



BUNDESVERBAND DEUTSCHER PFLANZENZÜCHTER E.V.

Der Geschäftsführer

European Patent Office
Registr of the Enlarged Board of Appeal
Mr. Wiek Crasborn
80298 München

Bonn, 17.09.2019 Bö/USc

Subject: written statement in respect of case G 3/19 (Referral further to the appeal proceedings T 1063)

Dear Mr. Crasborn,

The German Plant Breeders Association (Bundesverband Deutscher Pflanzenzüchter e.V. - BDP) represents the interests of its 130 members which are agricultural and horticultural breeding and seed trading companies.

We appreciate 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.

BDP 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.

Rule 28(2) EPC 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. Independent from the necessity of a consequent and consistent application of the Rule 28(2) for the whole plant breeding sector, Rule 28 (2) can also withstand legal examination:

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Admissibility of the President's referral under Article 112(1)(b):

Article 112(1)(b) EPC provides that "In order to ensure uniform application of the law, or if a point of law of fundamental importance arises: (a) [...]; (b) the President of the European Patent Office may refer a point of law to the Enlarged Board of Appeal where two Boards of Appeal have given different decisions on that question."

With regard to the question of admissibility, BDP fully supports the arguments put forward by the President of the EPO in his referral and besides, wishes to put forward the following arguments:

Article 112(1)(b) requires that two Boards of Appeal have given different decisions on a question of law. To our knowledge, in the field of biotechnological inventions it is always the same Technical Board of Appeal that decides on the cases, therefore technically the condition of "two Boards of Appeal" can never be fulfilled. However, it is clear that it could not be the intention of the legislator to exclude the field of biotechnological inventions from the Presidential right of referring a question of law to the Enlarged Board of Appeal. That would deprive the provision from its '*effet utile*' and would also unjustifiably discriminate one field of technology. When assessing the criteria under Article 112(1)(b), the Enlarged Board of Appeal therefore should look at the '*effet utile*' of the provision and acknowledge the Presidential right to a referral.

As regards the criterion of "different decisions", further to the cases cited by the President in his referral, we are of the view that the decision of the Technical Board of Appeal in case T 1063/18 is also contrary to the decision of the same Board of Appeal in case T 1208/12 rendered on 7 February 2017. In the latter case the patentability of an invention was questioned under Article 53(b) EPC and in its assessment the Board of Appeal largely relied on some key principles set out in case G 1/98, even if the invention in case T 1208/12 did not result from genetic engineering. In case T 1063/18 however, the same Board of Appeal chose another line of argumentation and did not refer to case G 1/98 at all. The application of one line of argumentation in case T 1208/12 and another one in T 1063/18 leads to different decisions from the same Board of Appeal touching upon the same fundamental question of law: the extent of the exclusions under Article 53(b) EPC.

Based on the above, the Enlarged Board of Appeal should give due consideration to the importance of the legal question at stake as well as to the '*effet utile*' of the provision under Article 112(1)(b) EPC when deciding on the admissibility of the President's referral.

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?

BDP is of the opinion that this question has to be answered in the positive.

The fundamental competence of the Administrative Council to amend the Implementing Regulation is laid down in Article 33(1)(c) EPC, and it has been recognized in various rulings. For only one example the decision G 2/06 can be mentioned in which the Enlarged Board of Appeal acknowledged that the Administrative Council is competent to give "*detailed guidance*

*on what was patentable and unpatentable*¹ via amendment of the Implementing Regulations. This has also been indicated in cases G 2/12 and G2/13, where the Enlarged Board of Appeal recognized that the Administrative Council “*may amend the Implementing Rules in the respect of both procedure and substance*”².

BDP is further of the opinion that the interpretation of Article 53(b) EPC is not *a priori* limited by the interpretation given in an earlier decision of the Board of Appeal or the Enlarged Board of Appeal. The Enlarged Board of Appeal interpreted Article 53(b) EPC in cases G 2/12 and G2/13 under the evaluation of all possible aspects which were known and available in 2015. The European Commission’s “Notice on the interpretation of certain articles of the EU Biotechnology Directive” (the “Clarification”) had not been issued at that time, but only in 2016. If it had been available in 2015 already, the Enlarged Board of Appeal would have been obliged to consider it in interpreting Art 53(b) EPC.

According to Rule 26(1) EPC the EU Biotechnology Directive (the “Directive”) has to be taken into account for the interpretation of the EPC. The Clarification issued by the European Commission (the EU COM) in 2016 has to be taken into account when correctly interpreting the Directive, given the facts that the EU COM is one of the key creators of the Directive, and that the Clarification is broadly supported by the European Union Member States, whereas such support by European Union Member States is also proven by the implementation of similar paragraphs into their national patent laws.

The fact that the EU COM issued the Clarification just in 2016 does not reduce its relevance for the interpretation of the Directive and - in consequence - of the EPC. According to Article 31(3) Vienna Convention any subsequent agreement between the parties regarding the interpretation of the treaty or its application, and any subsequent practice in the application of the treaty which establishes the agreement of the parties regarding its interpretation has to be taken into account. Rule 28(2) EPC must be seen as such a subsequent agreement and practice.

These circumstances lead to new factual findings which require a new legal analysis. Therefore, earlier decisions of the Boards of Appeal or the Enlarged Board of Appeal cannot preclude a clarification of Article 53(b) EPC via the Implementing Regulation by the Administrative Council.

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 BDP is of the opinion that Article 53(b) EPC implicitly excludes plants and animals obtained by means of an essentially biological process. In cases G2/12 and G 2/13 the Enlarged Board of Appeal stated that Article 53 (b) can be interpreted in different manners and is “not sufficiently obvious”³ whether a wide or narrow interpretation has to be applied, meaning whether the products from essentially biological

¹ OJ EPO 2009, 306, point 13 of the Reasons for the Decision.

² OJ EPO 2016, A 27 and A28, point VII. 2. (4) (a) of the Reasons for the Decision.

³ OJ EPO 2016, A27 and A28, point VII. 3. (3) of the Reasons for the Decision.

processes are patentable or not. Due to that there is room for interpretation via the Implementing Regulation to the EPC.

Only the interpretation in Rule 28(2) EPC leads to a reasonable application of Article 53(b) EPC. If claims directed to products obtained by a non-patentable essentially biological process were still 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 for the production of this product. We would like to underline that it could not be the intention of the legislator to adopt a provision deprived from its practical effect. In the light of the understanding of breeding today it seems to be obvious or even logical to interpret Article 53(b) in the way that beyond plant varieties all products obtained by a non-patentable essentially biological process should be excluded from patentability.

Furthermore – as already stated ad question 1) - it has been the clear intention of the legislator to align the EPC to the Directive which is explicitly stated in Rule 26(1) EPC and has been acknowledged in several decisions of the Enlarged Board of Appeal. The Clarification by the EU COM from 2016 gives clear guidance in that regard. Article 53(b) EPC has to be interpreted in the way stipulated in Rule 28(2) EPC.

Finally, BDP 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 utmost importance not only for the German but also 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, taking duly into account the considerations put forward above.

Yours sincerely

A handwritten signature in black ink, reading "Carl-Stephan Schäfer". The script is cursive and fluid, with the first letters of the first and last names being capitalized and prominent.

Dr. Carl-Stephan Schäfer