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**Datasheet for the decision
of 28 May 2010**

Case Number: J 0003/09 - 3.1.01

Application Number: 06758637.0

Publication Number: 1886370

IPC: H01M 8/04

Language of the proceedings: EN

Title of invention:

Fuel cells

Applicant:

The Gillette Company

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 82, 153

EPC R. 43(2), 43(5), 46, 161, 162(1)(2)(3)(4), 164(2)

Relevant legal provisions (EPC 1973):

EPC Art. 83, 157(2)

EPC R. 45, 46, 109, 110(1)(2)(3)(4), 112

Keyword:

"Refund of claims fees (no)"

"Abandonment of subject-matter (no)"

"Arbitrary delay by Office (no)"

"Permission to prosecute all claims subject to payment of
additional search fees (no)"

Decisions cited:

G 0002/92, J 0033/86, J 0010/07, T 0178/84, T 0631/97

Catchword:

1. Although the procedure on entry of an application into the European phase where the EPO has acted as the International Searching Authority has changed with the coming into force of EPC 2000, the responsibility for establishing whether or not the application meets the requirements of unity of invention still ultimately rests with the Examining Division, and the opinion of the EPO acting as the International Searching Authority on lack of unity is not final or binding on the Examining Division.
2. In the case of an *a posteriori* objection of non unity, even if justified, the claims may still usefully serve as a basis for later limiting the claimed subject-matter to a more specifically defined but now unitary and searched invention.
3. The payment of claims fees for claims exceeding the number of ten may thus have a useful purpose on its own independently of whether all the claims concern unitary subject-matter.



Case Number: J 0003/09 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 28 May 2010

Appellant: The Gillette Company
Prudential Tower Building
Boston
Massachusetts 02190 (US)

Representative: Rasser, Jacobus Cornelis
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Rembrandt Tower, 31st Floor
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Decision under appeal: Decision of the Examining Division of the
European Patent Office of 14 January 2009.

Composition of the Board:

Chairwoman: B. Günzel
Members: K. Garnett
G. Weiss

Summary of Facts and Submissions

- I. This is an appeal from the decision of the Examining Division dated 14 January 2009 refusing to order the refund of claims fees.
- II. On 26 April 2006 the applicant (hereafter referred to as the "appellant") filed international application PCTIUS2006/01588 6 with 68 claims.
- III. On 23 November 2006 the European Patent Office (hereafter referred to as "EPO") acting as International Searching Authority: (a) notified the appellant that it considered the application to be non-unitary, two inventions having been claimed; (b) enclosed a partial search report on claims 1 - 15, covering the first invention claimed; and (c) invited the appellant to pay additional search fees within one month. The appellant did not pay any additional fees.
- IV. The international application was published on 30 November 2006, containing the 68 claims.
- V. The application entered into the European phase on 8 November 2007, the proceedings being based on the published application documents. The appellant paid the full amount of claims fees (58 x € 45 = € 2610), i.e., having regard to the fact that the application comprised more than ten claims (Rule 110(1) EPC 1973).
- VI. On 16 January 2008 the Receiving Section issued a communication under Rules 161 and 162 EPC (provisions hereafter cited as "EPC" are those of the EPC 2000) notifying the appellant that there was now a further

opportunity within one month to file amended claims and that the claims applicable on the expiry of this period would form the basis of any claims fees to be paid. The communication further notified the appellant that if on expiry of this period there was a new set of claims containing fewer fee-incurring claims than previously, the claims fees in excess of those due under Rule 162(2), 2nd sentence, EPC would be refunded (Rule 162(3) EPC).

VII. No amended claims were filed.

VIII. On 17 March 2008 the Examining Division issued a communication under Article 94(3) EPC notifying the appellant of deficiencies in the application, in which inter alia:

- (a) It was noted that only part of the subject matter of the application had been searched following the objection of lack of unity.
- (b) The Examining Division said it agreed with the earlier finding of lack of unity.
- (c) In accordance with Rule 164(2) EPC the appellant was invited to limit the application to the invention covered by the international search report.
- (d) It was stated that the subject matter to be excised might be made the subject of a divisional application.

