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File No.: J 0025/92 - 3.1.1
Application No.: 89 909 962.6
Publication No.:
Classification: H01B 1/22
Title of invention: Process for making noble metal coated metallic particles, and resulting conductive materials

D E C I S I O N
of
29 September 1993

Applicant: Ostolski, Marian J.
Proprietor of the patent: -
Opponent: -

Headword: Metallic particles/OSTOLSKI

FPC: Art. 39(1)(a)
EPC: Art. 150(2), 94(2), 94(3), R. 104(1)(b)

Keyword: "Payment of examination fee" - "Lack of a specific written request"

Catchwords

If an examination fee plus a surcharge has been paid in due time, and if there is any doubt in the EPO's mind as to whether the Applicant intends to request examination, it is the duty of the EPO to warn the Applicant of the impending loss of rights due to the lack of a specific written request for examination (J 13/90 dated 10 December 1992 followed, headnote published in OJ 1993 issue 6 page XII).



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Patentamt

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Boards of Appeal

Chambres de recours

Case Number: J 0025/92 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 29 September 1993

Appellant: Ostolski, Marian J.
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Representative: Pennant, Pyers
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Decision under appeal: Decision of the Receiving Section of the European Patent Office dated 12 March 1992 according to which European patent application No. 89 909 962.6 was deemed to be withdrawn pursuant to Article 94(3) EPC.

Composition of the Board:

Chairman: R. Schulte
Members: J.P.B. Seitz
G. Davies

Summary of Facts and Submissions

- I. Euro-PCT patent application No. 89 909 962.6 was filed with the USPTO on 28 August 1989, claiming a US priority of 29 August 1988. The EPO is acting as an elected office.

The 30-month period of Article 39(1)(a) PCT expired on 28 February 1991, and the one-month time limit of Rule 104(1)(b) EPC (former version) on 28 March 1991.

- II. A communication pursuant to Rule 85(b) EPC was dispatched on 2 April 1991 and addressed directly to the Applicant as no representative had yet been appointed.

He was informed that a valid request for examination had not been filed within the time limit laid down in Article 150(2) EPC and that he still had the possibility of rectifying this deficiency within a one-month period of grace following notification of this communication.

- III. On 12 April 1991 the examination fee and the requisite surcharge were paid together with the national fee, the search fee, the designation fees, the renewal fee for the third year and the claims fees.

- IV. EPO Form 1200 normally used for Euro-PCT applications and concerning the entry into the regional phase before the EPO, as designated or elected office, was filed on 7 June 1991 together with the representative's authorisation.

- V. On 17 June 1991 a notification was dispatched pursuant to Rule 69(1) EPC informing the representative that the application was deemed to be withdrawn on the ground

that the written request for examination had been filed on 7 June 1991, i.e. after expiry of the prescribed time limit.

VI. By letter dated 29 July 1991 and received on 5 August 1991, the representative requested re-establishment of rights. The corresponding fee was paid on the same day.

VII. By letter dated 16 August 1991 and received on 22 August 1991, the representative applied for a decision under Rule 69(2) EPC. He submitted that the notification, pursuant to Rule 69(1), issued on 17 June 1991, was inaccurate on the ground that a valid request for examination was to be found in his letter to the Office dated 12 April 1991.

He pointed out that any deficiency in that request should have been notified to him in time so that he could have made the necessary correction before expiry of the time limit.

He also submitted that the communication pursuant to Rule 85(b) EPC either had not been sent by the EPO or had not been received by the Applicant.

VIII. In its decision, notified by registered letter dated 12 March 1992, the Receiving Section of the EPO:

- maintained the communication pursuant to Rule 69(1) EPC,
- refused the request for re-establishment of rights in relation to the time limit for filing the written request for examination.

IX. By letter dated 27 April 1992 and received at the EPO on 29 April 1992 the Applicant appealed against this decision.

He paid the corresponding fee on the same date and filed a written statement on 14 July 1992 setting out the grounds of appeal.

X. The Appellant puts forward two alternative contentions:

- the letter of 12 April 1991 constituted a correct request for examination in addition to providing payment of the examination fee; and
- as the Applicant's intention to file such a request may be assumed without any doubt from his letter of 12 April 1991, it is fair to re-establish his rights since his representative has demonstrated that he has acted with all the due care required by the circumstances.

Reasons for the Decision

1. The appeal complies with the requirements of Article 108 and Rule 68 EPC and, therefore, is admissible.
2. It is not contested, pursuant to Article 39(1)(a) PCT, Articles 150(2), 94(2) EPC and Rule 104(1)(b) (former version) EPC, that a request for examination had to be filed at least before the end of a 31-month period from the priority date, i.e. before 28 March 1991.

It is also not contested that, since at this date no request for examination had been filed and that no corresponding fee had been paid, the Receiving Section

of the EPO dispatched a communication pursuant to Rule 85(b) EPC directly addressed to the Applicant who had not yet authorised a professional representative entitled to act in the proceedings before the EPO. This communication, however, was not received.

The examination fee and the corresponding fee charges were paid in due time on 12 April 1991.

