

# PATENT COOPERATION TREATY

From the  
INTERNATIONAL SEARCHING AUTHORITY

# PCT

To:

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NOTIFICATION OF DECISION ON PROTEST  
OR DECLARATION THAT PROTEST  
CONSIDERED NOT TO HAVE BEEN MADE

(PCT Rule 40.2(c) and (e) and  
Administrative Instructions, Section 502)

Date of mailing  
(day/month/year)

11.02.2011

Applicant's or agent's file reference

## IMPORTANT NOTIFICATION

International application No.  
PCT/IL2010/000568

International filing date  
(day/month/year)

15.07.2010

Applicant  
CIRC MEDTECH LTD.

☒ The applicant is hereby notified that this International Searching Authority, after having examined the protest on the payment of the additional fees, has reached the decision indicated below.

1. ☐ **The protest is found justified** to the extent that:

- ☐ total reimbursement of the additional fees and, where applicable, any protest fee will be made in due course
- ☐ partial reimbursement in the amount of \_\_\_\_ (currency/amount) will be made in due course for the following reason(s):

2. ☒ **The protest is found unjustified** and the additional fees and, where applicable, any protest fee paid will not be refunded for the following reason(s):

**see separate sheet**

3. ☐ The International Searching Authority declares that the **protest is considered not to have been made** since the applicant has not paid the protest fee within the limit referred to in the invitation (Form PCT/ISA/206) dated

### ATTENTION

The applicant should notify the International Bureau promptly if he wishes a copy of the protest and the decision thereon to be sent to the designated Offices.

A copy of this notification has been sent to the International Bureau

Name and mailing address of the international  
searching authority:



European Patent Office

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Tel. +49 89 2399 - 0  
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Authorized Officer

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**NOTIFICATION OF DECISION ON PROTEST  
OR DECLARATION THAT PROTEST  
CONSIDERED NOT TO HAVE BEEN MADE**

International application No.

PCT/IL2010/000568

With letter of 23.12.2010 received on 30.12.2010 the applicant submitted a protest regarding ISA's assertion of multiple inventions. The arguments were that the inventions I to III share common technical features which are not disclosed by D1. The applicant's opinion is that D1 does not disclose the following features:

- 1). "...at least one circumferential groove, said at least one circumferential groove being located on a surface of at least one of said rigid ring and said at least one elastic ring..." and
- 2). "...wherein said rigid ring is placed around a first surface of said foreskin; wherein said at least one elastic ring is placed around a second surface of said foreskin, said foreskin being placed within said at least one circumferential groove..."

The arguments provided by the applicant are that D1 only teaches a system in which the circumferential groove is located on the outer surface of the rigid ring, in contrast to technical feature 1 and also that D1 only shows a system in which the rigid ring is placed on the inner surface of the foreskin and the elastic ring is placed on the outer surface of the foreskin, which is unlike technical feature 2.

These both arguments cannot be followed for the following reasoning:

- The technical feature 1 states merely that the circumferential groove can be on any surface, either on the rigid ring or on the elastic ring without any limitation in the claim, as to where this groove can be found. Since D1 shows the circumferential groove on the outer surface of the rigid ring (see figure 1), at least one of the alternatives defined in the present claims is disclosed and thus not new.
- The technical feature 2 refers merely to first and second surfaces, without limiting the claims as to which of these surfaces is the inner surface and which is the outer surface. As it is, D1 discloses as first surface the inner surface of the foreskin and the second surface as the outer surface of the foreskin, such that one of the alternatives defined in claims is disclosed, thus this technical feature not being new as well.

The attention of the applicant is also drawn to the fact that the technical feature named "technical feature 2" refers to a method of using the apparatus and is not a technical feature of the apparatus per se. Method steps found in product claims are not considered as limiting the scope of the claims.

Therefor the protest is found unjustified.

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אלי בורוכוב  
יהושע (שוקי) הגלר  
לי שילה  
קרני שרון

December 23, 2010

Via Facsimile and Confirmation by Courier

The International Searching Authority  
European Patent Office  
P.O. Box 5818  
Patentlaan 2  
2280 HV Rijswijk  
Netherlands

**EPO - DG 2**

**30. 12. 2010**

**65**

RE: **International Patent Application No. PCT/IL2010/000568**  
**Applicant: CIRC Medtech Ltd.**  
**Additional Search Fee and Protest Fee**  
Our Reference: 003672PC

Dear Sirs,

Pursuant to the Invitation to Pay Additional Fees and Protest Fee (Form PCT/ISA/206) of November 23, 2010, for the above referenced application, Applicant has paid for an additional search fee for **ONE** additional search for claims 21 and 26-29, specified in the above Form as **Invention 4**.

