

Publication in the Official Journal Yes  No

File Number: T 261/88 - 3.5.2

Application No.: 81 201 022.1

Publication No.: 0 045 117

Title of invention: Apparatus and method for writing a signal information track on a disc.

Classification: G11B 7/00

INTERLOCUTORY D E C I S I O N  
of 28 March 1991

Proprietor of the patent: Discovision Associates

Opponent: N.V. Philips' Gloeilampenfabrieken

Headword: Appealable decision/Discovision

EPC Articles 24, 125

Keyword: "Allegation of suspected partiality against examiner in Opposition Division" - "whether appeal lies on the ground" - "Referral to Enlarged Board".

Headnote

The following questions concerning important points of law shall be referred to the Enlarged Board of Appeal:

I. Following a decision of the director of the directorate to which the Opposition Division administratively belongs, in reply to and overruling an objection by a party to opposition proceedings to a member of the Opposition Division appointed to decide upon a particular case, the objection being on the ground that the member is suspected of partiality, does an appeal lie to the Board of Appeal against such decision?

.../...

II. If the answer to question (1) is yes:

(a) In deciding the question of partiality, do the same considerations apply to a member of an Opposition Division as to a member of a Board of Appeal under Article 24 EPC?

(b) In the present case, what was the effective date of the decision from which the time limit for filing an appeal is to be calculated?

III. In the present case, do the Appellant's objections on the ground of an alleged partiality of a member of the Opposition Division constitute valid grounds of appeal?



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Boards of Appeal

Chambres de recours

Case Number : T 261/88 - 3.5.2

Interlocutory D E C I S I O N  
of the Technical Board of Appeal  
of 28 March 1991

Appellant :  
(Proprietor of the patent)

Discovision Associates  
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Costa Mesa, Calif. 92626  
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Representative :

Raynor, John  
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Respondent :  
(Opponent)

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Representative :

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INTERNATIONAAL OCTROOIBUREAU B.V.  
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Decision under appeal :

Decision of the Opposition Division of the  
European Patent Office dated 19 April 1988  
revoking European patent No.0 045 117 pursuant  
to Article 102(1) EPC.

Composition of the Board :

Chairman : J.A.H. van Voorthuizen  
Members : G.D. Paterson  
W.B. Oettinger

## Summary of Facts and Submissions

- I. European patent No. 45 117 was granted to Discovision Associates: a notice of opposition was duly filed by N.V. Philips Gloeilampenfabrieken, on the ground of lack of inventive step having regard to certain prior published documents, and oral proceedings were requested.

Observations in reply to the notice of opposition were filed on behalf of the patentee (the Appellant), and further observations were filed on behalf of the Opponent (the Respondent). At this stage, a communication pursuant to Article 101(2) and Rule 58(1) to (3) EPC dated 9 March 1987 was issued to the parties by the Opposition Division. This communication referred to a further prior document, in addition to the five documents relied upon by the Respondent, and expressed the view that "the patent is likely to be revoked by virtue of Article 102(1) EPC." The communication was signed by a formalities officer and by the Primary Examiner of the Opposition Division. The parties were invited to file observations in reply.

Observations dated 10 September 1987 were duly filed by the Appellant, who, as a preliminary point, questioned whether the Primary Examiner was the same person who had participated in the prosecution of a previous opposition on behalf of the Respondent company to another European patent also owned by the Appellant company, and requested that if such was the case, the Opposition Division be reconstituted to consist entirely of people who have no previous direct connection either with the Appellant or with the Respondent. In reply, the Appellant received a letter dated 19 November 1987 from a director responsible for the composition of the Opposition Division in question, which

acknowledged that the Primary Examiner had been an employee of the Respondent company and had "represented this company many times in Examination and Opposition Procedures". The letter went on to state that:

- "(1) The only case of exclusion or objection raised by the EPC is stated in Article 24 EPC, which forbids the members of the Board of Appeal to take part in any appeal if they have any personal interest therein, if they have previously been involved as representative of one of the parties, or if they participated in the decision under appeal.
- (2) In examination and opposition proceedings at first instance we try, where this is possible, to exclude examiners from cases from a firm where they have previously been employed. But this cannot always be done. Because of practical difficulties, we cannot exclude (the Primary Examiner) from Examining or Opposition Divisions in the many cases where the Respondent Company is applicant or opponent.

