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**Datasheet for the decision
of 21 February 2014**

Case Number: T 1708/11 - 3.3.01

Application Number: 02787582.2

Publication Number: 1448726

IPC: C09D 11/00

Language of the proceedings: EN

Title of invention:

Ink formulations and uses thereof

Patent Proprietor:

Novartis AG

Opponent:

Johnson & Johnson Vision Care, Inc.

Headword:

Ink for printing color images on contact lenses/NOVARTIS AG

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"Added matter - all requests - (yes) - combination of features not clearly and unambiguously disclosed"

Decisions cited:

-

Catchword:

-



Case Number: T 1708/11 - 3.3.01

D E C I S I O N
of the Technical Board of Appeal 3.3.01
of 21 February 2014

Appellant:
(Patent Proprietor)

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Respondent:
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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 1 June 2011
revoking European patent No. 1448726 pursuant
to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman: A. Lindner
Members: J. Ousset
C. Brandt

Summary of Facts and Submissions

- I. An appeal was filed against the decision of the opposition division revoking European patent No. 1448726.
- II. With the statement setting out the grounds of appeal, a new main request and four auxiliary requests were filed by the appellant-patentee.

Claim 1 of the main requests reads as follows:

"1. An ink for inkjet printing of a color image on a contact lens comprising: a solvent; a colorant; and a binder polymer, wherein the ink is characterized by having a surface tension of from 20 mN/m to 60 mN/m, a viscosity of less than 50 mPa.s (50 centipoise), and a good adhesion to said contact lens that a color image printed with the ink on the contact lens can pass at least a finger rubbing test, wherein the solvent is selected from water, water/ethanol, water/isopropanol, water/glycerol, water/diethylene glycol, cyclopentanone and cyclohexanone, wherein the colorant comprises at least a pigment, and wherein the amount of the solvent is from 84% to 94% by weight, the amount of the binder polymer is from 5% to 10% by weight, and the amount of the colorant is from 0.5% to 5% by weight."

Claim 1 of auxiliary request 1 differs from claim 1 of the main request in that a color image printed with the ink on the contact lens can pass a finger-rubbing test and a sterilization-surviving test.

Claim 1 of auxiliary request 2 differs from claim 1 of the main request in that a color image printed with the ink on the contact lens can pass a finger-rubbing test and a sterilization-surviving test and in that the solvent is limited to water.

Claim 1 of auxiliary request 3 differs from claim 1 of the main request in that a color image printed with the ink on the contact lens can pass a finger-rubbing test and an autoclave-surviving test.

Claim 1 of auxiliary request 4 differs from claim 1 of the main request in that a color image printed with the ink on the contact lens can pass a finger-rubbing test and an autoclave-surviving test and in that the solvent is limited to water."

III. The appellant argued substantially as follows:

- The amendments performed in claim 1 were based on more preferred embodiments, and therefore did not add any new technical information.
- The amendments were supported by the examples of the description.

IV. The respondent argued substantially as follows:

- The appellant, in its statement setting out the grounds of appeal, asserted that the same level of preference was not an appropriate test to decide whether a combination of features was directly and unambiguously derivable from the application (see

statement of the grounds of appeal of 11 October 2011, page 3, third paragraph).

- There was no link in the description between the specific solvents and the different amounts of solvent, colorant and binder.

- V. The appellant requested that the decision of the opposition division be set aside and that the patent be maintained either on the basis of the main request or, alternatively, on the basis of one of auxiliary requests 1 to 4, all filed with the statement of the grounds of appeal of 11 October 2011.

- VI. The respondent requested that the appeal be dismissed.

- VII. At the end of the oral proceedings, the decision of the board was announced.

Reasons for the Decision

1. The appeal is admissible.

2. Article 123(2) - Main request

Any amendment made to the wording of claims must fulfil the requirements of Article 123(2) EPC.

- 2.1 In claim 1 of the main request, a list of specific solvents was added. These solvents are mentioned in the description as originally filed on page 7, penultimate paragraph. They are described as being a more preferred embodiment of the invention. Furthermore, the content

of the application as originally filed indicates that the colorant can be either a dye or a pigment or a mixture thereof (see page 7, last paragraph) and pigments are preferred to dyes (see page 9, beginning of the last paragraph). Moreover, it was further specified in claim 1 that the amount of solvent is from 84% to 94% by weight, the amount of the binder polymer is from 5% to 10% by weight and the amount of colorant is from 0.5% to 5% by weight. Such values are to be found on page 20 of the application as originally filed, where they are all listed as "more preferably" (see first full paragraph and claim 4 as originally filed). It results therefrom that these amendments in claim 1 of the different requests on file do indeed have a counterpart in the application as originally filed. It has however to be investigated whether they are clearly and unambiguously disclosed in combination there.