(e) As no search report had been drawn up on the other invention, the application would be prosecuted on the basis of the searched invention.

- IX. An inspection of the public files also shows that on 17 September 2008 the appellant filed a divisional application (08164537.6) to the present application.
- X. On 25 September 2008 the appellant requested refund of the payment made in respect of claims 16 - 68, i.e. $53 \times \text{€ } 45 = \text{€ } 2385$. It was argued that since only part of the claimed subject matter had been searched (claims 1 - 15), the application had to be limited to the invention covered by the international search report and that payment of fees for claims that could not possibly be prosecuted was a payment made without any legal basis.
- XI. By a communication dated 3 November 2008 the Examining Division refused any refund of claims fees. It reasoned that the conditions for any refund were to be found in Rule 162(3) EPC. Since no amendments had been filed in response to the Receiving Section's communication of 16 January 2008 and the number of claims remained unchanged, no refund was allowable.
- XII. By a letter from the EPO dated 4 November 2008, the appellant was notified that the present application was deemed to be withdrawn following the appellant's failure to file observations on the Examining Division's communication of 17 March 2008.

- XIII. On 11 November 2008 the appellant requested an appealable decision in respect of the communication of 3 November 2008.
- XIV. By a decision dated 14 January 2009, the Examining Division rejected the request for a refund of claims fees, repeating the reasons given in the communication of 3 November 2008.
- XV. On 18 March 2009 the appellant filed a notice of appeal against the decision together with a statement setting out the grounds of appeal. The appeal fee was paid on the same day.
- XVI. On 26 November 2009, together with a summons to oral proceedings, the Board sent the appellant a communication setting out the Board's provisional, non-binding opinion in the case.
- XVII. By a letter dated 23 December 2009 the appellant notified the Board that it would not be attending the oral proceedings and requested a written decision taking into account the additional comments made in the letter.
- XVIII. Oral proceedings duly took place on 1 February 2010, in the absence of the appellant. At the end of the oral proceedings the Board closed the debate and ordered the proceedings to be continued in writing.
- XIX. The arguments of the appellant as contained in the statement setting out the grounds of appeal and the letter of 23 December 2009 can be summarised as follows:

- (a) Generally, the appellant has not relied on any specific provision in the EPC authorising repayment of the claims fees, but rather it was argued that the payment of the fees in question had no legal basis. The appellant also referred to the transitional provisions under the EPC 2000 and said that the manner in which events occurred was at least partially in the hands of the EPO.

- (b) More specifically, the appellant argued that since only part of the subject matter had been searched, the application could only be pursued on the basis of these claims.

- (c) The conditions for refunds of fees are generally laid down in the Guidelines, Part A, Chapter XI, Point 10. Fee payments lacking a legal basis must be refunded (Guidelines for Examination, Part A, Chapter XI, Point 10.1.1(i)). Claims fees which have been paid in respect of claims that cannot be prosecuted lack a legal basis and so must be refunded.

- (d) It is up to the applicant to decide how to proceed. Subject matter in respect of which a search fee has not been not paid cannot obtain protection in that application and should be regarded as "abandoned", subject only to pursuing it via a divisional application. See G 2/92 (OJ EPO 1993, 591) and T 178/84 (OJ EPO 1989, 157). This approach is supported by the Guidelines, C-III point 7.11, explaining Rule 164(2) EPC.

