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D E C I S I O N
of 7 July 1997

Case Number: T 0794/95 - 3.4.2
Application Number: 90830033.8
Publication Number: 0382684
IPC: G02B 1/04, G02B 5/20, G02C 7/00,
C08J 7/00, C08K 5/00

Language of the proceedings: EN

Title of invention:

Optical element for use in eyeglasses, visors, masks and screens to reduce the image perception time and improve the contour definition thereof

Applicant:

INTERCAST EUROPE S.P.A.

Opponent:

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Headword:

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Relevant legal provisions:

EPC Art. 111(1), 109(1)
EPC R. 67

Keyword:

"Decision of refusal based on product claims - amended claims directed to the use of the product for a stated purpose filed with the statement of the grounds of appeal - remittal to the first instance"

Decisions cited:

G 0002/88, T 0139/87, T 0047/90

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 0794/95 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 7 July 1997

Appellant: INTERCAST EUROPE S.P.A.
Via G. Natta, 10
Areas SPIP
I-43100 Parma (IT)

Representative: Bottero, Claudio
c/o Porta, Checcacci & Botti S.r.l.
Viale Sabotino, 19/2
20135 Milano (IT)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 18 May 1995
refusing European patent application
No. 90 830 033.8 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: E. Turrini
Members: A. G. Klein
L. C. Mancini

Summary of Facts and Submissions

- I. European patent application No. 90 830 033.8 (publication No. EP-A-0 382 684) was refused by the Examining Division.
- II. The decision of refusal was taken on the basis of a set of claims 1 to 5 of which claim 1, the only independent claim, after correction of the evident typographical errors pointed out in point 3 of the decision, reads as follows:

"1. An optical element comprising a plate like supporting element suitable for use both as a graduated or neutral opthalmic lens and for making masks and screens in general, said plate-like supporting element being made of a clear plastic material selected from one or more elements of the group including polymers of polyolallyl-carbonate, polyacrylates and polyalkyl-acrylates, cellulose esters such as cellulose acetate-butyrrate, cellulose triacetate, cellulose propionate, polyurethanes, aromatic polycarbonates, polystyrene or transparent copolymers thereof with other monomers such as methylmethacrylate, maleic anhydride, triallylcianurate, vinylacetate, said plastic material further comprising 4-nitro-2-methyl-4-diethanolamino-azobenzene, characterized in that said 4-nitro-2-methyl-4-diethanolamino-azobenzene is included through said plastic material by dispersion or solution methods in an amount from 50 ppm to 350 ppm so as to provide said optical element with improved perception time and image contour definition properties corresponding substantially to a characteristic light absorption peak at 500 nm providing an optical density from 0.193 to 1.446, more preferably from 0.868 to 1.184."

The reason for the refusal was that the subject-matter of claim 1 was considered to lack an inventive step in the sense of Articles 52(1) and 56 EPC. In the Examining Division's opinion the claimed subject-matter was distinguished from the optical element disclosed in document "CHEMICAL ABSTRACTS" Vol. 103, No. 22, 2nd December 1985, page 90, abstract No. 179858f, Columbus, Ohio, US, & PL-A-123 942 (D1) only in that claim 1 specified that the 4-nitro-2-methyl-4-diethanolamino-azobenzene was included through the plastic material by dispersion methods, which was held to be a normal design procedure in the art of dyeing optical elements (see point 4.4 of the reasons).

With respect to the statement in claim 1 to the effect that the 4-nitro-2-methyl-4-diethanolamino-azobenzene was included "so as to provide said optical element with improved perception time and image contour definition properties ..." the Examining Division concluded that since the optical element disclosed in D1 comprised all those structural features of the optical element defined in claim 1 which were relevant for its optical properties, it would also exhibit the improved image perception time and image contour definition as set out in claim 1 (see point 4.3 of the reasons). The Examining Division also held that the purpose for which the 4-nitro-2-methyl-4-diethanol-amino-azobenzene was incorporated was irrelevant as to the optical element itself which was defined in terms of structural features (see point 5, paragraph A of the reasons).

III. The appellant filed an appeal against the decision.

In his statement of the grounds he requested that the claims on file be deleted and substituted with an amended set of claims 1 to 5 of which claim 1, the only independent claim, reads as follows:

"1. Use of 4-nitro-2-methyl-4-diethanolamino-azobenzene for reducing an image perception time and improve a contour definition thereof in an optical element comprising a transparent plastic member for eyeglasses, visors, masks and screens."

In his conclusions the appellant submitted that all the substantial objections underlying the contested decision had been overcome, and that interlocutory revision of the same pursuant to Article 109 EPC was considered appropriate in the circumstances in view in particular of decisions T 139/87 (OJ EPO 190, 68) and T 47/90 (OJ EPO 1991, 486). He further offered to amend the specification so as to take account of document D1 and of the new wording of claim 1 as soon as patentable subject-matter would have been recognized by the Office.

Oral proceedings were requested in case the Board envisaged to dismiss the appeal without further notice.

