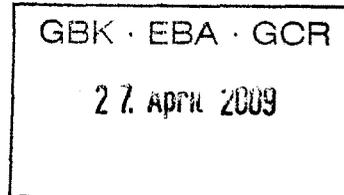


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Munich, April 27, 2009  
str/pf

**Re: Case No. G3/08  
Referral of the President of the European Patent Office under Article 112 (1) (b) EPC of  
October 22, 2008**

**Statement According to Article 11 b Rules of Procedure of the Enlarged Board of Appeal**

Dear Vice-President Dr. Messerli,

with reference to the Referral of the President of the European Patent Office of October 22, 2008, I respectfully submit the following comments under Article 11b RPEBA. I emphasize from the outset that these comments are my own sole responsibility and may in no way be related to the institution of which I until recently have been one of the Directors.

**I.**

**1.1** In the Summary of her Referral the President of the European Patent Office (EPO), first, pointed out that the patentability of computer programs since the drafting of the European Patent Convention (EPC) has been a complex issue and the legislative attempts to change or clarify the law in this field have met with more controversy than success, "although Article 52 EPC was amended to state that inventions in all fields of technology are patentable, thus making an implicit

requirement explicit."<sup>1</sup>

1.2 The President then pointed out that when the EPC was drafted, the feeling was that it was better not to define the exclusion precisely in law, but that the matter should be left in the hands of the EPO and the national courts, because this flexibility was important as technology develops and new technologies emerge. However, the President also referred to and quoted a working group statement, stressing that a matter as important as computer programs should not be left in a state of prolonged uncertainty pending legal developments.<sup>2</sup> The President then went on to state:

"Diverging decision of the boards of appeal have indeed created uncertainty, and answers to the questions arising from these decisions are necessary to enable the further, harmonious development of case law in this field."<sup>3</sup>

1.3 The President, eventually, added:

"Currently there are concerns, also expressed by national courts and the public, that some decisions of the boards of appeal have given too restrictive an interpretation of the breadth of the exclusion. It is clear that the European Patent Office should have the leading role in harmonising the practice of patent offices within Europe."<sup>4</sup>

1.4 Therefore, according to the President, four questions have been chosen for the referral in order to look at four different aspects of patentability in this field.

"Firstly, the relevance of the category of the claims is questioned. The next three questions concern themselves with where the line should be drawn between those aspects excluded from patentability and those contributing to the technical character of claimed subject-matter: ..."<sup>5</sup>

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<sup>1</sup> Summary of the Referral No. 1, first paragraph.

<sup>2</sup> 5th Meeting of the Inter-Governmental Conference for the Setting Up of a European Patent System for the Grant of Patents, held on 24-25 January and 2-4 February 1972, BR/168e/72eld/KM/gc, p.14, 36.

<sup>3</sup> Summary No. 1, paragraph 2, last sentence.

<sup>4</sup> Summary No. 1, paragraph 3.

<sup>5</sup> Summary No. 1, paragraph 4, first half of the second sentence.

## II.

### Question 1:

**Can a computer program only be excluded as a computer program as such if it is explicitly claimed as a computer program?**

**2.1.1** With the Referral of this question the President is invoking the divergence of the following decisions of the Board of Appeal: **T 1173/97** of July 1, 1998, and **T 424/03** of February 23, 2006.

**2.1.2** Both the decisions, **T 1173/97** and **T 424/03** were handed down by the Technical Board of Appeal (TBA) **3.5.1**. In **T 1173/97** the Board was composed of P. van den Berg (Chairman), V. Di Cerbo, R. Zimmermann (Members) and in **T 424/03** of S. Steinbrener (Chairman), K. Bumers and G. Weiss (Members).

