

Mr Wiek Crasborn

Registry of the Enlarged Board of Appeal

EBAamicuscuriae@epo.org

20 September 2019

Subject: Written statement of the European seed industry in case G 3/19

Dear Mr. Crasborn,

Euroseeds¹ appreciates the opportunity offered to third parties to file written statements in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal regarding the questions submitted pursuant to Article 112(1)(b) EPC by the President of the EPO to the Enlarged Board of Appeal on 5 April 2019, and which relate to the patentability of plants exclusively obtained by essentially biological processes and to decision T 1063/18 of a Technical Board of Appeal of 5 December 2018.

Euroseeds strongly holds that the free access to all genetic resources for further breeding and the freedom to operate in crossing and selection must be safeguarded.

Plant breeding is the science of recombining – by the physical use of plants - the genetics of already existing plant varieties with the purpose of creating a new plant variety. The aim of a plant breeder is always to obtain the best possible combination of genetics responding to the determined breeding goals which are – to a large extent - driven by societal needs and environmental challenges. To complete this work, throughout a breeding program a breeder might need to access and work with thousands of plants. Therefore, access to the widest possible genetic variability is the basis of plant breeding since those constitute the starting material of breeding work.

¹ Euroseeds (formerly ESA) is the voice of the European seed industry, representing the interests of those active in research, breeding, production and marketing of seeds of agricultural, horticultural and ornamental plant species. Today, Euroseeds has more than 35 national member associations, from EU Members States and beyond, representing several thousand seed businesses, as well as more than 70 direct company members, including from seed related industries.

Rule 28(2) adopted by the Administrative Council of the EPO in 2017 and the subsequent practice of the EPO to request a disclaimer in patent claims to restrict the scope of protection to the technical invention, are of key importance in safeguarding the abovementioned principles.

Therefore, Euroseeds would answer the questions at stake as follows:

Ad question 1)

Having regard to Article 164(2) EPC, can the meaning and scope of Article 53 EPC be clarified in the Implementing Regulations to the EPC without this clarification being a priori limited by the interpretation of said Article given in an earlier decision of the Boards of Appeal or the Enlarged Board of Appeal?

According to Euroseed's opinion, this question should be answered positively. Euroseeds supported the proposal of the Administrative Council of the EPO to include the exclusion of plants obtained by an essentially biological process in the Implementing Rules of the EPC. We therefore always have been and still are of the opinion that the interpretation of article 53(b) is not a priori limited by the interpretation given in an earlier decision of the Boards of Appeal or the Enlarged Board of Appeal. This has been clearly expressed also in our press release from 29 June 2017 regarding Rule 28(2) of the Implementing Regulations (see Annex 1). For the legal argumentation, we support the thorough and clear argumentation of the president of the EPO in his substantive considerations in part B sub I of the abovementioned referral.

Ad question 2)

If the answer to question 1 is yes, is the exclusion from patentability of plants and animals exclusively obtained by means of an essentially biological process pursuant to Rule 28(2) EPC in conformity with Article 53(b) EPC which neither explicitly excludes nor explicitly allows said subject-matter?

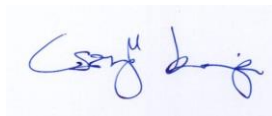
This question should as well be answered positively as we are of the opinion that Article 53(b) EPC implicitly excludes plants and animals obtained by means of an essentially biological process. In our written statement in respect of case G 2/12 of November 30, 2012 (see Annex 2) we explained that if claims directed to products obtained by a non-patentable essentially biological process would still be allowable, this would make the exclusion of Article 53 (b) EPC meaningless. This is because the protection on the product would also hinder the use of the essentially biological process. We would like to underline again that it could not be the intention of the legislator to adopt a provision deprived from its practical effect.

Further, also in relation to this question, we support the considerations of the President of the EPO as described in part B sub 2 of the afore-mentioned referral.

Finally, Euroseeds would like to thank you for the chance to contribute to the discussion on this important topic. We would like to emphasize that having clarity in this matter is of high importance for the European plant breeding sector and therefore, we would like to urge the Enlarged Board of Appeal to provide answers to the above questions in its deliberations on the referral at stake.

We are confident that you will give due attention to the considerations presented above and in the attached documents.

Yours sincerely,



Szonja Csörgő

Director Intellectual Property & Legal Affairs

Annexes:

1. ESA press release "EPO aligns with Commission notice on the non-patentability of plants obtained by essentially biological processes", 29 June 2017 (ESA_17.0439)
2. ESA written statement of November 30, 2012 (ESA_12.0823)



EPO ALIGNS WITH COMMISSION NOTICE ON THE NON-PATENTABILITY OF PLANTS OBTAINED BY ESSENTIALLY BIOLOGICAL PROCESSES

PRESS RELEASE
Brussels
29 June 2017

The European Seed Association—ESA is the voice of the European seed sector. ESA's members are national associations and individual companies active in research, breeding, production and marketing of seeds of agricultural and ornamental plant species. ESA represents more than 7000 seed businesses in the EU and beyond.

Media Contact:

Valentina Garoia
Avenue des Arts 52
B-1000 Brussels
T. +32 (0)2 7432860
valentinagaroia@euroseeds.eu

FOLLOW US ON



On June 28-29, 2017, at the meeting of the Administrative Council of the [European Patent Office \(EPO\)](#), Contracting States of the European Patent Convention (EPC) voted for a change of the rules of the Implementing Regulations of the EPC which allows the EPO to align its granting practices with the clarifications provided by the European Commission on Directive 98/44 last November.

ESA welcomes this decision and congratulates the EPO and its member countries on the efficient work and discussions they managed to conclude in the past few months in order to ensure the harmonized application of European patent law in the field of plant-related inventions.

