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**Datasheet for the decision  
of 21 September 2006**

**Case Number:** T 1033/04 - 3.4.02

**Application Number:** 95109659.3

**Publication Number:** 0690327

**IPC:** G02B 13/00

**Language of the proceedings:** EN

**Title of invention:**

Wide angle, deep field, close focusing optical system

**Applicant:**

Mantis Wildlife Films Pty. Limited

**Opponent:**

-

**Headword:**

Wide angle/MANTIS WILDLIFE

**Relevant legal provisions:**

EPC Art. 84, 56, 123(2)

EPC R. 66(2), 68(1)

**Keyword:**

"Withdrawal of appeal after announcement of final decision by the Board - no effect of the decision-taking procedure"

"Lack of clarity, added subject-matter, lack of inventive step"

"Non appearance at oral proceedings - dismissal of appeal on the grounds previously communicated to the appellant"

**Decisions cited:**

G 0008/91, G 0012/91, T 0515/94, T 0716/01

**Catchword:**

A statement of withdrawal of appeal made by the (sole) appellant after the final decision of the Board had been announced at oral proceedings does not relieve the Board of its duty to issue and to notify to the appellant the decision in writing setting out the reasons for the decision in order to conclude the decision-taking procedure triggered by the announcement of the final decision at the oral proceedings (point 3 of the reasons).



Case Number: T 1033/04 - 3.4.02

**DECISION**  
of the Technical Board of Appeal 3.4.02  
of 21 September 2006

**Appellant:** Mantis Wildlife Films Pty. Limited  
14 Taylors Road  
Dural, NSW 2158 (AU)

**Representative:** Gleiss, Alf-Olav  
Gleiss Grosse Schrell & Partner  
Patentanwälte Rechtsanwälte  
Leitzstraße 45  
D-70469 Stuttgart (DE)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 19 February 2004  
refusing European application No. 95109659.3  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** A. G. Klein  
**Members:** F. J. Narganes-Quijano  
C. Rennie-Smith

## Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal against the decision of the examining division to refuse European patent application No. 95 109 659.3 (publication No. 0 690 327).

In the decision under appeal the examining division held that the subject-matter of claim 1 then on file did not involve an inventive step (Article 56 EPC). In support of its finding, the examining division referred, among others, to the disclosure of document

D6: US-A-4867549

and to measures commonly used in the photographic imaging field.

- II. With the statement setting out the grounds of appeal the appellant submitted an amended set of claims 1 to 30 and requested that the decision under appeal be set aside and that a patent be granted on the basis of the amended set of claims. The appellant also requested oral proceedings on an auxiliary basis.

Claim 1 amended according to the appellant's request reads as follows:

"An optical system for a camera to photograph objects in space in front of the camera, comprising an objective lens (23,53,73), a field lens (27,57,77) and a relay lens (28,58,78), positioned in a barrel (22) and aligned on an optical axis (24,54,74) in that order, said objective lens accepting radiation from an object

(O) in space and forming a first image (25,55,75) between said objective lens (23,53,73) and said relay lens (28,58,78), said field lens collecting and transferring radiation from said first image to said relay lens to form a final image (29,59,79) at an image detection means wherein said field lens is fixed in said barrel in the desired location from the fixed objective lens and wherein the relay lens is adjustable along said optical axis for focusing said final image, wherein in said optical system the field lens (27,57,77) and the relay lens (28,58,78) are respectively arranged in a way that said first image is formed with a width  $W'$  and the final image is formed with a width  $W$ , the width  $W$  being smaller than the width  $W'$  whereby the size of said first image being greater than the size of said final image and wherein said relay lens consists of a single lens for relaying the radiation and forming the final image, and wherein said relay lens comprises means for aperture control."

