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Große
Beschwerdekammer

Enlarged
Board of Appeal

Grande
Chambre de recours

Case Number: G 0002/08

I n t e r l o c u t o r y D E C I S I O N
of the Enlarged Board of Appeal
of 15 June 2009

Appellant:
(Applicant)

KOS LIFE SCIENCE, INC.
2100, N. Commerce Drive
Weston, FL 3326 (US)

Representative:

Wallace, Sheila Jane
Marks & Clerk
90 Long Acre
London WC2E 9RA (GB)

Referral Decision:

Decision of the Technical Board of Appeal
3.3.02 dated 22 April 2008 in case T 1319/04.

Composition of the Board:

Chairman:

P. Messerli

Members:

J.-P. Seitz

P. Alting Van Geusau

B. Günzel

S. Nathanael

B. Schachenmann

R. Young

Summary of Facts and Submissions

- I. By decision of ... in the appeal proceedings concerning a patent application by ..., Board of Appeal ... referred questions of law to the Enlarged Board of Appeal. This referral is currently pending under case number
- II. In accordance with Article 2(2) of the Rules of Procedure of the Enlarged Board of Appeal (RPEBA) the Chairman of the Enlarged Board of Appeal determined the composition of said Board and designated *inter alia* ..., a ... member of the Enlarged Board of Appeal according to Article 2(1) of its Business Distribution Scheme for the year 2008.
- III. With letter dated 27 October 2008 ..., professional representatives acting on behalf of ... filed *inter alia* a request pursuant to Article 24(3) EPC that ... not be a member of the Enlarged Board of Appeal for the referral in this case (ie: G 2/08).

In support of this request they submitted that said permanent member of the Enlarged Board of Appeal was Chair of Board of Appeal ... that decided case They considered this decision to be exceptional in that it not only undertook a full review of the previous Board of Appeal decisions which had construed G 5/83 narrowly but also considered the policy reasons for construing Article 52(4) EPC broadly and reviewed certain decisions of the national courts In concluding that the claim in issue was allowable on the basis of a broad interpretation of G 5/83, that Board of Appeal had declined to follow earlier Board of

Appeal decisions and had not considered that a reference to the Enlarged Board of Appeal was required.

In view of this alleged exceptional way of dealing with the case they came to the conclusion that it might be very difficult for the member involved to approach the legal questions to be decided in the referral in suit with an open mind, and that this would be seen to be the case by the parties interested in the outcome of said referral.

They requested pursuant to Article 24(3) EPC that ... not participate as a member of the Enlarged Board of Appeal for deciding the referral in this case, on the ground of suspicion of partiality.

IV. After due deliberation of the Board, in the absence of the member concerned, the Chairman of the Enlarged Board of Appeal by order dated 4 December 2008 appointed Mr Young as alternate to ... for the purpose of the proceedings under Article 4 RPEBA and Article 24(4) EPC.

V. In *his/her* comments of 11 December 2008 *the objected to member* replied that no ground of objection arose against *him/her* because of *his/her* participation as Chair in case

The objected to member relied on two principles of procedure:

- the secrecy of judicial deliberation on the one hand,

- the absence of any presumption of partiality based on former judicial rulings on the same question of law by a judge on the other hand.

VI. In their comments ..., the sole party to the appeal proceedings and to the present referral proceedings, referred to the exact wording of Article 24(3) EPC which reads "Members ... of the Enlarged Board of Appeal may be objected to by any party for one of the reasons mentioned in paragraph 1, or if suspected of partiality." ... (emphasis added).

Thus neither ... nor their client ..., could object to a member of the Enlarged Board of Appeal in pending case ... since neither was a party to these proceedings. For this reason alone their request should be refused.

Subsidiarily on the merits of the objection they stressed that the sole reason submitted in order to support it was the mere fact that the member involved was the chair of the Board of Appeal which decided case ... which was alleged to be in some way so exceptional that it would be very difficult for this member to approach the issues to be decided in the pending referral with an open and impartial mind.

They disagreed with this contention for the following reasons:

(1) First, case ... was only one among a large number of cases relevant to the questions of law referred to the Enlarged Board of Appeal. Indeed, they themselves had quoted 26 EPO decisions (including ...) and 9

decisions of national courts. Others, filing *amicus curiae* briefs, had referred to further EPO and national decisions, several of them reviewing relevant case law in the manner described by the claimant. Therefore ... could hardly be seen as an "exceptional" case.

