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Decision of Technical Board of Appeal 3.X.X dated 18 March 2005

T 190/03 - 3.X.X

(Language of the proceedings)

Composition of the board:

Chairman: R. R. K. Zimmermann

Members: W. E. Chandler

B. J. Schachenmann

Patent proprietor/Respondent: N.N.

Opponent/Appellant: N.N.

Headword: Partiality/XXX

Article: 24 EPC

Article: 3 RPBA

Article: 6-1 EHRC

Keyword: "Suspected partiality (no)"

Headnote

I. The existence of partiality under Article 24 EPC can be determined on the basis of the following two tests:

Firstly, a "subjective" test requiring proof of actual partiality of the member concerned.

Secondly, an "objective" test where the deciding Board judges whether any circumstances of the case give rise to an objectively justified fear of partiality (point 9).

II. In the absence of exceptional circumstances, any procedural error in admitting requests would relate simply to flaws in the steps that the Board necessarily has to take to reach a decision. Thus, under the objective test, not admitting amended claims, regardless of whether the Board has correctly used its power or discretion to do so, does not give rise to any objectively justified fear of partiality (point 20).

III. At the beginning of an appeal case where a properly constituted Board has not performed a procedural step, there are generally no circumstances that give rise to an objectively justified fear of partiality based on circumstances in a previous case (point 22).

IV. The mere fact that the member concerned gives reasons and explanations of the reasons, which go beyond the facts, in response to an invitation under Article 3(2) RPBA does not give rise to an objectively justified fear of partiality under the objective test (point 27).

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Summary of facts and submissions

I. This decision results from a procedure under Article 24(3) EPC initiated by the patent proprietor's objection of suspected partiality against the chairman of the Board 3.X.X.

II. The objection, filed in a letter, dated 16 September 2004, was based on alleged procedural errors that occurred in oral proceedings in case T XXX/XX before the same Board in a different composition, but having the same chairman.

The proprietor also alleged that the effect of a lawsuit filed at the Verwaltungsgericht in XXX, having as its main request to set aside decision T XXX/XX and, as an auxiliary request, to declare that the decision had no legal effect in Germany, also gave rise to suspected partiality.

The proprietor made similar objections in its six other pending appeal cases before the same Board in various compositions, but having the same chairman and/or rapporteur.

III. The Board in the composition responsible for the appeal considered the objection admissible. For the purposes of taking the decision on suspected partiality, the chairman was replaced by his alternate.

IV. The Board in its new composition invited, pursuant to Article 3(2) RPBA, the chairman to present comments as to whether there was a reason for exclusion. The chairman duly provided comments.

V. Following a communication from the Board inviting the parties to present any further comments, the proprietor filed an auxiliary request for oral proceedings.

VI. In reply to the communication accompanying the summons to oral proceedings, stating that the objection against partiality under Article 24(3) EPC would be the sole subject of the oral proceedings, the proprietor argued that the chairman's comments in response to the invitation under Article 3(2) RPBA gave rise to further reasons for suspected partiality.

In a reply, the opponent considered that the proprietor's objection of suspected partiality was not founded, and stated that he would not be attending the oral proceedings.

VII. Oral proceedings were held in the present case and the six similar cases on the 17 and 18 March 2005. After opening the oral proceedings, the public was excluded in view of Rule 93(a) EPC. At the end of the oral proceedings, the public was readmitted and the decision was given.

VIII. The proprietor argued as follows:

(1) Article 24 EPC was an indispensable provision because the boards of appeal were the last level of jurisdiction for a European patent and there was no possibility of judicial review of the boards' decisions.

The Enlarged Board of Appeal had this in mind when they emphasised the strict observance on the requirement of impartiality in G 5/91.

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This was essential in a properly working judicial system because a party must feel that justice has been done.

(2) The present situation was not one where a party was resorting to allegations of partiality because the prospects in a particular case were bad. On the contrary, the proprietor felt that it had good prospects in its seven cases pending before Board of Appeal 3.X.X. Furthermore, the proprietor was not interested in reviewing the decision in case T XXX/XX, which had already been decided.

