

*Recher*

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Bezeichnung der Erfindung:

Title of invention:

Titre de l'invention :

**ENTSCHEIDUNG / DECISION**

vom / of / du 10 August 1983

Anmelder / Applicant / Demandeur : WARNER-LAMBERT COMPANY

Stichwort / Headword / Référence : Different sets of claims

**EPO / EPC / CBE** Articles 54(3), 87(1), 89, 93, 113(2); Rule 87

"Different sets of claims: filing, publication" - "Impermissible legal fiction" - "Text of application - only that submitted or agreed"

**Leitsatz / Headnote / Sommaire**

Rule 87 EPC does not authorize the inclusion in a European patent application of separate claims for different States before the European Patent Office "notes" the existence of a prior European right pursuant to Article 54(3) and (4) EPC.



Case Number: J 21 82

**DECISION**  
**of the Legal Board of Appeal**

of 10 August 1983

**Appellant:** WARNER-LAMBERT COMPANY  
201 Tabor Road  
Morris Plains New Jersey 07950  
U.S.A.

**Representative:** Jones, Michael Raymond  
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**Decision under appeal:** Decision of the Receiving Section of the  
European Patent Office dated 27 August 1982  
rejecting a request for publication of all  
three sets of claims as originally filed with  
respect to European patent application  
N° 82300793.5.

**Composition of the Board:**

Chairman: R. Singer  
Member: P. Ford  
Member: O. Bossung

SUMMARY OF FACTS AND SUBMISSIONS

- I. On 17 February 1982, the appellants filed a European patent application, claiming priority from U.S. national patent applications filed on 17 February 1981. The application contained three separate sets of claims relating to chemical compositions and their production:
  - one set, consisting of seven claims, was labelled "for Belgium, Switzerland/Liechtenstein, Federal Republic of Germany, United Kingdom, Italy, The Netherlands and France."
  - a second set, consisting of nine claims, was restricted to Austria.
  - a third set, consisting of six claims, was labelled "for Luxembourg and Sweden."
  
- II. The Receiving Section informed the appellants' representative, by letter dated 7 July 1982, that, except insofar as the set of claims for Austria was concerned, the filing of separate sets of claims for different designated Contracting States was considered to be inadmissible. Accordingly the set of six claims for Luxembourg and Sweden were considered not to have been filed and would not be included in the publication under Article 93 EPC. The set of seven claims was considered to have been filed for all the designated Contracting States but Austria.
  
- III. In reply, by letter dated 12 July 1982, the appellants' representative indicated that the reason for filing the two sets of claims for the Contracting States other than Austria was the existence of an alleged prior European right in the States for which the first set of seven claims was intended. The appellants made detailed submissions and asked for a decision on the matter and, in effect, for the withdrawal of the letter of 7 July 1982.
  
- IV. By the decision under appeal, dated 27 August 1982, the Receiving Section rejected the appellants' request for publication of all three sets of claims and held that the set of claims labelled "for Luxembourg and Sweden" should be deemed not to

have been received and that the restriction as to the first set of claims reading "for Belgium, Switzerland, Liechtenstein, Federal Republic of Germany, United Kingdom, Italy, the Netherlands and France" should be deleted. The existence of a prior European right was denied.

V. The appellants appealed against this decision by notice of appeal dated 21 October 1982, seeking reversal of the refusal to publish the set of claims labelled "for Luxembourg and Sweden", or, alternatively, that those claims should be published with the label amended to read "for all designated States other than Austria." The appellants also asked for cancellation of that part of the decision which held that the set of six claims for Luxembourg and Sweden should be deemed not to have been received. They asked for reimbursement of the appeal fee. That fee was duly paid.

VI. In the Statement of Grounds of their appeal, also dated 21 October 1982, the appellants explained the factual background to their case and referred inter alia to correspondence between their representatives and the Legal Division of the European Patent Office. They submitted, in particular, that Article 93 EPC was mandatory: failure or refusal to publish any claims "as filed" would be contrary to its provisions. Furthermore, since Rule 87 EPC provided for separate claims to be filed for those countries where prior European rights exist, it was permissible, and desirable, for an applicant to bring the matter to the attention of the European Patent Office before publication of the application. Action under Rule 87 EPC could be taken by the Receiving Section.

VII. In a communication dated 8 March 1983, the Legal Board of Appeal drew attention to the point that it seemed to be possible to deduce from the scheme of the EPC as a whole that it is not until a case reaches an Examining Division that questions of providing inter alia different claims for different States can be considered. Article 78(1) EPC did not authorize the filing of more than one description, one claim or set of claims,

one set of drawings or one abstract. Rule 49(3) EPC provided for the additional publication of new or amended claims but only under prescribed conditions. Since amendment to provide different claims, descriptions and drawings for different States was permissible under Rule 87 EPC there was no reason to suppose that it was also permissible under Rule 86(2) EPC before a case reached the Examining Division. This view was consistent with the general division of responsibilities between the Receiving Section and the Examining Division.

- VIII. In their letter in reply, dated 24 March 1983, the appellants' representatives indicated that they would wish to have the opportunity of attending oral proceedings if the Legal Board of Appeal were inclined to reject the appeal. In written submissions attached to their letter, they argued, in particular, that Rule 87 EPC expressly permitted the filing of separate sets of claims, a practice which was beneficial to the applicant, the European Patent Office and the public alike. The other provisions referred to by the Board were not inconsistent with their argument.
- IX. Oral proceedings were appointed for 13 July 1983. In a communication prior to the hearing, the appellants were informed inter alia that the conclusion that Rule 87 EPC explicitly permitted a plurality of claims ab initio was unlikely to be accepted on any material then in the case and that any advantages for the Examining Division from the filing of separate sets of claims ab initio would be counterbalanced by disadvantages for the Receiving Section.
- X. During the oral proceedings, the appellants' representative submitted that the public interest was paramount and that it detracted from the legal certainty ensured by early publication of applications if applications as published did not, where appropriate, contain separate sets of claims for different designated States. The Receiving Section did not have to check the alleged intervening prior right: therefore there

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was no organisational problem. The search could be conducted on the basis of the broadest claims filed. The very existence of Rule 87 EPC proved that there had to be exceptions to the principle that a European patent application is a unity. Furthermore, in many cases European patent applications proceeded to grant without amendment. This was an additional reason for allowing separate sets of claims to be filed ab initio. The appellants' representative maintained the claims for relief set out in the notice of appeal.

#### GROUNDS FOR THE DECISION

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. It is clear that in certain respects the decision under appeal was not correct. First, the appellants are right to object that the Receiving Section had no legal basis for declaring that the set of claims labelled "for Luxembourg and Sweden" should be "deemed not to have been received". Documents forming part of a European patent application which are received by the Receiving Section when an application is filed must be placed on the file and kept there and it is not possible to pretend that they are not there by applying a legal fiction for which there is no support in the European Patent Convention.
3. Secondly, the appellants justifiably complain that the Receiving Section misinterpreted the situation concerning the alleged prior European right. Since the appellants have claimed priority from U.S. national patent applications filed on 17 February 1981, there is prima facie no basis for refusing to consider as a prior European right a European patent application applied for before that date and published during the period in which the right of priority existed for the appellants under Article 87(1) EPC. Article 89 EPC expressly provides that the date of priority counts as the date of filing for the purposes of inter alia Article 54(3) EPC.

4. Thirdly, there was no legal justification for the Receiving Section's action in deleting the restriction applied by the applicants to their first set of claims. If the Receiving Section considered that it had good grounds for accepting only one set of claims for all the designated States other than Austria it should have invited the appellants to choose which set of claims they wished to have: cf. Article 113(2) EPC.
  
5. However, the Legal Board of Appeal is unable to accept the appellants' main submissions. Except in the special cases dealt with in Article 167(2)(a) EPC and Rule 16(2) EPC, there is no situation in which it is permissible for separate claims or sets of claims to be filed in respect of different designated States ab initio.
  
6. Rule 87 EPC does not authorize the inclusion in a European patent application of separate claims for different States before the European Patent Office "notes" the existence of a prior European right pursuant to Article 54(3) and (4) EPC. In the opinion of the Board, "notes" here means more than "is told by the applicant". It means that the matter has been investigated and evaluated (cf. the German and French texts which respectively use the terms "stellt fest" and "constate"). Only substantive examination can fulfill this requirement. This factor alone is enough to exclude the original filing of separate claims or sets of claims.
  
7. There is, of course, nothing to prevent an applicant from putting relevant information on the application file and from describing and claiming broadly in the first place and then applying to the Examining Division under Rule 87 EPC for amendment, at the right time. He will not be prevented from amending by anything in Article 123 EPC.
  
8. In these circumstances, the Board can only allow the appeal in part and it does not consider that it is justifiable to order reimbursement of the appeal fee.

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ORDER

For these reasons,

it is decided that:

1. Insofar as the decision of the Receiving Section dated 27 August 1982 decided that the set of claims labelled "for Luxembourg and Sweden" should be deemed not to have been received, it is set aside.
2. Insofar as the said decision decided that the restriction as to the set of claims labelled "for Belgium, Switzerland/ Liechtenstein, Federal Republic of Germany, United Kingdom, Italy, The Netherlands and France" should be deleted, it is set aside.
3. The case is remitted to the Receiving Section for publication of the application with, in addition to the set of claims for Austria, the set of claims originally labelled "for Luxembourg and Sweden", now to be labelled for all designated States except Austria.

The Registrar

signed: J. Bergeron

The Chairman

signed: R. Singer