Applicant is submitting a protest regarding the ISA's assertion of multiple inventions with regards to inventions 1, 2 and 3 (as per the above Form). Pursuant to the submitted protest, Applicant has paid the relevant protest fee and has attached the required technical reasoning explaining the reasons for the protest. Applicant's protest is made without prejudice to Applicant rights to protest the ISA's assertion of multiple inventions with regards to inventions 4, 5, 6, 7 and 8.

The relevant fees have been transferred to the bank details of the EPO, as detailed in the above Form, including €790 for the protest fee and €1,785 for the additional search fee.

Please confirm receipt of our letter and handling of this matter.

Respectfully yours,

  
Eli Borochov, Adv.

003672PC LTR-07 Protest Fee

## Technical Reasoning to Accompany a Protest

In Form PCT/ISA/206 of November 23, 2010, in the matter of International Patent Application No. PCT/IL2010/000568 (herein '568), the ISA stated that it found multiple inventions, listed as inventions 1-8 and that '568 does not meet the requirements of Unity of Invention as defined in Rules 13.1 and 13.2 PCT. The ISA asserted that Chinese Patent No. 2256299Y (herein D1) was identified as the prior art and that the features of claims 1-3, 7, 11, 19 and 22 are known from D1. Based on this assertion, the ISA then identified 8 inventions within the searchable claims of '568, each invention presenting a special technical feature making a contribution over D1. According to the ISA, the special technical features of these 8 inventions are neither the same nor do they correspond to one another, hence the Unity of Invention objection mentioned above.

Applicant respectfully disagrees. Applicant asserts that inventions 1-3 share common technical features, thus representing a single inventive concept over D1. In '568, regarding claims 1-3, 7, 11, 19 and 22, claims 1 and 22 are independent claims. These independent claims teach technical features which are not taught, mentioned or suggested in D1. These technical features are as follows:

1. A system for effecting ischemic necrosis in the foreskin in which the circumferential groove can be placed on the inner surface of the rigid ring, the inner surface of the elastic ring or the outer surface of the elastic ring (for example, claim 1 states "...at least one circumferential groove, said at least one circumferential groove being located on a surface of at least one of said rigid ring and said at least one elastic ring..."). This is also substantiated in '568, p.56, line 4 to p.57, line 8 and in Figures 9A, 9B, 10A and 10B.
2. A system for effecting ischemic necrosis in the foreskin in which the rigid ring may be placed on the outer surface of the foreskin and the elastic ring may be placed on the inner surface of the foreskin (for example, claim 1 states "...wherein said rigid ring is placed around a first surface of said foreskin; wherein said at least one elastic ring is placed around a second surface of said foreskin, said foreskin being placed within said at least one circumferential groove..."). This is also substantiated in '568, p.57, lines 9-29, p.58, line 15 to p.59, line 2 and in Figures 9C, 9D, 10C and 10D.

D1 only teaches and suggests a system for effecting ischemic necrosis in the foreskin in which *the circumferential groove is located on the outer surface of the rigid ring*, unlike technical feature 1. listed above (for example, the abstract of D1 states "The utility model adopts a ring loop, a ring groove is arranged on the outer circle of the ring loop..."). D1 also only teaches and suggests a system for effecting ischemic necrosis in the foreskin in which *the rigid ring is placed on the inner surface of the foreskin and the elastic ring is placed on the outer surface of the foreskin*, unlike technical feature 2. listed above (for example, the abstract of D1 states "...When the simple ring cutter for prepuce is used, the ring bracket is inserted and supported in the prepuce to support the prepuce, the blood of the front part of the prepuce is not circulated and is naturally blocked so that the prepuce falls off...").

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The technical features listed above of claims 1 and 22 therefore represent common special technical features over D1. As claim 1 is common to inventions 1, 2 and 3 (as per the ISA's listing of identified inventions in '568), these three inventions represent a single inventive concept. Inventions 1, 2 and 3 therefore do not lack Unity of Invention and are to be considered as a single invention.