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**Datasheet for the decision  
of 3 May 2012**

**Case Number:** T 2268/08 - 3.2.08

**Application Number:** 00911687.2

**Publication Number:** 1156757

**IPC:** A61F 2/06

**Language of the proceedings:** EN

**Title of invention:**

Woven intravascular devices and methods for making the same

**Patent Proprietor:**

Board of Regents,  
The University of Texas System

**Opponent:**

Boston Scientific Corporation

**Headword:**

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**Relevant legal provisions:**

EPC Art. 123(2)  
RPBA Art. 12(2), 13(1)

**Relevant legal provisions (EPC 1973):**

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**Keyword:**

"Main request - Added subject-matter (yes)"  
"Auxiliary requests - not admitted"

**Decisions cited:**

-

**Catchword:**

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Case Number: T 2268/08 - 3.2.08

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.08  
of 3 May 2012

**Appellant:**  
(Patent Proprietor) Board of Regents,  
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**Representative:** HOFFMANN EITLE  
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**Respondent:**  
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**Representative:** Hermann, Gerhard  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 12 December 2008  
revoking European patent No. 1156757 pursuant  
to Article 101(3)(b) EPC.

**Composition of the Board:**

**Chairman:** T. Kriner  
**Members:** M. Alvazzi Delfrate  
D. T. Keeling

## Summary of Facts and Submissions

- I. By decision taken at the oral proceedings on 10 November 2008 and posted on 12 December 2008 the opposition division revoked European Patent No. 1 156 757.
- II. The appellant (patent proprietor) lodged an appeal against this decision on 11 November 2008, paying the appeal fee on the same day. The statement setting out the grounds for appeal was filed on 21 April 2009.
- III. Oral proceedings before the board of appeal were held on 3 May 2012.

The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the Main Request filed on 3 April 2012 or on the basis of Auxiliary Requests I to III, all filed at the oral proceedings, or on the basis of Auxiliary Request IX filed on 3 April 2012.

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

The **Main Request** comprises independent device claim 1 and independent method claim 34. The latter reads as follows:

"A method of creating a body suitable for implantation into an anatomical structure, the body having two ends, the method comprising:

- bending a plurality of shape memory wires to create bent portions in the shape memory wires, the bent portions being arranged to define one end of the body, each shape memory wire having two ends;
  - weaving in a plain weave the ends of the shape memory wires to create the body such that the shape memory wires cross each other to form a plurality of angles, at least one of the angles being obtuse; and
  - securing the ends of the shape memory wires around a finish pin to form closed structures;
- wherein the value of the at least one obtuse angle may be increased by axially compressing the body."

Claim 1 of **Auxiliary Request I** differs from claim 34 of the Main Request in that it refers to finish pins instead to a finish pin, and by the addition of the wording

"the finish pins being supplied on a ring or engaged with a template".

Claim 1 of the **Auxiliary Request II** reads as follows:

"A method of creating a body suitable for implantation into an anatomical structure, the body having two ends, the method comprising:

- bending a plurality of shape memory wires to create bent portions in the shape of memory wires, the bent portions being arranged to define one end of the body, the bent portions having an angle  $b$ , each shape memory wire having two ends;
- weaving in a plain weave the ends of the shape memory to create the body such that the shape memory wires

cross each other to form a plurality of angles, at least one of the angles being obtuse; and

- forming closed structures with the ends of the shape memory wires by securing the wire ends around finish pins, the angle created between the crossed wire ends being similar, if not identical, to angle b, the finish pins being supplied on a ring or engaged with a template;

wherein the value of the at least one obtuse angle may be increased by axially compressing the body."

Claim 1 of **Auxiliary Request III** differs from claim 1 of Auxiliary Request II by the addition of the feature "angle b being about 140-160°".

Claim 1 of **Auxiliary Request IX** reads as follows:

"A method of creating a body suitable for implantation into an anatomical structure, the body having two ends, the method comprising:

- bending a plurality of shape memory wires to create bent portions in the shape memory wires, the bent portions being arranged to define one end of the body, each shape memory wire having two ends; and
- weaving in plain weave the ends of the shape memory wires to create the body such that the shape memory wires cross each other to form a plurality of angles, at least one of the angles being obtuse;
- wherein the value of the at least one obtuse angle being increased by axially compressing the body;
- the method further comprising providing a weaving system comprising:
  - o a template having first template projections;

o bending the shape memory wires around the first template projections to create the bent portions in the shape memory wires, the bent portions having an angle of about 140-160 degrees;

- the method further comprising forming closed structures with the ends of the shape memory wires, the closed structures being arranged to define the other end of the body; and
- after the plain weave process is complete, coupling the wire ends together instead of by twisting."

