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**Datasheet for the decision  
of 24 October 2024**

**Case Number:** T 1522/20 - 3.2.02

**Application Number:** 07864990.2

**Publication Number:** 2395902

**IPC:** A61B1/005, A61B1/00, A61B17/29,  
A61B1/018, A61B17/04,  
A61B10/06, A61B90/00,  
A61B17/02, A61B17/34

**Language of the proceedings:** EN

**Title of invention:**  
DIRECT DRIVE ENDOSCOPY SYSTEM

**Patent Proprietor:**  
Boston Scientific Limited

**Opponent:**  
Karl Storz SE & Co. KG

**Relevant legal provisions:**  
EPC Art. 54(2), 54(3), 87(1), 88(1), 123(2)  
RPBA 2020 Art. 12(4)

**Keyword:**

Priority - first application (no) - presumption of entitlement rebutted (no)

Amendment to case (no) - admissibly raised and maintained (yes) - taken into account (auxiliary request 4 - yes)

Novelty (main request, auxiliary requests 1 to 3 - no) (auxiliary request 4 - yes)

Amendments - added subject-matter (no)

**Decisions cited:**

G 0001/22, G 0002/22, T 0246/22, T 1135/22



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Case Number: T 1522/20 - 3.2.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.02**  
**of 24 October 2024**

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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
12 May 2020 concerning maintenance of the  
European Patent No. 2395902 in amended form.**

**Composition of the Board:**

**Chairman** D. Ceccarelli  
**Members:** S. Dennler  
N. Obrovski  
S. Böttcher  
Y. Podbielski

## Summary of Facts and Submissions

I. Both the patent proprietor and the opponent filed an appeal against the opposition division's interlocutory decision to maintain European patent No. 2395902 ("the contested patent") in amended form on the basis of auxiliary request 3.

II. The contested patent was granted from European patent application No. 07864990.2, published as international application under WO 2008/070556 A1 with the filing date of 30 November 2007 ("the PCT application"), and claiming priority from the following US provisional applications:

**P1** 60/872,155, filed on 1 December 2006

**P2** 60/909,219, filed on 30 March 2007

and from six other US provisional applications, all filed on 28 September 2007.

P1 names B. Weitzner, P. Smith, B. Intoccia, J. Golden, K. Kruger, N. Suon and W. Shaw as inventors and applicants. The PCT application names these seven persons, together with two other persons, as inventors and Boston Scientific Scimed, Inc. as applicant.

III. In its decision, the opposition division held that the priority claim from P1 was invalid because it was not established that the priority right derived from P1 had been validly assigned to Boston Scientific Scimed, Inc. prior to the filing of the PCT application.

As a result, the following document:

**E3** WO 2007/002545 A1, filed on 22 June 2006 and published on 4 January 2007

was prior art under Article 54(2) EPC. The opposition division concluded that the subject-matter of claim 1 as granted and claim 1 of auxiliary requests 1 and 2 lacked novelty over E3, and that the subject-matter of claim 1 of auxiliary request 3 was novel over E3.

IV. The **appellant-patent proprietor** requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or, alternatively, in amended form on the basis of one of auxiliary requests 1 to 17 enclosed with its statement of grounds of appeal.

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

V. The Board provided its preliminary view on the appeal in its communication under Article 15(1) RPBA.

VI. Oral proceedings were held before the Board on 24 October 2024, at the end of which the present decision was announced.

VII. This decision also refers to the following documents:

**VP10** assignment recorded for P2  
**VP11** affidavit of Leslie Bookoff  
**VP12** MHL Tek, LLC v. Nissan Motor Co.,  
655 F.3d 1266 (2011)

VIII. **Claim 1 as granted (main request)** reads as follows  
(with the feature numbering introduced in the decision  
under appeal):

**A** "A drive system for simultaneously controlling  
multiple degrees of freedom, the system  
comprising:  
**B** at least one tool (26), the tool (26) comprising:  
**C** a flexible elongate body (32)  
**D** extending [sic] between a proximal end (36) and  
a distal (34),  
**E** the distal end (34) including a distal end  
effector (40A, 40B), and  
**F** a controller (30) for  
**G** mechanically receiving user input and  
**H** mechanically transmitting those user inputs  
**I** to a distal articulation portion (56),  
**J** wherein the controller (30) is fixedly attached  
to the flexible elongate body (32) and  
**K** can direct at least one degree of freedom of  
the distal end effector (40A, 40B), and  
**L** a frame (22)  
**M** configured to mate with the tool (26),  
**N** wherein the controller (30) of the at least one  
tool (26) is movably connected with the frame  
(22), such that the controller (30) can move  
relative to the frame (22)  
**O** to allow the user to control at least two degrees  
of freedom of the tool (26) with respect to the  
frame (22)  
**P** while allowing simultaneously control of the at  
least one degree of freedom of the distal end  
effector (40a, 40b) via the controller (30)."

