

Enlarged Board of Appeal, 16 October 2009, Computer Implemented Inventions



PATENT LAW – LITIGATION

No suspicion of partiality

• According to established case law of the Boards of Appeal, of the Enlarged Board and also of national courts of member states, the mere fact that a board member has expressed a view on the legal issue to be decided on a previous occasion, be it in a prior decision or in literature, be it in a prior position in the EPO or as an expert for external political institutions, cannot lead to the conclusion of doubts as to impartiality.

• Nor does a purely subjective impression that the opinions of a board member might be disadvantageous to a particular interest justify an exclusion

(see T 954/98, point 2.4 of the Reasons; see also J 15/04; see further Interlocutory decision of 7 December 2006 in case G 1/05, point 20 of the Reasons; confirmed in G 2/08, supra, point 4.2 of the Reasons; [2002] EWCA Civ 90, [2003] QB 528 - Taylor v. Lawrence; [2003] UKHL 35, [2003] ICR 856 - Lawal v. Northern Spirit Ltd.; Locabail (UK) Ltd. v. Bayfield Properties Ltd.; Rappel de la portée des stipulations de l'article 6 de la Convention européenne des droits de l'homme et des libertés fondamentales, JurisClasseur Justice Administrative, Fasc 70-11; Baumbach/Lauterbach, Zivilprozessordnung, Vol. 1, 67th Edition, 2009, § 42 Margin 44, 45, 57; Zöller, Zivilprozessordnung, 27th Edition, 2009 § 42 Margin 26, 33; Fasching, Lehrbuch des österreichischen Zivilprozessrechts, 2nd Edition, 1990, Margin 154; Fasching, Kommentar zu den Zivilprozessgesetzen, Vol. 1, 2nd Edition, 2000, § 19 Jurisdiktionsnorm Margin 10).

2.5 Once lawfully appointed, a judge is deemed to act in good faith and is therefore presumed impartial until proven otherwise (see interlocutory decision in G 2/08, point 3.2 with further remarks). Moreover the parties to judicial proceedings have a right to have their case considered and decided by lawfully appointed judges. Such judges not only have the right to be member of a Board but also have the duty to decide in the cases allocated to them. They can neither withdraw at will from the proceedings, nor be objected to, at will, by a party to the proceedings, or by any other person. On the other hand they have to withdraw from a case in which their impartiality could be reasonably doubted (see interlocutory decision in case G 2/08). E.g. there might indeed exist an issue of partiality if a judge let it

be known that he would never change his mind on certain questions on which he has given his opinion before. However, in the present case there is no indication whatsoever that this might be so.

Source: epo.org

Enlarged Board of Appeal, 16 October 2009

(P. Messerli, M.J. Vogel, P. Alting van Geusau, M. Dom, A.G. Klein, U. Scharen, J.-P. Seitz)

Interlocutory Decision of the Enlarged Board of Appeal of 16 October 2009

Case Number: G 0003/08

Composition of the Board:

Chairman: P. Messerli

Members: M. J. Vogel, P. Alting Van Geusau, M. Dorn, A. G. Klein, U. Scharen, J.-P. Seitz

Summary of Facts and Submissions

I. In the present referral case under Article 112(1)b EPC concerning several questions raised by the President of the EPO on Computer Implemented Inventions ("CII") the Enlarged Board of Appeal invited the public to file opinions on the questions submitted by the President.

II. In an amicus curiae brief addressed to the Enlarged Board on 26 April 2009 Mr M. Schulz contested the impartiality of the Board giving the following reasons:

1. A technically qualified person in charge and mandated by the Enlarged Board of Appeal had officially and publicly given his opinion on the decisions mentioned in the referral of the President and on the interpretation of the EPC with respect to the exclusion of computer programs from patentability, among others on the decision in the case T 1173/97.

2. In the documents of the Diplomatic Conference of 2000, the decision in the case T 1173/97 was considered to justify the deletion of the EPC provision excluding computer programs as non patentable subject matter. This means that this decision was not taken on the basis of the law in force at that time.

3. Furthermore, the person mentioned above, now a member of the Enlarged Board in the present case, supported the EU-proposal of a directive on CII as a lobbyist of the Commission. He declared publicly that the then-drafted version of the EU-directive would not initiate a reversal of the jurisdiction of the Boards of Appeal. This is further proof that the then-valid law, which excluded computer programs from legal protection, had been disregarded by the Boards.

4. Finally, just before its publication, a member of the Boards of Appeal publicly took the position that the referral of the President was inadmissible. This was an undue attempt to put pressure on the President and the Members of the Enlarged Board.

5. On the strength of past experience with the behaviour of Board members the question is not whether there are different decisions and even whether these decisions are in line with the Convention. These questions have already been answered by the Boards' decisions. The question is rather whether it is possible having regard to the foregoing facts to compose an En-

larged Board from members of the Boards of Appeal, who have already been subject to a reproach of obliqueness.

6. Under these conditions there is a suspicion of partiality with the consequence that the present composition of the Enlarged Board has to be dissolved and the grounds of dissolution have to be published.

III. After due deliberation of the Board, in the absence of the member concerned, the Chairman of the Enlarged Board of Appeal by order dated 28 September 2009 appointed Mr Alting van Geusau as alternate to Mr Rees for the purpose of the proceedings under Article 4 RPEBA and Article 24(4) EPC.

IV. In his statement according to Article 4(2) RPEBA Mr Rees declared that, as a director in DG 2 between 2000 and 2003, he was assigned the duty of explaining the examination policy of DGs 1 and 2 with respect to computer-implemented inventions (CII), which was based on the case law of the Boards of Appeal, to the public and external bodies like the European Parliament. Furthermore he did the same when he attended as an expert for the European Commission a number of meetings of the responsible committee of the Council of Ministers where the proposal of a EU-directive on CII was discussed.

