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**Datasheet for the interlocutory decision
of 2 October 2014**

Case Number: T 1938/09

Application Number: ...

Publication Number: ...

IPC: ...

Language of the proceedings: EN

Title of invention:
...

Patent Proprietor:
...

Opponents:
...

Headword:
Objection for suspicion of partiality

Relevant legal provisions:
EPC Art. 10(2)(f), 10(3), 21(1), 23(3), 24, 112, 112a, 116(4)
EPC R. 12(5), 106
RPBA Art. 3, 21

Keyword:
"Suspected partiality (no)"

Decisions cited:
R 0019/12, R 0012/09

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 1938/09

I N T E R L O C U T O R Y D E C I S I O N
of Technical Board of Appeal
of 2 October 2014

Appellant: ...
(Patent Proprietor)

Representative: ...

Respondent: ...
(Opponent 1)

Representative: ...

Respondent: ...
(Opponent 2)

Representative: ...

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on XXX revoking
European patent No. XXX pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman M. C. Ortega Plaza

Members: H. Kellner

 R. Cramer

Summary of Facts and Submissions

- I. European patent No. 0 964 677, based on international application No. PCT/US1998/003584, published as WO 1998/036728 (European application No. 98 906 678.2), was granted with sixteen claims.
- II. Oppositions were filed against the granted patent.
- III. By its decision posted on 24 July 2009, the opposition division revoked the patent under Articles 101(2) and 101(3) (b) EPC.
- IV. The patent proprietor lodged an appeal against that decision.
- V. By letter of 6 May 2014 the appellant filed an objection under Article 24(3) EPC to the members of the board on the ground of suspected partiality "in the event that any member of this appeal board has acted or is acting as the appointed substitute of VP3 in the course of these appeal proceedings".

The oral proceedings originally scheduled for 8 May 2014 where thereupon cancelled.
- VI. By letter dated 15 May 2014 the board summoned the parties to oral proceedings to be held on 1 and 2 October 2014 and issued a communication pursuant to Article 15(1) Rules of Procedure of the Boards of Appeal (RPBA). It questioned the admissibility of the objection, and stated that at the oral proceedings it would decide on the admissibility in its original composition.

VII. Observations on the admissibility of the objection were filed by the appellant in its letter of 20 June 2014 and by respondent 01 in its letter of 6 August 2014. The appellant, by letter of 28 August 2014, restricted its objection under Article 24(3) EPC to the Chairman of the board. The objections to the other members of the board were not maintained.

By fax of 19 September 2014 the appellant filed inter alia conditional requests for the referral of questions to the Enlarged Board of Appeal (EBA) and for a stay of the proceedings. The board issued a further communication on 24 September 2014, in which it expressed the preliminary view that the objection now restricted to the Chairman of the board was admissible.

VIII. On 1 and 2 October 2014, oral proceedings took place before the board. As far as the Article 24 EPC related issues were concerned, the board decided in accordance with Article 116(4) EPC that they were not public.

After the board in its original composition had heard the parties and deliberated on the matter, the Chairman announced that the board had decided that the objection under Article 24(3) EPC against him was admissible, and that he would be replaced by an alternate to decide on the objection.

IX. Before resumption of the oral proceedings by the board in its alternate composition, the Chairman objected to was invited to provide his comments in accordance with Article 3(2) RPBA.

After resumption, a copy of his response was handed out to the parties; in this letter the Chairman objected to stated that he did not wish to make any comments.

X. Thereupon, the appellant filed two objections under Rule 106 EPC in conjunction with Article 112a(2) (c) EPC. "Objection 1" related to the time given to prepare a reaction to the response of the Chairman objected to as being not sufficient. "Objection 2" related to the appellant's right to be heard since the comments of the Chairman objected to provided no clarification of facts.

Objection 1:

"The patentee considers its right to be heard violated by the fact that the Board gave the Patentee only 30 minutes to react to the document dated October 1st, 2014 provided by the objected-to member and handed over during oral proceedings of October 1st, 2014 despite the Patentee's indication that it would require at least 1 hour in view of the complex legal situation arising from said document."

Objection 2:

"The document dated October 1, 2014 provided by the objected-to member and handed over in the oral hearing of October 1, 2014 comprises no statement on the facts regarding the objection for suspicion of partiality. In case that the objection for suspicion of partiality is rejected, this leads to a violation of the Patentee's right to be heard."

After discussion and deliberation, these objections were dismissed by the board.

- XI. The appellant requested that Question 1 on page 13 of its letter of 19 September 2014 be referred to the Enlarged Board of Appeal.

Referral question 1:

"Is an objection under Art. 24(3) EPC against a member of a Board of Appeal justified for the sole reason that, during the course of the appeal proceedings, the objected-to member in addition to the judicial function holds or has held an administrative position in the European Patent Office, provided that such dual function is not required by law, in particular when the objected-to member holds or has held the position of deputy of Vice President in charge of the Boards of Appeal?"

- XII. The appellant sought to submit a copy of a letter of the Vice-President of DG3 (VP3) dated 26 September 2014 and a copy of a fax from the appellant to VP3 dated 1 October 2014. The Board exercised its discretion not to admit these letters into the proceedings and they were given back to the appellant.

- XIII. On the afternoon of 1 October 2014 the appellant filed a new objection under Article 24(3) EPC to the original Chairman of the board.

The wording of the new objection under Article 24(3) EPC was:

"We herewith object under Art. 24(3) EPC to the already objected-to chairman of the Board of Appeal for suspicion of partiality based on the fact that the objected-to chairman refuses to provide substantive and complete comments on the facts at issue, including

disclosure of relevant facts within his own knowledge in response to the invitation under Art. 3(2) RPBA. By not providing such a response, the objected-to chairman prevents a clarification of the facts. This gives rise to a new and separate objection for suspicion of partiality."

The appellant stated that it held the present board to be competent to deal with this objection.

The document was admitted into the proceedings and the board declared that it would deal with the objection within the framework of the already pending proceedings under Article 24(4) EPC.

XIV. The appellant, on 2 October 2014, filed a reasoned written request to return to written proceedings. Furthermore, the appellant requested the referral of a question to the Enlarged Board of Appeal and submitted this question in writing:

Referral question 2:

"a) If an objected-to member is invited according to Art. 3(2) RPBA to present his comments as to whether there is a reason for exclusion: Should Art. 3(2) RPBA, in light of the general principles of law, be interpreted such that the objected-to member has a duty to cooperate, in particular by providing substantive and complete comments on the facts at issue, including disclosure of relevant facts within his own knowledge?

b) Does the answer to question a) depend on whether the objected-to member is objected to because of "subjective" or "objective" reasons?

c) If the objected-to member does not make any substantive comments in response to an invitation according to Art. 3(2) RPBA, is it then, under Art. 3(1) RPBA, up to the Board applying the procedure of Art. 24(4) EPC to inform the parties on the facts at issue (to the extent that the Board has knowledge of these facts or can ascertain them) and give the parties an opportunity to present their comments on those facts?

d) Does the fact that the objected-to member does not make any substantive comments in response to an invitation according to Art. 3(2) RPBA substantiates the objection for suspicion of partiality brought forward under Art. 24(3) EPC?

e) Can an objection for suspicion of partiality under Art. 24(3) EPC be occasioned by an already objected-to-member responding to an invitation according to Art. 3(2) RPBA by failing to provide substantive and complete comments on the facts at issue, including disclosure of relevant facts within his own knowledge?"

The appellant's request to return to written proceedings was refused.

Relating to this refusal, the appellant filed a further objection under Rule 106 EPC, which was dismissed.

Objection 3:

"The Patentee herewith raises an objection under Rule 106 EPC in combination with Article 112a(2) (c), Art. 113 EPC because the rejection of the request to return to written proceedings amounts to a violation of the Patentee's right to be heard."

- XV. The appellant requested the referral of a further question to the Enlarged Board of Appeal and submitted this question in writing.

Referral question 3:

"Is there an obligation for the Board on a request of a party to investigate with respect to the position of a member being objected to by the party for suspicion of partiality based on his position as elected permanent deputy of VP3 in case of the objected-to member has refused to offer information on his position as the elected permanent deputy of VP3?"

If the answer to the above question is yes, is there an obligation for the Board to provide the result of the investigation to the parties in accordance with Article 113 EPC?"

- XVI. The appellant's submissions, as far as relevant for the present decision, may be summarised as follows:

Sufficient substantiation of the objection of partiality followed from the evidence on file that the Chairman objected to was a member of the Presidium and according to Rule 12(5) EPC, all members were potential deputies for VP3. Additionally, the statement of a former chairperson was on file that prior to 2010 chairpersons of technical boards of appeal deputised for the VP3 then in office, and took part in managerial meetings as the deputy of VP3.

In view of the absence of further information, the appellant had to assume that the deputy of VP3 - at least during absences of VP3 - had the same rights and

the same duties as VP3, meaning that he was under the same obligation to assist the President of the EPO in exercising his functions and powers (Article 10(3) EPC). Therefore the deputy of VP3 was subject to the reasoning set out in the Interlocutory Decision of the Enlarged Board of Appeal R 19/12 of 25 April 2014 in the same way as VP3 himself and, consequently, to the suspicion of partiality.

With regard to the question why the members of the EBA in the composition that issued interlocutory decision R 19/12 had not refrained from taking part in the decision since they were members of the Presidium and therefore potential deputies for VP3, it was to be assumed that they in fact had not been active as deputies; otherwise they would have refrained from taking part in the decision. Moreover, the Chairwoman of the alternate EBA in the case R 19/12 was the Chairwoman of the Legal Board of Appeal and substituted for VP3 as Chairperson in the Enlarged Board in that function.

Concerning other lines of argument in interlocutory decision R 19/12, the importance of decisions of technical boards of appeal was at least as high in their technical fields as that of the EBA for the whole of DG3. The technical boards often cover the whole or nearly the whole of a technical field, and in particular when taking negative decisions, i.e. refusing applications or revoking granted patents, dominated this field on the basis of their opinion without any provision for further recourse. In combination with e.g. increased pressure to handle cases more efficiently, this could have severe effects. Such pressure could be imposed on chairpersons if they were acting as the deputy of VP3.

All the more, it was very important to obtain information on the extent to which the Chairman objected to in the present case was involved in such deputising. The statement of the Chairman objected to amounted to a refusal to give evidence he would be obliged to give in view of Article 3 RPBA.

The appellant could not be prepared for not receiving detailed information and therefore needed time to prepare a reaction, in particular since, under German law, giving no information would be a ground for suspicion of partiality in itself. In addition, the lack of a detailed answer amounted to a violation of the appellant's right to be heard since there was no clarification of facts concerning the activities of the original Chairman in administrative tasks of the EPO.

Regarding the questions for referral to the EBA, two further petitions were pending that involved further objections for suspicion of partiality concerning VP3; apparently the issue of partiality was an important point of law and it was necessary to ensure uniform application of the law under Article 112(1) EPC. It was for this reason that Referral question 1 was filed.

Referral questions 2 and 3 dealt with the situation that had occurred in view of the lack of specification given in the original Chairman's response to the invitation under Article 3(2) RPBA. They also concerned important points of law to be clarified by the Enlarged Board in the absence of case law from the EPO.

XVII. The respondents' arguments, as far as relevant for the present decision, may be summarised as follows:

Contrary to the arguments of the appellant, it was clear that a substitute to the position of VP3 never had the same obligations or the same authority to issue instructions as VP3. His possible involvement in the administration of the EPO was not comparable to that of VP3 himself and all the arguments based on the interlocutory decision of the Enlarged Board of Appeal R 19/12 of 25 April 2014 failed to be applicable to his position as deputy.

Consequently, all the questions for referral and all the objections under Rule 106 EPC in conjunction with Article 112a(2)(c) EPC were rendered moot.

Reasons for the Decision

1. Where in an admissible appeal an objection under Article 24(3) EPC in respect of a board member is made by one of the parties, the board in its original composition must first decide on the admissibility of the objection (interlocutory decision R 12/09 of 3 December 2009, Reasons for the decision No. 2). An objection is inadmissible if, for example, the party has taken a procedural step while being aware of a reason for objection, or bases the objection on the nationality of the board member (Article 24(3), second and third sentences, EPC). Furthermore, the objection must be sufficiently substantiated in order to be admissible (R 12/09, Reasons for the decision No. 2).

2. The board in its original composition considered the objection of suspected partiality with respect to the Chairman to be admissible. Therefore, the Chairman was

replaced in accordance with Article 24(4) EPC for the decision to be taken on the objection.

