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**Datasheet for the decision  
of 9 March 2023**

**Case Number:** T 1494/21 - 3.2.02

**Application Number:** 17185818.6

**Publication Number:** 3266391

**IPC:** A61B17/22, A61B17/221

**Language of the proceedings:** EN

**Title of invention:**  
APPARATUS FOR FLOW RESTORATION

**Patent Proprietor:**  
Covidien LP

**Opponent:**  
Phenox GmbH

**Headword:**

**Relevant legal provisions:**

EPC Art. 54  
RPBA 2020 Art. 13(2)  
EPC R. 124

**Keyword:**

Novelty - main request (no) - auxiliary requests (no)  
Amendment after summons - exceptional circumstances (no)  
Minutes of oral proceedings - request to record statement in  
the minutes (refused)

**Decisions cited:**

R 0007/17, T 0212/97, T 0642/97, T 0468/99, T 0263/05,  
T 1721/07, T 1354/18

**Catchword:**



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Case Number: T 1494/21 - 3.2.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.02**  
**of 9 March 2023**

**Appellant:** Covidien LP  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
26 July 2021 concerning maintenance of the  
European Patent No. 3266391 in amended form.**

**Composition of the Board:**

**Chairman** M. Alvazzi Delfrate  
**Members:** S. Böttcher  
N. Obrovski

## **Summary of Facts and Submissions**

- I. The opponent and the patent proprietor filed an appeal against the interlocutory decision of the opposition division to maintain European patent No. 3 266 391 on the basis of the first auxiliary request submitted on 26 June 2020.
- II. In order to help the parties to concentrate on essential points during the oral proceedings, the board issued a communication under Article 15(1) RPBA 2020, in which it indicated its preliminary opinion that the subject-matter of claim 1 of all claim requests lacked novelty over D4. Oral proceedings took place on 9 March 2023. In these oral proceedings, the case T 0450/20 relating to European patent No. 2 254 485 was also heard.
- III. Appellant 1 (opponent) requested that the decision under appeal be set aside and the patent be revoked.
- Appellant 2 (patent proprietor) requested that the appeal be dismissed and the patent be maintained as granted (main request) or, alternatively, that the patent be maintained on the basis of one of auxiliary requests 0 or 1 filed with the statement of grounds of appeal, on the basis of auxiliary request 1a filed during the oral proceedings or on the basis of one of auxiliary requests 2 to 4 filed with the reply to the opponent's statement of grounds of appeal.
- IV. By letter of 29 March 2023 the patent proprietor requested that the minutes of the oral proceedings be amended. The opponent replied to this request by letter

of 21 April 2023.

V. The following documents are relevant to the present decision.

D3 US 2003/0212430

D4 US 2005/0209678

D5 H. Henkes et al., "A Novel Microcatheter-Delivered, Highly-Flexible and Fully-Retrievable Stent, Specifically Designed for Intracranial Use", *Interventional Neuroradiology* 9: 391-393, 2003

D6 US 2006/0058836

D7 EP 1 437 097

D8 US 6,514,273

D9 US 2007/0208367

D10 US 2005/0267491

D11 US 6,458,139

D13 A. Doerfler et al., "A Novel Flexible, Retrievable Endovascular Stent System for Small Vessel Anatomy: Preliminary In Vivo Data", *AJNR Am J Neuroradiol* 26: 862-868, 2005

VI. Claim 1 of the patent as granted (main request) reads as follows.

"A self-expandable apparatus for removal of a thrombus in a blood vessel, comprising:  
a push or guide wire;  
a mesh structure of interconnected struts, the mesh structure comprising a first plurality of mesh cells, the mesh structure having a proximal end (3) and a distal end (2) wherein said distal end (2) of the mesh structure is configured to engage at least a portion of the thrombus to form a removable, integrated apparatus-thrombus mass;  
a tapering portion comprising a second plurality of

mesh cells, the tapering portion disposed toward the proximal end (3) of the mesh structure; and a connection point (9), at which the tapering portion converges, located at a proximal end (3) of the tapering portion, the tapering portion permanently attached to the push or guide wire (7) at or adjacent to the connection point (9); wherein the apparatus is pre-formed to assume a volume-enlarged form and, in the volume-enlarged form, takes the form of a longitudinally open tube tapering toward the connection point (9)."

VII. Claim 1 of both auxiliary request 0 and auxiliary request 1 is identical to claim 1 of the main request.

VIII. Claim 1 of auxiliary request 1a is based on claim 1 of the main request and further includes the term

"not releasably"

after the term "permanently".

IX. Claim 1 of auxiliary request 2 is based on claim 1 of the main request and further includes the feature

"for restoring localised flow to an occluded blood vessel"

after the term "A self-expandable apparatus".

