter and a distal region 13;

a single coil 8 (since the embolization coil 4 shown in Figure 7 is releasable, the guidewire of D3 is also disclosed as comprising only a single coil 8) is wound about and attached to the distal region 13, the coil having a uniform outside diameter, a proximal end 9, a distal end and a length extending between the proximal end and the distal end; and

the coil and the distal region being sized to fit within tortuous regions of the vasculature (column 1, lines 3 to 11);

whereby the ratio of the core proximal region outside diameter (e.g. 2 mm, column 8, lines 12 to 13) to the coil outside diameter (0.2 to 1 mm; see column 8, lines 36 to 38) is, for instance, 10 to 1 or 2 to 1, thus anticipating various values falling within the claimed range of at least 1.4 to 1, to optimize torsional efficiency of the guidewire when the guidewire is used within the tortuous regions of the vasculature (the optimized torsional efficiency is an inherent consequence of the disclosed ratios of diameters).

Accordingly, the guidewire according to claim 1 is distinguished over the disclosure of D3 in that the distal region includes a flattened end and tang.

3.3 Since neither D1 nor D3 discloses all the features of claim 1 in combination, these documents do not take away the novelty of the claimed subject-matter within the meaning of Article 54(1) and (2) EPC.

4. *Remittal*

The Examining Division refused the application on the ground of lack of novelty of the subject-matter of claim 1 then on file vis-à-vis D1. Since the requirement of inventive step has not yet been dealt with by the Examination Division in a reasoned manner, neither in the decision under appeal nor in the preceding communication dated 19 May 2006, the Board considers it appropriate to exercise its discretion under Article 111(1) EPC and to remit the case to the department of the first instance, as requested by the appellant, for further prosecution of the examination procedure, in particular with respect to inventive step vis-à-vis the cited prior art documents.

5. Since the decision under appeal is set aside and the case is remitted for further prosecution, the request for oral proceedings can be left aside.

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 further prosecution on the basis of claims 1 to 17 of the main request, filed as second auxiliary request on 15 November 2007.

The Registrar: The Chairman:

D. Sauter M. Noël