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**Datasheet for the decision
of 18 June 2024**

Case Number: T 2310/22 - 3.4.01

Application Number: 15700629.7

Publication Number: 3092035

IPC: A61N1/372, A61B5/0464,
A61B5/00, A61N1/362, H04B13/00,
A61N1/39, A61B5/0205

Language of the proceedings: EN

Title of invention:

COMMUNICATION OF THERAPY ACTIVITY OF A FIRST IMPLANTABLE
MEDICAL DEVICE TO ANOTHER IMPLANTABLE MEDICAL DEVICE

Patent Proprietor:

Cardiac Pacemakers, Inc.

Opponent:

Boult Wade Tennant LLP

Headword:

Communication between implantable LCPs/Cardiac Pacemakers, inc.

Relevant legal provisions:

EPC Art. 123(2)

RPBA 2020 Art. 12(2), 12(6), 13(1), 13(2), 11

Keyword:

Main Request, Auxiliary Request 1 - Amendments allowable (no)
Auxiliary Request 1A - Late filed request - admitted (no)
Auxiliary Request 1B - Amendments allowable (yes)
Primary object of appeal proceedings to review decision -
Remittal (yes)



Beschwerdekammern

Boards of Appeal

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Case Number: T 2310/22 - 3.4.01

D E C I S I O N
of Technical Board of Appeal 3.4.01
of 18 June 2024

Appellant: Cardiac Pacemakers, Inc.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 28 September
2022 revoking European patent No. 3092035
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chair P. Scriven
Members: A. Medeiros Gaspar
R. Winkelhofer

Summary of Facts and Submissions

- I. The patent was opposed on grounds under Articles 100(a), (b), and (c) EPC.
- II. Concerning the grounds under Article 100(c) EPC, the opponent argued all claims 1 to 9 of the patent to define subject-matter that extended beyond the content of the application as filed.
- III. The Opposition Division's decision covered only issues of added-matter. They found that claim 1 of the patent, as well as claim 1 of each of the 30 auxiliary requests before them defined subject matter that extended beyond the content of the application as filed (Article 100(c) EPC, Article 123(2) EPC). Consequently, they revoked the patent.
- IV. The proprietor appealed this decision and requested that it be set aside and the opposition rejected (main request), or that the patent be upheld in amended form on the basis of one of auxiliary requests 1, 1B to 1F, 2, 2A to 2F, 3, 3A to 3F, 4, 4A to 4F, 5 and 6, as submitted before the Opposition Division.
- V. The opponent (respondent) reiterated the grounds invoked before the Opposition Division and requested that the appeal be dismissed. They also argued against consideration of the auxiliary requests.

- VI. Additionally, both parties requested that the case be remitted to the Opposition Division for further prosecution, with regards to the other grounds of opposition, should the Board conclude that the issue of added-matter did not prejudice maintenance of the patent, either as granted or in amended form.
- VII. In a communication sent with a summons to oral proceedings, the Board expressed and explained their provisional view that claims 1-4, 6, 7, and 9 of the patent did not define subject-matter that extended beyond the content of the original application, but that claims 5 and 8 did. Additionally, the Board indicated its intention to consider the auxiliary requests and set out its view on how its provisional opinion regarding the main request applied to some of them. The Board also indicated that it would be inclined to remit the case to the Opposition Division for further prosecution, with regards to the other grounds of opposition, should a request be found not to extend beyond the content of the original application.
- VIII. The proprietor submitted a response to the provisional opinion ahead of the oral proceedings, including a further auxiliary request, 1A, to be considered after auxiliary request 1 and before auxiliary request 1B. The opponent did not respond to the provisional opinion, ahead of the oral proceedings.
- IX. Oral proceedings were held before the Board.

X. The claims of the patent (main request) read:

1. A medical system, the medical system comprising: a plurality of implantable medical devices including a first implantable medical device and a second medical device, wherein the first implantable medical device is a leadless cardiac pacemaker (LCP) and the second implantable device is a leadless cardiac pacemaker (LCP), wherein the first implantable device is configured to provide an anti-tachycardia response via one or more electrodes of the first implantable medical device and to communicate a message to at least the second implantable medical device before providing the anti-tachycardia response.

