

Veröffentlichung im Amtsblatt	Ja/Nein
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	Oui/Non

Aktenzeichen / Case Number / N° du recours : J 16/88
Anmeldenummer / Filing No / N° de la demande : 87 103 955.8
Veröffentlichungs-Nr. / Publication No / N° de la publication : 0 248 984

Bezeichnung der Erfindung: Production of cytokinins by microorganisms
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement : C12N 15/00

ENTSCHEIDUNG / DECISION
vom / of / du 18 August 1989

Anmelder / Applicant / Demandeur : The State of Oregon

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Claims fees/State of Oregon

EPÜ / EPC / CBE Articles 84, 106 to 108; Rules 29, 31, 67

Schlagwort / Keyword / Mot clé : "Claims fees - abandonment of Claims - examined prior to search"

Leitsatz / Headnote / Sommaire

Europäisches
Patentamt

Beschwerdekammern

European Patent
Office

Boards of Appeal

Office européen
des brevets

Chambres de recours



Case Number : J 16/88

D E C I S I O N
of the Legal Board of Appeal
of 18 August 1989

Appellant : The State of Oregon acting by and through the Oregon Stateboard of Higher Education on behalf of Oregon State University
P.O. Box 3175
Eugene Oregon 97403 (US)

Representative : Brown, John David et al.
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Decision under appeal : Decision of the Receiving Section of the European Patent Office dated 4 May 1988 refusing reimbursement of 35 claims fees.

Composition of the Board :

Chairman : P. Ford

Members : W. Moser

R. Schulte

Summary of Facts and Submissions

- I. On 18 March 1987, the State of Oregon (USA) acting by and through the Oregon State Board of Higher Education on behalf of Oregon State University filed European patent application No. 87 103 955.8 containing 14 claims. Priority was claimed from two US applications filed respectively on 19 March and 11 April 1986.

In the description of the European patent application a set of 35 clauses are included which, except for the fact that the term "claim" has been changed into "clause", correspond in substance to the 35 claims contained in the aforementioned US priority documents. These clauses define, according to the last sentence on page 32 of the description, "various aspects of the present invention".

Furthermore, clauses 1, 5, 10, 13, 17 to 19, 21 to 23, 27, 31, 34 and 35 are absolutely identical with respectively Claims 1 to 14 of the European patent application.

- II. On 9 September 1987, the Receiving Section of the EPO informed the Appellant that the examination pursuant to Article 91(2) EPC had disclosed that the fees for the Claims 15 to 50 (i.e. clauses 1 to 35 on page 33 to 37 of the description) had not yet been paid as required by Rule 31(1) EPC and that if the claims fee for any claim was not paid in due time, the claims concerned would be deemed to be abandoned (Rule 31(2) EPC).
- III. On 9 November 1987, the Appellant paid the fees for 35 excess claims. In a telex dated 9 November 1987 (duly confirmed on 12 November 1987), the Appellant further requested that the notification of 9 September 1987

requiring the payment of said fees be withdrawn and the latter refunded.

The Appellant pointed out that, in his view, the Decision in Case J 05/87 (cf. OJ EPO 1987, 295) was not applicable to the present case and requested an appealable decision on the matter by the Receiving Section in case his requests should be refused.

- IV. On 4 May 1988, the Receiving Section issued a Decision to the effect that the Appellant's request dated 9 November 1987 to refund the fees paid in respect of the 35 claims attached to the description was refused.

The Receiving Section was of the opinion that the facts underlying the above-mentioned Decision in Case J 05/87 were very similar to those of the present European patent application because the only noticeable difference between them consisted in the use of the word "clause" instead of "claim" in connection with the embodiments of the invention disclosed in the description. Consequently, the Receiving Section held that the ratio decidendi expressed in this Decision (i.e. J 05/87) equally applied to the present case.

- V. The Appellant filed notice of appeal against the decision of the Receiving Section on 30 May 1988. The appeal fee was duly paid and a written statement of the grounds of the appeal as well as an addition to it were filed respectively on 30 May and 4 August 1988.

The Appellant requested that

- the decision under appeal be set aside;
- the claims fees paid in respect of the 35 clauses at the end of the description be refunded;

- the appeal fee be reimbursed;
- oral proceedings be held in case the Board should intend to refuse the appeal.

