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**Datasheet for the decision
of 10 August 2016**

Case Number: T 1844/12 - 3.2.02

Application Number: 06254867.2

Publication Number: 1767156

IPC: A61B17/072

Language of the proceedings: EN

Title of invention:

Surgical stapling instrument having force controlled spacing
end effector

Patent Proprietor:

ETHICON ENDO-SURGERY, INC.

Opponent:

Covidien

Headword:

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

Added subject-matter - main request (yes), auxiliary request
(no)

Decisions cited:

Catchword:



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Case Number: T 1844/12 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 10 August 2016

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
8 June 2012 concerning maintenance of the
European Patent No. 1767156 in amended form.**

Composition of the Board:

Chairman E. Dufrasne
Members: M. Stern
D. Ceccarelli

Summary of Facts and Submissions

- I. The opponent lodged an appeal against the decision, posted on 8 June 2012, concerning maintenance of the European Patent No. 1 767 156 in amended form. In the decision under appeal, the Opposition Division held that the patent as amended according to the auxiliary request 1 then on file satisfied the requirements of the EPC, in particular those of Articles 123(2), 54 and 56 EPC.
- II. Notice of appeal was filed on 20 August 2012 and the fee for appeal was paid the same day. A statement setting out the grounds of appeal was received on 16 October 2012.
- III. Oral proceedings were held on 10 August 2016.

The appellant (opponent) requested that the decision under appeal be set aside and that the patent be revoked.

The respondent (patent proprietor) requested that the the appeal be dismissed or, in the alternative, that the decision under appeal be set aside and that the patent be maintained on the basis of auxiliary request 1 filed with letter dated 1 March 2013.

- IV. Claim 1 of the main request reads as follows:

"A surgical instrument (10), comprising:
an elongate staple channel (40) having a longitudinal channel slot (64) formed therein;
an anvil (20) pivotally attached to the elongate staple channel to grip tissue and having a staple

forming undersurface (60) with a longitudinal anvil slot (58) formed therein;

a staple cartridge (42) having an upper surface and received in the elongate staple channel and containing a plurality of staples each having a staple length sized for forming a closed staple between a first height and a second height;

an elongate shaft (18) attached to the staple channel;

a handle (12) proximally operatively coupled through the elongate shaft to close the anvil and to clamp tissue between the anvil and the staple cartridge to a clamped tissue thickness; and

a firing bar (36) translated by the handle and received for longitudinal reciprocating motion in the elongate shaft, the firing bar comprising:

- a vertical portion (52) passing through the longitudinal anvil slot and the longitudinal channel slot,
- an upper lateral surface (54) extending from the vertical portion positioned to exert an inward compressive force on the anvil during firing translation,
- a lower lateral surface (70) extending from the vertical portion positioned to exert an inward compressive force on the elongate staple channel during firing translation, and
- a resilient portion of the firing bar positioned to allow a height between the staple forming undersurface of the anvil and the upper surface of the staple cartridge to vary between the first and second heights in relation to the clamped tissue thickness,

characterized in that the resilient portion comprises a resilient member (150, 160, 170) attached to an inner surface of a selected one of

a group consisting of the upper lateral surface and the lower lateral surface."

Claim 1 of auxiliary request 1 is the same as claim 1 of the main request, except that the last paragraph reads as follows:

"characterized in that the ~~resilient portion~~ surgical instrument further comprises a resilient member (150, 160, 170) attached to an inner surface of a selected one of a group consisting of the upper lateral surface and the lower lateral surface" [amendments to the main request highlighted by the Board].

- V. The arguments of the appellant (opponent) concerning the main request are those on which the reasons set out below are based.

The appellant expressly indicated that it would not raise any objection against claim 1 of auxiliary request 1.

- VI. The arguments of the respondent (patent proprietor) are summarised as follows:

Claim 1 of the main request was properly based on claims 1 and 8 of the application as filed. The application did not disclose that the resilient member defined in original claim 8 was additional to the resilient portion of the firing bar defined in claim 1, and thus allowed for the possibility that the resilient portion of the firing bar solely comprised the resilient member. In original dependent claims 3, 4, 6 and 7, the resilient features of other embodiments were recited without the expression "*further comprising*" of

original dependent claim 8. Therefore, the skilled person would interpret original claim 8 analogously to the preceding claims. Furthermore, paragraph [0041] of the original application as published was a basis for the resilient portion to comprise the resilient member or pads 150, since these were not disclosed as an "added feature" to complement the compliance of the E-beam. The resilient pads were provided as an alternative to the upper pin 54e referred to in paragraph [0040] as an "added feature". That it was an added feature was simply derived from the fact that this component was not depicted in the firing bar shown in Figures 2 and 3. Since there was no discussion of the nature of the resilient portion in relation to Figures 2 and 3, there was no reason to suppose that the upper pin was a feature additional to another way of introducing resilience into the firing bar. The firing bar of Figures 2 and 3 had no resilience itself, but was just a template onto which different resilient features could be added according to the embodiments of Figures 5 to 13.

