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Datasheet for the decision of 23 July 2019

Case Number: T 0570/14 - 3.2.02

Application Number: 07113565.1

Publication Number: 1844716

IPC: A61B17/064, A61B17/068, A61B17/04, A61B17/11

Language of the proceedings: EN

Title of invention:
Endoscopic fundoplication devices for treatment of gastroesophageal reflux disease

Patent Proprietor:
Boston Scientific Limited

Opponent:
Leeming, John Gerard

Headword:

Relevant legal provisions:
EPC Art. 56, 76(1), 84, 100(a), 100(b), 100(c), 113(2), 123(2)
EPC R. 76(2)(c)
RPBA Art. 12(4)

Keyword:
Opposition admissible (yes)
Extent of the opposition limited (yes)
Admissibility of requests 2a, 2b (yes)
Extension beyond the application as filed or the earlier application as filed - auxiliary requests 1, 2, 2a, 2b - (yes)
Extension beyond the application as filed or the earlier application as filed - auxiliary request 2c - (no)
Clarity - auxiliary request 2c - (yes)
Inventive step - auxiliary request 2c - (yes)
Power to examine non-opposed claims (no)

Decisions cited:
G 0009/91, T 0376/90

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

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Case Number: T 0570/14 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 23 July 2019

Appellant: (Patent Proprietor)	Boston Scientific Limited Clarendon House 2 Church Street Hamilton HM11 (BM)
Representative:	Vossius & Partner Patentanwälte Rechtsanwälte mbB Siebertstrasse 3 81675 München (DE)
Appellant: (Opponent)	Leeming, John Gerard J.A. Kemp & Co. 14 South Square Gray's Inn London WC1R 5JJ (GB)
Representative:	J A Kemp 14 South Square Gray's Inn London WC1R 5JJ (GB)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 3 January 2014 concerning the maintenance of the European Patent No. 1844716 in amended form**

Composition of the Board:

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

Summary of Facts and Submissions

I. The appeals of the patent proprietor and of the opponent are against the Opposition Division's interlocutory decision dated 3 January 2014 that, account being taken the amendments (according to auxiliary request 1b) made by the patent proprietor during the opposition proceedings, the patent and the invention to which it related were found to meet the requirements of the Convention.

II. The patent in suit is based on a divisional application of the earlier application EP 03761072.2.

III. On 29 December 2010, the opponent filed the notice of opposition. In the letter accompanying the notice of opposition the following could be read:

"...hereby files Opposition to the above European Patent and requests that the patent be revoked in its entirety. In the event that the Opposition Division is unable to issue a decision revoking the patent in its entirety oral proceedings are requested..."

Under point V of Form 2300E the following can be seen:

V. Opposition is filed against	
the patent as a whole	☐
claim(s) No(s).	1-4 and 8-19

In the notice of opposition, under point 2 it is explained why the subject-matter of claim 1 extends beyond the content of the application as filed, under point 3 it is explained why the invention is not

sufficiently described for a person skilled in the art to carry it out, under points 5 and 6 it is explained why the subject-matter of claim 1 is not novel and/or not inventive and under point 7 it is explained why the subject-matter of dependent claims 2 to 4 and 8 to 19 lacks novelty and/or inventive step. Under point 8 of the notice of opposition, "Conclusion", the following can be read:

"*It is submitted that at both the priority and filing dates of the opposed patent the subject-matter of granted claims 1-4 and 8-19 was either known, or was the result of an obvious modification of a known surgical device. It is, thus, requested that the opposed patent be revoked in its entirety.*"

IV. The opponent's notice of appeal was filed on 13 March 2014 and the appeal fee paid on the same day. The statement setting out the grounds of appeal was filed on 9 May 2014.

V. The patent proprietor's notice of appeal was filed on 13 March 2014 and the appeal fee paid on the same day. The statement setting out the grounds of appeal was filed on 12 May 2014.

With its statement setting out the grounds of appeal the appellant/patent proprietor filed auxiliary requests 1, 2, 2a to 2f, 3 and 4. These requests contained handwritten amendments.

VI. By letter dated 27 June 2019, the appellant/patent proprietor filed typed versions of auxiliary requests 1, 2, 2a to 2f, 3 and 4 previously filed with the statement setting out the grounds of appeal. The requests' numbering was kept.

VII. Oral proceedings were held on 23 July 2019.

The appellant/patent proprietor requested that the decision under appeal be set aside and that the opposition be rejected as inadmissible or, in the alternative, that the patent be maintained on the basis of one of auxiliary requests 1, 2, 2a to 2f, all filed during the oral proceedings, and auxiliary requests 3 and 4, both filed by letter dated 27 June 2019.
All other requests were withdrawn.

In auxiliary requests 1, 2 and 2a to 2f, the dependent claims corresponding to claims 13 to 19 of the patent as granted present in the former auxiliary requests 1, 2 and 2a to 2f were deleted; the remaining claims of the requests were identical to the former ones.

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

All the requests for remittal to the department of first instance formulated in writing in the appellant/ opponent’s reply dated 28 November 2014, and concerning the requests examined in this decision, were withdrawn.

The appellant/opponent’s written objection in the reply dated 28 November 2014 as to the admissibility of the main request, auxiliary request 2, auxiliary requests 2c to 2e and auxiliary request 4 was withdrawn.

The appellant/opponent’s written objections in the reply dated 28 November 2014 against auxiliary request 2c pursuant to Article 100(b) EPC (or Article 83 EPC) and Rule 80 EPC were withdrawn.