2. The medical system of claim 1, wherein the implantable medical device is configured to provide the anti-tachycardia response that is for a ventricle of a heart.

3. The medical system of any of claims 1-2, wherein the second implantable device is configured to deliver a therapy for treating a heart, and the message received from the first implantable medical devices modifies the therapy that is delivered by the second implantable medical devices.

4. The medical system of any of claims 1-3, wherein the first implantable medical device is a leadless cardiac pacemaker

(LCP) that is configured to deliver an anti-tachycardia response, and the second implantable medical device is a leadless cardiac pacemaker (LCP) that is configured to deliver an anti-tachycardia response, wherein the anti-tachycardia response that is delivered by the second implantable medical device is affected, at least in part, by the communicated message from the first implantable medical device and/or wherein the second implantable medical device is configured to deliver a neural stimulation response.

5. The medical system of any of claims 1-4, wherein for delivering anti-tachycardia pacing therapy by at least one of the plurality of implantable medical devices, the plurality of implantable medical devices of the medical system comprises at least two implantable medical devices, wherein the at least two implantable medical devices include electrodes for providing an anti-tachycardia pacing response and are communicatively coupled.

6. The medical system of any of claims 1-5, wherein the second implantable medical device is configured to be inhibited in response to receiving the message from the first implantable medical device and preferably wherein, when inhibited, one or more electrodes of the second medical device are rendered inactive.

7. The medical system of any of claims 1-6, wherein the message informs the second implantable medical device of delivery of anti-tachycardia pacing therapy to the heart of the patient by the first implantable medical device.

8. The medical system of any of claims 1-7, further comprising means for sensing one or more cardiac signals, and means for determining to deliver an anti-tachycardia response based, at least in part on the one or more sensed cardiac signals, and/or wherein the first implantable medical device is configured for sensing one or more cardiac signals and for determining to deliver an anti-tachycardia response based, at least in part on the one or more sensed cardiac signals.

9. The medical system of any of claims 1-8, wherein the second implantable medical device is configured to deliver a therapy to an atrium of the patient's heart and/or wherein the first implantable medical device is configured to communicate the message to the second implantable medical device via a communication pathway that includes a body of a patient.

XI. Auxiliary request 1 differs from the main request in that some of the alternatives in claim 4 have been deleted.

- XII. Auxiliary request 1A differs from the main request in that claims 5 and 8 have been deleted and claims 6, 7, and 9 renumbered as claims 5, 6, and 7, respectively.
- XIII. Auxiliary request 1B differs from the main request in that dependent claims 2-6, 8 and 9 have been deleted and claim 7 renumbered as claim 2.

Reasons for the Decision

Main request - Claim 1

1. The original claims were all directed to *a method for operating a medical system*. The claims of the patent are directed to *a medical system*.
2. The proprietor argues that claim 2 of the original application provided a basis for claim 1 of the patent.
3. The opponent argues that the mere fact that a method claim and a system claim did not provide the same scope of protection, the scope a method claim being smaller than that of a system claim, showed that the original method claims could not serve as basis for the system claims of the patent.
4. However, scope of protection is not the same as content. A claim that defines a method might well, for example, set out a system in terms of all its essential features, while only defining a method of using, or operating, such a system.

5. Such is the present case, as original claim 1 defined a method of operating a medical system that the skilled person would have understood to comprise a plurality of implantable medical devices, through the operation of which the method steps were carried out.
6. Concretely, the method defined in original claim 1 comprised the steps of
 - (a) *providing an anti-tachycardia response via one or more electrodes of a first one of a plurality of implantable medical devices and*
 - (b) *communicating a message from the first one of the plurality of implantable devices to at least a second one of the plurality of implantable medical devices before and/or while providing the anti-tachycardia response.*
7. The opponent's objection to the first and second of the plurality of implantable medical devices being leadless cardiac pacemakers (LCPs) overlooks the fact that this possibility was among the alternatives in original claim 2.
8. Original claim 2 provides sufficient basis for a claim defining a medical system comprising a plurality of implantable medical devices; including a first and a second LCP, through the operation of which the method steps originally defined in claim 1 can be carried out.
9. The opponent also objects to the definition, in claim 1 of the patent, that *an anti-tachycardia response is provided via the first LCP*, since LCPs were originally described more narrowly, as providing *anti-tachycardia pacing therapy (ATP)*.

