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**Datasheet for the decision
of 20 July 2011**

Case Number: T 1033/08 - 3.2.02

Application Number: 95900364.1

Publication Number: 0768841

IPC: A61B 18/12

Language of the proceedings: EN

Title of invention:

System for controlling tissue ablation using temperature sensors

Patentee:

Boston Scientific Limited

Opponent:

C.R. BARD INC.

Headword:

-

Relevant legal provisions:

EPC Art. 56, 84, 107, 123(2)(3)

EPC R. 42(e)

Keyword:

"Exception to prohibition of reformatio in peius: no (main and first auxiliary requests)"

"Clarity: no (second auxiliary request)"

"Inventive step: yes (third auxiliary request)"

Decisions cited:

G 0009/92, G 0004/93, G 0001/99

Catchword:

-



Case Number: T 1033/08 - 3.2.02

DECISION
of the Technical Board of Appeal 3.2.02
of 20 July 2011

Appellant: C.R. BARD INC.
(Opponent) 730 Central Avenue
Murray Hill, New Jersey 07974 (US)

Representative: Marsh, Roy David
Hoffmann Eitle
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Respondent: Boston Scientific Limited
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Representative: Powell, Timothy John
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Nottingham NG1 5DD (GB)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
20 March 2008 concerning maintenance of
European patent No. 0768841 in amended form.

Composition of the Board:

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

Summary of Facts and Submissions

- I. On 20 March 2008 the Opposition Division posted its interlocutory decision concerning maintenance of European patent 0 768 841 in amended form.
- II. An appeal was lodged against this decision by the opponent by notice received on 30 May 2008, with the appeal fee being paid on the same day. The statement setting out the grounds of appeal was received on 30 July 2008.
- III. By communication of 7 April 2011, the Board summoned the parties to oral proceedings and forwarded its provisional opinion.
- IV. With letters of 23 June 2011 and 6 July 2011, respectively, the appellant (opponent) and the respondent (patentee) indicated that they would not be represented at the oral proceedings.
- V. Oral proceedings were held on 20 July 2011 in the absence of both parties.

In their written submissions, the requests of the parties were as follows:

The appellant requested that the decision under appeal be set aside and that the patent be revoked.

The respondent requested that the decision under appeal be set aside and that the patent be maintained on the basis of the set of claims filed as main request with the reply to the statement of grounds of appeal dated

13 March 2009, or on the basis of one of the sets of claims filed as first to third auxiliary requests with letter of 6 July 2011.

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

E1: US-A-5 277 201
E3: JP-A-4 325 166
E3T:English translation of E3
E6: WO-A-93/13816
E7: WO-A-93/08757
E8: WO-A-93/08756.

VII. Claim 1 of the various requests reads as follows:

Main request:

"1. An ablating system for ablating body tissue, comprising:
multiple emitters (30, 201, 202, 203) of ablating energy;
two or more temperature sensing elements (80, 208, 209, 210) at each energy emitter for measuring temperature at the energy emitter;
a power controller (230) coupling a source of ablating energy to each energy emitter to convey ablating energy to the energy emitters;
a processing element (215) which is adapted to periodically read the temperatures measured by each of the temperature sensing elements of each energy emitter and to select for at least one said energy emitter the hottest one of the measured temperatures, and to compare the hottest one of the temperatures for the or

each said energy emitter to a desired temperature, and which is adapted to generate a signal individually for each energy emitter based upon the comparison wherein the desired temperature is established for all emitters; and
a temperature controller (215) coupled to the power controller; the temperature controller which is adapted to individually control the conveyance of energy to each energy emitter based upon the signal for that energy emitter to maintain the hottest temperature at all energy emitters essentially at the desired temperature during tissue ablation."

First auxiliary request:

Claim 1 of the first auxiliary request corresponds to claim 1 of the main auxiliary request with the phrase "the temperature controller which is adapted to individually control ..." in the last paragraph of the claim being amended so as to read "the temperature controller **being** adapted to individually control ..." [emphasis added].

