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**Datasheet for the decision
of 23 April 2024**

Case Number: T 0974/21 - 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 Art. 54(1), 56, 100(c), 123(2)
RPBA Art. 12(1) (2007)
RPBA 2020 Art. 12(1), 12(2)

Keyword:
Consideration of objections of added-subject-matter (yes)
Added subject-matter (no)
Novelty and inventive step (yes)

Decisions cited:

T 0740/93, T 0742/04, T 1958/13, T 0478/17, T 2538/18



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Case Number: T 0974/21 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 23 April 2024

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
13 April 2021 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 dated 13 April 2021 finding European patent No. 1686367 as amended according to the main request to comply with the requirements of the EPC.

The opposition filed by the appellant against the patent as a whole was based on the grounds for opposition of added subject-matter (Article 100(c) EPC) and of lack of novelty and of inventive step (Article 100(a) together with Articles 52(1), 54(1) and 56 EPC).

In a first interlocutory decision dated 27 July 2018, the opposition division had maintained the patent in amended form on the basis of the then first auxiliary request. In the subsequent appeal proceedings T 2538/18 concerning the opponent's appeal, the board set the decision under appeal aside and remitted the case to the opposition division for further prosecution.

- II. The following documents cited during the first-instance proceedings were considered in the present appeal:

- E1: "QVPAK V7 - 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 239
- E2: "AutoCAD 14 - Markt & Technik", W. Sommer et al.; Buch- und Software-Verl., Haar, 1998; front

and back covers, bibliographic page, and pages 6 to 21, 52 to 57, 112 to 129 and 138 to 141.

- III. In the decision under appeal the opposition division held *inter alia* that the patent as amended according to the main request complied with Article 123(2) EPC and that the claimed subject-matter was new and involved an inventive step over documents E1 and E2 (Articles 54(1) and 56 EPC).
- IV. With its letter dated 5 January 2022 submitted in reply to the statement of grounds of appeal the respondent (patent proprietor) filed claims according to auxiliary requests I to IV.
- V. Oral proceedings before the board were held on 23 April 2024.

The appellant requested that the decision under appeal be set aside and that the European patent be revoked.

The respondent requested as a main request that the appeal be dismissed, i.e. that the patent be maintained in amended form as found allowable by the opposition division. Alternatively, the respondent requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the claims according to one of auxiliary requests I to IV, all filed with the letter dated 5 January 2022.

At the end of the oral proceedings the chairman announced the decision of the board.

- VI. Claim 1 of the main request - with the feature labelling 1 to 13, 13a, 14, 14a, 14 cont. and 14b in

square brackets used during the proceedings being inserted therein by the board - reads as follows:

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

[2] the video tool comprises video tool operations performed to analyze features in a workpiece image, [3] the video tool operations comprise at least one image analysis operation, and [4] at least some of the video tool operations are controlled based on the video tool parameters, [5] 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;

[6] 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, [7] wherein at least some of the parameter indicators may be added to modify a display of the video tool GUI, and [8] at least some of the parameter indicators may be adjusted in the display of the video tool GUI, and [9] at least some of the parameter indicators may be anchored in the display of the video tool GUI; and

[10] 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:

[11] (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);

[12] (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:

[13] (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),

[13a] 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

[14] (d) the user placing a sequence of respective placed points in step (b),

[14a] comprising the user placing each respective placed point using the same point-placing operation,

[14 cont.] 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

[14b] 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."

The claims of the main request also include dependent claims 2 to 18 all referring back to claim 1.

Reasons for the Decision

1. The appeal is admissible.
2. *Main request - Consideration of the objections under Article 123(2) EPC*
 - 2.1 In the decision under appeal the opposition division stated that the appellant had no objections under Article 123(2) EPC in respect of the main request and held that the patent as amended according to the main request complied with the requirements of Article 123(2) EPC.

With the statement setting out the grounds of appeal the appellant contested the opposition division's assertion in this respect and submitted that the objections first raised under Article 100(c) EPC in respect of the patent as granted and then under Article 123(2) EPC in respect of the previous first auxiliary request - and now main request - during the opposition proceedings leading to the previous opposition division's decision dated 27 July 2018 had at no time been withdrawn and had been maintained in the statement of grounds of appeal submitted in the appeal against the mentioned decision (appeal proceedings T 2538/18). Therefore, the mentioned objections were not mentioned in the decision now under appeal, but they were still the subject of the present proceedings because the first appeal was still not decided upon in respect of the substantive issues and the mentioned objections had never been withdrawn.

