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**Datasheet for the decision
of 14 May 2019**

Case Number: T 1461/14 - 3.2.02

Application Number: 10009127.1

Publication Number: 2263562

IPC: A61B17/072

Language of the proceedings: EN

Title of invention:

Tool assembly for a surgical stapling device

Patent Proprietor:

Covidien LP

Opponent:

ETHICON ENDO-SURGERY, INC.

Headword:

Relevant legal provisions:

EPC Art. 56, 76(1), 83, 100(c), 123(2)

Keyword:

Divisional application - subject-matter extends beyond content
of earlier application - main request (yes),
auxiliary request 1 (no)
Amendments - extension beyond the content of the application
as filed - auxiliary request 1 (no)
Sufficiency of disclosure - auxiliary request 1 (yes)
Inventive step - auxiliary request 1 (yes)

Decisions cited:

G 0002/10, T 0133/85, T 0331/87, T 0770/90, T 0663/16

Catchword:



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Case Number: T 1461/14 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 14 May 2019

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
22 April 2014 concerning the maintenance of
European Patent No. 2263562 in amended form**

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, despatched on 22 April 2014, that account being taken of the amendments made by the patent proprietor according to the main request, European patent No. 2 263 562 and the invention to which it related met the requirements of the EPC.
- II. The patent is derived from a divisional application of European patent application No. 09 013 099.8, which is itself a divisional of European patent application No. 03 773 180.9. The latter application as originally filed is referred to as "the first original application" in the following. The application as originally filed from which the patent is derived is referred to as "the original application" in the following.
- III. The present case is related to the case underlying decision T 663/16, claiming priority from the first original application.
- IV. Notice of appeal was filed on 1 July 2014. The appeal fee was paid the same day. A statement setting out the grounds of appeal was received on 2 September 2014.
- V. The Board summoned the parties to oral proceedings and provided its provisional opinion in a communication of 25 January 2019.
- VI. By letter dated 13 May 2019, the respondent objected to Mr Husband's involvement in the case as professional representative for the appellant.

- VII. Oral proceedings took place on 14 May 2019.
- VIII. The appellant requested that the decision under appeal be set aside and that the patent be revoked.
- IX. The respondent requested that the appeal be dismissed or, in the alternative, that the decision under appeal be set aside and that the patent be maintained on the basis of one of auxiliary requests 1 and 2, both filed with letter dated 3 December 2014. The objection to Mr Husband's involvement in the case was withdrawn.
- X. The following documents are mentioned in the present decision:

E1: US-A-2002/0143346;
E2: US-A-5,865,361;
E4: US-A-5,485,952;
E5: EP-A-0 741 996;
E6: US-A-5,312,023.

- XI. **Claim 19 of the first original application** reads as follows:

"A tool assembly for use with a surgical stapler comprising:

an anvil;

a cartridge assembly having at least one staple, the cartridge assembly being movable in relation to the anvil between spaced and approximated positions;

a clamp member positioned adjacent a proximal end of the tool assembly, the clamp member being movable from a retracted position to an advanced position to move the anvil and the cartridge assembly to the approximated position; and

a dynamic damping member positioned within the tool assembly and movable from a retracted position through the tool assembly to an advanced position to eject staples from the cartridge assembly, the dynamic damping member including an upper flange portion engaging a surface of the anvil and a lower flange portion engaging a surface of the cartridge assembly, at least one of the upper and lower flange portions having an arcuate cross-section along an axis transverse to the longitudinal axis of the cartridge assembly."

Claim 1 of the main request reads as follows:

"A surgical stapling device (10) for use with a surgical stapler comprising:

a tool assembly including an anvil (14) and a cartridge assembly (16) having at least one staple, the cartridge assembly being movable in relation to the anvil between spaced and approximated positions;

a clamp member (20) positioned adjacent a proximal end of the tool assembly, the clamp member being movable from a retracted position to an advanced position to move the anvil and the cartridge assembly to the approximated position and to prevent the gap between the proximal portions of the anvil and the cartridge assembly from exceeding a predetermined distance;

a dynamic clamping member (32) positioned and movable from a retracted position to an advanced position to move the anvil and the cartridge assembly to the approximated position and to eject staples from the cartridge assembly, the dynamic clamping member including an upper flange portion (36a) engaging a surface of the anvil and a lower flange portion (36b)

engaging a surface of the cartridge assembly (16), at least one of the upper (36a) and lower (36b) flange portions having an arcuate cross-section along an axis transverse to a longitudinal axis of the cartridge assembly (16)."

