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DECISION
of 21 April 2004

Case Number: T 0032/01 - 3.4.2

Application Number: 92917157.7

Publication Number: 0597994

IPC: G02C 7/04

Language of the proceedings: EN

Title of invention:

Toric lens with axis mislocation latitude

Applicant:

Dugmont Pty. Ltd.

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 52(1), 54(2), 56, 84, 113(2), 123(2)

Keyword:

"Unchallenged provisional opinion of the Board in communication under Article 11(1) RPBA: unclear requests, lack of clarity, added subject-matter, lack of novelty, lack of inventive step"

"Non appearance at oral proceedings"

"Dismissal of appeal on the grounds communication to the appellant"

Decisions cited:

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Catchword:

-



Case Number: T 0032/01 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 21 April 2004

Appellant:

Dugmont Pty. Ltd.
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Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 27 July 2000
refusing European application No. 92917157.7
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. G. Klein
Members: F. J. Narganes-Quijano
C. Rennie-Smith

Summary of Facts and Submissions

- I. The appellant (applicant) has appealed against the decision of the examining division to refuse European patent application No. 92917157.7 (based on the International application No. PCT/AU92/00418 published under International Publication No. WO 93/03409).

The decision under appeal was based on sets of claims according to a main and first to fourth auxiliary requests. In its decision the examining division held that claim 1 in each of the requests then on file did not comply with the requirements of Article 84 EPC and noted that the respective subject-matter was not patentable within the meaning of Articles 52(1), 54(2) and 56 EPC with regard to the prior art cited during the examination procedure.

- II. With the statement setting out the grounds of appeal the appellant submitted a main and first to third auxiliary requests each with an amended claim 1, and an amended dependent claim 6, and requested that the decision under appeal be set aside and that a patent be granted on the basis of one of these requests. The appellant also requested oral proceedings on an auxiliary basis.

Claim 1 according to the main request reads as follows:

"A toric lens which compensates for lens mislocation error when placed on an astigmatic eye, the lens having optical topography on at least one surface of the lens which provides built in latitude for automatic compensation for error in the correction of

astigmatism in the event that the principal meridians of powers of the lens move out of alignment with the principal meridians of power of the eye of a wearer; wherein the optical topography induces a depth of field or depth of focus effect on the eye which will either neutralise or compensate for astigmatic error in the event of a mislocation in the principal meridians of the lens and those of the wearer's eye requiring correction; and wherein the lens is thin enough to allow sufficient oxygen transmission therethrough to provide satisfactory morphology of the eye of the wearer."

In the first auxiliary request claim 1 differs from the main request in that the expressions "for automatic compensation for error in the correction of astigmatism" and "which will either neutralise or compensate for astigmatic error in the event of a mislocation in the principal meridians of the lens" are replaced by "for automatic correction of astigmatism" and by "which is capable of either neutralising or compensating for astigmatic error in the event of a mislocation of more than one degree of the principal meridians", respectively.

In the second auxiliary request claim 1 differs from the main request in that the expressions "for automatic compensation for error in the correction of astigmatism", "in the event of a mislocation in the principal meridians" and "to provide satisfactory morphology of the eye" are replaced by "for automatic correction of astigmatism", by "in the event of a mislocation in the order of 10 to 15 degrees of the

principal meridians" and by "thereby preserving satisfactory morphology of the eye", respectively.

In the third auxiliary request claim 1 differs from the main request in that the expressions "and wherein the lens is thin enough" and "to provide satisfactory morphology of the eye" are replaced by "wherein the lens has a thickness is 0.15 to 0.25 mm, which is thin enough" (*sic*) and by "thereby preserving satisfactory morphology of the eye", respectively.

III. Oral proceedings were appointed as requested by the appellant. In a communication pursuant to Article 11(1) of the Rules of Procedure of the Boards of Appeal (RPBA), annexed to the summons to attend oral proceedings, the Board gave a preliminary assessment of the case and indicated its provisional view that the application did not, according to any of the requests submitted by the appellant, appear to be allowable. The passages of the communication that are pertinent to the present decision are as follows:

(a) "It is not unambiguously clear in the requests formulated by the appellant with the grounds of appeal whether the amended dependent claim 6 submitted with the grounds of appeal replaces the previous dependent claim 6 according to all the present requests or only according to the present main request. It is also unclear whether the independent claim 13, the amended dependent claims and the amended description according to previous requests of the appellant are maintained according to the present main and auxiliary requests."

- (b) "The Board has doubts about the allowability under Articles 123(2) and 84 EPC of the amended claims at present on file, the reasons being as follows:
- (i) Claim 1 according to the present main request omits the feature relating to the optical topography of the lens enabling the axis powers of the lens to align with those of the eye. Since the corresponding feature was specified in claim 1 as originally filed and appears to be disclosed in the description as an essential feature (page 3, lines 29 to 33 and page 4, lines 12 to 17 of the application as published), its omission would appear to contravene both Articles 123(2) and 84 EPC.
 - (ii) For similar reasons, the omission in claim 1 according to the main request of the feature relating to the lens mislocation of 1 degree or more also appears to contravene the requirements of Articles 123(2) and 84 EPC.
 - (iii) The second alternative at line 6 of claim 1 of the main request relating to the "depth of focus" does not appear to be supported by the description (Article 84 EPC) nor by the original application (Article 123(2) EPC), it being noted in this respect that the depth of focus is not strictly synonymous with depth of field.
 - (iv) In the absence in claim 1 of the main request of any reference to the lens being of the contact lens type (see page 1, lines 8 to 11 together with line 27, and page 3, lines 29 to 36 of the application as published), the last of the features of the

claim relating to the definition of the thickness of the lens in terms of the oxygen permeability of the lens with respect to the morphology of the eye of the wearer is indefinite in the context of the claim (Article 84 EPC).

- (v) It is not unambiguously clear in the formulation of claim 1 according to the main request (Article 84 EPC) whether the astigmatism is corrected by the claimed toric lens itself or whether the claimed lens is only used for compensation of the angular misalignments of an additional astigmatism correcting lens, it being noted in this respect that only the first of these two alternatives would appear to be supported by the description (Article 84 EPC).
- (vi) The objections raised in paragraphs (i), (iii), (iv) and (v) above are also raised with regard to the amended claim 1 of the first to the third of the auxiliary requests at present on file, and the objection raised in paragraph (ii) above is also raised with regard to the amended claim 1 of the third auxiliary request.
- (vii) The amended feature of claim 1 of the first and the second auxiliary requests according to which the optical topography is suitable "for automatic correction of astigmatism" does not appear to be supported either by the original application (Article 123(2) EPC) nor by the description (Article 84 EPC) according to which astigmatism is corrected by the toric lens and the optical topography

refers to means for compensating errors in the correction of astigmatism by the lens caused by angular misalignments of the lens.

(viii) When compared with dependent claim 6 as published, the amended dependent claim 6 omits the expression "with little drop in visual performance". As a consequence of this omission, the amended dependent claim 6 encompasses embodiments in which mislocations up to 30° are strictly corrected for relatively high cylindrical powers greater than -2.50 dioptres. These embodiments, however, would not appear to be supported either by the description (Article 84 EPC) nor by the original application (Article 123(2) EPC), see in this respect page 6, lines 32 to 35 of the application as published and the observations in the [second] paragraph of point [(c)] below.

(ix) Notwithstanding the observations in point [(a)] above, it is noted with regard to the dependent claims that:

- the ion implantation and the birefringence techniques specified in claim 2 as originally filed cannot be considered to be encompassed by the generic technical meaning of the expression "optical topography" referred to in the corresponding claim 1, and that consequently these two alternatives defined in dependent claim 2 are inconsistent with the corresponding claim 1 (Article 84 EPC); and

- the feature defined in dependent claim 10 as originally filed does not appear to define any additional feature or particular embodiment of the lens defined in claim 1 (Article 84 and Rule 29(3) EPC), but a characteristic intrinsic to the family of lenses encompassed by the definition of the corresponding claim 1."
- (c) "The objections of lack of novelty and lack of inventive step (Articles 52(1), 54 and 56 EPC) raised by the examining division in the course of the first-instance proceedings on the basis of document D1 [EP-A-0439394] fail to persuade the Board because the document is silent as to the spherical aberration correction capability of the aspheric surfaces disclosed in the document. However, the same conclusion drawn by the examining division may be reached when the same rationale followed by the examining division on the basis of document D1 is applied to the disclosure of document EP-A-0375291 (in the following document D5) cited in the search report. This document discloses a contact lens having a toric back surface and diffractive surface means forming together an optical topography for correcting astigmatism and for enabling the axis of powers of the lens to align with those of the astigmatic eye of the wearer (abstract and page 4, lines 3 and 15 to 19), the diffractive surface means being also designed to correct spherical aberration (page 5, lines 25 to 36). As it is apparent from the compensation mechanism underlying the present invention (page 1, lines 2

to 7, page 2, line 37 to page 3, line 9, and page 5, lines 11 to 17 of the application as filed), the corrected spherical aberration will inherently increase in document D5 the depth of field and therefore will also inherently compensate for errors in the correction of astigmatism caused by angular misalignments of the lens with respect to the eye. Consequently, the spherical aberration correction diffractive surface means disclosed in document D5 will inherently achieve error compensation for at least small angular misalignments of the order of 1 degree. For higher angular misalignments of the order of 10 and up to 30 degrees the spherical correction disclosed in document D5 would also appear to inherently achieve a degree of compensation of the astigmatism correction errors comparable to that achieved according to the invention (see in this respect page 6, lines 26 to 35 and claim 6 of the application as published) and in any case, if this were not the case, the claimed compensation would then appear to be inherently achieved when carrying out the express teaching of document D5 relating to the correction of greater amounts of aberrations (page 5, lines 31 to 36).

These conclusions would appear to be particularly supported by the disclosure of document D5 relating to an astigmatism of 1 dioptre exemplified in the document (page 5, line 36 to page 6, line 34) since, as acknowledged in the present application (page 1, lines 33 to 37 together with page 6, lines 15 to 19 of the

application as published), the lower the astigmatism correction, the higher the angular misalignments that can be compensated, it being doubtful (Article 83 EPC) whether the mechanism proposed in the present application would achieve an acceptable compensation at relatively high angular misalignments for higher values of the astigmatism (see term "theoretically" on page 6, lines 32 to 35 of the application as published [...]).

In view of the above, it appears that the subject matter of claim 1 according to the main, the first and the second auxiliary requests would be inherently anticipated by the disclosure of document D5 (Articles 52(1) and 54 EPC), or at least rendered obvious by the teaching of document D5 (Articles 52(1) and 56 EPC) since the compensation specified in the claimed subject matter would merely constitute a bonus effect inevitably resulting from carrying out the express teaching of the document (see in this respect "Case Law of the Boards of Appeal" 4th edition 2001, chapter I, section D-7.7.1).

As regards the subject matter of claim 1 according to the third auxiliary request, the Board does not see in what respect the range of values of the thickness of the lens specified in the claim may contribute to inventive step (Articles 52(1) and 56 EPC)."

- IV. The appellant did not reply to the Board's communication or make any further submissions. The arguments in the statement of grounds of appeal in support of the appellant's requests pre-date, and thus have no bearing on, the issues subsequently raised by the Board in the communication annexed to the summons to oral proceedings.
- V. Oral proceedings before the Board were held on 21 April 2004. The appellant, albeit duly summoned, failed to appear at the oral proceedings. At the end of the oral proceedings the Board gave its decision.

Reasons for the Decision

1. The appeal is admissible.
2. In the communication pursuant to Article 11(1) RPBA annexed to the summons to oral proceedings the Board explained in detail why in its preliminary opinion:
 - (a) the requests of the appellant to be considered by the Board pursuant to Article 113(2) EPC were not clear, see point III-(a) above,
 - (b) claim 1 according to the main and the first to third auxiliary requests as well as the amended dependent claim 6 filed with the statement of grounds of appeal did not appear to comply with the requirements of Article 84 and 123(2) EPC, and dependent claims 2 and 10 on file did not appear to be clear (Article 84 EPC), see point III-(b) above, and

(c) the subject-matter of claim 1 according to the main and the first to third auxiliary requests did not appear to be novel (Articles 52(1) and 54(2) EPC) and in any case did not appear to involve an inventive step (Articles 52(1) and 56 EPC) with regard to the disclosure of document D5, see point III-(c) above.

3. In the course of the proceedings the appellant made no submissions in answer to the detailed objections raised by the Board in the communication under Article 11(1) RPBA and, more particularly, did not attend the oral proceedings which were held in its absence pursuant to Rule 71(2) EPC. The appellant has therefore not availed itself of the opportunity to reply to the preliminary view of the Board expressed in the communication.

4. After consideration of the reasons advanced in the communication under Article 11(1) RPBA and in the absence of any attempt by the appellant to clarify its requests (point III-(a) above) and to refute or overcome the objections raised by the Board with regard to the application documents on file (points III-(b) and (c) above), the Board sees no reason to depart from the preliminary opinion expressed in the communication. Accordingly, noting that the appellant has had, and has failed to use, the opportunity to present comments on the objections raised by the Board in the aforementioned communication (Article 113(1) EPC), the Board concludes that the requests of the appellant do not comply with the requirements of the EPC mentioned in paragraphs 2-(a), (b) and (c) above and that the appeal must therefore be dismissed for the reasons

already communicated to the appellant and reproduced in points III-(a), (b) and (c) above.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

P. Martorana

A. G. Klein