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Datasheet for the decision of 15 November 2018

Case Number: T 0274/14 - 3.2.02

Application Number: 09180367.6

Publication Number: 2218411

IPC: A61B17/16, A61B17/32

Language of the proceedings: EN

Title of invention:
Retrograde cutter with rotating blade

Patent Proprietor:
Arthrex, Inc.

Opponent:
Smith & Nephew

Headword:

Relevant legal provisions:
EPC Art. 56, 100(a), 100(b)
EPC R. 42(1)(e)
RPBA Art. 13(1)

Keyword:
Grounds for opposition - insufficiency of disclosure (no)
Inventive step - (yes)
Late-filed objection - admitted (no)

Decisions cited:

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

Boards of Appeal

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Case Number: T 0274/14 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 15 November 2018

Appellant: (Opponent)	Smith & Nephew York Science Park Heslington York YO10 5DF (GB)
Representative:	Meissner Bolte Partnerschaft mbB Widenmayerstrasse 47 80538 München (DE)
Respondent: (Patent Proprietor)	Arthrex, Inc. 1370 Creekside Boulevard Naples, FL 34108-1945 (US)
Representative:	Lohr, Jöstingmeier & Partner Junkersstraße 3 82178 Puchheim/München (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 3 December 2013 rejecting the opposition filed against European patent No. 2218411 pursuant to Article 101(2) EPC**

Composition of the Board:

Chairman	E. Dufrasne
Members:	D. Ceccarelli
	S. Böttcher

Summary of Facts and Submissions

I. The opponent has appealed against the Opposition Division's decision to reject the opposition against European patent No. 2 218 411. The decision was dispatched on 3 December 2013.

II. The patent was opposed on the grounds of insufficiency of disclosure and lack of inventive step.

III. Notice of appeal was filed on 30 January 2014. The appeal fee was paid on the same day. The statement setting out the grounds of appeal was received on 10 April 2014.

IV. The following documents are mentioned in the present decision:

E1: EP-A-1 987 786;
E2: US-A-5,147,373;
E3: US-A-2005/0240193;
E4: US-A-2008/0249481.

V. The Board summoned the parties to oral proceedings and provided its preliminary opinion. In particular, it drew the parties' attention to the appellant's objection of lack of inventive step starting from E1 as the closest prior art, which was presented with the statement of grounds, and to the provisions of Article 114(2) EPC and Articles 12 and 13 RPBA, to which the admission of any further submission was subject.

VI. In response to the summons, by letter dated 11 October 2018, the appellant presented a new

inventive-step attack starting from E3 as the closest prior art, in combination with E1.

By letter dated 12 October 2018, the appellant filed copies of six decisions of German courts.

VII. Oral proceedings took place on 15 November 2018.

The appellant requested that the decision under appeal be set aside, the patent not be maintained on the basis of the respondent's main request, and the case be remitted for further consideration on the basis of the first auxiliary request filed with letter dated 18 December 2012.

The respondent requested that the appeal be dismissed (main request) or, in the alternative, that the decision under appeal be set aside and that the patent be maintained on the basis of the first auxiliary request filed with letter dated 18 December 2012. The second auxiliary request filed with letter dated 11 August 2014 was withdrawn.

VIII. Claim 1 of the patent as granted (main request) reads as follows:

"A retrograde cutter comprising:

an elongated body having a distal end (12), a proximal end, and a longitudinal axis, said body further comprising an outer tube (10, 210) and an inner tube (20) housed by said outer tube;
a blade (30, 230) at said distal end of said body, wherein said blade (30, 230) is configured to rotate from a first position generally aligned with said longitudinal axis to a second, flip position which is

not aligned with said longitudinal axis;
and
a mechanism (15) connecting said blade to distal ends of both said outer and inner tubes, wherein said mechanism comprises a pin and a slot that allow conversion of linear movement of the inner tube (20) into rotational movement of the blade (30, 230) is configured to rotate said blade to said second, flip position upon linear movement of one of said the inner tube (20) and outer tubes in relation to the other of said inner and outer tubes (10, 210),
characterised in that
in the second, flip position, the blade (30, 230) is articulated to an angle of about 90 degrees to the longitudinal axis of the elongated body and faces the proximal end of the elongated body for retrograde drilling of a bone tunnel or socket and wherein the blade is locked by the mechanism in the second, flip position."

