

Amicus Curiae Brief

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to the Enlarged Board of Appeal of the EPO
concerning referral G3/19

Dear Chair and Members of the Enlarged Board of Appeal,

The following questions were referred by the President of the EPO in referral G3/19:

1. 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. If the answer to question 1 is yes, is the exclusion from patentability of plants and animals exclusively obtained by means of an essentially biological process pursuant to Rule 28(2) EPC in conformity with Article 53(b) EPC which neither explicitly excludes nor explicitly allows said subject-matter? (OJ 2019 A52)

1. I refrain from submitting any comments on the second question and on the interpretation of Article 53 EPC. Hence, I submit no comments on the patentability of inventions relating to plants. My comments deal only with the institutional considerations underlying the first question.

I. Competence to give authentic interpretations

2. As to the first question, leaving aside its admissibility, an underlying question is whether the Administrative Council has a power to give ‘authentic interpretations’, which amounts to identifying the legal basis for such power. A related question is what the nature is of the express delegation provisions in the EPC, such as in e.g. Articles 78(1) and 80 EPC (both referring to “the requirements laid down in the Implementing Regulations”). Are these references to the Implementing Regulations merely illustrative, or are they in some way a constitutive act for the laying down of the corresponding provisions in the Implementing Regulations? If such references in Articles of the EPC are generally constitutive rather than merely illustrative, Rule 28 may need a corresponding delegation provision in an Article of the EPC. In other words, is it in any way relevant that Article 53 EPC does not refer to further requirements laid down in the Implementing Regulations, whereas numerous other EPC provisions do?
3. If Rule 28 EPC is not based on a specific delegation provision in an EPC Article, it may still have legal basis based on some general principle that the Administrative Council has a competence to give authentic interpretations.

It is submitted that the EPC contains no provision expressly giving the Administrative Council such competence. In particular Article 33(1)(c) EPC does not expressly give such power. The text of Article 33(1)(c) EPC only indicates the addressee of the competence to amend the Implementing Regulations, without prescribing what can be laid down therein. I will discuss this in more detail in para. 13.

4. If the competence to give authentic interpretations is to be based on an unwritten general principle, it becomes relevant that substantive patent law is outside the scope of Article 125 EPC. Moreover, the Vienna Convention on the Law of Treaties does not identify decisions of administrative treaty bodies as a means of interpretation of treaty provisions.
5. The Enlarged Board in G2/07, r.2.2 said that “the function of the Implementing Regulations [is] to determine in more detail how the Articles should be applied and there is nothing in the Convention allowing the conclusion that this would not also apply in the case of Articles governing issues of substantive patent law”. The answer to present Question 1 may benefit from further analysis of this passage in G2/07.
6. Accordingly, it is submitted that the lack of delegation provisions in Article 53 EPC, compared to e.g. Articles 78 and 80 EPC, may indicate that the Diplomatic Conference saw less of a role for the Implementing Regulations regarding the requirements for patentability of subject-matter compared to procedural provisions and formal requirements for patent applications.

In fact, the *amicus* brief of Mr. Van Woudenberg in the present referral shows that the *travaux préparatoires* contain a highly pertinent statement on this specific issue, namely that the possibility of the Administrative Council “*adding new conditions relating to patentability*” was something that “*nobody wanted*” (M/PR/I p.28, para.33). The *travaux* evidence that the position of the UK delegation, that “*questions about patentability*” were “*primarily politico-legal matters which were the responsibility of the Administrative Council in its capacity as the political body of the Patent Organisation*” was strongly and “as a matter of principle” rejected by the other Delegations at the Diplomatic Conference (M/PR/I, paras. 27-34). This appears to rule out a general competence of the Administrative Council to add patentability requirements by way of laying down an authentic interpretation in the Implementing Regulations.

It is observed that G2/07 does not discuss the *travaux préparatoires* at all in r.2.2.

