Software Patents, Separation of Powers, and Failed Syllogisms: A Cornucopia from the Enlarged Board of Appeal of the European Patent Office

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ABSTRACT
The decision of the Enlarged Board of Appeal (EBA) of the European Patent Office (EPO) in G_0003/08 is considered, and the grounds for its rejection of the President’s referral on the computer programs exclusion of Article 52(2)(c) & (3) of the European Patent Convention (EPC) is analysed. An argument is made that the basis for that rejection is an interpretation of Article 112(1)(b) EPC that is inconsistent with Articles 31 and 33 of the Vienna Convention, and that offends the EPC’s separation of powers. The EBA’s support for the EPO Boards’ “technical character” theory of Article 52(2)(c) & (3) is also criticized, on doctrinal, theoretical, and other grounds.

In May 2010, the Enlarged Board of Appeal (EBA) of the European Patent Office (EPO) published its long- awaited decision in G_0003/08 (PRESIDENT’S REFERENCE/Computer program exclusion).¹ The decision involved a referral from the outgoing EPO President, Ms Alison Brimelow, under Article 112(1)(b) of the European Patent Convention (EPC).² The focus of her referral was four questions regarding the computer programs exclusion of Article 52(2)(c) & (3);³ arguably the

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¹ (Unreported, 12 May 2010); see also [2009] EPOR 9.
² Convention on the Grant of European Patents (1973) 13 ILM 268 (European Patent Convention).
³ The questions are reproduced in G_0003/08, [10], [11], [12], [13] respectively. Question 1 reads: “Can a computer program only be excluded as a computer program as such if it is explicitly claimed as a computer program?” Question 2 reads: (a) Can a claim in the area of computer programs avoid exclusion under Art. 52(2)(c) and (3) merely by explicitly mentioning the use of a computer or a computer-readable storage medium? (b) If Question 2(a) is answered in the negative, is a further technical effect necessary to avoid exclusion, said effect going beyond those effects inherent in the use of
most controversial provision of the EPC. According to its terms, “programs for computers ... shall not be regarded as inventions within the meaning of [Article 52(1)] ... to the extent to which a European patent application or European patent relates to [them] as such”. In what may be the longest ever (55-page) EBA opinion – and only the eighth involving Article 112(1)(b) to date – the EBA dismissed the referral as inadmissible. In this article I suggest that the basis for its decision is an interpretation of Article 112(1)(b) that is inconsistent with the principles of Articles 31 and 33 of the Vienna Convention, and that offends the constitutional principles from which it was expressly derived. Further, while the EBA purported to be unconcerned with the correctness of the EPO Boards’ approach to Article 52(2) & (3), its opinion lends strong support to that approach. I suggest that this is inappropriate

a computer or data storage medium to respectively execute or store a computer program?” Question 3 reads: “(a) Must a claimed feature cause a technical effect on a physical entity in the real world in order to contribute to the technical character of the claim? (b) If Question 3(a) is answered in the positive, is it sufficient that the physical entity be an unspecified computer? (c) If Question 3(a) is answered in the negative, can features contribute to the technical character of the claim if the only effects to which they contribute are independent of any particular hardware that may be used?” Question 4 reads: “(a) Does the activity of programming a computer necessarily involve technical considerations? (b) If Question 4(a) is answered in the positive, do all features resulting from programming thus contribute to the technical character of a claim? (c) If Question 4(a) is answered in the negative, can features resulting from programming contribute to the technical character of a claim only when they contribute to a further technical effect when the program is executed?”

4 See, eg, G_0003/08, [4.2].
5 The corresponding UK provision is Patents Act 1977 s 1(2)(c).
6 The others are G_0001/90 (REVOCATION OF A PATENT) [1991] EPOR 343 (regarding EPC Art 102); G_0001/92 (AVAILABILITY TO THE PUBLIC) [1993] EPOR 241 (regarding EPC Art 54(2)); G_0002/98 (X/Same invention) [2002] EPOR 17 (regarding EPC Art 87(1)); G_0004/98 (ANON/Designation fees) [2001] EPOR 42 (regarding EPC Art 91(4)); G_0003/95 (PLANT OR ANIMAL VARIETIES/Inadmissible referral) [1994] EPOR 521 (regarding EPC Art 87(1)); G_0001/02 (FORMALITIES OFFICERS POWERS) [2003] EPOR 49 (regarding various procedural Articles and Rules); G_0001/04 (CYGNUS/Diagnostic methods) [2006] EPOR 15 (regarding EPC Art 52(4)). Of the referrals considered in these cases, only that in G_0003/95 was held to be inadmissible. This was also the only case before G_0003/08 involving a substantive patentability provision.
7 See G_0003/08, [10.13.1] (“it is not the task of the Enlarged Board in this Opinion to judge whether this system [the approach adopted by the Boards to Article 52(2) & (3), as expounded in T_0154/04 (DUNS LICENSING ASSOCIATES/Estimating sales activity) [2007] EPOR 38, [5]] is correct”).
8 See, eg, ibid, [4.1] (accepting the premise of the Boards’ jurisprudence, that an invention within the meaning of Article 52(1) EPC is a subject matter having technical character, with the result that the only issue with respect to the computer programs exclusion is “where to draw the dividing line between applications relating to programs for computers as such, which are excluded from patentability under Articles 52(2)(c) and (3) EPC, and applications relating to patentable technical solutions, in the form of [computer-implemented inventions]”); ns 82, 83. See also European Patent Organisation. “EBoA confirms EPO approach to computer programs” (12 May 2010)
for at least three reasons; namely, that the Boards’ approach (a) suffers from the same faulty logic for which the EBA criticized the President’s referral, (b) lacks doctrinal and theoretical coherence, and (c) is incapable of producing legal certainty, either within the EPC or national (European) patent systems.

