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**Datasheet for the decision  
of 19 January 2012**

**Case Number:** T 1347/10 - 3.2.08  
**Application Number:** 00977422.5  
**Publication Number:** 1221922  
**IPC:** A61F 9/01, A61B 3/103  
**Language of the proceedings:** EN

**Title of invention:**  
Iris recognition and tracking for optical treatment

**Patent Proprietor:**  
Bausch & Lomb Incorporated

**Opponents:**  
AMO Manufacturing USA, LLC  
SensoMotoric Instruments GmbH

**Headword:**

-

**Relevant legal provisions:**  
RPBA Art. 13(1)

**Relevant legal provisions (EPC 1973):**  
EPC Art. 100(c), 114(2)

**Keyword:**  
"Added subject-matter (yes; Main request and alternative requests 1, 1A, 2, 3)"  
"Late-filed request (not admitted)"

**Decisions cited:**

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**Catchword:**

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Case Number: T 1347/10 - 3.2.08

**DECISION**  
of the Technical Board of Appeal 3.2.08  
of 19 January 2012

**Appellant:** Bausch & Lomb Incorporated  
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**Representative:** Vossius & Partner  
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**Respondent I:** AMO Manufacturing USA, LLC  
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**Representative:** Kazi, Ilya  
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**Respondent II:** SensoMotoric Instruments GmbH  
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**Representative:** Schöniger, Franz-Josef  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 8 April 2010  
revoking European patent No. 1221922 pursuant  
to Article 101(3)(b) EPC.

**Composition of the Board:**

**Chairman:** T. Kriner  
**Members:** M. Alvazzi Delfrate  
U. Tronser

## Summary of Facts and Submissions

- I. By decision posted on 8 April 2010 the opposition division revoked European Patent No. 1 221 922. The opposition division held that none of the requests then on file met the requirements of Article 123(2) EPC.
- II. The appellant (patent proprietor) lodged an appeal against this decision on 16 June 2010, paying the appeal fee on the same day. The statement setting out the grounds for appeal was filed on 18 August 2010.
- III. The appellant requests that the decision under appeal be set aside and the oppositions be rejected or alternatively that the patent be maintained on the basis of one of the alternative requests 1, 1A, 2 or 3 submitted during the oral proceedings before the opposition division or on the basis of alternative request 4 submitted during the oral proceedings before the board of appeal.
- IV. The respondents (opponents 1 and 2) request that the appeal be dismissed
- V. Claim 1 of the patent as granted (main request) reads as follows:

"A system for aligning refractive diagnostic and/or treatment data, comprising:

means (104) receiving first ophthalmic alignment data being maintained as a reference for first refractive diagnostic or treatment data for associating the first refractive diagnostic or treatment data with second

refractive diagnostic or treatment data by aligning the first alignment data with second alignment data, and

an ophthalmic diagnostic or refractive tool (100; 102; 106), employing the second refractive data, the ophthalmic diagnostic or refractive tool being adapted to capture the second ophthalmic alignment data as a reference for the second refractive data, wherein the first and second alignment data are both one of the following: iris data; or iris outline plus rotational marker data."

Claim 1 of the alternative request 1 differs from claim 1 as granted by the addition of the feature according to which the system comprises:

"a first ophthalmic diagnostic or refractive tool (100; 102; 106) employing first refractive data, the first ophthalmic diagnostic or refractive tool being adapted to capture first ophthalmic alignment data and maintain that data as a reference for the first refractive data".

Moreover, the ophthalmic diagnostic or refractive tool employing the second refractive data and being adapted to capture the second ophthalmic alignment is referred to as "second ophthalmic diagnostic or refractive tool".

Claim 1 of the alternative request 1A is identical to claim 1 of the alternative request 1.

Claim 1 of the alternative request 2 corresponds to that of the main request except for the deletion of the wording

"or iris outline plus rotational marker data".

Claim 1 of the alternative request 3 differs from claim 1 as granted by the addition of the feature according to which the system comprises:

"a first ophthalmic diagnostic or refractive tool (100; 102; 106) employing first refractive data, the first ophthalmic diagnostic or refractive tool being adapted to capture first ophthalmic alignment data and maintain that data as a reference for the first refractive data"

and the deletion of the wording

"or iris outline plus rotational marker data".

Claim 1 of the alternative request 4 reads as follows:

"A system for aligning refractive diagnostic and treatment data, comprising:

means (104) receiving first ophthalmic alignment data being maintained as a reference for first refractive diagnostic data for associating the first refractive diagnostic data with second refractive treatment data by aligning the first alignment data with second alignment data, and

an ophthalmic refractive tool (106), employing the second refractive data, the ophthalmic refractive tool

being adapted to capture the second ophthalmic alignment data as a reference for the second refractive data, wherein the first and second alignment data are both one of the following: iris data; or iris outline plus rotational marker data."

VI. The arguments of the respondents relevant to the present decision can be summarised as follows:

The combination of features of claim 1 as granted could not be found in the application as originally filed. Present claim 1 exhibited several differences in respect of claim 56 as originally filed, which had been indicated as a basis for this claim. The feature of claim 56 according to which the means associating the first refractive data with the second refractive data by aligning the first and second alignment data had been replaced in present claim 1 by means receiving first ophthalmic alignment data. The first ophthalmic diagnostic or refractive tool had been omitted, and the claim was now directed to a system for aligning refractive diagnostic and/or treatment data instead of a system for aligning refractive diagnostic and treatment data. Since none of these amendments had a basis in the application as originally filed, they were not allowable.

