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**Datasheet for the decision  
of 20 March 2009**

**Case Number:** T 1870/07 - 3.2.02

**Application Number:** 02725768.2

**Publication Number:** 1389968

**IPC:** A61B 18/18

**Language of the proceedings:** EN

**Title of invention:**

Method and apparatus for treating presbyopia

**Applicant:**

High Power Peripheral Cornea Corp., S.A.

**Opponent:**

-

**Headword:**

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**Relevant legal provisions:**

EPC R. 103

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

EPC Art. 52(1), 54, 96(2), 113(1)

EPC R. 51(3)

RPBA Art. 11

**Keyword:**

"Substantial procedural violation (yes)"

"Reimbursement of the appeal fee (yes)"

**Decisions cited:**

T 0951/92

**Catchword:**

-



Case Number: T 1870/07 - 3.2.02

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.02  
of 20 March 2009

**Appellant:** High Power Peripheral Cornea Corp., S.A.  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 11 April 2007  
refusing European application No. 02725768.2  
pursuant to Article 97(1) EPC 1973.

**Composition of the Board:**

**Chairman:** M. Noel  
**Members:** S. Chowdhury  
A. Pignatelli

## Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division dated 11 April 2007 to refuse European patent application No. 02 725 768.2.
- II. The application, claiming the priority of a US application, was filed as an international application and, following an International Search Report (ISR) established by the USPTO, was published under the number WO 02/085231. The application as filed and published included 22 claims, including method claims 1 to 16 and apparatus claims 17 to 22.
- III. Subsequently an International Preliminary Examination Report (IPER) was drawn up by the USPTO, acting as International Preliminary Examining Authority. In the IPER an objection of lack of novelty was raised against all 22 claims on the basis of the solitary document cited in the ISR. The IPER included a statement given in full below without amendment:-

"2. Citations and explanations (Rule 70.7)

Claims 1-22 lack novelty under PCT Article 33(2) as being anticipated by Swinger US Pat. No. 5,647,865.

Swinger discloses a surgical laser and methods for forming a peripheral zone in a cornea having a refractive disorder to provide corrected near vision for a presbyopic patient, while controlling the energy flux, beam diameter, and the exposure time of the treatment. See the abstract; Col. 7, lines 10-20; and Col. 8, lines 30-34.

In reference to claims 2-5, 8, 9, and 18 he teaches that the diameter of the ablation varies depending on the procedure being performed, but it is usually greater in diameter than the critical central optically used zone of the cornea, which is typically in the range of 5-8 mm (see Col. 4, lines 52-57)".

IV. The application then entered the regional phase, in which the applicant limited the claims to apparatus claims 1 to 6 only, corresponding to original claims 17 to 22.

An official communication was issued by the examining division, which referred to the Swinger patent mentioned above as D1 and two further documents D2 (WO-A-0 027 324) and D3 (US-A-5 395 356) which were cited in the European Search Report. The communication went on to raise the objection of lack of novelty against all the claims, in the following terms:-

"The presently claimed subject matter has been made the subject of an International Preliminary Examination Report, and the present examining division is in general in agreement with the objections raised therein.

Furthermore similar objections as to lack of novelty of the subject matter at least of claims 1 ,3-6 and including part of the range of claim 2 can be made based on each prior art document mentioned in the European Supplementary Search Report, considering that the apparatus explicitly or implicitly disclosed in each of these documents is suitable for use as in the present claims.

See in this regard in particular D2 and D3, and most in particular the passages cited in the Supplementary Search Report.

Since the present invention in essence relates to possibly inventive use of known apparatus for eye surgery (see present p. 8/1.16-19), such use not involving technical modification of the device itself and being subject matter excluded from patentability under Article 52(4) EPC, a successful outcome of the present application is not anticipated."

V. In response to this communication the applicant filed a revised set of claims numbered 1 to 5. It was argued that the revised claims related to subject-matter which was novel and inventive.

VI. The examining division thereafter refused the application for lack of novelty, based on the disclosure of the documents D1 to D3.