We can, however, give you the assurance that (the Primary Examiner) will act objectively in the present case as well as in similar cases. Anyway, the fact that any Examining or Opposition Division consists of three members is a safeguard for the applicant, the proprietor or the opponent."

This letter was not placed on the file of the opposition, nor is there any indication in the file that it was sent to the Respondent.

A summons to oral proceedings on 23 February 1988 was issued on 29 December 1987.

By letter filed on 11 February 1988 the Respondent stated that it would not attend the oral proceedings. At the conclusion of oral proceedings before the Opposition Division (in which the Primary Examiner remained unchanged), the Decision of the Opposition Division was announced that the patent was revoked. Minutes of the oral proceedings and a written Decision were subsequently duly issued on 19 April 1988, but these documents contain no reference to the Appellant's objection to the composition of the Opposition Division.

II. The Appellant duly filed a notice of appeal on 23 June 1988, and a statement of grounds of appeal on 18 August 1988, in which, in addition to challenging the grounds as set out in the Decision on which the patent was revoked, the Appellant also challenged the Decision on the ground that there had been "undue and unfair (if inadvertent) bias in the conduct of the opposition proceedings, because of the appointment of (the Primary Examiner) for the Opposition Division." In support of this ground, the Appellant contested the implication in paragraph (1) of the letter dated 19 November 1987 that "Article 24 EPC represents the only circumstances in which it would be improper for a member of the EPO to be involved in proceedings of a particular kind", as being "manifestly nonsense, and contrary to natural justice." Reference was made to Article 19 EPC which deals with the composition of an Opposition Division and includes a single exclusion, namely that "an Examiner who has taken part in the proceedings for the grant shall not be the Chairman". It was contended, however, that "There are many other circumstances in which it would manifestly not be in the interest of justice for a member of the Opposition Division to have an interest in the case", and examples of such circumstances were given. In particular, it was contended that an error in judgement or law had been made in this

case by the Opposition Division, "in that it is clearly contrary to natural justice that the main responsibility for the interpretation of the references, and indeed for deciding all the issues in the case, should fall to an individual whose view is coloured by his previous involvement (with the Respondent)." The objection to the

Primary Examiner was "not merely that he formerly acted for (the Respondent) as professional representative (although ... that alone would be sufficient), but that he acted for (the Respondent) in a number of oppositions against (the present Appellant), and concerning technology which is very closely related indeed to the subject-matter of the present (European patent)." The previous involvement of the Primary Examiner on behalf of the Respondent with cases involving the same Opponent, the same patentee and very closely related technology would inevitably affect his approach to the case in favour of the Respondent, as was evidenced by many itemised passages in the Decision of the Opposition Division. Evidence of the involvement of the Primary Examiner on behalf of the Respondent in a closely related opposition in 1985 was filed with the grounds of appeal.

For the reasons outlined above, the Appellant contended that the appointment and continuance of the particular Primary Examiner to the Opposition Division on this case constituted a gross procedural violation; he requested the reimbursement of the appeal fee.

The Respondent filed no observations in reply to the Statement of Grounds of Appeal.

- III. Having regard to these contents of the statement of grounds of appeal, a communication was issued to both parties on behalf of the Board of Appeal, which inter alia suggested

that the following question might be referred to the Enlarged Board of Appeal:

"Following a decision of the director of the directorate to which the Opposition Division administratively belongs, in reply to and overruling an objection by a party to opposition proceedings to a member of the Opposition Division appointed to decide upon a particular case, the objection being on the ground that the member is suspected of partiality, does an appeal lie to the Board of Appeal against such decision?"

IV. In his reply, the Appellant pointed out that if the letter dated 19 November 1987 did constitute an appealable decision, this was certainly not made clear in the letter, and it was suggested that an extension of time should if necessary be granted, for example up to 18 August 1988 when the notice of appeal was in fact filed, in the interests of justice.

V. The Appellant suggested that the following further questions be referred to the Enlarged Board of Appeal:

(1) Is it contrary to natural justice that an individual who has been involved as professional representative for an opponent, and has acted for that opponent in opposition proceedings against the same patent applicant, in a field of technology which is very closely related to the field of technology with which an opposition is concerned should act as a primary Examiner during opposition proceedings?

(2) If the letter from the director did constitute an appealable decision, should an extension of time for lodging an appeal thereto be granted in the interests of justice either to 18 August 1988 or to some



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unspecified future date, and should the appeal filed by the applicant on 18 August 1988 be deemed to constitute an appeal against the said appealable decision?

The Appellant submitted that in any event the alleged partiality of the Primary Examiner constitutes a valid ground of appeal in these appeal proceedings.

- VI. No comments were received from the Respondent within the stated time limit for reply to the Board's communication or at all.

#### Reasons for the Decision

1. Article 112(1)(a) EPC empowers a Board of Appeal, during proceedings on a case, of its own motion, to refer a question to the Enlarged Board if it considers that a decision is required on an important point of law which has arisen. In the present case, the Board of Appeal considers that a decision of the Enlarged Board is so required in relation to certain important points of law which have arisen, as discussed below.
2. As is clear from the Summary of Facts and Submissions above, the Appellant has raised a ground of appeal concerning the alleged partiality of the Primary Examiner of the Opposition Division, which, if accepted, on the basis of previous jurisprudence of the Boards of Appeal, would appear to justify a finding that the Decision issued by the Opposition Division was void and had no legal effect, so that the case would have to be remitted to the Opposition Division for further examination and decision by a properly constituted Opposition Division.

2.1 In this connection, reference is made to Decisions T 390/86 (OJ EPO 1989, 30), T 243/87 (30 August 1989) and T 251/88 (14 November 1989). In the first two of these cases, the composition of an Opposition Division was changed between the issuing of a decision during oral proceedings and the issue of the decision in writing. In the third case, the composition of an Opposition Division was contrary to Article 19(2) EPC, because two of the three members had taken part in the proceedings for grant of the patent to which the opposition related. In all three cases the Board of Appeal ordered that the decision of the Opposition Division should be set aside and that the case should be remitted for fresh examination by a new composition of the Opposition Division.

2.2 However, the present Board of Appeal considers that such an order is not necessarily correct, either in the above three cases or in the present case. A possible contrary view would be that the composition of an Opposition Division is an internal administrative matter, which is not decided by the Opposition Division itself but is an internal administrative "decision" made by the director of the directorate to which the Opposition Division belongs, within the department of the EPO which is constituted by the Opposition Divisions pursuant to Article 15(d) EPC. Such an internal administrative "decision" does not appear to be a decision within the meaning of Article 106(1) EPC and, therefore, does not appear to be a decision which is open to appeal at all.

There is nothing in the EPC which seems specifically to suggest that a member of a first instance department may be excluded from participation in a case or even objected to on the ground that he is suspected of partiality. This is in direct contrast to the position of members of the Boards of Appeal, in that under Article 24(2) EPC a member of a

Board of Appeal may request his own exclusion "for any other reason", and under Article 24(3) EPC may be objected to by a party "if suspected of partiality". Thus, it may be questioned whether a party to first instance proceedings within the EPO has a right even to object to members of that department who are appointed to decide a particular case.

3. In the letter dated 19 November 1987, it appears to be suggested that Article 24 EPC represents the only possible circumstances under the EPC where employees of the EPO may be the subject of exclusion or objection in connection with participation in the making of decisions in proceedings before the EPO. If that is correct, the conclusion in extremis is that all the appointed members of an Opposition Division could be obviously partial to one party without any possibility of remedy. Such a composition of an Opposition Division might justifiably cause dissatisfaction to the other party.

