

**CA/106/99**

Orig.: German

Munich, 07.12.1999

SUBJECT: Revision of the EPC: Article 11

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: 1. Administrative Council (for decision)  
2. Committee on Patent Law (for opinion)

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#### SUMMARY

This document contains a proposal to add a provision to Article 11 EPC which would make it possible, even after the planned deletion of Article 160(2) within the framework of the revision of the EPC, to appoint external legally qualified members of the Enlarged Board of Appeal of the European Patent Office.

The Administrative Council is requested to entrust the proposal to the Committee on Patent Law for detailed study.

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## **I. NATIONAL JUDGES ON THE ENLARGED BOARD OF APPEAL**

1. As part of the process of the harmonisation of patent case law in Europe, for some years now national judges have been acting as legally qualified members in proceedings before the EPO's Enlarged Board of Appeal pertaining to fundamental aspects of European patent law. The late Dr Karl Bruchhausen, judge at the German Federal Court of Justice (*Bundesgerichtshof*), Professor Jan J. Brinkhof, Vice-President of the Regional Court of Appeal (*Gerechtshof*) at The Hague, und Bernhard Jestaedt, also a judge at the *Bundesgerichtshof*, have already been involved in decisions of the Enlarged Board of Appeal. The Administrative Council had approved a proposal by the President of the EPO (see CA/6/99 dated 19 May 1999) to increase the participation of national judges and to appoint more external members of the Enlarged Board.

## **II. LEGAL BASIS FOR THE APPOINTMENT OF EXTERNAL BOARD OF APPEAL MEMBERS**

2. The legal basis for the appointment of external members of the boards of appeal and the Enlarged Board of Appeal is currently Article 160(2) EPC:

"During a transitional period, the expiry of which shall be determined by the Administrative Council, the Administrative Council, after consulting the President of the European Patent Office, may appoint as members of the Enlarged Board of Appeal or the Boards of Appeal technically or legally qualified members of national courts and authorities of Contracting States who may continue their activities in their national courts or authorities. They may be appointed for a term of less than five years, though this shall not be less than one year, and may be reappointed."

The transitional period referred to in Article 160(2) EPC may be terminated by a decision of the Administrative Council, but this has not yet happened.

In addition, on 20 October 1977, the Administrative Council, having regard to Article 33(2)(b) EPC, adopted the Regulation on the appointment and conditions of employment of members of the Boards of Appeal and of the Enlarged Board of Appeal appointed under Article 160, paragraph 2 of the European Patent Convention (CA/D 6/77). The provision in this regulation relating to payment was amended on 10 December 1987 (CA/D 13/87).

3. As part of the plans to revise the EPC, the transitional provisions in Articles 159-163 EPC are being deleted (see CA/156/97 dated 14 November 1997, No. 5.6, and CA/PL 18/98 dated 16 October 1998, No. 4), as almost thirty years on they are now obsolete. The Committee on Patent Law also agreed that Article 160(2) EPC should be deleted, because as it stands it is merely a transitional provision. However, according to the Committee, whether the substance of Article 160(2) EPC should be retained was a matter to be discussed by the Administrative Council (meeting on 3 and 4 November 1998, CA/PL PV 8, No. 9).

It is therefore necessary to examine whether and to what extent the option to appoint external members of the boards of appeal should be retained on a permanent basis in a suitable provision in the EPC.

### **III. PARTICIPATION OF EXTERNAL MEMBERS IN APPEAL PROCEEDINGS**

4. The participation of external legally qualified members from the EPC contracting states in proceedings before the Enlarged Board of Appeal has proved to be a success. It is expected that the involvement of national judges in important cases before the Enlarged Board will continue in future to provide valuable input, to help bring about international recognition of these decisions and, in so doing, to further the harmonisation of patent case law in Europe.

The appointment of national judges from the contracting states as members of the Enlarged Board of Appeal will thus continue to be highly desirable.

5. Under Article 160(2) EPC the Administrative Council has appointed not only legally qualified members of the Enlarged Board, but also a large number of technically qualified external members of the EPO's technical boards of appeal.

One of the reasons for introducing the appointment of external board members was the concern that, particularly in the early days, the EPO might not have the necessary wide range of specialist know-how available in-house. This is no longer the case today, as experts are in place in all technical fields. There is thus no reason to continue to appoint external technically qualified members of the technical boards of appeal, or external technically qualified members of the Enlarged Board of Appeal.

Recently, therefore, there have been very few instances of external members participating in cases before the technical boards of appeal. Arrangements had in any case proven, for organisational reasons, to be both complicated (need for repeated journeys to and from board meetings, difficulties in arranging dates, etc.) and increasingly inefficient.

6. These organisational difficulties are also an argument against retaining the option, which was only taken up in the early years, of appointing external legally qualified members to the Legal Board of Appeal or technical boards of appeal.
7. It is therefore proposed that the appointment of external board members be restricted to legally qualified members of the Enlarged Board of Appeal.

### III. INCORPORATION OF ARTICLE 160(2) INTO ARTICLE 11 EPC

8. It is proposed that the substance of Article 160(2) EPC be incorporated into Article 11 EPC ("Appointment of senior employees") and to add a new paragraph 5 as follows:

Article 11 EPC - Appointment of senior employees

Paragraphs (1) - (4): unchanged

**(5) The Administrative Council, after consulting the President of the European Patent Office, may also appoint as members of the Enlarged Board of Appeal legally qualified members of the national courts of the Contracting States, who shall continue their activities in their national courts. They shall be appointed for a term of three years and may be reappointed.**

### IV. EXPLANATION OF THE TEXT OF NEW ARTICLE 11(5) EPC

9. The first sentence of new Article 11(5) EPC corresponds, insofar as the provision is to be taken over, to the former Article 160(2), first sentence, EPC. It is clear from the intention and purpose of this provision that the members of the national courts of the contracting states referred to should be active in the field of patents. Mention of the authorities has been dispensed with, as this was geared to the appointment of external technically qualified members, who in most cases work in national patent offices.

The phrase "who shall continue their activities in their national courts" indicates that it is intended that the members of the national courts who participate in the Enlarged Board of Appeal should be active in these courts, otherwise it will not be possible to achieve the aim of full harmonisation of the case law, and should be so at least at the time the appointment is made. Should a judge cease to be an active member of his national court during his term as an external member of the Enlarged Board, for example as a result of retirement, he may continue in his appointment, but he will not be reappointed.

10. The second sentence of new Article 11(5) EPC differs from the second sentence of previous Article 160(2) EPC, which provides for a flexible term of office of between one and five years. This was required at the time because of the difficulties in forecasting requirements in the early years of the EPO.

In contrast, the proposed fixed term of three years, which is in line with current appointment practice, represents a clear and easy to manage solution. A term of five years, such as for internal board of appeal members, was rejected in order to keep to a minimum the remaining term of any judge who retires from his national court during his term of appointment as an external member of the Enlarged Board.

The option to reappoint judges who are still actively involved in their national courts should be retained, particularly in view of their contribution to the harmonisation process.

## **V. ADAPTATION OF THE REGULATION ON THE APPOINTMENT AND CONDITIONS OF EMPLOYMENT OF EXTERNAL BOARD OF APPEAL MEMBERS**

11. The Administrative Council's Regulation on the appointment and conditions of employment of members of the Boards of Appeal appointed under Article 160(2), as mentioned in paragraph 2 above, will have to be adapted to the changed legal situation following the revision of Article 11 EPC.

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