

Veröffentlichung im Amtsblatt	Ja/Nein
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	Oui/Non

Aktenzeichen / Case Number / N^o du recours : J 16/89 - 3.1.1

Anmeldenummer / Filing No / N^o de la demande : 86 905 604.4

Veröffentlichungs-Nr. / Publication No / N^o de la publication : WO8701374

Bezeichnung der Erfindung: Method and means for sorting and identifying
Title of invention: Biological information
Titre de l'invention :

Klassifikation / Classification / Classement : C07H 21/00

ENTSCHEIDUNG / DECISION

vom / of / du 7 March 1990

Anmelder / Applicant / Demandeur : Pieczenik, George

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

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

Europäisches
Patentamt
Beschwerdekammern

European Patent
Office
Boards of Appeal

Office européen
des brevets
Chambres de recours



Case Number : J 16/89

D E C I S I O N
of the Legal Board of Appeal
of 7 March 1990

Appellant : Pieczenik, George
61 West 62n Apt 11-6
New York, NY 10023
USA

Representative : Peter A. Rauh
Vossius & Partner
Siebertstraße 4
8000 München 80

Decision under appeal : Decision of the Receiving Section
of the European Patent Office dated
5 January 1989

Composition of the Board :

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

Summary of Facts and Submissions

- I. Euro-PCT application No. 86 905 604.4 (PCT/US/86/01796) was filed on behalf of the Appellant, a resident of the USA on 28 August 1986, claiming a US priority date of 28 August 1985.

- II. On 8 January 1987, the European Patent Office, acting as International Searching Authority, issued an invitation to the Appellant (who was at that stage represented by US attorneys) to pay additional search fees (Article 17(3)(a) and Rule 40.1 PCT) on the parent application, since in the Authority's opinion there was one invention in Claims 1 to 5 of the international application and there were 17 further inventions in the remaining Claims 6 to 80. The Appellant did not pay the additional search fees and consequently the International Search Report was drawn up for Claims 1 to 5 only. The Appellant's European professional representative submitted to the Board of Appeal at a very late stage that this non-payment constituted renunciation of the subject-matter of Claims 6 to 80 in the international phase so that only Claims 1 to 5 remained and determined the question of whether claims fees were payable on entry into the regional phase.

- III. Nevertheless, the A3 publication of the international application by WIPO contained 80 claims. Furthermore, on filing EPO Form 1200 on 27 July 1987, after entry into the regional phase, the Appellant's professional representative filed amendments to the application, namely:

additional pages 32 to 52 of the description, which contained the disclosure of the original 80 claims of the international application;

10 claims (pages 53 to 58).

- IV. After expiry of the time limit of Rule 104(b)(1) EPC, by a communication dated 15 September 1987, the Receiving Section invited the professional representative to pay claims fees within two months for "Claims 11-80" failing which the claims concerned would be deemed to be abandoned (Rule 31(2) EPC). (It added that the amended Claims 1-10 had been received on 27 July 1987 and would be passed to the Examining Division).
- V. There being no response to such invitation, the Receiving Section informed the representative on 25 January 1988 pursuant to Rule 69(1) EPC, that the "Claims 11-80" were deemed to have been abandoned, in accordance with Rule 31(2) EPC.
- VI. In reply, the representative, in his letter of 21 March 1988, expressed the belief that the Receiving Section's communication of 25 January 1988 had been issued in error and requested written confirmation that it was void.

The Receiving Section deemed this to be a request for a decision within the meaning of Rule 69(2) EPC, and gave the decision under appeal on 5 January 1989, holding its communication to be correct.

- VII. The Appellant's representative, in filing the Notice of Appeal on 14 March 1989 and presenting the Statement of Grounds on 16 May 1989 introduced arguments similar to those used in Cases J 15/88, J 16/88 and J 29/88.

- VIII. By communication dated 2 February 1990, this Board drew the attention of the professional representative to a previous decision rendered in Case J 9/84 "Claims fees/BURGESS", OJ EPO 1985, 233, in which it was held that the time limit for payment of any claims fees is determined not by the international application's date of filing, but by its date of transmittal under Article 22(1) or 39(1) PCT: cf. paragraph 5 of the Reasons for the Decision, which also stated: "As regards the amendment of claims and the claims fees payable, from the date of transmittal to the EPO the same applies to an international as to a European application."
- IX. At oral proceedings held on 7 March 1990, the Appellant's representative argued for the first time that the application contained only five claims on entry into the regional phase, for the reasons set out in paragraph II above. He complained that the Receiving Section had never made it clear to the Appellant that the real reason why the application was considered as containing 80 and not 10 claims on entry into the regional phase was that the filing of EPO Form 1200, in which amendments were requested, took place after entry into the regional phase and not simultaneously with it. Accordingly, the case had been decided and the appeal had been argued on the wrong basis, namely that it was a case like J 15/88, J 16/88 and J 29/88, when it was really different. He did not disagree with the Board's opinion that Case J 9/84 "Claims fee/BURGESS" (cited above) was correctly decided.

It would have been right and proper to draw the Appellant's attention to the fact that decisive for the falling due of claims fees is the number of claims present on expiry of the 20 month term of Article 22(1) PCT (Rule 104b(1) EPC) when the international phase is ended. However, it was incorrect to request claims fees by referring to items on new pages 33-52 of the description

that were incorporated into the description only with the amendment of 27 July 1987.

It was not in dispute that, upon entry into the national phase, according to Rule 104b(1) EPC, claims fees have to be paid according to the same rules as those which apply to a European patent application and that the set of claims which is before the EPO at the expiry of 20 months from the priority date is the relevant one.

The professional representative's first request was that the decision under appeal be set aside and that it be confirmed that pages 33-52 form part of the description. The professional representative also requested alternatively that either the decision under appeal be set aside and the Receiving Section be ordered to re-issue the invitation to pay claims fees, or (if the decision under appeal was not set aside) the Board should state that the claims considered abandoned can be prosecuted in a divisional application.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is admissible.
2. The decision under appeal made reference in its Summary of Facts to the application as published by WIPO having 80 claims at the beginning of the regional phase and to the Appellant's professional representative having filed amended documents together with EPO Form 1200 on 27 July 1987, but completely failed to appreciate the significance of this sequence of events, because it then went on to consider the amendments as if they had been part of the application at the beginning of the regional

phase. The resulting decision was, therefore, fundamentally erroneous and must be set aside on that ground.

3. The Appellant does not challenge the principle that the number of claims present at the date of entry into the regional phase is decisive for the calculation of additional claims fees but seeks to say that in the present case the situation was governed by the non-payment of additional search fees in the international phase. In the opinion of the Board, this argument raises novel questions, both of law and of Office practice, and should be considered first by the Receiving Section, for which reason the case should be remitted back.
4. Since there was a fundamental error in the procedure of the Receiving Section it is justifiable to order reimbursement of the appeal fee.

Order

For the above reasons, it is decided that:

1. The appeal is allowed and the decision under appeal is set aside.
2. The case is remitted to the Receiving Section for consideration of the question whether at the date of entry into the regional phase the application contained only five claims because additional search fees had not been paid in response to an invitation from the International Searching Authority.

3. The appeal fee is to be reimbursed.

The Registrar:

J. Lee

The Chairman:

Kevin Ford

01352

[Signature]

[Signature]