



The determination of technical facts in patent litigation

GRUR Annual Meeting 2017, Hamburg



Boards
of Appeal

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29.09.2017

Introduction

Questions:

- how are the boards of appeal composed (focus on technical boards)?
- what role/s do members play?
- what responsibilities do they have?

Sources:

- European Patent Convention
- Travaux préparatoires
- Practice

European Patent Convention

- **Mixed composition** (legally and technically qualified members):
 - **technical boards** of appeal
 - **Enlarged Board** of Appeal
- No mixed composition:
 - Legal Board of Appeal - 3 legally qualified members
 - not concerned with technical facts and arguments
- Specific mixed composition depends on
 - **type of case** and
 - **issues** involved

European Patent Convention

- **Technical boards – majority technically qualified members** (Art. 21(1),(3)(a),(b) and (4) EPC)
 - appeals against decisions concerning refusal of application or grant, limitation or revocation of patent
 - usual composition: **2 technically** qualified and **1 legally** qualified member/s
- possibility to enlarge to **3 technically** qualified and **2 legally** qualified member/s when ED or OD consisted of 4 members or BoA considers that **nature of appeal** so requires



European Patent Convention

- Compare to composition of the Enlarged Board of Appeal – majority legally qualified members
 - Referral for decision or opinion (Art. 112 EPC)

- uniform application of law

- clarification of **point of law** of fundamental importance



- Petition for review (Art. 112a, R. 104 - 110 EPC)

- a fundamental **procedural defect** occurred

- a criminal act may have had an impact on decision



European Patent Convention - Summary

- determines **composition**
 - technical boards: majority technically qualified members
 - Enlarged Board of Appeal: majority legally qualified members
 - Legal Board: only legally qualified members
- does not determine the **role** that the members play
 - who shall be rapporteur?
 - who shall be Chair?
- all members have the same **responsibility** for a case

Travaux préparatoires EPC 1973 - Art. 21 EPC

▪ Rapporteur

- **technically qualified member** foreseen as rapporteur; no contemplation of legally qualified member as rapporteur; emphasis of legally qualified members on legal issues
- for a long time foreseen: in addition to 3 member board (2 technically and 1 legally qualified member/s) a **technically qualified member who is rapporteur but does not take part in the decision**
- but: deleted from the proposal in 1973
 - addition of this technical rapporteur “unnecessary complication”; rapporteur should simply be one of the members
- designation of rapporteur left to **Rules of Procedure** (which leaves it to Chair)

Travaux préparatoires EPC 1973 - Art. 21 EPC

▪ Chair

- initial proposal: chair has to be a technically qualified member as he/she needs to chair proceedings of a technical nature
- no support for suggestion by French delegation to always have legally qualified members as chairs
- **no determination in final proposal** of whether legally or technically qualified members are chairs

Practice – technical boards

■ Responsibility

- all (3 or 5) members are responsible for all issues in the case; 1 vote per member
- technically qualified members have a high appreciation also of legal issues
 - through experience
 - some through education (EQE or legal studies)
- legally qualified members have a high appreciation also of technical issues
 - through experience
 - some through education (technical studies)

Practice – technical boards

■ Rapporteur

- technically qualified members where case mainly concerns technical issues
 - expertise of technically qualified members particularly important where amendments to claims play a role
 - expertise as previous members of Examining and Opposition Divisions
- legally qualified members are rapporteurs/co-rapporteurs where case/part of case concerns mainly legal issues

Practice – technical boards

▪ Chair

- 28 boards: **no limitation to technically qualified** ones
 - overwhelming majority: technically qualified
 - 3 chairs who are legally qualified (2 in electricity, 1 in mechanics)
- in some individual cases members are assigned as chair:
 - majority - technically qualified,
 - small number of cases - legally qualified members

Conclusion

- boards are **collegiate body** with mixed composition
- technically and legally qualified members have **expertise** in their respective fields that they share in a board; they often have **different roles**
- all board members, including the chair, carry the **same responsibility** for a case
- **all decide on all aspects of the case**