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**Datasheet for the decision
of 7 December 2010**

Case Number: T 1840/07 - 3.4.02

Application Number: 00974926.8

Publication Number: 1233285

IPC: G02B 3/00

Language of the proceedings: EN

Title of invention:
Manufacturing method of optical lens

Patentee:
HAMAMATSU PHOTONICS K.K.

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 123(2)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Added subject-matter - main request (yes)"
"Added subject-matter - auxiliary request (no)"

Decisions cited:
T 0201/83, T 0404/03

Catchword:
-



Case Number: T 1840/07 - 3.4.02

D E C I S I O N
of the Technical Board of Appeal 3.4.02
of 7 December 2010

Appellant: HAMAMATSU PHOTONICS K.K.
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Representative: Musker, David Charles
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 14 June 2007
refusing European patent application
No. 00974926.8 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. G. Klein
Members: M. Rayner
B. Müller

Summary of Facts and Submissions

I. The applicant appealed against the decision of the examining division refusing European patent application number 00 974 926.8 concerning manufacturing an optical lens.

II. Examination Procedure

In a communication dated 03.11.2006 attached to a summons to oral proceedings consequent to an auxiliary request, the examining division informed the applicant in consideration of claims 1 and 2 received on 06.03.2006 and an amended description, inter alia, that the term "having a shape" {of an array of half cylinders arranged side by side} was considered an amendment not complying with Article 123(2) EPC. The complex shape of Figure 3C is clearly defined in new claim 1. However the description not only defines a shape as such but also teaches a single manufacturing process, by arraying side by side a plurality of simple preforms (description on page 12, lines 6-10). No other manufacturing methods are disclosed in the application. Moreover, wherever complex shapes such as that of figure 3C are referred to in the application, they are always made by arraying optical cores of simple shapes (see e.g. page 12, lines 21-23 or page 19, lines 9-13).

The division suggested that the expression could be replaced by "having the shape of a plurality of half cylinders arrayed" or "by arraying a plurality of half cylinders". A claim amended as suggested would be considered to meet the requirements of Article 52(1) EPC, as using half cylinders and obtaining the shape of

claim 1 is not suggested in the prior art. The applicant thus had a clear idea of what the division would regard as patentable.

By letter dated 14.02.2007, the applicant filed fresh claims following discussion with the examiner concerning what would be acceptable. The examining division subsequently informed the applicant that the date fixed for oral proceedings was maintained. By letter dated 13.03.2007, the applicant then withdrew its request for oral proceedings and requested a decision according to the state of the file as of 3 November 2006, i.e. before filing the fresh claims discussed. The division cancelled the oral proceedings.

III. Decision under appeal

In the decision under appeal, the grounds for the decision were given as:

In the communication dated 03.11.2006 the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was also informed of the reasons therein. The applicant filed no comments or amendments in reply to the most recent communication of the division but requested a decision according to the state of the file by a letter received in due time on 13.03.2007. The application must therefore be refused.

IV. Case of the Appellant

The appellant requests that the decision under appeal be set aside and a patent granted on the basis of a

main request, i.e. claims 1 and 2 filed with its letter dated 24 October 2007, or, in the alternative, of its auxiliary request, i.e. claims 1 and 2 filed on 07 December 2010. The claims of the auxiliary request correspond to the subsequently withdrawn claims of 14.02.2007.

The appellant argued as follows in support of its case.

The claimed expression "having the shape of a plurality of half-cylinders arrayed side by side in contact with one another" does not contravene Article 123(2) EPC as an amendment is allowable if it is clearly and unambiguously derivable from the application as filed. In the present case, Figure 3A illustrates a first optical lens preform 240 which clearly and unambiguously has the shape of a plurality of half-cylinders arrayed side by side in contact with one another. The description on page 12 adds to this that the first optical lens preform may be fabricated by a plurality of first optical member preforms with a semicircular cylindrical shape shown in Fig. 1A, which are arrayed side by side in tight contact with each other, see page 12 lines 6-10. Clearly, the fabrication process as described at lines 6-10 on page 12 is optional. Figure 3A itself does not illustrate any particular fabrication process. Thus, lines 6-10 on page 12 merely describe that the first optical lens preform 40 may be fabricated by the disclosed method (as opposed to describing a fabrication method as also illustrated in the Figure). In other words, Figure 3A and lines 6-10 on description page 12 form separate disclosures of different features. Figure 3A discloses the shape of the first optical lens preform 40, whereas

lines 6-10 on description page 12 disclose how such shape can be fabricated. The skilled person would read these disclosures separately. Thus, when considering the shape illustrated in Figure 3A, the skilled person would not understand this to require fabrication by any particular method, or specifically the method described in lines 6-10 on page 12. Put in yet another way, no new subject-matter was added to claim 1 by incorporating a feature from Figure 3A without, at the same time, incorporating additional features which are mentioned in connection with but not shown in Figure 3A.

Moreover, according to T201/83 (also referred to in the Guidelines, C-V1, 5.3.1), if the amendment is by way of addition, the test for its allowability corresponds to the test for novelty. In the present case, the amendment was made by way of addition of the above feature to claim 1 during examination. Accordingly, the novelty test applies. In other words, the amendment is allowable if the amended subject-matter lacks novelty over the application as originally filed. The original application - including Figure 3A - is clearly novelty destroying to amended claim 1. Therefore, amended claim 1 meets the requirements of Article 123(3) in accordance with T201/83.

The Examining Division's objection under Article 123(2) is the result of incorrectly tying together disclosures in Figure 3A and at lines 6-10 on description page 12.

V. Appeal Procedure

The board appointed oral proceedings and, in a communication attached to the summons, gave preliminary and unbinding comments including the following.

- (a) The difficulty in the present case arises because there is no disclosure of the method in any context other than that of actual half cylinders arranged side by side in contact with each other. In other words, drawing a glass preform of any other cross section, for example a monolith, having the "shape" but not actually being half cylinders arranged side by side in contact with each other is not disclosed in the application as filed.
- (b) The appellant has, in its appeal, failed to show any method which does not involve half cylinders. There therefore seems to be no reason to set aside the decision of the examining division.
- (c) Of course Figure 3A has the shape of a plurality of half cylinders arrayed side by side in contact with one another. This is because this is what is said to be drawn, but the shape is not "detached" from those half cylinders as arrayed.
- (d) On the question of using the word "may", the board reads this more as "polite language", of the sort "the best pupil may now step forward to receive his prize". The board does not understand use of "may" on page 12 to mean the half cylinders are only a possibility, just as it would not expect

the pupil to walk away. The board does not therefore believe the submission to be correct that the skilled person would read the parts of the disclosure concerned separately, i.e. it is not convinced by the "optional" argument.

- (e) On the novelty test, it is true that specific half cylinders arrayed side by side remove novelty from the general "shape" subject matter claimed, but that does not stop other things included in "general", say a monolith, being added subject matter.

VI. Oral Proceedings

During the oral proceedings before the board, the appellant argued as follows.

Main Request

The important disclosure relating to the shape is based on the Figures which contain no indication of arranging. It is significant that Figure 3A does not show detachment lines, unlike say figure 10 showing such lines. This cannot be accidental.

Concerning the word "may", two meanings are up for consideration, namely a "possibility" or a "permission". A skilled person would understand the former, but even if a permission were involved, other fabrication possibilities would not be excluded. A monolith, for example, is not excluded.

If a deletion is considered concerned in the present case, reference can be made to the three point test and decision T0404/03. The test is met as the half cylinders are not essential but optional, they are not indispensable to the collimating function nor is any modification required.

Auxiliary Request

The claim submitted during the oral proceedings as auxiliary request is the same as that submitted to the examining division on 14.02.2007 and previous to the request on 13.03.2007 for a decision according to the state of the file as of 3 November 2006.

In connection with the auxiliary request, the appellant agreed that any consequential amendments to the description should be made before the examining division.

VII. Board's Comments

The board observed that the word "may" was not unambiguous in the present context. What is important is what the skilled person understands in the context of the disclosure. Later described embodiments refer to earlier embodiments.

VIII. Independent method claim 1 according to the main and auxiliary requests of the appellant is respectively worded as follows.

Main Request

"1. A method of manufacturing an optical lens, the method comprising:

forming a first optical lens preform (240) of a first transparent material having the shape of an array of half-cylinders arranged side by side in contact with each other;

drawing the first optical lens preform (240); and
slicing the first optical lens preform (240) to form a first optical lens (2) for receiving light (6) emitted from a semiconductor laser array."

Auxiliary Request

"1. A method of manufacturing an optical lens, the method comprising:

forming a first optical lens preform (240) of a first transparent material by forming an array of half-cylinders arranged side by side in contact with each other;

drawing the first optical lens preform (240); and
slicing the first optical lens preform (240) to form a first optical lens (2) for receiving light (6) emitted from a semiconductor laser array."

IX. The board gave its decision at the end of the oral proceedings.

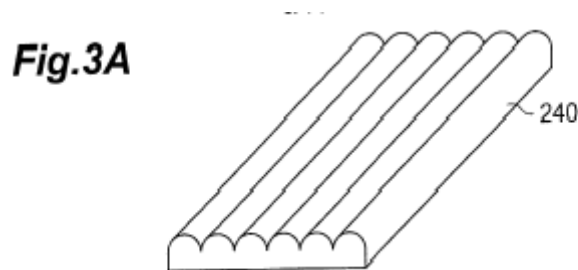
Reasons for the Decision

1. The appeal is admissible.

Main Request

2. Added subject matter
 - 2.1 The present case turns on what the skilled person understands from Figure 3A and page 12, lines 6 to 10 of the application as filed, both reproduced for convenience below.