VIII. Claim 1 according to auxiliary request 1 reads as follows:

"An endoluminal surgical device for fastening multiple tissue layers, comprising:
a tissue fastener (200, 300, 800);
a flexible needle (170, 270, 370, 700) configured to carry a portion of the tissue fastener through the multiple tissue layers; and
a deflector (150, 450) defining a curved conduit (157, 457) for deflecting and guiding the needle (170, 270, 370, 700) toward the multiple tissue layers, wherein the conduit (157, 457) includes a proximal portion extending substantially axially within the deflector (150, 450) and a distal portion extending substantially perpendicularly relative to the proximal portion."

IX. The different main claims of auxiliary requests 2 and 2a to 2c differ from each other only on account of the wording of the flexible needle feature, and as follows:

auxiliary request 2

"a flexible needle (170, 270, 370, 700) configured to carry a portion of the tissue fastener through the multiple tissue layers, the flexible needle having means to grasp a portion of the tissue fastener;"

auxiliary request 2a

"a flexible needle (170, 270, 370, 700) having means to grasp a portion of the tissue fastener, the flexible needle being configured to carry a portion of the tissue fastener through the multiple tissue layers by the means to grasp;"

auxiliary request 2b

"a flexible needle (170, 270, 370, 700) having means to grasp a portion of the tissue fastener, the flexible needle being configured to carry the tissue fastener through the multiple tissue layers by the means to grasp;"

auxiliary request 2c

"a flexible needle (170, 270, 370, 700) having means to grasp and release a portion of the tissue fastener, the flexible needle being configured to carry a portion of the tissue fastener through the multiple tissue layers by the means to grasp and release;"

X. Independent claim 8 of auxiliary request 2c reads as follows:

"An endoluminal surgical device for fastening multiple tissue layers, comprising:

a tissue fastener (200, 300, 800);
a flexible needle (170, 270, 370, 700) configured to carry at least a portion of a tissue fastener;
a deflector (150, 450) defining a curved conduit (157, 457) for deflecting and guiding the needle (170, 270, 370, 700) toward the multiple tissue layers, wherein the conduit (157, 457) includes a proximal portion extending substantially axially within the deflector (150, 450) and a distal portion extending substantially perpendicularly relative to the proximal portion; and
a tubular member (600) movable along the conduit (157, 457) of the deflector (150, 450) and configured to receive the needle (170, 270, 370, 700)."

XI. The appellant/patent proprietor's arguments relevant for the decision and not endorsed by the Board can be summarised as follows:

Admissibility of the opposition

The extent of the opposition was unclear because the notice of opposition (Form 2300E) mentioned claims 1 to 4 and 8 to 19 as the claims being opposed, whereas the last sentence of the conclusion of the notice of opposition (point 8 of the grounds) and the letter accompanying the notice of opposition stated that the opposed patent should be revoked in its entirety. According to T 376/90 (OJ EPO 1994, 906), such lack of clarity as regards the extent of opposition would justify inadmissibility.

Extension beyond the content of the application as filed and/or beyond the content of the earlier application as filed

The wording of the "flexible needle feature" in claim 1 of auxiliary requests 1, 2, 2a and 2b was supported by paragraphs [047] and [053] of the application as filed, which both explained that the fastener is carried through the tissue layers. The person skilled in the art understood that the essential part was the carrying function of the grasping and releasing means, not these means as such. Moreover, paragraph [010] provided a basis for a general claim.

XII. The appellant/opponent's arguments relevant for the decision and not endorsed by the Board can be summarised as follows:

Extent of the opposition

The statement in a letter accompanying the notice of opposition filed on the same day was evidence that the patent as a whole was opposed. G 9/91 (OJ EPO 1993, 408) also confirmed that as soon as an independent claim was opposed the dependent claims could be examined as well. Moreover, it made no sense to consider that the appellant/opponent did not wish to oppose a claim having exactly the same deficiency as claim 1, as was the case here since claims 5-7 did not overcome the objection under Article 100(c) EPC. A prima facie analysis thus led the reader of the notice of opposition to understand that the appellant/ opponent's intention could not have been to limit the objection under Article 100(c) EPC to claim 1.

Admissibility of auxiliary requests 2a and 2b

These requests could have been and had to be filed in the opposition proceedings, when the appellant/patent proprietor had the opportunity to file intermediate requests to the ones on file. These requests should therefore not be admitted into the appeal proceedings.

Extension beyond the content of the application as filed and/or beyond the content of the earlier application as filed

The wording of claim 1 of auxiliary request 2c did not make it clear that the portion grasped by the means to grasp and release was also the portion which was carried through the multiple tissue layers. Since the two portions could be different, the claim contained subject-matter extending beyond the content of the divisional application as filed.

Clarity

The wording of claim 1 was not clear since it was unclear whether the portion grasped by the means to grasp and release was the same portion as the portion carried through the tissue layers.

Inventive step

The subject-matter of claim 1 was not inventive in view of P1 (US-A-6071292), more specifically in view of the second version of the fourth embodiment presented in this document. The only difference between the subject-matter of claim 1 and the endoluminal surgical device disclosed in P1 was that the latter did not have means for grasping and releasing on its needle to grasp and release the suture. This feature was, however, an obvious alternative design choice the person skilled in the art selected without any inventive step.

