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**Datasheet for the decision
of 14 July 2015**

Case Number: T 1524/13 - 3.2.08

Application Number: 04734069.0

Publication Number: 1631211

IPC: A61F2/00

Language of the proceedings: EN

Title of invention:

DEVICE FOR THE PREVENTION OF URINARY INCONTINENCE IN FEMALES

Applicant:

Kimberly-Clark Worldwide, Inc.

Headword:

Relevant legal provisions:

EPC Art. 123(2), 84, 111(1)
EPC R. 137(5)

Keyword:

Amendments - added subject-matter (no) - after amendments
Claims - clarity - main request (yes) - after amendments
Appeal decision -
remittal to the department of first instance (yes)

Decisions cited:

Catchword:



**Beschwerdekammern
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Chambres de recours**

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Case Number: T 1524/13 - 3.2.08

**D E C I S I O N
of Technical Board of Appeal 3.2.08
of 14 July 2015**

Appellant: Kimberly-Clark Worldwide, Inc.
(Applicant) 2300 Winchester Road
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Representative: Mabey, Katherine Frances
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 25 February 2013 refusing European patent application No. 04734069.0 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairwoman P. Acton
Members: C. Herberhold
C. Schmidt

Summary of Facts and Submissions

- I. By its decision posted on 25 February 2013 the Examining Division refused application No. 04734069.0.
- II. In its decision the Examining Division held that the subject-matter of independent claim 1 then on file contravened Rule 137(5) EPC and Article 82 EPC and was furthermore not new (Articles 52(1) and 54 EPC).
- III. The appellant (applicant) lodged an appeal against that decision in the prescribed form and within the prescribed time limit.

He requested that the decision under appeal be set aside and that a patent be granted on the basis of the set of claims filed with letter dated 1 July 2015.

- IV. Claim 1 of the new main request reads as follows:

"A device (10) for minimizing involuntary urination in females adapted for being inserted into the vagina, comprising:

- (a) an internal support structure comprising:
 - (i) at least one pressure providing member (45c) capable of transition between a first collapsed position and a second expanded position, adapted for providing pressure, through the vaginal wall, on the mid-urethral region when being in the second position;
 - (ii) at least one anchoring member (45a) adapted for anchoring the internal support structure following insertion of the device into the vagina, so as to prevent undesired movement of the device; and
 - (iii) an elongated body (46), wherein the pressure providing member and the anchoring member are connected to each other through the elongated body (46);

(b) a pulling member (32) for removal of the device from the vagina; and
(c) a flexible cover (26) covering said internal support structure;
so that when said pressure providing member is in the collapsed position the internal device may be inserted or removed from the vagina; and when the device is inserted to the vagina said pressure providing member may be transitioned to the second expanded position, so as to provide pressure through the vaginal wall on the mid-urethra minimizing involuntary urination; characterized by the internal support structure comprising, at least one star-shaped element (45), each star-shaped element (45) having four prongs (50a, 50b, 50c, 50d), the at least one star-shaped element (45) being the pressure providing member positioned on said elongated body."

V. The essential arguments of the appellant can be summarised as follows:

Article 123(2), Rule 137(5), Article 84 EPC

Present claim 1 was based on claims 1, 5, 7, 23 and 27 as filed. Also the dependent claims corresponded to the dependent claims as filed, renumbered where necessary. As stated in the International Search Report (ISR) and in the Written Opinion of the International Searching Authority (WOISA), all these claims had been searched in the PCT phase such that their subject-matter combined with the originally claimed - and searched - invention to form a single general inventive concept. The amendments in the main request thus fulfilled the requirements of Article 123(2) EPC and Rule 137(5) EPC.

Moreover, the claims fulfilled the requirements of Article 84 EPC.

Reasons for the Decision

1. The appeal is admissible.
2. Article 123(2) EPC
 - 2.1 Claim 1 of the new main request is essentially a combination of claims 1, 5, 7, 23 and 27 as filed.

The claim tree as originally filed discloses a combination of the subject-matter of claims 1 and 5, claims 1 and 7 and claims 1, 23 and 27. The further combination of the "flexible cover covering said internal support structure" (claim 5 as filed) with the support structure comprising "an elongated body" and a 4-pronged star-shaped element (claims 23 and 27 as filed), the elongated body connecting the pressure-providing member and the anchoring member (claim 7 as filed and the description page 10, line 10) is disclosed e.g. in Figures 5a-5d and in the description as filed page 10, lines 19 and 20. The pressure-providing member and the anchoring member are claimed as individual parts of the internal support structure, connected to each other and thus being implicitly "separate" (as defined in claim 7 as filed).

- 2.2 Dependent claims:

Claims 2-4, 6 and 14-16 are based on claims 2-4, 9 and 38-40 as filed. They define further properties of the anchoring member, i.e. of a part different from the pressure member. It is immediately clear to the skilled

person that further individual developments of these two parts (pressure member vs anchoring member) can be combined since they are functionally independent.

Claim 5 corresponds to claim 8 as filed. According to the description page 10, line 10, for embodiments comprising the star-shaped member, the elongated body serves as the spacer (see also point 2.1 above).

Claims 7-13 and 18 correspond to claims 24-26, 28-31 and 43 (which were dependent on claim 23 as filed, the subject-matter of which is part of present claim 1 as filed) since Figures 5-9 show that the typical star-shaped element has 4 prongs, the combination of the subject-matter of claim 27 as filed ("each star-shaped element comprises 4 prongs") with each of claims 24-26, 28-31 and 43 thus being originally disclosed.

Claim 17 is based on claim 41 as filed. A string as the removal means is consistently shown in Figures 5c, 6a, 6b, 6c, 8 and 9b, and thus disclosed in combination with embodiments comprising the star-shaped element.

Claim 19 can be derived from claim 46 as filed which discloses that a device according to any of claims 1-45 as filed may be a disposable device.

Claims 20-23 are based on claims 46 - 49 as filed, with the obvious correction of "tampon-like applicator" to "tampon applicator-like applicator" in claim 23.

2.3 To conclude, all claims according to the new main request are in accordance with the requirements of Article 123(2) EPC.

3. Rule 137(5) EPC

Claim 1 according to the new main request comprises the features of claims 1, 5, 7, 23 and 27 as filed (see point 2.1), which - according to the ISR - have all been searched. The amendments are thus not to be objected to under Rule 137(5) EPC.

4. Article 84 EPC

All claims of the new main request fulfil the requirements of Article 84, in particular since it is clear for the person skilled in the art that disposability - see claim 19 of the new main request and the objection in the WOISA, Item VIII, 2 - implies the use of typical materials, such as for example polymeric material of limited long-term durability but suitable for cheap mass production, which is considered a technical feature.

5. Further proceedings.

Up to now - due to the appellant's initial strategy of pursuing a claim set directed to subject-matter different from that originally claimed and dealt with in the WOISA - no discussion on novelty and inventive step has taken place in the European phase. Moreover, due to claim amendments performed during the appeal procedure, the independent claim now comprises further limiting features with respect to the claims found not novel in the WOISA, Item V, 3.

In this situation, the Board finds it appropriate to remit the case to the Examining Division for examination of the further requirements of the EPC (Article 111(1) EPC).

Order

For these reasons it is decided that:

1. The matter is remitted to the Examining Division for further prosecution on the basis of Claims 1-23 as filed with telefax dated 1 July 2015 (received on 2 July 2015).

The Registrar:

The Chairwoman:



V. Commare

P. Acton

Decision electronically authenticated