IX. **Claim 1 of auxiliary request 1** differs from claim 1 as granted in that the word "expending" in feature D has been amended to "extending".

X. **Claim 1 of auxiliary request 2** differs from claim 1 of auxiliary request 1 by the deletion of the word "and" in feature K and by the following additional feature appended to the claim:

*"and a lock for inhibiting movement of the articulation portion (56) of the tool (26) when engaged."*

XI. **Claim 1 of auxiliary request 3** differs from claim 1 of auxiliary request 1 by the following amendments in features J and K, highlighted by the Board:

**J** *"wherein the controller (30) has a passageway (392) to receive the flexible elongate body (32), wherein an inner surface of the passageway (392) is fixedly attached to an outer sheath of the flexible elongate body (32), and*

**K** *wherein the controller (30) can direct at least one degree of freedom of the distal end effector (40A, 40B), and"*

XII. **Claim 1 of auxiliary request 4** differs from claim 1 of auxiliary request 1 by the following additional features appended to the claim:

*"the system further comprising a rail that movably mates the tool (26) and the frame (22), wherein the rail constrains movement of the controller (30) with respect to the frame (22) to movement along axes parallel to an axis defined by the rail, the system further comprising indicia on the rail, frame (22), and/or controller (30) for indicating the*

*relative position and/or orientation of the distal end (34)."*

XIII. The **patent proprietor's arguments** relevant for the present decision can be summarised as follows.

*Priority of P1*

As considered by the Board in its communication under Article 15(1) RPBA, the opponent, which bore the burden of proof as the party contesting the priority, had not convincingly rebutted the presumption, recognised in G 1/22 and G 2/22, that the applicant of the PCT application was entitled to claim priority, in particular from P1.

In any event, the assignment recorded for P2 in VP10 constituted a valid assignment of the right to claim priority from P1, even though VP10 did not expressly mention P1. Indeed, VP10 did not only refer to rights derived from P2, but also referred broadly to the "entire right, title, and interest in and to [the] invention" to which P2 related. This interpretation was supported by the affidavit VP11, the author of which was an experienced US patent attorney, and by VP12, which constituted a common law precedent on the question of the interpretation of an assignment under the applicable US law.

Furthermore, E3 did not disclose the subject-matter of claim 1 as granted and claim 1 of auxiliary requests 1 to 4, so that P1 was the "first application" for that subject-matter.



It followed that claim 1 as granted and claim 1 of auxiliary requests 1 to 4 were entitled to priority from P1.

*Main request - novelty over E3*

The subject-matter of claim 1 as granted was novel over E3. This document did not disclose the following features or group of features:

a) The mere bending of a flexible medical device tip as disclosed in E3 did not anticipate an articulation portion (feature I). The term "articulation portion" implied the presence of a structure defining a hinge, or at least a bending or pivot location. In the contested patent, this structure included a series of articulation segments 62 (Figure 3A, paragraph [0038]). No such structure was disclosed in E3.

b) E3 did not disclose that the controller was fixedly attached to the elongate body (feature J). In particular, a clamping device with a set screw as suggested by the opponent was not directly and unambiguously disclosed in Figure 6A, which was purely schematic, or in the description. Moreover, it was improper to rely on the scaled superimposition of Figures 6A and 6B presented by the opponent, which added new information as compared to what could actually be deduced from E3. In fact, a fixed attachment of the controller to the elongate body was not needed in E3 because the bending of the distal tip of the elongate body 250 using Bowden cables described in E3 only required the elongate body 250 to abut externally against the controller so as to arrest movement of the elongate body in the proximal

direction. A fixed attachment was even undesirable as clamping the elongate body 250 would have damaged it.

c) E3 did not disclose the combination of features E, K and L-P. The opponent's reasoning was incorrectly based on the undisclosed and artificial combination of distinct, separate embodiments of E3. On the one hand, the embodiments of Figures 1-6F, especially that shown in Figure 6A, did not disclose a distal end effector (features E, K), much less a suitability of the system to perform the simultaneous control defined in feature P. On the other hand, while the embodiments of Figures 7A-7I comprised a distal end effector, such as a biopsy forceps 304, operated by a controller (features E and K), this controller was not disclosed in association with any frame to which the controller was movably connected. Hence, these embodiments did not disclose a frame as defined by features L-P.

