

Abstract

The European regional phase was withdrawn for failure to meet the time limit to pay fees.

EPO boards of appeal decisions

Date of decision 25 September

Summary of Facts and Submissions

I. On 13 August 1979, the appellant filed an international application under the Patent Cooperation Treaty (PCT) in the United States of America. No claim was made to a priority date earlier than the date of the application. The European Patent Office was the designated office for the purposes of the PCT, as several EPC Contracting States were designated, it being indicated that it was desired to obtain a European patent for those States. The application thus being deemed to be a European patent application (Article 150(3) EPC) was accorded the number 79901397.4.

II. The appellant filed a request for examination of the European patent application on 8 January 1981. The examination fee was paid on 23 January 1981. The international search report was published on 19 February 1981.

III. By letter dated 1 June 1981, received on 3 June 1981, the appellant requested withdrawal of the European patent application, the refund of the search fee in respect of the supplementary European search report and the refund of the examination fee. As the EPO had not begun to draw up the supplementary European search report, the search fee was duly refunded in accordance with Article 10(4), Rules relating to Fees. The EPO did not refund the examination fee and after correspondence between the appellant's representative and the EPO and reference of the matter to the EPO's Legal Division, the refusal to refund the examination fee was made the subject of the decision under appeal, dated 18 April 1983.

IV. In the decision it was held that:

(1) In accordance with Article 22(1) PCT, the regional phase of processing the application had commenced on 14 April 1981, i.e. at the expiration of 20 months from the priority date.

(2) The request for examination and payment of the examination fee had had immediate effect, by virtue of the provisions of Article 150(3) EPC and Articles 11(3) and 11(4) PCT.

(3) Fees due under the EPC are as a general rule refunded only if there is express provision for such a refund.

(4) Under a practice of the EPO (cf. Legal Advice No. 1/79 Official Journal EPO, 1979, p. 61) a refund of the examination fee will occur if processing of a European patent application is terminated before responsibility for it is transferred from the Receiving Section to the Examining Division. However, this practice could not be applied to an international application because, under Articles 23(1) and 40(1) PCT, the EPO may neither process nor examine the international application before the start of the regional phase. The Examining Division always assumes responsibility for an international application from the moment when the request for examination is filed, even though it cannot process or examine the application before the start of the regional phase.

(5) It follows that an examination fee paid during the international phase can only be refunded if the application is withdrawn before the start of the regional phase. This was not the case with the present application.

V. By telex, on 17 June 1983, duly confirmed by letter dated 20 June 1983, the appellant gave notice of appeal against the decision. The appeal fee was duly paid. In the notice of appeal, the appellant requested full refund of the examination fee and reimbursement of the appeal fee. Reference of the case to the Enlarged Board of Appeal was also requested.

VI. In the Statement of Grounds of the Appeal, filed on 17 August 1983, the appellant contended that:

(1) The supplementary European search report is the definitive search report for the purposes of examination;

(2) Not only is it convenient to pay the examination fee earlier than necessary but it is also frequently impracticable to wait until the supplementary search report is received before paying the fee;

(3) The applicant could not have known at any material time that the Examining Division assumed responsibility for the application immediately the request for examination became effective since the matter was the subject of an amendment to the Guidelines for Examination not published until October 1981.

Furthermore, in fact, action had been taken in the case by the Receiving Section and the Search Division;

(4) It was absurd and illogical to refund the supplementary search fee and not the examination fee, since examination must follow search. The appellant repeated the request that the matter be referred to the Enlarged Board of Appeal.

VII. By a communication dated 17 July 1984, the Legal Board of Appeal indicated that it was able to envisage giving a positive decision in the present case, on the basis that where the fee for the supplementary European search can be refunded because the EPO has not begun to draw up the supplementary European search report, the examination fee can also be refunded. However, as there were other cases pending before the Board in which the question arose of refunding examination fees after the supplementary European search report had been drawn up and the arguments in those cases might conceivably affect the Board's view of the present case, the Board would not decide the present case immediately unless the appellant asked for that. By letter dated 1 August 1984, the appellant's representative asked for an immediate decision.

Reasons for the Decision

1. The appeal complies with Articles 106-108 and Rule 64 EPC and is, therefore, admissible.
2. The question of the refund of the examination fee in the case of withdrawal of an international application after receipt of the supplementary European search report is one which is recognised as giving rise to legal difficulty and, as it is the subject of other appeals pending before the Legal Board of Appeal, it is not a question which will be examined in the present decision.
3. It is possible to decide the present case without prejudging the issues which arise in those other cases, since it turns on a different point.
4. There is an inherent illogicality in a situation in which, as a result of withdrawal of an international application, it is lawful to refund the fee for a supplementary European search, in accordance with Article 10(4) Rules relating to Fees, but allegedly not lawful to refund the fee for a substantive examination which can never take place.
5. Now it is a well-established principle of interpretation of treaties that one should, if possible, avoid an interpretation which leads to a result which is manifestly absurd or unreasonable in the light of the objects and purposes of the treaty in question. It is undoubtedly for this reason that Article 32 of the Vienna

Convention on the Law of Treaties (cf. Official Journal EPO 1984, at p. 196) permits recourse to supplementary means of interpretation, including preliminary documents, to avoid manifest absurdity or unreasonableness.

6. The Board therefore considers it necessary to examine whether there is any justification in any provision of the EPC, the Implementing Regulations or the Rules relating to Fees for refusing to refund the examination fee in the circumstances of the present case. The provision that a request for examination cannot be withdrawn (Article 94(2) EPC) clearly does not have the effect that if an application is withdrawn the examination fee paid cannot be repaid: Legal Advice No. 1/79 (ubi supra: para IV (4)) could not have been given, if that were so. There is no other provision of the EPC, the Implementing Regulations or the Rules relating to Fees which even implies that an examination fee cannot be refunded if the examination cannot take place.

7. What is suggested in the decision under appeal is that an examination fee paid during the international phase of an international application can be repaid if the application is withdrawn during that phase, because the EPO is precluded from examining the application during that phase by the express provisions of Articles 23 and 40 PCT.

8. The question which arises in the present case is whether the EPO is not also precluded from examining an application under Article 94(1) EPC when the regional phase has begun, if no supplementary European search report can be drawn up in accordance with Article 157(2) (a) EPC, because the application has been withdrawn? If it is, then by parity of reasoning with the considerations mentioned in the previous paragraph, the examination fee must be repayable.

9. A supplementary European search report is clearly a "European search report" within the meaning of the EPC. (If this were not so, one consequence would be that the fee paid for such a search could not lawfully be refunded in accordance with Article 10(4) Rules relating to Fees). No special provisions of the Convention or the Implementing Regulations apply to a supplementary report. It follows that Articles 17 and 92 EPC apply to the drawing up of a supplementary European search report; i.e. that the Search Division alone, not the Examining Division, is responsible for drawing it up and sending it to the applicant. The consideration that at that point in time the Examining Division may be responsible for any examination of the application, in accordance with Article 18(1) EPC, cannot have the effect of authorising the Examining Division to commence examination, if a supplementary European search report- which is obligatory (Article 157(2) (a) EPC) - is never going to be made. It follows that if the application is withdrawn before the drawing up of the supplementary European search report can be begun, examination of the application is

precluded. In these circumstances, the examination fee is repayable. Reasoning in this way avoids the illogicality referred to in paragraph 4 above.

10. The decision under appeal failed to consider the relevant circumstances of the present case and erred in holding that an examination fee paid during the international phase can "only" be refunded if the application is withdrawn before the start of the regional phase. Accordingly, the decision must be set aside.

11. Since the questions of law arising in this case can be answered clearly by reference to the applicable provisions of the PCT, the EPC and the Rules relating to Fees, the Legal Board of Appeal finds no reason to refer any question to the Enlarged Board of Appeal. 12. Since no substantial procedural violation appears to have taken place, there is no ground for ordering reimbursement of the appeal fee.

ORDER

For these reasons, it is decided that:

1. The decision of the Formalities Section of Directorate-General 2 dated 18 April 1983 is set aside.
2. The examination fee paid in respect of European patent application No. 79901397.4 shall be refunded in full to the appellant.
3. The request that a question or questions of law should be referred to the Enlarged Board of Appeal is refused.
4. The request for reimbursement of the appeal fee is refused.