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ENTSCHEIDUNG / DECISION

vom / of / du 30 April 1985

Anmelder / Applicant / Demandeur : Burgess, Warren C. Jr.

~~Patentinhaber / Proprietor of the patent /~~

~~Titulaire du brevet :~~

~~Einsprechender / Opponent / Opposant :~~

Stichwort / Headword / Référence : Claims fees /BURGESS

EPÜ / EPC / CBE Rule 31

PCT Articles 19, 20, 22 and 39

Vienna Convention Art.31,32

"Allocation of claims fees"

"Abandonment of claims"

Leitsatz / Headnote / Sommaire

Rule 31(1) EPC is to be interpreted as meaning that claims numbered 1 to 10 upon filing of the European patent application - or transmittal to the European Patent Office of the international application under the PCT - are exempt from fees, and that claims numbered 11 onwards are not. Accordingly, abandoning a fee-exempt claim after filing - or transmittal - does not have the effect that its fee exemption is transferred to another claim.

Europäisches
Patentamt
Beschwerdekammern

European Patent
Office
Boards of Appeal

Office européen
des brevets
Chambres de recours



Case Number: J 09 / 84

DECISION
of the Legal Board of Appeal

of 30 April 1985

Appellant: Burgess, Warren C. Jr.
31 922 Lake Road
Avon Lake, Ohio
U.S.A.

Representative: Jones, Colin
W.P. Thompson & Co.
Coopers Building
Church Street
GB-Liverpool L1 3HB

Decision under appeal: Decision of the Receiving Section of Directorate
General 1 of the European Patent Office dated
13 March 1984.

Composition of the Board:

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

SUMMARY OF FACTS AND SUBMISSIONS

- I. On 4 October 1982, the applicant filed international application PCT/US 82/01439, selecting the EPO as designated Office for Belgium and France. This international application - like the US priority application - contained 30 claims. By two letters (plus enclosures) dated 3 June 1983 and received by the EPO on 6 June 1983, the applicant initiated the regional phase before the EPO, paying the fees pursuant to Rule 104b EPC except the claims fees, in which connection he explained that "The claims fees together with a revised set of claims, reduced in number, will follow shortly."

- II. By letter of 13 July 1983, the applicant informed the EPO *inter alia* that "The claims fee is to be allocated to claims 1 to 3, 5, 6, 8, 14, 15, 18 to 23 and 25 of the International Application as published", at the same time paying five claims fees at DM 60, i.e. DM 300. By letter of 4 August 1983, the Receiving Section informed the applicant that it regarded as unpaid the claims fees payable in respect of claims 11 to 13, 16, 17, 21, 22, 23, 24, 25 and 26-30. As was indicated by a typewritten postscript, this meant that the Receiving Section had taken the view that no fees were payable in respect of claims 1 to 10 and had allocated to claims 14, 15, 18, 19 and 20 the five claims fees paid, giving the applicant two months to pay the remainder.

- III. After an exchange of letters, the applicant paid under protest four further claims fees, which the Receiving Section allocated to claims 21, 22, 23 and 25. The applicant requested an appealable decision in the event that the five claims fees originally paid could not be allocated to the claims in the first numerical order given in paragraph II above.
- IV. By decision of 13 March 1984, the Receiving Section refused to allocate the claims fees as requested, essentially on the grounds that under Rule 31(1) only claims from the 11th onwards incur fees, with the result that any selection is limited to those fees. Nor, therefore, could the four claims fees (amounting to DM 240) paid under protest be refunded.
- V. On 11 April 1984, the applicant filed an appeal against this decision, at the same time paying the fee for appeal and setting out the grounds, namely that the quantitative restrictions of Rule 31(1) EPC - "more than ten" and "over and above that number" - were to be understood as including claims 1 to 10. An applicant filing more than ten claims could allocate the claims fees he paid to whichever claims he wished, including those amongst the first ten.
- VI. Informed in an interim communication of the interpretation of Rule 31 EPC to which the Board of Appeal tended, the appellant reiterated his views, adding that Rule 31 was a purely fiscal provision intended to go some way towards compensating the EPO for the extra work a multiplicity of claims involved; for which particular claims fees were paid was in no way germane

to this purpose. The appellant further contended that the Board was not entitled to consider preparatory documents to the EPC concerning the exemption from fees of the first ten claims. Moreover, the differences between the text of Rule 31(1) EPC and the preparatory documents in the three languages were purely questions of linguistics from which no conclusions could be drawn. Lastly, international applicants could amend the claims before entry into the regional phase, *inter alia* by selecting at will from amongst all the claims originally filed. If any doubt remained as to the interpretation to be given to Rule 31, reference could also be made to national law under Article 125 EPC. In this connection the PCT Applicant's Guide (Volume II, paragraphs SE.04(i), 05 and 08) indicated that in Sweden the applicant was able to select claims numbered between 1 and 10 as claims incurring fees, even after entry into the national phase.

