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**D E C I S I O N**  
**of 3 December 2002**

**Case Number:** T 0966/99 - 3.2.6

**Application Number:** 92112711.4

**Publication Number:** 0525676

**IPC:** A61F 13/15

**Language of the proceedings:** EN

**Title of invention:**

Clean dry facing needled composite

**Patentee:**

McNEIL-PPC, INC.

**Opponent:**

SCA MOLNLYCKE AB

**Relevant legal provisions:**

EPC Art. 108, 123(3), 54(2), 123(2), 56, 112(1)(a), 113  
EPC R. 65, 76(1)

**Keyword:**

"Admissibility of the appeal (yes)"

"Admendments - admissible (yes)"

"Novelty (yes)"

"Inventive step (yes)"

"Request to include in the decision certain reasoning in  
respect of the non-allowability of a request withdrawn by the  
patentee - rejected"

"Request to include in the minutes of oral proceedings the  
statements made by the parties concerning the withdrawn  
request - rejected"

"Referral of a question to the Enlarged Board of Appeal -  
rejected"

**Decisions cited:**

G 0009/92, G 0009/91, G 0001/97, G 0004/93, G 0004/95,  
T 0631/91

**Headnote:**

Rule 66(2) EPC implies that a decision should be reasoned in  
so far as the issues to be decided are concerned. Therefore,  
if the patent proprietor withdraws a request for maintenance  
of the patent on the basis of a set of claims, there is no  
longer a procedural basis for the Board to include reasons in

the decision concerning the withdrawn request (point 7.1).

Rule 76(1) EPC does not require the Board to include statements, which are no longer directly related to the requests on file, in the minutes of oral proceedings for the sole purpose of providing ammunition to the opponent in possible future infringement proceedings. The exclusive jurisdiction of the national courts for infringement proceedings pursuant to Article 64(3) EPC should not be prejudiced by opinions and interpretations submitted during the appeal proceedings when they no longer relate to the patent in the form in which it is upheld by the Board (point 7.2.3).

A common practice of drafting the minutes of oral proceedings based on Rule 76(1) EPC has been established by the Boards of appeal from which practice the minutes drawn up by the present Board do not deviate. The present situation therefore does not give rise to a question of non-uniform application of the law under Article 112(1)(a) EPC (point 7.3.1).



Case Number: T 0966/99 - 3.2.6

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.6**  
**of 3 December 2002**

**Appellant:** SCA MOLNLYCKE AB  
(Opponent) S-405 03 Goteborg (SE)

**Representative:** Hammond, Andrew David  
Ström & Gulliksson IP AB  
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**Respondent:** NcNEIL-PPC, INC.  
(Proprietor of the patent) Van Liew Avenue  
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**Representative:** Groening, Hans Wilhelm, Dipl.-Ing.  
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**Decision under appeal:** Interlocutory decision of the Opposition Division  
of the European Patent Office posted 20 July 1999  
concerning maintenance of European patent  
No. 0 525 676 in amended form.

**Composition of the Board:**

**Chairman:** P. Alting van Geusau  
**Members:** G. Pricolo  
M.-B. Tardo-Dino

## Summary of Facts and Submissions

I. The appeal is from the interlocutory decision of the Opposition Division posted on 20 July 1999 concerning the maintenance in amended form of European patent No. 0 525 676, granted in respect of European patent application No. 92 112 711.4.

In the decision under appeal the Opposition Division considered that the grounds for opposition under Article 100(a) to (c) did not prejudice maintenance of the patent in the form as amended during the opposition proceedings.

II. The appellant (opponent) lodged an appeal against this decision, received at the EPO on 15 September 1999, and simultaneously paid the appeal fee. The statement setting out the grounds of appeal was received at the EPO on 13 November 1999.

III. In an annex to the summons for oral proceedings pursuant to Article 11(2) Rules of Procedure of the Boards of Appeal the Board expressed its preliminary opinion that the appeal was admissible, and stated that the objections raised in respect of novelty and inventive step needed further discussion during the oral proceedings.

