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**Datasheet for the decision
of 7 October 2015**

Case Number: J 0007/13 - 3.1.01

Application Number: 11004301.5

Publication Number: 2476312

IPC: A01N33/18, A01N25/08,
A01N25/12, A01N25/30

Language of the proceedings: EN

Title of invention:

Flowering stimulant composition using nitrobenzene

Applicant:

Devi Crop Science Private Limited

Headword:

Amount of the search fee payable for a divisional application
- relevant date

Relevant legal provisions:

EPC Art. 76(1)
EPC R. 36(3)
Article 2(1), item 2, first indent RFees

Keyword:

Divisional application

Decisions cited:

G 0003/98, G 0001/05, G 0004/98

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: J 0007/13 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 7 October 2015

Appellant: Devi Crop Science Private Limited
(Applicant) 29-A, Workshop Road
Madurai 625001 (IN)

Representative: Griebeling, Onno
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Decision under appeal: **Decision of the Receiving Section of the
European Patent Office posted on 29 November
2012 refusing the request for partial refund of
the search fee in respect of European patent
application No. 11004301.5**

Composition of the Board:

Chairwoman E. Kossonakou
Members: C. Schmidt
O. Loizou

Summary of Facts and Submissions

- I. European patent application No. 11 004 301.5 was received at the EPO on 25 May 2011. It was filed as a divisional of European patent application No. 03 746 402.1 (the earlier/parent application), which had been filed on 3 April 2003.
- II. Together with the application documents, the EPO received Form 1010 listing the fees to be debited in respect of the divisional application from the account of the applicant's representative. The amount of the search fee was given as €800. An accompanying letter contained the explicit instruction that, if any of the amounts indicated in the form were wrong, the right amounts were to be debited from the account.
- III. With a communication dated 20 July 2011 the applicant was informed that the correct amount of the search fee payable in the present case was €1 105, so that an additional €305 would be debited from the representative's account. It was further set a two-month time limit for filing reasoned objections to that finding.
- IV. By fax dated 28 July 2011 the applicant did so, arguing that "since the filing date of the present application is 3 April 2003, the correct amount of the European search fee is 800 EURO" and requesting either a refund or an appealable decision.
- V. With communication pursuant to Article 113(1) EPC dated 6 September 2011 the applicant was informed that the search fee to be paid for a divisional application was the one due on its date of receipt at the EPO and that

it had to be paid in full under all circumstances. It was refunded, if the conditions of Article 9(2) of the Rules Relating to Fees (RFees) were fulfilled.

- VI. By fax dated 9 September 2011 the applicant clarified its intention to avoid any loss of rights. Regarding its differing understanding as to the correct amount of the search fee to be paid, it argued that, since Article 76(1) EPC stated that the divisional application was deemed to have been filed on the date of filing of the earlier application and no limitation as to the applicability of this provision was to be found anywhere in the Convention, this filing date was the only one that could determine the amount to be paid *inter alia* for the search fee.
- VII. These arguments were addressed in detail in the next communication pursuant to Article 113 EPC dated 25 June 2012, where the applicable provisions, in particular Article 2(1), item 2, RFees and Article 76(1) EPC, were analysed in the light of both their history and case law, having due to the legal nature of divisional applications.
- VIII. In a further submission dated 20 July 2012 the applicant maintained its original opinion, insisting that despite the fact that a divisional application was procedurally independent of the earlier one, they nonetheless both shared the same filing date. As that term had the exact same meaning in Article 76(1) EPC and Article 2(1), item 2, RFees, it was thus to be interpreted in the same way. In its opinion, no extended European search report should be prepared for divisional applications based on an earlier application filed before 1 July 2005

IX. A decision refusing the request for a partial refund of the search fee was issued on 29 November 2012. A notice of appeal against this decision and the statement setting out the grounds of appeal were filed by the applicant (hereinafter, the appellant) on 8 February 2013. The appeal fee was paid on the same date. The appellant requested that the contested decision be set aside, the search fee partially refunded and the appeal fee reimbursed. If the board of appeal intended to refuse these requests, the appellant also requested oral proceedings.

X. The statement of grounds of appeal focused on defining the term "filing" as used in the EPC, specifically in the English-language text, where it is used indiscriminately to indicate both the date on which documents were received at the EPO and the "official" date of filing of an application. The appellant argued that his position regarding the amount of the search fee due in the present case was fully supported by the German-language text, which used two different terms (Einreichungstag and Anmeldetag), thus clearly distinguishing between the simple act of submitting documents to the EPO (Einreichungstag) and the formal according of a date of filing for a patent application (Anmeldetag).

