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**Datasheet for the decision
of 1 March 2022**

Case Number: T 2557/17 - 3.2.02

Application Number: 11167763.9

Publication Number: 2392285

IPC: A61B19/00, A61F9/007,
A61F9/008, A61B17/00

Language of the proceedings: EN

Title of invention:

Methods of ensuring safe use of a surgical tool with a
surgical machine

Patent Proprietor:

Alcon Inc.

Opponent:

Geuder AG

Headword:

Relevant legal provisions:

EPC Art. 84, 111(1), 123(2)
RPBA 2020 Art. 11, 12(2), 13(2)

Keyword:

Amendment after summons - exceptional circumstances (yes)
- cogent reasons (yes) - taken into account (yes)
Amendments - added subject-matter (no)
Claims - lack of clarity no ground for opposition
Appeal decision - remittal to the department of first instance
(yes)

Decisions cited:

G 0003/14

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 2557/17 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 1 March 2022

Appellant:
(Patent Proprietor)

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Respondent:
(Opponent)

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Representative:

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 5 October 2017
revoking European patent No. 2392285 pursuant to
Article 101(3) (b) EPC**

Composition of the Board:

Chairman M. Alvazzi Delfrate
Members: D. Ceccarelli
C. Schmidt

Summary of Facts and Submissions

- I. The patent proprietor has appealed against the Opposition Division's decision, posted on 5 October 2017, to revoke European patent No. 2 392 285 on the grounds that the requests then on file did not comply with Article 123(2) or (3) EPC.
- II. The Board summoned the parties to oral proceedings and sent a preliminary opinion in a communication dated 16 June 2021. In this communication, the Board explained, in particular, that the subject-matter of claim 1 of the patent as granted appeared to include added subject-matter because it was not limited to a method in which power was provided to a surgical tool if the tool could safely be used, and no power was provided to the surgical tool if the tool could not be safely used. This limitation appeared to be central in the teaching of the application as filed.
- III. At the end of the oral proceedings, which took place on 1 March 2022, the requests were as follows:
- The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of auxiliary request 6 or 7, both of which were filed on 31 January 2022.
- The respondent requested that the appeal be dismissed.
- IV. Claim 1 of auxiliary request 6 reads as follows:
- "A method of ensuring that a surgical tool (400) is used safely with a surgical machine (100), the method comprising:

establishing (710,805,910) a communications connection between the surgical machine and the surgical tool; reading (720,810,920) an identification datum from the surgical tool; based on the identification datum, determining (740,830) if the surgical tool can safely be used with the surgical machine; illuminating (760,840) an illumination ring (135, 145) located on a face of the surgical machine to indicate that it is safe to use the surgical tool, only if it is safe to do so; and providing power (750, 835) to the surgical tool only if use of the surgical tool with the surgical machine is determined to be safe."

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

Admittance of auxiliary request 6

Auxiliary request 6 had been filed in response to the issue raised by the Board in the preliminary opinion in relation to the clause "providing power (750, 835) to the surgical tool (400) only if it is safe to do so". This issue had not been discussed at the oral proceedings before the Opposition Division or in the written decision. Moreover, the opponent had opted not to attend the oral proceedings before the Opposition Division.

For these reasons auxiliary request 6 should be admitted into the appeal proceedings.

Added subject-matter

Method claim 1 of auxiliary request 6 included the step

of "illuminating (760,840) an illumination ring (135, 145) located on a face of the surgical machine to indicate that it is safe to use the surgical tool, only if it is safe to do so".

In the impugned decision, the Opposition Division had argued that this meant that the illumination ring was illuminated only on the condition that it was safe to use the surgical tool and, by implication, that the illumination ring was not illuminated if it was not safe to use the surgical tool.

The skilled person would not apply this interpretation when reading the patent specification and claims as granted. Paragraph [0019] of the patent taught that the illumination ring was designed to display different colours indicating different modes of operation or statuses of the surgical machine. Claim 7 as granted specified that the illumination ring was illuminated in a different colour to indicate that it is was not safe to use the surgical tool. This was in accordance with paragraph [0019], which disclosed that the illumination ring was designed to display different colours. Hence, claim 1 as granted meant that an illumination ring would be illuminated to indicate that it was safe to use the surgical tool when it was established that it was safe to use the surgical tool. There was no implication in the claim wording that the surgical tool could not be illuminated at all when it had not been established that it was safe to use the surgical tool. There was a basis for this claim interpretation in particular in Figures 7 and 8 of the application as filed.

Clarity

The respondent's clarity objection, which was directed to the wording "only if it is safe to do so" in claim 1 of auxiliary request 6, should be disregarded by the Board as it related to wording which was already present in claim 1 as granted.

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

Admittance of auxiliary request 6

Auxiliary request 6 was only filed in the appeal proceedings, and after the summons to oral proceedings. The appellant had no reason for such a late filing, since the respondent had already raised objections of added subject-matter in relation to the omission of the feature of the provision of power to the surgical tool in the proceedings before the department of first instance, i.e. in the letters dated 18 May 2016 and 18 July 2017. Moreover, the objection of insufficient disclosure in section IV of the letter dated 18 May 2016 was directed to the expression "only if it is safe to do so". In view of the strict provisions governing the admissibility of late-filed requests, the Board should not admit auxiliary request 6 into the appeal proceedings.

Added subject-matter

The step of "illuminating (760,840) an illumination ring (135, 145) located on a face of the surgical machine to indicate that it is safe to use the surgical tool, only if it is safe to do so" in claim 1 of

auxiliary request 6 meant that the illumination ring was only illuminated when it was safe to use the surgical tool. If it was not safe to use the surgical tool, the ring was not illuminated. This interpretation, which followed from the expression "only if it is safe to do so", was in accordance with claim 16 of the parent application as filed. In the parent application, the same expression was used in conjunction with the feature of "providing power to the surgical tool", which implies an on or off condition.

Claim 7 as granted was irrelevant in this respect, as it contradicted claim 1, which was unambiguous. Claim 7 should have been deleted prior to grant for clarity reasons.

Based on this interpretation of the wording of claim 1 of auxiliary request 6, the claimed subject-matter extended beyond the content of the application as originally filed, and therefore it was in breach of Article 123(2) EPC.

Clarity

The expression "only if it is safe to do so" in claim 1 of auxiliary request 6 was unclear. The clarity objection should be considered by the Board since when amended claims are filed, it should be ensured that the claims as a whole are clear.

Reasons for the Decision

1. The invention

The invention relates to the safe use of a surgical tool with a surgical machine.

It finds application in the use of a surgical machine which can be connected to and operated with several different surgical tools, especially in the field of ophthalmic surgery.

The claims of auxiliary request 6 are methods of ensuring that a surgical tool is used safely with a surgical machine. According to claim 1, a communications connection is established between the surgical machine and the surgical tool, for example using RFID technology.

Subsequently, an identification datum is read from the surgical tool.

Based on the identification datum, it is determined whether the surgical tool can safely be used with the surgical machine, for example on the basis of a comparison between the identification datum and a set of data corresponding to different surgical tools stored in a memory of the machine.

An illumination ring located on a face of the surgical machine is then illuminated to indicate that it is safe to use the surgical tool, only if it is safe to do so. Moreover, power is provided to the surgical tool only if use of the surgical tool with the surgical machine is determined to be safe.

This should contribute to the safety of use of the surgical machine, as it should help minimise unwanted acts being performed on a patient by the surgical

machine.

2. Admittance of auxiliary request 6

Auxiliary request 6 was filed only after the summons to oral proceedings had been issued. It constitutes an amendment of the appellant's appeal case.

Its admittance is governed by Article 13(2) RPBA 2020, which states that any amendment to a party's appeal case made after notification of a summons to oral proceedings must, in principle, not be taken into account unless there are exceptional circumstances, which are to be justified with cogent reasons by the party concerned.

The appellant justified the filing of auxiliary request 6 by arguing that it had been in response to an issue raised by the Board in its communication containing the preliminary opinion, which had been sent in preparation for the oral proceedings.

In this communication, the Board explained, in particular, that the subject-matter of claim 1 of the patent as granted appeared to include added subject-matter because it was not limited to a method in which power was provided to a surgical tool if the tool could safely be used, and no power was provided to the surgical tool if the tool could not be safely used.

The appellant had not previously been confronted with such an objection in the appeal proceedings. Moreover, the objection was not the object of the impugned decision and was not even discussed at the oral proceedings before the Opposition Division, which the respondent chose not to attend. These constituted

exceptional circumstances, to which the appellant reacted by filing auxiliary request 6. This request addresses the point made by the Board, as claim 1 comprises the limitation that power is provided to the surgical tool only if use of the surgical tool with the surgical machine is determined to be safe.

Hence, the Board is satisfied that auxiliary request 6 was filed due to exceptional circumstances, which were justified with cogent reasons by the party concerned.

The respondent argued that it had already raised objections in relation to the omission of the feature of the provision of power to the surgical tool only if it was safe to do so in the proceedings before the department of first instance. However, in the appeal proceedings, the respondent merely referred to its letters dated 18 May 2016 and 18 July 2017 in relation to the deletion of the wording "providing power to the surgical tool" and Article 123(2) EPC, without elaborating further. During the oral proceedings before the Board, the respondent referred to objections of insufficient disclosure directed to the expression "only if it is safe to do so". These vague references differ in substance from the objection raised by the Board in its communication, which the appellant was confronted with only after the dispatch of this communication.

For these reasons, auxiliary request 6 is admitted into the appeal proceedings under Article 13(2) RPBA.

3. Added subject-matter

The respondent and the Opposition Division in the impugned decision held that the method step of

"illuminating (760,840) an illumination ring (135, 145) located on a face of the surgical machine to indicate that it is safe to use the surgical tool, only if it is safe to do so", as defined in claim 1 of the patent as granted and in claim 1 of auxiliary request 6, constituted added subject-matter in respect of the application as originally filed.

More specifically, they interpreted the expression "only if it is safe to do so" as implying that the illumination ring was not illuminated at all if it was established that it was not safe to use the surgical tool.

In contrast, the appellant interpreted this expression as requiring the illumination of the illumination ring in a certain manner to indicate that it was safe to use the tool, only if it was safe to use the tool. This did not imply that the ring could not be illuminated in a different manner if it was established that the tool was not safe to use.

The assessment of whether the feature in question constituted added subject-matter hinges on the correct interpretation of the claim.

The Board's view is that although on the basis of a purely semantic reading of claim 1 both interpretations are possible, based on a technical reading of the patent as a whole the correct claim interpretation can only be the one proposed by the appellant.

In particular, if the interpretation of the respondent and the Opposition Division were to be accepted, claim 7 would contradict claim 1 of the patent as granted. Claim 7 expressly states that the illumination ring

should be illuminated (in a different colour) if it is not safe to use the surgical tool. The appellant's interpretation also fits with the description, as paragraph [0019], referred to by the appellant, in conjunction with paragraph [0028], discloses that the illumination ring is illuminated (in red) if it is not safe to use the surgical tool.

The Opposition Division stated that the expression in claim 1 "only if it is safe to do so" would be redundant if the appellant's interpretation was adopted, as it merely repeated the condition under which the indication occurred.

The Board is not convinced. Redundancy as such is not necessarily a reason for excluding an interpretation of a claim. What is more important is that a claim feature should be interpreted in the context of the patent as a whole, which includes the teaching of claim 7 as explained above.

In this respect, it is also irrelevant that the expression "only if it is safe to do so" was used in claim 16 of the parent application as filed in conjunction with the feature of "providing power to the surgical tool", since the context is different and claim 16 of the parent application cannot be used to interpret the meaning of an expression in the patent as granted.

The respondent's argument that the teaching of claim 7 was irrelevant since the meaning of claim 1 of the patent as granted was unambiguous is not convincing either. The meaning of claim 1, when the claim is read in isolation, allows for both the interpretation of the Opposition Division and of the appellant. However, only

the appellant's interpretation provides for a technical meaning of claim 7 and fits in the context of the patent as a whole.

When construed as proposed by the appellant, the step of "illuminating (760,840) an illumination ring (135, 145) located on a face of the surgical machine to indicate that it is safe to use the surgical tool, only if it is safe to do so" in claim 1 of auxiliary request 6 is based on Figures 7 and 8 of the application as filed, as well as claim 3, page 10, lines 13 and 14, and page 11, lines 32 and 33.

It follows that the objection of added subject-matter in relation to Article 123(2) EPC raised by the respondent, which was accepted by the Opposition Division in the impugned decision, does not prejudice the maintenance of the patent on the basis of auxiliary request 6.

4. Clarity

The respondent argued that the expression "only if it is safe to do so" in claim 1 of auxiliary request 6 was unclear.

According to decision G 3/14 (Order), in opposition proceedings an alleged lack of clarity (Article 84 EPC) may be examined only when, and then only to the extent that, this lack of clarity is introduced by an amendment.

Since the expression "only if it is safe to do so" was already present in claim 1 of the patent as granted, the respondent's objection of lack of clarity cannot be

considered by the Board.

5. The decision under appeal only considered a respondent's objection under Article 123(2) EPC. This has been reviewed by the Board.

The decision did not deal with the other objections raised by the respondent, the consideration of which by two instances is deemed appropriate.

The parties did not have any objections to a remittal.

For these reasons, and in view of the primary object of the appeal proceedings being to review the decision under appeal in a judicial manner (Article 12(2) RPBA 2020), the Board considers that special reasons are present within the meaning of Article 11 RPBA 2020 for remitting the case to the Opposition Division for further prosecution, in accordance with Article 111(1) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division for further prosecution.

The Registrar:

The Chairman:



D. Hampe

M. Alvazzi Delfrate

Decision electronically authenticated