

EJ0021.98

Decision of the Legal Board of Appeal dated 25 October 1999

J 21/98 - 3.1.1

(Language of the proceedings)

Composition of the board:

Chairman: J.-C. Saisset

Members: V. Di Cerbo

S. Perryman

Applicant: Ausimont S.p.A.

Headword: Examination fee reduction/AUSIMONT

Article: 14(2) and (4), 23(3), 75, 92, 94(1), (2) and (3), 164(1) and (2) EPC

Rule: 6(1), (2) and (3), 67, 69(2), 85b EPC

RPBA Art. 15(2)

RFee Art. 12

Guidelines A-XI, 9.2.3

Keyword: "Fees - reduction - time limit for filing a request for examination in an official language of a contracting state other than English, French or German" - "Fees - appeal fee - reimbursement - substantial procedural violation (no)"

Headnote

The applicant has the right to reduction of the examination fee when the requirements provided for in Articles 14(2) and (4) and 94(2) EPC are fulfilled, which

in circumstances such as those of the present case may indeed be satisfied, even though the request for examination in an official language of a contracting state other than English, French or German has not been filed together with the request for grant.

Summary of facts and submissions

I. Application No. 93 102 384.0-2115 was filed at the EPO on 16 February 1993 by Sama Patents on behalf of Ausimont S.p.A., an Italian company. The publication of the European search report on said application was mentioned in the European Patent Bulletin published on 25 August 1993. Pursuant to Article 94(2) EPC the 6-month term for filing the request for examination on this application started from this date; accordingly, the last day for filing said request was 25 February 1994.

II. The appeal at issue lies from the Receiving Section's decision dated 11 August 1998 refusing the request of the applicant to obtain the 20% reduction of the examination fee under Article 12(1) of the Rules relating to fees (RFees) and stating that he had validly paid the examination fee with a 50% surcharge under Rule 85b EPC.

III. To support his claim the applicant maintained (see letter 25 February 1994) that he had sent in due time (ie on 8 February 1994) the request for examination in the Italian language, and that this request had been duly received by the European Patent Office on 10 February 1994.

IV. By the contested decision the first instance refused the applicant's request on the grounds that:

Pursuant to G 6/91 of the Enlarged Board of Appeal (OJ EPO 1992, 491) persons referred to in Article 14(2) EPC are entitled to the fee reduction under Rule 6(3) EPC if they file the essential item of the first act in examination in an official language of the State concerned other than English, French or German, and supply the

necessary translation no earlier than simultaneously. As a result it is not possible to benefit from a reduction of fees when the document concerned is filed in an admissible non-EPO language after the translation into the language of the proceedings has been filed.

The applicant would be allowed a reduction in the examination fee if the written request for examination was filed in an admissible non-EPO language and a translation of the written request for examination in the language of the proceedings was also filed.

In the case in suit the applicant had not filed the written request for examination in the Italian language at the same time as the request for grant. According to the Receiving Section's opinion, since the EPO Form 1001, to be used to file the request for grant, already contained a pre-printed box for the written request for examination in the official languages of the EPO, the written request for examination in the Italian language (ie in the admissible non-EPO language) should have been entered in said box. Furthermore the Receiving Section stressed that information about the use of said box had been published in OJ EPO 1992, 467, and mentioned in the Guidelines A-XI, 9.2.3. Moreover, in OJ EPO 1992, 597, reference had been made to a new Request Form 1001, in which section 5 had been adapted following decision G 6/91.

V. The applicant lodged an appeal on 27 August 1998 against the Receiving Section's decision and paid the appeal fee at the same time. The appellant requested the cancellation of the decision in its entirety. In the statement of grounds for appeal filed on 3 December 1998 the appellant further requested reimbursement of the appeal fee and submitted essentially as follows:

(a) It is clear from the "travaux préparatoires" that Articles 14(2) and (4) EPC and Rules 6(1) and (2) were drafted to compensate at least in part the disadvantages to nationals of Contracting States with non-EPO official languages.

(b) The pre-printed crossed box referred to in the decision under appeal only has the purpose of ruling out the possibility of a loss of rights where the applicant pays the examination fee during the prescribed period but fails to file the written request for examination.

(c) The view taken in the decision under appeal that the pre-printed crossed box also constituted the first act of the examination proceedings was incorrect, whereas in decision G 6/91 examination was correctly separated from filing the application. There was no reason why the examination fee reduction should be related to the filing of the application. At the time of filing an applicant was not yet in a position to evaluate whether it would be worthwhile prosecuting the application to grant. This could only be judged after receipt of the information in the search report which indicates the importance of the various prior art documents cited. The EPC had a coherent structure allowing an applicant to abandon the proceedings when he becomes aware of an obstacle to obtaining a patent. There was thus no logical sense in requiring that the request for examination be made when the applicant was still "in the dark" about the prior art, except purely by way of precaution to cover the situation of the applicant paying the fee but omitting to make a request.

(d) Requiring a request for examination in a non-official language already on filing the application, would bring about incorrect consequences: for example it would unlawfully prevent the fee reduction from being claimable if the application was originally filed in one of the EPO official languages, and afterwards transferred to an applicant having his residence or principal place of business within the territory of a Contracting State having a language other than English, French or German as an official language.

VI. Since neither originals nor copies of the request for examination written in Italian and the translations were put in the file, but merely a computer print out indicating the payment of the examination fee, the Board of its own motion initiated enquiries to locate the original of said documents. As a result the evidence has been obtained that said documents had been received by the EPO on 10 February 1994.

Reasons for the decision

1. The appeal complies with Articles 106 to 108 and Rules 1(1) and 64 EPC and is therefore admissible.

2. The contested decision concerns the right of the applicant to the 20% reduction of the examination fee pursuant to Articles 14(2) and (4) EPC, Rule 6(3) EPC and Article 12 of the Rules relating to Fees. The Receiving Section has rejected the applicant's request concerning said reduction on the assumption that he had not fulfilled the requirements provided for, in particular, in the Guidelines A-XI, 9.2.3 above cited, said provisions being derived from the decision G 6/91 of the Enlarged Board of Appeal. According to the decision under appeal the written request for examination in the Italian language should have been entered, for the above requirements to be fulfilled, in the pre-printed box contained in the EPO Form 1001 or should have been sent to the EPO together with said Form. Therefore, since no written request for examination in the Italian language had been filed on 16 February 1993 (ie the date of the application) "included in or together with EPO Form 1001", the 20% reduction of the examination fee mentioned in Article 12 of the RFees was not applicable. As a further, logical outcome of the above conclusion, the Receiving Section stated that the appellant (who had paid in due time only the 80% of the examination fee) validly paid the missing 20% of the examination fee, together with the 50% surcharge over the full amount of the examination fee, under Rule 85b EPC, and therefore said amounts could not be refunded.

3. The enquiries made by the Board of its own motion have proved that a request for examination written in the Italian language was filed relating to the application under discussion (and to four other applications) by letter dated 8 February 1994, received by the European Patent Office on 10 February 1994. Accompanying the letter was an English translation, a fee sheet and a cheque for the examination fees calculated allowing for a 20% rebate.

Furthermore, the documents in the file are evidence that:

(a) On 25 February 1994 the representative of the Appellant was informed by telephone by the Receiving Section that 20% of the examination fee was missing.

(b) On the same day the representative sent a fax in English pointing out that an examination request in the Italian language together with a translation had been filed on 8 February 1994 and received by the EPO on 10 February 1994; a copy of said documents was supplied. With the same fax the representative also asked for confirmation that the payment for the application was in order.

(c) By a fax communication dated 1 March 1994 the Receiving Section informed the representative that an applicant "who wants the benefit of Article 14 EPC has to file a request for examination by typing that request in "his Article 14 language" in the right part of field 5 in the Form 1001 (request for grant of a European patent) on the date of filing". Later filing of the examination request in Italian was not possible according to the decision G 6/91. As the last date for paying the normal examination fee had already passed, the 20% deficit and 50% surcharge had to be paid.

(d) By letter received on 15 March 1994 the Appellant sent under protest a cheque for the 20% deficit and 50% surcharge to avoid the application being deemed withdrawn under Article 94(3) EPC, applied under Rule 69(2) EPC for a decision on the matter in order to be able to file an appeal, and set out arguments why the original payment was correct and the payment of the 20% alleged deficit and 50% surcharge were not required.

4. The Board is satisfied that the decision of the Receiving Section is consistent with the instructions given by the European Patent Office after the decision of the Enlarged Board of Appeal G 6/91 mentioned above. In the "Notice from the European Patent Office dated 3 July 1992 concerning an amendment to the Guidelines for Examination in the European Patent Office (Part A)" (OJ EPO 1992, 467) it is stated that applicants wishing to obtain a reduction in fees under the provisions of Article 14(4) and Rule 6(3) EPC "are urgently recommended to file the request for examination in the admissible non-EPO language in the Request for

Grant (Form 1001)". Moreover, by Decision of the President of the EPO, dated 3 July 1992, point A-XI, 9.2.3, of the Guidelines, concerning reduction of the examination fee, was amended with effect from 1 September 1992 as follows: "The applicant will be allowed a reduction in the examination fee if the written request for examination is filed in an admissible non-EPO language and a translation of the written request for examination in the language of the proceedings is also filed. For the reduction to be allowed, the written request for examination in the admissible non-EPO language must be filed at the same time as the Request for Grant (Form 1001) since the form already contains a pre-printed box for the written request for examination in the official languages of the EPO; the written request for examination in the admissible non-EPO language should be entered in the box provided for the request for examination....".

5. However, neither the Guidelines nor any other instructions given by the EPO are binding upon the Boards of Appeal. In particular, according to Article 23(3) EPC, "in their decisions the members of the Boards shall not be bound by any instructions and shall comply only with the provisions of this Convention". The Board is therefore both required and entitled to decide upon the correctness of the decision presently under appeal by taking into account solely its conformity with the relevant provisions of the Convention. By Article 164(1) EPC the Implementing Regulations are an integral part of the Convention, subject to there being no conflict between the provisions of the Convention and those of the Implementing Regulations, when by Article 164(2) EPC the provisions of the Convention are to prevail. Thus the Board of Appeal shall comply with both the provisions of the Convention and of the Implementing Regulations, provided the latter are not in conflict with the provisions of the Convention.

6. Article 15(2) of the Rules of Procedure of the Boards of Appeal provides that if, in its decision, a Board gives a different interpretation of the Convention to that provided for in the Guidelines, it shall state the grounds for its action if it considers that this decision will be more readily understood in the light of such grounds. The Board here considers such a statement appropriate.

7. Pursuant to Article 94(2) EPC a request for examination may be filed by the applicant up to the end of 6 months after the date on which the European Patent Bulletin mentions the publication of the European search report. The request shall not be deemed to be filed until after the examination fee has been paid.

In the Board's opinion said provision, especially when considered in connection with the provisions of Article 75 EPC (governing the filing of the European patent application), Article 92 (concerning the European search report), and paragraph 1 of the same Article 94 EPC, has to be interpreted in the sense that, within the granting procedure, the request for examination constitutes an autonomous step, which has to be kept quite separated from the (previous) step of filing the European patent application. In particular, the provision of Article 94(1) EPC, pursuant to which, for the examination of the application to be started, the applicant must file a written request, shows that, according to the Convention, the patent application is not considered as the only necessary step to be taken by the applicant to obtain the grant of a patent, since a further step is necessary consisting in a written request for examination, that means a new declaration of intention to continue the granting procedure. According to the paragraph 2 of the same Article, for said declaration of intention to be filed by the applicant, a time limit is fixed, which expires after the publication of the European search report. This means that the applicant is given the right (since the verb "may" has been used in said provision) to know the outcome of the search report before deciding whether to ask for the prosecution of the granting procedure by means of the request for examination, which implies the payment of the related fee, or to drop said procedure.

8. It is also useful to point out that said interpretation seems to be the only one which is consistent with the ratio legis. The above-mentioned provisions are indeed clearly aimed at giving the applicant the possibility to properly consider the convenience of a further prosecution of the granting procedure in the light of the outcome of the search report. So far the Board shares the appellant's opinion according to which at the time of the filing of a patent application the applicant is not yet in a position to evaluate the opportunity of prosecuting the case by requesting

the examination, and only after the publication of the search report in the EPO Bulletin does the applicant become aware of the prior art relating to the invention and is therefore able to make said evaluation.

9. It follows that, since the Convention gives the applicant the right to file the request for examination after the publication of the search report, the same right must be owed to the applicant who wants to avail himself of the option provided for in Article 14(2) and (4) EPC, ie to file the request for examination in an admissible non-EPO language pursuant to said Article (provided that the requirements set thereon are fulfilled), since the latter provision does not change the time limit fixed in Article 94(2) EPC.

10. It further follows that said right cannot be annulled by instructions given by the EPO or by the provisions of the Guidelines for examination in the European Patent Office.

As pointed out in paragraph 4 above, the cited instructions arose from a decision of the President of the EPO dated 3 July 1992. Said decision was allegedly taken to adapt the practice of the EPO to the principles expressed by the Enlarged Board of Appeal in the decision G 6/91.

In the Board's opinion the principles expressed in said decision do not justify the contents of the above mentioned instructions. The Enlarged Board of Appeal had been referred, among others, the following questions: (a) when must a document drawn up in an admissible non-EPO language be filed for entitlement to the fee reduction referred to in Rule 6(3) EPC to be secured? (b) more specifically, is it possible to file such a document on the same day as a translation of it in an EPO official language without losing entitlement to the fee reduction? In its decision the Enlarged Board of Appeal stated that the persons referred to in Article 14(2) EPC are entitled to the fee reduction under Rule 6(3) EPC if they file the essential item of the first act in filing, examination or appeal proceedings in an official language of the State concerned other than English, French or German, and supply the necessary

translation no earlier than simultaneously. In no passage of the decision is there to be found a hint to change the time limit for filing the request for examination. On the contrary, the decision, after a preliminary remark according to which it is clear from the "travaux préparatoires" to the Convention that Article 14(2) and (4) and Rule 6(1) and (2) EPC were drafted to compensate at least in part for the disadvantages to nationals of Contracting States with non-EPO official languages of having to provide translations into an EPO official language, states that the "main aim of Article 14 and Rule 6 EPC is thus to enable such parties to benefit from all EPC time limits for filing applications and subsequent items ...". Moreover the decision G 6/91 expressly considers the request for examination as a step which is distinct from the patent application (see in particular paragraphs 16, 19, 21 and 22).

11. Accordingly, the Board has serious doubts as to the legitimacy of relying on a pre-printed statement (the above-quoted box) making a request for examination in the application Form 1001, which by Rule 26(1) EPC an applicant is obliged to use, to deprive an applicant of a fee reduction in relation to filing the request for examination in circumstances where, but for the pre-printed statement, the applicant would have been clearly entitled to the fee reduction. The pre-printed box for the written request for examination appears to have been inserted to protect applicants who failed to file a formal request for examination at all but had paid the fee. Reliance on the existence of this pre-printed statement to defeat the right of an applicant to a fee reduction seems incompatible with the European Patent Convention.

It has to be emphasised that, whilst the applicant using one of the three official languages of the EPO cannot suffer any detriment from said box, since he is free not to pay the examination fee, with the consequence that in such a case the request for examination is deemed not to be filed (Article 94(2) EPC), the applicant in an admissible non-EPO language pursuant to Article 14 EPC can suffer, on the basis of the above-quoted Guidelines, a considerable detriment when he does not specify, in said box, that the request is filed in a non-EPO language, since, according to the Decision under appeal, in this case he has no right to reduction of

the examination fee. It is self-evident, in the Board's opinion, that such a detriment is absolutely unjustified and against the ratio legis of Article 14(2) and Rule 6 EPC.

Moreover, as the appellant has correctly pointed out in his submissions, there are cases where the correct non-EPO language could not be stated when filing the application (for example, cases where the application, filed in one of the EPO official languages, is transferred, after it has been filed, to another applicant who has the right to avail himself of the option provided for in Article 14(2) and (4) EPC, ie to file the request for examination in an admissible non-EPO language) but Rule 6(3) EPC would nevertheless entitle the assignee of the application to claim the fee reduction for the request for examination. Conversely there would be cases where after an assignment the assignee would not be entitled according to Rule 6(3) EPC to the fee reduction, but under the Guidelines he could obtain it.

12. In conclusion, so far as the provisions in the Guidelines state that for the reduction of the examination fee to be allowed the written request for examination in the admissible non-EPO language must be filed at the same time as the request for grant, they have to be considered as being in conflict with the Convention and not to be applied in the case under consideration. Indeed, the provisions under discussion not only ignore the existence of Article 94(2) EPC, rather they also ignore that the request for examination relates to a step of the procedure quite separate from the filing of the application, and that applicants have a legitimate interest in being able to delay the request for examination until they have had time to consider the search report.

13. Given, for the reasons exposed above, that the applicant cannot be obliged to file the request for examination in an admissible non-EPO language at the same time as the request for grant, the Board considers that, since said request, to be filed in writing (as every request for examination), involves a further declaration of intention, which is distinct from the patent application (see paragraph 7), the mere circumstance that Form 1001 (used by the applicant to file a patent application) contains a pre-printed box for the written request for examination cannot be

considered as a distinct declaration of intention unless the applicant, being aware of his right to wait until the European search report is published, and notwithstanding said right, shows clearly his will to utilise the pre-printed box to file the request for examination at the same time as the request for grant.

14. In the case in suit the appellant has not shown such a will, since he did not write anything in the box nor put any suitable mark in it. Moreover, he has filed a written request for examination in the Italian language, together with a translation in English of said request, within the time limit provided for in Article 94(2) EPC. Indeed, as is clear from the receipt date impressed on the original request, said request (with the translation) was received by the EPO on 10 February 1994 (as was maintained by the appellant) together with 80% of the examination fee. In accordance with the decision G 6/91 the applicant/appellant is therefore entitled, under Rule 6(3) EPC, to the 20% reduction of the examination fee pursuant to Article 12 RFees as he has filed the essential item of the first act of examination (ie the written statement requesting examination) in an official language of the State concerned other than English, French or German, and supplied the necessary translation no earlier than simultaneously.

15. Accordingly, the 50% surcharge over the full amount of the examination fee, paid by the applicant/appellant to avoid that the application would be deemed to be withdrawn pursuant to Article 94(3) EPC (see letter of the applicant of 11 March 1994), is to be considered as unlawfully paid.

16. The appellant's request for reimbursement of appeal fees cannot be granted.

Pursuant to Rule 67 EPC the reimbursement of the appeal fee is ordered, among others, where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

In the Board's opinion the latter requirement (ie substantial procedural violation) is lacking in the case under consideration.

The Board has duly considered that a procedural violation occurred, since the original document concerning the request for examination in the Italian language, together with the translation into English of said request, has not been placed on the file until enquiries were made ordered by the Board of its own motion. It is also true that, as a consequence of this omission, the Receiving Section has decided upon the case in suit without taking into consideration said document, whose existence had been referred to by the appellant already in his submissions to the Receiving Section, and which, according to said submissions, had to be regarded as of decisive importance, since it shows the date it has been received by the EPO. However, in the Board's opinion, notwithstanding said omission, the requirements provided for in Rule 67 EPC for the appeal fee to be reimbursed are not fulfilled.

In the case in suit it is apparent from the reasons given in the decision under appeal that the Receiving Section did not consider said documents as relevant for the decision. According to the provisions of the Guidelines quoted above, the mere circumstance that the written request for examination in the Italian language was not filed together with the EPO Form 1001, ie together with the request for grant was indeed considered sufficient for the refusal of the applicant's request. A procedural violation which has not played any role in the decision cannot be considered as being substantial.

Further, no other argument needs to be considered by the Board, as in the statement of the grounds of appeal no grounds have been submitted to support the request for reimbursement of the appeal fee.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order to refund to the appellant the 20% examination fee and the 50% surcharge over the full amount of the examination fee.
3. The request for reimbursement of the appeal fee is rejected.