

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen

D E C I S I O N
of 18 September 1997

Case Number: J 0006/96 - 3.1.1

Application Number: 94902270.1

Publication Number: 0646000

IPC: A61K 9/14

Language of the proceedings: EN

Title of invention:

Compositions using microencapsulated neutralizing antibodies

Applicant:

CORPORATION OF MERCER UNIVERSITY

Opponent:

-

Headword:

claims fees/MERCER UNIVERSITY

Relevant legal provisions:

EPC Art. 78(1), 150(3), 157(1) and (3), 158

EPC R. 31(1), 86(1), 104b(1)

PCT Art. 18, 19, 22(1), 28

PCT R. 46

Keyword:

"Ultimate date for the calculation of the claims fees under
Rule 104b(1) EPC"

Decisions cited:

J 0009/84

Catchword:

-



Case Number: J 0006/96 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 18 September 1997

Appellant: CORPORATION OF MERCER UNIVERSITY
1400 Coleman Avenue
Macon, GA 31207 (US)

Representative: Perry, Robert Edward
GILL JENNINGS & EVERY
Broadgate House
7 Eldon Street
London EC2M 7LH (GB)

Decision under appeal: Decision of the Receiving Section of the European Patent Office dated 13 June 1995 refusing the refund of claims fees (European patent application No. 94 902 270.1).

Composition of the Board:

Chairman: J.-C. Saisset
Members: J. C. M. De Preter
M. K. S. Aúz Castro

Summary of Facts and Submissions

- I. Euro-PCT application No. 94 902 270.1 comprising 72 claims was filed on 16 November 1993 claiming US priority of 16 November 1992.
- II. On 7 July 1994 the international application together with the international search report of 27 January 1994 was transmitted to the EPO as designated office.
- III. On 11 July 1994 the Receiving Section sent a communication to the US representative about the procedural steps to be taken for entry into the regional phase.
- IV. The time limit provided for in Article 22(1) PCT in conjunction with Rule 104b(1) EPC for payment of the national fee to each designated office expired on 16 August 1994.
- V. On 23 September 1994 a communication pursuant to Rule 85a(1) EPC was sent by the Receiving Section to the applicant indicating that the national fee, search fee and designation fees had not been paid. These fees were paid on 21 October 1994 with the surcharge due.
- VI. On 24 October 1994 the applicant's European representative filed EPO Form 1200 (entry into the regional phase) with a set of 15 claims.
- VII. By a notification dated 14 November 1994 the European representative was informed that claims fees were due for claims 11 to 72.

- VIII. In his reply of 7 December 1994 the representative contested this finding and claimed that the relevant date was the date of actual entry into the regional phase.
- IX. The 62 excess claims fees were paid under protest on 8 December 1994. The representative requested a refund of the fees paid in respect of claims that were not in the file on the date of filing Form 1200.
- X. By a decision of 13 June 1995 the Receiving Section refused the request for refund of claims fees on the following grounds:
- Pursuant to Rule 104b(1) EPC the national fee, which in this case was due within 21 months from the earliest priority date for entry into the regional phase, comprises the claims fees provided for in Rule 31(1) EPC. By analogy to Rule 31(1) EPC the EPO accords a one month grace period, within which unpaid claims fees can still be validly paid without surcharge.
 - The general principles concerning the way of computing the claims fees which are due in each case are set out in the Information for PCT applicants under point B.II.4 (supplement No. 1 to OJ EPC 12/1992, page 7 for EPO/designated office and page 22 for EPO/elected office). The computation is linked to the point in time entry into the regional phase occurs; entry into the regional phase in this connection means that the applicant has performed at least one act clearly indicating that he wishes that the international application be processed by the EPO as designated or elected office, as the case may be. In the present case in which entry occurred only after expiry of the 21st month as from the priority

date, the relevant date for calculation of claims fees is the expiry of the 21st month i.e. 16 August 1994.

XI. An appeal was lodged on 3 August 1995; the appeal fee was paid on 4 August 1995 and the statement of grounds was filed on 23 October 1995. The appellant requests that the decision under appeal be set aside and that the fees paid for claims in excess of 15 be refunded.