Second auxiliary request:

Claim 1 of the second auxiliary request corresponds to claim 1 of the main request, with the penultimate paragraph of the claim being replaced as follows:

"a processing element (215) which is adapted to periodically read the temperatures measured by each of the temperature sensing elements of each energy emitter and to select for each energy emitter the hottest one of the measured temperatures, to compare the hottest

one of the temperatures for each energy emitter to a desired temperature, and is adapted to generate a signal individually for each energy emitter based upon the comparison wherein the desired temperature is established for all emitters, and".

Third auxiliary request:

"1. An ablating system for ablating body tissue, comprising
multiple emitters (30, 201, 202, 203) of ablating energy;
two or more temperature sensing elements (80, 208, 209, 210) at each energy emitter for measuring temperature at the energy emitter;
a power controller (230) coupling a source of ablating energy to each energy emitter to convey ablating energy to the energy emitters;
a processing element (215) which is adapted to periodically read the temperatures measured by each of the temperature sensing elements for each energy emitter and to select for each energy emitter the hottest one of the measured temperatures, to compare the hottest one of the temperatures for each energy emitter to a desired temperature, and is adapted to generate a signal individually for each energy emitter based upon the comparison wherein the desired temperature is established for all emitters, and
a temperature controller (215) coupled to the power controller; the temperature controller being adapted to individually control the conveyance of energy to each energy emitter based upon the signal for that energy emitter to maintain the hottest temperature at all

energy emitters essentially at the desired temperature during tissue ablation."

Claims 2 and 3 of all requests are dependent claims.

VIII. The appellant's arguments are summarised as follows:

Documents E7 and E8, filed with the statement of grounds of appeal, should be admitted into the procedure since they represented background material more relevant than any of the other available prior art.

The amendments made to the respondent's case with his letter of 6 July 2011, i.e. the set of auxiliary requests filed just two weeks before the date of the oral proceedings, should not be admitted under Article 13(1) and (3) RPBA.

With his main and first auxiliary requests, the respondent had broadened the scope of the claims with respect to the version upheld by the Opposition Division and thus improved his position to the detriment of the opponent and sole appellant, contrary to the principle of prohibition of reformatio in peius. The exception thereto developed in G 1/99 did not apply in the circumstances of the present case.

Claim 1 of the second auxiliary request lacked clarity since it did not make grammatical sense. Moreover, the text of the patent specification did not indicate which of the illustrated devices fell under the scope of the claim, and no drawing did in fact illustrate an

embodiment including all the features specified in the claim.

The embodiment illustrated in Figures 8A to 8c of document E7 disclosed all the features of claim 1 of the third auxiliary request with the exception of the selection of the hottest one of the temperatures measured by the temperature sensing elements on each energy emitter. The technical effect attributable to this novel feature was to assure that the temperature measured by the sensor in most intimate contact with the tissue to be ablated was selected as the feedback signal. However, it was common general knowledge that a sensor disposed in the path of flowing blood would sense a lower temperature than a sensor in intimate contact with the tissue. The alleged invention did nothing more than implement elementary technical considerations and was thus obvious from E7.

It was further disclosed in E3/E3T (in particular in paragraphs [47] and [58]) to select the hottest one of multiple sensed temperatures to control the conveyance of energy to be emitted in a device for internally treating tissue. Accordingly, claim 1 also lacked inventive step over E7 in combination with E3/E3T.

Starting from the embodiment shown in Figures 1 and 3 of document E1, depicting a single emitter provided with multiple sensors, the claimed subject matter was also obvious. The fact that document E6, disclosing multiple emitters, was cited in the patent application, indicated that the proprietor was aware of the thus achievable benefit of a uniform distribution of temperatures along the ablating element. This problem

was unrelated to that of ensuring use of a feedback signal best representative of the actual temperature of tissue to be ablated. Wishing to obtain the benefit of the two advantages, the skilled person would therefore modify the embodiment of E1 to arrive at the subject-matter of claim 1 in an obvious manner.

