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D E C I S I O N
of 20 October 1999

Case Number: T 0546/98 - 3.2.2

Application Number: 86115473.0

Publication Number: 0221570

IPC: A61F 2/04

Language of the proceedings: EN

Title of invention:

Expandable intraluminal graft, and apparatus for implanting an expandable intraluminal graft

Patentee:

Palmaz, Julio C.

Opponent:

Advanced Surgical Intervention, Inc.
Boston Scientific Corporation

Headword:

-

Relevant legal provisions:

EPC Art. 52(1), 69(1), 78(1), 84, 104(1), 123(2), (3)
EPC R. 27(1), 29(1)

Keyword:

"Inadmissibility of reconsidering patentability of the claims after appeal decision T 0818/93 ordering remittal to the first instance for adapting the description"
"Description properly adapted to amended claims"
"Apportionment of costs - refused"
"Referral to the Enlarged Board of Appeal - refused"

Decisions cited:

T 0818/93, G 0001/93, G 0009/91, G 0010/91, G 0004/92,
T 0843/91, T 0167/93, T 0055/90, T 0113/92, T 0757/91,
T 1063/92, T 0818/93

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 0546/98 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 20 October 1999

Appellant: Boston Scientific Corporation
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Respondent: Palmaz, Julio C.
(Proprietor of the patent) 12610 Stonehenge
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Decision under appeal: Interlocutory decision of the Opposition Division
of the European Patent Office posted 19 May 1998
concerning maintenance of European patent
No. 0 221 570 in amended form.

Composition of the Board:

Chairman: W. D. Weiß
Members: M. G. Noël
J. C. M. De Preter

Summary of Facts and Submissions

I. In consequence of a first appeal (T 818/93) lodged by the patent proprietor against revocation by the Opposition Division of the European patent No. 0 221 570, the Board decided on 2 April 1996 to maintain the patent as amended in the following terms:

"The case is remitted to the first instance with the order to grant the patent with claims 1 to 4 according to the main request (submitted at the beginning of the oral proceedings as the first auxiliary request - see item V of the present decision) and the description to be adapted thereto."

II. After the remittal to the first instance, the description was adapted to the claims decided upon by the Board. The opponent (sole opponent after the merger of opponent 1 with opponent 2) objected to the amendments made by the proprietor to the description, as leading to inadmissible broadening of the subject-matter of the patent over the content of the application as filed, and to inadmissible extension of the scope of protection. Further, considering that after remittal of the case to the first instance the opposition proceedings was still pending, new evidence and substantive arguments were submitted by the opponent against the patentability of the claims.

By interlocutory decision dated 19 May 1998, the Opposition Division decided not to consider the new facts and evidence filed by the opponent after the issuing of decision T 818/93 and to maintain the patent in the version (main request) as amended during the

oral proceedings of 6 May 1998.

- III. The appellant (opponent) lodged an appeal on 18 May 1998 against that decision, paid the appeal fee and filed a statement of grounds on 29 September 1998 supplemented by additional arguments filed by letter of 13 October 1999.

The appellant requested that the decision under appeal be set aside and that the European patent be revoked. Auxiliarily he requested that the case be remitted to the Opposition Division to reconsider the patentability of the claims on the basis of the facts and evidence submitted during the proceedings subsequent to the decision T 818/93 or that the following three questions be referred to the Enlarged Board of Appeal:

"Is a Board of Appeal in opposition appeal proceedings bound by the *ratio decidendi* of a previous Board of Appeal decision in opposition proceedings concerning the same patent, in which the Board of Appeal had remitted the case to the Opposition Division with the order to maintain the patent in amended form, if the facts are no longer the same?

Is the situation different if the new facts are highly relevant and *prima facie* invalidate the patent in suit (in particular if this finding has been made by two European courts)?

What is the situation if said highly relevant new facts were known to the patentee at the time of the previous Board of Appeal decision but were not known to the opponent and the EPO at that time because they were

deliberately withheld by the patentee?"

- IV. The respondent (patent proprietor) replied to the appellant's contentions by letter dated 12 February 1999.

The respondent requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the documents defined in the decision under appeal provided that page 3a of the description is replaced by page 3a of the description submitted at the oral proceedings. He also requested that the appellant should bear the costs of the present appeal.

