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**Datasheet for the decision
of 29 September 2022**

Case Number: T 3060/19 - 3.5.02

Application Number: 16152529.0

Publication Number: 3032560

IPC: H01H33/666, H01H1/00, H01H75/04

Language of the proceedings: EN

Title of invention:
Bistable actuator device

Patent Proprietor:
S & C Electric Co.

Opponent:
Siemens Aktiengesellschaft

Relevant legal provisions:
EPC Art. 54, 56, 83
RPBA 2020 Art. 12(6)

Keyword:
Novelty, inventive step, sufficiency of disclosure - main request (yes)
Late-filed objections - should have been submitted in first-instance proceedings (yes)

Decisions cited:

T 0862/11



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Case Number: T 3060/19 - 3.5.02

D E C I S I O N
of Technical Board of Appeal 3.5.02
of 29 September 2022

Appellant: Siemens Aktiengesellschaft
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
24 September 2019 concerning maintenance of the
European Patent No. 3032560 in amended form.**

Composition of the Board:

Chairman R. Lord
Members: C.D. Vassoille
W. Ungler

Summary of Facts and Submissions

- I. The opponent filed an appeal against the interlocutory decision of the opposition division concerning maintenance of the European patent no. 3 032 560 in amended form.
- II. The following documents are relevant for the present decision:
- D1: WO 2011/098353 A1
D6: EP 1 975 960 A1
D10: DE 32 30 564 A1
D10': US 4,490,701
D11: DE 43 27 180 A1
- III. In the decision under appeal, the opposition division *inter alia* came to the conclusion that the subject-matter of claim 1 of the then main request was new in view of document D1 and that it further involved an inventive step in view of a combination of document D1 with document D8 or D10 and also in view of a combination of documents D6 and D4.
- IV. In its reply to the appeal, the patent proprietor filed a new main request which differed from the then main request, underlying the decision under appeal and found to meet the requirements of the Convention, in that dependent claim 6 was deleted.
- V. The parties were summoned to oral proceedings. In a communication under Article 15(1) RPBA 2020 annexed to the summons, the board set out their preliminary

observations on the appeal, concluding that it did not see any prospect of success for the appeal.

VI. Oral proceedings took place on 29 September 2022 in the presence of the parties.

The opponent (appellant) requested that the decision under appeal be set aside and that the patent be revoked. The appellant further requested that the case be remitted to the opposition division for further discussion of auxiliary requests 1 to 4.

The patent proprietor (respondent) requested that the patent be maintained in amended form on the basis of the main request filed with the reply to the appeal, or if that was not possible that the patent be maintained in amended form on the basis of one of the auxiliary requests 1 to 4 also filed with the reply to the appeal.

VII. Claim 1 of the main request has the following wording:

"A device comprising:
a bi-stable actuator (172, 300) for operating a moving contact of a vacuum interrupter (152), the actuator (172, 300) having a first mechanically stable position corresponding to a make position of the moving contact, and a second mechanically stable position corresponding to a break position of the moving contact; and
a circuit coupled between first (312, 502) and second (316, 504) coils of the bi-stable actuator (172, 300);
characterised in that
the circuit includes a voltage tap (500) disposed between the first (312, 502) and second (316, 504) coils and further being configured to selectively pulse the first (312, 502) and second (316, 504) coils and

sense a voltage at the tap (500) for determining a position of the bi-stable actuator (172, 300) as being one of the first mechanically stable position or the second mechanically stable position; and wherein the actuator (172, 300) comprises flat magnets (306, 308) acting through associated pole pieces (302, 304) upon an operator (310) responsive to selective energization of first (312, 502) and second (316, 504) coils coupled with the flat magnets (306, 308) to drive the operator (310) to one of two positions and to stabilize the operator (310) in the one of two positions upon the operator (310) being driven to that one of the two positions."

Claims 2 to 9 are dependent on claim 1.

In view of the decision on the main request, it is not necessary to reproduce the wording of the auxiliary requests at this point.