Claim 1 of auxiliary request 1 reads as follows (amendments over the main request highlighted by the Board):

"A surgical stapling device (10) for use with a surgical stapler comprising:

a tool assembly including an anvil (14) and a cartridge assembly (16) having at least one staple, the cartridge assembly being movable in relation to the anvil between spaced and approximated positions;

a clamp member (20) positioned adjacent a proximal end of the tool assembly, the clamp member being movable from a retracted position to an advanced position to move the anvil and the cartridge assembly to the approximated position and to prevent the gap between the proximal portions of the anvil and the cartridge assembly from exceeding a predetermined distance;

a dynamic clamping member (32) positioned within the tool assembly and movable from a retracted position through the tool assembly to an advanced position to move the anvil and the cartridge assembly to the approximated position and to eject staples from the cartridge assembly, the dynamic clamping member including an upper flange portion (36a) engaging a surface of the anvil and a lower flange portion (36b) engaging a surface of the cartridge assembly (16), at least one of the upper (36a) and lower (36b) flange portions having an arcuate cross-section along an axis

transverse to a longitudinal axis of the cartridge assembly (16)."

Claims 2 to 8 are dependent claims.

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

Main request - Added subject-matter

Claim 1 of the main request differed from claim 19 of the first original application by the omission of the requirement for the dynamic clamping member to be positioned within the tool assembly and movable through the tool assembly. Since these omitted features were essential to the invention, claim 1 added subject-matter.

Auxiliary request 1 - Added subject-matter

A clamp member movable to approximate the anvil and the cartridge assembly was only found in claim 1 and page 2 of the original application and claim 19 of the first original application. However, there was no disclosure of such a clamp member in the description or drawings of either of those applications. Hence, their claims were not supported by the description. It followed that the description was not a suitable "reservoir" for amendments, as held in decisions T 770/90 and T 133/85. More specifically, as explained on page 11, lines 11 to 14 of both applications, it was the movement of a dynamic clamping member that approximated the anvil and the cartridge assembly. Page 11, lines 14 to 18 made clear that a clamp member in the form of a clamp ring simply followed the dynamic clamping member. The way the clamp ring and the dynamic clamping member moved

was shown in Figure 11 of both applications, which confirmed that the clamp ring did not play any part in the approximation. The combination of a clamp member movable to approximate the anvil and the cartridge assembly with features such as the clamp member being movable to prevent the gap between the proximal portions of the anvil and the cartridge assembly from exceeding a predetermined distance, taken from the description of an instrument where the dynamic clamping member alone affected approximation, created at least an ambiguity in the mind of the skilled person. Hence, that combination could not be directly and unambiguously derivable from the original application or the first original application, which resulted in added subject-matter.

The only original disclosure of a clamp member providing the function of preventing the gap between the proximal portions of the anvil and the cartridge assembly from exceeding a predetermined distance was with respect to a clamp ring that encircled the proximal portions of the anvil and the cartridge assembly in the advanced position. Page 11 and Figures 7 to 9 of the first original application disclosed a specific embodiment with the clamp ring. Although page 9, line 20 could imply that a clamp member per se could take many different shapes, there was no direct and unambiguous disclosure of any other shape of a clamp member providing that function. A generic clamp member not in the form of a ring would not even work. Hence, the omission of the definition of the clamp ring in claim 1 added subject-matter.

There was no original disclosure of a general advanced position in which the dynamic clamping member moved the anvil and the cartridge assembly to the approximated

position and ejected staples from the cartridge assembly, and in which the clamp member approximated the anvil and the cartridge assembly. Page 11, lines 11 to 14 and 21 to 23 of the first original application disclosed that the dynamic clamping member was moved to a first advanced position to perform the approximation and then to a second advanced position to eject staples. The presence of broad wording for an advanced position in claim 1 as originally filed did not justify the retention of that wording in claim 1 of auxiliary request 1, since new features had been added to the claim. It followed that claim 1 represented an intermediate generalisation, since there was no basis for the claimed single stage movement which caused the approximation and the ejection of staples. Furthermore, the description only provided a basis for the clamp member and the dynamic clamping member being moved together from a retracted position to a first advanced position. There was no basis for the separation of the two members in their initial advancement to the first position, which was covered by claim 1.

A further reason why claim 1 of auxiliary request 1 added subject-matter was that it constituted an intermediate generalisation of the embodiment originally disclosed, since it did not specify that the clamp ring was proximal of the dynamic clamping member, that the first advanced position of the clamp ring was the same as the first advanced position of the dynamic clamping member, and that the clamp ring and the dynamic clamping member were first moved together then the dynamic clamping member was moved alone. These features, without which the claim covered embodiments that were not disclosed in the first original application, were essential for the described embodiment to work.