III. Oral proceedings were appointed as requested by the appellant on an auxiliary basis. In a communication pursuant to Article 11(1) of the Rules of Procedure of the Boards of Appeal (RPBA), annexed to the summons to attend oral proceedings, the Board referred to the following documents, cited from the Board's own knowledge, in support of the common measures in the photographic imaging field alleged by the examining division:

- A1: US-A-2960565
- A2: US-A-4185297
- A3: EP-A-0236527
- A4: EP-A-0054127

and gave a preliminary assessment of the case. In particular, the Board raised a series of objections under Articles 84 and 123(2) EPC with regard to the amended claims and commented on the issue of inventive step (Articles 52(1) and 56 EPC) of the subject-matter of claim 1 and of the particular embodiments defined in the dependent claims. More particularly, as far as the subject-matter of claim 1 is concerned, the Board commented as follows:

*Articles 84 and 123(2) EPC*

"In view of the definition of the term "lens" in the description of the application (page 6, lines 2 to 5), it is not unambiguously clear (Article 84 EPC) whether the expression "single lens" at line 21 of claim 1 refers to a single lens element or to a single lens group possibly containing a plurality of lens elements (Article 84 EPC). In addition, in the event that the expression "single lens" of claim 1 is interpreted as a "single lens element", then it is doubtful whether the provision of the relay lens in the form of a single lens element can be clearly and unambiguously derived from the original application, and in particular from the generic disclosure at lines 2 to 5 of page 6 of the description (Article 123(2) EPC) [...]."

"The feature according to which the first or intermediate image is formed "between said objective lens and said relay lens" (claim 1, lines 9 and 10) constitutes a generalization of the feature defined in page 6, lines 17 to 19 of the original description for

which no support in the application as originally filed can be found."

*Articles 52(1) and 56 EPC*

"Document D6 discloses an optical system for photographically imaging objects with a camera (Figure 2 and column 1, lines 6 to 12 together with column 3, line 66 *ff.*). The optical system comprises an objective lens O (column 4, line 14 to 19), a field lens G1 (column 3, line 68), and a lens system G2F-G2R operating as a relay lens (see Figure 2 and column 1, lines 13 *ff.*). The objective lens forms an intermediate image of an object at a position close to the field lens (see Figure 2), and the field and the relay lenses form a final image at the image detection means of the camera (column 4, lines 29 to 33). In addition, the field lens is fixed with respect to both the camera and the objective (Tables 1 to 3), the relay lens contains means for controlling the aperture of the optical system (stop S in Figure 2, see column 4, line 10), and the optical arrangement is such that the final image is smaller than the intermediate image (column 1, lines 6 and 7, and column 4, lines 29 to 33).

Document D6 discloses the relay lens in the form of a single lens group constituted by a plurality of lenses L21 to L26 (Figure 2 and the corresponding description). Should claim 1 be interpreted as requiring that the relay lens is constituted by a single lens element (see [...] above), then it appears obvious to simplify the optical system of document D6 in accordance with the circumstances by replacing the relay lens group by a single relay lens element having the same image

relaying function. The description of the application itself refers to the two alternatives as two equivalent variants (page 6, lines 2 to 5).

While present claim 1 requires that the relay lens is movable for focusing the optical system, document D6 does not specify which of the optical elements are used for focusing the optical imaging system. However, the use of the image relay lens of a camera imaging optical system for focusing the image constitutes a conventional measure in this art, see as illustrative examples document A1 (Figure 4 and column 4, lines 61 to 63) and document A2 (Figure 1 and column 3, lines 50 to 55 and column 4, lines 14 to 42).

Finally, document D6 does not specify the means physically and optically enclosing the lens imaging system. However, especially in the case of a camera such as that considered in the document, such means are generally and conventionally in the form of barrels, see figures of documents A1, A2, A3 and A4.

In view of the above, the claimed subject-matter would not appear to involve an inventive step (Articles 52(1) and 56 EPC).

The arguments of the appellant in support of inventive step of claim 1 do not appear persuasive because neither the provision of a barrel nor the use of a rear relay lens possibly constituted by a single lens element as focusing means would support *per se* any improvement in the effective depth of field of the imaging system and/or in the imaging capability for small objects located close to the imaging system,



and/or in simulating a wide angle lens imaging system as submitted by the appellant."

- IV. In reply to the summons to attend oral proceedings, the representative confirmed that he had received the summons and requested a translation from English into German and *vice versa*. The Board informed the representative that it acceded to hold the oral proceedings in German.

No other request or substantive submission was made by the appellant before the oral proceedings. The arguments in the statement of grounds of appeal in support of the appellant's requests pre-date, and thus have no bearing on the issues subsequently raised by the Board in the communication annexed to the summons to oral proceedings.