*Auxiliary requests 1 to 3 - novelty over E3*

The subject-matter of claim 1 of each of auxiliary requests 1 to 3 was also novel over E3.

a) The subject-matter of claim 1 of auxiliary request 1 was in substance identical to that of claim 1 as granted, and was novel over E3 for the same reasons.

b) The lock disclosed on page 2, lines 28-30 of E3 prevented movement of the control body 12 along the rail 18. However, it did not lock the actuator 20 that was responsible for movement of the distal tip in the right/left and up/down directions, so that the distal articulation portion could still be freely actuated. Thus, the lock disclosed in E3 did not inhibit movement

of the articulation portion of the tool when engaged as required by the lock of claim 1 of auxiliary request 2.

c) E3 did not disclose that the controller had a passageway to receive the flexible elongate body, wherein an inner surface of the passageway was fixedly attached to an outer sheath of the flexible elongate body, as required by feature J of claim 1 of auxiliary request 3. As argued for claim 1 as granted, the proximal end of the elongate body 250 merely appeared to abut externally against the controller 140. Even assuming that Figure 6A disclosed a clamping device for clamping the elongate body 250, E3 did not directly and unambiguously disclose that this clamping device belonged to the controller and where the elongate body ended with respect to this clamping device.

#### *Auxiliary request 4*

#### *Admittance*

Auxiliary request 4 was identical to the auxiliary request 5 filed on 12 October 2018 in the opposition proceedings. This request had been admissibly raised and maintained throughout the opposition proceedings. This request therefore formed part of the appeal proceedings and the Board had no power to disregard it.

#### *Added subject-matter*

Claim 1 of auxiliary request 4 did not contain added subject-matter. Feature J was disclosed consistently for various embodiments of the PCT application as filed, for example for the embodiment of Figure 84 described in paragraph [0357]. In that embodiment, the control mechanism 24 and the adjuster 394 both formed

in combination a controller to which the elongate body of the catheter was "fixedly mate[d]", i.e. "fixedly attached". It was immaterial that the adjuster 394 could rotate with respect to the control mechanism 24. Feature J was not inextricably linked to the orientation adjuster or to the other features identified by the opponent.

*Novelty over E3*

The subject-matter of claim 1 of auxiliary request 4 was novel over E3. E3 did not disclose any indicia as defined in the claim.

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

*Priority of P1*

The PCT application and P1 had been filed in the name of different applicants. However, none of the various supporting documents submitted by the patent proprietor - including VP12, which could and should have been filed in the opposition proceedings and should therefore not be admitted on appeal - could conclusively prove that the right to claim priority from P1 had been validly assigned to the applicant of the PCT application prior to its filing. VP10 did not mention P1 but concerned the assignment of rights derived from P2. VP11 and VP12, even if admitted, did not lead to a different conclusion. As a result, no priority could be validly claimed from P1.

In any event, E3, which had been filed before P1 and by the same applicant as the PCT application, disclosed the subject-matter of claim 1 as granted and claim 1 of

auxiliary requests 1 to 3. Therefore, as the Board had stated in its communication under Article 15(1) RPBA, P1 was not the "first application" for that subject-matter. No priority of P1 could be validly claimed for it.

*Main request - novelty over E3*

The subject-matter of claim 1 as granted was not novel over E3.

a) The distal tip of the flexible elongate body 250 could be bent upon operation of control cables, such as Bowden cables (Figures 6A and 6B; page 3, lines 29-31; page 5, lines 24-27). This anticipated a distal "articulation portion" to which user inputs were mechanically transmitted by the controller as required by feature I. The broad term "articulation portion" was not further specified in claim 1 as granted. The articulation segments 62 shown in Figure 3A of the contested patent were also not hinged to each other.