IX. The appellant's arguments where relevant to the present decision may be summarised as follows:

Sufficiency of disclosure

The disclosure of the patent as granted was not sufficient for the whole scope of claim 1, which was extremely broad.

The claim was drafted in generally functional terms and defined a mechanism involving the use of a pin and a slot by which, in particular, a blade could be locked in a flip position to allow retrograde cutting. The patent provided no explanation of how such locking could be achieved by the mere use of the pin and the slot. The only embodiment in the patent disclosing this

claimed function comprised several additional non-claimed structural features, such as a second pin cooperating with a second circular slot. There was no embodiment according to which the claimed function could be achieved by mechanisms with only one pin and one slot. However, the claim covered such mechanisms.

Furthermore, the claim encompassed any mechanisms by which the claimed function could be obtained employing further non-claimed and non-disclosed structural elements. For example the blade could be locked by employing a hairspring at one end of an elongated slot to stop the pin movement in the slot, or by friction. The claim even covered the possibility that the mechanism was a one-way mechanism, such that the blade could not be flipped back into its original position.

In conclusion, the claim included numerous embodiments which were never conceived or intended to be covered, and its scope of protection extended far beyond that which was reasonable in view of the only embodiment explained in the patent. Establishing a reasonable scope of protection of a granted claim was a question related to sufficiency of disclosure, since the disclosure had to be sufficient over the whole scope. Moreover, the scope of protection of a claim was important for establishing infringement at national level. The patent was valid in a number of European countries, including Germany. As shown by a number of decisions filed by the appellant, the understanding of claim scope during infringement proceedings was rather broad under German jurisdiction as far as functional features were concerned. That had to be considered by the Board when deciding whether it was appropriate to have a broad scope of protection as defined in claim 1 in view of the much more limited disclosure of the

patent as granted. The claim had to be limited to a mechanism comprising two pins, two slots and a further separate element for locking the blade in the flip position.

Inventive step

The subject-matter of claim 1 of the patent as granted lacked an inventive step when starting from E1 as the closest prior art.

E1 disclosed a retrograde cutter comprising, in particular, an elongated body having a longitudinal axis, an outer tube and an inner tube; a blade configured to rotate from a first position aligned with the longitudinal axis to a second, flip position, and a mechanism allowing rotating and locking the blade.

According to paragraph [0028] of the patent, there was no technical difference between an "inner tube" and a "shaft". Hence, when it came to the claimed elements of the elongated body, an inner tube had to be considered as synonymous with a solid shaft.

It followed that E1 disclosed all the features defined in claim 1 except for the pin and the slot for connection of the blade to the outer tube in such a manner that the relative linear movement of the outer tube with respect to the inner tube flips the blade.

These distinguishing features provided the advantage that there was no need for another tool in order to flip the blade. Hence, the problem solved was how to flip the blade with the claimed instrument itself.

E2 provided a solution to this problem which was

identical to the one defined in the claim. More particularly, E2 disclosed a laparoscopic instrument with a jaw depicted in figures 2 and 16, an element of which could be flipped by a mechanism comprising a pin (94) and a slot (93) involving an axial movement of a slidable member (52a) connected to a rod (30). Figure 17 showed how the jaw could be locked in the flip position.

Similarly, E3 (figure 21) disclosed a mechanism for turning relative translational motion between an inner tube (156) and an outer tube (112) into rotation of a blade (120), involving the use of a curved pin (166) passing through a circular slot. Figure 22 showed how the blade could be locked in the flip position.

E4 (figure 4D) also disclosed a mechanism for turning relative translational motion between an inner tube and an outer tube into rotation of a blade (415), involving the use of a pin (455) passing through a corresponding slot. Relative holding of the inner and outer tube positions would lock the blade in the flip position.