- V. At the time appointed for the oral proceedings on 21 September 2006 the appellant was not present. The registrar of the Board contacted the representative of the appellant by telephone and was informed that the representative would not attend the oral proceedings. After receipt of this information, the oral proceedings were opened, it was established that the appellant, albeit duly summoned, was not present, and the oral proceedings were continued in the absence of the appellant and its representative. At the end of the oral proceedings the Board announced the decision reported in the order.

- VI. By a letter dated 25 September 2006 the representative of the appellant indicated that "the applicant withdraws the appeal".

## **Reasons for the Decision**

1. The appeal is admissible.
  
2. *Substantive matters*

In the communication pursuant to Article 11(1) RPBA annexed to the summons to oral proceedings the Board explained in detail why in its preliminary opinion the subject-matter of amended claim 1 did not satisfy the requirements of Articles 84 and 123(2) EPC and did not involve an inventive step (Articles 52(1) and 56 EPC).

In the course of the proceedings the appellant made no substantive submissions in reply to the detailed objections raised by the Board in the communication under Article 11(1) RPBA and, more particularly, did not attend the oral proceedings which were held in its absence pursuant to Rule 71(2) EPC and Article 11(3) RPBA. The appellant has therefore not availed itself of the opportunity to reply to the preliminary view of the Board expressed in its communication.

After consideration of the issues addressed in the aforementioned communication and in the absence of any attempt by the appellant to refute or overcome the objections raised with regard to claim 1 according to the appellant's request (point III above), the Board did not see during the oral proceedings any reason to depart from the preliminary opinion expressed in the communication. Accordingly, noting that the appellant had had, and had failed to use, the opportunity to

present comments on the objections raised by the Board in the aforementioned communication (Article 113(1) EPC), the Board concluded at the oral proceedings that the request of the appellant did not comply with the formal requirements of Articles 84 and 123(2) EPC and with the substantive requirements of Articles 52(1) and 56 EPC, and that consequently the appeal was to be dismissed for the reasons already communicated to the appellant and reproduced in point III above (Rule 66(2) (g) EPC).

3. *Procedural matters*

By letter dated 25 September 2006 the appellant stated that the appeal was withdrawn. This statement, however, was made after the final decision concerning the present appeal had already been announced by the Board under Rule 68(1) EPC, first sentence, at the oral proceedings held on 21 September 2006. Thus, since the decision given orally by the Board became effective on 21 September 2006 by virtue of its being pronounced (decision G 12/91, OJ EPO 1994, 285, point 2 of the reasons), no retroactive effect on the decision can be attributed to the late statement of withdrawal of the appeal (see for instance G. Paterson, "The European Patent System", 2nd ed., London, 2001, § 4-128). It follows that - irrespective of any potential effect of the statement of withdrawal of the appeal on other issues - the late statement of withdrawal of the appeal made by the appellant has no immediate effect on the final decision given orally by the Board and, consequently, the statement does not relieve the Board of its duty under Rule 68(1) EPC, second sentence to issue and to notify to the appellant the decision in

writing setting out the reasons for the decision (Rule 66(2) (g) EPC) in order to conclude the decision-taking procedure triggered under Rule 68(1) EPC, first sentence by the announcement of the final decision at the oral proceedings. This view is not at variance with the principle set down in decision G 8/91 (OJ EPO 1993, 346) according to which, in so far as the substantive issues are concerned, appeal proceedings are terminated when the sole appellant withdraws the appeal because in the present case the appeal proceedings were already terminated at the oral proceedings when the Board announced its final decision (see G 12/91 *supra*, point 3 of the reasons; see also decisions T 515/94, point 25 of the reasons, and T 716/01, point 18 of the reasons), and the issuance of the present written decision setting out the reasons for the decision after the statement of withdrawal of appeal does not constitute a continuation of the appeal proceedings within the meaning of decision G 8/91, but a procedural act (Rule 68(1) EPC, second sentence together with Rule 66(2) EPC) concluding the decision-taking procedure set out in Rule 68(1) EPC.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:

M. Kiehl

A. G. Klein