(3) In an objection of "suspected" partiality, it was not relevant at all whether the objected members were actually partial or not. What mattered was the perspective of a reasonable party, which in this case, was the proprietor because it had the loss of the patent at stake.

(4) The objection did not call the competence of the members concerned into question, or imply that they would deliberately set out to disadvantage the proprietor, or that there was any element of personal bias. The allegation was merely that the members could not remain unaffected by the overall situation arising from events triggered by the case T XXX/XX.

(5) There were three aspects to the present situation:

(i) The events that occurred in oral proceedings in case T XXX/XX.

(ii) The pending lawsuit filed at the Verwaltungsgericht XXX by the proprietor against the EPO (XXX lawsuit).

(iii) The chairman's comments in response to the invitation under Article 3(2) RPBA (chairman's comments).

Oral proceedings in case T XXX/XX

(6) At oral proceedings in case T XXX/XX, the main request and the first auxiliary request, consisting of a combination of granted claims 1, 19 and 20, were found not to meet the requirements of the EPC. Towards the end of the oral proceedings, the proprietor submitted a second and third auxiliary request further adding the features of granted claims 3, 8, and 9 to the first auxiliary request (the second auxiliary request not containing claim 20).

(7) The Board exercised its "discretion" not to admit the second and third auxiliary requests. The Board also refused to refer the case to the Enlarged Board of Appeal, and to adjourn the proceedings. Thus the Board set aside the decision of the opposition division and revoked the patent.

The Board did this despite the fact that the requests were clearly allowable and constituted the proprietor's last chance to achieve maintenance of the patent.

(8) Amendments combining features from sub-claims were not the same as amendments adding features from the description. An opponent, who had opposed the patent in full, should be in a position to discuss such requests at the oral proceedings. Moreover, such claims did not require a further search. If such requests were not admitted, the proprietor may lose the patent completely for formal reasons. This was his last chance because there was no possibility for judicial review.

(9) There was no proper basis in the EPC for rejecting such late-filed requests. Article 114(2) EPC only concerned facts or evidence and could not form the basis for rejecting requests filed in oral proceedings. The complete loss of

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rights was too severe a penalty to defer to the rules, such as Rule 71a(2) or Rule 57a EPC. Even these rules did not give a clear guidance on how to deal with such "late-filed" requests.

(10) Furthermore, there was no case law supporting such a discretion to reject late-filed requests consisting of combinations of granted claims. Rather the opposite was true. In particular, T 577/97 - Destruction of organohalogen compounds/ALLIEDSIGNAL (not published in OJ EPO) stated that "in general an opponent should be prepared that, as a defence against his attacks, claims are limited during oral proceedings to subject matter of one of the dependent claims", and "if it turns out that the amended set of claims fulfils the requirements of the EPC their rejection on procedural grounds seriously harms the patentee", and "the patentee is normally given an opportunity to limit his claims even at oral proceedings, so that he is given a last chance to obtain a patent".

(11) The procedure followed in T XXX/XX (supra) contradicted even the precedents of Board 3.X.X itself. For example, in the forty-two cases cited in Appendix 7, filed with the proprietor's response to the summons to oral proceedings, the Board with the same chairman accepted late-filed documents, late-filed claims or late-filed requests without the slightest hesitation.

(12) These procedural errors exceeded the limits of normal errors and had to be considered as "arbitrary" acts. The proprietor could discern no reason that could explain this decision that deviated from the case law of the EPO in such an obvious way.

It was a long-standing legal tradition in the legal theory and practice of the member states that serious procedural errors could establish disqualifying partiality (eg see Vollkommer in the commentary *Richard Zöller*, "Zivilprozessordnung", 24th edition, Köln: Verlag Dr. Otto Schmidt, 2004, §42, note 24).

If there was a reason for such acts, it had to be one that had nothing to do with the legal proceedings, but with the proprietor itself. The proprietor had to assume that the Board was deliberately harming it by eliminating a clearly allowable part of the patent for purely formal reasons in the knowledge that there was no possibility of judicial review. This led to the feeling that the members might be biased against the proprietor. It was an essential ingredient of the legal system that the patent proprietor must feel that it had a fair chance at oral proceedings, which was not the case after the events in T XXX/XX.