X. Claim 1 of auxiliary request 3 is based on claim 1 of the main request and further includes the feature that the mesh structure is configured "to expand into penetrating contact".

- XI. Claim 1 of auxiliary request 4 contains both the amendments of claim 1 according to the second auxiliary request and the amendments of claim 1 according to the third auxiliary request.
- XII. The opponent's arguments relevant to the present decision can be summarised as follows.

*Main request, auxiliary request 0 and auxiliary request 1 - novelty in view of D4*

The discussion of whether or not D4 was novelty-destroying for claim 1 focused on the question of whether D4 disclosed a permanent attachment of the implant to the push or guide wire. It was undisputed that the remaining features of claim 1 were disclosed in D4.

It was pointed out in the patent in suit that the device of D4 included several features of the patent in suit (paragraph [0004]) and that the procedure described therein could be carried out with a device as disclosed in D4 (column 3, lines 27 to 30, and paragraph [0029] referring to US 7,300,458 being the granted patent to published publication D4).

The connection between the guide or push wire and the mesh structure according to D4 was detachable (claim 15), due to the coupling of the guide wire to the mesh structure by an electrolytically corrodible element. Hence, the connection between the guide wire and the device was permanent for as long as no electric current was applied to that element. The application of an electric current to the element required additional measures and equipment, in particular a power source and an electrode, which was to be placed on the surface

of the body.

When using a device as described in D4 for removal of a thrombus, neither a power source for electric current nor an electrode to be placed on the surface of the body was used. Hence, during the whole process of thrombus removal the connection between the guide wire and the device would be unaffected and would remain intact. No particular measures had to be taken to make the connection permanent. On the contrary, very special measures would have to be taken to destroy the connection. However, the fact that a connection might, in principle, be destructible could not constitute a reason for denying the existence of a permanent connection. Ultimately, every connection was destructible, in particular a connection involving a thin wire. This was also true for the connection of the patent. Even in the patent in suit it was pointed out in paragraph [0027] that the connection between the push wire and the distal segment could be released if it was determined that removal from the patient was not possible.

D4 already described the possibility of moving the device back into the microcatheter (paragraphs [0009], [0013]). The device of D4 was further described in D5. Full retrievability was described therein as particularly advantageous (title, summary) although the device in principle was a stent. On page 393, left column, last paragraph, the stent was described as firmly attached to the delivery system. Hence, no clear distinction between devices that were releasable and devices that remained attached existed at the priority date of the patent for persons skilled in the art. The question of whether a connection was permanent constituted a question as to how the attending



physician decided to carry out the medical intervention, not a question concerning an inherent feature of an apparatus.

It could not be derived from paragraph [0010] of the patent in suit referred to by the patent proprietor - that a permanent connection was, in principle, not releasable. It was merely stated that a certain releasable mechanism, probably the mechanism disclosed in Figures 19a and 19b, was not covered by the invention. The description of the patent did not include a positive definition of the term "permanent attachment".

In summary, since the attachment of the stent to the guide wire in D4 had to be regarded as permanent, the subject-matter of claim 1 was not novel in view of D4.

*Auxiliary request 1a - admittance*

Pursuant to Article 13(2) RPBA 2020, auxiliary request 1a should not be admitted into the appeal proceedings.

The submission during the oral proceedings concerning the releasable mechanism mentioned in paragraph [0010] was made in response to the patent proprietor's arguments. All arguments as to novelty over D4 had already been put forward in the written proceedings. Hence, there were no exceptional circumstances that could justify the late filing of a new request.

*Auxiliary requests 2 to 4*

No submissions were put forward with regard to auxiliary requests 2 to 4.

*Request for amendment of minutes of oral proceedings*

The patent proprietor's request to this effect should be rejected because

- 1) it was not in line with the opponent's recollection , and because
- 2) barring errors arising, neither party should influence the board, post-hearing, in deciding what should, or should not, be part of the minutes.

The request by the patent proprietor did not correspond to the opponent's recollection. After the chair had announced the board's conclusion that the subject-matter of claim 1 of EP 2 254 485 was not new in view of D4, the representative of the patent proprietor asked for an explanation of the conclusion. However, this was not done to ensure that the decision was not based on new facts and arguments that were not part of the proceedings or to ensure that the right to be heard was not violated. Instead, the question was raised as to whether the decision was based on arguments allegedly presented for the first time in the oral proceedings. This was different from ensuring the right to be heard because, even if an argument had been presented in the oral proceedings for the first time (which was not the case), the patent proprietor would have had the opportunity to comment thereon.

