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**Datasheet for the decision
of 11 May 2021**

Case Number: T 1976/19 - 3.2.08

Application Number: 10194549.1

Publication Number: 2397106

IPC: A61F2/07, A61F2/966

Language of the proceedings: EN

Title of invention:
Stent graft

Patent Proprietor:
Bolton Medical Inc.

Opponent:
Cook Medical Technologies LLC

Headword:

Relevant legal provisions:
EPC Art. 84
RPBA 2020 Art. 13(2)

Keyword:
Claims - clarity after amendment (no)
Amendment after summons - cogent reasons (no)

Decisions cited:

G 0003/14, T 0728/98

Catchword:



Beschwerdekammern

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Case Number: T 1976/19 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 11 May 2021

Appellant: Bolton Medical Inc.
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Representative: Prüfer & Partner mbB
Patentanwälte · Rechtsanwälte
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Respondent: Cook Medical Technologies LLC
(Opponent) 750 North Daniels Way
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Representative: Williams Powell
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 1 July 2019
revoking European patent No. 2397106 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairwoman P. Acton
Members: C. Vetter
Y. Podbielski

Summary of Facts and Submissions

- I. The appeal was filed by the patent proprietor (appellant) against the decision of the opposition division to revoke the patent in suit (hereinafter "the patent").
- II. The opposition division had decided that the subject-matter of the claims as amended during the opposition proceedings extended beyond the content of the application as filed (Article 123(2) EPC).
- III. Oral proceedings were held by videoconference before the Board.
- IV. The appellant requested that the decision under appeal be set aside and the case be remitted to the opposition division for further prosecution on the basis of the main request filed with the statement setting out the grounds of appeal dated 11 November 2019 or, as an auxiliary measure, on the basis of
 - one of the auxiliary requests 1 to 9 filed on the same date, or
 - one of the auxiliary requests 10 to 19 filed during oral proceedings.

The respondent (opponent) requested that the appeal be dismissed and that auxiliary requests 4-19 not be admitted into the appeal proceedings.

- V. Claim 1 of the main request reads as follows (amendments compared to the claim as granted are highlighted; feature denomination in square brackets added by the Board):

- [1.1] A vascular repair device (1), comprising:
- [1.2] a tubular graft body (10) having a proximal end (12) and a distal end (14);
- [1.3] a structural framework having at least two stents (20);
- [1.4] a first of the stents (23) being connected to the tubular graft body (10) along an entirety of the first stent (23);
- [1.5] a second of the at least two stents being a bare stents (30), at the proximal end (12) of the tubular graft body (10)
- [1.6] having a shape that is a periodically changing shape to define proximal apices (32) having given radii of curvature (β) and distal apices (34) having radii of curvature (α) significantly smaller than said given radii of curvature (β) of the proximal apices; and
- [1.7] the bare stent (30) being connected to the tubular graft body (10) at the distal apices (34).

Claim 1 of auxiliary requests 1-9 contains feature [1.6] in unamended form, respectively.

Auxiliary requests 10-19 correspond to the main request and auxiliary requests 1-9, respectively, with the following two amendments made to each of the requests:

- deletion of the term "significantly" from claim 1
- deletion of dependent claim 9.

VI. The appellant's arguments, as far as relevant for the decision, can be summarised as follows:

Main request - clarity

The decision under appeal was correct to accept the expression "significantly smaller" as being clear. Relative terms were in principle allowable.

Auxiliary requests 10-19 - admission into proceedings

Auxiliary requests 10-19 were to be admitted into the proceedings, since the appellant was surprised by the Board's finding that the term "significantly" is unclear, and since the amendments made were simple and clearly allowable.

- VII. The respondent's arguments, as far as relevant for the decision, can be summarised as follows:

Main request - clarity

The term "significantly" was inherently unclear and could not define the scope of claim 1. The opposition division's definition was neither clear nor based on the patent.

Auxiliary requests 10-19 - admission into proceedings

Auxiliary requests 10-19 were not to be admitted into the proceedings, because the clarity objection of the term "significantly" had been in the procedure for a long time and the amendments made were not clearly allowable.

Reasons for the Decision

1. Clarity

1.1 Article 84 in combination with Rule 43(1) EPC stipulates that the claims shall be clear and define the subject-matter for which protection is sought in terms of the technical features of the invention. Those requirements serve the purpose of ensuring that the public is not left in any doubt as to which subject-matter is covered by a particular claim and which is not. From this principle of legal certainty it follows that a claim cannot be considered clear in the sense of Article 84 EPC if it does not unambiguously allow this distinction to be made (see also decision T 728/98, headnote and point 3 of the reasons).

