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**D E C I S I O N**  
**of 6 November 1998**

**Case Number:** T 1079/96 - 3.3.3

**Application Number:** 89402087.4

**Publication Number:** 0352199

**IPC:** C08J 7/17

**Language of the proceedings:** EN

**Title of invention:**

Hydrophilic material and method of manufacturing the same

**Patentee:**

Terumo Kabushiki Kaisha

**Opponent:**

Akzo Nobel Faser AG

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 69, 84, 102(2), (3), 107, 113(1)

EPC R. 58(2), (4), (5), 67

Guidelines VI, 7.2.1, 7.2.2

**Keyword:**

"Maintenance in amended form - opponent not informed of the full amended text - adaptation of the description - substantial procedural violation"

**Decisions cited:**

G 0001/88, G 0009/91, T 0273/90, T 0442/91, T 0113/92,

T 0996/92, T 0263/93

**Catchword:**

-



Case Number: T 1079/96 - 3.3.3

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.3**  
**of 6 November 1998**

**Appellant:** Akzo Nobel Faser AG  
(Opponent) Kasinostrasse 19-21  
42097 Wuppertal (DE)

**Representative:** -

**Respondent:** Terumo Kabushiki Kaisha  
(Proprietor of the patent) No. 44-1, Hatagaya 2-chome  
Shibuya-ku  
Tokyo 151 (JP)

**Representative:** Gillard, Marie-Louise  
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**Decision under appeal:** Interlocutory decision of the Opposition Division  
of the European Patent Office posted 7 October  
1996 concerning maintenance of European patent  
No. 0 352 199 in amended form.

**Composition of the Board:**

**Chairman:** C. Gérardin  
**Members:** P. Kitzmantel  
J. A. Stephens-Ofner



## Summary of Facts and Submissions

I. European patent application No. 89 402 087.4 in the name of TERUMO KABUSHIKI KAISHA which had been filed on 21 July 1989, claiming priority from a JP application filed on 22 July 1988, resulted in the grant of European patent No. 352 199 on 18 January 1995, on the basis of the following Claims 1 to 7:

"1. A hydrophilic material, characterized in that a block copolymer containing a material (X) having a hydrophilic polymer chain and a material (Y) having a hydrophobic polymer chain, and/or these materials (X) and (Y) are coupled as graft chain to the surfaces of a substrate (Z) of a polymer material.

2. A hydrophilic porous membrane composed of the hydrophilic material according to claim 1, characterized in that said substrate (Z) is a porous membrane substrate, and said block copolymer and/or the materials (X) and (Y) are coupled as graft chain to at least part of the surfaces of said porous membrane substrate (Z) and inner pore surfaces of said porous membrane substrate (Z).

3. The hydrophilic porous membrane according to claim 2, characterized in that said substrate (Z) is composed of a hydrophobic polymer material with a threshold surface tension of  $5 \cdot 10^{-4}$  N/cm (50 dyn/cm) or below and a water absorption factor of 1.0% or below, and said porous membrane has a bubble point of  $1.96 \cdot 10^4$  to  $1.96 \cdot 10^6$  Pa (0.2 to 20.0 kgf/cm<sup>2</sup>), a membrane thickness of 20

to 300  $\mu\text{m}$  and a porosity of 20 to 80%.

4. A hydrophilic porous membrane according to claim 2 or 3, characterized in that said substrate (Z) is composed of a hydrophobic polymer material mainly composed of polypropylene.

5. A material fitted to living bodies composed of the hydrophilic material according to claim 1.

6. A method of manufacturing a hydrophilic material characterized by comprising a first step of subjecting at least part of the surfaces (1a) of a substrate (Z) of a polymer material to a plasma treatment to thereby produce a polymer radical on said surfaces, a second step of causing graft polymerization with said polymer radical as point of initiation of polymerization by supplying a hydrophilic monomer (X) in gaseous phase to the substrate (Z) and a third step of causing graft polymerization subsequent to the second step with the polymer radical present at the point of growth of the hydrophilic monomer (X) and/or radical on the surfaces of the substrate (Z) as point of initiation of polymerization by supplying a hydrophobic monomer (Y) in gaseous phase to the substrate (Z).

7. The method according to claim 6, characterized in that said second and third steps are performed repeatedly in the mentioned order after said third step."

II. Notice of Opposition requesting revocation of the

patent, extending to Claims 1 to 5, on the grounds of Article 100(a) EPC was filed by AKZO NOBEL FASER AG on 17 October 1995.

III. On 7 October 1996 the Opposition Division issued a written decision, comprising:

- (i) a first page comprising EPO Form 2330 entitled "Decision rejecting the opposition (Article 102(2) EPC)",
- (ii) a second page comprising EPO Form 2339.3 identified as an interlocutory decision within the terms of Article 106(3) EPC,
- (iii) a third page comprising EPO Form 2339.4 headed "page 2 of the interlocutory decision",
- (iv) five pages of the "Grounds for the decision" on EPO Form 2916,
- (v) "Annex I" comprising a set of seven claims in typed (not printed) form showing the filing date of 17 December 1993, the wording of which conforms with that of the granted claims,
- (vi) "Annex II" comprising a set of (amended) seven claims as filed by the Patentee on 22 May 1996 with his submission dated 21 May 1996, and
- (vii) pages 1 to 8, as well as Figures 1 and 2 of the B1 version of the opposed patent, the only amendment therein being the deletion of lines 55

to 58 on page 8 (i.e. the beginning of the claims-portion of the patent).

IV. The claims of "Annex II" of that decision read as follows (with respect to the version of the claims as granted, statements in **bold** have been added, statements in *[square brackets]* have been deleted):

"1. A hydrophilic material[, characterized in that] **which comprises** a block copolymer containing a material (X) having a hydrophilic polymer chain and a material (Y) having a hydrophobic polymer chain, **said block copolymer being** *[and/or these materials (X) and (Y) are]* coupled as a graft chain to the surface[s] of a substrate (Z) of a **hydrophobic** polymer material.

2. A hydrophilic porous membrane composed of the hydrophilic material **of** *[according to]* claim 1, **wherein** *[characterized in that]* said substrate (Z) is a porous membrane substrate[, ] and **wherein** said block copolymer *[and/or the materials (X) and (Y) are]* **is** coupled as a graft chain to at least part of the surfaces of said *[porous membrane]* substrate (Z) and inner pore surfaces of said *[porous membrane]* substrate (Z).

3. The *[hydrophilic porous membrane according to]* **membrane of** claim 2, **wherein** *[characterized in that]* **the hydrophobic material of** said substrate (Z) *[is composed of a hydrophobic polymer material with]* **has** a threshold surface tension of  $5 \cdot 10^{-4}$  N/cm (50 dyn/cm) or below **or** *[and]* a water absorption factor of 1.0% or below, *[and]* said *[porous]* membrane ha**s**ving a bubble point of  $1.96 \cdot 10^4$  to  $1.96 \cdot 10^6$  Pa (0.2 to 20.0 kgf/cm<sup>2</sup>), a



[*membrane*] thickness of 20 to 300  $\mu\text{m}$  and a porosity of 20 to 80%.

4. **The** [*A hydrophilic porous*] membrane [*according to*] **of** claim 2 or **claim 3, wherein** [*characterized in that said*] **the hydrophobic material of** substrate (Z) is [*composed of a hydrophobic polymer material*] mainly composed of polypropylene.

5. A material fitted to living bodies, **which is** composed of the hydrophilic material **of** [*according to*] claim 1.

6. A method of manufacturing a hydrophilic material **which comprises** [*characterized by comprising*] a first step of subjecting at least part of the surface[s] (1a) of a substrate (Z) of a polymer material to a plasma treatment to thereby produce a polymer radical on said surfaces, a second step of causing graft polymeris[Z]ation with said polymer radical as point of initiation of polymeris[Z]ation by supplying a hydrophilic monomer (X) in gaseous phase to the substrate (Z) and a third step of causing graft polymeris[Z]ation subsequent to the second step with the polymer radical present at the point of growth of the hydrophilic monomer (X) and/or radical on the surfaces of [*the*] substrate (Z) as point of initiation of polymeris[Z]ation by supplying a hydrophobic monomer (Y) in gaseous phase to the substrate (Z).

7. The method **of** [*according to*] claim 6, **wherein** [*characterized in that*] said second and third steps are performed repeatedly in the mentioned order after said

third step."

V. The following statements appear in that decision:

V.1 In point 5 of Section I. "Facts and Submissions":

"In the letter of 21/05/96 the proprietor submitted a new set of claims 1 to 7, the text of which is appended to this decision (Annex II), and requested that the patent be maintained on the basis of the amended claims 1 to 7 since the subject-matter of the contested patent was novel and inventive."

V.2 In point 2 of Section II. "Reasons for the Decision":

"The claim version on file (Claims 1 to 7; 21/05/96) complies with Article 123(2) and (3) EPC ..."