7. Moreover, Article 112(1) EPC establishes that “in order to ensure uniform application of the law”, the Boards and the President of the Office may refer questions to the Enlarged Board. Article 112(1) EPC appears to indicate that ensuring uniform application of the law is the competence of the Enlarged Board (without prejudice to the EPO Guidelines which do not bind the Boards). The question arises if in view thereof, the Administrative Council also has a competence to prescribe a certain uniform application of the law to the Boards in the Implementing Regulations (notwithstanding the specific delegation provisions as discussed hereinabove). It is not clear if the Diplomatic Conference envisaged two bodies to have the task of “ensuring uniform application of the law”.
8. In conclusion, the Enlarged Board in G2/07, r.2.2 did not explicitly consider the limitation of Article 125 EPC to procedural law, the Vienna Convention on the Law of Treaties, the relevance of Article 112(1) EPC, the pertinent remarks in the *travaux préparatoires*, and the presence of delegation provisions in numerous Articles of the EPC yet not in Articles 53-57 EPC. For completeness’ sake, the Enlarged Board also did

say in G2/07, r.2.2 that the competence to give authentic interpretations follows directly and unambiguously from the wording of Article 33(1)(c) EPC.

9. The Enlarged Board in G2/07, r.2.2 furthermore did not consider Article 33(1)(b) EPC and Article 35(3) EPC, because these institutional provisions were introduced with EPC 2000 while the amendment at issue in G2/07 (OJ 1999 p.439) was made under EPC 1973. This furthermore allows to distinguish the amendments at issue in G2/07 with any later amendments made under EPC 2000.
10. G2/07, r.2.2 furthermore appears responsive to para. 58 of the referring decision T 83/05 and not so much to the referred questions; accordingly the passage appears to be *obiter*.
11. In order to analyze whether the Administrative Council has a general power to give authentic interpretations, two further decisions of the Enlarged Board are of particular relevance.
12. In G2/06, r.31, the Enlarged Board stated that, by what is now Rule 28 (1)(c), “the legislators have decided, remaining within the ambit of Article 53(a) EPC, and there is no room for manoeuvre”. The Enlarged Board did not expressly indicate a legal basis for this conclusion; moreover the cited sentence appears to be response an argument (of the referring Board) that said Rule would “go beyond Article 53(a) EPC and thus be ultra vires (Article 164(2) EPC)”. Hence, this concerns the limits of the competence to give authentic interpretations rather than its existence and legal basis.
13. In G6/95, the Enlarged Board noted that “According to Article 33(1)(b) EPC [1973], the Administrative Council is competent to amend the Implementing Regulations. There are obviously limits to the exercise of its powers, however. In fact, Article 164(2) EPC states [...]. Therefore, the Administrative Council may not amend the Implementing Regulations in such a way that the effect of an amended Rule would be in conflict with the EPC itself ("this Convention").” It is correct that (present) Article 33(1)(c) EPC identifies the Administrative Council as the body that can *amend* the Implementing Regulations rather than e.g. the President. However, it is not clear if Article 33(1)(c) EPC does more than identifying the body that is competent to amend the Implementing Regulations. If the provision only specifies an addressee of the competence to amend, the fact that it does not recite limits of the competence does not allow the conclusion that the competence is unlimited.

In particular, Article 33(1)(c) EPC is consistent with the interpretation that the Implementing Regulations can only be used for laying down rules pursuant to the above-discussed specific delegation provision, because it is then still necessary to identify the organ that can lay down those rules.

In addition, Article 33(1)(c) EPC as such does not indicate that the Administrative Council can go beyond the content of the Implementing Regulations as adopted at the 1973 Diplomatic Conference. Indeed, G6/95, r.1 also observed that “[t]he Intergovernmental Conference which adopted these original texts of the EPC itself and the Implementing Regulations clearly intended that, following the entry into force of these texts, [...] the Administrative Council would be competent to amend the original text of the Implementing Regulations pursuant to Article 33(1)(b) EPC [1973]”. This suggests

that the term “amend” in present Article 33(1)(c) EPC indicates a specific relation with the scope of the original Implementing Regulations.