The XXX lawsuit

(13) The XXX lawsuit against the EPO was triggered by the events that occurred in T XXX/XX, and pointed out the weaknesses of the European patent system that this case exposed.

(14) The first weakness was the potential disproportionate loss of rights as a result of not admitting late-filed requests consisting of combinations of granted dependent claims. The unjustness of this situation could be illustrated as follows (see XXX lawsuit in Appendix 4 of the proprietor's letter of objection, point B, IV): The proprietor applied for a patent and was granted 100%. The opposition division allowed 80% of it. From the Board, the proprietor got 0%, for the reason that the request for 60% was filed too late.

(15) The second weakness was that there was no proper basis in the EPC for the complete loss of the proprietor's rights (see above and explanation in the XXX lawsuit: point D, II, 1), which led to an unpredictable practice in the EPO.

If requests combining granted claims might not be accepted, the proprietor would be obliged to file many auxiliary requests in advance to be sure that they would be admitted into the proceedings.

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(16) The combination of events in T XXX/XX and the filing of the XXX lawsuit represented a wide ranging and serious attack on the whole system of the European Patent Convention. The EPO was a party to this lawsuit and was necessarily involved and affected by its outcome. Members of the Board involved in T XXX/XX would not have appreciated this course of action. Thus the chairman's comment (conclusion under Reason (ii)) in the reply to the invitation that the "Board cannot be concerned by a lawsuit against the European Patent Office or its President" could not be true.

In particular, the members objected to must be concerned because their actions triggered the situation. A reasonable party must, all the more so, have considered that the members would be affected.

(17) Regarding the prospects of the lawsuit, it was not the case that it had no chance whatsoever as could be inferred from the chairman's comments (conclusion under Reason (ii)). In fact, the Verwaltungsgericht had already issued a summons to oral proceedings for 14 April 2005. This showed that it was not a frivolous or vexatious lawsuit. On the contrary, a pending lawsuit with a scheduled oral proceedings was a serious matter.

(18) The stage reached by the lawsuit also showed that the present situation was not one that could have been manufactured by the proprietor with the aim of bolstering the objection of suspected partiality or manipulating the composition of the Board, as could also be inferred from the chairman's comments (Reason (ii), second paragraph). In any case, as mentioned before, the proprietor had no interest in doing this because there was no reason to doubt its prospects in the seven pending cases.

(19) The above also showed why the present situation was not a "normal" case of an appeal against a point of law decided by a first instance as asserted in the chairman's comments (Reason (ii), third paragraph). In fact, it was not even clear how the situation would end, and until it did, there would always be an element of conflict. The chairman could, for example, be summoned as a witness in the German proceedings.

Comments under Article 3(2) RPBA

(20) Article 24 EPC foresaw two different situations: exclusion and objection. Firstly, under paragraph 1, exclusion ex officio of a member of the boards of appeal for specific reasons, primarily having a personal interest or having been involved in the decision under appeal. Secondly, under paragraph 3, objection by a party if it suspected a member of a board of partiality.

Article 24 EPC provided two procedural alternatives. Firstly, under paragraph 2, the member concerned could inform the Board of a reason for exclusion. Secondly, under paragraph 3, a party may object to either situation if it had reasons.

Article 3(1) RPBA gave a third procedural possibility, namely that the Board itself may provide a reason for exclusion or objection. This also triggered the procedure under Article 24(4) EPC.

(21) Article 3(2) RPBA stated that "the member concerned shall be invited to give reasons for exclusion". This concerned explicitly exclusion and not objection. Thus, in the present case, which concerned an objection of suspected partiality and not an exclusion, the member concerned should not even have been asked to comment on the reasons.

(22) In some cases, it may be necessary to consult the concerned members to clarify facts before deciding on exclusion or objection. Nevertheless, in the present case, the chairman did not restrict himself to commenting on the facts surrounding T XXX/XX, but gave a legal opinion on the merits of the case, tantamount to directing the deciding board in its decision. The style of the comments was more like that of a lawyer presenting a case in which only the facts supporting the conclusion were emphasised. The comments were thus not factual but more of a personal

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opinion. This was not contemplated in the invitation under Article 3(2) RPBA. It was also contrary to Article 24(4) EPC, which stated that the member concerned may not take part in the decision. Finally, it was well settled case law in the member states that the judge objected to had to deliver only a statement on the facts. Regarding the German civil procedure, this could be seen from the commentary of Vollkommer in *Zöller* (supra, §44, note 4).

