

entering the European phase the corresponding provisions are R. 110 EPC 1973 and R. 164 EPC.

The Legal Board ruled in case J 9/84 (OJ 1985, 233) that R. 31(1) EPC 1973 was to be interpreted as meaning that claims numbered 1 to 10 upon filing of the European patent application – or transmittal to the EPO of the international application under the PCT – were exempt from fees, and that claims numbered 11 onwards were not. Accordingly, abandoning a fee-exempt claim after filing – or transmittal – did not have the effect that its fee exemption was transferred to another claim.

8.1. Number of claims

The question has arisen on a number of occasions as to whether part of, or an annex to, the description of a European patent application comprising a series of numbered paragraphs drawn up in the form of claims should be regarded as claims for the purposes of R. 31(1) EPC 1973.

In J 5/87 (OJ 1987, 295) the application contained, under the heading "Claims", ten claims; however it contained 33 further claims which were annexed to the description as preferred, numbered embodiments presented in the form of claims. The addendum appeared in form as well as in substance only to consist of claims within the meaning of Art. 84 and R. 29 EPC 1973. Furthermore, the appellant had admitted that the addendum had been included in the application in order to maintain the possibility of making its content a basis for substantive examination. As a result, the applicant was required to pay the claims fee – applicants were not at liberty to ignore the provisions on the form and content of the description and claims contained in R. 27 and R. 29 EPC 1973.

In J 15/88 (OJ 1990, 445) the Legal Board decided in a similar case that although the 117 disputed "clauses" in question were numbered and arranged as claims and seemed to define matter in terms of technical features, they were not to be regarded as such since the fact remained that they were never referred to as claims and there were claims elsewhere which were referred to as such.

Decisions J 16/88, J 29/88, J 25/89, J 26/89, J 27/89, J 28/89, J 34/89 and T 490/90 all confirmed this opinion, pointing out that the case dealt with in J 5/87 differed from the others since the applicant had indicated an intention to regard the annexes as claims. The intention of the appellant not to have this part considered as claims is more important than the form of the text.

8.2. No refund of claims fees

In J 3/09 the Legal Board rejected the appellant's request for a refund of the claims fee for claims 16-68 and noted that the legal basis for payment of those claims was R. 110(1) EPC 1973. It added that fees, once validly paid, were not refundable unless provision to the contrary was made (see also J 11/12). The appellant had not relied on any specific provision of the EPC in its support. In response to the appellant's argument that it was inevitable that the subject matter of the unsearched claims could not be prosecuted