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**Datasheet for the decision
of 2 December 2019**

Case Number: T 3028/18 - 3.2.02

Application Number: 06737222.7

Publication Number: 1858565

IPC: A61M1/00

Language of the proceedings: EN

Title of invention:

ACCESS PORT IDENTIFICATION SYSTEMS AND METHODS

Applicant:

C.R. BARD, INC.

Headword:

Relevant legal provisions:

EPC Art. 84, 111(1)

EPC R. 103(1)(a)

Keyword:

Claims - clarity - main request (yes)

Appeal decision - remittal to the department of first instance
(yes)

Reimbursement of appeal fee - (no)

Decisions cited:

Catchword:



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Case Number: T 3028/18 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 2 December 2019

Appellant: C.R. BARD, INC.
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Representative: Hoffmann Eitle
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 6 July 2018
refusing European patent application No.
06737222.7 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, posted on 6 July 2018, to refuse European patent application No. 06 737 222.7 for lack of clarity.
- II. The notice of appeal was filed on 13 September 2018. The appeal fee was paid on the same day. The statement setting out the grounds of appeal was received on 16 November 2018.
- III. The appellant requested that the decision under appeal be set aside and that the case be remitted to the Examining Division with the order to grant a patent on the basis of the main request filed on 5 June 2018 or, in the alternative, on the basis of one of auxiliary requests 1 to 7, filed by letter dated 8 May 2018, and auxiliary request 8, filed by letter dated 16 November 2018.

The appellant further requested "to establish the occurrence of a substantial procedural violation of the Examining Division and order re-imburement [sic] of the appeal fee".

The appellant further requested oral proceedings if the Board "cannot facilitate grant of a patent according to the main request within written proceedings".

- IV. Claim 1 of the main request reads as follows:

"A subcutaneously implantable power-injectable access port for providing subcutaneous access to a patient,

the access port comprising a body configured for capturing a septum for repeatedly inserting a needle therethrough into a cavity defined within the body, and at least one metal feature having a geometry that can be represented on an X-ray image generated by exposure of the access port to X-ray energy while simultaneously exposing an X-ray sensitive film to X-ray energy passing through the access port, the metal feature being correlative with the access port being power injectable, so that once the metal feature is observed, the correlation is accomplished and information pertaining to the access port is obtainable."

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

In the impugned decision the Examining Division wrongly held that the wording of claim 1 of the main request "the metal feature being correlative with the access port being power injectable, so that once the metal feature is observed, the correlation is accomplished and information pertaining to the access port is obtainable" lacked clarity.

The assessment of the scope of protection did not relate to clarity.

The wording of the claim was clear, as it basically required a predetermined relationship between the metal feature and the power injectability. A more structural definition of the metal feature in connection with the correlation with power injectability would unduly restrict the claim. Even if the claim were regarded as broad, this would not result in the claim being unclear per se.

The Examining Division had committed a substantial procedural violation, since it first questioned the appellant's submissions based on common general knowledge in the impugned decision, without having asked the appellant for evidence. This justified reimbursement of the appeal fee.

Reasons for the Decision

1. The appeal is admissible.
2. The invention

The invention relates to a subcutaneous access port. Such ports are implanted subcutaneously into a patient and provide access to remote areas within the body to which medicaments or other substances are to be delivered. According to the application, conventional access ports may exhibit similar geometries, which are difficult to differentiate once the access port has been implanted (paragraph [0006]). The identification is important, because not all access ports are suitable for every kind of delivery. In particular, not all access ports are suitable for being pressurised by power injectors, which are typically employed to deliver contrast media during computer tomography. The invention provides an access port with one identifiable characteristic, for determining the kind of access port implanted in the patient.

The access port defined in claim 1 of the main request includes a body for capturing a septum, through which a needle can be inserted to reach a cavity within the body. The access port comprises a metal feature which

can be detected and represented in an X-ray imaging procedure, the metal feature being correlative with the access port being power injectable.

3. The claims of the main request are based on claim 13, and paragraphs [0003], [0040], [0041] and [0072] of the application as originally filed. They comply with Article 123(2) EPC.
4. In the impugned decision, the Examining Division held that the definition of "the metal feature being correlative with the access port being power injectable, so that once the metal feature is observed, the correlation is accomplished and information pertaining to the access port is obtainable" lacked clarity, in particular because it failed to provide a well-defined limit to the scope of the claim.

The Board does not agree with the Examining Division's conclusion. While the scope of the claim may be broad, the technical meaning of the claimed features is clear, as submitted by the appellant. As far as the metal feature is concerned, it has to satisfy two conditions: it should be detectable by X-rays, and its detection should make it possible to establish some correlation with the access port that allows the identification of the latter as power injectable.

However, the claim does not define any specific nature of the correlation, in particular whether it can be univocal.

Concerning the potential difficulty in assessing whether an access port of the prior art is within or outside the scope of the claim, as considered in point 2.2 of the Reasons of the impugned decision, the Board

notes that this assessment may have to be carried out in the course of examining patentability, and depends on the specific technical context of the prior art. However, it is distinct from the assessment of clarity of the claim wording.

Hence, the subject-matter of claim 1 is clear and fulfils the requirements of Article 84 EPC.

The same reasoning applies to claims 2, 4 and 8, which were held to lack clarity in the impugned decision on the basis of arguments similar to those provided in relation to claim 1 (points 3.5 to 3.9 of the Reasons).

In conclusion, the main request complies with Article 84 EPC.

5. 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.

Since the impugned decision did not deal with other requirements of the EPC, in particular novelty and inventive step, the Board considers it appropriate to remit the case to the Examining Division for further prosecution, so that the appellant also has the opportunity for these requirements to be considered by two instances.

6. Under Rule 103(1) (a) EPC the appeal fee is to be reimbursed if the Board deems an appeal to be allowable and "if such a reimbursement is equitable by reason of a substantial procedural violation".

It is the Board's view that whether, and by whom, an assertion that something is common general knowledge should be proved is a matter of judgment, not of procedure. The Examining Division did not prevent the appellant from filing further evidence in support of its assertions. However, there is no provision in the EPC requiring the Examining Division to ask for such evidence, if the assertions are not found convincing.

In conclusion, the Examining Division did not commit a substantial procedural violation. It follows that the appellant's request for reimbursement of the appeal fees has to be refused.

7. As regards the appellant's conditional request for oral proceedings, the Board notes that remittal to the department of first instance for further prosecution, once it has been established that the main request complies with Articles 84 and 123(2) EPC, clearly "facilitates" the grant of a patent according to the main request. Consequently, the condition under which oral proceedings are requested is not fulfilled, and there is no need for the Board to hold oral proceedings.

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.

The Registrar:

The Chairman:



D. Hampe

E. Dufrasne

Decision electronically authenticated