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File Number: T 839/91 - 3.2.2

Application No.: 89 100 983.9

Publication No.: 0 326 033

Title of invention: Prophylactic sheath with augmented border

Classification: A61F 5/43

D E C I S I O N
of 23 March 1993

Applicant: LRC PRODUCTS LIMITED

Headword:

EPC Article 56

Keyword: "Inventive step (yes)"



Case Number : T 839/91 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 23 March 1993

Appellant : LRC PRODUCTS LIMITED
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Decision under appeal : Decision of the Examining Division 2.3.05.127 of
the European Patent Office dated 22 May 1991
refusing European patent application
No. 89 100 983.9 pursuant to Article 97(1) EPC.

Composition of the Board :

Chairman : G.S.A. Szabo
Members : W.D. Weiß
F. Benussi

Summary of Facts and Submissions

- I. European patent application 89 100 983.9, filed on 20 January 1989 and published on 2 August 1989 under No. 0 326 033, was refused by a decision of the Examining Division, dated 22 May 1991.
- II. The reason given for the decision was that the subject-matter of the Claim 1, filed on 11 March 1991, lacked an inventive step having regard to a combination of the documents
- (1) GB-A-1 259 284 and
 - (2) GB-A-2 018 604.

The principal argument was that the subject-matter of Claim 1 differed from document (1) in the selection of the parameter values for the material of the sheath, but these values were within the range apparent from document (2), page 1, line 114 to page 2, line 15.

- III. A Notice of Appeal was filed against this decision on 1 March 1991, and the appeal fee was paid simultaneously. The Statement of the Grounds was filed on 1 October 1991.
- IV. On 4 March 1993, by letter of 3 March 1993, the Appellant filed amended Claims 1, 3 and 10 together with an amended page 1 of the description. Claim 1 in this version reads as follows:

"1. A prophylactic device comprising a sheath of elastomeric sheet material having a 100% tensile modulus of at least about $1380 \cdot 10^3$ Pa (200 psi) and a thickness of less than about 0,03556 mm (0.0014 inch), said sheath having an open end with a border, characterised in that

said border is augmented by a resilient material having a 100% tensile modulus substantially lower than that of said elastomeric sheet material."

The Appellant contests that document (1) is a relevant state of the art, because, due to the particular construction of the prophylactic device disclosed therein, the relation of the elastic parameter between the border and the sheath materials is of no significant importance in this known device. He considers document (2) as the closest prior art which has, therefore, been taken to formulate the preamble of Claim 1.

V. Consequently, the Appellant requests grant of the patent on the basis of the following documents:

Claims: Claims 1, 3 and 10, filed on 4 March 1993,
 with letter of 3 March 1993,
 Claims 2 and 4 to 9 as originally filed;

Description: Page 1, filed on 4 March 1993, with letter of 3 March 1993,
 and pages 2 to 19, filed on 11 March 1991,
 with letter of the same date, in which the last sentence on page 19 has been replaced by "This example is not intended to restrict the scope of the claims." (Telecopy received on 12 March 1993).

Reasons for the Decision

1. The Appeal is admissible.

2. Amendments

The amended Claims 1, 3 and 10 differ from their original predecessors in that the values are now also indicated in SI Units in addition to the originally used non-metric units. Moreover, Claim 1 has now been formulated using the two-part form according to Rule 29(1) EPC.

Consequently, the subject-matter of the original claims has not been changed at all by these merely formal amendments.

Therefore, the amended claims do not contravene Article 123(2) EPC.

3. Novelty

Document (1) discloses a prophylactic device comprising a sheath having a border augmented with a resilient material (Figure 4). The sheath is made of synthetic plastics. The examples of suitable synthetic plastics (page 1, line 77, to page 2, line 4), which also include polyurethanes, comprise synthetic plastics of which elastomeric as well as form stable versions exist. From the fact that the brands "Mylar" and "Makrolon" are particularly preferred materials, it has to be concluded that document always means the non-elastomeric version of the said plastics, because these two materials are typical form-stable materials. For such materials the 100% tensile modulus is not defined, because they are subject to rupture before they reach the elongation which meets the test requirements. Mylar, for instance, is a typical material

for magnetic tapes. The validity of this interpretation is confirmed by the statement (page 2, lines 23 to 29) that "the synthetic plastics material may be relatively non-elastic and tearfree compared with rubber. Consequently, already the preamble of Claim 1 does not read on this document.

The Board is in agreement with the Appellant that document (2) discloses all the features in the first part of Claim 1 but not those in its characterising portion.

The subject-matter of Claim 1 is, therefore, novel.

4. Technical Problem based on the Closest State of the Art

Following the considerations under the preceding point 3, document (2), constitutes the closest state of the art.

The sheaths of prophylactic devices as disclosed in document (2), as well as those of the present application, are made of such materials which allow to form sheaths of less than half the thickness of latex products which have an equal strength. This reduced thickness of the products results in the advantage that these products provide greater transmission of heat and sensation (see EP-A-0 326 033, col. 1, lines 35 to 40).

Prophylactics made from these materials, however, are somewhat difficult to place over the body member for use, particularly when this is done by unrolling the sheath over the member. Moreover, these known prophylactics tend to roll back on themselves (EP-A-0 326 033, col. 2, lines 1 to 11).

Consequently, the technical problem consists in removing these disadvantages. This problem is solved by the characterising features of Claim 1.

5. Inventive Step

Document (1) discloses that a condom, the sheath of which is made of a material which is relatively non-elastic and tearfree compared with rubber, is better retained in place when the border of its open end is augmented by a appropriately sized extensible ring or band of a suitable material. This ring is, however, incorporated when being in an expanded state and, therefore in its released state, shirs the open end of the condom to a diameter which is smaller than the diameter of the sheath of the condom (Figure 2). In this released shirred state the elasticity of the sheath material does not compete at all with the elasticity of the extensible ring: in this state any sheath material behaves as if it had a negligibly low 100% tensile modulus. Moreover, it has to be considered that the sheath material used in document (1) is not an elastomeric one (point 3, first paragraph, above).

Consequently, the teaching of document does not deliver any incentive to the skilled reader, who wants to solve the above problem, to select purposively the 100% tensile modulus of the material of the extensible ring in relation with the respective modulus of the sheath material when this has elastomeric properties.

Hence the required inventive step is also involved.

6. Claim 1 according to the main request is thus allowable in accordance with Article 52(1) EPC.

The dependent Claims 2 to 10 are not open to objection on formal grounds and their subject-matter covers particular embodiments of the invention defined in Claim 1. They are, therefore, allowable.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order to grant a patent on the basis of the following documents:

Claims: Claims 1, 3, and 10, filed on 4 March 1993, with letter of 3 March 1993,
Claims 2, and 4 to 9 as originally filed;

Description: Page 1, filed on 4 March 1993, with letter of 3 March 1993, and
pages 2 to 19, filed on 11 March 1991, with letter of the same date, in which the last sentence on page 19 has been replaced by
"This example is not intended to restrict the scope of the claims."

The Registrar:



S. Fabiani

The Chairman:



G. Szabo

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