

Article 164(2) EPC

Amicus Curiae brief filed on EPO Enlarged Board of Appeal referral G03/19

1. Admissibility

1.1 The present reference by the President of the European Patent Office is made in accordance with Article 112(1)(b) EPC. This provision of the EPC states that “the President of the European Patent Office may refer a point of law to the Enlarged Board of Appeal where two Boards of Appeal have given different decisions on that question.” I am aware that at least one *amicus curiae* brief filed by another person has challenged whether the decisions referred to by the President have actually given different decisions on the question that has been referred.

1.2 I will not comment on admissibility and for the remainder of the present *amicus curiae* brief I will assume (without intending any opinion either way) that the reference is admissible.

2. Question 1

2.1 Question 1 states:

Having regard to Article 164(2) EPC, can the meaning and scope of Article 53 EPC be clarified in the Implementing Regulations to the EPC without this clarification being a priori limited by the interpretation of said article given in an earlier decision of the boards of appeal or the Enlarged Board of Appeal?

2.2 The wording of this question refers to the meaning and scope of an article of the EPC being “clarified” in the Implementing Regulations. However, the purpose of the Implementing Regulations must be to implement the EPC and this does not immediately imply that the Implementing Regulations can “clarify” the meaning and scope of an article of the EPC. It is necessary to consider what is the purpose and permitted effect of the Implementing Regulations.

2.3 As noted in the question, the effect of the Implementing Regulations is subject to Article 164(2) EPC. This states:

In case of conflict between the provisions of this Convention and those of the Implementing Regulations, the provisions of this Convention shall prevail.

Therefore the Implementing Regulations cannot conflict with or override the provisions of any Article of the EPC.

2.4 The main purpose of the Implementing Regulations therefore appears to be to provide detailed provisions to implement the more general provisions of the EPC. Thus for example Article 78(b) EPC requires that an application shall have a description but gives not further detail about the content or form of the description. Rule 43 of the Implementing Regulations

sets out requirements for the contents of the description and Rule 49 of the Implementing Regulations sets out the requirements for its presentation.

2.5 Nevertheless, there may be circumstances where the wording of an Article of the EPC is unclear or appears to permit more than one interpretation and as a practical matter it would be helpful to all parties (including both applicants and the EPO) to establish what interpretation will be used. There appear to be several ways in which this could be done, including published guidance from the EPO and discussion in the Guidelines for Examination. However, I would not wish to rule out the possibility of using the Implementing Regulations to purport to provide clarification or an interpretation of such an Article of the EPC. However, such a clarification or interpretation must always be subject to Article 164(2) EPC and therefore it can only be a “purported” clarification or interpretation. It must always be subject to the possibility that it is found to be in conflict with the correct meaning of the relevant Article in which case the provision of the Implementing Regulations must be *ultra vires* and ineffective.

2.6 Applying the conclusion reached above to the context of the question, it can therefore be answered that the Implementing Regulations can purport to clarify the meaning and scope of Article 53 EPC, but such a purported clarification must be subject to the actual meaning and scope of the Article if and when that is determined. Thus such a purported clarification is inevitably provisional and subject to being overridden in accordance with Article 164(2) EPC.

2.7 In the present situation, a complication arises because there has already been at least one ruling on the meaning and scope of Article 53 EPC by the Boards of Appeal or the Enlarged Board of Appeal. Where a Board of Appeal or the Enlarged Board of Appeal gives a ruling on the meaning or scope of an Article of the EPC, this is not a matter of the Board deciding in its discretion on how to implement an Article or which of multiple permitted meanings it prefers. Rather, such a ruling is a decision on the (unique and correct) meaning or scope of the Article. Clearly, if two Boards give inconsistent rulings this creates doubt over the correct meaning and scope of the Article concerned and the EPC provides for the possibility of a reference to the Enlarged Board to settle the correct interpretation in such a situation. Where the Enlarged Board has given a ruling, that establishes (to the extent that the ruling covers it) the meaning and scope of the Article. It is not possible to alter or challenge a ruling by the Enlarged Board except by amendment of the EPC or, exceptionally, by a later ruling from the Enlarged Board.

2.8 Therefore an interpretation by the Enlarged Board, or an uncontested interpretation by a Board of Appeal, establishes the meaning or scope of an Article of the EPC, and this is the meaning or scope of that Article for the purposes of Article 164(2) EPC unless and until it is overruled by the Enlarged Board. Consequently it is not possible for such an interpretation to be reversed by the Implementing Regulations, owing to the provisions of Article 164(2) EPC.

2.9 Where there remains uncertainty over the exact or correct meaning or scope of an Article, notwithstanding a decision from the Boards of Appeal or the Enlarged Board of Appeal, it might be possible to seek to provide clarity by providing a purported clarification in the Implementing Regulations. However, such a purported clarification must always be subject to the possibility of being overturned by a further decision of the Boards of Appeal or the Enlarged Board of Appeal. Additionally such a purported clarification, being in the Implementing Regulations, cannot alter the actual provisions of the EPC and therefore must be subject to the meaning, as already decided by the Boards of Appeal or the Enlarged Board of Appeal, of the Article concerned. Therefore it is inescapable that any clarification of the meaning or scope of any Article of the EPC must be *a priori* limited by an interpretation of that Article already given in an earlier decision of the Boards of Appeal or the Enlarged Board of Appeal.

2.10 As a result of the discussion above, I consider that the only possible answer to Question 1 must be “No”. This conclusion appears to be inescapably mandated by Article 164(2) EPC.

3. Question 2

3.1 Question 2 only arises if the answer to Question 1 is “Yes”. Since the answer to Question 1 is “No”, Question 2 does not arise.

3.2 If nevertheless the Enlarged Board decides that Question 2 falls to be considered, I have no comment to make on this matter.

4. Broader Context

4.1 The present reference from the President of the European Patent Office arises in the context that the Enlarged Board has already given an interpretation of Article 53(b) EPC in G /12 and G 2/13, and Board of Appeal decision T 1063/18 ruled that current Rule 28(2) is in conflict with that interpretation. Current Rule 28 was adopted for conformity with the interpretation by the EU Commission of the EU Directive 98/44/EC on Biotechnology.

4.2 In this situation, it may be desirable if a legitimate way can be found to bring the interpretation of Article 53 EPC before the Enlarged Board again, which can consider the matter afresh and possibly overturn its previous interpretation. Unfortunately, the present reference is not such a legitimate way to enable the reconsideration of Article 53.

Please note that the above comments are my personal views, and do not represent the views of my employer or of any client.



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