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**D E C I S I O N**  
**of 21 March 2002**

**Case Number:** J 0004/00 - 3.1.1

**Application Number:** 97...

**Publication Number:** -

**IPC:** ...

**Language of the proceedings:** EN

**Title of invention:**

...

**Applicant:**

...

**Opponent:**

-

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 94

EPC R. 85, 88, 104b

**Keyword:**

-

**Decisions cited:**

J 0012/82, J 0025/92

**Headnote:**

A request for examination under Article 94 EPC requires, over and above payment of the examination fee, that the underlying intention of an applicant that its application proceed to examination is manifested in a written statement made by the applicant or its representative addressed to the Office and received there in time. While this requirement is quite distinct from that of payment of the examination fee, there is no prescribed form of words for a request for examination which (as here) can be contained in the same document (here, a telex) as a debit order or other payment instruction. To qualify as a request for examination, the only reasonable interpretation in the circumstances of the case of the text filed with the Office must be that the applicant thereby wanted to inform the Office that it wish to have the application examined pursuant to Article 94 EPC.



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Boards of Appeal

Chambres de recours

**Case Number:** J 0004/00 - 3.1.1

**D E C I S I O N**  
**of the Technical Board of Appeal 3.1.1**  
**of 21 March 2002**

**Appellant:** N.N.

**Representative:** N.N.

**Decision under appeal:** Decision of the Receiving Section issued on 3 August 1999 that the application is deemed to be withdrawn due to the late request for examination pursuant to Article 94 EPC.

**Composition of the Board:**

**Chairman:** J.-C. Saisset  
**Members:** C. Rennie-Smith  
R. T. Menapace

## Summary of Facts and Submissions

- I. This appeal concerns Euro-PCT patent application 97 ... which derives from International application PCT/US97/... filed on ... 1997 and claiming priority from US 08/... of ... 1996. In the absence of any steps taken as regards entry into the regional phase, communications pursuant to Rules 85a(1) and 85b EPC were sent to the applicant on 22 April 1998 setting a time limit of one month.
- II On 22 May 1998, the last day of that time limit (Rule 78(2) EPC as then worded), the applicant's representative sent a telex to the EPO marked "For the attention of the cash and accounts department" and stating "Please debit the following fees from our deposit account" and then, after giving the number and name of that account, identifying the application by its number and the applicant's name and listing a number of fees to be debited including "Surcharge for examination DEM 1400.00" and "Examination fee DEM 2880.00". All the listed fees were deducted from the nominated account on the same date, 22 May 1998. A letter from the representative, bearing the same date of 22 May 1998 but sent by fax on 27 May 1998, referred to the communications of 22 April 1998 and enclosed a copy of the telex "by way of confirmation" and a completed Form 1200, also dated 22 May 1998, which includes a pre-crossed box in section 4 headed "Request for examination". A further letter, both dated and faxed on 27 May 1998, expressed the opinion that the necessary steps had been taken to prevent the application being deemed withdrawn and giving reasons therefor which are substantially the same as the arguments advanced in this appeal.

III On 24 June 1998 the Receiving Section issued a communication pursuant to Rule 69(1) EPC saying no written request for examination was filed within the time limits specified in Rules 104b(1) (as then worded) and 85b EPC. The representative replied by a letter of 24 August 1998 asking for a written decision, submitting that any finding that the application be deemed withdrawn be set aside as issued in error and observing that no reply had been received to the letter of 27 May 1998. The Receiving Section replied in turn by a letter of 15 February 1999 which gave reasons (substantially those in the decision under appeal) for its view that no valid request for examination had been made in time and setting a two month period for the representative to say whether she maintained her request for a decision. This was done by a letter of 14 April 1999 and the decision under appeal was issued on 3 August 1999.

IV On 1 October 1999 the applicant (hereafter "the appellant") filed a Notice of Appeal by fax. The appeal fee was paid on 30 September 1999. Grounds of Appeal were subsequently filed on 2 December 1999.

V The Receiving Section's reasons for deciding that no valid written request for examination was filed in time can be summarised as follows.

(a) The telex of 22 May 1998 did not constitute a written request for examination and could not be seen, as the appellant had submitted, as unequivocally conveying the written message that the applicant requested the EPO to examine the identified application. Although the examination fee and surcharge were paid in time, the written request was only received in Form 1200 on 27 May 1998.

- (b) Article 94 EPC requires both a written request and a fee to be paid in time. Fulfilling one of these conditions in time does not avoid the need for compliance with the other condition. Payment of the fee could be interpreted as a mere intention to request examination but cannot be a substitute for such a request. This followed from decision J 12/82 (OJ EPO 1983, 221).
  
- (c) While use of Form 1200 (for Euro-PCT applications) is not obligatory (unlike the corresponding Form 1001 for European applications), Form 1200 is recommended to ensure any kind of request is unequivocal or clear which was not the case with the telex.

The appellant's request to correct an obvious error in the telex under Rule 88 EPC could not be allowed. No reasons for this view were given.

The request in the representative's letter of 27 May 1998 to be informed of any deficiency in the examination request in accordance with the good faith principle referred to in decision J 25/92 (not published in OJ EPO) could not be met since it was made after the due date of 22 May 1998 and, even if made on the due date, would have allowed no time for an answer.

VI The appellant's arguments in the appeal can be summarised as follows:

- (a) Article 94 EPC, which does not specify any particular wording for a request for examination, is satisfied if a clear written indication is given that an applicant desires examination. The

telex of 22 May 1998 provided this. Decision J 12/82 can be distinguished from the present case since, in that earlier case, no written communication actually reached the EPO in time.

- (b) It is misleading to suggest that use of Form 1200 is optional if it is in fact treated as containing an essential requirement.
- (c) It is wrong to suggest that the good faith principle can only be applied in certain cases. In the present case the duty of good faith arose when compiling Form 1200 and the relevant guidelines and notes and was breached by treating that form variously as optional and essential.
- (d) The principle of good faith should apply in the present case even if, as the Receiving Section decision suggests, the relevant time limit had expired.
- (e) A written request for examination is deemed to have been filed in any Euro-PCT case. Such a request is integral with the Request for Grant Form 1001 which is compulsory for a European application which a Euro-PCT application is deemed to be by Article 150(3) EPC. Thus a written request for examination was deemed to be filed when the PCT application designating the EPC was itself filed.
- (f) Correction of the telex under Rule 88 EPC to add the words "Examination is requested" should have been allowed. The request for correction was made in sufficient time that no third parties would have been affected if it had been allowed when made. No reasons for refusal of this request had been given.

VII The appellant's main request is that:

- (a) the decision under appeal be set aside,
- (b) the written request for examination be deemed to have been filed in time,
- (c) the communication of 24 June 1998 noting a Loss of Rights be cancelled and
- (d) that the application be allowed to proceed and be remitted for search and examination.

A further request for reimbursement of the appeal fee was withdrawn following a communication from the Board of 12 November 2001. Auxiliary requests were made for oral proceedings if the main request could not be granted and for refund of all fees paid if the main request should not be granted whether after oral proceedings or not.

### **Reasons for the Decision**

1. The appeal is admissible.
2. The key issue in this case is the construction to be placed on the telex of 22 May 1998. If this was sufficient to constitute a written request for examination, Article 94 EPC has been complied with and the appeal must succeed. In that event, the appellant's other arguments become unnecessary. The same question of construction would also effectively dispose of the Rule 88 EPC request since, if a mistake is apparent in



the telex which calls for the proposed correction (to add the phrase "Examination is requested"), then the meaning of the telex as it stands would be such as at least to suggest examination was requested.

3. In its decision the Receiving Section relied principally on this Board's earlier decision J 12/82 and cited Headnote I:

"The mere payment of the examination fee within the time limits provided for in Article 94(2) and Rule 85b EPC cannot be a substitute for filing a request itself in good time. If such a request has not been filed within the time limits, the European patent application is deemed to be withdrawn under the terms of Article 94(3) EPC."

4. That statement is undoubtedly correct. However, the conclusion drawn therefrom in the decision under appeal is not correct, since the facts underlying decision J 12/82 and those of the present case differ on a critical point:

- 4.1 In J 12/82 the applicant made a payment order for the examination fee and surcharge to its bank which was credited to an account of the EPO some days before the time limit expired. A copy of the payment order was not received by the EPO in Munich until two days after expiry of that time limit. The applicant argued that making the payment order in time demonstrated a sufficient intention to file a request for examination that it could be treated as the actual request and that it could not be held responsible for the time between despatch of the payment order by the bank and its receipt by the EPO. The Receiving Section held that the

request had not been made in time and that, while the payment order could have exceptionally been treated as the request had it been received by the EPO in time, it was received out of time.

- 4.2 In its decision the Board distinguished quite clearly between payment of the examination fee and filing the request for examination. In paragraph 4 of the reasons, it said:

"Although the intention to file the request can unquestionably be assumed from the payment of the examination fee, the unequivocal terms of Article 94 EPC do not permit any wide interpretation - in fact the Article requires that the request be written, filed within a certain period and accompanied by payment of the fee within the same period. The fact that one or two of these conditions have been fulfilled cannot exempt the applicant from fulfilling the third condition within the specified period."

It was consequently held that in the circumstances of that case, while the examination fee was paid on the date on which it was credited to a bank account of the Office (Article 8(1)(a) Rules Relating to Fees) and thus paid in time, that payment did not in itself also amount to a request for examination within the meaning of Article 94 EPC.

- 4.3 By contrast, in the present case the document by which payment was effected in time was not a payment order sent to a bank but a telex sent to the EPO. The telex of 22 May 1998 is the only document which could qualify as a written request for examination: as the Receiving Section rightly found, the Form 1200 was received after the time limit expired. It may be that the Receiving Section, seeking to draw a parallel with J 12/82, equated the telex in this case with the payment order

in that case; having thereby decided the telex could not be a request for examination, it then understandably viewed the late request for examination in section 4 of Form 1200 as the only such request and thus as late filed. However, as already indicated, the facts of the two cases when analysed are far from parallel. Thus, in the present case a written document (the telex of 22 May 1998) was received in time, and the only question is whether the text of that telex (see point II above) contained a request for examination within the meaning of Article 94 EPC.