- V. Oral proceedings were held before the Board on 20 October 1999 during which the parties argued as follows:

(i) The appellant:

- (a) - Since the Board of Appeal's decision of 2 April 1996 new facts and evidence have come to light clearly preventing the maintenance of the opposed patent and therefore must still be considered as the EPO proceedings have not yet been finally terminated (see e.g. opinion G 4/92, decision G 9/91 and opinion G 10/91). These facts and evidence which relate to the inventor's own prior public disclosures could not be presented by the appellant at an earlier stage of the proceedings because they were not known to him but rather were known throughout the proceedings and in particular at the time of

the Board of Appeal decision of 2 April 1996 to the respondent himself, who had deliberately withheld these crucial facts.

- In the present case the facts are no longer the same as at the time of the Board of Appeal decision of 2 April 1996 so that, according to Article 111(2) EPC, this decision is not binding in subsequent proceedings before the EPO.
 - Article 111(2) EPC in any case only stipulates a binding effect of a Board of Appeal decision for the Opposition Division to which the case is remitted but not for the same or another Board.
 - In decision T 843/91 Article 111(2) EPC was interpreted in a overly restrictive way while in case T 167/93 the right principles of estoppel by *rem judicatam* were set out (see point 2.1 of the reasons).
 - The respondent should bear the entire costs of the opposition proceedings as he should not have allowed the EPO to issue a clearly invalid patent, and conducted the proceedings improperly since the entire opposition proceedings were unnecessary.
- (b) - The description was amended by way of a number of deletions. By deleting from the description information related to the prior art illustrated by Figures 1A, 1B, the reader is inclined to believe that the graft according to the invention and shown on Figures 2A, 2B is now

structurally and functionally even more different to the prior art than was originally presented. Since, therefore, the skilled person is now presented with new information which could not be directly and unambiguously derived from the original application, the patent was amended in such a way that it contains subject-matter which extends beyond the content of the application as filed, contrary to Article 123(2) EPC. In addition, said new information also contravenes Article 123(3) EPC in that it inadmissibly extends the protection conferred by improperly influencing the interpretation of the claims.

- Document (1) US-A-3 657 744 is improperly acknowledged in the introductory part of the description in that it fails to state all the features known from document (1). This is in contrast to the clear statement of the Board in decision T 818/93, according to which (cf. section 4.3) the subject-matter of claim 1 differs from the disclosure of document (1) only by two characterising features (a) and (b). Thus, the remaining features of the characterising portion of claim 1 are also known from the same document and should have been incorporated in the preamble of claim 1 as well as in the presentation of document (1) at column 3 of the description in accordance with Rules 27(1) and 29(1) EPC. Such a discrepancy leads, again, to an inadmissible broadening of the scope of claim 1 which also has to be interpreted in the light of the state of the art

as acknowledged in the description.

(ii) The respondent:

- (a) - The Board of Appeal decision of 2 April 1996 with regard to the validity of the patent in suit became final (*res judicata*) before the EPO (cf. T 843/91, point 3.4.2 of the reasons, T 55/90, T 113/92, T 757/91 and T 1069/92).
- (b) - The parts removed from the description are all concerned with the embodiment of Figures 1A, 1B, which later turned out to be the prior art; these deletions were made for clarification purposes only. Therefore, the contested deletions are of no consequence to the scope of the invention now restricted to Figures 2A, 2B. For the same reason, they cannot extensively modify the content of the invention itself, so that the skilled person is not presented with new information with respect to the content of the application as filed.
- The information introduced in connection with document (1), i.e. prior art which was not considered at the time the application was filed, can obviously never be deduced from the original disclosure. However, this kind of "new information" is generally accepted as prior art acknowledgment and cannot be regarded as an inadmissible broadening contravening Article 123(2) EPC.
- The appellant should bear all costs of the

present appeal proceedings because the repeated attempts to attack the validity of the patent before the EPO and to obstruct the procedure leading to the final issuance of the patent, appear to be an abuse of the procedures.

