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**Datasheet for the decision
of 24 January 2022**

Case Number: T 1797/17 - 3.2.07

Application Number: 02024899.3

Publication Number: 1310327

IPC: B24B9/14, B28D1/14

Language of the proceedings: EN

Title of invention:
Eyeglass lens processing apparatus

Patent Proprietor:
Nidek Co., Ltd.

Opponent:
Satisloh AG

Headword:

Relevant legal provisions:

EPC Art. 123(2), 123(3)
RPBA Art. 12(4)
RPBA 2020 Art. 25(2)

Keyword:

Amendments - main request and auxiliary requests 1 to 6 -
extension beyond the content of the application as filed (yes)
- auxiliary request 7 - extension of the protection conferred
by the patent (yes) - allowable (no)
Late-filed requests - submitted with the statement of grounds
of appeals - admitted (no)

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 1797/17 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 24 January 2022

Appellant:
(Patent Proprietor)
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 9 June 2017 revoking European patent No. 1310327 pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman I. Beckedorf
Members: A. Cano Palmero
S. Watson

Summary of Facts and Submissions

- I. The patent proprietor (appellant) lodged an appeal within the prescribed period and in the prescribed form against the decision of the opposition division revoking European patent No. 1 310 327.
- II. The opposition was filed on the grounds according to Articles 100(a) EPC (lack of novelty and inventive step) and 100(c) EPC (added subject-matter).
- III. The opposition division held
- (a) that claim 1 of the main request and of auxiliary requests 1 to 7 did not fulfill the requirements of Article 123(2) EPC, and
 - (b) that claim 1 of auxiliary request 7 did not fulfill the requirements of Article 123(3) EPC.
- IV. The appellant requested
- that the decision under appeal be set aside and that the patent be maintained in amended form according to one of the sets of claims filed as main request or auxiliary requests 1 to 7 before the opposition division, re-filed with the statement setting out the grounds of appeal, or, in the alternative,
- that the patent be maintained in amended form according to one of the sets of claims filed as auxiliary requests 8 to 15 with the statement setting out the grounds of appeal.

- V. The opponent (respondent) requested
that the appeal be dismissed.
- VI. In preparation for oral proceedings, scheduled upon the parties' requests, the Board communicated its preliminary assessment of the case to the parties by means of a communication pursuant to Article 15(1) RPBA 2020, according to which the appeal was likely to be dismissed.
- VII. Oral proceedings before the Board were held on 24 January 2022. At the conclusion of the proceedings the decision was announced. For further details of the oral proceedings, in particular the issues discussed with the parties, reference is made to the minutes.
- VIII. The lines of arguments of the parties, which are focused on the compliance of Article 123(2) EPC of the main request and of auxiliary requests 1 to 6, on the compliance of Article 123(3) EPC of auxiliary request 7, and on the admittance of auxiliary requests 8 to 15 into the appeal proceedings, are dealt with in detail in the reasons for the decision.
- IX. Independent claim 1 of the **main request** reads:

"An eyeglass lens processing apparatus for processing a periphery of an eyeglass lens (LE), comprising:
a lens holding shaft (702L, 702R) which holds the lens (LE) and rotates the lens (LE) about a first axis;
a piercing tool (835) which pierces through the lens (LE) to form a hole in the lens (LE); and
a holder which rotatable holds the piercing tool (835), the holder being a rotation part (830);

a grinding stone holder, the grinding stone holder being the rotation part (830), wherein the rotation part (830) holds the piercing tool (835) and a grinding stone portion (836); and means (420) for inputting data of a position of the hole, and characterized by means (520) for measuring a shape of a front surface of the lens (LE); determining means (160) for determining an angle of a normal direction of the hole with respect to the first axis based on data of the front surface shape of the lens (LE) and the data of the position of the hole; inclination means for changing the angle of the inclination direction of the hole by the piercing tool based on a determination result of the determining means (160); and control means for controlling rotation of the lens rotation shaft (702L, 702R) and inclination by the inclination means based on the determined normal direction."

X. Independent claim 1 of **auxiliary request 1** reads:

"An eyeglass lens processing apparatus for processing a periphery of an eyeglass lens (LE), comprising: a lens holding shaft (702L, 702R) which holds the lens (LE) and rotates the lens (LE) about a first axis; a piercing tool (835) which pierces through the lens (LE) to form a hole in the lens (LE); and means (420) for inputting data of a position of the hole, characterized in that a rotation part (830) holding the piercing tool (835) and a grinding stone portion (836) is attached to the leading end portion of a common support base (810), and characterized by

means (520) for measuring a shape of a front surface of the lens (LE);
determining means (160) for determining an angle of a normal direction of the hole with respect to the first axis based on data of the front surface shape of the lens (LE) and the data of the position of the hole;
inclination means for changing the angle of the inclination direction of the hole by the piercing tool based on a determination result of the determining means (160); and
control means for controlling rotation of the lens rotation shaft (702L, 702R) and inclination by the inclination means based on the determined normal direction."

XI. Independent claim 1 of **auxiliary request 2** reads:

"An eyeglass lens processing apparatus for processing a periphery of an eyeglass lens (LE), comprising:
a lens holding shaft (702L, 702R) which holds the lens and rotates the lens about a first axis;
a piercing tool (835) which pierces through the lens to form a hole in the lens; and
means (420) for inputting data of a position of the hole,
characterized in that a rotation part (830) holding the piercing tool (835) and a grinding stone portion (836) is attached to the leading end portion of a common support base (810),
wherein the common support base (810) is rotatably supported by bearings onto a further support base (804), and
wherein at one side of the bearing (811), a gear (813) to rotate the common support base (810) is fixed to the common support base (810),
and characterized by

means (520) for measuring a shape of a front surface of the lens or communications system for inputting data regarding the shape of the front surface of the lens; means (160) for determining an angle of a normal direction of the hole with respect to the first axis based on data of the front surface shape of the lens and the data of the position of the hole; inclination means for changing the angle of the inclination direction of the hole by the piercing tool based on a determination result of the determining means; and control means for controlling rotation of the lens rotation shaft (702L, 702R) and inclination by the inclination means based on the determined normal direction."

XII. Independent claim 1 of **auxiliary request 3** reads:

"An eyeglass lens processing apparatus for processing a periphery of an eyeglass lens (LE), comprising: a lens holding shaft (702L, 702R) which holds the lens (LE) and rotates the lens (LE) about a first axis; a piercing tool (835) which pierces through the lens (LE) to form a hole in the lens (LE); and means (420) for inputting data of a position of the hole, characterized in that a rotation part (830) holding the piercing tool (835) and a grinding stone portion (836) is attached to the leading end portion of a common support base (810), wherein the common support base (810) is rotatably supported by bearings onto a further support base (804), wherein at one side of a bearing (811), a gear (813) to rotate the common support base (810) is fixed to the common support base (810), and

wherein a pulley (832) is attached to a center portion of a rotation shaft (831) of the rotation part (830) and the shaft (831) is rotatably supported by bearings (834),
and characterized by
means (520) for measuring a shape of a front surface of the lens (LE);
determining means (160) for determining an angle of a normal direction of the hole with respect to the first axis based on data of the front surface shape of the lens (LE) and the data of the position of the hole;
inclination means for changing the angle of the inclination direction of the hole by the piercing tool based on a determination result of the determining means (160); and
control means for controlling rotation of the lens rotation shaft (702L, 702R) and inclination by the inclination means based on the determined normal direction."

XIII. Independent claim 1 of **auxiliary request 4** reads:

"An eyeglass lens processing apparatus for processing a periphery of an eyeglass lens (LE), comprising:
a lens holding shaft (702L, 702R) which holds the lens (LE) and rotates the lens (LE) about a first axis;
a piercing tool (835) which pierces through the lens (LE) to form a hole in the lens (LE);
a holder which rotatable holds the piercing tool (835);
and
means (420) for inputting data of a position of the hole,
characterized in that the holder holds at least one of a grooving grinding stone (836b) for forming a groove in an edge surface of the lens (LE) and a chamfering grinding stone (836a) for chamfering an edge comer of

the lens (LE) to be rotatable coaxially with respect to the piercing tool (835), and characterized by means (520) for measuring a shape of a front surface of the lens;
determining means (160) for determining an angle of a normal direction of the hole with respect to the first axis based on data of the front surface shape of the lens (LE) and the data of the position of the hole;
inclination means for changing the angle of the inclination direction of the hole by the piercing tool (835) based on a determination result of the determining means (160); and
control means for controlling rotation of the lens rotation shaft (702L, 702R) and inclination by the inclination means based on the determined normal direction."

XIV. Independent claim 1 of **auxiliary request 5** reads:

"An eyeglass lens processing apparatus for processing a periphery of an eyeglass lens (LE), comprising:
a lens holding shaft (702L, 702R) which holds the lens (LE) and rotates the lens (LE) about a first axis;
a piercing tool (835) which pierces through the lens (LE) to form a hole in the lens (LE); and
means (420) for inputting data of a position of the hole,
characterized in that a rotation part (830) holding the piercing tool (835) and a grinding stone portion (836) is attached to the leading end portion of a common support base (810),
and characterized by
means (520) for measuring a shape of a front surface of the lens (LE);
determining means (160) for determining an angle of a normal direction of the hole with respect to the first

axis based on data of the front surface shape of the lens (LE) and the data of the position of the hole; inclination means for changing the angle of the inclination direction of the hole by the piercing tool based on a determination result of the determining means (160), and control means for controlling rotation of the lens rotation shaft (702L, 702R) and inclination by the inclination means based on the determined normal direction, moving means for moving the piercing tool (835) between a piercing position and a retreat position, wherein the control means controls movement by the moving means, based on the piercing data; and protection means (900) for protecting the piercing tool (835) moved to the retreat position."

XV. Independent claim 1 of **auxiliary request 6** reads:

"An eyeglass lens processing apparatus for processing a periphery of an eyeglass lens (LE), comprising a lens holding shaft (702L, 702R) which holds the lens (LE) and rotates the lens (LE) about a first axis; a piercing tool (835) which pierces through the lens (LE) to form a hole in the lens (LE); a holder which rotatable holds the piercing tool (835); and means (420) for inputting data of a position of the hole, characterized in that the holder holds at least one of a grooving grinding stone (836b) for forming a groove in an edge surface of the lens (LE) and a chamfering grinding stone (836a) for chamfering an edge corner of the lens (LE) to be rotatable coaxially with respect to the piercing tool (835), and characterized by

means (520) for measuring a shape of a front surface of the lens;
determining means (160) for determining an angle of a normal direction of the hole with respect to the first axis based on data of the front surface shape of the lens (LE) and the data of the position of the hole;
inclination means for changing the angle of the inclination direction of the hole by the piercing tool (835) based on a determination result of the determining means (160); and
control means for controlling rotation of the lens rotation shaft (702L, 702R) and inclination by the inclination means based on the determined normal direction;
moving means for moving the piercing tool (835) between a piercing position and a retreat position, wherein the control means controls movement by the moving means, based on the piercing data; and
protection means (900) for protecting the piercing tool (835) moved to the retreat position."

XVI. Independent claim 1 of **auxiliary request 7** reads:

"An eyeglass lens processing apparatus for processing a periphery of an eyeglass lens (LE), comprising
a lens rotation shaft (702L, 702R) which holds the lens (LE) and rotates the lens (LE) about a first axis;
a piercing tool (835) which pierces through the lens (LE) to form a hole in the lens (LE); and
means (420) for inputting data of a position of the hole,
characterized in that a rotation part (830) holding the piercing tool (835) and a grinding stone portion (836) is attached to the leading end portion of a common support base (810),

wherein the common support base (810) is rotatably supported by bearings onto a further support base (804),
wherein at one side of a bearing (811), a gear (813) to rotate the common support base (810) is fixed to the common support base (810), and
wherein a pulley (832) is attached to a center portion of a rotation shaft (831) of the rotation part (830) and the shaft (831) is rotatably supported by bearings (834),
and characterized by
means (520) for measuring a shape of a front surface of the lens (LE);
calculation means (160) for obtaining normal direction data of the hole based on data of the front surface shape of the lens (LE) and the data of the position of the hole by measuring at least three points (Q1, Q2, Q3, Q4) around a hole position (P1) and approximately deriving a tangential plane (S) at the hole position (P1) from the measured results and by calculating the normal direction as a vertical direction of the tangential plane (S) at the hole position (P1);
a memory (161) for storing the normal direction data,
inclination means for changing the angle of the inclination direction of the hole by the piercing tool based on a determination result of the determining means (160); and
control means for controlling an inclined angle (α_1) of the rotation shaft (831) and the rotation angle (θ_1) of the lens (LE) based on the determined normal direction."

XVII. Since the wording of the claims according to auxiliary requests 8 to 15 is not relevant for the present decision, there is no need to reproduce it here.

Reasons for the Decision

1. *Transitional provisions*

The appeal proceedings are governed by the revised version of the Rules of Procedure which came into effect on 1 January 2020 (Articles 24 and 25(1) RPBA 2020), except for Article 12(4) to (6) RPBA 2020 instead of which Article 12(4) RPBA 2007 remains applicable (Article 25(2) RPBA 2020).

2. *Main request - Added subject-matter, Article 123(2) EPC*

2.1 The feature (identified by the parties as feature 1.8)

"determining means (160) for determining an angle of a normal direction of the hole with respect to the first axis based on data of the front surface shape of the lens (LE) and the data of the position of the hole"

has been introduced in claim 1 according to the main request.

2.2 According to the appellant, the determination of this angle and therefore the determining means is implicitly disclosed in original claims 1, 2, and 9. The originally filed description, page 1, lines 14 to 17 (corresponding to paragraph [0003] of the description according to the patent as granted) and figures 8B and 11B further support the disclosure of such angle determining means.

2.3 The appellant further argued that the inclination of the inclination means is only defined with respect to the first axis. Furthermore, according to original claim 2, which has now been introduced into claim 1,

the inclination with respect to the first axis is controlled based ultimately on the determined normal direction, which according to claim 9 is calculated by "calculation means for **obtaining a normal direction** at the hole position in the lens front surface". By doing so, the angle between the normal direction and the first axis inevitably has to be determined, at least at some point during the controlling step.

- 2.4 The Board cannot share this view and follows the reasoned findings of the opposition division in point 2.3.2 of the reasons of the decision under appeal. Indeed, according to the application as originally disclosed, only the orientation of the hole position in the normal direction to the lens surface is required to be established. This orientation is obtained by calculation means as disclosed in original claim 9. The obtained normal direction may be defined with reference to any appropriate reference system. When controlling the inclination of the inclination means based on this calculated normal direction, this will logically be performed with respect to the same reference system. The Board thus concurs with the opposition division that there is no need to additionally determine an angle of the normal direction of the hole with respect to the first axis of the lens rotation shaft, as is now required in amended claim 1. Although the holder is inclined with respect to the first axis during processing, the original disclosure does not require the determination of the angle between the normal direction of the hole and the first axis as such, only the calculation of the normal direction to the lens surface. That the holder is inclined to the first axis as a result of controlling the inclination based on the normal direction, and that such angle exists, as identified *inter alia* in figures 8B and 11B, does not

amount to an implicit disclosure of determining means for determining an angle of a normal direction of the hole with respect to the first axis, as it is now required by amended claim 1.

- 2.5 The skilled person is therefore presented with determining means that were not originally disclosed, so that **the subject-matter of claim 1 according to the main request extends beyond the original disclosure**, contrary to the requirements of Article 123(2) EPC.

3. *Auxiliary requests 1 to 6 - Added subject-matter, Article 123(2) EPC*

Auxiliary requests 1 to 6 contain the same amended feature 1.8. The appellant confirmed that the same critical subject-matter was present in those auxiliary requests, which, for the same reasons as for the main request, also extend beyond the original disclosure.

4. *Auxiliary request 7 - Extension of protection, Article 123(3) EPC*

- 4.1 In claim 1 of auxiliary request 7 the feature "means (160) for determining an angle of a normal direction of the hole with respect to the first axis" has been deleted with respect to claim 1 as granted.

- 4.2 The appellant argued in point 3 of its statement of grounds of appeal and in its letter of 13 August 2018, that the scope of protection has not been extended, since it is technically necessary and a structural requirement to determine the angle to the normal direction when driving the inclination means, and that these determination means must be included within the calculation means for obtaining normal direction data

of the hole as in amended claim 1 of the auxiliary request 7.

4.3 The Board disagrees. As it has been concluded in point 2.4 above, the calculation of the normal direction of the hole and the subsequent control of the inclination means does not require or necessarily include the determination of the angle between this normal direction and the first axis, let alone the corresponding determining means.

4.4 It follows that the cancellation of said means for determining such angle results in an extension of the scope of the protection conferred by the patent as granted, contrary to the requirements of Article 123(3) EPC.

5. *Admittance of auxiliary requests 8 to 15 - Article 12(4) RPBA 2007*

5.1 Auxiliary requests 8 to 15 were filed by the appellant for the first time with the statement setting out the grounds of appeal. Their admittance into appeal proceedings is subject to the Board's discretion pursuant to Article 12(4) RPBA 2007.

5.2 The appellant argued that these requests were filed in order to overcome the reasoned findings of the opposition division in point 2.3.3 of the reasons for the decision under appeal regarding the feature identified as 1.11:

"control means for controlling rotation of the lens rotation shaft (702L, 702R) and inclination by the inclination means based on the determined normal direction."

- 5.3 According to the appellant, this issue had never been discussed during opposition proceedings, including the oral proceedings before the opposition division. Since this objection appeared for the first time in the reasons for the decision under appeal the right to be heard of the appellant had been violated, which justified the submission of auxiliary requests 8 to 15 at the first possible opportunity to react, namely with the statement of grounds of appeal.
- 5.4 The Board, taking into account that the respondent contested the appellant's statement that the matter was not discussed during the oral proceedings before the opposition division, is not convinced by the arguments of the appellant, for the following reasons.
- 5.4.1 The Board notes that during opposition proceedings, the feature in question was objected to by the respondent at least under point C.3 of its written submissions dated 15 March 2017. Furthermore, according to point 2.1 of the minutes of the oral proceedings before the opposition division, "*[t]he opponent was of the opinion that the amendments in claim 1 [of the main request] in the passages relating to the grinding stone holder, the determining means **and the control means** result into an intermediate generalisation of an embodiment*" (emphasis added by the Board). It appears therefore that each of the objections corresponding to points C.1, C.2 and C.3 of the letter dated 15 March 2017 were orally relied upon by the respondent during the oral proceedings before the opposition division. The statement of the appellant, that the objection had been dealt with for the first time in the decision under appeal remains thus a mere allegation.

5.4.2 Further, according to the minutes, point 2.5, after deliberation of the opposition division on all issues regarding Article 123(2) EPC, the chairman stated that the feature regarding the "determining means" amounted to an infringement of Article 123(2) EPC, without giving any indication that the further objections were unsuccessful. It follows that the appellant cannot be surprised by the findings of point 2.3.3 of the reasons for the decision under appeal, which are based on grounds on which the parties had an opportunity to comment, in accordance with Article 113(1) EPC.

5.4.3 The Board notes moreover that although according to point 3.3 of the minutes the appellant at a later stage of the oral proceedings *"expressed his willingness to file further amendments in order to take some of the objections [under Article 123(2) EPC] into account."*, it also refrained from submitting further requests after being asked by the opposition division (see point 3.4 of the minutes).

5.5 In summary, the Board is convinced of the following:

- that the appellant was aware of the objection raised by the respondent under Article 123(2) EPC regarding feature 1.11 before oral proceedings before the opposition division took place;
- that the issue was discussed during such oral proceedings; and
- that after the discussion on the decisive objections under Article 123(2) EPC took place, the appellant was given the opportunity for filing additional requests addressing these objections.

In view of this, the Board concludes that the submission of additional requests for the first time in

appeal proceedings has not been convincingly justified, and that the appellant could and should have filed auxiliary requests in an attempt to overcome the issue based on feature 1.11 during opposition proceedings.

5.6 The Board, considering that the main aim of appeal proceedings is that of reviewing the decisions of the administrative departments of the EPO (Article 12(2) RPBA 2020), does not consider it appropriate that the appellant starts a completely fresh case in appeal, thereby avoiding having a decision from the competent EPO department.

5.7 Therefore, the Board, exercising its discretion under Article 12(4) RPBA 2007 **does not admit auxiliary requests 8 to 15 into the proceedings.**

6. *Conclusions*

It follows from the above that the appellant has not convincingly demonstrated the incorrectness of the relevant findings of the opposition division in the decision under appeal. Further, in the absence of any admissible and in its substance allowable request from the appellant, the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated