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Aktenzeichen / Case Number / N° du recours : J 5/87

Anmeldenummer / Filing No / N° de la demande : 86 101 061.9

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Bezeichnung der Erfindung: Hydrofining process for hydrocarbon containing
Title of invention: feed streams
Titre de l'invention :

Klassifikation / Classification / Classement : C 10 G 45/02

ENTSCHEIDUNG / DECISION

vom / of / du 6 March 1987

Anmelder / Applicant / Demandeur : Phillips Petroleum Company

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Number of claims incurring fees/PHILLIPS

EPO/EPC/CBE Articles 83, 84, Rules 27, 29, 31, 88

Kennwort / Keyword / Mot clé : "Number of claims incurring fees" -
"Content of the description" - "Form and
content of claims" - "Correction of
errors (denied)"

Leitsatz / Headnote / Sommaire

The question whether a claims fee is due under Rule 31(1) EPC has to be considered already in the course of the initial examination of the application as to formal requirements irrespective of whether at a later stage, as a consequence of the outcome of the substantive examination, such a fee may become due under Rule 31(2) in conjunction with Rule 51(4) EPC.



Case Number : J 5/87

D E C I S I O N
of the Legal Board of Appeal
of 6 March 1987

Appellant : Phillips Petroleum Company
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Bartlesville, Oklahoma 74004
USA

Representative : Dost, Wolfgang, Dr. rer.nat., Dipl.-Chem.
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Decision under appeal : Decision of the Receiving Section
of the European Patent Office
dated 13 August 1986

Composition of the Board :

Chairman : P. Ford
Member : E. Persson
Member : W. Moser

Summary of Facts and Submissions

- I. European patent application No. 86 101 061.9 containing 10 claims was filed on 27 January 1986 on behalf of Phillips Petroleum Company of Bartlesville, Oklahoma, USA. On the filing date the filing, search and designation fees were paid. Priority was claimed from US application 695 786 filed on 28 January 1985 containing 33 claims. No claims fees were paid in accordance with Rule 31(1) EPC.

- II. On 10 April 1986 the Receiving Section wrote to the Applicant's representative pointing out that the examination by the Receiving Section prescribed in Article 91(2) EPC had disclosed that the fees for 33 additional claims annexed to the description had not yet been paid as required by Rule 31(1) EPC and that if the claims fee for any claim were not paid in due time, the claims concerned would be deemed to have been abandoned in accordance with Rule 31(3) EPC.

The Receiving Section explained further that the application contained, under the heading "Claims", 10 claims. However, it contained 33 further claims which were annexed to the description with the following words: "The following parts of the description are preferred embodiments 1 to 33 presented in the format of claims". It was further stated that these additional 33 claims were drafted as claims and named as claims in the said introduction and in the references to dependent claims. Formally it was therefore clear that the 33 phrases were not a part of the description but claims. Also, in substance, there was no doubt that each of the 33 phrases defined a matter for which protection was sought. Notwithstanding the fact that the additional claims were annexed to the description they remained claims. The Applicant had included them into the application in order

to maintain the possibility of making them a basis for substantive examination. This became apparent, not only from the wording of the application, but also from the fact that the 33 additional claims in the European application were identical to the 33 claims in the priority document, the only claims in the earlier application.

Rule 31(1), first sentence, EPC, stipulates, it was stated, that a claims fee becomes due for any claim over and above ten. The Applicant cannot circumvent Rule 31 by arranging the claims in the wrong part of the specification.

- III. The Applicant responded with a brief letter received on 17 April 1986 requesting the Office to note that embodiments 1 to 33 belonged to the description and thus no additional fees were to be paid.
- IV. On 27 June 1986 the Receiving Section despatched a communication pursuant to Rule 31(3) EPC informing the Applicant that the additional 33 claims annexed to the description were deemed to be abandoned since the prescribed claims fees were not paid in due time.
- V. The Applicant replied by letter received on 14 July 1986 expressing the opinion that the finding of the European Patent Office was inaccurate. The Applicant restated his position that in the application as set forth on page 19, "the following part of the description" (pages 20 to 23) "are preferred embodiments 1 to 33 presented in the format of claims". In view of this sentence there could be no doubt that embodiments 1 to 33 formed a part of the description. There were 10 claims in the application identified by the headline "claims", which number of 10

coincided with the number of claims set forth under X on page 3 of the application form.

The Applicant requested a decision under Rule 69(2) EPC to the effect that no part of the application should be deemed to be abandoned.

VI. On 13 August 1986 the Receiving Section issued a decision according to which the 33 claims annexed to the description were deemed to have been abandoned in accordance with Rule 31(3) EPC. In the reasons for the decision it was stated inter alia as follows:

- a) It is not the heading of a part of the specification which is decisive for determining which part it is. If, for example, there is no heading at all, the EPO has to look at the content of the text when evaluating which part is the description and which part contains the claims. Even if there was only a part entitled "description" and no part entitled "claims" the EPO would have to give a filing date under Articles 80 and 90(1)(a) EPC, if under the heading "description" there appeared a text defining the matter for which protection is sought (Article 84 EPC). Moreover, the title "drawings" above a text which appears to be the claims could not change the character of that part. In summary, it is always the substance of a text which determines the legal character of a part of the application and not the arbitrary order or heading chosen by the Applicant. This has to be taken into consideration in favour of the Applicant when according a filing date and to his disadvantage when calculating the claims fees.
- b) Rules 27 and 29 EPC govern the form and contents of the description and claims respectively. The Applicant

is not at liberty to ignore these provisions and arrange his application in such a way as to effectively undermine the intentions and provisions of the Implementing Regulations to the EPC with a view to circumventing Rule 31(1) and the requirement to pay claims fees. Placing the claims in the wrong part of the application does not alter the fact that the application contains a total of 43 claims - 33 of which are subject to the payment of fees as provided by Rule 31(1) EPC.

- c) As the application contains 43 claims and no claims fees have been paid the Receiving Section's communication of 27 June 1986 (cf. point IV. above) must be maintained and the additional 33 claims are deemed to have been abandoned. The Applicant's request that this decision be reversed is accordingly rejected.

VII. By letter filed on 23 October 1986 the Applicant filed an appeal against the decision by the Receiving Section. The appeal fee was duly paid and a Statement of Grounds was communicated in a letter dated 19 December 1986. To that letter was annexed a request for correction of the description under Rule 88 EPC to the effect that in the sentence "The following parts of the description are preferred embodiments 1 to 33 presented in the format of claim", referred to under point II. above, the words "presented in the format of claims" should be deleted and in the following text the references to "Claim 1", "Claim 2" etc. should in each case be replaced by the word "embodiment".

VIII. Alternatively, the Appellant maintained that the initial enumeration of 33 preferred embodiments added to the description in the format of claims formed a part of the

description serving the purpose of disclosing the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art as requested under Article 83 EPC. If and when it was made clear that a disclosure formed part of the description, requirements other than called for in Article 83 EPC did not exist. Requesting to meet all kinds of formal requirements set out in the Rules of the EPC would mean to undermine an applicant's principle right to provide disclosure in the description. The formal examination by the Receiving Section should not be extended to a substantive examination as to whether or not a part of an application identified as description in the request for grant might be interpreted as claims. Rather, it was submitted that an applicant can include in the description any disclosure - irrespective of the formal appearance of that disclosure - as long as the disclosure illustrates the invention. Moreover, the practice utilised by the Appellant in the present case also served to facilitate the work of the Search Division of the EPO. The finding in the decision under appeal that the Appellant had included the wording of the basic US claims in the description in order to maintain the possibility of making this disclosure a basis for substantive examination (cf. point II. above) was quite adequate. However, this was only helpful for the Search Division and, most important, well within the provisions of the EPC as could be deduced from Rules 31(2) and 51(4) EPC in conjunction with Articles 84 and 123(2) EPC. Finally, it was submitted that the system practiced in the present application had been used for more than 8 years in some 500 cases without any problem.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.

2. According to Rule 31(1) EPC any European patent application comprising more than 10 claims at the time of filing shall, in respect of each claim over and above that number, incur payment of a claims fee. This claims fee shall be payable within one month after the filing of the application. If the claims fee for any claim is not paid in due time, the claim concerned shall, in accordance with Rule 31(3) EPC, be deemed to be abandoned. The justification for this additional fee is obviously the extra work needed for the search and the examination of an application comprising such a large number of claims.
3. It is to be noted that the question whether a claims fee is due under Rule 31(1) EPC has to be considered already in the course of the initial examination of the application as to formal requirements irrespective of whether at a later stage, as a consequence of the outcome of the substantive examination, such a fee may become due under Rule 31(2) in conjunction with Rule 51(4) EPC.
4. The Board shares the view expressed in the contested decision that an applicant is not at liberty to ignore the provisions on the form and the content of the description and the claims contained in Rules 27 and 29 EPC. It is of great importance for the proper functioning of the European patent system that these provisions are duly observed.
5. In the present case the Board is unable to accept the submission of the Appellant, that the disputed addendum to the description was necessary for providing the disclosure of the invention required by Article 83 EPC or even contributed to serve that purpose. On the contrary, the addendum appears in form as well as in substance only to consist of claims within the meaning of Article 84 and Rule 29 EPC. Furthermore, it is indisputable that the

addendum, identically corresponding to the claims of the US priority application, was included in the application in order to maintain the possibility of making its content a basis for substantive examination.

6. In these circumstances, the Board takes the view that the Receiving Section was right in requiring claims fees in accordance with Rule 31(1) EPC in respect of the 33 claims contained in the addendum to the description. Since the Appellant refused to pay such fees, the Receiving Section was also right in deeming these claims to be abandoned in accordance with Rule 31(3) EPC.

7. As to the request for correction of the description under Rule 88 EPC, the Board is not satisfied that the correction requested is obvious in the sense that it is immediately evident that nothing else would have been intended than what is now offered as the correction. On the contrary, the arguments put forward by the Appellant in favour of the application as filed would seem to indicate very clearly that there was no mistake at all within the meaning of Rule 88 EPC. Consequently, the request has to be rejected.

Order

For these reasons, it is decided that:

1. The request for correction of the description under Rule 88 EPC is rejected.

2. The appeal is rejected.

The Registrar:

J. Kue

The Chairman:

Peter Lind

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W.M.