The alternative requests 1, 1A, 2 and 3 were not allowable for the same reasons, as well.

As to the alternative request 4, it had been filed at an extremely late stage of the proceedings without any good reason. Moreover, it was prima facie also not

allowable. Therefore, it should not be admitted into the proceedings.

VII. The arguments of the appellant relevant to the present decision can be summarised as follows:

Claim 1 of the patent as granted was essentially based on claim 56 of the application as originally filed. Both claims related to a system comprising means for associating the first refractive data with the second refractive data by aligning the first alignment data with the second alignment data, for instance in the form of a computational unit. While the wording of originally filed claim 56 referred exclusively to means for associating the first refractive data with second refractive data, claim 1 as granted referred to means for receiving first ophthalmic alignment data and for associating the first refractive data with the second refractive data. In both claims said means could be in form of a computational unit and inevitably had to receive first ophthalmic alignment data to perform their function. This function, which was inherent in the means described in originally filed claim 56, was explicitly disclosed in present claim 1. Hence, the system of present claim 1 comprised the same means as the system of originally filed claim 56.

As to the fact that the system of present claim 1 was for aligning refractive diagnostic and/or treatment data, these alternatives were directly derivable from the wording of originally filed claim 56.

It was true that claim 1 as granted mentioned only one diagnostic or refractive tool while claim 56 as

originally filed mentioned two of them. However, this amendment was supported by claim 46 or claim 51 as originally filed.

Therefore, claim 1 as granted did not extend beyond the content of the application as originally filed. The same applied to claim 1 of the alternative requests 1, 1A, 2 and 3.

Alternative request 4 had been filed as a reaction to the discussion during the oral proceedings concerning the feature that the claimed system was for aligning refractive diagnostic and/or treatment data. Moreover, claim 1 of this request did not comprise any new feature but was merely restricted to one of the alternatives of claim 1 as granted. Therefore, this request should be admitted into the proceedings.

### **Reasons for the Decision**

1. The appeal is admissible.
2. Main request

According to the appellant claim 1 is mainly based on claim 56 of the application as originally filed. However, the latter claim is directed to a system comprising means for associating the first refractive data with the second refractive data by aligning the first alignment data with the second alignment data. It is true that present claim 1 comprises the wording "... for associating the first refractive diagnostic or treatment data with second refractive diagnostic or treatment data by



aligning the first alignment data with second alignment data". However, this wording has to be read in conjunction with the complete feature in which it is cited. According to this feature the system comprises means receiving first ophthalmic alignment data being maintained as a reference for first refractive diagnostic or treatment data for associating the first refractive diagnostic or treatment data with second refractive diagnostic or treatment data by aligning the first alignment data with second alignment data. This does not necessarily signify that said means are actually capable of performing the function of associating the first refractive data with the second refractive data by aligning the first and second alignment data. On the contrary, the claim's wording can be understood as to indicate that the first ophthalmic alignment data are intended to be used as a reference for first refractive diagnostic or treatment data for associating the first refractive diagnostic or treatment data with second refractive diagnostic or treatment data, while being silent as to when and how this association is actually performed. Hence, it is possible to construe claim 1 as directed to a system comprising means receiving first ophthalmic alignment data, which replace the means for associating the first refractive data with the second refractive data by aligning the first alignment data with the second alignment data, as defined in originally filed claim 56.

No basis can be found in the application as originally filed for this amendment. In particular both claims 46 and 51, which have been mentioned by the appellant, relate to specific systems different from the very general system of present claim 1 and which comprise

means actually performing an alignment of data, i.e. the control system of claim 46 and the means for aligning the refractive correction instrument with the patient eye in claim 51.

Accordingly, even if claim 1 could be interpreted as suggested by the appellant, i.e. that the claimed system comprised means for receiving and for associating first refractive data with second refractive data, it is also possible to interpret it in at least one way which extends beyond the content of the application as originally filed. Therefore, the main request cannot be allowed on the grounds of Article 100(c) EPC 1973 alone for this reason.

3. Alternative requests 1, 1A, 2 and 3.

The objection above applies also to each of the alternative requests 1, 1A, 2 and 3.

4. Alternative request 4

According to Article 114(2) EPC 1973, Article 13(1) of the Rules of Procedure of the Boards of Appeal (OJ EPO 11/2011, page 536), any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion. That discretion is to be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

In the present case, alternative request 4 was filed at a very late stage of the proceedings, namely towards

the end of the oral proceedings. The need for procedural economy requires that a request filed at such a late stage be admitted only if it at least complies without doubt with the formal requirements of the EPC and constitutes a promising attempt to counter the objections raised.

Claim 1 of alternative request 4 is still directed to a system comprising means receiving first ophthalmic alignment data being maintained as a reference for first refractive diagnostic data for associating the first refractive diagnostic data with second refractive treatment data. Hence, it cannot constitute a promising attempt to counter the objection raised against the requests already on file and is considered to be prima facie not allowable. Therefore, this request was not admitted into the proceedings.

## **Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

V. Commare

T. Kriner