



Amicus curiae brief by the Spanish Patent and Trademark Office (OEPM) to the case G 3/19 “Referral of a point of law to the Enlarged Board of Appeals by the President of the European Patent Office (Article 11.(1)(b) EPC)

I. Introduction.

1) As to the point of law referred by the President of the European Patent Office, the Spanish Patent and Trademark Office (OEPM) submits in case G 3/19 the following statements pursuant to Article 10 of the Rules of Procedure of the Enlarged Board of Appeal.

2) The President of the European Patent Office refers the following two points of law:

2.1) 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?

2.2) 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?

II. Legal Summary and Background.

3) At European Union level, Article 4 of Directive 98/44 / EC of the European Parliament and of the Council, of 6 July 1998, on the legal protection of biotechnological inventions (the Biotechnology Directive), expressly excludes from patentability plant and animal varieties as well as essentially biological processes for the production of plants or animals. And according to Article 2.2 of the Biotechnology Directive it must be understood that a process for the production of plants or animals is essentially biological if it consists entirely of natural phenomena such as crossing or selection.



- 4) However, the Directive does not expressly state whether plants or plant material (fruits, seeds, etc.) or animals or animal parts obtained through essentially biological processes can themselves be patented.

- 5) Article 53(b) of the European Patent Convention (EPC) establishes that European patents shall not be granted in respect of: “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”. Furthermore, Rule 26(5) of the Rules of implementation of the EPC repeats the wording of Article 2.2 of the Biotechnology Directive: “a process for the production of plants or animals is essentially biological if it consists entirely of natural phenomena such as crossing or selection”.

- 6) Moreover, paragraph 1 of the said Rule 26 of the EPC declares that “for European patent applications and patents concerning biotechnological inventions, the relevant provisions of the Convention shall be applied and interpreted in accordance with the provisions of this Chapter. Directive 98/44/EC of 6 July 1998 on the legal protection of biotechnological inventions shall be used as a supplementary means of interpretation”.

- 7) In cases G 1/12 and G 2/13, the Enlarged Board of Appeal (EBoA) concluded that the exclusion of essentially biological processes for the production of plants [...] does not have a negative effect on the allowability of a product claim directed to plants or plant material such as a fruit, even if the only method available for generating that fruit is an essentially biological processes for the production of plants. In other words, “plants or seeds obtained through a conventional breeding method are patentable”.

- 8) As a reaction to those decisions, the EU Commission released the Notice C/2016/6997 on certain articles of Biotechnology Directive. More precisely, in relation to Articles 2.2 and 4, the Commission firmly convinced declared that “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”. This Notice was endorsed both by the European Parliament and the EU Council.

- 9) In order to align the EPC and the EPO’s practice under Article 53(b) EPC with the interpretation of the EU Biotechnology Directive set out in the EU Commission Notice, by decision CA/D 6/17 of 30 June 2017 the Administrative Council decided to clarify, by amending Rules 27(b) and 28 EPC, that under Article 53(b) EPC plants and animals



exclusively obtained by means of an essentially biological process are excluded from patentability. The amended provisions entered into force on 1st July 2017.

- 10) However, in case T 1063/18 the Technical Board of Appeal 3.3.04 established that Rule 28(2) EPC is in conflict with Article 53(b) EPC as interpreted by the EBoA and in view of Article 164(2) EPC, it must be concluded that the provisions of the Convention prevail. In this decision, the Technical Board strongly stated that it was not bound by a Notice of the European Commission, but by the decisions of the EBoA, in the understanding that “an interpretation of the EPC by the EBoA is thus to be applied to all cases pending before the departments of the European patent office and before the Boards of Appeal and in all subsequent cases, unless the EBoA provides transitional dispositions”.

III. Question 1.

- 11) Regarding the first question, it is important to emphasize that in Decisions G 1/08 (Tomato I) and G 2/07 (Broccoli I) it was clearly stated by the EBoA that, if the rules of the Implementing Regulations are amended and this amendment is in conflict with an interpretation given to an article of the CPE by any case law before entry into force of the amended rule, this does not necessarily mean that there is a conflict between a provision of the Convention and its implementing regulation, in the sense of the art. 164.2 EPC.

