



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

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25 September 2019

The Registry of the Enlarged Board of Appeal
The European Patent Office
Bob-van-Bentham-Platz 1
80469 Munich
Germany

via email: EBAamicuscuriae@epo.org

For the attention of Mr Wiek Crasborn

RE \\ Case Number G 3/19

Dear Mr Crasborn,

FICPI is pleased to have the opportunity to provide the enclosed written statement for case G 3/19 in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal.

Yours sincerely,

Roberto Pistolesi
Secretary General

Enc.



Written statement for case G 3/19 before the Enlarged Board of Appeal

25 September 2019

Founded over 100 years ago, **FICPI** is the international representative association for IP attorneys in private practice throughout the world, with about 5,500 members in 86 countries and regions, including European patent attorneys, national patent attorneys and patent agents in all EPC contracting and extension states.

FICPI aims to study all administrative or legislative reforms and all improvements to international treaties and conventions, with the object of facilitating the exercise by inventors and IP owners of their rights, of increasing their security and of simplifying procedure or formalities.

In pursuance of this aim, **FICPI** strives to offer well balanced opinions on proposed international, regional and national legislation based on its members' experience with a great diversity of clients having a wide range of different levels of knowledge, experience and business needs of the IP system.

FICPI is pleased to have the opportunity to provide this written statement for case G 3/19 in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal.

I. Case G 3/19

1. Background

Under Article 53(b) EPC:

“European patents shall not be granted in respect of:

(b) plant or animal varieties or essentially biological processes for the production of plants or animals; this provision shall not apply to microbiological processes or the products thereof;”

According to Article 4(1) and (2) of Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions:

“1. The following shall not be patentable:

(a) plant and animal varieties;

(b) essentially biological processes for the production of plants or animals.

2. Inventions which concern plants or animals shall be patentable if the technical feasibility of the invention is not confined to a particular plant or animal variety.”

Thus, neither the EPC nor the Directive explicitly excludes the patentability of products obtained by means of essentially biological processes.



The Enlarged Board of Appeal decided, in case G 2/12 of 25 March 2015 (and similarly in case G 2/13), 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 [or plant parts]”

so that the patenting of plants and plant material exclusively obtained by means of an essentially biological process is not excluded under Article 53(b) EPC.

On the other hand, according to EU Commission Notice 2016/C 411/03 issued on 8 November 2016,

“The Commission takes the view that the EU legislator's intention when adopting Directive 98/44/EC was to exclude from patentability products (plants/animals and plant/animal parts) that are obtained by means of essentially biological processes.”

In view of this Commission Notice, the Administrative Council of the EPO introduced on 1 July 2017 a new Rule 28(2) EPC:

“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.”

However, Board of Appeal 3.3.04 found in decision T 1063/18 of 5 February 2019 (paragraph 46) that:

“Having established that Rule 28(2) EPC is in conflict with Article 53(b) EPC as interpreted by the EBA and in view of Article 164(2) EPC, it must be concluded that the provisions of the Convention prevail.”

2. The referral

Due to decision T 1063/18, the President of the European Patent Office has, on the basis of Article 112(1)b EPC, referred the following questions to the Enlarged Board of Appeal:

“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?”

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?”

In the following comments, reference will be made to the paragraphs of the referral, which is divided into two chapters: “A. Admissibility of the referral” and “B. Substantive considerations”.

II. FICPI’s Comments

1. Admissibility of the referral

According to paragraphs 2 to 18 of the referral, *“the requirement of “different decisions” [of Article 112(1)b EPC] is fulfilled in the present case since there is conflicting case law with regard to the way*



Boards of Appeal have assessed the EPC Rules which implement Article 53 EPC under Article 164(2) EPC”.

There are no conflicting decisions relating to Article 164(2) EPC. It can be seen from all the cases cited in the referral that the Boards of Appeal have consistently applied the provisions of Article 164(2) EPC. The fact that the application of the provisions to one fact situation leads to one outcome which is different from the outcome when the provisions are applied to a different fact situation does not mean that there is any conflict between the decisions. It merely reflects the consistent application of the provisions can lead to different outcomes. The referral shows no inconsistency in the application of the provisions of Article 164(2) EPC and so for this reason the referral of question 1 is inadmissible.

There has also been no inconsistency in the application of Article 53 EPC. The referral comes to the conclusion that there has by citing and discussing cases (T 315/03, T 272/95, T 666/05, T 1213/05, T 39/93 and G 2/07) which were decided well before decisions G 2/12 and G 2/13 were issued in 2015, not to mention Rule 28(2) EPC which has been in force since 2017, so that all cases cited in the referral cannot be of much relevance for T 1063/18. In fact, neither before nor after 2015 have the Boards of Appeal issued any decision that substantially diverges from T 1063/18, so that Article 112(1)(b) EPC cannot be applied to the present case.

Paragraphs 19 to 44 of the referral also try to apply Article 112(1)b EPC by analogy, in particular by submitting that Rule 28(2) EPC and/or the EU Notice can be considered as equivalent to a decision diverging from T 1063/18, G 2/12 and G 2/13.

