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**Datasheet for the decision
of 20 December 2012**

Case Number: T 1500/10 - 3.2.08

Application Number: 01130605.7

Publication Number: 1199052

IPC: A61F 2/06

Language of the proceedings: EN

Title of invention:

Stent and catheter assembly and method for treating bifurcations

Applicant:

Abbott Cardiovascular Systems Inc.

Headword:

-

Relevant legal provisions:

EPC Art. 84, 112(3), 113(1), 116(1), 123(2)
EPC R. 71(2), 103(1), 115(1)(2), 111(1)

Keyword:

"Clarity and allowability of amendments - (yes)"

"Reimbursement of the appeal fee (no)"

Decisions cited:

G 0004/92, T 0197/88, T 0951/92, T 0051/91

Catchword:

If oral proceedings take place at the instance of the European Patent Office because it considers this to be expedient under Article 116(1) EPC and the duly summoned party does not attend them without serious reasons, this conduct can have the consequence that it would not be equitable to reimburse the appeal fee."



Case Number: T 1500/10 - 3.2.08

D E C I S I O N
of the Technical Board of Appeal 3.2.08
of 20 December 2012

Appellant: Abbott Cardiovascular Systems, Inc.
(Applicant) 3200 Lakeside Drive
Santa Clara, CA 95054 (US)

Representative: McLeish, Nicholas Alistair Maxwell
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 27 January 2010
refusing European patent application
No. 01130605.7 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: T. Kriner
Members: R. Ries
A. Pignatelli

Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal against the decision of the examining division dated 27 January 2010 refusing European patent application No. 01130605.7.

The appeal was received at the European Patent Office on 29 March 2010 and the appeal fee was paid on the same day. The statement setting out the grounds of appeal was received on 7 June 2010.

- II. During the examination proceedings, the examining division objected in a first communication dated 29 September 2008 to the claims on file. The objections concerned lack of unity, lack of clarity, unallowable amendments, lack of novelty and of inventive step. The applicant amended the claims. Objections against the new claims were raised in a communication dated 12 February 2009. After the applicant filed new claims, the Examining Division summoned it to oral proceedings and sent, annexed to the summons, a communication dated 4 September 2009. In this communication, the examining division raised objections under Articles 84 and 123(2) EPC to the claims then on file.

On 21 September 2009 and again on 7 December 2009, the applicant's representative contacted the examiner by telephone and inquired whether the outstanding objections could be discussed over the phone. The examiner indicated on both occasions that a discussion over the phone prior to the appointed oral proceedings was not considered appropriate.

With a letter dated 10 December 2009 the appellant submitted a revised set of claims and stated that there was a misunderstanding on the part of the examining division and that it was not possible for it to understand where the misunderstanding lay. In the last paragraph of the letter it requested cancellation of the oral proceedings and continuation of the proceedings in writing. The reason was that "... the applicant does not consider it beneficial to attend the forthcoming oral proceedings".

During a telephone conversation on 1st January 2010, the examiner again explained to the representative that the examining division needed to discuss in oral proceedings, and not just in an informal telephone conversation, whether the recently filed claims really satisfied the requirements of clarity, added subject-matter and, subject to a clear claim formulation, of novelty and inventive step.

Despite this explanation, the representative informed the examining division by letter dated 8 January 2010 that he would not attend the oral proceedings scheduled for 12 January 2010. Instead he requested that a decision under Rule 111(2) EPC be issued on the basis of the submissions filed so far.

At the end of the oral proceedings, held in the absence of the applicant, the examining division issued the decision under appeal. The application was refused because claim 1 did not fulfil the requirements of Articles 84 and 123(2) EPC.

III. In the official communication of 20 April 2012 annexed to the summons to oral proceedings, the Board gave its provisional view on the case. The claims of all requests then on file were considered to lack clarity pursuant to Article 84 EPC and to contravene the requirements of Article 123(2) EPC.

IV. Oral proceedings were held on 23 October 2012.

The appellant requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution on the basis of claims 1 to 5 according to the request filed during the oral proceedings.

It further requested that the appeal fee be reimbursed.

The former main request and auxiliary requests 1 to 3 were withdrawn.

