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**Datasheet for the decision
of 2 April 2026**

Case Number: T 0579/24 - 3.4.01

Application Number: 14166815.2

Publication Number: 2772234

IPC: A61F9/00, A61F9/008, A61F2/16

Language of the proceedings: EN

Title of invention:
Apparatus for creating ocular surgical and relaxing incisions

Patent Proprietor:
AMO Development, LLC

Opponents:
Grünecker Patent- und Rechtsanwälte PartG mbB

Headword:
Ocular surgery / AMO Development

Relevant legal provisions:
EPC Art. 100(c), 112(1)(a)
RPBA 2020 Art. 13(1)

Keyword:

Grounds for opposition - added subject-matter (yes)

Amendment to appeal case - taken into account (no)

Referral to the Enlarged Board of Appeal - (no)

Decisions cited:

G 0001/24, T 0190/99, T 0330/05, T 2222/15, T 1480/16,

T 0914/18, T 0979/17, T 0995/18, T 1151/18, T 1857/19,

T 0951/22, T 2048/22

UPC CoA 764/2024

UPC CoA 774/2024



Beschwerdekammern
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Case Number: T 0579/24 - 3.4.01

D E C I S I O N
of Technical Board of Appeal 3.4.01
of 2 April 2026

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted/
electronically transmitted on 22 February 2024
concerning maintenance of the European Patent
No. 2772234 in amended form.**

Composition of the Board:

Chairman P. Scriven
Members: P. Fontenay
 D. Rogers

Summary of Facts and Submissions

- I. The patent in suit is based on European patent application 14166815, which was one of a number of divisional applications based on the previous patent application 08726822, published as WO-A-2008/112292. The previous application and parallel divisional applications were granted and opposed. The decisions of the Opposition Division constitute the subject of parallel cases T 322/18, T 547/19, T 1241/19 and T 1265/25 before the Boards of appeal.

- II. Two oppositions to the patent were originally filed. These were based on the grounds of Article 100(a) EPC in conjunction with Articles 54 or 56 EPC, Article 100(b) EPC, and Article 100(c) EPC in conjunction with Articles 76 and 123(2) EPC.

- III. Opponent 1 (Alcon Inc) withdrew their opposition before the Opposition Division.

- IV. The Opposition Division concluded that the subject-matter of claim 1 of the main request (claim 1 of the patent) did not involve an inventive step, in view of document D5 (US-B-6 325 792) and common general knowledge. It found that claim 1 of auxiliary request 1 involved an inventive step; was disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art; and that the subject-matter of claims 1, 3, and 6-12 of auxiliary request 1 did not involve added subject-matter. In

particular, it considered the reference, in claim 1 of auxiliary request 1, to a partially-penetrating incision with a bevel feature to have a basis in the parent and originally-filed applications.

- V. Both Opponent 2 (the opponent) and the proprietor appealed the Opposition Division's interlocutory decision that the patent could be maintained in amended form, on the basis of auxiliary request 1.
- VI. The opponent requested that the decision under appeal be set aside, and that the patent be revoked. It reiterated some of the objections that had been raised in the opposition proceedings under Articles 100(a), 100(b), and 100(c) EPC. In particular, it emphasised that both claim 1 as well as various dependent claims of the request deemed allowable (Auxiliary request 1) defined added subject-matter. This was due to the language used in claim 1, which deviated from the wording used throughout the application. Moreover, the combination of a partial incision with a bevel feature had no basis in the parent application. This issue of added subject-matter also applied to various dependent claims of the request considered allowable.
- VII. In its statement of grounds, the proprietor requested that the decision under appeal be set aside and the opposition rejected or, alternatively, that the decision under appeal be set aside and the patent maintained in accordance with one of auxiliary requests 1, 1A, 1B, 2, 3, 3A, 4, and 4A, first filed in opposition proceedings and re-filed with the statement of grounds of appeal.

