

BR/GT I/73 e/70

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INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

Brussels, 16 November 1970
BR/GT I/73/70

- Secretariat -

Working document
for Draft Rules relating to Fees
pursuant to the Convention establishing a European System for the Grant of Patents
put forward by the Chairman of the
Sub-Committee of Working Party I on "Rules relating to Fees".

Notes

Preamble

The relevant provision of the Convention in this case is that drawn up by Working Party II (BR/33/70, Article a, paragraph 1, B(c)).

Proposal

The Administrative Council of the European Patent Office, having regard to Article ... of the Convention establishing a European System for the Grant of Patents, hereby issues the following Rules relating to Fees:

Notes

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Article 1General

Proposal

The fees provided for in the Convention and in the Implementing Regulations to the Convention and the fees which the President of the European Patent Office lays down pursuant to Article 3 shall be charged in accordance with the provisions contained in these Rules.

Article 2

General

1. The list of fees provided for in the Convention and in the Implementing Regulations to the Convention could also be contained in an annex to these Rules. In that case, Article 2 might be worded as follows:
 "The amount of the fees provided for in the Convention and in the Implementing Regulations to the Convention shall be laid down in the Annex to these Rules."
2. As in the Report of Working Party IV on the financing of the European Patent Office (Chairman's proposals, BR/GT IV/37/70) the amounts of the fees are here given provisionally in dollars. The amounts of the fees proposed in that Report (Chapter XIII, Summary of Conclusions) have been taken over with the variants then proposed, which are given here as Variant A and Variant B. No amounts have been inserted for the fees marked "neutral" and "not taken into consideration" in Annex 11 of Working Party IV's Report. These amounts are not important either for the financing of the European Patent Office or for the applicant, as they are intended merely to cover costs. It would therefore be premature to lay down the amounts thereof at this stage.

Article 2

Fees Provided for in the Convention and in the Implementing Regulations to the Convention

Proposal

The fees provided for in the Convention and in the Implementing Regulations to the Convention shall be laid down as follows:

	Dollars	
	<u>Variant A</u>	<u>Variant B</u>
(1) Filing fee (Article 66 (3) of the Convention):	100	118

Notes

No. 2

Under Article 67 (2) of the Convention, the designation of a Contracting State is to be subject to the payment of the fee prescribed in the Rules relating to Fees. Under Article 67 (4), a group of Contracting States within the meaning of Article 8 of the Convention may provide that these States may only be designated jointly, and that the designation of one or some only of such States is to be deemed to constitute the designation of all the States of the group. The wording of this provision does not exclude a designation fee being paid for each of the Contracting States in such a group. If only one designation Fee is to be charged for such a group of Contracting States, this should be stated explicitly in the Rules relating to Fees at least.

Contrary to the conclusions of Working Party IV (see BR/GT IV/37/70), it might be considered whether the designation fee for a group of Contracting States might be a multiple of the designation fee for individual Contracting States.

No. 4

At present the IIB charges States Parties to the Agreement concerning the Establishment of an International Patents Bureau the sum of Fl.590 (\$163) for a report on the state of the art.

(Continued)

Proposal		
	Dollars	
	<u>Variant A</u>	<u>Variant B</u>
(2) Designation fee (Article 67 (2) of the Convention)		
(a) For each Contracting State designated:	12	15
(b) For a group of Contracting States which may only be designated jointly, in accordance with Article 67 (4) of the Convention:
 (3) Fee, in the case of more than ten claims (Article ... (Re. Article 71, No. 1 (1), of the Implementing Regulations), for the eleventh and each subsequent claim:		...
 (4) Fee for obtaining the report on the state of the art (Article 79 (1), of the Conven- tion):	As charged by the IIB	\$100 less than charged by the IIB

Notes

No. 6

The question as to who should bear the costs of the supplementary report on the state of the art has been reserved for further examination. See the Note to Article 122 (2) of the Convention.

