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D E C I S I O N
of 6 April 2000

Case Number: T 0736/98 - 3.4.2

Application Number: 87101198.7

Publication Number: 0231879

IPC: G01N 24/08

Language of the proceedings: EN

Title of invention:

Self-shielded gradient coils for nuclear magnetic resonance
imaging

Applicant:

GENERAL ELECTRIC COMPANY

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 84

EPC R. 27(1)(c)

Keyword:

"Adaptation of the description for consistency with the
claims"

Decisions cited:

T 0567/93

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 0736/98 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 6 April 2000

Appellant: GENERAL ELECTRIC COMPANY
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 5 March 1998
refusing European patent application
No. 87 101 198.7 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: S. V. Steinbrener
Members: A. G. Klein
M. J. Vogel

Summary of Facts and Submissions

I. European application 87 101 198.7 (publication number 0 231 879) was refused by a first decision of the Examining Division on the ground that the claimed subject-matter lacked an inventive step within the meaning of Article 56 EPC.

In its decision T 567/93 closing the subsequent appeal procedure the Board of Appeal, in a different composition, ordered that the case be remitted to the Examining Division with the order to grant a patent on the basis of claims 1 to 10 submitted at the oral proceedings held before it, with the description and, if necessary, the drawings to be adapted.

II. Following remittal of the case to the Examining Division, the application was refused again, on the grounds that:

- the amendments which the applicant requested to be brought to the claims considered allowable by the Board of Appeal were not allowable since they could not be regarded as corrections of obvious errors (see point 1 of the Reasons); and
- the embodiment described on page 7, line 22 to page 9, line 7 of the description and illustrated in figures 4 and 11 of the drawings clearly fell outside the scope of the claims which accordingly were not supported by the description as a whole, contrary to the requirement of Article 84 EPC (see point 2.1 and 2.2 of the Reasons).

The decision also pointed at several further passages of the description which were deemed to require modification (see point 2.3 of the Reasons).

- III. The appellant (applicant) lodged an appeal against this second refusal.

- IV. In a communication pursuant to Article 11(2) of the Rules of Procedures of the Boards of Appeal, annexed to the summons to attend oral proceedings which were eventually cancelled, the Board expressed its provisional, non-binding opinion that the objections made by the Examining Division in the appealed decision were justified. The Board also pointed at a further apparent inconsistency between a passage of the description which suggested that more than two coils could be provided (see page 6, lines 18 to 23 of the description as originally filed), and independent claims 1 and 10 which referred to an inner and an outer coil only.

- V. The appellant now requests that a patent be granted on the basis of the set of claims considered allowable by the Board in the decision T 567/93, and of an amended version of the description and drawings.

Reasons for the Decision

- 1. The appeal is admissible.

- 2. The present set of claims is identical to the set considered allowable by the earlier Board's decision. Their allowability is not an issue of the present

appeal (*res judicata*).

3. The embodiment which the Examining Division considered clearly inconsistent with the claims was deleted from the description and claims, and the further formal objections raised in the appealed decision were overcome as well.
4. The appellant also deleted from the description the original statement indicating that more than two coils could be provided, as was considered necessary by the present Board to establish formal correspondence between the wording of the claims and of the description (Rule 27(1)(c) EPC).

The appellant in his letters of 24 and 27 March 2000 expressed misgivings at accepting the deletion in view of the scope of protection which might be awarded to his claims in the future, insisting that the deletion not be interpreted as a waiver of any such scope of protection.

The Board in this respect remarks that the question whether a given coil system comprising more than two coils, or a method for providing such coil system, might fall into the scope of protection of the present claims actually addresses infringement matters. This question is clearly not an issue of the present granting procedure, nor can it be prejudiced by it, accordingly.

5. The description was also otherwise adapted to the claims and supplemented with an acknowledgement of the relevant prior art, as was considered necessary by the

Board in the last point of the Reasons in the earlier decision T 567/93.

The description and drawings in the Board's view now meet all the relevant requirements of the Convention.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order to grant a patent on the basis of the following documents:

Claims: 1 to 10 filed with the letter dated 24 March 2000.

Description: pages 1 to 5 and 7 to 12 filed with the letter dated 24 March 2000 and page 6 filed with the letter dated 27 March 2000,

with the following minor amendments as requested in the telephone conversation of 28 March 2000:

in the last sentence of the hand-written passage at the bottom of page 3, the expression "coil set" is to be changed to

"coil system"; and

on page 4, line 24 the expression "coil plot of Figure 8" is to be changed to "coil plot of Figure 7".

Drawings: Sheets 1/10 to 10/10 filed with the letter dated 24 March 2000.

The Registrar:

The Chairman:

P. Martorana

S. Steinbrener