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Case Number: T 0668/14 - 3.2.08

Application Number: 03772187.5

Publication Number: 1534183

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Title of invention:
FLEXIBLE AND CONFORMABLE STENT AND METHOD OF FORMING SAME

Patent Proprietor:
Unison Therapeutics, Inc.

Opponent:
Boston Scientific Scimed, Inc.

Headword:

Relevant legal provisions:
EPC Art. 123(2), 54
RPBA Art. 12(2), 12(4)

Keyword:
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Case Number: T 0668/14 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 9 March 2016

Appellant: (Patent Proprietor)	Unison Therapeutics, Inc. 919 Kifer Road Sunnyvale, CA 94086 (US)
Representative:	Roos, Peter Roospatent Bavariaring 20 80336 München (DE)
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Representative:	Vossius & Partner Patentanwälte Rechtsanwälte mbB Siebertstrasse 3 81675 München (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 22 January 2014 revoking European patent No. 1534183 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairwoman	P. Acton
Members:	M. Alvazzi Delfrate
	D. T. Keeling

Summary of Facts and Submissions

I. By its decision posted on 22 January 2014 the opposition division revoked European patent No.1534183.

The opposition division found that the requests which were admitted into the proceedings either related to subject-matter that lacked novelty (first auxiliary request then on file) or did not comply with the requirements of Article 123(2) and (3) EPC (second and third auxiliary requests then on file).

II. The appellant (patent proprietor) lodged an appeal against that decision in the prescribed form and within the prescribed time limit.

III. Oral proceedings before the Board of Appeal were held on 9 March 2016.

IV. The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or, in the alternative, in accordance with one of the auxiliary requests 1 to 7 filed with letter of 22 May 2014. Alternatively, it requested that the case be remitted to the opposition division for further prosecution.

The respondent (opponent) requested that the appeal be dismissed or that the case be remitted to the opposition division, should any of the appellant's requests be admitted into the proceedings and the issues of novelty and inventive step need to be discussed.

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

"1. A stent comprising:

a first radially expandable undulating ring (13-1) comprising a first apex and a second apex;

a second radially expandable undulating ring (13-2) comprising a third apex and a fourth apex longitudinally unaligned with respect to the first and second apices;

a mirrored pair of first and second arcuate flex members (12-1A, 12-1B) wherein the first flex member interconnects the first apex and the third apex, and the second arcuate flex member interconnects the second apex and the fourth apex, wherein apices of the first and second radially expandable undulating rings that are longitudinally aligned point in the same direction."

Claim 1 of **auxiliary request 1** reads as follows (differences with respect to claim 1 as granted emphasised):

"1. A stent comprising:

a first radially expandable undulating ring (13-1) comprising a first apex and a second apex;

a second radially expandable undulating ring (13-2) comprising a third apex and a fourth apex longitudinally unaligned with respect to the first and second apices;

a mirrored pair of adjacent first and second arcuate flex members (12-1A, 12-1B) wherein the first flex member interconnects the first apex and the third apex, and the second arcuate flex member interconnects the second apex and the fourth apex, wherein apices of the first and second radially expandable undulating rings

that are longitudinally aligned point in the same direction."

Claim 1 of **auxiliary request 2** differs from claim 1 of the main request by the addition of the wording:

"and wherein each of the arcuate flex members (12-1A, 12-1B) is not directly connected to adjacent arcuate flex members (12-1A, 12-1B)."

Claim 1 of **auxiliary request 3** reads as follows (differences with respect to claim 1 as granted emphasised):

"1. A stent comprising:

a first radially expandable undulating ring (13-1) comprising a first apex and a second apex;

a second radially expandable undulating ring (13-2) comprising a third apex and a fourth apex longitudinally unaligned with respect to the first and second apices;

a mirrored pair of adjacent first and second arcuate flex members (12-1A, 12-1B) wherein the first arcuate flex member (12-1A) interconnects the first apex and the third apex, and the second arcuate flex member (12-1B) interconnects the second apex and the fourth apex, wherein apices of the first and second radially expandable undulating rings (13-1,13-2) that are longitudinally aligned point in the same direction, wherein the mirroring of the first and second arcuate flex members (12-1A, 12-1B) creates an enclosed cell boundary made up of the first and second arcuate flex members (12-1A, 12-1B) and portions of the first and

second radially expandable undulating rings (13-1, 13-2)."