(Continued)

Proposal												
Dollars												
	<div>Variant AVariant B</div>											
(5) Fee for obtaining an additional report on the state of the art (Article 79 (5); Article 82 (3); Article 93 (2); Article 113 (3) of the Convention):	As charged by the IIB											
(6) Fee for obtaining a supplementary report on the state of the art (Article 122 (2) of the Convention)	As charged by the IIB											
(7) Examination fee (Article 88 (2) of the Convention)	100124											
(8) Renewal fees for the European Patent application (Article 129 (1) of the Convention)												
(a) For the 3rd year, calculated from the date of filing of the application	35											
(b) " " 4th " " " " " " " " " "	50											
(c) " " 5th " " " " " " " " " "	65											
(d) " " 6th " " " " " " " " " "	80											
(e) " " 7th " " " " " " " " " "	100											
(f) " " 8th " " " " " " " " " "	120											
(g) " " 9th " " " " " " " " " "	140											
(h) " " 10th and each subsequent year	170											

Notes

No. 11

It should be examined whether this fee should be a uniform fee or graduated according to the volume of the specification to be published. If the uniform fee is adopted it might be combined with the fee for grant to form a single standard fee.

No. 12

As regards whether this fee should be uniform or graduated, see the Note to No. 11.

Article 2

(Continued)

Proposal

Dollars

Variant A

Variant B

(9) Additional fee for belated payment of a renewal fee
(Article 130 (2) of the Convention):

...

(10) Fee for grant (Article 97 (1) of the Convention):

25

31

(11) Fee for printing the European patent specification
(Article 97 (1) of the Convention):

...

(12) Fee for printing a new specification of the
European patent (Article 105 (3) of the Convention):

...

(13) Opposition fee (Article 101 (1) of the Convention):

25

31

(14) Fee for appeal (Article 111 of the Convention):

100

124

Notes

No. 15

Article 28a, which is referred to in connection with this fee, is that newly drafted by Working Party I (BR/48/70).

No. 17

According to the proposal of the Chairman of the Sub-Committee on "Implementing Regulations" of Working Party I (see BR/GT I/63/70, Re. Article 162, No. 4) inspection of the files of European patent applications and of European patents may also take place, on special request, on the premises of the central industrial property office of the Contracting State on whose territory the person making the request has his residence or place of business. It is assumed that in this case the person making the request will also bear the costs of sending the files. In accordance with Article 3 of the present Draft Rules relating to Fees, the President of the European Patent Office may lay down the amount of such costs.

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Article 2

(Continued)

Proposal

	Dollars	
	<u>Variant A</u>	<u>Variant B</u>
(15) Fee for recording in the Register of European Patents the assignment of a licence or of any other right in respect of the European patent application (Article 23, (2); Article 28a, (new) of the Convention):		...
(16) Fee for the cancellation of an entry in the Register of European Patents concerning the grant or assignment of a licence in respect of a European patent application (Article ... (Re. Article 28, No. 1) of the Implementing Regulations):		...
(17) Fee for the inspection of the files of a European patent application or of a European patent (Article 23 (3); Article 162 (3) of the Convention):		...
(18) Fee for delivery of an extract from the Register of European Patents (Article 59 (2) of the Convention):		...

Notes

No. 23

The Article of the Implementing Regulations referred to here (No. 5 Re. Article 162 of the Convention), as proposed by the Chairman of the Sub-Committee on "Implementing Regulations" of Working Party I in BR/GT I/63/70, has not yet been discussed by that Sub-Committee.

Nos. 24 and 25

Article 22 (1) of the PCT and Rule 14 of the Regulations under the PCT leave it to the national law or to the receiving Office to charge this fee. Under Article 2(x) and (xv) of the PCT, "national law" is construed as the law of the relevant treaty, and the European Patent Office may be the receiving Office. Therefore if the European Patent Office wishes

Article 2

(Continued)

Proposal

Dollars

Variant AVariant B

- (19) Fee for obtaining duplicate copies of the European patent certificate (Article ... (Re. Article 99, No. 1) of the Implementing Regulations):
- (20) Fee for the request for conservation of evidence (Article ... (Re. Article 154, No. 7, (3)) of the Implementing Regulations):
- (21) Fee for an application for re-establishment of the applicant's rights (Article ... (Re. Article 156, No. 1) of the Implementing Regulations):
- (22) Fee for the issue of a certified copy of the European patent application (Article ... (Re. Article 159, No. 6) of the Implementing Regulations):
- (23) Fee for communicating information concerning the files of a European patent application or European patent (Article ... (Re. Article 162, No. 5) of the Implementing Regulations):
- [(24) Transmittal fee for an international patent application (Rule 14 of the Regulations under the PCT):
- [(25) "National fee" for an international patent application (Article 22 (1) of the PCT):

...