Reasons for the Decision

1. The appeals are admissible.

2. Admissibility of the opposition

According to the appellant/patent proprietor the extent of the opposition was unclear because the notice of opposition (Form 2300E) mentioned claims 1 to 4 and 8 to 19 as the claims being opposed, whereas the last sentence of the conclusion of the notice of opposition (point 8 of the grounds) and the letter accompanying the notice of opposition stated that the opposed patent should be revoked in its entirety. According to T 376/90 (OJ EPO 1994, 906), reasons 2.2.1, such lack

of clarity as regards the extent of opposition would justify inadmissibility: "*In the extreme, where the extent to which a patent is opposed is in serious doubt, this may indeed lead to a rejection of an opposition as inadmissible.*"

In that respect the statement at the end of point 8 was particularly unclear in terms of the extent: "*It is submitted that at both the priority and filing dates of the opposed patent the subject-matter of granted claims 1-4 and 8-19 was either known, or was the result of an obvious modification of a known surgical device. It is, thus, requested that the opposed patent be revoked in its entirety.*"

Therefore, the opposition had to be rejected as inadmissible.

The Board does not share the appellant/patent proprietor's opinion. For an opposition to be admissible the notice of opposition must fulfil the minimum requirement of Rule 76(2)(c) EPC, namely the indication of one ground for opposition and corresponding facts, evidence and/or arguments in support of that ground. As can be inferred from point II above, in the notice of opposition claim 1 was objected to under Article 100(c) EPC and Article 100(b) EPC and claims 1 to 4 and 8 to 19 were objected to under Article 100(a) EPC. The appellant/patent proprietor did not contest that the objections were properly substantiated for these claims, and the Board shares that view. Therefore, the minimum condition for the opposition to be admissible is met. Moreover, from the statements made in the notice of opposition and in the accompanying letter there is no doubt that at least claims 1 to 4 and 8 to 19 are objected to, or, in other

words, there is no doubt that the opposition to the patent extends at least to these claims. Whether claims 5 to 7 are covered by the extent of the opposition is a different question from the question of the admissibility of the opposition.

Therefore, the opposition is admissible.

3. Extent of the opposition

The question of the extent of the opposition is important, since from a procedural point of view there would be no opposition proceedings open against non-opposed claims, with the consequence that the appellant/opponent, the Board and even the appellant/ patent proprietor could not object to or amend these claims in any way.

The appellant/opponent considers that its statement in an accompanying letter to the notice of opposition filed on the same day and specifying that "*John Gerard LEEMING, (...), hereby files Opposition to the above European Patent and requests that the patent be revoked in its entirety.*" was evidence enough that the patent as a whole was opposed. Also G 9/91 (order, second sentence) confirmed that as soon as an independent claim was opposed the dependent claims could be examined as well: "*However, subject-matters of claims depending on an independent claim, which falls in opposition or appeal proceedings, may be examined as to their patentability even if they have not been explicitly opposed, provided their validity is prima facie in doubt on the basis of already available information.*"

The Board does not share the appellant/opponent's opinion. The basic principle to be applied is expressed by the Enlarged Board of Appeal in the first sentence of the order of G 9/91: "*The power of an Opposition Division or a Board of Appeal to examine and decide on the maintenance of a European patent under Articles 101 and 102 EPC depends upon the extent to which the patent is opposed in the notice of opposition pursuant to Rule 55(c) EPC.*" *(emphasis added).*

Hence, the Enlarged Board of Appeal made it clear that the extent mentioned in the notice of opposition pursuant to Rule 55(c) EPC 1973 or Rule 76(2)(c) EPC is the part of the patent which is opposed, and thus is the part on which the opposition division and, in case of an appeal, the board of appeal has the power to decide. There are no opposition proceedings open against the remaining part of the patent. In the present case, the extent clearly defined in the notice of opposition is claims 1 to 4 and 8 to 19 of the patent as granted. As can be seen under point II above, in Form 2300E under part V. the appellant/opponent had the option to cross the box "the patent as a whole" or specify which claims were opposed. This must be considered to be an expression of the appellant/ opponent's intention. The appellant/opponent chose to limit its opposition to claims 1 to 4 and 8 to 19. This intention is confirmed in the notice of opposition since claims 5 to 7 are not mentioned once in the grounds, unlike all the other dependent claims, thus confirming what has been crossed on Form 2300E. Clearly, no clerical error was made, contrary to the appellant/opponent's assertion.

The statement in the accompanying letter or at the end of the notice of opposition that the patent should be revoked in its entirety does not change this finding. In the European patent system, pursuant to Article 113(2) EPC, an opposition division (or a board) can only maintain a patent in a text submitted or agreed by the proprietor of the patent. This implies that an opposition division or a board cannot revoke a patent partially on its own motion if there is no request by the patent proprietor to that effect. In other words, even if only one claim were opposed, in the absence of a request by the patent proprietor for the patent to be maintained in amended form, the opposition division or the board would have to revoke the patent in its entirety. The statement at the end of the notice of opposition is, therefore, not in contradiction with the fact that not all claims have been opposed.

Furthermore, the second sentence of the order of G 9/91 is not applicable to the present case because the claims intended to be opposed have been clearly specified. This is explained by the Enlarged Board of Appeal under point 11 of the reasons: "*11. It follows that the answer to the first question put to the Enlarged Board in case G 9/91 has to be affirmative. However, even if the opposition is explicitly directed only to the subject-matter of an independent claim of a European patent, subject-matters covered by claims which are depending on such an independent claim may also be examined as to patentability, if the independent claim falls in opposition or appeal proceedings, provided their validity is prima facie in doubt on the basis of already available information (cf. T 293/88, OJ EPO 1992, 220). Such dependent subject-matters have to be considered as being*

implicitly covered by the statement under Rule 55(c) EPC (cf. paragraph 8 above)." (emphasis added)

Since in the present case the appellant/opponent expressly opposed claims 1 to 4 and 8 to 19, it follows that the above principle expressed by the Enlarged Board of Appeal does not give the Board the power to examine claims 5 to 7.