IX. The respondent's arguments are summarised as follows:

The appellant's statement that late-filed documents E7 and E8 only recently came to light was surprising in view of the fact that they had an inventor in common with E1 and were similarly classified.

Even though filed closely before the oral proceedings, no part of the content of the respondent's submission of 6 July 2011 was in fact new. The second auxiliary request was the same as the auxiliary request filed on 13 March 2009 in response to the appellant's statement of grounds, and the first and third auxiliary requests contained only minor corrections of the two previous requests filed on 13 March 2009.

G 1/99 superseded the earlier decisions G 9/92 and G 4/93, and the circumstances of the opposed patent were exactly those giving rise to the exception of the prohibition of reformatio in peius contemplated in G 1/99. With his statement of grounds of appeal, the appellant had attacked the clarity and support of the amendments introduced in claim 1 during the opposition proceedings, and patentability on the basis of the newly introduced documents E7 and E8, and alleged that claim 1 should be revoked. The late filing of E7 and E8 justified a re-appraisal of the scope of disclosure of

the opposed patent and the invention claimed therein. In order to respond to the new attacks of the appellant, the patentee was entitled to file amendments in conformity with the reasoning in G 1/99. Since an amendment that simply limited the scope of claim 1 compared with that maintained by the Opposition Division was not available, the patentee had to consider the second option provided in G 1/99, i.e. introducing one or more originally disclosed features which extended the scope of the patent as maintained, but within the limits of Article 123(3) EPC. Claim 1 as granted contemplated the selection of one measured temperature from the plurality constituted by the multiple emitters, and since the scope of the independent claim of the main request was further restricted, Article 123(3) was satisfied.

Although the grammar relating to the temperature controller in claim 1 of the main request and the second auxiliary request was not perfect, its sense was unassailably clear. Contrary to the appellant's view, failure to show the combination of all claimed features in a drawing did not present any shortcoming in the support for the claimed invention by the description as required by Article 84 EPC.

The appellant had failed to provide any corroboration of the assertion that blood-cooling of temperature sensors not in contact with tissue was common general knowledge. By recognising the significance of this phenomenon the inventors of the patent in suit had identified an important new factor in ablation device control and perceived that control inaccuracies as a result of blood-cooling were to be avoided.

E3/E3T was considerably removed from the subject area of the invention in that it did not relate to an ablation device and the temperature range described therein was below that needed for cardiac ablation. Starting from document E7, the skilled person would therefore not take into consideration the teaching of this document. Furthermore, the apparatus of E7 was exclusively designed with the aim in mind of operating a control system on the basis of average temperatures, which altered only slowly, whereas E3/E3T was concerned solely with high-frequency control. The objective of E3/E3T was to ensure that the temperature of the tissue did not exceed certain maxima in order to prevent burns. The blood-cooling problem was nowhere addressed in this document and was in fact of no relevance at all since the device was designed to operate inside the digestive tract rather than in an environment in which blood was present in any quantity.

E1 disclosed an apparatus exclusively concerned with endometrial ablation which was inherently unsuitable for cardiac ablation. The problem of blood-cooling was not contemplated and was not a relevant factor in E1 either. The reasons why combinations of E7 with general technical knowledge or with the teaching of E3/E3T were invalid applied equally strongly to the respective combinations of E1.

Reasons for the Decision

1. The appeal is admissible.

2. Late-filed submissions

2.1 Late-filed documents

Documents E7 and E8 are regarded by the Board as more relevant than E1 in that they disclose ablating systems with multiple emitters (electrodes) each having multiple sensors, whereas E1 only teaches either a single ablating electrode 14, 27 with multiple sensors 24 (Figures 1 to 3) or a plurality of conductive ablating segments 40 each having a single sensor 42 (Figures 5 and 6). The filing of E7 and E8, directly with the statement of grounds of appeal, is considered a justified reaction to the impugned decision. The Board therefore admits these documents into the appeal proceedings.

2.2 Late-filed auxiliary requests

The second auxiliary request corresponds to the version as upheld by the Opposition Division and is thus not late-filed. The first and third auxiliary requests comprise amendments introduced in order to overcome a minor clarity objection addressed in the Board's communication. Therefore all these auxiliary requests are admitted by the Board into the appeal proceedings in exercise of its discretion under Article 13(1) and (3) RPBA as far as their late-filing is concerned.

3. Main and first auxiliary requests - allowability

Claim 1 as upheld by the Opposition Division (current second auxiliary request) is restricted to the selection of the hottest one of the measured

temperatures **for each** energy emitter of the ablation system for comparison to a desired temperature (cf. feature (D4) in the denotation given below in point 5.2.1). By contrast, claim 1 of the main and the first auxiliary requests is of broader scope since the selection of the hottest one of the measured temperatures is carried out **for at least one** of the energy emitters. Consequently, the subject-matter of claim 1 of the main and first auxiliary requests, by covering the possibility of selecting the hottest one of the measured temperatures for **any selection** of the energy emitters, is broader than that of claim 1 upheld by the Opposition Division. This results in an improvement of the proprietor's position putting the sole appellant in a worse situation than if he had not appealed, contrary to the principle of prohibition of reformatio in peius.

The opponent is the sole appellant against the interlocutory decision of the Opposition Division concerning maintenance of the patent in amended form according to the respondent's main request filed in opposition proceedings. The proprietor is not adversely affected and has implicitly indicated that he will not contest the maintenance of the patent in the version accepted by the Opposition Division (G 1/99, point 9.1 of the Reasons). As ruled in G 9/92 and G 4/93 (see Headnote II and Reasons, points 15 and 16), under these circumstances the patent proprietor is primarily restricted during the appeal proceedings to defending his patent in the form in which it was maintained by the Opposition Division. In particular, the patent proprietor is not permitted to improve his position to the detriment of the opponent and sole appellant.

Amendments proposed by the patent proprietor as a party as of right under Article 107 EPC, second sentence, may be rejected as inadmissible by a board of appeal if they are neither appropriate nor necessary.

Contrary to the respondent's view, G 1/99 does not supersede G 9/92 and G 4/93, but is complementary thereto in that it gives directions for allowing an exception to the principle of prohibition of reformatio in peius as defined in these decisions. However, the exception to this principle developed in G 1/99 does not apply in the circumstances of the present case for the following reasons.

G 1/99 only deals with the deletion of a limiting feature added during the opposition procedure. The exception to the principle of prohibition of reformatio in peius applies to this situation only (see point 2.3 of the Reasons).

In fact, in order to allow such a deletion which puts the opponent and sole appellant in a worse situation than if he had not appealed, the following conditions must be fulfilled:

A limiting feature introduced during the opposition procedure has to be deleted. The necessity for its deletion must be caused by the appeal. This means that the deletion is necessary and appropriate because it is related to a ground of opposition and caused by new facts, evidence or arguments put forward by the appellant, or because of a different evaluation of the situation by the board of appeal. Without the deletion, the patent would have to be revoked. It is not possible

to overcome the objection by introducing new features which limit the scope of the patent as maintained.

Only if these preconditions are fulfilled, an objection may be overcome by introducing new features which extend the scope of the patent as maintained, but within the limits of Article 123(3) EPC according to the second option of G 1/99.

The amendment requested with the main and first auxiliary request, viz. replacement of the word "each" by "at least one" in feature (D4) of claim 1, is not a deletion of a limiting feature but a substitution of this feature. It does not overcome an objection raised with the appeal and it is not caused by a different evaluation by the Board. The objections against the claim in the version maintained by the Opposition Division can be overcome by amendments which do not extend the scope of protection (see point 5.1 below). The inadmissible amendment held allowable by the Opposition Division in its interlocutory decision relates to feature (E3) rather than to feature (D4) (see point 4 below), and this deficiency does not have the consequence that the patent would have to be revoked. Accordingly, the present amendment does not fulfil the preconditions defined in G 1/99 for justifying the exception.

