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**Datasheet for the decision
of 21 April 2015**

Case Number: T 0606/13 - 3.2.08

Application Number: 96304026.6

Publication Number: 0747021

IPC: A61F2/06

Language of the proceedings: EN

Title of invention:

Stent introducer

Patent Proprietor:

Cook Medical Technologies LLC

Opponent:

Boston Scientific Corporation

Headword:

Relevant legal provisions:

EPC Art. 100(c), 123(2), 111(1)

Keyword:

Amendments - intermediate generalisation - added subject-matter (no)

Decisions cited:

G 0002/10

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 0606/13 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 21 April 2015

Appellant:
(Patent Proprietor)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 8 January 2013
revoking European patent No. 0747021 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman T. Kriner
Members: C. Herberhold
C. Schmidt

Summary of Facts and Submissions

- I. By its decision posted on 8 January 2013 the Opposition Division revoked European patent EP-B-0 747 021.
- II. The Opposition Division held that the patent as granted as well as the auxiliary requests then on file extended beyond the application as originally filed.
- III. The appellant (patent proprietor) lodged an appeal against that decision in the prescribed form and within the prescribed time limit.
- IV. Oral proceedings before the Board of Appeal took place on 21 April 2015.

At the end of the oral proceedings the requests of the parties were as follows:

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of auxiliary request 3 filed on 20 March 2015, renamed as the main request, with all other requests being withdrawn.

The respondent requested that the appeal be dismissed.

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

"A stent introducer arrangement (10) comprising:
an elongated outer member (11) having an outer member passage (12) extending longitudinally therein and a first operable direction (13) for deploying a stent (14) from said outer member passage;
an inner elongated member (15) positioned in said outer member passage and having a second operable direction

(16) for deploying a stent from said outer member passage; and
an interconnection mechanism (17) including a first carrier (20) connected to the outer member (11) for operating the outer member (11) in the first operable direction (13) and a second carrier (21) connected to the inner member (15) for operating the inner member (15) in the second operable direction (16), whereby a stent in a collapsed condition is deployed from said outer member passage to an expanded condition;
characterised in that the interconnection mechanism further includes
a handle casing (48) in which the first carrier (20) is slidably housed and in which the second carrier is rotatably positioned and
an input member (22) rotatably mounted in said handle casing (48) and coupled to said first carrier and connected to said second carrier for concomitantly operating the outer member (11) in the first operable direction (13) and the inner member (15) in the second operable direction (16)."

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

The subject-matter of claim 1 was based on claims 4, 6 and 7 as originally filed.

As disclosed in column 8, line 52-56 and column 9, line 27-30, the operable distances and directions of the inner and outer members can be readily varied. Hence, omitting from the subject-matter of claim 7 as filed the feature defining the input member as being for operating the outer member in the first direction for a first distance and the inner member in the second direction for a second distance - labelled feature F in

the impugned decision - did not result in an extension of the disclosure beyond the content of the application as filed.

With respect to the features allegedly unallowably extracted from a specific embodiment, it had to be kept in mind that patents were addressed to skilled persons who possessed a certain general knowledge in their field, including a certain capability to abstract.

A skilled person would understand that the provision of a handle casing in which the first carrier was slidably housed and in which the second carrier was rotatably positioned, as well as the provision of an input member rotatably mounted in said handle casing were general concepts, disclosed separately from the details of the specific embodiment.

In particular, claim 6 explicitly generalized towards first and second carriers connected to the respective outer and inner members. Equally, claim 7 as filed explicitly generalized towards an "input member coupled to said first and second carriers", the "input member" and the "carriers" thus being self-contained abstract concepts disclosed on their own, without any need to turn to a specific embodiment.

Furthermore, a first carrier slidably housed in the handle casing - labelled feature B in the impugned decision - was disclosed in column 7, lines 22-24. The application also disclosed, in the passage bridging columns 7 and 8, two specific ways of embodying the input member, namely the rotatable drive member (22) and the rotatable drive wheel (8), which further supported the argument that a rotatable input member was a disclosed general concept.