**2.1.3** The Board in **T 424/03** states, *inter alia*:

"Moreover, the computer-executable instructions have the potential of achieving the above mentioned further technical effects of enhancing the internal operation of the computer, which goes beyond the elementary interaction of any hardware and software of data processing (see **T 1173/97** – *Computer program product/IBM*; OJ EPO 1999, 609). The computer program recorded on the medium is therefore not considered to be a computer program as such, and thus also contributes to the technical character of the claimed subject-matter."<sup>6</sup>

### Question 2:

**Can a claim in the area of computer programs avoid exclusion under Art. 52 (2) (c) and (3) merely by explicitly mentioning the use of a computer or a computer-readable data storage medium?**

**2.2.1** Here the President invoked as diverging the following decisions: **T 1173/97** and, less explicitly, **T 38/86** of February 14, 1989, on the one hand, and **T 258/03** of April 21, 2004,

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<sup>6</sup> Point 5.3 of the Reasons, *in fine* (bold emphasis added).

**T 424/03** and **T 1284/04** of March 7, 2007, on the other hand.

**2.2.2** Here again all the decisions invoked by the President were handed down by the **TBA 3.5.1**. As already mentioned above, the respective Board in **T 1173/97** was composed of P. van den Berg (Chairman), V. Di Cerbo and R. Zimmermann (Members); in **T 38/86** of P. van den Berg (Chairman), W. Wheeler and E. Person (Members); and in **T 258/03** of S. Steinbrener (Chairman), R. Wibergh and B. Schachenmann (Members); in **T 424/03**, as already mentioned above, of S. Steinbrener (Chairman), K. Bumès and G. Weiss (Members). The Board **T 1284/04** was composed of the same members as in **T 424/03**.

**2.2.3.1** The Board in **T 258/03**, states, *inter alia*:

"The idea behind the so-called contribution approach applied by earlier jurisprudence of the boards of appeal was that the EPC only permitted patenting in those cases in which the invention involves some contribution to the art in a field not excluded from patentability (**T 38/86**, OJ EPO 1990, 384, Headnote II)."<sup>7</sup>

**2.2.3.2** Moreover, the Board further stated in **T 258/03**:

"However, in more recent decisions of the boards any comparison with the prior art was found to be inappropriate for examining the presence of an invention:

Determining the technical contribution an invention achieves with respect to the prior art is therefore more appropriate for the purpose of examining novelty and inventive step than for deciding on possible exclusion under Article 52 (2) and (3) (**T 1173/97**, OJ EPO 1999, 609, point 8)

...

This view is shared by the Board in its present composition."<sup>8</sup>

**2.2.3.3** Finally, the Board also stated in **T 258/03**:

"Furthermore, in accordance with Article 52 (3) EPC, the subject-matter mentioned in paragraph 2 of the same article is only excluded from patentability as such. It has long been recognized that, due to this stipulation, a mix of technical and non-technical features

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<sup>7</sup> Point 3.2. of the Reasons, first sentence (bold emphasis added).

<sup>8</sup> Point 3.3. of the Reasons.

may be patentable:

'The use of technical means for carrying out a method for performing mental acts, partly or entirely without human intervention, may, having regard to Article 52 (3) EPC render such a method a technical process or method and therefore an invention within the meaning of Article 52 (1) EPC' (T 38/86, Headnote III)."<sup>9</sup>

**2.2.4** As already mentioned above<sup>10</sup> the Board in point 5.3 of the Reasons in T 424/03 made explicit reference to T 1173/97.

**2.2.5** As regards T 1284/04 the Board makes reference to T 258/04.<sup>11</sup> However, although in the context of the inventive step test, it also refers to well-established case law, as referenced in T 764/02.<sup>12</sup>

**Question 3:**

**(A) Must a claimed feature cause a technical effect on a physical entity in the real world in order to contribute to the technical character of the claim?**

**(B) If Question 3 (A) is answered in the positive, is it sufficient that the physical entity be an unspecified computer?**

**(C) If Question 3 (A) is answered in the negative, can features contribute to the technical character of the claim if the only effects to which they contribute are independent of any particular hardware that may be used?**

**2.3.1** For Question 3 the President invoked the following decisions as being diverging: T 163/85 of March 14, 1989 (where the Board was composed of P. van den Berg (Chairman), W. Oettinger and P. Ford (Members)); T 190/94 of October 26, 1995 (where the Board was composed of P. van den Berg (Chairman), W. Oettinger and G. Davies (Members)); T 125/01 of December 11, 2002

<sup>9</sup> Point 3.4. of the Reasons, first two paragraphs (bold emphasis added).

