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**Datasheet for the decision
of 6 September 2011**

Case Number: T 1388/08 - 3.2.02

Application Number: 95911745.8

Publication Number: 0746237

IPC: A61B 17/00

Language of the proceedings: EN

Title of invention:

Hingeless intraocular lens microcartridges

Patentee:

Staar Surgical Company

Opponent:

HOYA CORPORATION

Headword:

-

Relevant legal provisions:

EPC Art. 123(2), 84

Relevant legal provisions (EPC 1973):

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Keyword:

"Extended subject-matter (yes)"

"Clarity (no)"

Decisions cited:

-

Catchword:

-



Case Number: T 1388/08 - 3.2.02

DECISION
of the Technical Board of Appeal 3.2.02
of 6 September 2011

Appellant:
(Opponent)

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Respondent:
(Patent Proprietor)

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Decision under appeal:

Interlocutory decision of the Opposition
Division of the European Patent Office posted
8 May 2008 concerning maintenance of the
European patent No. 0746237 in amended form.

Composition of the Board:

Chairman: D. Valle
Members: P. L. P. Weber
A. Pignatelli

Summary of Facts and Submissions

I. The appellant (opponent) lodged an appeal on 18 July 2008 against the decision of the Opposition Division posted on 8 Mai 2008 to maintain the patent in amended form. The fee for the appeal was paid on the same day and the statement setting out the grounds for appeal was received on 17 September 2008.

II. The opposition was based on Article 100 (a) EPC.

III. Oral proceedings took place on 6 September 2011.

The appellant (opponent) requested that the decision under appeal be set aside and that the patent be revoked.

The respondent (patentee) requested that the patent be maintained on the basis of the auxiliary request filed with letter of 3 December 2010.

IV. Claim 1 of the sole request reads as follows:

"A hingeless lens microcartridge (200) for use with a surgical device for implantation of a deformable intraocular lens into the eye through a relative small incision made in the ocular tissue, the lens microcartridge (200) comprising:

a lens holder portion (202) having a lens receiving portion (206) for receiving and holding the deformable intraocular lens; and

a nozzle portion (204) connected to and extending from the lens holder portion (202) and having an outer wall and a free end, the lens holder portion (202) and the

nozzle portion (204) having a continuous passageway extending therethrough, the lens holder portion (202) including a transition portion (208) with an oval shaped barrel (222) located between the lens receiving portion (206) and the nozzle portion (204), wherein the transition portion (208) has a cross section that tapers inwardly from the lens receiving portion (206) to the nozzle portion (204), characterized in that the transition portion (208) has a pair of longitudinal grooves (226) through which the deformable intraocular lens is guided, the grooves (226) remaining in the same horizontal plane."

- V. The appellant argued essentially as follows. Claim 1 contained subject-matter not originally disclosed. In particular the feature that the grooves were present only in the transition portion was not disclosed. The feature that the grooves remained in the same horizontal plane was not clear.
- VI. The respondent contested the arguments of the appellant and argued in particular that the feature that the grooves should extend also in the receiving portion was not presented in the original disclosure as essential for the invention. The person skilled in the art would immediately understand reading the patent application that that was not the case. Furthermore, Figures 45 to 47 clearly showed a case where the grooves were present only in the transition section.

Claim 1 was also clear. The feature that the grooves remained in the same horizontal section was clear in view of the passage at page 20 of the original application, lines 7-9, where it was said with

reference to Figure 34, that the top surfaces defining grooves 226 and bottom surface 228 are parallel. The term horizontal referred to the view of the Figure 34, representing the case when the cartridge was laid on an horizontal plane before use.

Reasons for the Decision

1. The appeal is admissible.
2. Extended subject-matter

Claim 1 contains the feature that the transition portion (208) has a pair of longitudinal grooves (226). That means that the protection conferred by the claim extends also to the case where the grooves are present only in the transition portion.