With the casing, the rotatable operation of the input member as well as the particular movement of the carriers being self-contained key concepts of the disclosed device, the skilled person would not consider claim 1 to contain new technical information.

VII. The essential arguments of the respondent can be summarised as follows:

As evidenced by various passages in the application as filed, see e.g. column 2, lines 4-6 and lines 39-45, column 4, lines 48-52, column 5, lines 32-50, as well as the paragraph bridging columns 7 and 8, the term "concomitant movement" was used in the sense of movement of the two carriers in opposite directions throughout the application. Consequently the characteristic that the input member was for operating the outer member in the first direction for a first distance and the inner member in the second direction for a second distance - feature F -, in view of the description, had a very specific technical meaning. It was true that the description made passing reference to a possible variation of the operable distances and directions of the inner and outer members. This was, however, much too general a statement to provide the skilled person with the information that feature F could actually be omitted.

Regarding the characteristic that the input member was rotatably mounted in the handle casing - feature C in the impugned decision - and the feature that the input member was coupled to the first and second carriers for concomitantly operating the outer and inner member - feature D - the only possible basis was in column 7, lines 32 to 39 as well as in the paragraph bridging

columns 7 and 8. These passages disclosed, however, a very specific dish-shaped inner member carrier, to which the inner member was connected in a particular way, namely in a transverse channel with an attaching cross pin. Equally, the input drive member was disclosed as a very specific drive member, connected to an input drive wheel on either side of the handle casing for either left- or right-hand operation, the input drive member further comprising a hub connected to the inner member carrier at its central axis and rotatably riding in a handle casing hole in each of the casing halves. All these features were in close structural and functional correlation, such that rotatability of the input member could not be picked out of this functional context without making an undisclosed amendment over the application as filed.

For all these reasons, the subject-matter of claim 1 of the main request presented the skilled person with new information extending beyond the application as filed, thus not meeting the requirements of at least Article 123(2) EPC.

Reasons for the Decision

1. The appeal is admissible.
2. Article 123(2) EPC

It is uncontested that present claim 1 is to a large extent based on a combination of the subject-matter of claims 4, 6 and 7 as originally filed.

With reference to the feature combination disclosed in these claims, some features have been modified (point

2.1), some have been omitted (point 2.2) and some have been added (point 2.3). For ease of reference, the features are referred to using the capital letter coding from the opposition proceedings, adapted where necessary.

2.1 Modified features

Dependent claims 6 and 7 as filed define the first carrier as operating the outer member in the second direction and the second carrier as operating the inner member in the first direction, which is in obvious contradiction to the wording of independent claim 4 as filed, which states that the outer member is to be operated in the first direction and the inner member is to be operated in the second direction. The Board agrees with the Opposition Division (point 2.2 of the reasons, last paragraph) that the correction of this inconsistency in present claim 1 is obvious for the person skilled in the art. As also not contested by the respondent, the respective amendment is thus allowable.

2.2 Omitted feature - feature F

Present claim 1 omits the terms indicated below by strike-through from the feature that the input member is coupled / connected to the first and second carriers for operating the outer member (11) in the first operable direction (13) ~~for a first distance~~ and the inner member (15) in the second operable direction (16) ~~for a second distance~~.

While it is true that the detailed embodiment and several passages of the description show movement of the outer and inner member in opposite directions, it is also true that the description clearly and

unambiguously discloses that the "operable distances and directions of the inner and outer members can be readily varied" (column 9, lines 27-30), including cases wherein either the inner or the outer member is held fixed (column 9, lines 36-55) or wherein both are moved in the same operable direction (column 8, lines 52-56). In view of this - admittedly broad but nevertheless clear and unambiguous - disclosure, omitting the terms "for a first/second distance" cannot provide the skilled person with new technical information not originally disclosed. The omission of the underlined terms is thus in accordance with the requirements of Article 123(2) EPC.

2.3 Added features

With respect to the features of claims 4, 6 and 7 as filed, the following features have been added:

A) the interconnection mechanism further includes a handle casing (48),

B) in which the first carrier (20) is slidably housed and

B1) in which the second carrier is rotatably positioned [this feature was not present in claim 1 of the main request treated in the impugned decision]

and

C) an input member rotatably mounted in said handle casing,

D') the input member being connected to the second carrier for **concomitantly** operating the outer and the inner member.

