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D E C I S I O N
of 20 January 2004

Case Number: T 1086/01 - 3.4.2

Application Number: 96203631.5

Publication Number: 0780669

IPC: G01J 3/28

Language of the proceedings: EN

Title of invention:

Telescope with a large field of vision

Applicant:

NEDERLANDSE ORGANISATIE VOOR TOEGEPAST-NATUURWETENSCHAPPELIJK
ONDERZOEK TNO

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"Upper limit of a range disclosed in relation to the prior art
not allowed as lower limit in the definition of the invention
in the claims"

Decisions cited:

T 0507/99, T 1071/97

Catchword:

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Case Number: T 1086/01 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 20 January 2004

Appellant: NEDERLANDSE ORGANISATIE VOOR TOEGEPAST-
NATUURWETENSCHAPPELIJK ONDERZOEK TNO
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Representative: Prins, Adrianus Willem
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 9 May 2001
refusing European application No. 96203631.5
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. G. Klein
Members: M. P. Stock
G. E. Weiss

Summary of Facts and Submissions

- I. The applicant (appellant) has appealed against the decision of the examining division refusing European patent application number 96 203 631.5 on the ground that its subject-matter does not meet the requirements of Article 123(2) EPC because some amendments extend beyond the content of the application as filed.

The examining division was of the opinion that the feature in claim 1 underlying the appealed decision that the field angle α is equal to or larger than 30 degrees is not disclosed in the application as filed. Disclosed was only that the field angle α is equal to or greater than 90 degrees.

- II. The arguments of the appellant submitted with the grounds of appeal can be summarised as follows:

It was stated in the original application that the present invention had the object to provide a telescope of prior art having comparable dimensions but having a larger field of view. It was clear that the inventor tried to obtain a field angle which was larger than the field angle of the prior art telescope. No limitation as to the field angle had been made in the original claims. It was clear that any angle larger than 30 degrees fell under the scope of protection of this invention. The solution to the problem of increasing the field angle was to dimension and arrange the entrance pupil and the first reflecting element with respect to each other. The amendment "greater than 30 degrees" was only used in order to delimit the invention from the prior art. Consequently, no subject-

matter was added by saying that the field angle α according to the invention was larger than 30 degrees. The field angle α 90 degrees mentioned in the application was valid for an embodiment. This embodiment was only preferable and the invention was not limited thereto.

The appellant requested that a patent be granted on the basis of the claims filed with the grounds of appeal.

Claim 1 reads as follows:

"1. Telescope (1) comprising two reflecting elements (3,4), the first reflecting element (3) being arranged for reflecting an incoming light beam to the second reflecting element (4), the shape of the reflecting surfaces of the first and second reflecting element (3,4) being concave, an entrance pupil being located in the light path in front of the first reflecting element (3), the first reflecting element (3) being constructed and oriented for imaging the entrance pupil (2) in the focus of the second reflecting element (4), characterised by the entrance pupil (2) and the first reflecting element being dimensioned and arranged with respect to each other so that the field angle (α), being defined by the entrance pupil (2) and the first reflecting element (3) and being a measure for the field of view of the telescope (1), is larger than 30 degrees."

III. In preparation of the oral proceedings requested by the appellant the board of appeal made the following preliminary non-binding comments in a communication annexed to the summons:

Figures for a field angle are indicated in two sentences of the description of the present patent application as originally filed on page 3, lines 2 and 3. These sentences read:

"In the shown embodiment the telescope 1 has an angle α 90 degrees. In contrast α 30 degrees is valid for the known telescope."

The skilled person would derive from the first sentence that there is not only one embodiment having a distinct value of α falling within the range α 90 degrees, but that there is a whole class of embodiments having the layout shown in Figures 1 and 2 with different values of α all meeting the condition α 90 degrees. From the second sentence the skilled person would learn that α is much smaller, namely 30 degrees, in known telescopes than in embodiments of the invention. However, the skilled person would not derive from the second sentence that according to the invention α has a lower limit of 30 degrees. Rather would the skilled person arrive at the conclusion that for the invention the lower limit is 90 degrees.

The feature "less than 30 degrees" is related to the "known telescope" which is the one disclosed in DE-A-3 614 639 cited in the application, page 1, lines 13 to 19. The present application has the object to provide a telescope of this type having comparable dimensions but having a larger field of view, see page 1, lines 20 to 22. Even though it is indicated in the application that for telescopes of this type α 30 degrees is valid, it is not directly and

unambiguously derivable from this that "having a larger field of view" means "greater than 30 degrees". It had been left open in claim 1 as originally filed how much larger the field angle was according to the invention. Therefore any value for a field angle would fall within the scope of the original claim 1. However, if this range were to be restricted, the only disclosed subrange for the purpose of Article 123(2) EPC would be á 90 degrees.

According to the appellant the amendment "greater than 30 degrees" is only used in claim 1 as a delimitation from the prior art. Such a delimitation would have the character of a disclaimer.

However, the board is of the opinion that, if such a disclaimer were allowable at all, which is investigated at present by the Enlarged Board of Appeal (Referral by T 507/99 to be published, pending under G 1/03), it would be restricted to cases of accidental disclosure which would not be considered by the skilled person faced with the assessment of inventive step (see T 1071/97 discussed in Case Law, 4th edition 2001, page 211). In the present case the feature "less than 30 degrees" is disclosed in the application in relation to the "known telescope" which is the one disclosed in DE-A-3 614 639 cited in the application, page 1, lines 13 to 19. Since the problem stated in the application addresses the improvement of this type of telescope, see page 1, lines 20 to 22, DE-A-3 614 639 is considered for inventive step and there is no accidental disclosure justifying a disclaimer.

Moreover the board stated that the only issue to be discussed in the oral proceedings would be the ground of refusal under Article 123(2) EPC. If the appellant decided to define "á 90 degrees" in claim 1 and notified the board accordingly before the oral proceedings, the board would consider to cancel the oral proceedings, to set aside the appealed decision and to remit the case to the examining division for further prosecution on the basis of this version of claim 1.

- IV. With telefax dated 15 January 2004 the appellant notified the board that he withdraws the request for oral proceedings.

- V. Oral proceedings took place on 20 January 2004 in the absence of the appellant. At the end of the oral proceedings the decision was given by the board.

Reasons for the Decision

- 1. The appeal is admissible.

- 2. The board maintains its position that the subject-matter of claim 1 extends beyond the content of the application as originally filed; see Article 123(2) EPC. The reasoning given by the board in its communication annexed to the summons for oral proceedings (see paragraph III above) was not contradicted by the appellant who withdrew his request for oral proceedings without filing further arguments or requests.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

P. Martorana

A. G. Klein