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**Datasheet for the decision
of 21 January 2025**

Case Number: T 1833/23 - 3.4.02

Application Number: 16187146.2

Publication Number: 3144720

IPC: G02C7/04

Language of the proceedings: EN

Title of invention:
CONTACT LENS PRODUCT

Applicant:
Largan Medical Co., Ltd.

Headword:

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
Amendments - ranges - allowable (no)

Decisions cited:
T 1556/16

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

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Case Number: T 1833/23 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 21 January 2025

Appellant: Largan Medical Co., Ltd.
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 7 June 2023
refusing European patent application No.
16187146.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman P. Guntz
Members: A. Hornung
F. J. Narganes-Quijano

Summary of Facts and Submissions

- I. The applicant appealed against the decision of the examining division refusing European patent application No. 16187146.2 on the basis of Article 97(2) EPC because the requirements of Article 123(2) EPC were not fulfilled.
- II. The applicant requested "that the decision be set aside and that the patent be granted in accordance with the main request or, in the alternative, one of the first to fifth auxiliary requests in the series of numbering of the auxiliary requests, or, in the alternative, that the application be remitted to the Patent Division for further decision" (statement of grounds of appeal, page 8). The main request and the first to fourth auxiliary request are those underlying the appealed decision, respectively. The fifth auxiliary request has been filed for the first time with the statement of grounds of appeal.

The applicant did not request oral proceedings before the board of appeal in the notice of appeal, the statement of grounds of appeal or any other communication.

- III. Claim 1 of the main request reads as follows:

"A contact lens product (100), comprising:
a multifocal contact lens (210) for preventing myopia or controlling a progression of myopia, comprising:
a central region (211); and
at least one annular region (212, 213, 314) concentrically surrounding the central region (211), wherein a diopter of each of the annular regions (212, 213, 314) is different from a diopter of the central region (211); and

a buffer solution (120) comprising a cycloplegic agent, wherein the multifocal contact lens (210) is immersed in the buffer solution (120);

wherein the multifocal contact lens (210) is made of silicone hydrogel or hydrogel, the one of the annular regions (212, 213, 314) closest to a periphery of the multifocal contact lens (210) defining a first annular region (212), the diopter of the central region (211) of the multifocal contact lens (210) is $PowC$, a maximum diopter of the first annular region (212) of the multifocal contact lens (210) is $PowP1$, wherein the maximum diopter of the first annular region (212) of the multifocal contact lens (210) is greater than the diopter of the central region (211) of the multifocal contact lens (210), wherein a diameter of the central region (211) of the multifocal contact lens (210) is DiC , an outer diameter of the first annular region (212) of the multifocal contact lens (210) is $DiP1$, a weight percentage concentration of the cycloplegic agent in the buffer solution (120) is $ConA$, and the following conditions are satisfied:

$2D < PowP1 - PowC \leq 12D$;

$0.15 \leq DiC/DiP1 < 1$; and

$0.05\% \leq ConA < 1\%$.

Claim 1 of the first auxiliary request differs from claim 1 of the main request in that the first and the third conditions read:

$2.25D \leq PowP1 - PowC \leq 12D$ and

$0 < ConA \leq 1\%$.

Claim 1 of the second auxiliary request differs from claim 1 of the main request in that the first and the third conditions read:

" $2.25D \leq \text{PowP1} - \text{PowC} \leq 12D$ " and
" $0 < \text{ConA} < 0.5\%$ ".

Claim 1 of the third auxiliary request differs from claim 1 of the main request in that the first and the third conditions read:

" $2.25D \leq \text{PowP1} - \text{PowC} \leq 5D$ " and
" $0 < \text{ConA} \leq 1\%$ ".

Claim 1 of the fourth auxiliary request differs from claim 1 of the main request in that the first and the third conditions read:

" $2.25D \leq \text{PowP1} - \text{PowC} \leq 5D$ " and
" $0 < \text{ConA} < 0.5\%$ ".

Claim 1 of the fifth auxiliary request differs from claim 1 of the main request in that the first and the third conditions read:

" $2.25D \leq |\text{PowC} - \text{PowP1}| \leq 5D$ " and
" $0 < \text{ConA} \leq 1\%$ ".

Reasons for the Decision

1. Main request

Claim 1 has been amended in such a way that it contains subject-matter which extends beyond the content of the application as filed (Article 123(2) EPC).

1.1 Claim 1 comprises the following condition C1:

$2D < \text{PowP1} - \text{PowC} \leq 12D$. In other words, condition C1 defines a range for the optical power difference "PowP1 - PowC" with a lower limit equal to 2D and an upper limit equal to 12D.

1.2 As stated in the appealed decision, there is neither a literal basis for condition C1 in the patent application as originally filed, nor can a range from 2D to 12D be clearly and unambiguously derived therefrom.

