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**Datasheet for the decision
of 15 December 2022**

Case Number: T 2826/18 - 3.4.02

Application Number: 07301758.4

Publication Number: 2028531

IPC: G02C13/00

Language of the proceedings: EN

Title of invention:

Method of selecting a semi-finished ophthalmic lens according to a given spectacle frame

Patent Proprietor:

Essilor International

Opponent:

Carl Zeiss Vision International GmbH

Headword:

Relevant legal provisions:

EPC Art. 54(1)

RPBA Art. 12(2), 12(4), 13(1)

Keyword:

Novelty - main request (no)

Late-filed request - auxiliary requests 1 to 5 - lack of
substantiation - admitted (no)

Late-filed substantiation - justification for late filing (no)

Late-filed evidence - admitted (no)

Decisions cited:

Catchword:



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Case Number: T 2826/18 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 15 December 2022

Appellant: Carl Zeiss Vision International GmbH
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
2 October 2018 concerning maintenance of the
European Patent No. 2028531 in amended form.**

Composition of the Board:

Chairman R. Bekkering
Members: A. Hornung
G. Decker

Summary of Facts and Submissions

- I. The opponent appealed against the interlocutory decision of the opposition division maintaining European patent No. 2028531 in amended form.

Opposition had been filed against the patent as a whole and based on the grounds for opposition of Article 100(a) EPC, together with Articles 54(1) and 56 EPC, and Article 100(b) EPC.

The opposition division had found that the patent as amended according to a new main request filed with a letter dated 25 August 2017 and the invention to which it related met the requirements of the EPC.

- II. Oral proceedings before the board were held on 15 December 2022.
- III. The opponent-appellant requested that the decision under appeal be set aside and that the patent be revoked.

The patentee-respondent requested that the appeal be dismissed. Alternatively, it requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the claims according to one of the first to fifth auxiliary requests filed with the letter dated 2 February 2021.

- IV. The following documents will be referred to in the present decision:

E1: WO 01/84215 A1,

annexes 1 to 5, introduced by the patentee with the letter dated 2 February 2021,

documents A1 to A3 introduced during the oral proceedings before the board:

A1: "Face (de la monture)", ZEISS:<https://dicoptic.fr/>, pages 1 to 3,

A2: "Base du verre", ZEISS:<https://dicoptic.fr/>, pages 1 and 2,

A3: "Base monture", <https://dicoptic.fr/>, pages 1 to 3.

V. The opponent's written submissions are designated O1 and O2 as follows:

O1: statement of grounds of appeal,

O2: letter dated 8 September 2022.

The patentee's written submissions are designated P1 and P2 as follows:

P1: letter dated 24 June 2019,

P2: letter dated 2 February 2021.

VI. Independent claim 1 according to the patentee's main request reads as follows (the features of claim 1 are preceded by the numbering **1A** to **1D**, as defined in the appealed decision, point 8.1):

"1A A method of selecting a semi-finished ophthalmic lens according to a given spectacle frame comprising the steps of:

1B - providing the spectacle frame front face base data

1C - providing a list of semi-finished ophthalmic lenses with a plurality of front face bases,

1D - selecting from the list of semi-finished ophthalmic lenses the semi-finished ophthalmic lens whose front face

base is the closest to the front face base of the spectacle frame".

Reasons for the Decision

1. Main request - Novelty

The subject-matter of claim 1 lacks novelty with respect to the disclosure of document E1 (Article 54(1) EPC).

1.1 Claim construction

Features **1B** and **1D** comprise the obscure wordings "spectacle frame front face base data" and "front face base of the spectacle frame", respectively, which, hence, require interpretation.

1.1.1 These two expressions are neither defined in the patent nor do they have a well-defined meaning in the art. Therefore, they have to be interpreted in the broadest reasonable sense. The board, in view of the arguments presented by the opponent in its statement of grounds of appeal, point II.2, is of the opinion that the expressions "spectacle frame front face base data" of feature **1B** and "front face base of the spectacle frame" of feature **1D** refer to data generally describing a spectacle frame with respect to its supporting function of a lens, namely the three-dimensional shape of the frame rim.

The patent discloses a plurality of embodiments of the invention comprising steps of providing *geometrical data of the spectacle frame* (see e.g. paragraphs [0080] to [0082]; figures 6 to 9 and paragraphs [0116] to [0121]), wherein the geometrical data may comprise "3 dimensional data of the spectacle frame, 2 dimensional data of the spectacle

frame and curve data of the spectacle frame, an internal profile data of the rim of the spectacle frame" (paragraph [0082]). As submitted by the opponent (O1, page 6, last paragraph), these embodiments show that claim 1 and, hence, the expressions "spectacle frame front face base data" and "front face base of the spectacle frame" encompass a variety of embodiments in which the specific curvature of the front surface of the frame is irrelevant, contrary to the patentee's submissions. Therefore, the board concurs with the opponent that the two expressions cover any data describing the outline or the rim of a spectacle frame (O1, page 7, fourth paragraph).

1.1.2 In order to explain the meaning of the expressions "spectacle frame front face base data" and "front face base of the spectacle frame", the patentee referred to documents A1 to A3 and to annexes 1 to 5. These documents were not admitted into the proceedings for the reasons given in points 1.1.3 and 1.1.4 below.

1.1.3 Admittance of documents A1 to A3

Documents A1 to A3, filed by the patentee during the oral proceedings before the board, are not admitted into the proceedings under Article 13(1) RPBA 2007.

(a) In order to explain the meaning of the expressions "spectacle frame front face base data" and "front face base of the spectacle frame" the patentee submitted documents A1 to A3 during oral proceedings before the board. The patentee explained that these documents had been found just shortly before the date of the oral proceedings, that they were highly relevant to understand the meaning of the expression "spectacle frame front face base data" and that these documents were known to the opponent for having published them.

(b) The opponent denied that it knew these documents A1 to A3 and stated that the website dicoptic.fr, where the patentee had allegedly found documents A1 to A3, was neither run nor configured by the opponent Zeiss. As further submitted by the opponent, none of the documents A1 to A3 actually comprised the wording "spectacle frame front face base data" and, hence, could not provide reliable support for the patentee's interpretation of the contentious expression. Moreover, the interpretation of the expression "spectacle frame front face base data" had been one of the main contentious points between the parties since the beginning of the opposition proceedings. Therefore, documents A1 to A3 should not be admitted into the proceedings.

(c) The board concurs with the opponent that submitting evidence at such a late stage of the proceedings without any good reasons is generally not acceptable under the Rules of Procedure of the Boards of Appeal in the version of 2007. Therefore, the board exercises its discretion under Article 13(1) RPBA 2007 (applicable pursuant to Article 25(3) RPBA 2020) in not admitting documents A1 to A3 into the proceedings.

1.1.4 Admittance of annexes 1 to 5, filed with letter P2

Annexes 1 to 5, filed with letter P2, are not admitted into the proceedings under Article 13(1) RPBA 2007.

(a) In order to explain the meaning of the expressions "spectacle frame front face base data" and "front face base of the spectacle frame" the patentee further referred to annexes 1 to 5, filed with its letter P2. In the patentee's view, annexes 1 to 5 had to be

admitted into the proceedings because they had already been filed during the first-instance proceedings and, therefore, had been known to the opponent and the EPO even before the appeal proceedings started. Moreover, annexes 1 to 5 had been filed approximately 1,5 years before the date of the oral proceedings before the board, meaning that there had been sufficient time for the opponent to study these annexes.

(b) The opponent submitted that since annexes 1 to 5 had not been filed with the patentee's reply to the opponent's statement of grounds of appeal, they were late-filed. Moreover, annexes 1 to 5 were not able to provide evidence for the patentee's interpretation of the expression "spectacle frame front face base data" because this expression was not even disclosed in annexes 1 to 5 (O2, point III). Still further, the opponent showed that none of the annexes 1 to 5 clearly comprised a date of publication earlier than the date of filing of the patent application.

(c) In view of the annexes 1 to 5 being late-filed, their lack of prima facie high relevance and the doubt about whether they form part of the prior art, the board exercises its discretion under Article 13(1) RPBA 2007 in not admitting annexes 1 to 5 into the proceedings.

1.1.5 According to the patentee (P1, point I.1), "the term '*front face base*' is used by analogy to the terms used for the lens and refers to the shape, in particular the curvature, of the front surface of the frame". During oral proceedings before the board and in its letter P2, point I.1, the patentee explained that the expression "front face base" is known in the art to mean "base curve" or "base" and "[a]ll these terms refer to the same parameter, namely the curvature, expressed in dioptres, of

the front surface of a spectacle frame or of an ophthalmic lens" (P2, page 3, third paragraph). To support this view, the patentee referred to various paragraphs of the patent, such as [0004], [0007] and [0023]. In particular, paragraph [0004] disclosed that "the curvature of the front face is called a 'base-curve'".

In conclusion, the patentee argued that the expressions "spectacle frame front face base data" and "front face base of the spectacle frame" have to be interpreted as meaning "curvature of the spectacle frame".

1.1.6 The board is not convinced by the patentee's arguments for the following reasons:

- Assuming that a "front face base" of a lens corresponded to the curvature of the front face of the lens, a "front face base" of a spectacle frame cannot correspond by mere analogy to the curvature of the front face of a frame because a lens and a spectacle frame are items of a completely different nature: the lens is an optical item having a continuous optical surface whose precisely defined curvature is an essential feature of the lens, whereas the frame is a ring-shaped mechanical item for which the more vaguely defined curvature is of less relevance.

- A spectacle frame generally has no single and well-defined curvature. Neither in claim 1 nor in the patent is it defined how a curvature of a spectacle frame is unequivocally determined.

1.2 Disclosure of E1

1.2.1 The board concurs with the opponent (see O1, point III) that E1 discloses a method of selecting a semi-finished

ophthalmic lens according to a given spectacle frame [E1, page 4, lines 5 to 11] comprising the steps of:

- providing the spectacle frame front face base data [E1, page 2, line 20 to page 3, line 2; first and second step of claim 1 of E1],
- providing a list of semi-finished ophthalmic lenses with a plurality of front face bases [E1, page 4, lines 5 to 11],
- selecting from the list of semi-finished ophthalmic lenses the semi-finished ophthalmic lens whose front face base is the closest to the front face base of the spectacle frame [E1, page 4, lines 26 to 31: the selected lens should match the outline of the frame, especially in the direction perpendicular to the frame; E1, page 5, lines 14 to 25 and claim 5: the shape of the front face of the lens is selected so that it matches optimally the shape of the frame rings].

It follows that E1 discloses a method comprising all the features of claim 1.

1.2.2 The patentee, with reference to the appealed decision, points 8.3.2 to 8.3.4, denied in its letter of reply P1, point II.1, that E1 disclosed step **1D** of claim 1.

In essence, the patentee submitted that "[s]tep 1D recites selecting *the* semi-finished ophthalmic lens whose front face base is *the closest* to the spectacle frame. This language clearly rules out the use of any other parameter at Step 1D" [original emphasis], whereas in E1 that semi-finished lens, or blank, is selected which best suits both the prescription data and the frame shape. This would imply that the selected blank is not necessarily the closest to the front face base of the frame.

The board is not convinced by the patentee's counter-argument. Claim 1 does not define the content of the list of blanks. In other words, the content of the list is arbitrarily defined. For example, by forming the list only with blanks which are compatible with the prescription data, the finally selected blank is the blank from the list whose front face base is the closest to the front base of the spectacle frame.

- 1.2.3 The patentee, during oral proceedings, submitted that the term "the closest" had to be interpreted in the sense of a mathematical comparison between two numerical values, namely between the curvature of the spectacle frame and the curvature of the lens blank. In the patentee's view, the claimed method comprised the step of selecting the semi-finished ophthalmic lens whose numerical value of the front face curvature is the closest to the numerical value of the curvature of the previously determined spectacle frame. No such comparison took place in the method of E1.

The board is not convinced by the patentee's argument. The term "the closest" in feature **1D** has no well-defined meaning in the context of the claimed method because the exact parameter which is to be monitored for deciding if the front face base of one lens is closer to the front face base of the spectacle frame than the front face base of another lens is undefined. As submitted by the opponent (O1, point II.2.3), the patent discloses in figures 6 to 9 several ways of evaluating whether a front face base of a lens is the closest to the front face base of a spectacle frame. In fact, none of these evaluations considers a surface curvature of the lens or of the frame. The patentee's allegation that the term "the closest" had to be understood in the sense of a mathematical comparison has no support in the patent. Therefore, the board is of the opinion that feature **1D** of claim 1 is to be

interpreted broadly as meaning selecting the semi-finished lens whose front face base generally best fits the frame. In other terms, the criterion of selecting "the closest" is so vague and imprecise that it encompasses the criterion of "optimal matching" disclosed in E1, page 5, lines 20 to 25.

2. Auxiliary requests 1 to 5 - admittance

Auxiliary requests 1 to 5 are not admitted into the proceedings under Articles 12(2) and (4), 13(1) RPBA 2007.

2.1 The reasons for not admitting auxiliary requests 1 to 5 into the proceedings are as follows:

2.1.1 In response to the opponent's statement of grounds of appeal, the patentee merely declared that all auxiliary requests filed during the first-instance proceedings were maintained (P1, page 2, second paragraph). Contrary to the requirement of Article 12(2) RPBA 2007, according to which the reply to the statement of grounds of appeal shall contain the party's complete case, no substantiating arguments at all were submitted by the patentee about why the auxiliary requests overcame the objections of lack of novelty and inventive step raised by the opponent against the subject-matter of claim 1 of the main request.

Due to this way of proceeding of the patentee, the board would have been obliged to investigate itself the relevance of the amendments with respect to the prior art. This runs counter to the primary object of the appeal proceedings to review the decision under appeal in a judicial manner.

As a consequence, auxiliary requests 1 to 5, not being accompanied by arguments about why the objections on file

were overcome and therefore not complying with the requirements under Article 12(2) RPBA 2007, are not to be taken into account according to Article 12(4) RPBA 2007.

2.1.2 In response to the summons to oral proceedings, the patentee filed arguments why, in its view, the subject-matter of claim 1 of auxiliary requests 1 to 5 overcame the opponent's objections of lack of inventive step (P2, point II). This submission of the patentee represents an amendment to a party's case within the meaning of Article 13(1) RPBA 2007, which may be admitted and considered at the board's discretion.

In view of the following aspects, the board decides to exercise its discretion under Article 13(1) RPBA 2007 in not admitting auxiliary requests 1 to 5 into the proceedings:

- The substantiation of the auxiliary requests 1 to 5 is late-filed without any justification for the late-filing. In particular, the debate about the claim construction and the ensuing objections of novelty and inventive step in view of E1 had remained substantially unchanged during the whole opposition proceedings, including the objections raised in the board's communication annexed to the summons to oral proceedings. No change of the objections raised had occurred, which could have justified submitting counter-arguments at such a late stage.

Still more, the opponent's statement of grounds of appeal contained objections against the auxiliary requests filed during the first-instance opposition proceedings even though they were not yet filed by the patentee in the appeal proceedings (O1, point VI). Despite these objections having been raised in the

opponent's statement of grounds of appeal, the patentee decided not to submit arguments with its reply to the opponent's statement of grounds of appeal, explaining why the auxiliary requests overcame the objections raised.

- Auxiliary requests 1 to 3 do not define subject-matter along a convergent line of development, but appear to be divergent in the sense that they focus on different and unrelated aspects of the claimed method, namely the content of the list of lenses (auxiliary request 1), manufacturing steps (auxiliary request 2) and the selection criterion (auxiliary request 3).

- Auxiliary requests 1 to 5 do not address one of the main points that was controversially discussed between the parties regarding the main request, namely the interpretation of the expression "spectacle frame front face base data", but add entirely new features. This means that the case is taken in a new direction due to auxiliary requests 1 to 5.

2.2 The patentee argued that auxiliary requests 1 to 5 should be admitted into the proceedings because they were filed already during first-instance opposition proceedings. Moreover, a substantiation of auxiliary requests 1 to 5 was filed with the letter dated 2 February 2021, implying that the opponent and the board had sufficient time to consider the patentee's arguments before the oral proceedings taking place on 15 December 2022.

The board is not convinced by these arguments of the patentee. The sole fact that auxiliary requests, not underlying the appealed decision, were filed during first-instance opposition proceedings does not imply that they are automatically to be taken into account during the

appeal proceedings. In order to be taken into account by the board, the auxiliary requests must be substantiated and filed in time, i.e. with the reply to the statement of grounds of appeal (Article 12(2) and (4) RPBA 2007).

Moreover, the purpose of Article 13 RPBA 2007 is to ensure that the board is aware of all the main points in dispute, arguments and counter-arguments of the parties before drafting the summons. This enables all parties to prepare efficiently for the oral proceedings on the basis of the content of the communication annexed to the summons to oral proceedings. Amendments submitted by the parties after the board's communication has been issued are in principle at odds with the need for procedural economy and therefore only admitted to the proceedings by way of exception and under certain conditions.

3. For the above reasons the board comes to the conclusion that the patentee's main request is not allowable and its first to fifth auxiliary requests are not admitted into the proceedings.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



L. Gabor

R. Bekkering

Decision electronically authenticated