XII. The following submissions were made in the statement of grounds and in the response to the Board's communication as well as in the oral proceedings:

- The Information of PCT applicants is no more than information and is not legally binding.
- Entry into the regional phase is an expression of convenience. It appears to be only the provisions of Article 150 EPC that make the phrase meaningful in distinguishing between the respective effects of PCT and non-PCT applications filed at the EPO. In all other respects the effects of PCT and non-PCT applications at the EPO are the same (Article 150(3) EPC).
- The statute sets terms within which, if fees are paid, the application is treated not as an application as of the date at which those fees are due, with or without surcharge, but as if it were a non-PCT application to which different payment rules apply.
- There is nothing in the statute to suggest that the content of the specification, at any particular term set for the payment of fees, should be the basis for determining what those fees should be. Claims fees should be in respect

of those claims submitted for search and examination in order to provide some recompense for the greater length of time that must usually be spent in reviewing a greater number of claims. It is inequitable, in this case, to search 15 claims and require payment in respect of 72.

- Rule 31 EPC in accordance with Rule 104b EPC is open to interpretation. The phrase "at the time of filing" in Rule 31(1) EPC must be interpreted in the case of a PCT application on entry into the regional phase as meaning at the time of filing the claims to be searched. This is in consequence of the provisions for amendment on entering the regional phase. For an applicant seeking a European patent filed in accordance with Article 78 EPC, amendments after filing and before the search report is issued are specifically prohibited by Rule 86(1) EPC. In contrast, the applicant who has filed a PCT application is permitted to make amendments, even after the end of the 21-month period. Consequently the period for determining the number of claims and for adapting the claims in conformity with the EPC are different. Thus, the EPO cannot determine the claims to be searched until either the amendments are filed or expiry of the period for making amendments has occurred. It is only after amendment that a Euro-PCT application can be considered equivalent to an EPC application. Therefore, there has been no entry of the claims into the regional phase until either amendment has occurred at the time of filing the request of regional processing or it is clear that no amendment is sought.

- There is a disadvantage for the PCT applicants by comparison with non-PCT applicants in that in the case of a non-PCT application filed 12 months after the earlier priority date and for which claims fees are payable, the due date is one month after the date of filing. There is thus a one-month difference in effect between the date on which the statute requires claims fees to be paid for non-PCT applicants and the base date from which the Information for PCT applicants supposes that the specification is considered frozen for the purposes of determining the number of claims.

- By contrast with non-PCT applicants and especially the non-European non-PCT applicants who must be represented before the EPO at the time of filing, PCT applicants and particularly non-European PCT applicants, as in this particular case, can choose not to take any action at the EPO nor to appoint a representative until after the end of the 21st month from the earliest priority date. The fee may still be satisfactorily paid but this may also be the first opportunity to revise the claims for the benefit of the applicant as amendments are still allowed. Thus, if the effect of the decision under appeal is upheld, the applicant is disadvantaged and the EPO in effect discourages amendment.

Reasons for the Decision

1. The appellant is correct in stating that the "Information for PCT applicants" published in supplement No. 1 to OJ EPO 12/1992 is not legally binding and is only meant as a helpful service. The Board's decision is not to be based on this information but only on the Articles and Rules of the Convention.

2. The Board also agrees with the appellant that the term "entry into the regional phase" is an expression of convenience, though of great convenience, because it abbreviates the description of the requirements of Rule 104b EPC. It is true that the EPC itself makes no reference to the term.

3. According to Rule 104b(1)(b)(iii) EPC the claims fees provided for in Rule 31 EPC have to be paid as part of the national fee provided for in Article 158 EPC within a period of 21 months, where Article 22(1) PCT applies, from the priority date if priority has been claimed.

In the present case that time limit expired on 16 August 1994; before that expiry date the appellant performed no act indicating that it wished to pursue the application before the European Patent Office as designated Office. In such a case, as according to Rule 104b(1) EPC the payment of the claims fees has to be made within a period of 21 months, it is clear that the number of claims present in the file at the end of this period determines how many claims fees have to be paid (cf. J 9/84, OJ EPO 1985, 233, point 5 of the reasons; in that case the transmittal under Article 22(1) EPC occurred before the end of the 21st month).

Whether the number of claims is reduced later does not concern the requirements of Rule 104b(1)(b)(iii) EPC to be fulfilled at the end of the 21 months time limit.

The amount of fees to be paid does not depend on whether the payment is made within the time limit pursuant to Rule 104b(1) EPC or only within the extension provided for by Rule 31(1) EPC. The extension solely permits a later payment, not paying less. The decisive moment for determining how many claims fees

have to be paid is the time limit laid down in Rule 104b(1) EPC. Moreover, there is no legal reason why an extension of a time limit only provided to allow for late payment should also provide the possibility of determining the amount to be paid.

As Rule 104b(1) EPC is clear no other interpretation can be given.

4. There is no reason for interpreting the words "at the time of filing" in Rule 31(1) EPC in this case as Rule 104b(1)(b)(iii) merely refers to "the claims fees provided for in Rule 31" i.e. the fees that are to be paid in respect of each claim over and above ten claims. Moreover the "time of filing" referred to in Rule 31(1) EPC corresponds to the filing date of the international application referred to in Article 11(1) PCT.

5. It is true that for a non-PCT applicant seeking a European patent amendments before the receipt of the search report are prohibited by Rule 86(1) EPC whereas the applicant who has filed a PCT application is permitted to make amendments even after the 21 or 31 months period provided for in Rule 104b(1) EPC. However, according to Article 157(1) EPC the international search report under Article 18 PCT takes the place of the European search report. Therefore - beyond the possibility of filing amendments with the International Bureau after receipt of the international search report (Article 19 and Rule 46 PCT) - a PCT applicant seeking a European patent can present amended patent claims to the EPO as soon as it has received the international search report. Thus, the possibility for a PCT applicant to amend claims before each designated office (Article 28 PCT) is only the consequence of the fact that it is in another procedural phase and has nothing to do with the possibility of reducing the

claims in order to avoid or to pay less claims fees. It appears from the above that in fact the PCT applicant has more time to amend the number of the claims than a non-PCT applicant.

As for Article 150(3) EPC providing that an international application, for which the EPO "acts" as designated or elected Office, shall be deemed to be a European patent application, this provision is only concerned with the application after the end of the international phase, when it has to be examined for patentability like any other European application.

6. With respect to the due date of payment there is no disadvantage for the position of a PCT applicant compared with that of a non-PCT applicant having filed an application 12 months after the earliest priority date, as for the latter the due date of payment under Rule 31(1) EPC is one month after the date of filing and for the PCT applicant it is one month after the expiry of the time limit laid down in Article 22(1) PCT.

7. Contrary to the appellant's contentions the Board is not convinced that the claims fees provided for in Rule 104b(1)(b)(iii) EPC are only payable in order to provide some recompense for the greater length of time that must usually be spent in reviewing a greater number of claims. Indeed in this very case it can be stated that the 15 claims comprise the subject-matter of all the prior 72 claims. Moreover, according to Article 157(3) and Rule 104b(1)c a supplementary European search report must not always be drawn up (cf. the decisions of the Administrative Council of 21 December 1978, 17 May 1979 and 9 June 1995; OJ EPO 1979, 4, 50 and 248; 1995, 511).

The purpose of the claims fees seems rather to be to keep the number of claims within reasonable limits (see also Rule 29(5) EPC); the EPC encourages this by not imposing claims fees if there are no more than 10 claims.

Furthermore it is clear that the EPC has set a deadline for the calculation of the claims fees of both PCT and non-PCT applications: the filing date of a European application is the relevant date for the calculation of the claims fees according to Rule 31(1) EPC, whereas the ultimate relevant date for this calculation under Rule 104b(1) EPC is the end of the time limit mentioned in that Rule. This date has also to be observed by PCT applicants from jurisdictions where best practice encourages many claims irrespective of the fact put forward by the appellant that the non-European PCT applicant in particular can choose not to appoint a professional representative until after the said relevant date.

Order

For these reasons it is decided that:

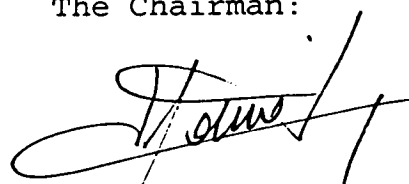
The appeal is dismissed.

The Registrar:



M. Béer

The Chairman:



J.-C. Saisset