IV. In respect of the issues relevant to the present decision the appellant argued essentially as follows:

*Main Request*

The feature of claim 34 according to which the ends of the shape memory wires were secured around a finish pin had to be understood in that way that the two ends of each shape memory wire had to be secured around a finish pin. Accordingly, a method which used more than one wire required the use of finish pins instead of a single finish pin. It was true that the use of finish pins according to the claimed method was disclosed in the application as originally filed on pages 37 to 39, and that, contrary to claim 34 of the Main Request, the embodiment disclosed in said passage comprised the use of a template. However, the application also disclosed, for instance at page 12, line 11 to page 13, line 8 or at page 43, lines 16-17, that the claimed method was not limited to the use of a template.

Nor was it necessary to use a template in order to obtain an angle between the crossed wire ends similar

to the angle  $b$ , since it was possible to imagine a technique to obtain this result which did not involve a template.

Hence the amendment which introduced in claim 34 of the Main Request the feature according to which the ends of the shape memory wires are secured around a finish pin to form closed structures complied with Article 123(2) EPC.

*Auxiliary Requests I to III*

Auxiliary Requests I to III had been filed as reaction to the discussion during the oral proceedings concerning the fact that claim 34 of the Main Request did not mention a template. It was true that the board had already indicated in its preliminary opinion that the claims of the Main Request appeared to be objectionable for this reason. However, this was merely a preliminary opinion with which the appellant disagreed. Moreover, filing Auxiliary Requests in advance of the oral proceedings to take into account all of the points raised in the preliminary opinion of the board would have resulted in an extremely high number of requests. Therefore, Auxiliary Requests I to III should be admitted into the proceedings.

*Auxiliary Request IX*

Auxiliary Request IX had been filed in advance of the oral proceedings and was clearly allowable. In particular, the feature according to which the wire ends are coupled together other than by twisting was disclosed in the application as originally filed on

page 37, lines 14-18. Hence, its introduction in claim 1 complied with Article 123(2) EPC. Moreover, although claim 1 did not comprise the feature relating to the finish pins, it did not create a fresh case, as other requests filed with letter of 3 April 2012 did not comprise this feature either. Under these conditions, Auxiliary Request IX should also be admitted into the proceedings.

- V. In respect of the issues relevant to the present decision the respondent argued essentially as follows:

*Main Request*

Although the application as originally filed disclosed that the body for implantation could be obtained without the use of a template, the use of finish pins was always disclosed in connection with the application of a template. Hence, the amendment of claim 34 which introduced the use of finish pin(s) without a template resulted in an unallowable intermediate generalisation contrary to Article 123(2) EPC.

*Auxiliary Requests I to III*

Auxiliary Requests I to III had been filed at an extremely late stage of the procedure without a good reason. Moreover, they were prima facie not allowable, since they all comprised an alternative wherein the finish pins were arranged on a ring, without the involvement of a template. Therefore, they should not be admitted into the procedure.



*Auxiliary Request IX*

Auxiliary Request IX was also late filed. Since this request did not involve the use of finish pins it created a completely fresh case. Moreover, it was prima facie also not allowable, since the application as originally filed disclosed that the wire ends are coupled together other than by twisting only for methods capable of withstanding a given heating treatment.

**Reasons for the Decision**

1. The appeal is admissible.
2. Main Request

During the opposition proceedings claim 34 of the Main Request (corresponding to the Main Request filed together with the statement of grounds of appeal) had been amended to comprise the feature according to which the ends of the shape memory wires are secured around a finish pin to form closed structures.

The application as originally filed discloses the use of finish pins in the passage on page 37, line 19 to page 39, line 19. However, contrary to claim 34, said passage also describes the use of a template.

In order to comply with Article 123(2) EPC it is only admissible to extract isolated features from a set of features which were originally disclosed in combination in an embodiment of the invention if the person skilled

in the art can directly and unambiguously derive from the application as filed that the isolated features are not closely related to the other characteristics of the embodiment.