10. However, this argument too cannot be followed, given that original claim 1 already employed the broader term *anti-tachycardia response*, and original claim 2 did not restrict that definition.
11. Additionally, while some parts of the original description indeed described LCPs as providing ATP, the description did not limit the type of tachycardia therapy provided by LCPs to ATP (page 6 line 24; page 7 lines 33 and 34; page 10 lines 11 to 17).
12. The skilled person would, then, have understood the broad term employed in the original claims to be part of the invention.
13. The opponent further objects to the definition of the first LCP as being *configured to* carry out the actions (a) and (b), i.e provide the anti-tachycardia response via one or more of its electrodes, and communicate a message to at least the second LCP.
14. According to the opponent, the formulation in original claim 1 was broader than that of claim 1 of the patent. The former did not require the first medical device itself to be configured to carry out the method steps, but only that it be involved. The steps themselves could, for instance, be triggered by an external device or a user.
15. The Opposition Division agreed with this.
16. However, claim 1 of the patent does not require that the first LCP be configured to carry out the method steps autonomously. It also encompasses the possibility that the first LCP acts under the instruction of an

external device or a user, as long as it is configured to act as defined.

17. In fact, for the method steps defined in original claim 2 (i.e. the steps of (a) providing an anti-tachycardia response via one or more of electrodes of the first LCP and (b) communicating a message from the first to the second LCP) to be carried out, the first LCP would also need to be configured so to act, whatever the trigger signal might be.
18. Therefore, contrary the Opposition Division's view, the inclusion of *configured to* in the claim wording does not limit the system set out in original claim 2 in the way the opponent suggested.
19. Therefore, the grounds under Article 100(c) EPC against claim 1 of the patent (main request) do not prejudice its maintenance.

Main request - Dependent claims

20. The opponent also invoked grounds under Article 100(c) EPC against each of the dependent claims of the patent.
21. With regard to claims 2 and 7, which define the same further limitations as original claims 3 and 10, respectively, the opponent's objection come down to arguing that the objections to claim 1 also applied to these claims, by virtue of their dependence on claim 1.
22. This is not persuasive for the same reasons as indicated above for claim 1.

23. The same applies to claim 3, which defines the same further limitation as original claim 4. Concerning this claim, the opponent additionally referred to an inconsistent use of the plural form, *devices*, rather than the singular. However, the same inconsistency was also present in original claim 4 and so, if there is an issue, it is not one of lack of basis in the original application.
24. Concerning claims 4, 6, and 9, the opponent's arguments are also not persuasive: these claims have bases in original claims 5 and 6, original claim 9, and original claims 13 and 14, respectively. The fact that certain combinations of features are not set out in the original description does not alter the fact that they were defined in the original claims, which were also part of the original application.
25. However, as for claim 5 of the patent, the Board agrees with the opponent that the formulation of this claim differs from that of original claim 7, in that it no longer requires that an anti-tachycardia pacing response be provided via electrodes of at least two of the plurality of implantable medical devices. Hence original claim 7 does not provide a basis for claim 5 of the patent.
26. The proprietor referred to the passage on page 20, lines 17 to 32 of the original description, but neither this nor any other part of the original description provides a basis for the wording of claim 5 of the patent either.
27. With regard to claim 8 of the patent, the Board also agrees with the opponent. It defines the medical system as comprising, in one of its alternatives, *means for*

sensing one or more cardiac signals and means for determining to deliver an anti-tachycardia response based, at least in part on one or more sensed cardiac signals. Consequently, claim 8 encompasses medical systems comprising sensing means and processing means in addition to the plurality of implantable medical devices.

