

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [-] To Chairmen
- (D) [X] No distribution

**Datasheet for the decision
of 5 November 2024**

Case Number: T 1345/23 - 3.2.02

Application Number: 20158596.5

Publication Number: 3679861

IPC: A61B5/0408

Language of the proceedings: EN

Title of invention:

FLEXIBLE HIGH-DENSITY MAPPING CATHETER TIPS AND FLEXIBLE
ABLATION CATHETER TIPS WITH ONBOARD HIGH-DENSITY MAPPING
ELECTRODES

Patent Proprietor:

St. Jude Medical, Cardiology Division, Inc.

Opponent:

D Young & Co LLP

Relevant legal provisions:

EPC Art. 76(1), 111(1)
RPBA 2020 Art. 11

Keyword:

Divisional application - subject-matter extends beyond content
of earlier application (no)
Remittal - (yes)

Decisions cited:

T 1791/16, T 1473/19, T 0367/20, T 0177/22



Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0

Case Number: T 1345/23 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 5 November 2024

Appellant: St. Jude Medical, Cardiology Division, Inc.
(Patent Proprietor) 177 East County Road B
St. Paul, MN 55117 (US)

Representative: Boulton Wade Tennant LLP
Salisbury Square House
8 Salisbury Square
London EC4Y 8AP (GB)

Respondent: D Young & Co LLP
(Opponent) 120 Holborn
London EC1N 2DY (GB)

Representative: D Young & Co LLP
3 Noble Street
London EC2V 7BQ (GB)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 10 May 2023
revoking European patent No. 3679861 pursuant to
Article 101(3)(b) EPC.**

Composition of the Board:

Chairman M. Alvazzi Delfrate
Members: S. Dennler
N. Obrovski

Summary of Facts and Submissions

- I. The contested patent was opposed for added subject-matter and lack of inventive step.
- II. The patent proprietor filed an appeal against the opposition division's decision to revoke the contested patent on the ground, *inter alia*, that claim 1 of the main request contained added subject-matter in breach of Article 76(1) EPC.
- III. Oral proceedings were held before the Board on 5 November 2024, at the end of which this decision was announced. This appeal case was heard jointly with the appeal case T 1886/22, which involved the same parties and had some issues of added subject-matter in common.
- IV. The parties' final requests were as follows:
 - (a) the **appellant (patent proprietor)** requested that the decision under appeal be set aside and that the case be remitted to the opposition division for further prosecution on the basis of the main request or one of the auxiliary requests 1 to 39 on which the decision under appeal was based;
 - (b) the **respondent (opponent)** requested that the appeal be dismissed or, in the event of the decision under appeal being set aside, that the case be remitted to the opposition division for further prosecution.
- V. **Claims 1 and 5 of the main request** read as follows (with amendments to claims 1 and 6 as granted, respectively, highlighted by the Board):

Claim 1:

"A catheter comprising the following:

a catheter shaft comprising a proximal end and a distal end, the catheter shaft defining a catheter shaft longitudinal axis extending between the proximal end and the distal end;

a flexible tip portion located adjacent to the distal end of the catheter shaft, the flexible tip portion comprising a flexible framework comprising nonconductive material; and

a plurality of microelectrodes (196) mounted on the flexible framework and forming a flexible array of microelectrodes adapted to conform to tissue, wherein the microelectrodes (196) are ring electrodes; wherein the flexible framework is configured to facilitate relative movement among at least some of the microelectrodes (196) relative to other of the microelectrodes (196); and wherein the nonconductive material insulates each microelectrode from other microelectrodes (196);

wherein the plurality of microelectrodes (196) are mounted on the flexible framework and arranged in a plurality of groups;

wherein each group of the plurality of groups of microelectrodes (196) comprises a row of longitudinally-aligned microelectrodes aligned parallel to the catheter shaft longitudinal axis; and

wherein the flexible array of microelectrodes (196) comprises a two-sided planar array of microelectrodes,

wherein the microelectrodes are configured for contacting tissue on a front side and a back side of the planar array; wherein the flexible framework comprises a plurality of longitudinally-extending and laterally separated arms (190, 192, 194, 188) extending parallel to the catheter shaft longitudinal axis, and lying in a plane; wherein each longitudinally-extending arm (190, 192, 194, 188) has a group of the plurality of groups of microelectrodes (196) distributed and located thereon; wherein a proximal bushing (206) is mounted on the distal end of the catheter shaft;

wherein the proximal portion of each of the longitudinally-extending arms extends through the proximal bushing; wherein each longitudinally-extending arm exits from a distal end of the proximal bushing (206)."