Figure 3A



Page 12, lines 6 to 10

"As shown in Fig. 3A, the first optical member preform 40 may be fabricated by a plurality of first optical member preforms 40 with a semicircular cylindrical shape shown in Fig. 1A, which are arrayed side by side in tight contact with each other."

- 2.2 As the examining division pointed out, the description as filed defines not only a shape as such, but also teaches a single manufacturing process, by arraying

side by side a plurality of simple preforms. No other manufacturing methods are disclosed in the application.

2.3 Moreover, as the board pointed out, the appellant, in its appeal, failed to show any method which does not involve half cylinders. The board therefore sees no reason not to uphold the decision of the examining division in respect of the main request.

2.4 The appellant argued that Figure 3A should be considered to be detached from the description thereof, in other words, the disclosure in the figure as not being bound by the description in relation to the half cylinders. This leads to a teaching simply of the shape, which, for example, may represent a monolith preform or for that matter any other configuration with this shape. The board is not persuaded by this argument because, in the present case, even if the skilled person knew that Figure 3A was involved in manufacturing an optical lens, such person would not be able to tell from the figure alone exactly what was disclosed. Consequently, reference to the description would be necessary, and at this point the argument fails. The reference made by the appellant to subsequent figures, for example Figure 10, does not help the appellant's case, because, as discussed in the examination and appeal proceedings, the description of such figures refers back to Figures 1 to 3, i.e. it is effectively the same. It is thus not relevant whether outlines or detachment/separation lines are or are not shown. The board thus reached the view that the examining division properly associated Figure 3A with its description.

2.5 Even if the description is associated with the Figure 3A, the appellant submitted the word "may" used that description to teach the skilled person that other manufacturing methods were able to be used, so that even in this case the shape is not limited to arraying the plurality of cylinders. The appellant was, however, aware that the word "may" is not unambiguous in this context, explaining to the board that it could mean a possibility or a permission. The board itself reads the sentence concerned simply as teaching how the fabrication takes place. There is no teaching in the application other than arraying the semicircular preforms. What is important is what the skilled person directly and unambiguously understands from the disclosure. This person understands English well, but is not a linguist trying to read embodiments into the disclosure based on stretching any possible linguistic ambiguity to cover undisclosed subject matter. The board is of the view that the skilled person would not receive, even implicitly, any teaching of other fabrications. In all fairness, the board considers alternatives, such as using a monolith, simply not to have been disclosed. The submission of the appellant did not therefore persuade the board.

2.6 So far as the test for novelty argument submitted by the appellant is concerned, the board points out that the amendment is towards the more general. A specific disclosure {arraying the half cylinders} removes novelty from the general disclosure {shape of a plurality of half cylinders}, but other things, such as a monolith, are added in moving towards the more general. This is not permissible for lack of disclosure. So far as arguing the converse is concerned, i.e.

deleting arraying the half cylinders, the board following the same line, cannot see that using wording covering, for example, the monolith, can be justified by reference to the three point test for deletion, as the monolith was never present in the documents as filed.

Accordingly, the submissions based on the novelty argument and three point test failed to convince the board.

The board therefore reached the conclusion that subject matter had been added to claim 1 by virtue of the feature "having a shape" {of an array of half cylinders arranged side by side}. The board thus concurs with the decision of the examining division in this respect.

3. Auxiliary Request

3.1 Examination Procedure

3.1.1 In the present case, while it is clear from the file that the examining division was satisfied, in principle, as to substantive patentability of the subject matter of claim 1 of the auxiliary request, the information in the file is not sufficient for the board to be able precisely to determine the position of the examining division on admissibility of the claims in relation to added subject matter. The fact that oral proceedings were maintained after their presentation could be seen as meaning that the division was not satisfied as to added subject matter, or, it may simply have been that the division wished to discuss the case and finish other matters such as adaptation of the description at

oral proceedings. It would have been helpful, had more information been available in the file about the division's view.

- 3.1.2 The board reached the view that it would be most efficient in this situation itself to exercise the powers of the examining division in respect of admissibility of the claims of the auxiliary request.
- 3.1.3 The board is satisfied that the expression "forming an array of half-cylinders arranged side by side in contact with each other", like that suggested by the examining division, calls for an array of arranged half cylinders and not, for example, a monolith. Since this corresponds to disclosure present in the description, the board does not consider any impermissible amendment to have been made.
- 3.1.4 So far as patentability is concerned, the board saw no reason to diverge from the view of the examining division. Therefore, having reached a positive view on admissibility of the claims according to the auxiliary request, the board considered it appropriate to remit the case for grant of a patent after further prosecution in relation to adaptation of the description, with which course of action the appellant was in agreement.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the first instance with the order to grant a patent with the following claims and a description to be adapted:
 - claims 1 and 2 of the auxiliary request filed during the oral proceedings.

The Registrar

The Chairman

M. Kiehl

A. G. Klein