<sup>10</sup> No. 2.1.3.

<sup>11</sup> Point 2 of the Reasons.

<sup>12</sup> Point 3.1, first paragraph of the Reasons of T 1284/04. Here it should be added, that the Board

(where the Board was composed of S. Steinbrener (Chairman), R. Wibergh and E. Lachacinski (Members)); and **T 424/03** of February 23, 2006 (where the Board was composed of S. Steinbrener (Chairman), K. Bumès and G. Weiss (Members)). Thus all decisions were handed down again by the **TBA 3.5.1**.

**2.3.2 T 125/01** does not contain any binding statements of interest since the patent was revoked on other grounds. Whether the result would have been a different one, is a matter of inappropriate speculation and cannot be deduced from the statement:

"Die Kammer **neigt** dazu, der im Streitpatent genannten Aufgabe der leichten Anpassbarkeit und damit flexiblen Verwendbarkeit eines Steuermoduls vom beanspruchten Typ technische Aspekte zuzubilligen, da eine derartige Aufgabenstellung bei der Ausbildung einer Hardware-Schnittstelle ohne weiteres als technisch angesehen werden würde.

Außerdem liefert nach Auffassung der Kammer die geeignete Umstrukturierung eines Steuerungsprogramms im Hinblick auf die Möglichkeit, weitere technische Gerätefunktionen aufzunehmen und/oder die Bedienbarkeit des Geräts zu verbessern, in Analogie zur Umkonstruktion einer Hardware-Steuerungseinrichtung zu diesem Zweck auch einen technischen Beitrag zur Erfindung."<sup>13</sup>

**2.3.3.1** In **T 424/03**,<sup>14</sup> as has already been mentioned,<sup>15</sup> the TBA refers to and relies on **T 1173/97**. In **T 1173/97**, at point 13 of the Reasons, the Board states the following:

"Furthermore, the Board is of the opinion that with regard to the exclusions under Article 52 (2) and (3) EPC, it does not make any difference whether a computer program is claimed by itself or as a record on a carrier (following decision **T 163/95**, OJ EPO 1990, 379, "Color Television Signal/BBC," as cited above)."

**2.3.3.2** It is clear that the reference to **T 1173/97** in **T 424/03** also implicitly includes a reference to **T 163/85**.

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in **T 764/02** was composed of S. Steinbrener (Chairman), S. Wibergh and G. Weiss (Members).

<sup>13</sup> Point 4.2 of the Reasons (emphasis added).

<sup>14</sup> Point 5.3 of the Reasons.

**Question 4:**

**(A) Does the activity of programming a computer necessarily involve technical considerations?**

**(B) If Question 4 (A) is answered in the positive, do all features resulting from programming thus contribute to the technical character of a claim?**

**(C) If Question 4 (A) is answered in the negative, can features resulting from programming contribute to the technical character of a claim only when they contribute to a further technical effect when the program is executed?**

**2.4.1** Here divergence of the following decisions of the TBA **3.5.1** is invoked by the President: **T 833/91** of April 16, 1993 (composed of P. van den Berg (Chairman), other members not identifiable based on the search); **T 204/93** of October 29, 1993 (composed of P. van den Berg (Chairman), W. Oettinger and G. Davies (Members)); **T 769/92** of May 31, 1994 (composed of P. van den Berg (Chairman), W. Oettinger and F. Benussi (Members)); **T 1177/97** of July 9, 2002 (composed of S. Steinbrener (Chairman), R. Zimmermann and S. Perryman (Members)); **T 172/03** of November 27, 2003 (composed of S. Steinbrener (Chairman), R. Zimmermann and B. Schachenmann (Members)).

