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**Datasheet for the decision  
of 2 April 2009**

**Case Number:** J 0014/07 - 3.1.01

**Application Number:** 01105375.8

**Publication Number:** 1120719

**IPC:** G06F 17/30

**Language of the proceedings:** EN

**Title of invention:**

Browser for hierarchical structures

**Applicant:**

SAP AG

**Opponent:**

-

**Headword:**

Browser for hierarchial structures/SAP AG

**Relevant legal provisions:**

**Rules relating to fees:**

EPC Art. 14(2)

**Relevant legal provisions (EPC 1973):**

EPC Art. 76, 94(1)(2), 106, 107, 108, 150(3), 112(1)(a)  
EPC R. 9(2), 70(2), 107(1)(2)

**Rules relating to fees:**

EPC Art. 2 No. 6, 10(1), 12(2)

**Keyword:**

"Communication establishing a decision (yes)"  
"Refund of examination fee (no)"

**Decisions cited:**

J 0008/81, J 0026/87, J 0010/07



Case Number: J 0014/07 - 3.1.01

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.01  
of 2 April 2009

**Appellant:** SAP AG  
Dietmar-Hopp-Allee 16  
D-69190 Walldorf (DE)

**Representative:** Jany, Peter  
Patentanwalt  
Karlstrasse 87  
D-76137 Karlsruhe (DE)

**Decision under appeal:** Communication of the Examining Division of the  
European Patent Office of 9 March 2007 refusing  
the request for refund of 50% of the  
examination fee.

**Composition of the Board:**

**Chairman:** B. Günzel  
**Members:** S. Hoffmann  
K. Garnett

## Summary of Facts and Submissions

- I. The appeal is directed against the communication of a Formalities Officer of the European Patent Office posted on 9 March 2007 refusing the appellant's request to refund 50% of the examination fee.
- II. On 9 March 2001, the present European patent application 01105375.8 was filed as a divisional application to the earlier European patent application 98945452.5. This later application originated from the international patent application WO 99/10820 for which the European Patent Office drew up an international preliminary examination report dated 23 February 1999.
- III. In a letter dated 27 January 2004 received by the European Patent Office on 29 January 2004 the appellant (applicant) requested that the examination fee in the amount of EUR 1,430 be withdrawn from its account and, furthermore, that 50% of the examination fee be refunded in accordance with Rule 107(2) EPC 1973 and Article 12(2) of the Rules relating to fees (RRF) because the European Patent Office had drawn up the above-cited international preliminary examination report dated 23 February 1999.
- IV. In the present divisional application, the examining division issued a communication report pursuant to Article 96(2) EPC 1973 on 18 August 2005.
- V. In letters dated 31 July 2006 and 19 February 2007 the appellant reminded the European Patent Office *inter alia* of its request to refund the examination fee in

accordance with Article 12 RRF.

VI. By a letter dated 9 March 2007 the appellant was informed that *"the request for partial refund of the examination fee of the present application is refused because a reduction of 50% of the examination fee was already given in the parent application 98945452.5 and this reduction can only be given once and not for divisional applications"*. This communication was produced by a Formalities Officer using a computer. The communication stated the name of the responsible Formalities Officer and bore the European Patent Office seal but was not signed.

VII. The appellant filed a notice of appeal and statement setting out the grounds of appeal on 27 March 2007. The appeal fee was paid the same day. Its arguments can be summarized as follows:

Although the communication posted on 9 March 2007 was not signed and did not contain any information regarding the right to appeal and did not indicate by which division of the European Patent Office the request to refund 50% of the examination fee was being refused, the communication took effect as a final decision to its detriment and is therefore subject to appeal according to Article 106(1) EPC.

The request for partial refund of the examination fee is justified by the history of the proceedings. In the international application proceedings PCT/IB 98/01553 the European Patent Office acting as International Preliminary Examining Authority drew up an international preliminary examination report dated

23 February 1999 for all parts and all claims of the international patent application, although the report contained an indication of lack of unity of invention.

On the basis of the international patent application PCT/IB 98/01553, the regional phase before the European Patent Office was entered on 9 March 2000 with the European patent application (parent application) having the application no. EP 98 945 452, in which the claims of the international patent application had been rearranged into two groups (claims 1-15 and claims 16-24) to take account of the indication of lack of unity of invention in the international preliminary examination report. On the basis of the second group of claims, the present European patent application was filed as a divisional application to the application No 98945452.

