

European Patent Office
Registry of the Enlarged Board of Appeal
Mr. Wiek Crasborn
Richard-Reitzner-Allee 8
85540 Haar
Germany

Vienna, September 26, 2019

ÖPA-0100.03/2019/26

Dear Mr. Crasborn,

in accordance with Article 10(1) of the Rules of Procedure of the Enlarged Board of Appeal of the European Patent Office, please find enclosed the amicus curiae brief regarding case G 3/19 by the Austrian Patent Office.

Yours sincerely,



Mariana Karepova
Austrian Patent Office
President

**Amicus Curiae Brief by the Austrian Patent Office (APO)
Case G 3/19**

„Referral of a point of law on the interpretation of Article 162(2) EPC and the assessment of Rule 28(2) EPC under said provision to the Enlarged Board of Appeals by the President of the European Patent Office (Article 112(1)(b) EPC)”

1. Introduction

In accordance with Article 112(1)(b) EPC, the President of the European Patent Office has referred the following points of law 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?”*

As to the point of law referred by the President of the European Patent Office, the Austrian Patent Office (APO) submits in case G 3/19 an Amicus Curiae brief pursuant to Article 10 of the Rules of Procedure of the Enlarged Board of Appeal.

2. Legal Summary and Background

Under Article 53(b) EPC European patents shall not be granted in respect of plant or animal varieties or essentially biological processes for the production of plants or animals.

Pursuant to Rule 26(1) EPC EU Biotechnology Directive (Directive 98/44/EC) shall be used as a supplementary means of interpretation when applying and interpreting the relevant provisions of the EPC. Article 4 of the Directive expressly excludes from patentability plant and animal varieties as well as essentially biological processes for the production of plants and animals. However, the Directive does not expressly indicate whether plants or plant material or animals or animal parts obtained through essentially biological processes can themselves be patented.

Therefore, in cases G 1/12 and G 2/13, the Enlarged Board of Appeal concluded that the exclusion of essentially biological processes for the production of plants [...] does not have a negative effect on the permissibility of a product claim directed to plants and material.

In December 2015, as a reaction, the European Parliament adopted a resolution asking the EU Commission to clarify the patentability of conventional plants under the EU Biotechnology Directive, in particular under its Article 4 concerning plant-related inventions, and to communicate its clarification regarding the patentability of products obtained from essentially biological processes.

On 8 November 2016 the European Commission published a Notice of non-binding nature on certain articles of the EU Biotechnology Directive. In this Notice the Commission states that the EU legislator's intention when adopting the EU Biotechnology Directive was also to exclude from patentability products (plants/animals and plant/animal parts) that are obtained by means of essentially biological processes. The Notice by the EU Commission was endorsed by the EU Council and by the European Parliament.

Following publication of the European Commission Notice, the President of the European Patent Office decided to stay all European Patent Office examination and opposition proceedings relating to plants or animals obtained by an essentially biological process while the discussions with the EPC's Contracting States were ongoing.

Following discussions in the Committee on Patent Law the Administrative Council decided in June 2017 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 amending Rules 27 (b) and 28 EPC decision CA/D 6/17 of 29 June 2017 intended to clarify, that under Article 53(b) EPC plants and animals exclusively obtained by means of an essentially biological process are also excluded from patentability. The amended provisions entered into force on 1 July 2017.

However, in case T 1063/18 of 5 December 2018 a Technical Board of Appeal concluded that Rule 28(2) EPC, which now excludes from patentability plants or animals exclusively obtained by means of an essentially biological process, is in conflict with Article 53(b) EPC as interpreted by the Enlarged Board of Appeal in decisions G 2/12 and G 2/13. With this decision the Technical Board of Appeal set aside the examining division's decision refusing the European Patent application no. 12 756 468.0 relating to "New pepper plants and fruits with improved nutritional value" which fell within the exception to patentability according to Article 53(b) and Rule 28(2) EPC.

In the reasons for its written decision Technical Board of Appeal stated that

- Rule 28(2) cannot be interpreted in such a way that it was in conflict with Article 53(b) EPC as interpreted by the Enlarged Board of Appeal,
- The amendment of Rule 28(2) EPC by the Administrative Council in June 2017 has no impact on the interpretation of Article 53(b) EPC,
- European Commission's Notice of November 2016 is not legally binding.

3. Statement of the Austrian Patent Office

With respect to the patentability of plants and animals Austria's national patent law is very strict and indisputable. With an amendment to the law in June/July 2016 – so even before publication of the European Commission Notice – further legal clarifications were made: under Austrian national law the products (plants and animals) of essentially biological processes are expressly excluded from patentability.

All 38 Contracting States of the European Patent Convention and not just Austria alone are fully aware of the significance and current relevance of the issue "Patents on Life" in all its dimensions and ramifications and therefore seek to establish a clear and unambiguous legal regime regarding conventionally cultivated/bred plants and animals.

To achieve this objective, the Administrative Council decided on June 29, 2017 to amend Rules 27(b) and 28 EPC in a way that now under Article 53(b) EPC- plants and animals exclusively obtained by means of an essentially biological process are excluded from patentability as well.

While the ultimately ensuing amendment to the Implementing Regulation purely as such was doubtless a step in the right direction Austria voted against this change of rules and was the only Contracting State to do so. This was because at that time we were afraid a simple rule change would not lead to the desired result and called for the amendment of the European Patent Convention – in particular Article 53(b) EPC.

However, Austria strongly shares the opinion of all other Contracting States of the European Patent Convention that on the basis of Rule 26(1) of the Implementing Regulations of the EPC Article 53(b) has to be interpreted in line with the Biotechnology Directive (on the basis of Rule 26(1)) for which the intention of the EU legislator has been clarified by the Commission Notice of 8 November 2016, endorsed by the EU Council and the European Parliament and has later on been implemented by the EPC legislator through Rule 28(2).

Especially in such a sensitive field as bio-patents the goal must ultimately be the establishment of a harmonized patent law. It is thus an issue of major concern to Austria that conventional cultivation and breeding and their results do not constitute matters that can be patented.

4. Conclusion

It is of paramount importance that at the Administrative Council Meeting on June 29, 2017 all 38 Contracting States of the European Patent Convention have officially recognized the importance of harmonizing procedures within Europe and between European Patent Convention and national law or practice of all EPC Contracting States.

Furthermore, all 38 Contracting States of the European Patent Convention have indicated and declared that under national law and practice the products (plants and animals) of essentially biological processes are excluded from patentability and that national law and practice is in line with the interpretation of Article 4(1)(b) of the EU Biotechnology Directive set forth in the European Commission Notice.

And all Member States either have dispositions within their national law, or will soon have patentability exclusions for products obtained by essentially biological processes.

All this cannot be disregarded by the Enlarged Board of Appeal!

Therefore it is our considered opinion, that the Boards of Appeal must take into account the recent developments – the Notice of the EU Commission endorsed by the EU Council and the European Parliament, the decision CA/D 6/17 of 29 June 2017 of the Administrative Council on the interpretation of the European Patent Convention and the EU Biotechnology Directive – and restore legal certainty for the users of the European patent system by clearly and firmly excluding patentability of products from essentially biological processes.