Consequently, after an interruption of the proceedings and deliberation, the chair announced that there was no need to explain the basis for the conclusion at that time, but pointed out that paragraph [0010] of EP 2 254 485 had not been of particular importance for the conclusion and that it was the view of the board that a release mechanism was not inconsistent with a permanent attachment. Anyway, paragraph [0010], as well as severa

1 other parts of EP 2 254 485, and D4 were discussed at length in written submissions of the parties and in the oral proceedings; hence, this was not a question of Article 113 EPC. The board had given both parties ample time to present their comments.

In parallel proceedings the patent proprietor had already announced that it was considering the option of filing a petition for review according to Article 112a(2)(c) EPC. It was the impression of the opponent that the patent proprietor was trying - with its request- to shape the minutes in a way that might support such a petition.

According to Rule 124 EPC and also in accordance with Article 6(4) RPBA, the preparation of the minutes should be the responsibility of the board, not the responsibility of the parties, let alone one of the parties. Submissions of the parties were not typically summarised in the minutes but in the written decision (T 1721/07). The minutes did not seem to include any errors and the question of which statements from each of the parties should be part of the minutes was left to the discretion of the board. The board should not be influenced by either party's post-hearing request, as that would subvert the fairness of the procedure. In particular, the request of the patent proprietor during the oral proceedings for an explanation of the reasons for the conclusion was not important for the decision itself.

XIII. The patent proprietor's arguments relevant to the present decision can be summarised as follows.

*Main request, auxiliary request 0 and auxiliary request*

*1 - novelty in view of D4*

D4 did not describe a permanent connection between the guide wire and the stent. In D4, the guide wire was connected detachably, by means of a separating element (paragraphs [0056], [0058], [0062]), such as an electrolytically corrodible element (claim 16). This was supported by the purpose of the stent described in D4. Since this was an implantable stent (title), the push or guide wire had to be detached at some point in time after introduction into the blood vessel.

The literal meaning of "permanently attached" was that the parts were attached in a permanent manner, i.e. the attachment was configured to last forever without already including means for ending it. A permanent connection was - if used for the intended purpose - not configured to be released.

The person skilled in the art was aware of this distinction, as - in the technical field of treating blood vessels - releasable devices were known, requiring means for disconnecting the treatment device (stent) from the positioning device (guide wire) (D4, D13) and, in contrast, permanently attached devices not comprising such disconnecting means were also known (D3, D6, D7, D8, D9, D10, D11). Furthermore, the meaning of "attached" and different ways of attaching the treatment device to the positioning device were disclosed in D3 (paragraph [0059]) and in D9, distinguishing between permanent and releasable attachments (paragraphs [0026] and [0027]).

Moreover, using "permanently" together with "attached" only made sense if the term "permanently" further specified the properties of the attachment such that

certain attachments were thereby excluded.

Also, the description of the patent described two alternatives for the connection between the mesh and the guide wire. In paragraph [0004], it was stated that the connection in D4 was releasable. In paragraph [0010] (column 3, lines 24 to 27), it was mentioned that a permanent attachment was in line with the invention, while a releasable attachment was disclaimed. Since D4 described the same release mechanism as the patent, the person skilled in the art would clearly have recognised that the device of D4 did not fall within the scope of the claim. It was obvious that a releasable connection could not be regarded as permanent. A positive definition of the term "permanent" was not necessary.

The description of the application as originally filed also distinguished between a permanent attachment and a non-permanent attachment, which included means for releasing the connection (page 6, lines 21 to 22).

As a consequence, the person skilled in the art learned from the wording of claim 1 as well as from the description of the present patent that a permanent connection could be distinguished from a non-permanent connection by the way in which the connection was achieved. If the device did not contain means for releasing the connection, the connection was configured to last forever and was therefore specified as being "permanent". However, if the connection contained means for releasing the connection, such as in D4, the connection would last until the user activated the means for releasing the connection, i.e. not necessarily forever. Therefore, this was not a permanent connection, but a releasable connection,

which did not fall within the scope of claim 1.

Therefore, D4 did not disclose a permanent connection as claimed.

The fact that the present patent also described a releasable attachment mechanism did not change the meaning of the feature "permanently attached". This was the case, in particular, since the patent clarified in paragraph [0010] that such a releasable mechanism was not in accordance with the present invention.

As a consequence, the subject-matter of independent claim 1 was novel over D4.

*Auxiliary request 1a - admittance*

The opponent had submitted during the oral proceedings that only the specific releasable mechanism of Figures 19a and 19b had been disclaimed in paragraph [0010], and not any releasable attachment. This new submission, made for the first time in the appeal proceedings, constituted exceptional circumstances justifying the filing of a new auxiliary request.

Thus, auxiliary request 1a should be admitted.

*Auxiliary request 2 - novelty in view of D4*

The subject-matter of claim 1 was novel in view of D4 since D4 did not consider the possibility of achieving immediate flow restoration.

*Auxiliary request 3 - novelty in view of D4*

D4 did not consider any interaction of the described

mesh structure with a thrombus. Hence, the subject-matter of claim 1 was novel in view of D4.

*Auxiliary request 4 - novelty in view of D4*

Claim 1 according to auxiliary request 4 contained the amendments of claim 1 according to auxiliary request 2 as well as the amendments of claim 1 according to auxiliary request 3. Therefore, the subject-matter of claim 1 according to auxiliary request 4 was novel over D4.

*Request for amendment of minutes of oral proceedings*

According to Rule 124(1) EPC, the minutes of oral proceedings had to contain the essential points of the oral proceedings.

In the oral proceedings, after the chair's announcement of the board's conclusion that the subject-matter of claim 1 of EP 2 254 485 B1 was not new in view of D4, the patent proprietor's representative had asked the board to explain the basis for that conclusion. The representative had explained the reason for the request as being a precautionary measure in order to ensure that the decision was not based on new facts and arguments that had not been part of the current proceedings. The representative further stated that there would, otherwise, be the danger that the right to be heard might be violated. The board had interrupted the proceedings to deliberate on this petition and had subsequently announced that it was not necessary to explain the basis for the conclusion at that time, and that the conclusion was based on the subject-matter submitted with the briefs and discussed in the oral proceedings.

Since the above discussion between the board and the patent proprietor's representative was considered to be an essential part of the proceedings, it was requested that the following section be added after the paragraph containing the announcement that claim 1 of EP 2 254 485 B1 was not new:

"The patent proprietor asked the Board to indicate the reason for this conclusion in order to prevent the decision from containing new considerations on which the parties were not heard. After deliberation, the Board asserted that the decision is based solely on the parties' submissions, but did not explain the reasons for the decision."

### **Reasons for the Decision**

1. The patent

The claimed subject-matter relates to an apparatus for restoring blood flow in occluded blood vessels, particularly occluded cerebral arteries. The apparatus (shown in Figure 1 of the patent, reproduced below) is self-expandable and comprises a push or guide wire (7) and a mesh structure. The mesh structure has a proximal end (3) and a distal end (2) and a tapering portion disposed toward the proximal end. The distal end (2) is configured to engage at least a portion of the thrombus to form a removable, integrated apparatus-thrombus mass. The apparatus further comprises a connection



point (9) located at the proximal end of the tapering portion. The tapering portion is permanently attached to the wire (7) at or adjacent to the connection point. The apparatus is pre-formed to assume a volume-enlarged form, in which it takes the form of a longitudinally open tube tapering towards the connection point.

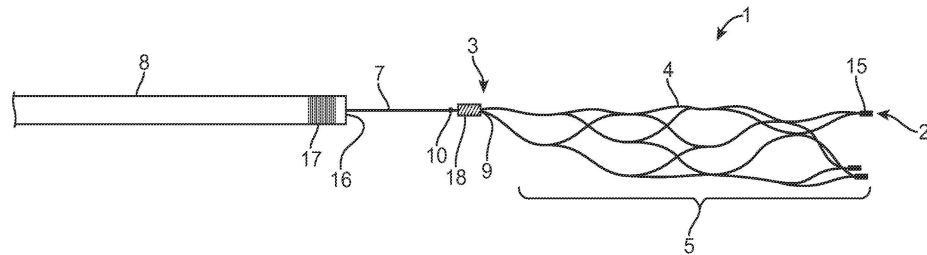


FIG. 1

2. Main request, auxiliary request 0 and auxiliary request 1 - novelty in view of D4

2.1 It is undisputed that D4 discloses a mesh structure forming a medical implant (stent) 1 having a tapering portion that is connected to a guide wire 21 (Figure 5), and that the mesh structure is suitable to engage at least a portion of the thrombus to form a removable, integrated apparatus-thrombus mass. It is mentioned in paragraphs [0014] and [0032] of the present patent that the apparatus of US 7,300,458, which is the granted patent to published application D4, may be employed for the methods described in the patent.

2.2 As acknowledged by both parties, the discussion of whether or not D4 is novelty-destroying for the subject-matter of claim 1 solely concerns the question of whether D4 discloses a tapering portion of the implant 1 which is "permanently attached" to the push or guide wire 21, in particular in view of the fact that in the apparatus according to D4 the implant can

be detached from the push or guide wire.

