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**Datasheet for the decision
of 19 October 2023**

Case Number: T 0609/20 - 3.4.02

Application Number: 14794798.0

Publication Number: 2994794

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B29L11/00, A61K9/00, A61K47/34,
B29D11/00, B29C41/22,
B29K83/00, B29K105/00

Language of the proceedings: EN

Title of invention:
SYSTEMS AND METHODS FOR PRINTING ON A CONTACT LENS

Applicant:
Menicon Singapore Pte Ltd.

Headword:

Relevant legal provisions:
RPBA 2020 Art. 12(6)

Keyword:
Late-filed request - should have been submitted in first-
instance proceedings (yes)

Decisions cited:

Catchword:



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Case Number: T 0609/20 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 19 October 2023

Appellant: Menicon Singapore Pte Ltd.
(Applicant) 8 International Business Park
Singapore 609925 (SG)

Representative: Gill, David Alan
WP Thompson
138 Fetter Lane
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 22 October 2019
refusing European patent application No.
14794798.0 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairwoman T. Karamanli
Members: A. Hornung
C. Kallinger

Summary of Facts and Submissions

- I. The applicant (appellant) appealed against the decision of the examining division refusing European patent application No. 14794798.0 on the basis of Article 97(2) EPC because the claims of the main and sole request then on file did not meet the requirements of Articles 84 and 54(1) EPC.
- II. With the statement setting out the grounds of appeal, the appellant filed amended claims according to a new main (and sole) request to replace the claims underlying the appealed decision and requested that the decision of the examining division be set aside and that a patent be granted on the basis of the claims of the main request.
- III. On 14 March 2022, a summons to attend oral proceedings to be held on 19 October 2023 was issued. In a communication accompanying the summons, the board set out its provisional opinion on the merits of the appeal.
- IV. The appellant informed the board with its letter dated 17 October 2023 that it would not be attending the oral proceedings.
- V. Oral proceedings were held on 19 October 2023 in the absence of the appellant, who had been duly summoned.
- VI. The present decision refers to the following documents which were dealt with in the proceedings before the examining division:

D1: US 2004/0130676 A1

D2: WO 2004/003636 A1

VII. Claim 1 of the main request reads as follows:

"A method of making a contact lens (100) comprising:
forming a first lens layer (104) including a first surface (112);
forming a pattern comprising silicone material (122) on the first surface of the first lens layer; and
forming a second lens layer (106) over the pattern,
wherein the first lens layer and/or the second lens layer includes hydrogel material, or is formed at least substantially entirely of hydrogel material, and
wherein the silicone material is silicone polymers without hydrogel polymers."

Reasons for the Decision

1. Non-attendance of the appellant at the oral proceedings before the board

In accordance with Rule 115(2) EPC, if a party duly summoned to oral proceedings before the EPO does not appear as summoned, the proceedings may continue without that party. Pursuant to Article 15(3) RPBA 2020 (which is applicable in accordance with Article 25(1) RPBA 2020), the board is not obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of a duly summoned party, which may then be treated as relying only on its written case.

In the case in hand, the appellant announced two days before the scheduled oral proceedings that it would not be attending them. By not attending the oral proceedings, the appellant effectively chose not to avail itself of the opportunity to present its observations and counter-

arguments orally, but to rely on its written submissions. The board was in a position to announce a decision at the conclusion of the oral proceedings in accordance with Article 15(6) RPBA 2020, which applies in accordance with Article 25(1) RPBA 2020.

2. Main request - admittance under Article 12(6) RPBA 2020

The board exercises its discretion under Article 12(6) RPBA 2020 and decides not to admit the main request into the appeal proceedings for the following reasons.

2.1 According to Article 12(2) RPBA 2020, "[i]n view of the primary object of the appeal proceedings to review the decision under appeal in a judicial manner, a party's appeal case shall be directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based".

2.2 In the current case, claim 1 of the main request has been amended compared to claim 1 of the sole request on which the appealed decision is based. In claim 1 of the current main request, the feature "*forming a pattern on the first surface of the first lens layer*" has been replaced by the feature "*forming a pattern comprising silicone material (122) on the first surface on the first lens layer*" and the feature "*wherein forming the pattern on the first surface includes depositing a lens enhancing material including a silicone material on the first surface and wherein said silicone material enhances the oxygen permeability of the contact lens*" has been replaced by the feature "*wherein the silicone material is silicone polymers without hydrogel polymers*".

Hence, essentially, in claim 1 of the current main request, the expressions "*lens enhancing material*" and

"silicone material enhances the oxygen permeability of the contact lens" have been deleted, and the feature *"is silicone polymers without hydrogel polymers"* has been added.

2.3 Pursuant to Article 12(6), second sentence, RPBA 2020, which applies in accordance with Article 25(1) and (2) RPBA 2020, the board "shall not admit requests ... which should have been submitted ... in the proceedings leading to the decision under appeal, unless the circumstances of the appeal case justify their admittance".

2.4 In the board's view, the current main request could and should have been submitted in the first-instance proceedings and there are no circumstances within the meaning of Article 12(6) RPBA 2020 which justify the filing of the current main request for the first time in the appeal proceedings for the following reasons.

2.4.1 Two objections under Article 84 EPC were raised by the examining division against claim 1 of the sole request then on file (see the appealed decision, point II.3). The objection that the expression "lens enhancing material" was unclear had already been raised in the examining division's communication dated 3 April 2019. The board does not see any valid reason why the claims then on file were not amended during the first-instance proceedings along the lines of the current claim 1 in order to overcome this clarity objection, even by way of an auxiliary request.

2.4.2 In addition, objections of lack of novelty based on D1 and D2 were raised against the subject-matter of claim 1 according to the request then on file throughout the entire first-instance examination proceedings and were upheld in the final decision of the examining division. The board sees no valid reason why the appellant did not

file the claims of the current main request during the first-instance proceedings to try to overcome the examining division's novelty objections.

2.4.3 Moreover, instead of using its last opportunity for defending and/or amending claim 1 then on file during the oral proceedings before the examining division, the applicant chose not to attend the oral proceedings before the examining division but to file amended claims according to a new main and sole request only at the outset of the appeal proceedings. However, the board is of the opinion that non-attendance at the oral proceedings before the examining division does not, in itself, justify the filing of new requests in the appeal proceedings as a (presumed) reaction to the course of the oral proceedings - in which the applicant chose not to participate - and the contested decision resulting from those proceedings.

2.5 The consequence of the appellant's failure to file the current main request in the proceedings before the examining division is that no in-depth exchange of views on the patentability of the amended features of claim 1 could take place between the applicant and the examining division. Hence, the examination of the patentability of the amended claims of the current main request would have to take place for the first time during the appeal proceedings, which is contrary to the primary object of the appeal proceedings, which is to review the decision under appeal in a judicial manner (Article 12(2) RPBA 2020).

2.6 In its letter dated 21 September 2023, the appellant provided for the first time reasons for submitting the current main request only upon entry into the appeal proceedings. The appellant put forward the following

arguments in favour of admittance of its main request into the proceedings.

- 2.6.1 Based on the fact that the appellant had consistently provided "*extensive novelty and inventive step arguments in support of the subject-matter they sought protection for during examination phase*" and that this had "*provided a clear indication that the Applicant genuinely considered the claimed subject-matter to be both novel and inventive over D1 and D2*", the "*Applicant did not felt [sic] it necessary to consider amending the claims to include the features that were subsequently added in the appeals [sic] phase*" (appellant's letter of 21 September 2023, page 2, first paragraph). Moreover "*the assertion that that [sic] the Applicant had many opportunities to present the subject-matter added in the appeals [sic] stage relies on hindsight since at the time there was no reason for us to look to such amendments where we were still pushing to secure protection for the subject-matter presented in the examination phase*" and "*[i]t was at no point apparent to the Applicant during first instance prosecution that such subject-matter would have been rejected eventually*" (appellant's letter of 21 September 2023, page 2, second paragraph).

The board acknowledges the appellant's right to submit or not amended claims during the first-instance proceedings as it sees fit. However, if, as in this case, the appellant decides not to file any (further) amended claims during the first-instance proceedings, even as an auxiliary request, and then changes its mind and wishes to file new requests on appeal, the appellant has to bear the consequence that the board may exercise its discretion under Article 12(6) RPBA 2020 and not admit the new requests into the appeal proceedings.

2.6.2 The appellant *"opted not to attend the OP"* before the examining division because it *"felt at the time that the written submissions filed in response to the summons to oral proceedings (OPs) would adequately address the patentability objections or at least enough to revert the prosecution to written examination"* (appellant's letter of 21 September 2023, page 2, first paragraph).

The board is not convinced by the appellant's argument. The appellant's written submissions, filed in response to the examining division's communication annexed to the summons to oral proceedings, contained an amended claim 1 according to a new sole request. Claim 1 was amended by the addition, for the first time, of the feature *"and wherein said silicone material enhances the oxygen permeability of the contact lens"*. According to the appealed decision (point II.3.3), this added feature was considered unclear by the examining division. The board acknowledges the appellant's right to submit amendments in response to the examining division's communication annexed to the summons to oral proceedings and not to attend the oral proceedings. However, if, as in the present case, the examining division concludes during the oral proceedings not attended by the appellant that the amendments raise new issues of clarity and do not overcome the patentability objections, the appellant has to bear the consequence that the examining division may take a decision refusing the European patent application at the oral proceedings.

2.6.3 The appellant argues that *"the amended features introduced do not deviate from the original subject-matter claimed but are rather directed to addressing the same features upon which the decision to refused [sic] was based"* (appellant's letter of 21 September 2023, page 2, second paragraph).

The board cannot accept the appellant's arguments since, contrary to the appellant's assertions, the deletion of two features from claim 1 underlying the appealed decision and the addition to current claim 1 of a new feature relating to the absence of hydrogel polymers do in fact constitute a substantial change to the claimed subject-matter.

3. Since the appellant's main and sole request is not allowable, the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairwoman:



L. Gabor

T. Karamanli

Decision electronically authenticated