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**Datasheet for the decision
of 23 May 2013**

Case Number: T 0973/12 - 3.2.02

Application Number: 10000629.5

Publication Number: 2177168

IPC: A61B 17/06

Language of the proceedings: EN

Title of invention:

Barbed suture and method of providing a barbed suture

Applicant:

Ethicon LLC

Headword:

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Relevant legal provisions:

EPC Art. 76(1), 111(1)

EPC R. 36(1)

Relevant legal provisions (EPC 1973):

EPC R. 25(1)

Keyword:

"Extension beyond earlier application (no, after amendment)"

Decisions cited:

J 0007/96, J 0007/04

Catchword:

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Case Number: T 0973/12 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 23 May 2013

Appellant: Ethicon LLC
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 1 December 2011
refusing European patent application
No. 10000629.5 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: E. Dufrasne
Members: P. L. P. Weber
M. Stern

Summary of Facts and Submissions

- I. The appeal is against the decision of the Examining Division posted on 1 December 2011, refusing the application because it did not fulfil the requirements of Article 76(1) EPC.

Notice of appeal was filed on 31 January 2012 and the appeal fee paid on the same day. The statement setting out the grounds of appeal was filed on 2 April 2012.

- II. Oral proceedings were held on 23 May 2013.

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the main request or, in the alternative, of one of auxiliary requests 1 to 4, all filed with letter dated 23 April 2013.

The request for correction of Figure 5 under Rule 139 EPC presented in the statement setting out the grounds of appeal was withdrawn during the oral proceedings.

- III. The present application with publication number EP-A-2177168 was filed as a divisional application of application with publication number EP-A-1803405, which itself was filed as a divisional application of application with publication number EP-A-1429664 (published as PCT application WO-A-03/017850 and hereinafter called first parent application).

The mention of the grant of patent EP-B-1429664 was published on 28 March 2007 in Bulletin 2007/13.

EP-A-1803405 was filed on 27 March 2007 and the decision of the Examining Division to refuse it was posted on 25 January 2010.

EP-A-2177168 was filed on 22 January 2010.

IV. Claim 1 according to the main request reads as follows:

"A method of providing a barbed suture comprising the step of:
providing at least one barb on a suture by cutting the suture by means of a blade,
characterised in that:
the step of cutting includes a combination of:
moving the blade in a direction along at least one of:
the longitudinal axis Y of the suture; and
a direction towards the suture, along an axis Z perpendicular to the longitudinal axis Y; and
oscillating the blade along a lateral axis X, perpendicular to both Y and Z axes."

Claims 2 to 5 are dependent claims.

V. The arguments of the appellant can be summarised as follows:

In claim 1 of the main request, the feature to which the Examining Division had objected, i.e. altering the trajectory of the blade when (or during) cutting, had been deleted and replaced by the oscillating blade feature.

The description and figures of all the successive applications were identical except for paragraphs [0060] to [0068], which had been added in the present

application. Support for claim 1 of the main request could be found in paragraph [0030] of the present application as published.

Reasons for the Decision

1. The appeal is admissible.

2. The first divisional application was filed on 27 March 2007, before the entry into force of EPC 2000 and thus under Rule 25(1) EPC 1973 which entered into force on 2 January 2002, and the first parent application was still pending at that time (J 7/96 published in OJ EPO 1999, 443; J 7/04, point 3. of the reasons).
The second divisional application was filed on 22 January 2010, under Rule 36(1) EPC 2000 but before the changes made to that rule which applied to divisional applications filed from 1 April 2010. Thus, the wording of Rule 36(1) EPC to be applied was that of Rule 25(1) EPC 1973 mentioned above. The first divisional application was refused by decision of the Examining Division posted on 25 January 2010, and was therefore still pending when the present divisional application was filed.

Hence, the requirements of Rule 25(1) EPC 1973 and of Rule 36(1) EPC in force at the different dates of filing of the divisional applications are fulfilled.

3. Support for the subject-matter of claim 1 of the main request in the first divisional application and the first parent application.

3.1 The description of the originally filed present second divisional application up to and including paragraph [0059] (of the published version) is identical to the originally filed description of the first divisional application and of the first parent application. All the originally filed figures are identical in all three successive applications.

The Board will therefore refer to the paragraphs of the published version of the present second divisional application when indicating where support can be found for claim 1 of the main request.

3.2 The wording of present claim 1 is supported by paragraph [0030] in which it is stated that "*A yet further method of cutting a barb is shown in Figures 4A-C where a back and forth or zigzag (oscillating on the "x" axis combined with the movement in z and/or y axis) motion of the blade with three degrees of freedom of blade movement and a solid plane geometry cuts the barb with a saw-like cutting motion.*", in combination with Figures 4A to 4C.

Nothing else is claimed in claim 1 of the main request, since its wording requires that the barb cutting movement combines an oscillating movement of the blade along an axis X perpendicular to the axis Y of the suture with a movement along the longitudinal axis Y of the suture and/or in a direction towards the suture, along an axis Z perpendicular to the longitudinal axis Y and X.

3.3 For these reasons claim 1 of the main request fulfils the requirements of Article 76(1) EPC.

4. Since the reasons given in the decision under appeal only concerned compliance with Article 76(1) EPC, the Board finds it appropriate to exercise its discretion under Article 111(1) EPC and to remit the case to the Examining Division for further prosecution on the basis of the main request.

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 for further prosecution.

The Registrar:

The Chairman:

D. Hampe

E. Dufrasne