The feature of claim 1 "wherein the proximal portion of each of the longitudinally-extending arms extends through the proximal bushing", which is central to the present case, is hereinafter referred to as **feature F**.

Claim 5:

"The catheter of and [sic] one of claims 1-3, wherein the plurality of longitudinally-aligned arms (190, 192, 194, 188) comprises a first outboard arm (188) and a second outboard arm (190), a first inboard arm (192) and a second inboard arm (194); and wherein the first outboard arm (188) has each having a most distal localization microelectrode (198) and the second outboard arm (190) has a most-proximal microelectrode (~~19~~200), said most-distal microelectrode (198) and said most proximal microelectrode (200) being slightly longer than the other microelectrodes (1960, 192, 194,

~~188~~) for more precise localization of the flexible array in mapping and navigation systems."

VI. The contested patent was granted from a divisional application of an earlier European patent application published in the PCT phase under WO 2014/113612 A1 ("the parent application"), the content of which is relevant for the assessment of added subject-matter under Article 76(1) EPC.

VII. This decision also refers to the following documents:

D3 US 2007/0135881 A1
D5 WO 2012/074580 A1
D9 US 2,421,261
D10 US 3,109,953
D11 US 3,116,195
D12 US 4,085,943
D13 US 878,997
D14 WO 2015/061692 A1
D15 excerpt from the Shorter Oxford Dictionary, Oxford University Press, 6th edition 2007, containing, *inter alia*, the entry "through"

VIII. The **appellant's arguments** relevant for the present decision can be summarised as follows.

The claims of the main request did not contain added subject-matter and this request complied with Article 76(1) EPC.

Claim 1 - feature F

As supported e.g. by D15 (see definition A.2), the expression "extends through" in feature F could not only mean that the proximal portion of the arms

extended "from one end of the bushing to the other", i.e. "through the entire bushing", as alleged by the respondent. It could also more broadly mean that the proximal portion extended "along within the bushing", i.e., phrased differently, "part of the way through" or "at least partially through" the bushing.

This second interpretation was broader than the one defended by the respondent and encompassed it. It was also technically sensible in the context of claim 1, as confirmed by the examples from D3, D5 and D9 to D14 discussed in the decision under appeal. Furthermore, the list of examples given in D15 for definition A.2 was not limitative and this second interpretation was not limited to contexts involving movement.

When reading claim 1 of the main request, the person skilled in the art would have no reason to interpret feature F narrowly. Whether the proximal portions of the arms extended through the entire bushing and thus terminated proximal to it, or whether they instead terminated within the bushing - and if so, where - was wholly irrelevant in the context of the claim. It was also a well-established principle in the case law that the terms of a claim should normally be given their broadest technically sensible meaning. The person skilled in the art would therefore interpret feature F in accordance with the second interpretation. This conclusion was also not inconsistent with the patent specification, which did not support one interpretation over the other.

Paragraph [0097] of the parent application as filed disclosed explicitly that the arms "exit[ed] from the distal end of the proximal bushing". This implied necessarily that the arms extended part of the way

through the bushing, i.e. along within it, otherwise they could not "exit" from it. This was also derivable from the figures, e.g. Figure 33.

It followed that feature F did not define added subject-matter.

Further added subject-matter objections

The further added subject-matter objections to the claims as granted raised by the respondent in the notice of opposition were either overcome by the claim amendments in the main request or not persuasive.

IX. The **respondent's arguments** relevant for the present decision can be summarised as follows.

The claims of the main request contained added subject-matter in breach of Article 76(1) EPC.

Claim 1 - feature F

The ordinary and broadest technically sensible meaning of "through" was "from one end to the other". Feature F therefore meant that the proximal portion of the arms extended through the entire bushing, i.e. into and out of it. Both linguistic and technical considerations, in particular when considering feature F in the context of claim 1, supported this interpretation.

The examples given in D15 for definition A.2, according to which "through" could also mean "along within", were all associated with the idea of movement. However, claim 1 of the main request defined only static features, so this other meaning could not apply to feature F.

