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Datasheet for the decision of 8 April 2010

Case Number: T 1548/08 - 3.2.02

Application Number: 99304229.0

Publication Number: 0962196

IPC: A61F 2/16

Language of the proceedings: EN

Title of invention:
Intraocular lens

Patentee:
Rayner Intraocular Lenses Limited

Opponent:
i-Medical Medizin-Produkte Vertrieb GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 56, 100(a)(b), 112(1)(a), 114(2), 123(2)
EPC R. 117, 124(1)
RPBA Art. 12(4), 13(1)(3)

Relevant legal provisions (EPC 1973):
EPC Art. 54(1)(2), 83, 113(1)
EPC R. 68(2)

Keyword:
"Novelty (no)"
"Admissibility of new requests (no)"
"Substantial procedural violation (no)"
"Referral to Enlarged Board of Appeal (no)"

Decisions cited:
G 0009/91, G 0003/98, T 0840/93, T 0921/94, T 0071/06

Catchword:

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 1548/08 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 8 April 2010

Appellant: (Patent Proprietor)	Rayner Intraocular Lenses Limited 1-2 Sackville Road Trading Estate Hove East Sussex BN3 7AN (GB)
Representative:	Perry, Robert Edward Gill Jennings & Every LLP Broadgate House 7 Eldon Street London EC2M 7LH (GB)
Respondent: (Opponent)	i-Medical Medizin-Produkte Vertrieb GmbH Wieblinger Weg 100 D-69123 Heidelberg (DE)
Representative:	Weber, Walter Weber & Seidel Rechts- und Patentanwälte Handschuhsheimer Landstrasse 2a D-69120 Heidelberg (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted 7 July 2008 revoking European patent No. 0962196 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman: M. Noël
Members: C. Körber
A. Pignatelli

Summary of Facts and Submissions

I. By decision posted on 7 July 2008 the Opposition Division decided to revoke European patent No. 0962196 on the grounds of extended subject-matter (Articles 123(2) and 100(c) EPC) and lack of novelty (Articles 54 and 100(a) EPC).

II. An appeal was lodged against this decision by the patentee (appellant) by notice received on 4 August 2008. The appeal fee was received on 22 August 2008. The statement setting out the grounds of appeal was received on 17 November 2008, accompanied by a main request and auxiliary requests 1 to 5. The counter-statement of the respondent (opponent) was received on 11 March 2009. A preliminary opinion of the Board was sent to the parties by a communication dated 21 January 2010 together with the summons to oral proceedings. With letter of 8 March 2010, the appellant submitted auxiliary requests 4 to 11.

III. On 8 April 2010 oral proceedings were held, at the end of which the appellant requested that the decision under appeal be set aside and that the patent be maintained as granted (main request), or in amended form on the basis of auxiliary requests 1 to 3 or 6 to 7 filed with letter dated 17 November 2008 (previously denoted as auxiliary requests 1 to 5, with auxiliary requests 4 and 5 being renumbered as auxiliary requests 6 and 7, as requested by letter of 8 March 2010), or auxiliary requests 4, 5 and 8 to 11 filed with letter dated 8 March 2010, or auxiliary requests 12 and 13 filed during the oral proceedings.

IV. The respondent requested that the appeal be dismissed. He further proposed a number of questions regarding the examination of sufficiency of disclosure (see point VII below) to be referred to the Enlarged Board of Appeal.

V. The following documents are considered in the present decision:

D1: EP-A-0 766 952 (supplemented by enlarged drawings D1.1 to D1.3 illustrating the pliability of the haptics shown in Figure 6A of D1, submitted with the statement of the grounds of opposition dated 14 November 2005).

VI. Claim 1 of the various requests in turn reads as follows:

Main request:

"An intraocular lens comprising an optic (1) and two or more curved haptics (3a, 3b) which can be compressed, in the plane of the lens, wherein each haptic is shaped such that, in use, the proximal part of the haptic can be fully compressed prior to compression of the distal part; and wherein the haptics are compressed to provide an essentially elliptical form (8b) of the lens."

Auxiliary request 1:

"An intraocular lens comprising an optic (1) and two or more curved haptics (3a, 3b) which can be compressed, in the plane of the lens, wherein each haptic is shaped such that, in use, the proximal part of the haptic can be fully compressed prior to compression of the distal

part; and wherein the haptics are compressed to provide an essentially elliptical form (8b) of the lens, to provide a lens that is essentially resistant to haptic failure."

Auxiliary request 2:

"An intraocular lens comprising an optic (1) and two or more curved haptics (3a, 3b) which can be compressed, in the plane of the lens, wherein each haptic includes an aperture (4a, 4b) having opposed points (5, 6) and each haptic is shaped such that, in use, the opposed points (5, 6) are brought into contact, during compression of the proximal part, and the proximal part of the haptic can be fully compressed prior to compression of the distal part; and wherein the haptics are compressed to provide an essentially elliptical form (8b) of the lens."

Auxiliary request 3:

"An intraocular lens comprising an optic (1) and two or more curved haptics (3a, 3b) which can be compressed, in the plane of the lens, wherein each haptic includes an aperture (4a, 4b) having opposed points (5, 6) and each haptic is shaped such that, in use, the opposed points (5, 6) are brought into contact, during compression of the proximal part, and the proximal part of the haptic can be fully compressed prior to compression of the distal part; and wherein the haptics are compressed to provide an essentially elliptical form (8b) of the lens, to provide a lens that is essentially resistant to haptic failure."

Auxiliary request 4:

"An intraocular lens comprising an optic (1) and two or more curved haptics (3a, 3b) which can be compressed, in the plane of the lens, wherein each haptic includes an aperture (4a, 4b) having opposed points (5, 6) and each haptic is shaped such that, in use, the opposed points (5, 6) are brought into contact, during compression of the proximal part, thereby defining a proximal part that is fully compressed and a distal part that can undergo further compression, such that the proximal part of the haptic is fully compressed prior to compression of the distal part; and wherein the haptics are compressed to provide an essentially elliptical form (8b) of the lens."

Auxiliary request 6:

"An intraocular lens comprising an optic (1) and two or more curved haptics (3a, 3b) which can be compressed, in the plane of the lens, wherein each haptic includes an aperture (4a, 4b) of which opposed points (5, 6) are brought into contact, during compression of the proximal part, and the proximal part of the haptic can be fully compressed prior to compression of the distal part, wherein the opposed points effectively define a bend in the aperture and the boundary between proximal and distal parts of the haptic; and wherein the haptics are compressed to provide an essentially elliptical form (8b) of the lens."

Auxiliary request 7:

"An intraocular lens comprising an optic (1) and two or more curved haptics (3a, 3b) which can be compressed, in the plane of the lens, wherein each haptic includes an aperture (4a, 4b) of which opposed points (5, 6) are brought into contact, during compression of the proximal part, and the proximal part of the haptic can be fully compressed prior to compression of the distal part, wherein the opposed points effectively define a bend in the aperture and the boundary between proximal and distal parts of the haptic; and wherein the haptics are compressed to provide an essentially elliptical form (8b) of the lens, to provide a lens that is essentially resistant to haptic failure."

Auxiliary request 8:

"An intraocular lens comprising an optic (1) and two or more curved haptics (3a, 3b) which can be compressed, in the plane of the lens, wherein each haptic includes an aperture (4a, 4b) that is essentially S-shaped and having opposed points (5, 6) and each haptic is shaped such that, in use, the opposed points (5, 6) are brought into contact, during compression of the proximal part, thereby defining a proximal part that is fully compressed and a distal part that can undergo further compression, such that the proximal part of the haptic is fully compressed prior to compression of the distal part; and wherein the haptics are compressed to provide an essentially elliptical form (8b) of the lens."

Auxiliary request 10:

"An intraocular lens comprising an optic (1) and two or more curved haptics (3a, 3b) which can be compressed, in the plane of the lens, wherein each haptic includes an aperture (4a, 4b) being shaped as depicted in Figure 1A and having opposed points (5, 6) and each haptic is shaped such that, in use, the opposed points (5, 6) are brought into contact, during compression of the proximal part, thereby defining a proximal part that is fully compressed and a distal part that can undergo further compression, such that the proximal part of the haptic is fully compressed prior to compression of the distal part; and wherein the haptics are compressed to provide an essentially elliptical form (8b) of the lens."

Auxiliary request 12:

"An intraocular lens comprising an optic (1) and two or more curved haptics (3a, 3b) which can be compressed, in the plane of the lens, wherein each haptic is shaped such that, in use, the proximal part of the haptic can be fully compressed prior to compression of the distal part; and wherein the haptics are compressed to provide an essentially elliptical form (8b) of the lens; and wherein each haptic is at least 0.6 mm thick."

Claim 1 according to auxiliary requests 5, 9, 11 and 13 differs from claim 1 according to auxiliary requests 4, 8, 10 and 12, respectively, in that it comprises the additional feature "to provide a lens that is essentially resistant to haptic failure".

VII. The arguments of the appellant are summarized as follows:

Auxiliary requests 4, 5 and 8 to 11 were submitted one month before the oral proceedings and in response to the novelty objection raised in the Board's communication annexed to the summons to oral proceedings. The additional features introduced into claim 1 of auxiliary requests 4 and 5 represented a more precise definition of the compression behaviour clearly present in the description. The geometrical shape of the apertures according to auxiliary requests 8 to 11 was always a subject of the proceedings. These requests should thus be allowable in spite of their late filing.

Auxiliary requests 12 and 13 submitted during the oral proceedings both included the feature of dependent claim 4, which was not explicitly opposed and thus not a subject of the decision of the Opposition Division. In view of G 9/91, the decision of the Opposition Division was therefore to be considered null and void since the patent could not be revoked without dealing with dependent claim 4. Accordingly, these requests did not amend the appellant's case and should not come as a surprise to the respondent.

There was no reason to refer any of the questions raised by the respondent to the Enlarged Board of Appeal since the underlying issues did not relate to important points of law requiring clarification.

D1 was entirely silent with respect to the compression behaviour of the haptics and in particular did not

disclose two-stage compression, as defined in claim 1 according to all requests. The term "fully compressed" was to be understood as explained in paragraph [0014] of the patent specification. It was not possible to determine the compression behaviour of the lens depicted in Figure 6A of D1 since the material of the haptics was not disclosed. Bringing pre-defined opposed points of the aperture into contact upon compression, as required by claim 1 of auxiliary requests 2 and 3, could not be derived from D1 either. The configuration shown in Figure 6A would result in a contact area, rather than a point of contact. There was also no bend in the aperture and no boundary defined by opposed contact points, as required by claim 1 of auxiliary requests 6 and 7.

Furthermore, D1 failed to disclose that the haptics could be compressed in the plane of the lens, as defined by claim 1 according to all requests, since Figure 6B clearly showed that the haptics were angled with respect to the plane of the lens. The statement in column 6, lines 25 to 28, that the haptics could be compressed in the median plane of the lens only related to the insertion of the foldable lens into the eye, which was the main aspect of D1, and not to their compression due to a contraction of the capsular sac. This difference was reflected by the term "in use" in claim 1 of the main request and auxiliary requests 1 to 3.

The feature that the lens was resistant to haptic failure, included in claim 1 of the odd-numbered auxiliary requests, was not derivable from D1, either. The avoidance of buckling upon compression, mentioned

in column 6, lines 26 and 27 of D1, was also addressed with respect to the insertion of the lens, rather than in relation to its implanted state in the capsular sac.

The test results provided with the statement of the grounds of appeal ("RDTR908") and with the letter of 11 November 2009 ("RDTR908/2") demonstrated that the lens shown in Figure 6 of D1 could not be compressed in the plane of the lens and was not resistant to haptic failure, in contrast to the lens according to the patent in suit.

VIII. The arguments of the respondent are summarized as follows:

The late-filed auxiliary requests 4, 5, and 8 to 13 should not be admitted in the procedure. They could have been submitted much earlier and did not respond to the objections raised. The fact that the underlying features were present in the description or drawings did not oblige the opposing party to deal with them. Moreover, some of these features related to unsearched subject-matter, thus requiring an adjournment of the oral proceedings and being likely to result in an unacceptable remittal to the first instance. Furthermore, a divisional application comprising the same set of claims had been filed and was still pending in examination proceedings. In such a situation, late-filed requests which were not examined in the first instance proceedings should not be accepted (according to T 840/93).

The features underlying auxiliary requests 12 and 13 were present in dependent claim 4 as granted. They were

a subject of the decision under appeal because a dependent claim is part of the decision even if it is not explicitly mentioned. If the appellant wanted to disagree with this, he should have contested this issue in the statement of grounds of appeal.