b) A fixed attachment of the elongate body to the control housing (feature J) was necessary for the operation of the systems of E3 in the manner disclosed, and was therefore implicitly disclosed in E3. Furthermore, in Figure 6A, the person skilled in the art would have directly and unambiguously recognised a clamping device having a set screw for clamping the outer sheath of the elongate body 250 and thereby fixedly attaching it to the control housing 140. This was also apparent from the scaled superimposition of Figures 6A and 6B shown on page 8 of the opponent's statement of grounds of appeal.

c) The control 140 in the embodiment of Figure 6A included a trigger 164 enabling a user to actuate a tool within the elongate device 250. In addition, Figures 7A-7I disclosed "a number of alternative trigger mechanisms that allow a tool to be actuated from the control that orients a medical device" (page 10, lines 7-9), where this tool could be, for example, a biopsy forceps 304, i.e. a distal end effector (page 10, last two lines). The person skilled in the art would have understood that these trigger mechanisms were intended to be combined with the control 140 of Figure 6A and that the actuation of the distal end effector, for example by operating the trigger 164, could be performed while simultaneously moving and rotating the control 140 with respect to the rail 142. E3 therefore disclosed features E and K in combination with features L to P.

*Auxiliary requests 1 to 3 - novelty over E3*

The subject-matter of claim 1 of each of auxiliary requests 1 to 3 also lacked novelty over E3.

a) Claim 1 of auxiliary request 1 was in substance identical to claim 1 as granted and lacked novelty over E3 for the same reasons.

b) The feature added in claim 1 of auxiliary request 2 required merely that the movement of the distal articulation portion be "inhibited", but not that it be completely prevented. By fixing the control body 12 with respect to the rail, the lock disclosed on page 2, lines 28-30 of E3 at the same time "inhibited" a corresponding movement of the catheter 14 and thus of the distal articulation portion.

c) The clamping device disclosed in Figure 6A and the control 140 together formed a controller. This mechanism necessarily required the outer sheath of the elongate body 250 to be received in a passageway of the clamping device and attached to an inner surface of this passageway, which anticipated feature J of claim 1 of auxiliary request 3.

*Auxiliary request 4*

*Admittance*

Auxiliary request 4 was identical to the auxiliary request 5 filed in the opposition proceedings. However, this request was not dealt with in the decision under appeal and had not been explicitly admitted by the opposition division. The patent proprietor had not actively and expressly confirmed at the end of the oral proceedings before the opposition division that it maintained this request. In these circumstances, in accordance with T 1135/22 and T 246/22, auxiliary request 4 was not part of the appeal proceedings and should not be admitted by the Board.

*Added subject-matter*

Claim 1 of auxiliary request 4 contained added subject-matter because feature J, according to which the controller was "fixedly attached" to the flexible elongate body, was nowhere disclosed in the PCT application as filed.

Firstly, the term "fixedly attached" was never used in the PCT application, which instead used the term "fixedly mated". The meaning of "mated" was broader than that of "attached".

Secondly, in the embodiment described in paragraphs [0357] and [0361], which the patent proprietor indicated as a basis for feature J, the elongate body of the catheter 25 was not directly attached to the control mechanism 24, but was "fixedly mated" to an intermediate "orientation adjuster" 394 which was itself rotatably coupled to the control mechanism 24 so that the elongate body of the catheter could rotate relative to the control mechanism 24. The latter two parts were therefore not "fixedly attached" to each other as required by feature J. In any event, the "orientation adjuster" 394, the specific mating mechanism with the elongate body received in a passageway of the orientation adjuster and a number of additional features had been disclosed in combination as essential parts of a specific embodiment. The omission of these features from claim 1 of auxiliary request 4 constituted an inadmissible intermediate generalisation.

At the oral proceedings before the Board, the opponent stated that it had no further objections to auxiliary request 4.

#### *Novelty over E3*

The opponent did not contest that the subject-matter of claim 1 of auxiliary request 4 was novel over E3.

### **Reasons for the Decision**

#### **1. The subject-matter of the contested patent**

The contested patent relates to a drive system for driving a tool in response to user input forces along





down (paragraphs [0017], [0018], [0033]), and which can direct at least one degree of freedom of the distal end effector.

The drive system further comprises a frame (22) configured to mate with the tool (paragraphs [0123] ff.). The controller of the tool is movably connected to the frame such that the controller can move relative to the frame to allow a user to control at least two degrees of freedom of the tool with respect to the frame while simultaneously allowing control of the at least one degree of freedom of the distal end effector via the controller. The frame may thus provide a reference point for manipulating the various degrees of freedom present relative to one another (and/or relative to a portion of the system and/or relative to a patient) in a manner that allows complex surgical procedures to be performed (paragraphs [0339] and [0340]).

## **2. Priority of P1**

2.1 Since E3 was published after the filing date of the earliest priority P1 and before the filing dates of the later priorities claimed by the contested patent, the question whether the priority of P1 is validly claimed, which is disputed by the opponent, is of central importance for the assessment of novelty and inventive step in view of this document.

2.2 In G 1/22 and G 2/22, the Enlarged Board of Appeal held that there is a strong, rebuttable presumption under the autonomous law of the EPC that an applicant claiming priority in accordance with Article 88(1) EPC and the corresponding Implementing Regulations is entitled to claim priority (see Headnote I). The party

challenging the entitlement to priority bears the burden of proof for the rebuttal of the presumption. This party cannot just raise speculative doubts but must demonstrate that specific facts support serious doubts as to the entitlement to priority (see point 110 of the Reasons).

In the present case, therefore, there is a strong, rebuttable presumption that the applicant of the PCT application is entitled to claim the priority of P1.

2.3 The opponent challenged this entitlement.

However, in support of its objection, the opponent merely argued that the patent proprietor had not conclusively shown that the right to claim priority from P1 had been validly transferred from the applicants of P1 to the applicant of the PCT application, which was different, prior to the filing of the PCT application. The opponent did not put forward any specific fact supporting serious doubts in this respect.

In particular, even if, as argued by the opponent, the evidence submitted by the patent proprietor, such as VP10, could be considered as only proving the transfer of the priority right derived from P2 and not from P1, this would not in itself rebut the presumption that the priority right derived from P1 was also validly transferred, possibly in a different way.

2.4 Notwithstanding this, as the Board noted in its communication under Article 15(1) RPBA (see point 4), E3 was filed by the same applicant as the PCT application. Therefore, since E3 was filed before P1, P1 cannot be the "first application" within the meaning

of Article 87(1) EPC for the subject-matter disclosed in E3, with the consequence that no priority can be claimed from P1 for that subject-matter.

As discussed below, E3 discloses the subject-matter of claim 1 as granted and of claim 1 of auxiliary requests 1 to 3. For this subject-matter, therefore, no priority can be claimed from P1, and E3 is (novelty-destroying) prior art under Article 54(2) EPC.

### **3. Main request (patent as granted) - novelty over E3**

3.1 With the embodiment shown in Figures 6A and 6B (see also page 7, lines 8-29), E3 discloses a drive system for simultaneously controlling multiple degrees of freedom (in particular, those of the distal tip of the flexible elongate body of the medical device 250, which can be moved in two different planes by operating the actuator handle 160; see page 7, lines 26-29), the system comprising:

- (a) at least one tool, the tool comprising a flexible elongate body (medical device 250) extending between a proximal end and a distal end; and a controller (control 140) for mechanically receiving user input (via actuator handle 160 of the control) and mechanically transmitting those user inputs to the distal tip of the elongate body to bend it accordingly (in two different planes; see page 7, lines 26-29), and
- (b) a frame (rail 142) configured to mate with the tool (see clamps 148, 150), wherein the controller of the at least one tool is movably connected with the frame such that the controller can move relative to

the frame (the control 140 can move along and rotate about the rail 142; page 7, lines 11-13).

3.2 The patent proprietor unconvincingly argued that E3 did not disclose, in combination with the above features, the following remaining features of claim 1 as granted.

3.2.1 *Feature I*

As shown in Figure 6A and described for example on page 7, lines 26-29, it is not the entire elongate body which bends in response to the actuation of the handle 160 of the control 140, but the "distal tip" of the elongate body, which bends relative to a more proximal portion thereof. Although not literally described as such in E3, the distal tip, to which the user input received at the control 140 is mechanically transmitted, would be considered by the person skilled in the art to be "articulated" and thus to form a distal "articulation portion", because it can bend relative to the more proximal portion of the elongate body. Contrary to the patent proprietor's view, and as the opposition division held in the decision under appeal, there is no reason why the person skilled in the art would interpret the term "articulation portion", which is not further specified in claim 1 as granted, as being limited to a hinged structure or to a structure comprising additional articulation parts such as the segments shown in Figure 3A of the contested patent. This figure depicts only a particular embodiment of the "articulation portion" described more generally in paragraph [0033].