VII. The reasons for the decision are given in full below without amendment:

"It is noted that present claim 1 corresponds in general to claims 17,18 as originally filed, and claims 2-6 correspond in general to claims 19-22 as originally filed.

It is further noted that for the requirement of Article 54 EPC to be met the subject matter of a claim must be clearly distinguished by technical features from the prior art.

The present application does not meet the requirements of Article 84 EPC since claim 1 is not clear, as it is not specified that the dimensions 5.5 mm, 10 mm are diameters rather than area. This objection could have been obviated within the requirements of Article 123(2) EPC by reference to Figure 2A.

The subject matter of claim 1 lacks novelty over each of D1 -D3 in the meaning of Article 54 EPC, as a result of which the requirements of Article 52 EPC are not met, since the device of claim 1 is not distinguished by technical features from the prior art of D1, D2 or D3.

In particular, considering that the presence of present claims 3-5 dictates against the interpretation of claim 1 as implying that the correction is only within the specified region, any device capable of being used to perform the present method deprives the subject matter of claim 1 of novelty. The present application mentions at p.8/1.18,19 a number of devices that can be so used, including a "laser sight" device. A "Lasersight" device is mentioned in D2 as being a "flying spot" preferred device for ablating in a way which may be determined by the user for correcting presbyopia as desired for the treatment, and the treatment area envisaged in D2 extends to a 10.5 mm diameter.

The dependent claims define their subject matter in terms of further surgical steps which are or are not taken during the operation, again without demanding any technical limitation on the claimed device.

The present application relates in fact to a possibly novel and inventive use of known apparatus, such use being excluded from patentability under Article 52(4) EPC".

VIII. On 14 June 2007 the appellant lodged an appeal against the decision and paid the prescribed fee on the same day. On 16 August 2007 a statement of grounds of appeal was filed.

The appellant requests that the decision be set aside and a patent be granted on the basis of claims 1 to 5 filed on 23 January 2007.

IX. Independent claim 1 refused by the examining division reads as follows:

"An apparatus for treating a patient's eye for near vision deficiency comprising; a laser beam generator; an optical network adapted to deliver a laser beam from said laser beam generator to the eye of the patient; and a controller coupled to said optical network and said laser beam generator and adapted to provide a peripheral ablation on a peripheral portion of the cornea to increase the dioptic power of said peripheral portion thereby correcting the eye for the near vision deficiency, wherein said controller is adapted to deliver said peripheral zone of the cornea within an area between 5.5 and 10 mm".

## Reasons for the Decision

1. The appeal is admissible.
2. The appeal is allowable because, from the brief passages of D1 which were cited during the examination procedure, it is apparent that D1 does not disclose the claimed subject-matter.

The essence of the invention as claimed in the present application is that laser treatment should not be applied to the central zone of the cornea but to its outer peripheral zone (see claim 1, the opening paragraph of WO 02/085231, page 6, lines 14 to 17, and Figure 2A, for example). Thus the controller shapes the laser beam to provide an annular beam of light.

By contrast, D1 teaches removing a central portion of the corneal disc, as clearly stated in the abstract, in the description (for example, column 4, lines 31 to 35), and illustrated in the Figures. This implies a controller for providing an axial laser beam. Therefore, the claimed apparatus is manifestly different from the apparatus of D1. Thus, the decision of the first instance must be set aside.

3. Fundamental deficiencies are apparent in the first instance proceedings, as explained in the following:

Article 113(1) EPC 1973 states that the decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.



3.1 The grounds for a decision normally consist of

i) the establishment of facts on the basis of the submissions of the parties, the taking of evidence and ex officio examination if necessary,

ii) the choice of the relevant provisions,

iii) the legal evaluation of the facts, i.e. the logical process according to which the facts are considered to fulfil the requirements of a provision, and

iv) the application of the legal consequence foreseen by the applied provision.

In order to be able to properly comment on the reasons for the decision, the party needs to know which facts are considered to be established, on which basis, which legal provisions are applied, and the logical process according to which the facts are considered to fulfil the requirement of the applied provision. All these together constitute the logical chain on which the decision is based, i.e. the reasons for the decision (see, for example, T 0951/92).

