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**Datasheet for the decision
of 16 November 2009**

Case Number: T 0364/08 - 3.2.07
Application Number: 99118996.0
Publication Number: 0990484
IPC: B24B 9/14
Language of the proceedings: EN

Title of invention:
Eyeglass lens processing system

Patentee:
Nidek Co., Ltd.

Opponent:
Buchmann Deutschland GmbH

Headword:

-

Relevant legal provisions:
EPC Art. 123(2), 56
EPC R. 124(1)

Relevant legal provisions (EPC 1973):

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Keyword:

"Extension beyond the content of the application as filed
(main request and main request 1): yes"
"Inventive step (main request 2): yes"
"Minutes need not contain statements without relevance for the
proceedings in question"

Decisions cited:

T 1149/97

Catchword:

-



Case Number: T 0364/08 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 16 November 2009

Appellant:
(Patent Proprietor)

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Representative:

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Respondent:
(Opponent)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted 14 December 2007
revoking European patent No. 0990484 pursuant
to Article 102(1) EPC.**

Composition of the Board:

Chairman: H. Meinders
Members: K. Poalas
E. Dufrasne

Summary of Facts and Submissions

- I. The appellant (patent proprietor) lodged an appeal against the decision of the Opposition Division revoking the European patent No. 0 990 484.
- II. Opposition had been filed against the patent as a whole based on Article 100(a) EPC (lack of novelty; Article 54 EPC and lack of inventive step; Article 56 EPC), on Article 100(b) EPC (insufficient disclosure; Article 83 EPC) and on Article 100(c) EPC (unallowable amendments; Article 123(2) EPC).
- III. The Opposition Division found that the subject-matter of claim 1 according to one of the main and first to third auxiliary requests did not involve an inventive step.
- IV. The following documents are mentioned in the present decision:
- D3: JP 07 186 027 A + PAJ Abstract in English + D3a = English translation of D3,
- E7: DE 195 27 222 C2.
- V. Oral proceedings before the Board took place on 16 November 2009.
- (a) The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request, filed with letter dated 13 October 2009 or, in the alternative, of one of the main request 1 and the

main request 2, both filed during the oral proceedings.

(b) The respondent (opponent) requested that the appeal be dismissed. It also requested to include the text as submitted by it during the oral proceedings in the minutes.

VI. Independent claim 1 according to the main request reads as follows (amendments over claim 1 as granted are in bold):

"An eyeglass lens processing system comprising:

- data input means (10, 11) for inputting frame shape data of an eyeglass frame to which a lens (LE) is to be fitted, and layout data for providing a layout of the lens with respect to the frame shape;
- arithmetic means (30, 160) for obtaining processing data for the lens based on the inputted data;
- a lens processing apparatus (100) for processing a periphery of the lens, the lens processing apparatus including:
 - two lens rotating shafts (111, 121) for clamping and holding the lens;
 - a rotatable grinding wheel (151); and
 - processing control means (160) for controlling a rotational angle of the lens rotating shafts and an axis-to-axis distance between a lens rotation axis and a grinding wheel rotation axis based on the processing data;
- a lens conveying apparatus (200) having a hand part (230, 232, 233, 240, 242, 243) for holding the lens and a moving unit (201-204, 210-215, 220-222, 231, 241) for moving the hand part so as to convey the lens, which

has been placed at a storing position, to an intended position; and

- a lens measuring apparatus (300) for obtaining at least an optical center position of the lens by detecting and processing an image of a measurement index of the lens measuring apparatus and obtaining a quantity of eccentricity of the optical center position with respect to a predetermined reference position,
- wherein the lens convey apparatus (200) picks and holds the lens from the storing position using the hand part, disposes the lens at a predetermined position of the lens measuring apparatus (300), and mounts the lens to one of the lens rotating shafts after measurement by the lens measuring apparatus (300),

- characterized in that the said system comprises:

- **holding means including** a sucking member (130), **wherein the sucking member (130) being** attached to one of the lens rotating shafts to which the lens is mounted and having an air passage (131) connected to a pump unit (135), for sucking and holding the lens **onto one of the lens rotating shafts;**

