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File Number: T 249/89 - 3.2.2
Application No.: 86 300 525.2
Publication No.: 0 194 014
Title of invention: Surgical instruments

Classification: A61F 2/46, A61B 17/14

DECISION
of 15 July 1991

Applicant: Chas F. Thackray Limited

Headword:

EPC Article 82

Keyword: "Lack of unity "a priori" (no)"

Headnote



Case Number : T 249/89 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal
of 15 July 1991

Appellant : Chas F. Thackray Ltd
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Decision under appeal : Decision of Examining Division 127 of the
European Patent Office dated 5 January 1989
refusing European patent application
No. 86 300 525.2 pursuant to Article 97(1) EPC.

Composition of the Board :

Chairman : G. Szabo
Members : M. Noel
L. Mancini

Summary of Facts and Submissions

- I. European patent application No. 86 300 525.2 (publication No. 0 194 014) was refused by a decision of the Examining Division on 5 January 1989.

The reason for the refusal was that the subject-matter of claims 1, 6 and 15 filed on 21 November 1988 in response to the first communication of the Examining Division, did not appear to have a single common feature so as to form a single general inventive concept. Consequently, the application did not comply with the requirement of unity of invention according to Art. 82 EPC.

- II. A Notice of Appeal against this decision was filed on 7 March 1989 and the appeal fee was paid. In support of the Statement of Grounds received on the same date, the Appellant filed several sets of claims of which a main request based on the claims as refused and three auxiliary requests including different amendments.

He submitted that since amended claims had been filed in response to the first communication of the Examining Division, a fresh objection of lack of unity should have been made before issuing a decision to refuse the patent. Therefore, the decision was incorrect.

- III. In a communication of 28 March 1991 the Board informed the Appellant of its provisional opinion agreeing that the set of claims according to the second auxiliary request would be acceptable as regards unity.

In his reply of 31 May 1991 the Appellant then submitted two new sets of claims (sets A and B).

IV. Claims 1, 6, 15 (of sets A and B) and 17 (of set B only) under dispute read as follows:

"1. A set of instruments for use in the surgical implantation of a knee prosthesis, characterised in that the set includes a femoral alignment rod (6) one end of which is for insertion into the medulla of a femur (2) through an access hole (7) located between the femoral condyles (5), said end being sufficiently blunt and said rod being of sufficient flexibility that the rod will not penetrate the bone of the femur but rather bend to travel within the medulla, said rod being however of sufficient resilience to maintain its linearity within the femur as far as possible, said rod being of sufficient length to extend at least beyond the lesser trochanter with the other end of said rod protruding exteriorly from between the femoral condyles (5), the access hole being sufficiently larger than the diameter of the rod to impose no physical constraint thereon, the set of instruments further including an angle adaptor (16) having an elongate body portion (17) and also having means (19) to allow the adaptor to be slid over and rotated about the protruding alignment rod with the longitudinal axis of the body portion of the adaptor forming an acute angle with the longitudinal axis of the alignment rod, said angle adaptor also having means (20) rigidly to fix said angle adaptor to the femur."

"6. A set of instruments as claimed in any preceding claim, together with a femoral component which is characterised in having an opening in its bearing surface adapted to accommodate the femoral alignment rod."

"15. A set of instruments as claimed in any preceding claim, together with a tibial component characterised in having an eccentric bore therein adapted to accommodate the tibial alignment rod."

"17. A femoral alignment rod for insertion within the medulla of a femur during surgical implantation of a knee prosthesis, the alignment rod being of intact integral unitary construction, and having a first blunt end for insertion within the medulla of the femur through an access hole located between the femoral condyles, and a second end opposite said first end, the length of the rod between said two ends being sufficient, with respect to the particular femur undergoing surgery, and the rod being sufficiently flexible, to allow said second end to protrude from said access hole whilst said first end is located within the medulla at least beyond the lesser trochanter, the rod also being resilient and the access hole being sufficiently larger than the diameter of the rod to impose no physical constraint thereon, such that once the rod is fully inserted within the medulla as aforesaid, the portion of the rod located within the medulla contacts the inner walls of the bone defining the medulla, whereby the portion of the rod which protrudes from the access hole is allowed to extend linearly along an axis the position of which is dictated by points of contact within the medulla between the rod and the inner walls of the medulla."

