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Aktenzeichen / Case Number / N° du recours : T 94/83

Anmeldenummer / Filing No / N° de la demande : 81 301 105.3

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Bezeichnung der Erfindung: Perioperative application of electronic pain control  
Title of invention: in combination with anesthetic agents  
Titre de l'invention :

Klassifikation / Classification / Classement : A 61 N 1/34

**ENTSCHEIDUNG / DECISION**

vom / of / du 1 March 1985

Anmelder / Applicant / Demandeur : Stimtech, Inc.

~~Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :~~

~~Einsprechender / Opponent / Opposant :~~

Stichwort / Headword / Référence :

EPÜ / EPC / CBE Article 111 (1) - Remittal of the case

Leitsatz / Headnote / Sommaire



Case Number: T 94 / 83

**DECISION**  
of the Technical Board of Appeal 3.4.1  
of 1 March 1985

**Appellant:** STIMTECH, Inc.  
9440 Science Center Drive  
Minneapolis, Minnesota 55428  
United States of America

**Representative:** Colgan, Stephen James  
Carpmaels & Ransford  
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**Decision under appeal:** Decision of Examining Division 040 of the European Patent  
Office dated 16 February 1983 refusing European patent  
application No 81 301 105.3 pursuant to Article 97(1)  
EPC

**Composition of the Board:**

Chairman: O. Huber

Member: P. Ford

Member: J. D. Roscoe

## Summary of Facts and Submissions

- I. European patent application No. 81 301 105.3 entitled "Peri-operative application of electronic pain control in combination with anesthetic agents", filed on 17 March 1981 and published on 30 September 1981 (publication No. 0 036 742) and claiming priority of 24 March 1980 from a previous application in the USA, was refused by decision of Examining Division 040 of the European Patent Office dated 16 February 1983. The decision was based on Claims 1 - 9 received on 18 October 1982 (8 method claims and one product claim). In its decision the Examining Division stated that the methods of the independent Claims 1, 6 and 8 fell in the category of methods for treatment of the human body by therapy which are excluded from patentability by Article 52 (4) EPC and that the product Claim 9 was not allowable under Rule 29 (1) and Article 84 EPC since the technical features of the nerve stimulation apparatus were not defined nor was it specified how the combination of the nerve stimulation apparatus and the anesthetic agent worked.
  
- II. On 15 April 1983 the appellant lodged an appeal against the decision by telex. A document reproducing the contents of the telex was filed on 16 April 1983. The appeal fee was paid in due time. A Statement of Grounds of Appeal was submitted on 29 April 1983. In communications on behalf of the Board, the rapporteur cited US-A-3 911 930 and "Electro-Technology" vol. 84, No. 3, September 1969, p. 57/58. In response to one of these communications the appellant referred to GB-A-972 926.

II. During oral proceedings held on 1 March 1985 at the request of the appellant, the appellant's professional representative requested :

- that the decision under appeal be set aside; and,
- that a patent be granted on the basis of Claim 1 submitted in the oral proceedings, Claims 2 to 4 and 6 to 8 filed on 16 April 1983 subject to the deletion in Claim 8 of the words "whereby the amount of muscle relaxant used is substantially less than the amount which would have been used in the absence of electrical stimulation."

The independent Claim 1 reads as follows :

A combination comprising :

- 1) a transcutaneous electrical nerve stimulation (TENS) apparatus for applying TENS to at least one point proximal to a site of incision, the apparatus being arranged to emit nerve stimulating pulses of electricity having a frequency variable within the range of 3 to 150 pulses per second, a pulse duration variable within the range of 20 to 400 microseconds, and an amplitude variable up to 60 milliamperes; and,
- 2) a general anesthetic agent, for simultaneous, separate or sequential use in preparing a patient for surgery or for alleviating sensation during surgery.

The representative argues essentially as follows :

The article in "Electro-Technology" relates to a method for producing anesthesia by applying a gradually increasing continuous pulsed current (or pulsed plus direct current) across the head and not for alleviating sensation of a patient by applying transcutaneous electrical nerve stimulation pulses (TENS) which are administered near the site of the incision. An electro-anesthesia is entirely different from TENS pain control, and the effects of the two types of treatment are completely different. So TENS does not have any effect on the brain, but merely has a local effect at the site of application. An apparatus suitable for inducing electro-anesthesia is not at all suitable for TENS. An apparatus for TENS, see e.g. US-A-3 911 930, produces modified square wave pulses of particular characteristics (pulse width, pulse amplitude and pulse frequency) which are mentioned in the present Claim 1.

Therefore, the invention as claimed in Claim 1 is both novel and inventive.

Since the situation in the present case is directly analogous to that in the Asta-Werke case (Decision T 9/81, published in OJEP 9/1983, 372-378), where the Appeal Board allowed a claim to the combination of two agents, Claim 1 was drafted in a form very similar to that of Claim 1 of the Asta-Werke case.

#### Reasons for the Decision

1. The appeal complies with Articles 106 - 108 and Rule 64 EPC and is therefore admissible.

2. The current claims are supported by the original documents. Concerning the frequency range, the pulse duration and the amplitude see page 6, lines 30 to 34, and Claim 3.
3. The present claims are directed to a product (combination of a TENS apparatus and an anesthetic agent). Therefore, they do not cover methods which are unpatentable by virtue of Article 52 (4) EPC.
4. Article 84 EPC only requires that the claims must define the matter for which protection is sought clearly and concisely. An indication in a claim of how an invention works is not required by Article 84 EPC. Therefore, contrary to the view expressed in the appealed decision in respect of Claim 9 filed on 18 October 1982, the failure of the present Claim 1 to indicate how the combination of the TENS apparatus and the anesthetic works does not constitute a violation of Art. 84 EPC.
5. The technical features of a TENS apparatus are familiar to a person skilled in the art, cf. US-A-3 911 926. They are also mentioned in the present Claim 1 which is not therefore open to the objection raised under Article 29 (1) EPC in the appealed decision against the aforesaid Claim 9, that it does not define the technical features of the invention.
6. The above-cited article in "Electro-Technology" discusses the possibility of the combined use of chemical anesthesia and electroanesthesia during the latter stages of surgery in order to reduce the quantity of chemical anesthetics at this stage and thereby minimize postoperative complications, see page 58, right-hand

column. Since electroanesthesia requires a different kind of pulse generator than TENS - in "Electro-Technology" it is only said that a most efficient frequency of pulses appears to be around 100 Hz, see page 57, right-hand column, 3rd paragraph ( in contrast to GB-A-972 926 where for electroanesthesia currents alternating sinusoidally at between 1250 and 2000 Hz are indicated ) - the claimed combination is not disclosed in "Electro-Technology". US-A-3 911 930 describes only a TENS apparatus producing electrical pulses with parameters lying in or around the ranges mentioned in Claim 1 (equals the first feature of the claimed combination) and a method of treating pain by applying TENS to a body without associated application of an anesthetic agent. The subject-matter of GB-A-972 926 is simply an apparatus for electro-anesthesia.

Thus the combination, as set out in Claim 1, is new.

7. The Examining Division has not examined whether the combination according to the new Claim 1 submitted in the oral proceedings involves an inventive step and complies with other requirements of the EPC. Therefore, the case must be remitted to the Examining Division (Article 111(1) EPC) for further prosecution in which due account should be taken of the above cited Asta-Werke decision.

Order

For these reasons, it is decided that :

- 1) The decision of the Examining Division dated 16 February 1983 is set aside.
- (2) The application is remitted to the Examining Division for further prosecution on the basis of the claims as requested at the oral proceedings.

The Registrar:

The Chairman:

J. Bickel

O. Huber