Auxiliary request 1 - Insufficiency of disclosure

Without inventive effort, the skilled person could not make a device according to claim 1, in which the clamp member or both the clamp member and the dynamic clamping member moved the anvil and the cartridge assembly into an approximated position, as the only device disclosed in the patent was one in which the dynamic clamping member, being distal of the clamp member, approximated the jaws alone. The subject-matter of claim 1 of auxiliary request 1 was therefore insufficiently disclosed in the patent.

Auxiliary request 1 - Lack of inventive step

The subject-matter of claim 1 lacked inventive step by virtue of lack of novelty over E1. In particular, E1 disclosed a surgical stapler with a C-shaped clamping member 60 (paragraphs [0040] and [0041], and Figures 16 to 18) which comprised two parts corresponding to the clamp member and the dynamic clamping member as claimed. According to the patent, the clamp member and the dynamic clamping member moved together. It followed that they could be parts of the same element.

The subject-matter of claim 1 lacked inventive step when starting from E1 as the closest prior art. The surgical stapler disclosed in E1 comprised, in particular, an I-beam 70, shown in Figures 13 to 15, which corresponded to the dynamic clamping member as claimed. In use, both a clamping member and the I-beam could be moved to cause a fine approximation of the jaws of the surgical stapler while tissue was trapped between them (paragraph [0035] and claims 6 and 13). It would have been obvious to the skilled person to

provide the I-beam with arcuate flanges as claimed.

The subject-matter of claim 1 also lacked inventive step when starting from E2 as the closest prior art. E2 disclosed a surgical stapling device comprising all the features of claim 1 except a clamp member for moving the anvil and the cartridge assembly to the approximated position. The problem to be solved by this distinguishing feature was how to provide gross approximation followed by fine approximation performed using a dynamic clamping member. That problem was solved by E1, which disclosed in paragraph [0035] that the jaws of a surgical stapling device were first grossly approximated and then finely approximated by a dynamic clamping member. The skilled person would therefore provide the surgical stapling device of E2 with a clamp member, such as one of those disclosed in E1, E4, E5 or E6, thereby arriving at the subject-matter of claim 1 in an obvious way.

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

Main request - Added subject-matter

The feature of claim 19 of the first original application that the dynamic clamping member was positioned within the tool assembly and was movable through the tool assembly, omitted from claim 1 of the main request, was clearly optional in the first original application. It was not present in the "Summary of the invention" on page 2, nor was it present in any of claims 1 to 18. Even in the detailed disclosure of one embodiment of the invention, on page 11, lines 6 to 18, that feature was not mentioned. Therefore, the omission of that feature fulfilled the

requirements laid down in decision T 331/87 and the Guidelines and was permissible under Article 76(1) EPC.

Auxiliary request 1 - Added subject-matter

Claim 1 of auxiliary request 1 was generally based on claim 19 of the first original application, which was reproduced verbatim on page 19 of the original application, with some additions based on the description of the first preferred embodiment depicted in Figures 1 to 13, in particular page 11, lines 11 to 18. That embodiment was not in contradiction with claim 19 of the first original application. That claim 19 did not state that the clamp member approximated the anvil and the cartridge assembly but stated that it was movable from a retracted position to an advanced position to move the anvil and the cartridge assembly to the approximated position. Since clamp member 20 abutted directly against dynamic clamping member 32 (visible in particular in Figures 7 and 8), the advancement of clamp member 20 inevitably advanced dynamic clamping member 32 and thereby inevitably moved the anvil and the cartridge assembly to the approximated position. It followed that clamp member 20 was movable from a retracted position to an advanced position to move the anvil and the cartridge assembly to the approximated position, in accordance with claim 19 of the first original application.

The clamp member of the embodiment depicted in Figures 1 to 13 was a clamp ring. However, the description of the first original application (in particular page 10, last line and page 9, line 20) made clear that other clamp members could be used. Moreover, claim 19 of the first original application referred to a clamp member, not a clamp ring. The additional

function specified in claim 1 of auxiliary request 1 that the clamp member prevented the gap between the proximal portions of the anvil and the cartridge assembly from exceeding a predetermined distance did not justify limitation of the claim to a clamp ring, since the skilled person recognised that this function was implicit in the very word "clamp".

Claim 1 of auxiliary request 1 did not define a general advanced position in which the dynamic clamping member moved the anvil and the cartridge assembly to the approximated position and ejected staples from the cartridge assembly. Rather, it defined a movement of the dynamic clamping member to an advanced position, a movement which initially brought the anvil and the cartridge assembly to the approximated position and then ejected the staples from the cartridge assembly, in accordance with page 11, lines 11 to 14 of the first original application. Furthermore, claim 19 of the first original application generally defined an advanced position of the clamp member and an advanced position of the dynamic clamping member. There was no requirement in the claim for these positions to be the same advanced position.