- 2.3 According to the established case law, patent claims must be interpreted through the eyes of the person skilled in the art, who should try - with synthetical propensity - to arrive at an interpretation of a claim which is technically meaningful and takes into account the whole disclosure of the patent (see Case Law of the Boards of Appeal, 10th edition 2022, II.A.6.1, first paragraph).
- 2.4 In the present case, both parties took the description of the patent into account to arrive at their differing interpretations of the expression "permanently attached". This is in line with the approach taken by the present board in a different composition in decision T 1473/19, Reasons 3.15, according to which the principles of claim interpretation as set out in Article 69 EPC and Article 1 of the Protocol on the Interpretation of that provision are to be applied in proceedings before the EPO.
- 2.5 Claim 1 itself neither defines nor specifies the term "permanently attached" further, either in terms of constructional features or in terms of the conditions under which the attachment is maintained. This matters insofar as the primacy of the claims under Article 69(1), first sentence, EPC, limits the extent to which the meaning of a certain claim feature may be affected by the description and the drawings (T 1473/19, Reasons 3.16.1).
- 2.6 Having said this, Article 69(1), second sentence, EPC, requires that the description and the drawings be taken into account when interpreting a patent claim. In the present case, the description of the patent does not

provide a definition of the term "permanently attached" either. The Board understands a definition as a statement which explains the meaning of a term used in the patent in a lexicographic and general manner (i.e. not only in the context of a certain embodiment), for example by specifying necessary and sufficient conditions for when that term should be used. In the description, reference to the feature "permanently attached" is only made in paragraph [0010] (column 3, lines 23 to 27) thereof: "In one embodiment, the distal segment 1 has a tapering structure at its proximal end 3 where the strings or filaments or struts converge at a connection point 9. The push wire 7 is preferably attached at or adjacent to the connection point 9. Such attachment 10 may be permanent, in accordance with the invention, or a releasable mechanism, not in accordance with the present invention."

2.7 In the board's view, the person skilled in the art understands the term "permanently" in claim 1 as characterising the attachment of the tapering portion of the implant to the push or guide wire with regard to how long this attachment will last. Therefore, this feature is arguably limiting to the extent that it requires the attachment to last a certain amount of time. However, as explained above, the required duration or durability of the attachment is not specified further anywhere in the patent, either in the claims or in the description.

2.8 The patent proprietor argued that an attachment was only permanent within the meaning of claim 1 if it was configured to last forever. The board does not consider this line of argument persuasive since the term "forever" indicates an endless period of time and is therefore not appropriate to specify the duration of a

connection which is part of a physical object. In the physical world, nothing lasts forever in its current form. Furthermore, a physical connection can always be detached if an appropriate external force is applied.

- 2.9 Against this background, the board considers the intended use of the claimed apparatus according to the patent to be the appropriate criterion for determining the required duration or durability of the attachment. The board thus construes the term "permanently" in claim 1 to mean that the attachment must last long enough for a thrombus to be reliably extracted by pulling on the guide wire (see paragraph [0005] of the patent). Contrary to the patent proprietor's allegation, this meaning does in the board's view not already follow from the word "attached" itself, since it is possible - if a use according to the patent is not intended - to realise an attachment that does not last long enough to allow the reliable extraction of a thrombus by pulling on the guide wire. However, even if the meaning as described above already followed from the word "attached" itself, it would not change the board's interpretation of claim 1, as it is - contrary to the patent proprietor's assertion - quite possible that a certain word in a claim does not have any limiting effect of its own.
- 2.10 This understanding of a "permanently attached" tapering portion does not exclude that the same tapering portion may - under certain conditions, for instance under the effect of corrosion caused by an electric current - be released from the push or guide wire.
- 2.11 The patent proprietor disagreed with this understanding, arguing that the description of the present patent defined "permanent" as the opposite of

"releasable".

- 2.12 The board cannot concur with this view. In paragraph [0004], which is part of the section "Background of the invention", a brief description of D4 is given, and it is mentioned in this context that in D4 the connection between the stent and the guide wire is releasable, since the stent is permanently implantable. However, the mere fact that D4 is referred to in this section of the patent does not automatically exclude it from falling within the scope of the invention as described in claim 1. Acknowledging a document in the description as a prior-art document is not sufficient to render the claimed subject-matter novel in view of this document.
- 2.13 The patent proprietor also argued that paragraph [0010] of the description - stating in the context of an embodiment that the connection at or adjacent to the connection point is "permanent, in accordance with the present invention or a releasable mechanism, not in accordance with the present invention" - disclaimed releasable connections. As explained above (see point 2.6), this does not define the meaning of the term "permanently attached" for the entire patent in a lexicographic and general manner. At most, this paragraph can be understood as an attempt to exclude from the claims, i.e. disclaim, releasable mechanisms by an amendment to a part of the description concerning a specific embodiment.
- 2.14 Taking account of the description and the drawings when interpreting a feature which is present in a claim is quite different from reading into a claim a - positive or negative - feature which is only present in the description or the drawings. As explained in T 1473/19, Reasons 3.11 to 3.15, the principles of claim