Claim 1 of **auxiliary request 4** reads as follows (differences with respect to claim 1 as granted emphasised):

"1. A stent comprising:

a first radially expandable undulating ring (13-1) comprising a first apex and a second apex;

a second radially expandable undulating ring (13-2) comprising a third apex and a fourth apex longitudinally unaligned with respect to the first and second apices;

a mirrored pair of first and second adjacent arcuate flex members (12-1A, 12-1B) wherein the first arcuate flex member (12-1A) interconnects the first apex and the third apex, and the second arcuate flex member (12-1B) interconnects the second apex and the fourth apex, wherein apices of the first and second radially expandable undulating rings (13-1,13-2) that are longitudinally aligned point in the same direction, wherein the mirroring of the first and second arcuate flex members (12-1A, 12-1B) results in a closed unit cell, wherein material defining the boundaries of the closed unit cell is made up of portions of the first and second arcuate flex members (12-1A, 12-1B) as well as portions of strut material from the two adjacent radially expandable undulating rings (13-1, 13-2)."

Claim 1 of **auxiliary request 5** reads as follows (differences with respect to claim 1 as granted emphasised):

"1. A stent comprising:
a plurality of radially expandable undulating rings (13) comprising first and second adjacent radially expandable undulating rings (13-1, 13-2);
the first radially expandable undulating ring (13-1) comprising a first apex and a second apex;
the second radially expandable undulating ring (13-2) comprising a third apex and a fourth apex longitudinally unaligned with respect to the first and second apices;
a plurality of link rings interconnecting the plurality of radially expandable undulating rings (13-1 to 13-7);
wherein each link ring is formed by arcuate flex members (12) placed around the circumference, wherein each arcuate flex member (12) contacts adjacent radially expandable undulating rings (13-1, 13-2) on circumferentially different longitudinal lines and is not directly connected to adjacent arcuate flex members (12),
wherein the plurality of link rings and the plurality of radially expandable undulating rings (13) have the same longitudinal spatial frequency,
wherein adjacent first and second arcuate flex members (12-1A and 12-1B) of the link ring (12-1) interconnecting the first and second adjacent radially expandable undulating rings (13-1, 13-2) are mirrored,
wherein the first arcuate flex member (12-1A) interconnects the first apex and the third apex, and the second arcuate flex member (12-1 B) interconnects the second apex and the fourth apex,
and wherein apices of the first and second radially expandable undulating rings (13-1, 13-2) that are longitudinally aligned point in the same direction."

Claim 1 of **auxiliary request 6** reads as follows (differences with respect to claim 1 as granted emphasised):

"1. A stent comprising:
a plurality of radially expandable undulating rings (13) comprising first and second adjacent radially expandable undulating rings (13-1, 13-2);
the first radially expandable undulating ring (13-1) comprising a first apex and a second apex;
the second radially expandable undulating ring (13-2) comprising a third apex and a fourth apex longitudinally unaligned with respect to the first and second apices;
a plurality of link rings interconnecting the plurality of radially expandable undulating rings (13-1 to 13-7);
wherein each link ring is formed by arcuate flex members (12) placed around the circumference, wherein each arcuate flex member (12) contacts adjacent radially expandable undulating rings (13-1, 13-2) on circumferentially different longitudinal lines and is not directly connected to adjacent arcuate flex members (12),
wherein the plurality of link rings and the plurality of radially expandable undulating rings (13) have the same longitudinal spatial frequency,
wherein adjacent first and second arcuate flex members (12-1 A and 12-1B) of the link ring (12-1) interconnecting the first and second adjacent radially expandable undulating rings (13-1, 13-2) are mirrored,
wherein the first arcuate flex member (12-1A) interconnects the first apex and the third apex, and the second arcuate flex member (12-1 B) interconnects the second apex and the fourth apex,
and wherein apices of the first and second radially expandable undulating rings (13-1, 13-2) that are longitudinally aligned point in the same direction."

