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Aktenzeichen / Case Number / N^o du recours : T 407/86 - 3.5.1

Anmeldenummer / Filing No / N^o de la demande : 82 306 993.5

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Bezeichnung der Erfindung: Non-volatile semiconductor memory circuit
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement : G11C 17/00

ENTSCHEIDUNG / DECISION

vom / of / du 1 March 1988

Anmelder / Applicant / Demandeur : Fujitsu Limited

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Use of abstract in support of amended
claims/Fujitsu

EPO / EPC / CBE Articles 78, 85, 123(2), Rule 88

Kennwort / Keyword / Mot clé : "Use of abstract in support of amended claims
(denied)" - "Request for correction under
Rule 88 EPC of drawings refused"

Leitsatz / Headnote / Sommaire



Case Number : T 407/86 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 1 March 1988

Appellant : Fujitsu Limited
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Decision under appeal : Decision of Examining Division 067
of the European Patent Office
dated 6 June 1986 refusing European
patent application No. 82 306 993.5
pursuant to Article 97(1) EPC

Composition of the Board :

Chairman : E. Persson
Members : J. Van Voorthuizen
W. Riewald

Summary of Facts and Submissions

- I. European patent application No. 82 306 993.5 (publication No. 85 260) was filed on 30 December 1982 claiming priority from two separate Japanese applications filed on 29 December 1981 (J1 and J2). It was related to a non-volatile semiconductor memory circuit and contained three claims, Claims 1 and 3 being independent claims and Claim 2 being dependent on Claim 1.
- II. Having been communicated, inter alia, that in the view of the Examining Division the application did not meet the requirement of Article 82 EPC, since the groups of inventions (Claims 1 and 2, on the one hand, and Claim 3, on the other) were not so linked as to form a single general inventive concept and reminded of the possibility to file a divisional application, the applicant filed a new set of Claims 1-3, Claim 3 now being dependent on Claims 1 and 2.
- III. In a further communication, the Examining Division informed the applicant that the new dependent Claim 3, including features of independent Claims 1 and 3 as filed, introduced new subject-matter and that, therefore, the application did not comply with Article 123(2) EPC. It appears from the file that the added subject-matter, referred to by the Examining Division, was the combination of depletion-type MOS transistors used for coupling the gate of the memory cells to a bias circuit (as disclosed in original independent Claim 3) with the particular bias circuit characterising the semiconductor memory circuit disclosed in Claim 1.
- IV. In response to this communication and in order to overcome the objection under Article 123(2) EPC, the applicant made

a request under Rule 88 EPC for a correction of the drawings referred to in the application to the effect that numeral 20 appearing in the top left-hand corner of Figure 5 (relating to original Claim 3) be inserted onto the top left-hand corner of Figure 1 (relating to Claim 1). The omission of this reference numeral in Figure 1 of the present application was claimed to be due to a clerical error. Alternatively, it was submitted that the amendment of Claim 3 as such did not contravene Article 123(2) EPC, since the subject-matter covered by Claim 3 as amended was fully supported by the abstract (in particular its last sentence) forming part of the application as filed. It was also argued that the application as filed did provide a sufficient basis for the amended Claim 3, since a man skilled in the art would perceive the correspondence between the items in the top left-hand corners of Figures 1 and 5 and therefore read the description as requiring box 20 in Figure 5 to contain all the elements (of the bias circuit) appearing in the top left-hand corner of Figure 1. Thus, the applicant maintained the application as amended.

- V. In the decision under appeal the Examining Division refused the application pursuant to Article 97(1) EPC. The reasons given for the decision read as follows:

"1. Rule 88 EPC requires that a correction to the drawings filed on a European Patent Application must be obvious, in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.

Reference numeral 20 was included in Figure 1 of the Japanese priority document 56-211 398 (J1). However, reference numeral 20 was not included in Figure 1 of the Japanese priority document 56-213 401 (J2). Figure 1 of J2 corresponds to Figure 1 of the present

application so that it appears that the omission of reference numeral 20 is not due to a clerical error. Figure 1 of the present application is an embodiment of a non-volatile semi-conductor memory circuit which contains a bias circuit of the present invention (cf. page 3 of the description). This bias circuit is dealt with in J2 (but not in J1) so that the "omission" of reference numeral 20 was not necessarily a mistake, rather it appears totally plausible because the figure was taken from J2.

If reference numeral 20 was inserted onto Figure 1 of the present application, it would follow that the block marked 20 in Figure 5 would comprise the particular bias circuit 11, an embodiment of which is shown in Figure 4. While Figure 5 originates from J1, Figure 4 originates from J2. J1 and J2 being independent applications, it is evident that such combination of Figures 4 and 5 was never envisaged.

Hence, the priority documents do not provide evidence that nothing else would have been intended than what is offered as the correction, nor do the European application documents as filed (see below). As the conditions for application of Rule 88 are not satisfied the requested correction in accordance with the main request must be refused.

2. According to Article 85 the abstract shall merely serve for use as technical information, it may not be taken into account for any other purpose. In his letter of 08.04.86 the Applicant submits that in the present circumstances the abstract is being used to provide a source of technical information to support the wording of existing Claim 3. Thus, the Applicant uses the abstract for a purpose other than allowed by

Article 85, viz. for supporting the wording of Claim 3. In the light of Article 85 the abstract may not be used to justify the addition of new subject-matter to the claims, this being in line with current office practice (cf. Guidelines C-II, 2, last sentence).

