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**Datasheet for the decision  
of 26 May 2008**

**Case Number:** T 1211/05 - 3.2.02

**Application Number:** 98918721.6

**Publication Number:** 0977532

**IPC:** A61F 9/013

**Language of the proceedings:** EN

**Title of invention:**

Cutting blade assembly and medical apparatus comprising a cutting blade assembly therefor

**Patentee:**

Hellenkamp, Johann F.

**Former Opponent:**

Surgin Surgical Instrumentation, Inc.

**Headword:**

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**Relevant legal provisions:**

EPC Art. 123(2),(3)

**Relevant legal provisions (EPC 1973):**

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**Keyword:**

"Extended subject-matter - no, after amendments"

**Decisions cited:**

T 0133/85

**Catchword:**

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Case Number: T 1211/05 - 3.2.02

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.02  
of 26 May 2008

**Appellant:**  
(Patent Proprietor)

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**Decision under appeal:**

Decision of the Opposition Division of the  
European Patent Office posted 19 July 2005  
revoking European patent No. 0977532 pursuant  
to Article 102(1) EPC 1973.

**Composition of the Board:**

**Chairman:** T. Kriner  
**Members:** M. Noel  
A. Pignatelli

## Summary of Facts and Submissions

I. European patent No. 0977532 was revoked by decision of the opposition division dated 19 July 2005 principally on the basis of Article 123(2) EPC 1973.

The reasons were that some of the claimed features were not supported by the application as filed and other features were omitted and replaced by broader ones so as to result in extended subject-matter going beyond the content of the application as filed.

II. The appellant (patentee) lodged an appeal against this decision by notice received on 20 September 2005 and paid the appeal fee on the same day. A statement setting out the grounds of appeal was filed on 29 November 2005 along with a number of amended sets of claims according to various requests. Oral proceedings were requested as well.

III. The respondent (opponent) informed the Board by letter of 24 February 2006 that he withdrew its opposition.

IV. In response to a Board's communication conveying a provisional opinion in favour of the second auxiliary request, the appellant replied, by letter dated 28 April 2008, that he was prepared to withdraw his request for oral proceedings provided that the Board would remit the case to the first instance based on the claims according to the second auxiliary request.

V. Claim 1 of the main request and of the first and second auxiliary requests reads as follows:

Main request:

"A cutting blade assembly (300) to be used with a surgical device that cuts at least partially across a cornea of an eye of a patient, the surgical device including a drive means said cutting blade assembly comprising:

- a) a cutting blade (310) having:
  - i) a front portion (312), said front portion including a sharp, forward cutting edge (313);
  - ii) a rear, trailing portion (314) including a rear edge (315);
  - iii) pair of side edges (316, 317) interconnecting said front portion and said rear trailing portion; and
  
- b) a blade holder (320) being operably connected to said cutting blade (310) and structured to be operably driven by the drive means of the surgical device, **characterised in that** said side edges (316, 317) of said cutting blade (310) being at least partially tapered between said front portion (312) and said rear trailing portion (314)."

First auxiliary request:

The content of claim 1 of the main request with the incorporation of the words "and secured" after the word "connected" in feature b).

Second auxiliary request:

The content of claim 1 of the main request after deletion of the words "at least partially" in the characterising portion.

- VI. In its written submissions, the appellant presented arguments to support the view that the claimed subject-matter according to the various requests met the requirements of Article 123(2) EPC, in particular as to the expression "at least partially tapered between" placed in the characterising portion of claim 1 and the features modified by way of replacement in the preamble thereof.

### **Reasons for the Decision**

1. The appeal is admissible.
2. Main and first auxiliary requests - Article 123(2) EPC

The expression "at least partially" in the characterising portion of claim 1 according to the main and the first auxiliary requests is nowhere to be found in the description of the application as filed, nor is it directly and unambiguously derivable from the drawings. Therefore the subject-matter of these claims has been extended over the content of the application as filed, contrary to the requirements of Article 123(2) EPC, as correctly decided by the opposition division.

The appellant's arguments about the alleged relationship between the words "partially" and "between" with the view to demonstrate that the feature "at least partially tapered between" is supported by the application as filed, are not convincing since "between" is self-sufficient to define the position of the side edges with respect to the front and the rear trailing portions, such that the addition in claim 1 of the expression "at least partially" during the examination procedure was both superfluous and useless and just resulted in introducing an ambiguity in the subject-matter of claim 1 (see also point 3.3. thereafter).

3. Second auxiliary request - Article 123(2) and (3) EPC

With respect to the second auxiliary request the matter to consider is whether the word "between" in the characterising portion of claim 1 is properly supported by the application as filed, i.e. if it actually fits in with the embodiments shown in Fig. 6A to 6C and 7, and whether the other amendments made in the preamble by way of replacement of features are allowable.

3.1 The characterising portion of claim 1 of the second auxiliary request states: "said side edges (316, 317) of said cutting blade (310) being tapered **between** said front portion (312) and said rear trailing portion (314)".

Comparatively, claim 1 of the application as originally filed states (see feature a) iii): "a cutting blade having a pair of side edges extending and tapering

**between** said front portion and said rear trailing portion".

Despite slight differences, both wordings are similar and fairly supported by the application as filed:

First of all, generally, with reference to Fig. 6 to 8: "The cutting blade 310 comprises a front portion 312 that includes a sharp, forward cutting edge 313, a rear, trailing portion 314 having a rear edge 315, and a pair of side edges 316, 317 that extend and taper **between** the front and rear trailing portions"(see from page 18, line 33 to page 19, line 1).

Then, more specifically, according to the embodiment considered: "In one embodiment, shown in Fig. 7, the side edges 316, 317 of the improved cutting blade 310' which extend **between** the front portion 312 and rear trailing portion 314, are rounded (see page 19, lines 10-13). Further on (page 19, lines 23-30): "The cutting blade 310, 310' can be formed to have other shapes to accomplish the same goal. For example, and as illustrated in Fig. 6A to 6C, in a more preferred embodiment, the front portion 312 of the cutting blade 310 has a generally rectangular shape and the rear trailing portion 314 has a generally trapezoidal shape, such that the side edges 316, 317 thereof taper **from** a wider dimension of the front portion 312 **to** a smaller dimension in the rear trailing portion 314".

It results therefrom that the characterising features of claim 1 according to the second auxiliary request do not extend beyond the content of the application as filed.

It is true, as set forth by the appellant, that the term "between" is not to be taken here in the ordinary sense of "in an intermediate position", because there is nothing between adjacent front and rear portions. However, by putting side by side the above quoted passages, it is allowed to conclude that in the present patent "between" has the meaning of "**from ... to**" since the tapering side edges 316, 317 extend from a place of wider dimension taken on the side of the rectangular front portion 312 to a place of smaller dimension taken on the side of the trapezoidal rear trailing portion 314.

"Between" within the meaning of "**shared by**" as proposed by the appellant and supported by the Webster's Third New International Dictionary (1986) is also accepted by the Board when considering that both side edges 316, 317 extend along the outside of the cutting blade from the forward cutting edge 313 to the rear edge 315 and include each the front and the rear portions 312, 314. In this respect it should be noted that the references identifying the different portions of the cutting blade in Fig. 6 and 7 of the application are rather misleading.

- 3.2 As to the features omitted from the original claim 1 and replaced by broader features, they all refer to the blade holder defined in the preamble of claim 1.

Feature b) of the claim 1 at issue states: "a blade holder (320) being operably connected to said cutting blade (310) and structured to be operably driven by the drive means of the surgical device".



Comparatively, claim 1 of the application as filed states: "a blade holder having an underside, said underside of said blade holder secured to said cutting blade at said at least one aperture formed in said cutting blade, and a top side of said blade holder including means for being operably driven by the drive means of the surgical device".

As it can be observed, the features omitted (the cutting blade being secured to the underside of the blade holder; at least one aperture formed in said cutting blade (for securing the blade holder); a top side of said blade holder (for being driven by the drive means)) and replaced by simplified features (blade holder operably connected to said cutting blade; and operably driven by the drive means) all find a proper basis in the application as filed (see page 17, lines 29-34 with reference to Fig. 5 and 9).

Moreover, the features of claim 1 referred to above were already present with the same wording in claim 1 as granted. Within the frame of the examination proceedings, it is allowed to broaden a claim provided that its subject-matter remains within the content of the application as filed (see T 133/85, OJ 1988, 441, points 4 and 5). This condition is satisfied in the present case since the subject-matter of claim 1 as a whole ("A cutting blade assembly... comprising: a) a cutting blade... and b) a blade holder...") has not been changed and structural features of minor relevance have been replaced at the examination stage by features which, although less specific are nevertheless fairly

supported by the application as filed, as demonstrated above.

As a consequence the amendments made to claim 1 of the second auxiliary request do not contravene the requirements of Article 123(2) EPC.

- 3.3 The remaining issue is to determine whether the deletion of the expression "at least partially" with respect to the version of claim 1 as granted leads to an extension of the protection conferred, which is prohibited by Article 123(3) EPC.

As stated in point 2 above the Board agrees with the opposition division that the disputed expression is not supported by the application as filed. Moreover, "at least partially" introduces an ambiguity in claim 1 to the extent that said expression has a lower limit (at least) but no upper limit. When it tends to its indefinite upper limit, the associated expression "at least partially tapered" equates to "fully tapered", i.e. a situation which is neither covered nor intended by the application as filed, since a front portion 312 being reduced to zero is never contemplated. As its lower limit said expression simply becomes "partially tapered" as illustrated in Fig. 6B, 6C or 7, which implies that the tapered portion of the side edges 316, 317 be shared between the front portion 312 and the rear trailing portion 314. This is just the additional meaning previously given (see point 2.1.1 above) in relation to the word "between", so that the contested expression "at least partially" not only fails to bring any technical contribution to the claimed subject-matter but it also represents an unnecessary redundancy

of the word "between" within the meaning of "shared by". In this context said expression can be deleted without prejudice.

Therefore, the deletion from claim 1 as granted of the expression "at least partially" meets the requirements of Article 123(3) EPC.

4. *Remittal*

Since the decision under appeal was exclusively based on the grounds of Article 123 EPC, now removed, the Board finds it appropriate to remit the case to the first instance for further prosecution, as also requested by the appellant.

**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 claims according to the second auxiliary request filed with the appellant's letter dated 29 November 2005.

The Registrar:

The Chairman:

V. Commare

T. Kriner