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D E C I S I O N
of 10 June 1998

Case Number: T 0596/97 - 3.2.4

Application Number: 94116245.5

Publication Number: 0648939

IPC: F04D 29/66

Language of the proceedings: EN

Title of invention:
Centrifugal fluid machine

Applicant:
Hitachi, Ltd.

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 82, 84, 113(1)
EPC R. 29(2), (4), 51(3), 67, 68(2)

Keyword:
"Plurality of independent claims - conciseness"
"Decision to refuse - lack of reasons"
"Substantial procedural violation - reimbursement of appeal fee"

Decisions cited:
T 0079/91, T 0300/89

Catchword:
-



Case Number: T 0596/97 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 10 June 1998

Appellant:

Hitachi, Ltd.
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Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 3 February 1997
refusing European patent application
No. 94 116 245.5 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: C. A. J. Andries
Members: M. G. Hatherly
J. P. B. Seitz

Summary of Facts and Submissions

- I. On 1 April 1997 the appellant (applicant) lodged an appeal against the decision of the examining division dispatched on 3 February 1997 to refuse the European patent application No. 94 116 245.5 (publication No. 0 648 939) for lack of conciseness due to 15 independent claims. The appeal fee was paid simultaneously and the statement of grounds of appeal was received on 23 May 1997.
- II. The appellant argues that the decision to refuse was taken prematurely without giving him a possibility to discuss further the subject-matter of the application and that the decision relied upon an allegation for which no reasons were given.
- III. The appellant's **main request** and **first auxiliary request** are for the examining division's decision to be set aside, the application to be remitted to the examining division for further prosecution, the appeal fee to be reimbursed, and auxiliarily oral proceedings.

The pages of the patent application for the **main request** are:

- claims 1 to 18 filed with the statement of grounds of appeal of 23 May 1997,
- description pages 1, 1a, 2 to 4, 8 to 29 and 32 filed with the statement of grounds of appeal of 23 May 1997,
- description pages 30 and 31 filed with the letter of 9 March 1998, and

- drawings pages 1/19 to 19/19 (Figures 1 to 24) filed with the statement of grounds of appeal of 23 May 1997.

The pages of the patent application for the **first auxiliary request** are those filed with the letter of 9 March 1998.

Reasons for the Decision

1. The appeal is admissible.
2. There are 18 claims in the present main request.

Claim 11 includes all the features of either claim 1 or claim 5 or claim 9 (claims 5 and 9 being themselves dependent on claim 1). Thus, although unusually worded, claim 11 is a dependent claim and is therefore unobjectionable on grounds of a lack of conciseness due to too many **independent** claims. It can be added that the reader will quickly realise that the scope of claim 11 is narrower than that of claim 1 and so claim 11 will cause him no undue extra burden in determining the widest scope of protection sought.

Thus it is clear that claims 3, 5 to 13 and 15 of the main request are dependent claims while claims 1, 2, 4, 14, 16, 17 and 18 are independent claims.

3. The board of appeal in decision T 79/91 (unpublished but referred to in the second edition of "Case Law of the Boards of Appeal of the EPO") stated that lack of clarity of the claims as a whole could arise from lack of conciseness. The invention in that case had been set out in at least ten independent claims of different scope. The board believed this presentation made it

difficult, if not impossible, to determine the matter for which protection was sought, and placed an undue burden on others seeking to establish the extent of the monopoly.

In section 2.3 of this decision T 79/91 the board went even further, stating that *prima facie* even six independent claims seemed too many, while adding that each case had to be judged on the adduced facts and arguments, e.g. whether convincing reasons were presented for the allowability of these six claims.

4. The board in the present case also considers that **prima facie** seven independent claims in the present application for the main request could be undesirable for reasons of conciseness and clarity and therefore could even be unallowable. However the final decision on the allowability cannot be answered on a *prima facie* basis in isolation but only having regard to the circumstances of this particular case.