The phrase "extends through" did not mean or encompass "extends partially through" or "extends part of the way through" as asserted by the appellant, but expressly excluded them, just as, for example, the word "dead" expressly excluded "partially dead".

In the examples of D3, D5, D9 to D14 discussed in the decision under appeal, the meaning of the term "extends through" was changed by the phrase "and terminates in" or "and terminates within", and not simply narrowed. Therefore, these examples could not prove that "extends through" encompassed "extends partially through". On the contrary, D9 and D13 also contained examples where the term "extends through" was used without any qualification to describe an object extending into and out of a second object. This indicated that, in a technical context, the term "extends through", when not modified by other words, as was the case in claim 1 of the main request, meant "extends into and out of".

This interpretation of feature F was further supported by the last feature of claim 1, which stated that the arm "exited" the bushing and thus implied that the arm had necessarily entered the bushing at some other location. Furthermore, it was not inconsistent with the patent specification, which did not exclude it.

The parent application as filed did not disclose that the proximal portion of each of the arms extended all the way through the proximal bushing. In particular, this feature was not directly and unambiguously disclosed in Figure 46.

In any event, the parent application as filed did not disclose feature F as interpreted by the appellant, but

only that the proximal portion of each arm exited from a distal end of the bushing.

It followed that feature F defined added subject-matter in breach of Article 76(1) EPC.

Further added subject-matter objections

The added subject-matter objections to the granted claims raised in the notice of opposition, which had been enclosed again with the respondent's reply, also applied to the main request. As argued therein, the claims of the main request defined features which were either not disclosed in the parent application as filed or only disclosed in combination with other features to which they were inextricably linked and whose omission from the claims of the main request resulted in an inadmissible intermediate generalisation.

Reasons for the Decision

1. The subject-matter of the contested patent

The contested patent relates to mapping and ablation catheters, e.g. for the diagnosis and treatment of cardiac arrhythmias via radiofrequency ablation (paragraph [0002]), having a flexible high-density catheter tip which is particularly well adapted to maintain, in use, adequate electrical contact between electrodes and cardiac tissue (paragraphs [0004] and [0005]).

For this purpose, as shown for example in Figure 33, reproduced below, a catheter according to claim 1 of the main request includes a flexible tip portion (10^K) located adjacent to the distal end of the catheter

shaft and including a flexible framework comprising a plurality of arms (188, 190, 192, 194) which extend parallel to the catheter shaft longitudinal axis and on which a plurality of ring microelectrodes (196) are distributed (paragraphs [0046]-[0048]).

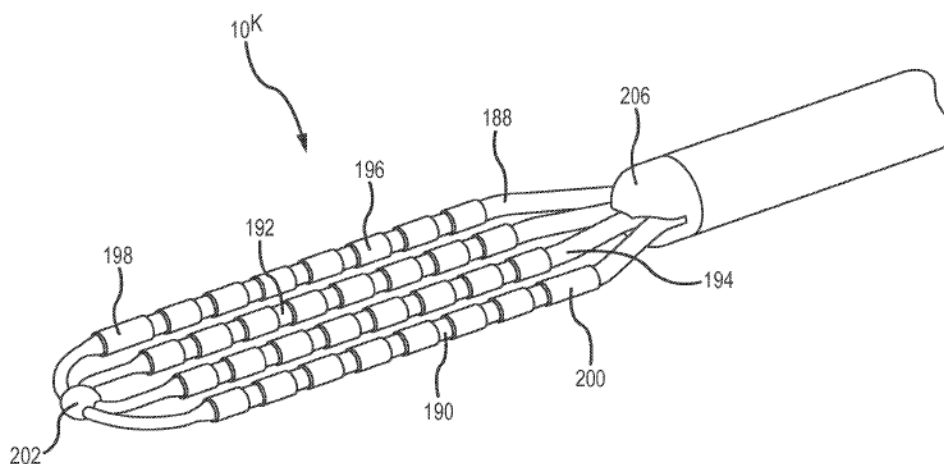


FIG.33

Claim 1 specifies that the proximal portion of each of the longitudinally-extending arms "extends through" a proximal bushing (206) mounted on the distal end of the catheter shaft (feature F), and that each arm exits from a distal end of the proximal bushing (see paragraphs [0049] and [0052]).

The microelectrodes arranged on the flexible tip portion form a flexible two-sided planar array which can easily conform to the cardiac tissue, thereby increasing the accuracy and corresponding diagnostic value of the recorded information (Figure 37, paragraph [0048]).

