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D E C I S I O N
of 22 September 1999

Case Number: T 0035/97 - 3.2.5

Application Number: 90400127.8

Publication Number: 0379427

IPC: B24B 9/14

Language of the proceedings: EN

Title of invention:
Uncut lens judging apparatus for lens grinding machine

Patentee:
Kabushiki Kaisha Topcon

Opponent:
Wernicke & Co. GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 111(1), 114(1,2)

Keyword:
"Admittance of late-filed document"
"Remittal to the first instance"

Decisions cited:
T 0156/84

Catchword:
-



Case Number: T 0035/97 - 3.2.5

D E C I S I O N
of the Technical Board of Appeal 3.2.5
of 22 September 1999

Appellant:
(Opponent)

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Representative:

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Respondent:
(Proprietor of the patent)

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Representative:

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 14 November 1996
rejecting the opposition filed against European
patent No. 0 379 427 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: A. Burkhart
Members: C. G. F. Biggio
W. Moser

Summary of Facts and Submissions

I. The appellant (opponent) lodged an appeal against the decision of the Opposition Division rejecting the opposition filed against European patent No 379 427.

Opposition was filed against the patent as a whole and based on Article 100(a) EPC, in conjunction with Articles 54 and 56 EPC (lack of novelty and inventive step).

The Opposition Division held that the grounds for opposition mentioned in Article 100(a) EPC did not prejudice the maintenance of the patent as granted, having regard to the following documents:

D1: EP-A-0 160 985,

D2: DE-A-33 16 619,

D3: Brochure Helbrecht INGOH 130 Typ 1311 CNC,

D4: Brochure Helbrecht "Ansaug- und Zentriergerät",

D5: EP-A-0 206 860,

D6: "Eidesstattliche Erklärung" by Mr Werner, dated 21 December 1994 and asserting public prior use,

D7: "Handbuch für Augenoptik", Zeiss 1977, pages 97 to 133 and 144 to 145,

D8: "Eidesstattliche Erklärung" by Mr Werner, dated 5 July 1993 and asserting public prior use, and

D9: List of Exhibitors, Optica 84, Cologne.

II. Independent Claims 1 and 4 as granted read as follows:

1. "An uncut lens judging apparatus for a lens grinding machine including:
frame configuration input apparatus for inputting a vector radius information of the configuration of a lens frame of a spectacle;
calculation/control apparatus for judging whether an uncut lens is large enough to be cut into said lens frame configuration and
display device controlled by said calculation/control apparatus;
characterized in that said display device is controlled by said calculation/control apparatus so as to display at least an angular range (α_1 and/or α_2) of said vector radius which is judged to be large enough when said judgement is negative".

4. "An uncut lens judging apparatus for a lens grinding machine including:
frame configuration input apparatus for inputting a vector radius information of the configuration of a lens frame of a spectacle; and
calculation/control apparatus for judging whether an uncut lens is large enough to be cut into said lens frame configuration;
characterized in that said calculation/control apparatus automatically corrects a cutting origin when the uncut lens is not large enough to be cut into a lens frame configuration, so that the uncut lens can be cut into the lens frame configuration."

III. Oral proceedings before the Board of appeal were held on 22 September 1999.

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

The respondent (patentee) requested that the appeal be dismissed, subsidiarily and conditionally (see item V) that the case be remitted to the Opposition Division for further prosecution.

IV. The appellant argued essentially as follows.

In the decision under appeal (see point II-3.2(c)) the Opposition Division stated that the "trick" described in document D6 was not part of the normal use of the apparatuses according to documents D2, D3 and D4 because no hint to said "trick" could be found in said documents and, therefore, the Opposition Division considered that the assertions of the drafter of document D6, in respect of the said "trick", were not credible. By doing so, the Opposition Division overlooked the fact that the said "trick" was normal practice of the person skilled in the field of grinding lenses for spectacles, either with manually or with CNC-grinding machines.

To support this submission, reference was made to the following documents filed for the first time during the appeal procedure:

- D10: Brochure Helbrecht INGOH 130 Typ 1311 CNC, carrying the handwritten notice: "HSD 20.06.85",
- D11: Brochure Helbrecht carrying the handwritten notice: "Optica 88",
- D12: Brochure WECO 480 CNC, carrying the printing notice: "H480 CNC D 1126/07.85",
- D13: Brochure WECO carrying the printing notice: "AP D 410/04.86",

D14: List of Exhibitors, Optica 86, showing Helbrecht and WECO as exhibitors,

D15: List of Exhibitors, Optica 88, showing Helbrecht and WECO as exhibitors, and

D16: "Eidesstattliche Erklärung" by Mr Schmitt-Lieb dated 20 April 1998.

The newly filed documents D10 and D11 referred to the same apparatus already referred to by the previously filed document D3, apparatus of which the prior use was already claimed during the opposition procedure.

Documents D10 and D11 merely served the purpose of more clearly evidencing the most important features of said apparatus. Thus, since documents D10 and D11 referred to the same prior use already claimed, the mention thereof, for the first time during the appeal procedure, could not be regarded as a "late-filed" evidence.

Similarly, documents D12 and D13, which referred to apparatuses exhibited at the "Optica" exhibition of 1998, could not be regarded as "late-filed" evidences. They served, in fact, merely the purpose of supporting and making more clearly evident the submissions already made by means of documents D3 and D6 during the opposition procedure.

Documents D14 and D15 served the purpose of providing evidences that documents D10 and D11 were indeed made available to the public on the respective dates they were carrying in handwritten form.

Document D16, a declaration by an independent expert in the field, served the purpose of providing an evidence that the theoretical teaching disclosed by document D7,

i.e. that, within some given tolerances, it was admissible to displace the optical lens-axis in respect of the eye-axis, was indeed normal practice of the person skilled in the field of grinding lenses for spectacles, either with manually or with CNC-controlled grinding machines, i.e. of the skilled optician, in order to allow the selection of uncut lenses having the smallest possible diameter.

Having regard to the state of the art according to documents D3, D10, D12 and D13 and to the common general knowledge of the person skilled in the art as represented by documents D7 and D16, the apparatus according to Claim 1 of the patent in suit did not involve an inventive step.

V. The respondent argued essentially as follows.

Documents D10 to D16 were submitted well after the expiration of the nine months delay time for opposition. For this reason alone, they should be considered as "late-filed" and, thus, disregarded pursuant to Article 114(2) EPC.

Moreover, the late-filed documents D10 to D13 did not disclose a state of the art coming closer to the apparatus claimed in the patent in suit than the prior art considered by the Opposition Division, so that these late-filed documents should be disregarded for lack of relevance.

Furthermore, it was not proved that documents D10 to D13 were effectively made available to the public before the priority date of the patent in suit.

Document D16 essentially referred to alleged but unsubstantiated prior uses, which should, accordingly, be disregarded pursuant to Article 114(2) EPC.

The last paragraph of page 2 of said document did not state anything more than what had already been stated by document D7 and in the patent in suit (column 1, line 53, to column 2, line 4). Thus, also this passage of document D16 was no more relevant than document D7, which had already been considered during the opposition procedure and should, accordingly, be disregarded.

In the event that the Board would, nevertheless, take into consideration the late-filed documents D10 to D16, remittal of the case to the Opposition Division was requested, so that the respondent could be given the opportunity to have the issue considered by two degrees of jurisdiction.

Reasons for the Decision

1. *Late-filed documents D10 to D16*
 - 1.1 Documents D10 to D16 were cited after the expiration of the period of nine months under Article 99(1) EPC for filing a notice of opposition. Since the patent in suit remained unamended, these documents have to be regarded as "late-filed documents".
 - 1.2 The main criterion for deciding on the admissibility of such documents is their relevance, i.e. their evidential weight in relation to other documents already in the case (cf. decision T 156/84 [OJ EPO 1988, 372])
 - 1.3 In the decision under appeal, the Opposition Division acknowledged that the subject-matter of the patent in suit involved an inventive step in particular for the following reasons (cf. point II-5.5 of the decision under appeal):

"The invention starts from the idea that even a comparatively small lens blank, which according to the apparatus disclosed by D1 had given cause for an alarm, can be used for grinding a lens when deviations from the ideal configuration, where eye axis and optical axis of the lens coincide, were tolerated.

Neither this idea, nor the solution according to independent Claims 1 and 4, is suggested by any of the documents D1 to D5, D6 (to the extent to which it is considered as prior art) and D7."

This conclusion of the Opposition Division, which was made with respect to the documents already considered during the opposition proceedings, holds also true with respect to the late-filed documents D10 to D15, since these documents are silent about said "idea" or the features of the characterising clause of Claims 1 and 4, respectively, of the patent in suit.

Therefore, the Board considers the late-filed documents D10 to D15 no more relevant than the documents already considered during the opposition proceedings and, consequently, disregards said documents D10 to D15 pursuant to Article 114(2) EPC.

As to the "Eidesstattliche Erklärung" by Mr. Schmitt-Lieb (document D16), the Board has come to the following conclusion:

The content of document D16, as far as it pertains to alleged but unsubstantiated prior uses, i.e. the wording of page 1, last paragraph, to page 2, 3rd paragraph, and the whole of page 3, is disregarded pursuant to Article 114(2) EPC.

Having regard to the disclosure of document D7, and to the fact that said disclosure appears to be reflected in the patent in suit (column 1, line 53, to column 2, line 4), in such a manner that it has to be construed as an acknowledgment of a prior art, the Board is satisfied that the statement in the last paragraph of page 2 of document D16 is correct, i.e. that at the priority date of the patent in suit it was normal practice of the skilled optician to tolerate a certain displacement of the optical lens-axis with respect to the eye-axis, so that an uncut lens could be used although it would be considered too small in the case where the eye-axis and the optical lens-axis coincide.

Since the statement in the last paragraph of page 2 of document D16 appears to be relevant when assessing novelty and inventive step of the subject-matter of the patent in suit, it should be considered under Article 114(1) EPC.

2. *Remittal to the Opposition Division*

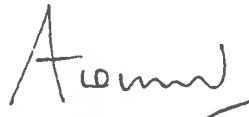
Since the admittance of the statement in the last paragraph of page 2 of document D16 into the proceedings alters the factual framework of the case under appeal compared with that upon which the decision under appeal has been taken, the Board exercises its discretion under Article 111(1) EPC to remit the case to the Opposition Division for further prosecution, so that the patentability of the subject-matter of the patent in suit can be examined at two levels of jurisdiction and the parties to the proceedings are not deprived of the possibility of a subsequent review.

Order

For these reasons it is decided that:

- 1. The decision under appeal is set aside.
- 2. The case is remitted to the Opposition Division for further prosecution.

The Registrar:


 A. Townend

The Chairman:


 A. Burkhart

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W. Paster 14. 12. 93