5. Independent claim 4 of the main request reads "Use of a centrifugal fluid assembly according to claim 1 in a barrel type centrifugal fluid machine comprising said casing as an inner casing (1) within an outer casing (1b)."

Once the reader has determined the scope of claim 1 of the main request, the extra effort needed to determine the scope of claim 4 is not unreasonable. Claim 4 is moreover a claim in a different category to that of all the other claims.

Thus the board does not object to claim 4 of the main request (on grounds of lack of conciseness of the set of claims).

6. There remain to be discussed the 6 independent **device** claims 1, 2, 14, 16, 17 and 18 of the main request.

Claims 1, 2, 14, 16 and 18 have almost identical pre-characterising portions, the only difference being that claims 14, 16 and 18 refer to "impeller vanes" and "diffuser vanes" in the plural whereas claims 1 and 2 are more general in referring to "at least one impeller vane" and "at least one diffuser vane".

The pre-characterising portion of claim 17 adds one feature (a fitting portion) to the pre-characterising portion of claim 1 but omits some of the latter's features. These omitted features (an impeller vane trailing edge and a diffuser vane leading edge) however then appear in the characterising portion of this claim 17.

There is a certain amount of overlapping in the characterising portions of the independent device claims as well, in that the first half of the characterising portion of claim 14 is also to be found in claims 16 and 18.

Nevertheless, while their features overlap, none of these six independent device claims of the main request includes all the features of another of the six. There is no undue repetition of wording between claims that could be avoided by the use of the dependent form, i.e. none of these claims could be made dependent on another.

7. The invention is based on the configuration of and the relationship between the leading edge of a diffuser vane and the trailing edge of an impeller vane. The configurations and relationships are defined by the characterising portions of the six independent device claims of the main request.

Each of these six claims is concise in itself. If it is to be argued that the number is to be reduced from six, then there has to be a reasonable way of doing so.

Starting with the first two independent device claims, the definition of the impeller vane trailing edge 7 and the diffuser vane leading edge 8 in claim 1 reads onto the arrangement shown in Figure 2 whereas the corresponding definition in claim 2 reads onto the arrangement shown in Figure 7.

The board considers it acceptable for the applicant to be trying to protect both these arrangements in the same application so to demand that one of the claims 1 and 2 be simply deleted would be unreasonable.

It seems to the board that an attempt to redraft these two claims 1 and 2 as a single claim might not be advantageous.

Obviously one might draft a single claim with the common pre-characterising portion followed by the two characterising portions of the present claims 1 and 2 quoted en bloc and presented as alternatives (so in effect there would remain two independent claims). This would only **seem** to reduce the number of independent claims and would not significantly reduce the burden upon the reader. It must be borne in mind that the reason for the claims being concise is to make the reader's task in understanding their scope manageable. A reduction in the number of the claims with no easing of the reader's task is merely a cosmetic change.

Alternatively, one might attempt to generalise the claim to apply to both arrangements. However this would give rise to an objection under Article 123(2) EPC if there was no basis in the originally filed application for such a generalisation. Moreover while the

specifically claimed subject-matter of the present claims 1 and 2 of the main request might be novel and inventive, this might not be the case for the generalised subject-matter of the combined claim.

Thus it is not immediately apparent to the board how claims 1 and 2 could be presented meaningfully as a single claim.

Extending this reasoning, it is also not immediately apparent to the board how the number of the other independent device claims of the main request could be reduced, other than by simply deleting claims.

8. It may be that, on closer reflection, it will be realised that the number of independent claims can indeed be reduced. However this will only occur in the course of the examination proceedings that is to be carried out by the examining division (and not by the board). Some of the present independent claims (and perhaps the arrangements they aim to cover) may turn out to be unallowable for other reasons, such as lack of unity of invention (Article 82 EPC) or lack of novelty or inventive step of their subject-matter (Articles 52(1), 54 and 56 EPC).