It also appears to be suggested that even if one member of an Opposition Division might not be fully objective, nevertheless, if there are two other members appointed to the Opposition Division who are both impartial, this is a sufficient safeguard for the other party. The Appellant in the present case does not seem to be prepared to accept this, however, and this is certainly understandable. There would seem, in principle, to be no reason why a party to proceedings should be disadvantaged in such a way.

- 3.1 On behalf of the Appellant, it is suggested that there are good reasons for the presence of Article 24 EPC, dealing only with grounds for exclusion or objection in respect of members of the Boards of Appeal: namely, the enshrining within the EPC itself of provisions (Articles 21 to 24 EPC) intended to ensure the independence of the Boards of

Appeal, and intended to guarantee the impartiality of members of the Boards of Appeal, as the final instance of appeal within the EPO which is responsible, inter alia, for the correction of errors of law within the first instance departments. This submission seems to accept that at least a guarantee of impartiality is more important in respect of the Boards of Appeal than in respect of the first instance departments.

- 3.2 Furthermore, the Appellant submits that the participation of the Primary Examiner in the Opposition Division in the present case was contrary to natural justice and wrong.

The concept of natural justice does not specifically appear within the EPC. However, this concept is commonly considered to be within the body of "general rules of law" which are generally recognised in countries such as the Contracting States of the EPC. The right to a fair hearing before an impartial tribunal is well established as in accordance with natural justice and as one of such general rules of law. It was expressed by the ILO Administrative Tribunal, for example, in the following terms (Judgement No. 179, Varnet v UNESCO, 8 November 1971):

"It is a general rule of law that a person called upon to take a decision affecting the rights or duties of other persons subject to his jurisdiction must withdraw in cases in which his impartiality may be open to question on reasonable grounds. It is immaterial that, subjectively, he may consider himself able to take an unprejudiced decision; nor is it enough for the persons affected by the decision to suspect its author of prejudice.

Persons taking part in an advisory capacity in the proceedings of decision-making bodies are equally subject to the above-mentioned rule. It applies also to members of

bodies required to make recommendations to decision-making bodies. Although they do not themselves made decisions, both these types of bodies may sometimes exert a crucial influence on the decision to be taken.

Because of its purpose, which is to protect the individual against arbitrary action, this rule applies in international organisations even in default of any specific text. It follows that, failing any explicit provision in the regulations and rules, the officials concerned are bound to withdraw if they have already expressed their views on the issue in such a way as to cast doubt on their impartiality or if for other reasons they may be open to suspicion of partiality."

Similarly, the World Bank Administrative Tribunal stated in Decision No. 28 (WBAT Reports, 1986) that:

"It is a fundamental rule of both judicial and quasi-judicial procedures that whoever is invited to pass judgement on another must assume his responsibility free from any possible prejudice developed through previous involvement in the case".

The appointment of members of an Opposition Division would seem to be a matter of procedure, and Article 125 EPC prescribes that "In the absence of procedural provisions in the EPC, the EPO shall take into account the principles of procedural law generally recognised in the Contracting States." The points made in the letter dated 19 November 1987 do not include any reference to such generally recognised principles of procedural law (which would seem to correspond to the "general principles of law" referred to above).

If Article 125 EPC is applicable in the circumstances of the present case, it may be that the Strasbourg Convention for the Protection of Human Rights and Fundamental Freedom also gives some guidance on what is generally recognised in the Contracting States as a principle of procedural law, when it states in Article 6(1) that "In the determination of his civil rights and obligations ..., everyone is entitled to a fair and public hearing within a reasonable time by an independent and impartial tribunal established by law." It may be questioned, however, whether a first instance department such as an Opposition Division of the EPO is a tribunal which is required to comply with this Article of the Strasbourg Convention, or with other generally recognised rules of law governing judicial procedures.

4. Thus, the contentions made by the Appellant in his Statement of Grounds of Appeal and in his reply to the Board's communication raise a basic question of law, as to whether or not the alleged partiality of a member of an Opposition Division can be the subject of a ground of appeal to a Board of Appeal. In the Board's view the EPC itself does not provide a clear answer to this important question of law. Consequently, the Board has decided to refer the question to the Enlarged Board of Appeal to ensure uniformity of law.

If such a ground of appeal does lie to a Board of Appeal, further important questions of law arise.

5. If members of a first instance department such as an Opposition Division may be objected to by a party on the ground of personal interest or partiality, the question arises as to the degree of partiality which has to be established in order that such an objection should succeed.

For example, if an appointed member of the first instance department has been previously involved in the drafting of the patent application which is the subject of proceedings before the EPO, should he be excluded from participation in the decision of that department as primary examiner, or should he be excluded from any such participation? If he has recently been previously employed by a party to such proceedings, in matters closely related to the points in issue in such proceedings, but has not been involved in any consideration of the actual patent or application which is the subject of such proceedings, again should he be excluded from participation in the proceedings as primary examiner, or should he be totally excluded? What is meant by "recent" employment by a party in this context? What is meant by a "closely related" field of technology?

These are factual questions of degree, rather than questions of law, and for this reason the Board does not consider it appropriate to refer a question such as question (1) as suggested by the Appellant to the Enlarged Board.

- 5.1 Nevertheless, the fact that the EPC does not contain any provisions concerning the members of first instance departments corresponding to Article 24 EPC concerning members of the Boards of Appeal raises the question whether the same criteria for impartiality are intended to be applied both to members of the Boards of Appeal and to members of first instance departments such as an Opposition Division.
6. Finally, the Appellant's submissions raise important procedural questions (on the assumption that objections to the composition of an Opposition Division can be the subject of an appealable decision).

In particular, a question arises as to what constitutes the appealable decision, and what is its date? Thus, in the present case it is questionable whether the appealable decision in respect of the composition was constituted by the letter dated 19 November 1987 or by the decision dated 19 April 1988. If the letter dated 19 November 1987 was an appealable decision, it did not comply with the requirements of Rule 68 EPC. If the letter dated 19 November 1987 was an appealable decision, it appears to the Board that no extension of time is possible in respect of the time limits set out in Article 108 EPC.

#### Order

For these reasons, it is decided that:

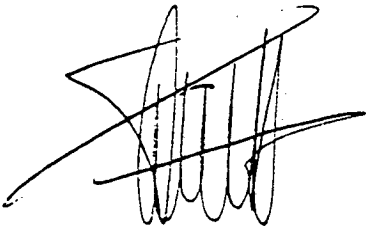
The following questions concerning important points of law shall be referred to the Enlarged Board of Appeal:

1. Following a decision of the director of the directorate to which the Opposition Division administratively belongs, in reply to and overruling an objection by a party to opposition proceedings to a member of the Opposition Division appointed to decide upon a particular case, the objection being on the ground that the member is suspected of partiality, does an appeal lie to the Board of Appeal against such decision?
2. If the answer to question (1) is yes:
  - (a) In deciding the question of partiality, do the same considerations apply to a member of an Opposition Division as to a member of a Board of Appeal under Article 24 EPC?



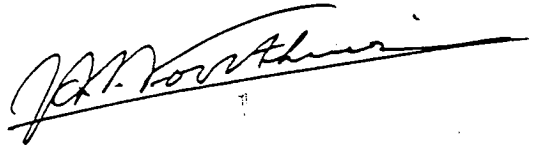
- (b) In the present case, what was the effective date of the decision from which the time limit for filing an appeal is to be calculated?
3. In the present case, do the Appellant's objections on the ground of an alleged partiality of a member of the Opposition Division constitute valid grounds of appeal?

The Registrar:



M. Kiehl

The Chairman:



J.A.H. van Voorthuizen

