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**Datasheet for the decision  
of 24 January 2019**

**Case Number:** T 1473/13 - 3.5.04

**Application Number:** 06751124.6

**Publication Number:** 1872573

**IPC:** H04N5/44, H04N7/173

**Language of the proceedings:** EN

**Title of invention:**

APPARATUS, SYSTEMS AND METHODS FOR PROVIDING IN-BAND ATSC  
VESTIGIAL SIDEBAND SIGNALING OR OUT-OF-BAND SIGNALING

**Applicant:**

Rohde & Schwarz GmbH & Co. KG

**Headword:**

**Relevant legal provisions:**

EPC 1973 Art. 83, 84  
EPC R. 137(5), 14(1), 78(1), 106  
EPC Art. 112a(2)(c), 113(1), 125, 135(1)(b)  
ECHR Art. 6(1)  
German Basic Law Art. 19(4)

**Keyword:**

Amendments of application

Amendments - amended claims relating to unsearched subject-matter (no)

Claims - all requests - clarity (no)

Sufficiency of disclosure - (no)

Competence of the boards of appeal - appeal from decision of the examining division

Stay of proceedings because of constitutional complaints pending before the German Federal Constitutional Court (no)

**Decisions cited:**

T 0166/84, T 0426/00, J 0002/14

**Catchword:**

1. Discussion of a possible general principle for staying proceedings before the EPO boards of appeal beyond Rules 14 / 78 EPC and Article 112(3) EPC, together with the associated case law.
2. The appellant has not stated a case for a stay. It has not shown, in particular, that a decision by the German Federal Constitutional Court ("Bundesverfassungsgericht") on pending constitutional complaints ("Verfassungsbeschwerden") against certain decisions of the Boards of Appeal and the Enlarged Board of Appeal claiming "insufficient judicial relief at the EPO against a decision of the Boards of Appeal" could possibly have an impact on unrelated proceedings that are pending before the boards, such as the present proceedings.



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Case Number: T 1473/13 - 3.5.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.04**  
**of 24 January 2019**

**Appellant:** Rohde & Schwarz GmbH & Co. KG  
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81671 München (DE)

**Representative:** Körfer, Thomas  
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**Decision under appeal:** **Decision of the Examining Division of the European Patent Office posted on 19 February 2013 refusing European patent application No. 06751124.6 pursuant to Article 97(2) EPC**

**Composition of the Board:**

**Chairman** C. Kunzelmann  
**Members:** B. Willems  
B. Müller

## **Summary of Facts and Submissions**

- I. The appeal is against the decision of the examining division dated 19 February 2013 refusing European patent application No. 06751124.6 pursuant to Article 97(2) EPC. The application was published as international application WO 2006/113929 A2.
- II. The documents cited in the decision under appeal included the following:
- D1: US 2004/160344 A1;
- D6: US 2004/179621 A1.
- III. The decision under appeal was based on the grounds that the independent claims of the main and the two auxiliary requests did not meet the requirements of Rule 137(5) EPC. In the section "*Further Remarks*" of the decision under appeal, the examining division noted that the independent claims of the main request did not meet the requirements of Articles 83, 84 and 56 EPC and that the independent claims of the auxiliary requests did not meet the requirements of Articles 84 and 56 EPC.
- IV. The applicant filed notice of appeal. With its statement of grounds of appeal, the appellant submitted claims according to a third auxiliary request. It requested that the examining division's decision be set aside and that a European patent be granted on the basis of the claims of the main request or the first or second auxiliary request forming the basis for the decision under appeal, or the claims of the third auxiliary request submitted with the statement of grounds. The appellant also requested to hold oral

proceedings "*if a decision according to main request [could not] be made in the written proceedings*". The appellant provided arguments as to why the independent claims of all requests met the requirements of Rule 137(5) EPC and Articles 83, 84 and 56 EPC.

V. The board issued a communication under Article 15(1) RPBA (Rules of Procedure of the Boards of Appeal, OJ 2007, 536). In this communication, the board

(a) introduced the following document into the appeal proceedings:

D9: Digital Video Broadcasting (DVB); DVB-H Implementation Guidelines, 26 January 2005, XP017800930,

(b) gave its provisional opinion that the examining division was incorrect in refusing the application for not meeting the requirements of Rule 137(5) EPC,

(c) gave its provisional opinion that the claims of none of the requests met the requirements of Article 84 EPC 1973 because the term "*deterministic mapping*" was ambiguous and the application did not meet the requirements of Article 83 EPC 1973,

(d) indicated that should the appellant succeed in convincing the board that the claims met the requirements of Articles 83 and 84 EPC 1973, the board would be minded to exercise its discretion under Article 111(1) EPC 1973 and remit the case to the department of first instance for further prosecution.

VI. With a letter dated 19 December 2018, the appellant replaced the request for oral proceedings with a request to stay the proceedings before the technical board of appeal until the Federal Constitutional Court ("FCC", in German: "*Bundesverfassungsgericht*") of the Federal Republic of Germany had given a ruling on the admitted constitutional complaints ("*angenommene Verfassungsbeschwerden*"), which were pending before the FCC under reference numbers "*2 BvR 2435/13, 2 BvR 421/13 and 2 BvR 2480/13*".

VII. With a letter dated 21 December 2018, the appellant informed the board that it did not intend to file amendments or observations or attend the oral proceedings scheduled for 24 January 2019. The board was requested to decide on the "*requests 1. to 4. outlined in paragraph II. in [the] submission of June 19, 2013 and 5. outlined in [the] submission of December 19, 2018 [...] without orally hearing the applicant*".

VIII. On 24 January 2019, the board held oral proceedings in the absence of the appellant.

The chairman noted that it appeared from the file that the appellant's final requests were that the decision under appeal be set aside and that a European patent be granted on the basis

- of the claims of the main request or the first or second auxiliary request underlying the decision under appeal, or
- the claims of the third auxiliary request filed with the statement of grounds of appeal, or, in the alternative, that the appeal proceedings be stayed

until the FCC had decided upon the constitutional complaints pending before it under the reference numbers "2 BvR 2435/13, 2 BvR 421/13 and 2 BvR 2480/13".

At the end of the oral proceedings, the chairman announced the board's decision.

IX. Claim 1 of the main request reads as follows:

"A method of transmitting an information signaling a deterministic mapping in each VSB data frame of an ATSC data stream, whereby the information signals the deterministic mapping of multiple different services into a VSB data frame, comprising the steps of:

inserting the information signaling the deterministic mapping into a reserved field of the VSB data frame;  
and transmitting the VSB data frame,

characterised in that

the deterministic mapping is a mapping of content data of multiple services, whereby the content data of each service is interleaved across a series of VSB data frames."

X. Claim 1 of the first auxiliary request reads as follows:

"A method of transmitting an information signaling a deterministic mapping in each VSB data frame of an ATSC data stream, whereby the information signals the deterministic mapping of multiple different services into a VSB data frame, comprising the steps of:

inserting the information signaling the deterministic mapping into a reserved field of the VSB data frame;  
and transmitting the VSB data frame,

characterised in that

the deterministic mapping is a mapping of content data of multiple services, whereby the content data of each service is interleaved across a series of VSB data frames and

the information signaling the deterministic mapping is provided by an emission multiplexer (504) in a transport stream emitter (514) and is transmitted to an exciter (512) in each transmitter (502) inserting the information signaling the deterministic mapping into the reserved field of the VSB data frame."

XI. Claim 1 of the second auxiliary request reads as follows:

"A method of transmitting an information signaling a deterministic mapping in each VSB data frame of an ATSC data stream, whereby the information signals the deterministic mapping of multiple different services into a VSB data frame, comprising the steps of:

inserting the information signaling the deterministic mapping into a reserved field of the VSB data frame;  
and transmitting the VSB data frame,

characterised in that

the deterministic mapping is a mapping of content data of multiple services, whereby the content data of each



service is interleaved across a series of VSB data frames and

the information signaling the deterministic mapping is provided by an emission multiplexer (504) in a transport stream emitter (514) and is transmitted in place-holder bytes in the SRS field of the transport data stream to an exciter (512) in each transmitter (502) inserting the information signaling the deterministic mapping into the reserved field of the VSB data frame."

