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Aktenzeichen / Case Number / N^o du recours : T 237/84

Anmeldenummer / Filing No / N^o de la demande : 81 200 098.2

Veröffentlichungs-Nr. / Publication No / N^o de la publication : 0 034 381

Bezeichnung der Erfindung : Tape recording and/or reproducing apparatus with
Title of invention: rotating magnetic head
Titre de l'invention :

Klassifikation / Classification / Classement : G11 B 5/52

ENTSCHEIDUNG / DECISION

vom / of / du 31 July 1986

Anmelder / Applicant / Demandeur : N.V. PHILIPS' GLOEILAMPENFABRIEKEN

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Reference signs/PHILIPS

EPÜ / EPC / CBE Articles 69(1), 84
Rules 29(1), (6), (7), 86(3)

Leitsatz / Headnote / Sommaire

- I. The purpose of reference signs in a claim (Rule 29(7) EPC) is to make the claims easier for all to understand. They do not limit the scope of the claim but they do affect its clarity and may enable it to be expressed more concisely than would otherwise be possible (Article 84 EPC).
- II. Inclusion in the description of a European patent application of a statement as to the purpose of inclusion of such reference signs is not "obviously irrelevant or unnecessary", such as to be prohibited matter within the meaning of Rule 34(1)(c) EPC, when there is a possibility - albeit remote - that a national Court in a designated State might regard the claims as limited by the inclusion of such reference signs, in the absence of such a statement.

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Case Number : T 237/84

DECISION
of the Technical Board of Appeal 3.5.1
of 31 July 1986

Appellant : N.V. PHILIPS' GLOEILAMPENFABRIEKEN
Groenewoudsweg 1
NL-5621 BA Eindhoven NL

Representative : Van Weele, Paul Johannes Fritz
INTERNATIONAL OCTROOIBUREAU B:V:
Prof. Holstlaan 6
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Decision under appeal : Decision of Examining Division 067 of the
European Patent Office dated 9 May 1984
refusing European patent application
No. 81 200 098.2 pursuant to Article 97(1)
EPC

Composition of the Board :

Chairman : G. Korsakoff
Member : P. Ford
Member : J. van Voorthuizen
Member : C. Payraudeau
Member : W. Oettinger

Summary of Facts and Submissions

- I. European patent application No. 81 200 098.2 was filed on behalf of the Appellant in the German language on 28 January 1981 and published under No. 0 034 381 on 26 August 1981. After the request for examination had been filed on 14 October 1981, the Examining Division, by telephone on 21 June 1982, requested the Appellant to add reference signs to the claims in accordance with the provisions of Rule 29(7) EPC. The Appellant complied with this request. Further amendments to the application were subsequently agreed with the Examining Division, also by telephone, and duly filed on 5 November 1982.

- II. By advanced notice of a Communication in accordance with Rule 51(4) and (5) EPC dated 4 August 1983, the Examining Division informed the Appellant of the text in which it intended to grant a European patent on the application, which text included the claims incorporating the reference signs which had been added to them in 1982.

- III. By letter dated 7 September 1983, the Appellant's representative responded to the advanced notice, indicating approval of the patent being granted with the text as notified but subject to the deletion of all reference signs from the claims.

- IV. Following telephone conversations between the primary examiner and the Applicant's representative and duly confirmed telex messages from the Appellant's representative, oral proceedings were held at the Appellant's request before the Examining Division, now enlarged pursuant to Article 18(2) EPC by a legally qualified examiner, on 21 February 1984. At the conclusion of the proceedings, the European patent application was refused by the Examining Division.

V. In the written Reasons for the Decision, issued on 9 May 1984, the Examining Division held that the Appellant could only amend the European patent application, at the stage reached, with the consent of the Examining Division (Article 86(3) EPC). Deletion of the reference signs would not improve the European patent application: the interests of potentially affected trade competitors of the Appellant in understanding the claims had to be considered. Rule 29(7) EPC supported the requirement of Article 84 EPC that claims shall be clear. Claim 1 in the present case was 30 typewritten lines long and referred to a large number of cooperating technical elements which were identified more than 50 times by no less than 38 reference signs. The claims as a whole extended over more than five pages. There were seven pages of drawings.

The Appellant had proposed various alternative amendments to the European patent application if the reference signs had to remain in the claims: these included footnotes to the claims, stressing that the embodiments shown in the drawing were by way of example only, or an explanatory statement in the description. These were considered to be unallowable for the reasons set out in Legal Advice No. 12/82 (OJ EPO 1982, 109). So far as the claims were concerned, they had to define the scope of protection in terms of the technical features of the invention (Rule 29(7) EPC). Any statements relating to interpretation were superfluous and inadmissible (Rule 24(1)(c) EPC applied). A listing of the reference signs included in the claims would likewise be superfluous and inadmissible.

The Appellant had submitted that difficulties of interpretation of the claims would arise in the United Kingdom unless the reference signs were deleted from the claims. The Examining Division was not satisfied that this would be so on the basis of the case reports and articles submitted.

- VI. The language of the proceedings was changed from German to English, following the completion of the proceedings before the first instance.
- VII. The Appellant filed a Notice of Appeal against the Decision on 18 June 1984 and the appeal fee was duly paid. A Statement of Grounds of Appeal was duly filed on 10 September 1984. In the Statement, the Appellant raised the following issues:
- (a) Is the deletion of reference signs an amendment within the meaning of Rule 86(3) EPC? If it is, is consent required?
 - (b) Can a European patent be refused merely because the Applicant insists that reference signs be removed when he receives advanced notice of the communication pursuant to Rule 51(4) and (5) EPC?
 - (c) Had there been a violation of procedure in accordance with Article 113(1) EPC when the Examining Division had referred to Rule 86(3) EPC for the first time during the oral proceedings and had then given the Applicant's representative cause to think that this was only a minor issue?

- (d) May non-compliance with Rule 29(7) EPC be used as the basis of a refusal of a European patent application? Even if it is, was there enough evidence in the present case to justify refusal?

VIII. By a communication dated 28 August 1985, the Technical Board of Appeal indicated that it considered that the reference signs had properly been required to be included in the claims and that they should remain there. Nevertheless, the Board was prepared to consider the merits of an addition to the text of the description of a statement to the effect that where technical features mentioned in any claim were followed by reference signs, those reference signs had been included for the sole purpose of increasing the intelligibility of the claims. Reference was made to Article 69(1) EPC, second sentence, in accordance with which "the description and the drawings shall be used to interpret the claims" and to the Protocol to the Article. The Board made it clear that it regarded any amendment to the application as a purely precautionary measure on the part of the Appellants. It was not satisfied that there was any real justification for the fears expressed about the attitude of the United Kingdom Courts to claims in European patents containing reference numerals.

IX. By letter dated 15 October 1985, the Appellant indicated willingness to put forward an addition to the text of the description for consideration by the Board, as suggested. The alternative of a footnote to the claims was, however, still suggested as it would then appear, with the claims, in all three official languages. Another minor amendment to the description, suggested by the Board, was also requested. The Appellant submitted further documents and

arguments in support of the contention that there was uncertainty amongst some British patent practitioners about the effect of reference signs on the interpretation of a claim.

- X. The Appellant originally requested oral proceedings before the Board. In the Statement of Grounds of the appeal, this request was restricted so as to apply only if the Board envisaged upholding the Decision to refuse the application and refusing to allow any amendment to save it. As the Board considered that it was able to allow amendment in order to save the application, no oral proceedings were appointed.
- XI. By a decision dated 24 March 1986, Mr. D.C.L. Blake, Superintending Examiner acting for the Comptroller-General of Patents, Designs and Trade Marks of the United Kingdom allowed an application by the present Appellants under Section 27, United Kingdom Patents Act 1977, to amend the specification of European patent (UK) No. 0 015 596 by inter alia deleting reference numerals from the claims. He dismissed an opposition to these amendments made by a third party, on the ground that the deletion of the reference numerals would not extend the protection conferred by the claims contrary to Section 76(2) Patent Act 1977 (which corresponds to Article 123 EPC). In the course of his decision, the Superintending Examiner reviewed the English case law referred to by the Opponent and concluded that the case law established that the presence in claims of reference numerals should be regarded as a helpful exemplification of the integers identified by words, imparting as the only restriction a definition of the integer which would not exclude the example. He considered that nothing in the Patents Act 1977 or in the Protocol on the interpretation of Article 69 EPC was inconsistent with the view that reference numerals do not limit the extent of

protection to the particular form of the features as illustrated. He further considered that Rule 29(7) EPC partly determined the extent of protection conferred by a granted European patent and, in his opinion, it was intended that Section 125(1) Patents Act 1977, which relates to the extent of protection conferred inter alia by a European Patent (UK), should be interpreted in such a way that the inclusion of reference numerals in claims does not limit the extent of protection. The Opponent did not appeal to the Patents Court of the High Court of Justice, so that the decision has now become final.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. Applying the principles of treaty interpretation expressly approved by the Enlarged Board of Appeal (in Cases Gr 01/83, 05/83 and 06/83: OJ EPO 1985, 60) it is clear that the provisions of Article 84 EPC, relating to claims, and those of Article 69 EPC, relating to the extent of protection, have to be considered together. When Article 84 EPC provides that the claims shall define the matter for which protection is sought and that they shall be clear and concise and supported by the description, it does so precisely because it is intended that the extent of protection conferred by a European patent or a European patent application shall be determined by what is in the claims, using the description and the drawings to interpret the claims, as is provided by Article 69(1) EPC and supported by the Protocol on the interpretation of that article.

