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D E C I S I O N
of 26 September 2001

Case Number: T 0276/99 - 3.5.1
Application Number: 93203143.8
Publication Number: 0598442
IPC: H04N 3/32, H04N 3/26, H04N 5/59

Language of the proceedings: EN

Title of invention:

Display device including a correction circuit, and correction circuit for use in said device

Applicant:

Koninklijke Philips Electronics N.V.

Headword:

Publication of patent specification/PHILIPS

Relevant legal provisions:

EPC Art. 23(3), 65, 69, 83, 84, 93, 97(1), 98, 123(2)
EPC R. 27(1), 34(1)(c), 51(4)(5)
TRIPS Art. 41(1)(2), 62(4)
German Law on International Patent Conventions (IntPatÜG)
Art.II(3)
German Basic Law (GG) Article 24(1)
EC Treaty Art. 28 (ex 30), 234 (ex 177)
Vienna Convention on the Law of Treaties Art. 30(3)

Keyword:

"Replacement of parts of the description by a reference to the
A-publication (no)"
"Referral to Enlarged Board of Appeal (no)"
"Referral to Court of Justice of the European Communities
(no)"

Decisions cited:

T 0211/83, T 0150/89, T 1173/97, ECJ C-44/98 BASF,
BVerG Beschl. v.4.4.2001-2 BvR 2368/99

Catchword:

(1) The description is an essential part of the patent specification for the purpose of understanding and being able to carry out the invention (Article 83 EPC) and for determining the scope of the claims pursuant to Article 69 EPC, and parts of the description cannot be replaced by a mere reference to the A-publication (even if this might save on translation costs).

(2) The provisions of the EPC, and the purpose of these, forbidding such replacement are clear, and no serious arguments based on the EC Treaty or the TRIPS Agreement exist which throw doubt on the matter or which raise anything that can be regarded as an important point of law that should be referred to the Enlarged Board of Appeal, let alone the Court of Justice of the European Communities. A reference to the latter would in any case appear to have no basis under the EPC or the EC Treaty Article 234 (ex 177).



**Europäisches
Patentamt**

**European
Patent Office**

**Office européen
des brevets**

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number: T 0276/99 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 26 September 2001

Appellant: Koninklijke Philips Electronics N.V.
Groenewoudseweg 1
NL-5621 BA Eindhoven (NL)

Representative: Kooiman, Josephus Johannes Antonius
INTERNATIONAAL OCTROOIBUREAU B.V.
Prof. Holstlaan 6
NL-5656 AA Eindhoven (NL)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 22 February 1999
refusing European patent application
No. 93 203 143.8 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: S. V. Steinbrener
Members: H. Preglau
S. C. Perryman
R. S. Wibergh
R. Randes

Summary of Facts of Submissions

- I. The application under consideration was filed on 11 November 1993.
- II. In a communication dated 7 March 1997 the Examining Division raised objection to Claims 1 and 7 under Article 84 EPC and also indicated that some amendments were required to the description, in particular that prior art document EP-A-0 324 991 needed to be acknowledged and briefly discussed in the introduction.
- III. On 5 August 1997 an answering submission and new pages 1 to 4 were filed, with pages 1 and 2 containing an introduction and brief discussion of the prior art and ending in a paragraph reading:

"Reference is made to the Article 93 publication (EP-A-0,598,442) of this application for a description in detail of at least one way of carrying out the invention claimed using examples and referring to drawings, that has to be taken into account for the purposes of Articles 69 and 83."

Pages 3 and 4 contained only an amended set of claims 1 to 7. It was requested as main request that a patent be granted on the basis of enclosed pages 1 through 4, as first auxiliary request that a patent be granted on the basis of enclosed pages 1 through 4 in which page 3, line 27 through page 4, line 9 of the description as filed were reinserted, and the drawing sheets 1/1 [sic] through 3/3 as filed, as second auxiliary request that a patent be granted on enclosed pages 1 through 6 [sic], in which page 3 line 27 through page 9, of the description as filed were reinserted, and the drawing

sheets 1/1 through 3/3 as filed. If the Examining Division were not prepared to allow the main or first auxiliary request, but were willing to allow this second auxiliary request, they were asked to give an appealable interim decision stating that the first two requests were refused but that the application in accordance with the second auxiliary request met the requirements of the EPC. The third auxiliary request was for oral proceedings.

