

BESCHWERDEKAMMERN
DES EUROPÄISCHEN
PATENTAMTS

BOARDS OF APPEAL OF
THE EUROPEAN PATENT
OFFICE

CHAMBRES DE RECOURS
DE L'OFFICE EUROPEEN
DES BREVETS

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen

D E C I S I O N
of 15 December 1995

Case Number: J 0017/93 - 3.1.1
Application Number: 91 910 699.7
Publication Number: 0 531 420
IPC: B25B 13/46

Language of the proceedings: EN

Title of invention:
Torque wrench

Applicant:
Barnes Group Inc.

Headword:
Search fee/BARNES GROUP

Relevant legal norms:
EPC Art. 106(1), 106(3), Rules 46, 84

Keyword:

Decisions cited:
J 8/81, J 37/89, T 493/88

Headnote:



Case Number: J 0017/93 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal
of 15 December 1995

Appellant: Barnes Group Inc.
123 Main Street
Bristol
Connecticut 06014 (US)

Representative: Cortey, Pierre
Cabinet Hirsch
34, rue de Bassano
F-75008 Paris (FR)

Decision under appeal: Refusal in communication dated 15 September 1993
from the Receiving Section of the request made
6 September 1993 for an extension of time of two
months of the period set by the Search Division in
which to pay an additional search fee.

Composition of the Board:

Chairman: R. L. J. Schulte
Members: S. C. Perryman
J. P. B. Seitz

Summary of Facts and Submissions

- I. European patent application No. 91 910 699.7 was filed as International Application No. PCT/US91/03588 on 21 May 1991 in the name of the Appellant. It duly entered the regional phase before the European Patent Office. By a communication dated 24 August 1993 from the Search Division of the European Patent Office the partial supplementary European search report under Rule 46(1) EPC was transmitted to the Appellant, indicating that the subject matter of the claims contained two separate inventions, (identifying these by reference to the claims) and informing the Appellant that if the European search report is also to cover these inventions other than the invention first mentioned in the claims, a further search fee must be paid for each of these inventions, within 1 month from the notification of the communication.
- II. By fax dated and received 6 September 1993 the Appellant asked for an extension of term of two months for filing the response to the pending official notification issued in accordance with Article 96(2) EPC.
- III. By communication dated 15 September 1993 the ReceivingSection replied:

"With reference to your fax dated 06 September 1993, we hereby inform you that your request for an extension of the time limit has been refused.

We draw your attention to Rule 46(1) EPC according to which a further search fee must be paid within a period to be fixed by the Search Division which must not be shorter than two weeks and must not exceed six weeks."

IV. By fax of and received on 16 September 1993 the Appellant filed a Notice of Appeal against the refusal of 15 September 1993 of the requested extension of time, paying the appeal fee, and asking that the decision be set aside arguing essentially that Rule 84 EPC allowed such an extension of time, and that any conflict between Rules 46 and 84 EPC should be resolved in favour of the Appellant. Further, interlocutory revision and refund of the appeal fee on the basis of a substantial vice of proceeding were requested.

V. On 22 September 1993 the supplementary search fee was paid, with a reservation of the right to challenge whether it was in fact due.

VI. A statement of the Grounds of Appeal was filed by fax on 17 January 1994, the Appellant requesting oral proceedings and arguing essentially as follows:

- (a) If the Appellant chose not to pay the supplementary search fee, then the right to put forward claims to the second invention in that application was lost, and this amounted to a final termination of the proceedings relating to the second invention. Accordingly the refusal to grant the extension of time amounted to a decision which did terminate proceedings finally in respect of the Appellant. In this connection it was suggested that the following questions be submitted to the Enlarged Board of Appeal:

"in the case of a non-unitary application, and if the applicant does not pay the further search fee requested under Rule 46(1) EPC, does the refusal of a request for an extension of the time limit under Rule 46 terminate the proceedings with regard to

the non-searched claims? If not, what is the final decision which terminates the proceedings with regard to the non-searched claims?"

"in the case of a unitary application, which is wrongly considered as non-unitary by the Search Division, and if the applicant does not pay the further search fee requested under Rule 46(1) EPC, does the refusal of a request for extension of the time limit under Rule 46 terminate the proceedings with regard to the non-searched claims. If not, what is the final decision which terminates the proceedings with regard to the non-searched claims?"

- (b) Whereas the special provisions of Rule 46 EPC derogated from the general provisions of Rule 84 EPC first sentence, Rule 46 EPC contained nothing equivalent to or derogating from Rule 84 second sentence "In certain special cases, the period may be extended upon request, presented before expiry of such period." This second sentence thus also applied in the case of an additional search fee for which a time limit had been specified under Rule 46(1) EPC, and thus the requested extension should have been granted.
- (c) In other (listed) cases the EPO had in fact granted extensions of time for paying an additional search fee. This suggested that the EPO in fact had a discretion to grant such extension. The failure to state any reasons for exercising the discretion to refuse in this case was thus both puzzling, and amounted to a procedural violation contrary to Rule 68(2) EPC, which amounted to a procedural violation making it equitable to repay the appeal fee, based on T 493/88 (OJ EPO 1991, 380).

- VII. A communication pursuant to Article 12 of the Rules of Procedure of the Boards of Appeal was sent expressing the provisional opinion of the Board that the Appeal was not admissible under the provisions of Article 106 EPC, and that in view of this the Board would not in its decision enter on the substantive issues the subject of the appeal.
- VIII. By fax of 13 April 1995, and in a subsequent telephone conversation between the rapporteur and Appellant's representative, the Appellant maintained and amplified his previous arguments, and further submitted that the principle of good faith applied by the Boards of Appeal meant that similar cases should be treated in similar ways. Thus the fact that extensions had been granted in other cases meant that an extension should have been granted here too. The delays that might occur by granting extensions of time were minimal and no prejudice to the public, but would assist applicants as the six week period was a very short time, particularly in the holiday period, to get authorization from those responsible to consider and make an additional major payment. The request for oral proceedings was withdrawn.

Reasons for the Decision

1. To be admissible under Article 106 EPC there must for the purpose of Article 106(1) EPC be a **decision** of the Receiving Section, Examining Divisions, Opposition Divisions or Legal Division, and under Article 106(3) EPC if this decision does not terminate the proceedings as regards one of the parties, the decision must allow separate appeal.

2. If after the refusal to extend the period set, the additional search fee had not been paid and this had indeed terminated the proceedings as far as the possibility of protection of the second invention was concerned, then it would have been the non-payment of the additional search fee, and not the refusal of the extension which would have terminated the proceedings as far as the second invention was concerned. In any case here the additional search fee was paid, so there is no question of the proceedings being terminated in any respect, and the Board sees no need to refer any question to the Enlarged Board.

3. The communication dated 15 September 1993 from the Receiving Section is not stated to be a decision, and it does not terminate the proceedings as regards the Appellant. Obviously, as it is not stated to be a decision, it does not contain a statement allowing a separate appeal against the refusal. Even if the Board were to treat the communication as a decision for the purposes of Article 106(1) EPC, the appeal would be inadmissible under Article 106(3) EPC as one against a decision not terminating the proceedings and for which a separate appeal has not been allowed. Nevertheless, though the outcome of this appeal does not turn on the question of whether the communication is a decision, inadmissibility under Article 106(3) EPC can only arise if the question of admissibility under Article 106(1) EPC has been answered in the affirmative. Also whether the refusal of the extension can be reviewed together with consideration of some other point on appeal from some final decision in these proceedings, depends on whether the communication of 15 September 1993 was a decision, so this must be decided.

4. Whether the communication of 15 September 1993 is a decision depends on its substance not on its form (cf. decision J 8/81 CATERPILLAR OJ EPO 1982, 10). The EPO officer writing the communication had not had her attention drawn to the arguments listed above under facts and submissions. An explanation is given for the refusal of the extension, namely that it would be contrary to Rule 46(1) EPC, but this seems to be given by way of information that what the Appellant asked for was impossible, rather than in a conscious awareness that a decision was being made. To consider the communication a decision would lead to the undesirable result that in any further appeal the Board then hearing the appeal would be deprived of the first instance's reasoning on many of the points made by the Appellant.

5. It is primarily the responsibility of the first instance to ensure that its practice is consistent with the EPC and uniform for all applicants. The first instance is also the organ of the EPO which can consider whether in the interest of applicants required to pay extra search fees the period for payment cannot be made longer by varying the EPC without adversely affecting other interests. In order to ensure that the first instance can carry out its duties, if its practice is challenged it is desirable that the first instance has the opportunity to consider the full arguments put forward, so that it can give a fully reasoned decision, which the Boards of Appeal can then if necessary review with the benefit of a full statement of the position of the first instance. It would be contrary to this desideratum to treat a communication which was merely intended to be informative, as a decision. The Board accordingly considers that it would be inappropriate in this situation to treat the communication of 15 September 1993 as a decision, in contrast to the situation considered in decision J 37/89 (OJ EPO 1993, 201) in

relation to a request for an extension of time under Rule 84 EPC, where the refusal of an extension was considered a decision for the purpose of Article 106(1) EPC.

6. The appeal must thus be rejected as inadmissible because there is no decision by the Receiving Section.
7. The questions raised by the Appellant are of considerable interest. In order that they can be considered fully in some appropriate case, it would seem appropriate for an applicant to ask for extension of time, and if this is refused for a reasoned decision for such refusal, allowing for a separate appeal.

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible.

The Registrar:

The Chairman:

M. Beer

R. L. J. Schulte