The written request for examination was filed with EPO Form 1200 on 7 June 1991 after expiry of the period of grace provided for in Rule 85(b) EPC.

3. The first problem to be dealt with in this case is to establish whether the payment of the examination fee made before expiry of the aforesaid period of grace may be regarded as a valid filing of the corresponding request.

In a decision dated 11 March 1983 (J 12/82, OJ EPO 1983, 221) on which the decision under appeal mainly relied, the Legal Board of Appeal stated that:

"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 other within the specified period.

The Article would otherwise have been worded differently."

This decision concerns a European patent application filed on 23 October 1980, i.e. at a time when the EPO Form 1001.1 for request for grant prescribed by the decision of the President of the EPO dated 2 October 1981, did not exist.

The provision in that new Form for immediate and automatic filing of the written request for examination in Part XIV was intended to obviate the danger of the Applicant losing his rights - despite having paid the examination fee in due time - because of failure to file the corresponding request within the prescribed time limit.

A further decision of the EPO dated 25 July 1986 prescribed a new version of the request for grant form, wherein the content differed from the previous one in that the wording of the requests for grant and examination were combined and condensed and a cross was preprinted in the relevant box to safeguard the Applicant's rights.

The present Form 1001.01.90 is worded in the same terms relating to request for grant and examination.

In the Guide for Applicants, "How to get a European patent", published by the EPO, the request for examination is described as an integral part of the request for grant (paragraph 152).

In the Guide it is stated, however:

- that a valid request for examination will not be deemed to be filed until after the examination fee has been paid; and

- that the only case in which the request for examination may be considered not to have been filed would be where the preprinted mention in Form 1001 had been deleted by the Applicant; however this would present the problem that the requests for grant and examination are combined therein.

In other words, and insofar as the Applicant for a European patent application must use the EPO forms, he now only has to ensure that the examination fee is paid in time as the first condition pointed out by the Board of Appeal in J 12/82 is in fact always fulfilled. That means that the payment of the fee in due time really constitutes the request.

The question to be solved remains that of the application *mutatis mutandis* of the same procedure to a Euro-PCT application, which is deemed to be a European application, when the EPO acts, as in the present case, as a designated office or elected office (Article 150(3) EPC).

For the entry into the regional phase before the EPO as designated or elected office, the request for examination consists of a written request already included in Form 1200 (cross preprinted in Section 4 of the form). Use of that form, although recommended, is not obligatory, so that an Applicant, when entering the regional phase before the EPO as designated or elected office, may file any kind of written request provided that it is unequivocal or clear.

In the present case, although the Appellant submitted that his letter dated 12 April 1990 should be considered as a written request for examination, the first instance did not consider it as such and took it merely as a payment order for various fees.

The Receiving Section took the same view, as it kept silent from 12 April 1990 until 12 May 1990 regarding the date of expiry of the period of grace for filing a request for examination.

To explain its attitude, the first instance pointed out in the appealed decision that:

- (a) on the one hand, an Applicant may also pay the examination fee when he is uncertain whether he really wants to proceed and in particular because, if he finally does decide to drop the case, he then obtains a refund of the fee; and
- (b) on the other hand, the EPO is under no obligation to send a reminder in such circumstances. Although the Office does provide such services, these remain purely courtesy services.

(a) This opinion is unconvincing and fully unrealistic. Normally an applicant does not pay a fee in doubtful circumstances but only to discharge a debt that really exists. If he intends only to pay a fee as a precaution he will make his reservation clear.

However, this is not the case here. A fair interpretation of the letter dated 12 April 1991, which the Board regards as having been in fact a response to the communication of 2 April 1991, leads to the conclusion that the Applicant did not pay the fees as a precaution but obviously wanted to file an unequivocal request for examination in order to comply with the aforesaid communication.

(b) This opinion is also incorrect, as the principle of good faith requires the EPO to warn an Applicant of any impending loss of rights, if such a warning can be

expected in all good faith and if the deficiency is readily identifiable and capable of being corrected within the time limit (J 13/90 dated 10 December 1992, headnote published in OJ EPO 1993, issue 6, page XII).

If such a warning can be expected but is not issued to the Applicant within the time limit to be observed, the EPO must set a period within which the Applicant may correct the deficiency and perform the procedural act in due time.

In the present case, the EPO:

- which had issued the notification directly to the Applicant himself in accordance with Rule 85(b) because he had not yet authorised a representative entitled to act before the EPO, and
- which had received from a newly appointed representative a month before expiry of the time limit the payment of the examination fee plus surcharge,

should at the least, if there were any doubt in its mind as to the intention of the Applicant to request the examination, have warned the representative of the impending loss of rights due to the lack of a specific written request.

For these reasons, the decision under appeal has to be set aside, the request for examination being deemed to have been filed on 12 April 1991, i.e. within the period of grace laid down in the communication issued on 2 April 1991.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The request for examination for Euro-PCT application No. 89 909 962.6 is deemed to have been filed on 12 April 1991.
3. The case is remitted to the Receiving Section for further processing.

The Registrar:



J. Rückerl

The Chairman:



R. Schulte