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Datasheet for the decision of 15 December 2025

Case Number: T 0514/23 - 3.2.03

Application Number: 12159487.3

Publication Number: 2500056

IPC: A61M25/01, A61M25/00

Language of the proceedings: EN

Title of invention:
Catheter grip

Patent Proprietor:
Rochester Medical Corporation

Opponent:
ConvaTec Limited

Headword:

Relevant legal provisions:
EPC Art. 54, 100(b), 100(c), 111
RPBA 2020 Art. 11, 12(4), 12(6)

Keyword:
Novelty - main request (yes)
Grounds for opposition - lack of clarity no ground for opposition - insufficiency of disclosure (no) - subject-matter extends beyond content of earlier application (no)
Appeal decision - remittal to the department of first instance (yes)
Remittal - special reasons for remittal
Amendment to case - objection - exercise of discretion - complexity of amendment (no) - amendment admitted (yes)
Late-filed objection - should have been submitted in first-instance proceedings (no) - circumstances of appeal case justify admittance (yes)

Decisions cited:
G 0003/14, G 0001/24

Catchword:

Europäisches Patentamt
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Beschwerdekammern

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Case Number: T 0514/23 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 15 December 2025

Appellant: (Patent Proprietor)	Rochester Medical Corporation 1500 Second Avenue NW Stewartville, Minnesota 55976 (US)
Representative:	Hoffmann Eitle Patent- und Rechtsanwälte PartmbB Arabellastraße 30 81925 München (DE)
Respondent: (Opponent)	ConvaTec Limited GDC, First Avenue Deeside Industrial Park Deeside Flintshire CH5 2NU (GB)
Representative:	D Young & Co LLP 3 Noble Street London EC2V 7BQ (GB)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 3 January 2023 revoking European patent No. 2500056 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman C. Herberhold
Members: R. Baltanás y Jorge
N. Obrovski

Summary of Facts and Submissions

I. European patent No. 2 500 056 B1 relates to a catheter grip.

II. An opposition was filed against the patent based on Article 100(c) and 100(a) EPC in conjunction with Articles 54 EPC and 56 EPC. During the opposition proceedings, the ground for opposition based on Article 100(b) EPC was also raised by the opponent.

III. The present appeal is against the opposition division's decision to revoke the European patent.

This decision was appealed by the patent proprietor (appellant).

IV. In a communication pursuant to Article 15(1) RPBA, the Board indicated its preliminary opinion.

Oral proceedings were held on 15 December 2025.

V. Requests

The appellant requested that the decision under appeal be set aside and the patent be maintained as granted and, in the alternative, that the patent be maintained on the basis of one of auxiliary requests 1 to 11 as stated in the letter dated 18 September 2024 (including a corrected version of auxiliary request 10), wherein auxiliary request 11 should be considered before auxiliary requests 1 to 10.

The opponent (respondent) requested that the appeal be dismissed.

VI. Claim 1 as granted (main request in appeal proceedings), including the numbering of its features as adopted by the parties, reads as follows (amendments with respect to claim 1 as originally filed are marked in bold):

1.1 *A catheter grip* ***(1), ~~comprising~~ consisting of:***
1.2 *a generally tubular body:*
1.3 *comprising a first end* ***(11)*** *and a second end* ***(13),***
1.4 ***having an inner surface and an outer surface,*** *defining a through bore, and*
1.5 *configured to slidably engage the shaft of a urinary catheter* ***(3);***
1.6 *the generally tubular body having a larger diameter at the first end* ***(11)*** *and at the second end* ***(13)*** *than at its middle,*
characterised in that:
1.7 ***the generally tubular body provides a first flare (5) at the first end, a second flare (7) at the second end, and a mid-section (9) at the middle,***
1.8 ***the smaller relative diameter at the mid-section aiding in positioning a user's fingers toward the middle on the outer surface of the generally tubular body,***
1.9 ***the inner surface of the generally tubular body configured to contact the urinary catheter along the mid-section when the user applies force thereto.***

Claim 7 as granted, including the numbering of its features as adopted by the parties, reads as follows (amendments with respect to claim 3 as originally filed are marked in bold):

7.0 *A system comprising a urinary catheter* ***(3)*** *and a catheter grip* ***(1);***

7.1 *the catheter grip* ***(1)*** ~~***comprising***~~ ***consisting of:***

7.2 *a generally tubular body:*

7.3 *comprising a first end* ***(11)*** *and a second end* ***(13),***

7.4 ***having an inner surface and an outer surface,*** *defining a through bore, and*

7.5 *configured to slidably engage the shaft of a urinary catheter* ***(3);***

7.6 *the generally tubular body having a larger diameter at the first end* ***(11)*** *and at the second end* ***(13)*** *than at its middle,*
characterised in that:

7.7 ***the generally tubular body provides a first flare (5) at the first end, a second flare (7) at the second end, and a mid-section (9) at the middle,***

7.8 ***the smaller relative diameter at the mid-section aiding in positioning a user's fingers toward the middle on the outer surface of the generally tubular body,***

7.9 ***the inner surface of the generally tubular body configured to contact the urinary catheter along the mid-section when the user applies force thereto.***

VII. Prior art

The following documents have been cited, both in the statement setting out the grounds of appeal and during the opposition proceedings, and are relevant to this decision:

D1: WO 03/002178 A2

D2: GB 322,426 A

D4: US 6,613,014 B1

VIII. The appellant's arguments of relevance to this decision can be summarised as follows.

(a) Sufficiency of disclosure

The skilled person was able to reproduce the invention without undue burden, in particular the functional feature 1.8/7.8 ("*the smaller relative diameter at the mid-section aiding in positioning a user's fingers toward the middle on the outer surface of the generally tubular body*"). The objection raised by the respondent against this feature amounted to an objection of lack of clarity rather than sufficiency of disclosure.

(b) Added subject-matter

The application as a whole, including the figures, supported the amendments in granted claim 1.

No conclusions could be drawn from figure 4 as originally filed with respect to the construction of the lower end of the catheter grip since most of the device was hidden by the hand represented therein. In contrast thereto, figures 1 and 2 disclosed an unobscured view of a catheter grip comprising flares at the ends as defined in feature 1.7/7.7, even if figure 4 could be considered a different embodiment disclosing different flares.

(c) Novelty, D1

The subject-matter of claims 1 and 7 differed from D1 in features 1.2/7.2 (tubular body), 1.7/7.7 (flares at

the ends) and 1.8/7.8 (smaller relative diameter at the mid-section).

The flanges ("*handling means 247, 248*") of D1 meant that the catheter grip shown in figures 24 to 28 was not a tubular body, contrary to the definition of feature 1.2/7.2.

In any case, it was noted that flares being provided "at the first end" and "at the second end" (feature 1.7/7.7) was a clear feature with a well-defined meaning, namely that the first and second flares had to extend all the way up to the respective ends of the catheter grip. This was not the case for the catheter grip of D1, where the end portions were cylindrical, as required in view of their use as a connection (see e.g. figures 24 and 30).

Concerning feature 1.8/7.8, the opposition division did not consider whether the degree of alleged flaring in D1 was significant enough to be detected by a user, nor that the provision of flanges (247, 248) would clearly affect the user's ability to detect any flaring. A non-detectable flare could not aid in positioning the user's fingers toward the middle.

Moreover, the smaller relative diameter at the mid-section as defined in feature 1.8/7.8 was defined relative to the flares previously introduced in feature 1.7/7.7. Without flares there could thus also be no smaller relative diameter in comparison with such non-existent flanges. The notch shown in D1 was not able to provide the effect defined in the claim since it was only perceived by the user when the fingers were at the mid point of the catheter grip.

(d) Novelty, D2

Feature 1.7/7.7 was not anticipated by D2 since the flanges formed a stepwise change in diameter instead of a flare as defined therein, i.e. a gradual widening. Even if the rounding of the flange facing the middle of the catheter grip were considered, there was a second rounding of decreasing diameter at the respective ends of the catheter grip. Thus, contrary to what was defined in claims 1 and 7, no flare was present at the ends since the only rounding which could possibly represent a flare did not extend up to the ends.

Concerning feature 1.8/7.8, D2 did not disclose any guiding of the user's fingers to the mid-section of the catheter grip as the widening was not gradual but in the form of flanges which had the purpose of assisting the user in finding the ends of the catheter grip.

(e) Novelty, D4

The objection of lack of novelty based on D4 should not be admitted into the appeal proceedings since it had not been raised in the opposition proceedings as it should have been (Article 12(6) RPBA).

In terms of substance, D4 did not anticipate feature 1.7/7.7 (flanges at the ends) either, since the ends of the catheter grip were flat (see figure 4). Feature 1.9/7.9 ("*the inner surface of the generally tubular body configured to contact the urinary catheter along the mid-section when the user applies force thereto*") was not revealed in D4 either, since the feature should be interpreted as requiring the application of a force in the mid-section for gripping the catheter. A

twisting force applied on a cap as in D4 was therefore not encompassed by the scope of the claim.

(f) Inventive step, remittal

The case should be remitted to the opposition division for examination of inventive step since this was a ground for opposition which had not yet been dealt with in the opposition proceedings and required a substantial discussion involving common general knowledge and further prior art.

IX. The respondent's arguments of relevance to this decision can be summarised as follows.

(a) Sufficiency of disclosure

The feature "*the smaller relative diameter at the mid-section aiding in positioning a user's fingers toward the middle on the outer surface of the generally tubular body*" (feature 1.8/7.8) was not sufficiently disclosed since the contested patent did not provide any information about the conditions under which this effect was achieved.

(b) Added subject-matter

There was no direct and unambiguous basis for the feature "catheter grip **consisting of** a generally tubular body" (feature 1.1/7.1) since the application as originally filed merely disclosed a catheter grip **comprising** a generally tubular body.

Furthermore, the application as originally filed did not disclose an inner and an outer surface as components of the generally tubular body as defined in

feature 1.4/7.4, nor that the inner surface of the generally tubular body was configured to contact the urinary catheter as defined in feature 1.9/7.9.

Finally, the application as filed only used the language "**toward** one or both ends", whereas, according to the submissions of the appellant/patent proprietor in the opposition proceedings, the expression "**at** the end" had a different meaning, namely that the flares extended all the way to the end of the grip. There was no direct and unambiguous disclosure of the latter in the originally filed application, in particular since the figures were not consistent and could not be considered to support the amendment.

(c) Novelty, D1

Document D1 disclosed all the features of claims 1 and 7.

The skilled person would understand the form of the device represented in the figures of D1 as a "generally tubular body" (feature 1.2/7.2).

When applying the broadest technically meaningful interpretation of "at the end" as defined in claims 1 and 7 (feature 1.7/7.7), the skilled person would understand this expression to at least encompass the flares being "toward or near the ends" as disclosed in D1.

Given the primacy of the claims, as confirmed by G 1/24, it was they that had to be taken as the starting point for interpreting feature 1.8/7.8. The notch shown in D1 necessarily aided in positioning a

user's fingers toward the middle on the outer surface of the generally tubular body as defined in claim 1.

(d) Novelty, D2

The flanges at the ends of the catheter grip of D2 corresponded to the flares defined in feature 1.7/7.7, in particular since claim 1 only required the generally tubular body to "provide" the flares at the ends and not that the ends were "flared".

Even if the feature "flare" were interpreted as a gradual widening, this feature was nonetheless disclosed in D2, the edges of the flanges facing the middle of the catheter grip being rounded (see figure).

Concerning feature 1.8/7.8 ("*smaller relative diameter at the mid-section aiding in positioning a user's fingers toward the middle on the outer surface of the generally tubular body*"), the combination of flanges and smaller relative diameter at the mid-section of D2 had the same purpose as described in lines 88 to 91.

(e) Novelty, D4

It was the respondent's intention to raise the objection on grounds of lack of novelty during the oral proceedings before the opposition division but the development of the proceedings prevented it from doing so since the patent was revoked after discussion of a different novelty objection.

In any case, an inventive step objection based on D4 as starting point had been raised in the notice of opposition. This admissibly filed objection inevitably required a discussion about whether there was any

distinguishing feature with respect to D4. It thus made no difference to the parties or the Board if this discussion was carried out within the framework of the newly raised novelty objection instead of during the discussion of inventive step.

In terms of substance, the subject-matter of claims 1 and 7 was not novel over D4, in particular since the handle member (see e.g. figures 1 and 4, 22) and the connecting member (29) worked as a single body in the catheter grip disclosed in D4 and corresponded to a "generally tubular body" within the meaning of the claims. Moreover, the tubular body provided flares toward the end section, as could be seen e.g. in figure 2.

(f) Remittal

No special circumstances arose which would justify remittal of the case to the opposition division with regard to inventive step. In any case, at least the inventive step objection based on D1 should be considered in the appeal proceedings.

Reasons for the Decision

1. Sufficiency of disclosure - Article 100(b) EPC

1.1 After having received the communication under Article 15(1) RPBA, in which the Board explained its preliminary opinion on sufficiency of disclosure, the parties had made no further submissions on this matter.

1.2 The respondent had argued in writing that the feature "*the smaller relative diameter at the mid-section*

aiding in positioning a user's fingers toward the middle on the outer surface of the generally tubular body" (feature 1.8/7.8) was not sufficiently disclosed since the contested patent did not provide any information about the conditions under which this effect was achieved. The effect was dependent on the particular user and the patent did not define what level of assistance constituted "aiding". According to the respondent, the possible non-circular cross-section of the generally tubular body of claims 1 and 7 cast doubt on how the diameter at the ends and at the mid-section of the generally tubular body was to be measured by the skilled person in order to determine the difference between them.

1.3 This is not persuasive since feature 1.8/7.8 is a **functional** feature which defines the device's suitability, irrespective of the clarity of such a definition, which cannot be assessed in appeal proceedings according to the principles set out in G 3/14 (see catchword). This means that only catheter grips suitable for the function defined in this feature fall under the scope of claim 1, whereas those not suitable for it are outside the scope of the claim.

1.4 The suitability defined in feature 1.8/7.8 is to be assessed from the perspective of the person skilled in the art, who would be able to provide the device with a smaller relative diameter at the mid section as defined in feature 1.8/7.8 which enables the device to fulfil this condition. The fact that the skilled person may have doubts as to whether or not a particular user will consider a particular configuration to fulfil the suitability defined in feature 1.8/7.8 depending on their skills or physical condition may be a matter of clarity but not of sufficiency of disclosure.

1.5 As far as the fact that the generally tubular element can be of non-circular cross-section with different diameters when measuring the cross-section in different directions is concerned (a possibility which is not excluded by the claims), this is of no relevance since the skilled person is able to provide such a device with appropriate dimensions of the flares and the smaller relative diameter at the mid-section in any given direction, the person skilled in the art being able to draw conclusions about whether or not a catheter grip to be produced is suitable for the function defined in feature 1.8/7.8.

2. Added subject-matter - Article 100(c) EPC

2.1 Feature 1.1/7.1 ("consisting of")

2.1.1 The respondent argued that there was no direct and unambiguous disclosure of the feature "catheter grip **consisting of** a generally tubular body" (feature 1.1/7.1) since the originally filed application merely disclosed a catheter grip **comprising** a generally tubular body. No passage of the description disclosed the contested feature, whereas the embodiment disclosed in figure 1 was merely schematic and did not allow the direct and unambiguous inference that other features (i.e. other than the generally tubular body) were to be excluded from the catheter grip.

2.1.2 This is not persuasive in view of the content of the originally filed application considered as a whole.

2.1.3 Originally filed figures 1, 2 and 4 (reproduced below) disclose a catheter grip (1) which is formed by what

the skilled person understands to be a generally tubular body.

FIG. 1

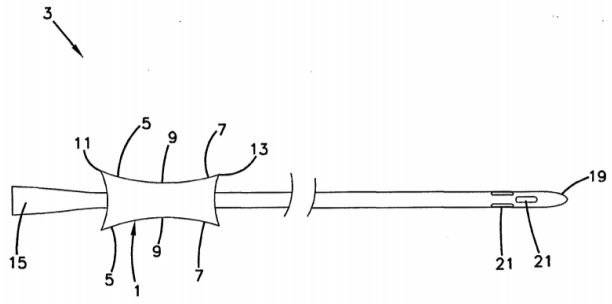


FIG. 4

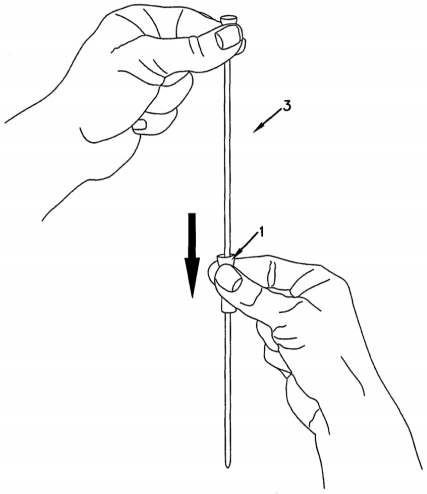
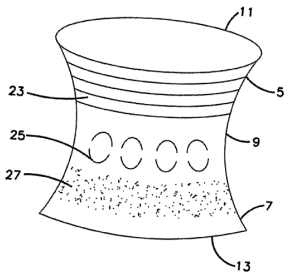


FIG. 2



2.1.4 That the catheter grip can include such a general tubular body having a larger diameter, i.e. the "flares", at the ends than at the middle as defined in granted claim 1 is disclosed in several passages of the application as originally filed (see page 1, lines 26 to 30, page 3, lines 11 to 13, page 6, lines 4 to 7, or claim 1).

2.1.5 The skilled person, being aware of all this information, can have no doubt that figures 1, 2 and 4 represent embodiments where the catheter grip consists of the disclosed generally tubular body without any supplementary elements. The skilled person can be sure

of the latter since the catheter grip of figures 1, 2 and 4 is fully functional in the configuration disclosed in the figures, operation of the device being relatively simple and no further features thus being required or suggested for proper function thereof.

2.1.6 In this context, it is irrelevant that the originally filed application discloses "textures" which could be interpreted as part of the generally tubular element or not, since such "textures" are disclosed as being merely optional (see page 4, lines 21 to 24, page 5, lines 9 to 11, or page 6, lines 7 to 11).

2.2 Features 1.4/7.4 (generally tubular body having an inner surface and an outer surface) and 1.9/7.9 (the inner surface of the generally tubular body configured to contact the urinary catheter along the mid-section when the user applies force thereto)

2.2.1 The respondent argued that the application as originally filed only disclosed an inner and an outer surface as components of the catheter grip and not of the generally tubular body as defined in feature 1.4/7.4 (see claim 2 and page 6, lines 8 to 11), the inner surface of the generally tubular body thus not being originally disclosed as "configured to contact the urinary catheter" as defined in feature 1.9/7.9.

2.2.2 This is not persuasive.

2.2.3 First, any generally tubular element must have an inner surface and an outer surface as defined in feature 1.4/7.4.

2.2.4 Second, once the skilled person understands that the embodiments shown in figures 1, 2 and 4 consist of a

generally tubular body as disclosed in the originally filed application (see preceding point 2.1), it follows that the inner surface of the generally tubular element acts as the inner surface of the catheter grip configured to contact the urinary catheter as defined in feature 1.9/7.9 (see also originally filed page 3, lines 17 to 19, page 4, lines 21 to 24, and page 6, lines 8 to 6).

2.3 Feature 1.7/7.7 (a first flare at the first end, a second flare at the second end)

2.3.1 The respondent argued that the application as filed only used the language "**toward** one or both ends" (see originally filed page 3, line 13), whereas, according to the submissions of the appellant/patent proprietor in the opposition proceedings, the expression "**at** the end" had a different meaning, namely that the flares extended all the way to the end of the grip. According to the respondent, there was no direct and unambiguous disclosure of the latter in the application as originally filed, in particular since the figures were contradictory regarding the alleged disclosure of flares at the respective ends and could not be considered as supporting the amendment. The respondent argued that, while the device disclosed in figure 4 corresponded to the same catheter grip with two flares as disclosed in figure 1 (see page 5, line 19 to 23 as originally filed), figure 4 did not depict a flare all the way to the lower part of the catheter grip (i.e. "at the lower end"). This interpretation of figure 4 was consistent with the disclosure of page 3, lines 11 to 13, since the flare could be followed by a cylindrical final portion at the end of the catheter grip, but would still exhibit a smaller diameter in the middle. The disclosure of figure 4 was clear in this

respect, since a flare was disclosed at the top end of the catheter grip but not at the lower end. Concerning the disclosure of figures 1 and 2, it was noted that the lines associated with signs (5) and (7) did not point to the very ends of the catheter grip, and that the appellant itself argued within the context of novelty with respect to D1 that a set of inconsistent figures added up to a lack of clear and unambiguous disclosure when it came to particular features only shown in these figures.

2.3.2 This is not persuasive since (at least) figures 1 and 2 as originally filed disclose in a direct and unambiguous manner that the flares (5, 7), which by definition are elements spreading outwards from a reference surface, are arranged at the ends of the flared gripper (1), the latter being formed by a generally tubular body according to the application as originally filed when considered as a whole (see point 2.1 above). The skilled person will understand that these flares achieve the claimed "larger diameter **at** the first end and **at** the second end" of the generally tubular body defined in claim 1 as originally filed. Even if the figures are schematic, the location of the flares falls within what the skilled person can derive in a direct and unambiguous manner given the level of detail necessary for ascertaining this particular feature, i.e. the skilled person would consider the figures precise enough for determining the location of the flares.

2.3.3 Concerning the alleged inconsistency of figure 4 with figure 1, it is noted that the description as originally filed does not disclose that the catheter grip of figure 4 corresponds to the one of figure 1, but merely that "*Figure 4 schematically illustrates **an***

embodiment of the flared gripper 1 *being moved from proximal the outlet 15 of catheter 3 toward its tip 19*". Thus, even if the skilled person understood on the basis of figure 4 that there was no flare at the lower end of the catheter gripper shown therein, as argued by the respondent, they would also understand that this is simply a different embodiment. Thus, the support of feature 1.7/7.7 in the originally filed application is not based on a set of inconsistent features as argued by the respondent.

2.3.4 The fact that the lines associated with signs (5) and (7) do not point at the very ends of the catheter grip in figures 1 and 2 is irrelevant since the lines point at flares which are directly and unambiguously disclosed as being at the ends of the catheter grip, irrespective of the precise portion of the flares at which the lines point.

3. Novelty - Article 54 EPC

3.1 D1

3.1.1 Features 1.1/7.1 and 1.2/7.2 (catheter grip consisting of a generally tubular body)

The appellant argued in writing that the flanges ("handling means 247, 248") of D1 meant that the catheter grip shown in figures 24 to 28 was not a tubular body, the latter having, according to paragraph [0014] of the patent, a cylindrical shape having a cross-section in the shape of any closed polygon. According to the appellant, this implied that the flanges (247, 248) could not be considered as forming part of the generally tubular body. It was disclosed in paragraph [0015] of the patent that "[t]*he shape of the*

catheter grip can be generally tubular (e.g., tubular), but smaller diameter in the middle and flared toward on e or both ends", the word "but" denoting the difference between a plain tube wall having a single diameter along its length and the flared catheter grip.

This is not persuasive.

The feature "generally tubular body" implies for the skilled person that the body as a whole must correspond to what the skilled person would identify as tubular. The feature does not define any further limitations concerning shape, and it does not rule out the "general tubular body" comprising any kind of surface irregularities (or indeed its being composed of several separate components, as pointed out by the opposition division) as long as the resulting body can be still identified as "generally tubular".

The passages of the patent specification do not contradict this. Paragraph [0014] merely discloses that "*the phrase 'generally tubular' refers to a configuration of the catheter grip that is capable of residing on and surrounding the shaft of a catheter*" and that "[a] *generally tubular device can have a cross section in the shape of any closed polygon, circle, or ellipse*". The catheter grip ("applicator") shown in figure 24 of D1 (reproduced below) complies with both definitions, the flanges (247, 248) having a circular cross-section.

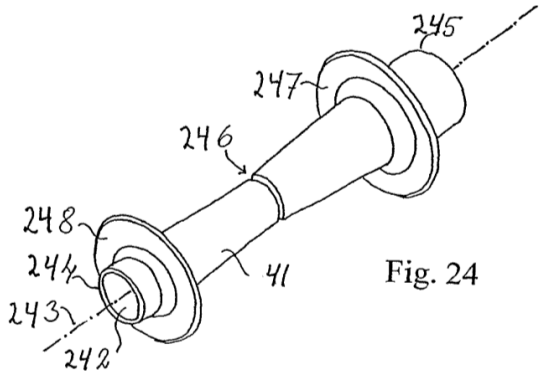


Fig. 24

Concerning the cited passage of paragraph [0015] of the patent, this merely repeats that the catheter grip can be generally tubular, i.e. as defined in claims 1 and 7, the word "but" simply specifying a certain relationship between the diameter in the middle (smaller) and toward the ends (flared) of the generally tubular catheter grip. No reference to a tube wall having a single diameter along its length can be found in this passage.

Finally, paragraph [0026] of the patent specification, also cited by the appellant, relates to a particular embodiment which does not have any limiting effect on the features of claim 1. Moreover, it simply states the advantages of a "pinch point" with respect to "a plain cylindrical or flat grip apparatus" but it does not state that the latter are the only possible shapes of a tubular body.

Consequently, the embodiment shown in figures 24 to 28 of D1 discloses a catheter grip ("applicator") consisting of a generally tubular body (features 1.1/7.1 and 1.2/7.2).

3.1.2 Features 1.3/7.3 to 1.6/7.6

The appellant does not contest that the embodiment shown in figures 24 to 28 of D1 discloses a catheter grip ("applicator"):

- comprising a first end and a second end (see figures 24 to 28) (feature 1.3/7.3)
- having an inner surface and an outer surface, defining a through bore (see "lumen 242") (feature 1.4/7.4)
- configured to slidably engage the shaft of a urinary catheter (see figures 26 to 28 and page 6, lines 24 to 31) (feature 1.5/7.5)
- the generally tubular body having a larger diameter at the first end and at the second end than at its middle (see figure 24) (feature 1.6/7.6)

3.1.3 Feature 1.7/7.7 (the generally tubular body provides a first flare at the first end, a second flare at the second end, and a mid-section at the middle)

The respondent argued in writing that, when applying the broadest technically meaningful interpretation of "at the end" as defined in claims 1 and 7 (feature 1.7/7.7), the skilled person would understand this expression to at least encompass the flares being "toward or near the ends", since the "end" of the generally tubular body was used in the claims relative to the middle of the body, the position considered to be the "end" of the tubular body being arbitrary. According to the respondent, this interpretation was supported by the use of the word "toward" in the patent specification, as in the description of figure 4, where it was stated that the catheter grip was moved toward the tip (19), i.e. in the direction of the catheter tip

but not all the way to the tip itself (see figure 4 and paragraph [0025] of the patent specification). Since it was derivable from page 30, lines 21 and 22 of D1 that the catheter grip was flared at least in part toward its ends, if not all the way to the ends, feature 1.7/7.7 was anticipated by D1.

This is not persuasive since feature 1.7/7.7 is perfectly clear concerning the location of the flares: a first flare **at** the first end and a second flare **at** the second end. The skilled person knows what the ends of a generally tubular body are, and this is not the same as, in the words of the respondent, "toward or near the ends". Rather, this implies the very ends of the generally tubular body.

The use of the term "toward" in paragraph [0025] of the patent specification cannot change the meaning of the **different** term "at" used in claims 1 and 7, the term "toward" being furthermore used in a completely different context as the movement of the catheter grip with respect to the catheter tip. The wording of claims 1 and 7 thus requires that the flares progress, from an undefined point, to the very end of the generally tubular body.

The respondent does not contest that the catheter grip shown in the embodiment of figures 24 to 28 of D1 does not disclose flares progressing up to either of the two ends of the generally tubular body. The schematic figures do not allow such conclusion to be drawn and, at most, seem to indicate that the ends of the generally tubular body are of a constant diameter between each of the flanges (247, 248) and the respective end. This is also necessarily so in the eyes of the skilled person in view of the use of at least

one of the ends for receiving a connector part (32) which is shown as non-flared (see page 31, lines 4 to 7, and also figures 30 to 32).

The passage of D1 cited by the respondent (page 30, lines 21 and 22) merely states in the context of figure 25 (which does not show flares at either end of the catheter grip) that "*The clearance 248 of the lumen narrows down towards the intermediate portion of the applicator*". This teaching (in particular in combination with figure 25) does not imply that the narrowing starts at the ends of the catheter grip.

Thus, D1 does not disclose feature 1.7/7.7.

3.1.4 Feature 1.8/7.8 (the smaller relative diameter at the mid-section aiding in positioning a user's fingers toward the middle on the outer surface of the generally tubular body)

The opposition division considered that feature 1.8/7.8 was a functional feature that was fulfilled as soon as the structural feature of providing a first flare and a second flare at the ends was fulfilled.

In a similar manner, the appellant argued that the smaller relative diameter at the mid-section defined in feature 1.8/7.8 was defined relative to the flares previously introduced in feature 1.7/7.7. Only in this manner could the smaller relative diameter at the mid section aid in positioning a user's fingers toward the middle on the outer surface of the generally tubular body, since the flares aided the user even if the fingers were not precisely in the middle of the catheter grip. Without flares at the end, feature 1.8/7.8 could not be considered disclosed. This was the

correct interpretation of feature 1.8/7.8 in the light of the description in accordance with G 1/24.

This is not persuasive since feature 1.8/7.8 defines a suitability based on the smaller relative diameter at the mid-section, without referring to the flares defined in feature 1.7/7.7. The claims do not define that the effect relating to aiding in positioning a user's fingers toward the middle on the outer surface of the generally tubular body is due to the flares but due to the smaller relative diameter. Even if feature 1.6/7.6 defines that the generally tubular body has a larger diameter at the first end and at the second end than at its middle, this does not imply that it is the presence of the flares at the ends of the catheter grip that aids the user according to the claim.

The appellant is right that the patent specification discloses such an embodiment (see column 3, lines 8 to 10), but the claims are not limited to this embodiment. Claims 1 and 7 encompass embodiments wherein a catheter grip would comprise a smaller relative diameter at the mid-section producing the defined effect without intervention of the flares (e.g. if the smaller relative section were not the result of the presence of the flares).

Moreover, the fact that the subject-matter of a claim is generally considered as not being limited by features which are only disclosed in an embodiment in the description is consistent with the case law before and after the issuance of G 1/24, which, in any case, acknowledges the claims as "*the starting point and the basis for assessing the patentability of an invention*" (see G 1/24, order and reasons 12 and 13,

T 1819/23, reason 3.3, T 2034/23, reason 3.6.2 or T 981/23, reason 2.2.3).

The appellant further argued that the opposition division did not consider whether the degree of alleged flaring in D1 was significant enough to be detected by a user, and also that the provision of flanges (247, 248) would clearly affect the user's ability to detect any flaring. Concerning the notch (246) of D1, the appellant maintains that it was not able to provide the defined effect since it was only perceived by the user when the fingers were at the mid point of the catheter grip.

This is not persuasive.

As explained above, claims 1 and 7 do not define any relationship between the flares and the suitability defined in feature 1.8/7.8, let alone a minimum threshold for this relationship.

Feature 1.8/7.8 is a functional feature which does not require a particular diameter at the mid-section. The skilled person will understand that any smaller diameter at that region which can be perceived by a user's fingers would achieve the defined suitability.

The catheter grip shown in the embodiments of figures 24 to 28 has a smaller diameter at its mid-section (see in particular "notch 246", but also the section of the opposing flares in between the flanges which is a smaller-diameter mid-section relative to flanges (247) and (248), see e.g. figure 24). This is clear to the skilled person from the figures. The low quality of hand-drawn figures 25 and 26 cannot cast doubt on the intended larger diameter of the right side of the

generally tubular body in view of the direct and unambiguous disclosure of figures 24 (the perspective view not being a reason for the difference in relative sizes of the mid-section and the ends of the catheter grip in the eyes of a skilled person interpreting technical drawings), 27 and 28 and the reference to the lumen (242) narrowing down toward the intermediate portion of the catheter grip disclosed in page 30, lines 21 and 22.