Claim 1 of **auxiliary request 7** reads as follows (differences with respect to claim 1 as granted emphasised):

"1. A stent comprising:
a first radially expandable undulating ring (13-1) comprising a first apex and a second apex;
a second radially expandable undulating ring (13-2) comprising a third apex and a fourth apex longitudinally unaligned with respect to the first and second apices;
a mirrored pair of first and second arcuate flex members (12-1A, 12-1 B) wherein the first arcuate flex member (12-1A) interconnects the first apex and the third apex, and the second arcuate flex member (12-1 B) interconnects the second apex and the fourth apex,
wherein apices of the first and second radially expandable undulating rings (13-1, 13-2) that are longitudinally aligned point in the same direction,
wherein the first radially expandable undulating ring (13-1) comprises more than one complete sinusoidal cycle which is coupled to the first and second adjacent arcuate flex members (12-1A, 12-1 B), and wherein the second radially expandable undulating ring (13-2) comprises less than one complete sinusoidal cycle which is coupled to the first and second adjacent arcuate flex members (12-1A, 12-1 B)."

VI. The following documents played a role for the present decision:

D1: WO -A- 01/89414;
D2: WO -A- 00/71053;
D3: WO -A- 02/056795; and
D4: US -B- 6,375,677.

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

Admission of the requests into the proceedings

All the requests were submitted together with the statement of grounds of appeal. It was true that none of the requests was the subject of the appealed decision. However, as established by the opposition division, the first auxiliary request underlying the appealed decision was basically the same as the granted patent, i.e. the present main request. As to the present auxiliary requests, they all related in essence to the same feature, namely the arrangement of the flex members, although worded in different ways. Hence, all the requests were to be admitted into the proceedings.

First auxiliary request - Novelty

D1 disclosed in Figure 1 a stent with radially expandable undulating rings connected by arcuate flex members. However, the arcuate flex members of Figure 1 were neither adjacent nor mirrored. They were not adjacent because they were spaced away from each other. As to the feature of the members being mirrored, it was neither shown in Figure 1 nor disclosed in the description. Also the passage on page 3, which referred to "gegensinnig" S-shaped flex members did not mean that they were mirrored but merely that they had a different orientation. Indeed mirrored flex members would not be compatible with the helical structure formed by the flex members in Figure 1. Therefore, the subject-matter of claim 1 was novel over D1.

Neither Figure 12 nor Figure 13 of D2 disclosed an embodiment with all the features of claim 1. D2 did not

disclose either to use the mirrored flex members of Figure 12 in the embodiment of Figure 13. Hence, the subject-matter of claim 1 was also novel over D2.

It could be considered that D3 disclosed in Figure 2 a stent with a first radially expandable undulating ring comprising a first apex and a second apex and a second radially expandable undulating ring comprising a third apex and a fourth apex, wherein a mirrored pair of arcuate flex members connected the first apex together with the third and the second apex together with the fourth. However, those flex members were not adjacent because they were separated by other flex members. Therefore, D3 was also not detrimental to the novelty of the subject-matter of claim 1.

A similar analysis applied in respect of Figure 1 of D4. Also in this case the mirrored elements connecting four different apices of the rings could not be considered to be adjacent. Therefore, D4 was not novelty-destroying either.

First auxiliary request - Article 123(2) EPC

Claim 1 was based on claims 15 and 24 as originally filed. In both present claim 1 and original claim 24 the stent comprised longitudinally aligned apices. Said aligned apices were arranged in-phase. Moreover, the term "pointed" used in original claim 24 had the same meaning of the term "point" in present claim 1, i.e. it defined an orientation and not a shape, as was apparent also from the drawings.

As to the term "adjacent" in connection with the flex members, it was disclosed in the application as filed in paragraphs [0013] and [0015] and, in particular, at the

end of paragraph [0041]. The closed unit cell also mentioned in paragraph [0041] was not an additional feature but merely the result of the mirroring of the adjacent flex members. The minimum distance to the material defining the boundaries of the cell was not a further limiting feature either, but something that always existed in a closed cell. As to the fact that Figure 1a showed six flex members on the same circumference, the application as originally filed disclosed that the number of flex members could be varied (paragraph [0022]). Indeed the application as originally filed concerned only stents with adjacent mirrored flex members. Accordingly, the introduction of the term "adjacent" in claim 1 did not represent an unallowable intermediate generalisation.

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

Admission of the requests into the proceedings

The main request corresponded to the maintenance of the patent as granted, i.e. a version of the patent that was not defended in opposition proceedings. Of the requests underlying the appealed decision the first auxiliary request was the one closest to the patent as granted. However, it was more limited in scope by virtue of several amendments, such as the addition of the feature that the pair of of mirrored arcuate flex members were "adjacent". Hence, the main request was not to be admitted into the proceedings.