The Board should appoint an independent expert in case of doubts about the compression behaviour of the claimed lens, in particular if its decision was likely to be affected by the contradictory test results submitted by both parties.

The Opposition Division had not considered the opponent's arguments regarding the compression behaviour of the lens as claimed, and had declined the request to obtain an expert's opinion in this respect, merely formally acknowledging the opponent's submissions without any reasoning. All these facts constituted a substantial procedural violation of the right to be heard.

The Opposition Division had not thoroughly examined the question of sufficiency of disclosure under Article 83 EPC. In its decision, it gave the impression that this criterion was fulfilled, since the patent was revoked for other reasons. To ensure a uniform application of the law, the following questions should be referred to the Enlarged Board of Appeal:

I. Is an Opposition Division obliged to examine sufficiency of disclosure with regard to a claimed feature (if a respective objection was raised in opposition) even if the patent is to be revoked for other reasons?

II. If the Opposition Division affirms the sufficiency of disclosure of a feature in spite of revocation of the patent for other reasons:

1. To what extent is the Division obliged to examine the opponent's arguments with respect to lack of sufficiency and to deal with them in its decision?

2. To what extent is the Division obliged to investigate the evidence offered by the opponent?

3. Is it necessary to provide reasoning if offers of evidence are not investigated, and must this reasoning deal with all substantiated relevant facts (relevant for the case where the other grounds for revocation do not succeed)?

The subject-matter of claim 1 according to the main request as well as that of auxiliary requests 1 to 7 was known from D1, in particular from Figure 6a and the text in column 6, lines 20 to 28, explicitly mentioning the compressibility of the haptics in the plane of the lens without buckling, i.e. resistance to haptic failure. The two-stage compression behaviour was illustrated in D1.1 to D1.3 and also evidenced by the comparative test results submitted as "E13" with letter of 13 May 2008. All intraocular lenses were in essence designed to be "resistant to haptic failure". Consequently, this feature was also disclosed implicitly in D1. A statement made by one of the representatives of the appellant during the oral proceedings before the Board, commenting on the experimental deducibility of the compression behaviour

of the haptics from the disclosure of D1, should be included in the minutes.

Furthermore, the term "fully compressed" in claim 1 was objectionable under Article 83 EPC 1973. Full compression of the proximal part at the end of the first stage of compression in fact corresponded to only about 50% of the total compression finally achieved, as shown in Figure 4 of the patent in suit. No structure was disclosed where the proximal part of the haptic was fully compressed prior to compression of the distal part, as required by claim 1 of all requests.

Reasons for the Decision

1. The appeal is admissible.

2. *Late filed submissions*

According to Article 12(4) RPBA, the Board can hold inadmissible requests that could have been presented in the first instance proceedings. Pursuant to Article 13(1) RPBA the admissibility of amendments to a party's case after it has filed its grounds of appeal is subject to the discretion of the Board. The discretion is to be exercised in view of inter alia the complexity of the new subject matter submitted, the current state of the proceedings and the need for procedural economy. Furthermore, according to Article 13(3) RPBA, amendments submitted after oral proceedings have been arranged shall not be admitted if they raise issues which the Board or the other party

cannot reasonably be expected to deal with without adjournment of the oral proceedings.

The Board cannot see any justification for the late filing of auxiliary requests 4, 5 and 8 to 13. The explanation that these requests were filed in reaction to the Board's communication is not acceptable in the present case since the objections of extended subject-matter and lack of novelty mentioned in this communication correspond to the respective objections already raised in the first instance proceedings which led to the revocation of the patent. Consequently, all these requests could have been filed in the first instance proceedings or with the grounds of appeal. Accordingly, they are inadmissible under Article 12(4) RPBA.

Furthermore, the features introduced into claim 1 of auxiliary requests 8 to 11 (specifying the geometrical shape of the apertures) were never claimed before. They are taken from the drawings and relate to unsearched subject-matter. Moreover, these requests gave rise to further objections by the respondent under Articles 84 and 56 EPC. This would justify an adjournment of the oral proceedings and possibly even require a remittal to the first instance. Accordingly, their admission would be contrary to the principle of procedural economy. These requests are therefore not admitted under Article 13(1) and (3) RPBA.

