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Bezeichnung der Erfindung: Bifocal contact lens
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement : G02C 7/06

ENTSCHEIDUNG / DECISION
vom / of / du 10 September 1990

Anmelder / Applicant / Demandeur : University Optical Products Co.

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPÜ / EPC / CBE Article 56

Schlagwort / Keyword / Mot clé : "Inventive step (No)"

Leitsatz / Headnote / Sommaire

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Case Number : T 382/89

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 10 September 1990

Appellant : University Optical Products Co.
537 Newtown Avenue
Norwalk Connecticut 06852 (US)

Representative : Skone, James Robert Edmund
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Decision under appeal : Decision of Examining Division 041 of the European Patent Office dated 3 January 1989 refusing European patent application No. 84 306 308.2 pursuant to Article 97(1) EPC

Composition of the Board :

Chairman : J.D. Roscoe
Members : W.W. Hofmann
L. Mancini

Summary of Facts and Submissions

I. European patent application No. 84 306 308.2 (publication No. 0 138 394) was refused by decision of the Examining Division.

II. The decision was based on the originally filed Claims 1 to 3, of which the only independent claim, Claim 1, reads as follows:

"1. A bifocal contact lens for the cornea of an eye, comprising:

a thin circular lens body (19) having a near-power correction region (31) of circular periphery in the central portion thereof, surrounded by a concentric distance-power annular correction region (41);

characterized in that the lens body (10) is formed of a single piece of plastics material and has a symmetrically curved rear surface (21) adapted to fit centrally on the corneal surface of the eye, and in that the near-power central region (31) has an area which is substantially equal to half the pupil area of the eye under average reading light conditions."

III. The reason for the decision was that although the subject-matter of Claim 1 was novel it did not involve an inventive step since it was obvious that a person skilled in the art reading pages 571 to 573 of the textbook "Contact Lenses" by J. Stone, A.J. Philips 2nd. Ed. (2vol.) 1980/81, combined second edition 1984 (hereafter D1) would immediately think of using the same relation (between near and distance power areas) in a lens having the near power area in its centre as that employed in the lens with a centrally placed far power area, irrespective of whether the lens was of the corneal or scleral type. The statement on page 660 of the textbook of Mandell (hereafter D2) referred to in the application itself that

the near power segment diameter should be equal to, or 0.1 to 0.2 mm smaller than the pupil size under bright illumination was deemed not to be inconsistent with satisfaction of the above-mentioned areal-relationship.

D2 clearly taught that any bifocal contact lens may be designed according to either the bivision or the simultaneous vision principle, and it appeared obvious to apply the former principle to the concentric bifocal lens - as illustrated in Fig. 29.4c of D2 or to the Williamson-Noble lens described in D1.

IV. An appeal was lodged against the decision.

V. The Appellant requested that the decision of the Examining Division be set aside and a patent granted on the basis of a set of Claims 1 to 3 filed on 5 May 1989 with the Statement of Grounds of Appeal.

The only difference between Claim 1, the sole independent claim of the set, and the Claim 1 on which the appealed decision was based is that the feature that the lens body be formed of a single piece of plastics material now appears in the preamble of the claim whereas it was previously a characterising feature.

In the Statement of Grounds the Appellant company presented arguments in defence of Claim 1 and requested oral proceedings in the event that the Board could not allow its request.

VI. In a communication of the Board pursuant to Article 11(2) of the Rules of Procedure of the Boards of Appeal, sent with the summons to oral proceedings, the Rapporteur, on behalf of the Board explained in the following terms why the Board had serious doubts as to the patentability of the subject-matter of all the claims.

"There are two categories of concentric bifocal contact lenses referred to in the documents (1) and (2), namely those designed to operate according to the bivision principle, and those operating on the alternating vision principle, and the rear surfaces of the respective categories of lens clearly have to be constructed so as (a) to maintain the lens essentially centered on the optic axis of the eye despite movement of the eye, for the bivision type, or (b) in the case of the alternating vision type, to allow the lens to move in a generally vertical direction so that at least a substantial part of the pupil is covered by the distance power correction zone when the wearer is looking directly ahead whereas when the eye is lowered when reading the lower lid can move the lens into a position in which most of the pupil area lies beneath the near power correction zone.

Although no cornea lens of the **bivision** type having the near power correcting zone at its centre is actually described in either of these two documents there seems to be nothing to dissuade a skilled person, made aware of the problems, referred to in item 4.3 of the Statement of Grounds, encountered with the type of lens illustrated in Figures 24 (typing error, should have read 29.4) c and d of document (2), from considering its replacement by such a bivision corneal type, especially since this type has already found use in the lens described in document (3), i.e. the article "Ultrafocal^{R} Bifocal Contact Lens" by Claude A. Kendall, from the January 1976 issue of Contacto, which makes use of the pinhole principle in design of its near-vision zone (see especially the text, items 2 and 3 in Figure 1, in conjunction with lines 3 to 5 on page 31, and lines 9 to 12 of the left-hand column of page 34).

In view of the qualities attributed to the claimed lens, the problem to be solved is to be seen as the designing of

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a lens providing this combination of qualities, namely good night-driving (distant) vision while retaining adequate near-vision and good depth of field in bright light in the near-vision zone.

The skilled person considering the design of a bivision central near-vision zone lens to meet these requirements had first to ensure that the rear surface of the lens is profiled in such a way that the lens remains essentially in a fixed position and the Rapporteur can see nothing surprising in the choice of symmetrical curving as claimed in order to achieve this. Then he has to decide how large to make the central zone. In doing so he must, in the Rapporteur's opinion, be expected not to decide this according to the criteria set out in documents (1) and (2) for lenses of the alternating vision type, but to follow the general principle of illumination used in the bivision type of concentric bifocal with central distance-vision zone, i.e. ensuring that approximately the same amount of light enters through the near and distant vision portions under conditions of "average" illumination (see page 573, left-hand column, lines 11 to 15 of document 1 and page 658, left-hand column, lines 4 to 8 of document 2), or at any rate to recognise the need for sufficient illumination of each zone of the lens under the conditions in which it is most employed or in which optimum performance is required. It cannot be seen that the skilled person would consider these criteria to be exclusive to the type of lens with a central distance-vision zone.

Following the equal illumination criterion would, it seems, inevitably lead the skilled person to a size of near-vision zone falling within the range claimed in all of the claims.

In view of his objectives, the skilled person might be expected next to construct such a lens and test its capabilities in the above-mentioned respects, in which case he would find that they satisfied his requirements.

Alternatively, he would first consider from a theoretical point of view how the lens might be expected to perform, making use of his routine knowledge of the response of the eye to different lighting conditions. Thus, he would realise that reduction of the light intensity as in night driving would cause the pupil to dilate so that a greater proportion of the available light illuminates the far-vision zone which would be seen as desirable. Furthermore, he would appreciate that under very bright conditions the pupil contracts to such an extent that only the central part of the near zone is active and would, therefore, have a considerably increased depth of focus and thus perhaps be adequate for distance as well as near-vision. All this could than readily be verified by experiment.

Having regard to the above considerations, the Rapporteur has serious reservations as to whether the lens claimed in Claim 1, 2 or 3 involves an inventive step."

VII. Oral proceedings were scheduled to take place on 18 July 1990 but in a letter received on 15 June 1990 the authorised representatives of the Appellant company stated that they had been instructed by their clients not to attend the oral proceedings. The letter contained no proposal to amend nor any arguments, stating simply that they wished a final decision to be made on the basis of the documents currently on file.

VIII. From this it must be assumed that the Appellant maintains his request as set out in item V above.

Reasons for the Decision

1. The appeal is admissible.

2. The Appellants by their withdrawal from the oral proceedings, their failure to submit new documents or comment on the reasoned arguments presented in the Board's communication and their wish that a final decision be made on the basis of the documents on file (item VII above) are clearly calling for a decision on the state of the file. The Board therefore sees no valid reason which could justify continuing further with the proceedings.

3. The reasoned opinion given in the Board's communication has not been contested by the Appellant, and the Board is therefore justified in basing its decision on that opinion, which it sees no reason to change.

Accordingly the Board finds that, for the reasons set out in item VI above, the subject-matter of Claims 1 to 3 is lacking in inventive step.

It follows therefore that the appeal has to be dismissed.

Order

For these reasons, it is decided that:

The appeal is dismissed.

The Registrar: **The Chairman:**

P. Martorana J.D. Roscoe

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