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**Datasheet for the decision  
of 6 September 2010**

**Case Number:** T 0952/07 - 3.2.02

**Application Number:** 02709109.9

**Publication Number:** 1353617

**IPC:** A61F 9/007

**Language of the proceedings:** EN

**Title of invention:**

Minimally invasive glaucoma surgical instrument and method

**Applicant:**

The Regents of The University of California

**Opponent:**

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**Headword:**

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**Relevant legal provisions:**

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

EPC R. 68(2), 67

RPBA Art. 11

**Keyword:**

"Lack of reasoning (yes)"

"Procedural violation (yes)"

"Reimbursement of appeal fee (yes)"

**Decisions cited:**

T 0034/90, G 0009/91, T 0278/00, T 0897/03, T 0276/04

**Catchword:**

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Case Number: T 0952/07 - 3.2.02

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.02  
of 6 September 2010

**Appellant:** The Regents of The University of California  
12th Floor  
1111 Franklin Street  
Oakland, CA 94607-5200 (US)

**Representative:** Kazi, Ilya  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 8 December 2006  
refusing European patent application  
No. 02709109.9 pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** M. Noël  
**Members:** P. L. P. Weber  
M. J. Vogel

## Summary of Facts and Submissions

- I. The appeal is against the decision of the Examining Division posted on 8 December 2006 to refuse European patent application N° 02709109.9.
- II. On 18 August 2003 the applicant entered the regional phase before the European Patent Office as elected Office. At the same time a new set of 32 claims was filed.

Claim 1 of the set reads as follows:

"1. A device for treating glaucoma, said device comprising:  
an elongate probe having a probe tip configured to be advanced into Schlemm's canal;  
a tissue ablator for ablating the trabecular meshwork;  
and protective member for preventing damage to Schlemm's canal while removing the trabecular meshwork."

- III. The first communication of the Examining Division was issued on 25 February 2004. In this one page long communication it was simply mentioned that the objection of extension of subject-matter raised in the International Preliminary Examination Report was still applicable and that no meaningful examination was possible until this objection was overcome. The applicant was also asked whether it wished to receive an invitation under Rule 112 EPC 1973.
- IV. In its response dated 17 August 2004 the applicant explained over two pages why in its opinion the

deletion of the feature "an aspiration port in the tip of the probe tip" from the main claim was allowable as it satisfied the 3 points test required by the case law.

- V. After a telephone conversation with the primary examiner the applicant filed a further two page long response dated 8 August 2005, together with a new set of twelve claims. The applicant explained why it considered the claims to be clear and where support for the amended version could be found in the application as filed.

Claim 1 reads as follows :

"1. A device for treating glaucoma, said device comprising:  
an elongate probe (700);  
an electrical tissue ablator (730) configured to form an opening in the trabecular meshwork such that fluid may drain through said opening into Schlemm's canal;  
and  
a protector (721) configured to be advanced into Schlemm's canal, said protector being configured and positioned in relation to the electrical tissue ablator such that the protector will substantially protect cells lining the scleral wall of Schlemm's canal from being substantially damaged by energy that emanates from the electrical tissue ablator."

- VI. In a letter of 25 August 2006 the applicant was summoned to oral proceedings to be held on 21 November 2006. In the annex to the summons the Examining Division made several points.  
Under point 1 the history of the case was mentioned.

Point 3 relates to further processing of the application.

Point 2 reads as follows :

*"2. The claims presently on file relate to subject matter defined by a combination of features not present among the claims as originally filed, as a result of which still no Invitation under Rule 112 can be meaningfully issued. No electrical ablation probe with protector was originally claimed.*

*2.1. Furthermore, the claims presently on file relate to unsearched subject matter not combining with the claims as searched to form a single general inventive concept, contrary to Rule 86(4) EPC.*

*2.2. Furthermore, the claims presently on file relate to subject matter extending beyond the original disclosure in that no support is found for an electrical ablation probe with a protector in general.*

*2.3. Claim 1 as searched relates to a laser ablation probe with an aspiration port. Other independent claims were only searched to the extent that they also fell within the first subject invention, ie with laser ablation. Present claim 1 relates to a electrical ablation probe with no aspiration port being necessarily present, but with a protector not further defined in terms of technical features.*

*2.4. The applicant states that the claims presently on file find support in the description of figures 7,8 on pp.12-14. This device is described as a "Goniectomy*

*cauterisation probe', although not claimed as such. Further, the footplate 721 is stated to protect the collector channels, but it is not stated from what they are protected."*

VII. In its six pages long response of 20 October 2006 the applicant re-explained why it considered that the set of claims according to the main request was considered allowable and explicitly requested that the Examining Division review the objections and grant a patent on the basis of the claims on file, since the basis for the removed feature and the basis for the protector feature had been given.

