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**D E C I S I O N**  
of 9 April 2003

**Case Number:** T 0116/98 - 3.4.2

**Application Number:** 88402465.4

**Publication Number:** 0310514

**IPC:** G02B 21/20

**Language of the proceedings:** EN

**Title of invention:**  
Binocular microscope

**Patentee:**  
Kabushiki Kaisha TOPCON

**Opponent:**  
Fima Carl Zeiss

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 114(2), 56, 123(2)

**Keyword:**  
"Admission of submissions relating to fresh issue at oral proceedings (no)"  
"Hearing of witness with respect to fresh issue - no"  
"Inventive step - yes"  
"Inadmissible amendment (no)"

**Decisions cited:**  
-

**Catchword:**  
-



## Summary of Facts and Submissions

### I. Overview

The present appeal was lodged by the opponent (=appellant) against the interlocutory decision of the opposition division that taking account of the amendments made by the proprietor, European patent number 310 514 (application number 88 402 465.4 with priority date 30 September 1987) and the invention to which it relates meet the requirements of the Convention. The patent concerns a binocular microscope. The appeal was focussed on alleged public prior use of a microscope according to a demonstration at and subsequent sale to the Rätisches Kantons- und Regionalspital in Chur, Switzerland (hereinafter referred to as the hospital in Chur).

### II. Independent Claim of the Patent in issue

The only independent claim of the patent upon which the decision of the opposition division was based and which remained unchanged in the appeal proceedings is worded as follows:

1. A binocular microscope comprising:
  - a stationary housing portion (2);
  - a movable housing portion (4) mounted on said stationary housing portion (2) for movement relative to said stationary housing portion (2);
  - objective optical means (10), disposed in said stationary housing portion (2), for receiving a bundle of light rays from an object and for emitting said bundle as parallel rays along an objective optical axis; and
  - a pair of ocular means (5) disposed on said movable housing portion (4);

said binocular microscope being characterised by:

① a pair of variable power optical means (12), disposed on a first and second sides of said stationary housing portion (2), for receiving and magnifying said parallel rays emitted from said objective optical means (10) and for emitting magnified rays as parallel rays;

② a pair of relay optical means (R), including relay lenses (18) and disposed on the first and second sides of said movable housing portion (4), for receiving and relaying the parallel rays emitted from said pair of variable power optical means (2) to said pair of ocular means (S);

means for allowing a rotation, within a predetermined range, of said movable housing portion (4) relative to said stationary housing portion (2) about said objective optical axis, in a boundary plane between said stationary housing portion (2) and said movable housing portion (4), so as to change an angle at which the object is viewed through said ocular means (S); said boundary plane being defined between said pair of variable power optical means (12) and the relay lenses (18) of said pair of relay optical means (R) and being substantially perpendicular to said optical axis of said objective optical means (10);

the movable range of said movable housing portion (4) being limited such that the majority of said bundle of rays which pass through the outgoing pupil (E) of said stationary housing portion (2) to contribute in forming an image will also pass through the incident pupil (E') of said movable housing portion (4).

### III. Evidence in the proceedings

In the proceedings before the first instance reference was made inter alia to the following patent document:-

D1: EP-A-0 167 926

and in relation to alleged public prior use, to copies of the following:

C1: Brochure "Operationsmikroskop OPMI MD",

C5: Delivery note and invoice dated 14 August 1987 of Carl Zeiss for microscope "OPMI MD",

C10: Invention Report dated 19 December 1986.

Reference was also made to

C11: Statement of Dr Sander as a witness before the opposition division (17 July 1997).

During the appeal proceedings, Dr Sander made a further statement

C12: Statement of Dr Sander as a witness before the appeal board (12 February 2003),

and the following were filed in relation to alleged prior use:

C13: Declaration of Mr Martin Wolf (dated 2 April 2003),

C14: Declaration of Mr Adrian Ammann (dated 2 April 2003), and

C15: Attachment to the Minutes of the second oral proceedings written by the representative of the appellant.

IV. Reasoning for Decision of the Opposition Division

Issues considered during the opposition proceedings included an alleged demonstration of a pre-production microscope at and a subsequent alleged delivery of an OPMI MD microscope to a hospital in Chur prior to the priority date of the patent in suit. The analysis of the division became focussed on the question of whether the evidence and arguments provided by the opponent were sufficient to prove that the microscope forming the subject of the prior use allowed for a relative rotation of two housing portions like claim 1 of the patent in dispute. Document C10, involving dovetail mechanical means for allowing relative rotation of binocular tubes and stereo splitter, was dated after the demonstration in the hospital in Chur and contains a statement that the invention had not been made public. This went against the opponent's statement assertion that the idea had already been realised before the declaration. In these circumstances, delivery of a microscope comprising all the features shown in document C1 could not be considered proven beyond doubt. Nevertheless, it followed from document C5, a delivery note concerning the "OPMI MD" microscope, that use was made by way of delivery before the priority date of the patent in suit of a microscope comprising a zoom system and a stereo splitter. The opposition division drew attention to its understanding of the German term "Schwenktubus" as mentioned in delivery note C5 as not corresponding to rotational binocular tubes shown on at the top of page 5 of document C1. Even if a rotation were to be considered proven for the sake of argument, the division was of the view that the corresponding arrangement would not anticipate the rotational arrangement of the microscope

according to claim 1 in dispute. The decision was silent as to inventive step in this context. The opposition did however remark that document D1 is not relevant to patent claim 1 as amended.

V. Appeal Procedure

A notice of appeal and a statement of setting out grounds therefor were filed and the views of the parties exchanged in writing. The appellant offered the re-hearing of witness, Dr Sander, and the hearing of a fresh witness Mr Wolf. Oral proceedings were requested on an auxiliary basis by both the appellant and the respondent (=patentee).

In a communication to the parties, the board remarked that it seemed statements of witnesses might reveal aspects of the delivery to the hospital in Chur calling into question the reasoning of the opposition division. Since the alleged prior use had already been considered before the first instance, the extended five member board gave its preliminary view that statements of the witnesses would seem not to amount to a fresh line of argument but to elaboration in the light of the decision under appeal of what had already been submitted. The board therefore reached the preliminary view that it would hear the witnesses without remittal to the first instance. The appellant agreed to the proposed course of action and no submissions to the contrary were received from the respondent. The board therefore issued an interim decision, subject to alteration (see point VI), to hear the witnesses. First oral proceedings were appointed for this purpose and second oral proceedings for final resolution of the case. While making the arrangements, the Registrar was

informed by Mr Wolf by telephone that he would not appear on any date. During the first oral proceedings, evidence was taken by way of the board and the parties questioning Dr Sander.

After hearing the testimony of Dr Sander, the board issued a communication advising the parties that it had doubts about whether prior use could be considered proven by the documents submitted in connection with the alleged delivery and sale. Moreover, the board considered it no longer appropriate within the context of Article 114(2) EPC to hear the witness, Mr Wolf. In the same communication, the board informed the parties that if filing of further submissions was intended, this should be done promptly, at least one month before the oral proceedings. Late submissions of any description from either side, especially if so complex as to delay unduly or prevent resolution of the issues at the oral proceedings, ran the risk of not being taken into consideration by the board. The respondent filed submissions in good time, the appellant filed a first submission in good time and second submissions, together with documents C13 and C14, three working days before the oral proceedings.

The appellant brought microscopes along to the second oral proceedings. During the second oral proceedings the representative of the appellant informed the board that the microscope delivered to the hospital in Chur had in fact been an "OPMI 6 SDFC" microscope on loan until an "OPMI MD" microscope as shown on the delivery note document C5 was available, these then being exchanged without charge.

During the oral proceedings, the respondent filed an amended claim 2, the other claims remaining unchanged over those before the first instance, and made consequential amendments to the description.



The board gave its decision at the end of the oral proceedings.

VI. Summary of Case of the appellant

Requests

Revocation of the patent.

Hearing of witnesses Dr Ulrich Sander and Martin Wolf.

Demonstration of microscopes brought along to the second oral proceedings.

