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**Datasheet for the decision
of 2 December 2008**

Case Number: T 0213/08 - 3.2.02

Application Number: 00932801.4

Publication Number: 1180978

IPC: A61B 17/56

Language of the proceedings: EN

Title of invention:

Apparatus for treating disc herniation

Patentee:

Ferree, Bret A.

Opponent:

Intrinsic Therapeutics, Inc.

Headword:

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Relevant legal provisions:

EPC Art. 108, 123(2)

EPC R. 99(2)

Relevant legal provisions (EPC 1973):

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Keyword:

"Admissibility of the appeal (yes)"

"Main request (unallowable broadening)"

"First auxiliary request (allowable - remittal to first instance)"

Decisions cited:

J 0022/86, T 0220/83, T 0729/90, T 0934/02

Catchword:

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Case Number: T 0213/08 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 2 December 2008

Appellant: Ferree, Bret A.
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Representative: Wilson, Gary
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Respondent: Intrinsic Therapeutics, Inc.
(Opponent) 30 Commerce Way
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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 November 2007
revoking European patent No. 1180978 pursuant
to Article 102(1) EPC 1973.

Composition of the Board:

Chairman: T. Kriner
Members: S. Chowdhury
A. Pignatelli

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. 1 180 978.
- II. The opposition was filed against the whole patent and based on Article 100(a) (lack of novelty and inventive step, patentability excluded under Article 52(4) EPC 1973), Article 100(b), and Article 100(c) EPC 1973.

With its decision posted on 30 November 2007 the Opposition Division held that claim 1 of all requests before it contravened Article 123(2) EPC 1973 and revoked the patent, accordingly. The grounds of opposition under Article 100(a) EPC 1973 were not dealt with.

- III. A notice of appeal against this decision was filed on 28 January 2008 and the appeal fee was paid on the same day. The statement of grounds was submitted on 28 March 2008.

- IV. Oral proceedings were held on 2 December 2008. The following requests were submitted:

The appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the main request or alternatively on the basis of one of the auxiliary requests I to V, all filed with the statement of the grounds of appeal.

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

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

"A device for preventing the escape of natural, artificial or therapeutic material through a defective region in an annulus fibrosis of a spinal disc, and for preventing disc herniation, said device having a first physical extent facilitating introduction of the device relative to the defective region in the annulus fibrosis, and a memorised second physical extent forming a final shape of the device, different from the first, characterised in that the device is a coiled metal wire composed of memory effect metal material that naturally returns to the memorised second physical extent, and which functions to occlude the defective region by expanding from the first physical extent to the second physical extent, wherein no further steps are required to form the memorised second physical extent".

Claim 1 of the first auxiliary request reads as follows:

"A device for preventing the escape of natural, artificial or therapeutic material through a defective region in an annulus fibrosis of a spinal disc, and for preventing disc herniation, said device having a straightened first physical extent facilitating introduction of the device relative to the defective region in the annulus fibrosis, and a memorised second physical extent forming a final shape of the device, different from the first, characterised in that the device in the memorised second physical extent is a coiled metal wire composed of memory effect metal material that naturally returns to the memorised second

physical extent, and which functions to occlude the defective region by expanding from the first physical extent to the second physical extent, wherein no further steps are required to form the memorised second physical extent".

VI. The parties argued as follows:

Appellant

The only reason given for revocation in the decision under appeal was given in paragraph 4.2, according to which "metal" was an intermediate generalisation since only a coiled metal wire was disclosed. The claims filed with the grounds of appeal met this objection so there was nothing to add apart from the fact that the amendments were supported by the same passage on page 11 of the PCT application, which the opposition division had also cited.

The claims had been amended in order to meet the objection of the opposition division and were fairly based on the disclosure of page 11 and Figure 11 of the PCT application. In particular these parts of the application did not require the metal wire to have a straightened form in one physical extent thereof. It was clear from the claim 1 as a whole that the second physical extent was the coiled state of the wire. The last part of claim 1 was not a disclaimer it was a clarifying amendment explaining the memory property of the metal, and was supported by original claim 7.

Respondent

The grounds of appeal did not indicate the facts and evidence required by Rule 99(2) EPC and the case law of the EPO (for example T 220/83). The appellant had filed new claims and pointed out the only relevant embodiment in the description, but there were no further reasons or arguments given, and it was left to the respondent and the Board to ascertain for themselves the relevant facts and evidence. The decision under appeal was based on an unallowable intermediate generalisation and the grounds of appeal should have argued why the claims filed on appeal complied with the EPC, so that the appellant's case was immediately apparent without the respondent and the board having to make their own investigations.

J 22/86 dealt with the question whether in exceptional cases it was not necessary to provide full reasons, but this case was different in that it related to ex-parte proceedings. T 934/02 dealt with an appeal of the patent proprietor which was considered to have been sufficiently substantiated even though it did not state any specific reasons why the contested decision was wrong, but this related to a different case in that the subject of the proceedings had changed, which was not the same as the present situation. T 729/90 dealt with a combination of claims 1 and 4 which the first instance clearly stated to be allowable, which was also different to the present case in which there was no indication of what amendment would be acceptable.