3. As stated in the description to Figure 5, the same elements as in Figure 1 are denoted by the same numerals and symbols in Figure 5. This suggests non-correspondence between the items in the top left hand corners of Figures 1 and 5 since they are not denoted by same reference numerals. From Claim 3 as originally filed it is also clear that the bias circuit (20) in Figure 5, which figure this claim concerns, is not required to contain all the elements appearing in the top left hand corner of Figure 1, just as it is by no means required to contain the particular embodiment shown in Figure 4 and covered by present Claim 3. Neither the description, nor the claims or drawings as originally filed disclose the combination of the features contained in present Claim 1 and the characterising portion of Claim 3. Rather these features belong to two separate inventions.
4. Whilst Claims 1 and 2 would be allowable, the application as a whole has to be refused since Claim 3 introduces new subject-matter and does not therefore comply with the requirements of Article 123(2) EPC".

VI. The applicant, appealing against the decision of the Examining Division, requests that this decision be set aside and a patent be granted on the basis of the present application with the addition of reference numeral 20 (included in Figure 5) to existing Figure 1 of the drawings. In the event that this main request is rejected

by the Board of Appeal it is requested that the case be remitted to the Examining Division with the instruction to grant a patent on the basis of existing Claims 1 and 2.

VII. In the statement setting out the grounds of appeal the appellant, emphasising that the abstract does form part of the European patent application according to Article 78(1)(e) EPC, submits, in essence, that the technical information contained in the abstract forms part of the subject-matter of the application as a whole and that such subject-matter - without conflicting with Article 123(2) EPC - may be transferred from one part of the application to the other, i.e. from the abstract to the "specification" or to the claims. It is further submitted that, in the present case, the abstract is not being used for interpreting the scope of protection sought for by Claim 3, which would be contrary to Article 85 EPC, but purely as technical information forming part of the application as filed and disclosing the subject-matter of (amended) Claim 3. This technical information clearly relates to the combination of a particular bias circuit with a depletion-type MOS transistor for coupling the gate of the memory cell transistor to the bias circuit, which combination the Examining Division is alleging not to be contained in the application as filed. As to the reference in the decision under appeal to the Guidelines C-II, 2, last sentence, according to which the abstract may not be used to justify the addition to the description of new subject-matter, this part of the Guidelines is, in the appellant's view, not supported by Article 85 EPC or by any other Article or Rule of the EPC. Apart from the fact that the Guidelines as such do not have the binding authority of a legal text, it is submitted that the said part of the Guidelines is in direct conflict with the EPC itself and as such ultra vires. Thus, the technical information contained in the abstract can, in the appellant's view, be used to

justify the addition of subject-matter to the description or the claims.

In the alternative, the appellant requests correction under Rule 88 EPC of Figure 1 of the drawings to include the reference numeral 20 (in Figure 5) referring to the elements shown in the top left-hand corner of Figure 1. In support of this request the appellant argues, inter alia, that it is very common for a single European patent application to be filed claiming priority from a number of earlier Japanese patent applications and for this single European application to seek to protect at least one of the aspects claimed in the earlier Japanese applications independently and also to protect the combination of elements claimed in the earlier Japanese applications. The appellant does not accept that the fact that these independent elements are protected separately in the earlier Japanese applications provides a reliable indication of the intention of the appellant when filing the present European application. It is submitted that, in the present technical context and having regard to the last sentence of the abstract, the correction asked for is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction. Thus, the requirements for the application of Rule 88 EPC are satisfied.

Reasons for the Decision

1. The appeal is admissible.
2. The arguments presented by the appellant in his Grounds of Appeal are essentially the same as those which were presented by him to the Examining Division. In the Board's view the reasons given by the Examining Division for

refusing the application (cf. paragraph V above), which took due account of these arguments, were correct and still hold good even against the arguments presented in support of the appeal. They are therefore endorsed by the Board. However, with respect to the legal status of the abstract the Board wants to add the following.

3. Although, as submitted by the appellant, the abstract forms part of the contents of the European patent application in accordance with Article 78(1)(e) EPC, it is to be noted that due to the very restricting provisions of Article 85 EPC there is a clear legal difference between the abstract, on the one hand, and the description, the drawings (if any) and the claims (Article 78(1)(b), (c), (d) EPC), on the other. In fact, only the latter parts of the application are to be considered as constituting the substantive contents of the European patent application to be taken into account for the purpose of judging what subject-matter is contained in the application as filed. Thus, it has to be concluded that for the purpose of Article 123(2) EPC "the content of the application as filed" does not include the abstract.

This interpretation is in conformity with a recent decision of the Technical Board of Appeal 3.4.1 dated 11 January 1988 in case T 246/86 (to be published). Cf. also the decision of the Technical Board of Appeal 3.5.1 dated 9 December 1987 in case T 260/85 (to be published), paragraph 3 of the reasons for the decision.

4. It follows from paragraphs 2 and 3 that the appellant's main request has to be rejected.
5. There can be no objection to remitting the case to the Examining Division for further prosecution in accordance with the appellant's subsidiary request.

Order

For these reasons, it is decided that:

1. The appellant's main request (to grant a patent on the basis of the present application with the addition of reference numeral 20 to existing Figure 1 of the drawings), including the request for correction under Rule 88 EPC, is rejected.

2. Setting aside the decision under appeal the Board remits the case to the Examining Division for further prosecution of the application on the basis of Claims 1 and 2.

The Registrar:

G. Fabiani

The Chairman:

E. Persson