The respondent's argument that the filing of fresh prior art (documents E7 and E8) by the sole appellant at the appeal stage should permit the respondent to retract amendments made by him before the Opposition Division is not accepted by the Board. It is true that G 1/99 (point 12 of the Reasons) states that the non-

appealing proprietor deserves protection for reasons of equity when new facts have been introduced in appeal proceedings, and that the patent can exceptionally be amended in a way that offends the principle of prohibition of reformatio in peius. However, this is possible only if a limitation proves impossible (point 15 of the Reasons). In the present case, the appellant's objection based on the above-mentioned new documents, which was raised against the version maintained by the Opposition Division, does not require any limiting amendment of the claims. To deal with new prior art documents, the respondent either has to distinguish from it by argument or by making further restrictions to the claims upheld by the Opposition Division. The respondent may not in principle request another version of the patent during appeal proceedings, unless this version is a restriction of the maintained version (see G 1/99, Reasons 9.1). As shown below in point 5.2, the respondent's arguments regarding the new prior art have already convinced the Board, without the need for introduction of any further distinguishing amendments of the claims.

From the above it follows that the main and the first auxiliary requests are contrary to the principle of prohibition of reformation in peius and do not fulfil the conditions for an exception.

4. Second auxiliary request

The second auxiliary request corresponds to the version of the patent upheld by the Opposition Division. As objected to by the appellant and mentioned in the Board's communication, the phrase "a temperature

controller (215) coupled to the power controller; the temperature controller **which is** adapted to individually control the conveyance of energy ..." (emphasis added) in the last paragraph of claim 1 is not clear since it does not make grammatical sense. Contrary to the respondent's assertion, the sense of such a distorted phrase is not "unassailably clear" and leaves the reader in doubt regarding its exact meaning. Accordingly, the second auxiliary request is not allowed since the amendment made to claim 1 at the opposition stage is not clear and does not meet the requirements of Article 84 EPC.

5. Third auxiliary request

5.1 Amendments

Claim 1 is based on claims 1 and 17 as granted, which correspond to original claims 18 and 36, respectively. The replacement of the words "which is" by the term "being" in the last paragraph of claim 1 overcomes the clarity objection discussed above (point 4) and does not add any technical information to the claim nor does it alter its scope. Accordingly, the Board is satisfied that the requirements of Article 123(2) and (3) EPC are met, and that the patent proprietor has not improved his position by this amendment.

In the description of the patent in suit (see for instance paragraphs [0036] to [0041]) it is clearly indicated that a plurality of emitters of ablating energy is foreseen, each of them in turn being provided with multiple temperature sensing elements, as shown in Figures 5 to 7 and required by claim 1. Accordingly,

the description provides sufficient support for the claims within the meaning of Article 84 EPC, second sentence, and describes in detail one way of carrying out the invention claimed, as required by Rule 42(e) EPC. Contrary to the appellant's assertion, it is not necessary that at least one of the drawings of the patent in suit actually depicts multiple emitters with multiple sensors.

5.2 Inventive step

5.2.1 For ease of reference, the feature denotation of claim 1 proposed by the respondent in his letter of 13 March 2009, will be used in the following:

(0) An ablating system for ablating body tissue, comprising:

(A) multiple emitters (30, 201, 202, 203) of ablating energy;

(B1) two or more temperature sensing elements (80, 208, 209, 210)

(B2) at each energy emitter

(B3) for measuring temperature at the energy emitter;

(C1) a power controller (230)

(C2) coupling a source of ablating energy to each energy emitter to convey ablating energy to the energy emitters;

(D1) a processing element (215)

(D2) which is adapted to periodically read the temperatures measured by each of the temperature sensing elements

(D3) for each energy emitter

(D4) and to select for each energy emitter the hottest one of the measured temperatures,

(D5) to compare the hottest one of the temperatures for each energy emitter to a desired temperature,

(D6) and is adapted to generate a signal individually for each energy emitter based upon the comparison wherein the desired temperature is established for all emitters, and

(E1) a temperature controller (215)

(E2) coupled to the power controller

(E3) the temperature controller being adapted to individually control the conveyance of energy to each energy emitter

(E4) based upon the signal for that energy emitter

(E5) to maintain the hottest temperature at all energy emitters essentially at the desired temperature during tissue ablation.