interpretation set out in Article 69 EPC and Article 1 of the Protocol on the Interpretation of that provision are to be applied when determining a patent claim's subject-matter in proceedings before the EPO. According to Article 69(1), first sentence, EPC, only the claims determine the extent of protection. The description and the drawings have no such function, and must only be used to interpret the claims. This means that the description and the drawings can only be used for interpreting features which are already present in the claims, but not for adding further - positive or negative - claim features or for replacing existing claim features by others. In the present case, the exclusion of a releasable mechanism is only indicated in the description, but not in the claims. Assigning to the term "permanently attached" in claim 1 - on account of paragraph [0010] of the description - the meaning that it excludes any releasable device would go beyond the mere interpretation of this claim feature in light of the description. It would, in fact, amount to adding a further limitation to the claim which is only present in the description - and this would not be in line with the principle of primacy of the claims (see T 1473/19, point 3.16.1). Hence, claim 1 of the patent as granted cannot be understood, on the basis of paragraph [0010] of the description, as excluding any releasable mechanism.

2.15 The patent proprietor further argued that the description of the application as originally filed states that the attachment at the connection point might be "permanent or a releasable mechanism" (page 6, lines 21 to 22). However, unlike the description of the patent, the application as originally filed is not referred to in Article 69(1), second sentence, EPC, as part of what must be taken into account when

interpreting a patent (T 1473/19, Reasons 4.4). The application as originally filed often - and also in the present case - differs from the patent as granted, regarding both the claimed invention and the contents of the description, and it usually cannot, for this reason alone, provide guidance for interpreting the claims of the patent as granted.

- 2.16 In any case, in view of the reasons set out above for the board's interpretation of claim 1 as granted, the board does not consider the incidental statement in the application as filed according to which the attachment "may be permanent or a releasable mechanism", to be a sufficient reason to interpret claim 1 as granted such that it excludes an attachment involving a releasable mechanism.
- 2.17 In conclusion, the description of the patent does not teach that any attachment that can potentially be released by the user must not be regarded as permanent. In other words, it does not follow from the description that the absence of the possibility of releasing the attachment is a prerequisite for the attachment to be considered permanent within the meaning of claim 1.
- 2.18 As stated by the patent proprietor, some prior-art documents (D4, D13) relate to systems for delivering stents which are releasable from the guide wire, whereas others (D3, D6, D7, D8, D9, D10 and D11) relate to systems for capturing a thrombus by means of a filter or basket which is not releasable from the guide wire. The board also acknowledges that in D3 and D9 a distinction is made between permanent connections and releasable connections.

- 2.19 As set out in point 2.3 above, patent claims must be interpreted through the eyes of the person skilled in the art. This includes taking account of the skilled person's common general knowledge. The prior art documents invoked by the patent proprietor are, however, not suitable evidence for proving the skilled person's understanding of the term "permanently attached" according to common general knowledge. Rather, this would have required evidence such as textbooks or technical lexica (see T 1354/18, Reasons 11).
- 2.20 The Board also notes that the material to be taken into account for claim interpretation under Article 69 EPC - in addition to the claims themselves - is limited to the description and the drawings (T 1473/19, Reasons 3.18). Prior-art documents are not part of the material referred to in that provision.
- 2.21 Furthermore, it cannot be assumed that a technical term which is used in a certain prior-art document and has a certain meaning in that document will have the same meaning in the patent claim to be interpreted merely because that claim uses the same term. Any text must be interpreted in its context (see T 1646/12, Reasons 2.1), and different documents, such as the patent under consideration on the one hand and a prior-art document like D3 or D9 on the other hand, necessarily provide different contexts for the terms contained therein and subject to interpretation.
- 2.22 While parties and the deciding body are not prevented from referring to prior-art documents in support of their understanding of a certain technical term used in the claims, account must be taken of the above limitations when proceeding in this manner. In the



present case this means that, even if one acknowledges that a distinction between permanent connections and releasable connections is made in certain prior art documents, this distinction cannot simply be transferred and applied to the patent as granted and claim 1 thereof, which itself does not contain any indication of being based on such a distinction.

- 2.23 Having set out how the expression "permanently attached" in claim 1 has to be interpreted, it must now be considered whether the tapering portion of the apparatus of D4 is "permanently attached" within the meaning of the claimed invention.
- 2.24 In D4, the implant is connected to the guide wire by a separating element 23 in such a manner as to be detachable by electrolytic corrosion. Paragraph [0058] mentions a steel material for the separating element, the material being susceptible to corrosion in an electrolyte under the influence of electrical energy. This means that, without electrical energy being provided to the separating element (which would require additional measures and equipment), the connection between the guide wire and the implant will remain intact.
- 2.25 The patent itself acknowledges in paragraph [0010] (column 3, lines 27 to 30) that the apparatus of D4 can be used to restore localised blood flow to an occluded vascular site. The patent does not indicate any need to modify the apparatus of D4 to achieve this. If the apparatus of D4 is used for the purpose of removing a thrombus as described in the patent, there is obviously no reason to apply an electrical voltage to the separating element, which would destroy the connection and make the removal of the thrombus impossible. When

removing a thrombus, the user will therefore refrain from doing this, and the attachment will last long enough to reliably extract the thrombus by pulling on the guide wire.