(2) Secondly, it could not be ascertained that the member involved ever shared the reasoning underlying the findings in case ... since deliberations within a Board of Appeal were secret on the one hand and subject to the rule of majority on the other.

(3) Thirdly, even assuming that the member involved did support the views expressed in case ... they nevertheless remained related to the circumstances of that particular case. There was therefore no reason to presume that this member would not consider the questions of law referred to the Enlarged Board of Appeal with an open mind.

(4) Fourthly, the former case law of the Enlarged Board of Appeal had to apply. Indeed in case G 1/05 a similar objection of partiality had been raised against a member of the Enlarged Board of Appeal who had already considered similar issues while being a member of a Board of Appeal. The Enlarged Board of Appeal in case G 1/05 rejected the objection of partiality relying on such an argumentation. More precisely they referred to point 27 of the reasons which reads: "as regards proceedings before the Enlarged Board of Appeal and unless there are specific circumstances throwing doubt on the Board member's ability to approach the parties' submissions with an open mind on a later occasion there cannot be any objectively justified,

i.e. reasonable suspicion of partiality against a member of the Enlarged Board of Appeal within the meaning of Article 24(3), first sentence, EPC for the reason that a position on the matter was adopted in a prior decision of a Board of Appeal in which the Board member concerned had participated."

Finally, a judge was not normally considered to be partial simply because he had previously decided issues on which he was, by law, empowered to decide.

Subsidiarily they requested that ..., not being a party to the case referred to the Enlarged Board of Appeal, not be permitted to address the Enlarged Board of Appeal at oral proceedings in respect of the referral.

Reasons for the Decision

1. Admissibility of the request.

1.1 Whereas Article 24(1) EPC foresees the grounds requiring the exclusion of members of the Boards of Appeal or of the Enlarged Board of Appeal from taking part in a case:

- in which they have a personal interest,
- in which they have been previously involved as representatives,
- in which they participated in the decision under appeal,

Article 24(3) EPC additionally foresees that members of either the Boards or the Enlarged Board may also be objected to by any party if suspected of partiality.

- 1.2 In other words, under "Exclusion and Objection" (Ausschließung und Ablehnung; Abstention et récusation) the legislator distinguishes between an irrefutable presumption of law consisting in those compelling grounds of exclusion (*judex incapax*) that must apply *ex officio*, and may therefore also be raised by anyone, the parties, the Board, or a third person, without their having to justify any personal interest as of right on the one hand, and on the other hand the ground of objection that may be raised by any party to the proceedings if it suspects partiality (*judex suspectus*) in a member of a Board of Appeal or of the Enlarged Board of Appeal, since said party enjoys a personal and legitimate interest to act in the proceedings and is entitled to due process of law in respect of said interest. In such a case the burden of proof lies with the party who raises the objection, since members of a Board including the Enlarged Board of Appeal are *a priori* presumed to be unbiased.

- 1.3 This distinction is further reflected in Article 112a(2)(a) EPC, ruling that a possible ground of review consists in a member of a Board of Appeal having participated in a case in breach of Article 24(1) EPC or despite having been excluded pursuant to a decision under Article 24(4) EPC. In other words whereas the grounds under Article 24(1) EPC are considered to be peremptory due to the violation of the legal principle "*ne judex in re sua*", the ground which could have justified an objection for suspicion of partiality is

not directly foreseen as constituting *a priori* (i.e. unless proven and decided by the Board) a cause of review.

1.4 Hence, according to the EPC the right to object to a member of a Board of Appeal or of the Enlarged Board of Appeal is reserved to the party to the proceedings who suspects partiality in such a member. Since it cannot be contested that neither ... nor their client ... is a party to the proceedings which gave rise to the referral and the present proceedings the request for exclusion filed on 27 October 2008 is, as such, inadmissible.

2. Consideration of the complaint by the Enlarged Board of Appeal

2.1 Bearing in mind that, according to the EPC, objections of suspicion of partiality are the monopoly of parties to the proceedings, it remains nevertheless that pursuant to Article 4(1) RPEBA, in the version approved by the Administrative Council of the EPO on 7 December 2006, 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, then the procedure of Article 24(4) EPC shall be applied (emphasis added).

