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Aktenzeichen / Case Number / N<sup>o</sup> du recours : J 15/88 - 3.1.1

Anmeldenummer / Filing No / N<sup>o</sup> de la demande : 87 108 792.0

Veröffentlichungs-Nr. / Publication No / N<sup>o</sup> de la publication : 0 251 065

Bezeichnung der Erfindung: Enhanced production of antibodies utilising  
Title of invention: insolubilised immune complexes  
Titre de l'invention :

Klassifikation / Classification / Classement : C12P 21/00

**ENTSCHEIDUNG / DECISION**  
vom / of / du 20 July 1989

Anmelder / Applicant / Demandeur : NeorX Corporation

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Claims fees / NEORX

EPÜ / EPC / CBE R. 31, R. 29

Schlagwort / Keyword / Mot clé : "Claims fees - abandonment of Claims - examined  
prior to search"

**Leitsatz / Headnote / Sommaire**

1. An applicant normally has the right to derive subject-matter from any part of the description, claims or drawings as originally filed. 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 (abandonment of claims) must be applied carefully and within reasonable limits.

2. 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 his claims, whatever may be its form or substance.

3. Such an assumption will only not be reasonable if the other matter has the form and substance of claims and by his language the applicant shows an intention that the other matter should also be treated as claims.

Europäisches  
Patentamt

Beschwerdekammern

European Patent  
Office

Boards of Appeal

Office européen  
des brevets

Chambres de recours



Case Number : J 15/88 - 3.1.1

**D E C I S I O N**  
of the Legal Board of Appeal  
of 20 July 1989

**Appellant :** NeoRx Corporation  
410 West Harrison Seattle  
Washington 98119  
USA

**Representative :** Brown, John David  
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**Decision under appeal :** Decision of the Receiving Section  
of the European Patent Office  
dated 30 March 1988 refusing  
reimbursement of 117 claims fees.

**Composition of the Board :**

**Chairman :** P. Ford  
**Members :** F. Benussi  
O. Bossung

## Summary of Facts and Submissions

- I. European patent application No. 87 108 792.0 was filed on 19 June 1987 on behalf of the Appellant, a US Corporation. Priority was claimed from two earlier US applications.

As filed, the application contained a description, followed by a section headed "Preferred features of the invention" (consisting of 117 numbered "clauses") and a section headed "Claims", containing 13 claims.

On the filing date, the filing, search and designation fees were paid: in accordance with Rule 31(1) EPC, three claims fees were also paid on this date.

- II. On 7 August 1987 the Receiving Section wrote to the Appellant's representative pointing out that the examination by the Receiving Section prescribed in Article 91(2) EPC had disclosed that the fees for 117 additional "claims" annexed to the description had not yet been paid as required by Rule 31(1) EPC and, that if the claims fees for any claim were not paid in due time, the claims concerned would be deemed to have been abandoned in accordance with Rule 31(3) (now Rule 31(2)) EPC. In the opinion of the Receiving Section, the present application contained in fact a further 117 claims annexed to the description despite the fact that the Appellant had sought to describe them as "preferred features of the invention".

The Decision in Case J 05/87 dated 6 March 1987 (OJ EPO 1987, 295) was referred to, especially on the point that the rules on the form and content of the description and the claims (Rules 27 and 29 EPC) have to be duly observed

to ensure that the European patent system functions properly. Consequently the Appellant had to include the disputed "clauses" as claims in the application in order to maintain the possibility of making them a basis for substantive examination.

- III. The Appellant's representative responded with a telex received on 6 October 1987 (duly confirmed by letter) requesting that the notification of the Receiving Section of 7 August 1987 be withdrawn and that the additional 117 claims fees, paid under protest by him on 7 October 1987 in order to avoid a loss of rights, be refunded.

In his submission, the cited Decision J 05/87 was not applicable because the facts in the present case and in that case were different, particularly because in the present application the word "claims" did not appear in the section headed "preferred embodiments" and the present application did not include the statement that the preferred embodiments were "presented in the format of claims" as did the application in the cited case.

The representative further submitted that, in any event, identical sentences to those in question could have been presented as statements of invention in the introductory part of the specification and no claims fees could possibly then have been demanded.

- IV. On 3 March 1988, the Receiving Section issued a decision refusing the request to refund the claims fees paid in respect of the 117 "claims" on the basis (1) that it was always the substance of the text and not the form and the heading of a part of a patent specification which determined what that part was and (2) that Rules 27 and 29 EPC had to be applied.

An applicant was not at liberty to ignore those Rules and arrange his application in such a way as to effectively undermine the intention and provisions of the Implementing Regulations to the EPC with a view to circumventing Rule 31(1) EPC and the requirement to pay claims fees.

The application contained a total of 130 claims and therefore the 120 claims fees paid could not be refunded.

- V. The Appellant filed a Notice of Appeal and Statement of Grounds of Appeal on 27 May 1988 and the appeal fee was duly paid.
  
- VI. At the oral proceedings held on 8 March 1989, the Appellant's representative submitted that in the EPC there is no Rule which defines what has to be interpreted as a claim and that from Article 69 EPC it could be argued that claims cannot be put in the description, which is a different part of the application.

The present case was distinguishable from J 05/87.

The statements contained in the present application which had been considered by the Receiving Section as claims, were in fact only statements which could have been put in the earlier part of the description and therefore the EPO was not entitled to require the payment of claims fees for them.

Contrary to what the Receiving Section thought, the practice of including the substance of US claims, taken from a priority application, in the description of the European application, was not in any way intended to circumvent the requirement to pay claims fees.

The problem was that European professional representatives sometimes received an application of US origin so shortly before the last date for filing that it was difficult to make major changes to the text before filing and there was a grave risk that if the substance of the US claims were not repeated in the application as filed some subject-matter might be inadvertently but irretrievably omitted. The present case was an example. A representative who had sufficient time and opportunity -as he should with Euro-PCT applications - would revise the description to make it more suitable for European filing.

- VII. The Appellant's representative requested that the decision under appeal be set aside and that 117 claims fees be refunded.

#### Reasons for the Decision

1. The appeal is admissible.
2. The Board accepts the Appellant's representative's explanation of the reasons why the 117 "clauses" were included in the present application and that he had no intention of circumventing Rule 31 EPC as alleged or at all. However, the questions raised in the present case are not primarily concerned with subjective intention but with the intention to be deduced from the objective state of a patent application presented to the Receiving Section.
3. The present appeal raises problems which are the subject of several appeals pending before the Legal Board of Appeal. They merit careful consideration because they are evidently causing difficulties both for applicants and for the Receiving Section and Search Divisions of the EPO.

4. As was recognised by the Legal Board of Appeal in Case J 09/84 (OJ EPO 1985, 233), the purpose of requiring payment of claims fees (Rule 31(1) EPC) is not primarily fiscal but is intended to keep the number of claims within reasonable limits (cf. Rule 29(5) EPC) particularly for the purposes of the European search.
  
5. In Case J 05/87 (OJ EPO 1987, 295) the Board had to consider for the first time whether an addendum to the description of a European patent application, which consisted of 33 US claims, should be regarded as claims for the purposes of Rule 31(1) EPC. In the circumstances of the case, it was held that they were claims for which claims fees were payable. Two factors were taken into account, confirming the view of the Receiving Section, namely: (1) that the addendum appeared in form as well as in substance only to consist of claims within the meaning of Article 84 and Rule 29 EPC and, (2) that the addendum, identically corresponding to the claims of the US priority application, was included in order to maintain the possibility of making its content a basis for substantive examination. (In the Statement of Grounds of Appeal, the second point had been expressly admitted and it had been argued that the addendum did serve to facilitate the work of the Search Division).
  
6. An applicant who declines to pay claims fees when they are demanded runs the risk that features of a claim deemed to have been abandoned pursuant to Rule 31(2) EPC (numbered Rule 31(3) prior to the Decision of the Administrative Council of 5 June 1987, OJ EPO 1987, 276), which are not otherwise to be found in the description or drawings, cannot subsequently be reintroduced into the application and, in particular, into the claims. This point, strongly emphasised by the Appellant's representative in argument, is fully supported by the observations of Teschemacher in

Münchener Gemeinschaftskommentar, 7. Lieferung, Mai 1985, p. 70, para. 138.

7. 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 Article 52 (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.
  
8. 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 his 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 his language the applicant 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 05/87. It is not the present case.
  
9. 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 reasonably 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.

10. The reimbursement of DEM 7 605 paid as claims fees in respect of the 117 "clauses" is not excluded by Rule 31(2) EPC, second sentence, because the "clauses" in European patent application No. 87 108 792.0 were not "claims incurring fees", so that the fees paid were not due. They were wrongly demanded and must be reimbursed.

**Order**

**For these reasons, it is decided that:**

1. The contested decision is set aside.
2. Reimbursement of 117 claims fees of DEM 7 605 is ordered.

**The Registrar:**

J. Rückerl

**The Chairman:**

P. Ford