

Internal distribution code:

- (A) [] Publication in OJ
(B) [x] To Chairmen and Members
(C) [] To Chairmen
(D) [] No distribution

**Datasheet for the decision
of 23 April 2008**

Case Number: T 0606/06 - 3.2.03
Application Number: 99938911.7
Publication Number: 1105680
IPC: F23J 17/00, F23G 5/32
Language of the proceedings: EN

Title of invention:
Heating and incineration device

Applicant:
Ludwig, Mark

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 123(2)

Relevant legal provisions (EPC 1973):
EPC Art. 85, 78
EPC R. 33(2), 33(5), 34, 47

Keyword:
"Abstract part of contest of application as filed (no)"
"Reimbursement of appeal fee (no)"

Decisions cited:
T 0246/86, T 0168/86, T 0407/86, T 0077/87, T 1080/99,
J 0003/06, J 0010/07

Catchword:

The abstract as originally filed does not form part of the content of the application as filed for the purposes of Article 123(2) EPC 2000 (T 0246/86). The word "merely" in Article 85 EPC 1973 is to be understood as meaning "only" and the word "shall" in Rule 33(2) EPC 1973 is to be understood in the sense of "should" or "ought to". In the case of any discrepancy between the abstract as originally filed and the description, claims and drawings as originally filed, it is the latter which prevails.



Case Number: T 0606/06 - 3.2.03

D E C I S I O N
of the Technical Board of Appeal 3.2.03
of 23 April 2008

Appellant: Ludwig, Mark
4560 Mount Taylor Drive
Santa Rosa
CA 95404 (US)

Representative: Eder, Ephry
E. EDER & CO.
Suite 4, Ground Floor
No. 3 Accomodation Road
London NW11 8ED (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 13 December 2005
refusing European application No. 99938911.7
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: U. Krause
Members: C. Donnelly
K. Garnett

Summary of Facts and Submissions

I. This is an appeal against the decision of the Examining Division dated 13 December 2005 refusing European patent application No. 99 938 911.7 filed on 30 July 1999. The reason for the refusal was that the claimed subject matter extended beyond the content of the application as filed, contrary to Article 123(2) EPC.

II. Claim 1 of the single request before the Examining Division, corresponding to the claims filed with letter dated 12 July 2005, read as follows:

"A heating and incineration device, comprising:
a heating chamber (15;38) with a chamber inlet (16;48) for admitting a process stream and a chamber outlet (18;49) for discharging said process stream;

an incineration tube (22;40) connected to said heating chamber (15;38) and extending outwardly from said heating chamber (15;38), said incineration tube being positioned to provide an inlet (31;42) thereto opening into said heating chamber (15;38) and an outlet therefrom (32) positioned outside said heating chamber (15;38); and

a heat source (11;35;39) positioned inside said heating chamber (15;38) and located in substantially coaxial alignment with said incineration tube inlet (31;42), such as

(a) to produce and direct a column of hot gases into said incineration tube inlet (31;42) thereby to heat an interior of said incineration tube (22;40) to a high temperature to promote incineration of pollutants, and
(b) to heat said process stream to a lower working temperature - when said process stream is passed through said heating chamber (15;38) between said

chamber inlet (16;48) and said chamber outlet (18;49) - so that said process stream is generally prevented from mixing with said hot gases, and

(c) to cause said pollutants to pass through said incineration tube (22; 40) and be incinerated before being exhausted through said incineration tube outlet (32)."

III. In Claim 1 as originally filed, the above italicised portion read instead:

"an incineration tube extending into said heating chamber, said incineration tube having an incineration tube inlet positioned inside said heating chamber and an incineration tube outlet positioned outside said heating chamber;"

IV. In its communications dated 17 June 2004 and 20 January 2005 the Examination Division indicated that by deleting an essential feature from the filed claim, namely "an incineration tube extending into said heating chamber, said incineration tube having an incineration tube inlet positioned inside said heating chamber", the applicant (hereafter "the appellant") had introduced subject matter extending beyond the application as filed, contrary to Article 123(2) EPC.

V. In its response contained in letters dated 16 December 2004 and 21 July 2005, the appellant argued that a basis for the extension of the subject matter as filed could be found in the originally filed abstract. The relevant part of this read: "An incineration tube (22) is positioned into the heating chamber for providing

the only exit for gases from the heating chamber and the heating application."

VI. In its decision issued in writing on 13 December 2005 the Examining Division refused the application, holding that in accordance with decision T 246/86 (OJ EPO 1989, 199) the abstract could not serve as a basis for interpreting the scope of the protection sought. The Examining Division also held that in any event, on its proper construction, the abstract did not in fact provide the necessary disclosure.

VII. The appellant filed a notice of appeal on 13 February 2006 together with the grounds of appeal, having already paid the appeal fee on 7 February 2006. The appellant's main request was that the application be allowed in accordance with the amended claims of the single request before the Examining Division. A further set of amended claims was also filed with the grounds of appeal as the basis for an auxiliary request. Claim 1 according to this auxiliary request reads as follows:

"A heating and incineration device, comprising:
a heating chamber (15;38) with a chamber inlet (16;48) for admitting a process stream and a chamber outlet (18;49) for discharging said process stream;

an incineration tube (22;40) extending into said heating chamber (15;38) and extending outwardly from said heating chamber (15;38), said incineration tube having an inlet (31;42) that is positioned inside said heating chamber (15;38) and having an outlet (32) that is positioned outside said heating chamber (15;38); and

a heat source (11;35;39) positioned inside said heating chamber (15;38) and located in substantially coaxial alignment with said incineration tube inlet (31;42) such as:

- (a) to produce and direct a column of hot gases into said incineration tube inlet (31;42) thereby to heat an interior of said incineration tube (22;40) to a high temperature to promote incineration of pollutants, and
- (b) to heat said process stream to a lower working temperature - when said process stream is passed through said heating chamber (15;38) between said chamber inlet (16;48) and said chamber outlet (18;49) - so that said process stream is generally prevented from mixing with said hot gases, and
- (c) to cause said pollutants to pass through said incineration tube (22; 40) and be incinerated before being exhausted through said incineration tube outlet (32)."

VIII. In relation to its main request, the arguments of appellant as contained in the grounds of appeal can be summarised as follows (references to the EPC and the Implementing Regulations are to the EPC and Implementing Regulations before any amendment by the Act of 29 November 2000 revising the Convention on the Grant of European Patents - hereafter "the Revision Act"):

- (a) For the purposes of Article 123(2) EPC, the disclosure is to be found in the application, which consists of the description, the claims, the drawings *and the abstract*. The only restriction on the use of the abstract is its use to resolve any lack of clarity in the claims.

The following more detailed arguments form the basis for this core submission:

- (b) A comparison of the first and second sentences of Article 123(2) EPC shows that a distinction is drawn between an "application" and the "description, claims and drawings". The only thing that can distinguish an application from the description, claims and drawings is that the application includes in addition the abstract.
- (c) Article 123(2) EPC provides that a patent application may not be amended in such a way that it contains subject matter which extends beyond the *content* of the application as filed. As is made clear by Article 78(1) EPC ("A European patent application shall contain ...(e) an abstract") the content of the application, i.e. that which it contains, includes the abstract.
- (d) Although Article 85 EPC states that the abstract shall "merely" serve for use as technical information and may not be taken into account for any other purpose, the word "merely" is minimalistic; it does not mean "only" in the sense that the abstract may *only* serve for use as technical information. Further, the words which follow ("in particular not for the purpose of interpreting the scope of the protection sought nor for the purpose of applying Article 54, paragraph 3") restrict the meaning of the earlier expression "for any other purpose" to cases where the scope of protection needs to be interpreted.

Here, there is no difficulty in interpreting claim 1, with or without the amendment.

- (e) Since Rule 33(2) EPC provides that the abstract *shall* contain a concise summary of the disclosure as contained in the description, claims and drawings, the abstract *cannot* extend beyond such disclosure. In other words, technical information in the abstract must *ipso facto* be present in one or more of the description, the claims or the drawings. An amendment which recites such technical information cannot be deemed to extend the content beyond that of the application as filed.

- (f) Having regard to Rule 33(5) EPC, it would be perverse if the abstract contained information not present in the description, claims or drawings with the result that a person, having read the abstract and assessed that there was a need to consult the patent application itself, could not find the relevant material in any of the description, claims or drawings. This supports the submission that amending the claims or description to recite what specifically appears in the abstract cannot be deemed to extend the content beyond that of the application as filed.

- (g) The powers given under Rule 34 EPC in relation to prohibited matter are wide enough to require or enable the EPO to remove specified subject matter or statements from the abstract as well as from the description or claims. This confirms that the abstract forms part of the application.

- (h) Rule 35(5) EPC expressly provides that the application includes the abstract.
- (i) The argument of the Examining Division, that the abstract is only a concise summary of the invention and does not always contain all the features and aspects of the independent claims, does not detract from the fact that the entire text of the abstract is part and parcel of the application and can be transferred into the description or claims, as long as it does not serve to interpret the claims.
- (j) Finally, the appellant argued that the Examining Division in any event wrongly construed the abstract.

IX. The appellant requests:

- (a) Cancellation of the Examining Division's Decision in its entirety.
- (b) Costs, to include at least reimbursement of the appeal fee.
- (c) Grant of a patent on the basis of the claims according the request before the Examining Division.
- (d) Alternatively, grant of a patent on the basis of the auxiliary request filed with the grounds of appeal.

X. Oral proceedings were not requested.

Reasons for the Decision

1. The appeal is admissible.
2. *Main request: Article 123(2) EPC*
 - 2.1 This appeal is concerned with the effect of Articles 123(2), 85 and 78 EPC, and associated Implementing Regulations. These provisions have all been altered pursuant to the Revision Act. Although none of these changes affect the outcome of this decision, the formal position is as follows:
 - 2.1.1 Article 123(2) has been amended by Article 1(2) of the Revision Act, and the amended version of the article applies to the present application, being a European patent application pending on 13 December 2007, the date when the amended provision entered into force: see Articles 7(1) and (2) of the Revision Act and Article 1(2) of the Decision of the Administrative Council dated 28 June 2001 (OJ EPO, Special Edition 4 of 2007, 219). However, the amendment has no bearing on the outcome of the present case since the stipulation in Article 123(2) EPC that a European patent application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed remains unchanged.
 - 2.1.2 The text of the English version of Article 85 EPC has been revised under the powers given to the Administrative Council by Article 3(1) of the Revision Act. However, the revised provisions of this article do not apply to the present application. See again Articles 7(1) and (2) of the Revision Act and

Article 1(2) of the Decision of the Administrative Council dated 28 June 2001.

2.1.3 Article 78 EPC has been amended by Article 1(2) of the Revision Act. Again, however, the amended version of the article does not apply to the present application. See again Articles 7(1) and (2) of the Revision Act and Article 1(2) of the Decision of the Administrative Council dated 28 June 2001.

2.1.4 This appeal is also concerned with certain of the implementing regulations to the EPC (see paragraphs VIII (e) - (h), above). As to these, the Implementing Regulations to the new text of the EPC ("EPC 2000") were amended by the Decision of the Administrative Council of 7 December 2006 (OJ EPO, Special Edition 1 of 2007, 89). Article 2 of that Decision provides that: "The Implementing Regulations to the EPC 2000 shall apply to all European patent applications ... in so far as the foregoing are subject to the provisions of the EPC 2000." In the present context, the words "the foregoing" clearly refer to the expression "European patent applications" and the Board reads the words "in so far as" as limiting the application of the amended Implementing Regulations to those articles of the EPC 2000 to which the particular application is "subject". The present application is subject to Article 123(2) EPC 2000 but not to Articles 85 and 78 EPC 2000, but rather to Articles 85 and 78 of the version of the EPC before revision ("EPC 1973"). See paragraphs 2.1.1 to 2.1.3, above. Although the wording of the Decision of the Administrative Council is perhaps a little Delphic, the effect appears to be that so far as concerns implementation of the provisions of Articles 85 or 78

EPC 1973, reference is to be made to the form of the Implementing Regulations before amendment by the Decision of the Administrative Council of 7 December 2006. Rules 33 and 47 of this version of the rules (relating to the abstract), which are relied on by the appellant in this case, can be said to implement Article 85 EPC 1973 and they are thus indeed the relevant versions for present purposes. See also J 3/06, point 3, and J 10/07, point 1.3 (both to be published in EPO OJ).

- 2.1.5 In subsequent references to the EPC in this decision it is made clear which version of the EPC or Implementing Regulations is being referred to.
- 2.2 The appellant does not dispute that if the abstract does not form part of the content the application as filed within the meaning of Article 123(2) EPC 2000 then the main request must be refused.
- 2.3 Article 85 EPC 1973 provides that: "The abstract shall merely serve for use as technical information; it may not be taken into account for any other purpose, in particular not for the purpose of interpreting the scope of the protection sought nor for the purpose of applying Article 54, paragraph 3." Prima facie the meaning of the article is clear: the abstract is there only to provide (technical) *information*; it is not to be taken into account for any other purpose. Taking it into account for the purpose of ascertaining the content of the application as filed would be taking it into account for another purpose.

2.4 This conclusion is in agreement with T 246/86 (OJ EPO 1989, 199), where the Board concluded (point 2.2) that the abstract is intended solely for documentation purposes and does not form part of the disclosure of the invention. As well as relying on Article 85 EPC 1973 the Board also referred to Rule 33(5) EPC 1973, which provides:

"The abstract shall be so drafted that it constitutes an efficient instrument for the purposes of searching in the particular technical field particularly by making it possible to assess whether there is a need for consulting the European patent application itself."

The Board considered that although the abstract was to serve for use as technical information it did not follow that it could be used to interpret the content of the application as filed.

2.5 In the present case the appellant puts the case slightly differently, arguing that the abstract is part of the content of the application as filed and not just an aid to interpretation of the application as filed. However, if the abstract cannot be used to interpret the content of the application, a fortiori it cannot be part of the content of the application.

2.6 The appellant is correct to say that an application for a European patent must contain an abstract (Article 78(1) EPC 1973) and also that the abstract is one of the documents which should make up the application (Rule 35(5) EPC 1973) but it is not correct to say that for the purposes of Article 123(2) EPC 2000

the content of the application as filed includes the abstract. The point was explained in T 407/86, point 3:

"Although, as submitted by the appellant, the abstract forms part of the contents of the European patent application in accordance with Article 78(1)(e) EPC, it is to be noted that due to the very restricting provisions of Article 85 EPC there is a clear legal difference between the abstract, on the one hand, and the description, the drawings (if any) and the claims (Article 78(1)(b), (c), (d) EPC), on the other. In fact, only the latter parts of the application are to be considered as constituting the substantive contents of the European patent application to be taken into account for the purpose of judging what subject-matter is contained in the application as filed. Thus, it has to be concluded that for the purpose of Article 123(2) EPC "the content of the application as filed" does not include the abstract."

- 2.7 As regards the appellant's argument that the word "merely" in Article 85 EPC 1973 is minimilistic and does not mean that the abstract may *only* serve for use as technical information, the Board disagrees. The ordinary meaning of the word "merely" in this context is: only (what is referred to) and nothing more. See the Oxford Shorter English Dictionary. There is nothing in the present context to indicate that it should bear some other meaning. On the contrary, such a meaning is wholly consistent with the context. The appellant's submission is also inconsistent with the versions of the article in the German language ("Die

Zusammenfassung dient *ausschließlich* der technischen Information; ...") and in the French language ("L'abrégé sert *exclusivement* à des fins d'information technique; ...").

2.8 The appellant's argument in relation to the word "merely" is undermined by the change which has been made to the English language version of Article 85 EPC 1973 pursuant to the Revision Act. Article 85 EPC 2000 now provides: "The abstract shall serve the purpose of technical information *only*; it may not be taken into account for any other purpose, in particular for interpreting the scope of the protection sought or applying Article 54, paragraph 3" (emphasis added). This amendment was made under the powers given to the Administrative Council by Article 3 of the Revision Act to align the wording of the new text of the EPC, where necessary, in the three official languages. The revised wording of the English language version Article 85 is now aligned with the German and French versions (see paragraph 2.7, above), neither of which were themselves revised. Although the revised version of Article 85 EPC does not apply to the present application (see paragraph 2.1.2, above), the nature of the change, which was clearly not intended to effect any change in meaning, supports the interpretation given by the Board.

2.9 The Board also disagrees that the expression "in particular" in Article 85 EPC 1973 restricts the meaning of the words which precede it to the examples which follow. The use of the words "in particular" is a common linguistic device used by legislators when it is wished to make the position clear beyond doubt in relation to certain matters. Although the words which

follow the expression "in particular" may in some circumstances illuminate what has gone before, in normal use the expression does not imply a limitation on what has gone before. The Board sees nothing in the present context justifying the construction which the appellant places on the expression "in particular".

2.10 The appellant also relies on Rule 33(2) EPC 1973 (see paragraph VIII(e), above). This rule provides that the abstract "shall contain a concise summary of the disclosure as contained in the description, the claims and any drawings". Contrary to the submission of the appellant, the effect of this rule is to prescribe what the abstract should (i.e. ought to) contain and not to effect a legislative deeming whereby on the one hand the abstract, by force of law, contains a concise summary of the disclosure and on the other the disclosure is, by force of law, accurately summarised in the abstract. With this argument, the appellant is attempting to make the tail wag the dog. The argument is not only incorrect on the basis of the ordinary meaning of the words used in Rule 33(2) EPC 1973 but also the light of the nature and purpose of the abstract, as shown by the following.

2.10.1 First, as also noted in T 246/86, above, point 2.2, the failure to file an abstract merely constitutes a deficiency which can be corrected in accordance with Articles 91(1)(c) and (2), and Rule 41(1) EPC 1973 (now Article 90(3) and Rule 57 EPC 2000). This is not consistent with the argument that the abstract forms an integral part of the original disclosure.

