Internal distribution code:

(A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [-] To Chairmen
(D) [X] No distribution

Datasheet for the decision of 29 July 2020

Case Number: T 1689/16 - 3.2.08

Application Number: 09822269.8

Publication Number: 2346456

IPC: A61F6/20, A61B17/12, A61N1/36

Language of the proceedings: EN

Title of invention:
AN APPARATUS FOR TEMPORARY MALE CONTRACEPTION

Applicant:
Implantica Patent Ltd.

Headword:

Relevant legal provisions:
EPC Art. 84, 111(1)
RPBA 2020 Art. 11, 12(2)

Keyword:
Claims - clarity - main request (yes)

Decisions cited:

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1689/16 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 29 July 2020

Appellant: (Applicant)	Implantica Patent Ltd. Ideon Science Park 223 70 Lund (SE)
Representative:	Klunker IP Patentanwälte PartG mbB Destouchesstraße 68 80796 München (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 12 January 2016 refusing European patent application No. 09822269.8 pursuant to Article 97(2) EPC.**

Composition of the Board:

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

Summary of Facts and Submissions

I. By decision posted on 12 January 2016 the Examining Division refused European patent application No. 09822269.8 on the ground of Article 84 EPC.

II. In its decision the Examining Division held in particular that feature F1: "an implantable restriction device adapted to restrict [the] vas deferens in the region downstream the ampulla (...)" was not clear because there was no region of the vas deferens "downstream the ampulla" given that the ampulla was defined as the downstream end portion of the vas deferens.

III. The applicant (appellant) lodged an appeal against that decision in the prescribed form and within the prescribed time limit.

IV. In a communication dated 30 March 2020 the Board informed the appellant that, in view of the evidence available, it did not share the Examining Division's view with respect to Article 84 EPC. However, it appeared that the method and use claims violated Articles 53(c) and 57 EPC.

V. By letter dated 7 July 2020 the appellant submitted a new main request in which the former independent use and method claims were cancelled. By letter dated 20 July 2020 it was further clarified that the request for oral proceedings was withdrawn under the condition that the main request fulfilled the requirements of Articles 84, 57 and 53(c) EPC.

VI. The appellant's requests are as follows:

To set the decision under appeal aside and to grant a patent on the basis of the claims according to the main request filed by letter of 7 July 2020

Alternatively to grant a patent on the basis of the first to third auxiliary requests as attached to the statement of grounds of appeal.

Oral proceedings if the main request is found not to fulfil the requirements of Articles 84, 57 and 53(c) EPC.

VII. The only independent claim of the main request (claim 1) reads as follows:

"A male contraception apparatus for obtaining temporary sterility of a male human being comprising:

(feature F1) an implantable restriction device adapted to restrict vas deferens in the region downstream the ampulla during a controlled period,

said device thereby being capable of preventing sperms to reach the urethra, and

a control device for controlling the operation of the restriction device."

(Feature assignment added by the Board)

The further requests have no bearing on the present decision.

VIII. The following documents played a role in the present decision:

D8 "ductus deferens", Encyclopaedia Britannica, 9 January 2013 (2013-01-09), retrieved from the Internet: URL: http://www.britannica.com/EBchecked/topic/173003/ductusdeferens? sections=173003main&view=print [retrieved on 2013-01-09];
D9: "Male Infertility - A Guide for the Clinician", Anne M. Jequier, Ch2, page 14, John Wiley & Sons (30 April 2008);
D10: "Textbook of CLINICAL EMBRYOLOGY", Vishram Singh, Ch 2, page 10, Elsevier Health Sciences (10 February 2014);
D11: "Wolf-Heidegger's Atlas der HumanAnatomie", Frick et al, 4. Auflage, S. 299, Abb 343a;
D12: "Gray's Anatomy: The Anatomical Basis of Clinical Practice", S. Standring, editor, Elsevier, 2008, page 1268 - 1270.

IX. The essential arguments by the appellant can be summarised as follows:

Clarity

The statement that there was no region of the vas deferens downstream the ampulla was simply wrong. In their argumentation, the Examining Division had misinterpreted a statement from a single non-medical prior art document, the Encyclopaedia Britannica (D8). Indeed, as shown e.g. in D9, Figures 2.7 and 2.8 and the corresponding passages of the description as well as in D10, page 10, there was a terminal narrow part of the vas deferens distal to the ampulla, where the vas deferens joins the duct of the seminal vesicle to form the ejaculatory duct. The skilled person thus would

understand where the ampulla of the vas deferens ends and that there is a section of the vas deferens downstream the ampulla which, according to the claims, can be restricted by means of the implantable restriction device.

Claim 1 of the main request thus did not lack clarity.

Reasons for the Decision

1. Main request - clarity

1.1 Article 84 EPC

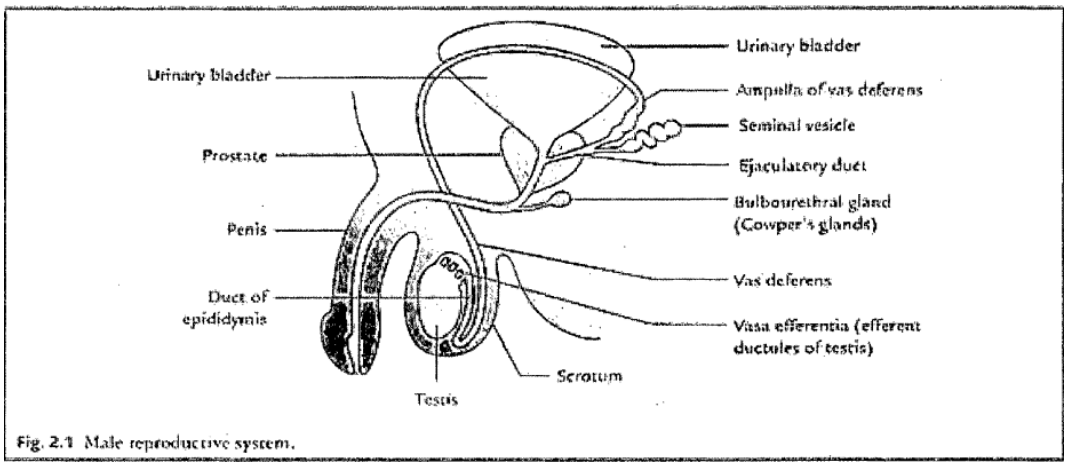
1.1.1 The central argument in the Examining Division's decision to refuse the application under Article 84 EPC is that "there is no such thing as a region of the vas deferens after its enlargement". In support of this argument, the Examining Division relies on an article from the Encyclopaedia Britannica (D8), which in its final sentence states that the ampullae join the ducts of the seminal vesicles to form the ejaculatory ducts.

In the Examining Division's view, said passage essentially excludes, by definition, "a region of the vas deferens downstream the ampulla". With exactly this region being part of the definition in the claim, the requirement of clarity could not be considered to be fulfilled.

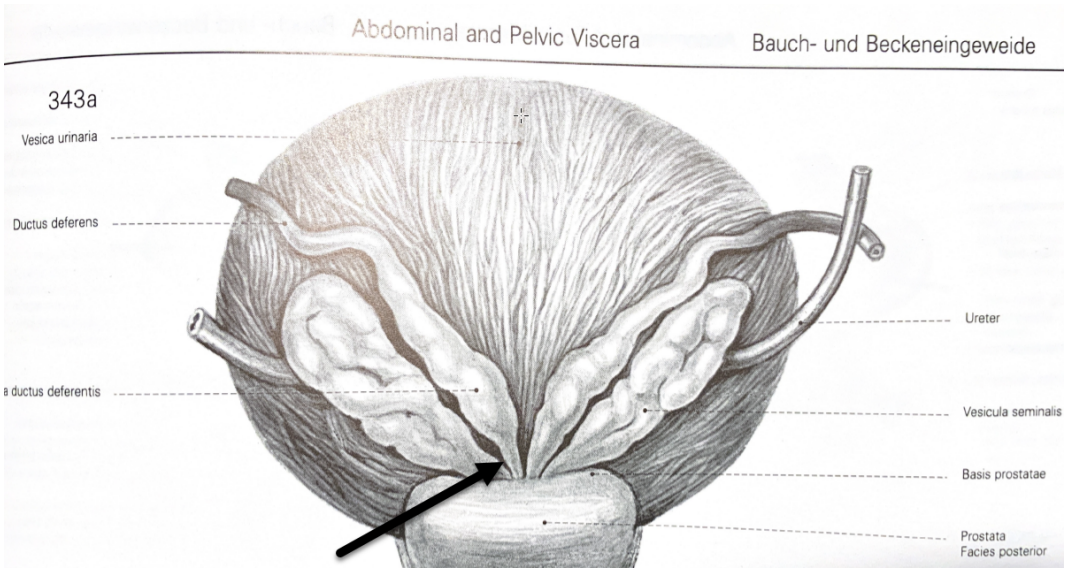
1.1.2 The anatomy:

