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**Datasheet for the decision
of 25 January 2022**

Case Number: T 1851/17 - 3.2.02

Application Number: 09700260.4

Publication Number: 2229194

IPC: A61M1/00

Language of the proceedings: EN

Title of invention:

SUCTION CONTROL FOR PHACOEMULSIFICATION ASPIRATION SYSTEM

Patent Proprietor:

Alcon Inc.

Opponent:

Abbott Medical Optics Inc.

Headword:

Relevant legal provisions:

EPC Art. 100(c)

Keyword:

Grounds for opposition - added subject-matter (yes)

Decisions cited:

G 0003/89, G 0011/91, G 0002/10

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 1851/17 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 25 January 2022

Appellant:
(Patent Proprietor)

Alcon Inc.
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Respondent:
(Opponent)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 26 June 2017
revoking European patent No. 2229194 pursuant to
Article 101(3) (b) EPC**

Composition of the Board:

Chairman M. Alvazzi Delfrate
Members: D. Ceccarelli
N. Obrovski
S. Dennler
Y. Podbielski

Summary of Facts and Submissions

- I. The patent proprietor has appealed against the Opposition Division's decision, posted on 26 June 2017, to revoke European patent No. 2 229 194.

The patent was opposed on the grounds of added subject-matter, lack of novelty and lack of inventive step.

- II. Oral proceedings took place on 25 January 2022 by videoconference.

The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of auxiliary request 3, filed with the statement of grounds of appeal.

The respondent (opponent) requested that the appeal be dismissed.

- III. Claim 1 of auxiliary request 3 reads as follows.

" A surgical system (10), comprising:
a) a handpiece (22) having an aspiration function;
b) a control console (12);
c) an aspiration pump (16) at least partially located in the control console, the aspiration pump providing vacuum to the surgical handpiece through an aspiration line (20);
d) an aspiration vent (30) in an aspiration vent line (24, 32) providing fluid communication through a vent valve between a fluid reservoir (28) and the aspiration line (20);

characterized by

e) a user adjustable input device (113, 115) connected to the control console for varying the operation of the aspiration pump (16) based upon a user input of a pre-programmed level of venting adjustment, during a venting operation."

IV. The appellant's arguments, where relevant to the present decision, can be summarised as follows.

In claim 1 of auxiliary request 3 the feature of the user adjustable input device for varying the operation of the aspiration pump based upon a user input of a pre-programmed level of venting adjustment, during a venting operation, was based on a number of passages of the application as filed.

Page 2, lines 24 and 25, disclosed the act of venting, which allowed the user to release blocking fragments from an aspiration port at the tip of the handpiece; page 3, lines 17 and 18, disclosed "a method of variably controlling aspiration venting"; page 3, lines 22 to 27, disclosed that the user could "selectively vary the level of venting performance" to control the venting operation and a "control system allowing the user to adjust or control the venting operation"; page 6, lines 4 to 6, disclosed "venting adjustment"; original claim 1 disclosed an input device for "varying the operation of the aspiration vent and/or aspiration pump".

Moreover, page 3, lines 7 to 16 of the application as filed referred to issues occurring during venting at fixed conditions which were addressed by the invention, as disclosed on page 3, lines 17 and 18. This implied that, according to the application as filed, the user

adjustable input device was for varying the operation of the aspiration pump based upon a user input of a pre-programmed level of venting adjustment, during a venting operation.

- V. The respondent's arguments, where relevant to the present decision, can be summarised as follows.

In claim 1 of auxiliary request 3 the feature of the user adjustable input device for varying the operation of the aspiration pump based upon a user input of a pre-programmed level of venting adjustment, during a venting operation, had no basis in the application as filed.

In particular, it was neither explicitly nor implicitly disclosed that the variation of the operation of the aspiration pump occurred during a venting operation.

To solve the problem described in the patent it was sufficient that the operation of the aspiration pump was varied before the venting operation actually took place. For instance, the operation of the aspiration pump could be varied when the settings of the surgical systems were changed, to ensure that a desired venting action or vent performance was still reached during a (later) venting operation.

It was irrelevant whether on the basis of the application as filed the person skilled in the art could have considered it obvious to provide a system in which the variation of the operation of the aspiration pump could be performed during venting. The test for added subject-matter was whether there was a direct and unambiguous disclosure of the feature in question.

Reasons for the Decision

1. The invention

The invention relates to a surgical system, of the kind typically employed in the field of eye surgery.

In the human eye, light is transmitted through a clear outer portion called the cornea and focused by a lens onto the back part called the retina.

Age and disease may cause the lens to become less transparent. As a result, vision deteriorates because of the diminished light which can be transmitted to the retina. Such a condition is called cataract.

Surgical systems of the kind of the invention use a technique called phacoemulsification to treat cataract. A thin phacoemulsification cutting tip is inserted into the diseased lens and vibrated ultrasonically. The vibrating cutting tip liquefies or emulsifies the lens so that the lens may be aspirated out of the eye. The diseased lens, once removed, is replaced by an artificial lens.

