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Datasheet for the decision of 12 February 2014

Case Number: T 0828/10 - 3.2.02

Application Number: 04076935.8

Publication Number: 1464293

IPC: A61B17/68, A61B17/88, A61M25/10, A61F2/46

Language of the proceedings: EN

Title of invention:
Improved inflatable device for use in surgical methods relating to fixation of bone

Patent Proprietor:
Kyphon SÀRL

Opponent:
Stryker S.A.

Headword:

Relevant legal provisions:
EPC Art. 76(1), 100(c)

Keyword:
Amendments - added subject-matter (yes)

Decisions cited:

Catchword:

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Case Number: T 0828/10 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 12 February 2014

Appellant: (Patent Proprietor)	Kyphon SÀRL Pierre-à-Bot 97 2000 Neuchâtel (CH)
Representative:	August & Debouzy avocats 6-8 avenue de Messine 75008 Paris (FR)
Respondent: (Opponent)	Stryker S.A. Cité-Centre, Grand-Rue 90-92 1820 Montreux 1 (CH)
Representative:	Schicker, Silvia Wuesthoff & Wuesthoff Patent- und Rechtsanwälte Schweigerstrasse 2 81541 München (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 11 February 2010 revoking European patent No. 1464293 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman: E. Dufrasne
Members: C. Körber
M. Stern

Summary of Facts and Submissions

I. On 11 February 2010 the Opposition Division posted its decision to revoke European patent No. 1464293.

II. An appeal was lodged against this decision by the patent proprietor by notice received on 13 April 2010, with the appeal fee being paid on the same day. The statement setting out the grounds of appeal was received on 21 June 2010.

III. By communication of 27 February 2012, the Board forwarded its provisional opinion to the parties, addressing objections under Articles 76(1) and 100(c) EPC, inter alia with respect to the catheter as defined in claim 1 of all requests (point 2.3), and summoned them to oral proceedings to be held on 30 May 2012.

IV. With its letter dated 10 April 2012, the appellant (patent proprietor) withdrew its request for oral proceedings and indicated that it would not take part in them. The respondent (opponent) also indicated with its letter dated 3 April 2012 that it would not attend the oral proceedings. By telefax of 16 May 2012, the Board informed the parties that the oral proceedings were cancelled. No further submissions were received by the parties thereafter. Since the reasons for the present decision are based on point 2.3 of the Board's communication of 27 February 2012, in response to which the parties have not presented any arguments, there is no need to summarise them.

V. The appellant requested that the impugned decision be set aside and, as its main request, that the patent be maintained as granted or, in the alternative, on the basis of one of auxiliary requests No. 1, 2 or 3 filed

on 21 June 2010. The respondent did not file any submissions or requests.

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

Main request:

"An assembly for use in treating a bone comprising:
a cannula (26) whose interior provides a percutaneous access path for inserting instruments into the bone;
a device (10) adapted to form a cavity in cancellous bone by enlarging from a first size that permits passage of the device through the cannula for insertion into bone, to a second predetermined shape and size sufficient for compressing at least a portion of the cancellous bone so as to form the cavity therein, the device including at least one component (117) to resist enlargement of the device beyond the predetermined shape and size;
a catheter (21) which has a size for passage through the cannula and is adapted to drive the device through the cannula into the bone;
a tool to place within the cavity through the percutaneous access path a volume of filling material."

Auxiliary request No. 1 (amendments to the main request highlighted in bold):

"An assembly for use in treating a bone comprising:
a cannula (26) whose interior provides a percutaneous access path for inserting instruments into the bone;
a**n inflatable** device (10) adapted to form a cavity in cancellous bone by enlarging from a first size that permits passage of the device through the cannula for insertion into bone, to a second predetermined shape and size sufficient for compressing at least a portion

of the cancellous bone so as to form the cavity therein, the device including at least one component (117) to resist enlargement of the device beyond the predetermined shape and size;
a catheter (21) which has a size for passage through the cannula and is adapted to drive the device through the cannula into the bone;
a tool to place within the cavity through the percutaneous access path a volume of filling material.

Auxiliary request No. 2 (amendments to the main request highlighted in bold):

"An assembly for use in treating a bone comprising:
a cannula (26) whose interior provides a percutaneous access path for inserting instruments into the bone;
a**n inflatable** device (10) adapted to form a cavity in cancellous bone by enlarging from a first size that permits passage of the device through the cannula for insertion into bone, to a second predetermined shape and size sufficient for compressing at least a portion of the cancellous bone so as to form the cavity therein, the device including at least one component (117) to resist enlargement of the device beyond the predetermined shape and size;
a catheter (21) which has a size for passage through the cannula and is adapted to drive the device through the cannula into the bone;
a tool to place within the cavity through the percutaneous access path a volume of **a biocompatible, flowable, bone** filling material."