- (e) It is inevitable that unsearched subject-matter will not be prosecuted in the application. It is not realistic to assume that the Examining Division will review a previous finding of the EPO acting as International Searching Authority and come to a different decision, a possibility suggested in T 631/97 (OJ EPO 2001, 13) and G 2/92. Since the date of these decisions, the situation has changed with the introduction of the BEST procedure. It is not realistic to think that an examiner will voluntarily review his or her own earlier finding on unity and come to a different decision. The decision regarding unity is effectively taken at the International Search stage, with the requisite opportunities to protest or appeal.
- (f) Nor is it correct to suggest that the payment of claims fees enables an applicant to preserve the right to prosecute the claims in a subsequent divisional application.
- (g) Generally, the purpose of claims fees is not, as suggested in J 6/96, to discourage excessive numbers of claims but rather to include an element of compensation for the extra work involved during the grant procedure. Other provisions of the EPC provided mechanisms to discourage an applicant from filing, or to relieve the Office of the burden of dealing with, a large number of claims, for example Articles 82 and 84 EPC, Rules 43(2), 43(5) and 46 EPC. The appellant asks rhetorically whether an examiner could validly make an objection under Rule 43(5) EPC in respect of

claims for which claims fees had already been accepted. This appears to lead to a conflict since it gives the EPO the power to accept fees intended to discourage excess claims and then refuse the claims anyway for being excessive.

- (h) The new wording of Rule 164(2) EPC specifically avoids any need for a review of the decision by the International Searching Authority, something that agrees with the situation under BEST procedure referred to above. The decision as to whether claims were "comprised" in the application according to Rule 46 EPC 1973 took effect at the moment that an applicant chose not to pay the further search fee.
- (i) In the present case the decision not to pay additional search fees was taken at a time when it was not known when the EPC 2000 would enter into force. As a result, the appellant was under the impression that additional search fees could be paid in response to a communication under Rule 112 EPC 1973 after entry into the regional phase.
- (j) Since entry into the regional phase took place before the entry into force of the EPC 2000, the Office could have sent such a communication under Rule 112 EPC 1973. The arbitrary delay in sending a communication, which resulted in it being sent under Rules 161 and 162 EPC instead, should not be decisive as regards the resulting treatment of the applicant. If the Office had issued the relevant communication within one month of the entry into the regional phase, i.e. before 8 December 2007,

one set of circumstances would have applied, but the wait of a further month resulted in a different situation which has been detrimental to the appellant. Although the appellant has made it clear that it does not accuse the Office of any lack of good faith, it argues that the present situation is at least partly attributable to a "delay" on the side of the Office. This has deprived the appellant from pursuing claims in the Euro-PCT application upon payment of additional search fees.

- XX. The appellant requests that the decision of the Examining Division to reject the request dated 25 September 2008 for refund of excess claim fees be set aside and the refund of such fees, alternatively to be permitted to prosecute all claims in the application subject to payment of additional search fees, with a refund of all fees paid on the related divisional application No. 08164537.6 (which would then be withdrawn).

Reasons for the Decision

1. The appeal is admissible.
2. Since the events in this case straddle the coming into force of EPC 2000, in this decision it will be expressly stated where the provisions of EPC 1973 are being referred to.

3. *The relevant rules and procedure.*

3.1 It is helpful first to set out the scheme of the EPC 1973 and EPC 2000, so far as relevant to the arguments submitted by the appellant.

3.2 The case is concerned with the application of Rules 110 and 112 EPC 1973, and Rules 162 and 164 EPC, which are to be found in the group of respective rules dealing with the position of the EPO as an International Searching Authority and the subsequent entry of the application into the European phase.

3.3 The EPC 2000 came into force on 13 December 2007. According to Article 7(1) of the Act revising the EPC of 29 November 2000, the revised convention shall not apply to pending applications unless otherwise decided by the Administrative Council. Article 1, paragraph 6 of the decision of the Administrative Council of 28 June 2001 (OJ EPO 2007, special edition 4, 219), provides that: "Articles 150 to 153 [EPC 2000] shall apply to international applications pending at the time of their entry into force." Art. 153 EPC therefore applies to the present application. The Implementing Regulations to the EPC 2000 are applicable to a pending European patent application in so far as it is subject to the provisions of the EPC 2000, i.e. in so far as a regulation is linked to an applicable provision of the EPC 2000: see the decision of the Administrative Council of 7 December 2006 (OJ EPO 2007, 89) and J 10/07 (OJ EPO 2008, 567, point 7 of the Reasons). Rules 162 and 164 EPC are linked to Article 153 EPC and therefore applied to the present application from

