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**Datasheet for the decision
of 13 February 2019**

Case Number: T 2198/14 - 3.2.02

Application Number: 12186721.2

Publication Number: 2545863

IPC: A61B17/32, A61B17/34

Language of the proceedings: EN

Title of invention:
Bladeless optical obturator

Applicant:
APPLIED MEDICAL RESOURCES CORPORATION

Headword:

Relevant legal provisions:

EPC Art. 111(1), 113(1)
EPC R. 103(1)(a)

Keyword:

Right to be heard - opportunity to comment (no) - substantial
procedural violation (yes)
Reimbursement of appeal fee - (yes)
Appeal decision - remittal to the department of first instance
(yes)

Decisions cited:

Catchword:



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Case Number: T 2198/14 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 13 February 2019

Appellant: APPLIED MEDICAL RESOURCES CORPORATION
(Applicant) 22872 Avenida Empresa
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Representative: Dolleymores
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 29 August 2014
refusing European patent application
No. 12186721.2 pursuant to Article 97(2) EPC

Composition of the Board:

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

Summary of Facts and Submissions

- I. The applicant has appealed against the Examining Division's decision, despatched on 29 August 2014, to refuse European patent application No. 12 186 721.2 for lack of novelty of the subject-matter of claim 1 of the only request on file.
- II. The Examining Division issued the impugned decision after having sent a single communication pursuant to Article 94(3) EPC dated 31 May 2013, to which the appellant had replied by letter dated 26 September 2013, with which it filed amended claims.
- III. Notice of appeal and the statement setting out the grounds of appeal were filed on 29 October 2014. The appeal fee was paid on the same day.
- IV. The following document is considered in the present decision.
- D1: WO-A-03/026512.
- V. The appellant requested that the decision under appeal be set aside and that the application be remitted to the Examining Division for further prosecution on the basis of claims 1 to 11 filed with letter dated 29 October 2014. It further requested reimbursement of the appeal fee.
- VI. Claim 1 as originally filed reads as follows.

"A surgical access device comprising:
a tissue separating obturator (18) comprising:
an elongate shaft portion (21) extending along a longitudinal axis (23) and defining a first lumen

between an open proximal end and a distal end; and
a transparent distal tip portion (27) with an inner surface and an outer surface adapted for penetrating tissue; the distal tip portion (27) disposed at the distal end of the shaft portion (21);

wherein the first lumen is sized and configured to receive an optical instrument having a distal end adapted to receive an image and the tip portion (27) being adapted to permit passage of an image; and characterized by the distal tip portion (27) including a bulbous section (27d)."

VII. Claim 1 filed with the letter dated 26 September 2013, underlying the impugned decision, reads as follows.

"A surgical access device comprising:

a bladeless tissue separating obturator (18) comprising:

an elongate shaft (21) extending along a longitudinal axis (23) and defining a first lumen between an open proximal end and a distal end; and

a transparent distal tip (27) with an inner surface and an outer surface adapted for penetrating tissue; the distal tip (27) disposed at the distal end of the elongate shaft portion (21); the outer surface of the distal tip extending distally to a blunt point;

wherein the first lumen is sized and configured to receive an optical instrument having a distal end adapted to receive an image and the distal tip (27) being adapted to permit passage of an image; and

characterized by the distal tip (27) including a bulbous section (27d) proximal to the blunt point and configured to accommodate the distal end of an angled lens optical instrument inside the distal tip."

VIII. The subject-matter of claim 1 filed with the letter dated 29 October 2014 differs from that of claim 1 underlying the impugned decision in having the following additional feature of the distal tip, which appears after the distal tip is mentioned in the characterising portion of the claim.

"... being hollow to receive the distal end of the optical instrument with the first lumen extending into the hollow distal tip (27)...".

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

The amended claims filed with the appellant's reply to the communication of the Examining Division addressed all the objections raised in that communication. There had been no reason to suspect that the application would be refused.

The reason for refusing the application because of lack of novelty of the subject-matter of claim 1 over D1 was supported by arguments based on features of the prior art not previously brought to the attention of the appellant. In particular, the main objection was based on the disclosure of figures 9 and 10 of D1, figures to which no reference had previously been made.

Reasons for the Decision

1. The appeal is admissible.
2. The invention

The invention relates to a surgical access device, e.g.

a trocar as depicted in figure 1A of the application reproduced below, comprising a bladeless tissue separating obturator (18) of the kind shown in figure 16 of the application reproduced below. In use the obturator can be pushed through tissue to provide a working channel for accessing the inner organs of a patient. The absence of a blade should reduce the risks of the insertion procedure for the patient (paragraph [0005] of the application as published).

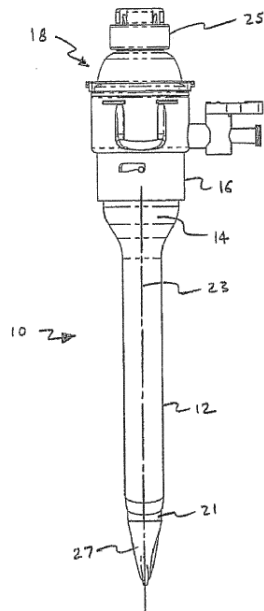


FIG. 1A

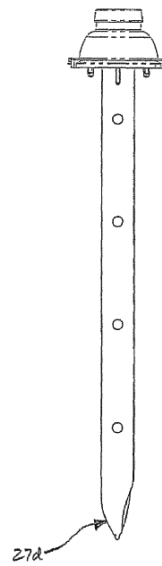


FIG. 16

The obturator (18) comprises an elongated shaft (21) with a lumen and a transparent distal tip (27) extending distally to a blunt point. An optical instrument can be inserted into the shaft to the distal tip in order to view the insertion of the obturator through tissue. The distal tip comprises a bulbous section (27d), proximal to the blunt point, for accommodating the distal end of an angled lens optical instrument.

