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**Datasheet for the decision  
of 23 January 2024**

**Case Number:** T 1686/21 - 3.2.01

**Application Number:** 14163073.1

**Publication Number:** 2789314

**IPC:** A61F2/24

**Language of the proceedings:** EN

**Title of invention:**

Minimally invasive valve replacement system

**Patent Proprietor:**

Medtronic 3F Therapeutics, Inc.

**Opponent:**

Boston Scientific Corporation

**Headword:**

**Relevant legal provisions:**

EPC Art. 76(1)

RPBA 2020 Art. 13(2)

**Keyword:**

**Decisions cited:**

**Catchword:**

Exceptional circumstances may justify the admissibility of a request filed for the first time at the oral proceedings before the board even when the amendment to the case is made in response to an objection of added subject-matter raised long in advance (see Reasons, 1.5).



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Case Number: T 1686/21 - 3.2.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 23 January 2024**

**Respondent:** Medtronic 3F Therapeutics, Inc.  
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**Appellant:** Boston Scientific Corporation  
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**Representative:** Peterreins Schley  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
27 July 2021 concerning maintenance of the  
European Patent No. 2789314 in amended form.**

**Composition of the Board:**

**Chairman** G. Pricolo  
**Members:** V. Vinci  
A. Jimenez

## **Summary of Facts and Submissions**

- I. Appeals were filed by the patent proprietor and the opponent against the interlocutory decision of the opposition division to maintain European patent No. 2789314 in amended form.

In its decision, the opposition division found that the ground for opposition pursuant to Article 100(c) in association with Article 76(1) EPC was prejudicial to the maintenance of the patent as granted. It decided to maintain the patent in amended form according to auxiliary request 1 submitted at the oral proceedings.

With a communication pursuant to Article 15(1) RPBA dated 18 October 2023 the board informed the parties of its preliminary, non-binding assessment of the case.

Oral proceedings pursuant to Article 116 EPC were held before the board on 23 January 2024 by videoconference.

At the end of the oral proceedings the patent proprietor withdrew its appeal.

- II. The final requests of the parties were as follows:

The appellant (opponent) requested that the decision under appeal be set aside and that the patent be revoked.

The respondent (patent proprietor) requested that the patent be maintained according to the main request filed as auxiliary request 1f" during the oral proceedings before the board.

III. Claim 1 according to the main request reads as follows:

*"A replacement valve assembly comprising a collapsible and expandable anchoring structure which comprises an inflow rim (20) formed with a zigzag configuration;*

*an outflow rim (23) formed with a zigzag configuration;*

*and three support posts (22) which extend longitudinally from the inflow rim (20) to the outflow rim (23),*

*wherein the support posts (22) are configured in the shape of a paddle and comprise blades (30) for attachment of commissural tabs of the valve (32) with an axial slot extending internally within the blades,*

*and wherein the blades are oriented toward the outflow rim of the anchoring structure and connect to the outflow rim at valleys; and*

*wherein the proximal ends (25) of the vertical support posts (22) are connected to peaks (29) of the inflow rim (20), and*

*the distal ends (24) of the support posts (22) are connected to valleys (27) of the outflow rim (23), and a valve (32), wherein*

*an inflow annulus of the valve is supported at the inflow rim (20) and commissural tabs of the valve are attached to the blades (30) of the support posts (22), wherein the outflow rim (23) of the anchoring structure is configured to be longitudinally displaced from a distal outflow annulus (34) of the valve leaflets (36) that reside within the lumen of the anchoring structure*

*and wherein the geometry of the anchoring structure is configured such that the geometry positions it across the entire longitudinal extension of a native valve sinus, wherein the inflow rim fits into the native valve sinus at a position near the inflow annulus of the native valve sinus against which it is designed to rest, while the outflow rim fits into the sinus at a position near the outflow annulus of the sinus against which it is designed to rest."*

## **Reasons for the Decision**

### **Admissibility**

1. The main request is admitted into the appeal proceedings under Article 13(2) RPBA.
  - 1.1 It was filed as auxiliary request 1f" during the oral proceedings before the board in reaction to the board's finding that the omission, in claim 1 of the patent as maintained, of the feature that the supports were configured in the shape of a paddle resulted - contrary to the assessment of the opposition division - in an unallowable intermediate generalisation of a specific embodiment disclosed in the originally filed international parent application WO 2005/046528. This therefore infringed Article 76(1) EPC.
  - 1.2 The appellant (opponent) contested the admissibility of this late-filed request. Contrary to the opinion of the respondent (patent proprietor), the appellant (opponent) put forward that the submission of this request for the first time in the oral proceedings amounted to an amendment to the patent proprietor's

appeal case, the admissibility of which would be subject to the strict conditions set out in Article 13(2) RPBA. The appellant (opponent) thereby argued that, as the omission of the feature in question had been the subject of an objection both during the opposition proceedings and in its statement of grounds of appeal, the respondent (patent proprietor) could and should have filed this request already during the first-instance proceedings or, at the latest, with its statement of grounds of appeal. Furthermore, it was argued by the appellant (opponent) that the facts as alleged by the respondent (patent proprietor) in order to justify the amendment of its case at such a late stage of the appeal proceedings did not amount to "*exceptional circumstances justified by cogent reasons*" within the meaning of Article 13(2) RPBA. Furthermore it was alleged by the appellant (opponent) that the main request was not duly substantiated.

- 1.3 Contrary to the respondent's (patent proprietor's) assertions, the board takes the view that the submission of the new request at issue, which contains further limitations inserted into independent claim 1 of the patent as maintained, represents an amendment of the respondent's (patent proprietor's) appeal case within the meaning of Article 13(2) RPBA. The board agrees with the respondent (patent proprietor) that the feature added to claim 1 of the patent as maintained - namely that the support posts are configured in the shape of a paddle - had already been added to claim 1 of several of the auxiliary requests submitted by the respondent (patent proprietor) in order to overcome the same added subject-matter objection. However, the specific combination of features now recited in claim 1 was never claimed as such in any of the requests filed by the respondent (patent proprietor). Since an

amendment to a claim must be considered in the context of the whole claim rather than in isolation, the main request at issue represents an amendment of the respondent's case in appeal.

1.4 It is uncontested that the "*paddle shape*" of the supports (22) now recited in claim 1 of the main request is directly and unambiguously derivable from the description of the international parent application, page 12, line 34, to page 13, line 10, in association with Figure 5.

1.5 That said, the board observes:

that, as stated above, the amendment under discussion is already present in several auxiliary requests filed during the first-instance proceedings and re-submitted by the respondent (patent proprietor) on appeal in order to address the objection raised by the appellant (opponent) concerning omission of the "*paddle shape*" feature;

that, in view of the above, the objection of lack of substantiation is not justified;

that this amendment explicitly defines the feature that the supports (22) are "*configured in the shape of a paddle*", which the opposition division implicitly read - albeit erroneously in the board's view - into the wording of independent claim 1 of the patent as maintained taken as a whole;

that this amendment clearly addresses and solves the issue under Article 76(1) EPC raised by the appellant (opponent) against the patent as maintained in relation to the omission of the paddle shape of the supports,



that, in view of all the above, the amendment cannot be considered surprising for the appellant (opponent) in such a way as to negatively affect its position in the appeal proceedings, thereby giving an advantage to the other party, in particular given that the opposition division understood the feature in question to be implied in claim 1 as maintained;

that the amendment at issue does not give rise to new objections and is not detrimental to procedural economy,

and, last but not least, that - as convincingly argued by the respondent (patent proprietor) - in view of the large number of different objections raised under Article 76(1) EPC, the number of requests to be filed at the very beginning of the appeal proceedings in order to provide appropriate fall-back positions for every possible outcome of the assessment of compliance with Article 76(1) EPC would have been extremely high and, as therefore not compliant with procedural efficiency.

- 1.6 The board considers that the above circumstances represent exceptional circumstances within the meaning of Article 13(2) RPBA justifying the admittance of the main request under consideration.
2. The appellant (opponent) confirmed during the oral proceedings that the remaining issues among those previously raised under Article 76(1) EPC against the patent as maintained by the opposition division and which could, in principle, affect the main request were not to be maintained, and that it did not have any further substantial objections. As the board likewise

see no reason for further objections, the contested patent can be maintained according to the main request.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent as amended in the following version:

Description: paragraphs 1-44, 46-158 of the patent specification, paragraph 45 as amended during the oral proceedings before the opposition division,

Claims: No. 1-9 according to the main request filed as auxiliary request 1f'' during the oral proceedings before the board, and

Drawings: 1-49 of the patent specification.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated