

Publication in the Official Journal ~~1990~~ / No

File Number: T 375/90 - 3.2.2

Application No.: 83 303 109.9

Publication No.: 0 095 926

Title of invention:

Classification: A61F 9/00, A61B 17/00

D E C I S I O N
of 21 May 1992

Applicant: SITE MICROSURGICAL SYSTEMS, INCORPORATED

Headword:

EPC Rule 86(3) and Article 123(2)

Keyword: "Late amendments (allowed)"

Catchwords

"Substantial amendments filed after Rule 51(4) EPC communication, - conditions for the application of Rule 86(3) EPC"



Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number : T 375/90 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 21 May 1992

Appellant : SITE MICROSURGICAL SYSTEMS, INCORPORATED
434 Virginia Drive
Ft. Washington, PA 19034 (US)

Representative : Jones, Alan John
CARPMAELS & RANSFORD
43 Bloomsbury Square
London, WC1A 2RA (GB)

Decision under appeal : Decision of Examining Division 2.3.05.127 of the
European Patent Office dated 6 December 1989, and
posted on 27 December 1989, refusing European
patent application No. 83 303 109.9 pursuant to
Article 97(1) EPC.

Composition of the Board :

Chairman : G.S.A. Szabo
Members : W.D. Weiss
W. Moser

Summary of Facts and Submissions

- I. European patent application 83 303 109.9, filed on 31 May 1983, and published under No. 0 095 926 on 7 December 1983, was refused by the Examining Division at the end of an oral proceedings held on 6 December 1989. The written reasoning for this decision was dispatched on 27 December 1989.
- II. The Examination Proceedings had already reached a stage in which the Examination Division, on 13 July 1988, issued a Communication pursuant to Rule 51(4) EPC identifying the documents on the basis of which it intended to grant a patent. On 10 November 1988, hence within the time limit of four months set in the Communication pursuant to Article 51(4) EPC, the Respondent (Applicant) filed a new set of 25 claims together with amended pages of the description.

In a communication dated 22 December 1988, the Examining Division drew the Appellant's (Applicant's) attention to the Guidelines C-VI, 4.7 to 4.9 and expressed its intention to deny, based on Rule 86(3), its consent to this amended version, because these amendments could not be considered as minor. Moreover, the opinion was expressed that the amendments appeared to be not admissible with respect to Article 123(2) EPC.

During the oral proceedings the Examining Division maintained these objections against the main request and an additionally filed auxiliary request and refused the patent application.

According to the written reasons of this decision, the Examining Division found, inter alia, that the amendments involved the deletion of many features of the claims in

comparison both with the application as filed and as proposed for grant. In the former case this necessarily required a careful examination to be carried out to see whether or not Article 123(2) EPC was complied with. In the latter case a careful re-examination of the patentability of the subject-matter would have been required, since it could not be readily ascertained that the claims were allowable.

III. A Notice of Appeal was filed against this decision on 22 February 1990 and the appeal fee paid simultaneously. The Statement of Grounds was filed by telecopy on 26 April 1990 confirmed on the next day and contained a main request and two auxiliary requests.

IV. In a communication of 18 February 1992 and in the oral proceedings held on 21 May 1992, the Board summarised the interpretation of Rule 86(3) EPC as reflected by the Guidelines and various decisions by the Board of Appeal.

Moreover, the Board drew the Appellant's attention to the fact that certain amended features of the then valid Claims would contravene Article 123(2) EPC.

V. The Appellant has consistently submitted, that it was only after the grant of the corresponding patent in the USA that the Appellants became aware of a product on the market which they considered to infringe their patent. The Appellants, therefore, became aware that it might be necessary to look again at the wording of the claims in all their corresponding pending applications to ensure that the invention was clearly and concisely claimed. They considered this to be a good reason justifying the submission of amendments at this late stage of the examination proceedings.

The Appellant pointed to the original independent Claims 1, 16 and 22 as well as to the Chapter titled "Objects of the invention" of the original description, which he considered to express clearly and unambiguously that the Appellant had always intended that the word "port" or even "port means" should be understood in its broad functional meaning as "a place of access to a system used for introduction or removal of energy or material" (Chambers Science and Technology Dictionary), "an opening by which a fluid enters or leaves" or "an inlet or outlet for a fluid" (Webster's New Collegiate Dictionary) and that it should not imply a particular physical structure.

VI. At a final stage of the oral proceedings, the Appellant filed a new set of 26 claims to replace the previous sets of claims, the independent Claims 1 and 17 of which read as follows:

"1. An ophthalmic microsurgical system comprising:

a console (22) having means for connection to a remote surgical instrument (42) adapted to be disposed in the vicinity of the surgery situs, said surgical instrument (42) including an aperture; and

a first conduit (56) for coupling to said surgical instrument aperture and arranged for carrying a fluid therethrough;

said console (22) having control means associated therewith for selectively precluding said fluid from flowing through said first conduit (56),

the system being characterised in that:

it includes a cassette assembly (20) releasably secured to said control (22);

said control means includes a first interrupter means (70) for cooperating with said cassette assembly (20);

said cassette assembly (20) comprises first port means (112) for communication with the first conduit (56), second port means (192) and first occludable means (120) coupled between the first and second port means; and

said first occludable means (120) is arranged for cooperation with said first interrupter means (70) when said cassette assembly (20) is secured to said console (22) to isolate the first and second port means from each other in response to a first signal, and to preclude flow of fluid through said port means and through said first conduit (56).

17. A cassette assembly, for releasable securement to the control console of an ophthalmic microsurgical system according to any one of Claims 1 to 16, the cassette (20) comprising:

first port means for communication with a conduit means coupled to an aperture in a microsurgical instrument;

second port means; and

first occludable means (120) coupled between the first and second port means, the first occludable means (120) being arranged for co-operation with a first means (70) on the control console when the

cassette is secured to the instrument to isolate the first and the second port means from each other in response to a first signal, and to preclude flow of fluid through said port means and through said conduit means."

VII. The Appellant requests grant of the patent on the basis of the following documents:

Claims: Claims 1 to 26 filed during the oral proceedings on 21 May 1992;

Description: Pages 1 to 20 filed during the oral proceedings on 21 May 1992;

Drawings: Figures 1 to 11 filed during the oral proceedings on 21 May 1992.

Reasons for the Decision

1. The appeal is admissible.
2. Principles ruling the application of Rule 86(3) EPC

Rule 86(3) EPC states: "After receipt of the first communication from the Examining Division the applicant may, of his own volition, amend once the description, claims and drawings provided that the amendment is filed at the same time as the reply to the communication. No further amendment may be made without the consent of the Examining Division" (or of the Board of Appeal exercising its power within the competence of the Examining Division, respectively, cf. Article 111(1) EPC).

The Boards have defined conditions limiting the extent of the discretion which may be exercised when applying Rule 86(3) EPC.

- (a) There is no discretion in the obligation to admit amendments which remove deficiencies constituting violations of the EPC (cf. T 171/85 OJ 1987, 160; T 609/88 unpublished).
- (b) In all the other cases the Office's interest in a speedy completion of the proceedings must be balanced against the applicant's interest in the grant of a patent with the amended claims (cf. T 166/86, OJ 1987, 372; T 182/88, OJ 1990, 287; and T 76/89 unpublished).

The Guidelines, Part C, VI, 4,8 and 4.9, state that "the communication under Rule 51(4) EPC does not constitute an opportunity for the applicant to call into question the outcome of the earlier procedure and only minor amendments will be considered within the period under Rule 51(4)". Moreover, the applicant has to "give good reasons for proposing the changes only at this stage of the proceedings". These rules of the Guidelines also reflect the call for the balance of interests applicable when judging cases falling under category (b) mentioned above.

It follows from the foregoing considerations that the Examining Division (or the Board acting within its competence), when applying the provisions of Rule 86(3) EPC, is not completely free to deny any examination of the respective amended documents.

Although it may be time consuming in particular cases, all appropriate examinations, which permit to decide whether

or not the conditions set out under items (a) and (b) are met, have to be carried out.

In the present case, it is the Board's opinion that for the conditions under item (b) it must, therefore, be examined:

- whether the Appellant has given good reasons for proposing amendments in this late stage of the examining proceedings;
- whether the claims clearly meet the formal requirements (Articles 123(2), 82, 84 EPC); and
- whether the positive result of the previous substantive examination with respect to novelty and inventive step implies that also the subject-matter of the amended claims are novel and involve an inventive step.