- 2.26 Claim 1 is an apparatus claim, and the mere existence of the possibility of terminating the attachment of the implant to the guide wire in the apparatus of D4 does not, in itself, have any impact on the duration of that attachment. Instead, the separating arrangement in the apparatus of D4 only provides the *potential* to terminate the attachment. The realisation of this potential requires a deliberate choice and action on the part of the user in order to provide electrical energy to the separating element of the apparatus of D4, which - in turn - requires the use of external equipment. In the absence of such user choice and action, the connection in the apparatus of D4 remains intact without any inherent limitation in time caused by the provision of the separating arrangement.
- 2.27 The patent proprietor also argued that a permanent attachment was mechanically more stable and secure, and that therefore the person skilled in the art would not consider the connection of D4 as permanent.
- 2.28 The board considers that in D4 the provision of a separating element which is made of corrodible steel does not, in itself, weaken the connection and does not therefore render the device less stable or secure. It is, in fact, mentioned in paragraph [0062] that a structural or chemical weakening "may be beneficial" as an optional, additional measure.
- 2.29 Furthermore, contrary to the patent proprietor's view, Figures 8a and 8b do not reveal that the dumb-bell-

shaped element 23 allows the implant to be separated from the guide wire. Instead, it follows from the description of D4 that further means, such as a power source or electrical contacts, are needed to apply current to the dumb-bell to detach the implant from the guide wire. No such means are disclosed in Figures 8a and 8b.

- 2.30 Moreover, none of the prior-art documents referred to by the patent proprietor suggest that the presence of an electrolytically corrodible element in a steel connection - as in the apparatus according to D4 - renders such an attachment non-permanent within the meaning of claim 1.
- 2.31 In conclusion, the person skilled in the art understands the connection in D4 realised by the dumb-bell-shaped element made of corrodible steel as a permanent connection within the meaning of claim 1, i.e. as a form of attachment which lasts long enough to allow reliable extraction of a thrombus by pulling on the guide wire. Hence, the attachment provided in the apparatus of D4 is permanent within the meaning of claim 1.
- 2.32 Consequently, the subject-matter of claim 1 of the main request lacks novelty over D4. Since claim 1 of auxiliary requests 0 and 1 are identical to claim 1 of the main request this conclusion applies also to those claims.
3. Auxiliary request 1a - admittance
- 3.1 During the oral proceedings before the board, the patent proprietor amended its case by filing auxiliary

request 1a.

- 3.2 The admittance of that request is subject to the conditions set out in Article 13(2) RPBA 2020. According to these conditions, amendments to a party's appeal case are, in principle, not to be taken into account unless there are exceptional circumstances which have been justified with cogent reasons.
- 3.3 In the board's view, there are no such exceptional circumstances. In the statement of grounds of appeal, the appellant stated that "the fact that a connection may in principle be destroyable cannot be a reason for negating a permanent connection". To corroborate this statement, the appellant referred to the patent disclosing in paragraphs [0027] and [0028] an embodiment with a releasable connection which allowed the mesh structure to be left in situ when it was no longer retrievable. The appellant further referred to claim 8 as granted showing that such an embodiment was considered by the patent proprietor to be part of the patent. Hence, the appellant had already submitted in the written proceedings that claim 1 as granted covered releasable attachments and that a releasable attachment could be regarded as permanent.
- 3.4 The appellant's line of argument as referred to above was taken up in the board's communication under Article 15(1) RPBA 2020, in which the board had indicated its preliminary opinion that the subject-matter of claim 1 of all claim requests lacked novelty over D4 because the "connection between the guide wire and the stent can be regarded as permanent [...] as long as it is not released".

- 3.5 During the oral proceedings, the patent proprietor referred to paragraph [0010] (lines 23 to 27) of the patent stating that a releasable mechanism was not in line with the invention. According to the proprietor, this statement supported its view that the patent clearly distinguished between permanent and releasable attachments.
- 3.6 The opponent replied to that submission by pointing out that paragraph [0010] did not include a clear statement to the effect that a permanent attachment was strictly not releasable. According to the opponent, the cited passage merely excluded certain release mechanisms from the invention.
- 3.7 The board cannot concur with the patent proprietor that this argument was raised for the first time in the oral proceedings before the board, and that this constituted exceptional circumstances justifying the filing of a new claim request in response thereto.
- 3.8 The board notes that a party may refine an objection within the previously established framework without this automatically constituting an amendment of its appeal case which could justify the filing of a new claim request. This also applies to a board taking up and refining arguments introduced by a party (T 1891/20, Reasons 4.1.4). In the present case, the opponent did in fact simply further elaborate on an argument already put forward in the written submissions, namely that the description of the patent did not clearly distinguish between permanent and releasable attachments.

