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1. Co-existence of independent jurisdictions

As an international organisation, the European Patent Organisation has an autonomous legal system of its own, which is independent of the national legal systems of the Contracting States.

The Boards of Appeal which are the courts of final jurisdiction within the legal system of the European Patent Convention (EPC). The jurisdiction of the EPO over European patents ends with their grant or with the conclusion of the opposition proceedings, if any. After grant national authorities assume responsibility for assessing the patent's validity and scope with effect for their territory. National authorities have independent national jurisdictions over the European patents. And, any co-existence of independent jurisdictions inevitably has a certain potential for conflict.

National revocation authorities are therefore not bound under the Convention by any decision of the European Patent Office maintaining a patents. Neither are they bound by any interpretation of the Convention emanating from the EPO but may interpret its provisions as they see fit.

Conversely, the boards of appeal are not formally bound by decisions of national courts.

There is no formally binding law provisions.

The European Patent Convention does not have, so far, an integrated judicial system for the Contracting States with a common court of appeal. In these circumstances, the co-existence of a plurality of independent jurisdictions involves the risk of different decisions on the validity of European patents and of conflicting interpretations of the Convention.

Therefore, the task of harmonisation rests on the shoulders of both the EPO and the national courts.
As far as the Boards of Appeal are concerned, they are well aware of this fact. In its very first decisions which concerned second medical use claims, the Enlarged Board emphasised that, to ensure uniform interpretation of the harmonised patent law, it was incumbent on the EPO, and particularly on the Boards of Appeal, to take into consideration the decisions and opinions of courts and industrial property offices in the Contracting States.

2. Bodies responsible for interpreting the European Patent Convention

The national courts and the Boards of Appeal are basically those bodies which are responsible for implementing and interpreting the EPC.

The boards of appeal decide on appeals against decisions of the EPO's first-instance departments. The national courts hear actions for proceedings for infringement of European patents and revocation proceedings against them.

Both courts too are bound by the substantive provisions of the EPC.

The basic rule for the post-grant life of the European patent is laid dawn in Article 2(2) EPC:

"The European patent shall, in each of the Contracting States for which it is granted, have the effect of and be subject to **the same conditions as a national patent** granted by that State **unless otherwise provided in this Convention.**"[1]

The post-grant life of the European patent has been subject on

[1] In other words, as for the effect and conditions of European patents, where nothing is foreseen in the EPC, national legislation applies. In this regard, this is the only provision on the order of prevalence between national legislation and the EPC.

several points to a **common regime** laid down in the EPC. It is what it has been called **EPC "standard rules"**[2]. As it announced in the second Recital of the Preamble, the Convention contains

"certain standard rules governing patents so granted".

Therefore, the Boards of Appeal and national courts are therefore sometimes called upon to decide the same or similar questions on the basis of similar or the same provisions. Both a European court and national courts apply to European patents the provisions of the EPC pertaining to novelty, inventive step, exceptions to patentability, interpretation of claims, and the like (as well as the provisions of the CPC). That is, they apply the EPC "standard rules", which in its turn are normally incorporated in the national patent laws of the Contracting States.

These provisions concern the rules as follows[3]:

(a) the term of the patent which is set out at twenty years.
(b) a limited number of grounds for revocation of the European patent (Article 138 EPC).
(c) the rules on patentability are part of these standard rules as Article 138(a) EPC make express reference to them (Article 52 to 57 EPC).
(d) Article 64(2) EPC for the protection of the patent process
(e) Article 69 EPC and its Protocol on the Interpretation on the

[2] See for instance, a decision of the German Federal Court of Justice held that the principles expressed in the Protocol of Article 69 EPC must be considered in determining the extent of the protection conferred by Germans patents (OJ EPO 1987, 551).

[3] The provisions are self-executing and does not depend upon implementing legislation.

> extent of protection.
>
> On the other hand, there is no legal framework (ie no European Court) for unifying and harmonising court decisions on patent matters in Europe.

However, the Preamble to the EPC emphasises the "co-operation between the States of Europe in respect of the protection of inventions". Thus, the principle of harmonised interpretation as a factor for interpreting patent law has become an essential method of interpretation used by the Boards of Appeal, the Enlarged Board of Appeal and in the courts of the Contracting States. In this respect, see the Enlarged Board of Appeal decision **G 5/83.**

3. Significance of the decisions of the Boards of Appeal for interpreting the EPC.

The decisions of the Boards of Appeal of the EPO are of crucial importance:

(a) The Boards of Appeal are in a better position than national courts as the number of disputes on infringement and revocation of European patent is smaller than those connected with the granting of European patents.

(b) The Boards of Appeal (including the Enlarged Board of Appeal) are expert courts. In the House of Lords' judgment of 26 October 1995 (Merrill Dow Pharmaceuticals Inc. at al. v. H.N. Norton & Co. Ltd.), Lord Justice stated:

> "These decisions [of the Boards of Appeal] are not strictly binding upon courts in the UK but they are of great persuasive authority ... because they are decisions of expert courts involved daily in the administration of the EPC"

(c) A European patent application and a granted patent have effect in a number of European States. If a European patent is refused or

revoked by an EPO Board of Appeal, there is no possibility of rectification or review. The decision is final.

(d) Matters of procedure and substantive patent law within the European Patent Office are normally brought into line with the relevant decisions issued by the Boards of Appeal. As a rule, the "Guidelines for Examination in the EPO" issued by the President of the Office are adjusted or amended accordingly. Therefore, the jurisprudence of the Boards of Appeal is normally followed by the first instance departments of the EPO
(e) The members of the Boards of Appeal are independent (see Article 11 EPC on their appointment). Moreover, Article 23(3) EPC states that "In their decisions the members of the Boards shall not be bound by any instructions and shall comply with the provisions of this Convention".

The Boards of Appeal have issued a large number of decisions. The most important decisions of the Boards of Appeal are published in the Official Journal of the EPO, either in full or in abbreviated form. All decisions of the EPO are accessible to the public. Non-reported decisions may be consulted in the EPO Library and copies may be obtained on payment of the photocopying costs. The EPO also publishes an Annual Report on the jurisprudence of the Boards of Appeal and the compilation "Case Law of the Boards of Appeal of the European Patent Office". A CD-ROM on the case law of the Boards of Appeal is also available.

4. The Enlarged Boards of Appeal

Even within the restricted framework of grant and opposition proceedings before the EPO, no absolute guarantee for uniformity is provided. Indeed, no appeal lies from the decisions by the Boards of Appeal.

Uniformity is provided by the Enlarged Board of Appeal (Article 112). It should be stressed that this is not a further appeal. Nor does it ensure harmonisation of interpretation of the EPC with that of

national law.

It is the Boards, not the parties, which decide whether a question will be submitted to the Enlarged Board.

The President of the EPO may also refer a point of law to the Enlarged Board where two Boards have given different decisions on that question.

According to Article 112(1) EPC, both grounds are subject to the condition that a referral is made "in order to ensure uniform application of the law or if an important point of law arises", but always within the framework of the EPC.

5. Significance of the decisions of the national courts

The reasons for the significance of the national courts are as follows:

(a) The national courts and the Boards of Appeal are basically those bodies which are responsible for implementing and interpreting the EPC. This task is done first by the Boards of Appeal within the framework of the European grant procedure, but this leaves considerable room for diversity in European patent case law. Indeed, the task of interpreting the EPC is ultimately in the hands of the national courts.

(b) Post-grant proceedings relating to European patents (in particular, infringement and revocation) are subject to the jurisdiction of national courts.

(c) National courts no longer operate exclusively in their national context, but in the context of the EPC. Therefore, in interpreting national patent law, the factor of the harmonisation of European patent law has been taken into account, and in some cases patent law provisions have been interpreted in a similar manner.

It must, however, be made clear that neither the Boards of Appeal nor national courts are legally bound to follow previous decisions of each other.

6. Impact of the national case law on the Boards of Appeal

The harmonisation of patent case law run from the EPO to the national courts and viceversa. Normally, if all the courts in the member states - or at least a large number of them - took the same line, it would be almost impossible for the EPO and its boards of appeal not to follow suit. The Boards of Appeal cannot ignore the decisions of the national offices and courts when applying the EPC. To do so would be at odds with the concept harmonised interpretation of the EPC and European patent law.

However, the existing national case law may well be non-uniform, and in many cases, there is no general agreement on the matters in dispute. Additionally, differences between national law and the EPC prevent national decisions from being applied in European case law.

Despite these difficulties, national case law play sometimes an relevant role in the case law of the EPO. Although the national case law is not binding on the EPO, it is highly persuasive. It may contain valuable solutions to relevant problems. However, it is not easy to take national case law into account, as there is no easy access to national decisions.

To what extent do the boards of appeal take account of national case law in their deliberations?

In the decision of the Enlarged Board of Appeal **G 5/83**, OJ EPO 1985, 64, the Enlarged Board of Appeal was concerned with the question of patentability of second and further medical indications.

The Enlarged Board of Appeal observed that it is incumbent upon the European Patent Office, and particularly its Boards of Appeal, to

take into consideration the decisions and expressions of opinion of courts and industrial property offices in the Contracting States.

In decision **T 452/91** the Boards of Appeal of the EPO held that in proceedings before the instances of the EPO, questions of patentability were to be decided solely in accordance with the EPC. No national decision should be cited as if it were binding on the EPO, and claims should not be refused by the EPO on the ground that their "patentability cannot be upheld under the jurisdiction of one member state". It coup be that the law in most or all other contracting states was different. The reasoning that led the national instance to its conclusion might well lead an EPO instance to a similar conclusion under the EPC, but this would first need a careful assessment of the EPC, and of relevant EPO board of appeal case law, a comparison with the legislation and jurisprudence on which the national instance reached its conclusion, and a study of the position in other contracting states.

7. Impact of Boards of Appeal case law on the national courts

In Europe, an increasing number of decisions on patent law matters are taken by national courts where frequently cite decisions of the EPO's boards of appeal. National judges also occasionally comment on decisions decided by national courts in other European countries.
It must be noted however that the inclusion of foreign decisions or decisions of the Boards of Appeal in a decision of a national court does not always mean that the same result is arrived at. It has been shown that a considerable amount of uniformity may be obtained on a strictly pragmatic basis.

To illustrate this practice it may be useful to quote some examples:

Example 1:

As long ago as 1979, the High Court held that the new UK Patent Act should be interpreted in a manner consistent with

corresponding provisions of international patent conventions to which the UK is a signatory if the words of the statute are reasonably capable of consistent interpretation, unless Parliament has clearly expressed a contrary intention. The judge compared the English provision with the corresponding provision of the CPC despite the fact that the CPC was not in force. The provisions were not identical, but the judge, by applying a comparative law method of interpretation came to a harmonised interpretation of the English provision. It must be noted that the British Patent Act of 1977 contains a harmonisation rule in Sec. 130(7) (*SKF Laboratories v. R.D. Harbottle (Mercantile) Ltd. of March 12, June 5-7, 1979*).

Example 2:

A decisions of the Supreme Administrative Court in Sweden (Regeringsrättens Dom) dated 6.13.90 stated that:

> "With respect to legal provisions, Sweden's ratification of the EPC justifies aligning Swedish case law with the case law of the Boards of Appeal and practice of the European Patent Office (EPO) when applying provisions that are in keeping with the EPC. Only Swedish patent legislation is of direct relevance when deciding whether a patent can be granted in Sweden. However, in view of the virtually identical wording of Section 1, second paragraph, Patents Act and the corresponding provision of the EPC great importance should be attached to how practice has developed in the EPO. This argument was also put forward in the preparatory work to the Patents Act and is further supported by the fact that patents granted by the EPO have the same effect in Sweden as patents granted by the Swedish Patent Office" (See translation OJ EPO 1993,094).

Example 3:

A decision of the Bundesgerichtshof (X. Zivilsenat) of 2.12.87 held

that:

> "Since the harmonization of national and European provisions of substantive patent law should serve the creation of largely identical patent law, care must also be taken that the interpretation in the national and international area be as uniform as possible. In the point of law to be decided in this case, the European Patent Office in accordance with the preceding reasons has the better arguments and it is not to be expected that it will change its position. Thus, for reasons of a desirable uniform interpretation of the law, it appears necessary also that this Court should abandon its earlier case law under the 1978/1981 Patent Act which has been adapted to the EPC" (translation from OJ EPO 1987, 429).