2.2 In the Enlarged Board's view when construing the meaning (and the ambit) of the wording "possible reason for exclusion or objection" one has to bear in mind the distinction set out above: i.e. *summa divisio*

- a) grounds that may be raised *ex officio* according to Article 24(1) EPC,

- b) objection of partiality, reserved to the parties.

Both can lead to the exclusion of the member objected to. It is therefore appropriate to consider the circumstances under which said possible reason comes to the knowledge of the Enlarged Board of Appeal, more generally the facts underlying the case in order exactly to assess the grounds brought forward in a complaint, and to exercise a necessary judgement to allow a complaint to be processed.

It must be borne in mind (see *summa divisio* above) that a request originating from a person not enjoying the status of a party to the proceedings (third person) cannot confer on this person the same rights as those of a party who is entitled to act in the proceedings. Nevertheless, in actual fact, the third person can worsen the procedural status of the party to the proceedings by attempting to deprive the latter of its judge established by law. Systematically allowing such complaints to proceed could well result in undue delay of the proceedings before the Enlarged Board of Appeal since Article 4(3) RPEBA prescribes that until a decision is taken on the exclusion of the member, there shall be no further proceedings in the case.

- 2.3 It might therefore 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. That would be the case where "*Summum jus summa injuria*" a complaint

is not substantiated at all, ignores established case law, or has been maliciously filed in order to damage the reputation of a member, or with the purpose of delaying the proceedings ... this list not being exhaustive.

For these reasons, in order to decide whether and how further to proceed with the complaint the Enlarged Board of Appeal has examined under this aspect the complaint of ... acting on behalf of

- 2.4 In the case in suit the complaint originates from a third person, ..., who is a party to a legal action in the United Kingdom in which the novelty of the claim resides solely in a dosage regime. Thus the decision of the Enlarged Board of Appeal in the pending referral G 2/08 could influence to some extent the outcome of the above litigation, even though pursuant to Article 112(3) EPC, the future decision of the Enlarged Board of Appeal is binding only on the Board of Appeal in respect of the appeal in question. The present referral remains for ... "*res inter alios acta*" i.e. a decision in which this person has no part.

The complaint also contains a statement of grounds which at first glance cannot be simply ignored. It relies on the fact that the member concerned chaired the Technical Board of Appeal which decided case This decision is alleged to be exceptional and in view of this the third person comes to the conclusion that it would be very difficult for the member concerned to approach the issues to be decided in the pending referral with an open mind and furthermore, that this

would be seen to be the case by those who are interested in the outcome of this referral.

In the view of the Enlarged Board of Appeal, these statements do not represent "*prima facie*" an abuse of procedure purporting to delay the proceedings or to damage the reputation of the member concerned, but rather represent a "possible reason for objection" as required by Article 4(1) RPEBA.

Therefore, the Enlarged Board of Appeal has decided further to proceed with the procedure under Article 24(4) EPC as prescribed by Article 4(1) RPEBA *in fine*.

3. On the merits of the complaint

3.1 Boards of Appeal of the European Patent Office and the Enlarged Board of Appeal respectively act as judicial bodies and apply general principles of procedural law (cf. G 1/86, G 9/91 and G 10/91, G 1/99, G 5/91, G 1/05, J 15/04, T 954/98).

The Enlarged Board of Appeal is established by law, the European Patent Convention being the valid instrument which confers powers on the European Patent Office, and internal as well as external members of the Board of Appeal who are called to form the Enlarged Board of Appeal are also appointed by the Administrative Council of the European Patent Organisation duly empowered by way of delegation of the Contracting States to the European Patent Convention.

Duly established by law, members of the Enlarged Board of Appeal have therefore the duty to sit in the cases allocated to them according to their jurisdiction both "*ratione legis*" and "*ratione materiae*".

That is, parties to judicial proceedings have a right to have their case considered and decided by the judge designated or appointed by law (*Droit d'être jugé par son juge naturel*; *Recht auf den gesetzlichen Richter*).

This essential principle is even enshrined at constitutional level in some Contracting States to the European Patent Convention e.g. Germany, Austria, Switzerland.