3. The EPC does not prescribe how the board in its alternate composition has to conduct proceedings under Article 24(4) EPC, but Article 3(2) RPBA states that the member concerned shall be invited to present his comments as to whether there is a reason for exclusion. This provision requires that the member objected to must be given an **opportunity** to present his comments and thus safeguards the member's right to be heard with respect to the objection (Münchner Gemeinschaftskommentar, Art. 24, Rdn. 46; see also Benkard, EPÜ, 2. Auflage, Art 24 Rdn. 26, Singer/Stauder, EPÜ 6. Auflage, Art. 24 Rdn. 16).
- 3.1 The Chairman objected to was given the opportunity to present his comments. The Chairman replied in writing that he did not "wish to make any comments".
- 3.2 The appellant argued that Article 3(2) RPBA involved an **obligation** of the member objected to to provide a full response to the objection raised. The board cannot deduce such a general obligation from Article 3(2) RPBA. The board acknowledges that there may be cases where a board would not be in a position to decide on the objection without having received the necessary information from the member objected to. There may however also be cases where the board is indeed in a position to take a decision without having received a full response to the invitation, as in the present case, where the objection is based on the fact that the Chairman is a member of the Presidium and could therefore have been asked to deputise for VP3 (Rule 12(5), first and second sentences, EPC). The Chairman has not provided details as requested by the

appellant on whether he has deputised for VP3 during the pendency of the appeal. The provision of such details would only have been necessary if the board in its present composition considered that these details were relevant for the decision to be taken.

3.3 Furthermore, the appellant objected that during the oral proceedings it was not given sufficient time to react to the response of the member objected to, as a complex legal situation had arisen from the lack of a substantive response. The board gave the parties a 30-minute break to prepare a reaction. The board is of the view that the parties should have been prepared at the oral proceedings to receive a response under Article 3(2) RPBA that was not to their satisfaction, or that the member objected to would not make use of his right to be heard. Moreover, with the submission of 19 September 2014, the appellant filed a copy of a letter of 17 September 2014 addressed to VP3 stating that so far no statement had been made by the member objected to, citing an English Court of Appeal case, and requesting VP3 to provide information with respect to the grounds for objection. The board concludes from this submission that the appellant in fact had, prior to the oral proceedings, given consideration to the possibility that no detailed answer would be given by the member objected to.

3.4 For these reasons "Objection 1", the request to return to written proceedings, and "Objection 3", all filed during the oral proceedings, were rejected by the board. "Objection 2" was rejected as well because it was a conditional objection and not relevant at the stage of proceedings at which it was filed.

4. The objection under Article 24(3) EPC was filed on the ground that any member of the Presidium of the boards of appeal could act as a substitute for VP3. Since interlocutory decision R 19/12 found that a party could on an objective basis have doubts with respect to the impartiality of the Chairman of the EBA in his dual role as Chairman of the EBA and as VP3, a party could also suspect any chairman of a board of appeal of being partial in a pending appeal case in which he or she was involved, if at any time during the pendency of the appeal proceedings he or she had been appointed as a substitute for VP3. The objection in the present case was only upheld in the event that the Chairman had indeed acted as a deputy for VP3 during the course of the present appeal proceedings, and he was requested to make an official statement as to whether or not he was appointed as a substitute for VP3 at any stage during the appeal proceedings.

4.1 The conclusion drawn in interlocutory decision R 19/12 is based on the circumstance that the Chairman of the EBA is not only Chairman of the EBA, but is also a Vice-President and as such subject to the supervisory authority of the President of the EPO under Article 10(2)(f) EPC (Reasons for the decision, No. 14.1 in conjunction with No. 16). Moreover every Vice-President has the duty to assist the President (Reasons for the decision, No. 14.1 in combination with No. 16) which duty is expressed in the form of a specific provision of the EPC (Article 10(3) EPC) applicable to the Vice-Presidents as such.

This situation could lead to a conflict of interests, as the Chairman of the EBA is as VP3 bound by Article 10 EPC on the one hand, and plays an important role in the development of case law on the other hand,

in particular in petition for review cases, where boundaries are set as to the extent to which boards of appeal may streamline their cases. These boundaries also have an effect on the way examining and opposition divisions may act in their cases (R 19/12, Reasons for the decision, Nos. 17.1 to 17.4, in particular No. 17.3, second paragraph on page 23).

- 4.2 The appellant's objection is to be understood as meaning that when a chairman of a board of appeal acts as a deputy for VP3, he or she - as a result of this deputising - would also be subject to the supervisory authority of the President of the EPO and would have the duty to assist him in the sense of interlocutory decision R 19/12.

- 4.3 The board cannot agree with this point of view.
 - 4.3.1 The duties of board of appeal members (including chairmen) are laid down in Article 21(1) EPC. When exercising these duties, they are only bound by Article 23(3) EPC and are not subject to the supervisory authority of the President laid down in Article 10(2)(f) EPC (R 19/12, Reasons, No. 16). A chairman is furthermore not a member of the administrative hierarchy of the EPO as has been held to be VP3 (R 19/12, Reasons, No. 14.1), and the duty to assist the President mentioned in Article 10(3) EPC and specifically applicable to Vice-Presidents cannot be imposed on a chairman or acquired by way of delegation if he is deputising for VP3.

 - 4.3.2 Consequently, if board of appeal members under a former VP3 had been present in a managerial committee as a deputy of VP3, as was suggested in the letter of 6 May 2014, filed as an annex to the appellant's

submission of 6 May 2014, they would not by their mere presence have become subject to the supervisory authority of the President, nor would the duty to assist the President under Article 10(3) EPC have been imposed on them.

- 4.4 Any comparison between a board of appeal member or a chairman of a board of appeal and the position of VP3 as adjudged in interlocutory decision R 19/12 must therefore fail.
5. As a further aspect, the findings in R 19/12 are based on the role that the Vice-President as the regular Chairman of the EBA plays in petition for review cases, which have an effect on the latitude given to the boards of appeal in general (see point 4.1 above in this decision, and Reasons for the decision in R 19/12, Nos. 17.2 to 17.5).

However, the chairman of a technical board of appeal, being active in the Enlarged Board only occasionally, is not in such a position of influence.

Nor is the board convinced by the appellant's arguments as to the technical field allocated to the board of the Chairman objected to (see point XVI. above, fourth paragraph). As stated under point 4 of this decision, the duty of VP3 to assist the President under Article 10(3) EPC cannot be imposed on a chairman of a board of appeal. Therefore, it cannot be assumed on an objective basis that, if he is deputising for VP3, a chairman might be subject to pressure to take measures that would lead to cases being handled differently in his board in comparison with other boards. Additionally, there are legal mechanisms to ensure a uniform application of the law by all boards

(Article 112 EPC and Article 21 RPBA) and for review in the case of an alleged procedural violation by a board (Article 112a EPC).

6. Under these circumstances, for the question of impartiality of the Chairman of this board in its original composition it is irrelevant whether he has during the pendency of the appeal proceedings at any time deputised for VP3 during the absence of the latter. Consequently, the board is in a position to take a decision without an official statement from the Chairman on whether and, if so, on what dates he has deputised for VP3.

The further objection under Article 24(3) EPC to the Chairman based on the lack of detailed information from him, as referred to in the previous paragraph, must therefore also be rejected, since the board cannot deduce any partiality on the part of the Chairman based on his decision not to provide such internal data, which, moreover, would involve giving personal data about absences of VP3.

7. *Referral of questions to the EBA*

According to Article 112(1)(a) EPC, if a point of law of fundamental importance arises, the board must refer any question to the EBA if it considers that a decision is required for this purpose. The appellant requested that three questions be referred to the EBA. It is within the discretion of the board to decide whether a question is referred to the EBA, and a board will usually not make use of this discretion if it is in no doubt that it can resolve a point of law itself.

- 7.1 Question 1, proposed by the appellant in its letter of 19 September 2014, involves a point of law that the board was able to deal with without any doubt, in view of the fundamental difference of the position of a member or chairman of a board of appeal and the position of a Vice-President in the EPO (see point 4 above).
- 7.2 The board was also able to deal with the issues raised in Question 2, which in essence involve the interpretation of Article 3(2) RPBA (see points 3, 3.1 and 3.2 above).
- 7.3 Question 3 is irrelevant for the present case as it presupposes that the member objected to held the position of "elected permanent deputy of VP3". This, however, has no factual basis.
- 7.4 The appellant argued that a referral of one or more of these questions would also be necessary in view of Article 21 RPBA, if the board were to deviate from an interpretation or explanation of the EPC contained in EBA interlocutory decision R 19/12. As R 19/12 does not apply Article 24 EPC beyond the question whether the current VP3 can be considered impartial in the proceedings concerned, the present board is not deviating from R 19/12. The question whether Article 21 RPBA is to be read in the light of the preamble of Article 112(1) EPC and therefore as being only applicable to EBA decisions and opinions under Article 112 EPC, or as also applicable to decisions under Article 112a EPC, therefore does not need to be answered.

Order

For these reasons it is decided that:

1. The objection of suspected partiality with respect to the original Chairman of the board is refused.
2. The requests for referral of Questions 1, 2 and 3 to the Enlarged Board of Appeal are rejected.

The Registrar:

On behalf of the Chairman
(according to Art. 8(3) RPBA):



S. Sánchez Chiquero

H. Kellner

Decision electronically authenticated