With respect to the late filing of auxiliary requests 12 and 13, the appellant's arguments are not convincing.

A dependent claim is for logical reasons a subject of the decision of the Opposition Division to revoke the patent, even if it has not been explicitly mentioned in the decision or in the notice of opposition, because a dependent claim cannot be maintained if the impugned independent claim from which it depends is not allowable. In the present case, no request was submitted during the opposition proceedings which included an independent claim comprising the features of dependent claim 4. Therefore, the subject-matter of dependent claim 4 was a subject of the decision of the Opposition Division, which was entitled to revoke the patent in its entirety even if this dependent claim was not explicitly impugned or examined.

Auxiliary requests 12 and 13 are therefore amendments to the appellant's case, and their admissibility is also subject to the discretion of the Board under Article 13(1) RPBA. They could have been filed earlier, either during the first instance proceedings or in the appeal proceedings. The appellant has not given any justification for the late filing of these requests during the oral proceedings in appeal. They are not admissible for the reasons already given above.

Accordingly, late-filed auxiliary requests 4, 5, and 8 to 13 are not admitted into the present appeal proceedings under Article 114(2) EPC in conjunction with Articles 12(4), 13(1) and (3) RPBA.

3. *Novelty vis-à-vis document D1*

3.1 Main request

D1 discloses (see Figure 6A and corresponding text) an intraocular lens as defined in claim 1 as granted, comprising an optic 40 and two or more curved haptics 41 which can be compressed, in the plane of the lens (column 5, lines 23 to 26; column 6, lines 25 to 26), wherein each haptic is shaped such that, in use, the proximal part of the haptic can be fully compressed prior to compression of the distal part (as illustrated in D1.2); and wherein the haptics are compressed to provide an essentially elliptical form of the lens (as illustrated in D1.3). The illustrations D1.1 to D1.3 provided by the respondent as an interpretation of the compression behaviour of the haptics shown in Fig. 6A of D1 are accepted by the Board. The term "essentially elliptical" in claim 1 is to be given the same broad meaning in D1 as in the patent in suit (see paragraph [0013] and reference numeral 8b in Figure 4).

The term "fully compressed" is to be understood as having the special meaning explained in paragraph [0014] of the patent in suit. In the Board's view, the two-stage-compression behaviour as defined in claim 1 as granted, even though not explicitly described in D1, inevitably occurs when the lens shown in Figure 6A is subjected to radially uniform compression, as caused by contraction of the capsular sac. This has been convincingly illustrated by the respondent in illustrations D1.1 to D1.3. The compression behaviour may not be exactly as depicted, but it is clear that initial compression of the haptics 41 will necessarily first lead to collapse of the aperture 42 and thus to abutment of opposed points of its walls (D1.2). Subsequently, further compression will finally bring the distal ends of the haptics into contact with the

periphery of the optic 40 (D1.3), exactly as described in paragraph [0014] of the contested patent. As soon as two opposed points of the aperture come into contact with each other, the first stage of compression is achieved, resulting in "full compression" of the proximal part as defined in paragraph [0014]. As a matter of fact, the contact between two opposed points of the aperture depicted in Figure 6A of D1 during compression of the haptics is inevitable. It follows that the proximal part of each haptic can be "fully compressed" prior to compression of the distal part, within the meaning of claim 1 as granted. This compression behaviour is a functional attribute of haptics having an aperture as shown in Figure 6A and is thus implicitly disclosed in D1.

The appellant's argument that D1 does not describe any compression behaviour and does not allow its analysis since the materials of the haptics are not disclosed is not accepted in view of the information given in this document about the materials (see for instance the last two paragraphs of column 2 and last paragraph of column 3). These materials are well known to the person skilled in the art.

The "in use" requirement does not distinguish the claimed subject-matter over D1 since the kind of "use" is not at all specified in the claim. It is to be noted that a claim to a device also covers the uses of the device, so that a difference in use, if any, is unable to confer novelty on the device. The appellant's argument that D1 is primarily concerned with the insertion of the lens into the eye and that the phrase "substantially without buckling" in line 26 of column 6

of D1 must necessarily also relate to properties achieved during insertion, rather than to the conditions after implantation when capsular sac shrinkage occurs, is not convincing since the "use" of the lens also includes its insertion into the eye. Moreover, the second paragraph of column 5 of D1 explicitly deals with the centration of the lens, i.e. with conditions after implantation of the lens into the eye.

The fourth paragraph of column 6 of D1 states that the "haptics can be compressed in the median plane of the lens" and explicitly refers to Figures 5 to 7B, including Figures 6A and 6B. There is no reason to restrict the above-cited statement to Figures 7A and 7B only since Figure 7B shows haptics lying in the median plane of the lens whereas Figure 6B shows haptics angled with respect to this plane, as argued by the appellant. Moreover, even in case of slight angulation as shown in Figure 6B, the haptics are not prevented from being compressed, at least to some extent, in the plane of the lens. The wording of the claim does not rule out that some compression may also occur outside this plane. Furthermore, compressibility of the haptics in the median plane of the lens is mentioned more generally in lines 23 to 26 of column 5 of D1.

3.2 Auxiliary requests

Claim 1 of auxiliary request 1 additionally includes the phrase "to provide a lens that is essentially resistant to haptic failure" which was comprised in claim 1 as originally filed. This feature is also present in claim 1 of auxiliary requests 3 and 7.

Claim 1 of auxiliary requests 2 and 3 comprises the features of granted claims 1 and 2, i.e. the additional requirement that each haptic includes an **aperture having opposed points brought into contact, in use**. Claim 1 of auxiliary requests 6 and 7 additionally requires that the opposed points effectively define a **bend** in the aperture and the **boundary** between proximal and distal parts of the haptic (cf. page 3, lines 14 to 16 of the application as originally filed), while the expression "in use" comprised in the higher ranking requests is omitted.

3.2.1 Resistance to haptic failure

The additional feature "to provide a lens that is essentially resistant to haptic failure" included in claim 1 of auxiliary requests 1, 3 and 7 does not represent a novelty-conferring distinction over D1. In fact, this feature is a general requirement common to all intraocular lenses, including the one disclosed in D1, without the need of an explicit disclosure. Moreover, the definition of "haptic failure" given in the patent in suit ("dislocation caused by buckling or twisting of the haptic", column 1, lines 18 to 20) is very general and corresponds to what is mentioned in line 26 of column 6 in D1: "the haptics can be compressed in the median plane, substantially without buckling". The further specification in D1 that the final diameter should be suitable for insertion of the lens into the eye, whereas "haptic failure" in the patent in suit relates to conditions after implantation upon capsular sac contraction, is of no further relevance since the wording of the claim merely states

"essentially resistant to haptic failure", without defining any final diameter.

In the Board's view, the issues of the compression behaviour and the resistance to haptic failure can be decided on the basis of D1 alone, i.e. without having to take into consideration the test results provided by both parties ("E13" filed by the respondent and "RDTR908" and "RDTR908/2" submitted by the appellant). The broad definitions of the compression behaviour "in use" and "essentially resistant to haptic failure" given in claim 1 and in the patent specification are not such as to permit meaningful experiments allowing a reliable comparison with the prior art. The test conditions (compression techniques in vitro, in vivo animal experiments) as well as the properties of the lenses tested can be varied with respect to numerous parameters, and thereby yield entirely different or even contradictory results. Moreover, the conditions found in the human eye can hardly be replicated at all. Accordingly, the significance of any such test results is regarded as doubtful, so that the respective results submitted by both parties are not able to change the conclusions of the Board.

3.2.2 Aperture having opposed contact points

The considerations presented under point 3.1 in relation to the main request also apply to the features added to claim 1 of auxiliary requests 2 and 3, according to which "each haptic includes an aperture having opposed points and each haptic is shaped such that, in use, the opposed points are brought into contact, during compression of the proximal part, and

the proximal part of the haptic can be fully compressed prior to compression of the distal part". As explained above, the contact between "two opposed points" of the aperture depicted in Figure 6A of D1 during compression of the proximal part of the haptics is inevitable, and the claim does not define further details of the contact points besides their "opposed" location in the aperture.