XII. Claim 1 of the third auxiliary request reads as follows:

"A method of transmitting an information signaling a deterministic mapping in each VSB data frame of an ATSC data stream, whereby the information signals the deterministic mapping of multiple different services into a VSB data frame and whereby the deterministic mapping is a deterministically changing mapping, comprising the steps of:

inserting the information signaling the deterministic mapping into a reserved field of the VSB data frame;  
and transmitting the VSB data frame,

characterised in that

the deterministic mapping is a mapping of content data of multiple services, whereby the content data of each service is to be interleaved across a series of VSB data frames in an exciter (512) in each RF transmission system (502) and the information signaling the deterministic mapping is provided by an emission multiplexer (504) in a transport stream emitter (514)

in a studio or in a network operations center and is transmitted in place-holder bytes in the Supplementary-Reference-Signal field of the MPEG-2 transport data stream over a distribution network (506) to each exciter (512) inserting the information signaling the deterministic mapping into the reserved field of the VSB data frame."

XIII. The examining division's objections, where relevant to the present decision, may be summarised as follows:

- (a) All originally filed claims related to deterministically mapping multiple distinct services into a single ATSC VSB framing structure and transmitting side information to signal the mapping to enable a receiver to find a multiplexed service for demultiplexing. Claim 1 of the main request added that *"the data of each service is interleaved across a series of VSB data frames"*. This feature addressed a separate, additional, problem, i.e. increasing resilience to long burst errors. Had this additional aspect been present in the claims at the search stage, it would have resulted in the requesting of an additional search fee. Therefore, the requirements of Rule 137(4) EPC 1973 were not met, and the main request was not admissible (see decision under appeal, Reasons, point 2.1).

Claim 1 of the first auxiliary request *"include[d] claim 1 of the main request in its entirety and [...] add[ed] [a further] aspect"* (see decision under appeal, Reasons, point 2.2), and claim 1 of the second auxiliary request only added *"a further detail [...] to the claim wording of auxiliary request 1 that [did] not alter the assessment"* for

the main request (see decision under appeal, Reasons, point 2.3).

- (b) The claims of the main request did not meet the requirements of Articles 83 and 84 EPC because it was not clear "*whether 'mapping' reflect[ed] service placement prior to or after 'interleaving' per figures 14-17 and paragraphs 96-99*", and this "*lack of clarity [... could not] be overcome in light of the description*" (see the "*Further Remarks*" section).

XIV. The appellant's arguments, where relevant to the present decision, may be summarised as follows:

- (a) The features added from the description further specify rather than replace the originally claimed in-band signalling of the deterministic mapping. These features did not affect the notion of unity of invention (see statement of grounds of appeal, page 4, point 1.4).
- (b) The terms "mapping" and "interleaving" were not used as synonyms in the application (see statement of grounds of appeal, page 6, penultimate paragraph).
- (c) The phrase "*deterministic mapping is a mapping of content data of multiple services*" in the characterising portion of claim 1 was clear (see statement of grounds of appeal, page 5, point 2.2), and the "*mapping*" clearly preceded convolutional byte interleaving (see statement of grounds of appeal, page 5, point 2.3, and page 10, last paragraph).

- (d) The "*mapping of content data of each service ... represent[ed] unambiguously and clearly a mapping of content data prior to the interleaving*" (see statement of grounds of appeal, page 5, point 2.3).
- (e) In its decision in case R 19/12 (dated 25 April 2014, the Enlarged Board held the incorporation of the boards of appeal into the European Patent Office ("EPO") to constitute a structural deficiency. This was because the boards, being an entity of the patent granting authority, were not organised like a court. This decision triggered the three above complaints based on the grounds that "*the decisions handed down by the boards of appeal before R 19/12 had been adopted lacked judicial independence*". The fact that the FCC had admitted the three constitutional complaints could be considered as an indication that the court had at least substantial doubts as to the judicial independence of the members of the EPO boards of appeal.

The structural deficiency had not been remedied in the wake of R 19/12 in the form of separating the boards' premises from the EPO's other official buildings. The boards were still not judicial or quasi-judicial reviewing bodies that were, from an organisational point of view, segregated from the EPO. The members did not enjoy lifetime tenure and continued to be subject to the EPO presidency's disciplinary right to give instructions.

Should the board refuse the fourth auxiliary request, the appellant contends that its right to be heard pursuant to Article 113 EPC would be infringed. The appellant addresses the question of

what would happen should the FCC hold that the boards of appeal were not empowered to review decisions of examining divisions because its members did not enjoy judicial independence. In its view, the appellant would in this case be **deprived of its right to bring its case again before an independent judicial body**. Such a body would have to be set up. As a precaution, the appellant therefore raises an objection under Rule 106 EPC for infringement of Articles 113 and 112a(2)(c) EPC.

Should the board hand down an unfavourable decision now, the appellant would have to file constitutional complaints before the national courts of member states, among others, the FCC.

Conversely, should the request for stay of the proceedings be granted, the right to be heard under Article 113 EPC would be safeguarded. This is because in the event of a favourable decision by the FCC, the appellant would be in a position to present its case before an independent judicial body that would have to be set up. The present case **on which no final decision would have been given** would have to be referred to that body.

## **Reasons for the Decision**

1. The appeal is admissible.
2. *Main, first and second auxiliary requests - Rule 137(5) EPC*
- 2.1 Rule 137(5) EPC provides that amended claims may not relate to unsearched subject-matter which does not

combine with the originally claimed invention or group of inventions to form a single general inventive concept.

According to established case law (see Case Law of the Boards of Appeal of the EPO, 8th edition 2016 ("Case Law"), section IV.B.5.4), features added from the description to further define an element already a feature of the original main claim do not "*affect the notion of unity of invention*". Amended claims can only be refused if the subject-matter of the claims filed originally and that of the amended claims was such that, had all the claims originally been filed together, a further search fee would have been payable.

- 2.2 The originally filed claims included independent method claims 1, 3, 5 and 7, all relating to signalling a deterministic mapping with the mapping inserted in a reserved field of a vestigial sideband data frame (claim 1), transmitted through spread spectrum (claim 3), transmitted through a signalling channel (claim 5), or transmitted from a second provider (claim 7).

The supplementary European search report was based on the claims as published.

In the European search opinion, point 2.1, the search division objected that the claims did not meet the requirements of Article 82 EPC because the claims related to two separate inventions:

- (a) in-band signalling of deterministic mapping using a single transmission channel for both, (ATSC) VSB frames and mapping information describing the frame structure, while retaining full (VSB frame)

synchronisation between both (method claims 1 to 4);

and

(b) out-of-band signalling of deterministic mapping in which the actual service content is transmitted from one service provider (e.g. ATSC broadcaster), while mapping information to access data in the content from the first service provider is transmitted independently in a separate signalling channel from a second content provider (method claims 5 to 8).

- 2.3 Claim 1 of the main, first and second auxiliary request specifies "*transmitting an information signaling a deterministic mapping in each VSB data frame of an ATSC data stream*".
- 2.4 The board agrees with the appellant that the features added from the description further specify rather than replace the originally claimed in-band signalling of the deterministic mapping and that these features do not affect the notion of unity of invention (see point XIV(a) above).
- 2.5 Even though the added features had not been "*hinted at in the original set of claims*" and addressed "*the different, unrelated problem of increasing resilience to long burst errors [...] by deeper than legacy ATSC interleaving*", the board is not convinced that if the claims underlying the appealed decision "*had been present in claims at the search stage of the application it would have resulted in requesting an additional search fee*" (see point XIII(a) above). The claims of the main and first and second auxiliary

requests relate to in-band signalling of deterministic mapping. Thus, they would have been included in the first group of claims identified in point 2.1.1 of the European search opinion. No further search fee was requested for claims within the first group.

2.6 In view of the above, the examining division was incorrect in refusing the application for not meeting the requirements of Rule 137(5) EPC.

3. *Main request and first, second and third auxiliary requests - clarity (Article 84 EPC 1973)*

3.1 According to Article 84 EPC 1973, the claims "*shall be clear and concise*".

According to established case law, the clarity of a claim is not diminished by the mere breadth of a term contained in it if the meaning of this term - either per se or in the light of the description - would be unambiguous for the person skilled in the art (see "Case Law", section II.A.3.3).