(23) This was particularly apparent from the following parts of the chairman's comments:

(a) "In my view, there is no reason for excluding me from further acting as chairman of Board 3.X.X in case" (opening paragraph). This was not factual and expressed a conclusion and personal opinion.

(b) "... the patentee has taken a procedural step after that decision ..., ie while being aware of the reason for objection, thus rendering the objection inadmissible pursuant to Article 23(3), second sentence EPC." (point 2). This was not at all factual, but represented a direction to the deciding Board. This went against Article 24(4) EPC, which required that the deciding Board must decide without the participation of the member concerned.

(c) "Firstly, the lawsuit was initiated by the patentee itself and not by the Board, ie it is not an action falling within the responsibility of the Board. Thus, any suspicion of impartiality could not be derived from the actual behaviour of any member of the Board." (Reason (ii), second paragraph). This implied a kind of allocation of blame for starting the lawsuit, as well as alluding to the fact that the proprietor could "create" the reason for the objection and thus influence the composition of the Board.

(d) "The Board cannot be concerned by a lawsuit against the European Patent Office or its President (irrespective of whether or not such a suit before national courts is admissible at all) ..." (conclusion under Reason (ii)). This implied that the XXX lawsuit had no chance of success and was, thus, not a serious endeavour.

(24) No reasonable party would be comfortable with such an opinion. In particular, the chairman showed an interest instead of remaining indifferent, which was what a judge should ideally have done. This would give rise at least to the suspicion that the chairman could be biased against the party. Moreover, if the deciding Board accepted the chairman's reasoning, the proprietor would have the negative impression that this reasoning had swayed the decision.

(25) Furthermore, the views expressed in this "legal opinion" reinforced the other aspects of the present situation. In particular, they indicated to the proprietor that the objection to procedural errors raised in the XXX lawsuit would affect the chairman's views about the party.

(26) Thus a reasonable party looking at the complete chain of events starting with the fundamental violation of the proprietor's rights to amend its patent, the allegation of this in a German court with all the possible ramifications, such as oral proceedings, board members being summoned as witnesses and the inherent uncertainty of the outcome of further instances, and finishing with the chairman's reply showing an interest in the case, going beyond the facts and directing the Board how to decide, cannot expect an unbiased treatment. This must meet the standard of "suspected" of partiality required by Article 24(3) EPC.

IX. The opponent argued as follows:

(1) The proprietor's reliance on the commentaries on German civil law was not appropriate. Article 125 EPC provided for the reference to general procedural provisions only in the absence of such provisions in the EPC, which was not the case here because of Article 24 EPC. Moreover, the proprietor had not shown that the principles of the German law relied on were generally recognised in the contracting states. Even for Germany, the answer to the question of whether the members objected to may voice legal opinions varied from commentary to commentary.

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(2) It was not otherwise apparent how the chairman's legal comments about the procedure could lead to a suspicion of partiality. The chairman had simply set out the procedural steps that had been taken and why he considered them to be correct. The present Board was in no way bound by this opinion, but was free to decide for itself.

Reasons for the decision

Competence of the Board

1. The Board in the composition responsible for the appeal considered the objection of suspected partiality as admissible under Article 24(3) EPC. The Board had thus to apply the procedure of Article 24(4) EPC and to decide the action to be taken (T 1028/96 - Suspected partiality / DU PONT DE NEMOURS, published in OJ EPO 2000, 475, see points 1 f. of the Reasons).

2. Pursuant to Article 24(4), second sentence, EPC, the member objected to (chairman) was replaced by his alternate, by the correct application of Article 2(1) of the Business distribution scheme for the Technical Boards of Appeal for the year 2004 (see Supplement to Official Journal No. 1 / 2004).

3. The Board in the present composition is hence competent to sit and decide on the objection made on the grounds of suspected partiality.