Nevertheless, in the present case and at the present opening stage of the examination proceedings, the board finds the presence according to the main request of the six independent device claims and the one independent use claim to be acceptable in relation to the nature of the invention the applicant seeks to protect.

The board repeats that this finding is a finding specific to **this** patent application at **this** stage of the proceedings and stresses that the finding is **not** to be considered as justifying similar numbers of independent claims in other cases.

9. It is observed that, in accordance with Rule 86(3) EPC, an applicant may, of his own volition, amend once but that he may make no further amendment without the consent of the examining division. In view of the reasons given by the board for allowing the plurality of independent claims at this stage of the proceedings, the board considers that the examining division would be entitled to refuse consent were the applicant to resile from his present main request by introducing new independent claims, broadening the scope of the existing independent claims or amending the dependent claims, in a manner not necessitated by an objection from the examining division.

10. *Reimbursement of the appeal fee*

10.1 The primary examiner's communication of 19 July 1996 included the following sections:

"1.1 The various definitions of the invention given in independent claims 1-7, 10-15 and 18-27 are such that the claims as a whole are not concise, contrary to Article 84 EPC. The claims should be recast to include only the minimum necessary number of independent claims, Rule 29(2) EPC, with dependent claims as appropriate, Rule 29(4) EPC. In the present case it is considered appropriate to use only one independent claim."

"1.2 Should there be more than one independent claim at the next stage of the proceedings, then care should be taken that the requirements of Article 82 and Rule 30 EPC, concerning unity of invention, are met."

10.1.1 Of course it might be possible for an invention to be of such a character as to justify a large number of independent claims but in the present application the number of independent claims at this stage was so large at 23 as to make it probable that the set of claims was not concise. Nevertheless, without some sort of analysis of the independent claims and some sort of reasoning, the examining division's objection of lack of conciseness was merely an allegation (see in this respect Rule 51(3) EPC: "reasoned statement").

Moreover, while the primary examiner stated that **in the present case** it was considered appropriate to use only one independent claim, he did not explain **why** he considered this so in the present case and did not, for example, suggest how this might be achieved.

The primary examiner then implied that more than one independent claim would be possible if care was taken to satisfy unity of invention. Indeed he specifically referred to Rule 29(2) EPC that states that "Subject to Article 82 (unity of invention), a European patent application may contain two or more independent claims in the same category (product, process, apparatus or use) where it is not appropriate, having regard to the subject-matter of the application, to cover this subject-matter by a single claim."

10.2 The applicant's reply of 17 January 1997 enclosed new pages of the patent application and included the following statements:

- "In view of item 1.1 of the office communication the number of independent claims was reduced by rewording from 23 to 14, thereby taking into account the explanations of items 1.2 and 3 of the office communication."

- "Regarding the unity of the application it is stated as follows: Fluid flows having left the impeller will not reach an inlet or inlets of the impeller vane or vanes at the same time but gradually (or with a time lag) reach such inlet or inlets between the front shroud side and the main shroud side to thereby reduce noises caused by collision of fluids. In this connection, the invention forms a single concept to provide a unity of invention."

- "As an auxiliary measure an interview is asked for."

10.2.1 Thus the applicant was attempting to meet the primary examiner's objections, by reducing the number of independent claims and by setting out the single concept of the invention to justify the presence of more than one independent claim.

10.3 Section 3 of the "Facts and Submissions" of the examining division's decision states that:

"In a first communication dated 19/07/96 the applicant was informed that the claims of the application did not meet the requirements of Article 84 EPC due to there being too many independent claims."

The whole of the "Reasons for the decision" reads:

- "1. The application does not meet the requirements of Article 84 and Rule 29(2), (4) EPC.

2. In the first communication dated 19/07/96 the applicant was informed that the claims of the application did not meet the requirements of Article 84 and Rule 29(2), (4) EPC due to there being too many independent claims and this not

being concise. In fact there were 23 independent claims at this stage. In the letter of reply dated 17/01/97 the applicant filed amended claims containing 15 independent claims. Arguments were not brought forward with respect to the objection of conciseness of the first communication, and no justification of the necessity of this manner of claiming was made. Having 15 independent claims is not considered to be a concise manner of claiming in the present case and the requirements of Article 84 and Rule 29(2), (4) EPC are not met.