...

...

...

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...

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]

]

Notes

Nos. 24 and 25 (Continued)

to charge the fee provided for in the PCT for international patent applications, a corresponding provision must be provided in the Convention or in the Implementing Regulations to the Convention.

Article 2

(Continued)

Proposal

Notes

Article 3

In the view of the Chairman, the power of the President of the European Patent Office to lay down the charges for providing specifications, subscription rates and charges for other publications is not contained in this provision. The reason it has not been included is that fees as such are not concerned in this respect. If the President of the European Patent Office is given no such power to lay down charges in the Implementing Regulations to the Convention, it would be expedient to extend the present provision accordingly.

Article 3Fees laid down by the President of the European Patent Office

Proposal

The President of the European Patent Office shall lay down and shall publish in the Official Journal of the European Patent Office the fee for further demands upon the European Patent Office, such as attestations, copies, photocopies, films and information.

Notes

Article 4

This provision corresponds to the proposal by the Chairman of the Sub-Committee on "Implementing Regulations" of Working Party I for Article ... (Re. Article 159, No. 7) and Note 2 to that Article. That Sub-Committee decided at its meeting from 20 to 23 October 1970 that such a provision should be contained not in the Implementing Regulations but in the Rules relating to Fees.

Article 4Due date for fees

Proposal

(1) Fees in respect of which the due date is not obvious from the provisions of the Convention or of the Implementing Regulations to the Convention, shall in principle be due on the date of receipt of the request for the procedure incurring the fee concerned.

(2) The President of the European Patent Office may however decide not to make the issue of documents, copies and photocopies, the supplying of information or the rendering of any similar service dependent on the advance payment of the corresponding fee.

Article 5 (1)

The list of possible methods of payment contains only those which are in current use for international payments. Whether other methods of payment should be made possible (e.g. remittance or delivery of Giro cheques, postal or money orders, etc.) depends largely upon the place in which the European Patent Office will be located. When this is known, it might be appropriate to consider further possible methods of paying fees, especially those practised in the country where the EPO is located.

Article 5 (3)

1. The proposed rule is based on a centralised solution, according to which the fees are to be paid at the place where the European Patent Office is located. Such a solution is recommended, in the view of the Chairman, for reasons of administrative economy. With 17 States participating, a decentralised system, under which the European Patent Office would have to maintain Giro or bank accounts in a large number of countries, would be very unwieldy. The centralised system entails no disadvantages for the applicant either. Sufficient means of making international payments exist and these ensure that the amounts to be paid will be rapidly transferred. For these reasons, this Draft does not oblige the European Patent Office to maintain bank or Giro accounts in the Contracting States.

Article 5

Payment of Fees

Proposal

(1) The fees due to the European Patent Office may be paid:

- (a) by payment of transfer to a bank account held by the European Patent Office;
- (b) by payment or transfer to a Giro account held by the European Patent Office;
- (c) by money order or postal order;
- (d) by delivery or remittance of cheques which are drawn on a banking establishment in ... (State in which the European Patent Office is located) and which are not transferable;
- (e) by cash payment.

(2) The President of the European Patent Office may allow other methods of paying fees and may lay down the details of such methods; this shall apply in particular to the payment of fees by means of fees vouchers, permanent accounts and debit transactions.

(3) The European Patent Office may also maintain bank accounts and Giro accounts in Contracting States other than ... (the State in which the European Patent Office is located), where this facilitates the payment of fees.

Article 5 (3) (Continued)

The possibility should not be excluded of introducing means of facilitating payments between any given Contracting State and the State in which the European Patent Office is located. Provision should therefore be made for the European Patent Office to maintain bank or Giro accounts in such cases in any Contracting State other than the State in which the European Patent Office is located.

2. On page 5 of the Minutes of the 2nd meeting of the Sub-Committee on "Implementing Regulations" of Working Party I (see BR/51/70), in connection with filing European patent applications with national offices, it is stated:
"This rapid notification should, in particular, serve for the levying of the filing fee by the European Patent Office"

It can be concluded from this that the Sub-Committee on "Implementing Regulations" holds the view that the filing fee must be paid directly to the European Patent Office even when, in accordance with Article 64, paragraph 1 (b) or paragraph 2, of the Convention, the application can or must be filed with a national office.

