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Via E-Mail EBAamicuscuriae@epo.org

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DÜSSELDORF¹ MÜNCHEN²
September 24, 2019

Your reference: G 3/19
Our reference: 53 628 K
Re.: Referral of a point of law to the Enlarged Board of Appeal
Related to patentability of plant/Art. 53 b) EPC

Dear Mr. Crasborn,

With reference to our written statement of May 24, 2019 we herewith file an opinion of Mr. Christopher Rennie-Smith. Mr. Rennie-Smith was a member of the Board of Appeal in the proceedings of T 315/03. The President of the European Patent Office in his reasoning for the Referral heavily relies on T 315/03.

Yours sincerely,



Gregor König

Enclosure
Opinion of Mr. Rennie-Smith
on T 315/03

SP2019017191

OPINION

SUMMARY

In summary, my opinion is that T 315/03 does not offer a decision differing from T 1063/18 as regards the first question referred to the Enlarged Board of Appeal in the referral 3/19. Further, both as regards admissibility of the Referral and the substantive issues raised therein, the arguments based on T 315/03 are unconvincing. The Referral refers to T 315/03 seven times for purported support but, as is explained in detail below, the content of T 315/03 is misrepresented.

1. INTRODUCTION

- 1.1 My name is Christopher Rennie Smith.
- 1.2 I am a former member of the Boards of Appeal of the European Patent Office (“EPO”). I have a degree in law (first class) from Cambridge University and a diploma in comparative law obtained after studies at the Vrije Universiteit, Amsterdam. After teaching law at Sheffield University for four years, I qualified as an English lawyer (solicitor) in 1978 and practiced in intellectual property litigation in London for over twenty years.
- 1.3 In June 1999 I took up an appointment as a legally qualified member of the Boards of Appeal, a post which I held until my retirement at the end of April 2014. I was a legally qualified member of the Enlarged Board of Appeal (“EBA”) from 2005 until my retirement. From early 2010 until my retirement I was chairman of Technical Board of Appeal 3.3.04. I was a member of the working group which drafted the Rules of Procedure of the Boards of Appeal (RPBA) in the form which they have substantially taken since 1 May 2003¹.
- 1.4 I have lectured and given talks on European patent law and procedure since 2001, including talks at seminars organised by the EPO on Board of Appeal case-law in 2012 and 2013. Since 2007 I was also involved in judicial training for both new members of the Boards of Appeal and judges from European national courts and I continue to be involved in teaching and training in patent law and procedure, for example as a tutor on CIPA’s course on EPO Proceedings and as a visiting lecturer at Cambridge, Uppsala and Bournemouth universities.
- 1.5 I now provide consultancy services relating to patents and European patents and EPO proceedings in particular. I have no connection with any party which might have an interest in the proceedings referred to below beyond having been

¹ A revised version of which will enter into force on 1 January 2020.

retained by Koenig Szynka Tilmann Von Renesse (“KSVR”) to review the matter mentioned below and to write this opinion.

2. INSTRUCTIONS AND DOCUMENTS REVIEWED

2.1 I have been asked by KSVR to review and comment in the form of this opinion on the referral G 3/19 (“the Referral”) to the EBA by the President of the EPO and in particular on the use made in the Referral of the decision T 315/03. I was a member of the Board of Appeal which made that decision. As the legal member co-rapporteur, I was principally responsible for writing the decision including those parts identified in references to the decision in the Referral. In this opinion I shall explain in my own words the background to certain parts of the decision which have been relied on in the Referral and how, in my view, the Referral misrepresents that decision.

2.2 In preparing this opinion I have reviewed the Referral, the decision T 1063/18 which has prompted the Referral, the various submissions made in the appeal proceedings which led to that decision, the decision T 315/03, and the EPO President’s documents CA/56/17 and CA/PL 4/17 which preceded the amendments to Rules 27 and 28 EPC. I have for many years been familiar with the relevant Articles and Rules of the EPC and I have more recently been following the discussions about those amendments and subsequent developments.