The ductus deferens is a relatively long vessel connecting the testis/epididymis in the scrotum to the ejaculatory duct and (further downstream) the intra-

abdominal part of the urethra (see in this respect D8; D12, "Vas deferens"; and D10, Figure 2.1., reproduced below)



The final part of the ductus deferens can be seen in D11, Figure 343a (arrow added by the Board):



In D12 (Gray's Anatomy), the final course of the duct is described as follows (Vas deferens, page 1268-1269):

"... Posterior to the bladder the lumen of [the vas deferens] becomes dilated and tortuous and is termed the ampulla; beyond this, where it joins the duct of

the seminal vesicle, it is again greatly diminished in calibre. ..."

According to Gray's Anatomy (D12), there is thus a part of the duct beyond the ampulla, where it is diminished in calibre. This can also be seen in the anatomy atlas D11 (see the arrow in the figure reproduced above). Furthermore, a "now narrowed portion of the vas deferens distal to the ampulla" is mentioned in D9, page 14, last paragraph. D10, Ch 2, page 10, under the heading "vas deferens", refers to the terminal part of each vas deferens being sacculated "and called ampulla of vas deferens", but then mentions a "terminal narrow part of vas deferens", which joins the duct of seminal vesicle to form the ejaculatory duct at the base of the prostate gland.

1.1.3 From these disclosures the Board concludes that the Examining Division has put too much weight on a single sentence in D8. There is consistent evidence that the most distal part of the vas deferens is of narrow calibre. It is also evident that a larger saccular part is present more proximally, which is referred to commonly as the ampulla. As several textbooks refer to a narrowed portion "distal" or "beyond" the ampulla, the Examining Division's argument that there is simply no such part cannot be upheld. Even if the narrower part was considered as part of the ampulla (as e.g. in D8), the skilled person would understand that the term "region [of the vas deferens] downstream the ampulla" can only refer to that narrow calibre portion. This is firstly because the skilled person would rule out an interpretation of the term which implies the definition of a non-existent body part, and secondly because the skilled person would immediately understand that a restriction of the vas deferens downstream the ampulla

could be effectuated at this part having a reduced calibre.

Therefore, the Board is convinced that feature F1 is clear.

1.1.4 Is the definition of the device as being "adapted to" restricting a certain part of ductus deferens clear?

As the anatomy of a male human being's vas deferens is known to the person skilled in the art, so are the requirements for the claimed restriction device in question. It needs to be small enough for implantation in the limited space available between the ampulla and the opening of the vas deferens into the ejaculatory duct. It also needs to grip the duct so as to restrict it. The disclosure mentions a variety of different ways to effect the restriction. It would thus be unduly limiting to restrict the claimed subject-matter to devices of a particular modality or exact size.

1.1.5 No further objections under Article 84 EPC have been raised by the Examining Division, nor are such objections apparent to the Board.

2. The objections under Articles 53(c) and 57 EPC have been overcome by deleting the method and use claims against which an objection was raised.

3. The decision does not address novelty or inventive step, for which the Board would have to provide a first and final decision. This is contrary to the primary object of the appeal proceedings as laid down in Article 12(2) RPBA, namely to review the decision under appeal in a judicial manner. The Board considers this to be special reasons in the sense of Article 11 RPBA

and thus finds it appropriate to remit the case to the Examining Division for further prosecution (Article 111(1) EPC, second sentence).

4. According to the above analysis, the claims of the main request fulfil the requirements of Articles 84, 57 and 53(c) EPC. With the appellant's request for oral proceedings being withdrawn under these conditions, the Board is in a position to decide the case in the written proceedings.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the Examining Division for further prosecution.

The Registrar: The Chairwoman:

D. Magliano P. Acton

Decision electronically authenticated