VI. Claim 1 in suit reads as follows:

"An expandable intraluminal vascular graft or prosthesis (70) for a body passageway, comprising: a tubular shaped member (71) having first (72) and second (73) ends and a wall surface (74) disposed between the first and second ends, the wall surface (74) being formed by a plurality of first and second intersecting elongate members (78, 79), at least some of the first elongate members (78) intersecting with some of the second elongate members (79) intermediate the first and second ends of the tubular shaped member (71), the tubular shaped member (71) having a first diameter (d) which permits intraluminal delivery of the tubular shaped member into a body passageway having a lumen, and the tubular shaped member (71) having a second expanded diameter (d') which is determined by the application from the interior of the tubular shaped member (71) of a radially, outwardly extending force, which second diameter (d') is variable and controlled by the amount of force applied to the tubular shaped member (71), at least some of the elongate members (78, 79) being deformed by the radially, outwardly extending force, to retain the tubular shaped member (71) with the second expanded diameter (d'), whereby the tubular shaped member (71) may be expanded to expand the lumen of the body passageway and remain therein, characterized

in that the first and second intersecting elongate members (78, 79) are a plurality of thin bars, each having a uniform thin rectangular cross-sectional configuration, wherein each pair of adjacent first bars (78) is interconnected by at least two of said second bars (79), each second bar (79) being formed integral with the respective pair of first bars (78) and extending only between said pair of first bars (78) and each second bar (79) extending on the circumference of a circle whose plane is perpendicular to the longitudinal axis of said tubular shaped member (71)."

Reasons for the Decision

1. The appeal is admissible.
2. *Legal effect of decision T 818/93*

The main question raised concerns the powers of the Opposition Division after the Board of Appeal decision of 2 April 1996 (T 818/93) which decided which claims of the patent could be maintained, and remitted the case to the Opposition Division with the corresponding order and with the order to adapt the description.

As the powers of the Opposition Division to which a case is remitted by a decision of a Board of Appeal depend on and are limited by the extent of the remittal, the Opposition Division was not entitled to re-examine the patentability of the claims. Thus the Opposition Division rightly decided that the new facts and evidence presented by the appellant to contest the

patentability of the claims could not be admitted or even taken in consideration. Consequently the arguments put forward by the appellant, concerning the proceedings not being finally terminated, the principles of good faith governing the relations between the EPO and the applicants, and the time consuming and expensive national invalidation proceedings, are not relevant.

Nor is appellant's reference to the first sentence of Article 111(2) EPC, and in particular to the words "insofar as the facts are the same" relevant, as said Article 111(2) EPC can only be interpreted in the light of the aforementioned principle of procedure regarding the extent of the remittal. Therefore, in case T 843/91 (OJ EPO 1994, 832, point 3.4.2 of the reasons) it was rightly decided that it follows from Article 111(2) EPC that the Opposition Division is free to consider fresh matter, but matter that is relevant only to the remitted matter i.e. (as in the present case) the adaptation of the description.

The present case is quite different from case T 167/93 (OJ EPO 1997, 229) referred to by the appellant, in which Article 111(2) EPC was not applicable as the Board had only to examine whether the Opposition Division was bound by a decision of a Board of Appeal on appeal from an Examining Division.

Furthermore, the mere fact that it is only provided in the first sentence of Article 111(2) EPC that the binding effect of a Board of Appeal decision extends to the organ of the EPO to whom the decision is referred back does not mean that the same binding effect

vanishes when the decision of that organ is appealed. The extent of the remittal to the Opposition Division defines also the frame for the subsequent procedure before a Board of Appeal.

As to the request of the appellant to refer three questions (see above under point III) to the Enlarged Board of Appeal, this must be rejected because the purpose of an appeal is mainly to give a losing party the possibility to challenge the appealed decision on its merits. Therefore, the appellant's request, which does not concern the question whether the powers of an Opposition Division depend on and are limited by the extent of a remittal, is irrelevant.

3. *Amendments to the description*

3.1 Procedural aspects

At the time the application was filed, two embodiments of the graft according to the invention were proposed and illustrated by Figures 1A, 1B and Figures 2A, 2B, respectively. During examination of the patent up to the appeal decision T 818/93, the first embodiment according to Figures 1A, 1B turned out to be known from each of documents

- (1) US-A-3 657 744 and
- (2) "Expandable Intraluminal Graft: A Preliminary Study" By Julio C. Palmaz et al. Radiology, vol. 156, No. 1, July 1985, pages 73 to 77.