V. Claim 1 of the sole new request reads as follows:

"An assembly for treating a bifurcation, the assembly comprising:

 a first, side branch catheter (31) having a balloon portion;

 a proximal-angled stent (10) mounted on the balloon portion of the first, side-branch catheter (31) for implanting in a side-branch vessel (5) adjacent a bifurcation (4) between the side-branch vessel (5) and a main vessel (6), the proximal-angled stent (10) comprising a cylindrical member (11) having a longitudinal axis (12), the cylindrical member having a distal end (13) and a proximal end (14), the distal end

(13) forming a first plane section (15) substantially transverse to the longitudinal axis, and the proximal end (14) forming a second plane section (16) having an acute angle (18) relative to the longitudinal axis (12);

a second, main-vessel catheter (50) having a balloon portion; and

a main-vessel stent (20) mounted on the balloon portion of the second, main-vessel catheter (50) for implanting in the main vessel (6) adjacent the bifurcation (4), the main-vessel stent (20) comprising a cylindrical member (21) having a distal end (22), a proximal end (23), an outer wall surface (24) therebetween, and an aperture (25) in the outer wall surface (24), the aperture (25) being configured so that, upon expansion, it approximates the diameter of the expanded proximal end (14) of the proximal-angled stent (10)."

Dependent claims 2 to 5 refer to preferred embodiments of the assembly according to claim 1.

VI. The appellant's arguments are summarized as follows:

Articles 84 and 123(2) EPC

Present claim 1 resulted from a combination of the subject-matter set out in claims 1 and 4 as originally filed and the technical disclosure given on page 24, lines 9 to 11 and page 26, lines 18 to 20. In order to meet the requirement of clarity, the explanatory wording in original claims 1 and 4 was deleted so that amended claim 1 was defined purely by the structural

features of the claimed assembly. Hence the requirements of Articles 84 and 123(2) EPC were met.

Reimbursement of the appeal fee; Rule 103(1) EPC

As stated in paragraph 3 of the Reasons for the decision, the examining division refused the application in view of the alleged deficiencies under Articles 84 and 123(2) EPC. The first deficiency concerned the interpretation of the term "assembly" while the second related to the term "aperture" recited as a feature of the main vessel stent. Both terms were considered obscure in their meaning, as set out in point 1 of the impugned decision.

However, neither objection was raised ever before the oral proceedings in any of the previous official communications or in the summons to oral proceedings. Moreover, neither objection was occasioned by the amendments to the claims filed with the appellant's submissions of 10 December 2009. Consequently, none of the previous communications contained the essential factual and legal reasoning leading to the finding in the subsequent decision that the definition of the terms "assembly" and "aperture" recited in claim 1 lacked clarity. Put another way, the application was not refused on the basis of any of the objections which were raised in the communications and known to the appellant, but rather on the basis of two further objections which at no point were communicated to the appellant. Since the decision itself informed the appellant for the first time of the existence of these specific objections and the appellant had not had an

opportunity to present its comments, it was taken by surprise. Such a surprising situation amounted to a substantial procedural violation in view of Article 113(1) EPC (reference being made in this context also to decision T 197/88, point 4).

Having regard to this lack of reasoning in the communications and following the considerations given in decision T 951/92, points 3.VI and VIII, it would have been legally necessary to send a further communication before issuing a decision. Failure by the examining division to do so also constituted a substantial procedural violation of Rule 71(2) EPC.

The impugned decision itself confirmed this finding in point 2, by stating that these objections were raised for the first time at the oral proceedings which the appellant had requested and, although duly summoned, chose not to attend.

Pursuant to Rule 115(2) EPC and according the Notice from the European Patent Office in the OJ/EPO, 10/2008, page 471, concerning the non-attendance at oral proceedings before the examining division, the oral proceedings could be conducted without the appellant, since a party should not be able to delay issuance of a decision by failing to appear. If, however, the situation arouse, as discussed in the Guidelines for Examination, Part E-III 8.3.3.3 that new facts were taken into consideration, then at the end of the oral proceedings a decision based on these facts could not be taken against the absent party. As was shown above, the contrary happened in the present case.

In the circumstances of this case, a substantial procedural violation occurred and it was therefore equitable that the appeal fee should be refunded.

VII. At the oral proceedings before it, the Board closed the debate and informed the party that the decision would be issued in writing.

Reasons for the Decision

1. The appeal is admissible.
2. Amendments, Articles 123(2) and 84 EPC
 - 2.1 The subject matter of claim 1 of the main request results from the technical disclosure of claims 1 and 4 as originally filed, page 24, lines 9 to 12 and page 26, lines 18 to 20.