IV. Question 2.

- 12) With regard to the second question, it is constant "jurisprudence" of the EBoA that a rule of the Implementing Regulations of the EPC can serve not only to develop formal aspects, but also substantive aspects of the EPC.
- 13) Article 53(b) EPC does not expressly exclude products obtained from essentially biological processes. Therefore, in order to clarify such substantive aspect of the EPC, it is possible to amend a rule of the Implementing Regulations of the EPC, as it is within the competence of the EPO's Administrative Council.
- 14) With respect to this matter, in light of article 31 of the Vienna Convention on the Law of Treaties (Vienna Convention), when interpreting a Convention it is necessary to take into account, together with the context:



14.1) Article 31(3)(a) of the Vienna Convention: “any subsequent agreement between the parties regarding the interpretation of the treaty or the application of its provisions”. In this connection, after the adoption of the Biotechnology Directive and even more, after the Decisions Tomato II and Broccoli II, some Member States have modified their internal legislations in order to make it clear that the products obtained exclusively from essentially biological processes are not patentable. This is the case, *inter alia*, of France, Portugal, Austria, Germany or Italy. The Netherlands dispositions had already this wording at the moment of implementing the Biotechnology Directive, before the Tomato and Broccoli II decisions, as it seemed the only appropriate way of implementing Article 4 paragraph 1(b) of the Biotechnology Directive, as the provision would be meaningless if it would only exclude the process from patentability, and not the resulting product.

14.2) Both the current Spanish Patent Act 24/2015, which entered into force in 2017, and the former Spanish Patent Law 11/1986 (as modified in 2002), were also drafted before Tomato and Broccoli II decisions were released. When drafting them, EPC provisions were closely regarded as a role model. Article 5(3) of the current Spanish Patent Act deals with exceptions to patentability, as contained in Article 4(1)(b) and Article 2(2) of the Directive, also contained in Article 53 (b) EPC and in Rule 26 (5) EPC. Paragraph 3 reads as follows: “Essentially biological processes for the production of plants or animals. For these purposes a process for the production of plants or animals shall be considered essentially biological if it consists entirely of natural phenomena such as crossing or selection”. And although Article 5 of the Spanish Patent Act does not expressly exclude the resulting product of an essentially biological process from patentability, this has been the interpretation given both by the OEPM¹ and Spanish courts. For example, in the ruling of April 11 2014 the Barcelona Commercial Court 4 considered that a product claimed in a patent as a product-by-process claim cannot be independent of the process by which such a product has been obtained; that is, that product-by-process claims are admitted only in cases in which a product can be defined in no other way than by describing its manufacturing process

14.3) Article 31(3)(b) of the Vienna Convention should also be considered. Such Article states that “any subsequent practice in the application of the treaty which establishes the agreement of the parties regarding its interpretation.” Thus, taking into account that the practice followed by the National Patent Offices, including the OEPM, and national courts decisions, Article 53(b) of the EPC should be interpreted as that the products obtained

¹ See, Part G4.2 of the SPTO's Guidelines for examination, available at: http://www.oepm.es/export/sites/oepm/comun/documentos_relacionados/Invenciones_Ley_24_2015/2019_02_07_Directrices_Examen_Patentes.pdf



exclusively from essentially biological processes are not considered patentable. As a consequence, new Rule 28(2) of the EPC is not in conflict with the Convention.

14.4) According to Article 31(4) of the Vienna Convention, it is necessary to take into account the intention of the parties. In the present case, the intention of the legislator has been elucidated in the Notice of the EU Commission of November 2016 (2016/C 411/03). This Notice has been endorsed both by the Council of the European Union and the European Parliament, co-legislators in the EU system (Articles 14 and 16 Treaty on European Union). The legislative and the governmental branches of all 28 Member States, which are also Contracting States of the EPC, are represented in both institutions (Article 10.2 TEU). While it is true that this is not an interpretation given by the Court of Justice of the European Union (CJEU), with its corresponding binding force, this notice does have a certain value as it reflects the EU legislator's authentic intention, which must be adequately taken into consideration.

V. Conclusion.

- 15) The Enlarged Board of Appeal should take into account the Notice of the EU Commission in order to determine the actual intention of the European legislator when it drafted Article 2(2) of the Biotechnology Directive and the subsequent modification of national laws afterwards. That would lead to the conclusion that products (plants/animals and plant/animal parts) that are obtained by means of essentially biological processes are excluded from patentability, even when the claim is a product-by process one, when the only process to obtain the product is an essentially biological process.
- 16) As a final conclusion, the new Rule 28(2) EPC is not in conflict with the EPC, in particular, with Article 53(b).

Madrid, September 16th, 2019.