Therefore, both documents could reasonably be

acknowledged in the background part of the description to illustrate the known features recited in the precharacterising portion of claim 1 (cf. decision T 818/93, sections 4.2 and 4.4.1).

Since the graft according to the invention as finally accepted by the Board was restricted to the second embodiment according to Figures 2A, 2B, all information related to the first embodiment and previously presented as representing the invention had to be removed from the description and rearranged to the background part to outline the state of the art represented essentially by documents (1) and (2). These are the actions which the prior Board's decision T 818/93 has ordered the Opposition Division to do by using the expression "and the description to be adapted thereto".

Adaptation of the description to finally amended claims and to the corresponding relevant prior art generally requires a short presentation of the state of the art, i.e. restricted to the features which are common to the precharacterising portion of claim 1 and to the closest prior art document. This presentation usually takes place in the introductory part of the description, before the detailed disclosure of at least one way of carrying out the invention (Rule 27 EPC).

In the present case, however, adaptation of the description required considerable work to be done because, according to the Board's judgement, document (1) had to be acknowledged as the prior art closest to the invention (T 818/93 section 4.2) instead of document (2) which was in this place according to the

patent as originally granted. Moreover, the detailed description of the first embodiment according to Figures 1A, 1B, which had turned out to belong to the state of the art, could be deleted from the description as superfluous and replaced by a short presentation of the known features in the background part of the description.

3.2 Deletions from the description in relation to Figures 1A, 1B

The following terms and passages were removed from the patent specification: "preferably" (column 6, line 58); information related to the materials (column 7, lines 17 to 22 and lines 30 to 34), to the cross-sectional configuration (column 7, lines 39 to 42) and to the fixation mode of the intersecting elongate members of the graft (column 7, lines 46 to 50). All these deletions are justified by the fact that they refer to the embodiment according to Figures 1A, 1B, i.e. to the state of the art. As mentioned above, information transferred to the background part must be short, possibly limited to the precharacterising features of claim 1 known from the disclosure of the closest prior art documents (1) and (2). Consequently, such deletions have no impact on the disclosure of the invention itself which is restricted to Figures 2A, 2B, and, therefore, are not such as to modify extensively the subject-matter of the patent in suit with respect to the content of the application as filed (Article 123(2) EPC).

Article 52(1) EPC states: "European patents shall be granted for any **inventions**...". Also Article 78(1)(b)

EPC states: "A European patent application shall contain: (b) a description of the **invention**". As a consequence thereof, the "subject-matter" of the European patent which, according to Article 123(2) EPC may not be amended to extend over the content of the application as filed, is the information related to the **invention**, not that concerning the state of the art.

Therefore, by acknowledging in the amended description that the embodiment according to Figures 1A, 1B is now prior art (cf. column 5, line 49 and column 6, line 18) and by deleting superfluous prior art information related thereto, the amendments made to adapt the description comply with the requirements of Rule 27(1) and Article 123(2) EPC.

3.3 Deletions from the description in relation to Figures 2A, 2B

The expression "Wire mesh tube" was removed whenever the second embodiment was described in relation to Figures 2A, 2B: column 8, lines 44 to 48; column 9, line 58 and column 10, line 4. Although the above expression is appropriate to define the graft of Figures 1A, 1B, i.e. "a stainless steel wire woven in a criss-crossed tubular pattern" (column 7, line 55 to column 8, line 1) - see also document (2) (page 73 and Figure 1) - this expression is improper for describing the graft according to Figures 2A, 2B.

After the first embodiment had become prior art it was justified to remove from the description the questionable expression for defining the second embodiment also since, as explained in the prior

decision T 818/93 (section 5.5) the two embodiments are not equivalent by reason of a number of structural differences. Therefore, the above deletions made in the description with respect to Figures 2A, 2B are correct and not such as to modify extensively the subject-matter of the invention. On the contrary, they promote the comprehension of the invention, by actually avoiding an expression which was not fully appropriate. Consequently, the adaptation of the description by way of a limitation of its subject-matter is also in line with the provisions of Article 123(2) EPC.