V.3 In point 6 of Section II. "Reasons for the Decision":

"The Opposition Division is therefore of the opinion that, taking into consideration the amendment made, the patent and the invention to which it relates meet the requirements of the EPC."

VI. On 10 December 1996 the Opponent (Appellant) lodged an appeal against the decision of the Opposition Division and simultaneously paid the appeal fee. On 1 February 1997 he submitted the Statement of Grounds of Appeal. With a letter dated 15 July 1997 he supplemented his submissions.

VII. The arguments of the Appellant may be summarized as follows:

Although, pursuant to page 1 the decision under appeal was identified as one rejecting the opposition under Article 102(2) EPC, it was actually an interlocutory decision for maintenance of the patent in amended form according to Article 102(3) EPC and was based on the claims as filed with the Patentee's letter dated 21 May 1995. The description, however, had not been adapted to these claims. Prior to that decision the Opposition Division did neither issue a request for adaptation of the description to the amended claims according to Rule 58(2) EPC nor invite the parties to comment, according to Rule 58(4) EPC, on the proposed version of the amended patent.

Thus, the Opponent/Appellant had not been given an opportunity to comment on the form in which the Opposition Division intended to maintain the patent, which amounted to a substantial procedural violation which justified the reimbursement of the appeal fee.

The Patentee's/Respondent's argument that there was no need for an adaptation of the description was contrary to the facts, since by defining that, according to claim 1, the substrate (Z) was "of a hydrophobic material" the patent was restricted to one of the originally disclosed alternatives, a fact that was not reflected in the statements on page 3, lines 7 to 19 of the granted version of the patent description.

In the Appellant's opinion, he was entitled to the appeal because the instant decision would lead to legal insecurity, not only because the wrong use of the

designation "rejection of the opposition" could lead third parties to the conclusion that the patent was maintained unamended, but also because Article 69 EPC, for the proper interpretation of the scope of protection conferred, relied upon the description, which, in the present case, was however not in agreement with the claims as required by Article 84 EPC. That an Opponent was adversely affected by an insufficient adaptation of the description, because this was harmful to his commercial interests, was recognized in decisions T 273/90, dated 10 June 1991, and T 996/92, dated 23 March 1993, both not published in the OJ EPO.

Since the Appellant was informed only by the decision under appeal of the form in which the Opposition Division intended to maintain the patent, the first opportunity he had to advance his respective objections was by appealing that decision. The Respondent's reproach that he, the Appellant, should have raised his objections before the first instance was unfounded, since he was not given an opportunity to do so.

VIII. The arguments of the Respondent (Proprietor of the patent) may be summarized as follows:

According to Rule 58(2) EPC there was no **absolute** obligation on the Opposition Division for requiring the Patentee, in a communication pursuant to Article 101 EPC, to file an amended description, because that Rule provides for such action only "where appropriate" and to the extent it is "necessary".

In the present case, however, it was neither appropriate nor necessary to adapt the description to the amended claims, since it was clear from the granted version of the patent in suit, page 3, lines 54 to 55 and page 4, lines 1 to 2, that the substrate of the claimed hydrophilic material was made of a hydrophobic material.

As to Rule 58(4) EPC, the Respondent argued that "this communication is useful only if the Opposition Division considers that the complete document expressly approved by the patent proprietor, on which the opponent has been able to comment, still requires amendments" (counterstatement of appeal, page 2, fourth paragraph). In the present case, there was thus no need for a communication under Rule 58(4) EPC, since the Appellant in the four and a half months between the reply of the Proprietor (21 May 1996) and the decision under appeal (7 October 1996) "chose [by his letter of 27 June 1996] not to comment on the letter of the Proprietor, **hence not to comment on the text submitted by him.**"

Furthermore, according to the Respondent, the patent in suit in the form as amended met the requirements of Article 84 EPC, since the word "hydrophobic" in the claims must have the same meaning as the identical word in the description. No problem of interpretation under Article 69(1) EPC could therefore arise, which interpretation, as pointed out in T 442/91 (of 23 June 1994, not published in the OJ EPO), was moreover not within the competence of the EPO.

A legal insecurity could also not arise from the

inadvertent use, as first page of the decision under appeal, of EPO Form 2330 (destined for a rejection of the opposition according to Article 102(2) EPC), because it was clear from the remainder of the documents sent by the EPO on 7 October 1996 that the patent in suit was to be maintained in amended form.

The Respondent furthermore stated that the Appellant, in his letter of 27 June 1996, should have informed the Opposition Division of his objection rather than filing an unjustified appeal.

IX. In a communication of 23 December 1997 the Board i.a. made the following preliminary comments:

"1. Despite the wrong EPO form used as first page there can be no doubt, in view of the other parts of the decision, that the decision under appeal is an interlocutory decision concerning the Opposition Division's intention to maintain the opposed patent in amended form, i.e comprising the description and drawings as granted and the claims as filed with Patentee's letter dated 21 May 1996."

"4. It appears that, in contravention of Art. 84 EPC, the amended claims are not clearly supported by the description. While there are some statements in the description of the patent in suit according to which the substrate (Z) consists of a hydrophobic polymer (see particularly page 4, last two lines and page 6, lines 2 to 6), there are other statements which leave it open whether the polymer of the substrate (Z) is hydrophilic or hydrophobic. The latter conclusion is

i.a. based on the fact that, when referring to the material of the substrate (Z) on page 3, lines 11 to 19 and on page 5, lines 8 to 16, the hydrophobic character of the substrate is only defined in connection with the preferred embodiments covered by granted Claims 3 and 4 (see also the word "suitably" on page 3, lines 14 and 18). Moreover the sentence on page 4, lines 54 to 56: "Further, by the term "hydrophilic porous membrane" according to the invention is meant a membrane having surfaces which are more hydrophilic, ... than the polymer substrate (Z)" implies that the substrate (Z), before grafting, may be hydrophilic in character.

That the possibility of the substrate (Z) being hydrophilic was within the scope of the granted patent (and thus within the scope of the (unamended) granted description) was admitted in the Patentee's submission dated 21 May 1996: on page 1 in the paragraph "2. New set of claims" he stated: "\* claim 1 has been limited to one of its alternatives ... to recite that (i) ... and (ii) substrate (Z) is made of a hydrophobic polymer material"."

"5. The Appellant was thus in a twofold fashion entitled to appeal against the Opposition Division's decision. First, the Opposition Division by not communicating to him the version in which it intended to maintain the patent in suit violated his right under Art. 113 (1) EPC and, secondly, the non-compliance of this version with the requirements of Art. 84 EPC adversely affected his commercial interests (T 273/90, T 996/92)."

"6. It therefore appears that the decision under appeal must be set aside, that the description must be adapted to the amended claims and that reimbursement of the appeal fee is to be ordered."

X. In response to this communication of the Board the Respondent, with his letter dated 28 April 1998, submitted amended pages 3 to 6 of the description.

Nevertheless, he protested against the Board's opinion according to which Article 84 EPC obliged him to adapt the description to the amended claims; in his view, interpretation of the claims was governed by Article 69 EPC and was within the competence of National Courts only.

XI. In reaction to the Respondent's afore-mentioned submission the Appellant asked for further amendment of the description, because, in his view, some passages it contained were still inconsistent with, respectively, Claim 1 and 2.

XII. In a further communication of 16 June 1998 the Board acceded to the objections of the Appellant, referred to in the preceding paragraph, and commented on the observations made by the Respondent in his submission of 28 April 1998 as follows:

"1. The Board concurs with the opinion set out in the Appellant's submission of 11 May 1998 and herewith requests the Respondent to further amend the description of the patent. Accordingly, the statements on page 3, lines 9 and 12 "and/or these materials (X)



and (Y) are" should respectively be replaced by "is" and the sentence on page 5, lines 5 to 7 "Further, .... surfaces." should be deleted.

2. Article 102(3) EPC states that the patent as amended in opposition proceedings must "meet the requirements **of this Convention**". Therefore the patent as amended must also meet Article 84 EPC, which requires that the claims be "supported by the description". Of course, "supported by the description" means that the description as a whole shall support the claims, and this requirement of Article 84 EPC cannot, therefore, be deemed to be met, when the description comprises conflicting statements or statements of obscure scope.

3. The present case is thus one of Article 84 EPC and not one of Article 69 EPC. Quite contrastingly, it is about avoiding possible later problems under Article 69 EPC. The decisions of the Boards of Appeal cited in the Respondent's letter of 28 April 1998, page 3, 2nd and 3rd paragraph from the bottom, do therefore not apply. No "violation of the Respondent's rights" did therefore occur.

4. While there are admittedly several statements in the specification of the patent which confirm that the polymer substrate (Z) is a hydrophobic polymer material, there were quite a few which allowed some speculation about the respective character of this material (cf. the Board's communication of 23 December 1997, point 4). These statements have now been amended and, in this respect, Article 84 EPC is satisfied.