According to the appellant/opponent, it also made no sense to consider that the appellant/opponent did not wish to oppose a claim having exactly the same deficiency as claim 1, as was the case here since claims 5-7 did not overcome and eliminate the objection under Article 100(c) EPC. A prima facie analysis thus led the reader of the notice of opposition to understand that the appellant/opponent's intention could not have been to limit the objection under Article 100(c) EPC to claim 1.

As explained, since claims 5 to 7 are not covered by the extent of the opposition there are no opposition proceedings open against them, so the Board has no power to examine them even though they may prima facie be objected to for the same reasons. In the Board's opinion, and contrary to the appellant/opponent's opinion, as explained above, the appellant/opponent's intention was to not oppose claims 5 to 7. The appellant/opponent may have had different reasons for doing so and it is not the Board's duty to try and find out why the appellant/opponent made this choice; it is sufficient to note that the extent of the opposition is limited.

Therefore, the extent of the opposition is limited to claims 1 to 4 and 8 to 19.

4. The invention

The invention concerns a device for a surgical procedure known as "fundoplication". This procedure is used for the treatment of Gastroesophageal Reflux Disease (GERD) and involves bringing the fundus wall of the stomach into closer proximity with the oesophageal wall to help close off the oesophageal opening into the stomach. In the prior art it was either done by open surgery or by laparoscopic surgery.

The invention proposes a less invasive device which can be used endoluminally through the oesophagus, as can be seen below.

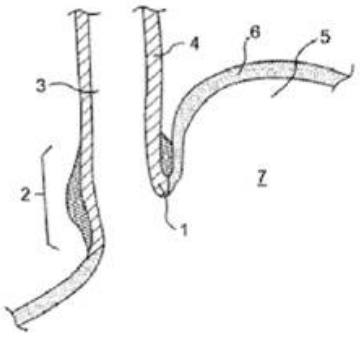


FIG. 1B

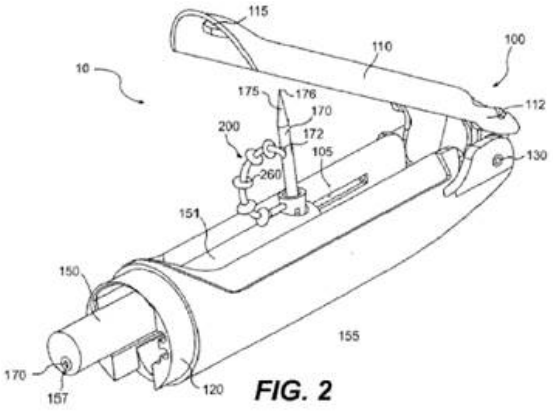


FIG. 2

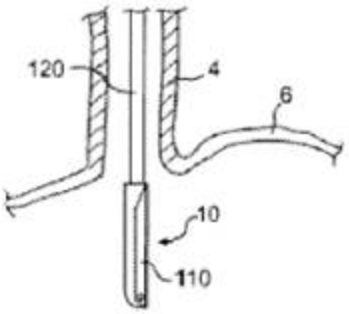


FIG. 13

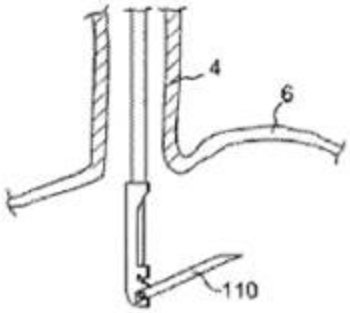


FIG. 14

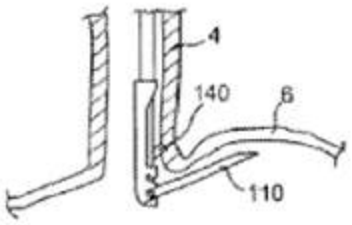


FIG. 15

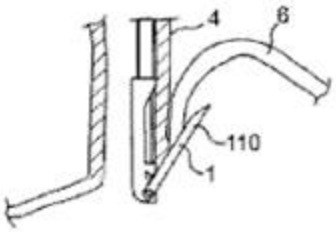


FIG. 16

5. Admissibility of auxiliary requests 2a and 2b (filed during the oral proceedings)

The appellant/opponent considered that these requests could have been and even had to be filed in the opposition proceedings, when the appellant/patent proprietor had the opportunity to file intermediate requests to the ones on file. Pursuant to Article 12(4) RPBA, therefore, these requests should not be admitted into the appeal proceedings.

In claim 1 of these requests the needle has means to grasp, but not to grasp and release. As can be inferred from points V, VI and VII above, the appellant/patent proprietor filed claim 1 of each of these requests together with its statement setting out the grounds of appeal, in which it also explained why these claims fulfilled the requirements of Articles 76(1) and 123(2) EPC. Each claim 1 of these requests represents an

intermediate position between the corresponding claim of the set of claims of the patent as granted and the corresponding claim of the set of claims as considered allowable by the Opposition Division. They are, as it were, consistently inserted into a set of convergent requests. Moreover, they do not introduce any new concept since the question of the meaning of the feature "configured to carry" in claim 1 and to what extent this feature has to be or does not have to be completed by additional features in order not to infringe Articles 76(1) and 123(2) EPC has been discussed right from the start of the opposition proceedings. Hence, the appellant/opponent should not have any difficulty dealing with them either.

Therefore, the Board does not consider these requests inadmissible pursuant to Article 12(4) RPBA.

6. Extension beyond the content of the application as filed and/or beyond the content of the earlier application as filed (Articles 100(c), 76(1) and 123(2) EPC) – Auxiliary requests 1, 2, 2a to 2f

6.1 For the parties the first litigious feature of any version of claim 1 according to the above-mentioned auxiliary requests is the flexible needle feature.

6.1.1 Claim 1 of auxiliary request 1 requires the flexible needle to be configured to carry a portion of the tissue fastener through the multiple tissue layers.

According to the appellant/patent proprietor this wording was supported by paragraphs [047] and [053] of the application as filed, which both explained that the fastener was carried through the tissue layers. The person skilled in the art understood that the essential

part was the carrying function of the grasping and releasing means, not these means as such. Moreover, paragraph [010] provided a basis for a general claim.

It is noted that the paragraphs cited are identical in the parent application as filed and in the divisional application as filed.

[047] reads as follows:
"When the needle basket 170 protrudes out of the side opening 155 and through the locking mechanism 220 of the tissue fastener 200, the needle basket 170 grasps the distal loose end 290 of the suture 150 by the grasping and releasing means, described above, and carries it through the multiple tissue layers, as shown in Fig. 9."

Paragraph [047] belongs to the part of the description in which it is explained how the suture or fastener is placed in the tissue layers. This is also shown in Figures 7 to 9. As mentioned at the beginning of paragraph [046]: *"For illustration purpose, the needle basket 170 shown in Figs. 3A-3B is used to describe its operation in connection with the deflector 150. It should be understood, however, that other embodiments of the needle baskets 270, 370 shown in Figs. 4A-4C and 5A-5B, respectively, can also be used in similar manner described herein."*

Consequently, paragraphs [046] and [047] not only specifically mention the means for grasping and releasing but they also refer to the three possible options for the means for grasping and releasing. And in the paragraphs describing the three options, namely paragraphs [040], [041] and [042], the means in question are always defined as means for grasping and

releasing. In the first two sentences of paragraph [040], for instance, these means are mentioned three times: "*The needle basket 170 includes means for grasping and releasing the distal end 290 of a suture 250, located proximate the distal end of the needle basket 170. Figs. 3A-3B show a portion of the needle basket 170 having means for grasping and releasing the distal end 290 of a suture 250, according to an embodiment of the present invention. In this embodiment, the means for grasping and releasing includes a suction hole 172 and a suction conduit 173 formed inside the hollow needle basket 170.*" (emphasis added)

[041] starts with "*Figs. 4A-4C show a needle basket 270 having a basket type grasping and releasing means, according to another embodiment of the present invention.*" (emphasis added)

In paragraph [042] the following can be read: "*Figs. 5A-5B show biopsy forceps used as a needle basket 370, according to still another embodiment of the present invention. (...) The jaws 374a, 374b can be closed and opened to grasp and release the distal end 290 of the suture 250 by suitable actuation means employable at the proximal end of the tubular member 376.*"

The second paragraph mentioned by the appellant/patent proprietor is paragraph [053], which reads as follows: "*As shown in Fig. 17, the needle basket 170 protrudes out of the deflector 150 and grasps the distal end 290 of the suture 250 with the grasping and releasing means 172. The needle basket 170 then carries the distal end 290 of the suture 250 from the esophageal side to the stomach side, as shown in Fig. 18. Once the needle basket 170 passes through the both walls 4,6, the*

needle basket 170 releases the distal end 290 of the suture 250 and is withdrawn back into the deflector 150, as shown in Fig. 19." (emphasis added)

Paragraph [053] belongs to the part of the description presenting a method of installing the tissue fastener, going from paragraph [049] to paragraph [053] and depicted in Figures 17 to 24. Here again, as can be seen in the part of paragraph [053] set out above, the means used to take the suture through the tissues are defined as grasping and releasing means.

It follows that when the verb "to carry" is used, it is always in conjunction with means for grasping and releasing; the Board could not identify any passage in any other part of the description of the divisional application as filed that did not refer to grasping and releasing means for fulfilling the carrying function. Additionally, paragraph [010], referred to by the appellant/patent proprietor, not only does not include the verb "to carry" but also specifies that the flexible needle has means for grasping and releasing a portion of the tissue fastener.

In such a case, a generalisation of the means to grasp and release to means only to grasp is not acceptable under Article 123(2) EPC.

For the above reason, the subject-matter of claim 1 of auxiliary request 1 extends beyond the content of the application as filed.

6.1.2 For the same reason, all versions of claim 1 not including grasping and releasing means but only means to grasp also contain subject-matter extending beyond

the content of the application as filed. This is the case for claim 1 of auxiliary requests 2, 2a and 2b.

It is noted that independent claim 22 of the parent application as filed reads as follows:
"An endoluminal surgical device for fastening multiple tissue layers, comprising: a tissue fastener; a flexible needle having a grasper for grasping a portion of the tissue fastener; and a deflector for deflecting and guiding the needle toward the multiple tissue layers."

As can be seen this claim only mentions "grasping" but not "releasing", but this claim is not present in the divisional application as filed, so it cannot serve as a basis for supporting any claim limited to grasping in the divisional application or in the patent based on the divisional application.

Hence, auxiliary requests 2, 2a and 2b also contain subject-matter extending beyond the content of the application as filed.

6.1.3 In claim 1 of auxiliary request 2c the litigious feature reads as follows:
"a flexible needle (170, 270, 370, 700) having means to grasp and release a portion of the tissue fastener, the flexible needle being configured to carry a portion of the tissue fastener through the multiple tissue layers by the means to grasp and release;"

In the Board's opinion, this wording of the litigious feature does not contain subject-matter extending beyond the content of the application as filed or beyond the content of the earlier application as filed, since this wording specifies that the flexible needle

has means to grasp and release, and further specifies that these means are the ones used to carry the portion of the tissue fastener through the multiple tissue layers, as for instance supported by the above mentioned paragraphs [010], [047] and [053].

6.2 The appellant/opponent further considered that the reference to "a" portion in the wording of claim 1 of auxiliary request 2c did not make it clear that the portion grasped by the means to grasp and release was also the portion which was carried through the multiple tissue layers. Since the two portions could be different, the claim contained subject-matter extending beyond the content of the divisional application as filed.

As can be seen, for instance in Figures 17 to 24 below, the whole fastener is never carried through the tissue layers since one end of it has to remain on the side of the oesophagus to be fixed to the other end when the latter is carried through the tissue layers back to its starting point. On the other hand, it is also not only the portion of the fastener grasped by the means to grasp and release which is carried through the tissue layers, since most often the portion passing through the tissue layers is longer. Hence, in the Board's opinion, when this feature of the claim is read in context the portion carried through the tissue layers is at least the portion grasped by the means to grasp and release, or more.

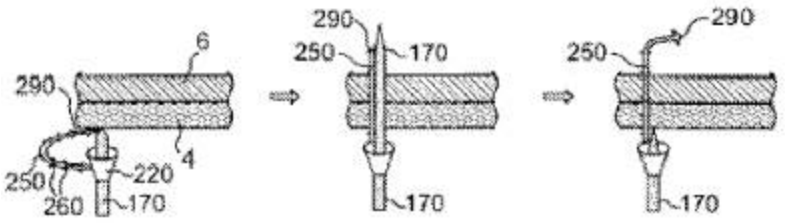


FIG. 17 FIG. 18 FIG. 19

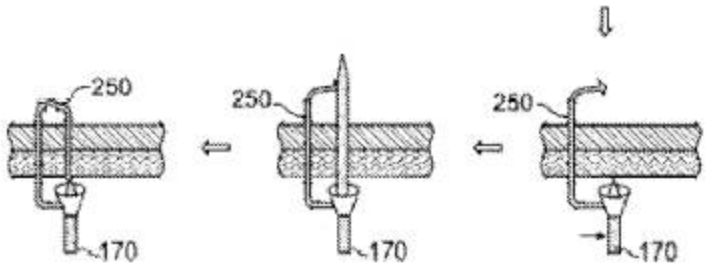


FIG. 22 FIG. 21 FIG. 20

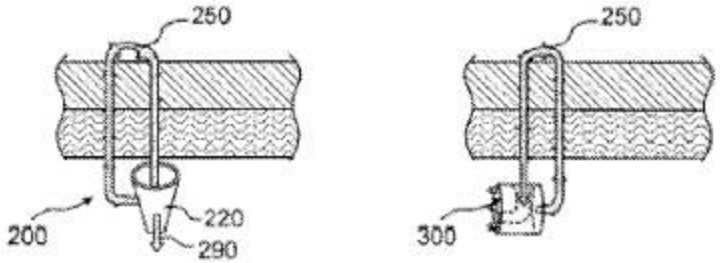


FIG. 23 FIG. 24

Therefore, the Board does not consider that this feature contains any extension beyond the content of the application as filed or beyond the content of the earlier application as filed.

6.3 Hence, claim 1 of auxiliary request 2c satisfies the requirements of Articles 76(1) and 123(2) EPC.

7. Clarity

The appellant/opponent considered that the wording of claim 1 was not clear since it was unclear whether the portion grasped by the means to grasp and release was the same portion as the portion carried through the tissue layers.

The Board has already explained the meaning to be given to this feature when read in context in connection with the extension of content objection dealt with above. The same applies here.

Therefore, claim 1 fulfils the requirements of Article 84 EPC.

8. Inventive step

The appellant/opponent considered that the subject-matter of claim 1 was not inventive in view of P1, more specifically in view of the second version of the fourth embodiment presented in this document, the description of which started in column 17, line 10 and which was presented in Figures 23a to 23h, 24a, 24b, 25, 25a and 26. The appellant/opponent considered that the only difference between the subject-matter of claim 1 and the endoluminal surgical device disclosed in P1 was that the latter did not have means for grasping and releasing on its needle to grasp and release the suture. This feature was, however, an obvious alternative design choice the person skilled in the art selected without any inventive step.

The embodiment described in P1 and considered by the appellant/opponent is an intraluminal suturing device used for instance to join approximated segments of an anatomical conduit such as a blood vessel (column 17, lines 12 to 18). The device incorporates a tissue

penetrating member in the form of a needle 530 that will extend out of the catheter body 502 of the device so as to pass a suture thread 529 through the wall of the luminal anatomical structure within which the catheter body was introduced. This can be seen in Figures 23a to 23h.

