



Internal distribution code:

- (A) [] Publication in OJ
(B) [X] To Chairmen and Members
(C) [] To Chairmen
(D) [] No distribution

**Datasheet for the decision
of the Enlarged Board of Appeal
of 25 November 2010**

Case Number: R 0015/10
Appeal Number: T 2030/07 - 3.4.02
Application Number: 96933640.3
Publication Number: 0809126
IPC: G02C 7/06
Language of the proceedings: EN

Title of invention:

Progressive spectacle lens with progressive surface and correction of astigmatism provided on the rear side of the lens

Patentee:

Seiko Epson Corporation

Opponents:

Essilor International (Comp. Générale d'Optique) SA
Rodenstock GmbH
Carl Zeiss AG

Headword:

Fundamental violation of Article 113 EPC/SEIKO

Relevant legal provisions:

EPC Art. 112a(2)(c), 113

Keyword:

"No right to advance indications of the reasons for a decision before it is taken"
"Petition for review - clearly unallowable"

Decisions cited:

R 0001/08, R 0012/09, R 0015/09, R 0018/09, T 0506/91



Case Number: R 0015/10

D E C I S I O N
of the Enlarged Board of Appeal
of 25 November 2010

Petitioner: Seiko Epson Corporation
(Patent Proprietor) 4-1, Nishi-shinjuku 2-chome
Shinjuku-ku
Tokyo 163 (JP)

Representative: Schweighart, Peter
Hoffmann - Eitle
Patent- und Rechtsanwälte
Arabellastrasse 4
D-81925 München (DE)

Other parties: Essilor International (Comp. Générale
(Opponent 01) d'Optique) SA
147 Rue de Paris
F-94220 Charenton le Pont (FR)

Representative: Vignesoult, Serve L. M.
Cabinet Plasseraud
52, rue de la Victoire
F-75440 Paris Cedex 09 (FR)

(Opponent 02) Rodenstock GmbH
Isartalstr. 43
D-80469 München (DE)

Representative: Rocke, Carsten
Müller-Boré & Partner
Grafinger Strasse 2
D-81671 München (DE)

(Opponent 04) Carl Zeiss AG
Carl-Zeiss-Strasse 22
D-73447 Oberkochen (DE)

Representative: Diehl Hermann O. Th.
Diehl & Partner GbR
Postfach 34 01 15
D-80098 München (DE)

Decision under review: **Decision of the Technical Board of Appeal
3.4.02 of the European Patent Office of
30 April 2010.**

Composition of the Board:

Chairman: B. Schachenmann
Members: C. Rennie-Smith
 M. Noël

Summary of Facts and Submissions

- I. The petition for review concerns decision T 2030/07 of the Technical Board of Appeal 3.4.02 of 30 April 2010 dismissing the appeal of the petitioner against the decision of the Opposition Division to revoke its European patent No. 809 126 entitled "Progressive spectacle lens with progressive surface and correction of astigmatism provided on the rear side of the lens". The petition is based on the ground in Article 112a(2)(c) EPC, namely that a fundamental violation of Article 113(1) EPC occurred in the appeal proceedings.
- II. The previous proceedings, to the extent they are relevant for the purposes of the present petition proceedings, can be summarized as follows:
- (a) Four oppositions were filed against the patent, one of which was later withdrawn. At oral proceedings held on 19 September 2007 before the Opposition Division, the petitioner's third auxiliary request was discussed. Claim 1 of this request contained an equation for calculating the coordinates of the eyeglass surface on the side of the eye. This equation comprises a parameter C_p which is defined as the approximate curvature at any point P of the original progressive refractive surface. As appears from points 4.3 and 4.4 of the minutes of those oral proceedings, opponent II objected that this claim was not clear and that the invention was not sufficiently disclosed (Articles 83 and 84 EPC) because the explanation of the approximate curvature C_p given in