THE EBA’S INTERPRETATION OF ARTICLE 112(1)(b) EPC

By provision of Article 112(1)(b) of the EPC:

In order to ensure uniform application of the law, or if a point of law of fundamental importance arises:... the President of the European Patent Office may refer a point of law to the Enlarged Board of Appeal where two Boards of Appeal have given different decisions on that question.

On its face this Article seems to require two things, consistent with it having two distinct limbs: (a) “different decisions” given by two Boards of Appeal, (b) on a point of law of fundamental importance, or producing such divergence that an EBA decision is necessary “to ensure uniform application of the law”. Implicit in this view is an interpretation of Article 112(1)(b) as supporting two heads of presidential referral: one aimed at clarifying points of law of fundamental importance, and the other at ensuring the uniform application of the EPC.9

In G_0003/08, the EBA seemed initially to share this view. Thus, in determining the admissibility of the referral before it, it asked whether the computer programs exclusion to which the referral related is “a point of law of fundamental importance”, and whether the cases cited by the President in support of that referral disclose differences on that point by two EPO Boards.10 It decided that while the exclusion is a point of law of fundamental importance,11 the cases do not disclose “different decisions” within the meaning of Article 112(1)(b).12 Its reasons for the second of these conclusions were as follows. First, a comparison of the official

http://www.epo.org/topics/news/2010/20100512.html (describing the EBA in G_0003/08 as “taking the opportunity to set out and confirm the approach of the EPO regarding the patentability of computer programs under the European Patent Convention”). I am grateful to Reinier Bakels for alerting me to this EPO notice.

9 Cf G_0004/98, [8] (“As stated at the beginning of Article 112 EPC, one of the purposes of a referral to the Enlarged Board of Appeal is to ensure uniform application of the law. This is particularly true for the referral by the President of the EPO under Article 112(1)(b) EPC, which is dependent on the existence of conflicting decisions.”)

10 See ibid [4]–[5].

11 See ibid [4.2].

12 See ibid [10]–[13].
English, French and German versions of the phrase “different decisions” / “décisions divergentes” / “abweichende Entscheidungen” reveals an interpretive ambiguity in the first limb of Article 112(1)(b) which can only be resolved with reference to the Article’s “object and purpose”, consistent with Article 31 of the Vienna Convention (the principles of which the EBA is bound to observe). And second, such object and purpose are revealed by “current constitutional thinking” to support a restrictive interpretation of Article 112(1)(b), as requiring (in all cases)

...a divergence or, better, conflict in the case law making it difficult if not impossible for the Office to bring its patent granting practice into line with the case law of the Boards of Appeal.

The “constitutional thinking” which led to this conclusion concerns democracy and the notion of legal development. According to the EBA, such considerations are relevant to Article 112(1)(b) by virtue of the nature of the European Patent Organisation as

...an international, intergovernmental organisation, modelled on a modern state order and based on the separation of powers principle, which the sovereign contracting states have entrusted with the exercise of some of their national powers in the field of patents.

From this, and the democratic nature and obligations of EPC Contacting States, the EBA derived a duty on the part of the Organisation to ensure “the predictability and verifiability” of its actions, and to protect “the separation of powers, the rule of law and respect for human rights including fundamental procedural rights.” It is this duty which provided the essential context for its reading of Article 112(1)(b).

Of particular importance to that reading was the separation of powers doctrine. According to the EBA, that doctrine supports a view of the EPO Boards as

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13 See ibid [7.1]–[7.2].
14 Vienna Convention on the Law of Treaties (Vienna, 23 May 1969, UNTS 1155, 331) (Vienna Convention). Article 31.1 provides: “A treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose.”
15 See G_0003/08, [7.2] and the authorities cited therein.
16 See ibid [7.2.1].
17 See ibid [7.26].
18 See ibid.
19 See ibid (“As a democracy is prohibited from signing an international treaty which would undermine its citizens’ constitutional guarantees, the EPO must therefore support these fundamental principles”).
20 See ibid.
21 See ibid.
having primary responsibility for interpreting the EPC, as the only proper judicial bodies within the Organisation. By enabling presidential referrals to the EBA, it suggested, Article 112(1)(b) involves a limited usurpation of those functions, which can only be justified in *extremis*:

The fact that the Enlarged Board takes action only on a referral from the Boards of Appeal or the President (with the exception of petitions for review under Article 112a EPC, which however concern procedural matters and have a very narrow scope) and thus does not constitute a further instance ranking above the Boards of Appeal within the EPC judicial system is a clear indication of the extent of its significance for legal uniformity. The exhaustive list of admissibility criteria for a referral under Articles 112(1)(a) and (b) EPC implies that the Enlarged Board takes decisions on specific legal questions and that neither the Boards of Appeal nor the President are authorised to consult it whenever they so wish in order to clarify abstract points of law. For that purpose the President can call upon a separate Legal Department within the Office.