Hence, the skilled person would combine the teaching of any of E2 to E4 with E1 and arrive at the subject-matter of claim 1 of the patent as granted in an obvious way.

The fact that E2 did not relate to a retrograde cutter, or that the blade disclosed in E3 was not coupled to a drill with a powered motor, was irrelevant in this respect since E1 disclosed a retrograde cutter as claimed. Moreover, E3 disclosed a manually operated tool which was a drill, albeit a slow one. The fundamental teaching of E2 and E3, which belonged to neighbouring fields of that of E1, was the mechanism

for flipping an element at one end of an elongated instrument by the instrument itself, which addressed the problem solved by the distinguishing features of claim 1. If the possibility of coupling the retrograde cutter of E1 to a powered motor had to be retained, the skilled person would adapt the teaching of E2 or E3 accordingly.

If a solid rod were not to be considered as an inner tube within the meaning of claim 1, then the presence of an inner tube instead of a solid rod would address a different technical problem, e.g. how to reduce weight with a comparable mechanical stability when torque had to be transferred. Providing a hollow structure instead of a solid rod would be within the competence of the skilled person.

Admissibility of the new inventive-step attack starting from E3

The subject-matter of claim 1 of the patent as granted lacked an inventive step also when starting from E3, in combination with E1.

This was not a new objection, but merely a new formulation of already presented facts from a different perspective, i.e. a new line of argument that had to be examined by the Board.

Moreover, even though the new attack had been submitted for the first time around one month before the oral proceedings, Article 13 RPBA still allowed for such late submissions if they do not cause unnecessary delays in the proceedings. That was not the case here, since the documents to be considered were already on file. The reason for presenting the new attack so late

was that its relevance had become apparent during the review of the case in preparation for the oral proceedings. More specifically, E3 *prima facie* related to a retrograde cutter and solved the same problem as the invention defined in claim 1 of the patent as granted. It had even more features in common with the claimed invention than E1. Hence, E3 clearly qualified as the closest prior art.

X. The respondent's arguments where relevant to the present decision may be summarised as follows:

Sufficiency of disclosure

Claim 1 of the patent as granted comprised both structural and functional features that had to be fulfilled by a retrograde cutter falling within its scope. The functional features presupposed other structural elements for their fulfilment. A mechanism comprising a pin and a slot but not allowing the claimed rotation and locking of the blade was clearly outside the scope of claim 1.

The patent disclosed how a retrograde cutter with a mechanism according to claim 1 was carried out, in particular with reference to figures 1 to 4. Based on that complete disclosure of one way of carrying out the invention and on further exemplary embodiments discussed in paragraphs [0029], [0034] and [0038] the skilled person could devise a multiplicity of well-known alternatives for providing the same functions as the specific elements shown.

Claim 1 was drafted in more general terms than the specific examples provided in the patent, but it did not have to be more specific since the skilled person

could carry out the whole subject-matter without undue burden.

Inventive step

The subject-matter of claim 1 of the patent as granted was inventive when E1 was considered the closest prior art.

E1 disclosed a retrograde cutter which comprised neither an inner tube nor a mechanism comprising a pin and a slot for connecting a blade to both an inner and an outer tube, flipping the blade and locking it in the flip position.

As far as the inner tube was concerned, claim 1 required its presence, i.e. the presence of a hollow element according to the common meaning of the term "tube". There was no contradiction with the disclosure of the patent that identified such an element with a shaft, as that presupposed that the shaft was a hollow one.

Those distinguishing features over E1, which was discussed in the patent, provided the advantage mentioned in paragraph [0010] that the flipping of the blade was facilitated. The objective technical problem solved was therefore improving the retrograde cutter of E1 for increasing the operational efficiency of the hospital while reducing the risks involved for the patient.