[compared with claim 1 of the main request treated in the impugned decision, the term "coupled to" has been replaced by "connected to"]

2.4 With respect to feature D' the Opposition Division was of the opinion that the feature (at that time still using the term "coupled to" instead of "connected to") represented a functional limitation of the input member, whereas in the original disclosure "concomitant operation" had only been disclosed for the "interconnection mechanism", i.e. without said functional limitation applying specifically to the input member or to the coupling of the input member. Accordingly, feature D(') was considered an unallowable amendment.

However, claims 4, 6 and 7 as filed define the input member as being a part of the "interconnection mechanism":

"the interconnection mechanism also includes an input member coupled to said first and said second carriers..."

According to the claims as filed, operation of the input member, i.e. of the input part of the interconnection mechanism, is - via movement of the first and second carriers to which the input member is coupled - for operating the inner and outer members, whereby a stent in a collapsed condition is deployed from the outer member passage to an expanded condition.

As disclosed in (among others) column 2, line 4-6 and column 4, line 48-52 of the specification as filed, the interconnection mechanism concomitantly operates the inner member and the outer member (as discussed before, according to column 9, line 27-30 and column 8, line 52-56, the "operable distances and directions of the inner and outer members can be readily varied", the concomitant operation mode of the interconnection mechanism thus not being limited to movement of the inner and outer member in opposite directions). With the "input member" being - by virtue of its name - the input of the interconnection mechanism, and with the input member being part of the interconnection mechanism, which concomitantly operates the inner and outer member (by being coupled to the first and second carriers, which also belong to the interconnection mechanism), the input member is disclosed to be coupled to the first and second carriers for concomitantly operating the inner and outer member in the respective directions.

Consequently, feature D' does not extend beyond the application as filed (with respect to the use of the term "connected to" instead of "coupled to" see below).

- 2.5 With respect to features A)-C) and D' (a part from the "concomitant operation" aspect covered in point 2.4 above), it is uncontested that these features have been disclosed with respect to the specific embodiment shown in Figures 2 and 3 and discussed mostly in column 7, line 16 - column 8, line 4. In particular, the outer member carrier being slidably housed in a handle casing (features A, B) is described in column 7, line 22-24, the second carrier being rotatably positioned in the handle casing (feature B1) is disclosed in column 7, line 32-34, and the rotatable input (drive) member

connected to the inner member carrier and rotatably riding in the handle casing (feature D') is mentioned in column 7, lines 53-55.

However, as can be seen from the above passages, these features are described together with further features, such as the second carrier being dish-shaped, the outer circular edge of the inner member carrier including a recessed channel or groove for cradling the inner member, the inner member being connected to the inner member (carrier) at the outer edge thereof in a transverse channel with the aid of a cross-pin, and the input (drive) member comprising a hub connected to the inner member carrier at its central axis and rotatably riding in a handle casing hole in each of the casing halves.

Present claim 1 is thus more detailed than the feature combination defined in claims 4, 6 and 7, but less detailed (or more generalized) with respect to the feature combination disclosed for the specific embodiment, a situation which may result in an "intermediate generalization".

It should, however, be kept in mind that not every generalization is unallowable. As is the case for any amendment, the question to answer is whether the amendment provides the skilled person with new technical information (the so-called "gold standard", see G2/10, r. 4.5.1, which applies to "any amendment"). This question needs to be answered on a case-by-case basis, taking into account the particular facts of the case.

2.6 From the feature combination defined in claims 4, 6 and 7 as filed, the person skilled in the art derives that

a particular level of abstraction / generalization with respect to the interconnection mechanism includes the first and second carriers and the input member coupled to said carriers, without definition of any further details specifying said coupling. The Board agrees with the appellant that the skilled person would also derive from the application as filed that such an interconnection mechanism may be provided with a "housing". It is true that the disclosure of the housing comprises a certain inter-engagement of the elements of the interconnection mechanism with the housing. However, said inter-engagement is defined in the present claim. The first carrier is defined as slidably housed in the casing, the second carrier as rotatably positioned and the input member as rotatably mounted in the handle casing.