There remains, however, the problem of the term "and/or these materials (X) and (Y)" which term has been deleted from Claims 1 and 2 as granted, but - in contravention of Article 84 EPC - is still in the description (cf. point 1 supra)."

XIII. With his letter dated 17 July 1998 the Respondent filed further amended pages 3, 4 and 5 of the description which took account of the observations made in the Appellant's submission of 11 May 1998 and confirmed in the Board's communication of 16 June 1998.

XIV. Until the date of the present decision, i.e. within a period of more than three months after the latest submission of the Respondent was communicated to him with EPO Form 3345 dated 24 July 1998, the Appellant has not reacted thereto.

XV. In the Statement of Grounds of Appeal the Appellant requested

(i) setting aside of the decision under appeal and

(i-1) remittal to the first instance with the order to adapt the description to the claims as filed with Patentee's submission dated 21 May 1996, or

(i-2) revocation of the patent to the extent of Claims 1 to 5,

(ii) oral proceedings (as an auxiliary measure), and

(iii) reimbursement of the appeal fee.

After the adaptation of the description in the appeal proceedings the above requests (i) and (ii) are without object, and only request (iii) remains valid.

The Respondent originally requested that the appeal be dismissed and the decision under appeal be confirmed. With letter of 28 April 1998 he withdrew his previous requests for oral proceedings.

By submitting an amended description the Respondent obviously has changed his requests to one for maintenance of the patent in suit in the following version:

**Claims:** 1 to 7, filed with letter dated 21 May 1996,

**Description:** pages 2, 7 and 8 as granted, pages 3 to 5 as filed with letter dated 17 July 1998, page 6 as filed with letter dated 28 April 1998,

**Figures:** 1 and 2 as granted.

## Reasons for the Decision

### 1. *Admissibility*

The Appellant was entitled to appeal pursuant to Article 107 EPC, because, as set out below, he was

adversely affected by the impugned decision in a twofold way:

Firstly, he was not given an opportunity to comment on the form of the amended patent as required by Rule 58(4) EPC (cf. point 4 below) and, secondly, by deciding on the allowability of the patent in a form contravening Article 84 EPC, his interests had been jeopardized (cf. T 273/90, Reasons point 1; T 996/92, Reasons point 1; T 113/92 of 17 December 1991, Reasons point 2; all these decisions not published in the OJ EPO).

Since the further formal requirements are also met, the appeal is admissible.

2. *Article 113(1) EPC*

A decision is possible

- (i) without holding oral proceedings because the Respondent has dropped his respective request and the Appellant's request was an auxiliary one, operative only in the event that his substantial request for adaptation of the description to the amended claims would be unsuccessful, this not being the case;
- (ii) because the Appellant had sufficient opportunity (more than three months) to comment on the further amended pages of the description (meeting the Appellant's previous objections: cf. Sections XI to XIV supra) submitted with the Respondent's letter of 17 July 1998 and

communicated to the Appellant by the Board's registry on 24 July 1998 (cf. T 263/93 of 12 January 1994, not published in the OJ EPO).

3. *Category of the decision under appeal*

While there is admittedly an inconsistency between the first page of the decision under appeal, identifying a decision rejecting the opposition under Article 102(2) EPC (EPO Form 2330) and the second and third pages, identifying an interlocutory decision under Article 102(3) EPC (EPO Forms 2339.3 and 4) (cf. Section III, items (i) to (iii) supra), there can be no doubt from the whole content of the "Facts and Submissions" and the "Reasons for the Decision" that the decision was meant to be one according to Article 102(3) EPC, namely deciding that, taking into consideration the amendments made by the Proprietor of the patent during the opposition proceedings, the patent and the invention to which it relates met the requirements of the EPC (cf. Section V supra).

4. *Rule 58 EPC*

4.1 According to paragraph (4) of this Rule, the Opposition Division, before deciding on the maintenance of the patent in amended form, shall inform the parties that it intends to do so and shall invite them to state their observations within a period of two months if they disapprove of the text in which it is intended to maintain the patent.

Paragraph (5) of this Rule stipulates that if

disapproval of the text communicated is expressed, examination of the opposition may be continued. That is, if necessary, the written proceedings set out in paragraph (2) of this Rule - according to which the Proprietor shall be invited to file, where necessary, the description, claims and drawing in amended form - are to be resumed in such a case.

4.2 In the present case during the first instance opposition proceedings the Patentee, with his letter dated 21 May 1996, filed an amended set of claims and requested that the patent be maintained **on their basis** (cf. page 7, point 7 of the Patentee's "Reply Brief" attached to his aforementioned letter). In reaction thereto, the Opponent in his letter dated 27 June 1996 explained, that he did not intend to comment on the Patentee's afore-mentioned submission ("Der Einsprechende teilt mit, daß er nicht beabsichtigt, zum Schreiben des Patentinhabers vom 21.05.1996 Stellung zu nehmen").

4.3 This renunciation to comment on the contents of the Patentee's letter of 21 May 1996 is clearly only directed to this step in the opposition proceedings, i.e. to the Opponent's request to maintain the patent **on the basis** of the amended claims, which request is silent on the fate of the description, and cannot consequently be construed as a waiver of the Opponent's vested rights under Rule 58(4) EPC.

The Respondent's argument (cf. point VIII supra, third paragraph) that the Proprietor had forfeited his right to file observations by deliberately not commenting "on

the text submitted by him" (cf. Respondent's submission of 22 May 1997, page 2, sixth paragraph) is beside the point, because no "text", i.e. no complete set of documents (claims, description, drawings) had been submitted.

4.4 Notwithstanding, on 7 October 1996 the Opposition Division issued a decision (the appealed decision) to maintain the patent in amended form, i.e. with Claims 1 to 7 received on 22 May 1996 and pages 1 to 8 of the description as granted as well as two sheets of drawings as granted. Whether the Opposition Division acted in this manner because they considered that no adaptation of the description was necessary or for some other reason is of no consequence for the factual situation.

4.5 From the history of the file it is thus evident that the Opposition Division failed to respect the requirement of Rule 58(4) EPC, in that it did not inform the parties, the Opponent inclusive, of its intention to maintain the patent with the amended claims and an unamended description. Thereby, the Opposition Division contravened the requirement of Article 113(1) EPC, that the decisions of the EPO may only be based on grounds on which the parties concerned have had an opportunity to present their comments.

4.6 This amounts to a substantial procedural violation justifying the reimbursement of the appeal fee (Rule 67 EPC).

4.7 The obligation that an opponent is to be given

sufficient opportunity to comment on the proposed new text was stressed in G 1/88, point 6 of the Reasons (OJ EPO 1989, 189) and is also emphasized in the Guidelines for Examination, Chapter VI, Section 7.2.1, first paragraph and Section 7.2.2, second paragraph.

5. *Article 102(3) EPC, Article 84 EPC*

Article 102(3) EPC stipulates that a patent can only be maintained in amended form if it meets "the requirements of this Convention". This was also stressed in the Enlarged Board's decision G 9/91 (OJ EPO 1993, 408, Reasons: point 19). It is thus clear that the amended patent has to comply with Article 84 EPC.

This Article, however, i.a. requires that the claims shall be supported by the description, implying that these two parts of the patent are to be consistent.

This requirement was not fulfilled by the documents of the patent on which the decision under appeal was based, because the description contained statements which conflicted with or obscured the meaning of the subject-matter of the claims (cf. the respective points 4 of the Board's communications of 23 December 1997 and 16 June 1998, both quoted in, respectively, Sections IX and XII supra).

The Respondent's argument that after the issuance of the impugned decision the patent was beyond the competence of the EPO (cf. Section X supra), is not acceptable, because an admissible appeal was filed



against that decision; according to Article 106(1) EPC appeals have suspensive effect. Hence, the existing inconsistency between the claims and the description was not a matter of interpretation to be carried out by the National Courts applying the principles enshrined in Article 69 EPC, but was a matter to be settled under the aegis of Article 102(3) EPC.

Insofar, the Respondent's reference to T 442/91 (cf. supra, Reasons point 3) is without relevance to the issues under consideration, because the provisions of Article 69 EPC need not be invoked here.

6. However, since the amended pages of the description submitted by the Respondent during the appeal proceedings no more suffer from the deficiencies objected to by the Appellant, the reasons causing the present appeal do no longer exist.

## Order

### For these reasons it is decided that:

1. The appealed decision is set aside.
2. The case is remitted to the first instance with the order to grant a patent in the following version:

**Claims:** 1 to 7, filed before the first instance with letter dated 21 May 1996,

**Description:** pages 2, 7 and 8 as granted, pages 3 to 5 as filed with letter dated 17 July 1998, page 6 as filed with letter dated 28 April 1998,

**Figures:** 1 and 2 as granted.

3. The reimbursement of the appeal fee is ordered.

The Registrar: The Chairman:

E. Görgmaier C. Gérardin