5.2.2 Document E7, which relates to the technical field of cardiac ablation and aims at precisely monitoring and controlling the emission of energy from the ablation electrode, represents the closest prior art. It discloses (see Figures 8A to 8C and the corresponding part of the description starting at page 20, line 24) an ablating system for ablating body tissue comprising all features of claim 1 with the exception of features (D4), (D5) and (E5).

Instead of selecting for each energy emitter 110, 112 the **hottest** one of the measured temperatures and comparing the **hottest** one of the temperatures for each energy emitter to a desired temperature as required by features (D4) and (D5), document E7 teaches a selection and comparison on the basis of an **average** value of the temperature (page 20, lines 28 to 33 and page 21, line 21). With respect to feature E5 it is to be noted that there is no teaching in document E7 that both emitters 110 and 112 are to be kept at the same (average) temperature. The sensors 94 in each emitter are averaged and displayed separately (page 20, penultimate paragraph and page 21, 5th paragraph). No specific advantages are indicated in document E7 for the use of multiple sensors and averaging. There is no hint to deviate from the concept of averaging and that the hottest temperature could be of any interest.

5.2.3 The temperature sensor providing the maximum temperature for a given emitter indicates that the corresponding region of the emitter is in most intimate contact with the tissue to be ablated, whereas those sensors providing lower temperatures are (more) exposed to convective cooling by the surrounding blood (see

paragraph [0121] of the patent specification). Accordingly, the technical effect of the above-mentioned distinguishing features (D4) and (D5) with respect to document E7 is that the most representative temperature signal is used as set point for the temperature control system. Maintaining all emitters at this temperature (feature (E5)) yields an improved thermal control of the treatment site along the entire length of the ablating element (see paragraphs [0110] and [0126]).

- 5.2.4 The objective technical problem underlying the above-mentioned effects is to achieve a more accurate temperature control and thus a more effective ablation treatment. This problem is derivable from paragraph [0008] of the specification of the patent in suit.
- 5.2.5 The appellant's assertion that the solution according to claim 1 is obvious in view of the common general knowledge of the skilled person is not accepted by the Board. The appellant has failed to produce any evidence that the phenomenon of cooling resulting from contact of tissue ablation device temperature sensors with blood was taken into account by the skilled person before the priority date of the patent in suit. By recognising the significance of this phenomenon, i.e. that blood-cooling of certain temperature sensors could result in a distorted signal, not being representative of the temperature of the tissue to be ablated, the inventors of the present patent have in fact identified an important new factor to be taken into consideration in ablation device control. Taking further into account the rather opposite teaching of E7 (averaging vs. distinct use of an extreme value), the solution

proposed by claim 1 cannot be regarded as obvious from E7 in view of the common general knowledge of the skilled person.

5.2.6 E3/E3T does not explicitly relate to an ablation device, but to devices for performing thermal therapy of "internal affected areas", e.g. the esophagus and other parts of the digestive tract (see paragraphs [0001], [0010] and [0046]), i.e. to a neighbouring field which would principally be taken into consideration by the skilled person. The range of working temperatures disclosed in E3T, e.g. 40°C to 45°C as mentioned in paragraph [37], lies within the lower part of the range of 40°C to 90°C indicated in paragraph [0123] of the patent specification as being suitable for cardiac ablation.

