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**D E C I S I O N**  
**of 26 June 2001**

**Case Number:** T 0512/97 - 3.4.2

**Application Number:** 92906649.6

**Publication Number:** 0576496

**IPC:** G02B 13/14, G02B 23/12

**Language of the proceedings:** EN

**Title of invention:**  
Infrared Optical System

**Applicant:**  
BAE SYSTEMS AVIONICS LIMITED

**Opponent:**  
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**Headword:**  
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**Relevant legal provisions:**  
EPC Art. 111(1)

**Keyword:**  
"The ground for the refusal no longer apply to the amended application"  
"Remittal to te first instance for further prosecution"

**Decisions cited:**  
-

**Catchword:**  
-



Case Number: T 0512/97 - 3.4.2

**D E C I S I O N**  
**of the Technical Board of Appeal 3.4.2**  
**of 26 June 2001**

**Appellant:** BAE SYSTEMS AVIONICS LIMITED  
The Grove  
Warren Lane  
Stanmore  
Middlesex HA7 4LY (GB)

**Representative:** Fletcher Watts, Susan J.  
BAE Systems plc  
Intellectual Property  
Lancaster House - PO Box 87  
Farnborough Aerospace Centre  
Farnborough, Hampshire GU14 6YU (GB)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 20 December 1996  
refusing European patent application  
No. 92 906 649.6 pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** E. Turrini  
**Members:** A. G. Klein  
V. Di Cerbo

## Summary of Facts and Submissions

- I. European patent application No. 92 906 649.6 (International publication No. WO 92/16864) was refused by decision of the examining division on the ground that it did not disclose the invention set out in claim 1 - in as much as the latter comprised the feature "that a T.V. camera is incorporated by using a small aperture formed in the side of the objective lens" - in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art, in contravention of the requirement of Article 83 EPC.

The examining division held that the problem of incorporating a TV camera into the claimed optical arrangement *inter alia* involved optical, electrical and mounting aspects. The original application was however completely silent as to which of these aspects was solved by the "small aperture formed in the side of the objective lens", and neither the description nor the figures contained any detailed information as to the incorporation of a TV camera.

- II. The appellant (applicant) filed an appeal against the decision, submitting in substance that the contested feature of claim 1 was meant to express that the objective lens comprised a hole at its periphery through which visible light was transmitted to a TV camera located at the same side of the lens as the imaging system and the source.
- III. In a communication pursuant to Article 11(2) of the Rules of Procedure of the Boards of Appeal, dated 15 March 2001, the board expressed its provisional doubts that the expressions "incorporated by using a

small aperture" or "formed in the side of the objective lens" in claim 1 clearly defined the arrangement suggested by the appellant, or any alternative arrangement, in contravention of the requirement of Article 84 EPC. Clarifying claim 1, which appeared necessary before any meaningful assessment of the sufficiency of the disclosure might be made, might however prove difficult, in consideration of the content of the application as originally filed (Article 123(2) EPC).

- IV. Oral proceedings were held on 26 June 2001, at the end of which the appellant requested that the case be remitted to the first instance for further prosecution on the basis of a main request filed as first auxiliary request with its fax letter dated 13 June 2001 or of any of auxiliary requests 1 to 7, filed at the same date as auxiliary requests 2 to 8.

### **Reasons for the Decision**

1. The appeal is admissible.
2. The feature relating to a TV camera being incorporated in the claimed optical arrangement, on which the examining division based its objection under Article 83 EPC, no longer appears in any of the claims of the appellant's present requests.

The grounds for the refusal of the patent application thus no longer apply to these requests, neither do the doubts expressed by the board under Article 84 in its communication of 15 March 2001.

The independent claims 1 of the respective requests recite various combinations of the features of claim 1 as originally filed with those defined in different dependent claims as appended thereto.

Although the examining division had indicated in its communication of 27 April 1995 that it considered certain of these combinations to lack an inventive step, this issue was not debated further, the case having thereafter been concentrated on the sole question of the sufficiency of the disclosure. The appellant's detailed arguments in support of the patentability of the claimed subject-matter as presented with its fax letter of 13 June 2001 have not yet been considered by the examining division.

For these reasons, and in accordance with the appellant's main request, the board deems it appropriate in the circumstances to make use of the possibility given to it by Article 111(1) EPC to remit the case to the first instance for further prosecution.

## **Order**

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

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of the main request, filed as first auxiliary request with the fax letter dated 13 June 2001, or on the basis of auxiliary requests 1 to 7, corresponding to auxiliary requests 2 to 8 as

filed with the fax letter of 13 June 2001.

The Registrar:

The Chairman:

P. Martorana

E. Turrini