

Abstract

Applicant filed a Euro-PCT application. The EPO examination fees were not paid within the prescribed time limit. The Receiving Section deemed the European application withdrawn. This decision was upheld by the Board on appeal.

EPO boards of appeal decisions

Date of decision 21 May
Case number J 0903/87 - 3.1.1

Summary of Facts and Submissions

- I. On ... the appellant filed European patent application No. ... , naming Italy as sole designated State. At the same time he also filed Euro-PCT application No. ... for the same invention.
- II. On ... the European Patent Bulletin mentioned publication of the European search report for patent application No. The period for requesting examination and paying the examination fee (Article 94(2) EPC) thus expired on
- III. No examination fee was paid within that period, and by communication of 7 August ... the Receiving Section therefore informed the appellant that he still had a period of grace of two months from ... in which to remedy the deficiency, provided he also paid a surcharge (Rule 85b EPC). The Belgian postal authorities returned this communication to the European Patent Office, the appellant having changed his address. ...
- V. On 18 March 1986 the Receiving Section issued a Rule 69(1) communication informing the appellant that since neither examination fee nor surcharge had been paid within the prescribed periods European patent application No. ... was deemed withdrawn.
- VI. On ... the appellant requested a decision under Rule 69(2) EPC. In this request he explained that his failure to observe the time limits had been caused by health problems, which had made him less careful and caused him to confuse the proceedings concerning European patent application No. ... with the parallel ones for Euro-PCT application No. As a result he had believed that paying the examination fee plus surcharge for the latter application only would meet the requirements for both sets of proceedings. He therefore asked the Office to resume proceedings in respect of European patent application No. ... , and to

consider whether what was in effect a combined request for examination of two applications and payment of one of the examination fees could be regarded as valid for the examination of his European application. As evidence of his health problems he enclosed a medical certificate attesting that on ... he had been in a state of physical and mental exhaustion and depression.

VII. On ... the Receiving Section in accordance with Article 113 EPC informed the appellant that it would not accede to his request of ... for the following reasons: ...

VIII. By letter of ... the appellant maintained his request for a decision and, under Rule 90(1)(a) EPC, asked for interruption of the proceedings in respect of European patent application No. He argued that: - he had not received the communication of 7 August ...; - he had in fact been aware of when the period for payment for European patent application No. ... expired; - his health problems in ... had however rendered him incapable of prosecuting his patent applications and carrying out professional work; - this incapacity had brought ... , his company, to the brink of bankruptcy, with the result that in ... he had been obliged to ask for a special overdraft facility in order to pay the examination fee plus surcharge for Euro-PCT application No. ...; - non-payment of the examination fee plus surcharge for European patent application No. ... had originally been caused by physical incapacity, but payment was now beyond his means financially.

IX. These fees were not paid subsequently.

X. By decision of ... , taken at the appellant's request, the Receiving Section refused the requests of ... and ... for resumption and interruption of the proceedings and ruled that European patent application No. ... was deemed withdrawn under Article 94(3) EPC.

XI. In a letter of ... the appellant appealed against that decision and requested resumption of the proceedings. ...

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 EPC, and is therefore admissible.

2. The Patent Cooperation Treaty (PCT) entered into force for Italy on 28 March 1985 (cf. OJ EPO 3/1985, p. 91). Prior to that date a PCT application could not cover Italy, which is why the appellant filed a European patent application naming Italy as sole designated State in addition to his Euro-PCT application for

the same invention. He seems to have believed that in these circumstances he could meet the procedural requirements for both applications by paying the examination fee (plus surcharge) for the Euro-PCT application alone. The Board would point out that:

2.1 Neither the European Patent Convention nor the Rules relating to Fees provide for exemptions from payment of the examination fee (cf. Gall, *Münchener Gemeinschaftskommentar*, February 1986, Part 10, Article 51 (Rules relating to Fees), point 258), or for its refund once duly paid.

2.2 However, in Legal Advice No. 10/81 (cf. OJ EPO 9/1981, p. 349 et seq.) the European Patent Office did acknowledge that if a European and Euro-PCT application were consolidated one of the examination fees was refundable.

2.3 Such consolidation presupposes that the two applications be identical as regards filing and priority dates, text of description and claims and any drawings. The Examining Division, not the Receiving Section, checks that this is the case and that consolidation can be allowed. The competent Examining Division does not begin examining a European patent application until a request for examination has been filed (Articles 16 and 18 EPC), which involves paying the examination fee within the periods prescribed (Article 94(2), 2nd sentence, EPC).

2.4 If the request for consolidation is made on or before the day on which the later of the two requests for examination is validly filed, the decision to consolidate means that no separate examination proceedings are initiated for the application in question. The examination fee paid for that application is therefore refunded (cf. Legal Advice No. 10/81, loc. cit., p. 354). One might therefore ask whether it is really essential for the applicant to pay an examination fee that in all probability will subsequently be refunded. On the other hand, an arrangement whereby just one examination fee was payable for two applications it was desired to consolidate would have grave disadvantages. Firstly, it would run counter to Articles 16, 18 and 94(2) EPC. Secondly, it could prove extremely prejudicial to applicants since it is the Examining Division and not the Receiving Section that will decide on the request for consolidation (cf. point 2.3 above), and if, contrary to all expectations, the request were to be refused, the periods fixed by Article 94(2) EPC and Rule 85b EPC would probably already have expired and the application be deemed withdrawn under Article 94(3) EPC.

2.5 It follows from this that the examination fee plus surcharge were in fact payable in respect of European application No.

3. Since - as the Receiving Section noted in its communication of ... - these two fees were not paid within the periods laid down in Article 94(2) and Rule 85b EPC respectively, under Article 94(3) EPC the application had to be deemed to be withdrawn.

4. The communication of 7 August ... (EPO Form 1149) was issued mainly to draw the applicant's attention to the fact that he still had until ... to pay the examination fee plus surcharge. It failed to reach him because he had not notified the Office of his change of address. The European Patent Convention nowhere obliges the European Patent Office to inform an applicant or his representative that a fee - in this case the examination fee - has not been paid in due time. And even where - as in Rule 50(1) EPC - it does stipulate that the applicant be informed of a time limit to be observed the applicant cannot invoke the omission of that communication (Rule 50(2) EPC). The communication of 7 August ... was thus merely a courtesy service to the appellant, not an obligation on the part of the Receiving Section. The fact that the appellant never received it is therefore irrelevant.

5. Under Rule 90(1)(a) EPC, proceedings before the EPO are interrupted in the event of incapacity of the applicant. Nowhere however does the Convention define this term, and an applicant's incapacity to prosecute a European patent application must therefore be determined in accordance with the relevant national law (Legal Board of Appeal decision of 1 March 1985, OJ EPO 1985, 163). The appellant concedes that his sole evidence of incapacity is a brief medical certificate. Whilst this does show that on ... he was in a state of physical and mental exhaustion and depression, it says nothing about the seriousness and duration of this condition. Nor does it say anything about the appellant's ability validly to enter into undertakings and perform legal acts. It is not therefore sufficient to establish incapacity within the meaning of Rule 90(1)(a) EPC. Besides, the fact that in ... the appellant successfully applied for a "special" overdraft renders such incapacity highly improbable. Rule 90(1)(a) EPC does not therefore apply here. Nor does Rule 90(1)(b) EPC; there is no definite proof of action having been taken against the appellant's property during ..., thereby preventing him from prosecuting applications before the EPO. That the appellant may have had financial problems or his firm been on the verge of bankruptcy does not alter the situation.

6. Article 122(5) EPC expressly rules out re-establishment of rights in respect of the time limits for requesting examination and paying the examination fee plus surcharge (Article 94(2) and Rule 85b EPC).

7. The time limits laid down in Article 94(2) and Rule 85b EPC are those of the Convention, and not set by the EPO. As a result, further processing under Article 121 is likewise ruled out in this case.

Appeal dismissed

Remarks:

The Case Number given above is a fictitious number necessary for database purposes, as the bibliographic data must comply with the format defined for the data base. The actual Case Number will not be published.

O.J. EPO issue: 1988,177

Case law reports: CLBA 1996