PART I

BOARD OF APPEAL ACTIVITIES IN 1996

1. Introduction

In 1996, the total number of new proceedings was 1,185 (1995: 1,076). This represents an increase against the previous year of 10.1%.

Between 1978 and 31 December 1996, a total of 11,710 cases came before the boards of appeal (up to 31 December 1995: 10,525 cases).

Details are given under point 2 below.

The EDP system for appeal proceedings known as APPSYS (Appeal System) and the PALDAS (Patent Law and Decisions Access Support) database for board of appeal decisions were both developed further. For details of the information systems facilitating access to case law, see point 6 below.

2. Volume of work

2.1 Appeals filed and other proceedings before the boards of appeal

2.1.1 Enlarged Board of Appeal

In the year under review no cases were referred to the Enlarged Board of Appeal for a ruling on a point of law (1995: 8 cases).
2.1.2 Legal Board of Appeal

The number of appeals filed with the Legal Board of Appeal was 30 in 1996 (1995: 36 appeals).

2.1.3 Technical boards of appeal

The number of new proceedings (appeals and protests) before the technical boards of appeal totalled 1 127 (1995: 1 016).

There was a total of 1 120 technical appeals (excluding protests) in 1996 (1995: 1 010). The number of inter partes proceedings (opposition appeals) reached 782 (69.8 %), still a substantially higher figure than for ex parte proceedings against examining division decisions (338; 30.2 %). In 1996 the percentage of opposition appeal proceedings rose a little (1995: 68.1 %).

The 1 120 technical appeals received in 1996 were distributed among the boards as follows:

The highest number was again in mechanics with 457/40.8% (1995: 413/40.9 %), followed by chemistry with 331/29.5% (1995: 306/30.3%), physics with 209/18.7% (1995: 175/17.3%) and electricity with 123/11% (1995: 116/11.5%).

In 1996, five boards of appeal were active in mechanics (3.2.1 - 3.2.5) and four in chemistry (3.3.1 - 3.3.4), and two each in physics and electricity (3.4.1, 3.4.2, 3.5.1 and 3.5.2). The number of technical boards of appeal - 13 - thus remained the same as in the previous year.

2.1.4 Protests

The number of PCT protests (Articles 154(3) and 155(3) EPC) settled in 1996 is approximately the same as in 1995 (1996: 7; 1995: 6).

These are low figures compared with previous years and clearly reflect the fact that, since 1 October 1992, PCT protests have had to pass an additional review before the review panel.
2.1.5 Disciplinary matters and European qualifying examination

In 1996, 28 new appeals came before the Disciplinary Board of Appeal (1995: 16 appeals). 25 were against decisions of the Examination Board for the European qualifying examination, one was against a decision of the Examination Board secretariat, and two concerned the rules and regulations governing the patent profession.

2.2 Appeals settled

The number of cases settled in 1996 totalled 911, a fall against the 1995 figure (984). By 31 December 1996 the total number of cases settled had risen to 9,086.

2.2.1 Enlarged Board of Appeal

In the course of 1996, the Enlarged Board of Appeal settled the seven cases that were still pending at the end of 1995.

In all these cases the points of law had been referred to it by a board of appeal:

- Pleading by a person other than an authorised representative during oral proceedings (G 2/94
  
- Interpretation of the concept "new ground for opposition" (G 1/95
  
- Replacement of application documents (G 2/95
  
- Pleading by a person other than an authorised representative during oral proceedings (G 4/95
  
- Applicability of Rule 71a EPC in board of appeal proceedings (G 6/95
  
- Interpretation of the concept "new ground for opposition" (G 7/95
  
- Competence of Legal Board or technical board in appeals against a decision refusing a request under Rule 89 EPC for correction of the decision to grant (G 8/95

On 31 December 1996, therefore, no cases were pending before the Enlarged Board.
For details concerning the case law of the Enlarged Board of Appeal see Part II.

2.2.2 Legal Board of Appeal

The Legal Board of Appeal settled a total of 30 cases (1995: 31). Nine of the appeals were successful, six were dismissed, and 15 were settled in other ways.

2.2.3 Technical boards of appeal

The number of appeals settled decreased slightly, from 938 in 1995 to 862 in 1996.