IV. The arguments made in support of these requests were substantially as follows:

- In view of Rule 34(1)(c) the description and the drawing sheets had been replaced by a reference to the A-publication of the application. It was believed obviously unnecessary and a mere waste of ink, paper and CD-ROM storage space, to repeat in the B-publication information which was already present in the A-publication.
- Article 65 EPC allowed a Contracting State to prescribe that the specification of a European patent be translated into one of its official languages if the patent was not granted in such a language. Since all major Contracting States prescribed such a translation, the grant procedure of a European patent had become costly. Investigations of the use of translations had revealed that they were hardly ever consulted. Hence, translation costs were not only high but unnecessary.
- The TRIPS Agreement had entered into force for all EPC Contracting States on 1 January 1996 and had

to be taken into account when applying the EPC in view of customary international law as codified in Article 30(3) of the Vienna Convention on the Law of Treaties.

- Articles 62(4) and 41(2) of the TRIPS agreement prescribed that procedures concerning the acquisition of intellectual property rights should not be unnecessarily complicated or costly. The high and unnecessary translation costs for obtaining grant of a patent under the EPC violated this.
- The proposed replacement would reduce such unnecessary translation costs and was justified under the TRIPS agreement.

V. On 21 January 1999, the Examining Division issued a communication pursuant to Rule 51(4) EPC indicating the text and drawings on which they intended to grant the patent. This corresponded substantially to the second auxiliary request of 5 August 1997 (cited in point III above) but with the reference to the Article 93 EPC publication (cited in point III above) deleted.

VI. In an annex to this communication, the Examining Division commented on the requests before it to the effect that:

- Rule 34(1)(c) EPC was seen as a questionable legal basis for substituting the description by a reference to the A-publication. The purpose of Rule 34(1)(c) EPC was to keep the patent specification free of unnecessary information to make sure that its content related only to what

was invented and what protection was sought for. Therefore matter which was irrelevant from the beginning or became irrelevant during the examining procedure (for example embodiments which were not new) fell under Rule 34(1)(c) EPC and should be deleted.

- The part of the description for carrying out the invention was however an essential part of the application, as shown by Rule 27(1) EPC defining the content of the description. The description must sufficiently disclose the invention to meet the requirements of Article 83 EPC, and it must provide the support for the claims required by Article 84 EPC. Therefore, none of the parts of the description mentioned in Rule 27(1) EPC as a whole could be regarded as irrelevant in the sense of Rule 34(1)(c) EPC, and this rule provided no justification for replacement of disclosure by a mere reference to another document.

- It was a basic principle that a patent specification should be understandable on its own such that all essential aspects of the invention were present in the specification itself and did not need to be searched for elsewhere. The amendments made according to the main and first auxiliary requests of 5 August 1997 would violate this principle, since a reader of the patent specification would also have to consult the A-publication in order to get information on the invention.

VII. The Examining Division also indicated that the reference to the A-publication in the second auxiliary

request of 5 August 1997 was completely superfluous, and thus had been deleted pursuant to Rule 34(1)(c) EPC.

VIII. By letter of 4 February 1999 the appellant indicated that it did not approve of the proposed text for grant.

IX. By a decision dated 22 February 1999 the application was refused pursuant to Article 97(1) and Rule 51(5) EPC by reason of the EPO having received the applicant's express disapproval of the proposed text for grant, and there being no text to serve as a basis for grant.

X. Against this decision an appeal was lodged on 1 March 1999 and the appeal fee was paid the same day. A statement setting out the grounds of appeal and containing detailed argumentation and requests was filed on 11 March 1999. The following legal questions were proposed for referral to the Court of Justice of the European Communities and/or the Enlarged Board of Appeal on page 7 of the statement of grounds:

1. Is it necessary to take EC law into account in the interpretation and application of the EPC?
2. It is [sic] necessary to take the TRIPS Agreement into account in the interpretation and application of the EPC?
3. Is it allowable to replace those parts of a European patent application that have not been amended by a simple reference to the corresponding A-publication for the purposes of Articles 69, 83 and 84 EPC as well as Rule 27 EPC?

XI. On the 11 May 2001 the Board issued a communication indicating its provisional view that the EPC made clear that the patent specification as published had to contain the description and not merely a reference to another document containing this, and that there was no need to refer any legal questions. The appellant filed a written response on 19 July 2001.

XII. Oral proceedings were held on 26 September 2001. The appellant's submissions made in writing and at the oral proceedings in addition to those already submitted to the Examining Division (see point IV above) can be summarized as follows:

Rule 34(1)(c) EPC

- Even though it was agreed that the information it was proposed to give only by reference to the A-publication was extremely relevant for the purposes of Articles 69, 83 and 84 EPC, it was obviously unnecessary within the meaning of Rule 34(1)(c) EPC to repeat in the B-publication what was already easily available to the public by means of the A-publication, so that in the B-publication a simple reference to the A-publication would suffice.

Article 98 EPC

- What was required to be published was not clear, and needed to be interpreted in the light of all treaties which had to be taken into account when interpreting the provisions of the EPC. This raised important questions of law.

Rule 27 EPC

- The reference to the A-publication would also meet the requirements of Rule 27 EPC. The requirements of Rule 27(1)(a)-(c) EPC are fulfilled by what is left in the description and the requirements of Rule 27(1)(d)-(e) EPC would be fulfilled by the reference to the A-publication.

TRIPS

- The TRIPS Agreement being an intellectual property law treaty of later date than the EPC, and all EPC Contracting States (except Monaco) being members to this later treaty, by virtue of (customary law as codified in) Article 30(3) of the Vienna Convention on the Law of Treaties, the TRIPS Agreement prevailed over the EPC.
- The EPC was primarily a tool for the 15 EPC Member States also members of the EC to fulfill their EC obligations in a manner compatible with the EC treaty, a legal situation accepted by the other EPC Member States. Thus the system of law mentioned in Article 1 EPC is a system that is subject to EC law, so the EPO must observe conventions such as the TRIPS Agreement to which the EC has become a party, and whenever a question on the interpretation of EC law needs to be answered by an EPO Board of Appeal or by the Enlarged Board of Appeal, that Board has to apply Article 177 EC Treaty (now Article 234) and refer a legal question to the EC Court of Justice.
- The TRIPS Agreement contained provisions relevant

to patent acquisition procedures. As had been rightly observed by the German Bundesverfassungsgericht, the EC had delegated its patent granting tasks to the EPO. See its decision dated 4 April 2001 published in GRUR 2001, Heft 8, pages 728 to 730, especially the first paragraph at bb) in the left column on page 729. So the relevant EC law as regards patent granting procedures was the EPC, which meant that where the EPC was not yet compatible with the TRIPS Agreement, the EPC had to be amended, and that in the mean time, as much as possible, the EPC had to be interpreted in line with the TRIPS Agreement.

- The mentioned decision by the German Bundesverfassungsgericht was relevant in another respect: it said that the EC had **delegated** functions to the EPO. This statement underlined that the EPO's power to grant patents was not an original power; it was a power that was derived from those who gave that power to the EPO, i.e. the EC and the EPC Contracting States. Because of the generally accepted legal principle *nemo dat plus quam habet* (nobody gives more than he has), the power given to the EPO was subject to the same limitations as the original powers of the EC and the EPC Contracting States, as the EC and the EPC Contracting States were simply not able to give unlimited powers to the EPO. The EPC Contracting States that are EC Member States were bound by EC law (of which the TRIPS Agreement formed part), so that they could not give a power to the EPO to grant patents that was not limited by EC law (including the TRIPS Agreement) in the very same manner as they were bound themselves. As the power

of the EC and all EPC Contracting States but Monaco to grant patents was subject to the TRIPS Agreement, so was the EPO's power to grant patents.

- The fact that the absence of an obligation to translate patent specifications did not cause any problems in Luxembourg or Monaco, and had caused no problems in Germany or Britain in relation to European Patents granted before an obligation to translate existed in these countries, showed that the obligation to translate caused unnecessary costs contrary to Articles 62(4) and 41(2) of the TRIPS Agreement.

Article 30 EC Treaty

- The requirements to translate the full text of a granted patent combined with the requirement of the Examining Division to keep the full text of the application as filed, resulted in a situation in which it was not affordable to obtain patent protection for the whole Internal Market, and thus these requirements amounted to a violation of Article 30 EC Treaty (now Article 28).
- Even though the decision of the Court of Justice of the European Communities (European Court of Justice - ECJ) C-44/98 BASF did admittedly decide that the translations provided for in Article 65 EPC are not barred by Article 28 EC Treaty, this court had not decided on whether the TRIPS Agreement would no longer allow this, as that question was not before the court, which was confined to answering the questions that were put

to it.