Auxiliary request No. 3 (amendments to the main request highlighted in bold):

"An assembly for use in treating a bone comprising:

a cannula (26) whose interior provides a percutaneous access path for inserting instruments into the bone;
a**n inflatable** device (10) adapted to form a cavity in cancellous bone by enlarging from a first size that permits passage of the device through the cannula for insertion into bone, to a second predetermined shape and size sufficient for compressing at least a portion of the cancellous bone so as to form the cavity therein, the device including at least one **restraining** component (117) to resist enlargement of the device beyond the predetermined shape and size;
a catheter (21) which has a size for passage through the cannula and is adapted to drive the device through the cannula into the bone;
a tool to place within the cavity through the percutaneous access path a volume of **a biocompatible, flowable, bone** filling material."

Reasons for the Decision

1. The appeal is admissible.

2. Amendments

Claim 1 according to all above-mentioned requests comprises the feature of "a catheter (21) which has a size for passage through the cannula and is adapted to drive the device through the cannula into the bone". This feature was not included in the set of claims of the parent application as originally filed (WO-A-95/20362). Claims 32 and 69 of the parent application merely refer to a "catheter tube ... for removing fats and debris", without referring to the function of driving the device through the cannula into the bone.

In the description of the parent application, there are various passages dealing with catheters or catheter tubes. The respective passages in the "Summary of the invention" also refer to a "suction catheter" for removing fat, fluid or other products (page 7, lines 8 to 11; page 8, lines 16 to 19), denoted by reference numeral 16 in the "Detailed Description of the Preferred Embodiment" (Figures 1, 2 and 6 to 8 in combination with page 18, lines 20 to 25, page 20, lines 1 to 3, page 21, lines 6 to 7). Nowhere is there any indication that this catheter (16) is used to drive the device through the cannula into the bone.

Figures 1, 2 and 8 further depict a catheter (21) branching into two tubes (18 and 20) for introducing inflation liquid into the two parts of the balloon (page 18, lines 26 to 31). Similarly, the tube or catheter (88) shown in Figures 6, 6A, 7, 15 and 17A also serves to inflate the balloon (page 16, lines 22 to 25; page 21, lines 2 to 6 and 13 to 14; page 23, lines 4 to 6; page 25, lines 2 to 6). Figures 6 and 6A depict a second catheter 16 in addition to catheter 88, which is said at page 21, lines 6 to 7 to be "inserted into the space 96 between the two parts of the balloon 80". To the skilled person reading this passage in the context of the overall disclosure it is clear, however, that this second catheter is the above-mentioned suction catheter denoted by reference numeral 16, and not an additional catheter for driving the device through the cannula into the bone.

In the second paragraph of page 19 it is stated with respect to the embodiment shown in Figure 8 that "[t]he balloon in cannula 26 is deflated and is forced through the cannula by exerting manua1 force on the catheter 21

which extends into a passage 28 extending into the interior of the bone. The catheter is slightly flexible but is sufficiently rigid to allow the balloon to be forced into the interior of the bone where the balloon is then inflated by directing fluid into tube 88 whose outlet ends are coupled to respective parts 12 and 14". From this passage it may be derived that the catheter (21) "has a size for passage through the cannula and is adapted to drive the device through the cannula into the bone", as claimed. However, this catheter (21) is the one which also serves to inflate the balloon, i.e. it is one and the same catheter that performs both functions. There is no basis in the parent application for a catheter that only performs the claimed function of driving the device through the cannula, without also performing the function of inflation. The above-mentioned passage at page 19 relating to Figure 8 cannot be interpreted as a disclosure of two separate catheters, i.e. one catheter (21) adapted to drive the device through the cannula into the bone, and an additional tube or catheter (88) adapted to inflate the balloon. The referenced "tube 88" is not depicted anywhere in Figure 8, let alone in addition to the catheter denoted by reference numeral 21. In view of the fact that reference is made to "tube 88 whose outlet ends are coupled to respective parts 12 and 14", it seems that in this passage reference numeral 88 was used erroneously instead of reference numeral 21.

Finally, the passage at page 7, lines 1 to 5 refers to a "guide pin" and a cannula for inserting the balloon into the bone. However, a "guide pin" cannot be equated to a catheter for driving the device through the cannula into the bone.

Accordingly, there is no disclosure of a catheter which merely "has a size for passage through the cannula and is adapted to drive the device through the cannula into the bone", without being linked to its function of also inflating the balloon. For this reason alone, the subject-matter of claim 1 not only of the main request but also of the first to third auxiliary requests extends beyond the content of the parent application as filed, contrary to Articles 76(1) and 100(c) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

D. Hampe E. Dufrasne

Decision electronically authenticated