3. THE REFERRAL AND OTHER ISSUES

3.1 It is important that I distinguish here between on the one hand my views on the issues giving rise to the Referral and on the other hand my views on the Referral itself and its use of T 315/03 in particular. As regards the issues giving rise to the Referral, I consider in summary that

(a) the EU Commission’s Notice 2016/C 411/03 was no more than a notice expressing a view on the interpretation of Directive 98/44/EC (“the Biotechnology Directive”) as regards the products of essentially biological processes;

(b) that Notice, as it stated itself, had no legal effect on the actual or required interpretation of the Biotechnology Directive which is a matter for the Court of Justice of the European Union (the highest judicial authority in the European Union);

(c) the opinion of 25 March 2015 of the EBA (the highest judicial authority in the European Patent Organisation) in decisions G 2/12 and G 2/13 provided an interpretation of Article 53(b) EPC as regards the products of essentially biological processes and that interpretation is to be used until either the EBA provides a different opinion (as has very occasionally happened) or Article 53(b) EPC is changed;

(d) as a result, the amendments to Rules 27 and 28 are at best of doubtful legal validity, those amendments certainly have no effect on the interpretation of Article 53(b) EPC, and the decision in T 1063/18 is not only correct but the only decision which could have been reached².

3.2 I hold those views on those issues because, as a lawyer and former member of the Boards of Appeal and the EBA, I believe that laws must be made and altered only in the accepted and expected manner and that a judicial decision must be respected until it is overruled either by a later decision or properly enacted legislation. Those are principles of the rule of law (*état de droit*, *Rechtsstaat*) to which all truly democratic countries subscribe and with which they expect the international organisations they have created to comply. When I was a member of the Boards of Appeal and the EBA, those principles were accepted without question and it is a matter of sadness to me that they are now called into question and that the EPO is attracting widespread disrespect as a result. I add that I am not alone in these views. Even among those who might be sympathetic to the interpretation of the EU Commission Notice there is a very grave concern at the manner in which these issues have been handled by the EPO³.

3.3 While those are my views on the issues giving rise to the Referral, they have had no bearing on the formation of my views on the Referral itself and the use therein of decision T 315/03. The former are views on institutional issues which reflect my belief in the rule of law and the separation of powers while the latter are views on matters of procedure and of the interpretation of case law which reflect my experience of the Boards of Appel and the EBA and my knowledge of one of the decisions relied on in the Referral. I am perfectly capable of preventing my personal views on the former from affecting my professional views on the latter.

4. **STRUCTURE OF THIS OPINION**

4.1 I have identified a total of seven references in the Referral to T 315/03. Two are in part A of the Referral which addresses its admissibility and are relied on as part of the Referral's case that T 1063/18 differs from previous decisions as regards the first referred question. The other five references are all in part B of the Referral entitled "Substantive considerations".

² I also consider that the stays of pending proceedings both before the introduction of amended Rules 27 and 28 EPC and following the Referral are unwarranted and without legal basis and that both those stays and first instance decisions employing the interpretation of those rules as amended and contrary to that of the EBA in G 2/12 and G 2/13 are acts which could give rise to claims by the affected parties against the EPO. I expressed such views in blog posts on my website.

³ For completeness I should state that if the law had been amended in an acceptable manner to achieve a different interpretation of Article 53(b) EPC to that of G 2/12 and G 2/13 then, while I might disagree with that new interpretation, I would and could have no objection to the validity or effect of the amendment.

4.2 In this opinion I shall, after commenting on the Referral's admissibility submissions, describe the Referral's argument that there are different Board of Appeal decisions as regards the first referred question since T 315/03 is said to be one such decision. I shall then describe those of the issues which arose in T 315/03 which are relevant to the arguments in the Referral, then explain why I consider T 315/03 is not a different decision as suggested by the Referral. Lastly, I shall examine and comment on each of the seven references in the Referral to T 315/03.

5. **ADMISSIBILITY OF THE REFERRAL**

5.1 While I have not been asked to comment in any detail on the Referral other than as regards its use of T 315/03, I need to mention the general issues of admissibility of the Referral to place the use of T 315/03 in context.

5.2 The two questions referred to the EBA are these:

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?

5.3 As the Referral correctly summarizes (paragraph 1)

“According to Article 112(1)(b) EPC, in order to ensure the uniform application of the law, or if a point of law of fundamental importance arises, the President of the European Patent Office may refer a point of law to the Enlarged Board of Appeal where two Boards have given different decisions on that question.”

