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**Datasheet for the decision  
of 25 September 2018**

**Case Number:** T 0022/15 - 3.4.02

**Application Number:** 03783457.9

**Publication Number:** 1563271

**IPC:** G01M11/02, G02C7/04

**Language of the proceedings:** EN

**Title of invention:**

AUTOMATED INSPECTION OF TINTED OPHTHALMIC PARTS

**Patent Proprietor:**

Johnson & Johnson Vision Care, Inc.

**Opponent:**

Novartis AG

**Headword:**

**Relevant legal provisions:**

EPC 1973 Art. 100(b), 111(1)

EPC 1973 R. 67, 68(2)

**Keyword:**

Fresh ground for opposition not admitted into proceedings by  
the opposition division - subsequent agreement of the patentee  
for admitting fresh ground  
Substantial procedural violation - appealed decision  
sufficiently reasoned (no)  
Remittal to the department of first instance - (yes)  
Reimbursement of appeal fee - (yes)

**Decisions cited:**

G 0010/91, G 0001/95, T 1286/14

**Catchword:**



**Beschwerdekammern**

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Case Number: T 0022/15 - 3.4.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.4.02**  
**of 25 September 2018**

**Appellant:** Novartis AG  
(Opponent) Lichtstrasse 35  
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**Representative:** Henkel, Breuer & Partner  
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**Respondent:** Johnson & Johnson Vision Care, Inc.  
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**Representative:** Tunstall, Christopher Stephen  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
29 October 2014 concerning maintenance of the  
European Patent No. 1563271 in amended form.**

**Composition of the Board:**

**Chairman** R. Bekkering  
**Members:** A. Hornung  
G. Decker

## **Summary of Facts and Submissions**

- I. The opponent appealed against the interlocutory decision of the opposition division maintaining European patent No. 1563271 in amended form.

Opposition had been filed against the patent as a whole and based on the grounds of Article 100(a) EPC 1973, together with Articles 54(1) and 56 EPC 1973, and Article 100(c) EPC 1973, together with Article 123(2) EPC.

After the opposition period laid down in Article 99(1) EPC 1973, the opponent raised the ground for opposition according to Article 100(b) EPC 1973.

The opposition division found that the late-filed ground for opposition according to Article 100(b) EPC 1973 was not prima facie relevant to prejudice the maintenance of the patent and consequently did not admit the late-filed ground for opposition into the proceedings.

The opposition division further found that the patent as amended according to a second auxiliary request then on file and the invention to which it related met the requirements of the EPC.

- II. The appellant (opponent), in its statement setting out the grounds of appeal, requested to set aside the decision of the opposition division and to revoke the patent.

- III. The respondent (patentee), in its letter of reply to the grounds of appeal, dated 23 July 2015, requested as a main request that the appeal be dismissed and as auxiliary requests that the decision under appeal be set aside and that the patent be maintained in amended form on the basis

of the claims according to one of the auxiliary requests 1 to 4 and 1' to 4'. It also requested not to admit into the proceedings the late-filed ground for opposition according to Article 100(b) EPC 1973.

- IV. In a communication annexed to the summons to oral proceedings, the board informed the parties about its provisional views concerning admissibility of the late-filed ground for opposition according to Article 100(b) EPC 1973 and concerning inventive step of the claimed subject-matter.
- V. With a letter dated 24 August 2018, the patentee responded to the board's communication. It maintained its initial main request that the appeal be dismissed and filed 48 auxiliary claim requests, partially replacing the previously filed auxiliary claim requests 1 to 4 and 1' to 4'. It added the procedural request that in case the board decided to admit the late-filed ground for opposition according to Article 100(b) EPC 1973 "the case be remitted to the opposition division for further consideration and in particular for a substantive examination of the grounds of lack of sufficiency".
- VI. Oral proceedings before the board were held on 25 September 2018.
- VII. During oral proceedings, a debate took place concerning the admissibility into the appeal proceedings of the late-filed ground for opposition according to Article 100(b) EPC 1973. After the debate, the board informed the parties that it maintained its view expressed already in the summons to oral proceedings, point 7.1.1.(c), that "the decision of the opposition division was not well substantiated". It further announced that, in the event that the respondent declared that it agreed to the fresh ground for opposition under Article 100(b) EPC 1973 being admitted into the

proceedings, the board would be minded to remit the case to the department of first instance for further prosecution.

Thereupon, the patentee declared that it agreed to the ground for opposition according to Article 100(b) EPC 1973 being admitted into the proceedings.

VIII. Final requests of the parties

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

The respondent (patentee) requested that the decision under appeal be set aside and the case be remitted to the department of first instance for further prosecution.