E2 did not concern a retrograde cutter, but a comparatively complex hand-held laparoscopic device. Its structure was not compatible with the large forces

involved in the use of a motor-driven drill foreseen for the device of E1. Moreover, E2 did not disclose an inner tube as claimed. Such a tube could transmit larger torque compared with a solid rod of the same weight.

E3 did not concern a motor-driven drill either. It did not disclose a mechanism comprising a pin and a slot. In particular, element 166 in figure 21 mentioned by the appellant was a tether, which the skilled person would not regard as a pin within the meaning of claim 1. The mechanism for flipping the blade in E3 functioned in a different way, based on the flexibility of the tether. Moreover, E3 did not disclose an inner tube as claimed.

E4 did not concern a retrograde cutter but rather an apparatus for forming a curvilinear cavity in a body by means of a blade at one end. It did not disclose a mechanism for converting a linear movement of an inner tube into rotational movement of the blade, which was manipulated by pulling a cable (450, figure 4D).

Hence, the skilled person would not combine any of E2 to E4 with E1, and, even if the combination was made, that would still not provide an inner tube as claimed. It followed that the subject-matter of claim 1 of the patent as granted was inventive starting from E1.

Admissibility of the new inventive-step attack starting from E3

The appellant raised a new objection starting from E3 as the closest prior art, in combination with E1, which was late and should not be admitted into the proceedings. This objection amounted to more than

simple arguments, as it involved a different closest prior art and a totally different way of attacking inventiveness.

Moreover, at first glance, E3 did not relate to an instrument of the same kind as the invention, and the combination with E1 would still not comprise important features of claim 1 of the patent as granted. More specifically, that combination would clearly not comprise a mechanism with a pin and a slot as claimed.

Reasons for the Decision

1. The appeal is admissible.

2. The invention

The invention relates to a retrograde cutter, comprising an elongated body, of the kind used during arthroscopy for creating a bone tunnel or socket for lodging a graft employed in the anterior cruciate ligament (ACL) reconstruction. In operations involving the use of such cutters, a pilot hole is first drilled through the bone from the outside of the knee articulation. The elongated body of the cutter is then inserted through the hole to a position within the knee from which, after having extended a blade from the elongated body of the cutter in the radial direction of the pilot hole, a socket with a larger diameter is drilled with a retrograde movement.

The invention as defined in claim 1 of the patent as granted focuses on a mechanism for positioning the blade and connecting it to the elongated body, the

latter comprising an outer and an inner tube. More specifically, the mechanism comprises a pin and a slot for transforming relative axial movement between the tubes in a rotational movement of the blade causing its radial extension by flipping, which is best seen in the sequence of figures 1 to 4 reproduced below.

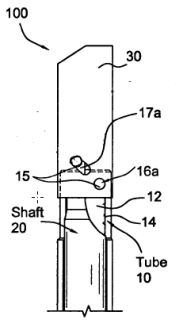

FIG. 1

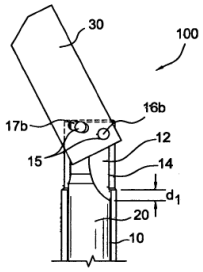

FIG. 2

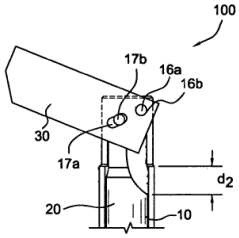

FIG. 3

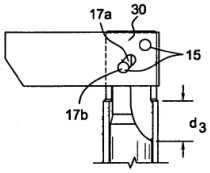

FIG. 4

According to the patent, such a mechanism facilitates the set-up for the subsequent drilling (paragraph [0010]).

3. Sufficiency of disclosure

3.1 The appellant argued that the invention as defined in claim 1 of the patent as granted was not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

In particular, the appellant argued that the claim had been drafted by employing broad functional definitions which included a number of undisclosed embodiments. It

followed that the patent did not provide sufficient disclosure over the whole scope of the claim.

3.2 It is established jurisprudence that, for the assessment of sufficiency of disclosure, the skilled person's common general knowledge, together with the content and the context of the patent as a whole, has to be taken into account.