The proportions of inter partes and ex parte proceedings were 64.3% and 35.7% respectively (previous year: 61.8% and 38.2%).

Of all the cases settled, mechanics accounted for 356 (41.3%), chemistry for 253 (29.3%), physics for 143 (16.5%) and electricity for 111 (12.9%).

Of the ex parte appeals settled after substantive examination, ie not concluded in some other way (inadmissible, withdrawn, etc.), 74.3% were either partially or completely successful and 25.7% were dismissed. In 65.4% of the successful cases it was ruled that a patent was to be granted, in 34.6% that examination should be resumed.

Of the inter partes appeals settled after substantive examination, 44.9% were dismissed. 55.1% were either partially or completely successful. The patent was maintained unamended in 22 cases, maintained in amended form in 133 and revoked in 49. In 34 instances it was ruled that the proceedings should be resumed.

2.2.4 Protests

A total of five protests under Article 154(3) EPC and Article 155(3) EPC were settled in the period under review, compared with eight in 1995. Fees were refunded fully or in part in two cases; three requests for reimbursement were refused.
2.2.5 Disciplinary matters and the European qualifying examination

The Disciplinary Board of Appeal settled seven cases in 1996. All of these were concerned with appeals against decisions of the Examination Board for the European qualifying examination.

2.3 Appeals pending

The total of 2,616 appeals not settled on 31 December 1996 included 2,521 technical cases (ex parte appeals: 741; inter partes appeals: 1,775). At year's end 1995 the total number of appeals pending was 2,341, including 2,265 technical cases.

The average length of technical proceedings was the same as in the previous year, ie 26 months (ex parte appeals: 24 months; inter partes appeals: 27 months). Looking at the figures for appeals pending for more than two years at the end of the year under review, ie filed in 1994 or earlier, the following picture emerges: 1990: 2; 1991: 8; 1992: 33; 1993: 206; 1994: 463.

2.4 Breakdown of appeals and oral proceedings by language

The language used in new appeal proceedings and protests was as follows: English 64%, German 29% and French 7%.

A total of 454 oral proceedings took place in 1996.

The language used in oral proceedings was as follows: English 56%, German 38% and French 6%.

2.5 Involvement of the President of the EPO in appeal proceedings

Article 11a of the Rules of Procedure of the Enlarged Board of Appeal and Article 12a of the Rules of Procedure of the boards of appeal enable any board, on its own initiative or at the request of the President of the EPO, to invite the President to comment in writing or orally on
questions of general interest which arise in the course of proceedings pending before it (OJ EPO 1989, 361, 362).

During the period under review, this option was not used.

**2.6 Statements by third parties in proceedings before the Enlarged Board**

In accordance with Article 11b of the Rules of Procedure of the Enlarged Board of Appeal third parties are allowed to submit written statements (OJ EPO 1994, 443). In 1996, two "amicus curiae" briefs were filed in case G 7/95.

**3. Developments in Directorate-General 3**

1996 saw a changeover at the top in Directorate-General 3 when, after more than 10 years in office, Paolo Gori retired. His successor, appointed by the Administrative Council of the European Patent Organisation, is Peter Messerli, a Swiss national who has also taken over the chairs of the Enlarged Board of Appeal and the Disciplinary Board.

In the year under review the President set up a working party to examine the question whether more specific institutional arrangements are needed to guarantee and to stress in the eyes of the outside world the independence of members of the Enlarged Board and the boards of appeal. The working party, whose members include judges from national courts, met for the first time in October 1996 under the chairmanship of Antje Sedemund-Treiber, President of the German Federal Patent Court.

**4. Number of staff and distribution of responsibilities**

The number of board of appeal chairmen and members was 78 (1995: 79) on 31 December 1996. The 50 technically qualified and 14 legally qualified members were divided amongst 13 technical boards of appeal and one Legal Board of Appeal.

The composition of each board is published in the EPO Official Journal (OJ EPO 1-2) (Rule 10(1) EPC).
The number of staff (excluding the Vice-President and secretariat) totalled 117 on 31 December 1996 (compared with 118 on 31 December 1995).