2. Admittance of D3, D5 and D9 to D15

2.1 The parties did not object to D3, D5 and D9 to D14 being taken into account in the appeal proceedings.

2.2 D15, filed by the appellant on the day before the oral proceedings before the opposition division, was not admitted by the opposition division, in particular because the opposition division considered that it was not *prima facie* relevant. In its reply, the respondent requested that D15 not be admitted on appeal either.

As indicated in the communication under Article 15(1) RPBA, the Board did not share this view and was inclined to admit D15. D15 is a dictionary excerpt containing the entry "through". It was submitted as evidence of what the person skilled in the art would understand by that word, which is central to the interpretation of feature F (see point 3.1 below). As this Board has held in T 1473/19 (see point 3 of the catchword), while claim interpretation is overall a question of law which must as such ultimately be answered by the deciding body and not by linguistic experts, it does involve the appraisal of linguistic facts, which may be supported by evidence submitted by the parties, such as D15. Moreover, D15 is short and readily understandable.

At the oral proceedings before the Board, the respondent did not object to the admittance of D15. The Board therefore decided to take D15 into account as well.

3. Main request - added subject-matter (Article 76(1) EPC)

Contrary to the respondent's view and the opposition division's finding in the decision under appeal, the claims of the main request do not contain added subject-matter and this request complies with Article 76(1) EPC.

3.1 *Claim 1 - Feature F*

- 3.1.1 The dispute between the parties as to whether or not feature F complies with Article 76(1) EPC rests on the different interpretations they give to this feature, in particular to the term "extends through".

The Board does not agree with the approach taken in T 1791/16 (see catchword and point 11 of the reasons), to which the opposition division referred in the decision under appeal (see point 2.4 of the reasons), that all technically reasonable interpretations of an ambiguous claim must be considered in assessing whether the claim contains added subject-matter, and that it is sufficient that one of these interpretations leads to added subject-matter in order to conclude that the claim is not allowable.

Rather, the Board considers that it must first be determined how the person skilled in the art would interpret feature F before it can be assessed whether this feature is disclosed in the parent application as filed and, accordingly, whether it adds subject-matter (see T 367/20, catchword).

Furthermore, the terms in a given patent claim must be interpreted in a uniform, consistent and objective manner (see T 177/22, points 3.1 to 3.3 of the reasons), including for the purposes of assessing e.g. added subject-matter and novelty. As set out below, in the present case only the narrower of the two possible - and both technically reasonable - claim interpretations could lead to added subject-matter. Hence, in the present case the approach suggested in T 1791/16 would also require a deviation from the

established practice to interpret a claim in doubt rather more broadly than more narrowly.

- 3.1.2 The respondent argued that the word "through" in its ordinary and broadest interpretation means "from one end to the other", so that feature F must be interpreted as requiring the proximal portion of each of the arms to extend through the entire bushing, i.e. into and out of the bushing. This interpretation is referred to hereinafter as interpretation (a).

The appellant did not dispute - and the Board agrees - that the word "through" can have this meaning and that interpretation (a) is technically sensible. The opposition division's finding that feature F extends beyond the content of the parent application as filed is based on this interpretation (see point 2.1 of the decision under appeal).

- 3.1.3 However, as submitted by the appellant, the word "through" can also mean "along within", as supported, *inter alia*, by the dictionary definition A.2 given in D15. Interpreted with this different meaning, feature F requires the proximal portion of each of the arms to extend "along within" the bushing, i.e. along a certain distance within the bushing. This second interpretation is hereinafter referred to as interpretation (b).

- 3.1.4 The Board agrees with the appellant that interpretation (b), like interpretation (a), is both linguistically and technically sensible. The respondent's arguments to the contrary are unconvincing, as discussed below.

Compared to interpretation (a), interpretation (b) imposes fewer limitations on the proximal portion of the arms, requiring only that the proximal portion

extend along a certain distance within the bushing, rather than from one end of the bushing to the other (or into it and out of it). The appellant's proposed alternative wordings "extends part of the way through" or "extends at least partially through" are based on this understanding. At the same time, by leaving open where and how long the proximal portion extends within the bushing, interpretation (b) does not exclude that the proximal portion also extends from one end of the bushing to the other, i.e. through the entire bushing. Indeed, if the proximal portion extends from one end of the bushing to the other, then of course it extends part of the way through the bushing, i.e. "along within" it. The Board therefore agrees with the appellant that interpretation (b) is broader than and encompasses interpretation (a).

