

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [-] To Chairmen
- (D) [X] No distribution

**Datasheet for the decision
of 10 April 2019**

Case Number: T 2307/14 - 3.4.02

Application Number: 10382062.7

Publication Number: 2325610

IPC: G01D5/347

Language of the proceedings: EN

Title of invention:
Optoelectronic measuring device

Patent Proprietor:
Fagor, S. Coop.

Opponent:
Dr. Johannes Heidenhain GmbH

Headword:

Relevant legal provisions:
EPC Art. 52(1), 56
RPBA Art. 13(1)

Keyword:

Inventive step - main request (no) - auxiliary requests 1 and 2 (no)

Late-filed auxiliary requests 3 and 4 - admitted (no)

Decisions cited:

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 2307/14 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 10 April 2019

Appellant: Dr. Johannes Heidenhain GmbH
(Opponent) Dr. Johannes-Heidenhain-Straße 5
83301 Traunreut (DE)

Respondent: Fagor, S. Coop.
(Patent Proprietor) Barrio San Andrés, s/n
Apdo. 213
20500 Arrasate-Mondragon (ES)

Representative: Igartua, Ismael
Galbaian S. Coop.
Garaia Parke Teknologikoa
Goiru Kalea 1
20500 Arrasate-Mondragón (ES)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
31 October 2014 concerning maintenance of the
European Patent No. 2325610 in amended form.**

Composition of the Board:

Chairman R. Bekkering
Members: C. Kallinger
B. Müller

Summary of Facts and Submissions

- I. The opponent lodged an appeal against the interlocutory decision of the opposition division to maintain the patent in amended form on the basis of the claims filed with letter dated 8 August 2014.
- II. The appellant requested that the interlocutory decision be set aside and the patent be revoked in its entirety.
- III. In its reply to the appellant's statement of grounds of appeal, the respondent (patent proprietor) requested that the appeal be dismissed or, in the alternative, that the patent be maintained as amended on the basis of the claims according to the first to ninth auxiliary requests filed during the first-instance opposition proceedings with a letter dated 8 August 2014.
- IV. On 17 October 2018 the board issued a summons to oral proceedings and informed the parties about its preliminary opinion on inventive step and admissibility of the auxiliary requests.
- V. In its reply to the summons to oral proceedings dated 27 December 2018 the respondent filed claims according to a first to ninth auxiliary request.
- VI. In its further reply to the summons to oral proceedings of 8 March 2019 the respondent filed four auxiliary requests replacing the previously filed nine auxiliary requests.
- VII. Oral proceedings were held on 10 April 2019.

VIII. The parties' final requests are as follows:

The appellant (opponent) requested that the decision under appeal be set aside and that the European patent No. 2325610 be revoked.

The respondent (patent proprietor) requested that

- the appeal be dismissed or, in the alternative,
- that the decision under appeal be set aside and that the patent be maintained as amended on the basis of the claims according to the first to fourth auxiliary requests filed with a letter dated 8 March 2019.

IX. The following documents will be referred to in this decision:

D1: DE 35 06 494 C1
D2: DE 33 02 151 A1 .

X. Claim 1 of the patent as maintained in amended form reads as follows (itemisation added by the board):

Optoelectronic measuring device, comprising

- a) a profile (1) with a longitudinal inner groove,*
- b) a measuring band (2) arranged in the longitudinal groove of the profile (1), attached at both ends to said profile (1), and*
- c) a read head (3) that moves through the longitudinal groove of the profile (1) in order to read the measuring band (2), characterised in that*
- d) the device (100) also comprises a tensioning device (4) for adjusting the length of the measuring band (2), said measuring band (2) being attached at one end*

- to the profile (1) by means of said tensioning device (4), and
- e) locking means (6) adapted for locking the tensioning device (4) in respect of the profile (1),
 - f) the locking means (6) and the tensioning device (4) being arranged outside the path followed by the read head (3) when said read head (3) is removed from the profile (1), so that there is no need to dismantle said tensioning device (4).

XI. Claim 1 of auxiliary request 1 reads as follows (amendments compared to the main request are marked by underlining):

"1. [Features added at the end of claim 1 of the main request]
... for the removal of the read head (3) from the longitudinal groove of the profile (1) through the end where the measuring band (2) is attached to said tensioning device (4)."