While recognizing that Rule 28(2) EPC and the Commission Notice diverge from T 1063/18, neither this Rule nor this Notice can be considered equivalent to a decision of a Board of Appeal since they do not come from a “judicial branch”, as neither the Administrative Council of the EPO nor the European Commission have the power to deliver decisions under the EPC or to interpret the EPC. The judicial branch of the EPO is the Boards of Appeal and the judicial branch of the EU is the CJEU and neither of these has issued a decision in conflict with T 1063/18.

Moreover, as already decided in case G 3/08, in the absence of decisions from the Boards of Appeal which clearly differ from each other, a referral to the Enlarged Board of Appeal is inadmissible under Article 112(1)(b) EPC.

Therefore, both questions raised in the referral are to be rejected as inadmissible, since the Boards of Appeal have not given any decision diverging from T 1063/18, G 2/12 or G 2/13.

2. Substantive considerations

In any event, even if the questions of the referral are admitted, it should be observed that question 1 makes a distinction between the clarification of “*the meaning and scope of Article 53 EPC*” and “*the interpretation of said Article given in an earlier decision of the Boards of Appeal or the Enlarged Board of Appeal*”.

However, in the present case the “clarification” of Article 53 EPC cannot be distinguished from its “interpretation”, since G 2/12 and G 2/13 have already clarified that this Article does not exclude the



patentability of products obtained by means of essentially biological processes, so that no further “clarification” is possible in this respect.

Therefore, Rule 28(2) EPC, by excluding the grant of European patents “*in respect of plants or animals exclusively obtained by means of an essentially biological process*”, adds another exception to patentability *a posteriori*, so that this rule substantially changes the scope of Article 53 EPC and does not just “clarify” it.

Moreover, while it is true that “*Article 53(b) EPC itself does not explicitly allow the patentability of plants (or animals) exclusively obtained by essentially biological processes*” as indicated at paragraph 75 of the referral, it is remarked that Article 53 EPC specifically provides a list of “exceptions to patentability”. Thus, if not present in this list of exceptions, any invention is patentable under Article 52(1) EPC and does not need to be “explicitly allowed” by Article 53 EPC. It is well accepted in EPO case law that exceptions must be treated narrowly and so only cover what is explicitly recited therein and cannot be extended.

Since Article 53(b) EPC, as already confirmed by G 2/12 and G 2/13, does not exclude the patentability of products produced by essentially biological processes, Rule 28(2) EPC is in conflict with Article 53(b) EPC, so that this Article prevails according to Article 164(2) EPC.

Furthermore, also Directive 98/44/EC does not contain such an exception to patentability. In fact, recital 29 of the directive explicitly states that “*inventions, which concern plants are patentable provided that the application of the invention is not technically confined to a single plant variety*”.

Accordingly, the only way to introduce this exception into the EPC is by amending Article 53 EPC itself. This could be done by adopting a specific “European Community legislation” in this matter and then amending Article 53 EPC by means of Article 33(1)(b) EPC. Any future amendment of Article 53 EPC should also be done without any retroactive effect due to the principle of protection of legitimate expectations.

Therefore, neither the laws of some EPC Contracting States nor the Commission Notice on the Directive, discussed at paragraphs 77-112 of the referral, are sufficient to allow an amendment of Article 53 EPC. In fact, the same Commission Notice recognizes at paragraph 6 that it does not even provide a binding interpretation of the Directive:

“In view of the above, this Notice sets out the Commission's views on the patentability of products emanating from essentially biological processes (addressed in Article 4 of the Directive). [...] The Notice is intended to assist in the application of the Directive, and does not prejudge any future position of the Commission on the matter. Only the Court of Justice of the European Union is competent to interpret Union law.”

As a consequence, question 1 of the referral should receive a negative answer and question 2 should not receive any answer.

Incidentally, it is observed that question 2 has already received a negative answer in G 2/12 and G 2/13, which confirmed that Article 53(b) EPC does not exclude the patentability of plants and animals



exclusively obtained by means of an essentially biological process. Thus, Rule 28(2) EPC should be deleted as soon as possible, as it is in conflict with Article 53(b) EPC.

III. Conclusions

In view of the above, FICPI suggests answering the questions referred to the Enlarged Board of Appeal as follows:

- A. both questions are inadmissible, since there are no diverging opinions from the Boards of Appeal which justify a referral under Article 112(1)b EPC;**
- B. at any rate, the two questions should receive the following answers if they were admitted:**
 - 1. no;**
 - 2. not applicable according to the negative response to question 1.**

IMPORTANT NOTE:

The views set forth in this paper have been provisionally approved by the Bureau of FICPI and are subject to final approval by the Executive Committee (ExCo). The content of the paper may therefore change following review by the ExCo.

The International Federation of Intellectual Property Attorneys (FICPI) is the global representative body for intellectual property attorneys in private practice. FICPI's opinions are based on its members' experiences with a great diversity of clients having a wide range of different levels of knowledge, experience and business needs of the IP system.

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FICPI has national sections in Argentina, Austria, Belgium, Brazil, Chile, China, Czech Republic, Greece, Hungary, India, Ireland, Israel, Malaysia, Mexico, Netherlands, New Zealand, Romania, Russia, Singapore, South Korea, Spain, Turkey and the United States of America, a regional section covering for the Andean States (Bolivia, Colombia, Ecuador, Perú and Venezuela), a provisional national section in Poland and individual members in a further 41 countries and regions.

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