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EPO May Return to Patenting Plants Obtained by an Essentially Biological Process

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On December 5, 2018, a Technical Board of Appeal of the European Patent Office (EPO) announced that a recently introduced rule, which prohibits the grant of patents in respect of plants or animals exclusively obtained by means of an essentially biological process, is in conflict with the articles of the European Patent Convention (EPC). In this situation, the articles prevail, which appears to mean that the EPO may return to granting patents in respect of plants or animals exclusively obtained by means of an essentially biological process.

One of the provisions of the EPC, Article 53(b), states that patents shall not be granted in respect of plant or animal varieties or essentially biological processes for their production. In terms of plants, a reason for this exclusion is that a separate regime exists to provide protection for such subject matter (the International Union for the Protection of New Varieties of Plants), and so patent protection is not required. However, in the era of genetically modified plants, Article 53(b) EPC has required some clarification from the EPO to determine exactly what is considered to be patentable subject matter.

A relatively early decision of the EPO's Enlarged Board of Appeal (EBoA) decided that a claim wherein specific plant varieties are not individually claimed is not excluded from patentability under Article 53(b) EPC even though it may embrace plant varieties (G 1/98; Dec 1999). This decision was later followed up by two consolidated EBoA decisions (G 2/07 and G 1/08; Dec 2010), where the Board provided guidance as to which processes can be considered to be "essentially biological". However, all of these decisions left open the question of whether the products of essentially biological processes were patentable. For instance, would tomatoes or tomato plants generated by a new and inventive, but essentially biological, process be patentable?

To address this, two consolidated decisions (G2/12 and G2/13; Mar 2015) provided further clarification as follows:

> The exclusion of essentially biological processes for the production of plants in Article 53(b) EPC does not have a negative effect on the allowability of a product claim directed to plants or plant material such as a fruit.

This was a controversial decision, because patent protection for such products did not align with the laws of several European countries. The European Commission (EC) then became involved and decided that the EU Biotech Directive (98/44/EC), which is written into the EPC, should be interpreted to exclude from patentability products (plants/animals and plant/animal parts) that are obtained by means of essentially biological processes (2016/C 411/03; Nov 2016). The views of EC are not binding on the EPO because the EPO is not an EU organisation. However, to ensure uniformity of European patent law, in 2017 the EPO's Administrative Council amended the Implementing Regulations to include Rule 28(2) EPC which states:

> Under Article 53(b), European patents shall not be granted in respect of plants or animals exclusively obtained by means of an essentially biological process.

It was therefore assumed that such products were not patentable. However, the EPO has recently issued the following notice (reproduced in full):

> Case T 1063/18 concerns the appeal by the applicant against the decision of the examining division to refuse European patent application no. 12 756 468.0 (publication no. EP 2 753 168) for the sole reason that the claimed subject-matter falls within the exception to patentability according to Article 53(b) and Rule

28(2) EPC (here: plants exclusively obtained by means of an essentially biological process).

At the oral proceedings, which took place on 5 December 2018, Technical Board of Appeal 3304, in an enlarged composition consisting of three technically and two legally qualified members, held that Rule 28(2) EPC (see OJ 2017, A56) is in conflict with Article 53(b) EPC as interpreted by the Enlarged Board of Appeal in decisions G 2/12 and G 2/13. The Board referred to Article 164(2) EPC, according to which the provisions of the Convention prevail in case of conflict with the Implementing Regulations, and decided to set the decision under appeal aside and to remit the case to the examining division for further prosecution.

The written decision containing the board's full reasons is expected to be issued early next year.

Key takeaways

We will await the full written decision with interest, but the above statement indicates that the EPO may return to granting patents in respect of plants or animals exclusively obtained by means of an essentially biological process. Applicants should, therefore, consider seeking European patent protection for such subject matter, despite the apparent exclusion. Of course, applicants should also take into account that such patents may not be enforceable in some jurisdictions, although (as we have seen) much can change in the 20 year life span of a patent.

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