**2.4.2.1** The review of the decisions invoked for this question as diverging by the President reveals that apart from **T 1177/97** in which **T 769/92** was cited, but not in the context at hand, the decisions referred to contain no cross references to each other. This, however, should not come as a surprise, because statements such as

"a programmer's activity of writing a computer program is **also** excluded by that Article<sup>16</sup> because it requires **performing mental acts as such.**"<sup>17</sup>

in TBA 3.5.1 decisions, to the understanding of this writer, did not relate to computer programs

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<sup>15</sup> Above No. 2.1.3.

<sup>16</sup> Article 52 (2) (c) EPC (J.S.).

<sup>17</sup> T 204/93, point 3.2 of the Reasons (emphasis added).

(as such), but to mental acts (as such), which are also explicitly mentioned in Article 52(2)(c) EPC.

**2.4.2.2** In T 204/93, therefore, the Board added the word "also". This should be plain, as plain as that the **activity of a chemist of writing a structural formula of a chemical compound** can not be patented because it presents the performance of a mental act as such. This, however, it goes without saying, has absolutely nothing to mean as to the patentability of the chemical compound represented by that structural formula.

**2.4.3** Consequently, no contradicting case law as to the substance at hand is addressed by Question four.

### III.

#### 3.1 Under Article 112 EPC

"(1) In order to ensure uniform application of the law, or if a point of law of fundamental importance arises:

....

(b) the President of the European Patent Office may refer a point of law to the Enlarged Board of Appeal where two boards have given different decisions on that question."

**3.2.1** In its G 4/98 Opinion of November 27, 2000, the Enlarged Board of Appeal stated, *inter alia*, in this context:

**3.2.2** "As to the admissibility of the present referral, questions arise with respect to two requirements laid down in Article 112 (1) (b) EPC, namely that different decisions were given on a question and that they were given by two Boards of Appeal."<sup>18</sup>

**3.2.3** "In the present case, the conflicting decisions stem from the Legal Board of Appeal, so that the question arises whether the second requirement mentioned in Article 112 (1) (b) EPC is met, namely that the different decisions must stem from two Boards of Appeal."<sup>19</sup>

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<sup>18</sup> Point 1 of the Reasons.

<sup>19</sup> Point 1.2, first sentence of the Reasons.

**3.2.4** "As stated at the beginning of Article 112 EPC, one of the purposes of a referral to the Enlarged Board of Appeal is to ensure uniform application of the law. This is particularly true for the referral by the President of the EPO under Article 112 (1) (b) EPC, which is dependant upon the existence of conflicting decisions. If his power of referral were to be defined by a restrictive reading of the term "two Boards of Appeal" based on organisational structure, then no referrals would be possible with respect to the Legal Board of Appeal, which is one organisational unit only...

...

In this context, it is noteworthy that the EPC does not define the Legal Board of Appeal as an organisational unit, but only by its composition, which lends additional strength to the argument that different decisions may be the basis of a referral by the President of the EPO, at least if taken in different compositions. As this is the case here, there is no need to discuss whether a referral by the President of the EPO would also be admissible had the Legal Board of Appeal handed down different decisions in the same composition. Likewise, no opinion is to be expressed on the admissibility of a referral, had the present situation arisen not in the Legal Board of Appeal. Finally, no discussion is necessary on the limitation of the power of referral by the President by the power of the Legal Board of Appeal to develop its case law by abandoning former case law [reference omitted]."<sup>20</sup>

**3.3.1** The Enlarged Board of Appeal in **G 1/04** of December 2005 opined on the admissibility of the referral of the President:

"Both decisions T 385/86 and T 964/99 originate from Technical Board of Appeal 3.4.1. Article 112 (1) (b) EPC provides for a referral by the President of the EPO when different decisions on a particular point of law have been given by two boards of appeal. However, it must be drawn into consideration that decisions T 775/92, T 530/93 of 8 February 1996 [...], T 1165/97 of 15 February 2000 [...] and T 867/98 [...] of other technical boards of appeal adopted the findings of decisions T 385/86. Hence, decision T 964/99 also diverges from decisions of other boards of appeal. **In addition**, decision T 385/86 and T 964/99 were rendered by Technical Board of Appeal 3.4.1 in completely different composition. Consequently, the referral is admissible."<sup>21</sup>