- 3.2 Once established by law the judge is deemed to act in good faith and is therefore presumed impartial until proven otherwise (cf ECHR, *De Cubber v. Belgium*, 26 October 1984; *ETTL v. Austria*, 23 April 1987; *Hauschildt v. Denmark*, 24 May 1989; *Academy Trading Ltd et al. v. Greece*, 4 April 2000).
- 3.3 On the other hand Article 6(1) of the European Convention for the Protection of Human Rights and Fundamental Freedoms of 4 November 1950, relying on principles of law common to the member states of the European Patent Organisation and applying to all departments of the said organisation, requires *inter alia* "In the determination of his civil rights and obligations ... everyone is entitled to a fair and public hearing within a reasonable time by an independent and impartial tribunal established by law".

These two principles are not incompatible and have to be construed in such a way that they are not mutually exclusive.

On the one hand Board members must duly discharge their duty to sit in cases allocated to them in accordance with their jurisdictions both "*ratione legis*" and "*ratione materiae*", and 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 it is the duty of the member not to sit in proceedings in which his impartiality could be reasonably doubted, whatever his feelings might be. In decisions G 5/91 and G 1/05 the Enlarged Board of Appeal already underlined (point 3 of the reasons, and point 5 respectively) the importance of a very strict observance of the requirement of impartiality in proceedings before the Boards of Appeal and the Enlarged Board of Appeal in view of their judicial functions at final instance within the European patent granting system. The Enlarged Board in its present composition accepts this statement and the conclusions already drawn in these previously cited decisions. It is a general principle of law that a member should not decide a case in which one may have good reason to assume or even suspect partiality.

4. Under Article 24(3) and (4) EPC in order to assess the alleged partiality of a member of the Enlarged Board of Appeal the deciding Board should apply a twofold test, namely:

- Firstly a "subjective" test "in concreto" requiring evidence of actual partiality of the member concerned
- Secondly an "objective" test "in abstracto" to determine if the circumstances of a case would allow a reasonably objective and informed person to conclude that he might have good reason to suspect the partiality of the member concerned.

4.1 In the present case the complaint relied on Article 24(3) EPC, as partiality was suspected in the member concerned. By virtue of *his/her* Chair of the Board in decision ... of ..., ... is alleged to have already taken a position in relation to the questions of law to be currently decided in the present pending referral in such a manner that it could no longer be assumed that *he/she* remains unbiased.

On a subjective basis, there is no reason to raise doubt as to the personal impartiality of the member concerned, all the more so as *he/she* confirms *himself/herself* not to be biased. On the other hand the complaint does not contain any reason permitting any reasonable doubt in that respect. Nor can anything in the behaviour of the member concerned give rise to any kind of objection.

4.2 However "suspicion of partiality" could also be justified on an objective basis having due regard to the presumption that members of Boards of Appeal act in good faith and are deemed impartial.

The Enlarged Board of Appeal in its current composition accepts as its own the reasoning developed in decision G 1/05, (reasons points 20 to 26 of the reasons), and reiterates that "to the extent that participation in a referral pending before the Enlarged Board of Appeal of a Board member having already dealt with the matter as a member of a Board of Appeal is not excluded by these provisions, an objection of partiality cannot be based on that very same fact alone" (reasons point 27).

Decision ... was taken by a Board of Appeal composed of three members, and as such reflects the reasoning and findings of the Board as a judicial body rather than those of its respective members. Decisions are taken by majority vote and deliberations are secret.

For this very reason it cannot be presumed that ... represents the personal thoughts of the member concerned.

Even assuming the member concerned to share or endorse the views expressed in the said decision by virtue of the legal fiction that it is a decision of the Board as a whole, the present Board cannot identify in the corpus of said decision any reason justifying a suspicion of partiality or establishing a preconceived mind.

There is no need for the present Board to enter further into the qualitative analysis of decision ..., bearing in mind that it could also imply a prejudgement in some way of the subject-matter of the present referral.

It is sufficient to state that said decision does not contain any bold contention, nor has it been substantiated in "such outspoken, extreme or unbalanced terms" that it would preclude the capacity of the member concerned from dealing with the pending referral with an open mind and without preconceived thoughts.

Therefore there is nothing, whether "*in concreto*" or "*in abstracto*", in ...'s behaviour or in decision ... that could justify any suspicion against this member who therefore remains a member of the Enlarged Board of Appeal in the present case

Order

For these reasons it is decided that:

- The request of ... acting on behalf of ... is rejected as inadmissible.
- ... remains a member of the Enlarged Board of Appeal in case

The Registrar:

The Chairman:

W. Roepstorff

P. Messerli