3. As a result of the above objection, the application is refused pursuant to Article 97(1) EPC."

10.3.1 Thus the decision stated that "15 independent claims is not considered to be a concise manner of claiming in the present case" but gave no reason for this finding, so the finding remained merely an allegation. The examining division stated that the applicant had not brought forward arguments with respect to the objection of conciseness of the first communication but overlooked the fact that this communication had not given any specific arguments for the objection of lack of conciseness in the present case. Moreover the communication had implied that a plurality of independent claims would be allowable provided unity of invention was present. In reply the applicant had explained why unity of invention was present and the examining division at no time made an objection to unity of invention.

- 10.4 Thus the board considers that the decision's finding of lack of conciseness of the claims of 17 January 1997 was not reasoned, contrary to Rule 68(2) EPC that lays

down that decisions of the EPO that are open to appeal shall be reasoned. Accordingly the board finds that the examining division committed a substantial procedural violation.

- 10.5 At this point the board must emphasise that it has not decided that the objections to the presence of 23 or 15 independent claims in the patent application were necessarily wrong but that it merely considers that the reasons for the objections were not given.

It is within the discretion of the primary examiner, when faced with a large number of independent claims in the originally filed patent application, to object under Article 84 EPC in very general terms in a first communication, in the hope that the applicant will respond by reducing this large number. Moreover the board recognises that the examining division has the discretion to refuse an application after only one communication so long as the decisive reasoned objection against the grant of a patent remains the same.

However, according to Article 113(1) EPC, the decision may only be based on grounds or evidence on which the applicant has had an opportunity to present his comments. Thus here, since the decision to refuse must be reasoned and since the examining division could not simply add to the decision the specific reasons that it had not already given in the first communication, the examining division was not in a position in the present case to decide immediately after the first communication and thus should have continued with the examination.

While refusal of a request for **oral proceedings** normally constitutes a substantial procedural violation, it is for the examiner's discretion to decide whether to allow a request for an **interview**, bearing in mind the particular circumstances of the case, see section 9.3 of decision T 300/89 (EPO OJ 1991, 480). Not to grant the interview auxiliarily requested in the applicant's letter of 17 January 1997 therefore in itself was not a substantial procedural violation.

Nevertheless if the examiner had at least telephoned the applicant before the decision to refuse was taken there might well have been an overall saving in time and effort on the part of both the applicant and the EPO (even if not on the part of the primary examiner himself).

- 10.6 According to Rule 67 EPC the appeal fee is to be reimbursed where the board considers the appeal to be allowable, if reimbursement is equitable by reason of a substantial procedural violation.

For the reasons given in sections 10.4 and 10.5 above, the board considers that the examining division committed a substantial procedural violation in the proceedings leading up to the refusal of the application and that it is equitable to reimburse the appeal fee.

11. Since the appellant's main request can be allowed completely, the first auxiliary request does not need to be considered.

Order

For these reasons it is decided that:

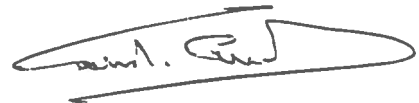
1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of the documents of the main request:
 - claims 1 to 18 filed with the statement of grounds of appeal of 23 May 1997,
 - description pages 1, 1a, 2 to 4, 8 to 29 and 32 filed with the statement of grounds of appeal of 23 May 1997,
 - description pages 30 and 31 filed with the letter of 9 March 1998, and
 - drawings pages 1/19 to 19/19 (Figures 1 to 24) filed with the statement of grounds of appeal of 23 May 1997.
3. The request for reimbursement of the appeal fee is allowed.

The Registrar:



N. Maslin

The Chairman:



C. Andries