14. If it is assumed that a competence of the Administrative Council to give authentic interpretations exists (beyond the specific delegation provisions), this does not mean that Article 164(2) EPC is the only limit to such competence.
15. As said, the term “amend” in present Article 33(1)(c) EPC appears to indicate a specific relation with the original Implementing Regulations. Accordingly, the Implementing Regulations that were already adopted at the Diplomatic Conference of 1973 may be distinguished from provisions that are newly introduced into the Implementing Regulation by the Administrative Council, as the former provisions were already taken into account during the ratification of the EPC 1973 under the parliamentary procedure of each Contracting State. This can be seen as a legal basis for regulating such matters in the Implementing Regulations, as alternative legal basis to the specific delegation provisions that were added under EPC 2000.

The amendments of the Implementing Regulations resulting from the Diplomatic Conference of 2000 and the ratification of the EPC 2000 may likewise be distinguished from amendments made under the normal procedure involving the Administrative Council only.

16. Finally, any flexibility necessary in view of EU law is presently (under EPC 2000) provided by Article 33(1)(b) EPC with the important safeguards of the procedure of Article 35(3) EPC. That procedure ensures the democratic involvement of national parliaments during the one-year period as well as the implicit involvement of the European Parliament in any adopted EU legal instrument. Together with the general revision procedure of Article 172 EPC, this appears to be an essential provision for ensuring that the patentability requirements are democratically established with the appropriate involvement of the European Parliament as well as of national parliaments. Decision making in the Administrative Council cannot replace this democratic parliamentary procedure, if only because it is much less transparent. It is submitted that the specific democratic procedure of Article 35(3) EPC cannot be bypassed through the Implementing Regulations.

II. The meaning of ‘conflict’ in Article 164 EPC

17. Question 1 can also be analyzed with a focus on the meaning of the phrase “in case of conflict between the provisions of this Convention and those of the Implementing Regulations” in Article 164(2) EPC. If the Administrative Council is assumed to be competent to lay down an authentic interpretation of Article 53 EPC in a Rule, then a conflict in the sense of Article 164(2) EPC may possibly exist not only in case of a conflict of the Rule with Article 53 EPC, but also in case of a conflict of the Rule with Article 112 EPC, in particular with the specific role of the Enlarged Board laid down therein. This role of the Enlarged Board (ensuring uniform application of the law) can also be distinguished from the role of the Technical Boards of Appeal and of the Legal Board of Appeal.

18. Indeed the Enlarged Board observed in G6/95, r.5 that: “[if] Rule 71a(1) EPC [1973] [present Rule 116 EPC 2000] were to be interpreted as applying to all departments of the EPO, including the boards of appeal, its effect would be directly contradictory to and in conflict with the effect of Article 11(2) RPBA which was adopted pursuant to Article 23(4) EPC as the emanation of the independence of the boards of appeal. However, the Administrative Council must be presumed to know the limits of its own power.” The relevance of the passage for the present referral is that although the Rule at issue in G6/95 dealt with oral proceedings, the possible conflict in the sense of Article 164(2) EPC was not a substantive conflict with Article 116 EPC, but a systematic conflict, namely with the institutional provision of Article 23(4) EPC.
19. I refrain from submitting any comments on the admissibility of the first question; the above observations hence do not imply that the first question is admissible in my view. I also refrain from commenting on whether or not the phrasing of the first question accurately describes the decision of the Administrative Council adopting Rule 28(2) EPC.
- I furthermore note that the above observations concern only a single paragraph of decision G2/07 (namely, r.2.2); I explicitly refrain from submitting any comments on the other parts of G2/07.
20. The above observations are my personal views only.

Respectfully submitted,

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