#### IV.

**4.1.1** As reported above, all decisions invoked by the President of the EPO in the present referral as diverging were handed down by the **very same** Technical Board of Appeal **3.5.1**. The time

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<sup>20</sup> Point 1.2, second paragraph of the Reasons.

<sup>21</sup> Point 1 of the Reasons (emphasis added).

span over which those decisions were handed down covers, depending on the question referred to, roughly 20 years. During this time the Board had two chairmen, and the composition of the Board varied under each chair to a certain extent, but could not be described as being "completely different." Some members, who served already under the "old" chair, continued to serve for a certain period of time also under the second chairman.

**4.1.2** To the understanding of this writer, the question of admissibility of the referral of the President, cannot be viewed as being answered completely in **G 1/04** by the sentence "in addition the sentences ... were rendered by the Technical Board of Appeal 3.4.1 in completely different composition." Having regard to the Rules of interpretation laid down in the Vienna Convention on the Law of the Treaties of 1969 to which the Enlarged Board of Appeal has repeatedly subscribed since its **G 01/83** (points 3 and 4) decision, a treaty had to be interpreted in good faith in accordance with the **ordinary meaning** to be given to the terms of the treaty in their context and in the light of its purpose (Article 31 (1)).

**4.1.3** This writer believes that the ordinary meaning of "two boards" as the term is used in EPC Article 112(1)(c), under organisational circumstances prevailing in the European Patent Office (in particular where the Boards of Appeal are identified by a number – such as 3.5.1 in the present case), means **two different boards having different numbers**. Nonetheless, the Enlarged Board of Appeal, at least as regards the Legal Board of Appeal took a different position. The Enlarged Board of Appeal, however, pointed out the rather unique position of the Legal Board of Appeal. In **G 1/04** the Enlarged Board of Appeal, eventually, also identified diverging decisions on the question of law at hand by different Boards of Appeal. However, the Enlarged Board of Appeal did not give any explanation as to the justification and its legal foundation of its final statement in the context of interest, namely:

"In addition, decisions T 385/86 and T 964/99 were rendered by Technical Board of Appeal 3.4.1 in completely different compositions."<sup>22</sup>

**4.1.4** Should this phrase mean that "two boards" against the ordinary meaning of **two** should also

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<sup>22</sup> Point 1 of the Reasons.

mean **one and the same board** only in different, how different (?) compositions, recourse may be had for the interpretation to the preparatory work of the treaty and the circumstances of its conclusion, since either the meaning of "two boards" is to be viewed as ambiguous or obscure or the interpretation in its ordinary meaning to lead to manifestly absurd or unreasonable result, in the sense of Article 32 (a) and/or (b) of the Vienna Convention. To this extent to the understanding of this writer, the Enlarged Board of Appeal has not yet examined the preparatory documents and has not yet expressed itself.

## V.

**5.1** The opinions expressed in the legal doctrine do not reflect a homogenous stand, as a recent publication of *S. Steinbrener*<sup>23</sup> has revealed.

**5.2** Prior to briefly touching upon the diverging views expressed in the legal doctrine, however, it should be emphasized that the preparatory documents as researched by this writer and also by *Steinbrener*<sup>24</sup> unambiguously reveal that the treaty makers of the EPC clearly rejected the competence of the President of the EPO to refer to the Enlarged Board of Appeal questions of law, which are simply of interest to the European Patent Office – for whatever reason. This is due to the court-like character of the Enlarged Board of Appeal and that it should not function as a consultative legal department of the European Patent Office. According to the preparatory documents, the competence for referrals of the President of the European Patent Office should exist exclusively in cases of concrete diverging decisions of two Boards of Appeal in specific cases.<sup>25</sup> *Steinbrener* therefore opines that otherwise motivated referrals, for instance as a result of different legal positions, political considerations or diverging national case law, should be

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<sup>23</sup> Zur Frage der Zulässigkeit einer Vorlage an die Große Beschwerdekammer nach Art. 112 EPÜ, GRUR Int. 2008, 713 ss.