IV. With letter dated 4 November 2002, the respondent (patentee) filed amended patent documents forming the basis for auxiliary requests in addition to the main request to maintain the patent in the form allowed by the Opposition Division.

V. During oral proceedings, which took place on 3 December 2002, and following the announcement of the Board's opinion that the main request to maintain the patent in the form as upheld by the Opposition Division was not allowable, the respondent withdrew the main request and requested dismissal of the appeal and maintenance of the patent in amended form on the basis of the claims and description filed during oral proceedings, and drawings as granted.

The appellant withdrew all the objections raised in respect of the respondent's previous main request, and only raised the objection that the description of the patent was not in conformity with the claims as amended during the oral proceedings.

The appellant also filed further requests in writing, which read as follows:

"In addition to the request that the patent be revoked in its entirety, it is further requested that:

1. the written decision provide reasoning as to why the original Main Request is deemed not to be allowable;
2. in the event that Request 1 cannot be met, that in accordance with Rule 76(1) EPC the Minutes of the oral proceedings be drawn up containing the relevant statements made by the parties concerning the proprietor's original main request;
3. in the event that neither Request 1 or Request 2 can be met, that the following question be put to the Enlarged Board under Art. 112(1)(a):

To what extent must the Minutes of Oral Proceedings reflect the submissions of the parties regarding the allowability of the patent in the form which is appealed which, in the opinion of the Board, is not allowable when such request is thereafter withdrawn during the oral proceedings, when such proceedings concern an opponent appellant as sole appellant?".

VI. The following documents which featured in the opposition procedure were considered to be relevant in respect of the claims of the respondent's request filed during oral proceedings:

D2: GB-A-983 576;

D3: US-A-3 811 445;

D4: EP-A-207 904;

D7: US-A-4 726 976.

VII. Independent claims 1, 17 and 19 read as follows:

"1. Facing material (100) suitable for use in diapers and sanitary napkins comprising a fibrous top layer (10) for engaging a body fluid, a generally opaque apertured middle layer (20) for hiding absorbed body fluid and comprising an opaque film, and a bottom layer (30) having a capillary structure for drawing said body fluid from said fibrous top layer (10), said fibrous top layer (10) extending through said generally opaque middle layer (20) for communicating with said bottom layer (30) and for providing fluid transfer from said fibrous top layer (10) into said bottom layer (30)".

"17. A method of preparing a facing material suitable for use in diapers and sanitary napkins, comprising:  
a) providing a tri-layered flexible composite including a fibrous top layer (10) for engaging body fluid, a generally opaque middle layer (20) for hiding absorbed body fluid and comprising an opaque film and a bottom layer (30) having a capillary structure for drawing said body fluid; and  
b) perforating said composite to provide a plurality of apertures through said generally opaque middle layer (20) and to dispose a portion of said fibrous top layer (10) through said apertures for communicating with said bottom layer (30) and for providing fluid transfer from said fibrous top layer (10) into said bottom layer (30)".

"19. A facing material (100) suitable for use in diapers and sanitary napkins, comprising:  
- a fibrous top layer (10) for engaging a body fluid,  
- a generally opaque apertured middle layer (20) for hiding absorbed body fluid and comprising an opaque film,  
said fibrous top layer (10) extending through said generally opaque middle layer (20) for providing for fluid transfer from said top layer (10) through said middle layer (20)".

VIII. The arguments of the appellant can be summarized as follows:

The appeal met the requirements of Article 108 EPC. The grounds for appeal only provided reasons with regard to claim 20 because the decision under appeal only provided reasons with regard to claim 20, the remaining claims being of narrower scope.

The description was not in conformity with the claims: On column 2, lines 44 to 45, it was stated that the invention covered a facing material having **only** a fibrous top layer and a generally opaque apertured layer comprising an opaque film, and on column 6, lines 28, 29, that the generally opaque middle layer was **preferably** an opaque film of polyethylene and/or polypropylene. The claims however referred to a facing material comprising more than two layers. They also made it clear that the feature that the middle layer was an opaque film was not a preferred feature, but an essential one.

