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**Datasheet for the decision  
of 6 April 2017**

**Case Number:** T 0701/13 - 3.2.08

**Application Number:** 96940506.7

**Publication Number:** 1021271

**IPC:** B23K26/04, G06K1/02, G06K1/12

**Language of the proceedings:** EN

**Title of invention:**  
LASER MARKING SYSTEM AND METHOD FOR GEMSTONES

**Patent Proprietor:**  
LAZARE KAPLAN INTERNATIONAL INC.

**Opponent:**  
Sarin Technologies Ltd.

**Headword:**

**Relevant legal provisions:**  
EPC Art. 100(c)

**Keyword:**  
Grounds for opposition - added subject-matter (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 0701/13 - 3.2.08

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.08**  
**of 6 April 2017**

**Appellant:** LAZARE KAPLAN INTERNATIONAL INC.  
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**Representative:** Katscher Habermann Patentanwälte  
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**Appellant:** Sarin Technologies Ltd.  
(Opponent) 7 Atir Yeda  
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**Representative:** Vossius & Partner  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
9 January 2013 maintaining European patent  
No. 1021271 in amended form.

**Composition of the Board:**

**Chairwoman** P. Acton  
**Members:** C. Herberhold  
F. Blumer

## **Summary of Facts and Submissions**

- I. By its decision posted on 9 January 2013 the Opposition Division decided that European patent No. 1 021 271 as amended according to the fourth auxiliary request then on file, and the invention to which it related, met the requirements of the EPC.
- II. Appellant 1 (patent proprietor) and appellant 2 (opponent) lodged appeals against that decision in the prescribed form and within the prescribed time limit.
- III. In accordance with the appellants' requests the Board issued a summons for oral proceedings. In a communication pursuant to Article 15(1) RPBA dated 9 December 2016 the Board noted that the objections raised by appellant 2 against the claims of the auxiliary requests appeared to apply *mutatis mutandis* to the corresponding dependent claims of the patent as granted, including dependent claim 26, and that discussion of these objections in the context of the main request was envisaged.
- IV. Oral proceedings before the Board took place on 6 April 2017. As announced with submissions dated 9 December 2017 and 6 March 2017 respectively, appellants 1 and 2 did not attend.
- V. The requests submitted in the written proceedings were as follows:

Appellant 1 requested that the decision of the Opposition Division be set aside and that the patent be maintained as granted or, alternatively on the basis of the first, second, third or fourth auxiliary

request as filed with the statement setting out the grounds of appeal.

Appellant 2 requested that the decision of the Opposition Division be set aside and that the patent be revoked in its entirety.

VI. Granted claim 26 (main request) dependent on claim 1 reads as follows:

"A laser energy microinscribing system, comprising:  
a pulse laser energy source (1);  
a gemstone mounting system (144), allowing optical access to a mounted gemstone;  
an optical system for focusing laser energy from the laser energy source (I) onto the gemstone;  
means (50, 51) for directing said focused laser energy onto a desired portion of the gemstone, having a control input;  
an electronic imaging system (8; 24; 23; 28 or 34; 33; 32) for viewing the gemstone from a plurality of vantage points;  
said imaging system comprises an electronic imaging device for transmitting image information to a processor; (original claim 19)  
an input for receiving marking instructions;  
said processor (157) for controlling said directing means based on said marking instructions and said image information from said imaging system (8; 24; 23; 28 or 34; 33; 32), to selectively generate a marking based on said instructions and a predetermine program;  
a storage system for storing information relating to images of a plurality of gemstones in conjunction with information relating to said marking instructions.  
(original claim 27)",

further comprising "a control for controlling a focus of said optical system (5, 8, 10) with respect to a desired portion (12) of the gemstone (11, 111) based on closed loop optical feedback provided through said imaging system (8; 24; 23; 28 or 34; 33; 32), wherein (Feature A) said laser energy source (1) and imaging system (8; 24; 23; 28 or 34; 33; 32) share a common solid element within an optical path (25)."

Feature identifier "**A**" has been added by the Board.

Feature A is likewise claimed in all auxiliary requests, i.e. in independent claim 1 of auxiliary request 1, in dependent claim 26 of auxiliary request 2, in independent claim 1 of auxiliary request 3 and in dependent claim 24 of auxiliary request 4.

VII. The main arguments of appellant 2 (see submission dated 7 October 2013, point 3.2.1) can be summarised as follows:

The subject-matter of Feature A was first introduced into the application on 24 March 2005, with the indication that it was supported by Figs. 1, 2, 3, 9 and 10. However, whereas these figures showed that the laser beam and the optical axis of the imaging system both passed through dichroic mirror 8 and microscope objective 10, the broad term "a common solid element within an optical path" used in **Feature A** of granted dependent claim 26 and in amended claim 1 of the first auxiliary request had no support in the PCT application as filed. It was thus not directly and unambiguously derivable from the PCT application as filed, which meant that this amendment constituted an inadmissible broadening compared with the specific optical elements originally disclosed.

Consequently, the requirements of Article 123(2) EPC were not fulfilled.

VIII. The main arguments of appellant 1 can be summarised as follows:

The subject-matter of dependent claim 26 of the request filed during examination proceedings with submission dated 24 March 2005 - which was identical to claim 26 as granted and which comprised **Feature A** - was based on the disclosure in Figures 1, 2, 3, 9 and 10 as originally filed (see the handwritten annotations in the claim set filed with the submission). The requirements of Article 123(2) EPC were therefore fulfilled.

No arguments concerning the original disclosure of claim 26 as granted have been presented by appellant 1 during opposition and appeal proceedings.

### **Reasons for the Decision**

1. Article 100(c) EPC

1.1 While the description as originally filed mentions that the laser beam (page 23, line 2-4 of the published PCT application) as well as the reflected collimated illumination beam (page 23, line 7 - 15) both pass through specific solid elements, i.e. through a dichroic mirror and a microscope objective, it does not disclose the more general **Feature A** according to which "said laser energy source and imaging system share a common solid element within an optical path".

Also drawings 1, 2, 3, 9 and 10 only show particular common solid elements within the optical path, i.e. the dichroic mirror (Figures 2, 9: **8**) and the microscope objective (Figure 2: **10**) / focusing lens (Figure 9: **10**), and thus cannot support a generalisation towards sharing a "common solid element" within the optical path in general.

Therefore, the application as originally filed does not provide clear and unambiguous basis for the generalised broad term "common solid element within an optical path" in **Feature A**. With the subject-matter of claim 26 as granted extending beyond the content of the application as originally filed, Article 100(c) EPC prejudices the maintenance of the patent as granted.

- 1.2 In its communication dated 9 December 2016 the Board had indicated (point 3.1 of the communication) that the objection of added subject-matter raised against the auxiliary requests appeared to apply *mutatis mutandis* also to dependent claim 26 as granted. It had further mentioned (page 3, third paragraph) that whether or not there was a basis for the generalisation in **Feature A** towards a "common solid element" was to be discussed. The attention of appellant 1 had thus been drawn to the decisive objection. By deciding not to attend the scheduled oral proceedings and not to file substantive arguments in reply to the Board's communication, appellant 1 chose not to make use of the opportunity to comment on the ground on which the decision is based (Article 113(1) EPC), either in written form or orally at the oral proceedings.



2. Auxiliary requests

**Feature A** is present in one claim of each auxiliary request, i.e. in independent claim 1 of auxiliary request 1, in dependent claim 26 of auxiliary request 2, in independent claim 1 of auxiliary request 3 and in dependent claim 24 of auxiliary request 4. The auxiliary requests are thus not allowable at least for the reasons discussed in point 1.1 above.

3. With the opposition ground under Article 100(c) prejudicing maintenance of the patent as granted, and with the amendments in auxiliary requests 1-4 likewise not fulfilling the requirements of the Convention, the patent has to be revoked.

**Order**

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

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairwoman:



C. Moser

P. Acton

Decision electronically authenticated