

**Internal distribution code:**

- (A) [ - ] Publication in OJ
- (B) [ - ] To Chairmen and Members
- (C) [ X ] To Chairmen
- (D) [ - ] No distribution

**Datasheet for the decision  
of 24 May 2012**

**Case Number:** T 0458/09 - 3.3.10

**Application Number:** 02251370.9

**Publication Number:** 1236478

**IPC:** A61L29/16, A61L29/08,  
A61L31/10, A61L31/16

**Language of the proceedings:** EN

**Title of invention:**

Peroxisome proliferator-activated receptor gamma ligand  
eluting medical device

**Patent Proprietor:**

Medtronic Vascular, Inc.

**Opponent:**

Conor Medsystems, Inc.

**Headword:**

**Relevant legal provisions:**

EPC Art. 100(c), 123(2)

**Keyword:**

Added subject-matter (yes, all requests)

**Decisions cited:**

**Catchword:**



Case Number: T0458/09 - 3.3.10

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.10**  
**of 24 May 2012**

**Appellant:** Medtronic Vascular, Inc.  
(Patent Proprietor) 3576 Unocal Place  
Santa Rosa, CA 95403 (ETATS-UNIS D'AMERIQUE)

**Representative:** Baker, Colin John  
Potter Clarkson LLP  
Park View House  
58 The Ropewalk  
Nottingham  
NG1 5DD (ROYAUME UNI)

**Appellant:** Conor Medsystems, Inc.  
(Opponent) 1003 Hamilton Court  
Menlo Park, CA 94025 (ETATS-UNIS D'AMERIQUE)

**Representative:** Schorr, Frank Jürgen  
Diehl & Partner GbR  
Augustenstrasse 46  
80333 München (ALLEMAGNE)

**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted 22  
December 2008 concerning maintenance of the  
European Patent No. 1236478 in amended form.**

**Composition of the Board:**

**Chairman:** P. Gryczka  
**Members:** R. Pérez Carlón  
D. Rogers

## Summary of Facts and Submissions

- I. The present appeal lies from an interlocutory decision of the opposition division to maintain European patent No. EP 1 236 478 in amended form.
- II. An opposition had been filed, which objected to the subject-matter of the patent in suit as containing added subject-matter (Article 100(c) EPC), that the invention was not disclosed in a manner sufficiently clear to be carried out by a skilled man (Article 100(b) EPC) and that the subject-matter of the claims was not novel and did not involve an inventive step (Article 100(a) EPC).
- III. The opposition division decided that claim 1 of the main request (patent as granted) contained added subject-matter, and that auxiliary request A then pending fulfilled the requirements of the EPC.

Both parties appealed the decision.

- IV. Claim 1 of the main request (patent as granted) reads as follows:

*"A medical device comprising a vascular implant having a controlled release coating comprising at least one PPAR- $\gamma$  agonist wherein the at least one PPAR- $\gamma$  agonist is delivered locally to a blood vessel wall in an amount sufficient to inhibit cellular proliferation without inducing systemic toxicity."*

With the statements of grounds for appeal, the patent proprietor (appellant 2) filed 14 sets of auxiliary requests. Independent claim 1 of every auxiliary request on file also contains the feature "...in an

*amount sufficient to inhibit cellular proliferation without inducing systemic toxicity".*

- V. In the annex to the summons to oral proceedings, the board informed the parties that they should be prepared to discuss, *inter alia*, whether the feature "in an amount sufficient to inhibit cellular proliferation without inducing systemic toxicity", present in independent claim 1 of all the requests on file, found a basis in the application as originally filed.
- VI. With a letter dated 23 April 2012, appellant 2 (patent proprietor) withdrew its request for oral proceedings and requested a decision on the contents of the file.
- VII. Oral proceedings took place before the Board on 24 May 2012, in the absence of the duly summoned appellant 2.
- VIII. Appellant 1 (opponent) submitted that the feature "in an amount sufficient to inhibit cellular proliferation without inducing systemic toxicity" found no basis in the application as originally filed. Claim 1 of all requests did thus not comply with the requirements of Article 123(2) EPC.
- IX. Appellant 2 (patent proprietor), who requested a decision based on the contents of the file, did not provide in writing any argument relating to the basis in the application as filed of the feature "in an amount sufficient to inhibit cellular proliferation without inducing systemic toxicity".
- X. Appellant 1 requested that the decision under appeal be set aside and that the European patent No. 1 236 478 be revoked.

- XI. Appellant 2 requested, in writing, that the decision under appeal be set aside and the patent be maintained as granted (main request), or alternatively upon the basis of the claims of one of the auxiliary requests 1-14 filed with the statements of grounds for appeal.
- XII. At the end of the oral proceedings, the decision was announced.

### **Reasons for the Decision**

1. The appeal is admissible.

Main request, added subject-matter:

2. The feature "in an amount sufficient to inhibit cellular proliferation without inducing systemic toxicity", not present in the claims as filed, has been added to claim 1 of the patent in suit during examination.
3. The term "proliferation" can be found in the application as filed in paragraphs [14], [17], [22], [30], and examples 6-8.

On each occurrence, this term is, however, combined with the disclosure of those types of cells on which proliferation shall be inhibited, namely "vascular smooth muscle cells" (VSMC), "human coronary artery smooth muscle cells" or "human coronary artery endothelial cells".

The application as filed does not provide, therefore, a basis for a vascular implant with a controlled release coating which allows delivering a therapeutic agent to a blood vessel in an amount sufficient for inhibiting

proliferation of *any type of cells* as required by claim 1 of the main request.

4. Since the afore-mentioned inhibition of proliferation has only been disclosed in the application as filed in combination with those specific types of cells whose proliferation shall be inhibited, and this limitation is not present in claim 1 of the patent as granted (main request), the board concludes that the subject-matter of the patent as granted extends beyond the content of the application as originally filed.

Since the ground for opposition mentioned in Article 100(c) EPC prejudices the maintenance of the patent on the basis of claim 1 as granted, the main request must be rejected.

Auxiliary requests 1-14, added subject-matter:

5. The feature "in an amount sufficient to inhibit cellular proliferation without inducing systemic toxicity" is also present in independent claim 1 of all the auxiliary requests, without any limitation regarding the type of cells whose proliferation would be inhibited. Therefore, none of the auxiliary requests on file is allowable, for the same reason explained above with respect to the main request.

## **Order**

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

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated