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### **Important information for applicants of plant patents: Conventionally bred plants are again patentable at the EPO**

In our last Newsflash on this topic in the second half of 2017, we have warned that newly introduced Rule 28(2) EPC would not establish legal certainty on the patentability of plants (against the expressed intentions of the EPO's Administrative Council). According to that Rule, "European patents shall not be granted in respect of plants or animals exclusively obtained by means of an essentially biological process." Our assumption was that the Enlarged Board of Appeal would not uphold the new Rule given its previous clear interpretation of the higher ranking Article 53(b) EPC in G 2/12 and G 2/13 (Tomato/Broccoli II). Therein, plants as defined in the Rule were held patentable (unless they are individual plant varieties; see G 1/98).

Now, Rule 28(2) EPC has recently indeed been annulled, however not by the Enlarged Board of Appeal, but by Technical Board of Appeal 3.3.04, chaired by Ms. Gabriele Alt. In the case T 1063/18 (Pepper plants/SYNGENTA) on patent application EP12756468.0, it was decided that Rule 28(2) EPC was not applicable. The decision was pronounced in the oral proceedings on December 5, 2018. The Written Decision is not out yet, but the Minutes are. They say very clearly:

After deliberation, the chair announced that the board was of the opinion that Rule 28(2) EPC was in conflict with Article 53(b) EPC, as interpreted by the Enlarged Board of Appeal in decisions G 2/12 and G 2/13, and that in accordance with Article 164(2) EPC the provisions of the Convention prevailed. (Minutes issued on December 14, 2018)

In other words, the provisions of Article 53(b) EPC, as interpreted by the Enlarged Board of Appeal in G 2/12 and G 2/13, prevail over the conflicting Rule 28(2) EPC. This means that

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. (G 2/12, Catchword 1)

Accordingly, there is no applicable provision in the EPC that prohibits compound claims directed to plants (except for the exclusion of plant varieties under Article 53(b) EPC). The Guidelines at G-II, 5.4, which reflect Rule 28(2) EPC, should consequently not be applicable anymore.

One might consider it surprising that the case was not referred to the Enlarged Board of Appeal. To Technical Board 3.3.04, the legal situation must have appeared clear enough so that they could decide on the case by themselves. A consequent application of the Article-over-Rule provision of Article 164(2) EPC, together with the thoroughly reasoned G 2/12 and G 2/13 decisions, obviously gave the Board the right means for taking this approach.

For the users of the EPO working in the plant sector, it was certainly frustrating to be at first confronted with a law change banning conventionally produced plants from patentability and, one and a half year later, to have to learn that this ban is lifted again. Not easy to craft reasonable IP strategies under such circumstances. The question is: What comes next?

It is difficult to see how the EPO President or the Administrative Council could change the course again. Article 112(1)(b) EPC provides the President with the power to refer questions of law to the EBA, but only in case of conflicting Board of Appeal decisions. As yet, there are no conflicting decisions on the patentability of conventionally produced plants. So, this instrument should not be available.

Another possibility would be to again try to amend the EPC. However, at the level of the Implementing Regulations, such an attempt has already failed (see Rule 28(2) EPC). The other alternative would be to amend Article 53(b) EPC. However, this would require revising the EPC through a lengthy and complicated process, not very attractive to those wanting a swift ban of plant patents.

Thus, it may be that the probably still existing political pressure against plant patents will now be sought to be released outside the EPC in the post-grant sphere. By finding more liberal regulations as regards the scope of protection, plant breeders could be

enabled to use patented seed material for further breeding according to the breeder's exemption as is long-established for plant variety protection.

The big hope is that the present Board of Appeal decision terminated the period of legal uncertainties. It began in the hearing of November 8, 2011 in the Tomato case (T 1242/06) when the Opponent, Unilever, questioned patentability of conventionally bred plants on the basis of the process exclusion of Article 53(b) EPC. This undesirable development is now over.

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