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D E C I S I O N
of 30 November 2004

Case Number: T 0592/04 - 3.4.2

Application Number: 97912612.5

Publication Number: 0943114

IPC: G02B 23/00

Language of the proceedings: EN

Title of invention:
Viewing instrument

Applicant:
HEED, Björn, et al

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 52(1), 54, 111(1)
EPC R. 86(3)

Keyword:
"Main request - novelty (no)"
"Auxiliary requests - substantial amendments - remittal to
first instance"

Decisions cited:
T 0063/86

Catchword:
-



Case Number: T 0592/04 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 30 November 2004

Appellant: HEED, Björn
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 2 December 2003
refusing European application No. 97912612.5
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. G. Klein
Members: F. J. Narganes-Quijano
J. H. P. Willems

Summary of Facts and Submissions

- I. The appellants (applicants) have lodged an appeal against the decision of the examining division to refuse European patent application No. 97912612.5 (based on the International application No. PCT/SE97/01846 published as WO98/26321).

In the decision under appeal the examining division held that claim 1 then on file did not define new subject-matter (Articles 52(1) and 54 EPC) with regard to the prior art cited in the decision, and in particular with regard to document

D7 : US-A-4 516 157.

- II. The appellants requested that the decision under appeal be set aside and that "the case be remitted back to the first instance for a decision on novelty (Article 54 EPC)" on the basis of claim 1 as amended according to a main request and first to fourth auxiliary requests filed with the statement setting out the grounds of appeal.

The appellants also requested oral proceedings "in case none of the above requests is preliminary granted".

Claim 1 according to the main request reads as follows:

"An instrument for real-time observation of distant objects, characterised in that it is provided with a memory function to freeze the image being viewed by the user."

Claim 1 according to the first auxiliary request reads as follows:

"A hand-held telescopic real-time observation instrument for distant objects, comprising at least one line-of-sight, each line-of-sight being provided with a set of optical lenses, having a first zoom-state, and having electronic retina means registering a presented real-time observation, and an electronic display screen showing an image of said presented real-time observation, characterised in that said display screen is having two display modes: a real-time display mode, and a still-image display mode, said display screen being adapted to exclusively show only one display mode at a time at the choice of a user of said instrument by control means, wherein said display screen in said still-image display mode is being adapted to freeze said presented real-time observation and said instrument is assuming a second zoom-state in order to further magnify said frozen image."

The wording of claim 1 according to the second to fourth of the auxiliary requests is not relevant to the present decision.

III. In a communication under Article 110(2) EPC the Board expressed the preliminary view that the subject-matter of claim 1 according to the main request did not appear to be novel with regard to document D7, and that in any case if the claim were to be construed according to the appellants' submissions, then the claim would not appear to define new subject-matter with regard to the disclosure of document

D8 : US-A-5 026 158

cited from the Board's own knowledge. The Board also noted that consideration of the first to fourth auxiliary requests would require the remittal of the case to the first-instance department, and that in view of the formulation of the appellants' subsidiary request for oral proceedings, oral proceedings were not considered necessary.

IV. In reply to the Board's communication, the applicants expressed their agreement with the Board's finding that there was no need for oral proceedings and declared that they did not have any further comments on the content of the communication.

V. The arguments of the appellants in support of their requests are essentially the following:

The examining division failed to interpret the claimed subject-matter as prescribed by Article 69(1) EPC. Claim 1 amended according to the main request recites a telescopic instrument such as a telescope or binoculars aimed for real-time observation of objects. Furthermore, the claim refers to "distant objects", i.e. objects that appear small against a large background and are at a distance greater than the overall length of the instrument. In addition, the claimed instrument is designed so that the user can freeze, within the viewing field of the instrument, the magnified image of the object being viewed by the user. The invention therefore solves the problem of instability inherent to hand-held instruments operating at a high magnification

and none of the documents considered by the examining division discloses all these features.