paragraphs [35] and [36] of the patent was unclear. The approximate curvature was defined by three points: the vertex at coordinate $(0,0,0)$, point P with the coordinates (X,Y,Z) on the *original* refractive surface and the point P' with the coordinates $(-X,-Y,Z)$. However, as a consequence, C_p must be a point symmetric function and the surface shape according to the equation must then also be point symmetric which would certainly not describe a progressive lens. This auxiliary request was withdrawn. The patent was subsequently revoked by the Opposition Division on the ground that claim 1 of the main request lacked novelty in view of prior art document E1. However, in a section of its decision entitled "Further Remarks", the opposition division commented on the equation and observed that the disclosure of the patent was not sufficiently clear as to how function C_p had to be determined.

- (b) In the appeal proceedings this issue was raised again by opponent II which, in paragraph VI.11 of its letter of 4 September 2008, referred to the definition of the value of approximate curvature C_p according to paragraphs [35] and [36] of the patent and made detailed submissions why the equation defined a surface exhibiting point symmetry rather than a progressive surface. On 2 July 2009 the petitioner filed auxiliary request 3 which contained the equation and also an explanation of the equation taken from column 8, lines 24 to 40, of the patent application. Opponent II objected to this request also (see section XIII, pages 17 to 18, of the decision

under review), again arguing that, when the value of C_p was determined as disclosed in the patent, the equation would define a surface having point symmetry which therefore could not be a progressive surface, and that there was no basis in the patent application for the petitioner's interpretation.

- (c) In the decision under review the Board of Appeal dealt with auxiliary request 3 in point 5 of the reasons. After summarizing the parties' submissions, the Board set out the petitioner's submission

"that only the point P was a point on the original progressive surface, whereas the point P' was a virtual point with point symmetry to the point P relative to the centre (0,0,0) and that this point P' was only used for constructing a circle through these points representing the reciprocal of the curvature sought" (see reasons, point 5.1).

Then, in point 5.3, the Board analysed the basis of auxiliary request 3 in the original application and came to the conclusion that point P' was only characterized as rotationally symmetric to point P and that there was no information that this was also a point on the original progressive surface. Finally, in point 5.4, the Board stated that it concurred with the opponents and concluded

"...in order to make sense of the passage in column 8, the skilled person would probably

understand that point P' should not be a point on the original progressive refractive surface. However, this passage does not give any further indications about the position and function value of this point P'. Also, in spite of the fact that this objection had been discussed already at the oral proceedings before the opposition division, during the appeal proceedings the appellant did not provide any further proofs or support in the patent application documents which could have clarified this question".

III. The petition for review is confined to the treatment by the Board of Appeal of auxiliary request 3 and, in particular, to its discussion of the equation referred to above and the value of C_p in point 5.4 of the reasons. The petitioner's arguments can be summarized as follows:

- (a) The Board gave no indication whatsoever that it was of the opinion that a clear and fully defined mathematical definition of the variables of a mathematical equation could be unclear. Therefore the finding that further indications about the position and function value of point P' should have been provided (see the passage from point 5.4 of the reasons cited in section II above) was highly surprising for the petitioner.
- (b) The petitioner also complained that the oral proceedings before the Board were conducted under great time pressure which might have been a reason why the Board did not give any indication that it

was a further requirement of clarity that a skilled person should understand not only the use of a mathematical equation but also its physical background. No matter whether there was time pressure, the appellant relied on the fact that clarity was established once the meaning of the terms of a claim are clear to the person skilled in the art and should have been informed by the Board that it took another and stricter approach which required the skilled person also to understand the physics behind an equation.

- (c) Therefore, the petitioner's right to be heard was violated since the decision is based on grounds on which it did not have an opportunity to present arguments. The violation was fundamental because it related to the key aspect of claim 1 of the auxiliary request 3 and gave rise to the rejection of the appeal, and because the Board took a position on clarity which is beyond the well established principles for assessing the requirements of Article 84 EPC.

IV. In a communication of 27 October 2010 the Enlarged Board of Appeal informed the petitioner of its provisional view that the petition appeared not to be clearly inadmissible but, for substantially the reasons below, appeared to be clearly unallowable. The petitioner responded by a further written submission of 19 November 2010 in which it provided additional information concerning the equation in auxiliary request 3.

- V. Oral proceedings were held on 25 November 2010 at the end of which the Enlarged Board of Appeal announced its decision.
- VI. The petitioner requested that decision T 2030/07 be set aside and the proceedings before the Board of Appeal 3.4.02 be re-opened, that the members who participated in taking decision T 2030/07 be replaced, and that the fee for the petition be reimbursed in accordance with Rule 110 EPC.

Reasons for the Decision

Admissibility

1. The petition was filed within two months of notification of the decision in question, the petitioner was adversely affected thereby, the prescribed fee was paid in time, and the petition identified grounds contained in Article 112a(2) EPC and complied with Rule 107(1) and (2) EPC.
2. The petition is silent as regards the requirement in Rule 106 EPC to object to a procedural defect during the appeal proceedings. However, since the petitioner's case is that it was not heard on a point which only first appeared from the Board of Appeal's written decision, it could be said that the exception in Rule 106 EPC applies.
3. Accordingly, the petition is not clearly inadmissible.

Allowability

4. It appears from the petition itself (see paragraphs 8 to 13) that the petitioner was at the oral proceedings before the Board of Appeal heard on the only matter with which the petition is concerned - namely, the mathematical equation in claim 1 of the petitioner's auxiliary request 3. Indeed, the petition recites that the Board invited the petitioner's representative to explain the use of the equation (see the petition, paragraph 8, first sentence), what the representative said by way of such explanation (see the balance of paragraph 8 and paragraph 9), and that the Board understood what it was told (see paragraphs 10 and 11).
5. The petition also refers to several passages in the written decision to show that the Board understood the petitioner's submissions. The first reference is to page 10, line 5, which is part of the Board's summary, in section XII of the "Summary of Facts and Submissions", of the petitioner's arguments in support of its auxiliary request 3. This summary runs from page 9, line 9 to page 10, line 28 and is an almost verbatim reproduction of the relevant text of the petitioner's arguments in its letter of 30 March 2010.
6. The second reference is to point 5.2 of the "Reasons for the Decision" in which the Board of Appeal records that the petitioner referred to the minutes of the oral proceedings before the Opposition Division and then summarizes the arguments of the petitioner and the opponents as given in points 4.6 and 4.7 respectively of those minutes. The third reference is to page 33, lines 21 to 24 of the decision which is the penultimate

- sentence of point 5.3 of the reasons (see section II(c) above). The Enlarged Board also notes there are further references to the petitioner's (and the opponents') submissions on the equation in point 5.1 of the reasons.
7. It is therefore beyond all possible doubt that the petitioner was heard in this respect. Indeed, as indicated above, the petitioner relies specifically upon both its written and oral submissions on this issue as recorded by the Board of Appeal in its decision. It is abundantly clear, and not disputed by the petitioner, that the Board heard the arguments of all parties and then decided that those of the opponents should prevail. However, the petitioner's complaint is that in its subsequent written decision the Board of Appeal took a view of the clarity of the claim containing the equation which was not, but should have been, put to the petitioner so that it could have presented arguments on that view.
 8. However, as the Enlarged Board has already indicated in several previous decisions on petitions for review, such complaints do not disclose a denial of the right to be heard. There can be no such denial if a Board of Appeal, after hearing the appellant in ex parte proceedings, or both or all parties in inter partes proceedings, subsequently reaches its own conclusion which is then recorded in its written decision.
 9. That in the present case the Board did not at the oral proceedings indicate, or invite comments on, its own conclusion cannot be a denial of the right to be heard, let alone a denial amounting to a fundamental procedural deficiency. In all but the most clear cut