As regards the requests filed in writing during the oral proceedings, the appellant essentially argued as follows:

The respondent withdrew the previous main request to maintain the patent in the form as upheld by the Opposition Division after the Board announced its opinion that said main request was not allowable. The withdrawal of the main request and the filing of a new main request to maintain the patent in amended form on the basis of the documents filed during the oral proceedings, resulted in the appeal being successful to the extent that the decision under appeal was set aside. If the written decision did not provide reasoning as to why the previous main request was deemed not to be allowable, then the opponent as sole appellant and only party that paid the appeal fee, would not be provided with the reasons why the appeal was successful. Furthermore, the reasoning was important in order to understand the interpretation of



the claims by the Board of Appeal, and this was important information for the public and also for later infringement proceedings.

If the written decision did not provide such reasoning, then the reasons why the abandoned main request failed should at least be apparent from the minutes of oral proceedings. In accordance with Rule 76(1) EPC, the minutes of the oral proceedings should contain the essentials of the oral proceedings. This did not imply that the minutes should only refer to those parts of the oral proceedings that were essential for the final decision of the Board. Rule 76(1) EPC was not written only for the benefit of the EPO, but also in the interest of the parties to the proceedings and of the public. Therefore, drawing up the minutes without including the relevant statements made by the parties concerning the respondent's main request which was withdrawn, would mean ignoring the interests of the public and of the parties, in particular those of the opponent and sole appellant who paid the appeal fee.

If neither request 1 or request 2 were allowed, then an important point of law arose, which justified the referral to the Enlarged Board of Appeal of the question concerning the extent to which the minutes of oral proceedings must reflect the submissions of the parties regarding the allowability of the patent in the form which is appealed which, in the opinion of the Board, is not allowable when such request is thereafter withdrawn during the oral proceedings, when such proceedings concern an opponent appellant as sole appellant. If the minutes were silent in respect of these submissions, there was no record on file of the facts and arguments that led the Board to form the

opinion that the main request, which was allowed by the Opposition Division, might be held not allowable before the Board of Appeal. This had implications for what concerned the requirements of Articles 84, 52 to 56, 123(2) and 113(1) EPC. Article 125 EPC, which referred to the principles of procedural law generally recognised in the Contracting States, should also be taken into consideration when deciding on the extent to which the minutes of Oral Proceedings must reflect the submissions of the parties.

IX. In support of its request the respondent relied essentially on the following submissions:

Although the appellant requested that the contested patent be revoked in its entirety, the grounds of appeal only contained reasons in respect of claim 20 and therefore the appeal did not meet the requirements of Article 108 EPC.

The amendments were clearly based upon the application as filed. The description was amended where necessary to bring it into conformity with the claims as amended. The passages of the description objected to by the appellant were not in contradiction with the claims. Indeed, an embodiment having only two layers, namely a fibrous top layer and a generally opaque apertured middle layer consisting of an opaque film, fell within the scope of the facing material as claimed. Furthermore, the term "preferably" in the passage of the description reciting that the generally opaque middle layer was **preferably** an opaque film of polyethylene and/or polypropylene, did not imply that the presence of the opaque film itself was only a preferred feature.

The European patent disclosed the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. In particular, the skilled person would simply select a material for the middle layer which is opaque so that it can hide body fluid.

The claimed subject-matter was novel and also involved an inventive step over the cited prior art. Starting from the closest prior art, represented by a facing material in accordance with document D4, the problem underlying the invention consisted in improving removal of body fluids away from the skin of the user and in better hiding absorbed body fluids. The available prior art did not suggest the claimed solution to this problem. In particular, D4 did not suggest the provision of a fibrous top layer extending through the apertured middle layer. Furthermore, although D4 disclosed the use of an intermediate layer consisting of a white low-density polyethylene film, it did not address the problem of hiding absorbed body fluid. Neither was this problem addressed by document D7. Documents D2 and D3 related to absorbent products with a top layer which remained wet after fluid was absorbed and could not suggest the solution to the above mentioned problem.