In the present case this requirement is not satisfied. It is true that the application as originally filed discloses at page 12, line 11 to page 13, line 8 and at page 43, lines 16-17, that the body suitable for implantation can also be created without the use of a template. However, neither of these passages discloses that the template can be dispensed with when finish pins are used.

On the contrary, the application as originally filed presents said features as closely related. According to the passage on page 39, lines 8-10 an aim of the use of finish pins is to obtain an angle between the crossed wire ends similar to the angle  $b$ , which is the angle obtained by bending the wires around starting pins placed on a template (see paragraph bridging pages 33 and 34). The only ways of obtaining this result disclosed in the application as filed involve providing the finish pins on the template either directly (see page 37, lines 20-24) or by means of a ring carrying the pins and engaged with the template (see page 37, lines 24-29).

The appellant submitted that it was possible to imagine obtaining said result without the use of a template. However, said possibility, even if its existence is accepted, is not directly and unambiguously derivable from the application as filed.

Hence, the person skilled in the art cannot directly and unambiguously recognize from the application as filed that the use of finish pins is not closely related to the use of a template. As a consequence, the addition of the feature according to which the ends of the shape memory wires are secured around a finish pin to form closed structures without the feature relating to the use of a template in combination with the finish pins results in an unallowable intermediate generalisation. Therefore, claim 34 has been amended contrary to Article 123(2) EPC.

### 3. Auxiliary Requests

3.1 According to Article 13(1) of the Rules of Procedure of the Boards of Appeal (OJ EPO 11/2007, page 536), any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion. That discretion is to be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

3.2 Auxiliary Request I has been filed at the oral proceedings before the board of appeal, i.e. at a very late stage of the proceedings. According to the appellant this request was filed as a reaction to the discussion during the oral proceedings concerning the fact that claim 34 of the Main Request did not mention a template.

However, the issue of the absence of a template was already addressed in the decision under appeal (see point 4.2 of the reasons for the decision). Moreover,

it was also one of the points raised by the board of appeal in its communication annexed to the summons to the oral proceedings. Hence, the appellant, albeit disagreeing with the board's opinion, was well aware of the potential problem and could have filed an auxiliary request in advance of the oral proceedings to address it, especially since the number of points raised in said communication was very limited. Therefore, no good reason can be seen for filing the Auxiliary Request I at said late stage.

Moreover, claim 1 of Auxiliary Request I relates to two alternative arrangements of the pins. While one of them involves finish pins engaged with a template, the other one, according to which the pins are supplied on a ring, does not require the use of a template. Hence, it is doubtful that this claim meets the objection under Article 123(2) EPC raised against the Main Request, and Auxiliary Request I cannot constitute a promising attempt to counter the objection raised in respect of the Main Request. As a consequence, it is not *prima facie* allowable and its filing at such a very late stage of the proceedings is at odds with the need for procedural economy.

Under these circumstances, Auxiliary Request I was not admitted into the proceedings.

- 3.3 The same reasoning applies *mutatis mutandis* to Auxiliary Request II and III. As a consequence, they were not admitted into the proceedings either.
- 3.4 Auxiliary Request IX was filed with letter of 3 April 2012. Contrary to all the requests underlying the

appealed decision and to those filed together with the statement of grounds of appeal Auxiliary Request IX does not comprise the feature relating to the finish pin(s). Therefore, it creates a fresh case. This is neither in line with the main function of the appeal proceedings, which is not to examine and decide upon a fresh case but rather to review the decision under appeal, nor with the requirements of Article 12(2) RPBA, according to which the statement of grounds of appeal and the reply shall contain a party's complete case. The fact that the same applies in respect of other requests filed with the same letter of 3 April 2012 is immaterial, since said other requests were also not filed together with the grounds of appeal.

Moreover, it is doubtful whether or not the application as originally filed supports the amendment introducing the feature according to which the wire ends are coupled together other than by twisting. The passage indicated by the appellant as a basis, on page 37, lines 14-18, discloses that the wire ends may be coupled together instead of by twisting, using any suitable means capable of withstanding the heating described below said passage. Since claim 1 of Auxiliary Request IX does not state said capability of withstanding heating, this request does not prima facie comply with Article 123(2) EPC.

Under these circumstances Auxiliary Request IX is not admitted into the proceedings either.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:

V. Commare

T. Kriner