

Abstract

This case was consolidated with Case No. J 0009/83. Applicant filed an international application designating the EPO. After receiving the supplementary European search report the applicant decided to withdraw its application and requested a refund of the examination fee. On appeal, the Board found that Article 96 EPC gave direct European applicants the ability to withdraw their applications after receiving the European search report without having to pay the examination fee. The Board thus found that based on Article 150(3) EPC, and the fact that the examination section never had responsibility for this application, the applicant should have had the opportunity to withdraw the application after receiving the supplementary European search report. A refund of the examination fee was ordered.

EPO boards of appeal decisions

Date of decision 13 February 1985

Summary of Facts and Submissions

I. On 28 July 1980, the appellant filed an international application under the Patent Cooperation Treaty (PCT) in the United States of America, claiming priority from a U.S. national patent application filed on 30 August 1979. The European Patent Office was a designated Office for the purposes of the PCT, as three EPC Contracting States were designated, it being indicated that it was desired to obtain a European patent for those States. The application was allotted the European patent application number 80901737.9.

II. The international search report was transmitted to the appellant by the United States PCT International Searching Authority on 30 October 1980. In December 1980, the appellant filed amended claims with the International Bureau. The international application was published with the amended claims and the international search report on 5 March 1981. Having paid the national fees on 21 April 1981 and the examination fee on 6 August 1981, the appellant filed a request for examination with the European Patent Office in due time on 11 August 1981.

III. The supplementary European search report was transmitted to the appellant's representative on 16 February 1982. By letter dated 22 April 1982, the representative informed the European Patent Office that the applicant did not wish to proceed further with the application and that it was thereby withdrawn. In reliance on the reasoning of Legal Advice No. 1/1979 (OJ EPO 1979, 61), a refund of the examination fee was claimed.

IV. By a communication dated 20 May 1982, a Formalities Officer of Directorate-General 2 advised the appellant's representative that no refund of the examination fee was possible and that, if the appellant disagreed with this finding, a decision might be requested under Rule 69(2) EPC. V. By letter dated 5 July 1982, the appellant's representative duly requested such a decision. It was submitted that the supplementary European search report was part of the European search report for the purposes of Article 96(1) EPC. The transmittal of the supplementary European search report was the relevant act for the purposes of Article 96(1) EPC and the appellant had been denied the opportunity to claim the benefit of a refund of the examination fee in accordance with Legal Advice No. 1/1979 as no invitation under that Article had been sent.

VI. The Decision under appeal, given on 18 April 1983, refused the request for a refund of the examination fee on the ground that an applicant for an international application which was deemed to be a European patent application (a "Euro-PCT application") had the right to a refund only if the application was withdrawn before the start of the regional phase, prior to which, in accordance with Articles 23(1) and 40(1) PCT, the EPO was forbidden to process or examine the application.

VII. By letter dated 8 June 1983, the appellant gave notice of appeal against the Decision, appealing against the whole of the decision and requesting that it be reversed and that the refund of the examination fee be ordered. The appeal fee was duly paid.

VIII. In the Statement of Grounds of the appeal, duly filed on 25 July 1983, the appellant contended that no provision of the EPC or the Implementing Regulations ruled out a refund of the examination fee. Article 96(1) EPC applied in the present case, as did Legal Advice No. 1/1979. Furthermore, it was in the public interest and also that of the EPO that by having the prospect of a refund of the examination fee applicants should be positively encouraged to review their applications when invited to do so and to withdraw those that were likely to be unsuccessful before examination was commenced. There was also a moral justification for a refund: the examination fee was a fee for substantive examination and in the present case there had been no such examination.

IX. In a communication issued on 17 July 1984, the Legal Board of Appeal indicated that there appeared to be difficulties in accepting that Article 96(1) EPC applied in the case of a Euro-PCT application. Attention was drawn inter alia to statements made to the Standing Advisory Committee of the European Patent Office (SACEPO) in 1981, by a representative of Directorate-General 5.

X. In reply to the communication, by letter dated 11 September 1984, the appellant's representative requested to be heard in oral proceedings. After consultation with the representative and also with the representative of the appellant in Case No. J 09/83, in which case the same points of law arose, oral proceedings were appointed for and held on 23 January 1985.

XI. With the agreement of the representatives concerned, the oral proceedings in both cases were consolidated (cf. Rules of Procedure of the Boards of Appeal, Article 9(2)). After hearing the representatives of both appellants the Board stated that it would reserve its decision in each case and that if it did not find it possible to come to a positive decision in favour of the appellant it would consider submitting a point of law to the Enlarged Board of Appeal. The appellant's representative indicated that he would like the Board to formulate any question to be put to the Enlarged Board of Appeal but that he would appreciate the opportunity of making observations to the Board before the question was submitted.

Reasons for the Decision

1. The appeal complies with Articles 106-108 and Rule 64 EPC and is, therefore, admissible.
2. The question raised in the present case, whether the examination fee may be refunded when a "Euro-PCT" application is withdrawn after receipt of the supplementary European search report, is one which has long been recognised as giving rise to legal difficulty. It has been considered on several occasions by the Legal Service of the European Patent Office and was discussed in 1981 by the Standing Advisory Committee of the European Patent Office (SACEPO), without positive result.
3. Since an early stage in the work of the European Patent Office, it has been the practice to refund the examination fee when a European patent application which is not a "Euro-PCT" application is withdrawn before responsibility for the application has passed from the Receiving Section to an Examining Division. According to the views expressed in Legal Advice No. 1/79 (OJ EPO 1979, 61), this is justified because the purpose behind the provisions of Article 96(1) EPC is to avoid unnecessary initiation of the examining procedure.
4. Article 96(1) EPC provides that "if the applicant for a European patent has filed the request for examination before the European search report has been transmitted to him, the European Patent Office shall invite him after the transmission of the report to indicate whether he desires to proceed further with the European patent application." If he does not wish to proceed further, he may

simply refrain from answering the invitation within the time limit, so that the application is deemed to be withdrawn pursuant to Article 96(3) EPC.

5. Rule 51(1) EPC provides that, in the invitation pursuant to Article 96(1) EPC, the European Patent Office shall invite the applicant, if he wishes, to comment on the European search report and to amend, where appropriate, the description, claims and drawings.

6. The provisions of Article 96(1) EPC and Rule 51(1) EPC clearly operate in the respective interests of applicants, third parties and the European Patent Office by encouraging applicants to review their applications critically and realistically in the light of the European search report, before substantive examination begins. The opportunity given by the Office to obtain a refund of the substantial fee for examination by withdrawing the application at that stage, or allowing it to be deemed to be withdrawn, provides an additional incentive to withdraw cases which are unlikely to succeed.

7. Article 96(1) EPC and Rule 51(1) EPC confer rights upon an applicant for a European patent which he otherwise would not enjoy. The applicant may of his own volition amend the description, claims and drawings after receiving the European search report (Rule 86(2) EPC). Moreover, since he has the right under Rule 51(1) EPC to comment on the European search report at that stage, he can expect to receive the Examining Division's response to his comments in the first communication, which can be to his advantage because of his right to submit amendments with his reply to that communication (Rule 86(3) EPC).

8. As a matter of principle, the applicant for an international application which is deemed to be a European patent application in accordance with the provisions of Article 150(3) EPC must be entitled to the same rights as any other applicant for a European patent. There can be no discrimination between applicants. Nevertheless, distinctions can properly be made between applicants in different legal situations.

9. In the case of an international application, Article 157(1) EPC provides *inter alia* that, without prejudice to the provisions of Article 157(2) to (4) EPC, the international search report, which is drawn up and transmitted to the applicant by the international searching authority under Article 18 PCT, shall take the place of the European search report. Article 19 PCT gives the applicant the opportunity to amend the claims of the international application in the international phase. In contrast, Article 92(1) EPC provides for the drawing up and Article 92(2) EPC provides for transmittal to the applicant of the European search report by the EPO. The invitations required to be given under Article 96(1) EPC and Rule 51(1) EPC are sequential to and consequent upon the

provisions relating to the drawing up and transmittal of the European search report. Hence, it can be concluded from the context that if those provisions do not apply, then Article 96(1) EPC and Rule 51(1) EPC do not apply either.

10. According to Article 16 EPC, the Receiving Section ceases to be responsible for a European patent application when a request for examination has been made or the applicant has indicated under Article 96(1) EPC that he desires to proceed further with his application. In the case of an international application for which no supplementary European search report has to be drawn up, for the reason given in the previous paragraph, the reference to Article 96(1) EPC in Article 16 EPC has to be ignored as inapplicable. Therefore, it is correct to say that the Examining Division assumes responsibility for such an international application when the request for examination has been made.

11. The question whether Article 16 EPC applies differently in a case in which a supplementary European search report is required in accordance with Article 157(2)(a) EPC can only be answered by considering the legal nature of a supplementary European search report. As the Board has already decided in Case J 06/83 (OJ 4/1985, p. 97, Decision of 25 September 1984), a supplementary European search report has to be considered to be a European search report within the meaning of the EPC for certain purposes and the provisions of Articles 17 and 92 EPC apply to its drawing up and transmittal to the applicant by a Search Division.

12. Bearing in mind the matters considered above in paragraphs 7 to 9, the Board concludes from the language of Article 96(1) EPC, from its purpose, and from its context in the other provisions of the EPC, that there is every reason to consider that the reference in Article 96(1) EPC to transmittal of the European search report must be interpreted as including transmittal of a supplementary European search report.

13. It follows that Article 16 EPC applies to its full extent in a case in which a supplementary European search report is transmitted. The making of a request for examination before the supplementary European search report has been transmitted to the applicant does not have the effect of immediately transferring responsibility for the application to the Examining Division. In this respect, the Guidelines for Examination in the European Patent Office Part C-VI, 1.1.3., October 1981, cannot be followed by the Board. Thus, the applicant is in the same legal position as any other applicant who is entitled to receive invitations under Article 96(1) and Rule 51(1) EPC.

14. Applying Article 16 EPC in the present case, it is clear that responsibility for the application did not pass from the Receiving Section to the Examining Division at any time. Since the appellant corporation never received the

invitations under Article 96(1) and Rule 51(1) EPC to which it was entitled, it never had any opportunity to respond.

15. In these circumstances, the decision under appeal must be set aside and the appellant is entitled to a refund of the examination fee.

16. The Legal Board of Appeal considers that as the legal position under the EPC is clear, it is unnecessary to refer any question of law to the Enlarged Board of Appeal for decision.

17. Although the Legal Board of Appeal has decided that, contrary to the previously accepted general opinion, the responsibility for the application did not pass to the Examining Division at any time, the action of the Examining Division in deciding the case in accordance with the prevailing interpretation of the EPC cannot be regarded as a substantial procedural violation within the meaning of Rule 67 EPC such as to justify reimbursement of the appeal fee.

ORDER

For these reasons, it is decided that:

1. The decision of the Formalities Section of Directorate-General 2 of the European Patent Office dated 18 April 1983 is set aside.
2. The examination fee paid in respect of the European patent application shall be refunded to the appellant.