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**D E C I S I O N**  
**of 24 May 1996**

**Case Number:** T 0829/93 - 3.4.2

**Application Number:** 84300452.4

**Publication Number:** 0118980

**IPC:** G02B 6/38

**Language of the proceedings:** EN

**Title of invention:**

Methods of making optical fibre terminations

**Patentee:**

BRITISH TELECOMMUNICATIONS public limited company

**Opponent:**

Philips Electronics N.V.

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 57(1) and 58(2)

**Keyword:**

"Admissibility of amendments to the patent - (no)"

**Decisions cited:**

G 0009/91, G 0009/92, T 0127/85, T 0406/86, T 0295/87

**Catchword:**

The necessity and appropriateness, and thus admissibility of amendments in opposition proceedings is not a question of subjective, but of objective judgment. It was objectively clear that new dependent claims did not have an influence on the characteristics of the invention as specified in Claim 1, and thus were not an adequate response to the attacks of the Opponents on the inventive step of the claimed subject-matter.



Case Number: T 0829/93 - 3.4.2

**D E C I S I O N**  
of the Technical Board of Appeal 3.4.2  
of 24 May 1996

**Appellant:** BRITISH TELECOMMUNICATIONS public limited  
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**Representative:** Roberts, Simon Christopher  
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**Respondent:** Philips Electronics N.V.  
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**Representative:** Pennings, Johannes  
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**Decision under appeal:** Interlocutory decision of the Opposition Division  
of the European Patent Office posted 24 June 1993  
concerning maintenance of European patent  
No. 0 118 980 in amended form.

**Composition of the Board:**

**Chairman:** E. Turrini  
**Members:** W. W. G. Hofmann  
B. J. Schachenmann

## Summary of Facts and Submissions

I. The Appellants (Proprietors of the patent) lodged an appeal against the interlocutory decision of the Opposition Division on the amended form in which the patent No. 0 118 980 (application number 84 300 452.4) can be maintained.

Opposition had been filed against the patent as a whole and based on Article 100(a) EPC.

The Opposition Division had held that, taking into consideration the amendments made by the Proprietors of the patent in their auxiliary request, the patent and the invention to which it relates met the requirements of the EPC. However, the Opposition Division had also held that the main request was not allowable since the documents on which it was based comprised newly introduced dependent claims the filing of which was not relevant or appropriate in the sense of Rules 57(1) and 58(2) EPC, and was thus not admissible.

II. Oral proceedings were held in which, as announced beforehand in writing, the Respondents (Opponents) did not participate. At the end of the oral proceedings, the Appellants requested that the decision under appeal be set aside and

as main request:

that the patent be maintained on the basis of Claims 1 to 9 (designated as "primary request") filed with the letter of 15 January 1991 (letter received on 23 January 1991);

as first auxiliary request:  
that the following point of law be referred to the  
Enlarged Board of Appeal:

"In opposition proceedings, is it permissible to  
replace, add, delete or amend dependent claims (which  
have been opposed) when an independent claim (which has  
also been opposed) is replaced, deleted or amended in  
the first response to an opposition when prior art newly  
cited in the opposition shows that the features of the  
relevant dependent claims do not add patentable subject  
matter to the relevant independent claim?"

as second auxiliary request:  
that the patent be maintained on the basis of Claims 1  
to 5 filed with the letter of 4 November 1993  
(designated as "subsidiary request 1"),

as third auxiliary request:  
that the patent be maintained on the basis of Claims 1  
to 5 filed with the letter of 15 January 1991 (received  
on 23 January 1991) (designated as "subsidiary  
request").

The Respondents did not file a request.

III. The wording of the set of claims according to the main  
request reads as follows:

"1. A method of providing an optical fibre termination  
having a locating surface concentric with the optical  
fibre (1), comprising the steps of inserting a monomode  
optical fibre end (5) into a sleeve member (2) securing  
the optical fibre end within the sleeve member, mounting  
the resulting fibre termination in a clamping device  
(7a, 7b, 8) of a machining tool, the clamping device  
being rotatable with respect to the machining tool,

transmitting light through the fibre core so as to produce a light beam emerging from the core at the fibre end, adjusting the rotatable clamping device until rotation thereof produces a stationary light beam, and machining the locating surface about the axis defined by the stationary light beam whilst the termination is rotating.

2. A method as claimed in claim 1 wherein the machining tool is a precision lathe having a hollow head spindle (9).

3. A method as claimed in claim 2 wherein the hollow head spindle (9) has an internal diameter large enough to permit passage therethrough of said fibre termination.

4. A method as claimed in any one of the preceding claims wherein a former or reel (10) is provided to accept coils of said optical fibre, the former or reel (10) rotating in synchronism with said clamping device (8, 7a, 7b).

5. A method as claimed in claim 4 as dependent on claim 2 or claim 3 wherein said former or reel (10) is mounted on one end of said hollow head spindle (9), said clamping device being mounted on an opposite end of said spindle.

6. A method as claimed in any one of the preceding claims wherein the optical fibre end (5) is secured within the sleeve member (2) by means of a light-curable dental adhesive.

7. A method as claimed in any one of the preceding claims wherein alignment of the optical fibre prior to machining is determined by viewing the light beam end-on

while the termination is rotating, observation of a circle of light indicating a misaligned condition, and observation of a stationary point of light indicating an aligned condition.

8. A method as claimed in any one of the preceding claims wherein the light beam is observed electronically.

9. A method of manufacturing an optical fibre connector which method comprises providing at least one optical fibre termination with a locating surface rendered concentric with the optical fibre (1) by a method according to any one of claims 1 to 8."

Claim 1 according to the second auxiliary request<sup>1</sup> is identical to that of the main request.

The further claims according to this request read as follows:

"2. A method as claimed in claim 1 in which the locating surface is machined to be cylindrical, and wherein the machining tool is a precision lathe having a hollow head spindle (9).

3. A method as claimed in claim 1 or claim 2, in which the sleeve member (2) comprises an optical fibre connector ferrule, and, in the case that the machining tool is a precision lathe having a hollow spindle, the hollow spindle having an internal diameter large enough to permit passage therethrough of said fibre termination.

4. A method as claimed in any of claims 1 to 3 in which the light beam is observed electronically, and wherein alignment of the optical fibre prior to machining is

determined by viewing the light beam end-on while the termination is rotating, observation of a circle of light indicating a misaligned condition, and observation of a stationary point of light indicating an aligned condition.

5. A method of manufacturing an optical fibre connector, which method comprises providing at least one optical fibre termination with a locating surface rendered concentric with the optical fibre (1) by a method according to any one of claims 1 to 4."

Claim 1 according to the third auxiliary request is identical to that of the main request.

The further claims according to this request read as follows:

"2. A method as claimed in claim 1 in which the locating surface is machined to be cylindrical.

3. A method as claimed in claim 1 or claim 2, in which the sleeve member (2) comprises an optical fibre connector ferrule.

4. A method as claimed in any of claims 1 to 3 in which the light beam is observed electronically.

5. A method of manufacturing an optical fibre connector, which method comprises providing at least one optical fibre termination with a locating surface rendered concentric with the optical fibre (1) by a method according to any one of claims 1 to 4."

IV. The Appellants argued substantially as follows:  
In the notice of opposition, not only Claim 1, but also the dependent claims were attacked by the Opponents, and

documents were cited which also covered the features of the dependent claims. The filing of new dependent claims was an answer to this attack. Such filing of new dependent claims may well be caused by grounds for opposition since in such dependent claims a proprietor of a patent can - in precisely formulated wording - point out further features which appear important to him, on which he wants to gather the opinion of the Opposition Division, and which could be used for supplementing the main claim if the subject-matter of this claim in its former wording should not be considered as involving an inventive step, either before the EPO or a national court. Proprietors are held by the rules of procedure of the EPO to file such amendments at the earliest possible stage of the procedure, which the Appellants did in the present case.

The statement of decision T 295/87, that the addition of dependent claims which had no counterpart in the granted version of the claims of the patent in suit could not be regarded as an attempt to respond to an objection under Article 100 EPC, is in conflict with the decision G 9/91 of the Enlarged Board of Appeal which makes it clear that the patentability of all opposed claims must be examined by the Opposition Division, and hence that the provisions of Article 100 EPC apply equally to dependent claims and to independent claims. If, as suggested in T 295/87, independent claims cannot be amended by taking features from the description and also new dependent claims cannot be filed, the Proprietor is deprived of nearly all means of defence against an opposition. Moreover, it must be considered that T 295/87 as well as T 406/86 (to which reference is made in T 295/87) relate to cases where the amendments were filed at a late stage of the proceedings, contrary to the present case.

V. The Respondents did not file any comments.



### Reasons for the Decision

1. The Appellants were adversely affected (Article 107 EPC) by the decision of the Opposition Division not to allow the main request. The appeal is thus admissible.
2. Since the Respondents did not file an appeal of their own, the decision of the Opposition Division, so far as it concerns the maintenance of the patent on the basis of the documents filed as "subsidiary request" (which correspond to those of the present third auxiliary request), cannot be challenged. In accordance with the decision G 9/92 (OJ EPO 1994, 875) of the Enlarged Board of Appeal, this request will not be called in question by the Board.
3. Claim 1 is identical for the main, second auxiliary and third auxiliary requests. The same is true (apart from different numbering) for the last claim of each set. There is no controversy about the allowability of these claims.

However, the dependent claims according to the main request comprises six new dependent claims (Claims 2 to 7) added to some of the granted dependent claims, and according to the second auxiliary request additional subject-matter has been added to the granted Claims 2, 4 and 5.

Thus, the only point at issue is whether these new or amended dependent claims are admissible. This was denied by the Opposition Division since in its view the added claims were irrelevant to the grounds of the opposition

and thus their introduction into the set of claims was neither directly relevant nor appropriate in the sense of Rules 57(1) and 58(2) EPC.

4. Two different basic reasons (mentioned by the Appellants) for possibly rejecting a request for amendment of a patent in opposition (appeal) proceedings should be distinguished:

- (a) Late filing of the amendments: this reason does not apply in the present case and was not brought forward by the Opposition Division since the amendments to the set of claims were filed together with the first response to the notice of opposition.

- (b) Unnecessary and inappropriate amendments: objections regarding this point are based on an interpretation of Rules 57(1) and 58(2) EPC. New Rule 57a EPC, which directly addresses this point, entered into force on 1 June 1995, i.e. after the first filing of the amendments discussed in the present case, and will therefore not be taken as a basis for the present decision. Reason (b), which will be dealt with below, is independent of the question of early or late filing.

5. The Board concurs with the statements made in the decisions T 127/85 (OJ 1989, 271), T 295/87 (OJ 1990, 470) and T 406/86 (OJ 1989, 302) to the effect that admitting amendments during opposition proceedings is a matter of discretion under Rules 57(1) and 58(2) EPC, and amendments should only be admitted if they can influence the decision on issues under Article 100 EPC or arise in relation to matter to be amended in consequence of such issues. New Rule 57a EPC corresponds to this established case law. This judgment is in line

with the general principles expressed by the Enlarged Board of Appeal in its decision G 9/91 (OJ 1993, 408) (see in particular paragraphs 9 and 10 of the reasons), where emphasis is put on the fact that the opposition proceedings constitute only an exception to the rule that a European patent after grant is no longer within the competence of the EPO. Thus, the possibility of amendments at this stage is justified only as an answer to grounds for opposition endangering the patent.

6. *Main request*

6.1 The six new claims of this request are dependent on a Claim 1 that has been found by the Opposition Division to meet the requirements of the EPC, and in particular to define novel and inventive subject-matter. There is no requirement of the EPC, including those under Article 100, which would call for the presence of these new claims. Not even an adaptation of the granted dependent claims to the amended Claim 1 was necessary (apart from the deletion of Claim 3 the feature of which had been introduced into Claim 1) since these claims are fully compatible with the amended Claim 1.

6.2 The Appellants argue that the filing of new dependent claims was an answer to the attacks of the Opponents against the dependent claims. In fact, in the notice of opposition, the Opponents had opposed the patent as a whole on the ground of lack of inventive step, and had indicated that the cited documents related to the dependent claims as well and that the dependent Claims 2 to 6 did not form patentable matter on their own. However, the necessity and appropriateness, and thus admissibility, of amendments is not a question of subjective, but of objective judgment. On an objective basis, it was clear that dangers to the maintenance of the patent arose only from the way the invention was

specified in Claim 1, and that new dependent claims did not have any influence on the characteristics of the invention as specified in Claim 1 and thus were not an adequate response to the attacks of the Opponents on inventive step. Non-inventive subject-matter of an independent claim would not become inventive by the presence of a dependent claim involving inventive subject-matter.

6.3 The Appellants' argument that existing dependent claims constituted a valuable fall-back position for the case that Claim 1 was found unallowable, may in practice be true since they are often better adapted to being added to an independent claim without reformulation than disclosure derived from the description. However, in opposition proceedings, the filing of new dependent claims just for improving such fall-back position is in no way necessary or appropriate. If amendments to an independent claim are required, suitable features can as well be taken directly from the description. In any case, from a legal point of view, nothing is gained by insisting on a two-step process of first transferring certain features from the description into new dependent claims, and later on possibly introducing them into an independent claim.

6.4 The Appellants are mistaken in thinking that by filing dependent claims the Opposition Division can be obliged to advance an opinion on the merits of each of these claims. Decision G 9/91 (OJ 1993, 408), cited by the Appellants in this respect, does not support such an expectation. This decision is mainly concerned with restricting the power of an opposition division or a board of appeal to examine non-opposed subject-matter. Regarding dependent claims it only states (see paragraph 11 of the reasons) that under certain conditions subject-matters of (not explicitly opposed) dependent

claims **may be** examined as to patentability, **if** the independent claim falls in opposition or appeal proceedings. This statement neither indicates any obligation to examine, nor is it applicable to the situation of the present case.

There are quite a number of ways in which patentees can informally indicate their willingness to effect certain amendments of an independent claim, but the only way of obliging an opposition division to express its opinion on all of the patentees' proposals before revoking the patent, is to file a corresponding series of auxiliary requests.

- 6.5 The Appellants further argue that following the lines of the above-cited decision T 295/87 (in particular paragraph 3 of the reasons) would lead to unreasonable results since according to this decision no features from the description, but only features from dependent claims could be introduced into the independent claims so that, if no new dependent claims could be filed, a patentee would be deprived of all possibilities to react to an opposition, unless he was lucky enough to have filed, before grant and without knowledge of further prior art documents to come, just the right set of dependent claims.

In the Board's view, this interpretation of T 295/87 is not correct. The reason indicated therein for not admitting amendments in opposition proceedings, is the fact that the amendments did not arise out of the grounds for opposition laid down in Article 100 EPC. If the subject-matter of the new claims is mentioned as not having been previously claimed and not having a counterpart in the granted version of the claims, this does not indicate a separate point of objection against the amendments, but only serves to characterise the type

of amendments requested in that case (ie amendments to the set of dependent claims going beyond mere adaptation and being neither necessary nor appropriate). Contrary to the interpretation of the Appellants, the question of amending independent claims by introducing into them features from the description, is not addressed in T 295/87, and, in fact, the Board can derive neither from this decision, nor from the EPC any general rule prohibiting amendments to a patent for the sole reason that they relate to the transfer of features from the description to the claims.

6.6 Moreover, the whole above-mentioned argumentation of the Appellants ignores the fact that in the present case the Opposition Division found Claim 1 allowable (together with the granted Claims 2 and 4 to 6). Thus, even if the Appellants at first considered it necessary and appropriate to answer to the opposition by filing new dependent claims (which, as shown above, was not the case on an objective basis), the end of such necessity must have become definitively clear at the very latest during the present appeal procedure when it became certain that no appeal had been filed against the maintenance of Claim 1. It is thus clear that at present no necessity exists for adding new dependent claims.

Bringing a maintainable patent in a new shape for possible further proceedings before a national court, be the new shape useful therefor or not, is not the function of the opposition (appeal) proceedings.

6.7 Thus, there neither was, nor presently is a reason under Rules 57(1) and 58(2) EPC for admitting the new dependent claims filed as main request. The Appellants' main request is therefore not allowable.

7. *First auxiliary request*

This request concerns a question, formulated by the Appellants and relating to the possibility of adding, deleting or amending dependent claims in opposition proceedings, to be referred to the Enlarged Board of Appeal.

However, the Board neither sees non-uniform application of the law in the above-cited decisions, nor wishes itself to deviate from the case law contained therein. The said question also is not open in such a way that it would constitute an important point of law. This is the more so since meanwhile new Rule 57a EPC has further clarified the situation in the sense indicated above.

The first auxiliary request is therefore refused (Article 112(1) EPC).

8. *Second auxiliary request*

According to this request, those features which form the added dependent Claims 2, 3 and 7 of the main request are now attached to the granted dependent Claims 2, 4 and 5, respectively. However, this addition of subject-matter constitutes a substantial, inappropriate and unnecessary amendment for the same reasons as outlined above. It is of no importance in this context whether subject-matter is added to already existing dependent claims or formulated in new dependent claims.

For essentially the same reasons as given above for the main request, the second auxiliary request is therefore also not allowable.

9. *Third auxiliary request*

The Opposition Division has already decided on the maintenance of the patent with those patent documents which now form the basis of the third auxiliary request. The aim of the present appeal was to replace the text of the patent as maintained by the opposition Division, or, if this is not allowed, that the patent be maintained in the form allowed by the Opposition Division. Dismissing the present appeal is therefore tantamount to allowing the third auxiliary request.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

P. Martorana

E. Turrini