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**Datasheet for the decision  
of 13 June 2013**

**Case Number:** T 1480/09 - 3.4.02

**Application Number:** 06024282.3

**Publication Number:** 1754992

**IPC:** G02C7/04, A61F2/16

**Language of the proceedings:** EN

**Title of invention:**  
Binocular lens systems

**Applicant:**  
Abbott Medical Optics Inc.

**Relevant legal provisions:**  
EPC 1973 Art. 84  
EPC Art. 123(2)

**Keyword:**  
Added subject-matter (no - amended claims)  
Clarity (yes - amended claims)  
Remittal to the first instance for further prosecution



**Beschwerdekammern  
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Case Number: T 1480/09 - 3.4.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.4.02**  
**of 13 June 2013**

**Appellant:** Abbott Medical Optics Inc.  
(Applicant) 1700 E. St. Andrew Place  
Santa Ana, CA 92705-4933 (US)

**Representative:** HOFFMANN EITLÉ  
Patent- und Rechtsanwälte  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted on 27 February  
2009 refusing European patent application No.  
06024282.3 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman:** A. G. Klein  
**Members:** F. J. Narganes-Quijano  
B. Müller

## **Summary of Facts and Submissions**

- I. The appellant (applicant) lodged an appeal against the decision of the examining division refusing European patent application No. 06024282.3 (publication No. 1754992).

In its decision the examining division held that the subject-matter of claim 1 of the main request then on file was not clear (Article 84 EPC) and was anticipated or at least rendered obvious by the prior art (Article 52(1) EPC) and that the subject-matter of claim 1 of the auxiliary request then on file contravened the requirements of Article 123(2) EPC.

- II. In reply to a communication of the Board and a telephone consultation with the rapporteur of the Board, the appellant submitted with its letter dated 24 May 2013 an amended set of claims 1 to 6 and requested as sole request - as confirmed in the telephone consultation of 3 June 2013 - that the decision under appeal be set aside and the case be remitted to the examining division for further prosecution on the basis of the amended set of claims.

- III. The wording of claim 1 of the set of claims amended according to the present request of the appellant reads as follows:

"Use of an ophthalmic lens system for improving the vision of a patient comprising:  
providing a first intraocular lens (11) for use with one eye of the patient, said first lens having an optical axis (16) and first, second and third optical zones (27, 29, 31, 33, 35) arranged radially with respect to the optical axis, the second zone (29, 33)

being intermediate the first and third zones (27, 31, 35) and having a greater add power than either of the first and third zones; and providing a second intraocular lens (13) for use with the other eye of the patient, said second lens having an optical axis (38) and first, second and third optical zones (37, 39, 41, 43, 45) arranged radially with respect to the optical axis of the second lens, the second zone of the second lens (39, 43) being intermediate the first and third zones of the second lens (37, 41, 45) and having a greater add power than either of the first and third zones of the second lens, wherein:

the second lens has a power which varies from about an add power for near vision correction for the patient to about an add power for intermediate vision correction for the patient;

the first lens has a power which varies from about a power for distance vision correction for the patient to about an add power for intermediate vision correction for the patient; and

a larger area of the first lens has the power for distance vision correction than an area of the first lens having the add power for intermediate vision correction, and a larger area of the second lens has the add power for near vision correction than an area of the second lens having the add power for intermediate vision correction;

the lens system such that:

the first lens provides better visual acuity for objects at infinity than the second lens and the second lens provides better visual acuity for objects at near distances than the first lens."

The amended set of claims also includes dependent claims 2 to 6 all referring back to claim 1.

## **Reasons for the Decision**

1. The appeal is admissible.
2. *Amendments*

Claim 1 is based on claim 1 as originally filed together with the paragraph bridging pages 5 and 6 and the paragraph bridging pages 6 and 7 of the description of the application as originally filed. The features of dependent claims 2 to 6 are respectively based on dependent claim 2, page 11, lines 25 to 30 and page 14, lines 10 to 13, the paragraph bridging pages 11 and 12, dependent claim 5, and dependent claim 6 of the application as originally filed.

In its decision the examining division held that the subject-matter of claim 1 of the auxiliary request then on file contravened the requirements of Article 123(2) EPC because the feature of the claim relating to "a larger portion of the area of the second lens body being used to direct light to the near focus region than to an intermediate focus region" constituted an unallowable intermediate generalization. This feature has a counterpart in claim 1 as presently amended requiring that "a larger area of the first lens has the power for distance vision correction than an area of the first lens having the add power for intermediate vision correction, and a larger area of the second lens has the add power for near vision correction than an area of the second lens having the add power for intermediate vision correction". This feature is based on the paragraph bridging pages 13 and 14 and the paragraph bridging pages 15 and 16 of the description as originally filed. As noted by the examining division

in its decision with reference to claim 1 of the then valid auxiliary request, while the claimed invention involves two lenses each having three zones, the passages of the description mentioned above relate to an embodiment of the invention in which each of the two lenses has five zones. However, according to the general disclosure of the invention on page 3, line 30 to page 4, line 32 of the description (see also page 17, third paragraph) one of the main features of the invention is that the first and the second lenses are biased for distance and for near vision, respectively, and the skilled person would see in the passages of the disclosure of the embodiment referred to above the technical means required for achieving such a feature not only in the specific case of the embodiment involving two lenses each having five zones, but also in the case of the claimed invention requiring two lenses each having three - and therefore not excluding having more than three - zones as claimed. Accordingly, in the Board's view the claimed feature is directly and unambiguously derivable from the content of the application as originally filed (Article 123(2) EPC).

3. *Clarity*

The set of claims of the main request underlying the decision under appeal was directed to a system of two lenses for improving the vision of a patient. In its decision the examining division held that the claimed subject-matter did not satisfy the requirements of Article 84 EPC in several respects. In particular, claim 1 of the then valid main request contained features - such as the features of present claim 1 defining the improvement in visual acuity of a person wearing the lenses - relating to the visual correction characteristics of the lenses and defined with

reference to a patient, and the examining division objected that these features related to the use of the lens system with a particular patient and that, as regards the claimed lens system, they were indeterminate and therefore unclear.

The set of claims amended according to the present appellant's request is no longer directed to the lens system, but to the use of the lens system for improving the vision of a patient. This change of category of the claimed subject-matter overcomes - as already acknowledged by the examining division in the decision under appeal in respect of the set of claims of the then auxiliary request also directed to the use of the lens system - the objections of lack of clarity raised by the examining division with respect to the claims of the then main request. In particular, the features previously objected to as referring to the use of the lens system now constitute technical features of the claimed use and the corresponding objections are no longer applicable to the amended claims.

Accordingly, the set of claims as presently amended overcome the objections of lack of clarity raised by the examining division with regard to the main request then on file and in the Board's opinion the claims satisfy the requirements of Article 84 EPC 1973.

4. In its decision the examining division found that the subject-matter of claim 1 of the main request then on file was not new or at least was rendered obvious by the prior art on file. This finding of the examining division was based on an assessment of the issues of novelty and inventive step in which the features referred to in point 3 above relating to the use of the claimed lens system and considered unclear by the

examining division were ignored because in the view of the examining division they did not determine any technical feature of the claimed lens system itself and therefore were not limiting features.

As a consequence of the change of category of the claims, however, the claimed features relating to the use of the lens system are now technical features of the claimed use and therefore they cannot be ignored any longer in the assessment of patentability of the claimed subject-matter. Therefore, the assessment of novelty and of inventive step of the subject-matter of the claims of the main request underlying the decision under appeal is no longer applicable to the present set of claims and the assessment of patentability has to be carried out now on a new basis.

5. In view of the considerations and conclusions in points 2 to 4 above, the Board arrives at the overall conclusion that the amended set of claims presently on file overcomes all the reasons for the refusal of the application given by the examining division in its decision. In view of the amendments made, however, the case might require further examination as to whether the application documents as presently amended and the invention to which they relate satisfy the remaining requirements of the Convention within the meaning of Article 97 EPC. For these reasons, the Board considers it appropriate to exercise its power under Article 111(1) EPC and - as requested by the appellant - to remit the case to the examining division for further prosecution on the basis of the set of claims as presently amended.



**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:



M. Kiehl

A. G. Klein

Decision electronically authenticated