28. Such medical systems find a basis neither in original claim 10, nor in any of the passages of the original description mentioned by the proprietor (page 6 lines 5 to 7 and last full paragraph; page 8, first full paragraph; page 11, first full paragraph; page 17 lines 5 and 6; page 19 lines 1 to 5), which all refer to sensing or processing carried out by one of the implantable medical devices.
29. In conclusion, the grounds under Article 100(c) EPC against claims 2 to 4 and 6, 7, and 9 also do not prejudice maintenance of the patent, but those against claims 5 and 8 do.
30. Therefore, the main request is not allowable.

Auxiliary requests underlying the decision - consideration

31. The opponent argued that the Board should not consider auxiliary requests 1, 1B to 1F, 2A to 2F, 3A to 3F, 4A to 4F, 5 and 6, due to their large number and lack of convergence.
32. However, all these auxiliary requests were considered and decided upon by the Opposition Division. They are, therefore, already part of these appeal proceedings (Article 12(2) RPBA), and the Board sees no reason to

interfere with the Opposition Division's exercise of discretion.

Auxiliary request 1

33. Claims 5 and 8 of auxiliary request 1 define the same subject-matter as claims 5 and 8 of the main request, respectively.
34. They therefore extend beyond the content of the original application for the same reasons as outlined above with regards to claims 5 and 8 of the patent (Article 123(2) EPC).
35. Consequently, auxiliary request 1 is not allowable either.

Auxiliary request 1A - consideration

36. Auxiliary request 1A differs from the main request in that claims 5 and 8 have been deleted and claims 6, 7, and 9 renumbered accordingly.
37. It was only filed after notification of the communication under Article 15(1) RPBA and is, therefore, subject to the provisions of Article 13(2) RPBA, according to which it shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified by cogent reasons by the party concerned.
38. No exceptional circumstances can be recognised in the fact that the Board's preliminary opinion with regard

to the main request deviated from the view of the Opposition Division.

39. It is true, as argued by the proprietor, that the amendments introduced merely amount to the deletion of two dependent claims, concretely of the only two for which the Board found the grounds of opposition under Article 100(c) EPC to prejudice maintenance of the patent.
40. Still, it cannot be concluded whether or not this request overcomes all the issues raised by the opponent, without giving rise to new ones, given that only the grounds brought forward under Article 100(c) EPC have been examined so far (cf. Article 13(1) RPBA).
41. The proprietor also noted that there seemed to be some degree of divergence in the case law, as to whether or not Article 13 RPBA applies to the mere deletion of dependent claims.
42. However, irrespectively of this question, this remains a request that was filed for the first time at a very late stage in appeal, and which, as correctly argued by the opponent, should have been submitted in the proceedings leading to the decision, but was not. That alone is sufficient reason for this request not to be considered (Article 12(6) RPBA).
43. In fact, objections under Article 100(c) EPC were brought forward against all claims of the patent at the outset of the opposition proceedings. Hence, the proprietor should have submitted such a request at the earliest opportunity, namely, in reply to the notice of opposition.

44. All in all, there is no room for taking into account such a request, filed at such a late stage of the appeal proceedings.
45. This does not rule out, however, admission of this request by the Opposition Division.

Auxiliary request 1B

46. Claim 1 of auxiliary request 1B is identical to claim 1 of the main request. Auxiliary request 1B differs from the main request in that dependent claims 2 to 6, 8 and 9 have been deleted and the remaining dependent claim renumbered as claim 2.
47. Since this request no longer comprises claim 5 or 8 of the patent and, for the reasons indicated above with regard to the main request, neither claim 1 nor claim 2 of this request defines subject-matter extending beyond the content of the original application, this request does not contravene Article 123(2) EPC.

Remittal

48. In view of the facts that:
- the decision under appeal dealt only with issues of added-matter,
 - the primary object of the appeal proceedings is the review of that decision, and
 - at least auxiliary request 1B does not contravene Article 123(2) EPC,
- the case is - in line with the parties' requests - remitted for further prosecution before the Opposition Division.

Order

For these reasons it is decided that:

1. The appeal is allowed.
2. The decision under appeal is set aside.
3. The case is remitted to the Opposition Division for further prosecution.

The Registrar:

The Chair:



D. Meyfarth

P. Scriven

Decision electronically authenticated