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D E C I S I O N
of 8 February 1997

Case Number: T 0666/96 - 3.2.2

Application Number: 90917823.8

Publication Number: 0479933

IPC: A61F 6/04

Language of the proceedings: EN

Title of invention:
A contraceptive

Applicant:
RAPPE, Axel G:son

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 54

Keyword:
"Novelty (no, after amendment)"

Decisions cited:
-

Catchword:
-



Case Number: T 0666/96 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 8 February 1997

Appellant: RAPPE, Axel G:son
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 8 March 1996
refusing European patent application
No. 90 917 823.8 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: M. G. Noël
Members: D. Valle
J. C. M. De Preter

Summary of Facts and Submissions

- I. By decision of 8 March 1996 the Examining Division refused application No. 90 917 823.8 (International Publication No. WO-91/00 076) on the grounds of lack of novelty vis-à-vis the state of the art represented by the document (1): SE-A-8 704 797-3.

The reason given by the first instance was that the known condom was made of a single piece having a first opening and an additional opening in the sense of the subject-matter of the application in suit.

- II. The Appellant (Proprietor of the patent) lodged an appeal against the first instance decision on 7 May 1996 and paid the appeal fee on the same day. A Statement of Grounds was filed on 2 July 1996 along with an amended claim and new pages 1a and 1b to substitute former page 1 of the description.

- III. The single claim now in suit reads as follows:

"A contraceptive in the form of a condom made from a material conventional in the manufacture of condoms, which condom in its extended state has an envelope surface (5) between its opening (2) and its closed front end, characterized in that said additional opening (4) is provided in said envelope surface (5) and in the part (3) of the condom nearest its opening (2) through which additional opening (4) the testicles (scrotum) of the wearer are intended to be inserted and in that a reinforcement (6) is provided on the wall constituting said envelope surface of the condom around said additional opening (4), which reinforcement comprises a thickening of the condom material in the reinforced area (6)."

- IV. The Appellant requested that the decision under appeal be set aside and the application granted on the basis of the latest submissions. The Appellant argues essentially as follows:

Document (1) is not prejudicial to the novelty of claim 1 because it does not disclose an additional opening in the envelope surface of the condom, but rather a rubber ring attached to the open end of the condom. The condom referenced in the figures by numeral 10 obviously does not show any additional opening on its envelope surface. The opening of the condom is designated by the reference sign 12, whereas a rubber ring 13 is attached to the condom outside this opening.

Reasons for the Decision

1. The appeal is admissible
2. *Amendments*

With respect to the version as originally filed, the claim has been amended by incorporating the following additional features.

The feature "which condom in its extended state has an envelope surface (5) between its opening (2) and its closed front end" is not mentioned in the description. However it is derivable from figure 1 of the original application which clearly shows an envelope 5 extending between the opening 2 and the opposite front end.

The feature "and in that a reinforcement (6) is provided on the wall constituting said envelope surface of the condom around said additional opening (4)," is taken from the original claim 2.

The feature: "which reinforcement comprises a thickening of the condom material in the reinforced area," is taken from the description (page 2, lines 18 and 19).

Therefore, the amendments made are not such as to extend the claimed subject-matter beyond the content of the application as originally filed, so that, the requirements of Article 123(2) EPC are met.

Furthermore, the Board observes that the expression "said additional opening (4)" introduced at the beginning of the characterizing part has no antecedent in the preamble, which renders the claim unclear (Article 84 EPC). However, further consideration of this objection can be dispensed with, since the claim is not acceptable for other substantive reasons, as demonstrated below.

3. *Novelty*

- 3.1 Document (1) discloses a contraceptive in the form of a condom made from a material conventional in the manufacture of condoms which, in its extended state, has an envelope surface generally designated by 10 and extending between its main opening and its closed front end. Moreover, an additional opening (angled aperture between 12 and 13 in figure 5) is provided at one end of said envelope surface and in the part of the condom nearest its main opening, through which the testicles (scrotum) of the wearer are intended to be inserted (compare figure 5 with figure 4). A reinforcement 12 is also provided on the wall constituting said envelope surface of the condom around at least part of said additional opening, which reinforcement comprises a thickening of the condom material so as to form a reinforced area.

3.2 The Appellant's assertion, that Document (1) does not disclose any additional opening in the envelope surface of the condom, but rather an additional rubber ring 13 attached to the open end 12, 14 of the condom is based, in the Board's view, on a misleading interpretation of the terms "additional opening" and "envelope" with respect to the disclosure of Document (1). On this point the position of the Board is as follows.

The main opening of a condom is the aperture through which the penis of the wearer is inserted. The "additional opening", therefore, must be regarded as an additional aperture which serves another purpose. According to the application in suit this additional opening has merely the function of inserting the testicles therethrough.

Accordingly, the main "opening" is the opening having the reference sign 2 in the application, which corresponds to the opening with the reference 12 in Document (1), that is the opening through which the penis is inserted (see figure 5 of Document (1) after the testicles have been inserted).

As to the "additional opening", it has the reference sign 4 in the application, which corresponds to the aperture comprised between the ring 13, the connecting segment 14 and the reinforcement 12 in Document (1). As already explained, that additional opening performs the same function as the additional opening 4 of the subject-matter of the application, namely to lodge the scrotum. As a consequence, the same terminology can apply.

The term "envelope" is defined by the whole surface surrounding the penis including the reinforcement 12 and the rubber ring 13 in the embodiment shown in figure 3 of document (1). Since, however, the subject-

matter of the claim in suit defines the condom before use ("through which additional opening the testicles are intended to be inserted") the known condom may be considered in the state illustrated in figure 3 of Document (1) in which the additional opening between ring 13 and reinforcement 12 is clearly provided in the "envelope" surface of the condom.

The Appellant's line of arguments was principally based on a difference of terminology. The Board, however, observes that it is not necessary that the same terminology be used both in the application and in the prior art to assess lack of novelty. Novelty is destroyed if all the claimed elements are disclosed in combination in one and the same document of the prior art. An element of the claim is further disclosed when the corresponding element in the prior art is not distinguishable therefrom either by its structure or function, as it is the case here.

- 3.3 Since all the features contained in the claim as drafted are disclosed by Document (1), its subject-matter is not novel within the meaning of Article 54(1) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:



S. Fabiani

The Chairman:



M. Noël