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**Datasheet for the decision  
of 12 December 2013**

**Case Number:** J 0014/12 - 3.1.01

**Application Number:** 10185974.2

**Publication Number:** 2280093

**IPC:** C23C14/34, C23F3/00, C23F1/16

**Language of the proceedings:** EN

**Title of invention:**  
Method of manufacturing enhanced finish sputtering targets

**Applicant:**  
Praxair S.T. Technology, Inc.

**Headword:**

**Relevant legal provisions:**

EPC Art. 86(1) sentence 1, 86(1) sentence 2  
EPC R. 51(2), 51(3) sentence 1, 51(3) sentence 2, 103(1) (a)  
Rules relating to Fees (as amended by the decision of the  
Administrative Council of 9 December 2008) Art. 2(1)  
Rules relating to Fees (as amended by the decision of the  
Administrative Council of 9 December 2008) Art. 5(1)  
Rules relating to Fees (as amended by the decision of the  
Administrative Council of 9 December 2008) Art. 5(2)  
Arrangement for deposit accounts (valid as from 1 April 2009)  
6.1  
Arrangement for deposit accounts (valid as from 1 April 2009)  
6.2  
Arrangement for deposit accounts (valid as from 1 April 2009)  
6.3  
Schedule of fees and expenses of the EPO (applicable as from 1  
April 2010) 1.A.5

**Keyword:**

Refund of additional fees relating to renewal fees  
Reimbursement of appeal fee - (no)

**Decisions cited:**

T 0170/83, T 0152/82, T 0087/88, T 0538/89, T 0182/92

**Catchword:**



**Juristische Beschwerdekammer**  
**Legal Board of Appeal**  
**Chambre de recours juridique**

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Case Number: J 0014/12 - 3.1.01

**D E C I S I O N**  
**of Legal Board of Appeal 3.1.01**  
**of 12 December 2013**

**Appellant:** Praxair S.T. Technology, Inc.  
(Applicant) 441 Sackett Point Road  
North Haven, CT 06473 (US)

**Representative:** Schwan - Schwan - Schorer  
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**Decision under appeal:** **Decision of the Receiving Section of the European Patent Office posted on 2 March 2012 refusing the applicant's request for refund of the additional fees relating to the renewal fees for 3rd to 12th years.**

**Composition of the Board:**

**Chairwoman:** B. Guenzel  
**Members:** W. Sekretaruk  
T. Karamanli

## **Summary of Facts and Submissions**

- I. European patent application No. 10185974.2 was filed on 1 October 2010 as a divisional application of European patent application No. 99968653.8. That earlier application had been filed on 2 September 1999. On filing the divisional application on EPO Form 1001E, no mode of payment was specified under point 42 "Payment" of that form. An "Internal fee calculation sheet", which is automatically generated by default by the online filing system using the data entered in EPO Form 1001E, was attached to the form in which the filing fee, the fee for a European search and the renewal fees for the 3rd to 10th years were listed by the applicant.
  
- II. With a letter dated 20 October 2010, received by the European Patent Office (EPO) on 21 October 2010 (in the following: "letter of 20 October 2010") the applicant's representative requested that the fees which fell due for payment with the filing of the divisional application be debited, without indicating the purpose of the payment in greater detail. On the basis of this request the Receiving Section gave the instruction to debit the filing fee and the search fee.
  
- III. No renewal fees for the 3rd to 12th years were paid by the applicant, or debited from the representative's account on the basis of his request of 20 October 2010, within four months after the filing date.
  
- IV. After having been informed accordingly by the EPO, the applicant's representative, on 14 March 2011, paid the renewal fees for the 3rd to 12th years and the additional fees of 50% relating to all of those renewal fees. Together with these fees, the filing fee and the

search fee were paid a second time; this second payment has since been refunded by the EPO.

V. With a letter dated 18 March 2011, the appellant requested, as a main request, that the additional fees for the 3rd to 12th years be refunded, and, as an auxiliary request, that the additional fees relating to the renewal fees for the 3rd to 10th years be refunded. It takes the view that the respective renewal fees for the 3rd to 12th years were paid in time. After having realized the omission in EPO form 1001E, the appellant, with its letter of 20 October 2010, had requested that the fees which fell due in relation to the filing of the divisional application be debited. This authorization constituted a timely payment of all fees listed on the "Internal fee calculation sheet" of the EPO, including the fees for the 3rd to 10th years. The same applied for the 11th to 12th years following decisions T 170/83, Reasons, pt. 6, and T 152/82, Reasons, pts. 8 and 9.

VI. With its decision of 2 March 2012, the Receiving Section rejected both the main and the auxiliary request as far as the refund of the additional fees relating to the renewal fees for the 3rd to 12th years or the 3rd to 10th years respectively was concerned. Pursuant to Rule 51(3) EPC renewal fees were payable to the EPO. They were due in respect of the third year and each subsequent year. In case of a divisional application where renewal fees for the parent application had already fallen due, these renewal fees had also to be paid for the divisional application calculated from the date of filing of the parent application. The period for payment was four months from the filing of the divisional application. If not paid in due time, the fees might still be validly paid

within six months of the date the divisional application was filed provided that at the same time the additional fee of 50% of the late-paid renewal fees was paid (Art. 2(1) No. 5 RFees). The instruction to debit the filing fee and the search fee on the basis of the applicant's request of 20 October 2010 was made erroneously. As in the representative's request on EPO form 1001E no mode of payment was specified and no deposit number was indicated, a clear, unambiguous and unconditional debit order within the time-limit of four months would have been necessary. The letter dated 20 October 2010 could not qualify as such an order, as it did not contain the necessary details. The "Internal fee calculation sheet", which was part of online form 1001E and gave an overview of the fees due to be paid, was automatically generated by the EPO system for the convenience of the applicant and was not uploaded into the EPO's electronic file. Consequently, no valid debit order was on file during the four-month time-limit from filing of the divisional application, and the payment made on 14 March 2011 (renewal fees for the 3rd to 12th years and additional fees) was in the correct amount and therefore, the additional fee could not be refunded.

- VII. The applicant filed a notice of appeal on 23 April 2012 and requested that the impugned decision be set aside, and, as a main request, that the additional fees paid for the 3rd to 12th annuities be refunded, or, as an auxiliary request, that those additional fees paid for the 3rd to 10th annuities be refunded. The appeal fee was received on the same day.
- VIII. In its grounds of appeal filed on 29 June 2012 the appellant argued that when filing the divisional application on 1 October 2010 via the EPO's filing

software it had indicated the filing fee, the search fee and the renewal fees for the 3rd to 10th years by submitting the "Internal fee calculation sheet" (a copy of which was attached to the grounds of appeal as ANNEX A). It inadvertently had omitted to indicate the deposit account number from which the above-mentioned fees should be debited. After having noticed this omission, the applicant, on 20 October 2010, sent a letter to the EPO, in which it was stated clearly and unambiguously:

"It is kindly asked to debit the fees which fell due for payment with the filing of the above-mentioned divisional application from deposit account No. 28000610".

Consequently, a payment via a deposit account debit order had to be considered to have been timely made, and following decision T 170/83, Reasons, pt. 6, this applied to the fees for the 11th and 12th years, irrespective of whether the fees for the 11th and 12th years were listed in the "Internal fee calculation sheet". The applicant had at least every reason to assume that all necessary information was given to the EPO in order to debit all due fees, as the filing fee and the search fee could correctly be debited and no request for communication of the purpose of the payment according to the Guidelines for Examination in the EPO, Part A, Chapter XI-7.1.2 was sent to the applicant. This view was in line with decision T 152/82, in which it was held that a debit order had to be carried out notwithstanding incorrect information given in it if the intention of the person giving the order was clear. Such was the case here. The payment of 14 March 2011 of the fees including the additional fee was only a precautionary measure. If the Board could not accept the foregoing arguments, at least the auxiliary request should be granted because the applicant's

submission of 20 October 2010 had to be read in combination with the "Internal fee calculation sheet" submitted with the application which contained an express indication of the fees for the 3rd to 10th years. It could not play any role that the "Internal fee calculation sheet" was not uploaded into the EPO's electronic file. In any event the EPO had to be taken as having knowledge of its own procedures; additionally the "Internal fee calculation sheet" was part of the documents accompanying the application. Further, reimbursement of the appeal fee was requested because the Receiving Section's failure to carry out the applicant's debit order constituted a substantial procedural violation. Finally the appellant requested oral proceedings "for the event that neither the Main Request nor the Auxiliary Request should not be granted".

### **Reasons for the Decision**

1. The appeal is admissible. In respect of the auxiliary request it is also allowable. Hence there was no need to appoint oral proceedings since the appellant only requested oral proceedings if neither its main nor its auxiliary request were allowable.
  
2. Under Article 86(1), first and second sentences, EPC renewal fees for the European patent application shall be paid to the EPO in accordance with the Implementing Regulations. These fees shall be due in respect of the third year and each subsequent year, calculated from the date of filing of the application. Rule 51(3), first sentence, EPC provides that renewal fees already due in respect of an earlier application at the date on which a divisional application is filed shall also be



paid for the divisional application and shall be due on its filing. On 1 October 2010, the filing date of the divisional application, renewal fees for the earlier application with the filing date of 2 September 1999 had fallen due for the 3rd to 12th years (2000 - 2011).

