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**Datasheet for the decision
of 10 October 2013**

Case Number: T 0919/09 - 3.4.01

Application Number: 00966314.7

Publication Number: 1149301

IPC: G01R 33/385

Language of the proceedings: EN

Title of invention:

Acoustic liner for MRI gradient coils

Applicant:

GEMSO Limited

Headword:

-

Relevant legal provisions:

EPC Art. 108

EPC R. 99(2)

Keyword:

"Admissibility of appeal (no)"

Decisions cited:

T 0220/83, T 0213/85, T 0934/02, T 0717/01

Catchword:

-



Case Number: T 0919/09 - 3.4.01

DECISION
of the Technical Board of Appeal 3.4.01
of 10 October 2013

Appellant:
(Applicant) GEMSO Limited
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Representative:
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 4 December 2008
refusing European patent application
No. 00966314.7 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: G. Assi
Members: T. G. Zinke
C. Schmidt

Summary of Facts and Submissions

- I. The appeal filed on 10 February 2009 lies from the decision of the Examining Division, posted on 4 December 2008, refusing European patent application No. 00 966 314.7 published with the publication No. 1 149 301. The appeal fee was paid on the same day. The statement setting out the grounds of appeal was filed on 9 April 2009.
- II. In the decision under appeal, referring to previous communications dated 12 March 2008 and 26 September 2008, the Examining Division found that the requirements of Article 84 EPC 1973, Article 83 EPC 1973 and Article 123(2) EPC were not met. In addition, the Examining Division also addressed *"for completeness"* novelty, although the issues of novelty and inventive step could be *"discussed in a meaningful manner only after the objections under Articles 83, 84 and 123(2) have been overcome."*
- III. In the notice of appeal of 10 February 2009 the appellant (applicant) requested to set aside the decision under appeal and to grant a patent *"on the basis of the present claims, or on the basis of amended claims which may be submitted in the course of the proceedings"*. Together with the statement setting out the grounds of appeal the appellant supplied a *"replacement set of claims"* with claims 1 to 12 *"for consideration by the Appeal Board with a view to addressing the objections raised in the Examining Division's Communication dated 26 September 2008."*

IV. In the statement of grounds the arguments of the appellant were as follows: *"In order to address the objections raised in the aforementioned latter Communication, the claims have been amended for further clarity. In particular, claim 1 has been rewritten to correspond to the embodiment of Figure 2. The basis for amended claim 1 can therefore be found in Figure 2 and the corresponding description on page 6, line 20 to page 7, line 1. Dependent claims 2 to 12 correspond substantially to previous claims 3 to 13, respectively.*

As indicated in the description of the pending application, various embodiments of the present invention provided in accordance with the amended claims provide an improved device for the reduction or elimination of the acoustic noise that is produced by a gradient coil when in operation.

However, it is respectfully submitted that none of the cited documents indicated by the Examining Division disclose or suggest an acoustic liner in accordance with amended claim 1 with a view to addressing the aforementioned problem.

Accordingly, it is respectfully submitted that the amended claims supplied herewith are novel and possess an inventive step with respect to the cited documents."

V. In a communication posted on 17 July 2013 the Board summoned for oral proceedings to take place on 10 October 2013 and informed the appellant that during the oral proceedings the question of admissibility of the appeal will be discussed.

The appellant was not present at the oral proceedings.

VI. Independent claim 1 of the request as filed together with the statement setting out the grounds of appeal reads as follows:

*"1. An acoustic liner for use with a magnetic field gradient coil (2,15) in a magnetic resonance imaging (MRI) system, the acoustic liner comprising:
an inner flexible sheet (9) having a pattern of conductors (10) etched onto each surface, one side of the inner flexible sheet (9) being provided with X-type patterns and the other side of the inner flexible sheet (9) being provided with Y-type patterns;
a second inner single-sided flexible sheet (11) provided with Z-type conducting patterns etched thereon, wherein the second inner single-sided flexible sheet (11) is bonded to the inner flexible sheet (9);
a compressible insulating material (12) placed over the an inner flexible sheet (9) and the second inner single-sided flexible sheet (11) and bonded thereto;
an outer flexible sheet (13) provided with a pattern of conductors (14) that define X-type patterns on one side thereof and Y-type patterns on the other side thereof, wherein the outer flexible sheet (13) is placed over and bonded to the compressible insulating material (12); and
a second outer single-sided flexible sheet provided with Z-type conducting patterns etched thereon, wherein the second outer single-sided flexible sheet is placed over and bonded to the outer flexible sheet (13)."*

Reasons for the Decision

1. *Admissibility of the appeal*

- 1.1 According to Article 108, sentence 3 EPC a statement setting out the grounds of appeal shall be filed within four months of notification of the contested decision. In Rule 99(2) EPC it is specified that in the grounds of appeal the appellant shall indicate the "*reasons*" for setting aside the decision impugned, or the extent to which it is to be amended, and the "*facts*" and "*evidence*" on which the appeal is based.

The jurisprudence of the boards of appeal has established the principles applicable to the statement of grounds (Case Law of the Boards of Appeal, 6th edition 2010, VII.E.7.6.1).

In particular, the grounds of appeal should state the legal or factual reasons why the decision should be set aside (T 220/83, OJ 1986, 249).

In T 213/85 (OJ 1987, 482) it was specified that the grounds of appeal had to be analysed in detail vis-à-vis the main reasons given for the contested decision.

Moreover, according to T 934/02 (unpublished; Reasons, 2.) "*... an appeal is to be considered sufficiently substantiated to satisfy the requirements of Article 108, third sentence EPC even if it does not give the reasons why the decision is contested, provided the two following criteria are met*

(i) The subject of the proceedings has changed eg due to the filing of a new set of amended claims together with the statement of grounds and

(ii) The reasons for the decision are no longer relevant in view of the change in the subject of the proceedings

More precisely, decision T 717/01 ... states the following ...: An appeal of the patent proprietor is to be considered sufficiently substantiated within the meaning of Article 108, third sentence, even though it does not state any specific reasons why the contested decision is wrong, if

(i) there is a change in the subject of the proceedings due to the filing of new claims together with the statement of grounds

(ii) the statement of grounds sets out in detail why the raised grounds for opposition do not prejudice the maintenance of the patent as amended on the basis of these new claims."

- 1.2 In the present case, the contested decision refers to communications of the examining division dated 12 March 2008 and 26 September 2008 in which the applicant was informed that the application did not meet the requirements of the European Patent Convention. In these communications a plurality of objections were raised, inter alia:
- a) objections with regard to lack of clarity and support by the description (Article 84 EPC 1973) of the claims then on file;

- b) objections with regard to an insufficient acknowledgment of the prior art in the description (Rule 42(1)b) EPC);
- c) objections with regard to insufficient disclosure (Article 83 EPC);
- d) objections with regard to Article 123(2) EPC;
- e) objections with regard to lack of novelty (Article 54(1), (2) EPC 1973.

The examining division moreover underlined that there was a "*virtually irremediable lack of clarity ... and of disclosure*" (cf. first passage on page 1 of the communication dated 26 September 2008).

- 1.3 In the grounds of appeal the appellant filed an amended claim set and argued only generally that "*In order to address the objections raised in the aforementioned latter Communication, the claims have been amended for further clarity. In particular, claim 1 has been rewritten to correspond to the embodiment of Figure 2.*" No detailed comment, however, was made with regard to Article 123(2) EPC, Article 83 EPC 1973 and Article 54(1), (2) EPC 1973. Also the objection with regard to Rule 42(1)b) EPC was not discussed at all.
- 1.4 Whereas the first criterion mentioned above is met by filing a new set of amended claims with the grounds of appeal, the second criterion above is not fulfilled at all.
- 1.5 Present claims concern an acoustic liner without clearly defining the arrangement of the acoustic liner to the gradient coil. Thus, the clarity objections raised by the Examining Division are still relevant.

This relates in particular to expressions like, for example, "*compressible*", "*in synchronism*", "*identical conducting paths*", "*resistance to gradient coil*", "*mutual inductance*", "*coupling*", "*closed loop*", "*number of turns*" and "*centre*".

1.6 Further, the appellant has failed to submit any comments on the objections under Article 83 EPC 1973 as expressed in point 3. of the communication of 12 March 2008, although the Examining Division had clearly underlined the seriousness of these objections. In this respect, the Board has no reason to disagree with the Examining Division.

1.7 In conclusion, the statement of grounds of appeal does not set out in detail why at least some of the reasons for the decision refusing the application no longer apply or are not well-founded.

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible.

The Registrar:

The Chairman:

R. Schumacher

G. Assi