IV. In support of the admissibility of the amended claims the appellant stressed that the rejected product claims had been substituted by claims directed to the use of 4-nitro-2-methyl-4-diethanolamino-azobenzene for a new and inventive purpose.

Following the ruling of the Enlarged Board of Appeal in decision G 02/88 (OJ EPO, 1990, 93) such claim should be interpreted as including the technical effect of a reduction of image perception time and improvement of the contour definition thereof as a functional technical feature.

The technical feature of reducing image perception time and improving a contour definition thereof was neither disclosed nor suggested by any of the citations on the file, which aimed at solving technical problems which

had nothing to do with that the invention, i.e. those of imparting a graded coloration to eyeglasses or glass frames and, respectively, of selectively absorbing radiation in the red and near red infrared portions of the spectrum.

The appellant with his statement of the grounds also filed a report of the results of a series of comparative tests carried out by the Polytechnic of Central London, School of Biological & Health Sciences, to demonstrate the unexpected technical effect underlying the invention.

Reasons for the Decision

1. The appeal is admissible.
2. The decision under appeal and the whole procedure which led to it after the issuance of two communications by the Examining Division, each followed by an attempt made by the Appellant to restrict the scope of his claims, were based on an assessment of the novelty of, and inventive step involved by, the subject-matter of **product claims**, which defined an optical element essentially in terms of the composition of the material from which it was made. The Examining Division rightly held that the indication in the claim of the intended purpose of the inclusion into the claimed composition of 4-nitro-2-methyl-4-diethanolamino-azobenzene - namely to improve image perception time and image contour definition properties of the optical element - could not in the circumstances be considered to define any distinguishing feature over the prior art product as disclosed in D1, which exhibited the same composition. As a result, the question of the novelty of, and inventive step involved by, the **use** of 4-nitro-

2-methyl-4-diethanolamino-azobenzene for the stated purpose was not evoked in the decision and there is no evidence in the file that this issue, which indeed was immaterial to merits of the subject-matter of the product claims before the Examining Division, has ever been considered by it.

3. With his statement of the grounds of appeal the Appellant requested that the **product** claims on which the decision was based be deleted and substituted by amended claims directed to the **use** of 4-nitro-2-methyl-4-diethanolamino-azobenzene for reducing an image perception time and improve a contour definition thereof in an optical element.

As a result of this change the claims have been substantially amended, in a way which also calls for substantial further examination of a number of issues on which the Examining Division did not yet express a reasoned opinion, like:

- whether the amendments brought to the claims meet the requirements of Article 123(2) EPC, and whether the claims are clear in the meaning of Article 84 EPC in respect in particular of the definition of the technical effect;
- whether the principles set out in the decision of the Enlarged Board of Appeal G 02/88 (supra) relied upon by the Appellant apply to the present case;

- if so, whether the reality of the occurrence of the alleged technical effect as stated in claim 1 is adequately supported by the evidence on the file, in particular by the information available from the test report joined to Appellant's statement of the grounds of appeal, for the entire scope of the claim; and
 - whether the claimed use is novel and inventive in view of the prior art as already on the file or as might be put to light by an additional search centred on the technical effect set out in claim 1 rather than on the composition, should such additional search be considered appropriate in the circumstances (see Guidelines for Examination in the EPO, Chapter VI 8.5).
4. Accordingly, in order not to deprive the Appellant of the right to have his case decided on all these issues by two instances and taking also in account that the essential function of appeal proceedings is to determine whether a decision at first instance was correct on its merits rather than to provide a continuation of first instance proceedings, the Board deems it appropriate to exercise its power under Article 111(1) EPC and to remit the case to the Examining Division for further prosecution; see also published decision T 47/90 (supra), points 3 to 5 of the reasons.
5. In the Board's judgement, the Examining Division should have in the present circumstances rectified its decision under Article 109(1) EPC and proceeded to the interlocutory revision expressly requested by the Appellant in his statement of the grounds of appeal. The reasons for the refusal were based on an assessment of the inventive step of the subject-matter of product claims which expressly did not take into account the

question of the novelty and obviousness of the purpose for which the claimed composition was used. The reasons for the refusal therefore clearly did no longer apply to the subject-matter of the amended claims filed with Appellant's statement of the grounds, in replacement of the claims on which the refusal was based; see also published decision T 139/87 (supra), points 3 and 4 of the reasons.

Whether the Examining Division not having rectified its decision constitutes a substantial procedural violation in the sense of Rule 67 EPC for the purpose of the reimbursement of the appeal fee need not be examined further, since such reimbursement would certainly not be equitable in the circumstances. As a matter of fact the examining procedure up to the decision under appeal was not tainted with any failure and the necessity for the Appellant to file an appeal exclusively emerged from the decision, not from its later incorrect handling by the Examining Division.

6. Since the Board does not envisage to dismiss the appeal oral proceedings as requested in such event by the Appellant need not to be held.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution on the basis of claims 1 to 5 filed by the Appellant with his statement of the grounds of appeal dated 18 September 1995.

The Registrar

The Chairman

P. Martorana

E. Turrini