- 3.9 In conclusion, the board decided not to admit auxiliary request 1a into the proceedings.
4. Auxiliary requests 2 to 4 - novelty in view of D4
- 4.1 According to claim 1 of auxiliary request 2, the apparatus is "for restoring localised flow to an occluded blood vessel".
- 4.2 The present patent mentions (column 3, lines 27 to 30) that the methods disclosed therein can be performed with the distal segment (or apparatus or stent) of D4. Hence, the apparatus of D4 has to be considered to be suitable for restoring localised flow to an occluded vessel.
- 4.3 Therefore, the subject-matter of claim 1 of auxiliary request 2 lacks novelty over D4.
- 4.4 According to claim 1 of auxiliary request 3, the distal end of the mesh structure is "configured to expand into penetrating contact to engage at least a portion of the thrombus".
- 4.5 The present patent mentions (column 3, lines 27 to 30) that the methods disclosed therein can be performed with the distal segment (or apparatus or stent) of D4. Hence, the apparatus of D4 has to be considered to be configured to expand into penetrating contact.
- 4.6 Therefore, the subject-matter of claim 1 of auxiliary request 3 lacks novelty over D4.
- 4.7 Claim 1 of auxiliary request 4 combines the features of claim 1 of auxiliary request 2 and claim 1 of auxiliary request 3. Hence, the reasoning given for these

auxiliary requests applies mutatis mutandis.

5. Since none of the requests on file is allowable, the patent has to be revoked.
6. Request for amendment of minutes of oral proceedings
  - 6.1 By its submission dated 29 March 2023, the patent proprietor requested a correction of the minutes as indicated in point XIII above.
  - 6.2 Pursuant to Rule 124(1) EPC, minutes of oral proceedings are to be drawn up, containing the essential points of the oral proceedings and the relevant statements made by the parties.
  - 6.3 Under Article 6(4) RPBA 2020, the minutes of oral proceedings are to be drawn up by a member of the deciding board or the registrar, as designated by the chair. According to the travaux préparatoires to this provision, "the minutes drawn up by the board record the essential procedural acts, for example the parties' requests and the submission of documents during the oral proceedings. However, arguments presented by the parties during the oral proceedings are not generally included in the minutes, although they may form part of the board's written decision" (CA/3/19, page 22).
  - 6.4 As explained in T 1891/20, Reasons 2.3, it is at the discretion of the minute-taker what to consider "essential" or "relevant" (T 212/97, Reasons 2.2; T 642/97, Reasons 9.3; R 7/17, Reasons 23). A summary of the arguments made by the parties during the oral proceedings is not usually included in the minutes (T 1721/07, Reasons 17; see also T 263/05, Reasons 8.7). The minutes do not normally record any questions

posed by the parties to the board either. Moreover, the board is responsible for deciding on what needs to be recorded in the minutes, not the parties (T 468/99, Reasons 1.5; T 1721/07, Reasons 15).

- 6.5 According to the unanimous recollection of all three members of the board, after the chair had announced the board's conclusion in the oral proceedings that in case T 0450/20 the subject-matter of claim 1 of the patent as granted lacked novelty over D4, the patent proprietor asked for the board's reasons for this conclusion, and in particular whether paragraph [0010] of the patent had been decisive. After deliberation, the chair had informed the parties that the board considered the feature "permanently attached" in claim 1 not to exclude a release mechanism as in D4 and that paragraph [0010] of the patent had not been of particular importance for the board's conclusion. The chair further stated that the details of the board's reasoning would be contained in its written decision.
- 6.6 According to the unanimous recollection of all three members of the board, the patent proprietor did not refer at any time in the oral proceedings to a potential violation of its right to be heard.
- 6.7 The patent proprietor is thus requesting the insertion of a paragraph into the minutes which is - according to the unanimous recollection of all three members of the board and the representative of the appellant - factually incorrect. Moreover, as explained above, the minutes do not normally record any questions posed by the parties to the board, as such questions do not usually - and also in the present case - form part of the essential issues of the oral proceedings. As an aside, the board also notes that parties are not



entitled to receive advance indications of the reasons for a decision (see, for example, R 19/11, Reasons 2.2).

6.8 The request for amendment of the minutes of the oral proceedings is therefore refused.

## Order

### **For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



C. Moser

M. Alvazzi Delfrate

Decision electronically authenticated