The present auxiliary requests were not to be admitted either, since none of them was considered in the decision under appeal and they were all divergent. Moreover, the second auxiliary request was also similar

to the first auxiliary request of 8 November 2013, which was withdrawn during the opposition proceedings.

Request to remit the case to consider novelty

If any request was to be admitted into the proceedings and the issue of novelty had to be discussed the case should be remitted to the opposition division because the decision under appeal did not deal with the novelty of these particular requests.

First auxiliary request - Novelty

Figure 1 of D1 showed a stent with all the features of claim 1, save for the fact that the flex members were not mirrored. Indeed, the flex members of Figure 1 were adjacent, because nothing separated them, but not mirrored, since they were oriented in the same way. However, the description disclosed on page 3 that the S-shaped flex members could have different orientations, i.e. be mirrored. This applied also to the embodiment of Figure 1. Therefore, the subject-matter of claim 1 was not novel over D1.

It was true that neither Figure 12 nor Figure 13 of D2 disclosed a stent with all the features of claim 1. However, it was apparent to the person skilled in the art that the mirrored pair of arcuate flex members of Figure 12 were to be used also for the embodiment of Figure 13. Therefore, an embodiment with all the features of claim 1 was also disclosed in D2.

D3 also disclosed, in Figure 2, a stent with all the features of claim 1. It was true that the mirrored arcuate flex members which, as foreseen by claim 1, connected four different apices of the undulating ring,

were separated by other elements. However, they could still be considered to be adjacent. Hence, D3 also took away the novelty of the subject-matter of claim 1.

In respect of D4 reference was made to the written submissions. There it was argued that considerations similar to those made for D3 applied also to Figure 1 of D4, which thus disclosed a stent with all the features of claim 1.

First auxiliary request - Article 123(2) EPC

Claim 1 was not based on originally filed claims 15 and 24. The latter required the presence of longitudinally aligned apices and hence an in-phase arrangement. By contrast, present claim 1 did not require that longitudinally aligned apices were present. Merely in that case it excluded an out-of phase arrangement.

Moreover, original claim 24 used the term "pointed" in relation to the apices. This term, which appeared also on page 8, lines 16-17 defined a shape, while the term "point" in claim 1 defined an orientation. Therefore, also in this respect the meaning of the claim had been changed.

Finally, the introduction of the term "adjacent" in connection with the flex members represented an unallowable intermediate generalisation. It was true that this term was disclosed in paragraphs [0013] and [0015] and at the end of paragraph [0041]. However, this disclosure was linked with other feature which were not comprised in the claim. In particular, paragraph [0041] stated that the mirroring of the flex members resulted in a closed unit cell, where the material defining the boundaries of the cell was made up of portions of the

flex members as well as portions of the strut materials from two adjacent undulating expansion rings. Moreover, any location within a cell had a minimum distance to the material defining the boundaries of the cell. Finally Figure 1a, which was described in paragraph [0041], showed a stent with six flex members on the same circumference, while claim 1 did not stipulate the number of the flex members. All these features were not present in claim 1.

Therefore, claim 1 comprised subject-matter which extended beyond the content of the application as originally filed.

Reasons for the Decision

1. Admission of the main and the auxiliary requests into the proceedings

1.1 All the requests were submitted together with the statement of grounds of appeal, in compliance with Article 12(2) RPBA. However, none of them was the object of the decision of the opposition division. Since it is undisputed that the appellant could have submitted them for decision to the opposition division, the Board has the power, under Article 12(4) RPBA, to hold them inadmissible.

1.2 The main request corresponds to the maintenance of the patent as granted. During the opposition proceedings the patent proprietor chose not to defend this version of the patent but rather sought the maintenance of the patent in a more limited scope.

In particular the first auxiliary request underlying the appealed decision, which undisputedly is the request considered in that decision coming closest to the patent as granted, was more limited in scope, since it stipulated that the pair of mirrored arcuate flex members are "adjacent", a feature that is not present in claim 1 as granted. This finding is not changed by the fact that the opposition division stated in the appealed decision, point 15.3.3, that the scope of said first auxiliary request was the same as that of the patent as granted. Indeed this statement was made in the context of an evaluation of another amendment (the change from "point in a direction" to "being pointed in a direction") and did not consider at all the feature relating to the "adjacent" flex members.