The test for partiality

4. Article 24 EPC stipulates a variety of reasons why a member of a board of appeal shall not, or might not be able to, take part in an appeal. Thus in paragraph 1:

"Members of the Boards 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."

In paragraph 2:

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

In paragraph 3:

"Members of the Boards of Appeal ... may be objected to by any party for one of the reasons mentioned in paragraph 1, or if suspected of partiality. ..."

5. The present Board agrees with the proprietor that the Enlarged Board of Appeal set out the importance of the requirement of impartiality implied by the provisions of Article 24 EPC in G 5/91 - Appealable decision/DISCOVISION (OJ EPO 1992, 617), which states at point 3 that "a very strict observance of this requirement is particularly important in proceedings before the Boards of Appeal and the Enlarged Board of Appeal in view of their judicial functions at supreme level within the European system of patent law".

6. Concerning the criteria for judging whether there is partiality, the Enlarged Board in G 5/91 (supra) went on to say at point 3 that "it must ... be considered as a general principle of law that nobody should decide a case in respect of which a party may have good reasons to assume partiality."

Similarly G 2/94 - Representation/HAUTAU II (OJ EPO 1996, 401) states at the end of point 5, in connection with national restrictions on judges subsequently working in private legal practice, that "The existence of such restrictions reflects the generally recognised principle of law that parties to legal proceedings are entitled to a fair hearing before judges that cannot reasonably be suspected of partiality."

7. A number of decisions of the boards of appeal go on to emphasise the point that what matters is not just whether the member objected to is in fact partial, but solely whether "good reasons" or "reasonable grounds" objectively exist to suspect a member of partiality (see T 261/88 - Appealable decision/DISCOVISION, OJ EPO 1992, 627 at point 3.2, T 433/93 - Rehearing/ATOTECH, OJ EPO 1997, 509 at point 2 or T 1028/96, supra, at point 6.1). The requirement for "objective" and "reasonable" grounds means that, notwithstanding the strict observance of the requirement of impartiality stated in G 5/91, purely subjective impressions or vague suspicions are not enough (see T 954/98 - Ablehnung wegen Besorgnis der Befangenheit, not published in OJ, at point 2.4 or T 261/88, supra, at point 3.2).

8. In the present case, the proprietor's objections and arguments involve a rather complex combination of possible sources of partiality; taking certain procedural steps being an "arbitrary" act or, alternatively, deliberately harming the proprietor (see point VIII(12) above), reactions to criticism producing bias against the party (see point VIII(16) above), appearing as witnesses in a civil lawsuit leading to a conflict of interest (see point VIII(19) above), commenting on the proprietor's objections directing the deciding Board (see point VIII(22) above) and showing bias against the party (see point VIII(24) above), and so on. Moreover, the Board sees something of a contradiction in terms in the proprietor's reassurances that there is no actual bias (see point VIII(4) above) and the proprietor's actual objections, some of which imply that the member concerned must be biased against the proprietor.

9. The various objections mentioned above do not fit in neatly under the possible reasons for partiality given in Article 24 EPC, which specifies only a few reasons and leaves open other possible reasons, in particular by using the formulation "for any other reason" in paragraph 2. There is thus a need to explore the nature of partiality in more detail in order to derive criteria for judging it. There are two distinct aspects of partiality involved in the proprietor's objections and the situations envisaged by Article 24 EPC. Firstly, partiality for subjective reasons, ie an actual partiality on the part of the member, for example due to a personal interest or a dislike of a party. Secondly, a suspicion or appearance that there is partiality, which would be derived by an "objective observer" from a particular action of a member, or an assumed response to a proprietor's action.

Actual partiality is an internal characteristic of the member himself and its presence is clearly objectionable because it goes against the principle of a fair trial. However, suspicion and appearances are not enough to show actual partiality. This is because it is a fundamental duty of a member of a board of appeal acting in a judicial capacity to take decisions objectively and not be swayed by personal interest or other peoples' comments or actions. Indeed, this principle is explicitly contained in the solemn declaration taken by members of the boards of appeal at the time of their inauguration. Thus, personal impartiality of a member of a board of appeal is to be presumed until there is proof to the contrary.

