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

**Case Number:** T 1886/22 - 3.2.02

**Application Number:** 14703679.2

**Publication Number:** 2908723

**IPC:** A61B5/0408, A61B18/04,  
A61B18/18

**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. 111(1), 114(1), 123(2)

RPBA 2020 Art. 11, 12(4), 13(2)

**Keyword:**

Examination of own motion

Amendments - added subject-matter (no)

Amendment to case - admissibly raised and maintained (yes) -  
amendment within meaning of Art. 12(4) RPBA 2020 (no)

Late-filed objection - after notification of Art. 15(1) RPBA  
communication - exceptional circumstances (no) - admitted (no)

Remittal - (yes)

**Decisions cited:**

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



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Case Number: T 1886/22 - 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.  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 24 May 2022  
revoking European patent No. 2908723 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, insufficiency of disclosure 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 that all of the requests taken into account in the opposition proceedings, including auxiliary request 2B filed on 24 February 2022, contained added subject-matter in breach of Article 123(2) 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 1345/23, which involved the same parties and had some issues of added subject-matter in common.
- IV. The parties' final requests at the oral proceedings 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 one of auxiliary requests 5 to 11 filed with the statement of the grounds of appeal;
  - (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 8 of auxiliary request 5** read as follows (with amendments to claims 1 and 8 as granted, respectively, highlighted by the Board):

Claim 1:

*"A high-density mapping 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 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) in the plane."*

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 8:

*"The high-density mapping catheter of claim 1, wherein the plurality of longitudinally-aligned arms (190, 192, 194, 188) comprise a first outboard arm (188), and 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 microelectrode (198, 200) and the second outboard arm (190) has a most-proximal microelectrode (200), said most-distal microelectrode (198) and said most-proximal microelectrode (200) being slightly longer than the other microelectrodes (190, 192, 194, 188) for more precise localization of the flexible array in mapping and navigation systems."*

VI. The contested patent was granted from a European patent application published in the PCT phase under WO 2014/113612 A1 ("the application"), the content of which is relevant for the assessment of added subject-matter under Article 123(2) 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.

*Auxiliary request 5 - admittance*

Auxiliary request 5 should be taken into account by the Board. This request was duly substantiated in point 4.5 together with points 4.2 and 4.3 of the statement of grounds of appeal. Moreover, as the respondent itself noted, auxiliary request 5 was identical to auxiliary request 2B filed on 24 February 2022, which had been admissibly raised and maintained throughout the opposition proceedings.

*Auxiliary request 5 - added subject-matter*

The claims of auxiliary request 5 did not contain added subject-matter and this request complied with Article 123(2) EPC.

*a) 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 provided by D3, D5 and D9 to



D14 in similar technical contexts. 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.

On reading claim 1 of auxiliary request 5, 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 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, for example from Figure 33.

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

*b) Added subject-matter objection to claim 13 raised during the oral proceedings before the Board*

The added subject-matter objection to claim 13 of auxiliary request 5 raised by the respondent for the first time at the oral proceedings before the Board was late filed and should not be admitted at such a late stage of the appeal proceedings. In any event, this objection was *prima facie* not convincing.

*b) Further added subject-matter objections*

The further added subject-matter objections to the claims as granted raised by the respondent in its reply were either overcome by the claim amendments in auxiliary request 5 or unconvincing.

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

*Auxiliary request 5 - admittance*

Auxiliary request 5 should not be admitted on appeal. This request was not substantiated in the statement of grounds of appeal as required by Article 12(3) RPBA. Moreover, the appellant had not demonstrated that it had been admissibly raised in the opposition proceedings. Although it appeared that this request corresponded to auxiliary request 2B filed on 24 February 2022, this was not clear from the statement of grounds of appeal.

*Auxiliary request 5 - added subject-matter*

The claims of auxiliary request 5 contained added subject-matter in breach of Article 123(2) EPC.

*a) 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. In contrast, 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 D3, D5, D9 to D14, the meaning of the term "extends through" was changed by the phrase "and terminates in" or "and terminates within" that followed it, 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 auxiliary request 5, 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 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 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 123(2) EPC.

*b) Added subject-matter objection to claim 13 raised during the oral proceedings before the Board*

Following the incorporation of claim 11 as granted into claim 1 of auxiliary request 5, claims 12 to 14 as granted had been renumbered as claims 11 to 13 in that request. However, the dependency of claim 14 as granted on claim 12 had not been changed accordingly, so that claim 13 of auxiliary request 5 was dependent on claim 12. This dependency introduced subject-matter not disclosed in the application as originally filed.

This objection should be admitted. The respondent had already objected to the erroneous dependency of claim 14 as granted in the notice of opposition. This

objection had not become relevant in the opposition proceedings and was not addressed in the decision under appeal only because the opposition division had decided to revoke the contested patent on other grounds.

*c) Further added subject-matter objections*

The further added subject-matter objections to the granted claims raised in the reply also applied to auxiliary request 5. The claims of that request defined features which were either not disclosed in the application as filed or only disclosed in combination with other features to which they were inextricably linked and whose omission from the claims of auxiliary request 5 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 [0001]), 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 [0014] and [0015]).