3.2 In the context of the examination procedure, Article 113(1) together with Article 96(2) and Rule 51(3) EPC 1973 aim at giving the applicant, before a decision is taken, the possibility of knowing on which legal and factual reasons the decision will be taken and to comment and amend his case correspondently, by imposing the duty on the examining division to send a reasoned communication as often as necessary.

- 3.3 In the present case, an IPER was sent, a communication of the examining division followed, and then the decision was taken.

The single communication from the examining division pursuant to Article 96(2) EPC 1973 merely signalled agreement with the IPER, indicating lack of novelty with respect to D1, and further cited D2 and D3, merely referring to passages thereof cited in the European Search Report without further explanation or amplification. No further objections were raised in that communication.

- 3.4 The Board sees no objection to citing an IPER from an International Preliminary Examining Authority other than the EPO (in the present case the USPTO), provided that it constitutes a reasoned statement according to the criteria described above. The requirement that a communication should be sent as often as necessary does not mean that once a communication fulfils the criteria cited above it is necessary to give the applicant another opportunity to comment on the same reason.

However, in the present case in the Board's view the IPER fails to meet the above cited requirements of a reasoned statement.

In the case of a novelty objection this will require the analysis of the claims in order to establish their meaning, the analysis of one or more prior art documents and the explanation of the logical process according to which the content of the prior art is considered to disclose the claimed subject-matter in a

way that leads to the application of the consequences of the provisions on novelty.

The IPER does little more than identify a document and cite four passages from it, which are said to render all the subject-matter of the claims lacking in novelty without explaining the logical chain leading to this conclusion. Even by careful analysis on the part of the reader an argument to be answered cannot be constructed because, from the brief passages of D1 cited, it is apparent that D1 does not, in fact, disclose the claimed subject-matter.

- 3.5 Since the IPER does not fulfil the requirements of a reasoned communication, it behoves the EPO to perform its own analysis of the prior art and present the legal and factual reasons as defined above, and give reasons why there are objections to the grant of a patent, instead of relying on the IPER.

In the communication of the examining division, there is no logical chain of reasoning which would have permitted the appellant to understand and deal with the novelty objection, either by amendment or counter-argument. Article 113(1) EPC 1973 is, therefore, not satisfied.

Thus, a substantial procedural violation has occurred.

- 3.6 In addition, the impugned decision is based on legal and factual reasons which were not mentioned in the communication and which were presented for the first time to the applicant, who has had no opportunity to comment on them or to produce counter-arguments.

The decision states, for the first time during the examination procedure, that claim 1 is not clear, and goes on to state that the presence of claim 3-5 dictates against the interpretation of claim 1 as implying that the correction is only within the specified region, and then argues why D2 anticipates the claimed device. Despite the statement at the end of the impugned decision, that Article 84 EPC 1973 did not contribute to the decision to refuse, this ground did play a role because claim 1 was given a particular interpretation under Article 84 EPC 1973.

Moreover, the decision states that D2 mentions a Lasersight device as a flying spot device preferred for ablating in a way which may be determined by the user for correcting presbyopia as desired for the treatment, and the treatment area envisaged in D2 extends to 10.5 mm diameter. This represents a new line of argumentation.

Since these are new reasons which were never communicated to the party before the decision was issued, Article 113(1) EPC 1973 is violated also in these respects, and these are further instances of substantial procedural violation.

4. In the circumstances of the case, the Board remits the case to the department of first instance for a full substantive examination on the basis of the EPC under Article 11 RPBA. In order to guarantee a fair conduct of the further proceedings a different composition of the examining division might be considered by the first

instance, and the examining division should also consider giving this case priority treatment.

5. Since the applicant's right to be heard has been violated and substantial procedural violations have been committed, the Board considers it equitable to refund the appeal fee in accordance with Rule 103 EPC.

## **ORDER**

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

1. The decision under appeal is set aside
2. The case is remitted to the department of first instance for further prosecution
3. The appeal fee is refunded.

The Registrar

The Chairman

D. Sauter

M. Noel