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Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number : J 4/88 - 3.1.1



**D E C I S I O N**  
of the Legal Board of Appeal  
of 23 September 1988

**Appellant :** GEO MECCANICA IDROTECNICA s.r.l.  
via Campoleone Tenuta 13  
1-04010 Campoleone 2T

**Representative :** Dr. Bruno Reitzner  
c/o Patentanwälte Dipl.-Ing. R. Splanemann,  
Dr. B. Reitzner  
Tal 13  
8000 München 2

**Decision under appeal :** Decision of the Receiving Section of  
the European Patent Office dated  
31 July 1988.

**Composition of the Board :**

**Chairman :** P. Ford  
**Members :** R. Schulte  
F. Benussi

## Summary of Facts and Submissions

- I. The Applicant - a legal person having its principal place of business in Italy - filed a European patent application No. 85 830 167.4 on 2 July 1985. The description of the invention, the patent claims and the abstract were filed in Italian and English, whereas the Form 1001 containing the request for grant of a European patent, the request for examination and the designation of nine States was filled in in English only. The examination fee was not paid at the time of filing.
- II. The publication of the European search report was mentioned in the European Patent Bulletin on 12 February 1986.
- III. By a communication dated 19 February 1986 the Applicant was reminded to pay the examination fee. As it remained unpaid, a communication of 9 September 1986 informed the Applicant of the possibility of rectifying the deficiency within a period of two months after the 12 August 1986 by paying a surcharge according to Rule 85b EPC.
- IV. On 8 October 1986 the Applicant paid a sum representing 80% of the examination fee and the surcharge of 50% of the full examination fee in cash into a bank account held by the EPO with an Italian bank. On the same day, the Applicant sent a second request for examination by registered letter (special delivery) in which the request was expressed both in English and in Italian. This letter was not, however, received until 14 October 1986.
- V. By communication dated 7 November 1986, the Receiving Section informed the Applicant, pursuant to Rule 69(1) EPC, that the application was deemed to have been

withdrawn as the examination fee had not been paid. In response to a protest by the Applicant, the Receiving Section subsequently asserted that since no translation of the request for examination had been filed in the Italian language prior to 13 October 1986, the Applicant was not entitled to a reduction in the examination fee. The translation had been received too late.

VI. The Applicant requested a decision under Rule 69(2) EPC. The Receiving Section gave the decision under appeal dated 31 July 1987 stating that the European patent application was deemed to be withdrawn because the request for examination is deemed not to have been filed in due time because the full amount of the examination fee had not been paid. The amount lacking (13.33%) could not be considered small within the meaning of Article 9(1), fourth sentence, of the Rules relating to Fees.

VII. The Applicant duly lodged an appeal against the decision, requesting that the decision be set aside. The Appellant argued essentially that the underpayment should be considered small in the light of the decision of the Legal Board in Case J 11/85, OJ EPO 1986, 1.

#### Reasons for the Decision

1. The appeal is admissible.
2. The Board is unable to share the opinion of the first instance that the patent application is deemed to be withdrawn. The request for examination was filed and a sufficient amount for the examination fee was paid in due time.

3. The Receiving Section correctly found that the effective request for examination was that filed with the patent application in English only and that no translation of this request in Italian was filed within the six month period prescribed in Article 94(2) EPC.
4. However, pursuant to Article 14(2) and Rule 6(3) EPC, a legal person having its principal place of business within the territory of a Contracting State, having a language other than English, French or German as an official language (in this case Italy), may file a European patent application in an official language of that State (in this case Italian). An applicant who avails himself of the option provided in Article 14(2) EPC shall be allowed a reduction in the examination fee, according to Rule 6(3) EPC.
5. In the present case, the Appellant filed his European patent application partly in Italian and English, partly in English only, namely the Form 1001 containing the request for grant, the designation of States and the request for examination in English only and the description of the invention the claims and the abstract in Italian and English. The Board considers that this is sufficient for the purposes of Article 14(2) EPC. It is true that Article 14(2) EPC mentions the filing of a "European patent application" and according to Article 78(1) EPC a European patent application shall contain the request for grant, the description, at least one claim, drawings and an abstract. But for the purpose of Article 14(2) EPC, only those parts of a European patent application are of interest which are difficult to translate and these are the description and the claims whereas all other parts cause no difficulties in translating or understanding. On this basis, this Board decided in Case J 07/80, OJ EPO 1981, 137, that for the

purposes of Article 14(1) and (2) in accordance with Article 80(d) EPC, the significant language is that used for the description and claims. The same reasoning applies in relation to Article 14(2) and Rule 6(3) EPC. Therefore, it is sufficient for the reduction of the fees mentioned in Rule 6(3) EPC that the description, the claims and the abstract were filed in an official language of a Contracting State other than English, French or German. If this requirement is fulfilled it is not significant for this purpose that other parts of the European patent application, e.g. the request for grant, the request for examination and the designation of States, are filed in one of the official languages of the EPO only.

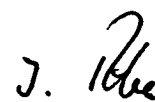
6. In consequence, the Appellant was entitled to pay the examination fee with a reduction of 20%. As the amount for the reduced fee was paid in time the surcharge paid has to be reimbursed.

#### Order


For these reasons, it is decided that:

1. The decision of the Receiving Section dated 31 July 1987 is set aside.
2. The surcharge paid with respect to the examination fee is to be reimbursed.

The Registrar:

  
J. Rückerl

The Chairman:

  
P. Ford

3. The opposition fee is deemed to have been paid and the notice of opposition of the Appellant filed, in due time.

The Registrar:

The Chairman:

P. Martorana

K. Lederer