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**Datasheet for the decision  
of 10 March 2009**

**Case Number:** T 0069/07 - 3.2.07

**Application Number:** 99101573.6

**Publication Number:** 0933163

**IPC:** B24B 13/005

**Language of the proceedings:** EN

**Title of invention:**  
Cup attaching apparatus

**Patentee:**  
Nidek Co., Ltd.

**Opponent:**  
Buchmann Deutschland GmbH

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 54, 111(1), 123(2)(3)

**Relevant legal provisions (EPC 1973):**  
-

**Keyword:**  
"Non-appearance of party without previous indication"  
"Added subject-matter - no (after amendment)"  
"Novelty - yes"  
"Remittal - yes"

**Decisions cited:**  
T 0954/93

**Catchword:**  
See point 1 of the reasons



Case Number: T 0069/07 - 3.2.07

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.07  
of 10 March 2009

**Appellant:**  
(Patent Proprietor)

Nidek Co., Ltd.  
7-9, Sakae-cho  
Gamagori-shi  
Aichi (JP)

**Representative:**

Weber, Joachim  
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**Respondent:**  
(Opponent)

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**Representative:**

Christophersen, Ulrich Rudolf  
Christophersen & Partner  
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**Decision under appeal:**

Decision of the Opposition Division of the  
European Patent Office posted 8 November 2006  
revoking European patent No. 0933163 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** H.-P. Felgenhauer  
**Members:** P. O'Reilly  
I. Beckedorf

## Summary of Facts and Submissions

- I. Opposition was filed against European patent No. 0 933 163 as a whole based on Article 100(a) EPC (lack of novelty and lack of inventive step), Article 100(b) EPC (insufficiency of disclosure) and Article 100(c) EPC (added subject-matter), whereby for Article 100(b) EPC the corresponding box in Form 2300 was crossed, but no substantive grounds were filed.

The opposition division decided to revoke the patent. It held that the subject-matter of claim 1 of the main request was not novel and that the amendment to claim 1 of the auxiliary request did not comply with Article 123(2) EPC.

- II. The appellant (proprietor) filed an appeal against that decision.
- III. The appellant requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution.

The respondent (opponent) requested in the written proceedings in essence that the appeal be dismissed.

- IV. Oral proceedings were held before the Board on 10 March 2009.

At the oral proceedings the appellant indicated that the set of claims filed during the oral proceedings were to be the basis of the proceedings.

The respondent did not appear at the oral proceedings. In a telephone conversation with the registrar of the Board the representative of the respondent indicated that the respondent had decided the day before the oral proceedings not to attend these.

V. The independent claim 1 (reference letters added by the Board) of the patent according to the main request reads as follows (amendments when compared to claim 1 of the patent as granted are depicted in bold or struck through):

1. A cup attaching apparatus comprising
  - (a)- attaching means (~~7~~; 107) having a reference axis (L) for attaching a cup (~~6~~; 106) as a processing jig to a ~~subject~~-lens along the reference axis (L);
  - (b)- illuminating means (~~10~~; 110) for projecting light onto the lens (LE) and ~~an index plate (14; 114) having an index of a predetermined pattern~~ by means of substantially parallel rays of light **having a larger diameter than the diameter of the lens (LE)**;
  - (c)- **a screen (105) arranged at a position where an entire image of the lens is projected;**
  - (d)- **imaging means (117b) for picking up the lens image projected onto said screen; and**
  - (e)- **display means (102) for displaying the lens image (LE') of the lens (LE) picked by said imaging means,** characterized in that
  - (f)- said illuminating means (~~10~~; 110) projecting the light onto the lens (**LE**) and an index plate (~~14~~; 114) having an index of a predetermined pattern by means of the substantially parallel rays of light;

