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**Datasheet for the decision
of 1 March 2011**

Case Number: T 1920/08 - 3.2.02

Application Number: 04102979.4

Publication Number: 1506757

IPC: A61F 9/00

Language of the proceedings: EN

Title of invention:

Tip assembly

Applicant:

Alcon, Inc.

Opponent:

-

Headword:

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Relevant legal provisions:

EPC Art. 123(2), 83, 84, 56

Relevant legal provisions (EPC 1973):

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Keyword:

"Extended subject-matter (no)"

"Sufficient disclosure (yes)"

"Clarity (yes)"

"Inventive step (yes)"

Decisions cited:

T 0331/87

Catchword:

-



Case Number: T 1920/08 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 1 March 2011

Appellant: Alcon, Inc.
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Bösch 69
CH-6331 Hünenberg (CH)

Representative: Moore, Barry
Hanna Moore & Curley
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Dublin 2 (IE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 24 April 2008
refusing European patent application
No. 04102979.4 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: D. Valle
Members: C. Körber
J. Geschwind

Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal on 17 June 2008 against the decision of the examining division posted on 24 April 2008 to refuse the application. The fee for the appeal was paid on the same day and the statement setting out the grounds for appeal was received on 21 August 2008.
- II. Following a communication of the Board dated 13 January 2011, the Appellant filed with letter of 1 February 2011 a new amended version of the application.
- III. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of:

Claims: 1 to 5, and

Description: pages 1 - 3, and

Drawings: one figure,

as filed with letter of 1 February 2011.

- IV. Following documents are relevant for the decision:

D1 = US - A - 5 616 120

D3 = US - A - 4 674 502.

- V. Claim 1 of the main request reads as follows:

"An assembly for connecting a tip to a liquefaction handpiece, comprising:

a) a generally hollow outer cap (12) adapted to be screw-fitted to the handpiece;

b) an inner connector (14) that is adapted to be received and retained in the outer cap so as to allow rotational movement of the inner connector within the outer cap,
the inner connector having:
an alignment tab (22);
a first bore (28) adapted to receive an outer tube (26) of the tip, and an inner tube (24) that telescopically fits within the outer tube (26);
a second bore (15) adapted to permit cooled or ambient irrigation fluid to pass through connector (14); and
a third bore (36) adapted to fluidly communicate with the first bore (28) and the interior of the outer tube (26)."

VI. The appellant argued essentially that the application complied with Article 123 (2) EPC and contained sufficient pieces of information in order to carry out the invention as claimed. The application was also clear and the subject-matter of claim 1 involved an inventive step.

Reasons for the Decision

1. The appeal is admissible.
2. *Article 123 (2) EPC*

Claim 1 claims an assembly made of a cap and a connector for connecting a tip to a handpiece. The tubes do not belong to the claimed invention.

Contrary to the finding of the decision under appeal, the claim is supported by the original description, page 2, lines 29 and 30 where it is said that the assembly of the present invention generally includes outer cap 12 and inner connector 14. The tubes are not mentioned in this passage. Certainly, the original claim is of narrower scope, comprising also the tubes, but for the determination whether an amendment of a claim does or does not extend beyond the subject-matter of the application as filed, it is necessary to examine if the overall change in the content of the application originating from this amendment (whether by way of addition, alteration or excision) results in the skilled person being presented with information which is not directly and unambiguously derivable from that previously presented by the application, even when account is taken of matter which is implicit to a person skilled in the art in what has been expressly mentioned. In other words, it is to examine whether the claim as amended is supported by the description as filed (see T331/87, OJ 1331, 22). In this case the amendments to the claims are clearly supported by the original description. Furthermore, the tubes are not explained as essential in the disclosure, not indispensable for the function of the invention, and the deletion of them from claim 1 does not require substantial modification of other features to compensate for the change. Consequently, their removal from original claim 1 is not in breach of Art. 123(2) EPC.

Article 83 EPC

The decision under appeal found that it was not clear where the second bore 15 ended at the distal end of the connector. This however is not relevant for the question of feasibility. The bore should merely, according to the claim, permit ambient or irrigation fluid to pass through the connector 14. The person skilled in the art will find no difficulty to make such connection. He would be able to design a connector having a bore fulfilling this function without being told exactly where the bore has to exit the connector.

The same considerations apply for the third bore 36. In order to carry out the invention, the person skilled in the art does not need to know exactly how to join the bore to the interior of the outer tube in order to establish fluid communication therewith. It belongs to the common knowledge of the skilled person in the field of hydraulics to know how to realize a fluid communication between two points.

Article 84 EPC

Claim 1 as amended is also clear. The functional features relating to the bores are self-explaining.

Inventive step

D1, considered the closest prior art, discloses an assembly comprising those features of claim 1 which are acknowledged in the fifth paragraph of page 1 of the description of the present application. However, the

handpiece described in this document has no disconnectable tip assembly at all.

In particular, D1 fails to disclose a connector comprising:

- (a) a generally hollow outer cap (12) adapted to be screw-fitted to the handpiece;
- (b) an inner connector (14) that is adapted to be received and retained in the outer cap so as to allow rotational movement of the inner connector within the outer cap, the inner connector having:
 - an alignment tab (22);
 - a first bore (28) adapted to receive an outer tube (26) of the tip, and an inner tube (24) that telescopically fits within the outer tube (26);
 - a second bore (15) adapted to permit cooled or ambient irrigation fluid to pass through connector (14); and
 - a third bore (36) adapted to fluidly communicate with the first bore (28) and the interior of the outer tube (26).

The purpose of the invention is therefore to be seen in an improvement of the known device, in particular in providing a connector which is detachable, so that the handpiece can be used with a removable or interchangeable tip.

D3 discloses a generally hollow cap (110) adapted to be press-fitted to the handpiece (102).

However, neither D3 nor any other document of the prior art discloses the further distinguishing features of the invention, that is:

an outer cap adapted to be screw-fitted to the handpiece;

an inner connector (14) that is adapted to be received and retained in the outer cap so as to allow rotational movement of the inner connector within the outer cap, the inner connector having:

an alignment tab (22);

a first bore (28) adapted to receive an outer tube (26) of the tip, and an inner tube (24) that telescopically fits within the outer tube (26);

a second bore (15) adapted to permit cooled or ambient irrigation fluid to pass through connector (14); and

a third bore (36) adapted to fluidly communicate with the first bore (28) and the interior of the outer tube (26).

The prior art cited does not teach or suggest a connection assembly for use between a liquefaction handpiece and a concentric tubular tip arrangement, in which the connection permits screw-threaded connection and disconnection whilst permitting the fluid intercommunication of three separate conduits, as required for the liquefaction technique.

Therefore, the subject-matter of claim 1 involves an inventive step.

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 with the order to grant a patent on the basis of the following version:

- Claims: 1 to 5,
- Description: pages 1 to 3, and
- Drawings: one figure,

as filed with letter of 1 February 2011.

The Registrar:

The Chairman:

D. Sauter

D. Valle