For this purpose, as shown for example in Figure 33, reproduced on the next page, a catheter according to claim 1 of the main request includes a flexible tip portion (10<sup>K</sup>) 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 [0055]-[0057]).

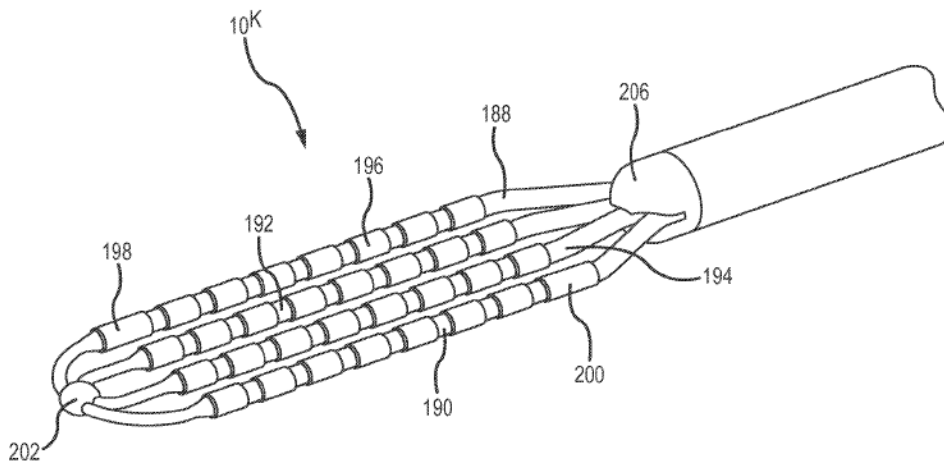


FIG.33

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 [0058] and [0061]).

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 [0057]).

**2. Admittance of D3, D5 and D9 to D15**

2.1 The parties did not object to D3 being taken into account in the appeal proceedings.

2.2 D5 and D9 to D15 were filed and referred to by the parties in their written submissions in the other case T 1345/23, with which the present case was heard jointly at the oral proceedings before the Board (see point III. above). Like D3, D5 and D9 to D14 are patent documents in which the term "extends through" is used in a technical context. D15 is a dictionary excerpt containing the entry "through". All these documents were referred to by the parties - and taken into account by the Board - in the other case T 1345/22 as evidence of what the person skilled in the art would understand by the term "extends through" used in feature F. The question of how the person skilled in the art would interpret this feature is also central to the present case (see point 4.1 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 or technical experts, it does involve the appraisal of linguistic and technical facts, which may be supported by evidence submitted by the parties.

Given the similarity between the present case and the other case T 1345/23, the Board considered it appropriate to take these documents into account in the present case as well, pursuant to Article 114(1) EPC. None of the parties objected to the admittance of these documents.

### **3. Auxiliary request 5 - admittance**

3.1 Auxiliary request 5 is clearly identified in point 4.5 of the statement of grounds of appeal as a combination of the higher-ranking auxiliary requests 2 and 3 which

were also filed on appeal. The latter are themselves substantiated in points 4.2 and 4.3 of the statement of grounds, where the basis in the application as filed for the amendments made in these requests and the reasons for these amendments are set out in detail.

The Board is therefore satisfied that, contrary to the respondent's view, auxiliary request 5 is substantiated in the statement of grounds of appeal, as required by Article 12(3) RPBA.

- 3.2 As acknowledged by the respondent, auxiliary request 5 is identical to auxiliary request 2B filed by the appellant in the opposition proceedings on 24 February 2022.

In point 3 of the decision under appeal, the opposition division held that auxiliary request 2B contained added subject-matter in breach of Article 123(2) EPC for the same reasons as set out in the decision for claim 1 as granted. Therefore, the decision under appeal is based on auxiliary request 2B.

Consequently, auxiliary request 5 request meets the requirements of Article 12(2) RPBA and is therefore not an amendment within the meaning of Article 12(4) RPBA. It is part of the appeal proceedings and the Board has no power to disregard it under these provisions.

#### **4. Auxiliary request 5 - added subject-matter**

Contrary to the respondent's view and the opposition division's finding concerning the first-instance auxiliary request 2B, the claims of auxiliary request 5 do not contain added subject-matter and this request complies with Article 123(2) EPC.



4.1 *Claim 1 - Feature F*

- 4.1.1 The dispute between the parties as to whether or not feature F complies with Article 123(2) 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) 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.

4.1.2 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 points 1.1.1 and 1.1.2 of the decision under appeal).

4.1.3 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).

4.1.4 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.

- 4.1.5 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.

- 4.1.6 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.

4.1.7 Paragraph [0097] of the 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 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.

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

4.2 *Added subject-matter objection to claim 13 raised during the oral proceedings before the Board*

During the oral proceedings before the Board, the respondent raised an added subject-matter objection to claim 13 of auxiliary request 5, based on the fact that claim 13 was dependent on claim 12, which, according to the respondent, was not supported by the application as filed.

It is common ground that this objection was not substantiated in the appeal proceedings until the oral proceedings before the Board. Its admittance is therefore subject to Article 13(2) RPBA, according to which it shall in principle not be taken into account, unless there are exceptional circumstances, justified with cogent reasons by the respondent.