3.2.3 Opposed points defining a bend and boundary

Claim 1 of auxiliary requests 6 and 7 includes the additional limitation that "the opposed points effectively define a bend in the aperture and the boundary between proximal and distal parts of the haptic", further described in paragraph [0011] of the contested patent. The aperture 42 shown in Figure 6A of D1 is clearly curved and the opposed points therefore define a "bend" in the aperture. Contrary to the opinion of the appellant, the location of the opposed points to be brought into contact is not specified in claim 1. Consequently, the resulting boundary between the proximal and distal parts of the haptics remains ill-defined and entirely open as well. Wherever the contact between the walls upon compression first occurs, a "boundary" between the proximal and distal parts is formed, with the proximal part being "fully compressed" and the distal part being further compressible. Appellant's argument that, in the configuration shown Figure 6A of D1, the compression of the haptics would allow a contact area to be formed instead of a contact point, is neither realistic nor convincing since the contact of the opposed "points" 5 and 6 shown in Figure 3 of the contested patent

corresponds likewise to an area rather than a contact point, taken in a mathematical sense.

3.3 From the above it follows that the subject-matter of claim 1 of the main request and auxiliary requests 1 to 3, 6 and 7 is not new within the meaning of Article 54(1) and (2) EPC 1973.

4. Since none of the above-mentioned requests is allowable for lack of novelty vis-à-vis D1, it is not necessary for the Board to deal further with the additional objections under Article 83 EPC 1973 and Article 123(2) EPC raised by the respondent.

5. *Procedural issues*

5.1 Expert's opinion

Since the Board was able to decide the case without relying on the diverging test results provided by both parties, as indicated above (point 3.2.1), it did not find it necessary to appoint an independent expert. All the elements of information already on file and the general knowledge of the skilled person provided the Board with a sufficient basis to reach a decision, particularly when taking into account the equally general teachings of the patent in suit and of document D1.

5.2 Right to be heard

The Opposition Division duly and correctly exercised its discretionary power when refusing to appoint or accept an expert or to hear Mr. E. Roth at the oral

proceedings, as indicated in points 7.2 and 7.3 of the decision under appeal.

The evidence and crucial arguments submitted by the opponent were duly considered and analysed by the Opposition Division, so that its conclusions cannot be regarded as a "mere formal acknowledgement of the submissions", as argued by the respondent (cf. also T 921/94, reasons 6.2.3). Moreover, the Opposition Division decided in point 4 of the decision on the issue of sufficiency in a reasoned manner as required by Rule 68(2) EPC 1973, and was clearly entitled to decide on this issue. The right to be heard under Article 113(1) EPC 1973 is fulfilled, and no substantial procedural violation can be ascertained.

5.3 Referral to the Enlarged Board

The questions regarding the examination of sufficiency of disclosure by the Opposition Division, proposed for referral to the Enlarged Board of Appeal by the respondent, are irrelevant to the present decision since the patent cannot be maintained due to lack of novelty. As a matter of fact, the admissibility of a referral under Article 112(1)(a) EPC presupposes that an answer to the question is necessary for the referring Board to be able to decide on the appeal (cf. G 3/98, point 1 of the reasons). A purely theoretical interest in clarifying points of law is no justification for a referral. Moreover the present Board has ruled in favour of the respondent, i.e. the party requesting the referral. Under these circumstances requests for referral are on principle refused (see Case Law of the Boards of Appeal of the

EPO, 5th Edition (2006), VII.D.13.2, 2nd and 4th paragraphs). Therefore, the request for referral to the Enlarged Board of Appeal is rejected under Article 112(1)(a) EPC.

5.4 Request for recording a statement in the minutes

According to Rule 124(1) EPC the minutes of oral proceedings shall contain the essentials of the oral proceedings and the relevant statements made by the parties. According to the jurisprudence of the boards of appeal (see T 71/06, point 6 of the reasons), it is not the function of the minutes to record statements which a party considers to be possibly relevant such as the statement made by one of the representatives of the appellant, relating to the experimental deducibility of the compression behaviour of the haptics from the disclosure of D1. This statement does not relate to the surrender or abandonment of subject-matter and does not otherwise have an impact on the definition of the subject-matter to be dealt with by Board. It does not form part of the essentials of the oral proceedings and is not relevant for the present decision, either. Consequently, it is not a proper subject for the minutes according to Rule 124(1) EPC, and the respondent's request to include this statement in the minutes is therefore refused.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

A. Vottner M. Noël