- VIII. In their second response to the grounds of appeal, the proprietor filed additional requests 0X, 1X, 1AX, 1BX, 2X, 3X, 3AX, 4X and 4AX which differed from the main request filed with the first response, respectively, in that the dependent claims had been deleted. In their view, as had already been acknowledged in various decisions of the Boards of Appeal, the deletion of claims in existing requests did not amount to an amendment to the proprietor's case. Should the Board, for formalistic reasons, decide otherwise, the admission of these requests would nevertheless be justified, as they met all relevant requirements of Article 12(4) and 13(1) RPBA. Specifically, the new requests constituted a response to the newly-detailed objections raised by the opponent in reaction to the proprietor's statement of grounds.
- IX. Both parties were summoned to oral proceedings, in accordance with their respective requests.
- X. In a communication under Article 15(1) RPBA, annexed to the summons to attend oral proceedings, the parties were informed of the Board's preliminary opinion.
- XI. The Board indicated that the main request and auxiliary request 1, which underlay the impugned decision, were part of appeal proceedings. The Board also intended to admit auxiliary requests 1A, 1B, 2, 3, 3A, 4, and 4A, which had all been filed before the Opposition Division but had not been decided upon, since a higher-ranking request had been considered allowable. However, The Board did not intend to admit the other auxiliary requests (the X-series). The deletion of dependent

claims, in the Board's provisional view, was considered to constitute an amendment to the proprietor's case, in the sense of Article 12(4) RPBA and the circumstances did not justify their admission in the proceedings.

XII. In contrast to the Opposition Division's finding regarding added subject-matter, the Board considered that there was no clear and unambiguous basis for combining the features of various dependent claims of the patent with those of claim 1. This applied, in particular, to dependent claim 2 of the main request, which related to a partial cataract incision and depended on claim 1, which specified that the incision had a bevel feature.

XIII. During oral proceedings before the Board, the proprietor withdrew auxiliary requests 2, 3, 3A, 4, 4A and corresponding auxiliary requests of the X-series.

XIV. The proprietor's final requests were that the decision under appeal be set aside and the opposition rejected or, alternatively, that the opponent's appeal be dismissed and the patent maintained on the basis of auxiliary request 1. In the further alternative, it requested that the decision under appeal be set aside and the patent be maintained in accordance with one of auxiliary requests 1A, 1B, 0X, 1X, 1AX, or 1BX.

The opponent's requests remained unchanged.

XV. In their submissions at oral proceedings, the proprietor argued that the way the Boards of Appeal

handled the admissibility of new requests, which differed from previous requests in that claims had been deleted, was not consistent. A significant number of decisions had not considered the deletion of claims as amendments. The Board originally entrusted with the present appeal (board 3.2.08) was more lenient in this regard than present Board.

- XVI. Furthermore, the proprietor reiterated and elaborated on their arguments regarding added subject-matter, as had previously been set forth in its response to the Board's preliminary opinion. It again referred to paragraphs [0019], [0051], and [0059] of the original application (paragraphs [0010], [0042], and [0050] of the published application). Taken together, these paragraphs constituted clear pointers, in the sense given to this term in the relevant case law, that the feature of an incision with a bevel feature being only partial had been disclosed, at least implicitly, in the original application documents.
- XVII. In context of these submissions regarding added-matter, the proprietor orally formulated a question that could be potentially referred to the Enlarged Board. This question was: "Is the interpretation in the sense of G 1/24 also relevant for determining questions of added matter?"
- XVIII. Claims 1 and 2 of the main request (the patent) read:

1. A scanning system (2) for incising target tissue in a patient's eye (68) comprising:

a light source (4) for generating a light beam (6), wherein the light source (4) is an ultrafast laser; a controller (300) a scanner (40, 50) for deflecting the light beam to form first and second treatment patterns of the light beam under the control of the controller;

a delivery system for delivering the first treatment pattern to the target tissue to form a cataract incision therein that provides access to an eye chamber of the patient's eye and also for delivering the second treatment pattern to the target tissue to form a relaxation incision in the patient's eye to reduce astigmatism thereof; and the controller (300) being operatively coupled to the light source and the scanner (40, 50), and configured to:

(a) control the scanner to scan the light beam in the first treatment pattern so that the cataract incision has a bevel feature (430) and so that the light beam incises the cataract incision in the cornea or limbus; and

(b) control the scanner to scan the light beam in the second treatment pattern so that the light beam incises into the limbus or the cornea of the patient's eye.

2. System of claim 1, wherein the cataract incision is a partially penetrating incision.

XIX. Claim 1 of auxiliary requests 1, 1A, and 1B differ from claim 1 of the main request in that they incorporate

claim 2 of the patent. Auxiliary requests 1A and 1B define additional limitations regarding the light source and the scanner.

- XX. Auxiliary requests 0X, 1X, 1AX, and 1BX differ from the main request and auxiliary requests 1, 1A, and 1B, respectively, in that the dependent claims have been deleted.

Reasons for the Decision

1. The effective filing date of the opposed patent is its filing date, namely 13 March 2008. This follows from the fact that the feature in claim 1, relating to a first treatment pattern for forming a first cataract incision with a bevel feature, is missing from the priority document. This applies to each of the claims of the patent.
2. The original application 14166815 includes the complete text of the previous application 08726822, published as WO-A-2008/112292. In particular, the claims of the original parent application were reproduced in the form of "clauses identifying some prominent aspects of the technology described", at the end of the description.

Admission - all requests

3. The main request and auxiliary requests 1, 1A, and 1B were among the final requests submitted by the proprietor during the opposition proceedings.
4. The main request and auxiliary request 1 correspond to the requests on which the Opposition Division based its decision and are thus part of the proceedings (Article 12(2) RPBA). Auxiliary requests 1A and 1B were submitted before the Opposition Division and have been maintained ever since. They are thus also part of the proceedings. Since auxiliary request 1 was allowed, they were not addressed in the contested decision.
5. The auxiliary requests of the X-series were first filed with the proprietor's second reply to the opponent's statement of grounds, after the proprietor itself had appealed the interlocutory decision, thus at a late stage of the proceedings. They are each based on the corresponding main request and auxiliary requests 1, 1A and 1B, with the dependent claims having been deleted.
6. The proprietor argued that the existing case law of the Boards of Appeal was ambiguous and did not provide any clear line regarding the admissibility of requests which differed from earlier requests solely in that some claims had been deleted. It was, in particular, emphasised that different boards took different approaches regarding the nature of the amendments resulting from the deletion of claims. Some decisions held that the deletion of claims did not amount to an amendment in the sense of Articles 12(4) or 13(1) RPBA. In support of the proprietor's position, the decisions in T 914/18 (Immunonutritional composition/NESTLE), T 979/17, T 1480/16, T 995/18, T 1151/18

(Hochvoltbatterie/AUDI), and T 1857/19 (Compressor and PSA dryer/Ateliers François) were cited in this respect.

7. In the Board's view, however, the deletion of claims in previous requests on file does constitute an amendment to the proprietor's appeal case within the meaning of Article 13(1) RPBA, and can be considered at the Board's discretion. In the decision in T 951/22 (points 1-4), the present Board, in a different composition, indicated that it adhered to this alternative line of jurisprudence, which appeared better to preserve legal certainty. For a comprehensive analysis of the two approaches in the jurisprudence, reference is made to section V.A.4.2.3.d of the Case Law of the Boards of Appeal, 11th. edition.
8. The arguments and circumstances put forward by the proprietor were insufficient for the Board to exercise its discretion in favour of admitting the late-filed requests.
9. Decisions that fall within the discretion of the decision-making body are, by their very nature, dependent on how that body assesses the issues at hand, within the context of applicable law. The proprietor cannot derive any advantage or benefit from the fact that, in their opinion, other boards might have exercised their discretion differently and, under the given circumstances, possibly admitted the late-filed requests of the X-series.
10. The proprietor's argument, that the deletion of the dependent claims constituted a response to the new, detailed objections to the claims of the then pending requests raised, by the opponent, in reaction to the

proprietor's statement of grounds, is not persuasive, since the objections concerning added subject-matter of the dependent claims of the patent had already been raised in the notice of opposition. Although brief, they were fully comprehensible in their substance. They concerned the combination of the features relating to a partial incision with those of the incision having a bevel feature.

11. In the decision under appeal, the same combination was considered in connection with claim 1 of auxiliary request 1 (decision, point 37).
12. The fact that the Opposition Division followed the proprietor's arguments in this respect is no guarantee that the Board, dealing with similar issues, would decide the same way. Appeal proceedings inherently review appealed decisions. It is inherent, that findings may be reversed.
13. In line with its general approach (see the decision in T 2222/15 Noise reduction / SONOVA, points 25-32, which explicitly refers to the decision in T 1480/16 cited by the proprietor; and also T 951/22, cited above), the Board holds that the present circumstances are not sufficient to justify the admission of requests 0X, 1X, 1AX, and 1BX. In particular, the undeniable difficulty for a proprietor to deal with a large number of attacks can not, on its own, justify the filing of fall-back positions only at a late stage in proceedings.
14. Finally, it is observed, with regard to the criteria referred to in Article 13(1) RPBA, that the new auxiliary requests give rise to new objections (auxiliary request 0X) or do not resolve the issue of added subject-matter (Auxiliary requests 1X, 1AX, and

1BX) identified by the Board with regard to claim 2 of the main request. This is because the deletion of claim 2 in auxiliary request 0X, with its indication that the incision is partial, raises new questions regarding the meaning of a bevel feature in claim 1, and because the deletion of dependent claims in auxiliary requests 1X, 1AX, and 1BX is without any bearing on the added matter issue regarding the combination of an incision having a bevel feature with that of the incision being only partial.

Main request - Added subject-matter

15. Claim 2 of the main request defines the cataract incision as a partially-penetrating incision. This further limits the subject-matter of claim 1, which specifies that the cataract incision has a bevel feature. The proprietor urged that the recited combination of features had to be construed, in the light of the settled case law as established by the decision in T 190/99, by taking the whole disclosure into account, so that the interpretation made technical sense to the skilled person. The Enlarged Board of Appeal, in its decision in G 1/24, OJ EPO 2025, A60, confirmed that *the description and any drawings are always referred to when interpreting the claims, and not just in the case of unclarity or ambiguity.*

16. In the proprietor's view, the teaching of the decision in G 1/24 also applied to issues regarding added subject-matter, as had been confirmed by the decision in T 2048/22 *BSN MEDICAL / WOUND DRESSING / MULTILAYER*. In the present situation, both the original application and original parent application implied that the partially-penetrating cataract incision and its bevel

feature provided complementary effects that contributed to the protection of the interior of the eye from infection both before and after surgery. As had been confirmed by the Court of Appeal of the UPC (UPC CoA 764/2024 and UPC CoA 774/2024) the question of added matter required prior claim interpretation, followed by an analysis of what the skilled person would directly and unambiguously derive from the application as filed.

17. Contrary to the Opposition Division's view regarding claim 1 of the then pending auxiliary request 1, according to which both the original application documents and the original previous application documents provided a sufficient basis for the recited combination of features, the Board considers that the combination of the two aspects was envisaged for the first time in the original claims of the present, divisional application. Original claim 7 of the original application defined the feature of a bevel cataract incision and was dependent on claim 2, which defined the partially-penetrating incision. No corresponding basis existed in the previous application. The claims of the previous application contain no reference to a bevel feature at all. This applies, in particular, to claims 1 and 3 of this previous application which define the features of claim 2 of the patent in suit, but do not contain any mention of a bevel feature.

18. The embodiment disclosed in paragraph [0059] of the original previous application, as published, referred to by the proprietor, relates to Figure 8 and has a bevel incision. While figure 8 shows a complete incision, paragraph [0059] emphasised that many geometries were possible, using the invention. The

proprietor further referred to paragraph [0051] of the original previous application, which specifically referred to a partial cataract incision and its advantages in the context of the invention.

19. As underlined by the opponent, there is, however, no indication, in the description, that the embodiment of paragraph [0059] is to be construed in the light of paragraph [0051]. A direct and unambiguous basis for combining the two is missing. The fact that the cataract incision is referred to with the same reference signs in figures 5A, 5B, and 8, and corresponding paragraphs [0051] and [0059], is insufficient to establish that the same incision is meant. It is usual in patent applications to use the same reference signs for similar elements, even though they differ between embodiments.
20. Similarly, the original previous application contains no indication that the embodiment discussed with reference to Figure 8 is to be interpreted in the light of claims 1 and 3 of this parent application or in the light of paragraph [0019]. In the proprietor's view, the latter contained general statements regarding the invention and applied to all embodiments. Paragraph [0019] explicitly disclosed the possibility of incisions being complete or partial.
21. The argument is not persuasive.
22. Paragraph [0019] is the first paragraph of the section dedicated to the detailed description of the preferred embodiments. Although this paragraph appears to describe, in general terms, the advantages of the techniques made possible by the invention, it does not contain any statement that its content applies to all

disclosed embodiments of the invention. The reference, in paragraph [0019], to a surface profiler, or other similar device, suggests something different, since the corresponding feature of a profilometer was only specified in dependent claim 4, i.e. as an option for the originally disclosed invention.

23. In its decision, the Opposition Division found that the two features of a partial incision and a bevel feature could be combined. This is not disputed by the Board. However, the mere possibility of a combination, even if that combination might have been obvious to the skilled person, is not sufficient to establish that this combination of features was originally disclosed. It is established case law of the boards of appeal, that an amendment is allowable under Article 100(c) EPC, Articles 123(2) EPC, or 76(1) EPC if there is a direct and unambiguous basis for it in the relevant, original application documents.
24. The proprietor put emphasis on the healing, sealing, and locking effects achieved by a cataract incision with a bevel feature. This was particularly relevant in the context of the invention, in which a partial incision was first performed in a non-sterile environment and later opened with a scalpel in the operating theatre. The bevel incision was to be understood in connection with such a procedure, and was particularly adapted for the healing, sealing and locking of the incision after surgery.
25. While the proprietor's arguments regarding the advantages of a partial incision with a bevel feature make sense in the context of the disclosure, they are insufficient to establish that this aspect was originally considered. A direct and unambiguous basis

establishing that the two aspects were considered in combination is simply missing. The structure of the original application as a whole appears entirely consistent with the view that the two embodiments disclosed in paragraphs [0051] and [0059] constitute separate disclosures. This is also fully consistent with the general statements in paragraph [0019]. Paragraphs [0051] and [0059] each illustrate two different implementations that offer the advantages mentioned in paragraph [0019] in terms of rapidity, improved accuracy, precision, and limitation of the risks associated with the making of incisions. While paragraph [0051] explicitly refers to the advantage of partial incisions in an *unsterile field*, paragraph [0059] refers to the alternative of a bevel structure that provides improved wound healing, sealing, or locking. In particular, the explicit reference to sealing and locking effects suggests an alternative to partial incisions, thereby reducing the risks of infection. A basis for the proprietor's argument that these effects related to the post-operative period is lacking.

26. Claim 2 of the main request thus contains added subject-matter, contrary to the requirements of Article 100(c) EPC.

Auxiliary request 1, 1A and 1B

27. Claim 1 of auxiliary requests 1, 1A, and 1B is based on combinations of claims 1 and 2; 1, 2, and 4; and 1, 2, 4, and 6 of the patent, respectively. Each independent claim of these auxiliary requests combines the features of a partially penetrating incision with the feature of granted claim 2 relating to a bevel incision. For the

reasons set out above with regard to claim 2 of the main request, the original parent application lack a basis for this combination of features (Article 76 EPC) in claim 1 of auxiliary requests 1, 1A and 1B.

28. Claim 1 of auxiliary requests 1, 1A, and 1B, therefore, contains added subject-matter, contrary to Article 100(c) EPC.

Referral to the Enlarged Board of appeal

29. The proprietor submitted a question to be referred to the Enlarged Board of Appeal, asking whether the interpretation in the sense of G 1/24 was also relevant for determining questions of added matter.
30. The proprietor's request was rejected (Article 112(1) (a) EPC).
31. In the Board's view, no decision is required under the circumstances. This is because the Board agreed with the proprietor that the description is to be taken into account for the interpretation of the claims when it has to decide on issues regarding added subject-matter.
32. Although the proprietor believed that such an interpretation would inevitably lead to the conclusion that the combination of an incision with a bevel structure with that of the incision being partial, is disclosed, the analysis developed above shows otherwise. The interpretation of the claims of the pending requests, in the light of the teaching developed in decision G 1/24, does not affect the finding that a direct and unambiguous finding for the claim combinations is missing.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



D. Meyfarth

P. Scriven

Decision electronically authenticated