On the other hand, the dish shape of the inner member carrier and the particular details of the connection between the inner member and the inner member carrier do not play a role for the inter-engagement between the abstractly defined interconnection mechanism and the housing. The feature of the housing is thus not functionally or structurally inextricably linked to these features. In fact, the feature of the housing has not been isolated from these features, because they are - on the level of abstraction provided by claims 4, 6 and 7 - covered by the more general claim feature "a second carrier connected to the inner member".

Furthermore, the details of the connection between the input member and the outer member carrier belong to the functional group referred to as the "transfer assembly" (defined in dependent claim 8 as filed), the abstract definition of the interconnection mechanism (in claims 4, 6 and 7 as filed) without the "transfer

assembly" (only defined in claim 8 as filed) thus being a level of abstraction disclosed via the particular structure of the claim tree as filed. Consequently, there is support in the application as filed to abstractly define the connection between the input member and outer member carrier as "coupled", i.e. without the transfer assembly or its full particulars such as the toothed rack.

With respect to the input member "rotatably mounted in the handle casing and connected to the second carrier", such an input member is disclosed in column 7, lines 52-55. Of this disclosure, from a functional point of view, it is essential that the input member is connected to the inner member carrier - a feature which is claimed. On the other hand, the person skilled in the art understands that, as long as the input member rotatably rides in the handle casing and is connected to the inner member carrier, whether the input member comprises "a hub connected to the inner member carrier at its central axis" does not play a functional role. The omission of this feature - which is merely a design option for the input member - thus cannot be considered as new technical information for the skilled person.

Claims 4, 6 and 7 define an interconnection mechanism having an input member. The subject-matter of the invention is thus disclosed to be definable without the particular way the input member - and thus the interconnection mechanism - is activated, e.g. without the drive wheel (8) connected to the drive member on either side of the handle casing for either left- or right-hand operation. This situation is not changed by the fact that the input member is further defined to be rotatably mounted in the housing. The person skilled in the art derives from the claim structure as filed that

the interconnection mechanism is and remains an abstract functional entity, which may be claimed separately from the means for its activation. The claim formulation without the features of the drive wheel (8) thus cannot be considered new technical information.

Furthermore, even without knowledge of the prior art, the skilled person understands that the particular details of the way the input member is rotatably held in the handle are far from what may be considered the invention, as long as the input member is capable of rotatably riding in the casing. Conventional means for embodying a member rotatably riding in a handle - such as having the rotatable member ride with its central axis in handle casing holes in each of the casing halves - are well known to the skilled person. The particular way the member is rotatably held in the casing as it is disclosed for the specific embodiment thus provides trivial information of details at a very fine level, from which the person skilled in the art - based on his/her general knowledge and also based on the knowledge that in patent applications the specific embodiments are generally described in a very detailed way without however limiting the invention to trivial details - immediately abstracts, such an abstraction thus not being new technical information.

2.7 To conclude, after analyzing the particular disclosure in combination with the level of abstraction provided by the original claim structure and taking into account the knowledge of the skilled person, the Board comes to the conclusion that present claim 1 does not add new information over the disclosure as originally filed. The requirements of Article 123(2) EPC are thus met.

2.8 No objection under Article 123(2) EPC has been made against the dependent claims and the Board does not see any reason to do so either.

3. Procedural issues

Further objections under Articles 100(a) and (b) EPC have been raised which have not yet been addressed before the Opposition Division. Thus, following the respondent's request and in order to allow the case to be examined at two levels of jurisdiction, the Board finds it appropriate to remit the case to the Opposition Division for continuation of the proceedings on the basis of the pending main request (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 Opposition Division for further prosecution on the basis of the claims of auxiliary request 3 as filed on 20 March 2015, this now being the main request.

The Registrar:

The Chairman:



D. Magliano

T. Kriner

Decision electronically authenticated