

REFUNDING EXAMINATION FEES



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The search and examination of European patent applications occur in separate stages, which means that an applicant receives the search report before he has to decide whether he wishes the application to be examined.

The Examination Division assumes responsibility subsequent to the applicant's request for examination and payment of the examination fee. When the first examination report is drawn up is subject to variations depending on the workload of the European examiners.

If the applicant loses interest in the application he may invoke Art. 11(b) of the Rules relating to Fees, which states that 75 percent of the examination fee can be refunded if the "application is withdrawn, refused or deemed to be withdrawn after the Examining Division has assumed responsibility, but before substantive examination has begun".

This article encourages applicants to withdraw applications so that the Examining Division can focus its limited resources on 'relevant' applications.

Decision J 25/10 from the Legal Board of Appeal concerns a European application based on an international patent application. The applicant filed a request for examination and paid the examination fee but reconsidered and filed a request for withdrawal of the European application together with a request for partial refund of the examination fee. The decision of the European Patent Office (EPO) to deny the partial refund was appealed and, according to the decision on the appeal, the denial was based on the simple statement from the primary examiner that "he had already started with the substantive examination when the application was withdrawn".

The file did not contain any indication showing, by reference to objective criteria, that the Examining Division had performed a concrete act of any kind that could be regarded as a start of substantive examination in the regional phase once the request for examination had been filed.

Decision J 25/10 summarises that:

- A written opinion issued by the EPO for the related international patent application cannot be considered an act of substantive examination;
- As the start of substantive examination depends of the individual circumstances of the case, which are unknown to the applicant, this leaves the applicant in uncertainty with respect to when he can withdraw his application and receive the partial refund; and
- The request for partial refund was denied by the Examining Division without reference to underlying facts that could objectively demonstrate that substantive examination had begun prior to the applicant's request

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for withdrawal of the application, so the applicant was deprived of any basis to determine the correctness of the decision to deny the refund.

The Legal Board of Appeal concluded that the Examining Division's denial of the refund was made in a manner that was neither predictable nor verifiable for the applicant, which is contrary to the principles of legal certainty set out in decision G 3/08 by the Enlarged Board of Appeal. The relevant information of whether or not substantive examination was actually started lay solely within the knowledge of the EPO. As the decision to allow or deny a request for partial refund of the examination fee also involves the financial interest of the EPO, it is important for public confidence in the EPO that the grounds for such a decision are transparent.

The Legal Board of Appeal decided that the applicant was entitled to a partial refund of the examination fee.

Based on decision J 25/10, the EPO may change its practice regarding partial refunds of examination fees. It may be that the Examining Division will notify the applicant of the date on which the substantive examination starts.

Decision J 25/10 does not mention a corresponding issue with the possible refund of the search fee which, according to Art. 9(1) of the Rules relating to fees, will be refunded in full if the application is withdrawn, refused or deemed to be withdrawn before the Search Division starts to draw up the search report. This issue might be the subject of an appeal in the future, or a change in the Guidelines for Examination at the EPO.

Until any future change occurs in the practice of the EPO, it is recommended that applicants carefully consider if and when a request for withdrawal and a request for refund of the fee(s) should be submitted after the applicant has lost interest in the application, in order to increase the likelihood of having the fee(s) refunded. ■

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