The choice of the patent proprietor to replace the patent as granted with versions of more limited scope actively prevented the opposition division from taking a decision on the granted patent, which had been attacked in the notice of opposition. Re-admitting this request at this stage of the proceedings would run contrary to the primary function of the appeal proceedings, which is to review the decision of the opposition division.

Under these circumstances the Board decided not to admit the main request into the proceedings.

1.3 The situation in respect of the auxiliary requests is different because none of them was submitted and then withdrawn during the opposition proceedings. This applies also to the second auxiliary request, since this request is, although somewhat similar, not identical with the first auxiliary request of 8 November 2013.

It is true that the auxiliary requests are not convergent in the sense that not each lower-ranking request comprises exactly all the features of the higher-ranking requests. However, these requests do not point in completely different directions because they all relate, like the requests underlying the claimed decision, to the same aspect of the claimed invention, namely the arrangement of the arcuate flex members and their relationship with the undulating rings. The fact that this aspect is dealt with by limiting the claim with different wordings is, in the Board's view, justified by the number of different attacks raised against the claimed invention based on different ways of interpreting the wording of the claim.

In view of these considerations and of the circumstance that all the requests were submitted at the earliest possible stage of the appeal proceedings (with the grounds of appeal) the Board decided to admit all the auxiliary requests into the proceedings.

2. Request to remit the case to consider novelty

The respondent had requested to remit the case to the opposition division for the examination of novelty. However, novelty as a ground of opposition was already dealt with by the opposition division in the decision under appeal. Moreover, as already mentioned above, the features added by the first auxiliary request relate to an aspect which was already addressed, albeit with slightly different wording, by the auxiliary requests underlying the appealed decision. Under these circumstances the Board sees no reason to remit the case to the opposition division for examination of novelty.

3. First auxiliary request - Novelty

3.1 Novelty of the first auxiliary request has been disputed for the subject-matter of claim 1 in view of each of the documents D1, D2, D3 and D4.

3.2 Figure 1 of D1 undisputedly discloses a stent with a first radially expandable undulating ring (24) comprising a first apex and a second apex and a second radially expandable undulating ring (24) comprising a third apex and a fourth apex longitudinally unaligned with respect to the first and second apices. The stent further comprises a pair of first and second arcuate flex members (20) wherein the first flex member interconnects the first apex and the third apex, and the second arcuate flex member interconnects the second apex and the fourth apex. The apices of the first and second radially expandable undulating rings that are longitudinally aligned point in the same direction.

Even if the arcuate flex members are spaced apart from each other (there are only two of them on a circumference), they can be considered to be "adjacent", since nothing is interposed between them.

The arcuate flex members shown in Figure 1 are not mirrored. The respondent did not dispute it but referred to the passage on page 3 (lines 8-11 and lines 26-30), disclosing that the arcuate flex members ("S-förmigen Biegeelemente") can be arranged equidirectionally ("gleichsinnig") or opposite directionally ("gegensinnig"). However, quite apart from the question whether the opposite directional arrangement disclosed in the passage on page 3 is to be applied in the particular embodiment of Figure 1 (D1 discloses for instance also embodiments wherein the apices connected

by flex members are aligned, see Figures 3e) and 3f)), it is a matter of fact that D1 does not provide any detail as to what is an opposite directional ("gegensinnig") arrangement. While this arrangement clearly requires that the S-shaped flex members are oriented in a different way, it does not necessarily imply that they are "mirrored". For instance one S may be reversed in its orientation in respect of its own longitudinal axis of symmetry instead of with respect to the longitudinal axis of the stent. This would result in a "gegensinnig" arrangement of the two members without them being "mirrored". Therefore, mirrored arcuate flex members as stipulated by claim 1 are not clearly and directly derivable from D1.

3.3 In respect of D2 the respondent made reference to Figures 12 and 13.

Figure 12 shows an embodiment representing a stent comprising a first radially expandable undulating ring (2) comprising a first apex and a second apex and a second radially expandable undulating ring (3) comprising a third apex and a fourth apex. The first apex and the third apex are connected by a first arcuate flex member (26) and the second apex and the fourth apex are connected by a second arcuate flex member (26), wherein the arcuate flex members are a mirrored pair of adjacent arcuate flex members. However, in contrast to what is required by claim 1, the third apex and the fourth apex are longitudinally aligned with respect to the first and second apices. Moreover, the apices of the first and second radially expandable undulating rings that are longitudinally aligned do not point in the same direction but rather in opposite directions.

