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Aktenzeichen / Case Number / N^o du recours : J 27/89

Anmeldenummer / Filing No / N^o de la demande : 88 104 963.9

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Bezeichnung der Erfindung: Modified labelled nucleotides and polynucleotides
Title of invention: and methods of preparing, utilising and detecting
Titre de l'invention : same

Klassifikation / Classification / Classement : C07H 21/00

ENTSCHEIDUNG / DECISION

vom / of / du 19 March 1990

Anmelder / Applicant / Demandeur : Enzo Biochem Inc.

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Number of claims incurring fees/Enzo Biochem

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

Schlagwort / Keyword / Mot clé : "Number of claims incurring fees" -
"Content of the description" - "Form and
content of claims"

Leitsatz / Headnote / Sommaire



Case Number : J 27/89

D E C I S I O N
of the Legal Board of Appeal
of 19 March 1990

Appellant : Enzo Biochem, Inc.
325 Hudson Street
New York, New York 10013 (US)

Representative : Peter A. Rauh
Vossius & Partner
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8000 München 80 (DE)

Decision under appeal : Decision of the Receiving Section
of the European Patent Office
dated 17 March 1988

Composition of the Board :

Chairman : P. Ford
Members : L.C. Mancini
F. Benussi

Summary of Facts and Submissions

- I. Euro-PCT patent application No. 88 104 963.9 was filed on 28 March 1988 on behalf of the Appellant, a US corporation. Priority was claimed from a US application dated 23 June 1982.
- II. In the Request for Grant form (Box 37 - "number of claims") was entered the number 17. Under the heading "What is claimed" at pages 121 to 133 of the application there were in fact 43 claims and 7 claims fees were paid on 28 March 1988.

From page 9 to page 64 of the description under the heading "Preferred embodiments of the present invention are explained in detail in the following enumeration", there were 296 numbered paragraphs, each of which corresponded to a claim in the US priority application, but none of which was referred to as a claim: each paragraph was called an "item".

- III. On 1 September 1988 the Receiving Section, by a communication pursuant to Article 91(2) and Rule 41(1) EPC (EPO Form 1068), informed the Appellant's professional representative that the fees for the additional "Claims 1-296" annexed to the description could be paid within 2 months from receipt of the communication, and referred to decision J 5/87 of 6 March 1987. By a further communication (EPO Form 1066) dated 6 December 1988, the representative was informed that since fees for such claims had not been paid in due time, they were deemed to have been abandoned (Rule 31(2) EPC).

By letter of 16 February 1988 the representative objected to such findings and asked for a decision under Rule 69(2) EPC and further contended in a letter of 3 March 1989 that the 296 enumerated sentences were an integrated and essential component of the original disclosure and that, therefore, the facts in the present case clearly were different from those of the Decision of the Legal Board of Appeal J 5/87 (OJ EPO 1987, 195).

In support he pointed out that the present application was a divisional one, containing unchanged the original description of the parent application which had not at the time been objected to by any Section of the Office. He, therefore, was of the opinion that the list of the 296 "preferred embodiments" has become a part of the original disclosure of the parent application and hence, part of the disclosure of the divisional application as well.

- IV. The Receiving Section restated its opinion in a communication of 7 March 1989 (Art. 113 EPC), and then gave the decision under appeal on 17 March 1989, again relying on Decision J 5/87, which it considered decisive for the present case.

- V. In its decision the Receiving Section *inter alia* observed that an oversight imputable to the Office seemed to have occurred in dealing with the present application's parent application, but held that this could not create a precedent and, hence, give rise to any rights.

Therefore, the argument that there had been no prior objection to the 296 preferred embodiments as being part of the description of the parent application was of no relevance.

- VI. The Appellant filed a Notice of Appeal on 17 March 1989 and presented the Statement of Grounds on 17 May 1989, paid the appeal fee and requested oral proceedings as an auxiliary measure, requesting that the decision under appeal be set aside.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. The Board finds that the application as filed contains Claims 1 to 17 which constitute claims within the meaning of Article 84 EPC and are included in a section identified as containing claims. Furthermore, in this context in the application and in his letter dated 3 March 1989, the Appellant has expressed a clear intention that the disputed 296 sentences should not be treated as claims. In these circumstances, it can be reasonably accepted, for the purpose of examination prior to search, that Claims 1 to 17 are those which the Appellant wants and that matter contained elsewhere (i.e. "preferred embodiments 1 to 296") is not intended to be claims, whatever may be its form or substance.
3. In three recent decisions (J 15/88 dated 20 July 1989, J 16/88 dated 18 August 1989 and J 29/88 dated 18 October 1989) the Legal Board of Appeal has held that parts of the descriptions of European patent applications (headed respectively "Preferred features of the invention", "Various aspects of the present invention" and "Summary of the invention") and each containing a series of paragraphs, could not be considered as containing claims since the specification in question also comprised a

section identified as claims and actually containing claims.

Such decisions do not conflict with that in Case J 5/87 where the addendum to the description had the form and substance of claims and the Applicant by his language had clearly shown an intention that the matter of the addendum should also be treated as claims.

4. In the present case, the disputed 296 enumerated sentences (paragraphs) constitute part of the description, rather than an addendum to the description. They are never referred to as claims. Hence, it is not justified to presume that the Appellant intended them to be claims.
5. In the Board's view, since the facts underlying the decision in Case J 5/87 differ significantly from those of the present case, the ratio decidendi expressed in the decision in Case J 5/87 cannot extend to the present case.
6. Accordingly, 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 and that, at the time of filing, the 296 "preferred embodiments" did not represent "claims incurring fees", within the meaning of Rule 31(1) EPC. The Board does not consider it necessary to take into account the Appellant's argument based on the contents of the parent application in reaching this conclusion.
7. The fact that the Receiving Section asked the Appellant to pay claims fees for the 296 preferred embodiments without correctly considering the Appellant's intention regarding the matter to be protected does not, in the Board's view, constitute a substantial procedural violation within the

meaning of Rule 67 EPC. Consequently, the appeal fee is not to be reimbursed.

8. Oral proceedings were requested in case the Board might consider it should reject the appeal. In fact, the Board accepts the Appellant's arguments and sets aside the impugned decision as requested without holding oral proceedings. The request for oral proceedings is understood to apply only if the Board considered rejecting the appeal itself, and not if it merely considered that it should reject reimbursement of the appeal fee.

Order

For these reasons, it is decided that:

The decision of the Receiving Section is set aside.

The Registrar:



The Chairman:

