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Datasheet for the decision of 14 February 2020

Case Number: T 1872/18 - 3.4.02

Application Number: 07828091.4

Publication Number: 2085806

IPC: G02B21/36, G02B21/16, H04N5/225, H04N5/915, H04N1/21, G11B27/031, G02B21/00, H04N5/262

Language of the proceedings: EN

Title of invention:
MICROSCOPE DEVICE

Applicant:
Nikon Corporation

Headword:

Relevant legal provisions:
EPC Art. 123(2)
RPBA Art. 13(1)

Keyword:
Main and auxiliary requests - amendments after arrangement of oral proceedings - prima facie clearly allowable (no) - admitted (no)

Decisions cited:

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

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Case Number: T 1872/18 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 14 February 2020

Appellant: (Applicant)	Nikon Corporation 15-3, Konan 2-chome Minato-ku Tokyo 108-6290 (JP)
Representative:	Petzold, Silke Maucher Jenkins 26 Caxton Street London SW1H 0RJ (GB)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 16 February 2018 refusing European patent application No. 07828091.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	R. Bekkering
Members:	A. Hornung
	G. Decker

Summary of Facts and Submissions

I. The applicant appealed against the decision of the examining division refusing European patent application No. 07828091.4 on the basis of Article 97(2) EPC because the requirements of Article 56 EPC were not fulfilled.

II. Initially, the appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the claims according to a main request or of an auxiliary request, all requests filed with the statement setting out the grounds of appeal.

III. On 24 May 2019, the board summoned the applicant to attend oral proceedings. In a communication accompanying the summons, the board provided its provisional opinion on the merits of the appeal.

IV. In response to the summons to oral proceedings, the applicant, with a letter dated 13 January 2020, filed amended claims according to a new main request and a new auxiliary request, in replacement of the main and auxiliary request filed with the statement of grounds of appeal.

V. Oral proceedings before the board were held on 14 February 2020.

VI. As its final requests, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the main request or of the first auxiliary request, both requests filed with the letter dated 13 January 2020, or of the second or the third auxiliary request, both requests filed at the oral proceedings.

VII. Claims of the requests

Main request

Independent claim 1 according to the main request reads as follows:

"A microscope apparatus (1), comprising:

a time-lapse imaging unit adapted to repeatedly capture a specimen at predetermined time intervals and to generate a plurality of images captured during a period of time-lapse capturing;

a recording unit adapted to store transiently said plurality of images captured during said period of time-lapse capturing and record selectively either one of an image group including each of the plurality of images captured in a predetermined period among said images stored transiently and an image group including a plurality of images picked at predetermined time intervals among said images stored transiently; and

a selecting unit adapted to monitor a state of the specimen using said plurality of images stored transiently and decide the predetermined period to select the image group based on a result of the monitoring".

First auxiliary request

Independent claim 1 according to the first auxiliary request differs from claim 1 of the main request only in that it comprises the following additional features at the end of the claim:

"and an observation member for a fluorescence observation of the specimen, wherein

the selecting unit is adapted to select the image group by obtaining an intensity ratio in fluorescence based on the images each stored transiently and generated by the time-lapse imaging unit when the fluorescence observation is performed by two types of different wavelengths".

Second auxiliary request

Independent claim 1 according to the second auxiliary request reads as follows:

"A microscope apparatus (1), comprising:

a time-lapse imaging unit adapted to repeatedly capture a specimen at predetermined time intervals and to generate a plurality of images captured during a period of time-lapse capturing, wherein said plurality of images captured during said period of time-lapse capturing are transiently stored;

a recording unit adapted to record selectively either one of an image group including a plurality of images captured in a predetermined period among said images generated during said period of a time-lapse capturing performed by the time-lapse imaging unit and an image group including a plurality of images picked at predetermined time intervals among said images generated during said period of the time-lapse capturing performed by the time-lapse imaging unit,

a selecting unit adapted to monitor a state of the specimen using said plurality of images captured during said period of time-lapse capturing and decide the predetermined period to select the images to be recorded from said plurality of images captured during said period of time-lapse capturing as the image group based on a result of the monitoring".

Third auxiliary request

Independent claim 1 according to the third auxiliary request differs from claim 1 of the second auxiliary request only in that it comprises the following additional features at the end of the claim:

"and an observation member for a fluorescence observation of the specimen, wherein

the selecting unit is adapted to select the images to be recorded by obtaining an intensity ratio in fluorescence based on the images each generated by the time-lapse imaging unit when the fluorescence observation is performed by two types of different wavelengths".

Reasons for the Decision

1. Main request

The board decides not to admit the main request into the proceedings under Article 13(1) RPBA 2007.

1.1 The main request has been filed with the letter dated 13 January 2020 in response to the annex of the summons to oral proceedings.

1.2 According to the applicant's letter, "[t]he replacement requests are an earnest attempt to overcome the objections raised with regard to added matter and clarity". This submission might be seen as a justification for the admission of the new auxiliary request into the proceedings. During oral proceedings, the applicant further submitted

that no objection of added subject-matter or clarity was raised in the appealed decision. It amended claim 1 *inter alia* in order to take account of the board's interpretation of the "selecting unit" of claim 1.

1.3 One of the criteria for admitting new requests into the proceedings is indeed that sound reasons, for instance, new developments occurring during the proceedings, exist therefor. New objections raised by the board may represent such new developments. It remains, however, that a new request filed in response to a summons to oral proceedings represents an amendment of the party's case within the meaning of Article 13(1) RPBA 2007. Such an amendment of the party's case may be admitted only at the board's discretion. Otherwise, the automatic admission of any amendments submitted in response to new objections, including amendments not overcoming all the objections raised and/or introducing new objections, would bear the risk of running counter to the need for procedural efficiency.