Reasons for the Decision

1. The appeal is admissible.
2. The patent relates to a surgical instrument for applying lines of staples to tissue while cutting the tissue between the staple lines (paragraph [0001]) which allows the tissue gap between the staple cartridge and the anvil to vary in response to increases in pressure which occur when thicker tissue is clamped. The instrument is claimed to comprise a firing bar with a resilient portion which allows the height between the anvil and the upper surface of the

staple cartridge to vary between two different heights. As explained in the last sentence of paragraph [0011] of the patent as granted, the resilient portion of the firing bar allows some flexure to accommodate an increased compression load due to a thicker layer of clamped tissue. In the description of the patent, the firing bar is alternatively referred to as the "E-beam".

3. *Main request - Article 123(2) EPC*

3.1 Original claim 1 defines the surgical apparatus as comprising a firing bar comprising a **resilient portion** which allows the height between the anvil and the upper surface of the staple cartridge to vary between two heights. Original dependent claim 8 defines a preferred embodiment of this apparatus "**further comprising a resilient member** (150) attached to an inner surface of ... the lower lateral surface (of the firing bar)". Thus, according to original claim 8, the resilient member (150) is an *additional feature* to the resilient portion of the firing bar defined in original claim 1.

However, claim 1 of the main request (which was considered allowable by the Opposition Division) defines that "**the resilient portion comprises a resilient member** (150) attached to an inner surface of ... the lower lateral surface (of the firing bar)". This definition no longer requires the apparatus to comprise two distinct resilient elements as in original claim 8, i.e. the resilient portion of the firing bar and a *further* resilient member.

3.2 Contrary to the submissions by the respondent, the Board considers that the application as filed does not

provide a direct and unambiguous basis for the subject-matter as thus defined.

- 3.2.1 The respondent argued that in original dependent claims 3, 4, 6 and 7 the resilient features of other embodiments were recited without the expression "*further comprising*" of original dependent claim 8. Therefore, the skilled person would interpret original claim 8 analogously to the preceding claims.

The Board does not find this argument convincing. Original claims 3, 4, 6 and 7 define resilient features of the apparatus of claim 1 which are different from those of original claim 8. Whilst it is not unambiguously clear that the different wording of original claim 8 should be interpreted analogously to that of original claims 3, 4, 6 and 7, not even in these claims is it said that the resilient portion of the firing bar comprises the defined resilient features.

- 3.2.2 The respondent cited, moreover, paragraph [0041] of the original application as published as providing a basis for claim 1.

The Board disagrees also with this view. In fact, paragraph [0041] is actually consistent with what original claim 8 defines, namely that the resilient member (pads 150) is an *additional* feature to the otherwise resilient firing bar. Paragraph [0041] describes a sixth embodiment of a compliant E-beam (or resilient firing bar) as "a compliant E-beam 50f as described for Figures 2 and 3 [which] **further includes** resilient pads 150 that are attached to upper surfaces 152 of the bottom foot 70" [emphasis added]. The E-beam of Figures 2 and 3 is described in paragraphs [0016]

and [0017] to be a force-adjusted (compliant) height firing bar consistent with the present invention. The "present invention" as defined in original claim 1 comprises a firing bar with a resilient portion. Also according to paragraph [0035], the E-beam of Figure 2 is compliantly biased and provided with "an inherent flexure".

Moreover, the summary of each of the embodiments of Figures 5 to 13 in paragraphs [0019] to [0027] mentions that the firing bar of Figure 2 may be provided with different resilient features so as to "enhance vertical flexure". The "enhancement" of the flexibility or resilience mentioned in each of these paragraphs is to be understood as the enhancement of the flexibility which the firing bar of Figure 2 has. Furthermore, each one of paragraphs [0039], [0040], [0042] and [0043] explicitly refers to a "version of a compliant E-beam ... as described for Figs. 2-3 with an added [resilient] feature". As a consequence, the Board does not share the respondent's view that the E-beam of Figure 2 has no resilience itself, but is just a template onto which different resilient features may be added according to the embodiments of Figures 5 to 13.

Consequently, the Board considers that the skilled person understands from paragraph [0041] that the resilient pads 150 are *additionally* provided onto the otherwise inherently compliant or resilient E-beam of Figures 2 and 3. The fact that paragraph [0041] mentions that the sixth embodiment is an alternative to "incorporating flexure into an upper pin 54" just means that the sixth embodiment is an alternative to the preceding fifth embodiment described in paragraph [0040] in which the resilient feature added

to the compliant E-beam of Figures 2 and 3 is the flexible upper pin 54e.

3.3 The Board therefore concludes that claim 1 of the main request introduces subject-matter extending beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC.

4. *Auxiliary request 1*

4.1 Claim 1 is strictly formulated by combining original claims 1 and 8, thereby remedying the aforementioned deficiency under Article 123(2) EPC.

4.2 Although the appellant requested that the patent be revoked, it also expressly indicated that it would not raise any objection against claim 1 of auxiliary request 1. Under these circumstances, the Board sees no reason to consider any further objection which could prejudice the maintenance of the patent as amended according to auxiliary request 1.

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 maintain the patent on the basis of:
 - claim 1 of auxiliary request 1 filed with letter dated 1 March 2013;
 - description:
columns 1, 2, 5 and 6 of the patent specification and columns 3, 4 and 7 to 9 filed during oral proceedings on 15 May 2012; and
 - figures 1 to 13 of the patent specification.

The Registrar:

The Chairman:



D. Hampe

E. Dufrasne

Decision electronically authenticated