

4.3. National decisions: no binding effect on the boards of appeal

In decision T 452/91 it was 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 could 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 (R 21/09, T 1753/06).

In G 1/19 (Pedestrian simulation), the Enlarged Board observed that in the course of the referral proceedings, reference was made to certain national decisions (from Germany and UK). However, as the referred questions were only understood in the framework of the COMVIK approach, which was specifically established in the case law of the boards of appeal and on which the national decisions are not based, the Enlarged Board did not consider it appropriate to address them in detail.

5. Decisions of the Administrative Council: boards of appeal not formally bound

In J 16/96 (OJ 1998, 347) the issue was whether an association of representatives within the meaning of R 101(9) EPC 1973 could also be formed by professional representatives who did not work in private practice. The Administrative Council of the European Patent Organisation had decided at its 4th meeting in 1978 that an association within the meaning of this rule could only be an association consisting of professional representatives in private practice. The Legal Board of Appeal pointed out that in their decisions the boards of appeal were not bound by any instructions and complied only with the provisions of the EPC 1973 (Art. 23(3) EPC 1973). The boards of appeal could not be formally bound by a decision of the Administrative Council concerning a question of interpretation, nor could such a decision be deemed to be an instruction for their decisions. However, such a decision was a relevant element in interpretation. Interpreting the case in accordance with Art. 31(1) of the Vienna Convention, the board concluded that an association within the meaning of R 101(9) EPC 1973 could also be an association of representatives not engaged in private practice. The intended aim of the Council's decision, which was to eliminate ambiguities in the application of R 101(9) EPC 1973, had, in the light of recent developments in the profession, not been achieved, and as such the decision was less important in relation to the other factors involved in interpretation.

In G 3/19 the Enlarged Board concluded that, in view of the clear legislative intent of the contracting states as represented in the Administrative Council and having regard to Art. 31(4) Vienna Convention, the introduction of R 28(2) EPC allowed and indeed called for a dynamic interpretation of Art. 53(b) EPC. In the referral decision (T 1063/18), the board had held that, although the Administrative Council was competent to amend the