The further requests of the appellant, filed during oral proceedings, were not admissible because filed at a very late stage of the proceedings. In any case, they should be rejected. By withdrawing the previous main request on file, the patent proprietor withdrew the consent to the maintenance of the patent maintained by the Opposition Division, and therefore there was no reason for the Board to provide reasoning as to why

that main request was deemed not to be allowable. The Board only gave an opinion as regards that main request, and there was no basis in the EPC to require that reasons in respect of an opinion formulated during oral proceedings be given in the final decision. It was irrelevant whether the opponent as sole appellant was the only party to have paid the appeal fee: the payment of the appeal fee did not establish the right to know why a request withdrawn by the respondent might not be allowable before the Board of Appeal. In this respect, the situation would be the same if the patent proprietor had also filed an appeal. Neither were there any legal interest of the appellant that would justify providing a reasoning in respect of the request withdrawn by the respondent, since the patent was to be maintained in a form which was more restricted. Rule 76(1) EPC should be interpreted in the sense that only the requests of the parties relevant to the decision were included in the decision. In any case, it was only the Board that could decide what were the essentials of the oral proceedings for the purposes of Rule 76(1) EPC, in the exercise of its discretionary power. Furthermore, remittal of the question raised by the appellant to the Enlarged Board of Appeal was not justified because it would result in an unacceptable delay in proceedings.

## **Reasons for the Decision**

### **1. *Admissibility***

- 1.1 The appeal meets the requirements of Rule 65 EPC and is therefore admissible.

- 1.2 The Board has already treated the question of admissibility in its annex to the summons to oral proceedings in respect of the objection raised by the respondent, who has not supplied further arguments concerning this point.

The requirements of Article 108 are met because a written notice of appeal and a written statement setting out the grounds of appeal have been filed in due time. The appeal fee was also paid in due time.

The Board observes that the statement setting out the grounds of appeal sufficiently specifies the reasons on which the case for setting aside the decision is based, ie why the judgment of the Opposition Division in respect of novelty and inventive step of independent claim 20 is allegedly wrong. Moreover, the extent to which cancellation of the decision is requested (Rule 64(b) EPC) is clear: the appellant's request to set aside the decision and revoke the contested patent implies that the decision under appeal should be cancelled to the extent that the appellant's original request for revocation of the patent in its entirety was rejected in the said decision (see e.g. T 631/91).

2. *Amendments*

- 2.1 In accordance with the decisions G 9/92 and G 4/93 of the Enlarged Board of Appeal, if the opponent is the sole appellant against an interlocutory decision maintaining a patent in amended form, as in the present case, amendments proposed by the patent proprietor as a party to the proceedings as of right under Article 107,

second sentence, EPC, may be rejected as inadmissible by the Board of Appeal if they are neither appropriate nor necessary (point 16 of G 4/93, OJ EPO 1994, 875).

During the oral proceedings, the Board announced its opinion that the patent in the version maintained by the Opposition Division was not allowable for lack of novelty of the subject-matter of claim 1 over the disclosure of document D3. As a consequence, the amendments proposed by the patent proprietor arise from the appeal. They are therefore both appropriate and necessary and, as such, admissible.

- 2.2 Claim 1 includes all the features of claims 1 and 8 of the application as filed. Claim 17 includes all the features of original claims 20 and 8. The feature that the opaque middle layer is for hiding absorbed fluid can be derived from the text on page 6, lines 18 to 21, of the application as filed.

Support for independent claim 19 can be found in original claim 1 in combination with the disclosure on page 5, lines 8 to 18, and page 6, lines 18 to 21, of the application as filed.

Dependent claims 2 to 12, 14 to 16 and 18 recite the features of original claims 2 to 7, 9 to 13, 15, 16, 19, 21. The features of claim 13 can be derived from original claim 14.

The description of the patent in suit is adapted to be consistent with the claims as amended and to acknowledge document D4 as prior art.

Hence, the amendments do not introduce subject-matter which extends beyond the content of the application as filed.