XII. Claim 1 of auxiliary request 2 reads as follows (amendments compared to the main request are marked by underlining):

"1. Encapsulated optoelectronic measuring device, comprising
[Features added at the end of claim 1 of the main request]
... for the removal of the read head (3) from the longitudinal groove of the profile (1) through the end where the measuring band (2) is attached to said tensioning device (4)."

XIII. Claim 1 of auxiliary request 3 reads as follows
(amendments compared to the main request are marked by
underlining):

"1. *[Features added at the end of claim 1 of the main request]*
... wherein the tensioning device (4) comprises a fixed piece (40), a moving piece (41) that is connected to the measuring band (2) and which moves in relation to the fixed piece (40) in order to adjust the tension of said measuring band (2), and an adjustment member (43) that is associated to said moving piece (41) and which it is acted upon in order to adjust the tension of the measuring band (2), the locking means (6) locking said moving piece (41), and
wherein the tensioning device (4) comprises a spring (42) coiled in an external area (43a) of the adjustment member (43) that is external to the fixed piece (40), said spring (42) causing the adjustment of the length of the measuring band (2) when the adjustment member (43) is acted upon, thereby causing the movement of the moving piece (41)."

XIV. Claim 1 of auxiliary request 4 reads as follows
(amendments compared to the main request are marked by
underlining):

"1. Encapsulated optoelectronic measuring device,
comprising
[Features of claim 1 of the main request]
... for the removal of the read head (3) from the longitudinal groove of the profile (1) through the end where the measuring band (2) is attached to said tensioning device (4),
wherein the tensioning device (4) comprises a fixed piece (40), a moving piece (41) that is connected to

the measuring band (2) and which moves in relation to the fixed piece (40) in order to adjust the tension of said measuring band (2), and an adjustment member (43) that is associated to said moving piece (41) and which it is acted upon in order to adjust the tension of the measuring band (2), the locking means (6) locking said moving piece (41), and

wherein the tensioning device (4) comprises a spring (42) coiled in an external area (43a) of the adjustment member (43) that is external to the fixed piece (40), said spring (42) causing the adjustment of the length of the measuring band (2) when the adjustment member (43) is acted upon, thereby causing the movement of the moving piece (41),

the profile (1) comprising a housing (10) in its base (1 a) for housing, at least partially, the tensioning device (4), said housing (10) being accessible from one end (1b) of said profile (1),

the locking means (6) comprising a locking member (6a) that acts transversally on the tensioning device (4) in order to lock it, and

the profile (1) comprises a locking hole (60a) or groove to enable the locking member to move from the outside of the profile (1) to the tensioning device (4)."

Reasons for the Decision

1. Main request - patent as maintained in amended form

The subject-matter of claim 1 of the main request does not involve an inventive step with respect to the combination of documents D2 and D1.

1.1 Inventive step - D2 as closest prior art

Document D2 discloses a measuring device comprising

- (a) a hollow profile (page 5, lines 32 to 33:
"Trägerkörper T [...] aus einem [...] Aluminium-Hohlprofil") with a longitudinal groove (page 6, line 5: *"Innenraum des Trägerkörpers"* and line 27: *"innerer Querschnitt"*),
- (b) a measuring band arranged in the groove (page 6, lines 1 to 3: *"bandförmige Maßverkörperung M eingeschoben"*) and attached at both ends to the profile (page 6, lines 15 to 16 and figure 1: *"Befestigungsbaustein B1 bzw. B2"*),
- (c) a read head that moves through the longitudinal groove of the profile (page 6, 1st paragraph: *"Abtastbaustein A [...] im Innenraum des Trägerkörpers [...] verschiebbar"*),
- (d) a tensioning device for adjusting the length of the measuring band (claim 4: *"Spannvorrichtung (S)"*), said measuring band being attached at one end to the profile by means of said tensioning device (see page 7, lines 10 to 15).

D2 thus discloses the features a) to d) of claim 1.

This was not contested by the respondent.

1.2 Differences

D2 fails to disclose:

- (i) that the measuring device is optoelectronic
- (ii) locking means according to feature e

- (iii) the arrangement of the tensioning device and the locking means according to feature f

These differences are undisputed by the parties.

1.3 Combination of D2 with D1

1.3.1 Optoelectronic measuring device (difference (i))

With respect to the first difference, the board agrees with the appellant's line of argument that the choice of an optoelectronic measuring principle is disclosed in document D1 (column 5, lines 51 to 59). It is also within the skilled person's knowledge and therefore does not contribute to the presence of an inventive step.

This was not contested by the respondent.

1.3.2 Locking means (difference (ii))

With respect to the second difference, the respondent argued that the measuring devices disclosed in D2 and D1 were incompatible, because D2 related to an encapsulated measuring device whereas D1 disclosed an "open" measuring device. Furthermore, the tensioning by segments as taught by D1 could not directly be applied to the hollow profile of D2, as the fastening means of D1 were not easily accessible from the outside. This would lead to another incompatibility between the measuring devices of D1 and D2.

Therefore, the skilled person would not consider combining the teachings of the two documents.

The respondent argued further that, even if the skilled person consulted D1 and tried to implement the locking means disclosed therein in the device known from D2, this would require major modifications of the profile known from D2. D1 did not teach where and how to provide the locking means disclosed therein in the device known from D2.

The respondent's argument with respect to the incompatibility of the teachings of D1 and D2 is not convincing. D1 discloses an "open" measuring device with a longitudinal profile ("*Längshalter 29*"), a measuring band ("*Band 30*") attached at both ends (figures 4, 5 and 7) and a tensioning device ("*Spannkopf 33*"). Although D2 shows an encapsulated measuring device, it also explicitly mentions "open" measuring devices (page 7, lines 20 to 23). The board is therefore of the opinion that the skilled person would consider combining D2 and D1.

D1 discloses locking means ("*Schrauben 41*") for locking the tensioning device in respect of the profile (column 6, lines 24 to 32 and figure 7). D1 discloses a first configuration of the locking means in figures 7 and 8 but explicitly mentions an alternative configuration according to which the locking screws 41 can be arranged in the longitudinal profile (column 6, lines 30 to 32). The board is therefore of the opinion that, based on this teaching of how and where to arrange the locking means, the skilled person could implement the locking means of D1 by merely constructional measures. Such measures do not require major modifications which could justify acknowledging the presence of an inventive step.

1.3.3 Arrangement of tensioning device and locking means
(difference (iii))

With respect to the third difference the respondent argued that, even if the locking means of D1 were used in D2, D1 had no teaching to keep the locking means out of the way of the read head as required by feature f. As D1 was an open measuring device, the read head could be lifted off from the measuring band in a vertical manner and no need for an arrangement according to feature f would arise.

The board is not convinced by this line of argument. D2 already explicitly teaches to arrange at least one of the measuring band attachments B1 or B2 so that the space where the read head moves is free of any projections (see claim 1). Thus, the arrangement of both measuring band attachments outside the path followed by the read head when said read head is removed from the profile is explicitly disclosed in D2. Therefore, when starting from D2, which explicitly discloses to also keep the attachment means comprising the tensioning device out of the way of the read head, the skilled person would necessarily arrange the locking means taught by D1 such that they are arranged outside the path followed by the read head when removed from the profile.

1.4 The board comes to the conclusion that the patent as maintained in amended form does not meet the requirements of Article 52(1) EPC, because the subject-matter of claim 1 does not involve an inventive step within the meaning of Article 56 EPC with respect to the combination of documents D2 and D1.

2. Auxiliary request 1

Auxiliary request 1 was admitted into the proceedings but the subject-matter of claim 1 does not involve an inventive step with respect to the combination of documents D2 and D1.

2.1 Admissibility

The appellant argued that auxiliary request 1 should not be admitted as it was late filed and prime facie not suitable to address the inventive step objections.

The board exercised its discretion according to Article 13(1) RPBA in admitting auxiliary request 1 into the proceedings. The amendment was not complex and did not raise any issues which could not reasonably be dealt with during the oral proceedings.

2.2 Amendments

Claim 1 of auxiliary request 1 was amended by adding the following features at its end:

"for the removal of the read head (3) from the longitudinal groove of the profile (1) through the end where the measuring band (2) is attached to said tensioning device (4)."

This feature is disclosed on page 2, lines 22 to 28 and page 4, lines 23 to 28 of the application as filed.

This was not contested by the appellant.

As a consequence, the board is of the opinion that the requirements of Article 123(2) EPC are met.

2.3 Inventive step - Article 56 EPC

With reference to figure 1 and page 6, line 26 to page 7, line 2 of D2, the respondent argued that the measuring device of D2 was clearly restricted to the removal of the read head from the groove through the end where the attachment device B1 was located, i.e. the side where no tensioning device was present. As neither D2 nor D1 taught this feature, the subject-matter of claim 1 involved an inventive step.

The board is not convinced by this line of argument. Claim 1 of D2 explicitly states that at least one of the fastening means is shaped and positioned to allow the scanning unit to move past said at least one of the fastening means. Contrary to the respondent's argument, the board sees this as a clear disclosure of an arrangement of the tensioning device according to amended feature f, i.e. *"outside the path followed by the read head (3) when said read head (3) is removed from the profile (1), so that there is no need to dismantle said tensioning device (4) for the removal of the read head (3) from the longitudinal groove of the profile (1) through the end where the measuring band (2) is attached to said tensioning device (4)."*

For the same reasons as those given in section 1.3.3 above, the skilled person would, as a consequence, also arrange the locking means taught by D1 at this end of the profile.

The board therefore comes to the conclusion that auxiliary request 1 does not meet the requirements of Article 52(1) EPC, because the subject-matter of claim 1 does not involve an inventive step within the meaning

of Article 56 EPC with respect to the combination of documents D2 and D1.

3. Auxiliary request 2

Auxiliary request 2 was admitted into the proceedings, but the subject-matter of claim 1 does not involve an inventive step with respect to the combination of documents D2 and D1.

3.1 Admissibility

The appellant argued that auxiliary request 2 should not be admitted as it was late filed and prime facie not suitable to address the inventive step objections.

The board exercised its discretion according to Article 13(1) RPBA in also admitting auxiliary request 2 into the proceedings as the amendment was not complex and did not raise any issues which could not reasonably be dealt with during the oral proceedings.

3.2 Amendments

In comparison to auxiliary request 1, claim 1 of auxiliary request 2 was amended by introducing the underlined feature:

"1. Encapsulated optoelectronic measuring device, comprising, ...[features as in claim 1 of auxiliary request 1]".

The appellant argued that this feature was not literally disclosed in the application as filed.

The respondent argued that this feature, although not disclosed literally, had a basis in the whole description and the drawings.

The board is of the opinion that the description and the figures as a whole disclose an encapsulated measuring device and that therefore the requirements of Article 123(2) EPC are met.

3.3 Inventive step

The respondent argued that the newly introduced feature now clearly specified that the invention related to an encapsulated measuring device. Therefore the skilled person would not consider document D1, as this document related to an "open" measuring device.

The board is not convinced by this line of argumentation. Although the embodiment shown in figures 1 and 2 of D2 relates to an encapsulated measuring device, D2 nevertheless contains the explicit disclosure that the teaching of D2 can be applied equally to encapsulated as well as open measuring devices (see page 7, lines 20 to 29).

The board comes to the conclusion that auxiliary request 2 does not meet the requirements of Article 52(1) EPC because the subject-matter of claim 1 does not involve an inventive step within the meaning of Article 56 EPC with respect to the combination of documents D2 and D1.

4. Auxiliary requests 3 and 4

Auxiliary requests 3 and 4 are not admitted into the proceedings.

In its response to the summons for oral proceedings dated 8 March 2019, the respondent filed auxiliary requests 3 and 4. In this letter the respondent indicated a basis for the amendments and presented arguments for the presence of an inventive step.

The appellant requested not to admit auxiliary requests 3 and 4 into the proceedings as they were late filed and raised new issues which had not been present previously.

According to Article 13(1) RPBA, any amendment to a respondent's case after it has filed its reply to the grounds of appeal may be admitted and considered at the board's discretion. The current amendments relate, *inter alia*, to mechanical details of the tensioning device which have not been discussed during the appeal proceedings so far and would require a discussion of documents D3 to D5.

In view of this complexity and the very advanced state of the proceedings the board does not admit auxiliary requests 3 and 4 into the proceedings.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:



M. Kiehl

R. Bekkering

Decision electronically authenticated