IX. Independent claim 1 according to the main request of the decision under appeal reads as follows:

"A method for inspecting ophthalmic parts comprising colorants the method comprising the steps of:

a) capturing an image of said ophthalmic part comprising at least one colorant wherein said image comprises an array of pixels and said at least one colorant is present in a portion of said image;

b) locating a reference means in said image of said ophthalmic part and finding the center of said reference means;

c) locating at least one first pixel area in the portion of said image of said ophthalmic part comprising said at least one colorant ;

characterised in that the method further comprises:

d) comparing the location of said at least one first pixel area to the location of a first pixel standard to determine the location of said colorant center (910); and comparing the location of the center (909) of said reference means to the location of said colorant center (910) to determine if said at least one colorant is properly located on said ophthalmic part."

### **Reasons for the Decision**

1. The opponent requested that the appealed decision be set aside and the patent be revoked on the basis of Article 100(a) EPC 1973, in combination with Article 56 EPC 1973, or on the basis of Article 100(b) EPC 1973. In principle a meaningful assessment of inventive step of the claimed subject-matter presupposes that the invention as defined in claim 1 is disclosed in the patent in a manner sufficiently clear and complete for it to be carried out by the skilled person. In the present case the ground for opposition according to Article 100(b) EPC 1973 was filed by the opponent.

Therefore, the opponent's objection of insufficiency of disclosure according to Article 100(b) EPC 1973 is addressed first.

2. The ground for opposition according to Article 100(b) EPC 1973 was filed outside the opposition period laid down in Article 99(1) EPC 1973. The opposition division decided not to admit the late-filed ground for opposition into the proceedings.

3. Extent of examination of the late-filed ground for opposition during the appeal proceedings

3.1 In view of the established case law, e.g. G 10/91, G 1/95 and T 1286/14, fresh grounds for opposition may be considered in appeal proceedings only with the approval of the patentee. A fresh ground is a ground which was neither raised and substantiated in the notice of opposition, nor introduced into the proceedings by the opposition division. This, however, presupposes that the appealed decision concerning the non-admission of the ground for opposition does not give rise to any formal reserve to the way the opposition division exercised its discretion.

3.2 In the present case, the board is of the opinion that the decision of the opposition division is not adequately reasoned under Rule 68(2) EPC 1973. In particular, the board agrees with the opponent, point 2.2.1 of the grounds of appeal, that the opposition division "merely points to some places of the specification providing definitions for certain terms used in claims 1 and 10", "expresses the view that other terms 'may prima facie be understood by the skilled person'" and considers "that the skilled person would understand the meaning of these features", while "leav[ing] it entirely open what in their view the meaning of the features would be". "Furthermore, it remains unclear from the reasons of the contested decision how understanding the meaning of the features would enable the skilled person to carry out the claimed method".

The appealed decision, point 4.2.3, last paragraph, refers to numerous passages of the patent application. These passages, however, do either not deal with the central issue relating to determining the location of the colorant center as defined in step (d) of claim 1 and/or relate to embodiments with specific features missing in claim 1 (e.g.



perfectly circular pattern shown in figures 8 and 9) and are, therefore, not suitable to provide a general teaching enabling the skilled person to carry out the invention as defined in claim 1.

- 3.3 The patentee essentially argued that it was sufficient for the opposition division to indicate its final opinion on the prima facie relevance of the late-filed ground for opposition without giving details about why and how the skilled person would carry out the invention as claimed. It further referred to the opponent's letter of 29 August 2014, filed during the first instance opposition proceedings in response to the summons to oral proceedings where the ground for opposition according to Article 100(b) EPC 1973 was raised for the first time by the opponent. In particular, it referred to the shortness and vagueness of the objection raised.

The board cannot accept the patentee's argument. In spite of relating "only" to the prima facie relevance of the ground for opposition and in spite of the objection being raised in general terms, the decision of the opposition division must be reasoned according to Rule 68(2) EPC 1973.

- 3.4 It follows that the reasoning of the opposition division's decision is not comprehensible and does not comply with the requirement of Rule 68(2) EPC 1973.

- 3.5 Under these circumstances, considering the late-filed ground for opposition in the appeal proceedings lies in the discretion of the board.

For a start, considering the late-filed ground for opposition depends on whether it is prima facie relevant for the maintenance of the patent.