5. Contact with national courts, applicants and professional representatives

A major event in 1996 was the 8th Symposium of Patent Judges, held on this occasion in Stockholm at the invitation of the Swedish government. The proceedings were attended by more than 70 patent judges from the EPC contracting states, a number of further European countries, the USA, Japan and China, in addition to members of the EPO boards of appeal. Among the topics discussed were novelty, the patentability of plants and animals, and problems with amending patents in the context of the prohibition to extend the scope of protection. The participants agreed on the need to harmonise patent practice. The remarkably well-organised and successful symposium was rounded off by a practical case study, reports on trends in national law, and a plea by a representative of industry for the harmonisation of procedural law relating to patent litigation. The papers and a report on the symposium will be published in the following journals: IIC (English), PIBD (French) and GRUR Int. (German).

Members of the boards of appeal visited colleagues at the courts in Turin and took part in a colloquium of French judges, held in Lyon, on the subject of cross-border injunctions in patent infringement proceedings. They also attended various conferences, and visited a number of firms as well as the European Parliament in Strasbourg. Two board members travelled to China to explain the arrangements for judicial review of decisions by the EPO's examining and opposition divisions and its Legal Division.

6. Information on board of appeal case law

6.1 Publication of decisions in the Official Journal

During the year under review, 36 decisions were published in the EPO Official Journal (compared with 42 in 1995).

By the end of 1996 only 15 decisions were awaiting publication, compared with 21 at the end
of 1995. Publication of new decisions in the year ahead will probably take place within approximately six months of drafting and only one to two months after the headnotes have been completed. In view of this much shorter publication cycle compared with previous years, it is no longer necessary to publish the headnotes in advance. A quarterly index of decisions, listing both those already published and those still awaiting publication, appears in the EPO Official Journal.

6.2 PALDAS full-text database

This EPO database contains the texts - in all three official languages - of board of appeal decisions published in the EPO Official Journal and - in the language of proceedings - of all unpublished decisions of the technical boards with case numbers T nnnn/nn as well as the decisions of the Legal Board. Decisions can be called up by keying in an article, rule or headword, and the full text searched for freely definable text strings. The database is used by personnel in all Directorates-General: board of appeal members, search and substantive examiners in DG 1 and DG 2, Receiving Section staff and formalities officers, lawyers in DG 5 and members of the Language Service. In the year under review, the database was expanded once more. Improvements to the user-friendly interface and the provision of electronic access to search strategies dealing with specific problems have made it easier to find relevant decisions.

6.3 Case law data on CD-ROM

The public can now purchase the following data on compact disc (CD-ROM) under the ESPACE programme: the decisions published in the EPO Official Journal and - in the language of proceedings - the unpublished decisions of the technical boards of appeal with case numbers T nnnn/nn and the decisions of the Legal Board, the Guidelines for Examination in the EPO and important international agreements, as well as the second edition of "Case Law of the Boards of Appeal of the EPO". The discs are designed for full-text searching and updates are issued at regular intervals (at present twice yearly).

Further details can be obtained from the EPO sub-office in Vienna.
6.4 Headnotes and texts of decisions on microfiche

In addition to the new information medium CD-ROM, the long-established microfiche series containing the headnotes and full texts of published decisions plus data on unpublished decisions will continue to be available.

The comprehensive microfiche series with the texts of all technical board of appeal decisions - including those not intended for publication - is updated on a quarterly basis.

Again, further details can be obtained from the EPO sub-office in Vienna.

6.5 Further publications by DG 3

To mark 10 years of Enlarged Board of Appeal case law, past and present members of the board were invited to comment on their work. The collected results were published under the title "The law and practice of the Enlarged Board of Appeal of the EPO during its first ten years - a series of articles reviewing the development of jurisprudence under the European Patent Convention". They provide an instructive picture of the board's activities.

A comprehensive overview of decisions by the boards, covering the period 1978-1995, was published in 1996 under the title "Case Law of the Boards of Appeal of the European Patent Office" and is available from bookshops or direct from the EPO. This information is updated every year in the form of a special edition of the Official Journal. This year’s report provides a systematically structured summary of the important decisions of the boards of appeal in 1996.

The collection of important regulations implementing the European Patent Convention is also obtainable via bookshops or direct from the EPO.

\[\text{OJ EPO 1996, 401.}\]
ii OJ EPO 1996, 615.

iii OJ EPO 1996, 555.


vi OJ EPO 1996, 626.

vii OJ EPO 1996, 481.