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File Number: J 10/89 - 3.1.1
Application No.: 85 901 084.5
Publication No.:
Title of invention: Television Game Machine

Classification: A63F 9/22

D E C I S I O N
of 16 July 1991

Applicant: Kabushiki Kaisha Taito

Headword:

EPC Articles 94(2), 150(2), 158(2), Rules 85a and b, 104b

Keyword: "time limit-payment of fees" - "change of rules"

Headnote



Case Number : J 10/89 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 16 July 1991

Appellant : Kabushiki Kaisha Taito
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Chiyodaku (JP)

Representative : Hayward, Denis Edward Peter
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Decision under appeal : Decision of the Receiving Section of the European Patent Office dated 14 September 1988 deeming Euro-PCT application 85 901 084.5 to be withdrawn pursuant to Article 39(2) PCT.

Composition of the Board :

Chairman : O. Bossung
Members : J. Stephens-Ofner
J.-C. Saisset

Summary of Facts and Submissions

I. Euro-PCT application 85 901 084.5 was filed in Japanese with the Japanese Patent Office, acting as Receiving Office, on 28 February 1985. The Appellant elected to have the international application subject to international preliminary examination in the Japanese Patent Office, in accordance with Article 31(1) PCT. The Appellant chose the European Patent Office as elected office, by a request filed on 22 July 1985. There was no priority claimed.

Consequently, the time limits relevant to the application were as follows:

- (a) in accordance with Article 39 PCT, the time limit for filing the translation of the international application prescribed by Article 158(2) EPC expired on 28 August 1987:
- (b) in accordance with Rule 104b(1), the time limit for payment of the national search and designation fee without surcharge expired on 28 August 1987. A further period of grace is allowed by Rule 85a; this is one month (for the search fee) or two months (for the designation fee) from notification of a communication pointing out the failure to observe the time limit;
- (c) in accordance with Article 150(2) EPC, the time limit for filing the request for examination prescribed by Article 94(2) EPC without surcharge expired on 28 August 1987. An extension period on the same terms as that applicable to search fees under Rule 85a is allowed by Rule 85b.

- III. On 13 November 1986, information about deadlines and procedural steps before the EPO was sent to the Appellant's Japanese patent attorney by the Receiving Section of the EPO.
- IV. On 22 September 1987, the Appellant filed at the EPO an English translation of the international application, and the search and examination fees, together with the surcharge due on the examination fees under Rule 85a EPC.
- V. On 27 October 1987, the Receiving Section sent a communication pursuant to Rule 69(1) EPC to the Appellant's European professional representative, informing him that the application was deemed withdrawn pursuant to Article 39(2) PCT, owing to failure to provide a translation of the international application into one of the official languages of the EPO within the relevant time limit. The Appellant was informed of his right to apply for a decision on the matter under Rule 69(2) EPC.
- VI. By a letter dated 22 December 1987, the Appellant, through his European professional representative, applied for re-establishment of rights under Article 122 EPC.
- VII. In the decision under appeal dated 14 September 1988, the Receiving Section found that it had not been established that all due care required by the circumstances had been taken.
- VIII. On the 22. November, the Appellant filed a Notice of Appeal, in which oral proceedings were requested, and duly paid the appeal fee. A Statement of Grounds was filed on 23 January 1989.

- IX. The Appellant requests that the decision under appeal be set aside and that he be granted re-establishment of his rights.

Reasons for the Decision

1. The appeal is admissible.
2. The legal provisions of the PCT and EPC in force at the relevant time clearly provide that the time limit for filing the translation expired on 28 August 1987, 30 months after the filing date (Article 39(1)(a) PCT). At that time, no extension period for late filing existed.
3. However, while the present application for re-establishment of rights was pending before the Legal Board of Appeal, Rule 104b EPC was amended by decision of the Administrative Council dated 7 December 1990 and with effect from 1 June 1991 (OJ EPO 1991, 4 et seq.). The amended version provides that:

"... the applicant shall perform the following acts within a period of ... thirty-one months [cf. 30 in the original] where Article 39, paragraph 1 (a), of the Cooperation Treaty applies, from the date of filing of the application, or, if priority has been claimed, from the priority date:

- (a) supply, where applicable, the translation of the international application required under Article 158, paragraph 2, of this Convention;"

4. This decision of the Administrative Council has retrospective effect by virtue of Article 3, which provides that:

"Rule 104b, paragraph 1 (a), of the Implementing Regulations to the Convention as amended by this decision shall apply to all cases in which the establishment of loss or rights has not yet become final on the date of entry into force of this decision."

5. The decision of the Administrative Council entered into force on the 1 June 1991 and on that date the establishment of loss or rights had not yet become final in the case under appeal.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Receiving Section for further processing of the Application.

The Registrar:

The Chairman:

M. Beer

O. Bossung