VIII. The arguments of the appellant as far as they are relevant for the present decision are as follows:

Sufficiency of disclosure (Article 83 EPC)

The patent did not describe the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. According to claim 4 of the main request, the magnets and pole pieces were located in a molded cavity of the bobbin without using glue or adhesives. However, the patent did not disclose any technical effects or advantages resulting from this. Consequently, the skilled person had to arbitrarily try out all other fastening methods, since the patent did not contain anything that would

enable the skilled person to recognise a successful attempt.

Novelty (Article 54 EPC)

Document D1 disclosed all features of claim 1. In particular, D1 disclosed flat magnets, see figure 1, permanent magnet 15. It also disclosed that the flat magnets acted through associated pole pieces, see the element illustrated in figure 1 between the permanent magnet 15 and the armature 16.

Claim 1 may recite "magnets". This wording was however unspecified and the skilled person therefore had reason to interpret the term with the help of the description. The patent in paragraph [0019] allowed for an interpretation of claim 1 such that only one magnet is sufficient. Article 69 EPC was relevant for the interpretation of claim 1.

D1 at least implicitly disclosed pole pieces, because the skilled person would always consider the commonly known use of pole shoes in order to control the magnetic flux. This was demonstrated by document D11.

Inventive step (Article 56 EPC)

The subject-matter of claim 1 did not involve an inventive step in view of a combination of D1 with document D10 and the common general knowledge of the skilled person. Document D10 disclosed flat magnets 11a and 11b, see figure 4, which the skilled person would have used instead of the ring magnet of D1.

Furthermore, the skilled person confronted with the objective of adapting the shape of the magnets to the

armature knew that this could be done by means of the well-known use of pole shoes.

The subject-matter of claim 1 also did not involve an inventive step in view of document D6. D6 disclosed all features except sensing a voltage at a tap. In particular, element 16 in figure 3 corresponded to pole pieces in the sense of claim 1.

Document D10' - Admittance into the appeal procedure

While it was true that admitting document D10' into the opposition proceedings was not explicitly requested, the document in fact had been the subject of discussions during the oral proceedings before the opposition division. This was neither reflected in the decision nor in the minutes, as the latter were not detailed, but limited to the formal course of the proceedings and the decision. Requesting a correction of the minutes therefore did not seem to be possible.

Objections under Article 123(2) EPC - Admittance into the appeal procedure

The integration of granted claim 2 into granted claim 1 led to an inadmissible extension of the claimed subject-matter, since the resulting combinations of the new claim 1 with the dependent claims was not originally disclosed. The infringement of Article 123(2) EPC by the introduction of new claim combinations was readily apparent and the corresponding objection should therefore be admitted into the appeal procedure.

IX. The arguments of the respondent as far as they are relevant for the present decision are as follows:

Sufficiency of disclosure (Article 83 EPC)

The skilled person was aware of methods for locating parts that do not involve gluing, for example using fasteners or simply mechanically locating a part within a housing or frame. The main request thus met the requirements of Article 83 EPC.

Novelty (Article 54 EPC)

The subject-matter of claim 1 was new in view of document D1, because it did not disclose either (a plurality of) flat magnets or associated pole pieces. The term "magnets" in claim 1 clearly had its normal, plain meaning, namely more than one magnet. The description in paragraph [0019] mentioned one or more magnets in relation to a pole piece but not in relation to the whole actuator. D1 in contrast disclosed a single annular magnet and not a plurality of flat magnets. D1 further did not disclose pole pieces as required by claim 1.

Inventive step (Article 56 EPC)

Document D1 referred to a steering device comprising an electromagnetic lock for a vehicle. It was not apparent why the skilled person would select document D10 in order to modify the steering device of D1. While pole pieces generally formed part of the common general knowledge, the combination of magnets with pole pieces as an alternative to flattening an armature in an actuator did not pertain to the common general knowledge. Hence, even if the skilled person were to

turn to D10, they would not arrive at the subject-matter of claim 1, because D1 did not disclose pole pieces and it was not apparent why they would use pole pieces instead of a flattened armature.

The need to first modify the construction disclosed in document D10 before applying its teaching to the device of document D1 was an indication of the presence of an inventive step.

Document D10' - Admittance into the appeal procedure

Document D10' should not be admitted into the appeal procedure. D10' was used by the respondent in the course of the oral proceedings before the opposition division as a translation aid for document D10. A copy of this document was not handed over to the opposition division. The appellant, who had access to a copy of the document, did not request admittance of it into the opposition proceedings. Accordingly, document D10' was neither mentioned in the minutes nor in the decision under appeal and thus the document and the arguments in the appeal grounds based on it constituted a new objection.

In accordance with Article 12(6) RPBA 2020, the document and the objections based on it should have been already submitted in the proceedings before the opposition division. Admitting the document would contradict the principle laid down in Article 12(2) RPBA 2020, according to which the primary object of the appeal procedure is to review the decision under appeal.

Objections under Article 123(2) EPC - Admittance into the appeal procedure

The appellant should have submitted the objections under Article 123(2) EPC already in the first instance proceedings. The amended claims were filed at a very early stage of the proceedings so that the appellant had had sufficient time to submit these objections. This is particularly the case given that, as argued by the appellant, the inadmissible extension of the claimed subject-matter was so obvious. The objections under Article 123(2) EPC were therefore not to be admitted into the appeal procedure.

Reasons for the Decision

1. The appeal is admissible.
2. *Main request - Sufficiency of disclosure (Article 83 EPC)*
 - 2.1 The patent discloses the invention as defined in claim 4 in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.
 - 2.2 The invention according to claim 4 of the main request is defined by the following feature:

" [...] wherein the magnets (306, 308) and pole pieces (302, 304) are located in a molded cavity of the bobbin (318) without using glue or adhesives."
 - 2.3 Firstly, it should be noted that the board does not consider the lack of disclosure of a technical effect or advantage of the feature of claim 4 to be relevant

for the assessment of compliance with Article 83 EPC in the present case. In any event, the appellant did not submit any arguments in support of their contention that a lack of technical effect of the feature claimed by claim 4 affects its practicability (on the question of the relevance of the technical effect for the assessment of Article 83 EPC, see T 0862/11, in particular point 5.5 of the grounds).

Therefore, with regard to the question of sufficiency of disclosure, it is irrelevant in the present case that no explicit technical effect of the feature of claim 4 is mentioned in the patent or derivable from it.

For the sake of completeness the board notes that a technical effect in the present case could simply be seen in the avoidance of the disadvantages resulting from gluing and adhesive bonding.

2.4 Apart from the above, the board agrees with the opposition division's findings in the decision under appeal, according to which claim 4 implies the use of a method to fasten the magnets and pole pieces in a molded cavity of the bobbin other than gluing or adhesive bonding (see point 2 of the reasons for the decision under appeal). In the sense of a mathematical exclusion set, claim 4 encompasses all possibilities of locating the magnets and the pole pieces in a molded cavity of the bobbin except gluing and adhesive bonding.

However, this circumstance does not prevent the skilled person from implementing the feature in question, as they merely have to dispense with gluing or adhesive bonding in order to carry out the invention as defined

in claim 4. In this context, it is not apparent to the board, and the appellant did not provide any convincing arguments in this respect, why it should not be possible for the skilled person to find alternative solutions for locating of the magnets and the pole pieces in a molded cavity of the bobbin. Furthermore, there are no indications that the selection of an appropriate alternative method involves an insurmountable effort that would hinder the skilled person from implementing the invention. On the contrary, there are clearly other methods for locating the magnets and pole pieces in a moulded cavity of the bobbin, such as fasteners or mechanical positioning, as was argued by the respondent.

- 2.5 The board has therefore come to the conclusion that the patent discloses the invention as defined in claim 4 in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

Consequently, the main request meets the requirement of Article 83 EPC.

3. *Main request - Novelty in view of D1 (Article 54 EPC)*

- 3.1 The subject-matter of claim 1 of the main request is new in view of document D1, as it at least does not disclose that the actuator comprises

"flat magnets acting through associated pole pieces upon an operator".

