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**Datasheet for the decision
of 25 May 2016**

Case Number: T 0156/12 - 3.2.02

Application Number: 07015958.7

Publication Number: 1862122

IPC: A61B17/00, A61F2/01, A61B17/12

Language of the proceedings: EN

Title of invention:
Percutaneous catheter directed occlusion devices

Applicant:
Aga Medical Corporation

Headword:

Relevant legal provisions:
EPC Art. 76(1), 123(2), 84, 111(1)

Keyword:
Amendments - added subject-matter (no)
Claims - clarity - main request (yes)
Request to finish examination - rejected

Decisions cited:

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

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Case Number: T 0156/12 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 25 May 2016

Appellant: Aga Medical Corporation
(Applicant) 5050 Nathan Lane North
Plymouth MN 55442-2204 (US)

Representative: Potter Clarkson LLP
The Belgrave Centre
Talbot Street
Nottingham NG1 5GG (GB)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 8 August 2011
refusing European patent application
No 07015958.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman E. Dufrasne
Members: P. L. P. Weber
D. Ceccarelli

Summary of Facts and Submissions

- I. The appeal of the applicant is against the decision of the Examining Division posted on 8 August 2011 to refuse the application because of non-compliance with the requirements of Article 123(2) EPC.

In its decision the Examining Division considered that no support was present in the application as filed for the feature "*the shoulder having a portion of its surface perpendicular to the central axis of the body portion*" of the then valid main request.

Claim 1 of that request read as follows:

"A collapsible medical device (10, 50, 140, 160) for occluding a vessel comprising a metal fabric exhibiting shape memory properties, the fabric having an expanded preset configuration when unconstrained, said expanded configuration including a body portion (12, 52, 142, 166) extending between first and second ends (18, 20, 56, 58) of the device defining a central axis, the first end (14, 58) comprising a shoulder (16, 54, 144, 164) extending radially outward from the body portion to define a generally circular base portion having a diameter larger than the body portion, the shoulder having a portion of its surface perpendicular to the central axis of the body portion, the ends of the strands being secured to prevent unravelling of the metal fabric, the medical device being collapsible to a reduced diameter for deployment through a channel of a patient's body."

- II. The notice of appeal was filed on 6 October 2011 and the appeal fee paid on the same day. The statement

setting out the grounds of appeal was filed on 13 December 2011.

- III. In the annex to the summons dated 18 February 2016 the Board communicated its provisional opinion to the appellant in preparation of the oral proceedings. The Board indicated in particular that since the impugned decision only addressed the question of added-matter it intended to remit the case to the department of first instance if it found that one of the appellant's requests complied with Article 123(2) EPC.
- IV. With letter dated 24 March 2016, the appellant filed additional observations as well as further auxiliary requests.
- V. Oral proceedings were held on 25 May 2016.

The appellant requested that the decision under appeal be set aside and that the patent be granted on the basis of the new main request filed during the oral proceedings or, in the alternative, of one of auxiliary requests 1, 2, 2A, 2B and 3 filed with letter dated 24 March 2016.

During the oral proceedings the appellant further requested the Board to examine also novelty and inventive step, so as to possibly arrive at a grantable version of the application to form a basis for remittal.

- VI. Claim 1 of the new main request reads as follows (amendments to the former main request are underlined):

"A collapsible medical device (10, 50, 140, 160) for occluding a vessel comprising a metal fabric comprising

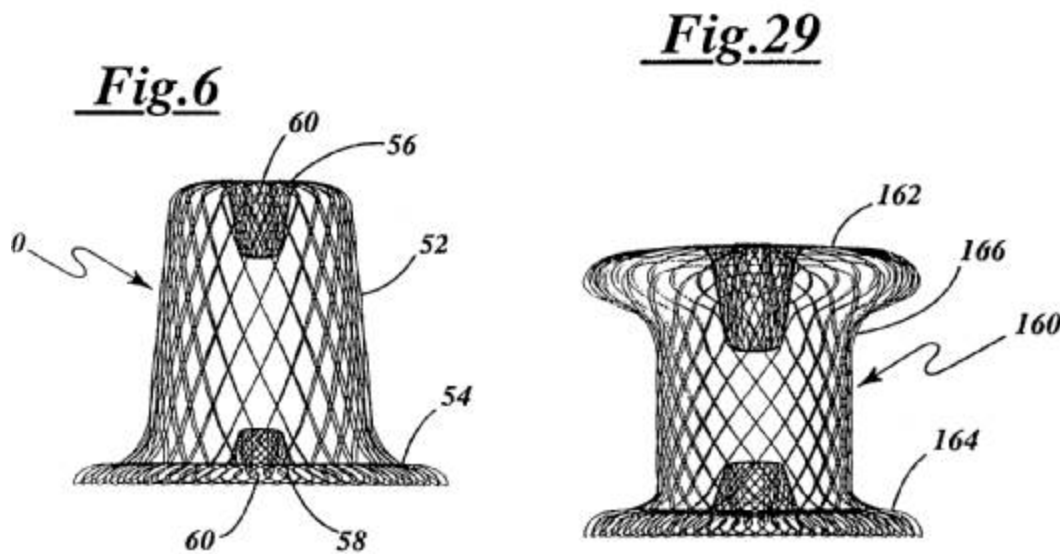
metal strands exhibiting shape memory properties, the fabric having an expanded preset configuration when unconstrained, said expanded configuration including a body portion (12, 52, 142, 166) extending between first and second ends (18, 20, 56, 58) of the device defining a central axis, the first end (14, 58) comprising a shoulder (16, 54, 144, 164) extending radially outward from the body portion to define a generally circular base portion having a diameter larger than the body portion, the shoulder having an annular portion of its surface perpendicular to the central axis of the body portion, the ends of the strands being secured to prevent unravelling of the metal fabric, the medical device being collapsible to a reduced diameter for deployment through a channel of a patient's body."

- VII. The application in suit is a divisional application of WO-A-99/12478 / EP98946804.6. The divisional application was filed on 14 August 2007, while the parent application was still pending. The description and drawings are identical in both applications. In the following the Board will refer to the application published as WO-A-99/12478.
- VIII. The appellant's arguments are essentially those on which the following reasons for this decision are based.

Reasons for the Decision

1. The appeal is admissible.
2. The invention

The invention relates to low-profile occluding devices for treating, for example, ASD (atrial septal defect), VSD (ventricular septal defect) and PDA (patent ductus arteriosus). The claims of the application in suit concentrate on the shape of the shoulder following the body portion in some of the embodiments (two exemplary embodiments below).



The Board considers it important to clarify that in the context of the present invention, as also acknowledged by the appellant, the word "shoulder" designates the surface of the radially expanded part directly following the body portion (the parts referenced 54 or 164 in the two drawings above) and not the base surface at the very end of the device ("flat" surface in the two embodiments shown).

3. The decision of the Examining Division concentrated on whether or not support was present in the application as filed for the feature "the shoulder having a portion of its surface perpendicular to the central axis of the body portion" of the then valid main request, and took the view that there was none.

In the new main request the wording of this feature has been amended to "*the shoulder having an annular portion of its surface perpendicular to the central axis of the body portion*" (emphasis added).

It should first be noted that in the understanding of the Board the annular portion defined does not need to be a regular annular portion, e.g. the circles defining the annular portion do not need to be concentric as is the case, for instance, for the embodiment of Figure 24.

In the opinion of the Board, at least in Figures 6, 7 and 22 to 32 of the application as filed the shape of the relevant shoulder is always the same: the shoulder extends radially outward from the body portion to define a generally circular base portion having a diameter larger than the body portion, and the strands of the metal fabric forming that expanded part define an annular portion of the shoulder surface perpendicular to the central axis of the body portion. It should be noted here that, in the opinion of the Board, the terms "surface" and "perpendicular" should not be taken in a mathematical sense, but as a person skilled in the art would understand them in the present context. In particular, it seems self-evident that, as the device is mainly made from a metal fabric comprising metal strands, the "surface" meant is not a continuous surface in the mathematical sense but a surface defined discretely by the strands. Thus, as indicated above, although not literally mentioned in the description, such an annular portion of a surface perpendicular to the central axis of the body portion is visible in all the figures mentioned, which in itself constitutes a basis for the proposed feature.

Indeed, unless special circumstances present themselves for deciding otherwise, when the same feature is visible in numerous drawings relating to different embodiments, as in the present application, it seems hardly possible to hold that the feature in question is not disclosed for the person skilled in the art. Whether the person skilled in the art would give it a particular technical relevance in the context of the invention is a different question.

In the present case, as argued by the appellant, this feature allows the desired low profile of the device to be obtained. Having an annular portion of the surface perpendicular to the central axis of the body guarantees that a larger portion of the said surface is close to the wall of the vessel in which the device is going to be placed, hence contributing to the shoulder as a whole being closer to that wall. It also has the additional advantage of improving initial (blood) tightness around the shoulder due to the larger surface contact with the walls of the vessel. It is self-evident that the shape of the body portion does not play any role for these effects, since the body portion will be inside the orifice to be closed.

Hence, in the opinion of the Board, in the present case the drawings unambiguously disclose the said feature.

The Examining Division did not object to any other feature under Article 123(2) EPC and the Board is satisfied that there is a basis in the application as filed for the other features of the claim. In particular, since several body shapes have been described there is a sufficient basis for a generalisation of the body shape, and the reference to the occlusion of a vessel can for instance be found

page 1, lines 22 and 23; page 6, lines 29 to 31 and page 12, line 30 to page 13, line 1.

Hence, claim 1 of the new main request complies with Article 123(2) EPC (and implicitly Article 76(1) EPC).

4. The appellant further amended claim 1 by introducing the feature that the metal fabric comprises metal strands. This clarifies that the ends of the strands mentioned at the end of the claim as being secured to prevent unravelling are the strands of the metal fabric mentioned at the beginning of the claim.

The Board is satisfied that, with this amendment, claim 1 of the new main request complies with Article 84 EPC.

5. During the oral proceedings the appellant requested the Board to examine novelty and inventive step.

In its annex to the summons the Board indicated that since the decision of the Examining Division was only based on the question of compliance with Article 123(2) EPC (and implicitly Article 76(1) EPC) the Board intended to concentrate on these requirements, and possibly remit the case to the department of first instance for further prosecution.

In its reply to the Board's summons dated 24 March 2016, the appellant did not take issue with that intention. Consequently the Board, in line with its original intention, did not prepare itself for a discussion of novelty and inventive step.

For these reasons, the appellant's request is rejected pursuant to Article 111(1) 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 for further prosecution.

The Registrar:

The Chairman:



D. Hampe

E. Dufrasne

Decision electronically authenticated