The respondent submitted that the mentioned objections of added subject-matter were raised for the first time with respect to the amended claims in the statement of grounds of the first appeal and that this matter, as stated by the opposition division in the second oral proceedings, was already decided upon by the opposition division during the first first-instance oral proceedings. Since there was no appeal in respect of the refusal of the then main request (patent as granted) and no objection of added subject-matter was raised during the first oral proceedings with respect to the then first auxiliary and now main request, this matter was precluded from forming part of the appellant's case in the present appeal (Article 12(2) RPBA 2020). In any case, the objections had not been raised after the remittal of the case to the opposition

division and in particular during the second first-instance oral proceedings.

2.2 The relevant facts for the issue under consideration can be summarised as follows:

In the opposition division's decision dated 27 July 2018 (in the following "the first decision"), the opposition division

i-a) held that, while features 4 and 5 of claim 1 of the patent as granted (i.e. of the then main request) did - contrary to the appellant's submissions - not constitute added subject-matter within the meaning of Article 100(c) EPC, feature 14 of claim 1 as granted was not directly and unambiguously derivable from the application as filed and that for this reason the ground for opposition under Article 100(c) EPC prejudiced the maintenance of the patent as granted;

i-b) stated - as confirmed by the minutes of the oral proceedings held on 29 June 2018, see page 3, penultimate paragraph: "The Opponent states that he has no objections under Article 123(2) EPC." - that the appellant had no objection under Article 123(2) EPC in respect of the first auxiliary request and concluded that this request met the requirements of Article 123(2) EPC (reasons for the decision, page 8, section "Article 123(2) EPC");

i-c) held that the subject-matter of claim 1 of the first auxiliary request involved an inventive step; and

i-d) concluded that the patent as amended according to the first auxiliary request complied with the requirements of the EPC.

The appellant lodged an appeal against the first decision of the opposition division and in these appeal proceedings (in the following "the first appeal")

ii-a) the appellant submitted with the statement of grounds of appeal that claim 1 of the first auxiliary request did not comply with the requirements of Article 123(2) EPC in view of the features corresponding to features 4 and 5 of claim 1 as granted, and that the opposition division's conclusion that the subject-matter of claim 1 of the first auxiliary request involved an inventive step was based on grounds on which the appellant had no opportunity to comment; and

ii-b) the board concluded that the decision under appeal was tainted by a substantial procedural violation in respect of the opposition division's assessment of the issue of inventive step and issued a decision (decision T 2538/18) setting aside the decision and remitting the case to the department of first instance for further prosecution.

During the subsequent first-instance proceedings

iii-a) the opposition division issued summons to oral proceedings and in the communication annexed to the summons the opposition division expressed its preliminary view on the issue of inventive step of claim 1 of the first auxiliary request;

iii-b) during the subsequent oral proceedings the first auxiliary request became the main request, the "Chairperson observe[d] that the outstanding point to be addressed is the presence of an inventive step as required by Article 52(1) / Article 56 EPC" (minutes, page 1, fifth paragraph) and, after the parties had been informed of the opposition division's conclusion that the subject matter of claim 1 of the main request involved an inventive step, both parties were asked whether they had "any further remarks or comments" or "any further requests", and they replied in the

negative (see minutes, page 5, first and second paragraphs: "*quod non*"); and

iii-c) in the opposition division's decision subject of the present appeal the opposition division stated that "[t]he opponent had no objections under Article 123(2) EPC" (reasons, point 3, first paragraph) and held *inter alia* that the main request complied with the requirements of Article 123(2) EPC (reasons, point 3, second paragraph) and of Article 56 EPC (reasons, point 7).

2.3 The board first notes that the objections under Article 123(2) EPC under consideration (i.e. the objections of added subject-matter raised in respect of features 4 and 5 of claim 1 of the present main request) were first raised under Article 100(c) EPC in respect of the corresponding features of claim 1 of the patent as granted and that the opposition division held that these objections were not persuasive. During the corresponding oral proceedings the then first auxiliary request was discussed and the appellant stated that "he ha[d] no objections under Article 123(2) EPC" (point 2.2 above, paragraph i-b)). Subsequently, only the opponent filed an appeal (the first appeal) and in the statement of grounds of appeal the appellant raised the objections under Article 123(2) EPC under consideration in respect of claim 1 amended according to the first auxiliary request (paragraph ii-a) above).

2.3.1 The question arises in this context whether these objections are to be considered new objections raised for the first time in respect of the then first auxiliary request with the statement of grounds of appeal of the first appeal or whether, on the contrary, these objections previously raised in respect of the

patent as granted had been maintained in respect of the then first auxiliary request.

The board first notes that the mentioned objections raised in respect of claim 1 as granted applied, by their very nature, also to the unamended features 4 and 5 of claim 1 of the first auxiliary request and that there is no record that the appellant had explicitly withdrawn these objections in respect of the first auxiliary request. In addition, the appellant's statement during the first oral proceedings that "he ha[d] no objections under Article 123(2) EPC" was in the board's view to be interpreted in its specific context only in the sense that the appellant had no further, additional objection of added subject-matter - in particular, no objection in respect of the substantive amendments made to claim 1 of the first auxiliary request and directed to overcome the objection raised under Article 100(c) EPC in respect of feature 14 of claim 1 as granted (see paragraph i-a) above) -, and not in the sense that the appellant had implicitly withdrawn in respect of the first auxiliary request the objections raised under Article 100(c) EPC in respect of features 4 and 5 of claim 1 as granted.

Therefore, in the board's view the objections of added subject-matter initially raised under Article 100(c) EPC in respect of features 4 and 5 of claim 1 as granted were, in its specific context, implicitly maintained as objections under Article 123(2) EPC in respect of the corresponding features of amended claim 1 and, consequently, these objections constituted part of the appellant's case in the first appeal under Article 12(1) RPBA 2007.

2.3.2 The board also notes that the first decision of the opposition division was set aside in decision T 2538/18 (paragraph ii-b) above), with the consequence that it was - save for issues such as that relating to the prohibition of *reformatio in peius* in view of the opponent being the sole appellant - no longer legally effective. In addition, neither the procedural status nor the substance of the appellant's objections under Article 123(2) EPC were addressed in decision T 2538/18 (see paragraph ii-b) above), so that there was no issue decided by the board and relating to these objections that would have triggered any binding effect of the decision in the subsequent proceedings. In addition, the board ordered the remittal of the case for further prosecution, and the further proceedings after the remittal were therefore to be regarded as a continuation of the original opposition proceedings (see, for instance, decision T 742/04, point 3 of the reasons, second paragraph, and decisions cited therein) taking into account, in addition, the parties' submissions during the first appeal, and in particular the appellant's submissions in the statement of grounds of appeal (see, for instance, decision T 740/93, point 5.2, second paragraph, and point 5.4, second paragraph).

In the present case, however, the opposition division, instead of addressing the mentioned objections under Article 123(2) EPC - and, in particular, addressing any possible doubt on the procedural status of the objections, see point 2.3.1 above, first paragraph - or at least inviting the parties to clarify whether their submissions made during the preceding appeal proceedings were maintained, only addressed in the communication annexed to the summons and also during the oral proceedings the issue of inventive step (see

paragraphs iii-a) and iii-b) above) and omitted consideration, during the subsequent first-instance proceedings and also in the decision presently under appeal, of the objections raised by the appellant under Article 123(2) EPC in the statement of grounds of appeal of the first appeal. The board also notes that there is no record in the file that the appellant had withdrawn the mentioned objections under Article 123(2) EPC in the subsequent first-instance proceedings, and the mere fact that the appellant stated at the end of the second of the first-instance oral proceedings that they had no "further remarks or comments" (see paragraph iii-b) above) cannot be interpreted as an implicit withdrawal of objections previously raised in the statement of grounds of appeal of the first appeal and not addressed during the second oral proceedings.

It is also noted in this respect that the appellant could - and should - during the written proceedings, in particular in reply to the opposition division's communication annexed to the summons to oral proceedings (see paragraph iii-a) above), or during the oral proceedings, and at the latest at the end of the same (see paragraph iii-b) above), have drawn the attention of the opposition division to the pending objections under Article 123(2) EPC, and there is no record in the file that the appellant would have reacted in this way. In the statement of grounds of appeal the appellant submitted that during the second oral proceedings the opposition division stated that the sole issue to be decided was the question of inventive step because the objections under Articles 100(c) EPC and 123(2) EPC were already decided in the first of the first-instance oral proceedings and the remittal of the case had no effect in the corresponding decision as the substantial procedural

violation addressed by the board in decision T 2538/18 only concerned the issue of inventive step and this decision only addressed this issue. However, the board notes that the opposition division observed during the mentioned oral proceedings that "the outstanding point to be addressed [was] the presence of an inventive step" (see paragraph iii-b) above), and that neither this statement alone, nor any other element in the minutes or in the file supports the opposition division's statements reported by the appellant. In addition, there is no record in the file that the appellant would have requested correction of the minutes to reflect the opposition division's statements mentioned by the appellant.

In any case, the opposition division's statements alleged by the appellant would not be correct at least in that the objections raised under Article 123(2) EPC in respect of the then first auxiliary request could not be merely regarded as objections already decided upon and in that, as a consequence of the first decision being set aside and being no longer legally effective (see point 2.3.2 above, first paragraph), the opposition division's interlocutory decision maintaining the patent as amended according to the present main request required a decision on each of the objections raised by the appellant against this request.

The board also notes that - irrespective of whether the appellant was misled by the alleged statements of the opposition division - it would have been incumbent upon the appellant to draw the attention of the opposition division to all these issues, and that there is no record in the file that they did so.

Nevertheless, the board considers that the objections referred to in point 2.3.1 above, last paragraph, and constituting part of the appellant's case in the first appeal under Article 12(1) RPBA 2007 were subsequently implicitly maintained in the second first-instance proceedings and that at no point of the entire proceedings these objections were withdrawn by the appellant. In addition, the opposition division should have addressed these objections in the decision presently under appeal.

- 2.4 As regards the respondent's submissions relating to Article 12(2) RPBA 2020 (see point 2.1 above, last paragraph), the board notes that the decision presently under appeal is, indeed, not explicitly based on the appellant's objections under Article 123(2) EPC within the meaning of Article 12(2) RPBA 2020. However, it cannot be ignored that, as concluded in point 2.3.2 above, last paragraph, these objections constituted part of the appellant's case during the entire first-instance proceedings and that the opposition division inappropriately disregarded consideration of these objections. Therefore, the objections under Article 123(2) EPC under consideration constitute in the specific circumstances of the case part of the appellant's appeal case to be considered in the present appeal proceedings (Article 12(1) RPBA 2007 and Article 12(1) RPBA 2020).

3. *Main request - Objections under Article 123(2) EPC*

- 3.1 The appellant submitted that the expression "at least some" of feature 4 of claim 1 of the main request ("at least some of the video tool parameters are controlled based on the video tool parameters") resulted in this feature extending beyond the content of the application

as filed (Article 123(2) EPC) because the feature encompassed video tool operations that were not controlled based on video tool parameters and there was no basis in the application as filed for video tool operations not controlled based on video tool parameters.

- 3.1.1 The board notes, however, that according to claim 1 the video tool is not only operated "to analyze features in a workpiece image" (feature 2), but also "to determine video tool parameters used by the video tool" (feature 1). Therefore, the "video tool operations" referred to in feature 4 do not only "comprise at least one image analysis operation" as specified in feature 3, but also operations relating to the determination of video tool parameters used by the video tool when performing, for instance, image analysis operations. It follows that these operations relating to the determination of video tool parameters also constitute "video tool operations" within the meaning of claim 1 as explicitly recited in claim 1, see features "(c)" and "(d)" of claim 1 both involving "performing video tool operations ..." in the context of the determination of video tool parameters. In addition, the corresponding feature "(c)" of claim 1 of the application as filed also specifies "performing video tool operations" relating to the determination of video tool parameters, and these video tool operations are performed to determine video tool parameters, without them being required to be controlled based on video tool parameters (see claim 1 as originally filed). Therefore, the application as filed discloses video tool operations that are controlled based on the video tool parameters and also video tool operations that are not required to be controlled based on video tool parameters.

3.1.2 During the oral proceedings the appellant submitted that the expression "at least some of the video tool operations" encompassed "all the video tool operations", contrary to the argumentation in point 3.1.1 above that there were video tool operations not controlled based on the video tool parameters.

The respondent submitted that this argument was presented for the first time during the oral proceedings before the board and requested that it not be admitted into the proceedings.

The board notes that the expression "at least some" of claim 1 encompasses "all", but that "all" is not disclosed in individualised form by the generic expression "at least some". In addition, the skilled person would not interpret the expression "at least some" in the specific context of claim 1 as possibly including all possible video tool operations because, as already noted in point 3.1.1 above, at least the video tool operations defined in features (c) and (d) of claim 1 in the context of the determination of video tool parameters are not required to be controlled based on the video tool parameters. Therefore, the appellant's argument - to the extent that it only constituted a counter-argument (in which case its consideration would not be at the board's discretion) or was otherwise to be admitted by the board under Article 13(1) RPBA and/or 13(2) RPBA 2020 - is not persuasive. In these circumstances, the respondent's request not to admit the argument into the proceedings can be left undecided.

3.1.3 For these reasons, the board is of the opinion that feature 4 of claim 1 of the main request does not extend beyond the content of the application as filed.

3.2 The appellant submitted that the expression "one or more" of feature 5 of claim 1 of the main request ("the video tool parameter comprising one or more of ...") constituted an unallowable intermediate generalisation of the content of the application as filed (Article 123 (2) EPC). The appellant referred to Fig. 12A and 12B of the application as filed and submitted that there was no disclosure in the application as filed of embodiments involving only one of the parameters shown in Fig. 12A and 12B, while omitting the remaining parameters.

3.2.1 During the oral proceedings the appellant also noted in respect of the "one set of exemplary embodiments" referred to in the description of Fig. 12A and 12B on page 29, lines 24 to 27, of the application as filed that according to general dictionaries a "set" is a group of elements sharing a common property, so that the application as filed only disclosed one set of parameters bound together, and that the objected expression "one or more" involved a selection of the parameters shown in Fig. 12A and 12B which was not directly and unambiguously derivable from the content of the application as filed.

The respondent submitted that these submissions of the appellant constituted a new argument based on the reference to unspecified dictionaries and requested that it not be admitted into the proceedings.

3.2.2 The board, however, is not convinced by the appellant's arguments. It is noted that the application as filed

discloses different independent video tool parameters (Fig. 3 to 9 together with the corresponding description) and that the chart represented in Fig. 12A and 12B of the application as filed only constitutes an example of a possible combination of video tool parameters, see "FIGURES 12A and 12B are diagrams of a chart 1400 that illustrates one set of exemplary embodiments of how the determination of various video tool parameters may ..." on page 29, lines 24 to 27 (emphasis added by the board). The skilled person would therefore understand that the specific set of tool parameters disclosed in Fig. 12A and 12B is not an indissociable group of tool parameters. On the contrary, the skilled person would understand in the technical context of the application as filed (see, in particular, page 3, lines 17 to 21: "Video tool parameters, for example for an edge-detection video tool, may include a region of interest [...], a scan direction, and other parameters [...].") that different video tool operations controlled on the basis of video tool parameters would require, depending on the characteristics of each video tool operation, a specific one or specific ones, but not necessarily all possible video tool parameters mentioned in the application as filed, and in particular not all - i.e. not the entire set of - the video tool parameters shown in Fig. 12A and 12B.

Therefore, in the board's view the claimed feature relating to "the video tool parameters comprising one or more of" the list of parameters defined in feature 5 does not constitute an unallowable intermediate generalisation of the content of the application as filed. It also follows from the above considerations that the question of the admittance into the

proceedings of the appellant's submissions mentioned in point 3.2.1 above can be left undecided.

3.3 In view of the considerations in points 3.1 and 3.2 above, the board concludes that the patent as amended according to the main request meets the requirements of Article 123(2) EPC.

4. *Main request - Novelty*

The opposition division concluded in its decision that the method defined in the claims of the main request is new over the prior art, and in particular over document E1, and this conclusion has not been disputed by the appellant. The board is satisfied that the subject-matter of claims 1 to 18 of the present main request is new within the meaning of Articles 52(1) and 54(1) EPC.

5. *Main request - Inventive step*

5.1 The appellant contested the opposition division's view that the method of claim 1 involved an inventive step over document E1 as closest prior art in combination with the common general knowledge exemplified by document E2.

5.2 Distinguishing features over document E1

The method defined in claim 1 comprises two variants "(c)" and "(d)" (see "[...] and operations comprising at least one of (c) [...] and (d) [...]"). In its decision the opposition division concurred with the respondent that the distinguishing features of claim 1 over document E1 were constituted by both variants "(c)" (i.e. the combination of features 13 and 13a) and "d" (i.e. the combination of features 14, 14a and 14b).

The appellant disputed the opposition division's view in this respect and submitted that feature 13 of variant "(c)" and feature 14 of variant "(d)" were also disclosed in document E1.

The board notes, on the one hand, that each of features 13 and 14 taken in isolation - in particular, when read independently of the respective features 13a and 14b - are disclosed in document E1. In particular, the drag-and-draw operation disclosed in document E1, page 170, table, entry "Box, Minimum, Maximum", involves first placing a starting point which automatically becomes a box corner and then automatically adjusting a different parameter, i.e. a scanning direction, according to the drag direction of the cursor, and this automatic setting or adjustment of parameters according to the position of the cursor falls in the board's view within the general meaning of the "automatic linking" defined in each of features 13 and 14. The respondent's submissions that features 13 and 14 were new over document E1 in view of the way the automatic linking was specifically performed as disclosed in the description of the patent specification (see, in particular, Fig. 3A to 3C and the corresponding description) cannot be followed by the board because they are based not on features 13 and 14 of claim 1, but on a specific interpretation of the automatic linking process of each of features 13 and 14 on the basis of the passage in paragraph [0033] of the patent specification, and this passage expressly involves and requires restrictions only reflected in features 13a and 14b of claim 1, and not in features 13 and 14 when read independently of features 13a and 14b, respectively.

On the other hand, features 13a and features 14a and 14b impose - as noted by the opposition division in its decision - restrictions on how the operations respectively defined in features 13 and 14 are performed, and therefore they are inextricably linked to features 13 and 14, respectively. For this reason, the assessment of the issue of inventive step of the claimed method is to be carried out not on the basis of feature 13a and/or of features 14a and 14b taken in isolation, but on the basis of feature 13a in the specific context of feature 13 and on the basis of features 14a and 14b in the specific context of feature 14.

5.3 Technical effect - Objective technical problem

5.3.1 In its decision the opposition division held that the technical effect achieved by each of the combination of features 13 and 13a and the combination of features 14, 14a and 14b was that moving a mouse - or an analogous input device - without having to hold down a mouse button in a depressed position as it was required in the drag-and-draw operation of document E1 (page 170, section "Manually drawing edge detection tools", items 3 to 6, together with the entry "Box, Minimum, Maximum" in the table on page 170 and the figure on page 169) was more stable and as such improved the accuracy and/or precision of the input, thereby improving the reliability of the method of operation of the video tool. The opposition division concluded that the objective technical problem resided in the improvement of the reliability of the method for operating the video tool.

The appellant disputed the opposition division's view in this respect and submitted that feature 13a and also

features 14a and 14b related to the use of the video tools with several separate mouse clicks instead of the drag-and-draw operation of document E1 and that the technical effect resided only in providing an alternative form of user input for defining the video tool parameters. There was no need to address whether this alternative form of user input was more convenient or reliable because the patent did not provide any evidence in this respect and the operation of the system remained the same. Therefore, the objective technical problem was to be seen in the provision of a method for operating a video tool with an alternative form of user input.

- 5.3.2 The board, however, is not persuaded by the appellant's submissions in this respect. As noted by the respondent, the patent specification discloses that the operations and, in particular, the "automatically linking" processes respectively defined in features 13 and 14 are respectively improved by features 13a and by features 14a and 14b in that "a button need not be held in an unstable state" (paragraph [0034], in particular column 11, lines 33 to 41). The drag-and-draw operations of document E1 require, among other operations, holding a button while dragging, in particular for determining a scanning direction (point 5.2 above, second paragraph), and the improvement mentioned in the patent specification results in the technical effect of improving the reliability of the method for operating the video tool of document E1 as held by the opposition division in its decision. In the board's view, the higher the number of the "plurality respective placed points" to be placed for carrying out the determination of the corresponding video tool parameters (feature "(b)" of claim 1), the more apparent the mentioned technical

effect will be. Therefore, the objective technical problem formulated by the opposition division is supported by, and derivable from the patent specification. The board also notes in this respect that according to the established case law there is no need for the objective technical problem to be explicitly disclosed in the patent specification, it being foreshadowed therein is sufficient (see for instance decision T 478/17, point 3.5.3 of the reasons).

Furthermore, the appellant's submissions relating to feature 13a and features 14a and 14b merely providing an alternative to the drag-and-draw operation of document E1 are based on an undue isolated consideration of these features taken out of the specific context of the claimed method, see in this respect the comments in point 5.2 above, last paragraph.

In addition, in the board's view the assessment above is not at variance with decision T 1958/13 cited by the appellant in support of its case. This decision addressed the replacement of a drag gesture on a touch-screen display of a terminal for controlling a function of the controller of the terminal by a different drag gesture, and the corresponding board considered that the objective technical problem solved by the mentioned replacement of the drag gesture could only be seen as the implementation of an alternative direction-sensitive gesture because a series of effects submitted by the appellant were to be considered technical but they could not be regarded as objectively credible technical effects (reasons for the mentioned decision, points 2.2.3 to 2.2.6). In the present case, however, the restrictions imposed by feature 13a and feature 14b

to feature 13 and to feature 14, respectively, do not constitute a mere replacement of gestures when compared with the drag-and-draw operations of document E1, but omits a physical action on a device (holding down a mouse button during dragging) required by the drag-and-draw operations of document E1. In addition, in the board's view the improved reliability of the claimed method mentioned above constitutes - contrary to the case in the mentioned decision - an objectively credible technical effect.

5.3.3 Therefore, in the board's opinion the objective technical problem solved by the claimed method resides in the improvement of the reliability of the method for operating the video tool of document E1.

5.4 Inventive step

The appellant referred to document E2 as exemplifying the common general knowledge relating to the configuration of graphical elements such as a box or a circle using individual clicks (E2, page 57, section 1.13.2) as an alternative to the use of a drag-and-draw operation (pages 123 and 124, section 3.3, and page 139, section "Ausführung: Befehl Rechteck"). The appellant submitted that feature 13a and also features 14a and 14b were rendered obvious by this common general knowledge.

However, in the board's opinion the claimed invention goes, contrary to the appellant's submissions, beyond a mere replacement of a drag-and-draw operation by a multi-click operation and also beyond a mere use of multi-click operations for defining graphical elements in a display (see comments in point 5.2 above, last paragraph). In addition, the common general knowledge

mentioned by the appellant and exemplified by document E2 does not contain any hint towards a solution to the objective technical problem formulated in the specific technical context of document E1. It is noted in this respect that document E2 discloses the use of a multi-click operation with a mouse in the context of drawing geometrical shapes (page 113) such as circles (pages 123 and 124) and rectangular boxes (page 139 and 140) in a display and determining the geometrical coordinates of specific points of the geometrical shape (page 57, last paragraph), but that the document is silent as to the reliability of the multi-click operations, in particular in a context such as that of document E1 in which rectangular boxes and circles are drawn not merely for determining geometrical coordinates of specific points of boxes and circles, but for simultaneously determining other additional parameters unconnected with the geometrical shape of the boxes as such, such as the determination - or, in the language of claim 1, the "automatic linking" - of a scanning orientation during the drag operation of the drag-and-draw operation (document E1, page 170, entries "Box, Minimum, Maximum" and "Circle" modes in the table, together with items 3 to 5).

Therefore, the board concurs with the opposition division in that the skilled person confronted with the objective technical problem would not consider the common general knowledge mentioned by the appellant and exemplified in document E2 to be pertinent and in that, in any case, the mentioned common general knowledge, and in particular document E2, would not suggest the skilled person performing the operations of the method of document E1 according to any of the two variants "(c)" and "(d)" defined in the claimed method. More specifically, and as submitted by the respondent, the

"Box" operation of document E1 referred to by the appellant requires that, after a first click with a button of the mouse, the button of the mouse is held depressed while dragging in order to determine or dynamically adjust a parameter (the scanning direction), and there is no counterpart of this operation in the multi-click operations disclosed in document E2.

For these reasons, the board is of the opinion that the subject-matter of claim 1, and therefore also that of dependent claims 2 to 18, is not obvious over documents E1 and E2 (Article 56 EPC).

6. In view of the above considerations, the board concludes that the patent as amended according to the main request and the invention to which it relates meet - as held by the opposition division in the decision under appeal - the requirements of the EPC within the meaning of Article 101(3)(a) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



L. Gabor

R. Bekkering

Decision electronically authenticated