Claim 1 of auxiliary request 1 did not comprise any inadmissible intermediate generalisation because the features added with respect to claim 19 of the first original application, permissibly taken from the embodiment shown in Figures 1 to 13, were not inextricably linked with any other specific features of that embodiment which were not included in the claim. In particular, the dynamic clamping member was movable independently from the clamp member by advancing center rod 62. As far as the claim coverage was concerned, what was covered by claim 1 of auxiliary request 1 was

also covered by claim 19 of the first original application.

In summary, claim 1 of auxiliary request 1 complied with Articles 76(1) and 123(2) EPC.

Auxiliary request 1 - Insufficiency of disclosure

Since the embodiment shown in Figures 1 to 13 of the patent was in accordance with the subject-matter of claim 1 of auxiliary request 1, that embodiment was a detailed description of one way of carrying out the invention, which disclosed the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

Auxiliary request 1 - Lack of inventive step

E1 did not disclose a device having both a clamp member and a dynamic clamping member as defined in claim 1. According to the claim wording, those members could not be the same component as in E1. Functional equivalence was not enough to destroy novelty.

In the embodiment of E1 comprising a dynamic clamping member in the form of an I-beam 70 (shown in Figures 1 to 15), that dynamic clamping member was not movable from a retracted position to an advanced position to move the anvil and the cartridge assembly to the approximated position as defined in claim 1 (as clear from Figure 13). To reconfigure the I-beam such that it was so movable was a substantial change for which the skilled person would have no motivation in E1 or any of the other cited documents.

Starting from E2 as the closest prior art, the

objective technical problem solved by a clamp member as defined in claim 1 could not be the one formulated by the appellant. The problem of providing gross approximation followed by fine approximation performed using a dynamic clamping member was nowhere to be found in the patent in suit. The skilled person had no motivation to combine E2 with any of E1, E4, E5 and E6 in order to provide better approximation of the anvil and the cartridge assembly.

It followed that the subject-matter of claim 1 of auxiliary request 1 was inventive.

Reasons for the Decision

1. The appeal is admissible.
2. The invention

The invention relates to a surgical stapling device comprising an anvil and a cartridge assembly having at least one staple.

Devices of the kind of the invention are typically used in laparoscopic or endoscopic procedures for splitting and stapling together tissue. Generally, the tissue to be treated is first clamped between the anvil and the cartridge assembly and then cut through along a longitudinal direction of those two components. At the same time as the tissue is cut, staples are applied at each side of the cut.

Figure 1 of the patent, reproduced below, shows such a surgical stapling device.

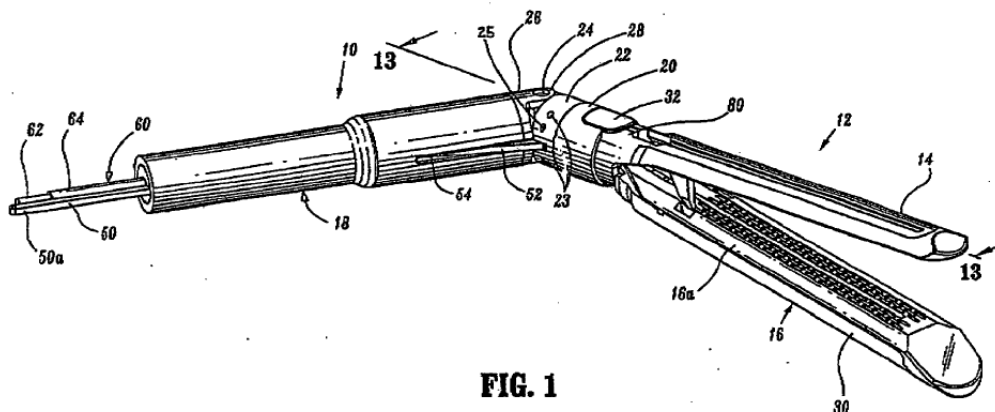


FIG. 1

The claimed invention features a clamp member (20), movable to bring the anvil (14) and the cartridge assembly (16) to an approximated position and to prevent the gap between the two elements from exceeding a predetermined distance, and a dynamic clamping member (32) engaging the anvil and the cartridge assembly to move them to the approximated position and to eject staples from the cartridge assembly.

3. As mentioned above, the patent in suit is derived from a divisional application of European patent application No. 09 013 099.8, which is itself a divisional of European patent application No. 03 773 180.9. All applications as originally filed contain the description, drawings and claims of the first original application. In the present context, if compliance with Article 76(1) EPC is established, then compliance with Article 123(2) EPC is established too.

4. Main request - Added subject-matter

Claim 1 of the main request is mainly based on claim 19 of the first original application. Claim 19 specified that the dynamic clamping member was positioned within the tool assembly and movable through the tool

assembly. These features are not present in claim 1 of the main request.