5. In considering this question the following matters are relevant:

5.1 As the appellant has observed, there is no prescribed wording for a request for examination. Any written statement addressed to the Office which, on its wording as understood in the circumstances of the case, unambiguously expresses an applicant's wish for substantive examination of a specific application will suffice. As both the appellant and the Receiving Section agree, use of Form 1200, which contains a request for examination, is not obligatory. If a sufficient request is made in time before a Form 1200 is filed, the late filing of that form is in this respect immaterial. It is of course desirable that either Form 1200 (which says "Examination of the application under Art 94 EPC is hereby requested") is filed or some other equally clear written request for examination is made in time, but the exact form of words to be used is a matter for the applicant.

5.2 Payment of the examination fee, for example by entry of the appropriate amount in a bank account of the Office as in J 12/82, cannot of itself, even if made correctly and timeously, constitute a request for examination. Payment is in factual terms quite literally just

payment, as can be seen from the fact that under the Rules Relating to Fees it can be validly made by anyone (cf. Legal Advice 6/91 rev, OJ EPO 1991, 573 with which the Board concurs in this respect). All that is required is the receipt by the Office of the requisite sum of money. In contrast, the request for examination is by its very nature a fundamental procedural step which (within the limits of Article 133(2) EPC) can only be performed by one party, namely the applicant or its representative.

5.3 Equally, the mere intention of an applicant to have his application examined as provided for in Article 94(1) EPC - an intention which could be inferred beyond doubt from, for example, payment of the examination fee - is not sufficient. To use the words of decision J 12/82, the unequivocal terms of Article 94 EPC do not permit any wide interpretation: Article 94 EPC requires, over and above payment of the examination fee, that the underlying intention of an applicant that its application proceed to examination is manifested in a written statement made by the applicant or its representative addressed to the Office and received there in time.

6. In the present case, all these criteria are met by the telex received by the Office on 22 April 1999, the last day of the time limit pursuant to Rule 85b EPC, by which the appellant's representative ordered the Office in writing to debit from her firm's deposit account inter alia both the examination fee and the examination fee surcharge which had by then also become due for the application in question. As regards the words used (bearing in mind no prescribed form of words is required - see point 5.1 above), it has to be observed that the telex contained the word "examination" twice and in substance ordered the debiting of the very fees payment of which would avoid the request for

examination being deemed not to have been filed (Article 94(2) EPC). Although, as the appellant would no doubt accept, a more explicit request would have been advisable, it was not in all the circumstances necessary. The text of the telex includes, in addition to a debit order, a request for examination within the meaning of Article 94(1) EPC because, in the context of those circumstances, the only reasonable interpretation of the text filed with the Office by telex on 22 May 1998 is that the representative thereby wanted to inform the Office that, in addition to the examination and other fees being paid, the appellant wished to have the application examined pursuant to Article 94 EPC.

7. In the present case the telex of 22 May 1998 was addressed to the EPO cash and accounts department. While the requirements of payment of the examination fee and a written request for examination are separate specific conditions imposed by Article 94 EPC, there is no requirement that they must be implemented by separate communications addressed to different departments of the Office. Accordingly if a single communication to one department, as in this case the telex to the cash and accounts department, could constitute compliance with both conditions, it is the responsibility of the department receiving the communication to forward it to any other department which may have an interest therein.
  
8. The appeal being allowable on these grounds, it is not necessary to consider the appellant's other arguments. The consequence of this decision is that the case must be prosecuted further on the basis of a written request for examination pursuant to Article 94(1) EPC having been filed in time.

**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.

The Registrar:

The Chairman:

S Fabiani

J.-C. Saisset



Case Number: J 0004/00 - 3.1.1

Decision of 5 June 2002 correcting error in the  
D E C I S I O N  
of the Legal Board of Appeal 3.1.1  
of 21 March 2002

**Appellant:** Netphonic Communications, Inc.  
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**Representative:** Freeman, Jacqueline Carol  
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Celcon House  
289-293 High Holborn  
London WC1V 7HU (GB)

**Decision under appeal:** Decision of the Receiving Section issued on  
3 August 1999 that the application is deemed to  
be withdrawn due to the late request for  
examination pursuant to Article 94 EPC.

**Composition of the Board:**

**Chairman:** J.-C. Saisset  
**Members:** C. Rennie-Smith  
R. T. Menapace

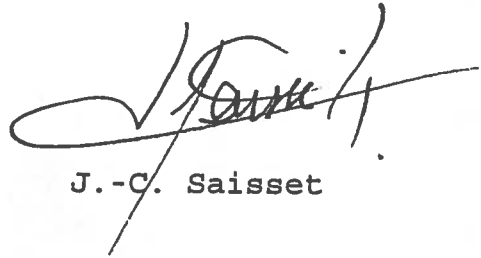
In application of Rule 89 EPC the cover page of the Decision in the Appeal Case J 0004/00 - 3.1.1 is corrected by substitution of "Technical Board" by "Legal Board".

The Registrar:



P. Martorana

The Chairman:



J.-C. Saisset