<sup>24</sup> For simplicity reasons, therefore, reference is made here only to the preparatory documents referred to in the footnotes 2-16 in the article of Steinbrener.

<sup>25</sup> Cf. Steinbrener, GRUR Int. 2008, 715 (right column, first paragraph). Cf. also Moser, in Münchner Gemeinschaftskommentar, 20. Lieferung 1997, Article 112 marginal note 7, with references to the preparatory documents.

inadmissible.<sup>26</sup>

**5.3.1** The legal doctrine, as also summarized by *Steinbrener*, which is interestingly represented exclusively by either still active Members of the Boards of Appeal, including *Steinbrener* himself,<sup>27</sup> or members of the legal services,<sup>28</sup> or former members of the Boards of Appeal and also of the Enlarged Board of Appeal,<sup>29</sup> have different views on the point at hand.

**5.3.2.1** Prior to **G 4/98** Opinion of the Enlarged Board of Appeal the doctrine constantly interpreted "two Boards of Appeal" as

"dass zwei Kammern über die Frage von einander abweichende Entscheidungen getroffen haben,"

or

"dass verschiedene Spruchkörper..."<sup>30</sup>

or

"zwei Beschwerdekammern in Sinne des Art. 21 müssen über die vorgelegte Frage von einander abweichende Entscheidungen getroffen haben."<sup>31</sup>

**5.3.2.2** To the understanding of this writer, these statements do not support the interpretation of "two boards", within the meaning of EPC Article 112(1)(c) to mean one and the same board (in the sense as having the same reference number) in different composition.

**5.3.3.1** Since the publication of **G 4/98** of the Enlarged Board of Appeal authors like *Moufang* concede the President the competence to refer questions of law practically always to the Enlarged

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<sup>26</sup> Id., p. 718 (right column).

<sup>27</sup> The others are B. Günzel, in: Benkard, *Europäisches Patentübereinkommen 2002*, R. Moufang in Schulte, *Patentgesetz mit EPÜ*, 8th ed. 2008.

<sup>28</sup> U. Joos, in Singer/Stauder, *The European Patent Convention*, 3rd ed., 2003.

<sup>29</sup> R. Teschemacher, *Der Beitrag des Präsidenten des Europäischen Patentamts zur Rechtsprechung der Großen Beschwerdekammer – Eine erste Bestandsaufnahme*, GRUR 1993, 320 ss.; Moser, in: *Münchener Gemeinschaftskommentar*, 20. Lieferung 1997.

<sup>30</sup> Teschemacher, GRUR 1993, 321.

<sup>31</sup> Moser, id., Art. 112, marginal note 38.

Board of Appeal **when a Board of Appeal changes or further develops its former case law** on a certain question of law.

"Die Möglichkeit zur Vorlage wird dem Präsidenten nicht dadurch beschränkt, dass die entscheidende Kammer 'ihre' frühere Rechtsprechung aufgibt. Auch dann liegen zwei von einander abweichende Entscheidungen vor. Der Präsident kann daher vorlegen, wenn er der Auffassung ist, dass die neue Rechtsprechung falsch, die frühere dagegen richtig ist."<sup>32</sup>

### 5.3.3.2 *Joos*, who states that

"The crucial factor for the application of this provision should be that two decisions are contradictory in their constructions of law, and not that the divergent decisions were taken by two separate boards of appeal, i.e. boards of different affiliations."<sup>33</sup>

refers in this respect to the problem with the Legal Board of Appeal, on the other hand emphasises the necessity to draw a distinction between contradictory decisions and developments in case law. According to *Joos*

"Such developments are to be seen when a board of appeal with the same organisational affiliation (e.g. Technical Board of Appeal 3.4.5) in the same composition, deviates from its earlier decision. In all other cases, it is possible to recognize indications of an intended development in case law in the fact that a new composition of a board of appeal, or another board of appeal discusses in-depth the earlier findings in reasons for the decision. Nevertheless, the President should be able to refer point of law to the Enlarged Board when this appears the only way to achieve a uniform application of law."<sup>34</sup>

## VI.

**6.1** The opinion expressed by *Moufang* that the President should be always entitled to refer points of law to the Enlarged Board of Appeal, whenever he or she is of the opinion that a change in case law is wrong application of the EPC as compared with the previous case law raises two categories

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<sup>32</sup> In Schulte, id., Art. 112, marginal note 42.

<sup>33</sup> In Singer/Stauder, id. Art. 112, marginal note 30.

<sup>34</sup> Id.

of questions. The first category has to do with the natural and necessary evolutionary development of case law and the second category has to do with the court-like status of the Enlarged Board of Appeal and, eventually, of Boards of Appeal in general.

**6.2.1** As to the first aspect, first the question has to be resolved how, but in case of the very special status of the Legal Board of Appeal, the term "two boards of appeal" has to be interpreted in view of the preparatory documents of the EPC.

**6.2.2** Should the result of that interpretation be that "two" is actually "one board" but in different composition, the question becomes what "different composition" has to mean – whether different chairpersons, variation of one member, variation of two members, or where all of the members of a given composition of a Board must be different.

**6.2.3** It subsequently will have to be clarified, irrespective of the issue of "same", "different" or "entirely different" composition, when is a "contradictory" change of treating a point of law at hand and when an evolutionary further development of the case law.

**6.2.4** Finally, and maybe most importantly, until which point in time should the President of the European Patent Office be allowed to refer a point of law to be clarified by the Enlarged Board of Appeal, if he or she is of the opinion that the former case law on that point of law was correct and that the later one was not. Can a new President, after the "new case law" has been applied and progressively developed over a number of years make such a referral?

**6.3.1** Should the latter be the case, the EPO President is essentially placed in a position of being able to interfere with well established case law of one of the technical boards of appeal. This would very likely have an impact on the until now recognized independent status of the boards of appeal, including that of the Enlarged Board of Appeal as a judicial authority<sup>35</sup> in general and in the context of the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS)

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<sup>35</sup> Cf. decision G 1/97 of December 10, 1999, point 5 (a) and (c) of the Reasons, including references to the respective national case law. Further, European Commission of Human Rights (First Chamber) of September 9, 1998 (application no. 39025/97 and 38817/97 by Lenzing AG

more specifically.

**6.3.2** The finally internationally recognized status of a judicial authority of the Boards of Appeal of the European Patent Office should not be taken for granted. The problems regarding the status of the Boards of Appeal in terms of institutional independence have been known since long and have been thoughtfully and skilfully presented, and solutions suggested in the study prepared by the former President of the German Federal Patent Court, Ms. A. Sedemund-Treiber and Professor F. Ferrand, of October 25, 2003.<sup>36</sup>

**6.3.3** Since the Sedemund-Treiber/Ferrand Study was submitted to the Administrative Council of the European Patent Organisation, nothing has happened to improve the institutional independence of the Boards of Appeal. Rather, the opposite seems to be the case. *Teschemacher* recently gave a number of reasons why the judicial status of the boards of appeal should be treated with even more care than in the past.<sup>37</sup>

## VII.

**7.1** One of the reasons for the referral which the President explicitly mentioned were current concerns, also expressed by national courts and the public that some decisions of the boards of appeal have given too restrictive an interpretation of the breadth of the exclusion of computer programs as such from patentability. Moreover, the President said that the European Patent Office should have the leading role in harmonising the practice of patent offices within Europe.

