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**D E C I S I O N**  
of 6 April 2001

**Case Number:** J 0013/98 - 3.1.1

**Application Number:** 95500093.0

**Publication Number:** 0713905

**IPC:** C09D 7/14

**Language of the proceedings:** EN

**Title of invention:**

Method for the incorporation of additives in ground paint

**Applicant:**

MINERALS GIRONA, S.A.

**Opponent:**

-

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 94(2), 122(5), 85b

RRF Art. 8(1), (3)

**Keyword:**

"Rules relating to fees"

"Date of payment"

"Cheque sent by private courier"

**Decisions cited:**

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**Catchword:**

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Boards of Appeal

Chambres de recours

Case Number: J 0013/98 - 3.1.1

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.1  
of 6 April 2001

**Appellant:** MINERALS GIRONA, S.A.  
Ctra. Nacional II KM 8,3  
ES-17600 Figueras (Girona) (ES)

**Representative:** -

**Decision under appeal:** Decision of the Receiving Section of the European Patent Office dated 10 October 1997 declaring that European patent application No. 95 500 093.0 is deemed to be withdrawn.

**Composition of the Board:**

**Chairman:** J.-C. Saisset  
**Members:** V. Di Cerbo  
A. C. G. Lindqvist

## Summary of Facts and Submissions

- I. European Patent Application No. 95 500 093.0 was filed on 29 June 1995 on behalf of Minerals Girona S.A.

The application was published under number EP 0713905 on 29 May 1996.

Pursuant to Article 94(2) EPC a request for examination may be filed by the applicant up to the end of six months after the date on which the European Patent Bulletin mentions the publication of the European search report; said request shall not be deemed to be filed until after the examination fee has been paid.

In the case in suit the time limit expired on 29 November 1996.

- II. By a letter dated 28 November 1996 the professional representative of the applicant requested examination and sent a cheque in payment of the examination fee. Said letter was not received by the EPO until 2 December 1996.
- III. On 5 March 1997 a communication pursuant to Article 8(3) and (4) of Rules relating to fees and to Rule 85b EPC was sent to the applicant's representative informing him that the examination fee had been paid after the expiry of the time limit and that the fee could nevertheless be considered as having been (validly) paid within the period of grace of one month after notification of the communication, provided that one of the conditions specified in the communication itself were satisfied. In particular the communication mentioned the possibility of paying a surcharge of 50% on the examination fee pursuant to Rule 85b EPC.

On 30 April 1997 the applicant's representative sent to the EPO, by facsimile, a letter (dated 29 April 1997) where it was submitted that the reason for the delay in answering the EPO communication dated 5 March 1997 was that he had tried to obtain from the courier company TNT Express Worldwide evidence that the cheque relating to the payment of the examination fee had been delivered to the EPO in due time, ie on 29 November 1996. However the documents obtained by TNT (copies of which were sent as annexes to the letter) showed that said cheque and the letter with the request for examination (which had been sent to Munich on 28 November 1996) had been received by the EPO only on 2 December 1996.

On 21 May 1997 noting of loss of rights pursuant to Rule 69(1) EPC was sent to the applicant by the formalities officer. According to the notice the European Patent Application No. 95 500 093.0 was deemed to be withdrawn pursuant to Article 94(3) EPC because no valid request for examination had been filed within the time limits laid down in Article 94(2) and Rule 85b EPC. With the same letter it was pointed out that the examination fee was not validly paid.

By facsimile (dated 28 May 1997) sent to the formalities officer the applicant's representative stressed in particular that he had sent the payment of the examination fee on 28 November 1996, ie one day before expiry of the time limit, and requested that the EPO take into account said circumstance.

By a letter dated 19 June 1997 the formalities officer informed the applicant's representative:

- (a) that the evidence supplied with the communication dated 29 April 1997 had been filed too late, since

the grace period had elapsed (one month after the notification of EPO Form 1149a, dated 5 March 1997).

- (b) that no surcharge had been paid;
- (c) that the evidence provided could not anyhow be considered sufficient.

By a letter dated 27 June 1997 the applicant's representative provided the formalities officer with a statement by TNT Express Worldwide confirming the date of the delivery of the documents to the EPO (on 2 December instead of 29 November, as planned); according to said statement the delay was "due to technical problems in Cologne's Airport". In the same letter the applicant's representative submitted that the ground for the delay in answering the EPO communication dated 5 March 1997 was that the person handling the case left the office without informing the patent attorneys that the file was pending for response.

In its decision dated 10 October 1997 the Receiving Section stated: "The European Patent Application is deemed to be withdrawn (Article 94(3) EPC) because no valid request for examination was filed within the time limits laid down in Article 94(2) and Rule 85 b EPC, since the examination fee was not validly paid".

The reasons given by the Receiving Section for its decision can be summarized as follows:

A private courier service, such as the one used by the applicant to send the request for examination (TNT Express Worldwide), cannot be considered as falling within the meaning of "postal services" as used in Article 120 EPC. Consequently the only remedy available

to the representative to validate the late payment of the examination fee was the payment of a surcharge of 50% of the examination fee (pursuant to Rule 85b EPC and Article 2, item 7, Rules relating to fees). Since the 50% surcharge was not paid within the time limit (in fact it was never paid) no valid request for examination existed. Accordingly the application was deemed to be withdrawn due to late payment of the examination fee.