3.2 Claim 1 of each of the requests on file specifies that "*the deterministic mapping is a mapping of content data of multiple services, whereby the content data of each service is to be interleaved across a series of VSB data frames*".

3.3 The board agrees with the examining division that it is not clear from the wording of the claims what is meant by the "*deterministic mapping of multiple different services into a VSB data frame*" and that the subsequent phrase "*whereby the content data of each service is interleaved across a series of VSB data frames*" does not clarify what is meant by "mapping".



3.3.1 The board shares the appellant's view that "mapping" and "interleaving" are not used as synonyms in the application (see point XIV(b) above). The mapping or dynamic allocation of services to slices in a frame shown in Figures 10 to 12 (see also paragraph [0085]: "*Each frame carries data placed in locations known to correspond to different services*") is to be distinguished from the convolutional byte interleaving shown in Figure 17. This distinction is further illustrated by paragraph [0084], which discloses that "*dispersions of the segments caused by an interleaver in exciter 512 are not shown. A conceptual mapping of such dispersions caused by the interleaver 106 in exciter 512 is discussed [...] with reference to FIG. 17*".

3.3.2 However, the adverb "whereby" suggests that the mapping results in the interleaving of data across frames. Mapping of services to slices in a frame only results in spreading the data related to a service over plural frames if only part of the data of a service is allocated (mapped) to one frame and the remaining data allocated (mapped) to different frames.

3.3.3 The board has not been persuaded that the phrase "*deterministic mapping is a mapping of content data of multiple services*" in the characterising portion of claim 1 is clear and that the claimed mapping clearly precedes convolutional byte interleaving (see point XIV(c) above).

The appellant quoted the following part of paragraph [0097]:

*"[As shown in FIG. 15, 208 packets are shown which have been grouped into four (4) slices. The four slices are*

*grouped into a block and transverse coding is applied to the block, where the parity bytes are placed within the block (2D R-S Parity).] Emission multiplexer 504 can control time diversity by controlling where slices will be placed within a data frame as well as the particular data frame. For example, emission multiplexer 504 can control where each of the 4 slices shown in FIG. 15 will be inserted into frames by exciter 512, thus separating the slices by a predetermined time (e.g., placing the first slice of one frame into a frame five frames later and repeating the process every five frames). This provides virtual interleaving and strengthens the correction capability over bursty channels."*

According to paragraph [0097], packets are grouped in slices, slices are grouped in blocks and a block is subjected to 2D Reed-Solomon coding. The term "*virtual interleaving*" in the context of "*bursty channels*" suggests that the placement of packets into slices and the subsequent error correction coding is similar to Multiprotocol Encapsulation - Forward Error Correction (MPE-FEC) known from DVB-H (see, for instance, D9, sections 5.4, 6.1.1 and 10, page 55). In addition, time diversity is controlled by placing slices within a data frame. However, the mapping of slices to data frames is not clear. If one block comprised four slices, and assuming one slice were mapped to one data frame, then the first slice of the next block would be transmitted four frames later, i.e. the first slice of the current and the next block would be placed in the first and fifth frames. In contrast, paragraph [0097] suggests "*placing the slice of one frame into a frame five frames later*", i.e. the first slice of the current and the next block would be placed in the first and sixth frames.

The last sentence of paragraph [0097] refers to the "*deterministic nature of VSB frame*" (emphasis added), whereas the preceding sentences in the paragraph refer to a data frame. Assuming that a "*VSB frame*", "*a VSB data frame*" and a "*data frame*" denote the same data structure, the "*deterministic nature*" of the frame only implies that slices (shown in Figures 15 and 16) are mapped to VSB data frames according to a known algorithm. However, the application does not disclose any steps of such algorithm.

The perfunctory statement in paragraph [0085] that "*several slices [... are] dynamically assigned across a VSB frame*" does not hint at how to assign a slice of 52 packets (see paragraph [0097]: "*208 packets ... have been grouped into four (4) slices*") to a row shown in Figure 10.

The appellant also referred to paragraph [0066] (see statement of grounds of appeal, page 5, point 2.2). However, the statement "*mapping can be static or dynamic [...and] a dynamically based implementation supplies the service content for different services by signaling to the receiving device that the information is deterministically changing*" does not aid in understanding how, i.e. according to which algorithm, slices are mapped to frames.

3.3.4 Furthermore, the board has not been persuaded that "*the mapping of content data of each service ... represent[s] unambiguously and clearly a mapping of content data prior to the interleaving*" (see point XIV(d) above). The "*memory map of a convolutional byte interleaver*" shown in Figure 17 (see paragraph [0099]) shows a slice of 52 packets. This suggests that the input to the convolutional interleaver is a slice and

not a frame with multiple slices. Hence, convolutional interleaving precedes placement of slices in frames.

- 3.4 In view of the above, the claims of all requests on file fail to meet the requirements of Article 84 EPC 1973 because the term "*deterministic mapping*" is ambiguous.
4. *Main request and first, second and third auxiliary requests - sufficiency of disclosure (Article 83 EPC 1973)*
- 4.1 According to established case law, the requirement of sufficiency of disclosure of Article 83 EPC is not met if an effect expressed in the claim cannot be reproduced (see the decisions cited in "Case Law", section II.C.5.1).
- 4.2 Claim 1 of each request specifies that "*the deterministic mapping is a mapping of content data of multiple services, whereby the content data of each service is interleaved across a series of VSB data frames*" (emphasis added).
- 4.3 The wording quoted in point 4.2 above suggests that the mapping results in the interleaving of data across frames. For the reasons set out in section 3 above, the board is not convinced that the claimed deterministic mapping results in the claimed interleaving across frames, i.e. the claimed effect (the interleaving of data across frames) cannot be reproduced.
- 4.4 In view of the above, the application does not meet the requirements of Article 83 EPC 1973.

5. *Fourth auxiliary request - the details*

The request mentions three constitutional complaints allegedly pending before the FCC under reference numbers "2 BvR 2435/13, 2 BvR 421/13 and 2 BvR 2480/13".

These case numbers are not in line with the contents of the FCC's website, accessed shortly before the announcement of the decision at the oral proceedings before the board at the URL [https://www.bundesverfassungsgericht.de/DE/Verfahren/Jahresvorausschau/vs\\_2018/vorausschau\\_2018.html](https://www.bundesverfassungsgericht.de/DE/Verfahren/Jahresvorausschau/vs_2018/vorausschau_2018.html).

Under "Preview for 2018, Second Senate, Reporting Justice: Justice Prof. Dr. Huber", the following cases are mentioned in point 9:

"2 BvR 2480/10, 2 BvR 421/13, 2 BvR 756/16, 2 BvR 786/16".

The title of the cases is:

Constitutional complaint pursuant to Art. 2(1), Art. 19(4), Art. 20(3), Art. 24(1) and Art. 103(1) of the German Basic Law ["Grundgesetz"; German Constitution] for **insufficient judicial relief** at the European Patent Office against a decision of the Boards of Appeal. (Translation by the board, emphasis added.)

The German original text reads:

Verfassungsbeschwerde wegen Verletzung von Art. 2 Abs. 1, Art. 19 Abs. 4, Art. 20 Abs. 3, Art. 24 Abs. 1 und Art. 103 Abs. 1 GG [Grundgesetz] wegen **unzureichenden Rechtsschutzes** beim Europäischen Patentamt gegen Entscheidung der Beschwerdekammern. (Emphasis added.)

The same mention was made in the 2017 annual preview. In the 2016 preview, the first two constitutional complaints 2 BvR 2480/10 and 2 BvR 421/13 were cited.

Case 2 BvR 2435/13 is mentioned in none of these previews, while 2 BvR 421/13 is, and "2 BvR 2480/13" obviously relates to 2 BvR 2480/**10**. Instead of case **2 BvR** 2435/13, a case with the number **AR** 2435/13 is referred to in some publications of 2014 (see e.g. <https://www.juve.de/nachrichten/verfahren/2014/05/europaisches-patentamt-befangenheitsantrag-gegen-vorsitzenden-richter-sorgt-fur-wirbel>) as relating to a constitutional complaint then pending before the FCC. In German courts, the reference "AR" is an abbreviation of "Allgemeines Register", i.e. "General Register", referring to preparatory proceedings ("Vorverfahren") or "other" proceedings. The reference "BvR" relates, in particular, to constitutional complaints under Article 93(1) number 4(a) of the German Basic Law. (See <https://www.gerichtsaktenzeichen.de/gerichte/bverfg/>.)

