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Boards of Appeal

Chambres de recours

Case Number : J 5/89

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**D E C I S I O N**  
of the Legal Board of Appeal  
of 9 June 1989

**Appellant :** JMK Magnusson & Co.  
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Sweden

**Representative :** Kurt Lautman  
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**Decision under appeal :** Decision of the Receiving Section of the European Patent Office dated 17 November 1988 rejecting requests for (a) re-establishment in the period prescribed by Rule 6(1) EPC, (b) removal of the withdrawal fiction under Article 90(3) EPC and (c) changing the date of filing of a European patent application.

**Composition of the Board :**

**Chairman :** P. Ford  
**Members :** J. Stephens-Ofner  
E. Persson

Veröffentlichung im Amtsblatt	Ja/Nein
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	Oui/Non

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Aktenzeichen / Case Number / N° du recours : J 5/89

Anmeldenummer / Filing No / N° de la demande : 87 850 252.5

Veröffentlichungs-Nr. / Publication No / N° de la publication : -

Bezeichnung der Erfindung: Locking device

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : -

**ENTSCHEIDUNG / DECISION**

vom / of / du 9 June 1989

Anmelder / Applicant / Demandeur : JMK Magnusson & Co.

Patentinhaber / Proprietor of the patent /

Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPU / EPC / CBE Articles 14(2), 80, 90(3), Rule 6(1)

Schlagwort / Keyword / Mot clé : "Translation into official language of the EPO (missing)" - "filing date changed at applicant's request" - "misleading information furnished by EPO"

Leitsatz / Headnote / Sommaire

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## Summary of Facts and Submissions

- I. European patent application No. 87 850 252.5 concerning a locking device was filed at the Swedish Patent Office (under Article 75(1)(b) and Rule 24(2) and (3) EPC) on 25 August 1987. The description of the invention and the abstract as filed were in the Swedish language. Since priority was being claimed from a previous Swedish application filed on 1 September 1986, the time limit for filing a translation of the parts of the application filed in Swedish into one of the official languages of the EPO expired on 1 October 1987 in accordance with the provisions of Article 14(2) and Rule 6(1) EPC. However, such translation was not filed until 6 November 1987, the applicant having been notified on 27 October 1987 under Rule 69(1) EPC that the application was deemed to be withdrawn pursuant to Article 90(3) EPC.
- II. In the course of the proceedings before the Receiving Section, the applicant's representative submitted, inter alia, that the failure to file the translation of the relevant parts of the application in due time was mainly due to the fact that the person within his office responsible for this application was unaware of Rule 6(1) EPC, and that this application was the first European patent application with priority that this person had dealt with. The representative requested re-establishment of rights with regard to the time limit in Rule 6(1) EPC. Alternatively, he requested that the application be treated as an application without priority (in which case the requirement under Rule 6(1) EPC to file a translation within three months after the filing of the European patent application would have been met). Finally, it was requested, in the last resort, to change the date of filing

and consider the date when the translation was filed, i.e. 6 November 1987, as the proper filing date for the application.

III. It appears from the file that the Receiving Section in communications on 10 December 1987 and 5 February 1988 raised objections to the request for re-establishment of rights. However, in both communications it was clearly stated that the alternative request based on the withdrawal of the priority claim could be accepted. This had also been confirmed in a telephone conversation between the applicant's representative and the Formalities Officer of the Receiving Section, which had taken place on 30 October 1987.

Nevertheless, in a communication of 11 August 1988, the Receiving Section, having re-examined the matter, informed the applicant's representative that his alternative request based on the withdrawal of the priority claim could not be accepted.

IV. In the decision under appeal, all requests of the applicant were rejected. As to the request for re-establishment of rights, it was held that all due care required by the circumstances had not been taken (Article 122(1) EPC). With regard to the first alternative request, it was stated, inter alia, that, although the effect of a withdrawal of a priority claim was not expressly dealt with in the EPC, it was indicated in the Guidelines (E-VIII, 1.5) that where a priority date no longer applied this did not restore any loss of right resulting from a time limit which had already expired before the loss of priority date. In the present case the time limit (prescribed by Rule 6(1)) had already expired on the date (6 November 1987) when the priority claim was withdrawn. Finally, a change of filing date in accordance with the second alternative request was considered not allowable.

- V. The applicant, appealing against this decision, maintains his two alternative requests but is not pursuing the request for re-establishment of rights. In support of the first alternative request, it is submitted that according to prevalent practice a loss of priority claim does not mean that the application will be rejected.

#### Reasons for the Decision

1. The appeal is admissible.
2. Although the appellant is not expressly requesting re-establishment of rights before the Board, the Board has, of its own motion, considered this matter. However, the Board has come to the conclusion that the finding in the decision under appeal, that is to say that the applicant failed to exercise all due care required by the circumstances is correct.
3. The Board is also satisfied that it was justified to reject the appellant's first alternative request for the reasons given in the decision under appeal.
4. As to the appellant's second alternative request, i.e. to consider the date of filing as being 6 November 1987 on which date the translation of the parts of the application filed in Swedish were filed at the EPO, it appears that the decision under appeal on this point is based on an interpretation of a decision of the Legal Board of Appeal of 2 June 1987 in Case J 4/87 (OJ EPO 1988, 172). However, it is to be noted that the circumstances of that case were quite different from those of the present one in that the question at stake there was whether or not it was possible either to accord an earlier filing date to an application

than that prescribed by Article 80 EPC, or to extend a time limit (for claiming priority). In contrast, in the present case, the question is whether or not a later filing date can be accepted, and there is no question of extending any time limit prescribed by the EPC.

5. In considering this question, the special circumstances of the present case must be kept in mind. In particular it is to be noted that in view of the misleading information given to the applicant's representative by the Formalities Officer on 30 October 1987 (see paragraph III above), the representative had no reason to believe that there was any risk that the application could be totally lost. Consequently, there was no reason for him to consider the need for making, at least as a precautionary measure, a (formally) new application when he filed the translation received by the EPO on 6 November 1987. Such a new application would have, of course, suffered from the disadvantage of getting a later filing date than the originally claimed priority date and even the original filing date, but in any case would have been much more favourable to the applicant than the situation he now faces through having been made to lose a lot of time until he was made aware, in August 1988, that there was a risk of the complete loss of rights in respect of the application.
  
6. Article 80 EPC provides that the date of filing of a European patent application shall be the date on which documents cited by the applicant contain certain prescribed information. It is clear that the Article sets a date before which a date of filing cannot be accorded to an application, but it does not follow that an application may not be given a later filing date with the consent of the applicant, provided that there is no detriment to the

public interest, in circumstances in which the applicant has been misled by the EPO into not filing a new application entitled to that later filing date.

7. In the present case, an acceptance of 6 November 1987 as the filing date of the present application, which has not been published, can do no harm to any public interest. In the Board's view, it would, in view of the special circumstances referred to above and having regard to the principles of good faith which govern the relations between the EPO and applicants for European patents (cf. Cases J 10/84, OJ EPO 1989, 71; J 02/87, OJ EPO 1988, 330 and J 03/87, OJ EPO, 1989, 3), be unfair to the appellant not to allow his second alternative request.

#### Order

For these reasons, it is decided that:

1. The appellant's request with regard to the withdrawal of the priority claim is rejected.
2. The decision under appeal is set aside.
3. European patent application No. 87 850 252.5 is to be given the filing date of 6 November 1987.
4. The said application is referred to the Receiving Section of the EPO for further prosecution.

The Registrar:

*J. He*

The Chairman:

*Percy Ford*

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*[Handwritten signature]*