Article 4G of the Paris Convention was also drawn upon for further arguments, since it specified that division ought to "preserve as the date of each divisional application the date of the initial application". Therefore, in the appellant's opinion, the same situation ought to exist as if the two applications had been physically filed on the same date; in other words,

the two applications (earlier/parent and divisional) "are on equal levels of hierarchy".

Although the appellant acknowledged that the time limit for payment set in Rule 36(3) EPC only made sense if calculated on the basis of the actual date on which the application documents were received at the EPO, it drew a distinction between the timing of the payment and the calculation of the payable amount, arguing that the latter had to be done by reference to the deemed filing date, as only this course of action guaranteed that the parent and divisional applications were indeed treated as if filed on the same date, as required by Article 76(1) EPC.

Finally, it rebutted the arguments of the contested decision based on decision G 3/98 of the Enlarged Board of Appeal (OJ EPO 2001, 62ff), arguing essentially that the relevant terms were discussed exclusively within the framework of Article 55 EPC, which differed from that of Article 76 EPC, let alone of Article 2(1), item 2, first indent, RFees which was not even mentioned in that decision.

In the statement of grounds of appeal no argument was given in support of the request for reimbursement of the appeal fee.

- XI. The board summoned to oral proceedings and issued a preliminary opinion in a communication dated 5 May 2015. The proceedings took place as scheduled on 7 October 2015. Reference is made to the minutes.

XII. In preparation for them and in reaction to the board's comments, the appellant filed clarifications and further arguments, pointing out that Article 2(1), item 2, RFees still distinguished between applications filed before 1 July 2005, which could only refer to divisional applications as they were the only ones still able to claim such an early filing date. It also indicated that the EPO had charged both the examination and the designation fees in accordance with the schedule of fees applicable to applications with a filing date before 1 July 2005, thus reinforcing the impression that this was the schedule to be applied in the present case.

This approach showcased an inconsistent interpretation by the EPO of the terms "applications eingereicht ab"/ "applications eingereicht vor", which constituted a procedural violation justifying the requested refund of the appeal fee.

The appellant also requested that the following question be referred to the Enlarged Board of Appeal (text as proposed with the submissions of 5 October 2015):

"In the case of an amendment of a provision of the EPC, its Implementing Regulations or the Rules relating to Fees, whenever the decision provides that the amended provision shall apply to applications filed ("eingereicht") after a certain date and hence that the previous version of the provision concerned shall continue to apply to applications filed ("eingereicht") before said certain date, which date shall in this respect be the relevant date in the case of a divisional application: the date of its ACTUAL receipt at EPO (i.e. the date of dividing the parent

application) or its DEEMED date of filing ("gilt als eingereicht") according to Art. 76?".

Lastly, the submission of 5 October 2015 contained a conditional request for a refund of the difference between the higher amounts of the examination and designation fees charged and the lower amounts (potentially) due, should the appeal fail and the request for a referral to the Enlarged Board be refused.

Reasons for the Decision

1. The appeal is admissible but not allowable.
2. The board has carefully considered all the arguments presented by the appellant in both the written and oral proceedings but cannot agree with them. The provisions of Article 76(1) EPC are quite clear in their intention to address the substantive repercussions of an application being filed as a divisional: the application is accorded a fictitious date of filing and a priority right and date if it fulfils certain substantive requirements ("subject-matter which does not extend beyond the content of the earlier application as filed").
 - 2.1 This legal fiction is conditional not on "application documents being submitted/filed" but on substantive requirements being met (specific content of the divisional compared with the parent application). The effects of this legal fiction are likewise substantive in that the state of the art for the divisional

application is that at the fictitious date of filing (or priority date, as the case may be).

2.2 An analogous situation can be considered to exist regarding the statement in Article 89 EPC that the date of priority counts as the application's date of filing for the purposes of certain provisions. The Enlarged Board of Appeal has explained in quite some detail in decision G 3/98 (supra) why the two terms "date of filing" and "date on which application documents are filed" cannot be regarded as synonymous (see in particular Reasons, point 2.2, last paragraph). The relevant statements of the Enlarged Board are of a general nature and thus not limited to the case then at hand. This is apparent from the references in the decision to a number of EPC provisions dealing with filing and the requirements involved (in fact the case underlying G 3/98 concerns the application of Article 55 EPC), but also from the fact that the terms concerned are used non-interchangeably throughout the Convention. This board thus cannot see how the Enlarged Board's conclusions could be ignored in the context of the present case, as the applicant suggests.

2.3 Lastly, the EPC provisions relating to divisional applications are fully in line with the requirements of the Paris Convention, as they do preserve the earlier application's filing date for the benefit of the divisional application. However, as explained in point 2.1 above, the shared hierarchy level of the two applications concerns the substantive aspects, specifically the prior art to be considered in respect of the later application, not the fees as contended by the appellant.

3. Rule 36(3) EPC and Article 2(1), item 2, first indent RFees are clearly centred on the actual date on which application documents are physically filed, which they specify as the basis for the payment period and the amount to be paid, respectively.

Moreover, as acknowledged by the appellant, the time limit for payment - "within one month" - set in Rule 36(3) EPC can only refer to the actual date on which the divisional application documents were received at the EPO.

- 3.1 The appellant's contention that the payable amount should depend on the fictitious date of filing accorded to the application under Article 76(1) EPC has no basis in the law, which provides neither systemic nor interpretative support for it. On the one hand, the wording of Rule 36(3) EPC is so clear as to preclude any need for interpretation ("within one month of filing the divisional application"). On the other, as pointed out above, Article 76(1) EPC, when according the fictitious filing date to the divisional application, is only concerned with, and thus limited to, the substantive aspects of the procedure, as only these are critical to the divisional application's *raison d'être*, which is to ensure a fair chance of obtaining patent protection for subject-matter disclosed in the earlier application but claimed only in the later one. Without the benefit of the earlier application's filing and, where appropriate, priority date, the divisional application would be subject to prior art created subsequent to its disclosure.

- 3.2 The fees can serve no such purpose; they ensure only that the filing itself fulfils the formal and procedural requirements applicable to all applications. That is why - logically enough - their amounts too are determined by the rules applicable to all applications, namely in terms of the dates on which they fall due and are paid. This principle has also found its way into the EPO's Guidelines for the Examination (see A-IV.1.4 for divisional applications, and A-X.5, in particular 5.1.1, 5.1.2 and 5.2.1, for the general arrangements).
- 3.3 Regarding the argument that Article 2(1), item 2, first indent RFees as revised in 2007 still distinguishes between applications filed before and after 1 July 2005, the board notes that it appears that EPO examiners - at least at the time the RFees were last revised - still dealt with applications filed before that date which had a unity-of-invention problem not yet addressed. This is the only reason this distinction is still made now.
- 3.4 Lastly, noted that the Enlarged Board has confirmed that in all procedural aspects a divisional application is independent of its parent application and (to be) treated as a new application (see decision G 1/05, OJ EPO 2008, 271 ff., point 8.1 of the Reasons, referring to opinion G 4/98, OJ EPO 2001, 131 ff., point 5 of the Reasons).
4. In view of the above, the board considers all the EPC provisions applicable to the present case to be clear and unequivocal, both in their wording and in their intended application. Hence it can discern no open legal issue which might affect the outcome of the present appeal. Therefore the board sees no need to

make a referral to the Enlarged Board, as the answer would have no impact on its decision. This request therefore fails.

5. Regarding the request for reimbursement of the appeal fee, this is possible only if the appeal is found allowable (Rule 103(1)(a) EPC). Since, as explained above, the board is not convinced by the appellant's arguments, the appeal is to be rejected and therefore this request too must be refused.

For the sake of completeness, and as also discussed during the oral proceedings, it is noted that the request for reimbursement of the appeal fee could not have succeeded on the ground of an alleged procedural violation either; no such ground was substantiated in good time. The argument submitted with the appellant's letter of 5 October 2015, namely that the EPO applied the RFees inconsistently, was presented for the very first time 4 days before the oral proceedings in appeal, i. e. at the very end of the procedure, and was therefore late-filed and thus not admissible.

Moreover, this argument regarding inconsistent practice was not put forward by the appellant to the Receiving Section, which therefore had no opportunity to consider the issue and possibly rectify its decision. It follows that this issue is not part of the present appeal.

6. Lastly, regarding the request for reimbursement of the amount of €285, i.e. the difference between the higher amounts of the examination and designation fees charged and the lower amounts the appellant believes were actually due, the board observed during the oral proceedings that this issue was not addressed in the decision under appeal and that no such request appears

to have ever been made to the Receiving Section. The applicant did not contest this finding, from which it follows that this issue is likewise not part of the present appeal, and the board is therefore unable to decide on it.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairwoman:



C. Eickhoff

E. Kossonakou

Decision electronically authenticated