- VII. The appellant requests that the contested decision be set aside and that four claims fees and the fee for appeal be reimbursed.

REASONS FOR THE DECISION

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. Whether Rule 31(1), 1st sentence EPC means that the first ten claims are exempt from fees but those from No. 11 onwards are

not, or whether it merely exempts from fees a total of ten claims regardless of numerical order, depends in the first instance on its text, giving the terms used their ordinary meaning in their context. In all three languages this text makes reference to the claims contained in the application at the time of filing and provides for ten of those claims to be exempt from claims fees. The natural interpretation is that the exemption relates to the first ten claims in the application as filed. The applicant is able before filing to place first those claims for which he is seeking this exemption, which cannot then be transferred from claims deleted after filing to claims numbered 11 onwards.

3. The view that the words "in respect of each claim over and above that number" relate to the claims as numbered rather than just their number is clearly confirmed by the French text, which states that a fee is payable in respect of each claim "au sus de la dixième" (not "en sus de dix"). This is also confirmed by the original (German) text of the Reports on the 1971 Second Preliminary Draft of the EPC (point 35, p.45); it uses the words "vom elften Patentanspruch an", after which a special fee is payable. Contrary to the appellant's unsupported contention, applying international law as recognised in the Vienna Convention on the Law of Treaties of 23 May 1969, the Board is in fact perfectly entitled to draw on the preparatory documents to confirm its opinion (see Decision Gr 05/83 of the Enlarged Board of Appeal dated 5 December 1984, OJ EPO 3/1985, p. 64 et seq., especially point 5(5), p. 65).
4. As the text of Rule 31(1) EPC permits clear interpretation to the effect that fees are payable in respect of claims numbered

11 onwards only, there is no need to consider whether a more liberal interpretation would meet the Rule's purpose, which the appellant takes to be financial compensation to the EPO in respect of extra work caused by the number of claims. In any event, the Board disagrees; it considers the main purpose of Rule 31 EPC to be to induce the applicant to limit the protection sought to a certain number of claims, in the first instance for the purposes of the European search. This is why Rule 86(1) EPC rules out any amendment (*inter alia* deletion) of the claims until the search report has been received.

5. The present case concerns an international application under the PCT. Under Rule 104b(1) EPC, in such a case the time limit for payment of any claims fees is determined not by the international application's date of filing but by its date of transmittal under Article 22(1) or 39(1) PCT. In accordance with Article 19 PCT, in international proceedings under the PCT the applicant may amend the claims after receiving the international search report, although under Rule 46.1 PCT he must do this before the International Bureau within a period of two months, i.e. before entry into the national or regional phase. Under Article 28 PCT, whether the claims may be amended in the national or regional phase is determined by the relevant provisions of the national or regional law applicable. As regards the amendment of claims and the claims fees payable, from the date of transmittal to the EPO the same applies to an international as to a European application.

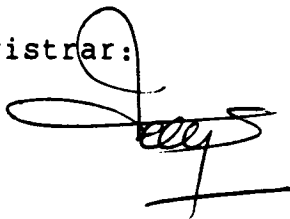
6. The question whether Rule 31(1) EPC exempts certain claims - and, if so, which - from claims fees cannot be regarded as one of procedural law. For this reason, Article 125 EPC is not applicable in the present case and there is, therefore, no need to consider the appellant's statements regarding Swedish practice in connection with claims fees.
7. As the appeal cannot succeed, for the foregoing reasons, the requirements under Rule 67 EPC for reimbursement of the fee for appeal are not satisfied.

ORDER

For these reasons, it is decided that:

1. The appeal against the decision of the Receiving Section of 13 March 1984 is dismissed.
2. The request for reimbursement of the fee for appeal is refused.

Registrar:

RF


Chairman:

R. Singer

To J.H. 11