The requirements of Rule 107(2) EPC and Article 12(2) RRF are fully and literally fulfilled. These provisions do not state that a fee reduction can be given only once and cannot be given in respect of divisional applications.

Furthermore, the appellant referred to Part C, Chapter III, 7.11.4 of the Guidelines for Examination in the European Patent Office where it is stated "*If the European Patent Office has established an IPER on the application and the applicant wishes the application to proceed on the basis of claims which were not the subject of this IPER because they were not searched during the international phase because of lack of unity, he will be invited to pay further search fees under Rule 112 EPC for the inventions not searched and*

*to additionally pay the difference between the full examination fee and the reduced examination fee as mentioned in Rule 107(2) EPC, if he wishes the application to be examined on the basis of an invention which was not the subject of the IPER."*

In the present case the European Patent Office drew up an IPER on all claims of the international application, and consequently the applicant was not invited to pay further search fees. According to the appellant no difference between the full examination fee and the reduced examination fee has to be paid and therefore 50% of the examination fee has to be reimbursed.

VIII. In response to the Board's communication dated 17 September 2008 the appellant contested that Rule 107(2) EPC 1973 was limited to an international patent application entering the regional phase before the European Patent Office (European phase) and referred to the wording of this paragraph, which would also be applicable to a divisional application filed later. The appellant submitted furthermore that if it were legally possible to file a divisional international application after the European Patent Office had drawn up the complete international preliminary examination report for the original international application and if that international divisional patent application had entered the European phase, the applicant would be entitled to a reduction of the examination fee. Furthermore, the appellant pointed out that Rule 107(2) EPC 1973 has the same purpose as the current Article 14(2) RRF 2000, which embraces divisional applications as well. Finally, the

appellant argued for the direct applicability of Article 14(2) RRF 2000.

IX. The appellant requests that:

- the decision dated 9 March 2007 be reversed
- 50% of the examination fee be reimbursed;
- the fee for the appeal be refunded in accordance with Rule 67 EPC;
- as an auxiliary request, that in the event that the European Patent Office takes the position that the official communication dated 9 March 2007 is not a decision subject to appeal, the Office should
- submit such a decision, which will then be subject to appeal with respect to the request for the partial refund of the examination fee;
- and refund the fee for each appeal which in this situation would have been paid without any legal basis
- and in event that the Board takes the position that the examination fee is not to be refunded in the amount of 50%, the subject matter of the present appeal be referred to the Enlarged Board of Appeal according to Article 112(1)(a) EPC.

### **Reasons for the Decision**

1. As regards the EPC 2000, which entered into force on 13 December 2007, the present Board follows the reasoning in decision J 10/07 (OJ EPO 2008, 567, points 1.1, 1.2 and 1.3 of the reasons) that the provisions of

Article 106 to 108 EPC 1973 and the Implementing Regulations 1973 which are linked to these Articles are to be applied in the present case.

The Board agrees with the appellant that the communication refusing the request for reimbursement of 50% of the examination fee constituted a decision within the meaning of Article 106(1) EPC 1973.

According to the established case law, whether a document constitutes a decision or not depends on its substance and not on its form (J 8/81, OJ EPO 1982, 10, points 2 and 3 of the reasons); J 26/87, OJ EPO 1989, 329, point 1 of the reasons). In the present case the communication dated 9 March 2007 constituted a clear rejection of the appellant's request for reimbursement. The fact that it was not signed does not make void the authoritative and binding character of the refusal contained in the communication, since the formalities officer was competent to decide on the request for reimbursement of the fee according to the then current Rule 9(2) EPC 1973 in conjunction with paragraph I, point 22 of the Notice from the Vice-President of Directorate-General 2 of the European Patent Office dated 28 April 1999 concerning the entrustment to non-examining staff of certain duties normally the responsibility of the examining or opposition divisions (OJ EPO 1999, 504). Therefore, although not expressly indicated in the communication, as it should have been, it is also clear that the formalities officer acted on behalf of the examining division.

The mere indication of the name of the formalities officer without any signature, but which had been replaced by a seal, complied with the requirements of the then current Rule 70(2), first sentence EPC 1973



because the communication was produced by using a computer. Therefore the communication constituted a binding and definite refusal of the request for reimbursement of 50% of the examination fee and constituted an appealable decision in the sense of Article 106(1) EPC 1973.