Drafting claims in terms of functional features is common accepted practice since their purpose is to generalise a certain inventive technical teaching, as a fair balance between the specific disclosure and the scope of protection the invention deserves. It follows that there is no requirement that a patent should describe every single detail of every conceivable embodiment for fulfilling such functional features, as long as the skilled person, on the basis of a detailed description of at least one way of carrying out the invention claimed (Rule 42(1)(e) EPC), can figure out a variety of structures fulfilling those functional features. Hence, the appellant's argument that the claim encompassed any mechanisms making it possible to obtain the claimed function by further non-claimed and non-disclosed structural elements is, as such, not prejudicial to sufficiency of disclosure.

In this respect, the Board notes that the functional features contribute to the delimitation of the subject-matter of the claim and cannot be ignored. It follows that the appellant's argument that the patent provided no explanation of how a blade could be locked in a flip position by merely using a pin and a slot is beside the point. As the respondent submitted, the claim defines a mechanism comprising a pin and a slot and by which the blade can be locked in the flip

position. Hence, what the patent has to disclose is a mechanism comprising, *inter alia*, a pin and a slot, and fulfilling the claimed locking function, e.g. by means of other structural elements. It is common ground that the patent discloses at least one embodiment of such a mechanism comprising, in particular, a second pin (16b) cooperating with a pin hole (16a).

3.3 It is the Board's view that, on the basis of the specific embodiment described with reference to figures 1 to 4, the skilled person can think of a fairly large variety of equivalent mechanisms, all comprising a pin, a slot, an inner and an outer tube, and permitting the claimed flipping and locking of the blade. For example, generally known mechanical alternatives to the second pin would be a nut, a screw or another kind of hinge. The skilled person also knows that the locking function could, for example, be performed by providing a movable protrusion selectively engaging the inner and outer tubes or by providing a frictional engagement between those tubes.

This leads the Board to the conclusion that the level of generalisation of claim 1 of the patent as granted does not go beyond the scope of protection that the disclosure of the patent may deserve.

3.4 The Board is well aware that the scope of protection of a claim may subsequently be important, in case of a legal dispute, for establishing infringement at national level in the European countries in which the patent is valid. However, considering the specific, and possibly different, ways the competent national courts may deal with the issue of infringement extends beyond the powers and duties of the boards. Sufficiency of disclosure is a different issue, on which the boards

have established their own case law. In this context, decisions of German courts in specific cases of infringement proceedings are of little relevance for the present case.

3.5 In view of the above it is concluded that the patent as granted discloses the invention as defined in claim 1 in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. Hence, the ground for opposition according to Article 100(b) EPC does not prejudice the maintenance of the patent as granted.

4. Inventive step

4.1 The appellant argued that the subject-matter of claim 1 of the patent as granted lacked an inventive step when starting from E1 as the closest prior art.

4.2 E1, cited in paragraph [0003] of the patent, discloses a retrograde cutter comprising, in particular, an elongated body having an inner shaft (6, figure 2B) and an outer tube (4, figure 2B). At the distal end of the inner shaft, a blade (5, figure 2B) is mounted by means of a mechanism allowing rotating and locking the blade. With the blade, locked in a position such that the blade is perpendicular to the longitudinal axis of the elongated body, a hole can be drilled by motor-driven retrograde cutting.

It is common ground that E1 does not disclose that the mechanism comprises a pin and a slot for connection of the blade to the outer tube in such a manner that the relative linear movement of the outer tube with respect to the inner shaft flips the blade.

With the retrograde cutter of E1, the blade has to be articulated independently, for example by manipulating it with another instrument (sentence spanning pages 4 and 5). The blade can then be locked in the desired position.

4.3 The technical effect of the distinguishing features of the subject-matter of claim 1 is to allow flipping of the blade into the desired position without the need of an additional instrument or manipulation within the joint, since the flipping can be performed by a relative linear movement of the outer tube with respect to the inner tube as claimed.