3.2.2 *Feature J*

As shown in Figure 6B and described for similar embodiments in the paragraph spanning pages 3 and 4 and in the paragraph spanning pages 5 and 6, in E3 the bending of the distal tip is actuated by control cables, such as Bowden cables, sliding through the elongate body. Contrary to the patent proprietor's argument, simply arresting the movement of the elongate body in the proximal direction by merely abutting it externally against the housing of the control 140, without preventing it from disengaging from the control in use, would not allow for proper functioning of the tool and potentially open up unwanted access to the internal actuation mechanism, particularly when some of the control cables slide back in the distal direction. The person skilled in the art who is aware of these issues would therefore consider the control 140 to be necessarily "fixedly attached" to the elongate body 250, as defined by feature J.

This conclusion is also supported by the figures, which consistently show that, in use, the elongate body of the tool is in close contact with the rest of the tool, in particular the control housing. In particular, on the basis of the foregoing considerations, the person skilled in the art would directly and unambiguously recognise from Figures 6A and 6B - despite their schematic nature and without having to resort to any scaled superimposition as submitted by the opponent - that the elongate body 250 is "fixedly attached" to the control 140 by means of a clamping device (without reference sign in Figure 6A) in which the proximal end of the elongate body is received and fixed, and which has a hole for a set screw for adjusting the clamping force.

The patent proprietor has not disputed that such a clamping mechanism would be suitable for "fixedly attach[ing]" the elongate body, but claimed that the person skilled in the art would not see a clamping mechanism in Figure 6A because clamping could damage the elongate body. This is not convincing. The clamping mechanism disclosed in E3 must implicitly be adapted to prevent any damage to the elongate device.

Moreover, it is immaterial whether the clamping device identified in Figure 6A is a part of the control 140 or an additional, separate component. Feature J does not require the elongate body to be directly attached to the controller and, in any event, the clamping device and the control 140 also form a controller in combination.

### 3.2.3 *Features E, K and L-P*

As argued by the opponent, E3 discloses on page 7, lines 15-16 that the trigger 164 provided on the actuator handle 160 of the embodiment of Figure 6A "allows a user to actuate a tool within the medical device 250". Further, on page 10, lines 7-9, E3 states that Figures 7A-7I disclose "a number of alternative trigger mechanisms that allow a tool to be actuated from the control that orients a medical device in the [...] directions".

Therefore, contrary to the patent proprietor's argument, the person skilled in the art directly and unambiguously understands that each of the tools disclosed in connection with the embodiments of Figures 7A-7I, such as the biopsy forceps mentioned on page 10, line 33 - which is an end effector having at least one degree of freedom - is to be used as a "tool

within the medical device 250" for actuation by the trigger 164. It follows that E3 discloses that the distal end of the elongate body 250 includes a distal end effector of which the controller, via the trigger 164, can direct at least one degree of freedom, i.e. features E and K.

Furthermore, E3 discloses that the control 140 can move along and rotate about the rail 142 (page 7, lines 10-13) which, given the attachment of the control to the elongate body (see the discussion of feature J above), simultaneously causes the elongate body 250 to move and rotate accordingly. This allows a user to control at least two degrees of freedom of the tool relative to the rail. In addition, a user could well actuate the trigger 164 of the control 140 while simultaneously moving and rotating the control 140 with respect to the rail 142. Therefore, contrary to the patent proprietor's view, E3 also discloses features L to P in combination with features E and K.

3.3 It follows that E3 discloses all the features of claim 1 as granted in combination. The subject-matter of claim 1 as granted is therefore not novel (Article 54(2) EPC) and the main request is not allowable.

#### **4. Auxiliary requests 1 to 3 - novelty over E3**

Auxiliary requests 1 to 3 are identical to the corresponding requests on which the decision under appeal is based.

##### *4.1 Auxiliary request 1*



Apart from the correction of an obvious typing error, claim 1 of auxiliary request 1 is in substance identical to claim 1 as granted. Therefore, for the same reasons, claim 1 of auxiliary request 1 lacks novelty over E3 (Article 54(2) EPC). Hence, auxiliary request 1 cannot be allowed either.