The respondent has not convincingly put forward any such exceptional circumstances and the Board sees none.

It is immaterial that in the opposition proceedings the respondent raised, as it claimed, an allegedly similar objection to the dependency of claim 14 as granted, to which claim 13 of auxiliary request 5 corresponds. If the respondent wanted to have this objection taken into account by the Board on appeal, it should and could have substantiated it in its reply to the statement of grounds of appeal, which it did not.

Consequently, the Board decided not to take this objection into account.

#### 4.3 *Further added subject-matter objections*

The further added subject-matter objections to the granted claims raised in the respondent's reply to the statement of grounds of appeal (see points 2.2 to 3.3.5), to the extent that they apply to the claims of auxiliary request 5, are unfounded.

In respect to these objections, the respondent did not present any arguments at the oral proceedings before the Board, but merely referred to its written submissions.

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

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

As stated in the Board's communication under Article 15(1) RPBA (see point 3.1.1), this feature is

indeed not disclosed as such in the application as filed, but only follows implicitly from the fact that the microelectrodes carried by the arms are ring electrodes and that the array is planar. For this reason, the Board's preliminary view was that the definition of the above feature in claim 1 as granted while omitting the feature that the microelectrodes are ring electrodes added undisclosed subject-matter in breach of Article 123(2) EPC, as argued by the respondent.

However, unlike claim 1 as granted, claim 1 of auxiliary request 5 explicitly states that the microelectrodes are ring electrodes. The Board is therefore satisfied that this objection is overcome in auxiliary request 5. This conclusion was not disputed by the respondent at the oral proceedings before the Board.

4.3.2 *Claims 8, 9: the plurality of longitudinally-aligned arms comprise a first outboard arm and second outboard arm, "each having a most-distal microelectrode slightly longer than the other microelectrodes"*

In its communication under Article 15(1) RPBA (see point 3.1.2), the Board agreed with the respondent that the application as filed did not disclose the configuration defined in claim 8 as granted, comprising a first and a second outboard arms, each having a slightly longer most-distal microelectrode. Consequently, claim 8 and its dependent claim 9 both contained added subject-matter.

However, unlike claim 8 as granted, claim 8 of auxiliary request 5 was amended to define the particular layout defined in paragraph [0092] of the



application as filed, to which the respondent also referred (see point 1.2 of the reply). The Board is therefore satisfied that this objection is overcome in auxiliary request 5. This conclusion was also not disputed by the respondent at the oral proceedings before the Board.

4.3.3 The following objections were found to be unconvincing by the Board in its communication under Article 15(1) RPBA (see point 3.3). In the absence of any further arguments from the respondent, the Board sees no reason to depart from its preliminary view.

4.3.4 *Claim 1: each longitudinally-extending arm "exits from a distal end of the proximal bushing in the plane"*

Contrary to the respondent's argument, the person skilled in the art would derive this feature directly and unambiguously from the application as a whole, in particular from Figures 33 to 46, which, it is common ground, show embodiments in accordance with claim 1 as granted and claim 1 of auxiliary request 5. The Board refers in particular to Figure 35, also cited in this respect by the opposition division in the decision under appeal (see point 1.5.1), which shows a side view of the catheter tip portion of an embodiment in which all the arms are shown superimposed on each other and thus exiting from the bushing in the plane in which they lie.

The schematic nature of the figures does not contradict this conclusion. As also considered by the opposition division, the person skilled in the art would recognise that the purpose of Figures 44 and 45 is primarily to illustrate and highlight the irrigation port 214 which may be provided in an "alternative variation" of the

catheter (see paragraph [0097] of the application as filed). Therefore, the fact that the arms may be depicted differently in these two figures than in the other figures would not be identified as defining a different embodiment in which the arms do not exit from the distal bushing in one plane.

4.3.5 *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 application as filed, is not inextricably linked to any particular spacing between the arms. As considered by the opposition division in the decision under appeal (see point 1.5.2), the person skilled in the art would understand that the specific numerical values given in these passages of the parent application are merely particular exemplary values of spacing, none of which is critical to the functioning of the claimed catheter.

4.3.6 *Claims 12, 13: "localization microelectrodes" not being defined as "slightly enlarged"*

The respondent objected, in respect of claims 13 and 14 as granted, that referring to "localization microelectrodes" without specifying that these microelectrodes were enlarged, as disclosed in paragraph [0092], added subject-matter. Similarly, claims 12 and 13 of auxiliary request 5 do not specify this feature.

It is true that paragraph [0092] of the description as filed clearly links the use of these electrodes as localisation electrodes to the fact that they are enlarged. However, as stated in the Board's

communication under Article 15(1) RPBA (see point 3.3), the person skilled in the art would understand from the fact that the two microelectrodes are "configured as localization microelectrodes" that they are implicitly sufficiently enlarged for this purpose.

It follows that, contrary to the respondent's argument, the fact that claims 13 and 14 do not explicitly define that the two microelectrodes "configured for localization" are "slightly enlarged" does not add subject-matter.

#### **5. Remittal to the opposition division**

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

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