The additional wording featuring in the first part of claim 1 as originally filed that (i):

"the acute angle (18) being selected to approximately coincide with an angle formed by the intersection of the side branch vessel (5) and the main vessel (6)"

and in the second part of claim 4 as originally filed that (ii)

"the aperture being sized and positioned in the outer wall surface so that when the stent is implanted in the main vessel (6), the aperture (25) is alignable with the side-branch vessel (5) thereby allowing unrestricted blood flow from the main vessel through the side-branch vessel (5)"

has no limiting effect on the scope of these claims but is of an explanatory character only. Consequently, the absence of wording (i) and (ii) in present claim 1 of the main request does not contravene the requirements of Article 123(2) EPC.

2.2 As to the issue of clarity, it is evident from the application as filed that the term "assembly for treating a bifurcation" in fact means a "stent deployment or delivery assembly" or a "stent delivery system", respectively, which is adapted specifically for treating bifurcated vessels and comprises the structural parts defined in claim 1. Reference is made in this context to the application as filed, page 1, lines 3 to 6; page 11, lines 9 to 11 and page 12, lines 6 to 10; page 24, lines 9 to 12; and page 27, lines 21 to 24.

Turning to the term "aperture", which was objected to by the examining division in the impugned decision with respect to clarity, present claim 1 now clearly defines by structural features that aperture (25) is located in the outer wall surface of the main-vessel stent and upon expansion approximates to the diameter of the proximal end (14) of the expanded proximal-angled stent.

Dependent claims 2 to 5 correspond to claims 2, 3, 5 and 6 as originally filed.

2.3 Claims 1 to 5 of the main request therefore meet the requirements of Articles 123(2) and 84 EPC, respectively.

3. Reimbursement of the appeal fee; Rule 103 EPC
- 3.1 In the present case, the Board considers that the conduct of the applicant in the first instance proceedings was such that it is not equitable to reimburse the appeal fee even if it were assumed in its favour that a substantial procedural violation occurred.
- 3.2 The reimbursement of the appeal fee under Rule 103(1) (a) EPC is subject to three conditions:
 - i. the Board of Appeal considers the appeal to be allowable;
 - ii. a substantial procedural violation occurred during the proceedings before the first instance department;
 - iii. the reimbursement is equitable.
- 3.3 According to the jurisprudence of the Boards of Appeal, the conduct of the appellant can render the reimbursement of the appeal fee not equitable (cf. condition iii) even if a substantial procedural violation occurred, in particular if the appellant made no use of opportunities given to it to participate in the initial proceedings (cf. decisions cited in Case Law of the Boards of Appeal of the European Patent Office, 6th edition, 2010, VII.E.17.3.2).
- 3.4 It is generally recognised that the purpose of oral proceedings is to settle as far as possible all outstanding questions relevant to the decision and to speed up the procedure (see Visser, *The Annotated European Patent Convention*, 19th edition, Article 116, point 1; Benkard, *EPÜ* 2nd edition, Art. 116 note 2;

Singer-Stauder EPÜ Kommentar 5th edition, Art. 116 note 2; and also the "Notice from the European Patent Office concerning non-attendance at oral proceedings before the examining division", published in OJ EPO 2008, 471).

Accordingly, Article 116(1) EPC foresees that oral proceedings shall take place not only at the request of a party but also at the instance of the EPO if it considers this to be expedient.

This provision and the use of the word "shall" in it has three important procedural consequences:

- i. It follows from this provision that the parties have not only a right to oral proceedings when they request them but also a duty to participate in oral proceedings, where this is considered expedient by the Office in order to assist the Office to bring the proceedings to a close.
- ii. It also follows that parties do not have a right to a solely written procedure.
- iii. It further follows that under the EPC oral proceedings are in themselves a procedural opportunity for a party to present comments and for the Office to present objections, even if these were not communicated beforehand. Whether in such a case a party who duly attends the oral proceedings has the right to an interruption or even to a postponement of the oral proceedings to answer these new objections will depend on the particular case. However, this is not the issue in

the present case because the party did not attend the oral proceedings.

The consequence of the non-observation of the duty to attend the oral proceedings when they take place at the instance of the Office is set out on the one hand in Rule 115(2) EPC, according to which if a party duly summoned to oral proceedings before the EPO does not appear as summoned, the proceedings may continue without that party, and on the other hand in the "Notice from the European Patent Office concerning non-attendance at oral proceedings before the examining division", published in OJ EPO 2008, 471, which also makes it clear that a duly summoned party who chooses not to attend oral proceedings has to expect that a decision will be taken at the oral proceedings even if it has submitted amended claims on which no communication was issued.