Such a combination cannot be based on the set of claims as originally filed, which does not mention the solvent used in the claimed ink. In addition, claim 8 as originally filed mentions that the colorant comprises at least a pigment and/or at least a dye, and claim 9 as originally filed that the colorant comprises at least a pigment and optionally a dye. Hence, a clear and unambiguous disclosure of the specific combination of features of claim 1 of the requests currently on file cannot originate from the set of claims as originally filed.

The list of the specific solvents and the presence of at least a pigment in the claimed ink are disclosed under the heading "The ink of the present invention typically comprises a solvent, a colorant, and a

binder" (See page 6, last two lines). The limitation of the scope of claim 1 by selecting the more preferred solvents with the preferred colorant (namely a pigment) but leaving open the nature of the binder amounts to an intermediate generalisation. Furthermore, this intermediate generalisation was then further combined with specific amounts of solvent, binder and colorant which were themselves selected from a preferred embodiment among other preferred embodiments (see page 20, first paragraph to page 21, and first paragraph). Without any hint in the application as originally filed indicating to the person skilled in the art that this specific combination was disclosed without any ambiguity, this amounts to an unallowable intermediate generalisation contravening Article 123(2) EPC.

- 2.1.1 The appellant argued that, although the level of preference of the different constituents did not constitute the only test for assessing the disclosure of a combination of features, all these limitations concerned the more preferred embodiments and thus did not add any new technical information.

The level of preference of the different combined features does not constitute in itself a sufficient criterion to acknowledge that the combination of the preferred (or more preferred) features is to be regarded as having a basis in the application as originally filed. The relevant condition is rather whether the specific combination, obtained after amendment, is clearly and unambiguously derivable from the application as originally filed. This depends upon each specific case. In the present case, the appellant

has failed to show that the specific more preferred solvents selected (see page 7), disclosed among other preferred embodiments for the nature of the colorant and the binder polymer, are clearly and unambiguously disclosed in combination with the specific amounts of colorant, solvents and binder, the latter being also selected among other preferred embodiments (see page 20, first full paragraph to page 21, first full paragraph). Contrary to the appellant's viewpoint, this combination defines an ink which was never described in the application as originally filed. Claim 1 now describes an ink which must contain at least a pigment, specific solvents and these in specific amounts. This ink was, of course, encompassed by the generic disclosure of the invention as originally filed but there was no information available in the original application that it was specifically envisaged when the said application was filed. Therefore, this combination adds new technical information which was not available at the filing date of the patent in suit.

2.1.2 The appellant asserted that the claimed scope was supported by the examples.

That is true, but the board would point out the following:

The present examples disclose combinations of specific features in specific amounts from which it is not possible to derive directly and unambiguously the combination of features mentioned in claim 1. Hence, trying to design a restricted generic scope of claim 1 encompassing these examples without a proper basis in

the description as originally filed contravenes Article 123(2) EPC.

2.2 Claim 1 of the main request contravenes Article 123(2) EPC.

2.3 Auxiliary requests 1 and 3

These requests added that, in addition to the rubbing test, the claimed ink must also pass a sterilization-surviving test (auxiliary request 1) or an autoclave-surviving test (auxiliary request 3). These amendments do not affect the reasoning put forward for the main request (see 2.1 above). Moreover, the new requirement introduced into claim 1, namely passing both the rubbing test and the sterilization-surviving test (auxiliary request 1) or the rubbing test and the autoclave-test (auxiliary request 3), also leads to combinations of features which were not disclosed in the application as filed. Although the combination of the rubbing test with the sterilization-surviving test is regarded as preferable in the application as filed (see page 5, two last lines), there is nothing in the said application which would indicate that this preferred combination was clearly and unambiguously disclosed with the other features of claim 1 of auxiliary request 1. The combination of the rubbing test with the autoclave-surviving test requires that in the first place the preferred combination of the rubbing test and the sterilization-surviving test be made and then that, among the different sterilization-surviving tests possible, the autoclave-surviving test be selected (see page 6, line 7). This adds arbitrary

selections to the ones already mentioned for the main request (see point 2.1 above).

Therefore, none of these requests fulfils the requirements of Article 123(2) EPC.

2.4 Auxiliary requests 2 and 4

In these requests, the solvent was limited to water. Nowhere does the application as filed mention that water is the solvent to be used when the claimed ink is defined by the different features present in claim 1. This further selection can thus not be directly and unambiguously derived from the application as filed.

Auxiliary requests 2 and 4 also contravene Article 123(2) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

M. Schalow

A. Lindner