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**Datasheet for the decision
of 9 August 2018**

Case Number: T 0631/13 - 3.2.02

Application Number: 06009537.9

Publication Number: 1721631

IPC: A61M25/00

Language of the proceedings: EN

Title of invention:

Catheter

Patent Proprietor:

Terumo Kabushiki Kaisha

Opponent:

Boston Scientific Corporation

Headword:

Relevant legal provisions:

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

Keyword:

Amendments - extension beyond the content of the application
as filed (no)

Decisions cited:

Catchword:



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Chambres de recours

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Case Number: T 0631/13 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 9 August 2018

Appellant:
(Patent Proprietor)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 14 January 2013
revoking European patent No. 1721631 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

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

Summary of Facts and Submissions

I. The patent proprietor's appeal is against the decision of the Opposition Division, posted on 14 January 2013, to revoke the patent on the ground of added subject-matter.

II. The appellant-patent proprietor filed notice of appeal on 8 March 2013 and paid the appeal fee on the same day. The statement setting out the grounds of appeal was filed 17 May 2013.

III. Oral proceedings were held on 9 August 2018.

The appellant-patent proprietor requested that the decision under appeal be set aside and the patent maintained on the basis of one of the main and the first auxiliary requests filed with letter dated 17 May 2013, and the second and the third auxiliary requests filed with letter dated 21 October 2014.

The respondent-opponent requested that the appeal be dismissed.

IV. Claim 1 according to the main request reads as follows (amendments over granted version marked):

"A catheter (2) positionable in a living body comprising a catheter body (3) possessing a lumen (31), the catheter body (3) comprising:

an inner layer (5a) extending along at least a distal end portion (32) of the catheter body, the inner layer possessing an inner surface exposed to the lumen (31) of the catheter body (3);

an outer layer (5b) contacting the inner layer and extending along at least the distal end portion (32) of the catheter body;

a reinforcement layer (6) between said inner layer (5a) and said outer layer (5b); and

a marker (8) comprises [sic] of a material possessing contrast properties permitting confirmation of a position of the distal end portion (32) of said catheter from outside the living body;

said marker (8) and said reinforcement layer (6) being covered by said outer layer (5b);

wherein said reinforcement layer (6) comprises a filamentous member, extending in a spiral manner about said inner layer (5a) with ~~at least one~~ a gap between portions of said filamentous member which are adjacent one another in a longitudinal direction of said catheter body (3); and

said marker (8) comprises a filamentous member extending in a spiral manner about said inner layer (5a);

said marker (8) including an inner layer close contact portion (82) in close contact with the inner layer (5a) in ~~at least one~~ said gap (62);

characterized in that

said reinforcement layer (6) comprises a first filamentous member (61), and said marker (8) comprises a second filamentous member (81) including a

reinforcement layer close contact portion (83) in close contact with the reinforcement layer."

V. The arguments of the appellant-patent proprietor are essentially those underlying the reasons for this decision set out below.

VI. The arguments of the respondent-opponent relevant for the decision are summarised as and when appropriate in the following reasons for the decision.

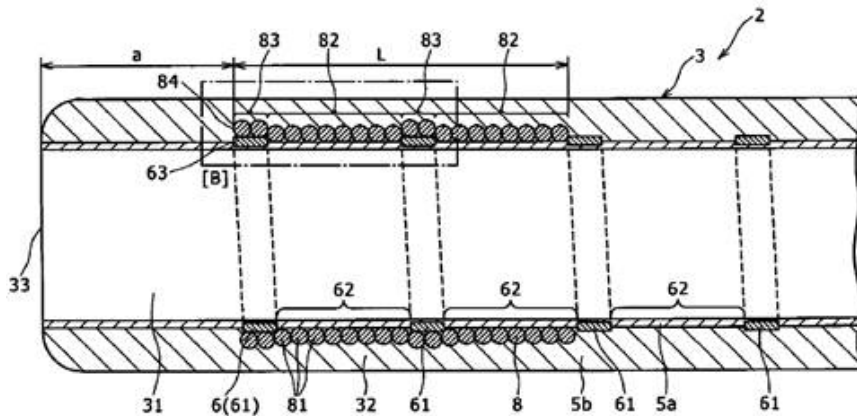
Reasons for the Decision

1. The appeal is admissible.

2. The invention

The invention is about the distal end of a catheter and, more specifically, how to make the distal end less cumbersome, smaller and yet flexible in order to have easier access to small arteries, while keeping a marker which enables its position to be viewed from outside the body of the patient.

The solution proposed is to place a spirally wound marker made of a small diameter thread (81) mainly between the spires or turns (61) of a helicoidal reinforcement layer.