XIII. At the close of debate the requests on which the appellant asked the Board to decide were as follows:

That the decision under appeal be set aside and

as main request that a patent be granted on the basis of the main request filed with the Examining Division on 5 August 1997, or

as first auxiliary request on the basis of the first auxiliary request filed with the Examining Division on 5 August 1997, or

as second auxiliary request to refer legal questions, in particular those set out on page 7 of the Grounds of Appeal of 5 March 1999 to the Court of Justice of the European Communities and/or to the Enlarged Board of Appeal, or

as third auxiliary request to grant a European patent on the basis of the Communication under Rule 51(4) EPC dated 21 January 1999.

XIV. At the end of the oral proceedings, the Board's decision was announced.

Reasons for the Decision

Admissibility

1. The appeal is admissible, as the appellant was a party to the proceedings before the first instance, and on a

broad view is adversely affected as a patent on the basis of the text he primarily wanted has been refused. The formal time limits of Article 108 EPC have also been observed.

Main and first auxiliary requests

2. Article 93 EPC requires the European Patent Office to publish the European patent application, containing the description, claims and drawings as filed. Article 98 EPC requires the European Patent Office to publish a specification of the European patent containing the description, claims and any drawings. Article 93(1) EPC even provides that the European patent application be published simultaneously with the publication of the specification of the European patent when the grant of the patent has become effective before the expiry of the time limit for publishing the European patent application. Both types of publication are required, and one cannot serve as a substitute, in whole or in part, for the other, as indicated by the legislator requiring both to be published even in these special circumstances.

3. The patent specification is the document of most critical importance to the legal rights that are created and can be enforced under a European patent in force in any particular member state. As stated in decision T 150/89 (see Case Law of the Boards of Appeal of the European Patent Office 4th ed. 2001, page 390), the patent specification reproduces the decision to grant a patent as regards existence and scope of the patent. The patent specification is an official document published by a public authority for general information and as such has legal force before the

courts. The description and claims as appearing in the patent specification will have been examined and allowed by the European Patent Office, and normally contain text that differs from the original application. The patent specification (or a translation of it into an official language of the Member State concerned) will be the prime document used by a court to determine what legal rights exist and whether there is infringement or not. Article 69 EPC and the protocol thereon make the description and drawings of critical importance for interpreting the scope of protection determined by the terms of the claims. It is thus imperative that the description and drawings be as complete as necessary for this purpose.

4. Not even the appellant is arguing that the drawings and the parts of the description that he seeks to incorporate in the patent specification by a mere reference to the publication under Article 93 EPC ("A-publication"), are not of importance for the purposes of Articles 69 and 83 EPC, as is apparent from the very form the reference to the A-publication takes (see point III above). Something which is critical for the understanding of the invention should appear in the patent specification, and not be incorporated by a reference. Where a reference in the description is to published prior art, a mere reference may be sufficient as such prior publication will not normally relate to the essence of the invention. Even in such a situation it may be necessary that for ease of consultation some prior published information should appear explicitly in the patent specification rather than by a mere reference (see decision T 211/83 of 18 May 1984, not published in OJ EPO).

5. Substituting an admittedly essential part of the description by a reference to the A-publication would simply impose an added burden on all who had to look at the patent specification and might introduce considerable uncertainty. When considering novelty of a patent over a prior art document referring to another prior art document for details, the boards of appeal have had considerable experience of the difficulties that arise when trying to ascertain what the combined disclosure amounts to. To allow the introduction of a reference to the A-publication could give rise to similar difficulties, and is not something that should be inflicted on users of the system. It is quite inconsistent with the purpose of examination to end up with a reference to the unexamined text.

6. The preparatory discussions which led to the EPC (see for example Minutes of the Munich Diplomatic Conference for the Setting up of a European System for the Grant of Patents (Munich, 10 September to 5 October, 1973, M/PR/I paragraphs 395 to 406, in particular 398) state explicitly that the reason for choosing the very long period of nine months from grant in which oppositions may be filed, was to allow interested parties in Contracting States to see a translation into their own language before deciding whether to oppose or not. Without a translation of the full description, which is frequently the only part of the specification which can be readily understood, and which is essential for the correct understanding of the claims, such parties would be at a serious disadvantage when considering whether or not to file an opposition.

7. The Board concludes that the substitution of a reference to the A-publication for the drawings and at

least part of the description in the patent specification is not allowable under the European Patent Convention taken by itself. The Board does not agree with the appellant that the matter is unclear or in need of interpretation: what the appellant is seeking is simply not in accordance with the requirements of the EPC.

TRIPS Agreement related arguments

8. Leaving aside for the moment the question whether the EPC must be interpreted so as to be in conformity with the TRIPS Agreement, and this has been doubted (see decision T 1173/97 OJ EPO 1999, 609), the Board will first consider whether there is any serious argument that its above view of the requirements of the EPC is not in conformity with the requirements of the TRIPS Agreement.
9. The main line of argument of the appellant is not that substitution of the description makes sense in the context of the EPC, but that the TRIPS Agreement Articles 62(4) and 41(2) forbid imposing unnecessarily complicated or costly procedures concerning the acquisition or enforcement of intellectual property rights, that Article 65 EPC allowing member states to require translation of the patent specification amounts to an unnecessarily costly procedure, and that this should serve as an excuse for the appellant to substitute part of the description by a reference to the A-publication and thereby save on some translation costs.
10. The appellant's argument, according to which the reference to the A-publication is supposed to make this

an integral part of the patent specification for the purposes of Articles 69 and 83 EPC, but not for the purpose of Article 65 EPC is highly ambivalent. Which line is taken seems to be based on no principle other than expediency for the patentee: the description is to be taken into account as important if it benefits the patentee (that is for the purposes of Articles 69 and 83), but not if this might impose a burden on the patentee (translation of the description for the benefit of others). This ambivalent argumentation seems quite inappropriate to the Board, who considers that the appropriate view must be univalent, namely the description is always important, whether this is to the benefit of the patentee or not.

11. The point of the EPC route, compared to obtaining national patents via a national route, was to allow the applicant to proceed with an application in only a single EPC official language. Only on grant would any necessity for translations arise for those Contracting States for which the applicant at that stage wanted a patent but which did not accept texts in the official language of the application at the EPO. This avoided the need to obtain translations for applications that were refused, and shifted the need for translations to a much later time than before, and then only for countries in which the patentee was still interested. Prima facie this seems in conformity with TRIPS. That different languages are in use in different parts of the EU and that thereby communication is more difficult and expensive are facts. The Board cannot see that TRIPS was intended to shift the burden of providing patent specifications that were understandable in the area in which the patent was to be in force from the patentee to the other users of the patent system. The

appellant has not referred the Board to the views of any other person to the effect that TRIPS is incompatible with requiring translations.

12. When viewing the obligation of providing a translation, the Board considers as appropriate the viewpoint of a patentee who seriously contemplates having to enforce his patent. From that point of view the requirement that the whole patent specification, including the complete description, be translated into at least one official language of the Member State concerned, as used by its courts, seems eminently reasonable. In fact the obligation of Article 41(1) of the TRIPS Agreement that members shall ensure that enforcement procedures are available under their law so as to permit effective action against any act of infringement of intellectual property rights, including expeditious remedies to prevent infringements, could well be argued as positively imposing a duty on member states to require a translation into a language used by their judicial authorities. Obviously if a patentee only wants a patent for little more than wallpaper with no expectation that anybody will bother to read it in any language, then requiring translations adds considerably to the costs of such "wallpaper", but this cannot be the typical case to be considered.

13. Further even if a reference to the A-publication were substituted for the description, or part of it, Article 65 EPC might well be interpreted by the authorities of a Member State as entitling them in those circumstances to demand a translation of the complete A-publication as an essential part of the text in which the European Patent Office intended to grant the patent. In such case, the appellant's efforts to

evade the translation costs would have failed, while the disadvantageous result of all dealing with the patent specification having to piece together a complete text for themselves would remain.

14. When the European Court of Justice decided its case C-44/98 BASF (www.curia.eu.int/jurisp), the Court held that Article 30 (now 28) of the EC-Treaty does not preclude provisions such as Art. II(3) of the German Law on International Patent Conventions (IntPatÜG) requiring translations of patent specifications published in another than the official language of the Member State. The Attorney General Antonia La Pergola even commented in § 15 (citing the Finnish Government) that it must be doubtful if there is a general public interest in having patents whose economic value is so low that they are not worth obtaining for the patentee (because of translation costs). The Board does not overlook the fact, that the question brought before the Court of Justice was one concerning a German legal provision. But this German legal provision is based upon Art. 65 EPC and therefore the Court considered EPC- provisions as well (§§3 to 6 of cited decision). The Court of Justice did not express any reservations against the EPC-provisions in this context.

15. The Boards of Appeal are bound by the provisions of the EPC (Article 23(3) EPC). What the appellant is seeking in his main and first auxiliary requests is against these provisions, and the Board cannot regard the appellant as having made out any serious case by reference to the TRIPS Agreement or the EU treaties that might justify allowing something forbidden by the EPC.

16. The main and first auxiliary requests thus must be refused.

Second auxiliary request

A *Referral to the Court of Justice of the European Communities*

17. Under the EC Treaty referrals to the Court of Justice of the European Communities are governed by Article 234 (ex Article 177) reading:

"The Court of Justice shall have jurisdiction to give preliminary rulings concerning:

- (a) the interpretation of this Treaty;
- (b) the validity and interpretation of acts of the institutions of the Community and of the ECB;
- (c) the interpretation of statutes of bodies established by an act of the Council, where those statutes so provide.

Where such a question is raised before any court or tribunal of a Member State, that court or tribunal may, if it considers that a decision on the question is necessary to enable it to give judgement, request the Court of Justice to give a ruling thereon.

Where any such question is raised in a case pending before a court or tribunal of a Member State against whose decisions there is no judicial remedy under national law, that court or tribunal shall bring the matter before the Court of Justice."

Prima facie as the EPO Boards of Appeal are not a court or tribunal of an EU Member State, they do not have the

status to refer a question to the Court of Justice of the European Union. Further the question that this Board has to decide directly is what the European Patent Convention requires for the description of a patent to be granted. On the wording of Article 234 this does not fall under any of the headings (a), (b) or (c) setting out the jurisdiction of the Court of Justice to give preliminary rulings.

18. The appellant seems to have misunderstood the comments of the German Bundesverfassungsgericht (BVerfG (4. Kammer des Zweiten Senats), *Beschl. v. 4.4.2001- 2 BvR 2368/99*, published in *GRUR* 2001, Heft 8, pages 728 to 730). A fuller translation of point bb) at page 729 would be:

"The European Patent Organisation is an interstate institution in the sense of Article 24 I [sic] of the Basic Law (Grundgesetz). It is an organization "on the fringes of the EU" (T. Oppermann, *EuropaR.* 3. Aufl., Rdnr. 461) having legal personality under international law, to which the exercise of functions of the European Community has been delegated, without it yet having become part of the European Union..."

The point is that the delegation referred to here is the delegation of powers to the EPO directly by the EPC Contracting States who are also members of the EU, and not any delegation from the EU itself. There is also delegation of powers by the non-EU Contracting States. Because the European Patent Organisation is not part of the European Union institutions, and because the delegation of powers by the non-EU Contracting States is to the EPO but not to the European Union or its institutions, there exists no obvious basis for

referring a question to the Court of Justice of the European Communities from a Board of Appeal of the European Patent Office.

19. The real grievance of the appellant seems to be against the practice of Contracting States also members of the EU in exercising their rights under Article 65 EPC. This is something that would be open to challenge in national proceedings before the courts of an EU member state. Indeed such a challenge was made before a German court, who did refer the matter to the Court of Justice. The challenge failed (see point 14 above). It is true that incompatibility was only argued with Article 30 (ex 28) of the EC Treaty, and not in relation to TRIPS, but TRIPS appears then already to have been in force. That the point in relation to TRIPS was neither argued before nor decided by the German Court or the Court of Justice, might be explained not because the point was overlooked, but because the TRIPS related arguments were considered devoid of chances of success. In the circumstances the Board sees neither a *prima facie* basis nor any need to refer any question to the Court of Justice.

B *Referral to the Enlarged Board of Appeal of the European Patent Office*

20. On the issues that can be decided in this appeal the Board sees no important question of law arising, such as might require a referral to the Enlarged Board of Appeal. Whether and to what extent, and at what level, the Boards of Appeal should take into account the TRIPS Agreement or EU law, or refer questions of law to the EC Court of Justice, are important questions of law that might need to be referred to the Enlarged Board of

Appeal in some future case. Here however what the appellant is seeking in the main and first auxiliary request is so clearly contrary to the EPC, and the arguments seeking support for a different conclusion based on the TRIPS agreement or the EC treaty so feeble and farfetched that they cannot be treated as raising an important question of law. Thus a reference to the Enlarged Board of Appeal is not justified.

Third auxiliary request

21. The Board sees no objection to the patent being granted in the form proposed by the Examining Division.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The request for referral of legal questions to the Court of Justice of the European Communities is refused.
3. The request for referral of legal questions to the Enlarged Board of Appeal is refused.
4. The matter is remitted to the Examining Division with the order to grant a patent on the basis of the text accompanying the Communication under Rule 51(4) EPC dated 21 January 1999.

The Registrar:

The Chairman:

M. Kiehl

S. V. Steinbrener