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Datasheet for the decision of 29 March 2012

Case Number: T 2065/09 - 3.4.02

Application Number: 04000025.9

Publication Number: 1437617

IPC: G02C7/02

Language of the proceedings: EN

Title of invention:
Progressive-power lens comprising markings

Applicant:
HOYA CORPORATION

Relevant legal provisions:
EPC 1973 Art. 54(1), 56

Keyword:
Novelty and inventive step (no)

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T2065/09 - 3.4.02

D E C I S I O N
of the Technical Board of Appeal 3.4.02
of 29 March 2012

Appellant: (Applicant)
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Decision under appeal:
Decision of the Examining Division of the European Patent Office posted 4 June 2009 refusing European patent application No. 04000025.9 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: A. G. Klein
Members: F. J. Narganes-Quijano
B. Müller

Summary of Facts and Submissions

I. The appellant (applicant) lodged an appeal against the decision of the examining division refusing European patent application No. 04000025.9 (publication No. 1437617).

II. In is decision the examining division held, *inter alia*, that, in view of the prior art then on file, the subject-matter of the independent claims of the then valid requests was either not novel or not inventive, depending on whether or not the claimed features relating to the information content of the inscriptions formed on the lens were disregarded in the assessment of patentability.

III. With the statement setting out the grounds of appeal the appellant submitted sets of claims amended according to a main request and auxiliary requests I to IV.

IV. Oral proceedings were appointed and in a communication annexed to the summons to attend oral proceedings the Board referred to document

A1: "Frames and lenses" J. Carlton; Slack Incorporated (US), 2000; chapter "Lenses", page 33

cited from the Board's own knowledge and gave a preliminary assessment of the case.

V. In reply to the summons to attend oral proceedings the appellant, by letter dated 29 February 2012, maintained the main request, withdrew auxiliary requests I to III and submitted an amended version of the sets of claims

of auxiliary request IV (in the following "the auxiliary request").

VI. Oral proceedings before the Board were held on 29 March 2012.

The appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the main or the auxiliary request.

At the end of the oral proceedings the Board announced the decision reported in the order below.

VII. The wording of claim 1 of the main request reads as follows:

"A method of inscribing optical performance information on a progressive-power lens (9) for evaluation of the lens (9), the method comprising the steps of:
forming on the progressive-power lens (9) a first inscription (11d) including symbolized optical performance information specifying an optical performance value of the progressive-power lens (9); and
forming on the progressive-power lens (9) a second inscription (11e) including symbolized definition information specifying how the optical performance value inscribed on the first inscription (11d) is measured."

The main request also includes claim 6 reading as follows:

"A progressive-power lens (9) having inscribed thereon first and second inscriptions (11d, 11e) utilizing the method according to one of claims 1 to 5."

The wording of claim 1 of the auxiliary request differs from that of claim 1 of the main request in that the claim further reads as follows:

"wherein the performance information includes an addition diopter value of the progressive-power lens (9), and the second inscription (11e) indicates which of the convex or concave surface of the progressive-power lens (9) is used as a reference for obtaining the addition diopter value or whether the addition diopter is calculated based on a sight line position and a center of rotation of an eyeball when wearing the progressive-power lens (9)."

The auxiliary request also includes claim 4 reading as follows:

"A progressive-power lens (9) having inscribed thereon first and second inscriptions (11d, 11e) utilizing the method according to one of claims 1 to 3."

VIII. The arguments submitted by the appellant in support of its requests can be summarised as follows:

The main request is directed to a method of inscribing on a progressive-power lens symbolized definition information specifying measurement methods of optical performance values inscribed on the lens, and the auxiliary request defines in detail to which optical performance values this definition information relates. The symbolized definition information defined in the claims relates to an optometric measuring process of the optical performance information of the lens, the process being inherently technical. Providing this technical information obtained by a technical process

for the purpose of the further technical process of evaluating the lens at an optician's store to improve accuracy of lens evaluation constitutes a step of a technical nature.

Document A1 discloses a progressive lens with markings. Some of the markings may indicate how the lens was designed, but none of them specify any particular technical method of measurement of the values of the optical parameters of the lens, i.e. none of them constitute symbolized definition information specifying how the optical performance values of the lens are measured. The technical information encoded in the claimed lens consists of functional data allowing the optician to precisely obtain the optical performance values of the lens, i.e. constitutes a feature of a technical nature, and this technical information is different from the technical information encoded in the lens disclosed in document A1. The markings on the lens of document A1 may indicate the method of design of the lens and/or of the type of lens, but this information is not sufficient to derive the method of measurement of the optical parameters of the lens. Assuming that the inscriptions of the lens of document A1 relating to the manufacturer or to the design code would allow the optician to find out the measuring method of the optical performance value, the optician would then have to call a person at the lens manufacturer by telephone or try to find the required information on the manufacturer's website. The aim of the invention is to avoid this additional burden for the optician, to enable the optician to more precisely evaluate and accurately measure the optical performance of the lens, to improve the reliability of the information he obtains, and to simplify and improve the handling of the lenses by including in the lens symbolized

definition information specifying optical performance definition information on how the optical performance value of the lens is measured.

As regards the auxiliary request, the addition dioptre of a progressive-power lens can be measured with respect to the convex surface of the lens, or with respect to the concave surface, or with respect to the sight line position and the centre of rotation of the lens wearer's eyeball, and each of these methods is conventionally used in the art. It is therefore important to specify which specific method is to be used when checking and evaluating the prescription values of a particular lens in the spectacle shop. The information encoded in the lens of document A1 is insufficient to discern any particular method of measurement of the addition dioptre of the progressive lens, and in the absence of any hint in the prior art towards the specific problem considered in the application and towards encoding the claimed information in the lens, only hindsight knowledge of the invention would suggest the claimed approach.

The corresponding Japanese and US patents have been granted based on a broad wording of claim 1 similar to that of the main request.

Reasons for the Decision

1. The appeal is admissible.

2. *Main request*

2.1 Document A1 discloses a progressive-power lens having a plurality of different inscriptions engraved on its

surface and having the form of symbols (Figure 2-21 on page 33). Some of the symbols represent values of the optical performance of the lens; in particular, the symbol "25" engraved on the lens shown in Figure 2-21 represents the add power of the lens. According to the text in Figure 2-21 the inscriptions also include symbols representing the design or the vendor and symbols representing the design code or the manufacturer, and the disclosure on page 33 emphasizes the importance of selecting the appropriate progressive design for the lens (page 33, second paragraph) and teaches engraving markings on the lens indicative of the particular lens design (page 33, third paragraph). In addition, according to the disclosure of document A1 (page 33, third paragraph) the inscriptions have been formed for the purpose of indicating the corresponding information relating to the lens, and therefore for the purpose of evaluating the optical characteristics and performance of the lens.

2.2 The appellant has submitted that the claimed invention is distinguished from the disclosure of document A1 by requiring the formation on the lens of an inscription including "symbolized definition information" specifying how the optical performance values inscribed on the lens are measured.

In the decision under appeal the examining division held that the claimed features relating to the information content of the inscriptions, and in particular those relating to the "symbolized definition information", were purely cognitive and therefore not technical and that consequently they had to be disregarded in the assessment of novelty and inventive step, and during the appeal proceedings the appellant has disputed the examining division's view in this

respect. In the circumstances of the present case, however, there is no need to address this issue in the present decision because, irrespective of whether or not the information content of the claimed "symbolized definition information" constitutes a technical aspect of the claimed invention which can contribute to novelty and inventive step within the meaning of Articles 52(1) and 56 EPC 1973 (see "Case Law of the Boards of Appeal", EPO, 6th edition (2010), chapter I, sections C-3.2.8 and D-8.1.2), in the Board's opinion the claimed feature under consideration is already anticipated or at least rendered obvious by the disclosure of document A1 relating to the inscription of a symbol representing the design or a design code and indicative of the particular lens design.

2.2.1 Indeed, it is inherent to the optical design of a progressive-power lens such as that disclosed in document A1 to previously define the different optical parameters of the lens on which the optical design method is to be based, and the corresponding definitions determine how the optical parameters are to be evaluated and therefore measured in the lens resulting from the design. Consequently, information on the particular optical design of a progressive lens inherently constitutes information on how the optical parameters, and therefore the optical performance of the lens, are to be measured. As mentioned above, the lens shown in Figure 2-21 of document A1 has a specific symbol indicative of the particular design of the lens and, in view of the considerations above, the symbol itself constitutes information representative of how the values of the optical performance inscribed on the lens are defined and therefore representative of how the values are to be measured.

It follows that the symbol on the lens of document A1 indicative of the particular lens design constitutes "symbolized definition information" within the generic meaning of the claimed expression, and also within the specific meaning of the expression given in the description of the application. Indeed, according to the description of the application the claimed "symbolized definition information" refers to information that allows the identification of one among a series of methods of definition of the values of the optical performance of the lens, the series being encoded in the form of a code table that is for instance available in the form of electronic data and that can be obtained from the manufacturer, for instance via a network communication line (page 8, lines 4 to 8 and page 25, lines 22 to 24, together with the disclosure relating to the code tables 5 and 6). In the case of the lens disclosed in document A1, the information inscribed on the lens and representative of the particular lens design unambiguously identifies a source of information that would allow - if necessary, by contacting the vendor and/or the manufacturer also identified on the lens by the information encoded in one of the markings - the identification of the particular lens design and therefore of the corresponding definition of the optical design and thus of the corresponding method of determination or measurement of the values of the different optical parameters on which the design is based and encoded in the symbols inscribed on the lens such as the add power value "25". The appellant's objection that this approach would require contacting the manufacturer is not considered pertinent because, as already noted above, according to the description the claimed invention also presupposes contacting the manufacturer, or at least a source of information related to the

manufacturer, in order to interpret the meaning of the information encoded in the inscription relating to the claimed symbolized definition information (*cf*. page 25, lines 22 to 24).

2.2.2 The appellant has disputed that the information encoded on the lens of document A1 and relating to the design of the lens was sufficient to derive or identify the method of measurement of the optical parameters of the lens. As concluded above, however, the information encoded on the lens of document A1 and relating to the particular lens design and to the vendor and/or the manufacturer is sufficient for an optician to retrieve a source of information that would allow him to determine the method of measurement of the values of the optical parameters encoded on the lens by means of inscriptions, and in this regard the claimed invention is anticipated by the disclosure of document A1. In any case, should the information encoded in the plurality of markings referred to above still not be sufficient, either because the specific method of design of the lens can still not be completely or unambiguously identified in view of the information content of the markings relating to the lens design or because the specific design can be identified but does not uniquely and unambiguously identify the appropriate method of measurement of the optical parameters, the optician and the manufacturer would both immediately have noticed it in view of the unsuccessful attempts by the optician to obtain the appropriate information from the manufacturer, and in these circumstances it would have been obvious to improve the information content of the multiple markings already present in the lens so as to remedy this deficiency, thus resulting in "symbolized definition information" as claimed.

2.3 Having regard to the above considerations, the Board concludes that the claimed feature relating to the "symbolized definition information" is intrinsically anticipated or at least rendered obvious by the disclosure of document A1 and that consequently - independently of whether or not the information content defined in the claimed feature under consideration constitutes a technical aspect to be taken into account in the assessment of patentability in the sense mentioned in point 2.2 above - the method defined in claim 1 and the lens defined in independent claim 6 of the main request are not novel (Article 54(1) EPC 1973), and in any case do not involve an inventive step over the prior art (Article 56 EPC 1973).

3. *Auxiliary request*

When compared with claims 1 and 6 of the main request, each of claims 1 and 4 of the auxiliary request further requires that the performance information includes the addition dioptre value of the lens and that the symbolized definition information indicates which of the convex or concave surface of the lens is used as a reference for obtaining the addition dioptre value or whether the addition dioptre is calculated based on the sight line position and the centre of rotation of the lens wearer's eyeball.

As already mentioned in point 2.1 above, the progressive lens disclosed in document A1 already includes a symbol representing the value of the addition dioptre of the lens (symbol "25" representing the value of the add power of the lens, see Figure 2-21) and a symbol identifying the particular design of the lens. In addition, as acknowledged by the appellant in the statement of grounds of appeal (*cf.* point VIII

above, penultimate paragraph) and in the introductory part of the description of the application in connection with the different determination criteria used in Japan, USA and Europe (paragraphs bridging pages 4 and 5 of the description, together with the disclosure of Tables 5 and 6), it is known in this art that the value of the addition dioptre can be defined, depending on the design criteria used, with respect to the convex surface, or with respect to the concave surface of the lens, or with respect to the sight line position and the centre of rotation of the lens wearer's eyeball.

Thus, in view of the considerations in points 2.2.1 and 2.2.2 above that the design method of the lens intrinsically identifies how the different optical parameters of the lens are defined and consequently determined or measured, it is to be expected that the symbol in the lens of document A1 identifying the particular design of the lens would inherently represent information indicative of whether the value of the addition dioptre is measured with respect to the convex surface, or with respect to the concave surface of the lens, or with respect to the sight line position and the centre of rotation of the lens wearer's eyeball. In any case, should this not be the case, it would then have been obvious for the same reasons as those given in point 2.2.2 above with regard to the main request to improve the information content of the markings already present in the lens so as to remedy this deficiency, thus resulting in "symbolized definition information" as claimed.

It follows that - independently of whether or not the "symbolized definition information" relating to the reference used in the measurement of the addition

dioptre value constitutes a technical aspect to be taken into account in the assessment of patentability in the sense mentioned in point 2.3 above - the method defined in claim 1 and the lens defined in independent claim 4 of the auxiliary request are not novel (Article 54(1) EPC 1973), and in any case do not involve an inventive step over the prior art (Article 56 EPC 1973).

4. During the appeal proceedings the appellant drew the Board's attention to the fact that patents have been granted to the appellant for essentially the same invention by different patent granting authorities (in particular, those in the USA and in Japan). The decisions to grant referred to by the appellant, however, cannot have an influence on the assessment by the Board of the patentability of the claimed invention because the Board has to examine the present patent application under the EPC, i.e. under an autonomous system which applies independently of the patent law systems referred to by the appellant, and in any case there is no indication as to whether - and how - the content of document A1 has been considered during prosecution of the corresponding patent applications.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

M. Kiehl A. G. Klein

Decision electronically authenticated