- a host computer (30) for controlling the lens conveying apparatus (200)

- to pick and hold the lens (LE) from the storing position,
- to move and dispose the lens (LE) at the predetermined position of the lens measuring apparatus (300), and
- to move and mount the lens (LE) to one of the lens rotating shaft through the sucking member (130) based on measurement data obtained by the lens measuring apparatus (300)

so that the lens rotation axis is coincident with the reference position or the optical center position;

- selecting means (30) adapted for selecting a position with which the lens rotation axis is made coincident by the holding means; and

- judging means (30) adapted for judging whether or not the quantity of eccentricity falls within a predetermined range, wherein the holding means are adapted for holding the lens so that the lens rotation axis is coincident with the reference position if the judging means judges the quantity of eccentricity is within the predetermined range, and are adapted for holding the lens so that the lens rotation axis is coincident with the optical center position if the judging means judges the quantity of eccentricity is outside the predetermined range, and wherein the arithmetic means (30, 160) obtains the processing data based on

- the frame shape data,
- the layout data and the
- quantity of eccentricity

if the lens (LE) is held so that the lens rotation axis is coincident with the reference position, and obtains the processing data based on

- the frame shape data and
- the layout data

if the lens (LE) is held so that the lens rotation axis is coincident with the optical center position".

Claim 1 according to the main request 1 differs from claim 1 according the main request in that the paragraphs of the characterizing part referring to the sucking member and the selecting means read as follows (amendments over claim 1 according the main request are struck through or in bold):

~~"holding means including a sucking member (130),
wherein the sucking member (130) being attached to one
of the lens rotating shafts to which the lens is
mounted and having an air passage (131) connected to a
pump unit (135), for sucking and holding the lens onto
one of the lens rotating shafts;"~~,
"- selecting means (30) adapted for selecting a
position with which the lens rotation axis is made
coincident by ~~the~~ holding means **of the lens conveying
apparatus (200)**;"

Claim 1 according to the main request 2 differs from
claim 1 according the main request in that the
paragraphs of the characterizing part referring to the
sucking member, the selecting means and the judging
means read as follows (amendments over claim 1
according the main request are struck through or in
bold):

~~"holding means including a sucking member (130),
wherein the sucking member (130) being attached to one
of the lens rotating shafts to which the lens is
mounted and having an air passage (131) connected to a
pump unit (135), for sucking and holding the lens onto
one of the lens rotating shafts;"~~,
"- selecting means (30) adapted for selecting a
position with which the lens rotation axis is made
coincident by the ~~holding means~~ **hand part of the lens
conveying apparatus (200)**; and
- judging means (30) adapted for judging whether or not
the quantity of eccentricity falls within a
predetermined range, wherein the ~~holding means are~~ **hand
part is** adapted for holding the lens so that the lens
rotation axis is coincident with the reference position

if the judging means judges the quantity of eccentricity is within the predetermined range, and ~~are~~ **is** adapted for holding the lens so that the lens rotation axis is coincident with the optical center position if the judging means judges the quantity of eccentricity is outside the predetermined range".

VII. The text submitted by the respondent during the oral proceedings for inclusion in the minutes reads as follows:

"Opponent has no objections under Art 123(2) or Art. 123(3) EPC against the term "holding means" in the claim 1 according to the main request of October 13, 2009".

VIII. The appellant argued essentially as follows:

*Claim 1 according to the main request: amendments
(Article 123(2) EPC)*

Claim 1 according to the main request being a combination of the granted claims 1 and 8 and of the originally filed claims 2, 3 and 4 meets the requirements of Article 123(2) EPC. The fact that the originally filed claims 2, 3 and 4 were not present in the patent as granted does not deprive the appellant of the right to introduce the features of these claims into claim 1 according to the main request. The expression "wherein the sucking member (130) being attached to one of the lens rotating shafts" clarifies that the sucking member and not the holding means is attached to one of the lens rotating shafts. This

amendment is in compliance with the requirements of Article 123(2) EPC.

