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**I N T E R L O C U T O R Y   D E C I S I O N**  
**of 30 May 2006**

**Case Number:** J 0015/04 - 3.1.01

**Application Number:** 03020299.8

**Publication Number:**

**IPC:**

**Language of the proceedings:** EN

**Title of invention:**  
Gear cutting method and apparatus

**Applicant:**  
MITSUBISHI HEAVY INDUSTRIES, LTD.

**Opponent:**

-

**Headword:**  
Possible reasons for exclusion/MITSUBISHI HEAVY INDUSTRIES,  
LTD.

**Relevant legal provisions:**

EPC Art. 24(1) to (4)  
RPBA Art. 3(1)(2), 13, 14

**Keyword:**

"Notices of self-recusation of two members of the new Board concerning a possible reason for exclusion of the Chairman of this Board"

**Decisions cited:**

T 1028/96

**Catchword:**

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Case Number: J 0015/04 - 3.1.01

**I N T E R L O C U T O R Y   D E C I S I O N**  
of the Legal Board of Appeal 3.1.01  
of 30 May 2006

**Appellant:** MITSUBISHI HEAVY INDUSTRIES, LTD.  
5-1, Marunouchi 2-chome  
Chiyoda-ku,  
Tokyo (JP)

**Representative:** Kern, Wolfgang  
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Patent- und Rechtsanwälte  
Sollner Strasse 38  
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**Decision under appeal:** Decision of the Receiving Section of the  
European Patent Office of 5 April 2004.

**Composition of the Board:**

**Chairman:** C. Holtz  
**Members:** S. Hoffmann  
E. Lachacinski

## Summary of Facts and Submissions

- I. This decision results from a procedure under Article 24(3) EPC initiated by the notices of self-exclusion of two members of the Legal Board.
- II. The European Patent application behind the present appeal case J 15/04 was filed as a divisional application to the parent application No. 98106600.4. This parent application was finally refused on the ground of lack of inventive step by the decision given during the oral proceedings on 18 June 2003 of the Technical Board of Appeal T 108/03-3.2.6. The legal member on that board later became Chairman in the appeal proceedings to the divisional application deriving from application No. 98106600.4.
- III. The present divisional application No. 03020299.8 was refused by decision of the Receiving Section posted on 5 April 2004 stating that European patent application No. 03020299.8 was not being processed as a divisional application (Rule 25(1) EPC), because when it was filed the earlier European patent application 98106600.4 had already been finally refused.
- IV. With letter of 7 June 2004 the applicant (appellant) filed a notice of appeal against this decision, paid the appeal fee on the same day and submitted a statement of the grounds of appeal on 16 August 2004.

According to the Business Distribution Scheme, this appeal was assigned to the Legal Board of Appeal composed of the legal member from the parent

application appointed now as Chairman and two additional legal members.

- V. The two legal members appointed held that the Chairman should have recused himself in the present appeal case because of his participation in the decision refusing the parent application.

As the Chairman appointed did not share this view and did not envisage availing himself of Article 24(2) EPC, the members stated that they might be suspected by the appellant of sharing any potential partiality of the Chairman and gave notice that they recused themselves pursuant to Article 24(2) EPC.

Despite the allegations of possible partiality the Chairman saw no objective reasons to be excluded from taking part as Chairman of the Board in the further appeal proceedings.

- VI. By administrative order of 27 September 2005 the originally appointed Chairman and legal members were replaced by their alternates pursuant to the Business Distribution Scheme for the purpose of taking a decision according to Article 24(3) EPC and Article 3(1) RPBA.

- VII. With communication dated 27 October 2005 the appellant was informed about the essential procedural facts concerning the legal question of a possible exclusion of one or more of the originally appointed members of the Board and afforded the opportunity to file comments on this issue. The appellant refrained from doing so.

## Reasons for the Decision

1.1 The present case gives reason to scrutinise the competence of the Legal Board in its present composition to decide on the issue of exclusion of one or more members of the originally appointed members of the Board.

Paragraphs (1) to (4) of Article 24 EPC read inter alia as follows:

*(1) Members of the Boards of Appeal or of the Enlarged Board of Appeal may not take part in any appeal if they have any personal interest therein, if they have previously been involved as representatives of one of the parties, or if they participated in the decision under appeal.*

*(2) If, for one of the reasons mentioned in paragraph 1 or for any other reason, a member of a Board of Appeal or of the Enlarged Board of Appeal considers that he should not take part in any appeal, he shall inform the Board accordingly.*

*(3) Members of a Board of Appeal or 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. An objection shall not be admissible if, while being aware of a reason for objection, the party has taken a procedural step. No objection may be based upon the nationality of members.*

*(4) The Boards of Appeal and the Enlarged Board of Appeal shall decide as to the action to be taken in the cases specified in paragraphs 2 and 3 without the participation of the member concerned. For the purposes of taking this decision the member objected to shall be replaced by his alternate.*

- 1.2 According to Article 24(4) in conjunction with paragraphs (2) and (3) EPC, the replacement of one of the originally appointed members of the Board by his alternate requires that the individual member has informed the Board that he should not take part in the appeal or was objected to by one of the parties.

Thus, only the replacement of the originally appointed two legal members of the present divisional application who submitted their notices of self-recusation is obviously justified under Article 24(2) EPC.

However, these notices do not fulfil the requirements pursuant to Article 24(2) or (3) EPC with regard to the replacement of the originally appointed Chairman by an alternative Chairman because the originally Chairman did not recuse himself (paragraph 2) and the two other originally appointed legal members are not objected to by any parties to the proceedings (paragraph 3).

- 1.3 According to Article 3(1) RPBA the application of Article 24(4) EPC is extended to cases where the Board 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. Thus, Article 3 RPBA establishes the possibility of an objection by other members of the same Board (cf.

Gerald Paterson, *The Law and Practise of The European Patent Convention*, second edition, London 2001, page 238, point No. 5-22, second paragraph, first sentence).

In the present case, the notices of self-recusation of the two legal members contained information concerning a possible reason for exclusion of the Chairman (*which does not originate from the Chairman himself*) because it states that the Chairman's participation in the decision on the refusal of the parent application No. 98106600.4 dated 18 June 2003 requires his exclusion from the present appeal.

For the purposes of taking a decision under Article 24(4) EPC the replacement of the originally appointed Chairman by an alternate Chairman is justified under Article 3(1) RPBA.

Thus, the Board as now constituted in its present composition is competent to hear the case with regard to the subject matter of whether or not the originally appointed members of the Legal Board of Appeal are excluded from hearing the appeal against the decision taken on 5 April 2004 by the Receiving Section.

2. As the originally appointed Chairman submitted the notices of self-recusation of the two other legal members together with his comments as to why he should not be excluded, a further statement pursuant to Article 3(2) RPBA is not required.

3. The exclusion of the originally appointed Chairman could be required under the terms of Article 24(1), last alternative, EPC, if he had participated in the decision now under appeal.

According to the wording of this provision, the exclusion of the originally appointed Chairman is obviously not justified because the decision under appeal is different from the decision refusing the parent application (see also the narrow interpretation of the wording " decision under appeal" in T 1028/96, reasons of the decision, point 5, OJ EPO 2000, 475).

4. In order to provide a *fair trial* as is enshrined in Article 6(1) of the European Convention on Human Rights the legal question arises whether and to what extent it could be justified to interpret the wording "participated in the decision under appeal" in Article 24(1)EPC in a broader sense than is indicated by the simple literal wording of this provision.
5. Even if one accepted that the participation in the decision under appeal also embraces any participation in the proceedings which led to the decision under appeal, the exclusion of the originally appointed Chairman would not be required by Article 24(1) EPC because the proceedings concerning the parent application are different from those of the divisional application.
6. With regard to the intention of Article 24 EPC the Board considered whether or not it would be appropriate to exclude a member of the Board from proceedings whenever he played any role in a former case which has



any functional coherency with the current one. Such functional coherency could be seen in the relationship of a divisional application to its parent application as in the present procedural situation.

7. It is self-explanatory that in cases where a specific Board of Appeal decides the same legal question in every case in an identical way an exclusion of the members of this Board cannot be petitioned even if a party has already "suffered from" such a decision although a functional coherency of these cases cannot be denied. Otherwise any established jurisprudence of a Board would lead to a permanent exclusion of its members whenever the same legal question is at stake. The opposite view would endanger the judicial efficiency of the Boards of Appeal. It is to be noted that the principle of judicial efficiency also constitutes an essential element for the right to a *fair trial* and outweighs any allegation concerning a generally "possible" suspicion of partiality which is not based on the specific facts of the current case under appeal.
  
8. By the same token, the principle of a *fair trial* does not generally exclude that a member of the Boards of Appeal deals with a party's case repeatedly as might happen when a Board refers a case back to the first instance and the appeal from the then following decision establishes the competence of the same Board composed of the former members who had taken the first decision.

As a result of these considerations, the Board holds that any broader interpretation of the wording "participated in the decision under appeal" pursuant to Article 24(1) EPC must be based on the occurrence of specific facts of the case to be decided, which are sufficient to raise specific concrete doubts on the ability of the member of the Board to hear the appeal with an objective judicial mind and cannot be concluded from the mere procedural fact that a member of the Board was already involved in former proceedings with the same party or the same legal question to be decided in the current case.

9. The fact that national law may contain reasons for recusation based on such facts, which may give parties the impression that a member of a deciding body is partial does not mean that the previous handling of a closed case automatically calls for recusation. The essence of Article 24(1) EPC is not to establish an assumption that any former involvement of a member of the Board in a case dealing with the interests of a specific party establishes a possible suspicion of partiality of that member in all subsequent cases, but is specifically to exclude the participation of this member reviewing a decision under appeal which had been dealt with by himself as part of the deciding body.
10. As regards the procedural facts of the present case, it has to be noted that the originally appointed Chairman was and is involved as a member of the Boards of Appeal in the same (appeal) instance but is not called to review a decision of an inferior instance as a member of a higher instance.

11. Moreover, any legal substantial question to be decided in the present case would be different from the reasons of the decision issued in the parent application refusing that application on the grounds of lack of inventive step because of the difference of the facts on which a decision has to be based. The subject matter of the present appeal proceedings is solely the formal question of rejection of the divisional application because it was (allegedly) filed after the former parent application was no longer pending (Rule 25(1) EPC). The issue of inventive step in respect of the subject matter of the divisional application does not lie within the Legal Board's competence and is therefore not part of the pending proceedings. Therefore, the Board cannot determine any procedural fact which would justify the assumption of a similar procedural situation to that addressed by Article 24(4) EPC or as envisaged under the general principle of the right to a *fair trial*.

As a result of the above considerations, the Board finds that Article 24(1) EPC does not apply to the present appeal and that therefore the originally appointed Chairman is not excluded from deciding on the subject matter of the present appeal.

12. As regards the other item of whether or not the other originally appointed legal members are excluded from the further participation in the present case, the Board notes that under the European Patent Convention their notices of self-recusation do not automatically effectuate their final exclusion from the proceedings otherwise the reference of paragraph 4 in Article 24 EPC to paragraph 2 of this provision and the necessity

to take a decision would be void. The decision to be taken pursuant to Article 24(4), second sentence, EPC requires a discretion for the deciding alternates to answer in the negative or in the affirmative to the question referred. In this respect a notice of self-recusation only initiates the proceedings under Article 24(4) EPC but does not anticipate the outcome of the decision to be taken. Furthermore, if one accepted that a notice of self-recusation would immediately and automatically exclude the member concerned, then the party's formal right to a hearing before a duly constituted member of the Board as established by the European Patent Convention would be violated. Such a self-recusation requires that the member in question realises that the circumstances may put him in a situation where a party may suspect him of partiality, not because of the situation of a fellow member, but because of his own relations to a party or to the subject matter to be examined.

13. The present Board in its current composition is aware of the fact that the grounds of possible partiality given by a member of the Boards in a notice of self-recusation should normally be respected by the decision whether or not an exclusion is justified. It can be expected that the member submitting a notice of self-recusation based on specific facts knows at best whether or not a possible suspicion of partiality could arise. It is important that there should be no remaining real possibility of the public or a party suspecting bias after a decision of a Board of Appeal finds no grounds of suspicion of partiality.

14. In the present case, the grounds given by the two legal member's notices of self-recusation do not justify any assumption of such a real possibility of bias either for the public or for the party concerned.

Both legal members submitted congruent grounds which are based on the fact that the originally appointed Chairman did not decline to be a member in the present divisional application although he had been party to the decision of the parent application refusing this application.

In view of these statements it is obvious that the two members did not invoke any ground which could establish a real conflict of interest or bias with respect to their own function as members of the Board. The notice of self-recusation is based on the situation that the two members did not share the Chairman's legal opinion in respect of the occurrence of a possible suspicion of partiality and a presumption that the appellant might therefore doubt their legal integrity.

A legal disagreement between the members of a Board as such does not establish any ground for exclusion or objection under Article 24 EPC. Each member of a Board is responsible for a decision even if he is voted down by the majority of the other members of the Board as it can be concluded *inter alia* from Articles 13 and 14 RPBA and the fact that the European Patent Convention does not allow the announcement of the existence and grounds of a dissenting vote. The same reasoning applies to a disagreement between the members of a Board on the legal question of whether or not the exclusion of one of them is justified.

15. If there is any doubt about the exclusion of a member of the Board, the only correct procedure is established by Article 3 RPBA in conjunction with Article 24(4) EPC which stipulates that a decision is to be taken *inter alia* by the alternates of the members concerned. Subject matter of this present appeal procedure is exclusively the question of whether or not specific members can further participate in the proceedings, but not the further participation of those members who are not in question. The European Patent Convention does not provide the possibility to circumvent the procedure pursuant to Article 3 RPBA in conjunction with Article 24(4) EPC by means of a notice of self-recusation submitted by other members not under suspicion of partiality in circumstances where the members of a Board disagree on the correct composition of the Board. Otherwise a self-recusation of a member would produce the illogical result that the non-disputed member is excluded from the proceedings but the essential question of whether or not the disputed member is entitled to further participate in the proceedings remains open. Such a result would seriously affect the proper functioning of the Boards of Appeal and their procedural efficiency.

As in the present case the notices of self-recusation are exclusively based on the fact that the original appointed Chairman did not envisage availing himself of Article 24(2) EPC, the present Board comes to the conclusion that the reasons for self-recusation are unfounded and the exclusion of the two legal members is not consistent with the provisions of the European Patent Convention in this respect.

**Order**

**For these reasons it is decided that:**

The three originally appointed members of the Board as duly constituted under The European Patent Convention are not excluded from taking part in the further appeal proceedings on the case.

The Registrar:

The Chairman:

P. Martorana

C. Holtz