The Board shares the respondent's view that this technical effect solves the objective technical problem of increasing operational efficiency of a retrograde cutter for retrograde drilling of a bone tunnel or socket, while reducing the risks involved for the patient. The problem formulated by the appellant is not acceptable since it contains elements of the solution, i.e. of the claimed way of flipping the blade.

4.4 E2 concerns a hand-held elongated laparoscopic instrument comprising two alligator jaws (12 and 14, figures 1 and 2) at different positions along the longitudinal axis of the instrument. The jaws can be operated by respective finger grips at the proximal end of the instrument. As the appellant argued, an element of the proximal alligator jaw can be flipped by actuating a mechanism comprising a pin (94, figure 16) and a slot (93, figure 16), such that a slidable member (52a, figure 16) connected to a rod (30, figure 2) axially moves within the instrument.

The Board notes that there is no indication in E2 that

the mechanism for operating the proximal jaw should be in any relation to the objective technical problem of increasing operational efficiency of a retrograde cutter for retrograde drilling of a bone tunnel or socket while reducing the risks involved for the patient.

Furthermore, the mechanism of E2 does not connect the blade to a distal end of an inner tube, as required by claim 1 of the patent as granted. In this respect, the appellant's argument that a solid shaft should be considered as synonymous with a tube is not accepted. As the respondent submitted, the common meaning of the term "tube" is a hollow element. The patent does not give a different meaning. It follows that when the term "shaft" is used for identifying the inner tube, a hollow shaft is implied. This is the case, for example, in paragraph [0028] cited by the appellant comprising the expression "*the outer tube 10 of the retrograde cutter 100 hoses an inner tube or shaft*" and in the definition of the shaft in paragraph [0025], first sentence, which reads:

> *"As described in more detail below, formation of the recipient socket begins by inserting an outer tube and an inner tube (i.e. a shaft) of the instrument into the joint space, preferably from the outside in, through a small diameter tunnel."*

Hence, in order to obtain an instrument falling within the scope of claim 1 of the patent as granted, a modification of the rod of the mechanism of E2 would be required. As the respondent submitted, a tube instead of a solid rod is advantageous for motor-driven drills since a tube could transmit larger torque compared with a solid rod of the same weight.

Finally, the mechanism for flipping the jaw element of E2 is clearly not suitable for a motor-driven drill such as those usable with the instrument of E1. In order to keep this possibility of use, the implementation of the mechanism of E2 in the instrument of E1 would require further important adaptation.

The appellant's argument that the skilled person would adapt the teaching of E2 in order to retain the possibility of coupling the retrograde cutter of E1 to a powered motor is considered to be based on hindsight. There is no evidence to support such an argument without knowing the invention. The large number of modifications needed would rather discourage the skilled person from trying the combination of E2 with E1 altogether.

In view of the above considerations, the Board concludes that the subject-matter of claim 1 of the patent as granted would not be arrived at in an obvious way when starting from E1 in view of E2.

4.5 E3 concerns a hand-held elongated tool for creating voids in interior body regions, such as a vertebra (figure 3). It comprises a mechanism for turning relative translational motion between an inner plunger rod (156, figure 21) and an outer tube (112, figure 21) into rotation of a blade (120, figure 21). The mechanism includes a tether wire (166, figure 21) looped to pass through holes in the blade such that by acting on the wire the blade can be flipped (paragraph [0115], third and fourth sentences).

The Board notes that there is no indication in E3 either, that the mechanism for flipping the blade

should be in any relation to the objective technical problem of increasing operational efficiency of a retrograde cutter while reducing the risks involved for the patient.

Furthermore, similarly to E2, the mechanism of E3 does not connect the blade to a distal end of an inner tube, as required by claim 1 of the patent as granted, but to a plunger rod. Hence, in order to obtain an instrument falling within the scope of the claim, an important modification of the plunger rod of the mechanism of E3 would be required. It is also not disclosed in E3 that that mechanism is suitable for a motor-driven drill such as those usable with the instrument of E1.

Finally, the mechanism for flipping the blade of E3 does not even comprise a pin and a slot as defined in claim 1 of the patent as granted. As the respondent submitted, a tether wire is not a pin according to the common meaning of these terms, and a mechanism employing a wire looped to pass through holes in the blade, such that by acting on the wire the blade can be flipped, functions in a different technical way, based on the flexibility of the wire.

Hence, by analogy with the conclusions drawn with respect to the combination of E1 and E2, the subject-matter of claim 1 of the patent as granted would also not be arrived at in an obvious way when starting from E1 in view of E3.

4.6 E4 concerns an elongated tool for creating voids in interior body regions, such as a vertebra (Paragraph [0002]). It comprises a mechanism for flipping a blade (415, figure 4D) by pulling a cable tether (450, figure 4D) connected to the blade and extending along the

longitudinal axis of the tool.

There is no indication in E4 either that the mechanism for flipping the blade should be in any relation to the objective technical problem of increasing operational efficiency of a retrograde cutter while reducing the risks involved for the patient.

Furthermore, similarly to E2 and E3, the mechanism of E4 does not connect the blade to a distal end of an inner tube, as required by claim 1 of the patent as granted, but to a cable tether.

Finally, although a pin (455, figure 4D) around which the blade can pivot is present, this pin is not involved in the connection of the blade with the cable tether. Hence, the mechanism of E4 does not comprise a pin and a slot as defined in claim 1 of the patent as granted. The cable tether itself is not a pin according to the common meaning of these terms, and the mechanism employing the cable tether, such that by acting on the cable tether the blade can be pivoted around the pin so that it is flipped, functions in a different technical way, based on the flexibility of the cable tether.

Hence, by analogy with the conclusions drawn with respect to the combinations of E1 with E2 or with E3, the subject-matter of claim 1 of the patent as granted would also not be arrived at in an obvious way when starting from E1 in view of E4.

4.7 It follows that the subject-matter of claim 1 of the patent as granted is inventive (Article 56 EPC) when starting from E1 as the closest prior art. Hence, the ground for opposition of lack of inventive step according to Article 100(a) EPC does not prejudice the

maintenance of the patent as granted.

5. Admissibility of the new inventive-step attack starting from E3

5.1 The appellant presented an inventive-step attack against claim 1 of the patent as granted starting from E3, in combination with E1, for the first time around one month before the oral proceedings.

5.2 It argued that it was not a new objection, but merely a new formulation of already presented facts from a different perspective.

The Board does not share this view. The new inventive-step attack starting from E3 is based on a closest prior art different from that considered before. The distinguishing features of the claimed subject-matter over E3 are also different from those over E1 and they address a different technical problem. In summary, the problem-solution approach to be followed in order to assess inventive step in view of the new attack would have to be structured anew, based on different technical considerations. This amounts to a new objection involving more than simply new arguments based on a mere new formulation of already presented facts and is therefore an amendment to the appellant's case, filed after the statement of grounds of appeal, the admission of which is at the Board's discretion under Article 13(1) RPBA.

5.3 The discretion is to be exercised in view of, *inter alia*, the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy. A further relevant criterion, according to the established case law of the

boards of appeal, is the *prima facie* relevance of the amendment.

The Board notes that the appellant provided only subjective reasons why the new objection was presented so late.

Moreover, *prima facie*, the combination of E3 with E1 misses several features of the subject-matter of claim 1 of the patent as granted, such as a mechanism connecting a blade to a distal end of an inner tube and comprising a pin and a slot as claimed (point 4.5 above). Hence, it does not appear to be prejudicial to the inventive step of the subject-matter of claim 1 of the patent as granted.

It follows that the *prima facie* relevance of the new objection is not given.

Consequently, under Article 13(1) RPBA, the Board does not admit that new objection into the proceedings.

6. Since, on the basis of the appellant's objections in the appeal proceedings, no ground for opposition prejudices the maintenance of the patent as granted, the appeal has to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

D. Hampe E. Dufrasne

Decision electronically authenticated