3. Rule 29 EPC carries the matter further by requiring definition of the matter for which protection is sought in terms of the technical features of the invention (Rule 29(1) EPC), without reliance, except where absolutely necessary, on reference to the description or drawings (Rule 29(6) EPC).
4. Rule 29(7) EPC, on the other hand, provides that if the European patent application contains drawings, the technical features mentioned in the claims shall preferably, if the intelligibility of the claims can thereby be increased, be followed by reference signs. These reference signs shall not be construed as limiting the claims.
5. The purposes of the reference signs is to make the claims easier for all to understand - increased intelligibility - and it is plainly the duty of the Examining Division to consider, in the public interest, in every case in which a European patent application contains drawings, whether the use of reference signs in the claims can increase intelligibility. Contrary to submissions made in the Appellant's Statement of the Grounds of Appeal, such reference signs are not included merely to facilitate quicker understanding of the claims by the Examiner and, thereafter, become redundant so that they can be deleted. They do not limit the scope of a claim but they do affect its clarity and may enable it to be expressed more concisely than would otherwise be possible.
6. The present case provides a clear illustration of the value of reference signs in this respect. As noted above (para. (V), Claim 1, for example, is 30 typewritten lines long and refers to a large number of cooperating technical elements, identified more than 50 times by 38 reference signs. In its present form, including the reference signs, it is sufficiently clear to be allowed. Without the reference signs,

it would almost certainly have to be refused for lack of clarity, as not complying with Article 84 EPC, unless it were to be extensively redrafted, a kind of amendment which should certainly be avoided at a late stage in the application procedure.

7. The Board is, therefore, satisfied that the reference signs must remain in the claims if the European patent application is to be allowed to proceed to grant.

8. It has, however, considered the Appellant's submissions that difficulties of interpretation of the claims might arise in the United Kingdom if the reference signs remain in the claims. The Appellant has relied upon documents filed in the United Kingdom Patent Office proceedings referred to in para. XI above. The Board has not found anything in these documents which justifies the submissions of the Appellant in this respect and the decision of the Superintending Examiner appears to support the view that the fears of the Appellant may be wholly unfounded. Since, however, the matter has not been considered by the Patents Court, let alone by any higher national Court, the Board is prepared to allow the Appellant to amend the description of the European patent application in the manner previously suggested by the Board and requested in the Appellant's representative's letter dated 15 November 1985 so that the description contains, in particular, a statement as to the purpose of inclusion of the reference signs. In the present circumstances, the Board does not regard the inclusion of such a statement as "obviously irrelevant or unnecessary" within the meaning of Rule 34(1)(c) EPC: in this respect it takes a different view from that taken by the Examining Division.

9. The Appellant has alleged that there was a procedural violation, within the meaning of Article 113(1) EPC, by the Examining Division. It is objected that no reference was made to non-compliance with the provisions of Rule 86(3) EPC (requirement of consent of the Examining Division to amendments submitted later than in reply to the first communication) until the oral proceedings; that in those proceedings the matter of such consent was treated as of minor importance and then made an important element in the decision under appeal. The Board does not find the alleged violation of procedure to be established. The requirements of Rule 86(3) EPC must be presumed to be very familiar to every European professional representative, such that he must be expected to have them in mind when he submits amendments in circumstances to which they apply. Further, the minutes of the oral proceedings indicate that non-compliance with the requirements of Rule 86(3) EPC was specifically referred to by the Chairman of the Examining Division in his opening remarks, so that the Appellant's representative clearly had an opportunity and even an invitation to deal with the matter.

In these circumstances, the requirements of Article 113(1) EPC were fully satisfied.

Order

For these reasons,

it is decided that:

1. The decision of the Examining Division dated 9 May 1984 is set aside.
2. The case is remitted to the Examining Division with the order to grant the European patent applied for on the basis of the following documents:

- (a) Description as referred to in the advance Communication under Rules 51(4) and (5) EPC dated 4 August 1983 subject to the following amendments:
- i) amendments listed on page 2, lines 16-21, of the Appellant's representative's letter dated 15 October 1985,
 - ii) new page 12 (to replace previous page 12) accompanying the Appellant's representative's letter dated 15 November 1985,
 - iii) Statement submitted with the said letter of 15 November 1985 (to be inserted at the end of page 39 of the description as the final paragraph thereof),
- (b) Drawings as referred to in the said advance Communication,
- (c) Claims 1-13 as referred to in the said advance Communication.

The Registrar

The Chairman

J Ruckerl

G Korsakoff