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**Datasheet for the decision
of 6 May 2014**

Case Number: T 0979/11 - 3.2.08
Application Number: 02709109.9
Publication Number: 1353617
IPC: A61F9/007, A61F9/011, A61B18/00
Language of the proceedings: EN

Title of invention:

MINIMALLY INVASIVE GLAUCOMA SURGICAL INSTRUMENT AND METHOD

Applicant:

The Regents of The University of California

Headword:

Relevant legal provisions:

EPC Art. 84
EPC 1973 R. 112
EPC R. 103(1)(a)

Keyword:

Claims - clarity (no)
Admissibility of auxiliary requests 4 to 9 (no)
Reimbursement of appeal fee - (no)

Decisions cited:

T 0952/07

Catchword:



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Chambres de recours**

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Case Number: T 0979/11 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 6 May 2014

Appellant: The Regents of The University of California
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 29 November
2010 refusing European patent application No.
02709109.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman T. Kriner
Members: P. Acton
I. Beckedorf

Summary of Facts and Submissions

- I. The appellant (applicant) filed a notice of appeal against the examining division's decision posted on 29 November 2010 refusing the European patent application No. 02 709 109.9.
- II. The examining division held inter alia that the application was not clear as required by Article 84 EPC in combination with Rule 43 EPC because each of the terms "configured to access the trabecular network", "sufficient to ablate said trabecular network" and "configured to protect Schlemm's canal from damage by said laser light energy" which were present in the claims attempted to define subject-matter in terms of suitability for intended use rather than in terms of technical features necessary and sufficient to provide suitability for such use as required by Rule 43 EPC.
- III. Oral proceedings took place before the board of appeal on 6 May 2014.

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of one of the sets of claims filed as new main request and as new auxiliary requests 1 to 11 with letter of 5 April 2014 or, alternatively, that the case be remitted to the examining division for further examination and prosecution, and that the appeal fee be reimbursed.

- IV. Claim 1 according to the main request reads:

"A probe (700, 2400) for the treatment of glaucoma, comprising:

a probe tip (710, 2410) configured to access the trabecular meshwork; and a tissue ablator disposed on said probe tip and configured to ablate said trabecular meshwork, wherein a portion of the length of said probe tip is sized to fit within Schlemm's canal."

Claim 1 according to auxiliary request 1 differs from claim 1 of the main request by addition of the feature according to which the probe comprises:

"an aspiration port on said probe tip".

Claim 1 according to auxiliary request 2 differs from claim 1 of the main request by addition of the feature according to which the probe comprises:

"a shield (721, 2410) configured to protect Schlemm's canal from damage by the tissue ablator".

Claim 1 according to auxiliary request 3 differs from claim 1 of the main request by addition of the features according to which the probe comprises:

"an aspiration port on said probe tip" and "a shield (721, 2410) configured to protect Schlemm's canal from damage by the tissue ablator".

Claim 1 according to auxiliary request 4 reads:

"A surgical instrument (700, 2400) useable to ablate trabecular meshwork in a human eye for the treatment of glaucoma, said surgical instrument comprising; an elongate member having a distal end that is insertable into the anterior chamber of the eye; a protective member (721, 2410) on the distal end of the elongate member; and a tissue ablator (730) for

ablating trabecular meshwork tissue; wherein the protective member is configured to penetrate through the trabecular meshwork into Schlemm's canal and to then protect endothelial cells and collector channels lining the sclera wall of Schlemm's canal as the tissue ablator is being used to ablate trabecular meshwork tissue."

Claim 1 according to auxiliary request 5 differs from claim 1 of auxiliary request 4 by addition of the feature according to which the surgical instrument comprises:

"an aspiration port"

Claim 1 according to auxiliary request 6 reads:

"A surgical instrument useable to ablate trabecular meshwork in a human eye for the treatment of glaucoma, said surgical instrument comprising;
a probe (700, 2400) having a probe tip (710, 2410), said probe tip comprising a protective member (721, 2410); an aspiration port; and a tissue ablator (730) for ablating trabecular meshwork tissue; wherein the probe is insertable into the eye and the probe tip is configured to penetrate through the trabecular meshwork into Schlemm's canal and to thereafter protect endothelial cells and collector channels lining the sclera wall of Schlemm's canal as the tissue ablator is being used to ablate trabecular meshwork tissue."

Claim 1 according to auxiliary request 7 reads:

"A surgical instrument useable to ablate trabecular meshwork in a human eye for the treatment of glaucoma, said surgical instrument comprising a

probe (700, 2400) which comprises a probe shaft (705, 2405) having a distal end, a probe tip (710, 2410) and a tissue ablating element (730) for ablating trabecular meshwork tissue:

wherein the probe tip extends at an angle from the distal end of the probe shaft (705, 2405) and comprises a foot plate (721, 2410) which penetrates through the trabecular meshwork into Schlemm's canal where it then serves as a guide for advancement of the instrument along Schlemm's canal and protects endothelial cells and collector channels lining the sclera wall of Schlemm's canal as the tissue ablator is used to ablate trabecular meshwork tissue."

