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**Datasheet for the decision
of 13 January 2020**

Case Number: T 2538/18 - 3.4.02

Application Number: 05027593.2

Publication Number: 1686367

IPC: G01N21/88

Language of the proceedings: EN

Title of invention:

Enhanced video metrology tool

Patent Proprietor:

Mitutoyo Corporation

Opponent:

Carl Zeiss Industrielle Messtechnik GmbH

Relevant legal provisions:

EPC 1973 Art. 113(1)

EPC R. 103(1)(a)

RPBA 2020 Art. 11

Keyword:

Substantial procedural violation (yes)

Remittal of the case and reimbursement of the appeal fee (yes)



Beschwerdekammern

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Case Number: T 2538/18 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 13 January 2020

Appellant: Carl Zeiss Industrielle Messtechnik GmbH
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
27 July 2018 concerning maintenance of the
European Patent No. 1686367 in amended form.**

Composition of the Board:

Chairman R. Bekkering
Members: F. J. Narganes-Quijano
G. Decker

Summary of Facts and Submissions

- I. The appellant (opponent) lodged an appeal against the interlocutory decision of the opposition division finding European patent No. 1686367 as amended according to the then first auxiliary request to meet the requirements of the EPC.

In its decision the opposition division held *inter alia* that the then first auxiliary request complied with the requirements of Articles 123(2), 84 and 54(1) EPC and that, contrary to the submissions of the appellant, the claimed invention involved an inventive step (Article 56 EPC) over the disclosure of documents

E1: "QVPAK - 3D CNC Vision Measuring Machine - User's Guide, Version 7", Manual No. 99MCB225A1", Series No. 359, Mitutoyo Corporation & Micro Encoder Inc., 2003; front page, two bibliographic pages, and pages 3 to 237; and

E2: "AutoCAD 14", W. Sommer *et al.*; Markt und Technik, Buch- und Software-Verlag, 1998; front and back covers, bibliographic page, and pages 6 to 21, 52 to 57, 112 to 129 and 138 to 141.

- II. With the notice of appeal the appellant requested that the decision under appeal be set aside and that the patent be revoked. The appellant also requested oral proceedings as an auxiliary measure.

With the statement setting out the grounds of appeal the appellant submitted *inter alia* that the reasons given by the opposition division in concluding that the subject-matter of claim 1 of the then first auxiliary

request involved an inventive step were based on an objective problem that was formulated for the first time in the contested decision and on which the appellant had no opportunity to comment.

- III. In reply to the statement of grounds of appeal the respondent (patent proprietor) submitted claims according to auxiliary requests I to IV and requested that the appeal be dismissed (main request) or that the patent be maintained on the basis of one of auxiliary requests I to IV. The respondent also requested oral proceedings as an auxiliary measure.
- IV. In a communication pursuant to Rule 100(2) EPC the board informed the parties that in its preliminary opinion the facts submitted by the appellant and relating to the objective problem formulated by the opposition division amounted to a breach of the right to be heard (Article 113(1) EPC 1973) and, in the circumstances of the case, to a substantial procedural violation affecting the entire proceedings. The parties were informed of the board's intention to set aside the decision under appeal, to remit the case to the opposition division pursuant to Article 11 RPBA, and to order the reimbursement of the appeal fee under Rule 103(1)(a) EPC.
- V. In reply to the board's communication both the appellant and the respondent withdrew their respective requests for oral proceedings.
- VI. Claim 1 of the first auxiliary request underlying the decision under appeal and constituting in the present appeal proceedings the respondent's main request reads as follows:

"A method for operating a video tool (143a, 143m) to determine video tool parameters used by the video tool, wherein:

the video tool comprises video tool operations performed to analyze features in a workpiece image, the video tool operations comprise at least one image analysis operation, and at least some of the video tool operations are controlled based on the video tool parameters, the video tool parameters comprising one or more of a region of interest height, a region of interest width, a region of interest angular orientation, a selector location, a scan direction, a sampling direction, a circle or arc edge point, and an arc end point;

the video tool further comprises a video tool graphical user interface (GUI) (300) including a plurality of displayable parameter indicators (350B, 370, 342, 385, 360; 550I, 550E, 570, 542, 585, 560; 750I, 750E, 770, 742, 785, 760; 850, 870; 950R, 950L) corresponding to video tool parameters, wherein at least some of the parameter indicators may be added to modify a display of the video tool GUI, and at least some of the parameter indicators may be adjusted in the display of the video tool GUI, and at least some of the parameter indicators may be anchored in the display of the video tool GUI; and

the video tool is included in a machine vision inspection system (100), the machine vision inspection system comprising a camera portion (260) usable to provide the workpiece image, which is an actual image of a particular portion of a workpiece (20) that is to be inspected, a control system portion (120) that includes the video tool, and a display portion (136) usable to display the workpiece image and the video tool GUI overlaying the workpiece image,

the method comprising:

(a) displaying the video tool GUI and a cursor overlaying a workpiece image after a user selects the video tool, wherein the user may position the cursor at a desired position (1110-1114);

(b) determining a plurality of video tool parameters that are controlled by the user placing a plurality of respective placed points (1, 2, 3) at respective desired positions (330, 340, 380'; 530, 540, 580; 730, 740, 780; 830, 840, 880; 930, 940, 980) while the video tool GUI is displayed (1116, 1122, 1154, 1158); and operations comprising at least one of:

(c) for at least one respective time when the user places a respective placed point, performing video tool operations comprising automatically linking and displaying at least one newly-linked parameter indicator that is dynamically adjusted based on the cursor position as the cursor is moved away from that respective placed point (1116-1118, 1122-1150), without requiring the user to take or maintain any special action to dynamically adjust the newly-linked parameter indicator, including not requiring the user to continue to depress or hold down an input device button to drag the newly-linked parameter indicator, and

(d) the user placing a sequence of respective placed points in step (b), comprising the user placing each respective placed point using the same point-placing operation, modifying the parameter indicators displayed in the video tool GUI at respective times based on the user placing the respective placed points of the sequence (1116, 1122, 1154), and before the user places a final respective placed point that is the last respective placed point added to the sequence (1154), performing video tool operations comprising automatically linking a plurality of different types of parameter indicators (350B-sides, 385, 370; 550I, 550E, 585, 570; 750I, 750E, 770, 785; 850-right-side, 850-

bottom-side; 950L, 950R) to be dynamically adjusted at the same time (1150) based on the position of the cursor without requiring the user to take or maintain any special action to dynamically adjust the newly-linked parameter indicator, including not requiring the user to continue to depress or hold down an input device button to drag the newly-linked parameter indicator." [*underlining added by the board*].

Reasons for the Decision

1. The appeal is admissible.
2. *Substantial procedural violation*
 - 2.1 In the interlocutory decision under appeal the opposition division held that the patent amended according to the first auxiliary request then on file - i.e. to the present main request underlying the respondent's request for dismissal of the appeal - met the requirements of the EPC, and in particular that the subject-matter of claim 1 of the mentioned request involved an inventive step (Article 56 EPC) over documents E1 and E2 (reasons for the decision, pages 9 to 11).

In respect of the issue of inventive step the opposition division first noted in its decision (reasons for the decision, page 9, third paragraph from the bottom, to page 10, last paragraph) that

- both the appellant and the respondent considered document E1 to represent the closest state of the art;

- while the appellant considered that the automatic linking of the parameter indicators was already disclosed in document E1 and the method of claim 1 differed from document E1 only in the features added to the method steps "(c)" and "(d)" of claim 1 as granted and shown underlined in the text of claim 1 in point VI above and relating to how the user inputs the instructions, the respondent considered that claim 1 further differed from document E1 in the automatic linking of the parameters indicators specified in both steps "(c)" and "(d)" of the claim; and

- while the appellant considered that the effect of the distinguishing features (helping the user to learn the operations more quickly and to avoid an unsuitable ergonomic state by associating one type of operation with one function) was not technical and the mentioned features solved the non-technical problem of how to input instructions in a convenient manner and, alternatively, that it would be obvious for the skilled person to replace the "drag&draw" operation of document E1 by the "same point-placing operation" proposed in document E2 as one of different possibilities of drawing a rectangle for the automatic edge detection, the respondent considered that the claimed invention solved the technical problem of allowing the user to individually customise the parameters in a more convenient manner (see also minutes of the first-instance oral proceedings, page 4, sixth paragraph), that the skilled person had no incentive to consult document E2 for different types of point-placing operations, and that the combination of documents E1 and E2 would not result in the automatic linking of the parameter indicators as claimed.

In view of these considerations, the opposition division then held (reasons for the decision, page 11,

first paragraph) that "with regard to the definition of the objective problem to be solved, next to the non-technical elements, like ease of learning and avoidance of unsuitable ergonomic state, the replacement of the 'drag&draw' operation by placing each respective placed point using the same point-placing operation, also solves a technical problem of the operation to be reliable, because 'a button need not be held in an unstable state', which is mentioned on page 13, line 8, of the description as originally filed" [*emphasis added by the board*].

The opposition division then concluded (reasons for the decision, page 11, second paragraph) that "[t]his technical problem is not addressed in E1 or E2. Furthermore, the combination of the features disclosed in E1 and E2 is not a simple replacement of the method steps disclosed in E1 by one of the specific method steps disclosed in E2, but would require further modifications by introducing automatic linking of the parameter indicators. Such modifications are considered to be not obvious for the person skilled in the art."

2.2 The board first notes that in its decision the opposition division found that the method of claim 1 was new over document E1 by virtue of the claim requiring at least one of features "(c)" and "(d)" (reasons for the decision, page 9), without however addressing explicitly the issue raised by the parties relating to the question of whether or not document E1 disclosed the automatic linking of the parameters indicators specified in both steps "(c)" and "(d)" of claim 1 (see point 2.1 above, second paragraph, second sub-paragraph). As a consequence, the decision fails to clearly identify the claimed features that would distinguish in the opposition division's

view the claimed method from the method disclosed in document E1 and on which the opposition division based its formulation of the objective problem.

- 2.3 In addition, the opposition division's reasoning of inventive step is based on "the operation to be reliable" as the objective technical problem solved by the claimed method. However, there is no record in the file that this formulation of the objective technical problem had previously been communicated to the parties, with the consequence that - as submitted by the appellant in the statement of grounds of appeal - the parties had had no opportunity to comment on it. In particular, the objective problem formulated by the opposition division is different from that formulated by the respondent (allowing the user to individually customise the parameters in a more convenient manner), and also from the objective problem formulated by the appellant (how to input instructions in a convenient manner), this problem being, in addition, non-technical according to the appellant's submissions.

Furthermore, the opposition division's reasoning of inventive step primarily relied on its finding that "[t]his technical problem is not addressed in E1 or E2" (see point 2.1 above, last paragraph) and therefore on the specific objective technical problem formulated by the opposition division. The opposition division also stated that the combination of documents E1 and E2 would, beyond a simple replacement of steps, also require modifications by introducing automatic linking of the parameters indicators and that these modifications would not be obvious for the person skilled in the art (see point 2.1 above, last paragraph). However, this statement is, in its context, a subsidiary argument of inventive step. It is also

noted that the question of the extent to which the skilled person would consider modifications and, if so, the further question of whether they would be in a position to carry out the appropriate modifications generally depend on the objective technical problem under consideration. For this reason, the specific objective problem formulated by the opposition division was also essential for the subsidiary argument.

In view of these considerations, the board is of the opinion that the decision of the opposition division in respect of the first auxiliary request then on file and now main request was based on grounds on which the parties, and in particular the appellant, had had no opportunity to comment, and that this amounts to a breach of the right to be heard (Article 113(1) EPC 1973) and, in the circumstances of the case, to a substantial procedural violation affecting the entire proceedings.

3. In view of the substantial procedural violation mentioned above, the board considers it appropriate to set aside the decision under appeal, to remit the case to the opposition division pursuant to Article 11 RPBA 2020 (OJ EPO 2019, A63), and to order the reimbursement of the appeal fee under Rule 103(1)(a) EPC. Upon remittal the appellant and the respondent will have the opportunity to have their respective requests considered by the opposition division.

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 for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:



S. Sánchez Chiquero

R. Bekkering

Decision electronically authenticated