On the other hand, the appearance of partiality involves external aspects and reflects, regardless of whether the member is actually biased or not, the confidence that the Board inspires in the public; as the old adage goes – "Justice must not only be done; it must be seen to be done" (see also T 900/02, not published in OJ, at point 4). Since this aspect of partiality relates to appearances it does not need to be proved in the same way as actual partiality, but the circumstances must be judged to see whether they give rise to an objectively justified fear of partiality. This essentially corresponds to the "objective" and "reasonable" grounds identified above in the case law of the EPO.

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10. The above is in line with generally acknowledged procedural principles in the contracting states, eg the jurisprudence of the European Court of Human Rights (ECHR). This court has ruled extensively on Article 6, paragraph 1 of the Convention for the Protection of Human Rights and Fundamental Freedoms (EHRC), which provides that "in determination of his civil rights ..., everyone is entitled to a ... hearing ... by an ... impartial tribunal" The ECHR has interpreted impartiality in this provision in terms of the above-mentioned two aspects since *Piersack v. Belgium* (1 October 1982, Series A, No. 53, p. 14, para. 30) and it was stated recently in *Puolitaival and Pirttiäho v. Finland* (23 November 2004, No. 54857/00, para. 41).

11. The question arose in the present case as to who has to judge the reasons potentially giving rise to the fear of partiality. The proprietor considered that it should be the party making the objection because only this party has something at stake, eg the loss of the patent, and must feel that it is being considered fairly. However, the Board judges that the issue of partiality should not depend on what is at stake because this standard would vary between cases, whereas the fear of partiality is judged from an objective point of view and implies a fixed standard. Otherwise, it would mean that when there was much at stake a mere hint of suspicion would be enough to justify the fear of partiality. Thus the deciding Board judges whether the overall circumstances of the case give rise to an objectively justified fear of partiality. This conclusion is in line with the ECHR case law, for example, *Puolitaival and Pirttiäho v. Finland* (supra) at point 42, which states that "the standpoint of the person concerned is important but not decisive".

12. Thus, the existence of partiality must be determined on the basis of the following two tests, one for each of the aspects identified above by the Board:

Firstly, a "subjective" test requiring proof of actual partiality of the member concerned.

Secondly, an "objective" test where the deciding Board judges whether any circumstances of the case give rise to an objectively justified fear of partiality.

13. Applying the above tests to the present case, the Board must determine whether there is either any proof of actual bias (subjective test), or any circumstances that give rise to an objectively justified fear of partiality (objective test) for each of the various aspects raised by the proprietor.

Subjective test

Oral proceedings in T XXX/XX

14. The proprietor alleges that the non-admission of the auxiliary requests in case T XXX/XX was a procedural error that can only be explained by an intent to harm the proprietor, ie partiality (see point VIII(12) above). However, no proof has been offered that the chairman of the Board was actually biased. On the contrary, the proprietor repeatedly stressed that it was not being alleged that any member of the Board in T XXX/XX made any personal comments or showed any personal dislike or bias (see point VIII(4) above). Thus there is no proof of partiality, and thus no partiality under the subjective test.

The XXX lawsuit

15. The only part of the lawsuit that could apply directly to the chairman in the present case relates to the alleged improper application of the discretion to reject late-filed requests, and even then it only applies to the Board's decision as a whole and not directly to any particular member. The kind of prejudice that comes to mind as a result of the allegations would have to derive from irritation or annoyance at one's actions being publicly criticised (see point VIII(16) above). However, the proprietor has offered no proof of such a reaction, as required by the subjective

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test. On the contrary, as mentioned above, the proprietor went to great lengths to point out that the criticism in the present case was not of a personal nature, but was against the jurisprudence of the EPO as a whole. Furthermore, it is not uncommon that decisions of boards of appeal are criticised in public, such as in legal commentaries or articles. Specifically naming members who participated in a criticised decision would not significantly alter this situation, especially in the absence of personal attacks. Thus, the present Board judges that presuming a subjective bias as a reaction to such criticism falls a long way short of proving it as required by the subjective test.

16. Another possible subjective aspect could be the chairman's behaviour if summoned as a witness before the Verwaltungsgericht (see point VIII(19) above). However, since this has not happened, it cannot be proof of partiality as required by the subjective test.