The skilled person will understand that the smaller diameter at the mid-section of the catheter grip of D1 necessarily aids an average user in positioning their fingers toward the middle on the outer surface of the generally tubular body, feature 1.8/7.8 being so broadly (and unclearly) defined that no further particular requirement for this can be considered. Any user perceiving the smaller diameter at the mid-section of D1 (e.g. perceiving the notch (246) or the lower-diameter area in between the flanges (247, 248)) will certainly be aided in positioning their fingers toward the middle on the outer surface of the generally tubular body.

In view of the above, D1 discloses feature 1.8/7.8.

3.1.5 Feature 1.9/7.9 (the inner surface of the generally tubular body configured to contact the urinary catheter along the mid-section when the user applies force thereto)

The appellant is not contesting in the appeal proceedings the opposition division's reasoning concerning the disclosure of feature 1.8/7.9 in D1.

The Board agrees with such reasoning since the gripping function of the catheter grip of D1 disclosed in lines 24 to 31 of page 6 and in figures 27 and 28 corresponds to the subject-matter of feature 1.9/7.9.

3.1.6 Conclusion

The subject-matter of claims 1 and 7 differs from D1 in feature 1.7/7.7.

3.2 D2

3.2.1 Features 1.1/7.1 to 1.6/7.6 and 1.9/7.9

The appellant does not dispute that D2 (see e.g. the figure) discloses a catheter grip ("catheter holder") consisting of a generally tubular body (A) (features 1.1/7.1 and 1.2/7.2):

- comprising a first end and a second end (see figures) (feature 1.3/7.3)
- having an inner surface and an outer surface, defining a through bore (see catheter grip (A) holding catheter (B) in the figures) (feature 1.4/7.4)
- configured to slidably engage the shaft of a urinary catheter (see figures) (feature 1.5/7.5)
- the generally tubular body having a larger diameter at the first end and at the second end than at its middle (see figures) (feature 1.6/7.6)
- the inner surface of the generally tubular body configured to contact the urinary catheter along the mid-section when the user applies force thereto (implicit in a tube made of India rubber as disclosed in D2) (feature 1.9/7.9)

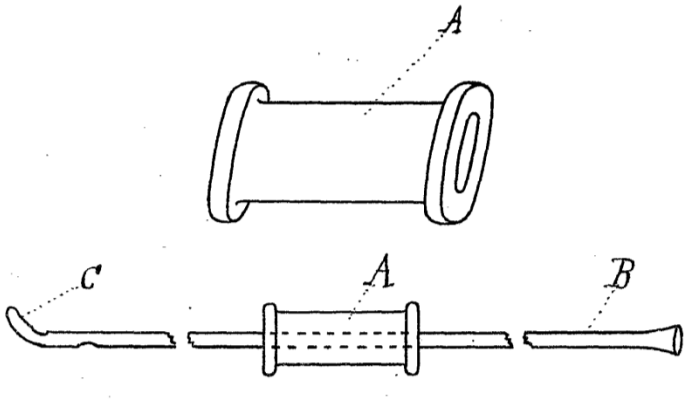
3.2.2 Feature 1.7/7.7 (the generally tubular body provides a first flare at the first end, a second flare at the second end, and a mid-section at the middle)

The respondent argued in writing that the flanges at the ends of the catheter grip of D2 corresponded to the flares defined in feature 1.7/7.7, in particular since claim 1 only required the generally tubular body to "provide" the flares at the ends and not that the ends be "flared".

This is not persuasive since, as acknowledged by the respondent in point 53 of its letter dated 2 January 2025, a "flare" is a **gradual** widening, whereas the flanges shown in D2 do not provide such gradual widening but consist of a step-wise projection. Furthermore the Board does not see why the fact that the generally tubular body provides the flares according to feature 1.7/7.7 should affect the further definition of the feature, i.e. that these flares must be located at the ends.

The respondent also argued that, even if the feature "flare" were interpreted as a gradual widening, D2 showed this feature in its figures, since the edges of the flanges facing the middle of the catheter grip were rounded. Claims 1 and 7 did not define how gradual the widening of the flare should be, and therefore the flares comprising such rounding represented flares at the ends of the catheter grip within the meaning of features 1.7/7.7. It was noted that, in order to acknowledge anticipation of a feature, it was required that the same technical information be shown, and not necessarily that the same wording be used in the claim.

The Board agrees that what is of relevance when it comes to acknowledging anticipation is the disclosure of the technical teaching and not literal coincidence of the particular wording used in the contested claims. However, D2 does not show flares at the end of a catheter grip even if the rounding referred to by the respondent is taken into consideration. The figures of D2 (reproduced below) reproduce some rounding of both sides of each flange.



First, the skilled person would not understand such rounding, typical in medical devices for obvious safety reasons, as a "flare" within the meaning of claim 1, i.e. a gradual widening which can be easily perceived without the need of such an attentive examination of the drawings.

Second, even if the rounding on the face of the flanges oriented toward the middle of the catheter grip were interpreted as a "flare", it would not be at the ends of the catheter grip as defined in feature 1.7/7.7. In fact, if this level of detail were to be applied to perception of the drawing, the diameter of the catheter grip would have to be interpreted as decreasing at the ends since the same rounding can be seen there.

3.2.3 Feature 1.8/7.8 (the smaller relative diameter at the mid-section aiding in positioning a user's fingers toward the middle on the outer surface of the generally tubular body)

Concerning feature 1.8/7.8, the appellant argued that D2 did not disclose any guiding of the user's fingers to the mid-section of the catheter grip as the widening was not gradual but in the form of flanges. According to the appellant, the purpose of the flanges of D2 was to assist the user in finding the ends of the catheter grip and not in positioning their fingers toward the middle on the outer surface as defined in the claims.