2.10.2 Second, it is clear that an abstract as filed may well not comply with the provisions of Rule 33(2) EPC 1973 (or now, Rule 47(2) EPC 2000), in which case the examiner has power to amend it under Rule 47 EPC 1973 (or now, Rule 66 EPC 2000), it being the Office's responsibility under this rule to determine the definitive content of the abstract. Again, this is not consistent with the argument that the abstract plays a role in determining the content of the application as filed.

2.10.3 Third, even then, the abstract may in fact not comply with Rule 33(2) 1973 (or now Rule 47(2) EPC 2000), in which event there will be a discrepancy between the abstract and the disclosure as contained in the description, claims and drawings. It is the nature of any abstract, however, as is confirmed by the words of Article 85 EPC 1973, that it contains only a brief summary of the abstracted document and, in the case of a discrepancy between the two, it is the content of the abstracted document which is determinative and to which the reader should turn. This case of a patent abstract is no different, as explained in T 77/87, point 4.1.4:

"The original document is the primary source of what has been made available as a technical teaching and its abstract is by its nature merely a secondary and derivative source. It is axiomatic that an original basic document and its abstract cannot disclose two different subject-matters as a matter of technical reality. When, as in the present case, there is a substantial inconsistency between the original document and its abstract, it is clearly the disclosure of the original document

that must prevail. The disclosure in the original document provides the strongest evidence as to what has been made available to the skilled man."

The same point was made in T 1080/99 (OJ EPO 2002, 568), point 4.1, where, having cited T 77/87, the Board observed:

"Like other kinds of abstracts and summaries of scientific or technical articles, patent abstracts are to be read and interpreted in the light of the full disclosure of the corresponding original documents. Hence, taken alone, their content can only be considered to be provisional and acceptable on a prima facie basis. In the Board's opinion, this view corresponds to the reasonable expectation of a skilled person that the abstracting process involves an unavoidable condensation and simplification of the full contents of a document which may lead to clarity problems. ... This means, that patent abstracts - even if clear when taken alone - are only useful as a prima facie source of information attracting a skilled person's attention and pointing to the disclosure of the original document for full assessment of its contents, which becomes essential in case of doubt or for detailed study. It may be necessary to rely on an abstract as an isolated source of disclosure if the originals or their translations are not available. If however it can be proved using the original document that the content of an abstract does not concur with the original disclosure then the original disclosure prevails, and the abstract will be

interpreted or corrected in the light of this disclosure."

- 2.11 These considerations also deal with the appellant's argument by reference to Rule 33(5) EPC 1973 (see paragraph VIII (f), above) that it would be perverse if the abstract contained information not present in the description, claims or drawings.
- 2.12 As regards the appellant's argument that the powers given under Rule 34 EPC 1973 (now Rule 48 EPC 2000) confirm that the abstract forms part of the application (see paragraph VIII (g), above), the powers given to the Office in relation to the form in which the application is *published* have no bearing on the content of the application *as filed* within the meaning of Article 123(2) EPC 2000.
- 2.13 The Board therefore sees no reason to reach a different conclusion from that in T 246/86. Other Boards have reached a similar conclusion (see, e.g., T 168/86, point 5) and so far as the Board is aware its correctness has never been doubted. The decision of the Examining Division was therefore correct.
- 2.14 In the circumstances it is not necessary to consider whether the Examining Division's construction of the abstract was correct.

3. *Auxiliary request*

- 3.1 The amendments made in the auxiliary request overcome the particular objection raised under Article 123(2) EPC in the impugned decision since the deleted feature,

regarded as essential by the Examining Division, has effectively been reintroduced. However, the Board notes that the wording of claim 1 of the auxiliary request diverges slightly from that of the original claim 1 particularly by the use of:

- "substantially coaxial alignment" instead of "coaxial alignment";

and

- "to promote incineration of pollutants" instead of "hot enough for incinerating pollutants".

3.2 Further, the impugned decision is confined to the issue of the status of the abstract and whether it could serve as a basis for amendments introduced into the main request without infringing Article 123(2) EPC 2000. It does not in any way deal with the issues of novelty or inventive step of the claims according to the main request or auxiliary request.

3.3 In these circumstances the Board feels compelled to remit the case to the Examining Division for a complete examination of the auxiliary request as regards to its compliance with the requirements of the EPC.

4. *Reimbursement of the appeal fee*

4.1 The notice of appeal includes a request for costs, to include at least reimbursement of the appeal fee. However, no reasons justifying such a request are advanced in the grounds of appeal and the Board has itself been unable to see any.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution.
3. The request for costs, to include at least reimbursement of the appeal fee, is refused.

The Registrar:

The Chairman:

A. Counillon

U. Krause