The Board shares the appellant's view that, because of the omission of these features, the subject-matter of claim 1 extends beyond the content of the first original application. The position of the dynamic clamping member within, and its movement through, the tool assembly are technically inextricably linked to the upper and lower flange portions and the arcuate cross-section defined in claim 19 of the first original application. They are necessary for performing the claimed functions of bringing together the anvil and the cartridge assembly and then ejecting the staples while "maintaining alignment of the anvil and/or cartridge during actuation of the stapler", as explained, in particular, in the paragraph bridging pages 6 and 7 and in accordance with all the embodiments of the first original application.

The respondent's argument that the detailed disclosure of one embodiment of the invention, on page 11, lines 11 to 14, did not mention the omitted features of the dynamic clamping member is not convincing, since that disclosure is made with reference to figures that clearly depict a dynamic clamping member positioned within and movable through the tool assembly.

The respondent's argument that claims 1 to 18 and the "Summary of the invention" on page 2 of the first original application did not specify that position of the dynamic clamping member within, and its movement through, the tool assembly is without merit because those claims (the wording of which is repeated on page 2) are not specifically directed to the arcuate cross-section of the flange portions and are not the

ones on which claim 1 of the main request is based.

Since the omission conveys the technical information that the alignment of the anvil and/or cartridge during actuation of the stapler could also be effectively maintained without the dynamic clamping member being positioned within and moving through the tool assembly, it presents the skilled person with information that, at the date of filing, was not directly and unambiguously derivable, using common general knowledge, from the first original application. Therefore, in accordance with the established jurisprudence of the boards of appeal (decision G 2/10, point 4.3 of the Reasons), Article 76(1) EPC is not complied with. In this context, the respondent's reference to decision T 331/87 and the Guidelines is of secondary relevance.

In conclusion, the ground for opposition under Article 100(c) EPC prejudices the maintenance of the European patent on the basis of the main request.

5. Auxiliary request 1 - Added subject-matter

Claim 1 of auxiliary request 1 differs from claim 1 of the main request in that the features of the dynamic clamping member positioned within the tool assembly and movable through the tool assembly have been reinserted. It is mainly based on claim 19 of the first original application.

5.1 One of the appellant's objections of added subject-matter is based on an interpretation according to which the description and drawings of the first original application did not disclose any embodiment comprising a clamp member movable to approximate the

anvil and the cartridge assembly as defined in claim 19 of the first original application.

The description refers to a first preferred embodiment of the invention depicted in Figures 1 to 13 (page 6, first sentence). While the description also refers to other preferred embodiments of the invention depicted in Figures 14 to 17B (page 5, lines 9 to 19), the Board notes that these figures, compared with the first preferred embodiment, are specifically concerned with a different configuration of the dynamic clamping member (closure member 132, page 13, last paragraph) and further elements of the cartridge assembly (page 14, second paragraph). These other embodiments are not related, however, to different clamp members.

It follows that, if the embodiment of Figures 1 to 13 was not according to claim 19 of the first original application because of the configuration of its clamp member, then there would be no embodiment in accordance with that claim. This has to be taken into account when interpreting the claim wording.

More specifically, the appellant argued that, on the basis of the second paragraph on page 11 of the first original application, it was the dynamic clamping member - not the clamp member - that moved the anvil and the cartridge assembly to the approximated position due to the engagement of the cartridge assembly with a respective flange.

While this may appear correct as a literal interpretation, what actually happens is that clamp ring 20 is moved distally together with dynamic clamping member 32. Hence, its movement towards the advanced position as defined in claim 19 of the first

original application contributes to the movement of the anvil and the cartridge assembly to the approximated position. Trying to make technical sense of that claim in view of the disclosure of the first original application as a whole, that contribution has to be interpreted as fulfilling the claim requirement of a clamp member movable to approximate the anvil and the cartridge assembly.

It follows that the embodiment of Figures 1 to 13 is in accordance with, and supports, the invention as defined in claim 19 of the first original application. Hence, the situation underlying decisions T 770/90 and T 133/85 does not arise and that embodiment can provide a basis for amendments of claim 19 based on additions of its features.

5.2 As regards the added feature of the clamp member being movable to prevent the gap between the proximal portions of the anvil and the cartridge assembly from exceeding a predetermined distance, specifically objected to by the appellant, there is a disclosure on page 11, lines 14 to 18 of the first original application, relating to the embodiment of Figures 1 to 13.

The appellant argued that this disclosure in the first original application was with respect to a clamp ring that encircled the proximal portions of the anvil and the cartridge assembly in the advanced position, and that the omission of the definition of such a clamp ring in claim 1 added subject-matter.