It is clear beyond doubt that there are no different decisions of the Boards of Appeal on the subject-matter of the second referred question. On the contrary, there is an opinion of the EBA on the matter in the form of its decisions G 2/12 and G 2/13. Thus, the EBA has previously considered the matter to be a point of law of fundamental importance and has decided it and has thereby ensured the uniform application of the law. Therefore, in my opinion the second referred question is plainly inadmissible within the terms of Article 112(1)(b) EPC.

5.4 I would add that, while Boards of Appeal have on occasion sought by referrals to prompt the EBA to depart from a previous opinion⁴ and while the EBA has

⁴ For example, in T 1091/02 (OJ EPO 2005, 14) a Board of Appeal referred to the EBA the question whether opponent status could be freely transferred. Had the EBA agreed, that would have changed the position established in the earlier decision G 4/88 (OJ EPO 1989, 480). In the event, the EBA did not agree (G 2/04 OJ EPO 2005, 549).

on occasion done so⁵, that can make no difference to the admissibility of the Referral. Article 112(1)(b) EPC limits the power of the EPO President to refer a question to the EBA by the words “where two Boards of Appeal have given different decisions on that question”.

- 5.5 The Referral seeks to avoid inadmissibility by the inclusion of the first referred question which it claims to be admissible because, the Referral suggests, there are on that question different previous decisions. The Referral then proceeds to argue that, if the first question is admissible, the second question is also admissible because the two questions are directly related or, if the EBA does not accept that, because the EU Commission Notice and the earlier EBA decisions G 2/12 and G 2/13 should be viewed as analogous to different decisions.
- 5.6 I shall address the argument that there are conflicting decisions on the first question below. However, I can find no merit in the argument that, if the first question is admissible, the second question is also admissible because the two are directly related. Assuming, purely for the sake of considering the argument, that the EBA should find the first question admissible and proceed to examine it and even assuming, on the same basis, that it should agree with the Referral on that question, the clear and unambiguous words of Article 112(1)(b) EPC, which require “different decisions on that question”, would still make the second question inadmissible.
- 5.7 The analogy argument is in my opinion untenable. As the EU Commission Notice itself states, that Notice has no legal authority. If it had any legal standing, the Board which decided T 1063/18 would have given it appropriate consideration. Even if it had some legal authority, it would not be a decision of any court let alone a decision of a Board of Appeal of the EPO. Again, the words of Article 112(1)(b) EPC are quite clear and, on the canons of construction applied by the Boards of Appeal and the EBA⁶, not capable of extending to anything other than different decisions of the Boards of Appeal.

6. THE REFERRAL’S CASE FOR DIFFERENT DECISIONS

- 6.1 Paragraphs 4 to 18 of the Referral set out the EPO President’s case that there are different decisions of the Boards of Appeal on the first referred question. While for convenience I summarise that case in the next paragraphs, I draw attention to the full text of the Referral. The difference is said to be between decision T 1063/18 and earlier case law with regard to the way in which an EPC Rule which clarifies the meaning and scope of Article 53 EPC is assessed under Article 164(2) EPC.

⁵ For example, decision G 1/84 (OJ EPO 1985, 299), which in effect allowed a patent proprietor to oppose its own patent, was reversed in decision G 9/93 (OJ EPO 1994, 891).

⁶ For example, the Vienna Convention on the Law of Treaties.