Claim 1 according to auxiliary request 8 differs from claim 1 of auxiliary request 7 by addition of the feature according to which the probe comprises:

"an aspiration lumen (822 or 924)".

Claim 1 according to auxiliary request 9 differs from claim 1 of auxiliary request 8 by addition of the feature according to which the probe comprises:

"an irrigation lumen (922)"

Claim 1 according to auxiliary request 10 reads:

"A probe (2400) for the treatment of glaucoma, comprising:
a probe tip (2410) configured to access the trabecular meshwork; a laser providing light energy to said probe tip sufficient to ablate said trabecular meshwork: a shield (2410) configured to protect Schlemm's canal from damage by said laser light energy."

Claim 1 according to auxiliary request 11 differs from claim 1 of auxiliary request 10 by addition of the feature according to which the probe comprises:

"an aspiration port on said probe tip"

V. The appellant argued as follows:

Communication according to Rule 112 EPC (1973)

Despite the fact that the applicant had repeatedly requested an invitation under Rule 112 EPC (1973), no such invitation had been issued at any time by the examining division. Since it was incorrect for the examining division not to have issued a communication under Rule 112 EPC (1973) the board should take whatever steps were considered appropriate in the circumstances to advance prosecution so that the applicant was not disadvantaged thereby.

Clarity - main request, auxiliary requests 1 to 3, 10 and 11

The features according to which the probe tip is configured to access the trabecular meshwork, the tissue ablator is configured to ablate the trabecular meshwork and a portion of the length of the probe tip is sized to fit within Schlemm's canal were functional features. The use of functional features was not per se in breach of the requirements of clarity as expressed in Article 84 EPC. On the contrary, they were clearly permissible if a structural limitation of the claimed object led to an undue restriction of the scope of the invention.

In the present case the use of structural features for defining the probe tip, the tissue ablator or the size of the probe tip would inevitably result in such a restriction, since several embodiments of the probe tip and the tissue ablator were disclosed in the application. Moreover, the functional features were sufficiently clear for the expert to put them into practice without undue burden. In particular, the feature according to which the probe tip is configured to access the trabecular meshwork clearly indicated that the tip was shaped in such a way that it was possible to push it into the trabecular meshwork.

Moreover, the reference to Schlemm's canal in the last feature of claims 1 according to the main request and to auxiliary requests 1 to 3, 10 and 11 did not give rise to clarity problems. Since the dimensions of these anatomical parts were known to the skilled person for any given living being on which the probe could be used for the treatment of glaucoma, the skilled person always knew whether a given probe was designed for example for a child, an adult or a horse. On the contrary, this last feature clearly specified that the probe was designed to work within Schlemm's canal instead of focusing on Schlemm's canal from the outside like the probes described in the prior art.

Therefore, claim 1 according to the main request and to auxiliary requests 1 to 3, 10 and 11 complied with the requirements of Article 84 EPC.

Admissibility of auxiliary requests 4 to 9

Even if these requests did not respond to new objections raised by the board in its communication, they should be admitted into the proceedings.

They could not have been filed at an earlier stage of the appeal proceedings because the applicant's representative had changed later in the course of the proceedings.

Finally, since the additional features overcame the objections relating to added subject-matter, clarity and novelty, the requests were clearly prima facie allowable and should therefore be admitted into the proceedings.

Reimbursement of the appeal fee

The appeal fee should be reimbursed since the examining division had committed a substantial procedural violation not only by not sending an invitation under Rule 112 EPC (1973), but additionally by issuing a refusal as the first and only action immediately following the previous board of appeal's decision relating to the same European application (T 952/07), which had remitted the case to the examining division "for further prosecution" and not for a further decision.

Reasons for the Decision

1. Communication according to Rule 112 EPC (1973)
 - 1.1 Rule 112 EPC (1973) refers to the case in which during the PCT phase a non-unity objection was raised by the examining division, no additional search fees were paid and the application was still not unitary when entering the European phase.

A Rule 112 EPC (1973) communication was issued by the EPO as a first action upon entry into the European phase in the following cases:

the set of claims had not been amended and still contained several inventions, or
the set of claims contained only one invention (and was therefore unitary) which had not been searched in the PCT phase.

The Rule 112 EPC (1973) communication was issued before the first communication pursuant to Article 96(2) and Rule 51(4) EPC (1973) without the need for a request by the applicant and without the applicant being asked if he wished to receive the communication or not.

No communication according to Rule 112 EPC (1973) was issued if:

the set of claims was restricted to the searched invention, or
the claims to be examined related to an invention which differed from any of the originally claimed inventions and which did not combine with these inventions to form a single inventive concept.

A communication according to Rule 112 EPC (1973) later in the examination proceedings was not envisaged.

- 1.2 In the present case, when entering the European phase, the set of claims comprised one single independent claim. This claim was derived from the originally filed claims 11 and 19.

In the international search report, claim 19 as originally filed has been listed as being part of all different inventions. Moreover, under Box 2, point 4,

of the international search report, claim 19 has been explicitly listed under those claims which had been searched. Therefore, it is correct to assume that the content of claim 19, as well as of all the further ones listed under Box 2, has been searched.

This is even more the case, since the subject-matter of claim 19 is broader than that of claim 1. Hence, if claim 1 has been searched, claim 19 has automatically been searched as well.

Hence the set of claims filed upon entry into the European phase was unitary and was restricted to a searched invention. Hence there was no need to issue a communication according to Rule 112 EPC (1973).

1.3 Since Rule 112 EPC (1973) did not give the applicant any entitlement to receive a communication according to this rule upon request later during the European examination proceedings when entering the European phase, the examining division has not committed a procedural violation by not sending such a communication during the examination proceedings.

2. Clarity - main request, auxiliary requests 1 to 3, 10 and 11

2.1 All claims 1 according to the main request and to auxiliary requests 1 to 3, 10 and 11 contain the functional feature according to which the probe tip is "configured to access the trabecular meshwork", without specifying any structural feature of the probe.

Functional features defining a technical result are permissible in a claim only if such features cannot otherwise be defined more precisely by structural

features without unduly restricting the scope of the invention.

The appellant argued that the introduction of structural features into the claims would have led to an undue restriction of the scope of the claim and that no structural features needed to be introduced into the claim since the functional feature was enough to describe a tip designed in such a way that it can be pushed into the trabecular meshwork.

However, in the present case, it would have been possible to define the probe tip by means of structural features, e.g. by specifying its shape and dimensions.

In particular by incorporating as alternatives the few different probe shapes described in the application into the claim, the applicant would not have been unduly restricted in the definition of the scope of his invention.

Therefore, since it was possible to define the invention by means of structural features without unduly restricting the scope of the claim, the functional feature according to which the probe tip is configured to access the trabecular meshwork, used in all claims 1 according to the main request and auxiliary requests 1 to 3, 10 and 11, already does not comply with the requirements of clarity of Article 84 EPC.

2.2 Additionally, the feature of claim 1 of the main request and of auxiliary requests 1 to 3, according to which a portion of the length of the probe tip is sized to fit within Schlemm's canal, defines the probe by reference to features relating to its use. Hence these

claims do not define the probe itself but by way of its relationship to a second entity (Schlemm's canal) which is not part of the claimed probe.

It might be that a skilled practitioner would recognise immediately whether a given probe was suitable to be used for a child or for another living being, as the appellant pointed out. However, claim 1 does not specify for which patient the probe should be used, and the skilled person would not be able to know, confronted with a probe without a patient, whether it fell within the specification of claim 1 or not.

Moreover, contrary to the appellant's arguments, the feature according to which "a portion of the length of said probe tip is sized to fit within Schlemm's canal" does not specify that the probe is conceived to work within Schlemm's canal, but simply that some, potentially infinitesimal, portion of the probe tip is small enough to fit within it. Contrary to the appellant's arguments, this feature does not specify how to use the probe and is not useful for describing its structural features.

3. Admissibility of auxiliary requests 4 to 9

Auxiliary requests 4 to 9 were filed with letter of 5 April 2014 and hence at a late stage of the appeal proceedings.

As admitted by the appellant, their filing was not caused by new objections raised by the board in its communication issued together with the summons to oral proceedings.

The only argument mentioned for explaining that it had been impossible to file the requests at a previous stage of the proceedings was the change of representative. However, the change of representative is generally not a reason for the admissibility of late-filed requests, even less so in the specific case where the change had taken place two and a half years before the oral proceedings.

Moreover, since all these requests still contain functional features which are not suitable for overcoming the issue of clarity raised with respect to the remaining requests, they are prima facie not allowable.

In the light of these findings, auxiliary requests 4 to 9 are not admitted into the proceedings.

4. Reimbursement of the appeal fee

Rule 103(1)a EPC stipulates as a precondition for reimbursement of the appeal fees that the appeal must be allowable.

Since in the present case the board has dismissed the appeal, this precondition is not met and the appeal fee cannot be reimbursed.

Order

For these reasons it is decided that:

For these reasons it is decided that:

1. The appeal is dismissed
2. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



V. Commare

T. Kriner

Decision electronically authenticated