The respondent's argument that the term "through" would exclude "partially through" in the same way, for example, that "dead" excludes "partially dead" is not persuasive. Whilst it is of course not possible to be partially dead, it is quite possible, as discussed above, for the proximal portion of an arm to extend within the bushing only through part of it, i.e. "partially through" the bushing.

Moreover, contrary to the respondent's view, it is immaterial that the examples given in D15 to illustrate definition A.2 all involve some notion of movement, because these examples are merely non-limitative.

The Board does not consider that the examples in D3, D5 and D9 to D14, in which the term "extends through" is also used in a technical context, constitute evidence against interpretation (b). As argued by the appellant, the phrase "and terminates in" or "and terminates

within" which follows the term "extends through" merely confirms the broad meaning of this term according to interpretation (b) in these examples. Hence, these examples - some of which are also in the same field of medical technology as the contested patent - rather confirm that it is technically reasonable to use the term "extends through" in relation to a first part which only extends into, but not out of, a second part.

Furthermore, it is irrelevant that the last feature of claim 1 specifies that each of the arms "exits from a distal end of the bushing". An arm could well exit from a distal end of the bushing and still have its proximal portion terminate within the bushing between the proximal and distal ends. Such an arm would not "enter" the bushing at the other end and so its proximal portion would not extend through the entire bushing but only partially through it. The last feature of claim 1 is therefore not inconsistent with interpretation (b) and merely specifies at which location the arms extending through the bushing exit from it.

- 3.1.5 On the basis of the wording of feature F alone, and in the absence of any context, it cannot be concluded which one of the two aforementioned interpretations takes precedence over the other. One can only arrive at such a conclusion when interpreting feature F in the technical context of claim 1.

While claim 1 is directed generally to a catheter, most of its content is devoted to defining in detail the flexible tip portion located adjacent to the distal end of the catheter shaft and comprising a flexible framework formed by the longitudinally-extending arms which are referred to in feature F, on which a plurality of microelectrodes are mounted. In addition

to defining these parts and feature F itself, claim 1 defines the proximal bushing appearing in feature F as being mounted on the distal end of the catheter shaft, and specifies that each of the longitudinally-extending arms exits from a distal end of this bushing. Apart from the catheter shaft, the claim does not explicitly define any other part of the catheter that would be located proximal to the proximal bushing.

The person skilled in the art reading claim 1 as a whole would understand that for the catheter tip portion to be coupled to the distal end of the catheter shaft it is sufficient that the proximal portion of each of the arms extends partially through the proximal bushing, in other words, that it extends into the bushing. As argued by the appellant, it is irrelevant whether the proximal portion extends further into the bushing, in particular whether it extends through the entire bushing and thus terminates proximal thereto, or whether instead the proximal portion terminates somewhere within the bushing.

In this context, contrary to the respondent's view, the person skilled in the art would therefore interpret feature F broadly according to interpretation (b), which leaves open where the proximal portion of the arms terminates, and would not interpret feature F narrowly according to interpretation (a). In fact, to do so would be tantamount to reading an unjustified limitation into the claim.

- 3.1.6 In addition, interpreting feature F according to interpretation (b) is not inconsistent with the patent specification, in regard to which it is common ground that it does not support one interpretation over the other.

3.1.7 Paragraph [0097] of the parent application as filed discloses explicitly that the longitudinally-extending arms "exit from the distal end of the proximal bushing". Contrary to the respondent's view, this implies necessarily that the arms extend at least partially through the bushing, i.e. along within it, otherwise they could not "exit" from the bushing. This view is also consistent with the figures of the parent application as filed which show an embodiment of a catheter as claimed, such as Figure 33, where the arms are shown as being gripped within a notch formed within the bushing at its distal end.

3.1.8 The Board therefore concludes that feature F does not constitute subject-matter extending beyond the content of the parent application as filed.

3.2 *Further added subject-matter objections*

3.2.1 At the oral proceedings before the Board, the respondent agreed that the further objections under Article 76(1) EPC which it had to the main request, namely those raised in the notice of opposition against the granted claims (see points 3.6 to 3.6.3 and 3.8 to 4.9.3) and which were not dealt with in the decision under appeal, should be considered and decided by the Board in the course of the ongoing oral proceedings.

