

Lange Violettestraat 181
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Belgium
24 September 2019

Dear Members of the Enlarged Board

G-3/19

In 2019 OJ EPO A52, interested parties were invited to submit amicus briefs in relation to G-3/19, a referral to the Enlarged Board of Appeal (EBoA) by the EPO President. This amicus brief is submitted on my own behalf.

In G-3/19, the EBoA is being asked to decide on the correct interpretation of Art. 53(b) EPC.

Simply put, does Rule 28(2) EPC correctly interpret Art. 53(b) EPC as excluding certain subject matter from patentability under the EPC.

If it does not, then the Rule is *ultra vires* and should be ignored. If it does, then the Rule is valid. If it *is* valid, however, then the case law of the EBoA is faulty.

The “**elephant in the room**” is the EBoA’s opinion in G-1/98 NOVARTIS.

The EBoA cannot properly decide on the present case without revisiting its earlier and its most egregious mistake. **If that revisit is made, then it can be seen that the new Rule is not just valid but indeed unnecessary.**

G-1/98 (faced with a false dichotomy) incorrectly waved through the “higher taxonomic level” criterion for claim drafting to achieve *avoidance* of the statutory exclusions from patentability.

The thrust of G-1/98 was that, as long as something unpatentable was claimed in ‘generic’ terms, it *was* patentable, *but its performance would nevertheless infringe*. However, if we look to the field of surgery (also covered by Art. 53 EPC) we can easily see that the decision was *wrong*. Using the “higher taxonomic level” criterion, a claimed method of surgery on a living organism would be both patentable (since there are non-animal organisms) *and infringed when performed on humans – something that the framers of the EPC clearly did NOT intend*.

The travaux préparatoires for Art. 53 EPC are analysed at length in Chapter 2 of “Exclusions from patentability” (Sterckx and Cockbain, 2012, CUP) and G-1/98 and its background are discussed in sections 5-8, 17 and 18 of Chapter 7 of that book. Finally, the possible modes of interpretation of Art. 53 EPC are discussed in Chapter 9 of that book. For convenience, a copy of that book is included with the top copy of this letter.

I urge the EBoA to revisit G-1/98 and conclude that Art. 53(b) EPC made clear that true-breeding plants simply were not patentable and could not be encompassed by valid claims, and that, accordingly, Rule 28(2) EPC is valid.

Yours respectfully

A handwritten signature in black ink, appearing to be 'J. Cockbain', with a long horizontal flourish extending to the right.

Dr Julian Cockbain

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