- 3.2 Contrary to what the appellant argued, claim 1 recites "magnets" and is thus not vague but, quite to the contrary, clearly and unambiguously directed to a plurality of magnets. Furthermore, in the overall

context of claim 1, there is nothing that would lead the skilled person to assume that anything else could be meant by the term "magnets" than its normal meaning, namely a plurality of magnets. Consequently, there is no need for the skilled person to further interpret the claim and consult the description for this purpose.

3.3 The appellant's argument that Article 69 EPC was relevant in the context of the discussion on novelty of the subject-matter of claim 1 in view of D1 does not convince the board. Article 69(1) EPC concerns only the extent of protection, which is relevant for the purposes of assessing Article 123(3) EPC and in national infringement proceedings (see the Case Law of the Boards of Appeal, tenth edition 2022, II.A.6.3.2). Consequently, in the assessment of novelty, Article 69(1) EPC cannot be relied upon to give a different meaning to a feature which is clear in itself in the overall context of the claim, as is the case here.

3.4 For the sake of completeness the board notes that, even if a skilled person were to take into account paragraph [0019] for the purposes of interpreting claim 1, it is merely stated there that the pole pieces transmit flux from one or more magnets. Hence, it does not disclose that the actuator can comprise only one magnet. There is also no reference to a corresponding teaching in the further disclosure of the patent. Thus, there is nothing in the description that contradicts the normal meaning of this term in claim 1.

3.5 The appellant did not contest that document D1 does not disclose a plurality of magnets but only a single ring magnet 15. The board also cannot accept the appellant's argument that a two-part ring magnet was implicitly disclosed by document D1. An implicit disclosure refers

to a technical teaching that is directly and unambiguously derivable from the content of a document, even if it is not described explicitly. However, this clearly does not apply to the two-part form of the ring magnet, which constitutes a mere alternative to a one-piece ring magnet.

- 3.6 D1 therefore does not disclose "flat magnets" in the sense of claim 1.
- 3.7 Furthermore, document D1 does not disclose directly and unambiguously pole pieces within the meaning of claim 1. Figure 1 of D1 illustrates a hatched element between the magnet 15 and the armature 16. However, this element is not mentioned or described in document D1. In particular, from D1, neither structural nor functional properties of this element are derivable. Moreover, it is not clear from figure 1 whether the element consists of multiple parts or of a single piece.
- 3.8 Furthermore, the board cannot share the appellant's view that the element in question implicitly corresponded to "pole pieces", since it necessarily had to be made of a material that did not impede the magnetic flux from the magnets to the operator, which was the definition of a pole piece in the sense of claim 1.

According to paragraph [0022] of the contested patent, the pole pieces may be constructed from any suitable magnetic flux concentrating material. For the board, the pole pieces are therefore not equivalent to any element being made of a material that does not impede the magnetic flux, as submitted by the appellant. In any case, neither the type nor the function of the

element in relation to the magnetic flux can be derived from the disclosure of D1, which is shown only schematically in figure 1. In particular, it is not apparent that the skilled person could derive any property of the element in question in the sense of an implicit disclosure.

3.9 Consequently, document D1 does not disclose "pole pieces" within the meaning of claim 1.

3.10 Therefore, the subject-matter of claim 1 is new in view of document D1. Since the appellant did not raise any further objection under Article 54 EPC, the board concludes that the main request meets the requirement of Article 54 EPC.

4. *Main request - Inventive step (Article 56 EPC)*

4.1 *Document D1 in combination with D10 and the common general knowledge*

4.1.1 The subject-matter of claim 1 involves an inventive step in view of a combination of document D1 with D10 and the common general knowledge.

4.1.2 The subject-matter of claim 1 differs from document D1 in that the actuator comprises flat magnets acting through associated pole pieces upon an operator (see the board's findings under point 3. above).

4.1.3 The parties did not contest the objective technical problem as formulated by the opposition division in the decision under appeal, when starting from D1 and in view of these distinguishing features, i.e. to increase the responsiveness of the device.

4.1.4 The appellant essentially argued that the skilled person, in order to solve the objective technical problem, would have applied the flat magnets of D10 (see figure 4) to the device of D1. While doing so, the skilled person further would not have flattened the armature (operator) as disclosed in D10 in order to adapt the shape of the cuboid magnets to the armature, but they would instead have used pole pieces for this purpose. The use of pole pieces had been, according to the appellant, commonly known to the skilled person and, in particular, constituted known means to adapt the shape of a magnet to an armature as an alternative to flattening the armature to provide a large pole face.

The board is not convinced by this argument. As was submitted by the respondent, document D10 on page 10, third paragraph, explicitly discloses that the armature 8 is flattened in the region of the permanent magnets 11a and 11b, in order to achieve sufficiently large pole faces.

When applying the teaching of D10 to the actuator of D1, the skilled person would have required a motivation to deviate from this teaching disclosed in D10 with regard to adapting the shape of the cuboid magnets and the armature. Thus, even if the use of pole pieces to adapt the shape of the magnet and armature had been commonly known, it is not apparent for what reasons this alternative, not disclosed in D10, would have been chosen by the skilled person, thereby modifying the teaching of D10 before its application to the device of D1.

In this connection, the board notes that it has no doubt that pole pieces (pole shoes) as such belonged to

the common general knowledge of the skilled person. However, the board seriously doubts that this also applies to the use of pole shoes for the purposes of shape matching of magnet and armature. The appellant has not submitted sufficient evidence in this respect, nor is the board aware of any such common general knowledge. There is also nothing in the prior art that would have led the skilled person to modify the teaching of D10 to use pole pieces instead of a flattened armature. A corresponding teaching is not disclosed in any of the documents relevant to the procedure.

Furthermore, as argued by the respondent, using pole pieces instead of flattening the armature would have contradicted the clear teaching of D10 in view of increasing the pole face, and thus the magnetic flux, by flattening the armature in the area of the permanent magnets. As stated above, it is not apparent to the board what motivation the skilled person would have had to deviate from this teaching and the appellant has not submitted any convincing arguments in this respect.

4.1.5 The board therefore has come to the conclusion that the combination of document D1 with document D10 and further in combination with the common general knowledge does not render the subject-matter of claim 1 obvious to the skilled person.

4.2 *Document D6*

4.2.1 The subject-matter of claim 1 involves an inventive step in view of document D6.

4.2.2 In the statement of grounds of appeal, the appellant repeated verbatim the statement of grounds for

opposition, which contained, *inter alia*, an objection under Article 56 EPC to granted claim 2, which forms part of claim 1 of the present main request.

In particular, the appellant argued that document D6 disclosed all features of a combination of claims 1 and 2 except that of a tap to sense a voltage.

- 4.2.3 However, the board concurs with the findings of the opposition division in the decision under appeal that the magnet in document D6, see in particular figure 3, directly faces the operator (plunger 12) and consequently, that no pole pieces are disclosed in D6.

Document D6 therefore does not disclose pole pieces as required by claim 1.

The appellant considered elements 16, see D6 in figure 3, as pole pieces. However, contrary to the appellant's view, element 16 is a magnetic yoke, see D6 in paragraph [0023]. It is evident that the magnetic yoke neither corresponds to a pole piece in the sense of claim 1, nor does it serve to make the flat magnets act with the operator.

- 4.2.4 According to Article 12(3) RPBA 2020, the statement of grounds of appeal shall contain a party's complete case. It shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the requests, facts, objections, arguments and evidence relied on.

The appellant in the statement of grounds of appeal, however, did not set out any reasons why they considered the opposition division's conclusions in the

decision under appeal regarding document D6 to be wrong. They have merely repeated their first-instance arguments verbatim.

Consequently, in the absence of any arguments in this respect, the board, being in agreement with the opposition division in substance, sees no reason to deviate from the decision under appeal on this point.

The subject-matter of claim 1 is therefore not rendered obvious to the skilled person in view of document D6.

4.3 Since the subject-matter of claim 1 is neither rendered obvious by document D1 in combination with document D10 and the common general knowledge of the skilled person, nor by document D6, the main request meets the requirements of Article 56 EPC.