In case the main request could not be granted, the applicant filed eight auxiliary requests.

VIII. In a letter dated 20 November 2006, the applicant informed the Examining Division that, after a conversation with the primary examiner, it would not take part in the oral proceedings and it requested a written decision on the state of the file.

IX. The decision to refuse the application dated 8 December 2006 contains the following reasoning:

*"In the communication(s) dated 25.08.2006 the appellant was informed that the application does not meet the requirements of the European Patent Convention. The appellant was also informed of the reasons therein.*

*The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on 20.11.2006.*

*The application must therefore be refused."*

- X. Notice of appeal was filed on 19 February 2007 and the fee paid on the same day. The statement of the grounds of appeal was filed on 18 April 2007.
  
- XI. In its statement setting out the grounds of appeal the appellant submitted that there had been a substantial procedural violation in that the decision under appeal did not provide adequate reasons for the decision. While the appellant presented detailed arguments as to why it considered the set of claims on file allowable, the decision under appeal did not give any reason as to why the Examining Division was not convinced.
  
- XII. The appellant requests the decision to be set aside and a patent to be granted on the basis of the claims according to the main request or one of auxiliary requests 1 to 8.

The appellant further requests reimbursement of the appeal fee owing to a substantial procedural violation.

The appellant further requests that if the Board is unable to grant a patent the case be remitted to the Examining Division to perform substantive examination, or, if appropriate, to request a further search under Rule 112 EPC 1973, so that the applicant is not deprived of an instance.

## Reasons for the Decision

1. The appeal is admissible.
2. Pursuant to Article 106(1) EPC 1973 an appeal shall lie from the decisions of the examining divisions. According to Rule 68(2) EPC 1973 the decisions of the European Patent Office open to appeal shall be reasoned.
3. The function of appeal proceedings is to give a judicial decision upon the correctness of a separate earlier decision taken by a first instance department (see inter alia T 34/90 (OJ 1992, 454) and G 9/91 (OJ 1993, 408)). A reasoned decision issued by the first instance department meeting the requirements of Rule 68(2) EPC 1973 is accordingly a prerequisite for the examination of the appeal.

It is established jurisprudence of the boards of appeal that for this requirement to be fulfilled the decision must include, in logical sequence, the arguments justifying the order. The grounds upon which a decision is based and all decisive considerations in respect of the factual and legal aspects of the case must be discussed in detail in the decision (see inter alia T 278/00, OJ 2003, 546).

In the present case the Examining Division refused the application using EPO form 2061 for a so-called "decision on the state of the file".

This standard form is entirely appropriate in the special case where the examining division has fully expressed and reasoned its objections to the current



application text in the preceding communication(s), taking into account the applicant's submissions, and the applicant has not presented further counter-arguments or new requests before the decision is taken.

In a number of decisions, the boards of appeal of the European Patent Office have pointed out that, where a decision only refers to one or several previous communications, leaving it to the board of appeal and the appellant to speculate as to which of the reasons given by the examining division might be essential to the decision of refusal does not meet the requirement imposed by Rule 68(2) EPC 1973 (see T 897/03, T 276/04) that decisions which are open to appeal shall be reasoned.

These requirements obviously aim at allowing the losing party to understand the reasons for the negative decision taken against it so that it can envisage the filing of an appeal. The same is true for the board of appeal which may have to deal with the appeal and has to understand why the first instance took the impugned decision.

It should be noted that a request for a decision based on the current state of the file does not mean that the party gives up its right to a reasoned decision. It simply means that the party does not wish to further comment on the case. The instances of the European Patent Office cannot omit to give reasons for their decisions when the EPC so requires.

4. In the present case, the impugned decision refers solely to the communication of 25 August 2006, an annex to the summons to attend oral proceedings.  
As can be seen from point VI above, in this annex only points 2, 2.1, 2.2, 2.3 and 2.4 comment on the claims on file and can be considered to potentially address a requirement of the EPC.
- 4.1 Point 2 explains that, the claims on file not being combinations of features present among the claims as originally filed, no invitation under Rule 112 EPC 1973 can be issued. Rule 112 EPC 1973 being concerned with additional search fees possibly having to be paid because of a lack of unity objection in the set of claims as originally filed, it is not seen how the impossibility to write an invitation under this rule could lead to the refusal of the application, as the amended claims can be based on the searched claims. In any case there is no explanation whatsoever in this regard in this paragraph.
- 4.2 Point 2.1 explains that the claims on file relate to unsearched subject-matter not combining with the claims as searched to form a single general inventive concept, contrary to Rule 86(4) EPC 1973.  
This paragraph is obviously a simple statement, without any explanation as to why the subject-matter of the claims on file does not form a single general inventive concept with the searched claims. There is no indication as to which features or claims fall under this objection and why they do not satisfy the requirement of Rule 86(4) EPC 1973.