4. Prima facie relevance of the ground for opposition according to Article 100(b) EPC 1973
  - 4.1 The board is of the view that the ground for opposition according to Article 100(b) EPC 1973 is prima facie relevant for the maintenance of the patent.
    - 4.1.1 The scope of at least claim 1 is so broad that it is doubtful whether the skilled person would be able to gather all the missing information from the description and figures of the patent in order to obtain, over the whole scope of the claims, the claimed result, i.e. to determine if the colorant is properly located on the ophthalmic part. For instance, claim 1 leaves undefined which ophthalmic part is referred to; which image size and concrete portion of the ophthalmic part is to be captured; which kind of colorant shape is referred to and which colorant portion is to be captured; which kind of reference means are referred to; on the basis of which criteria the "first pixel area" and "first pixel standard" are selected in a portion of the image; and so on.
    - 4.1.2 Furthermore, claim 1 broadly refers to a "first pixel area" and a "first pixel standard". These areas are defined in paragraphs [0018] and [0019] of the patent specification essentially as being "distinguishable from other areas containing colorant", covering an area of the image/model of "about 5 x 5 pixels" and being located "anywhere in the image/model other than the Optical Zone (...) or the reference means". It is doubtful whether selecting *any* small area of 25 pixels in the image and in the model and fulfilling said broad conditions suffices for determining the location of the colorant center. Indeed, in the light of the disclosure of the patent specification, these small areas of 25 pixels are not necessarily unique in the image of the ophthalmic part, i.e. distinguishable from *all* other

areas in the image of the ophthalmic part; the relationship and similarity is undefined between the first pixel area and the first pixel standard to which the first pixel area is to be compared; rescaling and rotation between the colored image and the model, which would render complex a meaningful comparison, is not excluded in the claim; and so on. Due to the lack of guidance in the patent specification, a meaningful comparison between the location of the "first pixel area" and the location of the "first pixel standard", if possible at all, appears to be complex and burdensome, in particular over the whole scope of claim 1.

4.1.3 Determining the location of the colorant center according to step (d) of claim 1, i.e. based on the comparison between the location of the "first pixel area" and the location of the "first pixel standard", appears to require not only knowledge of a general location of the "first pixel area" and of the "first pixel standard" but also knowledge of the relative location of each of these areas with respect to the corresponding colorant center. This latter information appears to be missing in the patent specification.

4.1.4 The board further notes that the patent does not provide any information about how to determine the colorant center of the two concrete embodiments of a colored ophthalmic part shown in figures 12 and 13 comprising a pattern without central symmetry so that the pattern's colorant center cannot be readily determined.

4.2 Counter-arguments from the patentee

4.2.1 The patentee submitted that the skilled person would understand the expressions "first pixel area" and "first pixel standard" because they are defined in the description, paragraphs [0018] and [0019]. More precisely, in analogy to the method of inspection for determining the rotation of

colorant layers disclosed in paragraph [0052] of the patent, the skilled person would understand that the center of the colorant is determined by selecting the same distinguishable pixel area in the image and in the model and then comparing both locations. During oral proceedings, the patentee presented a simplified example of how to determine the location of the colorant center of a perfectly annular-shaped pattern.

4.2.2 The board is not convinced by the patentee's arguments since they rely on considerations going beyond the capability of understanding and on the knowledge of the skilled person. While the simplified example presented orally by the patentee might fall under the scope of claim 1, the board does not consider that this single and simplified example allows deducing information about how to carry out the invention over the whole scope of claim 1. The patentee's attempt to demonstrate how the skilled person would deduce missing information about proper centering from the patent specification, e.g. from the embodiment relating to the rotation of colorant layers (see patent, [0052]), puts an undue burden on the skilled person.

4.3 Reasoning of the appealed decision

The arguments of the appealed decision, point 4.2.3, denying the prima facie relevance of the ground for opposition according to Article 100(b) EPC 1973 are considered not being comprehensible (see point 3.2 above).

4.4 In view of the numerous missing pieces of information about how to carry out the invention over the whole scope of claim 1 without undue burden for the skilled person having no inventive skills, the board comes to the conclusion that the ground for opposition according to Article 100(b) EPC 1973 is prima facie relevant for the maintenance of the patent.

5. Patentee's agreement to admit the fresh ground for opposition

During oral proceedings, the patentee declared that it agreed to the ground for opposition according to Article 100(b) EPC 1973 being admitted into the proceedings.

Accordingly, the ground for opposition according to Article 100(b) EPC 1973 is admitted into the proceedings.

6. Remittal of the case

- 6.1 As requested by the patentee, the board decides to make use of its discretion under Article 111(1) EPC 1973 in remitting the case to the opposition division for further prosecution.

- 6.2 The opponent requested that the case not be remitted but that the board decided on the objection of insufficiency of disclosure.

In view of the decision G 10/91, OJ EPO 1993, 420, Reasons point 18, advising a remittal to the first instance in case of a fresh ground for opposition being admitted into the procedure, the board cannot accept the opponent's request.

7. Reimbursement of appeal fee

The fresh ground for opposition is admitted into the proceedings (see point 5. above). Therefore, the opponent's appeal is at least partially allowed and the impugned decision is set aside.

For the reasons provided in point 3.2 above, the board is of the opinion that the appealed decision is not adequately

reasoned (Rule 68(2) EPC 1973) which amounts to a substantial procedural violation.

Therefore, the board allows the opponent's request that the appeal fee be reimbursed (Rule 67 EPC 1973).

## 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.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:



M. Kiehl

R. Bekkering

Decision electronically authenticated