

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [-] To Chairmen
- (D) [X] No distribution

**Datasheet for the decision
of 16 October 2024**

Case Number: T 0537/22 - 3.5.01

Application Number: 17306119.3

Publication Number: 3451270

IPC: G06Q30/06, G06Q20/32, G07G1/00

Language of the proceedings: EN

Title of invention:

A METHOD OF ORDERING A NEW OPTICAL ARTICLE, A METHOD FOR
LAUNCHING PRODUCTION OF A NEW OPTICAL ARTICLE AND AN APPARATUS
FOR ORDERING A NEW OPTICAL ARTICLE

Applicant:

Essilor International

Headword:

Ordering and producing an optical article/ESSILOR

Relevant legal provisions:

EPC Art. 56

Keyword:

Inventive step - ordering and producing a new optical article
with the same characteristics as an existing one (no - non-
technical requirement with an obvious implementation)



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0

Case Number: T 0537/22 - 3.5.01

D E C I S I O N
of Technical Board of Appeal 3.5.01
of 16 October 2024

Appellant: Essilor International
(Applicant) 147, rue de Paris
94220 Charenton-le-Pont (FR)

Representative: Jacobacci Coralys Harle
32, rue de l'Arcade
75008 Paris (FR)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 10 November
2021 refusing European patent application No.
17306119.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman M. Höhn
Members: I. Kürten
L. Basterreix

Summary of Facts and Submissions

I. The appeal is against the examining division's decision to refuse European patent application No. 17306119.3 for lack of inventive step (Article 56 EPC) in view of *inter alia* the following documents:

D3: US 2015/288741 A1

D4: US 8115792 B2

II. In the statement setting out the grounds of appeal, the appellant requested that the decision to refuse the application be set aside and that a patent be granted based on the main request, or the first or second auxiliary request filed therewith, which corresponded to the refused third to fifth auxiliary requests. In a subsequent letter, the appellant also requested oral proceedings if the Board intended to uphold the contested decision.

III. In the communication accompanying the summons to oral proceedings, the Board tended to agree with the examining division that the claimed subject-matter lacked an inventive step (Article 56 EPC). The Board also referred to document D6 (WO 2015/040 338), cited in the application.

IV. In a letter dated 7 August 2024, the appellant withdrew their request for oral proceedings, which were subsequently cancelled.

V. Claim 1 of the main request reads (reference signs deleted by the Board):

A method of ordering a new optical article definable based on features of an initial optical article comprising at least a lens, said method comprising the following steps:

- an image sensor capturing a marking carried by the lens of the initial optical article;*
- determining an identifier based on the captured marking;*
- sending, by an electronic device and to a remote server, the identifier and an order for said new optical article;*
- retrieving, by a control unit of the remote server, characteristics of the initial optical article stored in a database in correspondence with the identifier and defining a prescription of a wearer of the initial optical article;*
- sending, by the control unit and to a manufacturing facility, a message launching production of the new optical article and comprising said characteristics;*
- producing, by a manufacturing set of the manufacturing facility, the new optical article in accordance with said characteristics.*

VI. Claim 1 of the first and second auxiliary requests replaces the term "optical article" by "ophthalmic lens". Claim 1 of the first auxiliary request additionally deletes the feature "defining a prescription of a wearer of the initial optical article".

Reasons for the Decision

1. *Second auxiliary request, inventive step*
- 1.1 The Board finds it convenient to start with the second auxiliary request as it provides the most specific definition of the invention.
- 1.2 The invention in claim 1 of this request concerns ordering a new ophthalmic lens by using the characteristics of an existing ("initial") lens, [0002] and [0007] of the published application.

This involves capturing an image of a marking on the initial lens, extracting an identifier from it, and sending the identifier along with an order for the new lens to a remote server, [0025] to [0033]. The server uses the identifier to retrieve the characteristics of the initial lens from a database and passes them to a manufacturing facility. The facility then produces the new lens in accordance with the received characteristics, [0034] to [0037].

- 1.3 The examining division held that claim 1 contained both technical and non-technical features. The technical features were known from *inter alia* D3. The non-technical aspects pertained to the re-ordering of an ophthalmic lens based on the markings on an existing one. Implementing these non-technical aspects within the known system was deemed obvious.

The division also noted (point 12.4 of the decision) that incorporating markings into ophthalmic lenses was

known in the art, e.g. from D4. Starting from such a lens, the skilled person would use the information encoded in a marking to re-order a new lens without employing inventive step (point 23.3 of the decision).

1.4 D3 describes storing various data about eyewear articles, such as ophthalmic lenses ([0079]), in a database of a remote server (e.g. [0094], [0135], [0139]). The data may relate to the wearer's prescription, optical characteristics of the lenses, and manufacturing parameters ([0090], [0105], and [0106]), all associated with an eyewear equipment identifier ([0107]). When an order request comprising this identifier is received, the stored characteristics are retrieved and sent to a manufacturer, who then produces the eyewear article ([0023] to [0026] and [0108] to [0110]).

1.5 Claim 1 essentially differs from the disclosure of D3 in that:

(i) the identifier is used to retrieve characteristics of an existing ophthalmic lens; and

(ii) the identifier is obtained from a marking carried by the existing ophthalmic lens, captured by an image sensor.

1.6 The Board considers that the two differences address different partial problems and can be assessed independently for inventive step.

While the Board agrees with the appellant that feature (i) facilitates the ordering and manufacturing of an ophthalmic lens with the characteristics of an existing one, it concurs with the examining division that this

is a non-technical requirement. When implementing it within the system of D3, the skilled person would naturally retrieve the existing lens's characteristics using its identifier before sending them to the manufacturer (e.g. [0022] to [0026] of D3).

Feature (ii) pertains to the storage and retrieval of the identifier of an ophthalmic lens. The Board notes that the term "*marking carried by the ophthalmic lens*" is broad and could simply refer to a label with a barcode attached to the lens, which is a common way of identifying articles. But even if interpreted as a marking engraved on the lens' surface (as described in [0029] of the application), it would still not involve an inventive step. The skilled person looking for a suitable way to store the lens identifier would readily recognise the benefits of embedding it in the lens via a suitable visual marking, as suggested in D4, (column 1, lines 33 to 44) and D6 (page 1, penultimate paragraph). Employing suitable reading means, such as an image sensor, to retrieve the identifier from the marking would have been a matter of routine for the skilled person.

Since the use of the identifier (feature (i)) is independent of its storage and retrieval (feature (ii)), the two differences do not yield an effect that is greater than the sum of their individual effects and there is no synergy. As each difference is obvious individually, their combination is likewise obvious.

1.7 Therefore, the Board judges that claim 1 of the second auxiliary request lacks an inventive step (Article 56 EPC).

2. *Main and first auxiliary request, inventive step*

Since claim 1 of the main and first auxiliary request have a broader scope, they lack inventive step (Article 56 EPC) for the same reasons as the second auxiliary request.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



T. Buschek

M. Höhn

Decision electronically authenticated