Consequently, a decision refusing an application on the basis of Rule 86(3) EPC shall state the reason as to which of these examinations gave rise to a negative result.

In the present case, the examining procedure had already reached a stage in which after two substantial communications from the Examining Division the Appellant had submitted documents on the basis of which the Examining Division had communicated according to Rule 51(4) EPC its intention to grant a patent.

Consequently, there is no doubt that, according to Rule 86(3) EPC, the acceptance of these new documents depends on the consent of the Board acting within the competence of the Examining Division (Article 111(1) EPC).

3. Nature of Amendments

Claim 1 differs from its predecessor which was communicated according to Rule 51(4) EPC substantially in that "port means" are now used instead of "port" and in that the word "flexible" is omitted as an attribute of the "occludable means (120)".

Claim 17, which is the first claim to refer to a "cassette assembly" is closely following the wording of Claim 1, but amended considerably with respect to the corresponding Claim 16 of the version communicated according to Rule 51(4) EPC, which previous claim was much narrower in scope. The claims which are dependent on these two independent claims contain amendments which are adaptations to the amended main claims.

The Board finds that the nature of these amendments is not such as to remove deficiencies in the claims communicated according to Rule 51(4) EPC which violate vital provisions of the EPC. Consequently, the amended claims and the other documents adapted thereto do not fall under the category (a) mentioned under point 2 above, the consent to which might not have been denied.

4. Justification for Amendments

Since therefore the amendments could only fall under category (b) mentioned under point 2 above, it must be assessed, whether or not the Appellant had good reasons to propose changes only at the late stage of the proceedings.

The Appellant has consistently submitted that, when filing the application, he had always interpreted the word "port" in its broad functional meaning, which is also backed up

by the most common encyclopedic dictionaries, as "an outlet or inlet for a fluid".

The Board agrees that this is the normal and usual interpretation of the word "port" and also cannot find any basis in the originally filed documents that would call for a more specific structural interpretation of the word "port" when used to characterise the broadest aspect of the invention.

The Board, therefore, understands that it was an unforeseeable event, when the Appellant was confronted with the narrow and specific interpretation of this word by his competitor. The fact that the application for the corresponding US-Reissued Patent was filed on 2 December 1988 and corresponding amendments arrived at the EPO on 10 November 1988 are strong indicators as regards the credibility of the Appellant's submission that he undertook immediate action all over the world to warrant that the invention was clearly and concisely claimed.

The Board, therefore, understands the Appellant's interest in ensuring an interpretation of his claims which he considers to be proper. Moreover, the event which is the cause for such interest justifies the late filing of the request for a corresponding amendment.

5. Article 123(2) EPC

The independent Claims 1 and 17 are based on the original Claim 22 as well as on the paragraph bridging the pages 4 and 5 of the original description. The dependent claims are based on the original description of the preferred embodiment.

Therefore, the amended claims do not contravene Article 123(2) EPC.

6. Novelty and inventive step

The Examining Division, in its communication of 17 February 1988, has accepted the Appellant's view that the then valid Claim 1, which was in substance identical with the Claim 1 which was later on communicated pursuant to Rule 51(4) EPC, was novel and involved an inventive step with respect to the two documents cited in the Search Report. The main reason for this view was that the subject-matter of Claim 1 represented a compaction and simplification with respect to the prior art which was not obvious. The two substantial amendments in the present Claim 1 ("port means", omission of "flexible") are not of such a nature that they can possibly change this reasoning.

Consequently, the fact that the subject-matter of the previous Claim 1 was considered novel and inventive implies the same judgement for the present Claim 1.

Claim 17 claims with nearly identical wording another form of a product in trade which represents the same invention. The allowability of this follows from the allowability of Claim 1.

7. The dependent Claims and the other documents are not open to objection on formal grounds.

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 documents:

Claims: Claims 1 to 26 filed during the oral proceedings on 21 May 1992;

Description: Pages 1 to 20 filed during the oral proceedings on 21 May 1992;

Drawings: Figures 1 to 11 filed during the oral proceedings on 21 May 1992.

The Registrar



S. Fabiani

The Chairman



G. Szabo