V. The Appellant requests

as a main request:

- that the decision under appeal be set aside,
- that examination of the application be continued on the basis of claims 1 to 18 (set B) filed on 31 May 1991, and
- that the appeal fee be reimbursed;

and as an auxiliary request:

- that examination of the application be continued on the basis of claims 1 to 16 (set A), should set B be deemed to be unallowable, with an opportunity to file a divisional application with respect to claims 17-18.

Reasons for the Decision

1. The appeal is admissible.
2. Amendments (main request - Set B)

Claims 1 to 18 in suit are derived from claims 1 to 18 in the version as refused by the Examining Division.

Claim 1 is based on claims 1 and 3 as originally filed after incorporation of additional features drawn up from the original description, page 2, lines 12-24.

Claims 2 to 16 are based on original claims 2 to 17. The minor correction brought to claim 4 is supported by the description, page 5, line 8 and is therefore acceptable.

Claims 17 and 18 were filed for the first time on 21 November 1988 in response to the first communication of the Examining Division in accordance with Rule 86(3) EPC.

Independent claim 17 is derived largely from a combination of the features of claim 1 in suit including features drawn up from the original disclosure, in particular page 2, lines 15 to 24 and page 9, lines 32 to 35.

Claim 18 is based on the original description, page 10, lines 6 to 23.

The Board is, therefore, satisfied that the current version of the claims (set B) does not contravene the requirements of Art. 123(2) since it does not include subject-matter extending the content of the application as originally filed.

3. Unity (main request - Set B)

Since the decision under dispute made no reference to the prior art, it is apparent to the Board that lack of unity "a priori" is intended (cf. also Guidelines C-III, 7.6).

Amendments made to the wording of claims 6 and 15 are such that these claims are now clearly and truly dependent from the preceding claims, and in particular from a set of instruments as claimed in claim 1. As a consequence the subject-matter of claim 1 is contained in and is common to all dependent claims. As long as this is not shown to make no contribution at all to an inventive step, unity cannot be denied for the set (cf. W 6/90, to be published).

In addition to such formal connection, a functional link between the technical features of claims 1, 6 and 15 can be seen in that the femoral and tibial components are both necessary for implantation of the knee prosthesis, considered as a common result, and are specially adapted to accommodate the respective rods of the set of instruments. In the present case the single general concept referred to in Art. 82 can therefore be derived on the basis of the recognition of common features in the various teachings of these claims, i.e. based also on the common functions of identical structural features.

Independent claim 17 refers to a femoral alignment rod and incorporates most of the features of claim 1 (cf. point 2 above). These common structural details represent a single

concept and are not such that it can be stated with any certainty that they could not influence the considerations for the inventive steps for both subject-matters at a later stage. Unity cannot therefore be denied a priori.

Summing up, the Board is satisfied that claims 1, 6, 15 and 17 appear to relate only to a single inventive concept so as to fulfil the requirements of unity according to Art. 82 EPC at this stage of the examining procedure.

Since claims 1 to 18 of the main request (set B) are acceptable, these claims can serve as a basis for further pursuance of their subject-matter by the first instance and the other auxiliary requests need no further be considered.

4. Reimbursement

The Appellant requested reimbursement of the appeal fee under Rule 67 EPC but failed to submit any substantiated reasoning for it. Although the interpretation of unity by the Examining Division which was based on an unamended set of claims, diverged from the present conclusion of the Board, this cannot itself be construed as a procedural violation.

As regards the Appellant's assertion under point II above that the Examining Division should have expressed its opinion on the last filed amendments as to the question of unity before the application was refused, the Board is of the opinion that the case does not suffer from a procedural violation in this respect either. In the reply of 21 November 1988 to the first communication, the Appellant filed additional claims 17 and 18 in accordance with Rule 86(3) EPC accompanied by a statement supporting only the novelty and the inventive step of the claims.

However, since objected claims 6 and 15 were maintained without amendment, the Examining Division rightly concluded that the Appellant's position with respect to unity was not altered, though he had been given an opportunity to comment (Art. 113(1) EPC). Therefore, it was entirely legitimate for the Examining Division to reject the application after the first communication on the basis of lack of unity of claims 1, 6 and 15.

In the Board's view there is, therefore, no basis for a reimbursement of the appeal fee under Rule 67 EPC.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of claims 1 to 18 (set B) according to the main request (point V).
3. The request for the reimbursement of the appeal fee is rejected.

The Registrar:



S. Fabiani

The Chairman:



G. Szabo