In fact, this Notice, together with Rule 115(2) EPC, make it clear that the oral proceedings are themselves an opportunity for the applicant to present its comments, in accordance with Article 113(1) EPC. They confirm that, if a party decides not to attend the oral proceedings without a serious reason, it chooses not to make use of the opportunity to comment at the oral proceedings on any of the objections raised during them and, as explained above, it has no right to make additional written submissions.

- 3.5 As is apparent from the file, the examining division repeatedly explained to the applicant that it considered the oral proceedings to be necessary in order to clarify all the problems of the claims on file.

It also appears from the file that it was clear to the appellant that the examining division had difficulty in understanding the case submitted by it and considered oral proceedings necessary to clarify the matter (see the letter of the appellant dated 10 December 2009).

It was clear to the appellant that the oral proceedings were appointed not only at its request but also because the examining division considered it expedient.

Thus, the applicant had an obligation to attend the oral proceedings as explained above under point 3.4.

3.6 Despite this clear situation, the applicant did not attend the oral proceedings and did not give any serious reasons for not attending.

In fact, the only reason for not attending was given in its letter dated 8 January 2010 which states that "... the applicant does not consider it beneficial to attend the forthcoming oral proceedings." It confirmed in the appeal proceedings that this was its only reason for not attending oral proceedings.

Serious reasons which could justify non-attendance at oral proceedings are the same reasons that could justify postponement and have been exemplified in the Notice of the Vice-President of Directorate-General 3 of the European Patent Office dated 16 July 2007 concerning Oral Proceedings before the Boards of Appeal (OJ EPO 2007, Special edition No. 3, 115). Although this Notice is directed to oral proceedings before the Boards of Appeal, the criteria set out therein are generally valid for all departments of the Office. From

the examples given in this Notice, it can be seen that serious reasons are personal or social circumstances which prevent the party or its representative from personally attending the oral proceedings.

The Board does not consider the reason submitted by the appellant to be a personal or social circumstance which would have prevented it or its representative from personally attending the oral proceedings.

- 3.7 The appellant was very well aware of the consequences of its conduct. In its statement setting out the grounds of appeal it submitted: "As it turns out, the applicant's fears as to what might occur at the oral proceedings were fully realised...". Therefore, it cannot be said that in view of the objections previously raised it was taken by surprise.

The appellant submits that its conduct was correct, because it had asked for a discussion of the case over the phone and this was refused.

However, a telephone conversation with one examiner cannot be considered to be a replacement for oral proceedings because it does not allow the case to be concluded since the other members of the examining division are not present.

- 3.8 The appellant also appears to believe that it is up to the party to decide whether the proceedings should be conducted only in writing or over the telephone or in oral proceedings, and the Office has to adapt itself to its wishes. As explained above, although the parties have a right to oral proceedings when they request them,

this does not mean that they have the right to decide in which way the proceedings as a whole are to be conducted.

- 3.9 It follows that the appellant not only consciously did not make use of a procedural opportunity given to it to present its comments but also acted in a way which was contrary to its procedural duty to assist the Office in bringing the case to a close.

This amounts to a conduct which contributed - as did the conduct of the examining division - to the procedural situation which arose in the oral proceedings and to the alleged procedural violation. Furthermore, it cannot be ruled out that the appeal could have been avoided if the applicant had attended the oral proceedings before the first instance.

- 3.10 G 4/92 was cited by the appellant. This opinion of the Enlarged Board of Appeal, which did not deal with the question of the equitableness of the reimbursement of the appeal fee, concerned inter partes cases and a theoretical situation in which, first, one party files new facts or evidence for the first time during oral proceedings, second, these facts or evidence are admitted by the opposition division although the late filing constitutes an abuse of procedure, and third, the other party does not attend the oral proceedings although it should be noted that the reasons for the non-attendance were not dealt with by the Enlarged Board.

In fact, the duty to hear the absent party was the consequence of the late filed submissions being admitted (see points 7 and 8 of the Opinion). Thus, the procedural situation under consideration in G 4/92 is a very specific one and, according to this Board, this opinion cannot form the basis for a general modification of the duty established in Article 116(1) EPC.

Decision T 197/88, also cited by the appellant, is not applicable because in the present case the examining division did give the applicant an opportunity to present comments. Decision T 951/92 is not relevant because it did not deal with the question of whether the reimbursement of the appeal fee was equitable.

3.11 For the above reasons the reimbursement of the appeal fee is not equitable.

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 first instance with the order to proceed with substantive examination of the application on the basis of claims 1 to 5, filed at the oral proceedings of 24 October 2012.
3. The request for refunding the appeal fee is dismissed.

The Registrar:

The Chairman:

V. Commare

T. Kriner