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**Datasheet for the decision
of 7 March 2024**

Case Number: T 1464/21 - 3.4.02

Application Number: 17001867.5

Publication Number: 3333599

IPC: G02B3/00, A61B1/00, G02B23/24

Language of the proceedings: EN

Title of invention:
ENDOSCOPE OBJECTIVE

Patent Proprietor:
Karl Storz SE & Co. KG

Opponent:
Henke-Sass, Wolf GmbH

Relevant legal provisions:
EPC Art. 52(1), 54(1), 84, 100(a), 111(1)
RPBA 2020 Art. 11, 12(2), 13(1), 13(2)

Keyword:
Admittance of documents filed in appeal (yes)
Admittance of submissions relating to interpretation of
claimed features (yes)
Novelty (no)
Remittal for further prosecution (yes)



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Case Number: T 1464/21 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 7 March 2024

Appellant: Henke-Sass, Wolf GmbH
(Opponent) Keltenstraße 1
78532 Tuttlingen (DE)

Representative: Patentanwälte Geyer, Fehners & Partner mbB
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Respondent: Karl Storz SE & Co. KG
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 5 August 2021
rejecting the opposition filed against European
patent No. 3333599 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman R. Bekkering
Members: F. J. Narganes-Quijano
T. Karamanli

Summary of Facts and Submissions

- I. The appellant (opponent) lodged an appeal against the decision of the opposition division rejecting the opposition to European patent No. 3333599.

The opposition filed by the appellant against the patent as a whole was based on the grounds for opposition of lack of novelty (Article 100(a) together with Articles 52(1) and 54) and of lack of inventive step (Article 100(a) together with Articles 52(1) and 56 EPC).

- II. During the appeal proceedings the parties referred *inter alia* to the following document already considered during the first-instance proceedings:

D1: US 4 850 342 A.

- III. In the decision under appeal the opposition division held that none of the grounds for opposition raised by the appellant prejudiced the maintenance of the patent as granted. In particular, the opposition division held that the subject-matter of claim 1 as granted was new and involved an inventive step over document D1 (Articles 52(1), 54(1) and 56 EPC).

- IV. With its letter dated 28 March 2022 and submitted in reply to the statement of grounds of appeal, the respondent (patent proprietor) filed claims according to a first to fourth auxiliary requests.

- V. With its letter dated 24 October 2022, the appellant filed the following documents:

L17: Excerpt from oxfordlearnersdictionaries.com, entry "adjacent" (3 pages)

L18: Excerpt from oxfordlearnersdictionaries.com, entry "interconnect" (3 pages).

VI. With its letter dated 5 April 2023, the respondent filed claims according to a "new first" to a "new third" auxiliary request.

VII. In a communication pursuant to Article 15(1) RPBA annexed to the summons to oral proceedings, the board presented a preliminary assessment of the case.

VIII. With its letter dated 26 January 2024, the respondent filed the following documents:

N1: Excerpt from the online "Oxford English Dictionary"; Oxford University Press, 2023; entry "adjacent" (6 pages)

N2: Excerpt from "The Oxford Dictionary of Synonyms and Antonyms"; Oxford University Press, 2nd edition 2007; entry "adjacent" (4 pages)

N3: Excerpt from "Langenscheidts Fachwörterbuch Kompakt Technik - Englisch-Deutsch/Deutsch-Englisch"; Langenscheidt, reprint of the 2nd revised edition; entry "adjacent" (4 pages)

N4: Excerpt from "Langenscheidts Fachwörterbuch Kompakt Technik - Englisch-Deutsch/Deutsch-Englisch"; Langenscheidt, reprint of the 2nd revised edition; entry "interconnected" (4 pages)

N5: Excerpt from "Langenscheidts Fachwörterbuch Kompakt Technik - Englisch-Deutsch/Deutsch-Englisch"; Langenscheidt, reprint of the 2nd revised edition; entry "rim" (4 pages)

- N6: Excerpt from the online "Oxford English Dictionary"; Oxford University Press, 2023; entry "rim" (11 pages)
- N7: Excerpt from the online "Oxford English Dictionary"; Oxford University Press, 2023; entry "encompass" (5 pages)
- N8: Excerpt from "Langenscheidts Fachwörterbuch Kompakt Technik - Englisch-Deutsch/Deutsch-Englisch"; Langenscheidt, reprint of the 2nd revised edition; entry "recess" (4 pages)
- N9: Excerpt from the online "Oxford English Dictionary"; Oxford University Press, 2023; entry "recess" (11 pages).

IX. Oral proceedings were held on 7 March 2024.

The appellant requested that the decision under appeal be set aside and that the patent be revoked.

The respondent requested that the appeal be dismissed (main request), and, alternatively, that the decision under appeal be set aside and that the case be remitted to the opposition division for further prosecution (auxiliary request 1), or that the patent be maintained as amended on the basis of the claims of auxiliary request 2 filed with letter of 28 March 2022 as "erster Hilfsantrag", auxiliary request 3 filed with letter of 28 March 2022 as "dritter Hilfsantrag", auxiliary request 4 filed with letter of 28 March 2022 as "zweiter Hilfsantrag", auxiliary request 5 filed with letter of 5 April 2023 as "neuer erster Hilfsantrag", auxiliary request 6 filed with letter of 28 March 2022 as "vierter Hilfsantrag", auxiliary request 7 filed with letter of 5 April 2023 as "neuer zweiter Hilfsantrag" or auxiliary request 8 filed with letter of 5 April 2023 as "neuer dritter Hilfsantrag". It also

requested as an auxiliary measure that the case be remitted to the opposition division for adaptation of the description, if necessary. Further, if its main request could not be granted, if the case could not be remitted to the opposition division for further prosecution or if one of its auxiliary requests 2 to 8 could not be granted, the respondent requested that a question still to be formulated be referred to the Enlarged Board of Appeal.

At the end of the oral proceedings the chairman announced the decision of the board.

- X. Claim 1 of the patent as granted - with the feature labelling "1" to "6" in square brackets used during the proceedings being inserted therein by the board - reads as follows:

"[1] Endoscope objective,
[2] comprising a deflection prism (22) having an entrance face,
[3] and comprising a negative lens (1, 11) having a first face with a first optical surface and a second face with a second optical surface opposing the first optical surface, the second optical surface being a concave optical surface (3, 13),
[4] wherein the negative lens (1, 11) is mounted on the entrance face of the deflection prism (22) such that a rim (4, 14) encompassing the concave optical surface (3, 13) abuts the entrance face of the deflection prism (22), characterized in that
[5] a recess (7, 17) is formed in the second face,
[6] the recess (7, 17) being adjacent to the concave optical surface (3, 13)."

Reasons for the Decision

1. The appeal is admissible.
2. *Documents L17, L18 and N1 to N9 - Admittance*
 - 2.1 The respondent submitted that documents L17 and L18 were not addressed to a skilled person, but to students, and requested that documents L17 and L18 not be considered in the appeal proceedings. Documents N1 to N19 represented the common general knowledge of the skilled person and should therefore be admitted.

The appellant submitted that documents N1 to N9 were late filed and that these documents should not be admitted into the proceedings.

- 2.2 The board notes that documents L17 and L18 were filed with the appellant's letter dated 24 October 2022 in reply to the respondent's reply to the statement of grounds of appeal and before the notification of the board's communication under Article 15(1) RPBA. Consequently, these documents constitute an amendment of the appellant's case within the meaning of Article 13(1) RPBA. Therefore, the admittance of documents L17 and L18 into the appeal proceedings is at the board's discretion under Article 13(1) RPBA.

As regards documents N1 to N9, these documents were filed after notification of the board's communication under Article 15(1) RPBA and, therefore, they constitute an amendment of the respondent's case within the meaning of Article 13(2) RPBA as in force from 1 January 2024 (see OJ EPO 2024, A15) - and their

admittance into the appeal proceedings is at the board's discretion under Article 13(2) RPBA.

2.2.1 Documents L17, L18 and N1 to N9 concern the definition in different dictionaries of terms used in claim 1 as granted and the meaning of which was already discussed during the first-instance proceedings. In particular, the question of whether the features of claim 1 involving terms such as "recess", "rim", "adjacent" and "encompassing" were disclosed in the prior art was extensively discussed during the opposition proceedings (see, in particular, minutes of the first-instance oral proceedings, points 2 to 6), and in this discussion the meaning and the interpretation of these terms in the context of claim 1 was also addressed (minutes, points, 2.1, 3.1, 4 and 6), in particular by reference to the definition of the term "encompassing" in the Oxford dictionary (minutes, point 4, and decision, point 14.3.1). In addition, these same issues have been addressed by the parties during the appeal proceedings and the appellant and the respondent have referred to documents L7 and L8 and to documents N1 to N9, respectively, to further support their respective arguments. Therefore, the board considers that these documents have only been filed as evidence in support of the common general understanding of specific terms used in claim 1 as granted, that the documents do not raise new issues and merely support existing arguments, and that the documents are pertinent for the issues addressed in the appeal proceedings.

2.2.2 In these circumstances, the board considers it appropriate in the exercise of its discretion under Article 13(1) RPBA to admit documents L17 and L18 into the proceedings, and also to take into account

documents N1 to N9 into the proceedings in the exercise of its discretion under Article 13(2) RPBA.

3. *Appellant's submissions - Admittance*

3.1 The respondent submitted that the appellant's arguments relating to the issues of novelty and of inventive step over the documents considered during the appeal proceedings, and in particular over document D1, contained submissions which in fact amounted to objections of lack of clarity of predetermined features of claim 1 as granted. The respondent requested that these objections of lack of clarity under Article 84 EPC not be admitted into the appeal proceedings because lack of clarity was not a ground for opposition under Article 100 EPC. The respondent also requested that the corresponding objections of lack of novelty and of inventive step based on the mentioned objections of lack of clarity not be admitted into the appeal proceedings either.

3.2 The board notes that the appellant's submissions referred to by the respondent as constituting objections of lack of clarity only addressed the interpretation of some of the features of claim 1 as granted in view of the meaning of terms such as "recess", "rim", "adjacent" and "encompassing" already discussed during the opposition proceedings (see point 2.2.1 above, third paragraph) and that - as submitted by the appellant - no objection of lack of clarity was actually raised under Article 84 EPC. In addition, the fact that Article 84 EPC does not constitute a ground for opposition does not preclude addressing the interpretation of the features of a claim of a granted patent for the purpose of determining the subject-matter actually claimed in the context of the

assessment of a ground for opposition (here, the grounds for opposition of lack of novelty and of lack of inventive step). Therefore, the board sees no reason that would justify not admitting the appellant's substantive submissions relating to the interpretation of the features of the claimed subject-matter and also the corresponding appellant's objections of lack of novelty and of inventive step based on the mentioned appellant's submissions.

4. *Main request (patent as granted) - Ground for opposition of lack of novelty (Articles 100(a) and 54 EPC) - Document D1*

4.1 In its decision the opposition division held that the endoscope objective of claim 1 as granted was new over the documents considered during the opposition proceedings and, in particular, that the claimed objective differed from the objective disclosed in document D1 by reference to Fig. 3A in features 5 and 6 of claim 1.

The appellant contested the opposition division's view that features 5 and 6 were not disclosed in document D1.

The respondent submitted that not only features 5 and 6 were new over document D1, but - contrary to the opposition division's view - also feature 4.

4.2 Feature 4

4.2.1 According to the respondent, the objective of Fig. 3A of document D1 was not mounted as required by feature 4 of claim 1. In particular, the frame 30 of document D1 was fixed to the prism and it constituted a distinct,

separate fixing means, and therefore the frame 30 could not be considered to constitute a component of the lens 29A of document D1. Furthermore, there was no disclosure in document D1 that the frame 30 completely encircled or encompassed the lens 29A, and in particular the negative lens component. More particularly, Fig. 3A only represented a cross-sectional view of the objective (document D1, column 2, line 29) and the frame 30 was only represented by two distinct portions, i.e. by an upper and a lower frame portion, and document D1 did not disclose in a direct and unambiguous way that the frame would be constituted by one single piece completely encircling the lens 29A. Therefore, the frame 30 did not constitute a rim, i.e. an "Einfassung" (document N5) or a peripheral portion or outer ring (document N6, section 3a on page 3) of the lens 29A within the proper meaning of the term "rim". In addition, the lower portion of the frame 30 was in contact with a portion of another frame 32 arranged below the deflection prism 29B, and the frame 30 did not abut the entrance face of the deflection prism as required by the claimed subject-matter.

4.2.2 The board, however, is not convinced by these arguments. It is first noted that according to document D1 the lens 29A of Fig. 3A is "fixed to the objective prism 29B with a frame 30" (column 4, lines 20 to 25) and that the formulation of the claim ("the negative lens (1, 11) is mounted on the entrance face of the deflection prism (22) such that a rim [...] abuts the entrance face of the deflection prism") does not require that the rim constitutes a component of the lens or that it is constituted by a prolongation of the material of the lens.

Furthermore, it is established jurisprudence of the boards of appeal that a disclosure can be implicit, where an implicit disclosure relates solely to matter which is not explicitly mentioned but is a clear and unambiguous consequence of what is explicitly mentioned (Case Law of the Boards of Appeal of the European Patent Office, 10th edition, July 2022, II.E.1.3.3). Fig. 3A shows only a cross-section of the objective and therefore only a cross-section of the frame 30. However, the person skilled in the technical field under consideration would understand in the technical context of document D1, and in particular in view of Fig. 3A together with the cylindrical symmetrical configuration of the optical system represented in Fig. 3B, that a "frame" configured to fix the lens 29A to the deflection prism 29B (D1, column 4, lines 23 to 25) would - as held by the opposition division in its decision - be a frame encircling the lens. The board concurs in this respect with the appellant's view that it would be unrealistic ("lebensfremd") that the skilled person would construe the disclosure of document D1 relating to the frame as possibly only involving a frame constituted by two distinct portions separated from each other. For these reasons, in the board's view, document D1 discloses implicitly that the frame 30 encircles the lens 29A along its whole perimeter as this is a clear and unambiguous consequence of what is explicitly mentioned.

Therefore, the frame 30 of document D1 constitutes a rim, and in particular an outer ring (document N6) or an "Einfassung" (document N5), "encompassing the concave optical surface" of the lens as required by feature 4 of claim 1.

In addition, at least the upper part of the frame 30 abuts the entrance face of the deflection prism 29B (Fig. 3A), and claim 1 requires that the rim "abuts the entrance face of the prism", but - contrary to the appellant's submissions - not necessarily that it abuts the mentioned face along the whole perimeter of the rim.

4.2.3 In view of the above reasons, feature 4 is disclosed in document D1.

4.3 Features 5 and 6

4.3.1 The appellant contested the opposition division's view that the air filled cavity formed between the body of the lens 29A and the deflection prism 29B of Fig. 3A of document D1 could not be considered as a "recess formed in the second face" of the lens within the meaning of features 5 and 6.

The respondent submitted that document D1 was directed to the dispersion of illumination fibres of an endoscope of the oblique view type (column 2, lines 13 to 18), and not to the light path followed by the light entering into the endoscope, and that the objective represented in Fig. 3A of document D1 included an air filled cavity between the concave optical surface of the lens and the prism, but not a recess within the proper meaning of this term. A recess was constituted by "a receding part or indentation" or "a small depression or indentation" (document N9, sections 8.a and 8.e), i.e. by an "Auskehlung", "Aussparung", "Vertiefung" or "Einstich" (document N8), and the opposition division held in the decision under appeal that a recess was to be considered as an indentation in a surface (reasons, point 14.5.2). In addition, the

German priority document of the patent in suit referred to an "Einschnitt". The lens of document D1, however, had no recess understood as a "Vertiefung", "Aussparung", "Ausschnitt" or "Einschnitt" in the planar peripheral portion or in the surface of the second face as claimed. More particularly, the air filled cavity was not formed in document D1 by a recess which extended the concave optical surface and was part of the second optical surface. Furthermore, the description of the patent disclosed that the recess formed a continuation of the optical surface (paragraph [0017], first sentence), so that the recess was a component of the second optical surface.

4.3.2 The board, however, is not convinced by the arguments submitted by the respondent in this respect. The second face of the lens 29A of Fig. 3A of document D1 has a planar annular peripheral portion encompassing the concave optical surface and this planar annular peripheral portion can be considered as resulting from cutting the peripheral annular portion of the second face of a corresponding lens having a concave surface extending beyond the concave surface of the lens 29A, thus resulting in the concave optical surface of the lens represented in Fig. 3A of document D1 surrounded by the planar annular peripheral portion also represented in Fig. 3A, this planar annular peripheral portion being adjacent to the concave optical surface. For this reason, the mentioned planar annular peripheral portion constitutes in the board's view "a recess [...] formed in the second face" of the lens 29A within the proper meaning of the term, the recess determining the air filled cavity mentioned by the parties and formed between the lens body and the prism (Fig. 3A of document D1). In particular, this planar annular peripheral portion constitutes a recess in the

second face of the lens 29A as claimed at least within the general meaning of the terms "a receding part", "Aussparung" and "Ausschnitt". The further question as to whether this recess also constitutes "a small depression", an "indentation", a "Vertiefung", an "Einschnitt", etc. or as to what extent these terms are strictly synonymous with the term "recess" can therefore be left open.

It is also noted in this respect that claim 1 is silent as to any technical function - in particular, any optical or mechanical function - and as to any specific geometrical configuration - in particular, the profile - of the claimed recess that would allow distinguishing the planar annular peripheral portion of the second face of the lens of document D1 from a recess as claimed.

4.3.3 Therefore, in the board's opinion also features 5 and 6 are disclosed in document D1.

4.4 In view of the above considerations, the board concludes that the endoscope objective defined in claim 1 as granted is not new over the endoscope objective disclosed in document D1 by reference to Fig. 3A (Articles 52(1) and 54(1) EPC).

It follows from this conclusion that the ground for opposition of lack of novelty under Article 100(a) in combination with Articles 52(1) and 54(1) EPC prejudices the maintenance of the patent as granted.

5. *Auxiliary request 1 - Remittal for further prosecution*

5.1 The respondent requested as auxiliary request 1 that the case be remitted to the opposition division for

further prosecution and as auxiliary requests 2 to 8 that the patent be maintained as amended on the basis of amended claims filed during the appeal proceedings (cf. point IX above). The respondent submitted in support of auxiliary request 1 that the primary object of the present appeal was to review the opposition division's decision rejecting the opposition, that it was not adversely affected by this decision, that the maintenance of the patent as granted was considered by the board to be prejudiced by a ground for opposition in view of an interpretation of claim 1 as granted substantially deviating from that of the opposition division, and that these circumstances justified the remittal of the case to the opposition division.

During the oral proceedings before the board, the appellant submitted that the remittal of the case to the opposition division would be contrary to procedural efficiency.

- 5.2 In view of the board's conclusion in point 4.4 above, the decision under appeal cannot be upheld since the patent cannot be maintained as granted. According to Article 111(1), second sentence, EPC, the board "*may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution*". In addition, pursuant to Article 11, first sentence, RPBA, "*[t]he Board shall not remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so.*"
- 5.2.1 The board's conclusion in point 4.4 above is, when compared to the decision under appeal, based on a substantially different and broader interpretation of

the features of claim 1 as granted (cf. point 4.3.2 above). This represents a substantive change in the subject of discussion. In reaction thereto and to other issues addressed during the appeal proceedings, the respondent filed during the appeal proceedings amended claims according to auxiliary requests 2 to 8. These auxiliary requests relate, as submitted by the appellant, to subject-matter along diverging directions and, in addition, the parties' cases raise numerous issues concerning the allowability of the amended claims. Consideration by the board of all these requests would amount to a fresh case and would - as submitted by the respondent - go beyond the primary object of the appeal proceedings to review the decision under appeal (Article 12(2) RPBA). In the board's view, this constitutes a special reason within the meaning of Article 11 RPBA that justifies the remittal of the case to the opposition division for further prosecution. In addition, the above considerations are in the board's view more substantive and outweigh considerations of procedural efficiency.

- 5.2.2 In view of all these considerations, the board considers appropriate in the specific circumstances of the case at hand and in the exercise of its discretion under Article 111(1), second sentence, EPC together with Article 11 RPBA to remit the case to the department of first instance for further prosecution, without deciding on the admittance of the respondent's auxiliary requests 2 to 8.

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:



L. Gabor

R. Bekkering

Decision electronically authenticated