As expressed in the Board's communication under Article 15(1) RPBA, these further objections, to the extent that they apply to the claims of the main request, are not convincing. The respondent did not present any arguments at the oral proceedings before the Board, but merely referred to its written submissions.

As explained below, the features whose omission from the granted claims was objected to by the respondent either were added in the corresponding claims of the main request or are not inextricably linked to the claimed features, so that their omission from the claims of the main request does not constitute an inadmissible intermediate generalisation.

3.2.2 Claim 1: catheter not defined as a "high-density mapping" catheter

Claim 1 of the main request is generally directed to a "catheter" and not to a "high-density mapping" catheter. Contrary to the respondent's argument, the omission of the phrase "high-density mapping" from claim 1 does not add subject-matter.

It is true that the embodiments of Figures 33 to 46 of the parent application as filed, which undisputedly fall within the wording of claim 1, are described as "high-density mapping" catheters (see e.g. paragraphs [0046] and [0051] to [0059]). Similarly, original claim 6, on which claim 1 is based, is also directed to a "high-density mapping catheter".

However, the person skilled in the art would understand from the description of the parent application as filed as a whole, in particular from paragraph [0092], that "high-density mapping" is merely another available functionality of the disclosed catheters, just like the ablation functionality. Paragraph [0104], which refers to "the disclosed catheters, with their plurality of microelectrodes" as "mapping catheters and ablation catheters", further supports this understanding.

3.2.3 *Claim 1: proximal bushing "mounted on the distal end of the catheter shaft"*

Contrary to the respondent's argument, the proximal bushing disclosed in paragraph [0097] of the parent application as filed as being "mounted on the distal end of the catheter shaft" is not inextricably linked to the presence of an irrigation port. The omission of the latter from claim 1 of the main request therefore does not add subject-matter.

While an irrigation port 206' is indeed present in the embodiment of Figure 44 to which paragraph [0097] refers, the first two sentences of this paragraph make it clear that the irrigation port is what distinguishes the "alternative variation" of Figure 44 from that of Figure 43, which also comprises the same proximal bushing but without an irrigation port. The person skilled in the art therefore understands that the irrigation port is an optional feature provided independently of the proximal bushing. The fact that in the embodiment of Figure 43 and in those of the preceding figures the proximal bushing has a different reference sign, 206 instead of 206', is irrelevant. The person skilled in the art would clearly infer from these figures and the corresponding description in the parent application that the proximal bushing 206 is also "mounted on the distal end of the catheter shaft", even though this is not explicitly described.

3.2.4 *Claim 1: arms "laterally separated"*

Contrary to the respondent's argument, the feature that the arms are "laterally separated", as disclosed, for example, in paragraphs [0091] and [0095] of the parent application as filed, is not inextricably linked to any

particular spacing between the arms. Indeed, the person skilled in the art would understand that the specific numerical values given in these passages of the parent application are merely particular example values of spacing, none of which is critical to the functioning of the claimed catheter. The fact that claim 1 of the main request does not specify any particular spacing therefore does not infringe Article 76(1) EPC.

3.2.5 *Claim 1: electrodes configured for contacting tissue "on a front side and a back side of the planar array"*

The respondent objected in relation to claim 1 as granted that there was no basis in the parent application as filed for the feature that the microelectrodes are configured to contact tissue "on a front side and a back side" of the planar array.

It is true that this feature, which is also defined in claim 1 of the main request, is not explicitly disclosed in the parent application as filed. However, the person skilled in the art would directly and unambiguously derive this feature from the particular ring shape of the microelectrodes carried on the longitudinally-extending arms of the flexible framework and from the fact that the microelectrode array is a planar array, as described in paragraph [0091] for the embodiments of Figures 33 to 46.

Since the feature that the microelectrodes are ring electrodes and the planar nature of the array are both defined in claim 1 of the main request, the Board is satisfied that the respondent's objection is overcome in the main request. The respondent has not convincingly argued that the feature objected to above would be inextricably linked to any other feature of

the embodiments of Figures 33 to 46 that would have been omitted from claim 1 of the main request (see next point in this respect).

3.2.6 *Claim 1: omission of features shown in the drawings*

The respondent contended that the drawings of the parent application as filed could not be considered as providing a valid basis for the claimed features discussed in points 3.2.2 to 3.2.5 above. This was because, in the respondent's view, the catheter tips shown in those drawings all have various additional features from which the claimed features could not be isolated without leading to an inadmissible intermediate generalisation.

This is not convincing. Contrary to the respondent's argument, the exact number of arms is immaterial, and the last sentence of paragraph [0091] of the parent application discloses that their number need not be exactly four ("Although each of the paddle catheters depicted in Figs. 33-42 shows four arms, the paddle could comprise more or fewer arms"). A distal member joining each of the arms together at the distal tip is merely optional, as disclosed in paragraph [0092] ("there may be a distal member (or 'button') 202 where one or more of the arms come together"). The person skilled in the art would understand that there are many ways of making the arms laterally separated as disclosed in the description that do not require an outward and inward curve at the proximal and distal ends of the arms. The exact number of microelectrodes and their arrangement on the arms is also not essential, as shown by the variation of layouts disclosed in the parent application as filed, both in

terms of the number of arms and the number of microelectrodes per arm.

3.2.7 *Claim 2: the arms "come together at a distal apex of the flexible tip portion"*

Contrary to the respondent's argument, the claimed feature that the arms "come together at a distal apex of the flexible tip portion" is not inextricably linked to a "distal member" at which they come together. As stated in the previous point, this distal member is merely optional. Its omission from claim 2 of the main request therefore does not infringe Article 76(1) EPC.

3.2.8 *Claim 5: specific microelectrode layout of Figures 33 and 34*

Claim 5 of the main request is based on claim 6 as granted, but additionally includes the features which the respondent claimed were missing (a first inboard arm, a second inboard arm, the most-distal and most-proximal position of the slightly longer localisation electrodes). Moreover, through the dependency of claim 5 on claim 1, the microelectrodes in claim 5 are ring microelectrodes. Claim 5 thus defines the specific layout shown in Figures 33 and 34 and described in paragraphs [0091] and [0092] of the parent application as filed. The Board is therefore satisfied that the respondent's objection to claim 6 as granted does not apply to claim 5 of the main request.

3.2.9 *Claim 6: "opposed corners", "symmetrically placed"*

The respondent objected to the terms "opposed corners" and "symmetrically placed" in claim 7 as granted which,

in its view, had no basis in the parent application as filed.

This is not convincing. These terms, which appear in claim 6 of the main request, are merely equivalent to the localisation electrodes being the most-distal microelectrode on the first outboard arm and the most-proximal microelectrode on the second outboard arm, as defined in claim 5 of the main request, on which claim 6 depends. Therefore, the use of these terms in claim 6 of the main request does not add subject-matter.

3.2.10 Claim 7: localization microelectrodes adapted for use for bipolar ablation

The respondent objected that there was no basis in the parent application as filed for claiming localisation electrodes, whether adapted for bipolar ablation or not, outside the particular embodiment described in paragraph [0092].

Claim 7 of the main request, which specifies that the two localisation microelectrodes are adapted for use for bipolar ablation, depends on claim 5, which, as discussed above, is limited to the particular embodiment described in paragraph [0092] and shown in Figures 33 and 34. The Board is therefore satisfied that the respondent's objection does not apply to claim 7 of the main request.

3.2.11 Claim 8: internal fluid delivery lumen

The respondent objected that the feature that the catheter is adapted to deliver irrigant defined in claim 10 as granted, on which claim 8 of the main

request is based, could not be isolated from the presence of an irrigation port.

Claim 8 of the main request has been amended to explicitly include an irrigation port. The Board is therefore satisfied that the respondent's objection does not apply.

3.2.12 The compliance of claims 5, 9 and 14 as granted with Article 76(1) EPC was also objected to in the notice of opposition. However, these claims have been deleted from the main request.

4. Remittal to the opposition division

The decision under appeal did not deal with the other ground for opposition also raised by the respondent in the notice of opposition, namely lack of inventive step.

In view of the primary object of the appeal proceedings, which is to review the decision under appeal in a judicial manner (Article 12(2) RPBA), the Board, in agreement with both parties, considers that there are special reasons under Article 11 RPBA for remitting the case to the opposition division for further prosecution under Article 111(1) EPC.

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 for further prosecution.

The Registrar:

The Chairman:



A. Chavinier-Tomsic

M. Alvazzi Delfrate

Decision electronically authenticated