- 2.3 The independent claims 1, 17 and 19 have been restricted, with respect to independent claims 1, 18 and 20 as granted (and as maintained by the Opposition Division), by way of inclusion of the feature that the opaque middle layer comprises an opaque film. Therefore, the amendments do not result in an extension of the protection conferred.
- 2.4 It follows that none of the amendments give rise to objections under Articles 123(2) and (3) EPC.
- 2.5 The appellant submitted that the passages of the description on column 2, lines 44 to 45, and on column 6, lines 28, 29, were not in conformity with the claims.

However, the first passage objected to recites that "the invention is intended to cover a facing material having only a fibrous top layer and a generally opaque apertured layer comprising an opaque film". This essentially corresponds to a facing material in accordance with claim 19, with only two layers because claim 19 does not require a third (bottom) layer. The second passage objected to recites that "the generally opaque middle layer 20 is preferably an opaque film of polyethylene and/or polypropylene". It refers to an embodiment in which the opaque middle layer consists of such an opaque film. The latter feature falls within the definition of the claims that the middle layer comprises an opaque film (this definition including

both a middle layer consisting only of an opaque film and a middle layer consisting of an opaque film and other materials).

Therefore, the passages of the description referred to by the appellant are not in contradiction with the claims.

3. *Sufficiency of disclosure*

The Board sees no reasons to deviate from the view of the Opposition Division expressed under point 3 of the decision under appeal. As a matter of fact, the patent includes sufficient details to enable a skilled person to reproduce the invention as claimed. In fact, the disclosure of column 6, lines 28 to 34, gives clear instructions on how to provide a generally opaque middle layer comprising an opaque film and the amendments made to claim 1 in the appeal proceedings cannot justify a different interpretation.

4. *Novelty*

4.1 Using the wording of claim 1, document D4 discloses (see Figure 4) a facing material (5) suitable for use in diapers and sanitary napkins, comprising a fibrous top layer (10) for engaging a body fluid, a generally opaque apertured middle layer (11) for hiding absorbed body fluid and comprising an opaque film (milky-white in colour; see page 15, lines 13 to 16),

D4 does not disclose that the fibrous top layer extends through the middle layer. Indeed, apertures are provided in a layered strip comprising the top layer (10) and the middle layer (11) by a perforating or



punching action (see page 11, lines 9, 12; page 16, lines 8 to 11) which provides clean cut portions as shown in Figures 4 and 5.

- 4.2 Document D2 discloses (see Figure 6) a facing material suitable for use in diapers and sanitary napkins (see page 1, lines 43 to 45; page 4, lines 73 to 76), comprising: a fibrous top layer (20) for engaging a body fluid and an apertured middle layer (19), said fibrous top layer extending through said middle layer for providing for fluid transfer from said top layer through said middle layer (see page 4, lines 81 to 95). The apertured middle layer is made of a cellular sponge materials such as polyurethane foam (page 5, "Example") which is "generally opaque", this expression implying that the layer is "relatively impervious to light" (see column 4, lines 14 to 17 of the patent in suit).

However, D2 does not disclose that the opaque middle layer comprises an opaque film. Although D2 contemplates the use of sponge sheets (middle layer) of a thickness down to 1/32 inch (ca. 0.8 mm; see page 3, line 6), such sponge sheets would not be identified as "films" by a skilled person, both because of their irregular surface appearance and because of their excessive thickness.

- 4.3 D3 discloses (see Figure 2) a facing material suitable for use in diapers and sanitary napkins (column 1, lines 11 to 13), comprising: a fibrous top layer (2) for engaging a body fluid; an apertured middle layer (3), said fibrous top layer (2) extending through said middle layer for providing for fluid transfer from said top layer through said middle layer (see column 3, lines 50 to 55). Since the middle layer is made of

cellulose crepe, it is also generally opaque. However, it readily absorbs fluid and is not suitable for hiding it. Furthermore, D3 does not disclose that the opaque middle layer comprises an opaque film.

- 4.4 D7 discloses a facing material suitable for use in diapers and sanitary napkins (column 1, lines 6 to 9), comprising (see Figure 1): a fibrous top layer (14) for engaging a body fluid and an apertured middle layer (12; see column 3, lines 49 to 64).

The middle layer consists of a thermoplastic film of eg polyethylene, polyester etc (column 3, lines 49 to 58; compare with column 6, lines 28 to 32 of the patent in suit). D7 does not disclose whether the film is opaque or not.

Furthermore, D7 explicitly teaches that the fibrous top layer should not extend through the middle layer (see column 2, lines 55 to 61; column 4, lines 37 to 42).

- 4.5 The other available documents do not disclose a facing material in which the fibrous top layer extends through an apertured middle layer which comprises an opaque film for providing for fluid transfer from said top layer through said middle layer.

- 4.6 Therefore, the subject-matter of the independent claims 1, 17 and 19 is found to be novel.

5. *Inventive step*

- 5.1 The objective underlying the patent in suit consists in providing facing materials suitable for use in diapers and sanitary napkins which provide for efficient

removal of body fluids away from the skin of the user and having a generally opaque appearance for hiding absorbed body fluids while maintaining a comfortable, fibrous texture (see column 3, lines 18 to 25, of the patent in suit).

5.2 In respect of the subject-matter of independent claim 19, document D4 represents the closest prior art because it discloses a facing material which aims at the same objective of providing efficient removal of body fluid away from the skin of the user while maintaining a comfortable, fibrous texture (see D4, page 3, lines 17 to 26), and has the most technical features in common with the claimed invention.

5.3 The above mentioned technical problem is solved, in accordance with the definition of claim 19, by the feature that the fibrous top layer extends through the generally opaque middle layer for providing for fluid transfer from said fibrous top layer through said middle layer.

The distinguishing feature effectively solves the problem posed because it provides improved flow of body fluid away from the top layer, and consequently away from the skin of the user. Moreover, since in use the body fluid can be absorbed by an absorbent layer disposed below the facing material, the fluid absorbed can be hidden by the opaque middle layer.

5.4 According to the teaching of document D2, the fibers passing from the top fiber layer down through the sheet sponge material (ie the middle layer) serve to draw fluid into the sponge body, which absorbs it, and to mechanically interlock the absorbent fiber layer with

the cellular sponge sheet (see page 2, lines 42 to 49). The teaching of document D3 is to provide, in an absorbent composite (see Figure 2), a filamentary absorbent layer (2) which extends through the openings in another absorbent layer (3, this layer constituting the middle layer; see column 3, lines 40 to 48). Therefore, in both D2 and D3 the top layer of the facing material extends through the middle layer to improve the absorbency thereof (see D2, page 1, lines 70 to 82 and D3, column 1, lines 51 to 58). In contrast thereto, in D4 the facing material is not intended to absorb fluid (see D4, lines 4 to 10): actually, it should not have a tendency to retain and absorb fluid because it has the purpose of facilitating the flow of fluids to an underlying absorbent core (see D4, page 1, last paragraph). As a consequence, the skilled person would not contemplate the provision, in the facing material of D4, of a feature of D2 and D3 which has the explicit purpose of increasing the absorbency of the facing material.

- 5.5 The remaining available prior art does not disclose the provision of a fibrous top layer extending through an apertured opaque middle layer for providing for fluid transfer from said top layer through said middle layer. Neither are the advantages thereof suggested by the available prior art. Therefore, the subject-matter of claim 19 is found to involve an inventive step.
  
- 5.6 Claim 1 includes all the features of claim 19 and, additionally, the feature that a bottom layer is provided. Therefore, the subject-matter of claim 1 also involves an inventive step.

Since the result of the method of claim 17 of preparing a facing material is a facing material having all the features of claim 1, the subject-matter of claim 17 likewise involves an inventive step.

6. Therefore, claims 1, 17 and 19, together with the dependent claims and the description as amended during the oral proceedings of 24 September 2002, and the figures as granted, form a suitable basis for maintenance of the patent in amended form.

7. *Further requests of the appellant*

7.1 First request

7.1.1 Pursuant to Rule 66(2) EPC the decisions of the boards of appeal shall contain reasons. Taken in combination with Article 113(2) EPC, which requires the boards of appeal to consider and decide upon the European Patent only in the text submitted to it by the proprietor of the patent, this means that the decision dealing with revocation or maintenance of the patent needs to include reasons only in respect of those requests of the patent proprietor concerning the text of the patent that are still pending. As soon as a request is withdrawn by the patentee, there is no longer a procedural basis for the Board to consider such a request and decide upon it.

Article 113(2) EPC gives the patentee the exclusive right of filing requests relating to the text of the patent, therefore such requests by parties to the proceedings other than the patentee are not admissible.

Accordingly the Board cannot include reasons in the decision in respect of such texts if submitted by the appellant/opponent.

7.1.2 Moreover, it follows from Article 107 EPC, and this has been underlined by the Enlarged Board of Appeal in its decision G 9/91 (point 18, OJ EPO 1993, 408), that the inter partes appeal procedure aims at giving the losing party the opportunity to challenge the decision of the opposition division on its merits. When the decision under appeal is set aside as a consequence of the withdrawal of the main request, the appellant is no longer negatively affected by the maintenance of the European patent in accordance with that request. Also for this reason there is no longer a procedural basis for the Board to state the reasons for the opinion that the main request was not allowable.

7.1.3 Furthermore the Board is neither aware of, nor was the appellant able to indicate support for, a general procedural principle according to which the reasons for an opinion given earlier in the appeal proceedings in respect of a request which has been withdrawn later on in proceedings should be included in the final decision, as the latter necessarily deals only with the requests maintained by the patentee.

Consequently the appellant's first auxiliary request, according to which the written decision should provide reasoning as to why the withdrawn main request might not be allowable, must be rejected.

7.2 Second request

7.2.1 In support of its second (auxiliary) request the appellant submitted that if the written decision did not provide reasoning as to why the previous main request was deemed not to be allowable, then the opponent as sole appellant and only party that paid the appeal fee would not be provided with the reasons why the appeal was in part successful. Therefore it should at least be apparent from the minutes why the withdrawn main request failed. This could also help with understanding the interpretation of the claims as arrived at by the Board, which was important information for the public and also for later infringement proceedings.

Summarising, the appellant is of the opinion that in the present case the minutes should contain more than matter only related to the requests upheld by the respondent, i.e. it should also contain information which would allow the appellant and also the public to understand why the withdrawn main request was not held acceptable.

7.2.2 According to Rule 76(1) EPC: "Minutes of oral proceedings ... shall be drawn up containing the essentials of the oral proceedings..., the relevant statements made by the parties...". Thus, having regard to the exact terms of the appellant's 2nd auxiliary request, the issue to be decided focuses on what should be considered "essential" and "relevant" within the meaning of that rule.

The Board accepts that Rule 76(1) EPC does not exclude mentioning that an earlier main request was withdrawn or giving further factual information on what the parties actually submitted during the oral proceedings in relation to such a request. However, it is primarily a matter of discretion for the Board to determine what is and what is not "relevant" or "essential" to the oral proceedings in the context of what has to be decided in the appeal proceedings. Since the Board itself did not consider the submissions made by the respondent in respect of the withdrawn main request relevant (otherwise it would not have expressed a negative opinion on it), it is up to the appellant to indicate which oral submissions are so "relevant" so as to be incorporated into the minutes. In such case the respondent would also need to be heard on the alleged "relevant" submissions before the Board may wish to insert such matter into the minutes. However, the appellant failed to indicate what part or parts of the respondent's oral submissions and/or those made by the appellant himself should be considered "relevant" or "essential" in order to serve the intended purpose. Already because of the absence of such an indication the second auxiliary request must be rejected.

The Board is also of the opinion that in any case the public interest cannot be considered as served by a selection of "relevant" matter in the submissions of the respondent as performed by the appellant/opponent, as it is by definition subjective and may take the submissions out of the context in which they were made.

7.2.3 Furthermore, considering the appellant's arguments concerning infringement proceedings and bearing in mind that the interpretation of the claims to establish the



extent of protection in accordance with Article 69 EPC should be conducted in accordance with the Protocol on the interpretation of Article 69 EPC, the Board is of the firm opinion that it is not its task to include statements in the minutes of oral proceedings for the sole purpose of providing ammunition for possible future infringement proceedings. Deciding on the extent of protection conferred by the patent during infringement proceedings is the exclusive jurisdiction of the national courts pursuant to Article 64(3) EPC. Such exclusive jurisdiction should not be prejudiced by opinions and interpretations which no longer relate to the patent in the form in which it is upheld by the Board.

Finally, and importantly the Board takes the view that the public interest is not affected since the decision includes the specific reasons for finding why the patent in suit according to the actual request forms a suitable basis for its maintenance in amended form.

### 7.3 Third request

- 7.3.1 In accordance with Article 112(1) EPC, a question has to be referred to the Enlarged Board of Appeal in order to ensure uniform application of the law or if an important point of law arises.

In so far as application of the law is concerned: a common practice of drafting the minutes of oral proceedings has been established by the Boards of Appeal from which practice the present minutes do not deviate. The present situation therefore does not give rise to a question of non-uniform application of the law.

7.3.2 The appellant submitted that an important point of law arose, because if the minutes of the oral proceedings before the Board were silent in respect of the submissions of the parties regarding the allowability of the patent in the form according to the main request as allowed by the Opposition Division in the decision under appeal, there would be no record on file of the facts and arguments that led the Board to its differing opinion.

The appellant is reminded that the appeal procedure is primarily a written procedure, and that oral proceedings are in principle appointed at a point in time when the Board considers the written submissions of all parties, including the written presentation of facts and evidence by all parties, to be complete (see "Guidance for parties to appeal proceedings and their representatives", point 3.2, OJ EPO 1996, 342; G 4/95, OJ EPO 1996, 412, point 4c). Thus, in principle there is a record in the written submissions of the appellant of the facts and arguments that led the Board to give the opinion that the main request was not allowable. Only new facts or a totally different line of argumentation submitted at the oral proceedings, when taken into account for the decision, need therefore be seen as "relevant" or "essential" .

7.3.3 The reference to Articles 84, 52 to 56, 123(2), 113(1) made by the appellant cannot provide support for a different conclusion, since these articles find their application in respect of the patent in suit only for what concerns the actually pending request. Any

findings applying these articles in respect of a main request which has been withdrawn cannot be automatically extended to the new main request; these must be reconsidered in the light of the new situation following from the actual subject-matter claimed.

- 7.3.4 The Board is aware of the different practice of writing the minutes of oral proceedings in opposition Proceedings when compared to appeal proceedings. Considering that the decisions of the Boards of Appeal are not subject to revision (see in this respect G 1/97, OJ EPO 2000, 322) whilst the decisions of the departments of first instance (eg Opposition Divisions) are open to appeal, it is clear that what constitutes the "essentials" and the "relevant statements" of the oral proceedings before the Board of Appeal needs not be noted down as extensively as the "essentials" and the "relevant statements" of the oral proceedings before the departments of first instance. This justifies and explains the current practice of the Boards of Appeal to include in the minutes of oral proceedings before it only the essential information which is necessary to ensure that all pending requests and all statements directly relevant to the decision resulting from the oral proceedings are noted.
- 7.3.5 Thus, the Board in this case is merely applying current practice and is not faced with an important point of law. Therefore, since the conditions of Article 112(1) EPC for referral are not met also the third auxiliary request of the appellant must be rejected.

7.4 The Board observes that it might become necessary to reconsider this current practice when the new Article 112a EPC concerning petitions for review by the Enlarged Board is applicable i.e. when the Act revising the European Patent Convention of 29 November 2000 enters into force.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The written requests filed by the appellant during the oral proceedings are rejected.
3. The case is remitted to the first instance with the order to maintain the patent on the basis of the following documents:

**claims:** 1 to 19, filed during oral proceedings;

**description:** columns 1 to 8 and the insert in column 2, filed during oral proceedings;

**drawings:** Figures 1 to 5, as granted.

The Registrar:

The Chairman:

R. Schumacher

P. Alting van Geusau