The result was a view of Article 112(1)(b) as having been “only intended” to have the limited scope above. Thus, a mere difference in two or more cases, including one that reveals the law to be proceeding in a non-linear fashion, that abandons or modifies an earlier approach, or that effects “a radical shift in [the Boards’] jurisprudence”, will never be a valid basis for a presidential referral. This is particularly important, the EBA suggested, in the context of the EPC, due to “its numerous undefined legal terms”, the challenges of “new technologies”, and the fact-specific nature of patent law. As expressed in its opinion,

…the Enlarged Board cannot develop the law in the same way as the Boards of Appeal, because it does not have to decide on facts of pending appeals, but only in specific instances and only in the aforementioned context of points of law referred to

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22 See ibid [7.2.5].
23 Cf generally P Leith, “Judicial or administrative roles: the patent appellate system in the European context” [2001] IPQ 50–99. Professor Leith’s article contains a fascinating study of the legal (including judicial) and administrative structure and culture of the EPO.
24 G_0003/08, [7.2.5].
25 See ibid [7.2.6].
26 See ibid [7.3.1].
27 See ibid [7.3.5].
28 See ibid [7.3.1].
29 See ibid [7.3.2].
30 See ibid [7.3.3].
31 See ibid [7.3.8].
it under Article 112(1) EPC. This applies *a fortiori* to referrals by the President, which
do not even arise from a specific appeal.\(^{32}\)

Several aspects of this reasoning are problematic. One is that it proceeds
without regard to the opening clause of Article 112(1)(b) – being the second part of
that Article’s second limb – and its text “or if a point of law of fundamental
importance arises.” As suggested above, this text envisages presidential referrals
aimed at *clarifying* fundamental points of law, regardless of whether they are needed
“to ensure [the law’s] uniform application”. By interpreting the first limb of Article
112(1)(b) as limiting the Article’s applicability to situations in which it is “difficult if
not impossible” for the EPO to apply the law as stated by its Boards,\(^{33}\) however, the
EBA rendered this head of referral redundant. Hence my suggestion, that its
reasoning exploits the ambiguity in the first limb of Article 112(1)(b) to import
considerations of constitutional policy, which considerations are then used to delimit
the literal meaning of the Article’s other terms, and thereby remove one of the
President’s heads of power. The result is a reading of Article 112(1)(b) which is
difficult to reconcile with its literal terms, and the “good faith” interpretation
required by Article 31 of the Vienna Convention.\(^ {34}\)

A second, albeit related, respect in which the EBA’s reasoning is problematic
concerns its failure to refer to the unpublished *travaux préparatoires* for Article
112(1)(b) in reaching its decision. Of importance in this regard is Article 33.4 of the
Vienna Convention:

> Except where a particular text prevails in accordance with paragraph 1, when a
> comparison of the authentic texts [of a treaty] discloses a difference of meaning
> which the application of articles 31 and 32 does not remove, the meaning which best
> reconciles the texts, having regard to the object and purpose of the treaty, shall be
> adopted.

In G_0003/08, it was the EBA’s comparison of the three official versions of the first
limb of Article 112(1)(b) which created the interpretive ambiguity above, and thereby
enabled the EBA’s reliance on constitutional factors to read down that Article’s scope
of application. However, and as Article 33.4 makes clear, this interpretive approach –
which involved reconciling the official versions of Article 112(1)(b) having regard to
the object and purpose of the EPC\(^ {35}\) – was not open to the EBA without first

\(^{32}\) Ibid.

\(^{33}\) Ibid [7.2.6].

\(^{34}\) See Vienna Convention Art 31.1 (n 14).

\(^{35}\) Cf G_0003/08, [7.2] (describing its approach to the resolution of the ambiguous wording in Article
112(1)(b) as being to “consider the object and purpose of Article 112(1)(b) in the context of the EPC”).
attempting to resolve the ambiguity by “the application of articles 31 and 32”. Article 32 states as follows:

Recourse may be had to supplementary means of interpretation, including the preparatory work of the treaty and the circumstances of its conclusion, in order to confirm the meaning resulting from the application of article 31, or to determine the meaning when the interpretation according to article 31: (a) leaves the meaning ambiguous or obscure; or (b) leads to a result which is manifestly absurd or unreasonable.

The effect of this provision, in combination with Article 33.4, was to make the travaux préparatoires for Article 112(1)(b) an essential “supplementary means of interpretation” in G_0003/08. Indeed, even without regard to Article 33.4, their relevance as such is apparent from the explicit basis of the EBA’s interpretation in the “object and purpose” of Article 112(1)(b), of which the travaux are primary evidence. This, in combination with the difficulty of reconciling the EBA’s interpretation of Article 112(1)(b) with that Article’s literal meaning and terms, and the EBA’s practice of considering the travaux to resolve ambiguities in the past – including in all but two of the cases involving Article 112(1)(b) referrals – supports the conclusion that in failing to refer to them in G_0003/08, the EBA proceeded inconsistently with Article 33.4, and perhaps Article 31, of the Vienna Convention.

The result is of more than methodological significance. The reason is that the travaux would seem to contradict the EBA’s interpretation of Article 112(1)(b), by suggesting that the central aim of that provision was indeed “to ensure the uniform application of the law or to clarify a fundamentally important point of law”, as suggested above. In addition, the travaux show that the drafters considered the constitutional issues relied on by the EBA, and supported Article 112(1)(b) even after

36 See G_0002/98, [6.3] (“In order to understand the legislative intent underlying [an EPC provision], it is necessary to consult the historical documentation related to the EPC.”)
37 See G_0001/90, [16]; G_0002/98, [6.3]–[6.8]; G_0004/98, [12], [22]; G_0001/02, [6.2], [6.3.1]–[6.3.3]; G_0001/04, [7.4], [8]. Cf G_0001/92; G_0003/95. For a discussion of the use made by the EBA of the EPC travaux in respect of EPC Art 53(b) – the focus of the G_0003/95 referral – see J Pila, “Article 53(b) EPC: A Challenge to the Novartis Theory of European Patent History” (2009) 72 MLR 436–462 (discussing G_0001/98 (NOVARTIS/Transgenic Plant Systems) [2000] EPOR 303).
38 Inter-Governmental Conference for the Setting up of a European System for the Grant of Patents (Luxembourg Conference), Minutes of the 5th Meeting of the Luxembourg Conference; Part II: Hearing of the non-governmental international organizations on the Second Preliminary Draft of a Convention establishing a European System for the Grant of Patents (Luxembourg, 26 January to 1 February 1972), BR/169/72 (Brussels, 15 March 1972) [117] (emphasis added). Compare the account of (former EFTA Secretariat and Luxembourg Conference participant) Dennis Thompson in D Thompson, “The Draft Convention for a European Patent” (1973) 22 ICLQ 51-82, 77 (describing the value of a referral under Article 112(1)(b) as being “simply to ensure a uniform application of the law in the future”).
doing so. Indeed, constitutional issues were foremost in the drafters’ mind, as shown by the following record of their earliest discussions of Article 112(1)(b) in November 1969:

Serious objections were brought forward against the possibility, provided for in paragraph 1 b, of the President of the European Patent Office asking the Enlarged Board of Appeal for an opinion on questions not arising in proceedings on a case: It was said that such a possibility would seriously impair the judicial character of the Enlarged Board of Appeal; Courts could not give an opinion on abstract questions put to them by administrative authorities but had to decide specific individual cases; If abstract questions are put to them for a decision they are recognized as having a quasi-legislative power; There was the danger that when the Enlarged Board of Appeal had given an opinion on an abstract question it would not depart from this in subsequent specific cases; There was no need to give the Enlarged Board of Appeal powers of this type, since the President of the Patent Office could first ask the Legal Department of the European Patent Office for an opinion on any questions arising for the first time; The President could also ask a member of the Enlarged Board of Appeal to give an opinion in his own name.39

Not all of the Working Party members agreed with these objections,40 producing a conflict of opinion41 over the desirable scope of the provision. The result was an initial version of Article 112(1)(b) that included, in addition to its current first limb, a sub-section which authorized the President “at any time [to] ask the Enlarged Board of Appeal for an opinion on any question, except where such question arises in proceedings on a case”.42 Alongside the Working Party’s record of this version, the following explanatory note appears:

39 Luxembourg Conference, Minutes of the meeting of Working Party I (Luxembourg, 24 to 28 November 1969), BR/12/69 (Brussels, 18 December 1969) [55].
40 See ibid (“Other members of the Working Party … thought that it ought to be possible, particularly in the early years of the European Patent Office’s activities, to promulgate guidelines which were not connected with a specific case. It was certainly true that the question whether these guidelines should be published, and should thus be made evident to the outside world, should be carefully examined.”)
41 See ibid (“The Working Party found it impossible to reach a unanimous opinion on this point. It therefore decided to include 2 sub-paragraphs in the Draft under (b) for the time being, and to re-examine the question later with the legal experts. It was pointed out in this connection that the second sub-paragraph in fact constitutes a specific application of the first sub-paragraph and could therefore be deleted, if the Working Party were to agree on the first sub-paragraph at a later date.”)
42 See Luxembourg Conference, Preliminary Draft Convention for a European System for the Grant of Patents: Articles 88 to 152 prepared by Working Party I (24 to 28 November 1969) 96; ibid. The initial version of what became Article 112(1)(b) read in full as follows: “(1) In order to ensure uniform application of the law, or if an important point of law arises:… (b) the President of the European Patent Office may: – at any time ask the Enlarged Board of Appeal for an opinion on any question, except where such question arises in proceedings on a case; – refer a point of law to the Enlarged Board of
The Working Party points out that the second sub-section of sub-paragraph (b) limits the President’s power to refer a matter to the Enlarged Board of Appeal. The Working Party was unable to agree on the advisability of giving the President the power provided for in the first sub-section of sub-paragraph (b). This question must be re-examined in consultation with the national legal advisers.43

When the participants of the Luxembourg Conference – the first of the EPC’s two preparatory conferences – came to consider the initial version of Article 112(1)(b) in January 1970, it agreed to postpone a decision on the first sub-section for the same constitutional reasons as considered by the Working Party in 1969. According to the record of the Conference discussions:

Several delegations expressed doubts on the provision in question, particularly since it would involve the risk of obliging the Enlarged Board of Appeal to take decisions on abstract questions, which might hinder it later when it came to consider concrete questions of a similar nature, and also because the Enlarged Board of Appeal, notwithstanding the rules governing its composition, cannot be totally likened to a judicial body.

On the other hand, other delegations believed the provision in question could be most useful, especially during the running in period of the European Patent Office, during which a number of questions of interpretation were bound to occur, on which it would be expedient for the President to be able to obtain the opinion of the Enlarged Board of Appeal.

Finally, the Conference considered that it would be particularly useful to receive the opinions of the national legal advisers before taking a final decision on this problem.44

Eleven months later the matter was considered by the Luxembourg Conference again. In the record of its meeting, the participants affirmed their commitment to the second sub-section, and their ongoing uncertainty regarding the first. According to the travaux:

Appeal where two Boards of Appeal have given different decisions on that question.” In the travaux, hand-written square brackets appear around the text “at any time … on a case”.

43 Luxembourg Conference, Preliminary Draft Convention for a European System for the Grant of Patents: Articles 88 to 152 prepared by Working Party I (24 to 28 November 1969) 96. See also Luxembourg Conference, Minutes of the 7th meeting of Working party I held at Luxembourg from 26 to 29 January 1971, BR/94/71 (Brussels, 6 April 1971) 39 (“The Working Party considered that the question of which text of paragraph 1(b) was preferable, should be discussed with the government legal experts. (See observations by the ICC and CPCCI)”). I am not aware of any record of the observations referred to, nor of the results of the discussions with the legal experts.

44 Luxembourg Conference, Minutes of the 2nd Meeting held at Luxembourg on 13 to 16 January 1970, BR/26/70 (Brussels, 30 January 1970) [36].
The Conference agreed that the President should in any event have the power to ask the Enlarged Board of Appeal for an opinion in the case referred to in the second sub-section of sub-paragraph (b). On the other hand, there was no agreement on the question whether the President should also be given such a power in the other cases referred to in the first sub-section, which are not covered by the second sub-section. If an affirmative answer is given to this question at a later date, the text of the second sub-section could be deleted.45

Then, in October 1971, the responsible Working Party

...agreed by a majority that the President of the European Patent Office may only call upon the Enlarged Board of Appeal when two Boards of Appeal have given different decisions on the same question; the more widely drafted first sub-section of this sub-paragraph was therefore deleted.46

The result was the version of Article 112(1)(b) which remains today, formulated and accepted by the drafters after full consideration of its constitutional implications, including – as the preceding discussion of the travaux demonstrates – for the separation of powers and the development of the law, and having regard to the fact-specific nature of judicial patent law-making, and the inability of the EBA to “be totally likened” to a court.47 In combination with the historical evidence regarding the aim of Article 112(1)(b), this raises a question regarding the appropriateness of the EBA’s reliance on constitutional arguments to restrict the literal meaning and terms of Article 112(1)(b). Indeed, it suggests that the EBA’s interpretation involved a subversion of the very democratic principles from which that interpretation was purportedly derived. This is because it involved the EBA’s usurpation of the constitutionally-mandated executive authority of the President, and the legislative

45 Luxembourg Conference, First Preliminary Draft of a Convention Establishing a European System for the Grant of Patents (Articles drafted by Working Parties I, II, III and IV), BR/70/70 (Brussels, 21 December 1970) 149.
46 Luxembourg Conference, Minutes of the meeting of Working Party I, held in Luxembourg from 14 to 17 September 1971, BR/132/71 (Brussels, 28 October 1971) [45]. From the travaux it seems that only the Netherlands dissented, “as it considered the wider wording more suitable”.
47 N 44. A subsequent request by certain delegations to delete the provision thus agreed “since in their opinion it was of no help to ask the Enlarged Board of Appeal to give decisions outside proceedings on a case” was rejected. See Luxembourg Conference, Minutes of the 5th Meeting of the Luxembourg Conference: Parts 1 and 3 (Luxembourg, 24–25 January and 2–4 February 1972), BR/168/72 (Brussels, 15 March 1972) [136]. See also Thompson (n 38) 77 (“During the course of the discussions it had been proposed that the President could refer any question, even if only hypothetical, to the Enlarged Board, in order that it might give a consultative opinion similar to the practice of the International Court of Justice, the Privy Council or the Conseil d’Etat. This, however, was rejected on the grounds that it would establish precedents which might conflict with actual points referred by the Boards of Appeal, and also that it would be unfair to establish precedents binding on future parties who did not have the opportunity of arguing their case before the Enlarged Board.”)
authority of the EPC Contracting States. 48 Further, while the EBA’s analysis was premised on a view of the Boards of Appeal as the only proper judicial bodies within the Organisation, that view is directly contradicted by the following description of the Boards on the EPO’s own website:

The current legal position is that the Boards of Appeal, together with their associated administrative services, are integrated into the European Patent Office as Directorate-General 3 (DG 3). However, the boards’ administrative and organisational attachment to the EPO which is an administrative authority obscures their judicial nature and is not fully commensurate with their function as a judicial body. 49

Indeed, it is precisely with a view to addressing this that the EPO has proposed that the EPC be revised. 50

SUPPORT FOR THE BOARDS’ “TECHNICAL CHARACTER” THEORY OF ARTICLE 52(2) & (3)

The question arises as to the implications of this analysis for the outcome of G_0003/08. In the EBA’s opinion, the differences of relevance in the cases cited by the President did not create sufficient difficulties for the EPO’s uniform application of the law to justify the referral of any of the four stated Questions under Article 112(1)(b). 51 It is clear, however, that had the EBA interpreted Article 112(1)(b) in the manner above, this conclusion would not have been sufficient to resolve the case. Rather, the EBA would have also needed to ask whether such differences satisfied the first limb of Article 112(1)(b), and concerned a matter of law of fundamental importance. If they did, the President’s request for clarification ought (on its own analysis) to have been valid.

With respect to Question 1, the EBA found that they did. Specifically, it found that the Question related to a point of law of fundamental importance, and that the cases cited by the President in support of its referral disclosed differences on that

48 For a UK perspective on this issue see Boyce v The Queen [2004] UKPC 32, [2005] 1 AC 400, [70] (“To say that a constitution is based upon the principle of the separation of powers is a pithy description of how the constitution works. But different constitutions apply this principle in their own ways and a court can concern itself only with the actual constitution and not with what it thinks might have been an ideal one.”)

49 http://www.epo.org/patents/law/legislative-initiatives/autonomy.html. I am grateful to Reinier Bakels for alerting me to this.

50 See Draft basic proposal for a revision of the EPC implementing the organisational autonomy of the Boards of Appeal of the European Patent Office within the European Patent Organisation, CA/46/04 (Munich, 28 May 2004).

51 For the text of the Questions see n 3.
point by two Boards of Appeal.\textsuperscript{52} By contrast, the EBA rejected the President’s referral of Questions 2 to 4, on the basis that the cases cited by the President in support thereof did not disclose a relevant difference of authority.\textsuperscript{53} Assuming that the EBA correctly resolved the semantic ambiguity in the first limb of section 112(1)(b) as requiring \textit{diverging} if not \textit{conflicting} decisions,\textsuperscript{54} it ought to follow from this rejection that the President’s referral of Questions 2 to 4 would still have been inadmissible on the view of Article 112(1)(b) advanced above.

It is not my purpose here to engage with the reasons for the EBA’s finding that the cases cited with respect to Questions 2 to 4 did not reveal “different decisions” of relevance in the sense required. Rather, my concern is with the EBA’s analysis of Article 52(2) & (3), and its support for the Boards’ understanding of that Article.\textsuperscript{55} On its face that support seems inappropriate. The reason is that the Boards’ understanding suffers from the same kind of logical flaw which the EBA attributed to the EPO President. In its opinion, by treating computer program claims and computer implemented method claims “as having an identical scope,”\textsuperscript{56} the President confused “a set of instructions for carrying out steps and the steps themselves”,\textsuperscript{57} and in doing so made an erroneous argument. In the event, the EBA was prepared to forgive the President her alleged\textsuperscript{58} error, and proceed to consider the admissibility of her Question nonetheless.\textsuperscript{59} However, it did not do so without explaining where she went wrong:

There is a general distinction in logic to be made between an object and a name or description of the object. Consider the following argument:

\begin{quote}
\textit{Tigers eat meat. Meat is a word. Therefore tigers eat words.}
\end{quote}

\textsuperscript{52} See G_0003/08, [10.7.2].
\textsuperscript{53} See ibid [11.2], especially [11.2.7]–[11.2.9].
\textsuperscript{54} In addition to the French version of Article 112(1)(b), this resolution finds support (unsurprisingly) in the Report of the French Delegation on the 1970 First Preliminary Draft, where the then draft Article 112(1)(b) was described as requiring “contradictory decisions” of two Boards of Appeal (Luxembourg Conference, Reports on the First Preliminary Convention for a European System for the Grant of Patents (1970) 25).
\textsuperscript{55} See n 8.
\textsuperscript{56} See G_0003/08, [11.2] (quoting from the referral).
\textsuperscript{57} Ibid [11.2.3].
\textsuperscript{58} The EBA’s characterization of the President’s argument here is contradicted by the language of her referral, which states that “claims for a computer program and a computer implemented can be seen as having an identical scope”, and not that she herself regarded them as having one. See [2009] EPOR 9, [30], relevantly quoted ibid [11.2], [11.2.1] (emphasis added).
\textsuperscript{59} See G_0003/08, [11.2.7].
Clearly there must be an error in this argument. It occurs because “meat” is being used differently in the two premises. In the second premise what is being discussed is not the substance meat, but the name of the substance. These are two different things, and the usual way of distinguishing them is to put the name in quotation marks.60

This “tigers eat words” syllogism clearly fails. On the other hand, and as argued in respect of its constitutional analysis above, the EBA’s lesson in syllogistic reasoning draws attention to a shortcoming in its own analysis. That shortcoming lies in its support for a theory of Article 52(2) & (3) that has the same “logical weakness” as it attributes to the President in the passage above. Among other things, this makes it difficult to accept the EBA’s view of the technical character theory of Article 52(2) & (3) as based on sound (“consistent”) logic.61

According to the theory, as expressed in the decisions of the EPO Boards,62 the list of “non-inventions” contained in Article 52(2) & (3) resolves to a positive requirement for technical character, with the result that if a subject matter has technical character it is an “invention” within the meaning of Article 52(1), and therefore capable of supporting a patent. For it to have technical character, a subject matter need only include some technical feature, regardless of whether that feature “predominates”.63 Further, while the requirement for an invention is expressed as being “essentially separate and independent of” the other patentability requirements,64 in determining novelty and inventive step it is only the “technical features” of a subject matter that count.65 Implicit in this theory is the following argument:

Computer programs as such are not inventions. Inventions have technical character.
Therefore computer programs as such lack technical character.

However, this argument suffers from the same kind of broken syllogism which the EBA attributes to the President above.

Consistent with what I have elsewhere suggested,66 there are additional reasons for criticizing the EBA’s support of the Boards’ theory of Article 52(2) & (3), including of the computer programs exclusion. One is that the theory is insufficiently

61 See ibid [10.8.2].
62 The account is from T_0154/04, [5], which is the main authority cited by the EBA for the Art 52(2) & (3) principles it summarized; see G_0003/08, [4.1], [10.7.1], [10.13.1], [10.13.2]. See also J Pila, “The Future of the European Requirement for an Invention” (2010) Oxford Legal Research Paper Series 35/2010.
63 T_0154/04, [5].
64 Ibid.
65 Ibid.
66 See Pila (n 62).
supported by the text or history of the EPC, and lacks doctrinal and theoretical coherence. For example, it is difficult to reconcile with the terms of Article 52(2) & (3), which include among their list of non-inventions such technical subject matter as computer programs.67 Further, while the drafters of the EPC assumed that inventions would be drawn from the technological arts, there is no evidence that they intended Article 52(2) & (3) to resolve to a requirement for “technical character” alone, and nor do the EPC’s object and purpose support that resolution.68 Rather, they support a view of the EPC’s central aim as being to support industrial growth, which view is not furthered by a definition of the threshold limits of the system anchored exclusively to a requirement for some “technical” feature. In combination, these points suggest that the Boards’ understanding of Article 52(2) & (3) is at best an argument for a de minimis conception of the European “invention”, and not an interpretation of Article 52(2) & (3) itself.69 Further, the Board’s attempt in T_154/04 to support that argument with reference to social theory, and the distinction supported by the “classical notion of invention” between “practical scientific applications and intellectual achievements”,70 is unpersuasive. The reason is that the premise of that distinction is an understanding of technology as applied science, which understanding has not only been rejected by social theorists,71 but also fails to explain the inclusion in Article 52(2) & (3) of computer programs, not to mention why inventions are not properly regarded as “intellectual achievements”. Hence my suggestion, that the logical flaws of the Boards’ understanding of Article 52(2) & (3) are compounded by its theoretical and doctrinal shortcomings. Relatedly, that understanding produces an unworkable definition of the European “invention”, due to the undefinability and obscurity of the concept of “technical character” itself.72 As

67 See T_1616/08 (AMAZON/Gift order) (unreported, 11 November 2009), [4.3] (reproduced below).
69 The point is made in Pila (n 62).
70 T_0154/04, [5].
72 This is supported by the history of Article 52(2) & (3) (see generally Pila (n 68)), the view of social theorists (see, eg, M Bunge, “The Philosophical Richness of Technology” (1976) 2 (Symposia and Invited Papers) PSA: Proceedings of the Biennial Meeting of the Philosophy of Science Association 153–172, 154; S D Fries, “Expertise against Politics: Technology as Ideology on Capitol Hill, 1966-1972” (1983) 8 Science, Technology & Human Values 6–15, 6; T J Misa, “Theories of Technological Change: Parameters and Purposes” (1992) 17 Science, Technology & Human Values 3–12, 4; R Laudan, “Natural Alliance or Forced Marriage? Changing Relations between the Histories of Science and Technology” (36) 2 Technology & Culture Supplement: Snapshots of a Discipline: Selected Proceedings from the
evidence of this, one need only refer to the extensive litigation involving Article 52(2) & (3), and the judicial decisions (and complaints) which that definition has elicited. As one UK Judge recently suggested, despite extensive judicial consideration, the nature of the European “invention” remains depressingly uncertain; a suggestion supported by the fact and terms of the G_0003/08 referral itself. Further, and contrary to the implication of the EBA, the inadequacy of the Boards’ interpretation of Article 52(2) & (3) is not resolved by their interpretation of the other Article 52(1) patentability criteria, including particularly novelty and inventive step. This is because the determination of those requirements depends on a prior conception of the subject matter under the description of the “invention”, which conception depends in turn on an understanding of what constitutes an invention for the purpose of the law. It follows that such determination cannot resolve the flaws in that understanding; rather, and as the Boards’ decisions reflect, it can only extend their effect into other areas of European patent jurisprudence. This is apparent from the reasoning in the recent Amazon 1-click purchasing method case – T_1616/08 (AMAZON/Gift order) – which is an example of the approach to inventive step referred to approvingly by the EBA in G_0003/08.

The only relevant criterion for inventive step is the one stated in Article 56 EPC 1973, namely whether the invention is obvious to a person skilled in the art. Since in accordance with established jurisprudence this “art” cannot be a field of business or administration, only elements of the solution falling within the competence of a technically skilled person (here: a programmer or computer scientist) can be taken into account.

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73 See Pila (n 68) chs 5-6. For judicial complaints see, eg, Aerotel Ltd v Telco Holdings [2006] EWCA Civ 1371, [25], [27] (prompting the G_0003/08 referral); n 74.


75 See G_0003/08, [10.13] (suggesting that “no exposition” of the Board’s understanding of Article 52(2) & (3) “would be complete” without consideration of their approach to inventive step and novelty).

76 The language used by the UK courts is “under the description”; see, eg, Merrell Dow Pharmaceuticals Inc v HB Norton & Co Ltd [1995] UKHL 14, [1996] RPC 76, [37], [38], [47], [54]; CFPH’s Application [2005] EWHC 1589, [93]. Cf in the copyright context, where Laddie J at least has emphasized the need when considering a claim of literary copyright to conceive the subject matter properly, “qua literary work”; see Electronic Techniques (Anglia) Ltd v Critchley Components Ltd [1997] FSR 401, 414.

77 See G_0003/08, [10.13.1], [10.13.2].

78 T_1616/08, [4.3].
Thus, while the Board’s de minimis conception of the “invention” supported the treatment of the 1-click method as a potentially patentable subject matter – notwithstanding Article 52(2)(c) & (3)’s express classification of business methods as non-inventions – the subject matter was nonetheless excluded from patentability for failing to advance an art not covered by Article 52(2) & (3). By this approach, the EBA implied, EPO Boards achieve the same result as would be achieved by applying a more robust conception of the “invention” itself: “[m]erely the EPC article applied is different.”\(^{79}\) However, this defence of the Board’s jurisprudence is problematic for two reasons: first, it ignores the importance of judicial reasoning to coherent and transparent judicial decision-making;\(^ {80}\) and second, it ignores the incoherence of the Boards’ reasoning on inventive step. That incoherence is apparent from the finding in T_1616/08, that while business is not a “technical” art due to the categorization of business methods as non-inventions, computer programming and science are such arts despite their categorization as non-inventions.\(^ {81}\) In reasoning such as this one re-encounters the failed syllogism above.

In conclusion, and for the reasons advanced, it is submitted that the EBA’s support of the EPO Boards’ jurisprudence on Article 52(2) & (3) was inappropriate. This is because, contrary to the EBA’s assertion, that view is not based on “consistent” logic,\(^ {82}\) has not “created a practicable system for delimiting the innovations for which a patent may be granted”,\(^ {83}\) and however amenable to clear formulation, is insufficiently coherent to be capable of supporting predictable and verifiable judicial decision-making.\(^ {84}\) In this sense, it fails the EBA’s own test of a constitutionally robust legal order.

The EBA’s decision fails that test in other ways as well. For example, by treating the European Patent Organisation as having the equivalent status of a national democratic state,\(^ {85}\) the EBA failed properly to consider its role within the wider European patent system, including the impact of its decisions on national

\(^{79}\) G_0003/08, [10.13]. See also [10.11] (“While the final outcome of the cases is not the decisive factor in determining the admissibility of a referral (see point 7.3.7 above), the Enlarged Board also notes that there is no suggestion in the referral that the change of approach from Article 52(2) EPC to Article 56 EPC had any effect on the final result of T 424/03.”)

\(^{80}\) Cf ibid [7.3.7] (“Legal rulings are characterised not by their verdicts, but by their grounds. That is the only way of assessing the courts’ opinion, and the ability to assess that is in turn the key to legal certainty.”); but cf [10.11] (ibid).

\(^ {81}\) The point is made in Pila (n 62).

\(^ {82}\) See ibid [10.8.2].

\(^ {83}\) See ibid [10.13.2].

\(^ {84}\) See n 21.

\(^ {85}\) See n 18; G_0003/08, [7.2.2] et seq.
patent laws, and the additional obligations which this imposes, or ought to be regarded as imposing. 86 That impact derives from the requirement that national European courts interpret their patent legislation in a manner that is consistent with the Boards’ interpretation of the EPC, 87 and is reflected in the leading UK authority on the computer programs exclusion. The authority is *Symbian v Comptroller-General of Patents*, 88 where the Court of Appeal referred to its commitment to cooperation with the EPO in denying any substantive difference between UK and EPO jurisprudence regarding Article 52(2)(c) & (3), and postponed the development of UK law with respect to that Article pending a decision of the EBA. 89 Among other things, this underlines an important point about Europeanization, which is the unequal burden of national courts to ensure its realization through “cooperation” with the EPO. 90 Hence my suggestion, that the very fact of this inequality imposes an obligation on European decision makers to take particular care to facilitate the task of national courts by offering detailed reasons for their decisions, whether or not they are bound by common law rules of precedent to do so. 91 Among other things, this is necessary to ensure transparent judicial analysis and consistent decision making, both of which were recognized as essential in G_0003/08. 92 It also leads to my conclusion, that by failing to give sufficient weight to the place and role of the Boards in the European patent system, the EBA rendered a decision that is higher on democratic language than democratic content. Given this, and the other factors

86 See G_0003/08, [5] (“decisions of other (national) courts are not relevant when examining the admissibility of a referral. Such courts are not part of the European Patent Organisation, and there is nothing in the EPC to make their decisions binding on the Office.”); [7.2.3] (“On the other hand, the interpretation of the EPC or equivalent national regulations by the courts of the Contracting States has no direct consequences for Office departments”); [10.8.2] (describing T_424/03 ([MICROSOFT/Clipboard formats I] [2006] EPOR 39 as unchallenged in any subsequent Board decision, and adding “national court decisions are another matter, but cannot be taken into account for admissibility as discussed above”).


88 [2008] EWCA Civ 1066.

89 See ibid [44].

90 See Pila (n 62). On the duties of the UK courts to cooperate with the EPO (and their limits) see ibid; *Eli Lilly v Human Genome Sciences Inc* [2010] EWCA Civ 33, [41].


92 See G_0003/08, [7.3.6] (on transparency); [12.21] (on consistency).
above, the only hope is for the European or national Legislatures to recognize that “judiciary-driven legal development”\(^{93}\) within the EPO has indeed met its limits, with the result – as the EBA itself suggested – that “it is time for the legislator to take over.”\(^{94}\)

\(^{93}\) Ibid [7.2.7].

\(^{94}\) Ibid.