Chairman's comments

17. As a preliminary point, the proprietor argues that Article 3(2) RPBA does not apply to cases where the member concerned has been objected to by a party under Article 24(3) EPC (see points VIII(20)-(21) above). The present Board considers that it is not entirely clear what Article 3(2) RPBA applies to. On the one hand, the provision follows directly after Article 3(1), which deals with the case where the reason for exclusion or objection (only "Ausschließungsgrund" in the German version) originates from the Board, but not the member concerned. Furthermore, as pointed out by the proprietor, Article 3(2) uses the words "reason for exclusion" and not objection. On the other hand, the final provision of Article 3, namely Article 3(3), is the general statement that there shall be no further proceedings in the case before a decision is taken on the exclusion of the member, which must apply to all cases of exclusion and objection. Finally, the French version of Article 3 RPBA uses only the single word "récusation" to cover both exclusion and objection, so that Article 3(2) could apply to either case. However, the present Board does not consider it necessary to analyse which cases of partiality are subject to the mandatory invitation to comment under Article 3(2) RPBA since, as the proprietor conceded (see point VIII(22) above), it may make sense to invite a member to comment on reasons in a variety of situations if the Board considers this useful. This is what happened in the present case.

18. Applying the subjective test to the chairman's comments in the response to the invitation, the present Board judges that there is nothing in the words used that proves that there is any partiality. The Board judges that the passages where the proprietor sees particular problems (see point VIII(23) above) are all neutral summaries of the chairman's opinion, for example that there is no reason for exclusion, or that the filing of the lawsuit by the proprietor cannot imply partiality on the part of the Board, or that the issues in the XXX lawsuit, which could turn out to be inadmissible, have no effect on the present case. Thus, the Board finds no proof of partiality, required by the subjective test, in the language of the comments.

Similarly, the Board finds no proof of disqualifying "interest", eg in the sense of "personal interest" mentioned in Article 24(1) EPC, in these comments as alleged by the proprietor (see point VIII(24) above).

19. Nevertheless, the present Board imagines that there could be circumstances in a case where comments from the member concerned about a previous or a pending case could be proof of personal bias and thus partiality. Thus, the content and wording of such comments should be chosen carefully. For similar reasons, where the mandatory invitation under Article 3(2) RPBA does not apply, it should be carefully considered whether such comments are actually required.

Objective test

Oral proceedings in T XXX/XX

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20. The proprietor alleges that the non-admission of the auxiliary requests in case T XXX/XX was an "arbitrary" act, such a serious procedural error directly establishing partiality (see point VIII(12) above). However, the present Board judges that, in the absence of exceptional circumstances, any procedural error of this kind would relate simply to flaws in the steps that the Board necessarily has to take to reach a decision, and would not *per se* relate to any aspect of partiality. Thus, not admitting amended claims, regardless of whether the Board has correctly used its power or discretion to do so, would not give rise to an objectively justified fear of partiality.

21. Moreover, the present Board does not consider that there was any procedural error or exceptional circumstances in T XXX/XX.

Contrary to the proprietor (see point VIII(10) above), the Board considers that according to the case law of the EPO there is a discretion when allowing late-filed claims in appeal proceedings (see Chapter VII.D.14, entitled "Filing of amended claims in appeal proceedings", in the book "Case Law of the Boards of Appeal of the European Patent Office", 4th edition 2001).

Furthermore, it is apparent from section 14.2 of this chapter that the exercise of this discretion is subject to relatively well-defined criteria. These criteria concern the time of filing, the difficulty of examination and the reasons for late filing. Similarly, the present Board cannot agree with the proprietor's allegation (see point VIII(12) above) that the application of the Board's discretion in T XXX/XX was an "arbitrary" act. The decision in T XXX/XX discusses at length at point 13 the situation surrounding the second auxiliary request. Among other aspects, the decision determines that the request was late, was not accompanied by any reasons for the lateness and was considerably different from previous requests. These aspects correspond directly to those required by the case law cited above. The third auxiliary request was rejected for the same reasons.