1.4 According to established jurisprudence of the boards of appeal (see Case Law of Boards of Appeal, 9th edition 2019, sections V.A.4.12.1 and V.A.4.12.2a), new auxiliary requests containing amended claims may be admitted into the proceedings under Article 13(1) RPBA 2007 *inter alia* if the claims are *prima facie* clearly allowable, wherein "[c]laims are clearly allowable if the board can quickly ascertain that they do not give rise to new objections and overcome all outstanding objections".

1.5 In the present case, this condition is not met since amended claim 1 contains subject-matter which extends beyond the content of the application as filed, contrary to the requirement of Article 123(2) EPC. The reasons are as follows:

1.5.1 The amendment extending beyond the content of the application as filed concerns at least the expression "a selecting unit adapted to (...) decide the predetermined period" in the following feature of claim 1: "a selecting unit adapted to monitor a state of the specimen using said plurality of images stored transiently and decide the predetermined period to select the image group based on a result of the monitoring".

1.5.2 According to the applicant, the basis for this feature was to be found in paragraphs [0055], [0056] and [0058] of the application as filed, in combination with figures 4A, 5A and 5C, showing the concept of "time clipping" (figure 4A), boxes for entering the start time and the end time of time clipping (figure 5A) and the marking button 57 (figure 5C).

More precisely, paragraph [0058] disclosed that "[t]ime clipping may be performed automatically" and that "processing similar to that by the marking button 57 explained in (1) - [1] may be performed based on a monitoring result". In the manual method, described in paragraphs [0055] and [0056], "the user may specify a desired time by selecting the marking button 57 via the input device 180 during the period of time-lapse photography and after the time-lapse photography is finished". As shown in figures 4A, 5A and 5C, the marking button 57 enabled the user to specify a period, called "time clipping" in figure 4A, among the period of time-lapse photography and to have time clipping performed according to the marks generated by the marking button 57. From this disclosure the skilled person would understand that the microscope apparatus of claim 1 comprised selecting means, such as a selecting unit adapted to decide the predetermined period during which the captured images are recorded. The wording "selecting unit" in claim 1 had to be understood as means having no concrete

structural features but merely the function of deciding the predetermined period.

1.5.3 As discussed during the oral proceedings, the board is unable to identify a clear basis for the amended feature "a selecting unit adapted to (...) decide the predetermined period" in the application as filed.

From the passages and figures referred to by the applicant no means for deciding the predetermined period can be deduced. While performing a "processing similar to that by the marking button 57 explained in (1) - [1]" is disclosed in paragraph [0058], it cannot be deduced therefrom that the selecting unit or some other more general functional means decides a predetermined period during which images are to be recorded as an image group.

The term "processing" in paragraph [0058] has a broad meaning covering various aspects of the functioning of the marking button 57 without implying the aspect of making a decision about the predetermined period. The term "similar" broadens even further the exact technical meaning of the term "processing".

The term "decide" in the amended feature of claim 1 generally implies certain process steps to be carried out before a decision can be made, for instance, gathering initial data, evaluating the data gathered, calculating values based on this initial data, comparing the values with predetermined thresholds, making a decision on the basis of the comparison or of other grounds. None of these process steps is defined in paragraph [0058], thereby confirming that the aspect of making a decision about the predetermined period is not unambiguously derivable therefrom. In the manual method described in paragraphs [0053] to [0057] of the application as filed, it would appear that the decision

of determining the predetermined period during which images are to be recorded as an image group is taken by the user. No automatic counterpart of the user's manual decision is disclosed in paragraph [0058].

1.5.4 Claims 2 and 3 as originally filed define a selecting unit. Therefore, these claims may represent a further possible basis for the amended feature of present claim 1. The selecting unit selects images to be recorded from the plurality of images as the image group according to a state change of the specimen (see also paragraphs [0006], [0007], [0010] and [0011] of the description as originally filed).

The applicant submitted that the selecting unit selects images to be recorded during the predetermined period, thereby implicitly deciding the predetermined period as claimed.

The board is not convinced by this reasoning since the selecting unit disclosed in the application as originally filed selects individual images according to a state change. Whether a specific image is selected by the selecting unit to form a predetermined period is not decided by the selecting unit but depends on the specimen's properties and whether its state changes or not.

1.5.5 Thus, neither originally filed paragraphs [0053] to [0058] nor originally filed claims 2 and 3 represent a direct and unambiguous basis for the amended feature of claim 1.

1.6 In conclusion, since claim 1 of the main request is not *prima facie* clearly allowable, the board exercises its discretion under Article 13(1) RPBA 2007 in not admitting the main request into the proceedings.

2. First to third auxiliary requests

The board decides not to admit the first to third auxiliary requests into the proceedings under Article 13(1) RPBA 2007.

2.1 Since all auxiliary requests have been filed shortly before or during the oral proceedings, they represent an amendment of the party's case within the meaning of Article 13(1) RPBA 2007 and may be admitted only at the board's discretion, similarly to the main request (see point 1.3 above).

2.2 Claim 1 of all auxiliary requests contains the same amended feature "a selecting unit adapted to (...) decide the predetermined period" as claim 1 of the main request. The additional amendments of claim 1 of the auxiliary requests with respect to claim 1 of the main request do not modify the meaning of the amended feature such that its basis in the application as originally filed would be modified. Thus, claim 1 of the first to third auxiliary requests is not *prima facie* clearly allowable for the same reasons as those provided for claim 1 of the main request in point 1.5 above.

2.3 Therefore, applying the same criterion for admission of the auxiliary requests as for the main request, the board exercises its discretion under Article 13(1) RPBA 2007 in not admitting any of the auxiliary requests into the proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

M. Kiehl R. Bekkering

Decision electronically authenticated