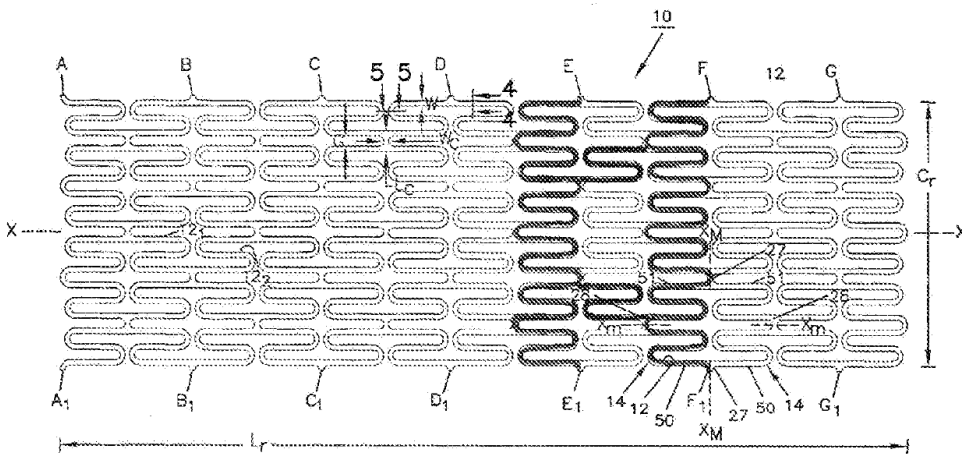
Figure 13 by contrast shows an embodiment representing a stent comprising a first radially expandable undulating ring (2) comprising a first apex and a second apex and a second radially expandable undulating ring (3) comprising a third apex and a fourth apex longitudinally unaligned with respect to the first and second apices. The stent comprises a pair of adjacent first and second arcuate flex members (20), wherein the first flex member interconnects the first apex and the third apex and the second arcuate flex member interconnects the second apex and the fourth apex. The apices of the first and second radially expandable undulating rings that are longitudinally aligned point in the same direction. However, the arcuate flex members are not mirrored.

Therefore, neither Figure 12 nor Figure 13 depicts an embodiment with all the features of claim 1. The respondent did not dispute that, but argued that the person skilled in the art would have understood that the mirrored flex members of Figure 12 were to be used also for the embodiment of Figure 13. However, D2 does not provide a clear and unambiguous disclosure in that sense, especially in view of the fact that such a measure would disrupt the helical structure formed by the arcuate members and the rings in Figure 13.

Therefore, D2 does not disclose a stent with all the features of claim 1.

3.4 Document D3 discloses in Figure 2 (reproduced hereafter with the relevant elements highlighted) a stent with a first radially expandable undulating ring (left dark ring) comprising a first apex (third apex from top in left dark ring) and a second apex (third apex from bottom in left dark ring) and a second radially expandable undulating ring (right dark ring) comprising

a third apex (second apex from top in right dark ring) and a fourth apex (second apex from bottom in right dark ring) longitudinally unaligned with respect to the first and second apices. The first and second radially expandable undulating rings are disposed such that longitudinally aligned apices in each of the first and second radially expandable undulating rings point in the same direction. Moreover, a first flex member interconnects the first apex and the third apex (upper dark connection between left and right dark rings) and a second arcuate flex member interconnects the second apex and the fourth apex (lower dark connection between left and right dark rings). Said first and second flex members constitute a mirrored pair of first and second arcuate flex members.



However, said mirrored arcuate flex members (highlighted in the drawing), which connect four different apices as required by claim 1, are not only spaced away from each other but also separated by other arcuate flex members that also connect the two rings. Hence, they cannot be considered to be "adjacent", since such an arrangement excludes the presence of other elements of the same nature between the two "adjacent" elements. Therefore,

D3 does not disclose a stent with all the features of claim 1 either.

3.5 A similar analysis applies in respect of D4 (Figure 1), since also in this case the mirrored flex members connecting four different apices of the rings cannot be considered to be adjacent.

3.6 Since none of the documents D1 to D4 discloses all the features of claim 1 in combination, its subject-matter is new.