Claim 1 according to the main request 1: amendments (Article 123(2) EPC)

The expression "holding means of the lens conveying apparatus (200)" used in the characterizing part of claim 1 is identical with "the hand part for holding the lens" as defined in the paragraphs of the preamble of claim 1 concerning the lens conveying apparatus 200.

Claim 1 according to the main request 2: amendments (Article 123(2) EPC)

It is clearly derivable from the passages on page 9, line 10 to page 10, line 15 and on page 19, line 16 to page 21, line 8 of the originally filed application that it is the hand part (first hand 230) which is used by the selecting means and the judging means claimed in claim 1.

Claim 1 according to the main request 2: inventive step (Article 56 EPC)

Given the fact that neither D3 nor E7 discloses in combination the selecting and judging means as claimed in claim 1 none of these documents can provide a hint for the person skilled in the art towards such a combination of features. Therefore, the subject-matter of claim 1 involves an inventive step.

Text for the minutes submitted by the respondent

Since, according to the respondent's statement, the text submitted is of no relevance for the present proceedings this text should not be included into the minutes.

IX. The respondent argued essentially as follows:

*Claim 1 according to the main request: amendments
(Article 123(2) EPC)*

According to the passages on page 22, line 19 to page 23, line 12 of the originally filed application the eyeglass lens processing system comprises selecting and judging means capable of evaluating the eccentricity between the rotational center/reference position on the one hand and both the optical center of the lens and the geometrical center of the eyeglasses frame on the other hand. Selecting and judging means capable of evaluating the eccentricity only between the rotational center/reference position and the optical center of the lens as now claimed in claim 1 have no basis in the patent as granted, since the originally filed claims 2, 3 and 4 were no longer present in the patent as granted. Claim 1 of the main request violates therefore the requirements of Article 123(2) EPC.

*Claim 1 according to the main request 1: amendments
(Article 123(2) EPC)*

According to the originally filed claims 1, 3 and 4 the holding means were connected to at least one of the lens rotating shafts and it was not part of the lens

conveying apparatus as now claimed in claim 1 of the main request 1.

*Claim 1 according to the main request 2: amendments
(Article 123(2) EPC)*

The absence of the term "holding means" in the eyeglass lens processing system as now claimed in claim 1 of the main request 2 violates the requirements of Article 123(2) EPC.

*Claim 1 according to the main request 2: inventive step
(Article 56 EPC)*

In the paragraph bridging columns 2 and 3 of E7 it is stated that in case the measured eccentricity of the optical axis with respect to the rotating shaft of the grinding machine is within permissible limits the lens grinding is performed. This information is also a hint to the person skilled in the art that in case the eccentricity is not within permissible limits the lens has to be repositioned on the rotating shaft so that the optical axis coincides with the rotation axis. This is a clear indication for the provision of selecting and judging means capable of performing the selection and judgement as claimed. A combination of the teachings of D3 and E7 together with the above mentioned consideration of providing the necessary selecting and judging means would thus render the subject-matter of claim 1 obvious to the person skilled in the art.

Text submitted by the respondent during the oral proceedings

A text submitted by a party reflecting a statement made by it during the oral proceedings should by definition be included into the minutes. For the present proceedings, however, the text has no relevance.

Reasons for the Decision

1. *Claim 1 according to the main request: amendments (Article 123(2) EPC)*
- 1.1 The term "holding means" introduced into the first paragraph of the characterizing part of claim 1 defines them as "including a sucking member (130), wherein the sucking member (130) being attached to one of the lens rotating shafts to which the lens is mounted and having an air passage (131) connected to a pump unit (135), for sucking and holding the lens onto one of the lens rotating shafts". This definition affiliates the "holding means" to the lens **processing** apparatus.
- 1.2 In the consecutive paragraphs of the characterizing part of claim 1 referring to the selecting means and to the judging means, "the holding means", which due to the term "the" have their antecedent in the "holding means" as mentioned above, are defined as "being adapted for holding the lens so that the lens rotation axis is coincident with the reference position" and as also "being adapted for holding the lens so that the lens rotation axis is coincident with the optical

centre position". This definition affiliates the "holding means" to the lens **conveying** apparatus.

- 1.3 Such "holding means" being at the same time affiliated to the lens processing apparatus and to the lens conveying apparatus and having the functions as claimed in claim 1 are not as such derivable from the originally filed application.

Claim 1 according to the main request thus contravenes the requirements of Article 123(2) EPC.

- 1.4 According to Article 123(2) EPC the European Patent "may not be amended in such a way that it contains subject-matter which extends beyond **the content of the application as filed**" (emphasis added by the Board).

Thus there is no basis for the respondent's argument that subject-matter based on the originally filed claims 2, 3 and 4, said claims no longer being part of the patent as granted and thus their subject-matter, cannot be reintroduced into the patent. In this respect the Board concurs with the findings of T 1149/97 (see OJ EPO 2000, 259, Reasons, points 6.1.9 and 6.1.10) that a "cut-off" effect due to the grant of a patent can be seen in the formal restrictions imposed on further amendments to the patent specification by Rules 80 and 138 EPC and, substantively only in the restriction imposed by Article 123(3) EPC.

In the present case, subject-matter of the originally filed claims 2, 3 and 4, can therefore be re-introduced into claim 1, as long as it does not infringe Article 123(2) and (3) EPC.

The result of the examination on Article 123(2) EPC is, however, negative as mentioned above.

2. *Claim 1 according to the main request 1: amendments (Article 123(2) EPC)*

2.1 According to the (unmodified) preamble of claim 1 the lens conveying apparatus has a **hand part**, whereby the lens conveying apparatus picks and holds the lens from the storing position using the hand part, disposes the lens at a predetermined position of the lens measuring apparatus, and mounts the lens to one of the lens rotating shafts after measurement by the lens measuring apparatus. According to the amended characterizing part of claim 1 in respect of the judging means there are **holding means** of the lens conveying apparatus which are "adapted for holding the lens so that the lens rotation axis is coincident with the reference position if the judging means judges the quantity of eccentricity is within the predetermined range", and are also "adapted for holding the lens so that the lens rotation axis is coincident with the optical center position if the judging means judges the quantity of eccentricity is outside the predetermined range".

There is, however, no support in the originally filed application for a lens conveying apparatus having anything other than a **hand part** performing the functions mentioned above. Thus there is no original basis for the generalisation of this feature to "holding means".

Accordingly, also claim 1 of the main request 1 contravenes the requirements of Article 123(2) EPC.

3. *Claim 1 according to the main request 2: amendments
(Article 123(2) EPC)*

3.1 According to the preamble of claim 1 (which is identical with the preamble of claim 1 as granted) the lens conveying apparatus has a hand part for holding the lens. According to the originally filed description page 9, line 10 to page 10, line 24 and page 19, line 6 to page 21, line 8 it is the first hand 230, which, being the hand part of the lens conveying apparatus, functions as claimed in claim 1 of the main request 2. The respondent did not raise any objection to this amendment, nor does the Board see any reason for such an objection.

The Board finds therefore that the corresponding replacement of the general term "holding means" as used in the originally filed claims 3 and 4 in the parts relating to the "selecting means" and the "judging means", now taken up into claim 1, by the more specific term "hand part" is in agreement with the requirements of Article 123(2) EPC.

3.2 The respondent referred, however, in this respect to the fact that on page 9, line 10 to page 10, line 20 of the originally filed description also a second hand 240 is referred to which does not function as the claimed hand part.

The Board considers that as the claim refers to the "hand part" as holding the lens when conveying it from a storing position to an intended position it can only be the first hand 230 that is meant, and that no

confusion or inconsistency can arise with the second hand, which performs an entirely different function, namely taking the lens off the lens rotating shaft of the processing apparatus after processing and returning it to the tray.

- 3.3 By deleting the term "holding means" from the first characterizing feature of claim 1 the wording as granted is restored for the "sucking member", to which latter feature no objections have been raised in opposition or in appeal.

Accordingly, claim 1 of the main request 2 meets the requirements of Article 123(2) EPC.

4. *Claim 1 according to the main request 2: inventive step (Article 56 EPC)*

- 4.1 The eyeglass lens processing system according to claim 1 differs from the one known from D3, said document representing the most relevant prior art, in that it comprises the selecting and judging means as claimed. This was not disputed by the respondent. Such selecting and judging means are also not known from E7. This was also not disputed by the respondent.

- 4.2 The selecting and judging means of the system according to claim 1 enable a suitable pre-selection of the lens' position with which the rotation axis of the lens processing apparatus is made coincident, depending on the quantity of eccentricity between the optical centre of the lens and a predetermined reference position, in order to achieve a more efficient processing of eyeglass lenses.

Since neither D3 nor E7 discloses or even suggests such selecting and judging means the Board finds that the subject-matter of claim 1 is not obvious to the person skilled in the art taking account of this prior art, due to the absence of any instruction or incentive to this effect.

- 4.3 The respondent argued that although no selecting and judging means as the ones claimed in claim 1 are mentioned in E7 the fact that in the paragraph bridging columns 2 and 3 of E7 it is stated that in case the measured eccentricity of the optical center position (optical axis) of the lens with respect to the lens rotation axis is within permissible limits lens contour grinding is performed, gives a hint to the person skilled in the art that in case that the eccentricity is **not** within such permissible limits the lens has to be repositioned so that the rotation axis coincides with the optical axis. This would be an obvious indication for the provision of selecting and judging means as claimed. Accordingly, the application of the teachings of E7 in the system of D3, together with the above mentioned consideration, would render the subject-matter of claim 1 obvious to the person skilled in the art.

- 4.4 The Board cannot follow the respondent's argument for the following reasons:

The apparatus of E7 has a sucking member 21 keeping the lens in contact with a hollow shaft 19, the axis of said shaft defining the lens rotation axis, see column 5, lines 31 to 35 and figure 2. The eccentricity of the

optical center position of the lens with respect to the **lens rotation axis** is detected, see column 4, lines 19-21. In case of an eccentricity within permissible limits the grinding process is performed taking account of this eccentricity. However, no information or advice for the skilled person exists in E7 for the case that the eccentricity is not within permissible limits. It may be that the lens is repositioned such that the optical axis is made coincident with the rotation axis (as argued by the respondent), but it may just as well be a repositioning only to such an extent that the eccentricity reaches a value which is within the acceptable limits. But even if, for the sake of argument the argumentation of the respondent is followed, it cannot hold, because the result would still be that the eccentricity with respect to the lens rotation axis is taken as reference value.

Different from this, the judging means of the system according to claim 1 judge whether a quantity of eccentricity of the optical center position with respect to a **predetermined reference position** falls within a predetermined range. Depending on the judging result, a position with which the **lens rotation axis** is to **coincide**, i.e. the **optical center position** or the **predetermined reference position**, can be selected and the lens is accordingly positioned. The important difference with what the respondent suggests is that the predetermined reference position is not the lens rotation axis.

It is therefore apparent that the selecting and judging means with their ability to function as claimed, will not be what the person skilled in the art will arrive

at on the basis of a reduction to practice of the teaching of E7 in the system of D3 as argued by the respondent.

Therefore, the subject-matter of claim 1 involves an inventive step (Article 56 EPC).

5. *Text for the minutes as submitted by the respondent during the oral proceedings*

The respondent's argument that a text reflecting a statement made by a party during oral proceedings is by definition to be included into the minutes, cannot be followed by the Board.

Rule 124(1) EPC states that the minutes should contain "the essentials of the oral proceedings ... and the **relevant** statements by the parties...".

Since according to the respondent its statement is not relevant for the present proceedings, which view is shared by the Board, the Board sees no need to include the text of this statement into the minutes.

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 with the order to maintain the patent on the basis of the main request 2 (claims 1 to 7) filed during the oral proceedings and of the description and of the figures of the patent as granted.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders