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D E C I S I O N
of 24 February 1998

Case Number: T 0740/97 - 3.2.2

Application Number: 96101180.6

Publication Number: 0722695

IPC: A61B 17/36

Language of the proceedings: EN

Title of invention:
Intrauterine cauterizing apparatus

Applicant:
Gynelab Products, Inc

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 76(1), 123(2)

Keyword:
"Divisional application - not extended subject-matter"

Decisions cited:
T 0133/85, T 0331/87, T 0888/90, T 0873/94

Catchword:
-



Case Number: T 0740/97 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 24 February 1998

Appellant:

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Representative:

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Decision under appeal:

**Decision of the Examining Division of the
European Patent Office posted 17 April 1997
refusing European patent application
No. 96 101 180.6 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: H. J. Seidenschwarz
Members: M. G. Noel
J. C. M. De Preter

Summary of Facts and Submissions

- I. European patent application No. 96 101 180.6 (publication No. 0 722 695) was refused by decision of the Examining Division issued on 17 April 1997 on the ground that the subject-matter of the European divisional application extended beyond the content of the earlier application as filed No. 89 910 571.2 (published as WO 90/02525) (Article 76(1) and 123(2) EPC).
- II. The reason for the refusal was that the applicator for effecting thermal cauterization of the tissue lining of a human body cavity could not be isolated from the apparatus as a whole, since there was no basis for this in the earlier application as filed. To solve the problem addressed in the application in suit, it was necessary that the applicator be used only in connection with the whole cauterization apparatus ie comprising also means external to the applicator, so that a claim directed to an applicator taken in isolation was not justified nor founded.
- III. The appellant lodged an appeal against the first instance's decision on 22 April 1997. A statement of grounds was filed on the same date and the appeal fee was paid in due time.

Grant of a patent was requested on the basis of claims 1 to 12 filed on 12 February 1997 along with an additional appendant claim 13 filed with letter of 1 October 1997.

IV. According to the appellant, the first instance did not properly apply Article 76(1) and 123(2) EPC in conjunction with Article 88(4) EPC. When correctly interpreting the earlier application as a whole, ie including the drawings, the present invention did not relate to the whole cauterization apparatus but primarily to an applicator alone for effecting thermal cauterization, ie without the consideration of extra external control means. As recited in the application in suit an object of the present invention was to provide a relatively inexpensive and easy to replace applicator. As a consequence, a claim directed to the sole applicator was not such as to extend its subject-matter beyond the content of the earlier application as filed.

V. By communication of the Board, the appellant was requested to file a new set of application documents for appeal, in consequence of ambiguities appearing in the text for consideration of the Board and discrepancies between the claims and the description.

VI. In a reply dated 14 November 1997 the appellant submitted a new set of amended claims 1 to 13 along with a complete set of recasted description pages 1 to 11 and drawings pages 1/5 to 5/5.

The appellant's previous requests are, therefore, based on these new pieces of documents.

VII. Claim 1 in suit reads as follows:

"Applicator for effecting thermal cauterization of substantially all of the human uterine endometrium, comprising:

a catheter for insertion into the uterus via the cervical canal, said catheter terminating in a rigid, axially closed proximal end portion and having an open distal end, and a distendable bladder (5) defining an enclosure attached at said proximal end portion and projecting axially beyond the proximal end of the catheter when distended; said bladder (5) when distended contacts substantially all of the tissue lining of the uterus:

inflating means (14) connected to said distal end for distending said bladder (5) with a fluid (25) from a fluid system and

heating means (44) for heating a fluid (25), said heating means being positioned internally to said bladder(5)."

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments*
 - 2.1 With respect to the version as refused, claim 1 in suit was amended by incorporation of the following feature:
"inflating means (14) connected to said distal end for distending said bladder (5) with a fluid (25) from a fluid system and".

This feature is fairly supported by both the divisional and the earlier application as filed, since said feature was present in claim 1 of each said application, respectively. In addition, the specification of a fluid supplied from a fluid system for distending the bladder, is based as well on the divisional application as filed (cf. column 6, lines 12 to 21) as on the earlier application as filed (cf. WO 90/02525, page 12, lines 7 to 17).

Therefore, the incorporation in claim 1 of the above mentioned feature is not objectionable under Article 84 or 123(2) EPC.

2.2 The reason given by the first instance was, essentially, that the subject-matter of claim 1 as refused (like that of claim 1 in suit) referred to an applicator for effecting thermal cauterization, whereas in the application as originally filed there was claimed an apparatus comprising (among others) an applicator ... comprising in turn a catheter ... and a distendable bladder attached thereto. Stated another way the scope of the claimed subject-matter had been widened over the content of the application as filed, in contradiction to the requirements of Article 76(1) and 123(2) EPC.