4. First auxiliary request - Article 123(2) EPC

4.1 Claim 1 is mainly based on claims 15 and 24 as originally filed. According to originally filed claim 24 "adjacent first and second radially expandable undulating struts are disposed such that longitually [sic] aligned apices in each of the first and second radially expandable undulating rings are pointed in the same direction". In present claim 1 of the first auxiliary request this wording has been amended to state that "apices of the first and second radially expandable undulating rings that are longitudinally aligned point in the same direction".

4.1.1 The respondent submitted that the wording of original claim 24 required an in-phase arrangement, because it stipulated the presence of longitudinally aligned apices, while present claim 1 did not comprise this feature because it did not require the presence of longitudinally aligned apices.

However, claim 1 of the first auxiliary request does not comprise any conditional clause defining a condition to be applied if longitudinally aligned apices are present.

Rather the claim states that apices "that are longitudinally aligned" point in the same direction. Hence, contrary to the respondent's view, it is clear from the claim's wording that the stent, like that of original claim 24, comprises longitudinally aligned apices.

4.1.2 It is true that the wording "are pointed in the same direction", as used in original claim 24 in connection with those longitudinally aligned apices, may define a shape, tapering to or ending in a point in a given direction. However, it may also define an orientation, in the sense of directed or aimed to a certain direction. Indeed, the drawings show aligned apices which do not have a pointed shape but are oriented in the same direction. This clearly indicates that in original claim 1 the second interpretation of "pointed" to define an orientation is, albeit possibly not exclusively, intended. The fact that the term "pointed" is also used in connection with a shape on page 8, lines 16-17 ("The end section of each "U" can be curved, flat, angled, pointed or any other appropriate shape") does not change this finding.

4.1.3 Therefore, the feature that "apices of the first and second radially expandable undulating rings that are longitudinally aligned point in the same direction" is disclosed in the application as originally filed.

4.2 Moreover, the claim has also been amended to specify that the a mirrored pair of first and second arcuate flex members is a pair of "adjacent" flex members.

4.2.1 In the originally filed application only embodiments comprising adjacent mirrored flex members are shown, with a purely hypothetical embodiment with only non-

adjacent flex members being nowhere disclosed. Moreover, the description explicitly uses the term "adjacent" in connection with the flex members (also referred to as "links") in paragraphs [0013] and [0015] and at the end of paragraph [0041]. In particular, in the latter passage it is stated that, as a feature of the invention, adjacent pairs of arcuate flex members such as flex members 12-1A and 12-1B are mirrored.

4.2.2 It is true that the passage in paragraph [0041] goes on to state that the mirroring of the flex members results in a closed unit cell, where the material defining the boundaries of the cell is made up of portions of the flex members as well as portions of the strut materials from two adjacent undulating expansion rings. However, this statement does not introduce any additional information but merely recites the consequence ("results in") of the mirroring of the adjacent flex members.

4.2.3 As to the sentence at the end of paragraph [0041] according to which any location within a cell has a minimum distance to the material defining the boundaries of the cell, this sentence does not define any limiting feature whatsoever, because such a minimum distance always exists and no value is defined for it.

4.2.4 It is also true that Figure 1a, which is described in paragraph [0041], shows a stent with six flex members on the same circumference, while claim 1 does not stipulate the number of the flex members, but for the fact that there is provided a pair of them. However, the application as originally filed discloses that the number of flex members can be varied (paragraph [0022]). Hence, it discloses that different numbers of flex members can be contemplated for the different embodiments of the stent. Hence, it is clear that there

is no structural or functional link between the feature of the adjacent mirrored flex members and the number of said flex members in Figure 1a.

4.2.5 Accordingly, contrary to the view of the respondent, no unallowable intermediate generalisation can be seen in respect of the introduction of the term "adjacent".

4.3 Therefore, claim 1 has not been amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.

5. The decision under appeal dealt solely with the issues of added subject-matter and novelty, while the ground of opposition of lack of inventive step, which was also raised in the notice of opposition, was not decided upon. Under these circumstances the Board considers it appropriate to remit the case to the opposition division for further prosecution to consider the latter issue.

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 Claims 1 to 25 of the First Auxiliary Request, as filed with the grounds of appeal.

The Registrar: The Chairwoman:

C. Moser P. Acton

Decision electronically authenticated