#### 4.2 *Auxiliary request 2*

4.2.1 It is true that the lock based on the clamps 16 disclosed in page 2, lines 28-30 of E3, when engaged, only prevents the control body 12 from moving relative to the rail 18, but does not prevent the distal tip of the medical device 14 from being freely actuated. The same applies to the clamps 148, 150 in the embodiment of Figure 6A, which fix the position and orientation of the control 140 relative to the rail 142 (page 7, lines 11-13), but do not prevent the distal tip from bending upon actuation of the actuator handle 160.

However, as argued by the opponent, the additional feature added in claim 1 of auxiliary request 2 requires only that the movement of the distal articulation portion be "inhibited", not completely prevented, when the lock is engaged. By fixing the control with respect to the rail, i.e. the frame in the wording of the claim, the clamps disclosed in E3 at the same time "inhibit" a corresponding movement of the elongate body and thus of the distal articulation portion. Therefore, E3 also discloses the additional feature of claim 1 of auxiliary request 2.

4.2.2 Furthermore, as noted by the Board in its communication under Article 15(1) RPBA, E3 also discloses additional mechanisms, such as brakes, to fix the position of the distal tip once it has been set by the controller

(page 6, lines 9-15), thereby "inhibiting" any further bending of the distal tip and thus any movement of the distal articulation portion. This also anticipates the additional feature of claim 1 of auxiliary request 2. This was not commented on by the patent proprietor.

4.2.3 It follows that the subject-matter of claim 1 of auxiliary request 2 is disclosed in E3 and is therefore not novel (Article 54(2) EPC). Hence, auxiliary request 2 is not allowable either.

#### 4.3 *Auxiliary request 3*

As argued by the opponent, the clamping device disclosed in Figure 6A of E3 (see point 3.2.2) also anticipates feature J as amended in auxiliary request 3. Contrary to the patent proprietor's view and the opposition division's assertion in the decision under appeal, such a clamping mechanism would not function if the clamping device did not have a passageway in which at least a proximal end of the elongate body is received, with an outer sheath of the elongate body at the proximal end being fixedly attached to an inner surface of the passageway, for example by means of the set screw.

It follows that the subject-matter of claim 1 of auxiliary request 3 is also disclosed in E3 and is therefore not novel either (Article 54(2) EPC). Therefore, auxiliary request 3 is not allowable.

### 5. **Auxiliary request 4**

#### 5.1 *Admittance*

- 5.1.1 Auxiliary request 4 is identical to auxiliary request 5 filed by the patent proprietor during the opposition proceedings.

Since it decided to maintain the contested patent as amended on the basis of a higher-ranking request, it was not necessary for the opposition division to deal with auxiliary request 5, and the decision under appeal is not based on it. This request is therefore a so-called "carry-over request". As discussed in T 1135/22 (see point 4 of the reasons), to which the opponent referred, such a request is not automatically part of the appeal proceedings. Rather, it must be assessed whether this request was, within the meaning of Article 12(4) RPBA, admissibly raised and maintained in the proceedings leading to the decision under appeal.

- 5.1.2 The opponent did not dispute that auxiliary request 5 was admissibly raised. The Board has no doubt that it was.

- 5.1.3 However, referring to T 246/22, the opponent argued that this request had not been maintained in the opposition proceedings because the patent proprietor had not actively and expressly confirmed this at the end of the oral proceedings before the opposition division. This is not convincing.

It is true that, in T 246/22, the deciding Board based its conclusion as to the maintenance in the opposition proceedings of the requests in question on the fact that, according to the minutes of the oral proceedings before the opposition division, the patent proprietor had expressly maintained those requests at the end of the oral proceedings before the opposition division,

namely "in the time between the announcement of the conclusion that a higher-ranking claim request was found allowable and the announcement of the decision". The deciding Board thus concluded that those requests had been "manifestly maintained until the opposition division took its decision" (see point 4.8 of the reasons).

In the present case, as argued by the opponent, there was no such express declaration by the patent proprietor at the final stage of the opposition proceedings that auxiliary request 5 was maintained. The minutes of the oral proceedings before the opposition division (see point 2.1) show that the patent proprietor confirmed the maintenance of auxiliary request 5 at the beginning of the oral proceedings.

The present Board considers that, in the absence of any subsequent active withdrawal of this request, as is clear from the minutes, the request was maintained throughout the oral proceedings up until the opposition division took its decision.

This conclusion follows from what is already apparent from the minutes, which form part of the basis of the appeal proceedings under Article 12(1)(a) RPBA, and is also in line with the conclusion of the deciding Board in T 246/22 (see point 4.9 of the reasons).