- 3.4 Article 123(3) EPC is not an issue in the present proceedings because the claims are no longer susceptible of amendment after the decision T 818/93. The last amendments were made to claim 1 before the Board during oral proceedings in case T 818/93. Therefore, they are no longer open to objections.

Although amendments to the description may, pursuant to Article 69(1) EPC, influence the interpretation of the claims and, therefore, inadmissibly extend the protection conferred, the claims are the primary place to define the matter for which protection is sought (Article 84 EPC), whereas the main function of the description is to disclose the invention so that it may be carried out (G 1/93, OJ EPO 1994, 541, Headnote II and section 14). In the present case, the Board does not see how some deletions related principally to the state of the art and one deletion made to properly redefine the invention could result in an extension of the protection conferred.

- 3.5 Acknowledgement of document (1) in the description

As stated in the background part of the patent specification, an expandable graft structure comprising the features of the precharacterising portion of claim 1 is known from document (1), in accordance with the analysis of the Board in decision T 818/93 (section 4.2). Moreover, in the following section 4.3, it is stated that claim 1 differs essentially from the disclosure of document (1) by the characterising features according to which:

- (a) each second bar (79) extends only between said pair of first bars (78), and
- (b) each second bar (79) extends on the circumference of a circle whose plane is perpendicular to the longitudinal axis of said tubular shaped member (71).

This statement, however, does not imply that the remaining characterising features are disclosed in document (1). The assessment of novelty which is dealt with in section 4.2 of said prior decision only requires the provision of at least one distinctive feature for the subject-matter of the claim as a whole to be regarded as novel. The most essential features (a) and (b) were selected by the previous Board to this end.

As explained in decision T 818/93 (section 4.2) the tubular-shaped implant illustrated in Figure 2 of document (1) differs from that of the present invention in that the rectangular cross-sectional configuration of the intersecting elongate members is uniform only in the first stage of the fabrication, i.e. during the operation of forming slits in the metal sheet. In the following stretching operation to cause the slits to open into diamond-shaped apertures, a twist is imparted to the elongate members, so that said uniform cross-section cannot be held any further (see Figure 5 in document (1)) when the implant is then formed into a sleeve.

As also explained in section 4.2 of said decision the sleeve configuration according to Figure 2 of document (1) is actually comparable with that of Figure 2B of the contested patent in that both illustrate a graft **after** expansion. However, the invention as defined by the characterising features of claim 1 is directed to Figure 2A of the patent, i.e. a graft shown **before** expansion. In that non-expanded state (cf. decision supra, section 4.3), the first and second bars are parallel with respect to one another and define a series of axially shifted rectangular openings in the direction of the axis of symmetry of the graft, which results from the simultaneous consideration of the characterising features (a) and (b).

Decision T 818/93 (cf. section 5.4) goes on to explain that the graft according to document (1) does not have second bars in the sense of the patent. The intersecting elongate members actually form a "wire

mesh tube", i.e. a structure made of obliquely oriented members joined at intersecting points. It follows that none of the features forming the characterising portion of claim 1 is disclosed in document (1) and that claim 1 is properly delimited vis-à-vis the disclosure of document (1), in accordance with Rule 29(1) EPC. Therefore, the acknowledgment of document (1) in the introductory part of the description is correct, which leaves no doubt as to the scope of protection conferred by the subject-matter of claim 1.

Thus, the Board is satisfied that the provisions of Rule 27(1) EPC, in particular items (b) and (c), are fulfilled. Claim 1 is also fairly supported by the description in accordance with Article 84 EPC, second sentence, since the problem and solution in relation to the invention are presented in column 3 of the patent specification in correspondence with the characterising features of claim 1.

4. *Apportionment of costs*

An apportionment of costs different from that provided by Article 104(1) EPC is not justified.

On the one hand no abuse of procedure has been committed by the appellant, who was fully entitled to question the manner in which the description had been amended. On the other hand the Board has no power to charge costs to the respondent for reasons related to his alleged impropriety of conduct during the procedure that led to decision T 818/93.

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 with the order to maintain the patent in amended form on the basis of the documents defined in the decision under appeal, provided that page 3a of the description is replaced by page 3a of the description submitted at the oral proceedings of 20 October 1999.
3. Both requests for apportionment of costs are rejected.

The Registrar:

The Chairman:

S. Fabiani

W. D. Weiß