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**Datasheet for the decision  
of 24 April 2024**

**Case Number:** T 0133/22 - 3.4.02

**Application Number:** 13005545.2

**Publication Number:** 2738515

**IPC:** G01B11/00, G01B21/04

**Language of the proceedings:** EN

**Title of invention:**

Measuring system, method and computer program product

**Patent Proprietor:**

Mitutoyo Corporation

**Opponent:**

Carl Zeiss Industrielle Messtechnik GmbH

**Headword:**

**Relevant legal provisions:**

EPC 1973 Art. 100(c)

EPC Art. 123(2)

RPBA 2020 Art. 13(2)

**Keyword:**

Amendments - added subject-matter (yes)

Amendment after communication under Article 15(1) RPBA - taken into account (no)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**

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Case Number: T 0133/22 - 3.4.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.4.02**  
**of 24 April 2024**

**Appellant:** Mitutoyo Corporation  
(Patent Proprietor) 20-1, Sakado 1-chome  
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**Representative:** Müller-Boré & Partner  
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**Respondent:** Carl Zeiss Industrielle Messtechnik GmbH  
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**Representative:** Witte, Weller & Partner Patentanwälte mbB  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 17 November  
2021 revoking European patent No. 2738515  
pursuant to Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chair** R. Bekkering  
**Members:** C. Kallinger  
B. Müller

## **Summary of Facts and Submissions**

- I. The patent proprietor (appellant) appealed against the decision of the opposition division revoking European patent No. 2 738 515.
- II. With its reply to the grounds of appeal the opponent (respondent) requested to reject the appeal and maintain the decision revoking the patent.
- III. In a communication pursuant to Article 15(1) RPBA 2020, the board presented its preliminary assessment. The board was, *inter alia*, of the opinion that the subject-matter of claim 1 as granted extended beyond the content of the application as filed.
- IV. In a reply to the board's communication the patent proprietor submitted further arguments as well as auxiliary requests 5 to 9.
- V. Oral proceedings were held on 24 April 2024.
- VI. The parties' final requests were as follows:

The patent proprietor requested that the decision under appeal be set aside and that the patent be maintained as granted or that the patent be maintained in amended form on the basis of the claims of

- auxiliary requests 1 to 4 filed with the statement of grounds of appeal of 28 March 2022 or
- auxiliary requests 5 to 9 filed with a letter of 25 March 2024.

The opponent requested that the appeal be dismissed.

VII. Claim 1 of the main request, i.e. of the patent as granted, reads as follows (feature numbering as used by the opposition division and the parties added by the board):

- 1.1 *A measuring device adapted for image measuring or coordinate profile measuring and comprising:*
- 1.2 *a measurement table (13);*
- 1.3 *a stylus head (18; 218; 418)*
- 1.3a *configured to be substantially displaced in X, Y, and Z directions relative to the measurement table (13) and*
- 1.3b *further configured to measure a work piece (12) to be measured that is placed on the measurement table (13),*
- 1.3c *obtain a measurement image (Imm), and output the measurement image data;*
- 1.4 *a wide angle surveillance camera (19; 119; 219; 419)*
- 1.4a *configured to capture in one pass an image that is arrangeable into a bird's-eye image (Imt) of the work piece (12),*
- 1.4b *the bird's-eye image (Imt) encompassing an entire field over which the stylus head (18; 118; 218; 418) is capable of relative displacement; and*
- 1.5 *a processor (35) configured to:*
- 1.5a *generate the bird's-eye image (Imt) based on said image captured by said wide angle surveillance camera;*
- 1.5b *define a position (18A) of the stylus head (18; 118; 218; 418) on the bird's-eye image; and*
- 1.5c *generate a navigation map (Imn) in which the position of the stylus head (18; 118; 218; 418) is composited with the bird's-eye image (Imt).*

## Reasons for the Decision

1. Main Request

1.1 Amendments - Ground for opposition under Article 100(c) EPC

1.1.1 The opposition division held that feature 1.3c was disclosed in the originally filed description and that the subject-matter of the European patent did not extend beyond the content of the application as originally filed (see decision, point 10).

1.1.2 The opponent was of the opinion that feature 1.3c was not directly and unambiguously derivable in its general form by the skilled person from the application as originally filed.