If this reasoning is correct, then it would not be necessary to include any special provision for this case in the Rules relating to Fees. If, however, the Sub-Committee on "Rules relating to Fees" considers that the applicant should, in the case provided for in Article 64, paragraph 1 (b) and paragraph 2, also have the possibility of paying at least certain fees (e.g. filing fee, designation fee, fee for more than ten claims) at national offices, then the Rules relating to Fees should include corresponding provisions.

3. The present provision assumes that no fees are to be paid at the information and liaison branches of the European Patent Office referred to in Article 33 (2) of the Convention.

Article 5
(Continued)

Proposal

Notes

Article 6 (3)

The unit of account referred to in Article 24 of the European Monetary Agreement of 5 August 1955 is equivalent to 0.88867088 grams of fine gold (= \$ parity).

Article 6Currencies

Proposal

(1) Payment or transfers to a bank account or a Giro account in accordance with Article 5, paragraph 1 (a) and (b) shall be made in the currency of the Contracting State in which that account is held.

(2) Payments in accordance with Article 5, paragraph 1 (c) to (e) shall be made in ... (national currency of the State in which the European Patent Office is located).

(3) If bank accounts or Giro accounts of the European Patent Office are held in Contracting States other than ... (the State in which the European Patent Office is located), the President of the European Patent Office shall lay down the equivalents in the currencies of the Contracting States of the fees payable pursuant to these Rules in ... (currency of the State in which the European Patent Office is located). Conversion shall be made on the basis of the unit of account within the meaning of Article 24 of the European Monetary Agreement of 5 August 1955. The amounts determined in this way shall be published in the official Journal of the European Patent Office at the beginning of each calendar year and whenever necessary. Revised amounts shall be binding on all payments which are made ten days or more after such publication.

Notes

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Article 7

Particulars concerning payments

Proposal

(1) Every payment must indicate the person making the payment and must contain the necessary particulars to enable the European Patent Office to establish immediately the purpose of the payment.

(2) If the purpose of the payment cannot immediately be established, the European Patent Office shall require the person making the payment to notify it in writing of this purpose within such period as it may specify. If he does not comply with this request or if it is impossible to serve this request on him, the payment shall be considered not to have been made. If it is not possible to refund the amount paid to the person who made the payment, it shall be held at his disposal for one year. At the end of this year the sum shall revert to the European Patent Office.

Article 8 (1)

Under Article ... (No. 2, Re. Article 64 of the Convention) drawn up by the Sub-Committee on "Implementing Regulations" of Working Party I, the date of receipt at the European Patent Office of the documents making up the European patent application is to be taken as the date of filing these documents. It would therefore appear consistent that for the payment of fees, the day on which the fee is received by the European Patent Office should be considered to be the date of payment. Such a solution is recommended as in certain cases the date of payment or of transfer is not obvious or is not immediately obvious from the documents received by the payee. The adoption of the system proposed in this provision should avoid the danger of the applicant being put at a serious disadvantage, even if the European Patent Office were to maintain bank and Giro accounts only at the place at which it is located; for the technical aids which exist today in the field of international payments, such as communication by telex, make possible rapid transfers even at very short notice.

Article 8 (2)

This provision prevents the person making the payment suffering legal disadvantages as the result of unusual delays in payment for which he is not responsible. The person paying a fee should therefore in the normal course of events be able to count on a payment made within the territory of the Contracting States ten days before the end of the period for payment being in the possession of the European Patent Office on the last day of that period at the latest.

Proposal

(1) The day on which a fee shall be considered to have been paid shall be :

- (a) in the case of payment or transfer to a bank account or a Giro account held by the European Patent Office: the date on which the sum is entered in the account;
- (b) in the case of payment by postal order or money order: the date of receipt of the amount at the European Patent Office or the date on which the amount is entered in a Giro account held by the European Patent Office;
- (c) in the case of delivery or remittance of a cheque: the date of receipt at the European Patent Office, provided that the cheque is met;
- (d) in the case of cash payment: the date of receipt of the cash at the European Patent Office.