According to the application, an angled lens optical instrument, e.g. a 30° laparoscope, permits a better view of anatomical structures after the first penetration, when the tip of the obturator is moved within the patient's body (paragraphs [0034] to [0036] of the application as published).

3. The Examining Division's communication pursuant to Article 94(3) EPC

The Examining Division took the impugned decision after having sent only one communication, in which it raised objections of lack of novelty of the subject-matter of claim 1 as originally filed over a number of documents, which included D1.

In particular, the Examining Division referred to figures 1 and 3 of D1. In relation to the bulbous section of the distal tip portion of the claimed surgical access device the Examining Division wrote the following between brackets (point 1.1 of the communication).

"Fig.1,3: since the tip 27 is blunt as on p.7, 1.17, its rounded distal end can be considered as bulbous; Figs. 15, 19 and 32 also show a bulbous section)."

The Examining Division proposed a number of amendments in order for the claims to comply with Articles 76(1) and 84 EPC, which included the incorporation of the features of claim 3 into claim 1 (point 2.1 of the communication).

No specific objections of lack of novelty were raised in substance against the subject-matter of the dependent claims. The only paragraph concerning novelty

of the subject-matter of the dependent claims in the communication is numbered 3.1 and reads as follows.

"These claims do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the EPC in respect of novelty and/or inventive step, see documents D1, D2, D3, D7, D9, D17 and D18, in particular the corresponding passages cited in the search report."

4. The appellant's reply to the communication

In response to the communication of the Examining Division, the appellant filed amended claims for the first time, in a clear attempt to address the objections raised.

In particular, a new claim 1 incorporating the features of former claims 2 and 3 and including some other amendments was filed. In its letter, the appellant argued that the new features of claim 1 provided novelty and inventive step (page 2, second paragraph).

Some of those new features concern the bulbous section - already defined in claim 1 as originally filed - and specify that the bulbous section is proximal to a blunt point of the distal tip and is configured to accommodate the distal end of an angled lens optical instrument inside the distal tip.

5. The reasons for the impugned decision

In the section entitled "Reasons for the decision" (point 2.1) the Examining Division explained that a bulbous section was shown in figures 6 to 11 of D1 and made precise references to specific elements of

figures 15, 19 and 32, together with passages of the description of D1.

In relation to the added feature of the bulbous section "configured to accommodate the distal end of an angled lens optical instrument inside the distal tip", the Examining Division argued as follows (point 2.1 of the decision).

"It is acknowledged that D1 does not mention the use of an angled laparoscope and that Figs. 9 and 10 of D1 may hint to a cylindrical lumen in the tip. This lumen is however regarded as adapted to accommodate both a straight and an angled laparoscope, as required by claim 1."

Furthermore, it made reference to some passages of the description of the present application, which were *"not sufficient to derive clear structural features"*.

6. The Board's conclusions

6.1 The references of the Examining Division to figures 6 to 11, to the specific elements of figures 15, 19 and 32 and to the passages of the description of D1 in relation to the claimed bulbous section were made in the impugned decision for the first time.

As explained above, in the communication preceding the impugned decision there were no specific novelty objections to claims 2 and 3 as originally filed, which comprised the features relating to the configuration of the bulbous section that were incorporated into claim 1 underlying the impugned decision. Figures 9 and 10 of D1, on the basis of which the Examining Division came to the conclusion that those features were anticipated

by D1, were not referred to at all. The description of the application in relation to the novelty of the subject-matter of the claims over D1 was not referred to either. Figures 9 and 10 of D1 are not even mentioned in the search report, which was generally referred to in the communication.

Thus, these references in relation to the bulbous section configured to accommodate the distal end of an angled lens optical instrument inside the distal tip were made in the impugned decision for the first time.

Consequently, the appellant's argument that it was confronted for the first time with decisive grounds for the refusal of its application in the written decision (page 2 of the statement of grounds) is accepted by the Board. As a result, the appellant did not have any opportunity to present its comments on those grounds, which is a substantial procedural violation, in contravention of Article 113(1) EPC.

Whether the assessment of novelty by the Examining Division is right or not is not relevant to this point.

6.2 Because of this substantial procedural violation, the appellant had no choice other than to appeal in order to have its rights respected. Hence, the reimbursement of the appeal fee under Rule 103(1)(a) EPC is equitable.

7. Remittal to the Examining Division

Under Article 111(1) EPC, following the examination as to the allowability of the appeal, the Board retains the discretion to remit the case to the department which was responsible for the decision appealed, for

further prosecution. Under Article 11 RPBA, the case is to be remitted if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise.

The Board does not see any such special reasons. Moreover, since the impugned decision was based only on lack of novelty, a remittal appears appropriate in order for the appellant to have the new claims examined at two instances in respect of all the requirements of the EPC.

Hence, the case is to be remitted, in accordance with the appellant's request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:



D. Hampe

E. Dufrasne

Decision electronically authenticated