The FCC's website states:

Applications are either entered directly into the Register of Proceedings or into the General Register; the latter applies if, for instance, a constitutional complaint is clearly inadmissible or, with due regard to the Federal Constitutional Courts's case-law, will clearly be unsuccessful.

If their application is entered into the General Register, the complainants may be informed in writing for what reasons their application probably has no prospects of success. If they nevertheless insist on a judicial decision, their constitutional complaints are transferred to the Register of Proceedings; otherwise, the proceedings terminate.

[https://www.bundesverfassungsgericht.de/EN/Verfahren/Der-Weg-zur-Entscheidung/der-weg-zur-entscheidung\\_node.html](https://www.bundesverfassungsgericht.de/EN/Verfahren/Der-Weg-zur-Entscheidung/der-weg-zur-entscheidung_node.html)

As the board has been unable to find any indication beyond non-official reports about the apparent then pendency of case AR 2435/13, it disregards this then possibly pending case. The discussion below is rather based on the fact that the four cases mentioned on the FCC's website in the section "Preview for 2018" are pending before the FCC and are all treated together under the same title "insufficient relief ... against a decision of the Boards of Appeal". These cases are 2 BvR 2480/10 and 2 BvR 421/13 on which the appellant relies, together with the two additional cases 2 BvR 756/16 and 2 BvR 786/16, but not case "2 BvR 2435/13".

In proceeding this way, the board does not depart from the substance of the appellant's submission that certain constitutional complaints are pending before the FCC, and that admittance by the FCC of these complaints was an indication that the Court had at least substantial doubts as to the judicial independence of the members of the EPO boards of appeal and that it might deliver a judgment denying that independence. The appellant neither provided any details relating to the two pending cases 2 BvR 2480/10 and 2 BvR 421/13 that it relies on beyond what is said above, nor mentioned the two additional cases.

6. *Whether the fourth auxiliary request for stay of the proceedings can be admitted into the appeal proceedings*

Pursuant to Article 13(1) RPBA

[a]ny amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion. The discretion shall be exercised in view of inter alia the complexity of the new subject matter

submitted, the current state of the proceedings and the need for procedural economy.

A request for stay of proceedings might, in principle, be admitted as a matter of course if it were based on an event that occurred after expiry of the period for filing the statement of grounds of appeal and if the request was filed without delay.

In the present case, however, the request for a stay was made long after the two constitutional complaints on which the request is validly based, bearing case numbers from 2010 and 2013, had been filed. As mentioned above (in point 5), those cases had already been part of the 2016 preview. As the appellant has not given any details beyond those set forth above and has not claimed to have been unable to do so for lack of access to the texts of the two complaints, the question about when the complaints became publicly available on the EPO's website is immaterial. Only for the sake of completeness, therefore, it is noted that the complaint in case 2 BvR 421/13 of 25 February 2013 was made available via EPO file inspection on 14 March 2013, and the complaint in case 2 BvR 2480/10 of 5 April 2013 on 8 May 2013 (see point 7.4.3 below for information on the cases). The request for stay was filed on 19 December 2018, roughly one month before the date appointed for oral proceedings on 24 January 2019. It was filed in response to the communication annexed to the summons, which provisionally considered none of the pending claim requests allowable.

The request for stay was thus filed at a very late stage of the proceedings, against the backdrop of a possibly adverse decision by the board, without any reason for this late filing given. The board's



unfavourable preliminary opinion cannot be taken into account in the balancing of the criteria of admittance. The appellant, like any appellant, always had to consider the possibility of losing its appeal. It should therefore have filed the request without delay after it had learnt about the constitutional complaints on which it is deemed to rely, i.e. 2 BvR 2480/10 and 2 BvR 421/13.

No further inquiry is needed, however, because the board admits the fourth auxiliary request because the issues involved are of general interest. Future FCC judgments on those cases dealing with insufficient judicial relief by the EPO boards of appeal at large might influence all proceedings pending before the boards of appeal in the same way. If the present board granted a stay due to the cases pending before the FCC, and if other boards adopted the same approach, then the administration of justice by the boards might become severely hampered and may even grind to a halt.

In the absence of this general interest, the circumstances set out in the present section would have suggested this to be a clear case of non-admittance of the request.

7. *Whether the fourth auxiliary request for stay of the proceedings can be allowed*

7.1 Legal basis for a stay in the EPC and the case law

The appellant has not mentioned any legal basis for its request that the board stay the present proceedings.

The EPC includes no general provisions for stays, but provides some specific legal bases for a stay of

proceedings (7.1.1). In addition, the case law has developed certain conditions (7.1.2).

#### 7.1.1 Stay pursuant to Rules 14(1) and 78(1) EPC

Pursuant to Rule 14(1) EPC, the EPO **must** stay grant proceedings if a third party provides evidence that it has instituted proceedings against the applicant for the purpose of seeking a decision that the third party instead of the applicant is entitled to the grant of the European patent (Article 61(1) EPC), subject to further conditions being met. The stay must be ordered for a specified period of time, after which proceedings for grant may be resumed (see Rule 14(3) EPC).

Provisions analogous to those of Rule 14 EPC apply *mutatis mutandis* if a third party provides evidence, during opposition proceedings or the opposition period, that it has instituted proceedings against the patent proprietor in the above meaning (see Rule 78 EPC). Below, references to Rule 14 EPC are deemed to also be effective for Rule 78 EPC.

The purpose of Rule 14 EPC was spelt out in J 2/14, point 3.4:

... the aim of Rule 14 EPC is to prevent a non-entitled applicant from **impairing the position of a potential true proprietor** by amending or even withdrawing the application without the latter's consent (cf. J 7/96, OJ EPO 1999, 443, point 8 of the Reasons, emphasis added).

#### 7.1.2 Case Law on stays when referrals before the Enlarged Board are pending

When a referral to the Enlarged Board of Appeal (EBA) is pending, then it follows from Article 112(3) EPC

that the proceedings before the referring board are stayed.

According to the case law, proceedings before other boards may also be stayed (see "Case Law", point IV.F.2.5.4).

In T 426/00 of 27 June 2003, the board had to answer questions identical to the questions raised in a referral pending before the Enlarged Board. The board held (point 4.2, last paragraph of the decision):

In order to ensure uniform application of the law as foreseen [sic] by Article 112(1) EPC and to comply with the spirit of Article 16 of the Rules of Procedure of the Boards of Appeal [of year 1980; Art. 21 RPBA 2007] which presupposes an already existing decision of the Enlarged Board of Appeal, this Board considers it appropriate to hold its decision in abeyance so that the Enlarged Board's evaluation of the question before it will not be anticipated (see also T 166/84, OJ EPO 1984, 489).

In T 1875/07 (point 8.3, last sentence) it was held that "*[s]ince in the present appeal the decision does not depend entirely on the outcome of the referral, there is no necessity to suspend the proceedings*". This statement, like the decision above in case T 426/00 (point 8.1) (and T 1044/07, point 6.1), relates to case T 166/84 (OJ EPO 1984, 489). In T 166/84, the board said (point 2):

It is the opinion of the Board that, whenever a decision of the Examining Division depends entirely on the outcome of proceedings before the EBA on a legal question or point of law raised according to Article 112 EPC [1973] - and this is known to the Examining Division - the further examination of the application must be suspended until the matter is decided by the EBA.

The board in T 166/84 gave no reasons for its opinion, which also led it to order the refund of the appeal fee in view of a substantial procedural violation according to Rule 67 EPC 1973.

7.2 Legal basis for a stay: balancing its respective adverse consequences

7.2.1 Rule 14 EPC as one embodiment of the general principle

It might be concluded that the above-identified rationale of Rule 14(1) EPC -to prevent a non-entitled applicant from impairing the position of a potential true proprietor (of the application)- is derived from the following **general principle**: a stay might be granted to **prevent disadvantage** for the requester which would be greater than the disadvantage caused if the stay were not granted.

In the situations covered by Rule 14 EPC, what is at stake is the relationship between two private parties both claiming entitlement to a patent application. Not granting the stay might prejudice the true applicant's right, granting it would cause a delay in the proceedings. It follows from Rule 14 EPC that lawmakers considered the potential disadvantage to the applicant, i.e. *in extremis*, the loss of its application, to be greater than the disadvantage consisting in the delay for a specified period of time (after which proceedings for grant may be resumed regardless of the stage reached in the proceedings instituted under Article 61(1) EPC (see Rule 14(3) EPC)).

In the present case, what is at stake is the power of the board of appeal to decide upon, in particular refuse, a patent application, a power that a future FCC

judgment might have an impact on. Granting the stay would cause a delay in the proceedings. The question is whether not granting the stay might disadvantage the applicant and, if so, whether this disadvantage would be greater than the disadvantage caused if the stay were granted, i.e. the delay in the proceedings. What was said in point 6 also needs to be considered. If other boards adopted the same approach, then the administration of justice by the boards might become severely hampered and may even grind to a halt.

Deriving the rationale of Rule 14 EPC from the general principle that *a stay might be granted to prevent disadvantage for the requester which would be greater than the disadvantage caused if the stay were not granted* is not incompatible with the reasons given in T 426/00 of 27 June 2003 for staying proceedings in the event of a referral pending before the Enlarged Board for boards other than the referring board, i.e. the uniform application of the law. That rationale may also be derived from the above general principle. When a referral is pending, and the outcome depends entirely on the Enlarged Board's decision, a balance must be struck between the disadvantage likely caused by staying, i.e. the delay of the proceedings, and by not staying, i.e. the uniform application of the law by avoiding contradictory decisions. Other factors, such as the pendency time of the European patent application weighing in favour of not staying, may, however, also have to be taken into account.

The - unreasoned - holding of T 166/84 requiring stay **without exception even for proceedings before first-instance** departments whenever a decision depends entirely on the outcome of proceedings before the EBA on a legal question or point of law (without giving any

reasons) is at least doubtful but not a subject of the present proceedings. It is the present board's position, however, that the holding of T 166/84 cannot be applied to proceedings before the boards, contrary to the decisions referred to above (see point 7.1.2) citing, and thereby endorsing, that holding. There is no apparent legal basis for such a strict approach, which runs counter to the general principle identified above from which the rationale of Rule 14 EPC was derived.

#### 7.2.2 The rule of law as source of the general principle

The question may arise whether, as discussed, in point 7.2.1 above, it is possible to detect a general principle of procedural law from provisions of the EPC, i.e. Rules 14 and 78: that *a stay of proceedings before the boards of appeal might be granted to prevent disadvantage for the requester which would be greater than the disadvantage caused if the stay were not granted.*

These provisions may not suffice to establish the intention of the Contracting States to recognise that general principle. Thus, it would have to be examined whether, pursuant to Article 125 EPC, a narrower principle relating to constitutional complaints could be derived from general principles of procedural law as acknowledged in the Contracting States, i.e. the principle that *a stay of proceedings before the boards of appeal might be granted to prevent disadvantage for the requester **in case of success of the constitutional complaints** which would be greater than the disadvantage caused **in case of failure of the complaints** if the stay were not granted.*

In this regard, the principle can be seen as rooted in the rule of law.

According to principles accepted by the European Court of Human Rights (ECtHR), aspects of the rule of law include **effective judicial review** and **independent and impartial courts**.

The European Commission stated:

The precise content of the principles and standards stemming from the rule of law may vary at national level, depending on each Member State's constitutional system. Nevertheless, case law of the Court of Justice of the European Union ("the Court of Justice") and of the European Court of Human Rights, as well as documents drawn up by the Council of Europe, building notably on the expertise of the Venice Commission, provide a non-exhaustive list of these principles and hence define the core meaning of the rule of law as a common value of the EU in accordance with Article 2 TEU.

Those principles include **legality**, which implies a transparent, accountable, democratic and pluralistic process for enacting laws; **legal certainty; prohibition of arbitrariness of the executive powers; independent and impartial courts; effective judicial review including respect for fundamental rights; and equality before the law**.

(Emphasis in the original, footnote 10 omitted.)

[Footnote 11] ...the European Court of Human Rights ... gives the rule of law a substantive nature by establishing that it is a concept inherent in all articles of the ECHR [European Convention on Human Rights] (see for example ECtHR *Stafford v United Kingdom*, 28 May 2001, para 63). ...

See Communication from the Commission to the European Parliament and the Council: A new EU Framework to strengthen the Rule of Law, COM(2014) 158 final, page 4, available at <http://ec.europa.eu/transparency/regdoc/rep/1/2014/EN/1-2014-158-EN-F1-1.Pdf>.

If a body whose nature as a court (and, concomitantly, its power to act as a court) is contested, ceased its activities, **effective judicial review** would be severely disadvantaged. It is, therefore, justified to consider that such a body must carry out the administration of justice in cases where the danger of a disadvantage from its rulings to the principle that **courts** must be **independent and impartial** is not higher than the danger to effective judicial review from it ceasing its activities.

Thus, a public authority supposed to be a court or equivalent, such as the EPO boards of appeal, that may not be authorised to act as such -as a compromise between delaying justice versus acting by delivering decisions without being entitled to do so- must not inflict a greater disadvantage than if it did not act.

7.2.3 In the present case, the question of whether

- a general principle that *a stay of proceedings before the boards of appeal might be granted to prevent disadvantage for the requester which would be greater than the disadvantage caused if the stay were not granted* is embodied in Rule 14 EPC or

- a narrower general principle that *a stay of proceedings before the boards of appeal might be granted to prevent disadvantage for the requester **in case of success of the constitutional complaints** which would be greater than the disadvantage caused **in case of failure of the complaints** if the stay were not granted* can be derived from the rule of law as such



will only need to be addressed in case of an actual finding of a greater disadvantage by deciding on a case than by not deciding on it.

Before making this inquiry, the board assesses whether there is evidence that the complaints are clearly inadmissible or devoid of any merit, in which case the balancing of adverse consequences in the above sense would be moot.

Otherwise, for the purposes of this decision, it will be assumed below, *arguendo*, that the board would have the power to stay the proceedings.

7.3 Whether the constitutional complaints are clearly inadmissible or devoid of merit

The board assumes, favourably for the appellant, that the constitutional complaints are admitted.

As to their substance, contrary to what the appellant alleges, it is not obvious that the pending constitutional complaints have a clear likelihood of success. The appellant alleges that the fact that the FCC admitted the three constitutional complaints it mentioned (of which only two could be identified as pending) could be considered indicative that the court had at least substantial doubts as to the judicial independence of the members of the EPO boards of appeal. The appellant makes this assertion even though the two complaints on which the appellant validly relies were based on the grounds that the decisions handed down by the boards of appeal **before R 19/12** had been adopted lacked judicial independence. In the appellant's view, the structural problem identified in

R 19/12 had not been remedied in the wake of that decision.

The appellant gives no reasons for its assertions.

The FCC itself made it clear that, in principle, admittance says nothing about the prospect of success.

See, for instance, FCC press release number 95/97 of 10 November 1997 (point I, third last paragraph):

A constitutional complaint may be admitted for decision-making because of its general constitutional significance (§ 93a(2)(a) Act on the FCC), because of the special weight of the infringement of the fundamental right relied on or because of a particularly severe disadvantage (§ 93a(2)(b) Act on the FCC). Such **admittance**, however, **is inconclusive as to its prospects of success**. Despite its admittance, the constitutional complaint may, for instance, be **refused** on its merits. (Emphasis added.)

The translation was made by the board. In the German original, the text reads as follows:

Auch wenn die Verfassungsbeschwerde ... wegen ihrer grundsätzlichen verfassungsrechtlichen Bedeutung (§ 93a Abs. 2 Buchst. a BVerfGG), wegen des besonderen Gewichts der geltend gemachten Grundrechtsverletzung oder wegen des Entstehens eines besonders schweren Nachteils (§ 93a Abs. 2 Buchst. b BVerfGG) zur Entscheidung **angenommen wird, besagt dies grundsätzlich noch nichts über ihre Erfolgsaussicht**. Die Verfassungsbeschwerde kann trotz Annahme beispielsweise als unbegründet **zurückgewiesen** werden. (Emphasis added.)

(Source: Pressemitteilung des Bundesverfassungsgerichts Nr. 95/97 vom 10. November 1997, <http://archiv.jura.uni-saarland.de/Entscheidungen/pressem97/BVerfG/annahme.html>)

An example of a constitutional complaint obviously not rejected at a preliminary stage as inadmissible is

provided by the FCC's judgment in case 2 BvR 1961/09 of 24 July 2018. In its decision ("Beschluss"), the full 8-member (second) Senate later rejected the complaint as inadmissible (see point 7.4.4 below, last paragraph).

Conversely, the board is not in a position to find that the complaints on which the appellant validly relies are clearly devoid of any merit either. Therefore, the board will now assess any possible adverse consequences of refusing a stay of the proceedings.

7.4 Assessment of disadvantage for the appellant in case of non-stay

7.4.1 The appellant's assertions relating to a possible favourable FCC position

The appellant refers to if the FCC held the EPO boards of appeal **not to be empowered to review decisions** of examining divisions because its members did not enjoy judicial independence. In this case, the appellant would be **deprived of its right to present its case again before an independent judicial body to be set up** should the board not stay the proceedings. This would amount to an **infringement** of the appellant's **right to be heard** pursuant to Article 113 EPC. The appellant would have to **file constitutional complaints** before the national courts of the designated Contracting States.

Conversely, if the present proceedings were stayed, **no final decision would be given**, and the appellant would be in a position to present its case before an independent judicial body that would have to be set up.

#### 7.4.2 Burden to state and prove the case

It follows from the case law of the boards of appeal that parties have the burden to state and prove their respective cases:

... [a] board stated in T 833/94 that, when the evidence offered did not directly indicate the truth or falsity of the fact in issue, but required knowledge of the national law and patent practice, such law and practice had to be proved, as did any other fact on which a party based its arguments (proof of a national right by means of a written statement from a Japanese lawyer (T 74/00), and proof of Israeli law applicable by submitting a legal expert opinion (T 517/14)). (See "Case Law", point III.G.5.1.1.)

In the cited case T 74/00, the board held (point 4):

... As is the generally accepted procedure in most European countries (cf. Article 125 EPC) and beyond, laws of other jurisdictions than the one before which proceedings are pending must be proved as a matter of evidence, for example by filing as documents adequate copies (in translation if necessary) of such laws and/or as appropriate by filing as expert evidence the opinions of a suitably qualified lawyer in the relevant jurisdiction. ...

The present board is of the opinion that the above case law means that a board is not required to make investigations of its own on a party's case but may, where it deems it appropriate, still do so, at least in *ex parte* cases. This principle is followed below where it is important to give a comprehensive opinion on the present request which was admitted into the proceedings because of the general interest (see point 6 above, penultimate paragraph).

In this context, the board notes that the appellant has not stated

- what the two pending constitutional complaints it effectively relies on are about (see point 7.4.3 below);
- whether the German FCC has jurisdiction to decide on constitutional complaints against acts of the international European Patent Organisation and what would be the scope of any such jurisdiction and the associated powers (see point 7.4.4 below);
- if the FCC does have such jurisdiction, what are the possible legal consequences, if any, on proceedings other than the respective cases pending before the FCC, such as the present proceedings (see point 7.4.5 below);
- if such consequences exist, why that would mean that the board's decision would be final and that the appellant would therefore be deprived of its right to present its case again before an independent judicial body to be set up (see point 7.4.6 below);
- if so, why the appellant's right to be heard pursuant to Article 113 EPC would be infringed, because it could not bring its case before a court (see point 7.4.7 below);
- why it could be relevant to the present request that the appellant considered having to file constitutional complaints before the national courts of the designated Contracting States (Germany - DE, France - FR, Italy - IT) (see point 7.4.8 below).

These matters are discussed in points 7.4.3 to 7.4.8. Given the appellant's burden to state its case, the board has made investigations of its own only to the extent necessary to satisfy the general interest in an answer to the request for stay. The findings of fact and law on which the decision is based are limited to those that the appellant not attending the oral proceedings had to expect.

- 7.4.3 The appellant has made the assertions referred to above (see point 7.4.1) without providing details about the subject of the two constitutional complaints it effectively relies on, apart from the submission that they deal with the question of whether "the decisions" by members of the EPO boards of appeal lack judicial independence and that the complaints were admitted by the FCC.

The two complaints are available via EPO online file inspection (see proceedings with application numbers 02732216.3 for 2 BvR 421/13 and 96102992.3 for 2 BvR 2480/10).

Both complaints are against decisions of the EPO boards:

- Case 2 BvR 421/13 with patent application number 02732216.3 is directed against the decisions of a board of appeal in case T 1022/09 of 27 October 2011 (revoking European patent No. 1 429 968) and of the Enlarged Board of Appeal in case R 2/12 of 17 October 2012 (reviewing the board's decision). The complaint is based on a violation of certain basic rights or principles due to a general and obvious insufficiency of the

judicial relief in the case law of the Enlarged Board.

- Case 2 BvR 2480/10 with patent application number 96102992.3 is directed against the decision of a board of appeal in case T 1676/08 of 9 March 2012 (dismissing the appeal against the decision maintaining European patent No. 0 722 730 in amended form). The requests include that certain provisions of the EPC, its Implementing Regulations, the RPBA and the RPEBA (Rules of Procedure of the Enlarged Board of Appeal) "are incompatible" with certain basic requirements emanating from the rule of law; and that the board's decision be set aside because it infringes certain basic rights of the complainants.

In neither case are the "**requests**" sections of the complaints expressly directed against the German Act of Assent to the EPC of 21 June 1976 (OJ [BGBl.] 1976 II, p. 649).

- 7.4.4 The appellant has made the assertions referred to above (see point 7.4.1) without giving any explanation on whether the FCC has jurisdiction on acts of the EPO, in relation to Germany, according to German constitutional law, and, if so, what is the scope of such jurisdiction and what are the powers vested in the FCC to exercise it.

While the appellant could equally be expected to furnish such explanations, the board considered it appropriate to cover the essentials of this point of law of its own motion. This is because in the absence of jurisdiction of the German FCC on acts of the EPO boards of appeal, any further discussion of the fourth

auxiliary request would be moot. As it will be seen, the findings support the appellant's case.

In this respect, the board refers to a number of decisions by the FCC not admitting certain constitutional complaints directed against the EPO (2 BvR 2368/99, affirmed by 2 BvR 2253/06 and 2 BvR 1848/07; see the treatise ("Kommentar") on the German Basic Law by Maunz & Dürig (ed.), Article 24, pp. 74-75, December 2016).

The first decision of non-admittance was adopted on 4 April 2001 (2BvR 2368/99) in relation to an unfavourable decision by a (disciplinary) board of appeal on the entry of a German patent attorney in the list of professional representatives pursuant to Article 134(2) EPC 1973. The FCC (point 2) held that the complainant showed ("ist dargelegt") that its complaint was directed against an act by a public authority in the meaning of § 90(1) Act on the FCC, i.e. the board's decision. The complainant, however, had not provided sufficient support for its submission that the protection of fundamental rights in the EPC was not in line with the requirements of the German Basic Law. The FCC therefore declined to exercise its jurisdiction.

In other words, decisions by the EPO boards of appeal are, in principle, subject to review by the FCC. Given that, thus far, to the board's knowledge, no constitutional complaint against an act by the EPO has been effectively admitted - with the exception of the complaints in issue, according to the appellant - there is no FCC case law on the implementation of a finding by the FCC that an EPO decision infringed the German Basic Law.



Nor does a judgment on a constitutional complaint against a German court decision relating to the European Schools organised by intergovernmental co-operation order such an implementation. The constitutional complaint underlying that FCC judgment in case 2 BvR 1961/09 of 24 July 2018 addressed the question of whether German courts had to provide relief to parents of students of the European School at Frankfurt am Main, Germany, against an increase in tuition fees. Indirectly, the complaint related to the compatibility of the German Act of Assent to the Regulations of the European Schools with the German Basic Law. (See point A of the judgment.) (A board of appeal has jurisdiction to adjudicate certain disputes.) The complainants had not provided sufficient submissions to support their case.

- 7.4.5 The appellant does not explain the possible **legal consequences**, if any, of any favourable decisions by the FCC on the constitutional complaints in issue on **proceedings other** than those pending.

As stated in point 7.4.3:

- the request of complaint 2 BvR 421/13 is directed at the setting aside of the decision of a board and the Enlarged Board based on insufficiency of the judicial relief in the case law of the Enlarged Board;
- the requests of complaint 2 BvR 2480/10 are not only directed at the setting aside of a decision by a board but also at certain provisions of the EPC, its Implementing Regulations, the RPBA and the RPEBA which "are incompatible" with certain basic requirements emanating from the rule of law.

- In neither case are the requests expressly directed against the German Act of Assent to the EPC of 21 June 1976.

For the board it is not obvious that any FCC decisions on the two constitutional complaints would have direct legal implications beyond those cases. This includes complaint 2 BvR 2480/10. The appellant has not stated on why and how a ruling on certain provisions of the EPC, its Implementing Regulations, the RPBA and the RPEBA could impact on other board decisions with effect for Germany. The complainant in case 2 BvR 2480/10 obviously seeks a finding to this effect while it is unclear whether such a finding should take the form of a "declaratory ruling" strictly speaking or merely serve as a basis for deciding on the legality of the board's decision. Neither the complainant in its requests nor the appellant in the fourth auxiliary request even mentioned the German Act of Assent to the EPC embodying the order to apply the EPC in Germany, and the possible consequences of the nullity of the Act.

For these reasons alone, the fourth auxiliary request seeking a stay of the proceedings must fail. The appellant has stated no possible disadvantage from a decision of the board in the present case *in case of success of the constitutional complaints*. So there is nothing to balance against the disadvantage if a stay is ordered, i.e. the delay of the proceedings.

For the sake of completeness, an analysis of the remaining issues is nevertheless done below.

- 7.4.6 The appellant does not explain why the specific consequences of non-stay it alleges would occur, i.e.

that the present board's decision would be final and that the appellant would therefore be deprived of its right to present its case again before an independent judicial body to be set up.

The following analysis shows that the appellant's suggested outcome is based on contradictory reasoning and therefore not convincing. It also shows other possible options without, however, speculating on any outcome of the cases pending before the FCC. Rather, the conceivable options presented below are derived from experience in comparable situations (decisions of the German Patent Office and the EUIPO boards of appeal considered administrative rulings by the German Federal Administrative Court in 1959 and by the Court of Justice of the European Union, respectively; see point 7.4.6 (a)) or are based directly on provisions of the EPC (conversion; see point 7.4.6(b)).

(a) The board's decision as a possible administrative ruling

The appellant only considers the possibility that the FCC would hold the EPO boards of appeal not to be empowered to review decisions of the examining divisions (because its members did not enjoy judicial independence). Thus, in its view, the appellant would be deprived of its right to present the case again before an independent judicial body should the stay not be granted. The appellant thus implies that the board's decision would be final (i.e. unappealable).

The appellant would then have to file constitutional complaints before the national courts of the designated Contracting States.

Conversely, if the stay were granted, the case would have to be referred to an independent judicial body to be set up.

The board is unable to recognise the logic underlying these assumptions. If the FCC held the boards of appeal not to be empowered to review decisions of the examining division (and possibly other departments of the EPO, such as the opposition division) in the capacity of a court, how could their decisions, as for Germany, possibly constitute a bar to judicial proceedings before a "genuine" court? According to the appellant, decisions by the examining divisions must be subject to judicial review.

Instead, a conceivable option in the event that the FCC found the boards of appeal to provide insufficient judicial relief would be to consider the boards' decisions as decisions in administrative as opposed to judicial proceedings, which by default are subject to judicial review under German constitutional law (Article 19(4) of the Basic Law). It is not clear why a decision by the board on the merits of the present case, presumed to be of an administrative and not a judicial nature, would categorically deprive the appellant of its right to present its case again before an independent judicial body presumed to be set up in the future, or an existing court. Rather, past (i) and present (ii) examples might suggest otherwise.

(i) First, there is the situation of the former boards of appeal (in German: "Beschwerdesenate") of the German Patent Office ("DPA"). In 1959, the

German Federal Administrative Court held the patent office to which the appeal boards belonged not to constitute a court. As a result, the Federal Patents Court was founded. In the meantime, the administrative courts provided an avenue of judicial relief. The events surrounding the creation of the Federal Patent Court were summarised by that court as follows:

The Federal Patent Court is a higher federal court. It was founded on 1 July 1961. Until its establishment, the decisions of the examining sections and of the departments of the German Patent Office concerning the registration or the existence of industrial property rights were solely subject to re-examination by boards of appeal which, from an organisational point of view, were part of the Patent Office and whose members were civil servants. The opinion was held at the time that no legal remedies were available against these decisions. With the entry into force of the Basic Law for the Federal Republic of Germany that opinion was no longer tenable and the status of the boards of appeal needed to be clarified. Article 19 para. 4 first sentence of the Basic Law guarantees that anyone whose rights have been violated by a public authority may have recourse to the courts. On 13 June 1959 the Federal Administrative Court issued a judgment on an administrative action referring to this principle. The Court ruled that the German Patent Office was not a court within the meaning of the law; the **decisions** of its **boards of appeal** were **administrative acts** which could be **contested before the Administrative Court**. Following an Amendment of the Basic Law, the Federal Patent Court was established as an independent, autonomous federal court with effect from 1 July 1961. Like the German Patent and Trade Mark Office, the Federal Patent Court is located in Munich. It is within the remit of the Federal Ministry of Justice.

See "The Federal Patent Court. Tasks | Organisation | Prospects", a brochure published by the President of the Federal Patent Court, Munich 2012, at p. 4, available at [https://www.bundespatentgericht.de/cms/media/Oeffentlichkeitsarbeit/Veroeffentlichungen/Informationsbroschueren/infobroschuere\\_en.pdf](https://www.bundespatentgericht.de/cms/media/Oeffentlichkeitsarbeit/Veroeffentlichungen/Informationsbroschueren/infobroschuere_en.pdf). (Emphasis added.)

(The 1959 judgment of the Federal Administrative Court in case IC 66.57 is published, *inter alia*, in the law review "Gewerblicher Rechtsschutz und Urheberrecht" ("GRUR") 1959, p. 435 and following.)

As a consequence of the judgment of the Federal Administrative Court, thousands of past decisions of the DPA had not yet become *res iudicata* but were subject to review by the German administrative courts. This was because none of those decisions included a communication of the possibility of appeal ("Rechtsbehelfsbelehrung"). Under the Bavarian code of procedure before the administrative courts in force at that time, in the absence of such a communication, decisions could be appealed without any time limit. A federal statute governing administrative court proceedings including a statutory one-year bar for appeals of 21 January 1960 had not yet entered into force when the Federal Administrative Court handed down its judgment on 13 June 1959. (See Völp, Die Reform des Rechtsweges gegen Entscheidungen des Patentamts, GRUR 1960, 205; in English: "Reforming access to judicial review against decisions of the patent office".)

Review without time limit came to an end by virtue of a statute of 17 February 1960 that entered into force on 1 March 1960 (see OJ [BGBl.] 1960,

78, GRUR 1960, 77). According to its § 1(1), decisions ("Beschlüsse und Entscheidungen") of the patent office that had been handed down on or before 13 June 1959 were subject to appeal only until one month after entry into force of that statute, or until one year after notification of the decision if that time limit expired later. Pursuant to § 1(2), third parties were, under certain conditions, granted a use right for an unlimited period of time in return for remuneration of the proprietor of the patent application or subsequent patent.

(ii) Second, in the European Union, the decisions of the European Union Intellectual Property Office (EUIPO, formerly referred to as OHIM) boards of appeal are subject to review by the General Court and, under certain conditions, in addition by the Court of Justice of the European Union. See Article 72 EUTMR (Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ EU L 154/1 of 16 June 2017, available at <https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:32017R1001&from=EN>)). Article 72(1) EUTMR reads: "*Actions may be brought before the General Court against decisions of the Boards of Appeal in relation to appeals.*"

In its judgment of 13 March 2007, C-29/05P, *Arcol*, EU:C 2007:162, para. 51 (available at <http://curia.europa.eu/juris/document/document.jsf?docid=62135&doclang=en>), the Court of Justice made a distinction between the boards of appeal, which remained departments of (the administrative agency) OHIM, and the subsequent possibility of judicial

review before the General Court and the Court of Justice.

(But see the later Opinion of Advocate General Bot of 28 November 2013, C-530/12P, *Mano*, ECLI:EU:C:2013:782, para. 93, according to which the role performed by the boards of appeal was not exclusively administrative. Rather, those bodies performed a quasi-judicial function equivalent to that of national courts deciding on a counterclaim in infringement proceedings. The Court of Justice had given a definition of quasi-judicial bodies before, in its judgment of 31 May 2005, C-53/03, ECLI:EU:C:2005:333, para. 29.)

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These two examples show that board of appeal decisions were or are qualified as administrative rulings in jurisdictions other than that of the European Patent Organisation.

If, similarly, the FCC found the decisions of the EPO boards of appeal in issue to be administrative rulings, then these rulings, under Article 19(4) of the German Basic Law, would, in principle, be subject to review by a court, either an existing one or one to be set up. Alternatively, it might be considered to be an acceptable, more practicable alternative, to make it possible to convert a patent application refused by a board of appeal into a German patent application. This is dealt with in the following section. A further alternative would be to make both options possible.



If the EPO board decisions adopted before any FCC ruling (such as the present one) have legal effect in Germany, in the present board's view, a balance would need to be struck between legal certainty and justice in substance when deciding whether access to a court against such decisions under Article 19(4) of the German Basic Law is to be granted. The balance struck in the wake of the 1959 judgment of the Federal Administrative Court under then prevailing German law for German administrative rulings was set out in point (i) above.

In the light of the foregoing, it is not at all certain that the appellant's assertion can be accepted that it would be deprived of its right to present its case again before an independent judicial body to be set up if the board gave an unfavourable decision in the present case.

- (b) Conversion: fresh proceedings before the German Patent Office and courts

The German legislature may also make it possible to convert refused European patent applications and revoked European patents into national patent applications and patents in accordance with Article 135(1)(b) EPC, which says: "*the central industrial property office of a designated Contracting State shall ... apply the procedure for the grant of a national patent ... in such other cases as are provided for by the national law, in which the European patent application is refused or withdrawn or deemed to be withdrawn, or the European patent is revoked under this Convention.*"

The board asks itself whether if the FCC held that decisions by the EPO departments of first or second (appeal) instance infringed the Basic Law and were not final for Germany, the conversion procedure under Article 135(1)(b) EPC would still be available. The application might then still be considered to have been refused by the examining division or the board of appeal in the meaning of Article 135(1)(b) EPC.

So far, Germany has not enacted provisions within the meaning of Article 135(1)(b) EPC but has enabled conversion into utility models (see the information on the German "Gebrauchsmustergesetz" ("Utility Model Law") in OJ EPO 1987, 175 and the current version of the pertinent § 5 Gebrauchsmustergesetz). However, no consideration will be given to this point as protection of an invention by means of a utility model is substantially inferior to the protection conferred by a patent. Furthermore, the time limit of 10 years from the filing date for effecting the corresponding "derivation" procedure (see § 5(1), third sentence) would have elapsed in the present case (the (international) filing date is 20 April 2006).

If conversion into patent applications (or patents) were made possible, the German part of the European patent application could be converted into a German patent application and be subject to full examination by the German Patent and Trademark Office. Decisions of that office are subject to review by the German Federal Patents Court and, under certain circumstances, by the German Federal Court of Justice ("Bundesgerichtshof").

The consequences of enabling conversion might be considered a practical if not fully equivalent alternative to making review of a European patent application possible for Germany only, or an additional option. The main practical difference might be the delay of the proceedings given that a fresh examination would have to be carried out.

- (c) Thus, the appellant has not established that, in the event of a favourable ruling of the FCC on the pending constitutional complaints, the present board's decision would be final for Germany pursuant to German constitutional law and that the appellant would therefore be deprived of its right to present its case again before an independent judicial body to be set up. (Apart from that it is not clear why, if the appellant were right, a judicial body would need to be set up and no appeal would lie to an existing "genuine" court.) Nor has the appellant mentioned conversion.

7.4.7 Infringement of the appellant's right to be heard pursuant to Article 113 EPC (because it cannot bring its case before a court)

The appellant alleges that (only) if the request for stay of the proceedings were granted, its right to be heard under Article 113 EPC would be safeguarded. This is because in the event of a favourable decision by the FCC, the appellant would be in a position to present its case before an independent judicial body that would have to be set up. The present case on which no final decision would have been given would have to be referred to that body.

This claim must be rejected because it is not directed to a denial of the right to be heard under Article 113 (1) EPC. In effect, the appellant asserts that it cannot defend its case before a court, and thus there is a denial of the right of access to a court provided under Article 6(1) ECHR. Only once the right of access has been established can compliance by a court with the right to be heard come into play. (See also FCC, 2 BvR 1961/09 (re European Schools), point 4, page 22.)

- 7.4.8 "The appellant will have to file constitutional complaints before the national courts of the designated Contracting States" (DE, FR, IT)

This argument is not convincing because the disadvantage would not be a legal one. The appellant must bear the consequences of not stating a case for a stay, including taking action against the present decision, if available, e.g. by means of a constitutional complaint to the FCC, if it perceives this to be appropriate. Given that the present decision on a stay relates to proceedings before the German FCC and any FCC ruling would have immediate impact for Germany only, the question of the availability of and "need" for any similar relief in the two other designated Contracting States, France and Italy, for which protection is sought is moot.

- 7.5 Conclusion on the question of a disadvantage for the appellant in case of non-stay

The appellant has not shown that non-stay would cause a disadvantage for it in that:

- a favourable ruling by the FCC could have legal consequences on the present proceedings (see point 7.4.5 above);
- the present board's decision would be final, and the appellant would therefore be deprived of its right to present its case again before an independent judicial body to be set up (see point 7.4.6 above);
- refusing a stay would infringe its right to be heard (see point 7.4.7 above);
- or that non-stay would cause a legal disadvantage in that the appellant would have to file constitutional complaints before the national courts of the designated Contracting States (see point 7.4.8 above).

#### 7.6 *Overall conclusion*

For purposes of the present decision, it has been assumed, favourably for the appellant, that a stay might be granted to prevent disadvantage for the requester (in case of success of the constitutional complaints) which would be greater than the disadvantage caused (in case of failure of the complaints) if the stay were not granted (see point 7.2.3 above).

As found in point 7.4, the appellant has not shown that non-stay would cause a legal disadvantage for it in case of success of the constitutional complaints.

On the other hand, the consequences of a stay of the present proceedings would impinge on effective judicial

review in the present case by causing a delay of the proceedings. Furthermore, if other boards adopted the same approach, the administration of justice by the boards might become severely hampered and may even grind to a halt.

In absence of an established disadvantage for the appellant, the respective adverse consequences of staying or not staying the proceedings cannot be balanced. Consequently, the request for a stay must be refused.

It follows that the question of whether a stay might be granted on the basis of one of the two alternative theories advanced above (see point 7.2.3) is moot.

8. *Objection under Rule 106 EPC*

If it were held that the boards are not empowered to review decisions of the examining division, the appellant asserts that it would be deprived of its right to present its case again before an independent judicial body to be set up, should the board not grant the request for stay. Therefore, the appellant raises an objection under Rule 106 EPC for infringement of Articles 113 and 112a(2)(c) EPC.

However, this objection is not directed to a denial of the right to be heard under Articles 113(1) and 112a(2)(c) EPC (see point 7.4.7 above).

Furthermore, Article 112a(2)(c) EPC deals with the right to be heard before the board, not an outside court possibly to be set up in the future (see "Case Law", IV.F.3.5, "Rule 106 - obligation to raise objections"). The objection does not relate to the

proceedings before the present board but to hypothetical future proceedings before a hypothetical future court.

As a consequence, the objection is dismissed.

9. In view of the above, none of the appellant's requests is allowable.

## Order

### For these reasons it is decided that:

1. The request for stay of the appeal proceedings is refused.
2. The appeal is dismissed.

The Registrar:

The Chairman:



K. Boelicke

C. Kunzelmann

Decision electronically authenticated