- (g)- **said screen (105) arranged at a position where an image of the index formed by the light transmitted through the lens and said index plate is projected;**
- (h)- **said imaging means (117b) picking up the entire lens image projected onto said screen; and**
- (i)- **said display means (102) displaying in a superposed manner the entire lens image (LE') of the lens (LE) picked by said imaging means and an intended lens shape figure (120) formed on the basis of the data inputted by input means (103, 137),**
- (j)- **wherein said input means (103, 137) are for inputting data on a shape of an eyeglasses frame into which the subjected lens is fitted and data on layout of the intended lens shape figure,  
the apparatus further comprises:**
- (k)- **index detecting means (~~17;~~ 117a) for detecting ~~an the index~~ image of ~~the index~~ formed by the light transmitted through the screen ~~an the index~~ plate projected onto said screen,**
- (l)- **optical-center sensing means (~~30, 34;~~ 130, 134) for obtaining a position of an optical center of the lens (LE) on the basis of positional variation of the index image detected by said index detecting means and obtaining positional displacement of the optical center position of the lens with respect to the reference axis (L);**
- (m)- **position storing means (~~40;~~ 140) for storing data on the positional displacement of the optical center position of the lens obtained by said optical-center sensing means when said cup is attached to the lens by said attaching means;**
- (n)- **wherein the data on the positional displacement of the optical center position of the lens stored by said position storing means is used at the time of correcting**

processing data for processing by an eyeglass lens processing apparatus (38;—138);

(o)- wherein said display means (102) displays the intended lens shape figure such that a position of an optical center of the intended lens shape figure determined on the basis of the data inputted by said input means (103, 137) is located at the optical center position of the lens (LE) obtained by said optical-center sensing means (130, 134);

(p)- shape storing means (140) for storing data on a shape of the cup (106) which is attached to the lens (LE),

(q)- wherein said display means (102) displays a cup shape figure (123) formed on the basis of the cup shape data stored by said shape storing means such that the center of the cup shape figure corresponds to said reference axis as a cup attaching center, and displays alignment information for avoiding processing interference, the alignment information including the cup shape figure displayed on the basis of the cup shape data stored by said shape storing means, the intended lens shape figure displayed on the basis of the data inputted by said input means, and the positional displacement of the optical center position of the lens with respect to the reference axis (L).

VI. The documents cited in the present decision are the following:

E6: JP-A-03 060 960;

E6a: Translation into English of E6.

VII. The arguments of the appellant may be summarised as follows:

- (i) The claims as amended comply with Articles 123(2) and 123(3) EPC.

The basis for the amendments to the claims is given using the division of claim into features (a) to (g) (see point V. above). For convenience reference is made to the claims and description of the patent as granted, though in each case there is a corresponding basis in the application as originally filed.

Feature (a) was already in claim 1 as granted and the deleted word "subject" was superfluous.

A basis for feature (b) may be found in claim 1 as granted and column 10, lines 17 to 20 whereby the feature has been divided into two parts without its meaning being altered, in view of the claim being in the two-part form.

A basis for feature (c) may be found in column 10, lines 20 to 25.

A basis for features (d) and (e) may be found in claim 11 as granted.

Feature (f) was already in claim 1 as granted.

A basis for feature (g) may be found in column 10, lines 20 to 25.

A basis for feature (h) may be found in claim 11 as granted.

A basis for feature (i) may be found in claim 11 as granted as well as column 11, lines 52 to 56.

A basis for feature (j) may be found in claim 3 as granted as well as column 11, lines 52 to 56.

A basis for feature (k) may be found in claim 1 as granted as well as column 10, lines 28 to 32.

A basis for features (l) to (n) may be found in claim 1 as granted.

A basis for feature (o) may be found in claim 4 as granted together with column 13, lines 19 to 24.

A basis for feature (p) may be found in claim 3 as granted.

A basis for feature (q) may be found in claims 3 and 4 as granted together with column 12, lines 24 to 30 and column 13, lines 19 to 24.

(ii) As no features have been deleted from the independent claim there has been no extension of the scope of protection contrary to Article 123(3) EPC.

(iii) The appellant would agree with a remittal of the case to the department of first instance.



VIII. The respondent in its response to the appeal dated 26 September 2007 argued in respect of the set of claims filed with the appeal grounds of the appellant that, amongst other things, the deletion of a feature from claim 1, i.e. "formed by the light transmitted through the lens and the index plate", did not comply with Article 100(c) EPC, as well as offending Article 123(3) EPC though this article was not expressly mentioned.

In a further submission of the respondent dated 5 September 2008 the respondent, considering the set of claims filed by the appellant with letter dated 28 March 2008, expressed the view that the replacement of the expression "frame shape" by "the intended lens shape figure" did not comply with Article 100(c) EPC.

