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New Enlarged Board of Appeal decisions G 2/12 and G 2/13: tomatoes and broccoli remain patentable subject-matter

The Enlarged Board of Appeal of the European Patent Office released its hotly awaited decisions on the patentability of plant-related inventions yesterday (G 2/12, "Tomatoes II"; and G 2/13, "Broccoli II"). We are representing the tomato patent. The good news is: Plants are not exempted from patentability under Article 53(b) EPC (unless the claimed invention specifically relates to plant varieties). This even applies to situations where the only method available for generating the plants is an essentially biological process for the production of plants.

Before the tomato case was referred for the second time to the Enlarged Board in 2011, there was a broad consensus in the community that, in terms of compound protection, Article 53(b) EPC did not present a bar to plant-related inventions other than to plant varieties as such. It was generally believed that the Enlarged Board had finally dealt with this topic in its decision G 1/98. Though triggered by a case relating to transgenic plants, the conclusions the Enlarged Board drew at that time were generally applicable to any type of plants. Accordingly, plants were in principle considered patentable unless a claim specifically related to plant varieties since these fall under the exclusion of Article 53(b) EPC.

Then there were decisions G 2/07 and G 1/08 where the broccoli and tomato cases were considered for the first time by the Enlarged Board, however, with respect to the breeding methods claimed in the respective patents. The Enlarged Board chose to interpret the process exclusion of Article 53(b) EPC quite broadly and basically reasoned that processes for producing plants fall under the exclusion as soon as they contain steps of sexual crossing entire genomes and selection. This had the consequence that patent proprietors in both cases had to delete their method claims.

The tomato case went back to the Technical Board and the remaining compound claims directed to tomato fruit were considered. Though G 1/98 had seemingly resolved any issues about the patentability of plants, this point was again raised by the opponent in the oral proceedings. It was argued that compound protection for tomato fruit would also embrace the activity of a breeder to obtain such plants. This would frustrate the legislator's intent to keep patent-free such activities as was determined in G 1/08. Thus, it was argued that the exclusion of essentially biological processes for the production of plants had to extend to the products of such processes. The Technical Board picked that point up and referred corresponding questions of law to the Enlarged Board – it was for the first time that one and the same case was considered twice by the Enlarged Board. The broccoli case followed suit so that it came again to consolidated proceedings before the Enlarged Board.

In its decision G 2/12, the Enlarged Board provided the following answers to the questions of law referred to it:

1. 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.
2. In particular, the fact that the only method available at the filing date for generating the claimed subject-matter is an essentially biological process for the production of plants disclosed in the patent application does not render a claim directed to plants or plant material other than a plant variety unallowable.
3. In the circumstances, it is of no relevance that the protection conferred by the product claim encompasses the generation of the claimed product by means of an essentially biological process for the production of plants excluded as such under Article 53(b) EPC.

The answers in G 2/13 were essentially the same and, in addition, clarified that the above conclusions equally apply to product-by-process claims. Furthermore, a question of law asking whether the problem could be resolved by a disclaimer was considered not applicable.

By following a systematic approach, the Enlarged Board could not find any indication in the EPC that the process exclusion of Article 53(b) EPC is to be interpreted broadly such that it extends to products of the prohibited processes (section VII of the Reasons). The Enlarged Board also held that the question of patentability of a claimed subject-matter must be distinguished from the question of the scope of protection that is conferred by the claim (point VIII.2(6) of the Reasons).

The pleasant consequence of G 2/12 and G 2/13 is that the EPO will continue to grant patents on plant inventions as it did before the last tomato referral in 2011.

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