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**Datasheet for the decision
of 14 August 2024**

Case Number: T 1986/22 - 3.2.08

Application Number: 14757324.0

Publication Number: 2961364

IPC: A61F9/007, A61F9/008

Language of the proceedings: EN

Title of invention:
SYSTEM FOR GLAUCOMA TREATMENT

Patent Proprietor:
Belkin Vision Ltd.

Opponent:
OD-OS GmbH

Relevant legal provisions:
EPC Art. 123(2)
RPBA 2020 Art. 11

Keyword:
Amendments - allowable (yes)
Remittal - (yes)

Decisions cited:
T 1727/12



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Case Number: T 1986/22 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 14 August 2024

Appellant: Belkin Vision Ltd.
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
14 June 2022 concerning maintenance of the
European Patent No. 2961364 in amended form.**

Composition of the Board:

Chairwoman P. Acton
Members: G. Buchmann
K. Kerber-Zubrzycka

Summary of Facts and Submissions

- I. The opposition division held that European patent No. 2 961 364 according to the then valid auxiliary request 3 fulfilled the requirements of the EPC.

The opposition division found that the main request and auxiliary requests 1 and 2 contravened Article 123(2) EPC.

- II. The patent proprietor filed an appeal against this decision.

- III. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request filed together with the statement setting out the grounds of appeal.

They further requested that the case be remitted to the first instance in case the Board decided in favour of the appellant in respect of the reasons for refusal of the main request by the opposition division (Article 123(2) EPC).

In the alternative they requested maintenance of the patent on the basis of auxiliary requests 1 or 2 both filed together with the statement setting out the grounds of appeal.

In the event that the Board was not prepared to allow the claims of the Main Request, they requested oral proceedings.

- IV. The respondent (opponent) did not make any submissions in the appeal proceedings.
- V. Claim 1 of the **main request** which corresponds to claim 1 as granted, reads as follows. The numbering was added by the Board. The amendments compared to claim 1 as originally filed are indicated by underlining or ~~deletion~~.

"Apparatus, comprising:

1

a probe (36), which is ~~positioned~~ positionable adjacent to an eye (28) of a patient and ~~is~~ configured to irradiate a trabecular meshwork of the eye with one or more optical beams that traverse a sclera of the eye, the apparatus being configured such that the probe does not make physical contact with the eye;

2

and a processor (144), which is configured to

2.1

select one or more target regions of the trabecular meshwork;

2.2

acquire images of a sclera and a limbus of the eye using a camera;

2.3

automatically identify the target regions of the trabecular meshwork based on the images of the sclera around the limbus and

2.4

control the probe (36) to irradiate ~~the selected target regions~~ with the optical beams multiple points, which lie on a region around the junction of the cornea and the sclera being a circle having a diameter between 10-14 millimeters around a cornea of the eye,

2.5

so as to irradiate the automatically-identified target regions of the trabecular meshwork."

Dependent claim 3 as granted was deleted in the main request.

VI. The relevant submissions of the appellant are included in the reasons for the decision below.

Reasons for the Decision

1. Article 123(2) EPC

1.1 According to the opposition decision, amended Feature 1 which requires that "the apparatus [is] configured such that the probe does not make physical contact with the eye", contravened Article 123(2) EPC.

According to the appellant, basis for this feature could be found in claim 3 as originally filed which reads: "An apparatus according to claim 1, wherein the probe does not make physical contact with the eye".

So, the wording of the combination of claims 1 and 3 was amended from

"an apparatus wherein the probe does not make physical contact with the eye"

to

"an apparatus being configured such that the probe does not make physical contact with the eye."

1.2 The opposition division reasoned that claim 3 as originally filed had the form of a "use feature", which

meant that the claim only specified the manner in which the probe was used. Therefore, the combination of claims 1 and 3 as originally filed referred to an apparatus which could be used without contacting the eye, but also included an apparatus which could be used with contacting the eye. To fulfil the definition of claim 3, it was sufficient that the apparatus was suitable for use without contact of the eye. In contrast, claim 1 of the main request specified an apparatus which was configured so that in any case the contact with the eye was precluded. This configuration was a further specification of the apparatus which was not originally disclosed in general but only in combination with further technical details.

- 1.3 The Board does not share the opinion that claim 3 as originally filed specifies a "use-feature". The wording of the claim clearly refers to an apparatus and the definition of the claim can be fulfilled by a specific configuration of the apparatus. Additionally, the wording of claim 3 does not specify an apparatus which needs not make contact with the eye, but an apparatus which does not make contact with the eye.

Contrary to the opposition division's opinion, the cited passage of the description on page 2, lines 12-14 does not refer to the use of the apparatus either, but is refers to an "embodiment" in the context of the description of the apparatus itself.

Therefore, the conclusion of the opposition division, that the feature of claim 3, being a use-feature, did not limit the scope of the claim directed to an apparatus, does not apply.

1.4 The opposition division further argued that the configuration of the apparatus such that it does not make contact with the eye, was disclosed only in the form of the fixture (page 5, lines 25-28) or in a particular operation of the processor (page 3, lines 12-14, page 11, line 33 - page 12, line 12).

They argued that these passages disclosed an apparatus which excluded contact with the eye but only in an inextricable functional relationship with other features which were not present in the claim. Therefore, amended Feature 1 resulted in an unallowable intermediate generalisation.

The passages cited above do, however, not even disclose an apparatus which excludes contact with the eye. Page 5, lines 25-28 mentions a distance between 0 mm and 200 mm and explains that irradiation from a distance is not mandatory. Pages 3 and 11 describe the control of the distance by the processor. This does not give any information about how big the distance has to be. Therefore, the cited passages do not disclose the subject-matter of the amended claim 1 in the context of further features which may not be omitted, and additionally they are not needed to support the amendment in claim 1.

Therefore, this argument of the opposition division does not apply either.

1.5 In sum, the amendment in Feature 1 of claim 1 is based on the combination of claims 1 and 3 as originally filed. The addition of "configured such that" does not add subject-matter to the claim.

1.6 Claim 3 as granted, in view of which the opposition division had a negative preliminary opinion, has been deleted in the main request.

2. Remittal

The appellant requested remittal of the case if the Board decided in favour of the appellant in respect of the reasons for refusal of the main request by the opposition division (Article 123(2) EPC). This situation applies.

The opposition division did not decide about novelty and inventive step of the main request (claim 1 as granted).

In the present case, the number of possible novelty/inventive step attacks is considerable (see the decision of the opposition division concerning auxiliary request 3). Due to the absence of the opponent in the appeal proceedings, for deciding about novelty and inventive step of the main request, the Board would have to perform an extensive ex officio examination of issues which were not part of the contested decision. This would contravene the spirit of Article 12(2) RPBA 2020 according to which the primary object of the appeal proceedings is to review the decision under appeal in a judicial manner. The Board therefore holds that there are special reasons for remittal of the case for further prosecution under Article 11 RPBA.

The case can be decided without oral proceedings. The appellant (patent proprietor) requested oral proceedings as an auxiliary measure if a patent was not granted on the basis of the main request. The

respondent (opponent) has not made any submissions in appeal. According to the established case law, a party is not adversely affected by a decision to remit a case for further prosecution, and for this reason there is no need to grant an auxiliary request for oral proceedings (see CLB 10th ed. 2022 III.C.4.5 with reference to case law, in particular T1727/12, reasons 3). The Board does not consider oral proceedings to be expedient ex officio (Art. 116 EPC).

Therefore, the Board allows the appellant's request for remittal to the first instance.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairwoman:



A. Pinna

P. Acton

Decision electronically authenticated