The Board therefore judges that the procedures adopted in case T XXX/XX did not deviate from the provisions of the EPC, or the Rules of Procedure or the case law of the Boards of Appeal, and, hence, in themselves cannot give rise to any objectively justified fear of partiality.

22. Furthermore, the present Board sees a fundamental difference between alleging actual partiality in a case based on circumstances in a previous case, and voicing a fear of partiality based on circumstances in a previous case. Actual partiality persists in time, whereas the circumstances relevant for the fear of partiality generally vary from case to case and therefore do not necessarily persist. In particular, at the beginning of an appeal case where a properly constituted Board has not performed a procedural step, there are generally no circumstances that give rise to an objectively justified fear of partiality. Otherwise all cases could be prone to such objections. Moreover, allowing such objections would have the undesirable side effect of re-analysing the reasons in a previous case and possibly effectively overruling the previous decision.

The Board also notes that none of the cases described in the section of the commentary on German civil procedure cited by the proprietor (see point VIII(12) above) appear to relate to the situation of raising objections based on procedural acts in previous cases either.

23. The situation might be different if the circumstances involve a systematic misapplication of the law against the same party in more than one case, and thus only apparent in combination with another case. However, this is not the situation here as the proprietor is relying only on the circumstances in the single case T XXX/XX. Nevertheless, the proprietor attempted to show such a systematic bias a contrario by providing a list of cases, which allegedly show that the Board with the same chairman accepted late-filed requests in other cases "without the slightest hesitation" (see point VIII(11) above). However, the Board notes that in two of the cases (T XXX/XX and T XXX/XX), the requests that were allowed were actually filed by the present patent proprietor.

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24. Thus, the present Board judges that the circumstances of the present case, which involve a question of discretion in a different and remote case, and in which a properly constituted board has not yet performed a procedural step, do not give rise to an objectively justified fear of partiality.

The XXX lawsuit

25. EPO proceedings are separate from those of the Verwaltungsgericht and the present Board sees no possible connection between them and thus no reason for an objectively justified fear of partiality.

Chairman's comments

26. The present Board judges that, notwithstanding the content, the mere act of commenting in response to an invitation to do so cannot give rise to an objectively justified fear of partiality.

27. Concerning the allegation that the comments go beyond the facts (see point VIII(22) above), the present Board sees no formal limits on what the member concerned may say. The present Board judges that the chairman was simply following the invitation and giving his reasons and explanations of the reasons, which does not indicate any partiality. Moreover, the proprietor's reliance on the commentaries on German civil procedure is not decisive because the commentaries appear to vary in opinion on this point, as stated by the opponent (see point IX(1) above).

28. Concerning the presence of comments on legal issues, the present Board notes that the objection of partiality stems from an alleged lack of a legal basis for the discretion to reject late-filed requests which is a legal objection. Thus, in this case, the facts underlying the objection have a legal dimension so that it is not unusual if legal issues are mentioned.

29. The present Board agrees with the proprietor (see point VIII(22) above) that the chairman does draw certain conclusions from these facts, which obviously represent possible decisions of the deciding Board. However, decisions of the present Board are not relevant to the partiality of the members in the Board in its original composition. In any case the chairman's comments do not amount to "participation of the member concerned" in the sense of Article 24(4) EPC, which relates to deliberation and voting according to Articles 14 and 15 RPBA. Rather, the Board agrees with the opponent (see point IX(2) above) that the present Board is in no way bound by this opinion, but is free to decide for itself. Thus, there is no reason for an objectively justified fear of partiality in the decision under Article 24(4) EPC either.

30. Finally, the "interest" being alleged by the proprietor (see point VIII(24) above) is at most an interest in the correct interpretation of the facts of the previous case T XXX/XX, ie an abstract professional interest. The Board judges that such an interest is not unexpected from a chairman of a board of appeal, and does not give rise to an objectively justified fear of partiality.

31. In conclusion, the present Board finds that none of the events raised by the proprietor demonstrate partiality on the part of the chairman under either the subjective or the objective test. The present Board therefore sees no reason to allow the proprietor's objection.

Order

For these reasons it is decided that:

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The objection of suspected partiality against the original chairman of the board is refused.