The respondent did not present arguments concerning the set of claims filed by the appellant with its submission of 9 February 2009 from which the set of claims filed during the oral proceedings differed only in the replacement in claim 1 of "layout of the lens with respect to the eyeglasses frame" by "the intended lens shape figure" and "relative optical center position of the lens obtained by said optical-sensing means with respect to said reference axis" by " position displacement of the optical center position of the lens with respect to said reference axis (L)".

## **Reasons for the Decision**

### *Absence of the respondent at the oral proceedings*

1. The respondent requested oral proceedings with its submission dated 5 September 2008.
  - 1.1 A summons to oral proceedings was issued by the Board on 7 November 2008, i.e. not long after the request for oral proceedings by the respondent.
  - 1.2 The respondent did not appear at the oral proceedings at the appointed time. After waiting some time to allow for a small delay in the arrival of the representative of the respondent the registrar of the Board telephoned this representative. The representative indicated in the telephone conversation that it had been decided the day before the oral proceedings that the respondent should not be represented at the oral proceedings.
  - 1.3 The Board notes that in accordance with Article 6 of the code of conduct of members of the European Patent Institute, of which the representative is obligatorily a member, the members are required to act courteously in their dealings with the European Patent Office.
  - 1.4 The representative of the respondent had sufficient time to inform the Board of its intended non-appearance at the oral proceedings, i.e. by informing the Board by telephone immediately after the decision not to attend was taken. This would have avoided that the other party and the Board first of all courteously waited for the representative of the respondent in case he had unintentionally been delayed, and then that the

registrar of the Board had to carry out enquiries to establish if it was intended that the representative would attend the oral proceedings.

1.5 The facts of the case dealt with in decision T 954/93 (not published in OJ EPO) were similar to those of the present case in that a party did not appear at the oral proceedings without informing the Board beforehand, causing telephone calls and a delay in the start of the oral proceedings. In that case the deciding board considered that the actions of the representative were "reprehensible" (see point 2 of the decision grounds). The present Board agrees with that decision and considers that the views of that Board also apply in the present case.

1.6 The oral proceedings were continued in the absence of the respondent.

## 2. *Articles 123(2) and (3) EPC*

2.1 The appellant argued that the amendments to the claims comply with Article 123(2) EPC giving a basis for each of the amendments (see point VII of the summary of facts and submissions). The arguments of the appellant refer to the claims and description of the patent as granted, though it should be noted in each case there is a corresponding basis in the application as originally filed. The Board can agree with the arguments of the appellant in this respect.

2.2 All of the amendments are of a limiting nature apart from the amendments in features (b) and (f) which divide

a feature of the granted claim into two parts, however, without extending the scope of protection.

The respondent argued in its response to the appeal that an amendment deleting a feature which was made to the claims filed with the appeal grounds extended the scope of protection. Since this feature has been reintroduced into the claims according to the presently valid request this objection no longer applies.

2.3 The Board is therefore satisfied that the amendments comply with Articles 123(2) and 123(3) EPC.

### 3. *Novelty*

3.1 The opposition division rejected the then main request of the opponent (maintenance unamended) for lack of novelty of claim 1 over E6/E6a.

As is evident from the discussion above of the amendments to claim 1 the claim has been so extensively amended that the arguments of the opposition division no longer apply in their form as set out in the decision.

3.2 E6/E6a is concerned with a lens machining apparatus. The document gives no indication of displaying data obtained in the use of the apparatus, so that at least the features of claim 1 that concern the display of the data, e.g. features (o) and (q), are not disclosed therein.

3.3 After the patent had been amended during the course of the appeal proceedings the respondent did not further argue lack of novelty, only arguing lack of inventive step in its submission dated 5 September 2008.

Also the Board does not consider that any of the other cited documents shows all the features of claim 1 as amended during the appeal proceedings.

3.4 Therefore, the subject-matter of claim 1 is novel in the sense of Article 54 EPC.

4. *Remittal to the department of first instance*

4.1 The opposition division has not yet examined claim 1 (as amended during appeal proceedings) with regard to the other relevant requirements of the Convention. In particular, the Board did not examine the amendments for clarity since it considered that this examination could best be carried out together the examination for inventive step wherein the meaning of the terms of the claims will in any case have to be considered.

4.2 In accordance with Article 111(1) EPC, the Board therefore considers it appropriate to remit the case to the department of first instance so as to give the parties the possibility to argue their case in this respect before two instances.

**Order**

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

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

G. Nachtigall

H.-P. Felgenhauer