3. In claim 1 according to the main request the wording "at least one gap" used in claim 1 of the patent as granted has been replaced by "a gap" in the following features:

"wherein said reinforcement layer (6) comprises a filamentous member, extending in a spiral manner about said inner layer (5a) with ~~at least one~~ a gap between portions of said filamentous member which are adjacent one another in a longitudinal direction of said catheter body (3); and

...;

said marker (8) including an inner layer close contact portion (82) in close contact with the inner layer (5a) in ~~at least one~~ said gap (62);"

4. The Board considers that this wording is supported by independent claims 1 and 8 of the application as filed.

Indeed, in independent claim 1 of the application as filed, the features in question read:

"said reinforcement layer comprising a first filamentous member, said first filamentous member extending in a spiral manner about said inner layer so that portions of said first filamentous member which

are adjacent one another in a longitudinal direction of said catheter body are spaced apart;

...;

at least a portion of said second filamentous member being positioned between portions of said first filamentous member which are adjacent one another in the longitudinal direction of said catheter body and being in contact with said inner layer;"

and, in independent claim 8 of the application as filed, they read:

"said reinforcement layer comprising a spiral first filamentous member, with a gap between portions of said first filamentous member which are adjacent to each other along a longitudinal direction of said catheter;

...;

a portion of said spirally wound second filamentous member being in contact with said inner layer in said gap."

Thus, according to claim 1 the *"... portions ... which are adjacent one another ... are spaced apart"*, and according to claim 8 there is *"... a gap between portions ... which are adjacent to each other ..."*.

Therefore, both independent claims of the application as filed require the presence of a space or gap between adjacent portions of the first filamentous member. They also both require that a portion of the second filamentous member be positioned between the adjacent portions of the first filament in contact with the inner layer, which is possible only if there is a gap or space between the portions of the first filament.

In the Board's opinion there is therefore already support in these independent claims of the application as filed for the feature *"a gap between portions of said filamentous member which are adjacent one another in a longitudinal direction of said catheter body"*.

The second amendment does no more than bring the wording of the claim into line with the first amendment, and is supported since both originally filed independent claims require that a portion of the second filamentous member (part of the marker) be in contact with said inner layer.

5. The respondent-opponent considered that, when read in the light of the description, in particular paragraph [0006] of the introductory part, presenting claim 8 and including the wording *"a gap provided between those portions of the first filamentous member which are adjacent to each other"* (emphasis added), it became clear that the gap had to be present between each of two successive adjacent portions. This concept was not present in the wording of the feature in claim 1 of the main request, which still allowed for the interpretation made in the opposition proceedings, namely that a non-supported embodiment with, for instance, two or more joined spires or portions separated from the adjacent two or more joined portions by a gap was encompassed.

The Board does not share this opinion. The wording used in claims 1 and 8 of the application as filed likewise allows for the interpretation referred to by the respondent-opponent. Claim 8 stated that *"a gap (is present) between portions of said first filamentous member which are adjacent to each other"*. This is almost exactly the same wording as that used in claim 1

of the main request. The wording used in claim 1 as filed is almost identical too, since it stated that "*portions of said first filamentous member which are adjacent one another in a longitudinal direction of said catheter body are spaced apart.*" Thus, whether and how this wording might have to be interpreted in the light of the description is irrelevant for the question in the present case as to whether there is support in the application as filed.

6. The respondent-opponent further contended that claim 8 of the application as filed recited the feature that the second filamentous member possessed a diameter smaller than the gap. This feature was essential for achieving the effect of the invention and could not be deleted.

While paragraph [0006] and claim 8 of the application as filed mention that the filament diameter of the second filamentous member is smaller than the gap, this is not mentioned in claim 1 of the application as filed, so that claim already supports the absence of that feature. Moreover, nowhere in the application as filed is this feature presented as essential. In the Board's opinion, one essential feature allowing the reduction of the outer diameter of the distal end portion of the catheter is to have part of the marker in contact with the inner layer in the gap between the adjacent portions of the filamentous member of the reinforcement layer, instead of having it everywhere above the reinforcement layer (e.g. paragraph [0037]). This feature was in both claims 1 and 8 of the application as filed and is in claim 1 of the main request.

7. The respondent-opponent also contended that, in view of, for instance, paragraph [0035] of the description of the application as filed, reciting that the marker was composed of a second filament, claim 1 of the main request added matter because the verb comprise was used instead. Moreover, claim 1 of the main request required that the second filamentous member 81 includes the reinforcement layer close contact portion 83, whereas in paragraph [0036] of the application as filed it was the marker which included that contact layer.

Both claim 1 and claim 8 of the application as filed recite that the marker comprises a second filamentous member and so support the wording of present claim 1. Additionally, paragraph [0036] makes it clear that the marker 8 includes an inner layer close contact portion 82 and a reinforcement layer close contact portion 83, and paragraph [0035] specifies that the marker 8 is composed of a spiral second filamentous member 81. This can also be seen in the figures. Therefore, it is clear that the second filamentous member 81 includes a reinforcement layer close contact portion 83 in close contact with the reinforcement layer.

8. Therefore, claim 1 according to the main request does not contain subject-matter extending beyond the content of the application as filed. It follows that the requirements of Article 123(2) EPC are fulfilled.
9. The remaining grounds for opposition and/or requirements of the EPC have not yet been dealt with by the department of first instance. Accordingly, the Board considers it appropriate to exercise its discretion under Article 111(1) EPC to remit the case to the department of the first instance for further

prosecution. The parties had no objections to the remittal.

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

Decision electronically authenticated