E3T teaches the use of the maximum temperature signal from a plurality sensor as set point for the temperature control system (see paragraphs [0038] and [0047]). The key objective, however, is to avoid burns or "fires" (see paragraphs [0005] and [0047]). By using the maximum temperature signal it is possible to assure that the maximum desired temperature (e.g. 45°C as shown in Figure 17) is nowhere exceeded. In the patent in suit, on the other hand, the aim is to use the temperature signal most representative of intense tissue contact and to positively achieve the desired ablation temperature at all emitters (see point 5.2.3 supra).

In the device of E3T, the contact of the internal emitter 3 with the tissue to be treated is established by means of an inflatable balloon 6. Under these

circumstances, the issue of certain regions of the emitter(s) being subject to convective cooling by surrounding blood, resulting in signals that are "too low" and not representative, plays no role.

Accordingly, when starting from E7 and attempting to solve the above-mentioned technical problem, the skilled person would not have taken into consideration the teaching of E3/E3T. Moreover, the combination of E7 and E3T would not lead to the subject-matter of claim 1 since both documents fail to teach or suggest that the hottest temperature is to be maintained at **all** emitters essentially at the desired temperature, as required by feature (E5).

5.2.7 Document E8 is very similar to E7 and comprises the same set of drawings. Its teaching does not go beyond that of E7.

5.2.8 Document E1 relates to an ablation device (see abstract, first sentence, and column 4, lines 39 to 43). However, it is more remote from the invention than E7 in that it only teaches either a single emitter 27 with multiple sensors 24 (Figures 1 to 3), or multiple emitters 40 each having a single sensor 42 (Figure 5), but fails to disclose multiple emitters each having multiple sensors, as required by features (A), (B1) and (B2) of claim 1. The document is also silent with respect to using the hottest temperature as a set point for the control system. Just as in document E3, local overheating is to be avoided (see column 4, lines 60 to 64). Furthermore, E1 also relates to a balloon-expandable system (column 2, lines 12 to 15) and fails to address the issue of blood-contact cooling. Accordingly, when taking E1 as a starting point instead of E7, the

subject-matter of claim 1 is not rendered obvious either.

The mere fact that the proprietor, when drafting the patent application, cited document E6 (cf. paragraph [0008] of the patent specification), which discloses an ablation device with multiple emitters, and might have been aware of the thus achievable benefit of a more uniform temperature distribution along the abating element, does not change this finding.

5.2.9 From the above it follows that the subject-matter of claim 1 of the third auxiliary request is not obvious and involves an inventive step within the meaning of 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 the first instance, with the order to maintain the patent in amended form on the basis of the following documents:

Claims 1 to 3 according to the third auxiliary request filed with the respondent's letter of 6 July 2011;

Description and drawings as upheld by the Opposition Division in the decision under appeal.

The Registrar:

The Chairman:

D. Hampe

M. Noël

Internal distribution code:

- (A) [] Publication in OJ
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(D) [] No distribution

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of 20 July 2011**

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Application Number: 95900364.1

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Language of the proceedings: EN

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Relevant legal provisions:

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EPC R. 42(1)(e)

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Decisions cited:

G 0009/92, G 0004/93, G 0001/99

Catchword:

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Case Number: T 1033/08 - 3.2.02

D E C I S I O N

**of 9 December 2011 correcting an error in the decision
of the Technical Board of Appeal 3.2.02
of 20 July 2011**

Appellant: C.R. BARD INC.
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Murray Hill, New Jersey 07974 (US)

Representative: Marsh, Roy David
Hoffmann Eitle
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Respondent: Boston Scientific Limited
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Representative: Powell, Timothy John
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted
20 March 2008 concerning maintenance of
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Composition of the Board:

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

In application of Rule 140 EPC, the decision in the appeal case T 1033/08 of 20 July 2011 is corrected in that at page 16, line 4, the erroneous reference to "Rule 42(e) EPC" is replaced by Rule 42(1)(e) EPC.

The Registrar:

The Chairman:

C. Eickhoff

M. Noël