It argued that the originally filed description (page 6, lines 5 to 8) disclosed a non-contact stylus head only in the form of a CCD camera and that therefore the combination of a wide angle surveillance camera with a general stylus head was not originally disclosed. Therefore, omitting the definition that the stylus head was realized by a CCD camera constituted an inadmissible intermediate generalisation.

1.1.3 The patent proprietor agreed with the opposition division's conclusion.

It argued that the description as originally filed (see page 5, lines 25 to 27) stated that *"[a] CCD camera 18 (as a particular stylus head) is mounted to (particularly a bottom end of) the image capture unit 17 so as to substantially oppose the measurement table*

13". Hence, the description explicitly disclosed the CCD camera as only a particular stylus head and the skilled person directly and unambiguously recognized that the use of a CCD camera was not inextricably linked to feature 1.3c ("*obtain a measurement image (Imm), and output the measurement image data*") as disclosed in the description (see page 6, lines 5 to 8).

In addition, the description stated (see page 11, lines 19 to 24) that "*in the above embodiment [i.e. the embodiment shown in Figure 3], a stylus head was non-contact and was a CCD camera for measuring an image*" and then continued to disclose a further embodiment without a CCD camera where the stylus head may be configured as a contact-type touch probe (see Figure 7). It was therefore apparent to the skilled person that the stylus head used in connection with the invention should not be limited to a stylus head exclusively in the form of a CCD camera and that other stylus heads could be used such as the explicitly disclosed "*contact-type touch probe*". The skilled person, when using his common general knowledge, was well aware of other camera technologies or, even more generally, of other imaging technologies which may be used in connection with the invention.

This was further confirmed by the description as originally filed which made clear (page 12, lines 18 to 32) that the discussed examples were merely for the purpose of explanation and were in no way to be construed as limiting.

1.1.4 The board does not agree with the opposition division and the patent proprietor but finds the opponent's arguments convincing for the following reasons:

The originally filed description discloses with respect to feature 1.3c a CCD camera "*as a particular stylus head*" (see page 5, lines 25 to 28) and that a "*CCD camera [...] obtains a measurement image Imm [...] and outputs the measurement image data*" (see page 6, lines 5 to 7). In the passages following this disclosure, whenever the camera 18 is mentioned it is consistently referred to as a CCD camera.

With respect to an alternative stylus head, the originally filed description (see page 11, lines 19 to 24) explains that the invention is not limited to the embodiment using a non-contact stylus head in form of a CCD camera for measuring an image, but that the stylus head may be configured as a contact-type touch probe.

The board does therefore not agree with the opposition division's argument that the application as filed disclosed a CCD camera as a "*particular implementation of the non-contact image generating stylus head*", but agrees with the opponent that the application as originally filed does not disclose that a non-contact stylus head could be realised with a technology other than the explicitly and repeatedly mentioned CCD camera.

Even if the skilled person were aware that other camera technologies or - even more generally in the sense of feature 1.3c - other imaging sensor technologies could be used instead of a CCD camera, this cannot replace a direct and unambiguous disclosure. However, such a direct and unambiguous disclosure of any imaging

measuring head other than a CCD camera is missing in the application as filed.

With respect to the patent proprietor's reference to page 12 of the description the board notes that such a general statement at the end of the description does not constitute, nor can it replace, a direct and unambiguous disclosure of an image obtaining stylus head not being a CCD camera.

In conclusion, the board is of the opinion that claim 1 of the main request contains an inadmissible intermediate generalisation due to the omission of the CCD camera in feature 1.3c.

Therefore, the subject-matter of claim 1 as granted extends beyond the content of the application as filed and the ground for opposition under Article 100 (c) EPC prejudices the maintenance of the patent as granted.

2. Auxiliary requests 1 to 4

During the first instance opposition proceedings, the opposition division admitted auxiliary requests 1 to 4 into the proceedings and discussed these requests in substance during the oral proceedings and in the decision under appeal.

With the statement of grounds of appeal, the proprietor maintained these requests.

According to Article 12(1) and (2) RPBA 2020 these requests are therefore part of the appeal proceedings.

Claim 1 of these requests does not contain the feature objected to above, i.e. that the stylus head which

obtains the measurement image is in the form of a CCD camera.

Therefore, for the same reasons as set out above in relation to the main request, the board is of the opinion that the omission of this feature constitutes an inadmissible intermediate generalisation.

In conclusion, the subject-matter of claim 1 of auxiliary requests 1 to 4 extends beyond the content of the application as filed and consequently fails to comply with Article 123(2) EPC.

### 3. Auxiliary requests 5 to 9 - Admittance

3.1 The amended claims of these auxiliary requests were filed after notification of the board's communication under Article 15(1) RPBA.

3.2 The patent proprietor requested to admit new auxiliary requests 5 to 9 into the appeal proceedings. It argued that this was justified due to the presence of exceptional circumstances.

In the first-instance opposition proceedings the opponent submitted that the addition of feature 1.3c ("*obtain a measurement image (Imm), and output the measurement image data*") to claim 1 would result in an inadmissible intermediate generalisation. This issue was discussed during the oral proceedings before the opposition division and the opposition division held in the decision under appeal that amended feature 1.3c did not constitute an inadmissible intermediate generalisation.

Since the opposition division found that feature 1.3c did not extend beyond the content of the application as originally filed, there was no reason for the patent proprietor to comment on this part of the decision, nor was it indicated, for reasons of procedural economy, to file any claim amendments, when appealing the decision.

Later, the board, in its communication under Article 15(1) RPBA, surprisingly appeared to disagree with the opposition division's findings with respect to the original disclosure of feature 1.3c, which could not be expected.

Therefore, new auxiliary requests five to nine were only filed in response to the board's communication.

The new auxiliary requests respectively corresponded to the main request, and auxiliary requests 1 to 4, with the sole amendment of specifying in the independent claims that the stylus head is a CCD camera. The amendments made, thus, did not lead to any undue burden on the participating parties, nor to any subject-matter essentially different to what was discussed in connection with the requests on file so far.

The patent proprietor, being aware of the requirements of Article 13(2) RPBA, requested the board to exercise its discretion by admitting these requests in order to give the patent proprietor the chance to defend its patent thereby enabling it to exercise its property right in the patent.

- 3.3 The opponent requested not to admit auxiliary requests 5 to 9 into the appeal proceedings as there were no exceptional circumstances present.

According to established case law of the boards of appeal, a preliminary opinion presented by a board merely agreeing with the opposing party did not amount to exceptional circumstances.

- 3.4 The board agrees with the opponent's arguments for the following reasons.

*According to Article 13(2) RPBA, "[a]ny amendment to a party's appeal case made [...] after notification of a notification of a communication under Article 15, paragraph 1, shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned".*

The board is of the opinion that amended claim 1 is an attempt to address an objection of added subject-matter which was already presented in the notice of opposition against the patent as granted. Therefore, this objection was from the beginning part of the opposition proceedings and was also discussed during the oral proceedings before the opposition division and in the decision under appeal. It was again raised and discussed by the opponent (respondent) in its reply to the patent proprietor's statement of grounds of appeal. The patent proprietor (appellant) therefore had to expect that the board might express a provisional opinion that was different from the opposition division's opinion. The appellant did not demonstrate that the board's provisional opinion contained any objection not raised previously (see Case Law of the Boards of Appeal, 10th edition 2022, section V.A.4.5.6 h)).

Thus, the board cannot recognise exceptional circumstances leading to the amendment, which have been justified with cogent reasons by the appellant.

Therefore, the board, pursuant to the provisions of Article 13 (2) RPBA, does not take into account auxiliary requests 5 to 9.

Those provisions, requiring "exceptional circumstances" for amendments to a party's appeal case to exceptionally be taken into account, limit a patent proprietor's right, arising from the property right vested in its patent, to defend the opposed patent on the basis of auxiliary requests. This limitation furthers the objective of achieving procedural economy.

In the case in hand, for the reasons given above, this latter objective must prevail over the objective of giving the patent proprietor a chance to defend the property vested in its patent on the basis of the claims of new auxiliary requests 5 to 9.

## **Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chair:



L. Gabor

R. Bekkering

Decision electronically authenticated