13 December 2007 onwards. Rules 110 and 112 EPC 1973 applied to the application before this date.

3.4 *Claims fees*

3.4.1 Rule 110(1) EPC 1973 provided that if the application documents on which the grant procedure was to be based comprised more than ten claims, a claims fee was payable within the period for entry into the European phase for the eleventh and each subsequent claim. Any claims fee not paid in due time could still be paid within a period of one month from notification of a communication pointing out the failure to pay (Rule 110(2), first sentence, EPC 1973. Where however amended claims were then filed within the period for payment, the claims fees were to be computed on the basis of the amended claims (Rule 110(2), second sentence, EPC 1973). Where the amount so computed was less than the claims fees which the applicant had already paid under Rule 110(1), the excess was to be refunded (Rule 110(3) EPC 1973). Where claims fees were not paid in due time, the claim or claims concerned were deemed to be abandoned (Rule 110(4) EPC 1973).

3.4.2 Furthermore, Rule 109 EPC 1973 provided that (without prejudice to Rule 86 EPC 1973, paragraphs 2 to 4), within a non-extendable period of one month as from notification of a communication informing the applicant accordingly, the application could be amended once (referring to a time after entry into the European phase before the EPO). On a literal reading of the rule the requirements for a refund under Rule 110(3) EPC 1973 would not have been fulfilled by virtue of an amended application being filed with fewer claims in

response to a notification under Rule 109 EPC 1973. This is because if the claims fees were paid in full in due time there would have been no notification under Rule 110(2) EPC 1973 triggering the potential application of Rule 110(3) EPC 1973. However, this rule was consistently applied by the EPO in conjunction with Rule 110 EPC 1973 to the advantage of applicants such that when a reduced number of claims were filed in response to a notification under Rule 109 EPC 1973, the amount of any claims fees was recalculated and any excess refunded.

3.4.3 The effect of Rules 161 and 162 EPC is the same as that of Rules 109 and 110 EPC 1973 respectively and there is no need to spell out the provisions again.

3.5 *Unity and search report on entry into European phase.*

3.5.1 Under Rule 112 EPC 1973, where, as here, only part of an international application had been searched by the International Searching Authority following an objection of lack of unity, and the applicant had not taken the opportunity to pay the relevant additional fees to the International Searching Authority, the EPO was required to consider whether the application in fact complied with the requirement of unity. If it considered that it did not comply, the applicant was to be told that a European search report could be obtained in respect of the unsearched parts of the application if a search fee was paid. The Search Division was then to draw up a European search report for those parts of the international application in respect of which search fees had been paid.

3.5.2 The Rules did not state what was to happen if the EPO considered, contrary to the view of the International Searching Authority, that the application did comply with the requirement of unity. However, the responsibility for establishing whether or not the application met the requirements of unity of invention under Article 82 EPC 1973 ultimately rested with the Examining Division, and the opinion of the EPO acting as the International Searching Authority on lack of unity was not final or binding on the Examining Division, see T 631/97, OJ EPO 2001, 13, point 3.8 of the Reasons. If the Examining Division disagreed with the conclusion in the search report on lack of unity an additional search would have had to be and would have been carried out without payment of any additional fee, since, subject to Rule 45 EPC 1973, an applicant was entitled to have a unitary invention completely searched. The examination would then have been conducted on the basis of all claims (see T 631/97 and the Guidelines for Examination, C-III, 7.10, and C-VI, 3.1-4).

3.5.3 The equivalent rule under the EPC 2000 is Rule 164. Under Rule 164(2) EPC, where the Examining Division considers that the application documents on which the European grant procedure is to be based do not meet the requirements of unity of invention or protection is sought for an invention not covered by the international search report, it is to invite the applicant to limit the application to one invention covered by the international search report. This was the procedure followed by the Office in the present case: see point VIII., above.