Annexing of document D15 to the minutes of the oral proceedings

Submissions

Amendments - Article 123(2) EPC

A binocular microscope in which the incident pupil of the movable housing system is smaller than the outgoing pupil of the stationary housing portion as in claim 2 is not disclosed in combination with the feature that the larger part of the rays passing through the outgoing pupil will also pass through the incident pupil as in independent claim 1 consequent to the amendment made before the first instance. Therefore the combination of claim 1 and claim 2 is directed to added subject matter.

Alleged Prior Use

The testimony of Dr Sander before the board of appeal had established that the demonstrated microscope corresponded to document C1 and had the rotational movement of the binocular tubes. The decision of the

opposition division was thus in error on this point. There was, moreover, no secrecy agreement at the demonstration as has been confirmed by Dr Sander (C12) and further underlined by the statement of Mr Wolf (C13). In addition, the declaration of Mr Ammann (C14) showed the microscope had been put on the inventory at the hospital in Chur and thus had been received before the priority date of the patent, it not being usual in Switzerland for a counter stamped copy of the delivery note to be issued as receipt. This is the operation microscope with stereo bridge and binocular tubes referred to in the declaration of Mr Wolf.

An "OPMI 6 SDFC" microscope and an "OPMI MD" microscope are identical with respect to the rotational movement under discussion. Exhibits for demonstration of this point had been brought along by the representative of the appellant. Moreover, the representative of the appellant had also arranged for Mr Wolf to be present at the EPO, should the board comply with appellant's request for him to give evidence at the oral proceedings. An earlier request of the appellant, in relation to not hearing Mr Wolf, for referral of a question to the Enlarged Board was withdrawn.

#### Substantive Patentability

The appellant submitted the opposition division should, in the situation where the alleged prior use was assumed proven, also have dealt with the question of inventive step of the subject matter of claim 1. In this case, the differences identified would not amount to an inventive step over the prior use alone or if considered in the context of standard practice such as illustrated by document D1.

VII. Summary of Case of the respondent

Requests

Maintenance of the patent in amended form on the basis of the set of claims filed during the oral proceedings.

Dispensing with hearing of witness Mr Martin Wolf and rehearing of witness Dr Ulrich Sander.

Refusal of request to present exhibits at the second oral proceedings.

Submissions

Amendments - Article 123(2) EPC

The appellant overlooked the wording "to contribute in forming an image" in claim 1, which qualifies the preceding wording "the majority of said bundle of rays which pass through the outgoing pupil (E) of said stationary housing portion (2)". The reason for this qualification can be found in providing a limitation for the movable range of the housing portion (4). The documents as filed disclose the outgoing pupil being larger than the incident pupil (e.g. Figure 9, see claim 2) as well as the incident pupil being larger than the outgoing pupil (e.g. Figure 10, see claim 5). In both cases the majority of said bundle of rays (from an object) contributing to forming an image pass through the outgoing pupil to the incident pupil.

Hearing the witnesses

The respondent considered rehearing Dr Sander unnecessary and hearing Mr Wolf superfluous as substantially the same statement would already had been made by Dr Sander.

### Alleged Prior Use

The testimony of Dr Sander before the appeal board (C12) and the declaration of invention (C10) make it clear that the demonstration at the hospital in Chur was not public. The submission of the appellant with respect to the declaration of Mr Wolf (C13) and Dr Sander that no confidentiality agreement existed amount to no more than an attempt to give the impression of public use using hindsight. Mr Wolf was moreover only permitted to make a disclosure of the new microscope in the context of making a sale.

Since it is apparent that the delivery note C5 does not correspond to what was delivered to the hospital in Chur because on the appellant's own admission the OPMI microscope was changed, delivery according to the delivery note was not proven. This is in accordance with experience, which teaches that in general, changing of component parts of complicated technical items is commonplace. Furthermore, the declaration of Mr Ammann does not give any details about what was actually delivered. Any hearing of Mr Wolf at or presentation of microscopes brought along to the second oral proceedings gives rise to objection as too late.

### Reasons for the Decision

#### 1. *Admissibility of the appeal*

The appeal complies with the provisions mentioned in Rule 65(1) EPC and is therefore admissible.

2. *Amendments - Article 123 EPC*

2.1 In comparison with claim 1 as granted, minor clarifying amendments have been made to claim 1, which has also been restricted in substance by inclusion of the features of granted claim 8. No objection was raised by the appellant in relation to Article 123(3) EPC, the requirements concerned also being considered satisfied by the board.

2.2 Claim 1 requires that the range of rotation of the movable housing portion be limited such that the majority of the bundle of rays which pass through the outgoing pupil of the stationary housing portion to contribute in forming an image will also pass through the incident pupil of the movable housing portion. The bundle of light rays is from an object according to the eighth line of the claim and of these, those rays which further down the optical train pass through both pupils to contribute in forming an image are those concerned in the limitation of the movable range according to claim 1. Dependent claim 2 specifies that the radius of the outgoing pupil of the stationary housing portion be larger than that of the incident pupil of the movable housing portion. This situation can be seen in Figures 8 or 9 as filed for example. There is no doubt that the majority of the bundle of rays contributing to the image pass through both pupils. The same situation also exists in the case of for example Figure 10 as filed, where the incident pupil is larger than the outgoing pupil, a configuration claimed in claim 5. The board is therefore satisfied that the amendment to the granted claim 1 to incorporate features of granted claim 8 did not give rise to addition of subject matter as a result of interaction between the amended independent claim and the dependent claims. A similar conclusion applies to consequential amendments effected to the description.

2.3 The submission of the appellant that subject matter has been added in the combination of claims 1 and 2 relies on understanding the claims to mean that the majority of the bundle of rays leaving the stationary housing also pass the incident pupil of the movable housing. This understanding is flawed, because as correctly pointed out by the respondent, the rays concerned are just those which contribute towards forming an image and this qualification was overlooked in the analysis of the appellant. Consequently, the submissions of the appellant did not persuade the board.

3. *Summary of pertinent points in evidence*

*Document C1*

3.1 This brochure is entitled Operationsmikroskop OPMI-MD and shows various configurations of microscope and, in particular in the figures at the top of page 5, a rotational movement of binocular tubes. The German term "Schwenktubus" is used for example at the top of the last page.

*Document C5*

3.2 A delivery note of the appellant company to the hospital in Chur containing amongst others, item number 1, Mikroskopkörper (=microscope body) OPMI MD and item number 7, binokularer "Schwenktubus" 180 Grad.

*Document C10*

3.3 The invention report concerns a rotatable dovetail joint for an operation microscope. A negative answer is given to question 7 in this report concerning whether the invention had been published in any form.

*Document C11*

- 3.4 Dr Sander was employed by the appellant company as microscope developer and was involved in the demonstration at the hospital in Chur. A pre-production model was demonstrated, which was later called OPMI MD. The binocular tubes could be rotated. Dr Sander assumed knowledge of this rotation could be passed on to the potential customer (see page 7, bottom).

*Document C12*

- 3.5 Dr Sander explained the relative movements of the binocular tubes and the definition of the German term "Schwenktubus" with reference to document D1. In reply to the question of whether the demonstration at the hospital in Chur was confidential or not, Dr Sander replied that it was usual to refer in preceding meetings to preserving confidentiality at such demonstrations, when, as in the present case, the device was not on the market. He could not remember a specific confidentiality agreement in the present case.

*Document C13*

- 3.6 Mr Wolf was employed by Carl Zeiss in functions relating to marketing engineering from 1971 to 1996. He was responsible for discussion of the technical requirements in relation to the microscope for the hospital in Chur. He was responsible for the sales negotiation at the demonstration. He was instructed by the sales manager to mention the possibilities of a new microscope in development only if a matter of not losing an order. He was never told the new microscope should be kept secret and assumed this was not the case and so did not refer to maintaining secrecy at the hospital in Chur. He remembered assembling a microscope

with a body, a stereo bridge and two binocular tubes at the hospital in Chur in the summer of 1987. Mr Wolf saw on 23 March 2003 that the microscope delivered is still in use in the hospital in Chur.

*Document C14*

- 3.7 Mr Ammann works as head of technical services at the hospital in Chur. He confirms that an operating microscope was entered into the inventory on the 24 August 1987. This information derives from the computer system.

*Document C15*

- 3.8 The operation microscope OPMI 6 SDFC delivered to the hospital in Chur was later exchanged for the operation microscope OPMI MD. The stereo bridge with binocular tubes could be attached to the OPMI 6 SDFC exactly as for the OPMI MD as shown in document C1. The technical differences between the OPMI 6 SDFC and the OPMI MD (4 times and 6 times zoom) are insignificant with respect to the subject matter of the patent. In order to prove this, an offer is made to take evidence from Mr Martin Wolf, who is available at the second oral proceedings.

4. *Article 114(2) - Disregarding of facts or evidence not submitted in due time*

- 4.1 A major feature of the appellant's case involved proving both delivery of a microscope to the hospital in Chur before the priority date of the patent in issue and exactly what the structure of this microscope was. Since activities of the appellant company itself were concerned, it is possible to imagine the appellant could and indeed should have been able to find out right from the start of the opposition procedure when



and what had been delivered. It was therefore a surprise that right at the last moment, i.e. during the second oral proceedings in the appeal stage, the appellant submitted that a different microscope to that specified in delivery note to the hospital had in fact been delivered, which meant that the appellant itself showed that the delivery note was not accurate. Therefore, in order to have established exactly what had been delivered, further investigative work would have had to be undertaken by the board to resolve a fresh issue. For example, a technical examination of the microscopes brought along by the appellant and testimony from Mr Wolf would have been needed in an attempt to determine any differences existing between the OPMI 6 SDFC microscope which was "on loan" and the OPMI MD for which it was subsequently exchanged. Moreover, since the actual microscope concerned is apparently still in the hospital in Chur (see C13), it would have been necessary, at the oral proceedings, to have established the exact relationship between all the microscopes concerned. The position of the appellant therefore entailed so complicating the issues that just the kind of situation arose, concerning which the board warned in its summons to oral proceedings may give rise to disregarding submissions, as it was impossible to deal in a fair way with the fresh issue within the time frame of the oral proceedings. Therefore the board exercised its option under Article 114(2) EPC and declined at that late stage both to hear Mr Wolf on the differences between the OPMI MD and the OPMI 6 SDFC and to look at the microscopes brought along by the representative of the appellant.

5. *Hearing the witnesses*

- 5.1 As part of its preliminary assessment, the board examined the evidence presented, especially the brochure C1 and the delivery note C5, the declaration

of invention C11 and the statement of Dr Sander C12. This examination caused the board to question the reasoning at the centre of the decision of the opposition division with respect to the German term "Schwenktubus", which is used for example in brochure C1 and delivery note C5. The doubts of the board led to a decision, subject to alteration, to hear witnesses. It is, of course, never possible in advance to be completely sure exactly how circumstances will develop following such a decision nor what testimony will result therefrom. This is why the decision is issued subject to alteration. In the present case, the matter developed in the following way.

Dr Sander - heard by the board

- 5.2 At the first oral proceedings, the testimony of Dr Sander put the board in a position where it was satisfied that it could decide what was understood by the German term "Schwenktubus" in the context both of the demonstration and of delivery note C5. In other words, the statement of Dr Sander enabled the board to resolve its doubts about the reasoning of the opposition division

Mr Wolf - not heard by the board

- 5.3 Consequent to the statement of Dr Sander, the board thus had, in advance of the second oral proceedings, no further need to hear Mr Wolf, either by requiring his attendance in Switzerland or at the EPO. Therefore, after the first oral proceedings, as the testimony offered was no longer necessary for deciding the case, the board did not pursue the matter.

Only during the second oral proceedings did it become apparent that Mr Wolf might be able to give evidence in relation to obscurities arising from the fresh issue

involving newly introduced discrepancies between document C5 and what was actually delivered to the hospital in Chur. However, such evidence would no longer have concerned questions pertaining to the reasoning of the opposition division, but instead pertained to the discrepancies referred to above. At the second oral proceedings it was too late to begin to unwrap this new issue and pursue these discrepancies for the reasons given in section 5 above.

6. *Alleged Prior Use - Demonstration at the hospital in Chur*

6.1 The demonstration in the hospital in Chur took place before the priority date of the patent in dispute and thus can be considered "prior". The demonstration cannot however be considered public because in the view of the board there was an implied confidentiality. The board reached this view because the testimony of Dr Sander (see second paragraph on page 4 or page 6 of document C12, for example) indicates that confidentiality is usually involved where a demonstration of a microscope was concerned, where it was not definite it would come onto the market. This position of Dr Sander is also consistent with his a few months later signing the declaration of invention C10, containing a reply in the negative to the question of whether there had been a pre-publication of the invention. The temporally close answer in document C10 carries more weight in the view of the board than the statement made years later in C12 that Dr Sander could not remember a specific confidentiality agreement.

6.2 According to document C13, Mr Wolf was instructed to reveal new possibilities of the microscope only when a matter of not losing the sale. This does not amount to an instruction to make an unconditional disclosure of the technical details of the microscope as a potential

commercial relationship is a precondition. He was never informed that the new microscope was to be kept secret at that time and assumed the microscope was not to be kept secret, his not indicating during negotiations at the hospital in Chur that the microscope shown was to be kept secret. This tallies with the fact that the hospital in Chur became a customer. In the board's view, not specifically indicating secrecy thus does not in itself amount to publication and thus document C13 does not amount to an unequivocal indication of an unconditional disclosure of what was demonstrated by Dr Sander. The combination of documents C11, C12 and 13 leads to the conclusion that the demonstration had an implied confidentiality and thus was not public and therefore does not constitute prior art within the meaning of Article 54(2) EPC.

7. *Alleged Prior Use - Delivery to the hospital in Chur*

7.1 During the entire first instance and the appeal proceedings, the appellant failed to confirm exactly what was delivered to the hospital in Chur, relying only on a delivery note of the appellant company. During the second oral proceedings in the appeal stage the appellant finally made clear its knowledge that the items delivered did not in fact even correspond exactly to the delivery note document C5. The appellant thus introduced a further and serious doubt about what had actually been delivered at a very late stage in the proceedings, which doubt called into question its entire previous submission that equipment corresponding to document C5 had been delivered before the priority date of the patent. There was no more time available for the board itself to resolve this doubt at this very late stage of the proceedings. Statement document C14 furnished just in advance of the second oral proceedings also could not heal this defect because it did not identify any details of the delivery, such as

by confirming receipt of any specifically itemised post on the delivery note. Accordingly, in view of the doubt, the board had little option within the constraints of established procedural law but to reach the conclusion that delivery of a microscope corresponding to delivery note C5 could not be considered proven. The case of the appellant in this respect therefore collapsed because the board reached the conclusion that the alleged delivery has not been shown to constitute prior art within the meaning of Article 54(2) EPC.

8. *Substantive Patentability*

8.1 The line of argument advanced by the appellant in the appeal proceedings with respect to inventive step relied on taking into account the disclosure of the OPMI-MD microscope. The other document mentioned in the statement of appeal, document D1, played only a subordinate role in the submissions as an illustration of the appellant's view of standard practice. Accordingly, once the alleged prior use is no longer available as prior art within the meaning of Article 52(1) EPC, the entire technical assessment of the microscope involved in this alleged prior use becomes irrelevant to substantive patentability. In other words, the line of argument of the appellant falls apart because the premise upon which it is based is not valid. In consequence, no persuasive reason for challenging inventive step of the subject matter of claim 1 has been presented by the appellant. The board has thus not been presented with any reason for diverging from the position of the opposition division in relation to substantive patentability and therefore does not so do, the change effected to claim 2 not bearing on this issue.

- 8.2 Accordingly, the case advanced by the appellant failed to convince the board that the independent claims are directed to subject matter which cannot be considered to involve an inventive step according to Article 56 EPC.

### 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 with the order to maintain the patent in amended form as follows:

claims 1 to 7 presented at the oral proceedings,  
description and drawings forming the basis of the interlocutory decision dated 17 December 1997, page 4 of the description being replaced by page 4 presented at the oral proceedings.

The Registrar:

The Chairman:

P. Martorana

E. Turrini