cases a Board will simply not know before it has finished hearing the parties what its own conclusion may be, let alone the reasons it may give for such a conclusion. However, even if that should not be the case, it would be contrary to a Board's necessary neutrality to assist a party by giving possible reasons for deciding against it (see R 1/08 of 15 July 2008, Reasons, point 3.1; R 18/09 of 27 September 2010, Reasons, point 14). As is clear from the Enlarged Board's jurisprudence, parties are not entitled to advance indications of the reason or reasons for a decision before it is taken (see the summary of the case-law in R 12/09 of 15 January 2010, Reasons, point 11 and the several other decisions there referred to; and subsequent decisions R 15/09 of 5 July 2010, Reasons, point 4; and R 18/09 of 27 September 2010, Reasons, points 14 to 15 and 18).

10. It follows that the petitioner's further argument (see section III(b) above) - that the reason why the Board of Appeal may not have given any indication of its own view was that the oral proceedings were conducted under time pressure - makes no difference. Since the Board was quite correct not to have given the parties any advance indication of its decision, the suggestion (even if correct) that time pressure may have been the reason for not doing so is irrelevant: observing proper procedure, even if paradoxically for an improper reason, cannot amount to a procedural violation. In any event, the Enlarged Board notes that the petitioner argues (see section III(b) above) that it was entitled to be told of the Board's view of the clarity of the equation "no matter whether there was time pressure", which entirely neutralizes the time pressure argument.

Although T 506/91 of 3 April 1992 was concerned with a different situation, the Enlarged Board agrees with the observation in the decision (see Reasons, point 2.7) that shortness of time is not in itself a violation of proper procedure.

11. Similarly, the fact that the petitioner was surprised by the Board's decision can also make no difference. The Board heard both parties and then made a decision by which one party necessarily had to lose. That party may, on reading the decision, be surprised and feel that, if it had known the reasons in advance, it would have argued against them. But such purely subjective surprise cannot with hindsight form the basis for claiming a right to advance notice of reasons for a decision (see R 12/09 of 15 January 2010, Reasons, point 13). While no finding on the point is required, the Enlarged Board notes that in fact the Board of Appeal's decision shows that, in its own view, it concurred with the arguments of the opponents which had been first raised in the opposition proceedings and reiterated on appeal in which case, objectively viewed, the petitioner should not have been surprised (see the passage cited from the reasons, point 5.4 in section II(c) above).

12. The petitioner also argues, although only to support the alleged fundamental nature of the alleged procedural violation, that in its decision the Board of Appeal took a position which is beyond the well established principles of assessment of clarity under Article 84 EPC (see section III(c) above). Since the Enlarged Board finds that there was no denial of the right to be heard and therefore no procedural violation,

there is no question of whether a violation was fundamental. However, it appears that the petitioner's underlying concern, and the source of its surprise on receiving the Board's written decision, was the (as the petitioner believes) more stringent than usual criteria used by the Board for assessing the clarity requirement of Article 84 EPC. Such matters clearly concern the substantive case decided by the Board of Appeal and it is not open to the Enlarged Board in petition proceedings to review the correctness or otherwise of the Board's decision on the application of substantive law (see R 1/08 of 15 July 2008, Reasons, point 2.1 and the *travaux préparatoires* cited there).

13. While again no finding on the point is required, the Enlarged Board also notes that in fact the Board of Appeal's decision shows that, as regards Article 84 EPC, it was the requirement of support rather than that of clarity which was not satisfied. It appears that lack of support was the thrust of the opponents' argument with which the Board, after hearing all the parties, ultimately agreed (see the decision under review, section XIII, pages 17 and 18, particularly the last sentence; reasons, point 5.1, last sentence; point 5.2; point 5.3, particularly the last sentence; and point 5.4).
14. The Enlarged Board accordingly finds the petition clearly unallowable.

Order

For these reasons it is unanimously decided that:

The petition for review is rejected as clearly unallowable.

The Registrar:

The Chairman:

P. Martorana

B. Schachenmann