Reasons for the Decision

1.1 As provided by Article 24(3) EPC, members of a Board of Appeal or of the Enlarged Board of Appeal may be objected to by any party for one of the reasons mentioned in Article 24(1) EPC, or if suspected of partiality. Whereas objections based on Article 24(1) EPC (*iudex inhabilis*) may be raised by anyone, whether he is a party or not, the right to object to a member of the Board because of alleged partiality (*iudex suspectus*) is reserved to parties in the proceedings (see [interlocutory decision of 15 June 2009 in case G 2/08](#), point 1.4 of the Reasons). In referral cases under Article 112 EPC, however, members of the public who file *amicus curiae* briefs do not have the status of a party. They are not entitled to file requests but only to submit their personal view of the case or that of their organisations, in order to support the Board with arguments that should be considered in its findings. Since an *amicus curiae* is not a party to the referral proceedings his request for exclusion of a member of the Enlarged Board or of the Enlarged Board as a whole is inadmissible under Article 24(3) EPC.

1.2 However, pursuant to Rule 4(1) of the Rules of Procedure of the Enlarged Board of Appeal (RPEBA) in the version approved by the Administrative Council of the EPO on 7 December 2006 (OJ 2007, 304), the procedure of Article 24(4) EPC is also to be applied, if the Enlarged Board of Appeal has knowledge of a possible reason for exclusion or objection which does not originate from a member himself or from any party to the proceedings. Under this provision the submissions of a third party with respect to a member of the Enlarged Board to be objected to according to Article 24(1) EPC or suspected of partiality under Article 24(3) EPC are taken as information on the basis of which the Board can *ex officio* look at the alleged grounds of ob-

jection or suspicion of partiality.

2.1 In the *amicus curiae* brief under consideration it is not alleged that one of the members of the Enlarged Board should be excluded from the case for reasons of a personal interest in the case, or for having been involved previously as a representative of the party (Article 24(1) EPC). Rather, the submission is based on the ground that one member of the Enlarged Board of Appeal in this case as well as the Board as a whole is suspected of partiality.

2.2 The [interlocutory decision in case G 2/08](#) mentioned under point 1.1 above states that it might appear appropriate not to proceed any further with a complaint or information received if the so-called "possible" reason for exclusion or objection which does not originate from a party to the proceedings or the Enlarged Board of Appeal itself, would amount to an abuse of procedure. The decision mentions as an example a complaint that is completely unsubstantiated or ignores established case law (point 2.3 of the Reasons).

2.3 Turning to the present case, the Enlarged Board notes that the submissions in the *amicus curiae* brief are vague and largely unsubstantiated. The brief does not say who made which concrete remarks in which function under which circumstances and in which connection with respect to the referred questions such as to justify his exclusion as a member of the Enlarged Board of Appeal for reasons of suspicion of partiality. Nevertheless the Enlarged Board is in the position to identify Mr D. Rees on the basis of these submissions as the member suspected in the *amicus curiae* brief and is also aware of his earlier duties as a director in DG 2 of the EPO between 2000 and 2003 and as an expert for the EU-Commission in the field of CII at that time. But these facts submitted to establish the suspicion of partiality are not suitable to do so. The mere general and unsubstantiated assertion that the member in question explained as an expert in earlier times, when he was still a director in DG 2, that the jurisprudence of the Boards of Appeal in the field of CII would not be against the EPC and the law of the member states of the EPO cannot support an argument that this member or even the whole Enlarged Board in this case (G 3/08) should be excluded from dealing with the referral. Nor can such a conclusion be supported by the – actually incorrect – submission that the members of the present Enlarged Board are all members of the Boards of Appeal. This is not an argument justifying the assumption that – deciding on the present referral – they are not solely bound by the provisions of the EPC.

2.4 According to established case law of the Boards of Appeal, of the Enlarged Board and also of national courts of member states, the mere fact that a board member has expressed a view on the legal issue to be decided on a previous occasion, be it in a prior decision or in literature, be it in a prior position in the EPO or as an expert for external political institutions, cannot lead to the conclusion of doubts as to impartiality. Nor does a purely subjective impression that the opinions of a board member might be disadvantageous to a particular interest justify an exclusion (see T 954/98, point 2.4 of

the Reasons; see also J 15/04; see [further Interlocutory decision of 7 December 2006 in case G 1/05](#), point 20 of the Reasons; confirmed in G 2/08, supra, point 4.2 of the Reasons; [2002] EWCA Civ 90, [2003] QB 528 - Taylor v. Lawrence; [2003] UKHL 35, [2003] ICR 856 - Lawal v. Northern Spirit Ltd.; Locabail (UK) Ltd. v. Bayfield Properties Ltd.; Rappel de la portée des stipulations de l'article 6 de la Convention européenne des droits de l'homme et des libertés fondamentales, JurisClasseur Justice Administrative, Fasc 70-11; Baumbach/Lauterbach, Zivilprozessordnung, Vol. 1, 67th Edition, 2009, § 42 Margin 44, 45, 57; Zöller, Zivilprozessordnung, 27th Edition, 2009 § 42 Margin 26, 33; Fasching, Lehrbuch des österreichischen Zivilprozessrechts, 2nd Edition, 1990, Margin 154; Fasching, Kommentar zu den Zivilprozessgesetzen, Vol. 1, 2nd Edition, 2000, § 19 Jurisdiktionsnorm Margin 10).

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3. Therefore, this Board sees no reason to exclude Mr Rees from its composition in case G 3/08 or to replace further members.

Order

For these reasons it is decided that:

1. The request of Mr Schultz is rejected as inadmissible.
2. The composition of the Enlarged Board of Appeal in case G 3/08 remains unchanged.