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Anmeldenummer / Filing No / N^o de la demande : 87 109 947.9
Veröffentlichungs-Nr. / Publication No / N^o de la publication : 0 256 296
Bezeichnung der Erfindung: Apparatus for scanning and reading bar codes
Title of invention:
Titre de l'invention :
Klassifikation / Classification / Classement : G06K 7/10

ENTSCHEIDUNG / DECISION
vom / of / du 18 October 1989

Anmelder / Applicant / Demandeur : Optel Bar Code Systems, Inc.
Patentinhaber / Proprietor of the patent /
Titulaire du brevet :
Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Claims fees/OPTEL
EPU / EPC / CBE Articles 80, 84, 123(2); Rules 27, 29, 31
Schlagwort / Keyword / Mot clé : "Claims fees - abandonment of claims (no)" -
"Claims fees - intention of applicant decisive
- deliberate choice (yes)"

Leitsatz / Headnote / Sommaire

Europäisches
Patentamt

Beschwerdekammern

European Patent
Office

Boards of Appeal

Office européen
des brevets

Chambres de recours



Case Number : J 29/88

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

Appellant : Optel Bar Code Systems, Inc.
770 Basket Road
Webster, N.Y. 14580
USA

Representative : Wagner, Karl H.
WAGNER & GEYER
Patentanwälte
Gewürzmühlstrasse 5
Postfach 246
D-8000 München 22

Decision under appeal : Decision of the Receiving Section
of the European Patent Office
dated 6 July 1988

Composition of the Board :

Chairman : P. Ford

Members : C. Payraudeau
J. Stephens-Ofner

Summary of Facts and Submissions

I. European patent application No. 87 109 947.9 was filed on 9 July 1987 on behalf of the Appellant, a US corporation. Priority was claimed from an earlier US application.

As filed, the European application contained a description ended by a section headed "Summary of the invention" consisting of 47 clauses numbered 1 to 47, a statement of claim headed "claims" containing 10 claims, 16 sheets of drawings and an abstract.

II. On 10 August 1987, the Receiving Section invited the Appellant to pay 47 claims fees in application of Rule 31(1) EPC, since, in their view, the 47 clauses in substance defined matter for which protection was sought and the Applicant could not circumvent Rule 31 by arranging the claims in the wrong part of the specification.

III. In reply, received on 20 October 1987, the Appellant submitted in substance that, owing to the differences between the US and the European patent systems, it was necessary for the European representative of a US applicant to adapt the claims of the US application, the priority of which was to be claimed, to the European practice. However, in particular in view of the time constraints imposed by the Paris Union Convention, it was necessary to incorporate the matter of the US claims into the disclosure of the European application in order to avoid any accidental loss of right, since the claims of the European application only reproduced some of the US claims.

IV. On 2 December 1987, the Receiving Section sent the Appellant a communication under Rule 69(1) EPC, stating that 47 additional claims were deemed to be abandoned. They

added that the arguments presented by the Appellant could not be accepted, and referred in this respect to decision J 05/87 (OJ EPO 1987, 295).

- V. On 23 December 1987, the Appellant applied for a decision under Rule 69(2) EPC. In support of this application, it was submitted that it was clear from Articles 78 and 84 EPC that it is up to the Applicant to decide what kind of claims he wishes to submit. When the application contains a part which is identified as "claims", the Receiving Section has no authority to determine whether other parts of the specification should be considered to contain claims.
- VI. On 24 February 1988, the European application was published with the remark "Additional Claims 1-47 annexed to the description are deemed to be abandoned due to non-payment of the claims fees (Rule 31(3) EPC)."
- VII. On 6 July 1988, in the decision under appeal, the Receiving Section held that the 47 claims contained in pages 22 to 30 of the specification under the heading "Summary of the invention" were deemed to have been abandoned.

In the reasons for the decision it was asserted that the decision followed the earlier decision J 05/87 of the Legal Board of Appeal, in which it was held that claims incorporated as such in the description under the heading "Preferred embodiments" were to be considered as effective claims for the application of Rule 31 EPC.

It was emphasized that the fact that the word "claim" has been deleted could not have the effect of changing the character of the phrase.

- VIII. On 16 September 1988 the Appellant filed a notice of appeal against the decision requesting that it be set aside. The

appeal fee was duly paid and a written statement of grounds developing the arguments already submitted to the Receiving Section was filed on 17 November 1988.

Reasons for the Decision

1. The appeal is admissible.
2. In two recent cases (J 15/88 dated 20 July 1989 and J 16/88 dated 18 August 1989) the Legal Board of Appeal has decided that parts of the descriptions of European patent applications headed respectively "Preferred features of the invention" and "Various aspects of the present invention" and each containing a series of numbered paragraphs, were not to be considered as containing claims, at least in the case where the specification also comprised a section clearly identified as containing claims and which did contain claims.

The Legal Board of Appeal also stated in these decisions that they were not in conflict with the decision in case J 05/87 relied upon by the Receiving Section, in those cases as in the present case, because in the case J 05/87 the addendum to the description not only had effectively the form and substance of claims but the Applicant had by his language shown an intention that the matter of the addendum should also be treated as claims.

3. In the present case, the word "claim" does not appear anywhere in the application as filed in the section of the description headed "Summary of the invention". The fact that the actual text used may have been a copy adapted, before filing, from the typed text previously in the US, by deleting the word "claims" therefrom, must be considered to be without significance. What was filed was, as a matter of

fact and a matter of law, the adapted text: it makes no difference that the Appellant's representative did not have it re-typed before filing, as he might have done.

4. The Board accepts that the Receiving Section was right to consider that it is the substance of a text which determines the legal character of a part of an application and not the arbitrary order or heading chosen by the Applicant.

However, the deliberate choice of the heading "Summary of the invention" and the avoidance of the use of the word "claim" in the summary as originally filed show the unmistakable intention of the Appellant to have this part of the description not considered as claims. This is clearly and fully confirmed by the presence of a section headed "claims" and containing paragraphs referring to one another as claims and which are in form and substance claims.

There is, therefore, no doubt that the intention of the Appellant was to have only the section headed "claims" considered as claims defining the matter for which protection is sought as specified by Article 84 EPC and to have the other matter contained in the section headed "Summary of the invention" only considered as an element of the description.

5. Therefore, the Board takes the view that for the purpose of Rule 31 EPC the only part of the specification to be considered as claims is the section so headed.
6. It should be noted in this respect that the Board does not adopt the view that the formulation of a summary could represent an attempt to circumvent Rule 31 EPC so that the

EPO should be entitled to restore the claims in their proper form.

The Board is of the opinion that, properly interpreted, the summary of the invention which contains the substance of the claims of the US patent application, the priority of which is claimed, had as its sole object incorporation of that substance into the description so as to avoid any loss of right which could result from the adaptation of the US type of claims to the form required by the EPC.

7. It is clear that a European application containing such a "summary" can, under Article 80 EPC, have a date of filing for all the elements of the filed specification, including this summary, even if the description so drafted might be considered as not fully satisfying the conditions of Rule 27 EPC. In such a case, the EPO may, of course, require at a later stage that the description should be amended in order to correct any formal irregularity but, in particular for the application of Article 123(2) EPC, the substance of this summary will be considered as part of the content of the application as filed.

8. As regards the search and examination of the application, the Board observes that according to Article 92 EPC the European search report is drawn up on the basis of the claims with due regard to the description and any drawing and that according to Article 84 EPC the claims define the matter for which the protection is sought, the substantive examination being made on the basis of the claims.

Therefore, no more and no less consideration should be given by the EPO to the summary than to the other elements of the description.

9. Accordingly, the Board holds that the section headed "Summary of the invention" is not to be deemed abandoned but is to be considered as a part of the description.

Order

For these reasons, it is decided that:

1. The contested decision is set aside.
2. It is ordered that the European patent application No. 87 109 947.9 is to be corrected by the cancellation of the remark "Additional Claims 1-47 annexed to the description are deemed to be abandoned due to non-payment of the claims fees (Rule 31(3) EPC)."

The Registrar:

J. Rückerl

The Chairman:

P. Ford