3. These fees and any renewal fee due within four months of filing the divisional application may be paid within that period without an additional fee (Rule 51(3), second sentence, EPC). As Rule 51(2) EPC also provides, in case a renewal fee is not paid in due time, the fee may still be paid within six months of the due date, provided that an additional fee is also paid within that period. Consequently, payment of the renewal fees that fell due for the present divisional application could be made until 1 February 2011 without an additional fee and until 1 April 2011 with an additional fee of 50% of the belated renewal fee (Article 2(1) Rules relating to Fees of 20 October 1977 as adopted by the decision of the Administrative Council of the European Patent Organization of 7 December 2006 and as [last] amended by the decision of the Administrative Council of 9 December 2008, Supplement to OJ EPO 2/2009 (RFees) and Schedule of fees and expenses of the EPO (applicable as from 1 April 2010), 1 A.5, see Supplement 1 to OJ EPO 3/2010).
  
4. On 20 October 2010 the applicant's representative wrote a letter to the EPO which included the following wording:  
"It is kindly asked to debit the fees which fell due for payment with the filing of the above-mentioned divisional application from deposit account No. 28000610."

5. This mode of payment is not provided for in Article 5(1) RFees 2008.
  
6. Under Article 5(2) RFees 2008 the President of the EPO may allow other methods of paying fees than those set out in paragraph 1. In the Arrangements for deposit accounts (ADA) and their annexes (valid as from 1 April 2009), Supplement to OJ EPO 3/2009, the President of the EPO made available debiting procedures in respect of fees (pt 6.1 ADA). Debiting occurs in principle on the basis of a debit order signed by the account holder and may be a debit order for individual fees that may be filed on paper, preferably on EPO form 1010 (pt. 6.2 ADA ). The debit order must be clear, unambiguous and unconditional. It must contain the particulars necessary to identify the purpose of the payment, including the amount of each fee or expense concerned, and must indicate the number of the account which is to be debited. Provided there are sufficient funds in the deposit account to cover the total fee payments indicated for the application referred to in the order or, in the case of an order containing a list of applications for each application referred to, this date is considered to be the date on which payment is made (pt 6.3 ADA).
  
7. When read in conjunction with the "Internal fee calculation sheet", the debit order received on 21 October 2010, in which it was asked to debit the fees which fell due for an explicitly mentioned divisional application, was clear, unambiguous and unconditional as regards the 3rd to 10th renewal fees. The debit order also indicated the number of the account which was to be debited. In the Board's judgment, in the case at hand, the purpose and amount of each of these fees were clearly derivable from the

"Internal fee calculation sheet", including the renewal fees for the 3rd to 10th years. By debiting the filing fee and the fee for a European search the EPO showed that it heeded the debit order in combination with the "Internal fee calculation sheet", filed as an attachment to the application, irrespective of whether it was obliged to do so or whether the "Internal fee calculation sheet" was uploaded to the electronic file. Consequently, 21 October 2010 is to be considered as the date on which the payment for the renewal fees for the 3rd to 10th year was made and, in relation to these years, no additional fee fell due. Payments of fees made without a legal basis are to be reimbursed.

8. As to the renewal fees for the 11th and 12th years, the purpose and the amount of each of these fees were neither stated in the debit order nor were they contained in the "Internal fee calculation sheet". As a consequence, the conditions for a valid debit order set out in the ADA as mentioned above were not fulfilled. A valid payment was effected on 14 March 2011 only, i.e. within the six-month time-limit provided for in Rule 51(3) EPC. Consequently, in respect of the renewal fees for the 11th and 12th years, the additional fees fell due and cannot be reimbursed.
9. No different conclusion can be drawn from the decisions of the Board of Appeal in cases T 170/83 (OJ EPO 1984, 605) or T 152/82 (OJ EPO 1984, 301). Decision T 170/83 dealt with a case in which the purpose (payment of the opposition fee) was clear. The same applies in relation to decision T 152/82 in which the purpose of the payment (appeal fee) was explicitly indicated.
10. Consequently, the appellant's main request is not allowable, but the auxiliary request can be allowed.

11. The conditions for reimbursement of the appeal fee are not met in the present case. Under Rule 103(1)(a) EPC the appeal fee shall be reimbursed where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation. The Board cannot identify any procedural deficiencies. In the present decision, the Board is taking a view on the question of interpretation of the applicant's debit order that differs from that of the Receiving Section. However, the fact that the Board has come to a different conclusion from the department of first instance does not by itself mean that the latter committed a substantial procedural violation (see for example decisions T 87/88, OJ EPO 1993, 430; T 538/89 of 2 January 1991, T 182/92 of 6 April 1993) but is rather a matter of judgment, which does not amount to a procedural violation (see for example decision T 182/92, Reasons, pt. 7 and Case Law of the Boards of Appeal of the EPO, 7th edition 2013, IV.E.8.3.5). Consequently, the request for reimbursement of the appeal fee must be refused.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside insofar as the refund of the additional fees relating to the renewal fees for the 3rd to 10th years is concerned. For the remainder the appeal is rejected.
2. The reimbursement of the additional fees relating to the renewal fees for the 3rd to 10th years is ordered.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairwoman:



C. Eickhoff

B. Guenzel

Decision electronically authenticated