There was no indication in claim 1 as to what the first and second physical extents of the device were and the

claim did not correspond to the description in this respect. In particular this required the first extent to be a straightened form. The last part of the claim was an unallowable disclaimer for which there was no support in the application as originally filed. It was also not clear what the further steps, which were to be excluded by the claim, could be.

Auxiliary request I was further objectionable in that it was broader than the supporting disclosure on page 11, lines 7 and 8, which required the final diameter of the device to be larger than the void.

Reasons for the decision

1. Admissibility

The impugned decision revoked the patent in suit on the grounds of Article 123(2) EPC 1973, stating that the subject-matter of claim 1 represented an intermediate generalisation of the embodiment described on page 11, lines 4-13, which was not originally disclosed. In particular, only that embodiment was disclosed in which only a metal material was disclosed in connection with a wire coil.

With the letter filed on 28 March 2008, which was filed within four months after notification of the decision from which the appeal lies and constitutes the grounds of appeal, the appellant filed claims of a main request and auxiliary requests I to V, wherein in each case independent claim 1 includes the feature that the device comprises a coiled metal wire composed of memory

effect metal material. The letter is very brief and contains the succinct statement "We hereby file a Main Request and Auxiliary Requests I - V. Basis for these claims may be found on, for example, page 11, lines 4-13 of the PCT application as filed". There follows a sentence concerning inventive step, and a further sentence summarising the appellant's requests.

The question is whether this very brief statement concerning Article 123(2) EPC 1973, the solitary ground of revocation, meets the minimum requirement of Article 108 and Rule 99(2) EPC in that the grounds of appeal should indicate the reasons for setting aside the decision impugned and the facts and evidence on which the appeal is based.

The decisions J 22/86, T 934/02, and T 729/90 are, indeed, not directly comparable with the present case for the reasons given by the respondent above. T 220/83 relates to the case where, in the face of a revoked patent, the patent proprietor made no amendments and referred to a statement in a US patent, and it was indeed left to the board and the respondent to ascertain for themselves any facts substantiating the claim to inventive step, and the appeal was deemed to be inadmissible.

In the present case, in which the opposition division objected to the omission of some features from claim 1 under Article 123(2) EPC 1973, and the appellant inserted these features into claim 1 of each request, it is self-evident that the contested decision has been deprived of its basis and should be set aside for this reason. This fact, together with the statement that the

same passage on page 11 of the application which was also cited by the opposition division supported the new claims, are sufficient in the present case to satisfy the above requirements of Rule 99(2) EPC because the Board and the respondent can immediately understand the appellant's case. Therefore, the Board finds, exceptionally given the circumstances of the present case, that the grounds of appeal, which may fairly be described as minimal, comply with Rule 99(2) EPC.

Therefore, the appeal is admissible.

2. Article 100 (c) EPC - main request

2.1 The decision to revoke the patent was taken on the grounds that the claims of all requests before the opposition division were inadmissibly broadened because the features "metal wire" and "coil shape" were omitted from these claims. As stated above, the claims filed with the grounds of appeal meet this deficiency and deprive the decision of its basis.

2.2 However, claim 1 is still open to objection under Article 123(2) EPC because the embodiment described with reference to page 11 and Figure 11, which provides the only basis for the device claimed in claim 1, discloses only that the coiled shape is attained from an initially straightened form of the wire. Claim 1, however, covers other initial shapes (for example a compressed coil, or a folded wire) for which there is no basis in the application, so that claim 1 is unduly broad in this respect.

2.3 For this reason the main request is not allowable.

3. Auxiliary Request I

3.1 Claim 1 of Auxiliary Request I meets the objection set out in point 2.2. Moreover, this claim sets out clearly what the first and second physical extents of the device are, thus answering another criticism of the respondent.

3.2 The respondent argued that this claim was still objectionable under Article 123(2) EPC because it did not include the feature that the final diameter of the device is larger than the void 1104, as set out on page 11, lines 7 and 8. The Board is, however, of the opinion that this is an inessential feature which would obscure the claim because it defines the device by reference to a part of the body, and should not be inserted in claim 1.

3.3 The last part of claim 1 is not a disclaimer, it merely includes a clarifying amendment whose effect is to limit the property of the metal material. In fact this feature is redundant given the previous statement in the claim that "the memory effect metal material naturally returns to the memorised second physical extent". This feature is supported by page 11, lines 10 to 13 and claim 7 of the PCT application.

3.4 For these reasons Auxiliary Request I meets the requirement of Article 123(2) EPC.

4. The opposition division has not yet given a decision with respect to Article 100(a) EPC so it is appropriate to remit the case to the department of the first instance 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 further prosecution on the basis of auxiliary request 1 filed on 28 March 2008.

The Registrar

The Chairman

V. Commare

T. Kriner