**7.2** It is respectfully submitted that neither of the named reasons can carry the admissibility of the referral. The conditions under which a referral by the President is admissible are exhaustively listed in Art. 112 (1) b) EPC. Admissibility requires the presence of different decisions on a point of law by two Boards of Appeal of the European Patent Office. A different decision by a national

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against Germany).

<sup>36</sup> Doc. CA/103/03 Add. 2.

<sup>37</sup> Cf. *Teschemacher*, EPÜ 2000: Das neue Verfahren zur Überprüfung von Entscheidungen der

court does not carry the admissibility of a referral and even less does a diverging public opinion. As much as harmonising the practice of patent offices within Europe is to be desired, the possibility of a referral by the President is not provided for this purpose.

**7.3** It is further submitted that the case law invoked by the President spans over a period of roughly 20 years and that always more recent decisions referred to and built upon the older ones. To the understanding of this writer the only interpretation allowed in this respect is that the TBA 3.5.1 continuously further developed its respective case law, which has been entirely in line with the mandate the Boards received by the Contracting Parties to the EPC, as revealed from the preparatory work.

**7.4** Finally, one decisive development of case law may be seen and has been frequently referred to is the decision **T 1173/97** of July 1, 1998, handed down by the **3.5.1 Board of Appeal** in the "old" composition P. van den Berg (Chairman), V. Di Cerbo and R. Zimmerman (Members). The later case law of the very same Board in the "new" composition has repeatedly referred to **T 1173/97** and has based its reasoning on it.

**7.5** Question 4 of the referral constitutes a general exception for reasons given above and may be disregarded in this context.<sup>38</sup>

## VIII.

**8.1** Dear Chairman Dr. Messerli, this *amicus curiae brief* is submitted, because of the concerns which the referral of the President may have on the status of the independence of the Boards of Appeal of the European Patent Office. It should, by all means, be ensured, that the interpretation of the European Patent Convention is the sole and not interfered competence of its Boards of Appeals, including the Enlarged Board of Appeal. Only under very strict conditions, namely, when there is a contradictory case law by "two boards" and not a progressive development of the

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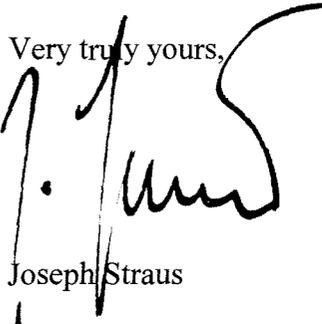
Beschwerdekammern, Mitt. 2008, 97 ss. (102 s.).

<sup>38</sup> See above nos. 2.4.2.1-2.4.3.

law by a "one board," as it seem to be at hand in the present referral may the President refer questions to the Enlarged Board of Appeal. This conclusion is supported by the ordinary meaning of the EPC and further supported by the preparatory work to that treaty.

**8.2** It is, finally, submitted that Article 112 (a) and (b) EPC also sets forth the competence of the Enlarged Board of Appeal as far as its powers to deliver opinions on points of law of fundamental importance are at hand. Such points of law can be referred to the Enlarged Board of Appeal only by the Boards of Appeal in a concrete case pending before them. The preparatory documents are crystal clear in this respect. Neither the President of the European Patent Office, nor the parties involved in the cases pending before the Boards, nor third parties, nor national courts, nor the public at large have such a right. The same applies to the Enlarged Board of Appeal itself: i.e. even if it does not agree with the case law of a concrete Board it has no competence to express its opinion on its own initiative. The Enlarged Board made this clear in its first NOVARTIS decision of November 27, 1995 (**G 3/95**) in which it rejected the referral of the President as inadmissible, although it disagreed with the Board on the point of law at hand, which it explicitly viewed as fundamental, as it became clear from its second NOVARTIS decision of December 20, 1999 (**G 1/98**).

**8.3** I hope, that the above thoughts, which should actually be viewed separately of the subject matter and the points of law disputed, no matter how important they are, will be of some help for the consideration of the Enlarged Board of Appeal.

Very truly yours,  
  
Joseph Straus