3.5.4 The procedure on entry into the European phase (i.e., Rule 112 EPC 1973; Rule 164 EPC) therefore changed with the coming into force of the EPC 2000, as explained in the remarks to the new rule published by the EPO (see OJ EPO 2007, Special Edition 5, 256),

"New Rule 164 EPC 2000 simplifies the procedure, and the opportunity to have multiple inventions searched within the framework of one application will be limited to the international phase. On entry into the European phase, non-unitary subject matter should be deleted.

The new procedure does not involve any loss of rights for the applicant. The result is just that the applicant will have to use the appropriate way of having any further inventions searched and examined by filing divisional applications. This will bring the Euro-PCT procedure in line with the Euro-direct procedure."

3.5.5 It is this change in procedure which has clearly given rise to the present appeal.

3.5.6 As with the position under Rule 112 EPC 1973, Rule 164 EPC does not state what is to happen if the Examining Division considers, contrary to the view of the International Searching Authority, that the application does comply with the requirement of unity of invention. However, the Board does not consider that the position in this respect has altered with the coming into force of the EPC 2000. Although the procedure has changed as explained in point 3.5.4 above, the Board considers that responsibility for establishing whether or not the application meets the requirements of unity of

invention still ultimately rests with the Examining Division, and the opinion of the EPO acting as the International Searching Authority on lack of unity is not final or binding on the Examining Division. Indeed the practice of the Examining Division in this respect remains as before, see the Guidelines for Examination, C-III, 7.10 and 7.11.1 (especially 7.11.1(v)). The explanatory remarks (see point 3.5.4 above) appear to the Board to have put the matter correctly by referring to the new limit on the possibility of having *multiple inventions* searched, while saying nothing about the more general possibility of having hitherto unsearched subject-matter searched. In this respect the legal situation remains unchanged, so that to the extent that an objection of non-unity raised by the International Searching Authority in the international phase turns out to be unjustified, the applicant is entitled as of right to have the whole subject matter of his unitary invention searched.

3.5.7 This is also apparent from the wording of Rule 164(2) EPC giving the EPO the power to invite the applicant to limit the application to one invention covered by the international search report. This implies that where there is in fact only "one" invention there is no sanction.

3.5.8 As it happened, in the present application the Examining Division in fact came to the conclusion that the previous opinion of the EPO acting as the International Searching Authority on the lack of unity was correct, see point VIII.(b), above.

4. *Legal basis for claims fees*

4.1 When on 8 November 2007 the appellant filed the requisite documents for the entry of the application into the European phase and paid the claims fees now in dispute, it was on the basis of Rule 110(1) EPC 1973.

4.2 While the Board can accept the general principle that fees paid without a legal basis are refundable, the Board cannot accept the appellant's basic argument in this case that the payment of claims fees in respect of claims 16 - 68 in the application had no legal basis. There clearly was such a legal basis, namely Rule 110(1) EPC 1973. The wording of the Rule is clear and straightforward. Apart from Rules 110(2) and (3), there is nothing to be found in the rules or elsewhere which modifies the effect of the rule or deprives it of its effect, for example, where claims are later withdrawn or abandoned.

4.3 The Board would add that under the EPC the general principle is that fees, once validly paid, are not refundable unless provision to the contrary is made. This means that fees paid on a legal basis are not normally refundable, even if for example the proceedings are terminated shortly after the fee is paid and the objects for which the fees were paid are not achieved. In other words, the reimbursement of a fee requires there to be special provision (see for example decision J 33/86, OJ EPO 1988, 84). As regards the refund of claims fees, as already noted, the appellant does not rely on any specific provision of the EPC in support.

- 4.4 The basic premise of the appellant's appeal is therefore false.
- 4.5 There is therefore no need for the Board to enter into a discussion about what the precise purpose of the provisions requiring payment of claims fees is. Even if it is to compensate for the extra work involved for the EPO with a large number of claims it follows from the above that the claims fee to fall due whether or not any extra work has actually been done in the case in question. The appellant has asked rhetorically whether an examiner could validly make an objection under Rule 43(5) EPC in respect of claims for which claims fees had already been accepted. The answer is clearly yes. Claims fees are payable within a prescribed time in accordance with the Rules Relating to Fees and have nothing to do with the Examining Division's assessment under Rule 43(5) EPC of what is a reasonable number of claims.
- 4.6 The Board would also point out that, following the Office's communication of 16 January 2008 under Rules 161 and 162 EPC 2000 (see point VI., above), the appellant had the opportunity to file amended claims and, if appropriate, obtain a refund of excess claims fees. The legal consequences of such action would have been no different than if it had directly entered the European phase with such reduced number of claims. For whatever reason, however, the appellant did not take such opportunity.

5. *Inevitable abandonment of subject matter*

5.1 In any event, the Board also does not accept the further premise which the appellant asserts, namely that it was inevitable that the subject matter of the unsearched claims could not be prosecuted in the application, and must therefore be considered as having been (at some unspecified stage) "abandoned".

5.2 As explained in points 3.5.2 and 3.5.6 above, it was perfectly possible, either before or, more realistically, after the EPC 2000 came into force, that the Examining Division would have concluded that the objection of lack of unity had been wrong, in which event an additional search would have been carried out and the examination conducted on the basis of all claims.

5.3 The appellant has cited the decision of the Enlarged Board in G 2/92, where in the concluding opinion it was said that:

"An applicant who fails to pay the further search fees for a non-unitary application when requested to do so by the Search Division under Rule 46(1) EPC [1973] cannot pursue that application for the subject-matter in respect of which no search fees have been paid. Such an applicant must file a divisional application in respect of such subject-matter if he wishes to seek protection for it."

5.4 This statement was considered in decision T 631/97, where the Board observed that the reference to "a non-unitary application" in this passage:

"... means that the application is non-unitary when the examining division upon review agrees with the opinion of the search division." (See point 3.7.2 of the Reasons)

5.5 The Board in that decision also noted (see points 3.7.4 - 3.9.1 of the Reasons) that the practice of the EPO as set out in the then current version of the Guidelines for Examination, C-III, 7.10 and C-VI, 3.4, whereby the Examining Division itself considers the issue of unity and a further search is if necessary carried out, was fully consistent with decision G 2/92.

5.6 The Board also does not consider that decision G 2/92 is authority for the proposition put forward by the appellant that subject matter which has not been searched is to be regarded as abandoned. The expression "abandoned" had been used in decision T 178/84 (OJ EPO 1989, 157) and the Enlarged Board in decision G 2/92 observed (point II in the Summary of the Facts) that:

"It seems that the word "abandoned" as used in this decision [i.e. T 178/84] is not intended to refer to a public renunciation of the applicant's desire to obtain patent protection for the relevant subject-matter but is used in a narrower sense simply to refer to the fact that protection for the relevant subject-matter per se within that particular patent application is no longer possible."

As already explained, protection within the present application for unitary subject-matter, even if unsearched, remained possible.

- 5.7 Although the appellant asserts that the Guidelines for Examination, C-III, 7.11, explaining Rules 164(2) EPC, support the approach that subject matter in respect of which a search fee has not been paid cannot obtain protection in that application and should be regarded as "abandoned", subject only to pursuing it via a divisional application, in fact this paragraph of the Guidelines states, in conformity with the Guidelines at paragraphs C-III, 7.11.1(v) and B-II, 4.2(iii), referred to above:

"(ii) if, during the international search, an objection of lack of unity has been raised and the applicant has neither taken the opportunity to have the other invention(s) searched by paying additional search fees for them, nor amended the claims so that they are limited to the invention searched, *and the examiner agrees with the objection of the ISA*, he will then proceed to issue a communication under Rule 71(1) and (2), dealing exclusively with the subject-matter of the one and only invention which has been searched."
(Emphasis added by the Board)

As already noted in points 3.5.2 and 3.5.6 above, the Guidelines at C-III, 7.11.1(v) go on to state what happens where the examiner does *not* agree with the objection of the ISA.

5.8 In this regard, the Board generally cannot accept the appellant's argument that this state of affairs altered following the introduction of the BEST system of examination in 1990. While it is true that following the introduction of this system the same person who gave the opinion on unity on behalf of the EPO acting as International Searching Authority may carry out the examination for unity of invention as principal examiner on behalf of the Examining Division, this will not necessarily be the case and is in any event irrelevant. It cannot be assumed, as the appellant apparently does, that the Examining Division will fail to carry out its obligation to consider the question of unity. Not only are the Guidelines for Examination on this matter clear, as already explained, but any finding may be made the subject of formal decision and an appeal to the Boards of Appeal.

5.9 Furthermore, in the frequent case of an *a posteriori* objection of non unity, even if justified, the claims may usefully serve as a basis for later limiting the claimed subject-matter to a more specifically defined but now unitary and searched invention. Admittedly, the extent to which this is possible depends on the circumstances of the individual case, but it remains the position that the payment of claims fees for claims exceeding the number of ten may have a useful purpose on its own independently from the question whether all the claims concern unitary subject-matter.

6. *Entering into force of EPC 2000*

6.1 Therefore, it is irrelevant whether, as the appellant asserts, the decision not to pay additional search fees

in the international phase was taken at a time when it was not known when the EPC 2000 would enter into force and, so the appellant says, at a time when it was under the impression that additional search fees could be paid in response to a communication under Rule 112 EPC 1973 after entry into the regional phase. Whether or not the appellant was under this impression, for the reasons given above it does not affect the legal position as regards the justification for the required payment and non-refundability of claims fees for claims exceeding ten in number, unless the conditions of Rules 162(3), 161 EPC (Rules 110(3), 109 EPC 1973) are met, which is undoubtedly not the case with respect to the present application.

7. *"Delay" by the Office*

7.1 The appellant further asserts that since the entry into the regional phase in this case took place before the entry into force of EPC 2000, the Office should have sent a communication under Rule 112 EPC 1973, but instead "chose" to send a communication under Rules 161 and 162 EPC instead. It is said that this arbitrary "delay" deprived the applicant of the opportunity of pursuing claims in the Euro-PCT application upon payment of additional search fees and that the present situation is at least partly attributable to this "delay" on the side of the Office.

7.2 Although the appellant has made it clear that it does not accuse the Office of acting in bad faith, the argument proceeds on the basis that the Office was at fault. The Board does not accept this. The appellant filed the form for entry into the European phase on

8 November 2007 and the Receiving Section perfectly promptly issued its communication under Rules 161 and 162 EPC on 16 January 2008. In any event, however, the appellant has not put forward any legal reason why the claims fees should have become repayable even if the Office had issued a communication under Rule 112 EPC 1973 before 13 December 2007. The argument is rejected.

8. *Request to prosecute all claims*

8.1 The appellant alternatively requests to be permitted to prosecute all claims in the application subject to payment of additional search fees, with a refund of all fees paid on the related divisional application EP 08164537.6 (which would then be withdrawn).

8.2 The appellant has not suggested any legal basis for the making of such an order, and the Board cannot itself see any basis for doing so in the context of the present appeal proceedings. The only subject of the present appeal proceedings is the appealed decision, i.e. its rejection of the appellant's request for refund of claims fees paid. Nothing else having been decided by the Examining Division, any decision on the appellant's requests referred to above would exceed the decision making power of the Board in the present proceedings.

9. *Conclusions*

9.1 For the above reasons, the appellant's requests cannot be granted.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairwoman:

W. Roepstorff

B. Günzel