- 6.2 In particular, paragraphs 4 to 8 of the Referral refer to the approach which, according to the Referral, was used in decision T 1063/18 and state that this approach differs from other decisions relating to the implementation of the Biotechnology Directive. T 1063/18 found that Rule 28(2) EPC is in conflict with the meaning of Article 53(b) EPC “*as interpreted by the Enlarged Board of Appeal*”, an approach it based on T 39/93. The Board assessed the conformity of Rule 28(2) EPC, which implements Article 53(b) EPC, in relation to an interpretation of that Article in an earlier EBA decision (G 2/12 and G 2/13). The Board thus equated law (“provisions of this Convention” within the meaning of Article 164(2) EPC) with case law (the interpretation of Article 53(b) EPC in the earlier EBA decision). On this approach “a clarification of the meaning and scope” of Article 53 EPC by means of an EPC Rule would not only be limited by Article 53 EPC itself but also by the interpretation of Article 53 EPC in an earlier decision of the EBA. In this context the Board considered it irrelevant that the earlier decision of the EBA did not and could not take into account the Administrative Council’s “implementation” of Article 53 EPC in an EPC Rule since the EBA’s interpretation would exclude any subsequent “clarification” by means of a Rule which would conflict with that interpretation.
- 6.3 Paragraphs 9 to 10, to which I shall return in more detail below, suggest that one decision which used a different approach was T 315/03. I set out the full text of those paragraphs below in paragraph 9.1 of this opinion.
- 6.4 Paragraphs 11 to 14 suggest that certain other decisions⁷ also used a different approach. Paragraph 15 then summarizes the suggested difference between T 1063/18 and the other decisions as follows:
- “15. In assessing the conformity of a Rule of the EPC the above-mentioned decisions took into account the available guidance from the Enlarged Board of Appeal and the Boards of Appeal on the interpretation of Article 53 EPC (A footnote reads “See, for example, T 315/03, OJ EPO 2006, 15, point 7.6 of the Reasons for the Decision”). The difference, though, is that unlike T 1063/18 none of these decisions considered an earlier interpretation of Article 53 EPC to impose an absolute bar on its implementation by a newly drafted EPC Rule subsequently adopted by the Administrative Council. In a nutshell, none of these decisions considered it decisive under Article 164(2) EPC whether a Rule was in conflict with an Article “as interpreted by the Enlarged Board of Appeal” in an earlier decision and thus whether the Rule was in conflict with case law.”*
- 6.5 The Referral’s reliance on T 315/03 to support the alleged difference between T 1063/18 and earlier case law is in my opinion incorrect⁸. It is significant that

⁷ T 272/95 (and T 666/05 and T 1213/05 which the Referral says reached the same conclusion) and G 2/07.

⁸ A view which was shared by the previous EPO President in his paper CA/PL 4/17 – see paragraph 46 which makes the exactly opposite case to that of the Referral, namely that Boards of Appeal can refuse to enforce and declare invalid an EPC Rule which conflicts with an EPC Article including an

the Referral makes little or no reference to the issues which fell to be decided in T 315/03 and only refers to isolated passages, and in two cases⁹, cites abridged passages of the decision. I consider it may be helpful to explain, by reference to the facts and history of the case, the relevant issues of T 315/03 and how they were decided and then to compare the actual decision with the use made of it in the Referral.

7. T 315/03 – THE ISSUES

- 7.1 T 315/03 was an appeal from the Opposition Division concerning a patent for the so-called “oncomouse” – a transgenic mouse whose germ cells and somatic cells contained an activated oncogene sequence introduced into it or an ancestor. The claims of the original patent application were directed to a “non-human eucaryotic animal” although the only animals exemplified were mice. In the course of the proceedings described below, the scope of the claims was reduced from animals to rodents and eventually to just mice. There were claims both to the method of producing transgenic animals and to the actual animals. The patent proprietor was Harvard University which had developed the oncomouse as a cancer research tool. Although the use of animals, and particularly mice, for medical research was long-established, the oncomouse case generated considerable comment and indeed controversy.
- 7.2 The patent application was refused by the Examining Division on the grounds of Article 53(b) EPC1973, which prevents patenting of animal varieties, and of Article 83 EPC, since it could not be assumed that the mice examples in the application could be extended to all other animals. The Examining Division also considered the application of Article 53(a) EPC1973, which excludes patents for inventions the publication or exploitation of which would be contrary to “ordre public” or morality, but concluded that patent law was not appropriate for resolving the potential problems which that provision raised.
- 7.3 Harvard appealed and in its decision of 3 October 1990 (T 19/90 OJ EPO 1990, 476), the Board of Appeal allowed the appeal. It held that Article 53(b) EPC applies to certain categories of animals but not to animals as such; and that, in the absence of serious doubts substantiated by verifiable facts, there was no reason to refuse the application under Article 83 EPC on the ground that it involved an extrapolation from mice in particular to animals in general. As regards Article 53(a) EPC1973, the Board expressed the view that, particularly in cases such as the present of genetic manipulation of animals by the insertion of an activated oncogene, there were compelling reasons to consider this Article. The Board remitted the case to the Examining Division which then granted a patent in May 1992 with claims limited to “a transgenic non-human mammalian animal”.

interpretation of that Article by a ruling of the EBA. Footnote 55 to paragraph 46 cites as authority for this both T 315/03 and T 39/93 which, in the Referral, are said to be differing decisions.