2.3 At first, Article 76(1) EPC operates only for amendments made to the divisional application with respect to the earlier application as filed. As to Article 123(2) EPC, it operates only for amendments made to the divisional application under consideration

with respect to the divisional application as filed.

Since the earlier and the divisional applications as filed are identical in all respects, all amendments made to the divisional application under consideration are concerned only with Article 123(2) EPC (cf. T 873/94, OJ EPO 1997, 456, points 1 and 2). Instead, Article 88(4) EPC referred to by the appellant is irrelevant to the question of adequate support by the original disclosure, it being restricted to the recognition of the priority rights which, in the present case, were not contested.

- 2.4 According to the divisional application as filed (page 8, line 3 to page 9, line 8) second and third paragraphs), it appears clearly that the applicator comprises internal means only, ie means to be inserted into the uterus, comprising an inflatable bladder 5 and a rigid tubing 3 for attachment thereto and provided with heating means 44 (cf. Figures 6 and 7). The remaining of the tubing set, comprising a flexible tubing 10, a controlled fluid source 14 and a control unit 30, are regarded as external means with respect to the elements to be inserted in the body cavity. The internal and external means form all together the so-called fluid system as a whole (cf. page 12, lines 4 to 12).

The problem underlying the present invention is not clearly defined in the application as filed. In its broadest definition, the main object of the invention is to provide a method for cauterizing the tissue lining of a body cavity (cf. paragraph bridging pages 5

and 6). However, having regard to the apparatus for performing the method (cf. page 6, lines 3 to 7), the main object of the present invention is to provide an applicator as such, "heated by non-toxic fluid ... and controlled by means external to the applicator". It results therefrom that the term "applicator" is to be understood in a narrower sense, according to which the heating applicator alone is regarded as the object for which protection is sought, beyond any specific application or additional control means.

2.5 In any case, the subject-matter of claim 1 in suit actually refers to an "applicator" for affecting thermal cauterization of the human uterine endometrium. Therefore, it is not restricted to the applicator as such but also includes the specific use for which said applicator is intended. Moreover the applicator as claimed is defined by combining structural and functional features, which is acceptable. In particular, the bladder is distendable by an inflating fluid and, when distended, uniform contact between the bladder and the endometrium is established. In addition, heating means positioned internally to said bladder are provided for heating the fluid so as to obtain thermal cauterization. Indeed, all essential features for effecting cauterization are present in claim 1. While external control means may be suitable for optimising the efficiency of the treatment, such means are not necessary for achieving a result, whatsoever. Therefore, there is no reason to limit the scope of the main claim to the entire tubing system as long as the applicator itself has not been seriously questioned

during the subsequent substantive examination. As a consequence, in the Board's judgment, the subject-matter of claim 1 is clear, complete and fairly supported by the divisional application as filed, within the meaning of Article 123(2) EPC.

- 2.6 With respect to claim 1 according to the divisional application as filed, the following feature has been omitted in claim 1 in suit: "and control means for regulating the distending and heating of said distendable bladder". While the omission of a feature may generally result in an unallowable generalisation, ie extension of the claimed subject-matter beyond the content of the application as filed, in the present case, however, external regulating means are not considered as essential since, as explained before, the applicator can operate as it is. It is the established case law (T 331/87, OJ EPO 1991, 22, points 6 and 7.5) that the removal of a feature which is not recited as essential in the disclosure does not constitute a violation of Article 123(2) EPC.

Moreover, broadening the scope of a claim during the examination procedure is not contrary to Article 123(2) provided the subject-matter resulting from the change was already to be found within the content of the application as originally filed (T 133/85, OJ EPO 1988, 441, points 4 and 5; T 888/90, OJ EPO 1994, 162 points 3.5 and 3.6).

As previously explained, all features present in claim 1 under consideration are fairly supported by the application as filed and protection of the applicator

as such is intended. Consequently, the subject-matter of the present invention remained the same. Although the claimed subject-matter is wider than the subject-matter as originally claimed, this is permissible under Article 123(2) EPC.

3. *Remittal to the first instance*

Since the refusal by the first instance was restricted to formal aspects under Article 76(1) and 123(2) EPC and considering that the main claim has been further modified by the appellant, the Board considers it appropriate to make use of its power conferred by Article 111(1) EPC to remit the case to the first instance for further prosecution on the substantive issues.

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 for further prosecution on the basis of the application documents filed with the appellant's letter dated 14 November 1997 (cf. point VI above).

The Registrar: The Chairman:

S. Fabiani

H. Seidenschwarz