This conclusion is not inconsistent with T 1135/22 either. In that case, the auxiliary requests in question were considered not to meet the "admissibly raised" criterion, as opposed to the "maintained" criterion, which is the issue to be assessed in the present case.

5.1.4 The Board therefore concludes that auxiliary request 4 was admissibly raised and maintained in the opposition proceedings, and that the Board has no power to disregard it in the appeal proceedings under Article 12(4) RPBA.

5.2 *Novelty and inventive step in view of E3*

5.2.1 It is common ground that E3 does not disclose indicia as defined in claim 1 of auxiliary request 4, so that the subject-matter of this claim is novel over E3.

5.2.2 As noted by the the Board in its communication under Article 15(1) RPBA (see point 7.2.2), the subject-matter of claim 1 of auxiliary request 4 is disclosed in P1, with the marking system described in paragraph [0076] of P1 constituting such indicia. P1 is thus the "first application" within the meaning of Article 87(1) EPC for such subject-matter.

Therefore, unlike the subject-matter of claim 1 of the higher-ranking requests discussed above, the subject-matter of claim 1 of auxiliary request 4 is entitled to the priority of P1 (see point 2.4). As a consequence, E3 is prior art for this subject-matter only under Article 54(3) EPC and is not relevant for deciding whether it involves an inventive step (Article 56 EPC).

5.2.3 This view was not contested at the oral proceedings before the Board by the opponent, which did not raise any novelty or inventive-step objection against claim 1 of auxiliary request 4.

5.3 *Added subject-matter*

5.3.1 The only added-matter objection substantiated by the opponent against auxiliary request 4, as it confirmed at the oral proceedings before the Board, concerned feature J, which, according to the opponent, was not supported by the PCT application as filed.

This objection is not convincing.

Firstly, as the opposition division also considered, the Board sees no difference in meaning between the terms "fixedly attached" and "fixedly mated". Paragraph [0357] discloses a variety of "mating" mechanisms ranging from "an adhesive, mechanical interlock, and/or frictional engagement" to a fixation by means of a set screw. All of these mechanisms are also "attaching" mechanisms. Therefore, the term "fixedly attached", although not used literally in the PCT application as filed, does not in itself add subject-matter.

Secondly, the feature according to which the controller is "fixedly attached", or "fixedly mated", to the flexible elongate body, is consistently supported by various passages of the PCT application as filed, as argued by the patent proprietor.

In particular, in the embodiment shown in Figure 84 and described in paragraph [0357], the control mechanism 24 and the adjuster 394 in combination form a controller to which the catheter body of the tool 40, i.e. the flexible elongate body in the wording of the claim, is "fixedly mated" ("the catheter body of tool 40 includes an outer sheath that fixedly mates to the inner surface of [the] passageway 392" of the adjuster 394), i.e. "fixedly attached".

This is so even though the adjuster 394 is itself adapted to rotate relative to the control mechanism 24 for adjustment purposes. The person skilled in the art would understand that it is the fixed attachment between the elongate body and the controller which allows a user to control at least two degrees of freedom of the tool relative to the frame by moving the controller relative to the frame. This function is not inextricably linked to a possible relative rotation between the elongate body and the controller, which is only an optional advantageous feature of the tool. The Board notes in this respect that paragraph [358] discloses that this rotation can in fact be prevented in use until adjustment is desired.

Therefore, contrary to the opponent's argument, the omission of such an orientation adjuster in claim 1 of auxiliary request 4 does not constitute an inadmissible intermediate generalisation. Nor does the omission of the other specific features of this embodiment referred to by the opponent, such as the reception of the elongate body in a passageway of the orientation adjuster. With respect to these other features the opponent did not explain why they should be considered as inextricably linked with the claimed ones. The Board sees no reason why they should be.

- 5.3.2 At the oral proceedings before the Board, the opponent stated that it had no further objections against auxiliary request 4.
- 5.3.3 The Board therefore concludes that claim 1 of auxiliary request 4 does not contain added subject-matter and complies with Article 123(2) EPC.

5.3.4 It follows that the patent can be maintained on the basis of auxiliary request 4.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent as amended in the following version:
  - claims 1 to 12 of auxiliary request 4 filed with the patent proprietor's statement of grounds of appeal
  - description and drawings of the patent specification

The Registrar:

The Chairman:



A. Chavinier-Tomsic

D. Ceccarelli

Decision electronically authenticated