The determination of technical facts in patent litigation
GRUR Annual Meeting 2017, Hamburg

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)

- 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
Committee – 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