The appeal is therefore admissible.

2. Although the appellant based its claim mainly on the application of Article 12(2) RRF in conjunction with Rule 107(2) EPC 1973, it also argued for the direct applicability of Article 14(2) Rules Relating to Fees (RRF) in force since 13 December 2007 because that article would be applicable in respect of payments after EPC 2000 entered into force and in the present case the examination fee will effectively be paid when the final decision of the Board of Appeal comes into legal binding force.

The Board does not share this legal view and holds that the provisions in force at the time when the examination fee was paid are to be applied.

Firstly, according to Article 2(1) of the Decision of the Administrative Council of 7 December 2006 amending the Rules relating to Fees (OJ EPO 2007, Special edition 1, 199), the revised Rules entered into force on the same date as the revised text of the EPC i.e. on 13 December 2007. Article 2(3) of this decision expressly stipulates that in the case of payments made before that date the Rules Relating to Fees in force at that time continue to apply.

Secondly, Article 2(3) of this decision does not concern payments executed by the European Patent Office in order to fulfil a legal obligation e.g. the refund of fees, as it will be explained by the following.

The appellant paid the examination fee in the amount of € 1,430 on 29 January 2004 in due time according to Article 94(1)(2) EPC 1973, in conjunction with the then valid Article 2, no. 6 RRF. There can be no doubt that the payment of the examination fee can only be assessed by provisions in force at the time when the fee was due. The payment of the fee has an immediate legal effect which cannot be reversed by provisions which entered in force later unless retroactive effect is expressly stipulated for.

The same reasoning has to be applied to the provisions concerning the refund of fees.

The legal requirements for any reduction of a fee are a matter for the relevant provisions of the EPC and its associated provisions. Any fee reduction must be based on a specific legal provision, and a full or partial refund is not a matter which is left to the discretion of the European Patent Office or the Boards of Appeal. Accordingly, the appellant's starting point, namely Rule 107(2) EPC 1973 in conjunction with Article 12(2) RRF, being the provisions in force at the time when the examination fee was due, is perfectly correct.

Article 12(2) RRF does not stipulate when the refund is due in the event that more than the due reduced amount has been paid but only refers to Rule 107(2) EPC 1973. Therefore, the refund of the part of the examination fee which was not due according to Article 12(2) RRF is

the reverse of the payment of the full examination fee and the respective amount of refund was due on the day when the examination fee was paid in full. Even if the Board considered the filing of a specific request for a refund as an unwritten requirement before refund became due, this request was filed in the present case on the day when the examination fee was paid, namely on 29 January 2004. It is incorrect to argue that the refund becomes due when the present decision becomes final. On the contrary, the refund must be due in order that a refund procedure can be initiated and a decision given. As a result, Rule 107(2) EPC 1973 in conjunction with Article 12(2) RRF as in force on 29 January 2004 is to be applied in the present case.

3. However, Rule 107(2) EPC 1973 in conjunction with Article 12(2) RRF only concerns a fee reduction for an international patent application which is entering into the regional phase before the European Patent Office (European phase) but does not address a later filed European divisional application.

Article 12(2), sentence 1 RRF stipulates the amount of reduction but not the reason why the reduction is to be given. In this regard, Article 12(2), sentence 1 RRF refers to the reduction laid down in Rule 107(2) EPC 1973. This reference clearly indicates that the reduction relates to the procedural situation defined by Rule 107(2) EPC 1973.

Rule 107(2) EPC 1973 is to be read in the context of the whole provision, which concerns "*The European Patent Office as a designated or elected Office - Requirements for entry into the European phase*" as

stated in the heading of this provision. Rule 107(1) EPC 1973 stipulates the procedural acts required when an applicant wishes to pursue an international application in the European phase as a European application. The appellant's argument that Rule 107(2) EPC 1973 constitutes a general provision for the refund of examination fees, which would be also applicable to applications not being European patent applications according to Rule 107(1) EPC 1973, has no basis in the wording and the purpose of Rule 107 EPC 1973 read as a whole and in its context within Part IX of the EPC 1973 concerning exclusively applications filed as international applications pursuant to the Patent Cooperation Treaty. There is no indication of any reason why the legislator should have "hidden" a general provision for fee reduction in a Chapter concerning PCT-applications. This conclusion is supported by the (in this respect) different regulations concerning the refund of search fees (cf. below point 5). As regards the context of Rule 107(2) EPC 1973 the Board cannot see any sensible reason to apply this provision to divisional European patent applications. The argument that a fee reduction could be obtained when an international divisional application could be filed during the international phase is mere speculation as how the legislator could have decided on this procedural situation. A Board of Appeal is not allowed to act as a legislator and any speculation on this fictive procedural situation does not lie within the Board's competence. Therefore, Rule 107(2) EPC 1973 relates to a specific application and not to any European application. In the present case, this specific application was the parent application of the now-pending divisional application.

4. Rule 107 EPC 1973 also does not provide a legal basis for reimbursement of the examination fee merely because the examiner in the proceedings of the present divisional application could have partly or fully based the examination report on the report which was already established by the European Patent Office acting as International Preliminary Examining Authority.

Hence, the fee reduction stipulated by Rule 107(2) EPC 1973 only concerns the reduction of the examination fee which was due for the parent application but not the one which was due in relation to the present divisional application.

5. The legal provisions in respect of the reduction of the search fee are different to those in respect of the reduction of the examination fee. Article 10(1) RRF as in force on 29 January 2004 stipulates that the "*search fee paid for a European or supplementary European search shall be refunded fully or in part if the European search report is based on an earlier search report already prepared by the Office on an application whose priority is claimed for the European patent application or which is the earlier application within the meaning of Article 76 of the Convention*". This provision thus expressly embraces the (partial) refund of the search fee in respect of a divisional application filed under Article 76 EPC. In contrast, Article 12(2) RRF as in force in 2004 in conjunction with Rule 107(2) EPC 1973 provides for a partial refund of the examination fee only when the international application enters the European phase and does not refer to a possible later procedural situation when a

divisional application is filed. The wording of these provisions is clear and precise and does not provide a legal basis for a broader interpretation such that a partial refund of the examination fee in respect of a divisional application can also be granted.

6. The appellant's reference to Part C-III, 7.11.4 of the Guidelines for Examination in the European Patent Office (as at December 2004) does not justify a different conclusion. The appellant overlooks that the Guidelines explicitly refer to the procedural situation defined by Rule 107(2) EPC. Therefore, the "application" referred to by the Guidelines only means the international application entering the European phase which, according to Article 150(3) EPC (1973), is deemed to be a European patent application. The present divisional application was a different application and the cited passage of the Guidelines does not refer to the requirements for filing a divisional application.
7. Summing up, the Board concludes that the payment of the examination fee in the amount of € 1,430 was properly due in accordance with Article 94(1)(2) EPC 1973 in conjunction with Article 2, no. 6 RRF as in force on 29 January 2004. The possibility of a fee reduction provided for by Rule 107(2) EPC 1973 in conjunction with Article 12(2) RRF as in force on 29 January 2004 is not applicable to the present divisional application.

Therefore the appeal must be dismissed.

8. Having regard to the conclusions reached in point 1, above, the Board does not need to consider the appellant's auxiliary request, which would only have

been relevant if the Board had come to the conclusion that the communication dated 9 March 2007 was not a decision.

9. As regards appellant's request for referral of the subject matter of the present appeal to the Enlarged Board of Appeal (Article 112(1)(a) EPC 1973) in the event that the Board should take in the position that the examination fee is not to be refunded in an amount of 50%, the Board observes that no legal question was expressly formulated as required by Article 112(1)(a) EPC 1973. However, when the Board considers the appellant's submissions as a whole it comes clear that the request is to be read as request to refer the legal question whether or not Rule 107(2) EPC 1973 in conjunction with the then current Article 12(2) RRF or in the alternative the current Article 14(2) RRF is applicable to a divisional application which originates from an international patent application according to Rule 107(1) EPC 1973.

The Board believes that the answer to these questions can be deduced directly and unequivocally (as explained above) from the EPC. Nor does it know of any contrary decisions which would justify a ruling by the Enlarged Board of Appeal with a view to ensuring uniform application of the law (Article 112(1) EPC 1973). Accordingly, no such ruling is needed (Article 112(1)(a) EPC 1973) and the request is therefore rejected.

**Order**

**For these reasons it is decided that:**

1. The request to refer a point of law to the Enlarged Board of Appeal is rejected.
2. The appeal is dismissed.

The Registrar:

The Chairwoman:

S. Fabiani

B. Guenzel