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Datasheet for the decision of 16 January 2020

Case Number: T 0228/16 - 3.2.03

Application Number: 04765064.3

Publication Number: 1667911

IPC: A45C11/00, A61L12/04, A61L12/08

Language of the proceedings: EN

Title of invention:
METHOD AND CONTAINER FOR STERILIZING AND STORING SOFT CONTACT LENSES

Patent Proprietor:
Novartis AG

Opponent:
Leeming, John Gerard

Headword:

Relevant legal provisions:
EPC Art. 100(b), 111(1)
EPC R. 84(2)
RPBA Art. 12(4)

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It can be changed at any time and without notice.

Keyword:
Late-filed request - admitted (yes)
Grounds for opposition - insufficiency of disclosure (no)
Appeal decision - remittal to the department of first instance (yes)

Decisions cited:

Catchword:

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Case Number: T 0228/16 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 16 January 2020

Appellant: (Patent Proprietor)	Novartis AG Lichtstrasse 35 4056 Basel (CH)
Representative:	Bohest AG Holbeinstrasse 36-38 4051 Basel (CH)
Respondent: (Opponent)	Leeming, John Gerard J.A. Kemp & Co. 14 South Square Gray's Inn London WC1R 5JJ (GB)
Representative:	J A Kemp LLP 14 South Square Gray's Inn London WC1R 5JJ (GB)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 20 November 2015 revoking European patent No. 1667911 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	G. Ashley
Members:	B. Miller
	E. Kossonakou

Summary of Facts and Submissions

I. European patent No. 1 667 911 (hereinafter: the patent) relates to a method and container for sterilizing and storing soft contact lenses.

II. An opposition was filed against the patent, based on the grounds of Article 100(b) EPC and Article 100(a) together with Article 56 EPC.

The opposition division revoked the patent, since the division concluded that the requirements of Article 83 EPC were not met by the contested patent.

The proprietor (hereinafter: the appellant) filed an appeal against this decision.

III. The appellant requested that the decision under appeal be set aside and a patent be granted in amended form on the basis of the main request or one of the two auxiliary requests, all submitted with the statement setting out the grounds of appeal.

IV. The respondent (the opponent) requested in its letter of reply that the appeal be dismissed.

V. The independent claims according to the main request read as follows:

Claim 1:

"A method for sterilizing a soft contact lens and providing a sterilized storage package of the soft contact lens maintained in a packaging solution, comprising the steps of:

(a) providing a container having a cavity for receiving a packaging solution and a soft contact lens having a core polymeric material and a hydrophilic coating thereon
(b) placing an amount of the packaging solution and the soft contact lens in the container, wherein the amount of the packaging solution is sufficient to have the soft contact lens to be fully immersed;
(c) sealing said container to form a storage package of the soft contact lens; and
(d) autoclaving said package to obtain the sterilized storage package of the soft contact lens,
characterized in that the cavity has a cavity surface which is modified by surface treatment to hydrophilic so that deformations of the soft contact lenses, caused during autoclaving by air bubbles formed between the cavity surface and the hydrophilic coating due to mismatch in surface hydrophilicity and/or by adherence of the soft contact lens to the cavity surface, are substantially reduced
wherein the cavity surface modified by surface treatment to hydrophilic is defined as a surface having an averaged contact angle of less than about 80 degrees."

Claim 4:

"A container for autoclaving and storing a soft contact lens having a core polymeric material and a hydrophilic coating in a packaging solution, comprising a base and a cover, wherein the cover is detachably sealed to the base, wherein the base includes a cavity for receiving a sterile packaging solution and the contact lens, characterized in that the cavity has a cavity surface which has a hemisphere shape and which is modified by surface treatment to hydrophilic so that deformations

of the contact lenses caused during autoclaving by air bubbles formed between the cavity surface and the hydrophilic coating due to mismatch in surface hydrophilicity and/or by adherence of the soft contact lens to the cavity surface can be substantially reduced wherein the cavity surface modified by surface treatment to hydrophilic is defined as a surface having an averaged contact angle of less than about 80 degrees."

Claims 2 to 3 and 5 to 10 of the main request relate to preferred embodiments of the process and the container according to claims 1 and 4.

VI. In a communication of the Board pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) accompanying the summons to oral proceedings, the Board informed the parties of its intention to set aside the impugned decision and to remit the case for further prosecution.

VII. With letter of 14 October 2019 the respondent withdrew its opposition.

VIII. With letter of 7 January 2020 the appellant stated that it did not object to a remittal of the case to the opposition division for further prosecution.

IX. The summons to attend oral proceedings were thus cancelled, and the proceedings were continued in writing.

X. The appellant's arguments can be summarised as follows.

The uncertainty which had motivated the opposition division to revoke the patent have been clarified by

the wording of the main request. The decision therefore should be set aside.
Concerning the further objections raised by the respondent with respect to the requirements of Article 83 EPC, the reasoning of the contested decision was correct.

XI. The respondent's arguments presented in the letter of reply to the grounds of appeal can be summarised as follows.

The requests of the appellant should be held inadmissible by the Board according to Article 12(4) RPBA 2007, since the appellant could and should have filed the further requests during the opposition proceedings.

Moreover, the skilled person was not in the position to rework the method according to claim 1 or the container of claim 4 according to the main request. The patent did not provide enough information in paragraph [0027] to enable the skilled person to measure the contact angle of water on a surface for determining its hydrophilic character, since there was no definition whether
- this method was static or dynamic;
- an advancing or receding contact angle was to be measured;
- the investigated material was fully hydrated or not.

The skilled person did not know
- how to interpret the term "by surface treatment to hydrophilic"
- how to determine if the claimed feature:
"so that deformations of the soft contact lenses, caused during autoclaving by air bubbles formed

between the cavity surface and the hydrophilic coating due to mismatch in surface hydrophilicity and/or by adherence of the soft contact lens to the cavity surface, are substantially reduced" was fulfilled or not, since the nature of the deformation of the contact lenses was not clear.

Reasons for the Decision

1. Admissibility of the main request and auxiliary requests 1 and 2

1.1 With the statement setting out the grounds of appeal the appellant submitted a main request and two auxiliary requests.

Despite the fact that everything filed with the grounds of appeal should form the basis of the appeal proceedings according to Rule 12(2) RPBA 2007, the Board has a discretion according to Rule 12(4) RPBA 2007 to hold new requests inadmissible.

When exercising this discretion, the Board considers whether the appellant could have filed the requests already in the opposition proceedings (see cases cited in Case Law of the Boards of Appeal, 2016, 8th edition, Chapter V.A.4.11.1 including in particular T1067/08, T23/10, T144/09 and further similar decisions cited by the respondent).

1.2 With respect to the present case the Board observes the following.

The reasoning leading to the revocation was not indicated in the annex to the summons to oral

proceedings as is evident from point 7.1.2 b) of the annex, which focuses only on the question whether a standard procedure for the measurement of hydrophilicity was available.

From the minutes of the oral proceedings (points 1 to 2.4) it is further evident that the detected inconsistency leading to the revocation was discussed during oral proceedings in combination with further points under Article 83 EPC.
The appellant was given the opportunity to file new requests only just before the deliberation of the opposition division and then just before the subsequent announcement of the final decision (see point 2.5 of the minutes).

1.3 Therefore it is questionable whether it was evident for the appellant before or at least during the oral proceedings that a single amendment, as now proposed in the main request filed with the statement of the grounds of appeal, would have been sufficient to obtain a request likely to be considered as fulfilling the requirements of Article 83 EPC.

1.4 Filing various auxiliary requests taking into account all objections and possible combinations thereof relating to insufficiency of disclosure discussed during the oral proceedings is not for a patent proprietor an economical and efficient way of dealing with this ground of opposition.

The appellant therefore does not seem to have reacted in an unfair manner by submitting a new request clarifying the feature which lead to the revocation once it was aware of the reasons adopted by the opposition division.

1.5 Therefore the Board exercising its discretion pursuant to Article 12(4) RPBA 2007 does not consider it appropriate to exclude the requests submitted with the statement setting out the grounds of appeal from the proceedings.

2. Article 100(b) EPC

2.1 The sole reason for revocation of the patent concerns the meaning of the term "hydrophilic material" in claim 1. The opposition division considered that a skilled person trying to reproduce the invention would be uncertain about what is covered by it, and hence they concluded that the granted patent did not comply with the requirements of Article 83 EPC.

However, the Board is of the view that the term "hydrophilic material" is well known in the art and refers to a material whose surface has a certain contact angle with water. Paragraph [0029] of the patent explains a material as being hydrophilic when its surface has a contact angle of at least 80°. Therefore the skilled person is made aware of the meaning of "hydrophilic material" according to the patent.

Even if the skilled person is uncertain about this definition, given the teaching in textbooks that a material is only considered to be hydrophilic when its surface has a contact angle of at least 90°, this uncertainty relates to the clarity of the subject-matter for which protection is sought. However, clarity is not a ground of opposition.

2.2 The respondent also argued that the patent does not provide enough information for the skilled person

- to measure the contact angle of water using the information in paragraph [0027] of the contested patent,

- to interpret the term "by surface treatment to hydrophilic" and

- to determine whether or not the claimed feature: "so that deformations of the soft contact lenses, caused during autoclaving ... are substantially reduced" was fulfilled.

With respect to these arguments the Board agrees with the reasoning in points 11.1 to 11.3 of the impugned decision that all of these objections relate to clarity and not to sufficiency of disclosure.

Therefore the Board reaches the conclusion that the ground of opposition pursuant to Article 100(b) EPC does not prejudice the maintenance of the patent as granted.

3. Remittal

In view of the withdrawal of the opposition and of the above finding of the Board, a decision under Rule 84(2) EPC, whether the Office continues the opposition proceedings of its own motion, should be taken.

The question arises whether this decision should be taken by the Board.

In the present case, objections under Article 100(a) EPC based on lack of inventive step were raised with the notice of opposition but the opposition division has not yet had the opportunity to consider the issue of inventive step.

Therefore the Board is of the view that the most appropriate course of action under the circumstances of the present case is to exercise its discretion under Article 111(1) EPC and remit the case for further prosecution.

4. In light of the preceding reasoning, oral proceedings were not considered necessary and were thus cancelled.

Order

For these reasons it is decided that:

1. The decision is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar: The Chairman:

I. Aperribay G. Ashley

Decision electronically authenticated