1.2.1 A lower limit of 2D of the range is not literally disclosed in the patent application as originally filed.

The patent application as originally filed, page 20, discloses exclusively the following conditions for the absolute value of the optical power difference "PowP1 - PowC":

$$\begin{aligned} |\text{PowC} - \text{PowP1}| &\leq 12D, \\ |\text{PowC} - \text{PowP1}| &\leq 10D, \\ |\text{PowC} - \text{PowP1}| &\leq 5D, \\ |\text{PowC} - \text{PowP1}| &\leq 3D, \\ |\text{PowC} - \text{PowP1}| &\leq 2D, \\ |\text{PowC} - \text{PowP1}| &\leq 1.5D, \\ |\text{PowC} - \text{PowP1}| &\leq 1D, \\ |\text{PowC} - \text{PowP1}| &\leq 0.5D, \\ |\text{PowC} - \text{PowP1}| &\leq 0.25D. \end{aligned}$$

The condition $|\text{PowC} - \text{PowP1}| \leq 12D$ is equivalent to the combination of the two conditions $0 \leq \text{PowC} - \text{PowP1} \leq 12D$ and $0 \leq \text{PowP1} - \text{PowC} \leq 12D$. Therefore, the patent application as originally filed discloses a range for the optical power difference "PowP1 - PowC" with a lower limit equal to 0D and an upper limit equal to 12D. A similar reasoning shows that the other conditions in the patent application as originally filed, using the absolute value,

disclose ranges for the optical power difference "PowP1 - PowC" with a lower limit equal to 0D and an upper limit equal to 10D, 5D, 3D, 2D, 1.5D, 1D, 0.5D or 0.25D.

It follows that while the patent application as originally filed discloses 12D as the upper limit of a range for the optical power difference "PowP1 - PowC", it does not disclose 2D as the lower limit of the range. As concluded in the appealed decision, point 12.2.1.1: "No alternative reflects a non-zero lower bound".

1.2.2 A lower limit of 2D of the range is also not implicitly directly and unambiguously derivable from the patent application as originally filed.

(a) In particular, while the claimed range from 2D to 12D lies within the broadest range originally disclosed, i.e. from 0D to 12D, there is no indication in the patent application as originally filed that would lead the skilled person to disregard the range between 0D and 2D. As stated in the appealed decision, point 12.2.1.3.2, "the exclusion of the [0;2]D range as claimed in claim 1 is not disclosed". On the contrary, all the ranges disclosed in the patent application as originally filed include at least a zone close to 0D. Therefore, the exclusion of the range from 0D to 2D, i.e. the range including the zone which is included in all the embodiments disclosed on page 20 of the patent application as originally filed, from the broadest range as originally disclosed (i.e. from 0D to 12D), amounts to new technical information, contrary to the requirement of Article 123(2) EPC.

(b) Furthermore, the patent application as originally filed, page 20, lines 5 to 7, discloses that "the increase degree of the diopter of the first annular

region 112 can be moderated, so that the discomfort resulted from the excessive increase degree of the diopter can be avoided" (also cited in the appealed decision, point 12.2.1.2). The skilled person is thus taught that a large optical power difference "PowP1 - PowC" (corresponding to the "increase degree of the diopter of the first annular region 112") causes discomfort to the user. Moreover, the skilled person is taught that a solution to this discomfort is to discard the upper part of the range, i.e. to reduce the upper limit (12D) of the range of the optical power difference "PowP1 - PowC". The teaching in the patent application as originally filed continues by disclosing a plurality of alternative conditions, all of which define ranges with a lower limit equal to 0D and an upper limit decreasing from 10D to 0.25D. See also the appealed decision, point 12.2.1.3.1. "[T]he skilled person has no incentive to seriously consider working in the upper range only, thereby disregarding the lower range" (appealed decision, point 12.2.1.3.3).

- (c) The claimed range of 2D to 12D is also not implicitly disclosed by the totality of the examples in the patent application or at least by a badge of examples showing particularly advantageous results. To the contrary, most examples are situated outside this range and the few examples that lie within are not highlighted for being significantly advantageous. Furthermore, since all of those few examples lie very near or exactly at the lower bound of 2D the person skilled in the art would not deduce from the examples the information that a preferred or in other ways marked range of the invention is to be found in the broad range (going far beyond any of the examples)

which is now claimed.

(d) Where 2D is mentioned as a single value in a specific example (for instance here in the 5th and 7th examples on pages 34 to 37 and 39 to 42 of the description), no information can be derived from that fact alone as to its suitability to possibly constitute a lower boundary of a range. Such information could only be found in a respective statement in the description regarding the quality of the example or in the situation of such value relative to other values. Since the value of 2D is neither commented in the description nor situated at a lower end of exemplified values, the skilled person is not provided with the information that 2D is a potential lower boundary of a range defining the invention.

1.3 In conclusion, the information underlying the condition C1 of claim 1, according to which the lower part (i.e. from 0D to 2D) of the originally disclosed range (i.e. from 0D to 12D) is to be disregarded, corresponds to new technical information that is not directly and unambiguously derivable from the patent application as originally filed.

1.4 The applicant's arguments for showing that the amendments have a basis in the patent application as originally filed are not convincing for the following reasons:

1.4.1 The applicant submits that "if, e.g., an originally disclosed broad range is mentioned to comprise two sub-ranges and one of these is indicated as being preferred, this does not mean that the applicant can define the invention either by the broad range or by the preferred sub-range, but not by the other (less preferred) sub-range" (statement of grounds of appeal, page 2, second paragraph). "As a result, the applicant is free to direct

the independent claim to an embodiment, e.g. defined by certain a [sic] sub-range, that is not presented as preferred in the application as filed" (statement of grounds of appeal, page 2, third paragraph).

Contrary to the applicant's premise, the "originally disclosed broad range" is **not** "mentioned to comprise two sub-ranges". As explained in point 1.2.1 above, the patent application as originally filed merely discloses a broad range from 0D to 12D and an alternative narrow range from 0D to 2D. There is no disclosure in the patent application as originally filed of a broad range being composed of a first sub-range from 0D to 2D and a second sub-range from 2D to 12D.

- 1.4.2 The applicant further refers to the fifth and seventh examples described in the patent application as originally filed (see tables 13 and 19 respectively). According to these tables, the optical power difference "PowP1 - PowC" is equal to 2D, thus, "in effect splitting the broad diopter range $|PowC - PowP1| \leq 12D$ into two sub-ranges, namely $0D \leq PowP1 - PowC \leq 2D$ and $2D < PowP1 - PowC \leq 12D$. Given that through their upper and lower limits both sub-ranges have been originally disclosed, the applicant can direct the main claim to any of these" (statement of grounds of appeal, page 2, last line, to page 3, first paragraph).

The board is not persuaded by the applicant's argument. In particular, the applicant's assertion that the mention of a particular value (2D) in a specific example allowed to split a broad range into two sub-ranges (from 0D to 2D and from 2D to 12D) amounts to a mere allegation, as it lacks any supporting reasoning from the applicant. The appellant in particular fails to explain where the information that

2D is suitable as a lower boundary of a range is taken from.

Besides this, according to the case law of the boards of appeal, "limiting an originally disclosed broader range using an isolated value taken from an example may be allowed, if it does not present the skilled person with information that goes beyond the content of the original disclosure" (see decision T 1556/16, point 19 of the Reasons and the explanation in points 20 and 21 relating to the suitability of the value chosen there as the lower boundary of a range). In the present case, this condition is not fulfilled. As stated in the patent application as originally filed, higher values of the optical power difference "PowP1 - PowC" cause discomfort to the user of the contact lens. Moreover, of the twelve numerical examples described in the patent application as originally filed, the majority, i.e. eight in total, exhibit an optical power difference "PowP1 - PowC" below 2D, with the highest optical power difference being 2.5D, i.e. close to 2D. Therefore, from the patent application as originally filed, the skilled person is taught that contact lenses having a lower optical power difference "PowP1 - PowC", namely below 2D, comprise technical features having a greater interest than contact lenses having a higher optical power difference "PowP1 - PowC", namely above 2D. By excluding the range from 0D to 2D in claim 1, the skilled person is presented with new technical information that cannot be directly and unambiguously be derived from the patent application as originally filed. Consequently, the condition C1 of claim 1 represents an unallowable amendment.

2. Auxiliary requests 1 to 5

Claim 1 of auxiliary requests 1 to 5 has been amended in such a way that it contains subject-matter which extends beyond the content of the application as filed (Article 123(2) EPC) for essentially the same reasons given in point 1 above in respect of claim 1 of the main request.

Claim 1 of all auxiliary requests 1 to 5 defines an optical power difference in a range whose lower end-point is 2.25D (instead of 2D as in claim 1 of the main request). However, the patent application as originally filed does not disclose such a lower end-point of a range, either explicitly or implicitly. The value of 2.25D is disclosed in the patent application as originally filed only in a particular example, namely the 11th example on pages 49 to 53 of the description. As outlined in point 1.4.2 above, forming a new range with an isolated value (2.25D) taken from an example cannot be allowed in the present case because excluding contact lenses with optical power differences ranging from 0D to 2.25D teaches new technical information to the skilled person that is not directly and unambiguously derivable from the patent application as originally filed.

3. Since the main request and auxiliary requests 1 to 5 on file contravene the requirements of Article 123(2) EPC, there is no basis for considering a remittal of the case for further prosecution as also requested by the appellant.
4. In view of the above, none of the applicant's requests is allowable and, therefore, there is no basis for setting aside the contested decision. Consequently, the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



D. Grundner

P. Guntz

Decision electronically authenticated