5. *Admittance of document D10' into the appeal procedure*

5.1 According to Article 12(6) RPBA 2020 (applicable under Article 25(1) RPBA 2020), the board shall not admit requests, facts, objections or evidence which should have been submitted in the proceedings leading to the decision under appeal, unless the circumstances of the appeal case justify their admittance.

5.2 Neither the minutes of the oral proceedings before the opposition division nor the decision under appeal contain any mention of document D10'.

The appellant has argued that document D10', which was used by the respondent as a translation aid for document D10, was the subject of discussion during the oral proceedings before the opposition division and that a request for correction of the minutes did not

seem to be possible. However, the appellant did not dispute that the formal introduction of D10' into the opposition procedure was not requested.

- 5.3 Against this background, the board agrees with the respondent that document D10' did not become part of the opposition proceedings and that the objection under Article 56 EPC based on this document and submitted for the first time with the statement of grounds of appeal constitutes a new objection, the admittance of which is subject to the provisions of Article 12(6) RPBA 2020.
- 5.4 The appellant did not provide any convincing reasons why document D10' as well as the objections based on it were submitted for the first time with the statement of grounds of appeal. In particular, the appellant did not provide any argument as to why the circumstances of the appeal case justified their admittance.
- 5.5 To the extent that the appellant argued that D10' was *prima facie* relevant in view of the disclosure of pole pieces in that document, the board repeats that it does not contest that pole pieces form part of the common general knowledge. However, the appellant's new objection is based on the particular configuration of D10', in particular that illustrated in figures 6, 7, 10, 11 and 12, and thus goes far beyond an argument based on common general knowledge.
- 5.6 The board concludes that the new objection under Article 56 EPC based on document D10' and submitted for the first time with the statement of grounds of appeal, should have already been submitted in the opposition proceedings. Furthermore, no special circumstances of the appeal case can be identified which could nevertheless justify an admittance of the new objection

and the appellant has not submitted any convincing argument in this respect.

The board therefore decided not to admit document D10' and the objection based on it into the appeal procedure under Article 12(6) RPBA 2020.

6. *Admittance of the objections under Article 123(2) EPC*

6.1 In the statement of grounds of appeal, the appellant argued for the first time in the proceedings that new combinations of claims, resulting from the combination of claims 1 and 2 in the present main request, led to an inadmissible extension of the claimed subject-matter (Article 123(2) EPC).

6.2 The admittance of the new objections under Article 123(2) EPC is subject to the provisions set out under Article 12(6) RPBA 2020, applicable under Article 25(1) RPBA 2020 (see point 5.1 above).

The board agrees with the respondent that the objections under Article 123(2) EPC against new claim combinations resulting from the combination of granted claims 1 and 2 should have been submitted already in the first instance proceedings. In particular, granted claims 1 and 2 were already combined at a very early stage of the opposition proceedings, namely with the reply of 4 May 2018 to the opposition, in the context of a new main request. There can be no doubt that the opponent thus already had sufficient time in the proceedings before the opposition division to become aware of any problems arising from the combination of claims 1 and 2 with regard to the original dependencies of the dependent claims and to react to them.

This is all the more true as the appellant has argued that the inadmissible extension of the present main request was so obvious that the corresponding objection should be admitted in the appeal procedure.

6.3 The appellant has also not submitted that the circumstances of the present appeal case justified admittance of the objections, and for the board no corresponding circumstances are apparent.

6.4 The board therefore decided not to admit the objections under Article 123(2) EPC against the main request into the appeal procedure.

7. *Conclusion*

Given that the main request fulfils the requirements of Articles 83, 54 and 56 EPC and considering that the further objections raised by the appellant were not admitted into the appeal procedure, the board had to accede to the respondent's main request. It was therefore not necessary for the board to decide on the appellant's request for remittal for discussion of the auxiliary requests.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent in the following version:

Claims:

No. 1 to 9 of the main request filed with the reply to the appeal.

Description:

Pages 2 to 5 of the patent specification.

Figures:

No. 1 to 16 of the patent specification.

The Registrar:

The Chairman:



U. Bultmann

R. Lord

Decision electronically authenticated