

Publication in the Official Journal ~~Yes~~ / No

File Number: T 490/90

Application No.: 86 111 671.3

Publication No.: 0 257 124

Title of invention: Hydrogen sulfide removal

Classification: B01D 53/34

D E C I S I O N
of 12 March 1991

Applicant: ARI Technologies, Inc.

Headword: Clauses/ARI

EPC: Rules 27, 29, 31(1) (2)

Keyword: Clauses - Abandoned subject-matter - Claims fees

Headnote



**Europäisches
Patentamt**

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Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number : T 490/90 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 12 March 1991

Appellant :

ARI Technologies Inc.
600 North First Bank Drive
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Representative :

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Decision under appeal :

**Decision of Examining Division 031 of the
European Patent Office dated 15 March 1990
refusing European patent application
No. 86 111 671.3 pursuant to Article 97(1) EPC.**

Composition of the Board :

Chairman : E. Turrini
Members : C. Payraudeau
C. Black

Summary of Facts and Submissions

- I. By a decision dated 15 March 1990, the Examining Division refused the European patent application No. 86 111 671.3 published under No. 0 257 124.
- II. This application contains at the end of the description 41 "clauses" under the heading "Preferred features" and a set of 11 "claims" under the heading "Claims".
- III. The Receiving Section did not question that the clauses for which no claims fees were requested were part of the description and the patent application has been published with the clauses forming an integral part of the description.
- IV. In a first communication, the Examining Division objected to the presence of clauses in the application on the basis of Article 84 and of Rules 27 and 29 EPC and assuming that clauses 1 to 41 had been abandoned in accordance with Rule 31(2) invited the Appellants to comment and to cancel these clauses (referring in this respect to the decision J 5/87 of the Legal Board of Appeal).
- V. In their answer to this communication, the Appellants did not offer to cancel these clauses but only referred to the decision J 15/88 of the Legal Board of Appeal indicating that the reasons given in §9 of this decision "should be directly applicable to the present application" implying therefore that they requested the Examining Division to re-examine its position in view of the ratio decidendi of this decision.
- VI. The Examining Division then gave a decision refusing the application on the ground that it did not conform to Article 84, Rule 27 and Rule 29 because of the presence of

the clauses which were in fact claims and which therefore rendered the claims unclear.

VII. The Appellants filed an appeal against this decision requesting, as main request:

that the decision of the Examining Division be set aside;
that the preferred features (clauses) numbers 1 to 41, pages 29 to 37 (original version) of European patent application No. 86 111 671.3 be held not to be claims and, therefore, be held not to be abandoned in accordance with Rule 34(1) EPC;
that examination of European patent No. 86 111 671.3 be continued; and
that the Appeal fee be reimbursed.

Auxiliarily, they requested:

that, in the the event of the preferred features (clauses) numbers 1 to 41 on pages 29 to 37 of European patent application No. 86 111 671.3 being considered to be claims, the Appellants should be given an opportunity to either pay excess claims fees in respect of the preferred features (clauses) or abandon the subject-matter thereof.

They also required, in case the Board of Appeal intended to refuse all or part of this appeal, an opportunity to be heard, before an adverse decision is given.

VIII. In their statement of grounds the Appellants essentially submitted that:

- (i) the Examining Division, by not referring the case to the formalities section contrary to the Guidelines which provide that the formal matters should be

dealt with by the formalities section, committed a substantial procedural violation;

- (ii) according to Rule 31(1) EPC combined with Article 91(2) and Rule 41 EPC, the excess claims fees are payable within one month of the filing of the application but the non-payment of these fees is a deficiency which may be remedied by the applicants after they have been notified to do so by the Receiving Section (or as the case may be by the Examining Division);
- (iii) the fact that the Examining Division decided the case which needed the interpretation of two decisions of the Boards of Appeal without having been enlarged by the addition of a legally qualified member was also a substantial procedural violation;
- (iv) the "clauses" contained in the present patent application were identical to the "clauses" of case J 15/88 and an identical solution should have been applied;
- (v) the refusal of the Examining Division to apply the most recently established jurisprudence of the Boards of Appeal but instead to rely on an older decision was another substantial procedural violation;
- (vi) the Appellants had only cited the decision J 15/88 in their reply to the Examining Division's communication considering that in view of the almost exact correspondence of the two cases the Examining Division would reconsider the case. However the Examining Division had immediately given a decision which is based on a comparison of the decisions

J 5/87 and J 15/88, i.e. on grounds on which the Appellants had not been invited to comment and this was also a substantial procedural violation. This applied also to the objections relating to the clarity of the claims and description based on Article 84 and Rules 27 and 29 EPC which might have had some substance but on which the Appellants had not been given any opportunity to comment. This also constituted a substantial procedural violation.

- IX. In an intermediate communication the Board gave the provisional opinion that the Examining Division had been wrong in considering the "clauses" as claims which were then deemed abandoned because no claims fees had been paid for them.

On the other hand, the Board was of the opinion that none of the alleged procedural violations could be considered as substantial so that it did not appear that the conditions of Rule 67 EPC for the reimbursement of the fee for appeal were met.

- X. In answer to this communication, the Appellants withdrew their request for reimbursement of the appeal fee. They also conditionally withdrew their request for oral proceedings in the case that the Board issued a decision in agreement with the provisional opinion given in the communication of the Board.

Reasons for the Decision

1. The appeal is admissible.
2. The Legal Board of appeal in the decision on the claims incurring fees issue, J 5/87, referred to in the decision

under appeal, considered that an addendum to the description containing claims under the heading "The following part of the description are preferred embodiments 1 to 33 presented in the format of claims" were in fact claims which had therefore to be considered as abandoned when the corresponding claims fees had not been paid (Rule 31(1) and (2) EPC). However, the Legal Board of Appeal also decided in a series of further decisions (J 15/88, J 16/88, J 29/88, J 25/89, J 26/89, J 27/89, J 28/89 and J 34/89) that an addendum to the description containing "clauses", "items", "aspects", etc..., having otherwise the form and substance of claims, was not to be considered as a set of claims but as a part of the description.

3. The decision J 15/88 states in particular (points 8 and 9 of the Reasons):

The idea that there can be forced abandonment of subject-matter, in reliance on one Implementing Regulation (Rule 31(2) EPC) introduced in order to secure compliance with another (Rule 29(5) EPC, first sentence) appears to be rather in conflict with principles of higher law (cf. Article 164(2) EPC) which are to be deduced from Rule 31(1) EPC taken together with Article 123(2) EPC. An applicant normally has the right to derive subject-matter from any part of the description, claims or drawings as originally filed. It seems to the Legal Board of Appeal that any limitations of this right must be construed narrowly if they are to be regarded as legally valid. It follows that Rule 31(2) EPC must be applied carefully and within reasonable limits.

If an application as filed contains what can clearly be seen to be claims within the meaning of Article 84 EPC - a *fortiori* if they are included in a section identified as

containing claims and cross-refer to one another as claims - then it is reasonable to assume for the purpose of examination prior to search that those are the claims which the applicant wants and that matter which is contained elsewhere is not intended to be the claims, whatever may be its form or substance. Such an assumption will only not be reasonable if the other matter has the form and substance of claims and by its language the application shows an intention that the other matter should also be treated as claims (and even given special attention by the Search Division): this was the case in J 5/87. It is not so in the present case.

Although the 117 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 seventeen of the "clauses" (numbered 1, 19, 37, 55-64, 76, 94 and 105) have counterparts in the claims properly so called. It is not reasonable to be supposed that the Appellant intended those seventeen "clauses" to be claims: nor can those clauses 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 100 "clauses" have the nature of summarised preferred additional features.

4. The facts of the present case being practically identical with those of the case J 15/88, the reasons given in this prior decision which the present Board of Appeal makes its own, do apply to the present case.

Therefore, the Board is of the opinion that the Examining Division was not justified in requiring from the

Appellants that they abandon the subject-matter of the "clauses" on the ground that they were claims for which no claims fees had been paid.

5. On the other hand, it does not seem questionable that the present description of the patent application including the addendum ("clauses") does not satisfy the requirements of Rule 27 EPC. At this stage of the proceedings it is quite normal that the Examining Division requires from the Appellants that they put their application formally in order by cancelling the said addendum because the description with the addendum does not satisfy Rule 27 EPC, is unclear and contains obviously unnecessary matter. At this stage, it should not be detrimental to the application to satisfy this requirement insofar as this is not an abandonment of the subject-matter contained in the clauses.
6. In conclusion, the Board is of the opinion that the Examining Division was wrong in considering the addendum as claims which had been abandoned due to the non-payment of the corresponding claims fees, but that it could validly require from the Appellants the cancellation of this addendum without any loss of rights for them. There is therefore no need to examine the auxiliary request of the Appellants.
7. The decision under appeal is thus to be set aside.
8. Since the substantial examination of the patent application has not yet begun, the Board considers it appropriate to make use of its discretion to remit the case to the first instance for continuation of the examination procedure (Article 111(1) EPC).

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 on the basis of the application documents on file with the addendum considered as a part of the description.

The Registrar:

The Chairman:

P. Martorana

E. Turrini