The surgical system according to claim 1 of auxiliary request 3 comprises a handpiece having an aspiration function, a control console and an aspiration pump providing vacuum to the handpiece through an aspiration line.

The aspiration function is for removing the emulsified lens from the eye by means of the handpiece, for instance through an aspiration port. As explained in paragraph [0008] of the patent, fragments of the

material to be aspirated may occasionally block the aspiration port. In these cases it is useful to vent, i.e. to release vacuum from the aspiration line. Aspiration pump reversal can be used to perform the venting operation (paragraph [0009]).

The claim further defines a user adjustable input device for varying the operation of the aspiration pump based upon a user input of a pre-programmed level of venting adjustment, during a venting operation.

2. Added subject-matter

The respondent argued that in claim 1 of auxiliary request 3 the feature of the user adjustable input device for varying the operation of the aspiration pump based upon a user input of a pre-programmed level of venting adjustment, during a venting operation, had no basis in the application as filed.

2.1 It is established case law that, for complying with the prohibition of extension of subject-matter, an amendment can only be made within the limits of what the person skilled in the art would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the application as filed. This test is considered as the "gold standard" in G 2/10 (point 4.3 of the Reasons with reference to G 3/89 and G 11/91).

Subject-matter may also be implicitly - but still directly and unambiguously - disclosed to the skilled person, using common general knowledge, in the application as filed. This, however, does not extend to subject-matter merely considered plausible or obvious

in view of the application as filed.

- 2.2 There is no explicit disclosure of the feature objected to by the respondent in the application as filed.

The appellant pointed to a number of passages in the application as filed which, in its view, provided an implicit disclosure of the feature.

The application as filed provides a basis for a user adjustable input device for varying the operation of the aspiration pump based upon a user input of a pre-programmed level of venting adjustment. However, there is no disclosure in the application as filed - neither explicit nor implicit - of the input device being suitable for varying the operation of the aspiration pump during a venting operation.

- 2.3 According to page 2, lines 24 and 25, of the application as filed,

"[the] act of venting allows user to release the blocking fragment, so he/she can reposition it, to attempt further aspiration".

There is no disclosure in this passage that a user adjustable input device must be suitable for varying the operation of an aspiration pump during the venting operation.

Page 3, lines 17 and 18, reads:

"Therefore, a need continues to exist for a method of variably controlling aspiration venting on surgical consoles".

According to this passage, the method may be limited to the variable control of the aspiration venting prior to the actual performance of the venting operation. In this respect, the Board does not share the Opposition Division's view (point 13.1.1 of the impugned decision) that controlling an operation necessarily implies a real-time control. Absent any teaching to the contrary, an operation could also be controlled by a certain setup which may be changed before the operation is triggered.

The same reasoning applies to page 3, lines 22 to 27, which reads:

"The present invention improves upon the prior art by providing a surgical system with a variable controller that allows the user to selectively vary the level of venting performance. Accordingly, one objective of the present invention is to provide a surgical console control system. Another objective of the present invention is to provide a surgical console control system allowing the user to adjust or control the venting operation".

The variation of the level of venting performance as well as the adjustment or control of the venting operation mentioned in this passage may be limited to the possibility of changing a setup of the system, resulting in different venting, before the actual venting operation is started.

Page 6, lines 4 to 6, simply discloses pre-programmed levels of *"venting adjustment"*. It does not disclose under which conditions these levels could be selected by means of the user adjustable input device. The same holds true for claim 1 as originally filed, which

discloses a *"user adjustable input device varying the operation of the aspiration vent and/or aspiration pump based upon user inputs"*. The conditions under which the operation can be varied are not specified.

- 2.4 As regards page 3, lines 7 to 16, of the application as filed, this passage describes disadvantages of systems providing fixed-pressure venting.

"While fixed pressure venting typically accomplishes the task, wide variety of the modern phaco tips and accessories, as well as wide range of a modern system settings (such bottle height and vacuum limit), can affect the consistency of the venting action user gets. In addition, a variety of evolved user techniques contributes to the variability of the vent performance. For example, a certain user technique can result in under-venting, forcing user to use reflux more often. In other cases, a user technique can be prone to over-venting, resulting in excessive lens material regurgitation. Depending upon the surgical technique being employed, this automatic operation can result to too much or too little vacuum being vented. This is particularly true with the large number of different types of tips, techniques and accessories currently available".

However, such disadvantages are mitigated already by the possibility of varying parameters influencing the venting operation when the system is set up. This could take place with due consideration of other specific system settings, but still only before any venting operation is started.

2.5 In conclusion, the application as filed fails to provide the person skilled in the art with a direct and unambiguous disclosure of a user adjustable input device for varying the operation of the aspiration pump based upon a user input of a pre-programmed level of venting adjustment, during a venting operation.

It follows that claim 1 of auxiliary request 3 includes added subject-matter. Hence, the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



D. Hampe

M. Alvazzi Delfrate

Decision electronically authenticated