Reasons for the Decision

1. The appeal complies with the requirements mentioned in Rule 65(1) EPC and is therefore admissible.
2. *Main request*
 - 2.1 Document D7 discloses an instrument comprising a pair of spectacles for real-time observation of objects (abstract and Figures 1 to 7 together with the corresponding description). The instrument includes a video recording device (column 1, lines 47 to 59) or an electronic still camera provided with a buffer memory (column 5, lines 20 to 25), the memory function of the video device and of the still camera being arranged to freeze the image being viewed by the user through a frame mounted on one of the lenses of the spectacles (column 2, lines 52 to 58, column 3, lines 27 to 33, and column 5, lines 46 to 55) so that the image is recorded as a still picture as in an electronic still camera (abstract and column 6, lines 6 to 8). In addition, the instrument disclosed in document D7 is also suitable for observing distant objects and for recording an image of the distant objects by means of the zoom facility of the instrument (column 4, lines 5 to 23).

Therefore, the instrument disclosed in document D7 anticipates all the structural and functional features of the instrument defined in claim 1 of the main request.

- 2.2 The appellants have referred to Article 69(1) EPC and essentially submitted that the claim recites a telescopic instrument, that by "distant objects" is meant objects that appear small against a large background and are at a distance greater than the overall length of the instrument, and that the claimed instrument is designed to freeze within the viewing field of the instrument the magnified image being viewed by the user.

However, none of the structural and functional features defined in claim 1 - and which features determine the matter for which protection is sought, see Article 84 EPC, first sentence together with Rule 29(1) EPC - reflect the features alleged by the appellants and therefore the appellants' construction of the claimed subject-matter is not supported by the actual wording of the claim. Consequently, the Board does not find persuasive the arguments submitted by the appellant.

In addition, even if the claimed subject-matter were to be construed as submitted by the appellants, i.e. as implicitly including the further features mentioned, then claim 1 of the main request would not define new subject-matter with regard to the telescopic sighting instrument disclosed in document D8 (abstract and Figures 1 to 8 together with the corresponding description). This instrument 10 is designed to observe in real-time objects 74 located at a distance greater

than the overall length of the instrument (Figures 7A and 7B) and is provided with memory means arranged to freeze the image being viewed by the user in a screen of the display 31 of the instrument in such a way that the user sees in the screen a frozen magnified image of the object (column 5, lines 40 to 59, and column 8, lines 2 to 8).

- 2.3 In view of the foregoing, claim 1 according to the main request and corresponding in essence with claim 1 on which the decision was based does not define patentable subject-matter within the meaning of Articles 52(1) and 54 EPC.

3. *First to fourth auxiliary requests - Further prosecution*

Claim 1 according to the first auxiliary request (see point II above) as well as claim 1 according to the remaining second to fourth auxiliary requests result from substantial amendments made to the claim 1 on which the contested decision was based. These amendments involve, among others, the provision of an electronic display screen operating in two display modes as well as the operation of the instrument in two different zoom states and are such that they substantially change the factual framework of the case under appeal compared with that upon which the decision was based, thus resulting in the Board being presented with a fresh case. In addition, it is current practice that any assessment of a new case should normally be carried out by the first-instance department so that the appellants are not deprived of the possibility of a subsequent review.

In view of the above, the Board considers it appropriate in the circumstances of the case to make use of its discretionary powers under Article 111(1) EPC and to remit the case to the examining division for further prosecution on the basis of the amended claims according to the first to fourth auxiliary requests. In addressing the remitted case, the examining division will have to consider whether to admit the amended auxiliary requests in the exercise of its discretion under Rule 86(3) EPC, last sentence (see decision T 63/86, OJ EPO 1988, 224, point 2 of the reasons) and, if such a discretion is favourably exercised, examine whether the amended claimed subject-matter according to the auxiliary requests comply with both the formal (see in particular Article 123(2) and 84 EPC) and the substantive (Articles 52(1), 54 and 56 EPC) requirements of the EPC.

4. *Request for oral proceedings*

Since the appeal is not being dismissed and the remittal of the case for further prosecution conforms, at least as far as the auxiliary requests are concerned, to the requests formulated by the appellants (point II above), there is no need to appoint oral proceedings as confirmed by the appellants in their reply to the Board's communication (point IV above).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

P. Martorana

A. G. Klein