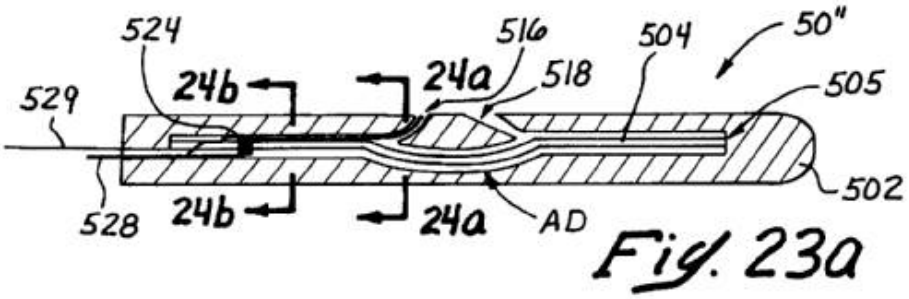
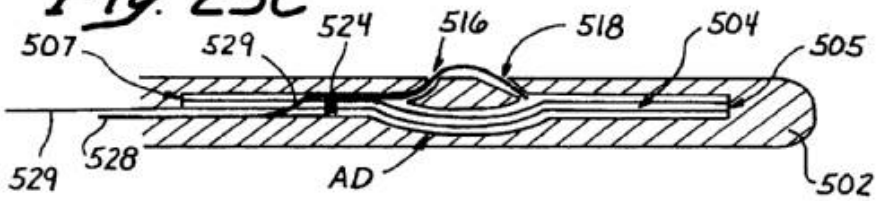


Fig. 23a

Fig. 23c



The end of the suture thread 529 is connected to the proximal end of the needle 530 (column 18, lines 20 to 24). The needle is a preformed curved needle, as can be seen in Figure 26, able to reenter the catheter through the lumen 518 after having passed through the tissue layer, as can be seen in Figure 23c.

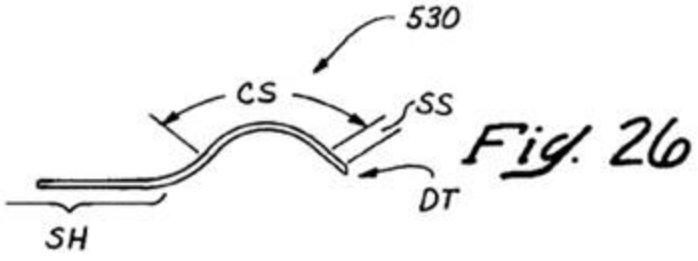


Fig. 26

The needle with its suture attached is moved within the catheter lumen with the aid of a needle advancing/ retracting member 520 comprising a clip 524 having two gripping arms 526a and 526b, as can be seen in Figure 25.

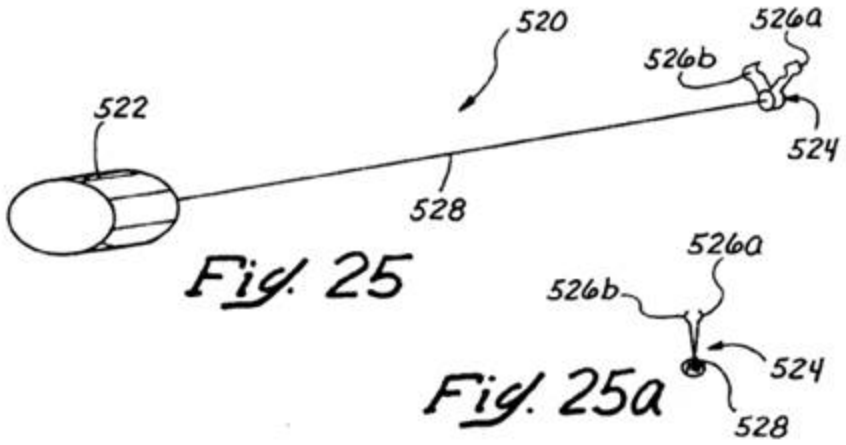


Fig. 25

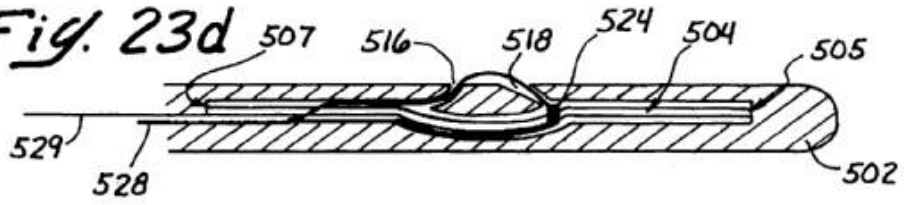
Fig. 25a

Notwistanding other differences, the Board agrees that P1 at least does not disclose the feature that the needle should have means to grasp and release a portion of the tissue fastener, here the suture.

As mentioned above the appellant/opponent considered this feature to be a simple and obvious alternative to connecting the suture using the needle mentioned in P1.

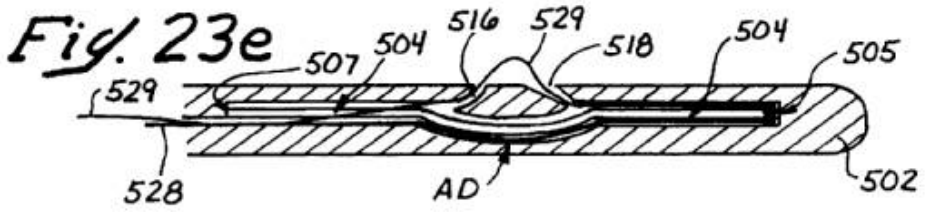
The Board does not share this opinion. As mentioned above and explained in more detail in column 18, line 25 to column 19, line 29 of P1, a stitch in the tissue layer is made by moving the needle forwards and then backwards using the needle advancing/retracting member 520 and its two gripping arms 526a and 526b. In a first phase, the needle is moved forwards until the distal end of the needle enters the lumen 518 of the catheter. After that the gripping arms are opened and the needle advancing/retracting member 520 is advanced to grip the needle distal end as shown in Figure 23d.

