

**Europäisches
Patentamt**

Beschwerdekammern

Case Number : J 14 /85

**European Patent
Office**

Boards of Appeal

**Office européen
des brevets**

Chambres de recours



**Correction Order of 18.08.86
to the D E C I S I O N
of the Legal Board of Appeal
of 30 July 1985**

Appellant : SUNTORY LIMITED
Osaka, Japan

Representative : Paget, Hugh Charles Edward
MEWBURN ELLIS & CO.
2/3 Cursitor Street
London EC4A 1BQ

Decision under appeal : Decision of the Formalities Officer acting for
the Examining Division of the European Patent
Office dated 4 March 1985 refusing a request
for repayment of the examination fee paid in
respect of European patent application
No. 83 300 695.0

Composition of the Board :

Chairman : P. Ford

Member : O. Bossung

Member : R. Payraudeau

Correction Order to the Decision of the Legal Board of Appeal
dated 30 July 1985.

The date of this Decision is hereby amended in accordance with
Rule 89 EPC to read 30 July 1986.

The Registrar

The Chairman



B. A. Norman



P. Ford

Veröffentlichung im Amtsblatt	Ja/Non
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	Oui/Non

Aktenzeichen / Case Number / N^o du recours : J 14/85
Anmeldenummer / Filing No / N^o de la demande : 83 300 695.0
Veröffentlichungs-Nr. / Publication No / N^o de la publication : 0 086 638
Bezeichnung der Erfindung: Tobacco Smoke Filter
Title of invention:
Titre de l'invention :
Klassifikation / Classification / Classement : A 24 D 3/06

ENTSCHEIDUNG / DECISION

vom / of / du 30 July 1985/6

Anmelder / Applicant / Demandeur : SUNTORY LIMITED
Patentinhaber / Proprietor of the patent /
Titulaire du brevet :
Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Repayment of examination fee
EPÜ / EPC / CBE Article 94(2) EPC

Leitsatz / Headnote / Sommaire

If a European patent application is withdrawn after responsibility for examination has passed to an Examining Division in accordance with Articles 16 and 18(1) EPC but before examination has in fact been commenced by the Division, the examination fee cannot be repaid unless there is some legal impediment to commencement of examination. The EPC does not prohibit repayment but there is no provision in the Implementing Regulations or the Rules relating to Fees which allows it.



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SUMMARY OF FACTS AND SUBMISSIONS

I. European patent application No. 83 300 695.0 was filed on behalf of the Appellant on 11 February 1983 claiming priority from a Japanese national application filed on 16 February 1982. The request for examination was made on the printed Request for Grant form.

Publication of the European patent application under No. 0 086 683 was notified in the European Patent Bulletin dated 28 March 1984 so that the period for making the request for examination expired on 28 September 1984. A second request for examination was filed on 28 August 1984 and the examination fee was duly paid. The Receiving Section recorded in the file on 18 September 1984 that a valid request for examination had been made.

II. On 18 September 1984 by telex, duly confirmed by letter received on 24 September 1984, the Appellant's representative withdrew the European patent application and requested a refund of the examination fee. He pointed out that the last day for payment of the examination fee had not been reached and he explained that he had understood his instruction from Japanese patent attorneys to pay the examination fee shortly before the due date as a definite instruction but, in fact, it had only been intended as a precaution, in default of subsequent definite instructions.

III. By the decision under appeal, dated 4 March 1985, the Head of Formalities Section of Directorate General 2 refused the request for repayment of the examination fee on the ground that since a fee is due on the date of the receipt of the request for the services incurring the fee concerned (Article 4(1) Rules relating to fees) a refund is possible only if there is express provision for it, as in Article 77(5) and Rules 31(3) and 67 EPC. A further basis for

ruling out a refund was that an examination fee does not cover the actual cost of examination. Furthermore, the Examining Division had no discretion to refund the examination fee, since responsibility for the application had passed from the Receiving Section to the Examining Division (cf. Legal Advice No. 1/79, OJ EPO 1979, 61).

IV. On 2 May 1985 the Appellant gave notice of appeal and the appeal fee was duly paid. The Statement of Grounds of the appeal was filed on 6 May 1985. Following a communication from the Board dated 9 January 1985, the Appellant filed observations by letter dated 19 February 1985.

V. The Appellant argued essentially as follows:

The decision under appeal had held that an examination fee could not be repaid once it had become due, i.e. once a request for examination had been made, which, in the present case, had occurred on the filing of the application. This view went too far, in view of the provisions of Article 94(2) EPC, which allows an applicant to delay filing his request for examination and paying the fee for examination until the end of six months after publication of the European search report. If the decision under appeal were right, there could never be a refund when the request for examination had been made at the time of filing. However, nothing in the EPC, the Implementing Regulations or the Rules relating to Fees operated to prevent such a refund, provided it was requested before the end of the period prescribed in Article 94(2) EPC.

Furthermore, the Guidelines for Examination (Part A, Chapter XI, 10.1) showed that there was a distinction between the "due date" for payment and the actual date of payment. Accordingly, the EPO had a discretion to refund an examination fee if this was requested before the end of the six months period. Repayment was justified if the

application were withdrawn before examination could begin. The possibility of obtaining repayment gave the applicant an incentive to save the EPO the work of carrying out an unnecessary examination.

The previous decisions J 06/83 (OJ EPO 1985, 97) and J 08/83 (OJ EPO 1985, 102) did not rule out repayment of the examination fee. Finally, the Guidelines (Part A, Chapter XI, 10.2.7) indicated that the printing fee could be repaid if an application were withdrawn at a time when publication could still be prevented.

- VI. The Appellant requested that the decision under appeal be set aside and the appeal fee be refunded.

REASONS FOR THE DECISION

1. The appeal complies with Articles 106-808 EPC and Rule 64 EPC and is, therefore, admissible.
2. The decision under appeal correctly held that there is no express provision in the EPC, the Implementing Regulations or the Rules relating to Fees, for the refund of the examination fee which has been paid when it is due. Nevertheless, the decision acknowledged that the EPO does refund the fee in the circumstances referred to in Legal Advice No. 1/19 (OJ EPO 1979, 61), namely when the European Patent application is withdrawn during the procedure before the Receiving Section.
3. Consideration of Legal Advice No. 1/79 and of two decisions of the Legal Board of Appeal in which refund of the examination fee was ordered (Case J 06/83, OP EPO 1985, 97 and Case J 08/83, OJ EPO 1985, 102) shows that there is a principle of law common to the Legal Advice and to both cases, namely that an examination fee which has been paid is

to be refunded if the EPO is precluded by law (in particular, the provisions of the EPC and, where applicable, the PCT) from commencing substantive examination at the date of actual or deemed withdrawal of the application. This is clearly so if responsibility for the application has not passed to the Examining Division in accordance with Articles 16 and 18 (1) EPC. It will also be so if, although responsibility has passed to the Examining Division, there is some other legal impediment. In Case J 06/83, it was held that examination was precluded by law at the date of withdrawal because the mandatory supplementary European search report had not been drawn up in respect of an international application. (cf. Gall, MÜNchner Gemeinschaftskommentar, Art. 51 Gebührenordnung, nos. 378-392).

4. In the present case, the Board considers that examination had been effectively requested and was not precluded by law at the date of withdrawal of the application in September 1984. In accordance with the provisions of Article 94(2) EPC, second sentence, the Appellant's request for examination, made on the Request for Grant form, is not deemed to have been filed until after the examination fee was paid in August 1984. Accordingly, as the European search report had already been transmitted to the Appellant in January 1984, this was not a case in which an invitation to indicate whether he desired to proceed further with the application had to be sent in accordance with Article 96(1) EPC.
5. There is no express bar to a refund of the examination fee, in the Convention, the Implementing Regulations or the Rules. Therefore, the Appellant contends that the EPO has a discretion to make a refund in the circumstances of the present case, in which the application was withdrawn so soon after the examination fee was paid that examination could not in fact have been commenced. Reliance is placed, inter

alia on observations in Case J 08/83 that the opportunity to withdraw a case operates to the benefit of all parties and that the prospect of a refund is an incentive to withdraw cases which are unlikely to succeed.

6. This argument has to be rejected. The observations made in Case J 08/83 (Reasons for the Decision, para. 6) related specifically to the policy behind Article 96(1) EPC and cannot be used to support an argument for the existence of a general discretion. The refund of fees is never a matter of discretion under the EPC, the Implementing Regulations and the Rules. If there is to be a refund, it is a matter of right, either because the fee paid was never due or because the service for which it was paid cannot be provided owing to some legal impediment or because there is express provision for repayment, as in Article 77(5) EPC and Rules 31(3) and 67 EPC and Article 10(4), Rules relating to Fees. The last-mentioned Article expressly provides for the full refund of the search fee if a European patent application is withdrawn or refused or deemed to be withdrawn at a time when the EPO has not begun to draw up the European search report. The Board finds itself unable to imply a corresponding rule, by analogy, to the refund of the examination fee in circumstances such as those of the present case.

7. The Appellant's argument that at the time the examination fee was paid it was not due, as the period under Article 94(2) EPC was still running, cannot be followed. The request for examination is made dependent on the payment of a fee on the applicant's own initiative - as are other requests e.g. for re-establishment of rights and for appeal. The request becomes effective once the fee is paid and thereafter, unless there is a legal basis for repayment, repayment cannot be demanded even if it is desired to withdraw the request or the European patent application.

This point was drawn to the attention of the Appellant in the Rapporteur's communication. In reply, the Appellant argued that because, in accordance with Article 94(2) EPC, second sentence, a request for examination is not deemed to have been filed until after the fee has been paid the fee is never due within the meaning of Article 4, Rules relating to Fees (which provides that a fee is due on the date of receipt of the request for the service incurring the fee). Accordingly Article 4 of those Rules had to be disregarded as inapplicable and Article 94 (2) EPC effectively set the due date for payment. This argument must also be rejected. There is no incompatibility between Article 4, Rules relating to Fees and Article 94 (2) EPC, since the actual filing of the request makes the fee due and the real effect of Article 94(2) EPC, second sentence, is that the request may not be acted upon unless and until the fee has been paid. If the fee is not paid by the end of the period prescribed in Article 94(2) EPC, first sentence, or by the end of the period of grace provided by Rule 85 b EPC, the request may never be acted upon.

8. The Appellant has also pointed out that the Guidelines (Part A, Chapter XI, para. 10.2.7) state that the fee for printing can be repaid if the European patent application is withdrawn at a time when it is still possible to stop publication. The Guidelines also state that the fee for grant will be refunded if the application is withdrawn before communication of the decision to grant (loc. cit., para. 10.2.6). The applicability of these statements, by analogy, to the present case cannot be accepted as justified.

9. For the foregoing reasons, the appeal must be rejected and the decision under appeal affirmed. It must, however, be observed that insofar as the decision under appeal stated that a further basis for ruling out a refund of the examination fee was that the fee does not cover the cost of examination, this reasoning cannot be supported. There are many circumstances in which a fee which does not cover the costs of providing the service in question may be refunded in accordance with the EPC : Rule 67 EPC (reimbursement of the appeal fee) is a good example.
10. In the present case, the requirements of Rule 67 EPC are not fulfilled : the appeal is not allowed and there was, in any case, no procedural violation. The request for reimbursement of the appeal fee must, therefore, be refused.

ORDER

For these reasons, it is decided that:

The appeal against the decision of the Head of the Formalities Section of Directorate General 2 dated 4 March 1985 is dismissed.

Registrar:

Chairman:



J. Rückerl



P. Ford