The Appellant argues as follows:

- The opinion that the application contains "a further 35 claims incurring fees" is wrong in fact and/or in law.
- The difference between the language used in the application which was the subject of appeal J 05/87 and the language used in the present application is material.
- The statements, which are now alleged to be additional claims, are clearly headed "The following clauses define various aspects of the present invention" and the clauses are not presented as claims, whereas in the application, which was the subject of appeal J 05/87, the annexed embodiments were clearly referred to as claims as originally filed.
- The claims required to be filed by Rule 29 EPC are clearly entitled "Claims".
- The decision presently under appeal does not set out the whole of the decision of appeal J 05/87. Indeed, paragraph 7 thereof is omitted and it is specifically noted that the amendment requested was not indicated by the Board to be equivalent to what had been filed, but that it was not satisfied that the correction requested was obvious. The Board could have said, but did not, that even if the amendment was allowed, the subject-matter of the "embodiments" was still to be deemed abandoned because the claims fees in respect thereof had not been paid.

- If the clauses at the end of the description of the present application are claims on which excess claims fees are payable (which is strongly denied), then presumably the claims filed are redundant or are a second set of claims smaller in number than the first set and accordingly no excess claims fees are payable in respect thereof. Thus, only 25 excess claims fees in total would be payable (whereas 39 excess claims fees in total have been paid). However, it is maintained that only the four excess claims fees originally paid are payable.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. The application as filed contains Claims 1 to 14 which can clearly be seen to be claims within the meaning of Article 84 EPC. Moreover, they are included in a section identified as containing claims (cf. heading "Claims" on page 38 of the European patent application as published) and cross-refer to one another as claims. On the other hand, in his telex dated 9 November 1987, the Appellant expresses his clear intention that the disputed "clauses" should not be treated as claims. It is therefore reasonable to assume for the purpose of examination prior to search that Claims 1 to 14 are the claims which the Appellant wants and that matter which is contained elsewhere (e.g. "clauses 1 to 35") is not intended to be his claims, whatever may be its form or substance (cf. Decision of the Legal Board of Appeal in Case J 15/88 dated 20 July 1989,

to be published). Thus, there exists no ambiguity in the present case as regards the matter for which protection is sought within the meaning of Article 84 EPC.

3. Although the 35 disputed "clauses" in the present case are numbered and arranged as claims are supposed to be for the purposes of Rule 29 EPC and they do seem to define matter in terms of technical features, the facts remain that they are never referred to as claims, that there are claims elsewhere which alone are so called and that fourteen of the "clauses" (numbered 1, 5, 10, 13, 17-19, 21-23, 27, 31, 34 and 35) have counterparts in the claims properly so called. Hence, there is no reason to suppose that the Appellant intended those fourteen "clauses" to be claims: neither can they possibly constitute any burden on the Search Division. If those clauses are not claims, then it is even more apparent that the details given in the remaining 21 "clauses" have the nature of summarised preferred additional features.
4. The Board takes the view that the facts underlying the Decision in Case J 05/87 (cf. point III supra) differ substantially from those of the present European patent application in so far as, in this particular case, the other matter (i.e. the addendum to the description of a European patent application, which consisted of 33 US claims) effectively had the form and substance of claims and the applicant by his language showed an intention that this other matter should also be treated as claims. Consequently, the ratio decidendi expressed in the Decision in Case J 05/87 (cf. point III supra) does not apply to the present case.
5. Based on the previous considerations (under points 3 and 4 supra), it follows that, at the time of filing, the 35 "clauses" added to the description did not represent

"claims incurring fees" within the meaning of Rule 31(1) EPC, so that the claims fees paid in respect of the 35 "clauses" were not due. By the same token, their reimbursement is not excluded by Rule 31(2) EPC, second sentence. They were wrongly demanded and must be refunded.

6. The fact that the Receiving Section called upon the Appellant to pay claims fees for the 35 "clauses" without taking into consideration the Appellant's clearly expressed intention regarding the matter to be protected does, in the Board's view, not constitute a substantial procedural violation within the meaning of Rule 67 EPC. Consequently, the appeal fee shall not be reimbursed.
7. Oral proceedings were only requested in case the Board intended to refuse the appeal. The decision fully concurs with the case put forward by the Appellant because the impugned decision is set aside as requested. Therefore, no oral proceedings were necessary either for the appeal or for the request of reimbursement of the appeal fee, although this request is rejected, because the request for oral proceedings was clearly meant to refer to the appeal only, and was not intended to refer to the request for reimbursement of the appeal fee.

Order

For these reasons, it is decided that:

1. The decision of the Receiving Section is set aside.
2. The claims fees paid in respect of the 35 clauses are to be refunded.

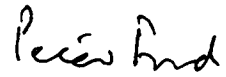
3. The request for reimbursement of the appeal fee is rejected.

The Registrar:



F. Klein

The Chairman:



P. Ford

22.8.85 / W. N. J. er