1.2 Claim 1 as granted defines in feature **[1.6]** that the shape [of the bare stent] is a periodically changing shape to define proximal apices (32) having given radii of curvature (β) and distal apices (34) having radii of curvature (α) smaller than said given radii of curvature (β) of the proximal apices.

In the present main request as well as in auxiliary requests 1-9, this feature has been amended by introducing the term "significantly" before "smaller":

"[...] distal apices (34) having radii of curvature (α) significantly smaller than said given radii of curvature (β) of the proximal apices"

Since the amendment derives from the description, it is to be examined under Article 84 EPC (G 3/14).

1.3 The introduced term "significantly" is a relative term, for which the appellant has not demonstrated that an unequivocal generally accepted meaning exists in the relevant art and which is not defined in the patent. In the context of claim 1, the objected term leaves it open as to how much smaller the radii of curvature of the distal apices have to be as compared to the radii of curvature of the proximal apices. As a consequence, it remains unclear which subject-matter is covered by the claim and which is not. The objected term, therefore, is not allowable under Article 84 EPC.

1.4 The appellant argued that the objected term was considered clear by the Opposition Division. In its decision, the Opposition Division found that "significantly" signifies that an observable difference between the two features being compared has to be present (point 16.5.2 of the reasons).

However, as correctly stressed by the respondent, whether something is "observable" is dependent on the manner in which the observation is made. Neither in the relevant art nor in the patent is there an indication as to whether "observable" means observable by the naked eye, or whether it means observable with measuring instruments and, if so, how precise those instruments need to be. The Opposition Division's construction of the term "substantially", therefore, is just as unclear as the objected term itself.

1.5 The appellant further argued that according to the case law of the Boards of Appeal, 9th edition 2019, chapter II.A.3.6, the use of a relative term in a claim may be accepted where the skilled person is able to understand the meaning of this term in a given context.

1.5.1 The appellant referred to page 18, lines 21-25, of the description as filed and argued that the objected term is linked to the effect of substantially preventing perforation of the blood vessel by the proximal apices, or, at a minimum, making it much less likely for the bare stent to perforate the vessel because of the less-sharp curvature of the proximal apices. According to the appellant, this effect could easily be verified by the skilled person, e.g. by simulations.

However, this effect is not part of the claim, so that it cannot be used to define its scope.

1.5.2 The appellant further referred to page 14, lines 13-15 and page 17, lines 20-23, and argued that in contrast to these passages, which recite (substantially) *equal radii*, the objected term denotes a difference which is "beyond substantially equal" or, in other words, "noticeable".

In the Board's view, the expression "beyond substantially equal" suffers from the same indefiniteness as the objected expression "significantly smaller". Again, it is left open as to how large the difference of the compared radii has to be in order to be considered *substantial*.

Regarding the term "noticeable", the above observations with respect to the term "observable" apply (see point 1.4 above).

1.5.3 Consequently, even accepting the appellant's definition it remains unclear which subject-matter is covered by the claim and which is not.

1.6 For these reasons, the main request as well as auxiliary requests 1-9 are rejected under Article 84 EPC.

2. Auxiliary requests 10-19 - admission into proceedings

2.1 Auxiliary requests 10-19 were filed during oral proceedings and, hence, after notification of the summons to oral proceedings dated 14 May 2020. According to Article 13(2) RPBA 2020 they therefore shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

2.2 The appellant argued that it was surprised by the Board's finding that the term "significantly" is unclear. The term had been considered clear by the Opposition Division and had not been objected to in the appeal proceedings before, at least not by the Board.

However, the respondent in its reply to the appeal (see point B.1. on pages 5 and 6) had argued in detail why the term "significantly" in its view is unclear. Also the Board in its communication of 21 August 2020 (see point 3.3.1 on page 6) had indicated that it needs to be discussed whether the relative term "significantly smaller" can clearly define the subject-matter for which protection is sought. The appellant, therefore, could not be taken by surprise that during oral proceedings the Board comes to the conclusion that the objected term is indeed unclear.

2.3 The appellant further argued that auxiliary requests 10-19 contain only simple amendments which clearly overcome the Article 84 EPC objection and which do not

lead to any new objections such as under Article 123(2) EPC.

In the Board's view, this is not the case at least for the deletion of the term "significantly". This term had been introduced by the appellant in order to address the finding of the Opposition Division that claim 1 as granted contravenes Article 123(2) EPC (see point 14.2.2, item 3 of the reasons of the decision under appeal; see also point II.2.1 of the grounds of appeal). Deleting the term from claim 1, therefore, would again raise this issue, so that said amendment cannot be considered as clearly allowable.

2.4 For these reasons, auxiliary requests 10-19 are not admitted into the proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairwoman:



A. Vottner

P. Acton

Decision electronically authenticated