According to the decision of the EPO's Administrative Council, Rule 28 of the Implementing Regulations, which deals with exceptions to patentability, is completed with a second paragraph stating that "under Article 53(b), European patents shall not be granted in respect of plants or animals exclusively obtained by means of and essentially biological process." As it also stated in the explanatory notes to the rule change, this new rule will allow EPC member countries to have a fully coherent approach in their national patent laws. At least for those EPC members which are also EU Member States, there is an obligation to implement both the EPC and EU Directive 98/44 in their national law, and an aligned interpretation of the two instruments is key for a harmonized approach and legal certainty.

"This is a huge success for the European seed industry! We started our discussions on this matter in 2007, ESA adopted its respective position in 2012 and has continuously advocated for a solution to re-establish the balance between patents and plant breeders' rights," says Garlich von Essen, ESA's Secretary General. *"Breeders must be able to continue their daily work, based on crossing and selection, without any disturbance of their classical way of working, largely empowered by the breeders' exemption, which is implemented in a few national patent laws as well as in the future Unitary Patent Court Agreement. This decision increases the legal certainty that is key for ESA members,"* von Essen continues.

Following the clarifying notice from the Commission, the EPO suspended all proceedings related to patent applications where products of essentially biological processes might have been claimed. These cases will now be processed in light of the newly inserted rule, which applies to pending files as well since the adopted interpretation is considered to be the only valid interpretation of the EPC. The application of the new Rule in practice will show how many grey areas still remain, including for example the fact that in 2015, in the Tomato and Broccoli II decision, the Enlarged Board of Appeal of the EPO came to a different interpretation of the EPC. *"Grey areas will always remain. We understand that with the new Rules it is also clarified that products of non-essentially biological process remain patentable and for breeders, the next important practical question will be to understand how the new rule influences the possibility to rely on essentially biological processes to come to the same products in an independent manner. This is however a matter that we hope to clarify in constructive discussions with the EPO,"* concludes Garlich von Essen.



**European Patent Office
Registry of the Enlarged Board
of Appeal**

Erhardtstr. 27
80469 München
Germany

ESA_12.0823

Brussels, November 30, 2012

Subject: written statement in respect of case G 2/12

Dear Madam / Sir,

ESA the European Seed Association appreciates the opportunity offered to third parties to file written statements in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal regarding the points of law referred to the Enlarged Board of Appeal by the Technical Board of Appeal with interlocutory decision of 31 May 2012 in case T 1242/06.

ESA is the voice of the European seed industry, representing the interests of those active in research, breeding, production and marketing of seeds of agricultural, horticultural and ornamental plant varieties. Protection of intellectual property is a matter of high importance for the European seed industry. In this respect we refer to the ESA position paper on Intellectual Property Protection for Plant-related Inventions in Europe (ESA_12.0100) adopted in October 2011, which is attached to the present letter.

ESA considers the 1991 Act of the UPOV Convention to be the most suitable existing *sui generis* intellectual property system for the protection of plant varieties *per se*: on the one hand it provides for effective protection of plant varieties of all genera and species in order to obtain return on investment; and on the other hand it guarantees the continuous flow of improved plant varieties by safeguarding access to genetic variability through the so-called breeder's exemption which is a key cornerstone of the system. At the same time ESA is of the view that besides plant breeder's rights also patents play an increasing and important role in the European seed and plant breeding sector. Nevertheless, it has to be underlined that while in theory plant varieties as such are excluded from patent protection, in practice – as a result of the specific nature of plant-related patents – plant varieties often fall under the scope of certain patents. As the current European patent system does not provide for a breeder's exemption this blocks access to biological material for further breeding which material otherwise would be free for such purposes under plant breeder's rights.

ESA is of the opinion that in order to safeguard the necessary access to genetic variability for the development of new, improved plant varieties the questions asked to the Enlarged Board of Appeal should be answered as follows:

Ad question 1)

Can the exclusion of essentially biological processes for the production of plants in Article 53(b) EPC have a negative effect on the allowability of a product claim directed to plants or plant material such as fruit?

This question must be answered in the affirmative.

If claims on products obtained by a non-patentable essentially biological process would still be allowable, this would make the exclusion of Article 53 (b) EPC meaningless. This is because the protection on the product would also hinder the use of the essentially biological process. Therefore the exclusion of essentially biological processes can and should have a negative effect on the allowability of a product claim directed to plants or plant material resulting from the application of such essentially biological process.

Ad question 2)

In particular, is a claim directed to plants or plant material other than a plant variety allowable even if 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?

As described above, allowability of such a claim would make the exclusion of essentially biological processes meaningless. Therefore this question has to be answered negatively.

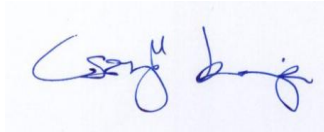
Ad question 3)

Is it of relevance in the context of questions 1 and 2 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?

ESA is of the view that it is of relevance because in the case a claim is directed to plants obtained by a **non** essentially biological process, for example, a process consisting of genetic modification, technically induced mutagenesis, protoplast fusion or another technical process not based on crossing and selection, such claim is allowable even if the same plants could be obtained by an essentially biological process. However in such a case ESA is of the opinion that the effect of patents granted on such plants should not extend to biological material having the same properties as the patented material but produced independently, without the use of the patented material, and by an essentially biological process.

ESA would like to thank you once again for the opportunity to contribute to the discussion on this important topic. We are confident that you will give due attention to the considerations presented above.

Yours sincerely,

A handwritten signature in blue ink, appearing to read 'Szonja Csörgő', is centered on a light blue rectangular background.

Szonja Csörgő

Manager Intellectual Property and Legal Affairs

Annex:

ESA position on Intellectual Property Protection for plant-related inventions in Europe (ESA_12.0100)