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Rule 68(2), Articles 150(2)(3), 157(2)(b)(3)(b)EPC; Article 10 Rules relating to Fees; Article 2(vii)PCT; Decision of the Administrative Council of 14 September 1979 on the reduction of the search fee for the supplementary European search report
"Form of decision" "international application" "international search report" "refund of fee for European search report"

HEADNOTE

- I. A decision of the European Patent Office may be, but ought not to be, given in a document which in form appears to be merely a communication. Whether a document constitutes a decision or a communication depends on the substance of its contents, not upon its form.

- II. An application for a European Patent which claims priority from an international application filed with a national patent office is not itself an international application within the meaning of Article 150(2) EPC.

- III. Since the amendment of Article 10 of the Rules relating to Fees on 14 September 1979, it is not possible to refund the fee for the European search report if that report is based on an international search report prepared under the provisions of the PCT by any International Searching Authority other than the EPO.



Case No. J 08/81

DECISION

of 30 November 1981

Appellant:

CATERPILLAR TRACTOR CO.,
100 Northeast Adams Street,
PEORIA,
Illinois 61629,
United States of America

Representatives:

Brunner, Michael John et al,
Gill Jennings & Every,
53-64 Chancery Lane,
LONDON WC2A 1HN,
England

Decision under appeal:

Decision dated 23 April 1981 of the
Receiving Section of the European
Patent Office rejecting a request
for a partial refund of the search
fee paid in respect of European
Patent Application No. 80 303 372.9.

Composition of the Board:

- R. Singer Chairman
- P. Ford Member
- L. Gotti Porcinari Member

SUMMARY OF FACTS AND SUBMISSIONS

- I. On 17 December 1979, the appellant corporation filed an international application under the Patent Cooperation Treaty with the United States Patent and Trademark Office designating 16 States including eight Contracting States to the European Patent Convention.
- II. On 18 June 1980, the United States Patent and Trademark Office, acting as International Searching Authority, issued a search report on the international application.
- III. On 25 September 1980, the appellant corporation filed a European patent application, claiming priority from the international application and designating three Contracting States to the European Patent Convention, two of which had also been designated in the international application. With the European patent application the appellant corporation filed a copy of the search report issued on the international application. The fee for the European search report was duly paid.
- IV. It appears that the appellant corporation was unable to designate in the international application one of the States designated in the European patent application because that State had not ratified the Patent Cooperation Treaty and that this was the only reason why the European application had to be made.
- V. By letter dated 29 September 1980 the appellant corporation's representatives requested a partial refund of the fee for the European search report on the ground that the European Patent Office had the benefit of the search report issued on the international application. A 20% reduction was suggested as appropriate as that was the reduction which would have been allowed if the European application had been the regional phase processing of the international application, rather than an independent application claiming priority from the international application.

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VI. In a letter dated 23 April 1981, the Receiving Section wrote as follows :

"In answer to your letter of September 29, 1980 concerning the above-mentioned European patent application, we inform you as follows :

In the present case we must reject your request for a partial refund of the European search fee, as the decision taken by the Administrative Council to reduce the search fee by one fifth only concerns the supplementary European search reports as mentioned in Art. 157, par. 2(a) of the Convention i.e. the regional phase processing of an International Application."

VII. On 23 June 1981, the appellant corporation lodged notice of appeal against "the Decision dated 23 April 1981" asking for it to be set aside and for at least a partial refund of the fee for the European search report. Reimbursement of the appeal fee was also requested. The appeal fee was duly paid.

VIII. On 9 July 1981, the Receiving Section wrote in acknowledgement of receipt of the notice of appeal, drawing attention to the necessity to file a written statement setting out the grounds of appeal.

IX. On 3 July 1981 the appellant corporation's representatives wrote to the Receiving Section querying whether they had been correct in appealing against the "Decision" but indicating that they would be prepared to accept it as an appealable decision.

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X. On 19 August 1981 the statement of grounds of the appeal was duly received. The appellant corporation contended therein that, in accordance with the Decision of the Administrative Council of 14 September 1979 on the reduction of the search fee for the European search report, it was entitled to a refund of 20 % of the fee because a European patent application claiming priority from an international application can be regarded as an international application within the meaning of Article 150(2) EPC, having regard to the definition of "international application" in Article 2 (vii)PCT. It contended that it would be inequitable to penalize an applicant who had to use a European application in addition to an international application in order to designate States which had signed but not ratified the Patent Cooperation Treaty. It further contended that Article 10 Rules relating to Fees enables a refund to be given in the case of a European patent application claiming priority from an earlier application on which the EPO has drawn up a search report. Where the earlier application is an international application filed at a receiving Office for which the EPO acts as International Searching Authority, the applicant can obtain the refund, but an applicant of United States nationality and residence cannot file at such a Receiving Office and is thus also penalized unless the Decision of the Administrative Council of 14 September 1979 can be applied in his favour.

REASONS FOR THE DECISION

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. The Receiving Section's letter dated 23 April 1981 constitutes a decision of the Receiving Section, within the meaning of Articles 21 and 106 EPC, inasmuch as it constitutes a clear rejection of the appellant corporation's request for a partial refund of the fee for the European search report and is also reasoned as required by Rule 68(2) EPC.

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3. In accordance with the normal practice of the European Patent Office, the contents of the letter ought to have been identified as a decision, so as to preserve the clear distinction made in the Convention and Implementing Regulations between decisions and communications; cf. e.g., Rules 68 and 70 EPC. The letter ought also to have drawn attention to the possibility of appeal and the provisions of Articles 106 to 108 EPC, in conformity with Rule 68 (2) EPC. The fact that the requirements of Rule 68(2) EPC were not fully complied with does not, however, mean that that the letter was merely a communication. Whether a document issued by the European Patent Office constitutes a decision or a communication depends on the substance of its contents, not upon its form. The appellant corporation's representatives were justified in treating the letter as an appealable decision.

4. The appellant corporation's contention that their European patent application can be regarded for the purposes of Part X of the European Patent Convention (Arts 150-158) as an international application, is, however, not sustainable and must be rejected. An application cannot be an "international application pursuant to the Patent Cooperation Treaty" unless it is filed under that Treaty, which the appellant corporation's European application was not. (Art 2 (vii) PCT; Art 150(2) first sentence EPC). The argument that Article 150(2) EPC is of wider scope than Article 150(3) EPC does not help the appellant corporation. All that Article 150(3) EPC provides is that some international applications are deemed to be European patent applications. The appellant corporation is seeking to establish the converse proposition, which is contrary to Article 2(vii) PCT and Article 150(2) EPC.

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5. It is to be noted that, simultaneously, on 14 September 1979, the Administrative Council made two related Decisions (cf. Official Journal EPO 1979, 368, 369). First, it decided to reduce the search fee provided for in Article 157(2)(b) EPC by one fifth in the case of international applications on which an international search report had been drawn up by any of three specified offices, including the United States Patent and Trademark Office. Secondly, it amended Article 10 of the Rules relating to Fees inter alia by abolishing the former Article 10(2), which had read: "The search fee may be refunded fully or in part if the European search report is based on an international search report prepared under the provisions of the PCT by the European Patent Office or by any other International Searching Authority".

The deletion of the former Article 10(2), coupled with the first Decision, shows that it was deliberately decided to reduce the scope for giving refunds after 14 September 1979. It is not possible, therefore, to interpret either the first Decision or the amended Article 10 by reference to the considerations of "equity" urged by the appellant corporation's representatives. In the absence of a basis for this appeal in the Rules relating to Fees, it cannot succeed.

6. As the appeal does not succeed, the application for reimbursement of the appeal fee in accordance with Rule 67 EPC must fail.

For these reasons,

it is decided that:

The appeal against the decision of the Receiving Section of the European Patent Office dated 23 April 1981 and the application for reimbursement of the appeal fee are dismissed.