⁹ See paragraphs 9 and 13 below

- 7.4 Between 18 December 1992 and 13 February 1993, the patent was opposed, not by any commercial parties but by seventeen non-commercial parties including several animal rights pressure groups as well as political and church organisations. The many grounds of opposition raised included Articles 53(a) and 53(b) EPC1973 and these were the principal issues both in the opposition and the subsequent appeal. The opposition proceedings lasted, extraordinarily, nearly ten years including two oral proceedings. In its decision the Opposition Division rejected all the opponents' objections to the patent except those under Article 53(a) EPC1973. It found that the claims directed to non-human mammalian animals were not allowable under that Article and accordingly maintained the patent in an amended form with independent claims directed to rodents. It also decided that Rules 23b to 23e EPC1973 (later re-numbered Rules 26 to 29 EPC), which had been introduced during the proceedings, applied to the case and rejected arguments to the contrary based on the principle of legitimate expectations.
- 7.5 Six opponents filed appeals and the appeal proceedings were the subject of decision T 315/03. Most of the arguments centred on Article 53(a) EPC1973 – whether or not the patent was for an invention the publication or exploitation of which would be contrary to "ordre public" or morality – and, to a lesser extent, Article 53(b) EPC1973 – whether or not the oncomouse was an animal variety or was produced by an essentially biological process. However, the Board identified several of those arguments as irrelevant¹⁰, including the assertion of four appellants that, until the introduction of Rules 23b to 23e EPC1973, the patenting of animals was not possible – an assertion which the Board called "quite simply erroneous".
- 7.6 The first issue relating to Article 53 which the Board decided¹¹ was whether or not Rules 23b to 23e EPC applied to the case. The decision was that those Rules did apply to the case. The Board took the view that the "new" Rules prima facie applied to the case unless one of the arguments it heard to the contrary succeeded. Those arguments were on both sides of the dispute. Four of the appellants argued that the new Rules were a fundamental amendment to the EPC providing, with both retrospective and prospective effect, for the patenting of animals and that changes of such significance should be made in the EPC itself and not in the Implementing Regulations. I set out below the Board's finding on this argument in full¹² since, as I observe below¹³, the Referral quotes only an abridged version.

"As regards the argument of appellants 3 to 6 that changes of such significance as those made by the new Rules should be made in the EPC itself and not in the Implementing Regulations, the Board can see no legal basis for the proposition, nor did the appellants cite any principle or legal provision to support

¹⁰ See point 4 of the Reasons for the decision.

¹¹ See point 5 of the Reasons for the decision.

¹² Point 5.8 of the Reasons for the decision.

¹³ See paragraph 13.2. below.

it. Article 164(2) EPC provides that, in the case of conflict between the EPC and the Implementing Regulations, the EPC shall prevail. Thus, Article 164(2) EPC might, in the event of such a conflict, affect the application of the new Rules but it does not and cannot affect how changes in the law may be made, namely by amending Articles of the EPC and/or by amending the Implementing Regulations. Further, in the absence of any such provision, the Boards of Appeal have no power within their existing jurisdiction to pronounce upon such matters. The Boards do have jurisdiction inter alia to interpret the EPC - whether Articles enacted by the Contracting States in conference or Rules enacted by the Administrative Council - and must have jurisdiction to refuse enforcement of, and to declare invalid, legislation which has been defectively enacted (for example, if passed by an insufficient number of States or Administrative Council delegations), since otherwise parties could be prejudiced by "laws" which in fact do not exist. The Boards also have jurisdiction to give effect to Article 164(2) EPC – to refuse enforcement of a Rule of the Convention which conflicts with an Article. But none of these powers mean that the Boards have any power, express or necessarily implied, to prevent the operation of correctly enacted legislation and, as regards the passage of legislation, the choice between Articles and Implementing Regulations is one exclusively for the legislator.”

7.7 Additionally, both the same four appellants and the respondent made arguments based on the long delay in the opposition proceedings which meant that the new Rules, which had come into force during the proceedings, affected them unfairly. This was similar to the legitimate expectations argument rejected by the Opposition Division. The Board, while agreeing that there had been unacceptable delay, was not persuaded that this meant the new Rules should not apply - changes in legislation apply to pending cases unless there are provisions otherwise. The real cause for complaint was the delay itself.

7.8 Having decided that, the Board then considered¹⁴ the relationship of Rule 23d(d) EPC1973 (now Rule 28 EPC or, after the amendment at the centre of the Referral, Rule 28(1) EPC) to Article 53(a) EPC1973 and decided that it provided for the denial of patents to those biotechnological inventions which, in the language of the Rule,

“in particular, concern the following:...

(d) processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes”.

However, the Board made clear that this applied only to those biotechnological inventions which fall within the Rule and that other cases remain to be considered under Article 53(a) EPC1973. Thus, it could be necessary to consider cases of genetic manipulation of animals under Rule 23d(d) EPC1973

¹⁴ See point 6 of the Reasons for the decision.

and, if that Rule did not apply, to consider those cases further under Article 53(a) EPC1973. That is what the Board, at a later stage in the decision, did in respect of both the proprietor's main request (the claims to rodents substantially as upheld by the Opposition Division) and first auxiliary request (the claims limited to mice)¹⁵.

- 7.9 The Board considered¹⁶ the arguments of the respondent (the patent proprietor) on the alleged inconsistency of Rule 23d(d) with the earlier decision T 19/90 which, as mentioned above, concerned the same case at the examination stage of the patent application. Since this is the part of the decision to which reference is made in the Referral to support the case for different decisions, I shall describe it in some detail (though I urge reading of the entire decision). In decision T 19/90, it was said¹⁷:

"The decision as to whether or not Article 53(a) EPC is a bar to patenting the present invention would seem to depend mainly on a careful weighing up of the suffering of animals and possible risks to the environment on the one hand, and the invention's usefulness to mankind on the other."

Quite clearly that earlier statement suggested a similar "balancing test" to that in the later Rule 23d(d) EPC1973¹⁸. As the Board observed, there is little doubt that the T 19/90 test was adopted, although adapted, by those who framed the Rule 23d(d) test¹⁹. However, despite the similarity of the two tests, that in T 19/90 balances suffering of animals not against substantial medical benefit to man or animal, but against usefulness to mankind. "Usefulness to mankind" may embrace a wider range of benefits than the "substantial medical benefit" found in the Rule 23d(d) EPC1973 test and accordingly the T 19/90 test is broader; and it is also manifestly clear that the reverse is true, namely that if "substantial medical benefit" is established so as to satisfy Rule 23d(d) EPC1973, then "usefulness to mankind" is necessarily established.

- 7.10 The respondent saw this difference between the tests as so inconsistent that it considered the EBA should decide whether, in spite of this difference, the Rule could be considered as a bona fide interpretation of Article 53(a) EPC1973. In this regard the respondent presented three separate arguments. The first was that, unless the matter was clarified by the EBA, Rule 23d(d) EPC1973 might be ultra vires. On this argument, the Board held:

"As the Board observed during the oral proceedings, such use of the term ultra vires appears incorrect. An administrative action or rule of subsidiary legislation is ultra vires if it falls outside the scope of a law which precludes or limits the legal power of the person or body doing the act or making the rule which is

¹⁵ See points 12 et seq. of the Reasons for the decision.

¹⁶ See point 7 of the Reasons for the decision.

¹⁷ OJ EPO 1990, 476, Reasons, paragraph 5.

¹⁸ See the previous paragraph above.

¹⁹ Which had been taken from the Biotechnology Directive.