Fig. 23d



The needle advancing/retracting member 520 then advances the needle until the entire needle is back in the catheter, as can be seen in Figure 23e.

Fig. 23e



After that the needle is gripped at its proximal end and brought back to its starting point, as can be seen in Figures 23f to 23h.

Fig. 23f

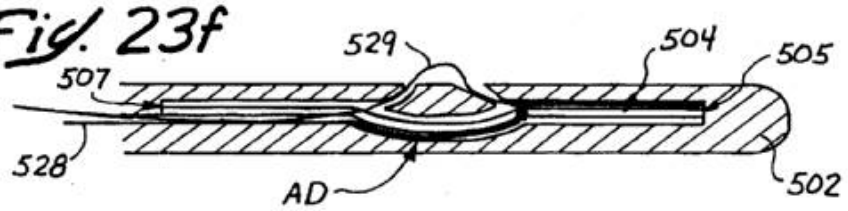


Fig. 23g

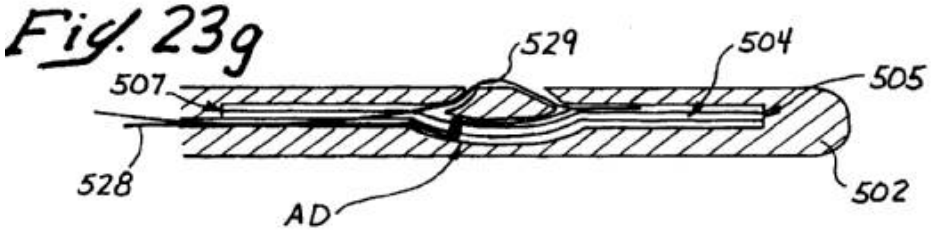
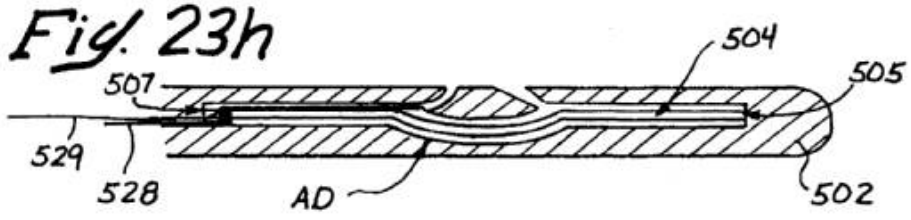


Fig. 23h



After that a new cycle can begin to make another stitch, if needed. In order to secure the stitch(es) an appropriate knot-pusher device of the type known in the art can be used (column 19, lines 30 to 37).

The Board fails to see for what reason, or put another way in order to solve what kind of problem, the person skilled in the art would wish to use a needle with grasping and releasing means in order to connect the needle in a releasable manner to the suture in the context of the device and method disclosed in P1. In this respect the appellant/opponent only presented the theoretical argument that such an option would be an obvious alternative to a fixed connection, without presenting any needle with grasping and releasing means which would be suitable for use in a device according to P1, and without presenting any document confirming its argument that this was general knowledge of the person skilled in the art. In the Board's opinion, the most usual way to deliver a suture for surgical stitching was with its needle permanently connected to it, which the appellant/opponent did not dispute. Indeed, it seems particularly important for the success of the stitching operation not to lose the suture during stitching. In addition, whether the device according to P1 might need any redesign to be able to be used with a needle having whatever kind of suture grasping and releasing means remains an open question, since no such suitable needle was presented.

Therefore, on the basis of the evidence and arguments presented by the appellant/opponent, the subject-matter of claim 1 of auxiliary request 2c is inventive pursuant to Article 56 EPC.

9. Examination on its own motion of claims 8 to 10.

Pursuant to point 19 of the reasons of G 9/91, it may be considered that the Board has a general obligation, also in the present case, to examine, on its own motion, any amemdment of the claims introduced during the opposition or appeal proceedings: "*In order to avoid any misunderstanding, it should finally be confirmed that in case of amendments of the claims or other parts of a patent in the course of opposition or appeal proceedings, such amendments are to be fully examined as to their compatibility with the requirements of the EPC (e.g. with regard to the provisions of Article 123(2) and (3) EPC).*"

The set of claims according to auxiliary request 2c also comprises independent claim 8 followed by dependent claims 9 and 10.

However, claims 8 to 10 strictly correspond to claims 5 to 7 of the granted patent. As explained above under point 3 there is no opposition proceedings open against these claims because they do not belong to the extent of the opposition as defined in the notice of opposition.

Since no opposition proceedings are open against these claims, the obligation under point 19 of G 9/91 is not applicable, with the Board having no power to examine these claims.

10. The appellant/opponent had no objection against the description and neither does the Board.

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:

   - claims 1 to 10 of auxiliary request 2c filed during the oral proceedings; and

   - description and figures of the patent as granted.

The Registrar: The Chairman:

D. Hampe E. Dufrasne

Decision electronically authenticated