4.3 Point 2.2 explains that the claims extend beyond the original disclosure, as no support is found for an electrical ablation probe with a protector in general. Here again there is no explanation whatsoever as to why no basis for a "protector in general" can be found in the application as filed and as to why the arguments presented in this regard by the applicant cannot be accepted.

Even when the file history is consulted, this objection is not understandable. When entering the regional phase the applicant filed a claim 1 with, as the last feature, *"protective member for preventing damage to Schlemm's canal while removing the trabecular meshwork."* In claim 1 as filed on 8 August 2005 (corresponding to the main request) this feature read: *"a protector (721) configured to be advanced into Schlemm's canal, said protector being configured and positioned in relation to the electrical tissue ablator such that the protector will substantially protect cells lining the scleral wall of Schlemm's canal from being substantially damaged by energy that emanates from the electric tissue ablator."*

It is therefore clear that the definition of the protector has been rendered substantially more specific and the Examining Division does not give any explanation whatsoever as to why it considers that this definition would not be supported by the originally filed application.

4.4 It is not clear what kind of objection is addressed in point 2.3. A comparison seems to be made between searched claim 1 and claim 1 on file, the latter not having the aspiration port but with a protector not

being further defined. No conclusion whatsoever is drawn from this statement.

The same is true in relation to point 2.4 which seems to imply that the Examining Division does not agree with the applicant as to what could be the basis for the amendments, but no explanation is given.

- 4.5 It might be that the Examining Division had the intention to give more detailed reasons to the applicant during the oral proceedings but, the oral proceedings not having taken place, a simple reference in the decision to such vague and incomplete statements cannot be considered as valid reasoning pursuant to Rule 68(2) EPC 1973.
  
5. In addition, it is clear that the statement of the Examining Division in the appealed decision that no comments or amendments had been filed by the appellant in reply to the last communication is not correct and clearly indicates that the Examining Division considered neither the appellant's arguments nor the auxiliary requests filed with its last reply of 20 October 2006.
  
6. This is at odds with the established jurisprudence of the boards of appeal already mentioned in point 3 above, namely that for the requirements of Rule 68(2) EPC 1973 to be fulfilled the decision must include, in logical sequence, the arguments justifying the order and that the grounds upon which the decision is based and all decisive considerations in respect of the factual and legal aspects of the case must be discussed in detail in the decision. The applicant's request "to have a

written decision on the state of the file" is not to be construed as a waiver of the right to a fully reasoned first instance decision. In view of this and of the fact that additional arguments and several auxiliary requests were filed, the Board is of the opinion that a decision on a standard form, simply referring to a previous communication for its grounds, was not appropriate in the present case. Instead, in its decision, the Examining Division should have explained the reason or reasons for its decision, why the counter arguments of the applicant were not considered convincing and why the auxiliary requests were not acceptable.

By failing to do so, the Examining Division did not issue a reasoned decision within the meaning of Rule 68(2) EPC 1973 and, therefore, committed a substantial procedural violation.

*Remittal to the first instance*

7. Pursuant to Article 11 of the Rules of Procedure of the Boards of Appeal, when fundamental deficiencies are apparent in the first instance proceedings, the case is remitted to the first instance for further prosecution.

In the present case the first instance proceedings at least infringed Rule 68(2) EPC 1973, and no special reasons being present in the file or having been mentioned by the appellant for doing otherwise, the remittal is justified.

*Reimbursement of the appeal fee (Rule 67 EPC 1973)*

8. The appeal is allowed insofar as the decision under appeal is set aside. Since the decision of the first instance clearly contravened Rule 68(2) EPC 1973, and the appellant had to appeal in order to obtain a fully reasoned decision, it is equitable to reimburse the appeal fee pursuant to Rule 67 EPC 1973.

**Order**

**For these reasons it is decided that:**

1. The impugned decision is set aside.
2. The case is remitted to the first instance for further prosecution.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:

D. Sauter

M. Noël