The Board does not share this view. That specific added feature of the clamp member is not technically inextricably linked to the clamp member being in the

form of a clamp ring encircling the proximal portions of the anvil and the cartridge assembly in the advanced position. Contrary to the appellant's assertions, it is technically evident that the clamp member, defined as such in claim 19 of the first original application, does not need to be in the form of a ring in order to fulfil its function of preventing the gap between the proximal portions of the anvil and the cartridge assembly from exceeding a predetermined distance. For example, it could take a form similar to that disclosed in respect of the dynamic clamping member or could simply be only part of a circle. Moreover, the description of the first preferred embodiment according to Figures 1 to 13 in the first original application left expressly open the possibility of the clamp member being in a form other than a ring. For example, the sentence on page 9, lines 18 to 20 reads: "*the drive mechanism includes a coaxial cable or drive member 60 (FIG. 3) having a center rod 62 and an outer sheath 64, a drive collar 66 (FIG. 9), a clamp member, here shown as clamp ring 20, and dynamic clamping member 32.*"

In conclusion, the omission of the definition of a clamp ring that encircled the proximal portions of the anvil and the cartridge assembly in the advanced position in claim 1 of auxiliary request 1 does not result in subject-matter extending beyond the content of the first original application.

- 5.3 The appellant argued further that there was no original disclosure of a general advanced position in which the dynamic clamping member moved the anvil and the cartridge assembly to the approximated position and ejected staples from the cartridge assembly, and in which the clamp member approximated the anvil and the cartridge assembly.

However, in the Board's view, such a general advanced position is neither explicitly defined nor contemplated in claim 1 of auxiliary request 1. As the respondent submitted, the claim defines a movement of the dynamic clamping member to an advanced position, a movement which is required to bring the anvil and the cartridge assembly to the approximated position and eject the staples from the cartridge assembly. Claim 19 of the first original application defined an advanced position of the clamp member, where the anvil and the cartridge assembly are brought into the approximated position, and an advanced position of the dynamic clamping member, where staples are ejected. These two advanced positions are distinct and refer to different members. There is no reason why they should be interpreted as a "general advanced position". From the technical context, it is even inherent that first the anvil and the cartridge have to be brought into the approximated position and then staples are to be ejected, otherwise a patient undergoing the laparoscopic procedure could be severely harmed. The description of the first preferred embodiment in the first original application (page 11, line 6 to page 12, line 6) confirms this by identifying a second advanced position of a center rod 62, more distal than a first or partially advanced position of the same center rod 62. While the center rod moves from a retracted position to its second advanced position, where staples are ejected, the dynamic clamping member passes through a position where it brings, together with the clamp member, the anvil and the cartridge assembly to the approximated position. When the dynamic clamping member is at that intermediate position, the clamp member is at its advanced position.

Since claim 1 of auxiliary request 1 neither defines nor contemplates a general advanced position as argued by the appellant, the lack of disclosure of such a position in the first original application does not result in the subject-matter of claim 1 extending beyond the content of the first original application.

As regards the argument that the description of the first original application only provided a basis for the clamp member and the dynamic clamping member being moved together from a retracted position to a first advanced position, the Board notes that claim 19 of the first original application did not include such a limitation. Hence, that limitation does not need to be present in claim 1 of auxiliary request 1 either.

- 5.4 The appellant raised a further objection based on the argument that claim 1 of auxiliary request 1 was an unallowable intermediate generalisation of the first preferred embodiment disclosed in the first original application because the claim did not comprise the features of the clamp ring being proximal of the dynamic clamping member, the first advanced position of the clamp ring being the same as the first advanced position of the dynamic clamping member and the clamp ring and the dynamic clamping member being moved together before the dynamic clamping member was moved alone.

The Board notes that claim 19 of the first original application was at least as general as claim 1 of auxiliary request 1 as far as those features are concerned. Moreover, the Board does not see, and the appellant has not explained, why those features should have become technically necessary in claim 1 because of the added features of the movement of the clamp member

being to prevent the gap between the proximal portions of the anvil and the cartridge assembly from exceeding a predetermined distance, and the movement of the dynamic clamping member causing the movement of the anvil and the cartridge assembly to the approximated position.

It follows that the intermediate generalisation does not extend beyond the content of the first original application.

5.5 In conclusion, the subject-matter of claim 1 of auxiliary request 1 does not extend beyond the content of the first original application, and Articles 76(1) and 123(2) EPC are complied with.

6. Auxiliary request 1 - Insufficiency of disclosure

The appellant's objection of insufficiency of disclosure hinges on the interpretation according to which the embodiment of Figures 1 to 13 of the patent was not in accordance with the invention as defined in claim 1 of auxiliary request 1. However, as explained under point 5.1 above, that embodiment is in accordance with that claim. Hence, precisely that embodiment provides a sufficient disclosure of the invention as defined in claim 1 of auxiliary request 1.

It follows that the requirements of Article 83 EPC are fulfilled.

7. Auxiliary request 1 - Lack of inventive step

7.1 The appellant raised an objection of lack of inventive step of the subject-matter of claim 1 of auxiliary request 1 by virtue of lack of novelty over E1.

E1 concerns surgical stapling devices of the same kind as the present invention, specifically for treating the oesophagus and the stomach (paragraph [0001]). The appellant referred to an embodiment shown in Figures 16 to 18 of E1, reproduced below.

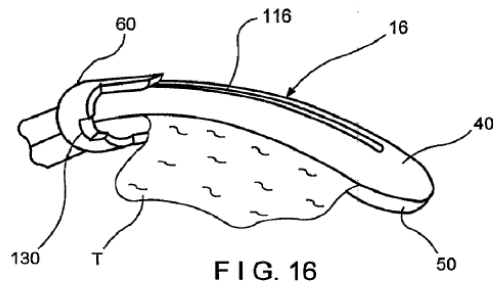


FIG. 16

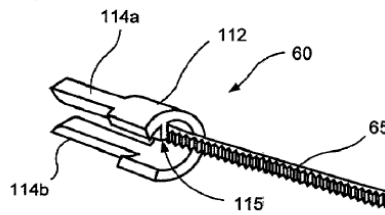


FIG. 17

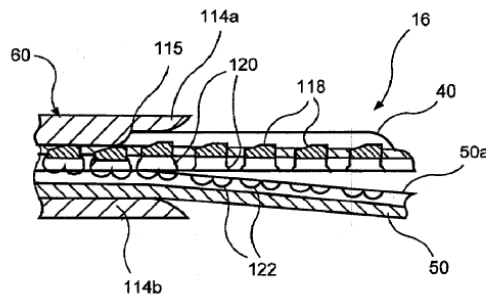


FIG. 18

That embodiment concerns a stapling device comprising a tool assembly with an anvil (staple forming portion 50) and a cartridge assembly (staple carrying portion 40). The stapling device comprises a translating clamping member (60) by which the anvil and the cartridge assembly can be finely approximated (paragraph [0035]). Clamping member 60 comprises a driving stem (115) for

ejecting the staples (paragraph [0041]), and a cutting blade (130).

According to the appellant, two parts of the same clamping member 60 corresponded to the clamp member and the dynamic clamping member defined in claim 1 of auxiliary request 1.

However, the claim recites two different members, i.e. two individual elements, on a normal technical interpretation of the claim. The embodiments disclosed in the description and figures of the patent comprise two separate elements. Hence, they fully support this normal interpretation. The appellant's argument that the clamp member and the dynamic clamping member of the patent moved together, and hence could be parts of the same element, is not convincing. First of all, in general, the same function can be achieved by different structures. Secondly, in the embodiments disclosed in the patent, the dynamic clamping member is followed by the clamp member only during a part of its movement.

It follows that the appellant's objection of lack of inventive step by virtue of lack of novelty over E1 does not succeed, since there is no disclosure of a clamp member or a separate dynamic clamping member as claimed.

7.2 The appellant also argued that the subject-matter of claim 1 of auxiliary request 1 lacked inventive step when starting from E1, in particular an embodiment comprising a dynamic clamping member in the form of an I-beam. Figures 12 to 15, reproduced below, depict this embodiment.

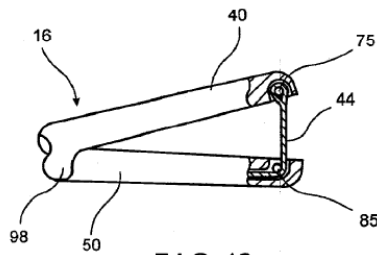


FIG. 12

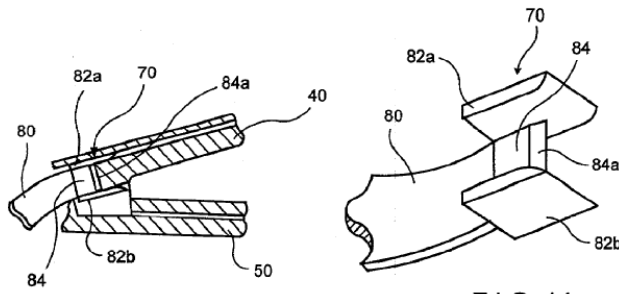


FIG. 13

FIG. 14

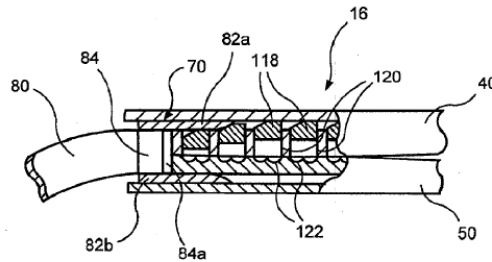


FIG. 15

The appellant argued that both a clamping member and the I-beam could be moved to cause a fine approximation of the jaws of the surgical stapler while tissue was trapped between them (paragraph [0035] and claims 6 and 13). However, it is the Board's view that the movement of I-beam 70 cannot move the anvil (50) and the cartridge assembly (40) of the surgical stapler to the approximated position as defined in claim 1 of auxiliary request 1. The claim defines an approximated position of the cartridge assembly in relation to the anvil by contrast to a spaced position. This is made clear by the reference to "the approximated position" - hence the same position - in relation to both the movement of the clamp member and the movement of the dynamic clamping member. Hence, the movement of the

anvil and the cartridge assembly to the approximated position has to be interpreted as a movement between the spaced and approximated positions as defined previously in the claim. This is perfectly in line with what is disclosed in the description, in particular paragraphs [0026] and [0027], of the patent.

What happens during use of the device of the embodiment described with reference in particular to Figures 12 to 15 of E1 is that the jaws of the surgical stapler are first "grossly approximated" by operating an actuation cable 44 (paragraph [0035]). As clear from Figure 13 in particular, I-beam 70 can only engage anvil 50 once such approximation is performed. Only then can the I-beam be driven through the surgical stapler to fire the staples. Hence, the fine approximation possibly caused by the movement of the I-beam does not move the anvil and the cartridge assembly to the approximated position (from a spaced position) within the meaning of claim 1 of auxiliary request 1.

It follows that the subject-matter of claim 1 of auxiliary request 1 differs from the embodiment of E1 on the basis of which the appellant argued, in particular in that the dynamic clamping member is movable to move the anvil and the cartridge assembly to the approximated position.

The technical effect of this distinguishing feature is that the movement of the anvil and the cartridge assembly to the approximated position can be performed more easily and reliably, since it is caused by the movement of two distinct elements.

This is considered as addressing the objective technical problem of trapping more reliably the amount

of tissue intended to be treated between the anvil and the cartridge assembly.

E1 provides no pointer to the distinguishing feature in order to address that problem. Moreover, as the respondent argued, to reconfigure the I-beam such that it was movable to move the anvil and the cartridge assembly to the approximated position would involve a complete re-design of the stapler assembly, which would only be done with hindsight.

Therefore, the Board concludes that the subject-matter of claim 1 of auxiliary request 1 is inventive when starting from E1.

- 7.3 The appellant argued that the subject-matter of claim 1 of auxiliary request 1 lacked inventive step when starting from E2 as the closest prior art.

While the surgical stapling device disclosed in E2 may comprise a dynamic clamping member for moving the anvil and the cartridge assembly to the approximated position, it is common ground that it does not comprise a further clamp member for moving the anvil and the cartridge assembly to that position.

The technical effect of this distinguishing feature is again that the movement of the anvil and the cartridge assembly to the approximated position can be performed more easily and reliably - or better, as the respondent put it - since it is caused by the movement of two distinct elements.

Consequently, the objective technical problem solved is the same as the one in respect of E1, i.e. how to trap more reliably the amount of tissue intended to be

treated between the anvil and the cartridge assembly.

The problem formulated by the appellant, i.e. how to provide gross approximation followed by fine approximation performed using a dynamic clamping member, is not accepted. There is simply no distinction between a gross approximation and a fine approximation in the patent or in E2.

While it is accepted, as the appellant argued, that E1, E4, E5 and E6 all disclose surgical stapling devices comprising clamp members for clamping tissue between jaws by moving them to an approximated position, none of these documents individually discloses or teaches two distinct elements, the movement of which may cause the jaws to move to the approximated position in order to address the objective technical problem.

Hence, the prior art does not provide the skilled person with any motivation to implement a further clamp member in the surgical stapling device of E2 for moving the anvil and the cartridge assembly to the approximated position.

It follows that the subject-matter of claim 1 of auxiliary request 1 is inventive when starting from E2.

7.4 In summary, the subject-matter of claim 1 of auxiliary request 1 is inventive (Article 56 EPC) in view of the cited prior art.

8. In conclusion, none of the objections raised by the appellant prejudices the maintenance of the patent on the basis of auxiliary request 1.

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 8 of auxiliary request 1 filed with letter dated 3 December 2014; and
 - description and figures of the patent as granted.

The Registrar:

The Chairman:



D. Hampe

E. Dufrasne

Decision electronically authenticated