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Aktenzeichen / Case Number / N<sup>o</sup> du recours : J 34/89-3.1.1

Anmeldenummer / Filing No / N<sup>o</sup> de la demande : 87 310 780.9

Veröffentlichungs-Nr. / Publication No / N<sup>o</sup> de la publication : 274 232 A2

Bezeichnung der Erfindung: Arrangement of an A-type mast on a sailing boat  
Title of invention:  
Titre de l'invention :

Klassifikation / Classification / Classement :

**ENTSCHEIDUNG / DECISION**  
vom / of / du 30 January 1990

Anmelder / Applicant / Demandeur : Atkinson, Christopher et al

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPO / EPC / CBE Article 80, 84 Rule 27,29,31

Schlagwort / Keyword / Mot clé : "Number of claims incurring fees"

**Leitsatz / Headnote / Sommaire**

Europäisches  
Patentamt

Beschwerdekammern

European Patent  
Office

Boards of Appeal

Office européen  
des brevets

Chambres de recours



Case Number : J 34/89

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.1  
of 30 January 1990

**Appellant :** Atkinson Christopher et al.  
9625 Second Street  
Sidney British Columbia  
V8L 3C5 Canada

**Representative :** Muir, Ian Robertson  
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**Decision under appeal :** Decision of the Receiving Section of the European Patent Office, dated 12 February 1989, deeming certain parts of patent application No. 87 310 780.9 to have been abandoned.

**Composition of the Board :**

**Chairman :** P. Ford

**Members :** C. Holtz

J. Stephens-Ofner

### Summary of Facts and Submissions

- I. European patent application 87 310 780.9 was filed on 08.12.87 and published on 13.07.88 (Bulletin 88/28).
- II. The descriptive part of the application as published contains a section headed "PREFERRED ASPECTS OF THE INVENTION ARE DEFINED AS FOLLOWS:" (col. 9, line 15 to col. 12, line 50). In this section 36 different "aspects" in all are numbered separately.
- III. In a decision dated 12.02.89 the Receiving Section found the above mentioned "aspects" to constitute 36 patent claims and declared them to be abandoned, on the ground that the corresponding claim fees had not been paid.
- IV. The decision of 12.02.89 has been duly appealed. The Appellant requests that the Decision be cancelled and the abandoned matter be restored.
- V. In his submissions, the Appellant argues mainly as follows:  
The preferred aspects are not claims and are therefore not to be included in the search. It is expressly noted in the patent application that the applicant has refrained from claiming these aspects to be included in the scope of protection. Consequently, no claims fees are due.

### Reasons for the Decision

1. The appeal is admissible.
2. In several recent decisions (J 15/88, dated 20.07.1989, J 16/88, dated 18.08.1989, and J 29/89, dated 18.10.1989), the Legal Board of Appeal has decided that such parts of

the description of a patent application as are headed "preferred aspects", "preferred features of the invention" or some similar phrase, are not to be considered as patent claims, unless the applicant has shown his intention to have them included in the scope of protection of the patent.

In so finding, the Board noted that there was no conflict with the decision J 05/87, OJ 1987, p. 295, "Number of claims incurring fees/PHILLIPS", in which case it had been the stated intention of the applicant to have the aspects in question treated as patent claims.

3. The further reasoning in J 29/88 (paras 3-8) can be applied mutatis mutandis to the case at hand. Thus, in summary, the presence of what are unquestionably claims in a section headed "CLAIMS", as well as the express reference in column 12, lines 36-50, preceding that section to the applicant's restricting the claimed scope of protection "in accordance with the following claims" indicate that the intention of the applicant was to have the section of the description headed "PREFERRED ASPECTS ..." regarded as part of the description only and not as claims.
4. Consequently, the Board holds that the section headed "PREFERRED ASPECTS ..." is not to be treated as abandoned, but is and always has been a part of the description.

#### Order

For these reasons it is decided that

1. The decision under appeal is set aside.

2. It is declared that the section of the text of patent application 87 310 780.9 headed "PREFERRED ASPECTS OF THE INVENTION ARE DEFINED AS FOLLOWS:", col. 9, line 15 to col. 12, line 50, is and always has been part of the description.

The Registrar:

*J. He*

The Chairman:

*Peirland*

*26.01.90: C. My*

00295

*30.1.90*

*[Signature]*