This is not persuasive since, as it has been explained in point 3.1.4 above, feature 1.8/7.8 merely requires the smaller diameter of the mid-section to aid in positioning a user's fingers toward the middle on the outer surface of the generally tubular body. The smaller section of the mid-section of the catheter grip shown in the figures of D2 must necessarily enable this capability irrespective of whether the intended purpose of the flanges was different (see D2, lines 88 to 91).

3.2.4 Conclusion

The subject-matter of claims 1 and 7 differs from D2 in feature 1.7/7.7.

3.3 D4

3.3.1 Admittance - Article 12(4), (6) RPBA

The appellant argued that the objection of lack of novelty based on D4 should not be admitted into the appeal proceedings since it had not been raised in the

opposition proceedings, when it should have been submitted (Article 12(6) RPBA). The objection changed what was common ground in the opposition proceedings and put a new burden on the appellant since it required the provision of new facts and arguments. Moreover, the respondent's assertion regarding its alleged intention to have raised the objection during oral proceedings before the opposition division was not verified by the facts.

The appellant's request not to admit the objection based on D4 is not accepted for the following reasons.

It is uncontested that only the objections based on D1 were discussed during the oral proceedings before the opposition division. Since the opposition division revoked the patent in view of these objections, there was no need (and no opportunity) for the respondent/ opponent to present its complete case concerning other possible objections at the time. This is irrespective of whether such a new objection would have possibly required the opposition division to reach a decision on its admittance. Therefore it cannot be concluded that the current objection based on D4 should have been presented during the opposition proceedings (Article 12(6) RPBA).

In terms of the burden on the appellant involved by the admittance of this objection (whether in the opposition or appeal proceedings), it is uncontested that an objection of lack of inventive step based on D4 as starting point was raised in the notice of opposition. Assessing this inventive step objection requires determination of the distinguishing features, if any, of the claimed subject-matter over document D4. Establishing whether the claimed subject-matter is

novel over document D4 does not, therefore, involve any burden which would be additional to determining whether there are distinguishing features over document D4 in the context of assessing inventive step. Thus, the alleged burden is no reason not to admit this objection, which moreover was presented at the earliest possible moment in the appeal proceedings.

In view of the above, the Board admitted the novelty objection based on D4 (Article 12(4) RPBA).

3.3.2 Feature 1.7/7.7 (the generally tubular body provides a first flare at the first end, a second flare at the second end, and a mid-section at the middle)

The respondent argued that the handle member (see e.g. figures 1 and 4, 22) and the connecting member (29) worked as a single body in the catheter grip disclosed in D4 and corresponded to a "generally tubular body" within the meaning of claim 1 and 7.

Even if anticipation of the feature "generally tubular body" (feature 1.2/7.2) can be acknowledged by the Board (see point 3.1.1 above), the respondent does not explain how feature 1.7/7.7 (a first flare at the first end, a second flare at the second end) could then be disclosed in D4, since the first and second ends of the disclosed catheter grip do not comprise any flares but rather a cylindrical portion of constant diameter (see figures 1, 2, 4 and 6) (see also point 3.1.3 above).

Feature 1.7/7.7 is thus not revealed in D4.

3.3.3 Feature 1.9/7.9

Feature 1.9/7.9 reads "*the inner surface of the generally tubular body configured to contact the urinary catheter along the mid-section when the user applies force thereto*".

The Board agrees with the appellant that the skilled person will understand from this wording that "thereto" applies to "the mid-section". This was not contested by the respondent in the appeal proceedings.

D4 shows that the compressible ring (31) contacts the catheter shaft (11) (NB: a PTCA catheter, not a urinary catheter) when the head (33) located at the end of the catheter grip (see figures 4 and 6) is rotated (see column 4, lines 36 to 46).

Since the force is thus not applied to the mid-section of the catheter grip, feature 1.9/7.9 is not anticipated by D4 at least for this reason.

3.3.4 Conclusion

The subject-matter of claims 1 and 7 differs from D4 at least in features 1.7/7.7 and 1.9/7.9.

4. Inventive step, remittal - Article 56 EPC, Article 11 RPBA and Article 111 EPC

4.1 The appellant argued that no special circumstances arose which would justify remittal of the case to the opposition division with regard to inventive step. In any case, at least the inventive step objection based on D1 could be considered in the appeal proceedings without undue burden since, once the distinguishing

features had been established in the analysis of novelty, assessing their obviousness did not result in any significant change in the subject-matter of the proceedings and was clearly favourable in view of the need for procedural economy. There was no absolute right for a party to have a particular issue decided on by two instances.

4.2 Even if the respondent is correct that there is no absolute right for a party to have a particular issue decided by two instances, it is not the function of the appeal proceedings to consider and decide upon issues which have not been examined at all by the department of first instance since this goes against the primary object of the appeal proceedings, i.e. to review the decision under appeal in a judicial manner (Article 12(2) RPBA) (see Case Law of the Boards of Appeal, 11th ed. V.A.9.2.1, in particular T 2839/19).

4.3 The lack of any reasoning to be reviewed in the contested decision concerning inventive step would oblige the Board to decide for the first time on an issue which requires an in-depth analysis going far beyond mere determination of the distinguishing features, not only in the case of the objection starting from D1, but also with respect to objections starting from the further closest prior art documents not yet considered at all by the opposition division. This does not correspond to the aim and purpose of the appeal proceedings.

4.4 Consequently, the case is to be remitted to the opposition division for further prosecution (Article 111 EPC and Article 11 RPBA).

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:

C. Spira C. Herberhold

Decision electronically authenticated