Furthermore, in its decision the Receiving Section informed the applicant that an application for Restitutio in integrum was specifically excluded by virtue of Article 122(5) EPC and that once the decision had become final the late paid examination fee would have been refunded to him.

IV. On 30 October 1997 a notice of appeal against the decision of the Receiving Section was filed by the applicant. On 31 October the appeal fee was paid.

On 23 January 1998 the statement of grounds was filed. The applicant requested that the prosecution of the application be allowed.

The appellant's submissions are summarized as follows:

- (a) The communication pursuant to Article 8(3,4) Rules relating to fees, dated 5 March 1997, was received, in the representative's office, by the person who handled the file; said person, who was going to leave the office due to health problems, did not inform anyone of the above communication; only on 25 April 1997, after this person had left the office, did the new employee who was entrusted with the file become aware of the above communication.

(b) The request for examination and the cheque for the payment of the examination fee had been sent to the EPO one day before the expiry of the time limit; on the basis of an agreement between the applicant's representative and the courier company TNT Express Worldwide said documents should have been delivered the next day, ie in due time; the delay in delivering the documents was due to technical problems which occurred at Cologne airport.

V. No request for oral proceedings has been filed.

VI. By a letter dated 30 November 2000 the appellant's representative urged the Board to decide on the appeal.

### **Reasons for the Decision**

1. The appeal complies with the requirements of Articles 106 to 108 and Rule 64 EPC. It is therefore admissible.
2. The relevant facts have not been disputed by the appellant. In particular he admitted: that the request for examination and the examination fee were received by the EPO on 2 December 1996, ie after the expiry of the time limit provided for in Article 94(2) EPC; that he used a courier (TNT Express Worldwide); that the communication dated 5 March 1997, which reminded the applicant of the possibility to enjoy a one month period of grace, had been duly received by the applicant's representative; that nevertheless the 50% surcharge on the examination fee had not been paid within said period of grace.

3. Pursuant to Rule 85b EPC, if the request for examination has not been filed within the time limit provided for in Article 94, paragraph 2, EPC, it may still be validly filed within a period of grace of one month from notification of a communication pointing out the failure to observe the time limit, provided that within this period a surcharge is paid. The amount of the surcharge has been settled as 50% of the examination fee (Article 2, item 7, Rules relating to fees).

In the case under appeal said surcharge has never been paid, although the appellant received the EPO communication referred to in Rule 85b EPC.

In the grounds of appeal it was maintained that the reason for the non-timely reaction to the above quoted EPO communication dated 5 March 1997, was that the latter was received, in the appellant's representative office, by an employee who, even though entrusted to handle the file, was going to leave the office and did not inform anyone of the said communication.

This argument cannot be shared by the Board since, as a matter of principle, a delay in taking into consideration a communication sent by the EPO falls entirely under the responsibility of the addressee (that is, in the case in suit the appellant's representative) and therefore cannot be justified. Nor can said argument be used to justify a request for restitutio in integrum since, apart from any other consideration, pursuant to Article 122(5) EPC, the provisions relating to re-establishment of rights are not applicable to the time limits referred to (among others) in Article 94, paragraph 2, EPC governing the request for examination and the examination fee.



4. The appellant further emphasized, in order to substantiate the appeal and the related request that the prosecution of the application be allowed, that the request for examination and the cheque for the payment of the examination fee had been sent to the EPO one day before expiry of the time limit; since there was an agreement between the applicant's representative and the courier company according to which said documents should have been delivered the next day, ie in due time, the delay in delivering the documents (which was due to technical problems which occurred at Cologne airport) was entirely out of his control.

Said argument is not convincing.

Indeed, pursuant to Article 8(1)(c) Rules relating to fees (in the wording in force in the year 1997) the date on which a payment shall be considered to have been made to the Office is, in the case of delivery of cheques made payable to the Office, the date of receipt of the cheque at the Office. (In the case in suit the date of receipt was 2 December 1997).

Moreover none of the conditions laid down in Article 8(3) Rules relating to fees are satisfied. In particular:

- (a) the requirements of items (a), (III) and (b) are not fulfilled, since the letter containing the cheque for the payment of the examination fee was not despatched at a post office but by a courier company and no surcharge of 10% on the examination fee was paid pursuant to Article 8(3)(b) Rules relating to fees.
- (b) the letter containing the cheque was not despatched at a post office at least ten days before the expiry of the period of payment.

It has to be stressed that to use a private courier such as TNT to despatch the letter containing the cheque to the EPO could not be considered, in 1997, as equivalent to the use of the postal services. Indeed, it was only in 1999 that the courier TNT was recognised by the EPO as a delivery service equivalent to the postal service (see Decision of the President of the EPO dated 11 December 1998, OJ EPO 1999, 45). But this provision cannot be applied to the case in suit since it entered into force on 1 January 1999 and cannot have retroactive effect. The principle "tempus regit actum" has to be applied.

**Order**

**For these reasons it is decided that:**

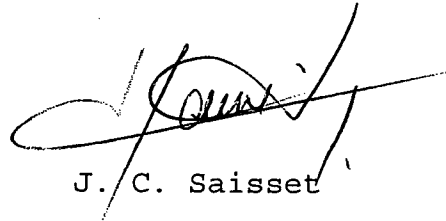
The appeal is dismissed.

The Registrar:



M. Beer

The Chairman:



J. C. Saisset

*vi di/Lgt*