However, there is no positive disclosure in the originally filed application of a cartridge according to the invention having grooves only in the transition portion. On the contrary, consistently, throughout the application it is disclosed that the grooves extend at least to the receiving portion and the transition portion, see page 20, lines 16-18: "the grooves 226 in the receiver portion 206, as shown in Figure 38, ... extend continuously to the grooves of the transition portion 208."; page 21, lines 1-10: "A deformable intraocular lens 234 is loaded on top of the receiver portion 206 ... [and is] pushed into the receiver portion 206 until it is fully inserted in the oval shaped configuration shown in Fig. 43. ... The grooves defined by the surfaces 226 hold the lens in position

and guide it while the lens is being pushed through the microcartridge by the insertion instrument."

The argument of the respondent that Figures 41-43 represented an embodiment where the grooves were provided only in the transition portion can not be followed. Figures 41-43 (front and rear views of the cartridge) together with Figure 40 (longitudinal vertical section) are merely the embodiment of Figure 34 with the additional illustration of the method of insertion of the intraocular lens, see page 13 of the original application, lines 7-18. The embodiment of Figure 34, on the other hand, clearly shows grooves in the receiving portion 206, see Figure 38, which shows the transversal section of the cartridge through the receiving portion.

It is further to be noted that the grooves described in the description are described in relation to these figures so that there can be no doubt that the cartridge shown in Figure 34 is meant to have grooves in the receiving portion.

On the contrary nothing in the description supports the view of the respondent that Figures 41 and 42 would clearly show a receiving portion without any grooves. In the Board's view, it can not be concluded from the apparent absence of grooves in the receiving portion of the cartridge shown in Figures 41 and 42, that these figures would unambiguously teach the skilled reader that an embodiment without grooves was intended to belong to the described invention.

The further argument of the respondent that in any case was evident that the grooves in the receiving portion were not essential is not convincing either. On the contrary, on the base of Figures 40-43 cited by the respondent and of the above cited passage of the description explaining the way of inserting the lens according to the claimed invention (page 21, lines 1-10), the Board is convinced that the grooves in the receiving portion are essential in order to carry out the invention. The lens is inserted in the cartridge through a lateral slot 212 in the receiving portion. The insertion of the lens is done by folding it to adapt it to the internal contour of the receiving portion. The lens is kept in place by snapping its border against the grooves. By use, the cartridge is lodged into the insertion instrument and then the lens is pushed forward through the transition and the nozzle portion and finally ejected through the nozzle. In order to safely push forward the lens from the receiving portion to the transition portion, the lens must be kept in place. To this purpose grooves are provided. Without grooves in the receiving portion the lens could spring out through the slot of the receiving portion. In the view of the Board this is the meaning of the sentence at page 21, lines 8 and 9, that the grooves hold the lens in position and guide it while the lens is being pushed through the microcartridge.

Accordingly, the subject-matter of claim 1 goes beyond the original disclosure and Article 123 (2) EPC is not met.

3. Clarity

The Board finds also that claim 1 does not comply with Article 84 EPC because the sentence that the grooves are in the same horizontal plane is not clear. The grooves do not lie in a plane but are three-dimensional. Furthermore, as it is explained in the patent in suit, grooves are provided with protrusions 230 which become less pronounced in a direction extending towards the nozzle portion. That adds a further level of uncertainty in the definition of the horizontal plane. For that reason is not possible to give a clear meaning to the sentence that the grooves are in a horizontal plane.

The respondent argued that the top surfaces 226 define the grooves, see column 12 of the patent in suit, lines 32-34. However, it is not clear what it is meant with top surfaces, also because, in the passage following the passage cited by the respondent it is further said that the top 226 (i.e. the top surfaces or grooves) is provided with a downwardly extended protrusion 230 having curved sides. Further down in the same column, point 0067 it is further said that the grooves 226 are defined by curled upper portions. These various definitions of the grooves make it impossible to clearly understand what it is really meant with the term grooves and make the sentence that the grooves are in the same plane unclear.

Accordingly, claim 1 does not comply with Article 84 EPC.

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. Sauter

D. Valle