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Aktenzeichen

File Number

Numéro du dossier

T 832 / 92 - 351

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- ein korrigiertes Vorblatt (Form 3030)
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- a copy of the decision correcting errors
- a corrected covering page (Form 3030)
- a headnote / catchword (Form 3030)
- a copy of the corrected decision.

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- une copie de la décision rectifiant des erreurs
- une page de garde (Form 3030) corrigée
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Anmeldung Nr. / Patent Nr.:

Application No. / Patent No.:

Demande n° / Brevet n°:

(soweit nicht aus der Anlage ersichtlich)

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84 105877.9

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D E C I S I O N
of 23 June 1994

Case Number: T 0832/92 - 3.5.1
Application Number: 84105877.9
Publication Number: 0129092
IPC: G05B 19/405

Language of the proceedings: EN

Title of invention:

Numerical control device for use with a machine tool and a machine tool having such a device

Patentee:

Mitsubishi Denki Kabushiki Kaisha

Opponent:

Robert Bosch GmbH

Headword:

-

Relevant legal norms:

EPC Art. 111(1)

Keyword:

"Generation of a new case"
"Remittal to the first instance"

Decisions cited:

-

Catchword:

-



Case Number: T 0832/92 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 23 June 1994

Appellant: Mitsubishi Denki Kabushiki Kaisha
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Respondent: Robert Bosch GmbH
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Representative: -

Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 0 129 092 revoking
European patent No. 0 129 092 pursuant to
Article 102(1) EPC.

Composition of the Board:

Chairman: P.K.J. van den Berg
Members: R. Randes
G. Davies

Summary of Facts and Submissions

- I. In response to a notice of opposition, the Opposition Division on 30 June 1992 revoked the European patent No. 0 129 092, granted in respect of European patent application No. 84 105 877.9 filed on 23 May 1984 and claiming priority from a prior application in Japan, on the ground that the subject-matter of the claims in accordance with the main and two auxiliary requests did not involve an inventive step.

In the decision the following documents were cited:

- D4: Zeitschrift für wirtschaftliche Fertigung, 1981, vol. 8, pages 55 to 359,
D5: Zeitschrift für wirtschaftliche Fertigung, 1981, vol. 8, pages 387 to 390,
D6: Zeitschrift für wirtschaftliche Fertigung, 1982, vol. 8, pages 353 to 357.

However, in its argumentation the Opposition Division only used the teaching of document D5 to support its decision.

- II. On 31 August 1992 the Appellant appealed against this decision and paid the appropriate fee. With the statement of grounds of appeal, filed on 28 October 1992, a new set of Claims 1 to 5 was filed. Claim 1 reads as follows:

"A numerical control device including:

a controller (CPU) for controlling a machine tool having first and second holder mechanisms (10,12) for jointly

holding a workpiece (11) and for storing data indicative of dimensional details of said workpiece (11), dimensional details of said first holder mechanism (10) and dimensional details of said second holder mechanism (12) entered into said controller (CPU);

a graphic display unit coupled to said controller (CPU) for displaying the workpiece (11) as held by said first and second holder mechanisms (10,12),

characterized in that

said controller (CPU) computes the positions of said first and second holder mechanisms (10,12) including the positions of [any] **the** moveable parts thereof (10a) which are to be displayed gripping the workpiece, on the basis of the data indicative of the dimensional details of said workpiece, whereby, when a new workpiece is to be displayed held by said first and second holder mechanisms (10,12) the new positions of said first and second holder mechanisms (10,12) [and gripping parts thereof] **along the central axis of the workpiece (11) and the new positions of the parts of the first and second holder mechanisms (10,12)** are automatically computed on the basis of the data indicative of the dimensional details of the workpiece."

The emphasized parts of the claim are amendments introduced by the Appellant and which replace the wording of Claim 1 of the revoked patent put into brackets before the emphasized parts.

- III. The Appellant stated that, according to the invention, "the configuration of chuck and tailstock is automatically developed and modified according to detailed measurement data of a workpiece so as to display that chuck and tailstock holding the workpiece

accurately and securely in the correct position both radially and also longitudinally. This special feature of the present invention has now been clearly stated in the main claim." He suggested that the variable data used according to D5 was dependent upon the diameter of the workpiece and was only used to determine the position of the movable parts of the holder in a direction perpendicular to the longitudinal central axis of the workpiece. D5 did not at all describe the position of the workpiece along the central axis.

IV. In a letter, filed on 20 January 1993, the Respondent, having regard to the teaching of D5, expressed the opinion that had the problem of the longitudinal axis really been forgotten, then anyway a skilled man would easily overcome the problem.

In any case, it was disclosed according to D6 (page 356, right hand column, second paragraph, last phrase) that tools might be automatically displayed in their actual holding position (in ihrer "tatsächlichen Einspannlage gezeigt"). From this it was implicitly understood that also the workpiece holders, which of course decided the holding position, also were displayed in their actual and real positions relative to the workpiece. In the next paragraph of D6, moreover, it was said that protection zones could be present between the workpiece and the holders. This must, however, indicate that the positions of the holders were exactly identified relative to the longitudinal as well as to the perpendicular axis.

Moreover, the Respondent mentioned a new document

D7: Zeitschrift für wirtschaftliche Fertigung, 1981, vol. 4, pages 153 to 155.

According to Figures 3, page 154, first image, in said document there was an example showing that both the diameter and the length of a workpiece was input to a simulation system. It appeared to be meaningful to give the information of the length only when it also was known which part of the length had to be machined. Therefore, according to Figures 3 (second image), the workpiece apparently was held by the holder (the data of which was stored in the system) in the way that the front end (side) of the holder was exactly positioned relative to the longitudinal axis of the workpiece.

- V. With a letter, filed on 29 September 1993, the Appellant filed additional dependent Claims 6 to 9, which were to be added to the valid set of Claims 1 to 5. The new claims, in particular Claim 6, were directed to the determination of new coordinate data for the new workpiece by employing relative coordinate systems with the determination of only one reference coordinate per relative coordinate system.

Moreover, the Appellant proposed that said late-filed document D7, filed by the Respondent, should not be admitted into the proceedings, since it did not appear to be more relevant than the documents already cited. In particular, it was emphasized that, according to the present Claim 1, there were two holding mechanisms, whereas document D7 only disclosed one holding mechanism. The input of the length of the workpiece in the simulation program merely appeared to mean that the tool always had to be pointed towards the end of the workpiece. The storage of a length of the workpiece together with the storing of several one-sided holding mechanisms would not lead to the automatic computing of new positions of two holding mechanisms.

Having regard to the teaching of D5, page 389, left hand column, first paragraph (where it is said that various "holding lengths" may be input), it appears that D5 intended to disclose that a single holding mechanism may grip the workpiece at different longitudinal portions and, therefore, cannot relate to the longitudinal adjustment of a second holding mechanism in combination with the transverse adjustment of a first holding mechanism.

Having regard to the protection zones disclosed in D6, the Appellant argued that this indicated a display of the holding mechanism and the tail stock, which was dependent on the arrangement of the protection zones, but which, however, gave no indication as to a calculation of the holding mechanism on the basis of the new workpiece data. Having regard to the Respondent's interpretation of D6 with regard to the phrase that the tools may be automatically displayed in their actual holding position (cf. under IV above) the Appellant made the following statement:

".. the cited passage merely describes the holding of a tool and does not relate to the calculation of new positions, longitudinally and transversely when a new workpiece is to be displayed. Moreover, the cited passage only relates to the display of the "tools" in their actually holding position. What will happen to the holding mechanisms, is not disclosed. Thus, whenever a new workpiece is employed, the **tool** is automatically displayed in its actual holding position, however, there is no indication as to the simultaneous adjustment longitudinally and vertically, of **two** holding mechanisms."

The Appellant also discussed the additional Claims 6 to 9 and stated that these claims were patentable in combination with Claim 1. In particular, he pointed out that

"it is **not** possible to determine **any** reference point on the workpiece surface as is suggested by the Opposition Division [cf. page 6 of the decision under appeal]. To the contrary, it is particularly important to choose the mentioned reference point since then only new workpiece dimensions have to be inserted and **the complete relative coordinate system** may be moved via the offset of the chosen reference point. Thus, the choice of three reference points in combination with the description of dimensional data with respect to a relative coordinate system is particularly advantageous and there is no reason to assume that such a choice would be within the normal skill of the average expert."

- VI. In a letter filed on 8 November 1993, the Respondent, contested the arguments of the Appellant that the prior art did not disclose two workpiece holders. At least D6 disclosed this feature (cf. IV above). Also this document implicitly disclosed that the workpiece holders could be displayed in their actual positions. All the documents D4 to D7 disclose implicitly that all the systems control the positions of the holders according to the dimensions of the respective workpiece. Moreover, also D4 discloses a second holder, a tailstock (cf. e.g. Figures 6).
- VII. In the course of the preparation of the present decision, on 15 June 1994, the Appellant filed a new Claim 1 according to an Auxiliary Request with an accompanying letter. This claim was based on Claim 6 of the Main Request. In the letter, the Appellant pointed out that the inventive activity with respect to Claim 1

of the main request did not only relate to the presence or absence of two holding mechanisms as the Respondent had understood to be the core of the argumentation of the Appellant but "rather to the calculation of the positions of the holding mechanisms in both the X and Z directions on the basis of the data with respect to a new workpiece".

VIII. The Appellant requests

- (1) that the opposed patent be upheld on the basis of the set of Claims 1 to 9 (cf. II and V above);
- (2) that the opposed patent be upheld on the basis of the basis of Claim 1 of the Auxiliary Request;
- (3) oral proceedings in case the Board is minded to come to a negative decision.

IX. The Respondent requests that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.
2. It appears to the Board that the amendment of Claim 1 made by the Appellant, although at first glance appearing to be a minor clarification of the wording of the claim, in effect has changed the whole argumentation of the parties in the proceedings before the Board in relation to the issues which were considered important in the decision under appeal. Now it is apparently clearly indicated in Claim 1 that two separate holder mechanisms are present, the positions of which must be separately computed in both X and Z directions.

In the decision under appeal, D5 was considered as the most relevant document and the revocation relied on that document exclusively. In the argumentation of the decision, there was no mention of two workpiece holders or problems relating to two workpiece holders, let alone why the use and positioning (in both X and Z directions) in the given context of two holders would be obvious to a skilled man.

The Board notes that in the proceedings before the Board the Respondent has filed a new reference document D7 in order to attack the amended Claim 1. Moreover, it appears that the key document in the proceedings is D6 which according to the Respondent discloses an arrangement having two separate holders (which apparently to a certain extent has been acknowledged by the Appellant) of the kind identified by Claim 1. As has been shown above, also the teaching of the cited reference D4 has been used in the argumentation of the appeal proceedings.

The Board also notes that additional dependent Claims 6 to 9 have been filed. Claim 6 identifies in detail the manner in which the automatic computation is performed with the aid of different reference points. It is, moreover, understood that the Appellant hints at the possibility of adding features of Claims 6 to 9 to the main claim ("so that these new claims [6 to 9] are also patentable in combination with Claim 1" letter, filed on 29 September 1993, at the top of page 8). In his last submission the Appellant has, moreover, made said Claim 6 the basis of a Claim 1 of an Auxiliary Request.

3. Thus, the Appellant has made amendments in the claims that the Opposition Division did not consider in its decision. The Respondent, therefore, in support of his argumentation before the Board had to use documents

which were not used by the Opposition Division in its decision; in particular, the Respondent has introduced a late-filed document D7, which possibly might be relevant. All this has changed the situation and raised matters which were not at all considered by the Opposition Division. In fact, it appears that a new case has been generated, which requires a new examination.

The principle task of the Boards of Appeal is to examine appeals, i.e. to examine whether a decision under appeal is correct or not. However, in this case, it appears that new submissions, made by both parties, have changed the entire situation to the extent that the decision taken no longer meets the present situation. Moreover, it appears that before a new decision can be taken an examination must be performed on the basis of the new set of claims of the Main Request (or if necessary of the Auxiliary Request) and in the light of the prior art now put forward and taking into account the arguments used by the parties in the course of the proceedings before the Board. Such re-examination, however, appears to be clearly the task of the Opposition Division and not of the Board. Moreover, in the Board's view, it is in any way appropriate that this re-examination should be carried out by the Opposition Division, so that the parties are not denied the opportunity of having patentability examined by two instances. The Board, therefore, makes use of its power under Article 111(1) EPC to remit the case to the Opposition Division for further prosecution.

4. Since the decision taken by the Board is not negative in respect of the Appellant, there is no need to hold oral proceedings (cf. VII above).

A copy of the Appellant's most recent letter has been dispatched by the Registry to the Respondent for information. Normally, before a department of the EPO takes a decision in a case when such copy has been sent to one of the parties, said party is given sufficient time to respond thereto (T 263/93, unpublished). However, in this case, as the case is remitted to the first instance for further prosecution, the Respondent still has the opportunity to contest the argumentation of the Appellant in said letter.

Order

1. The decision under appeal is set aside.
2. The decision is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

M. Kiehl

P.K.J. van den Berg