(2) Where payment of a fee has to be made within a certain period, should the date referred to in paragraph (1) occur after the last day of the period for payment, the fee shall be deemed to have been paid within that period if the person who made the payment can provide evidence that at least ten days before the end of that period he paid in the amount of the fee in favour of the European Patent Office at a banking establishment or a post office in a Contracting State, or duly gave an order to a banking establishment or a post office in a Contracting State to transfer the amount to an account held by the European Patent Office, or despatched by registered post at a post office in a Contracting State a cheque which fulfilled the requirements of Article 5, paragraph 1 (d), and which would be met. The European Patent Office may request the person who made the payment to produce such evidence within such period as it may specify. If he fails to comply with this request or if the evidence is insufficient, the fee shall be deemed not to have been paid within the period for payment.

Article 9 (2)

In connection with this provision, see the Note to Article 67 (2) of the Convention.
The corresponding provision in Rule 15.5 of the Regulations under the PCT is as follows:

"Partial payment

(a) If the applicant specifies the States to which he wishes any amount paid to be applied as designation fee, the amount shall be applied accordingly to the number of States which are covered by the amount in the order specified by the applicant.

(b) If the applicant does not specify any such wish and if the amount or amounts received by the receiving Office are higher than the basic fee and one designation fee but lower than what is due according to the number of the designated States, any amount in excess of the basic fee and one designation fee shall be treated as designation fees for the States following the State first named in the request and in the order in which the States are designated in the request up to and including that designated State for which the total amount of the designation fee is covered by the amount or amounts received.

(c) ..."

Article 9

Insufficiency of the amount paid

Proposal

(1) A time-limit for payment shall in principle be deemed to have been observed only if the full amount of the fee has been paid in due time. If the fee is not paid in full, the amount which has been paid shall be refunded after the period for payment has expired. The European Patent Office may, however, in so far as this is possible within the time remaining before the end of the period, give the person making the payment the opportunity to pay the amount lacking. It may also, where this is expedient, decide to overlook any small amounts lacking without prejudice to the rights of the person making the payment.

(2) Where the request for the grant of a European Patent designates more than one Contracting State, in accordance with Article 67 (1) of the Convention, and should the amount paid be insufficient to cover all the designation fees, the amount paid shall be applied according to the specifications made by the applicant at the time of payment. If the applicant makes no such specifications at the time of payment, these fees shall be deemed to be paid only for as many designations as are covered by the amount paid and in the order in which the Contracting States are designated in the request.

Notes

Article 10

This provision takes account of the Note to Article 79 of the Convention. It should be considered whether at least the principle of a refund should be contained in the Convention itself. The Chairman holds the view that it is outside the scope of the Rules relating to Fees to lay down the details of refunds, particularly as regards whether refunds should be made only on request or ex officio, which department should be responsible for deciding on refunds, and whether the applicant should have the right to appeal against a negative decision. It would be more appropriate to settle these questions in the Convention or at least in the Implementing Regulations to the Convention. It should also be noted that the question of refunds should also be dealt with in the working agreement between the European Patent Office and the IIB. In any case, that agreement should contain a provision laying down that the part of the search fee which is refunded to the applicant is to be credited to the European Patent Office by the IIB.

Article 10

Partial repayment of the fee for obtaining the report on the state of the art

Proposal

If a report on the state of the art drawn up in accordance with the criteria laid down for the European System for the Grant of Patents, has already been requested from the International Patent Institute at The Hague in respect of an application the priority of which has been claimed for a European patent application, half of the fee for obtaining the report on the state of the art provided for in Article 2 (4) shall be refunded if the report to be drawn up for the European patent application is based to a large extent on the first report.

Article 11

The fees in respect of which the reduction is granted and the percentage of the reduction cannot be inserted until the Sub-Committee on "Implementing Regulations" of Working Party I has laid down in Article ... (Re. Article 34, No. 2) of the Implementing Regulations which Articles of the Convention are concerned (See the Note to Article ... (Re. Article 34, No. 2) of the Implementing Regulations; BR/42/70). The second sentence is therefore included solely for clarification.

Article 11Reduction of fees

Proposal

The reduction laid down in Article ... (Re. Article 34, No. 2) of the Implementing Regulations shall be ... %. It shall apply to the fees laid down in Article 2, Nos. ...

Notes

Article 12Entry into force

Proposal

These Rules relating to Fees shall come into force on ... (date of opening of the European Patent Office).