*consequently invalid – the term ultra vires denotes an "excès de pouvoir". That is quite clearly not the case here. The law in question, Article 53(a) EPC, contains nothing which precludes or limits its own subsequent interpretation whether by case-law (as in T 19/90) or by legislation (as in Rule 23d EPC). The respondent appears to have argued that the law in question is not simply Article 53(a) EPC but that Article as interpreted in T 19/90. Not only is this a legal impossibility – one cannot combine a legislative provision with case-law interpretation to construct an artificial vires by which to judge an action or rule as ultra vires – but even if possible it would make no difference since that notional "law" would still contain nothing to preclude or limit subsequent interpretation. Ultra vires requires an inconsistency but there is none - Article 53(a) EPC as previously interpreted by T 19/90 remains unaffected by Rule 23d(d) EPC save that, as already indicated (see paragraph 6.1 above), the Rule deems four limited categories of inventions to fall within Article 53(a) EPC. That has been achieved in a perfectly valid - i.e. intra vires - manner."*²⁰

7.11 The respondent's second argument²¹ was that Rule 23d(d) EPC broadened the exclusion in Article 53(a) EPC contrary to the principle of narrow construction of exclusions and thus inventions which might have satisfied the T 19/90 test might now fail the Rule 23d(d) test. However, the Board considered that the Rule only broadened the Article 53(a) EPC exclusion in as much as the Rule now specified four limited categories of inventions which were deemed to fall within that Article. However, since it was unimaginable that cases within those four categories would not always have been considered under Article 53(a) EPC, it would be incorrect to say that the new Rule broadened the law as regards the exclusion of such cases.

7.12 The respondent's third argument contained four steps and I set out the Board's summary of these and its findings²² below:

"7.5 Third, and last, the respondent presented a four step argument which can be summarised as follows. First, T 19/90 was the only authoritative pronouncement on Article 53(a) EPC prior to the introduction of Rule 23d(d) EPC - which, if meaning T 19/90 provided the only test or manner of assessment for an Article 53(a) EPC objection, is correct. Second, in G 1/98 (OJ EPO 2000, 111) the new Rules were considered, as regards Article 53(b) EPC, only to offer interpretation - which is also correct. Third, in T 272/95 of 23 October 2002 Board 3.3.4 followed G 1/98 in applying the new Rules to Article 53(a) EPC but in doing so quite simply followed the Enlarged Board decision and, it is at least inferred, made no independent assessment for itself. Fourth, the argument thus concluded, there was no authoritative statement that Rule 23d(d) EPC was consistent with Article 53(a) EPC.

²⁰ See point 7.3 of the Reasons. This is the complete text of the passage quoted in edited form in paragraph 10 of the Referral.

²¹ See point 7.4 of the Reasons.

²² See points 7.5 and 7.6.

7.6 *The Board disagrees both with the argument and the conclusion. While the respondent's first and second submissions are, as indicated above, correct, the third is not. While it is correct that T 272/95 followed G 1/98 in finding that the new Rules only interpret Article 53 EPC, it is only to be expected that Board 3.3.4 should have followed the approach of the Enlarged Board of Appeal - the function and purpose of Enlarged Board decisions is to give guidance to the Boards and others in matters of law ("to ensure uniform application of the law" – see Article 112(1) EPC). Further, the inference that Board 3.3.4 made no independent assessment is incorrect - paragraph 5 of the Reasons in T 272/95 begins:*

"Having regard to Article 164(2) EPC, the Board has to examine whether or not the new rules insofar as they relate to Article 53(a) EPC are in conformity with this article."

As mentioned above (see paragraph 5.8), Article 164(2) EPC provides that, in the case of conflict between the EPC and the Implementing Regulations, the EPC shall prevail. Thus it is clear that, in T 272/95, Board 3.3.4 posed the question whether the new Rules were consistent with Article 53(a) EPC and, relying as one would only expect on available guidance from the Enlarged Board, found that the new Rules were so consistent. The respondent was therefore quite simply wrong to conclude that there is no authoritative statement in that respect."

7.13 The decision T 315/03 then considered²³ in turn the following issues – the point in time to apply the Rule 23d(d) test, Rule 23d(d) and matters of evidence, the meaning of morality and “ordre public” in Article 53(a) EPC1973, and the application of Article 53(b) EPC1973 to animal varieties (as to which the Board proposed to follow the EBA decision G 1/98 relating to plant varieties although, as regards animals, the differences of wording between the different language texts of the EPC added a complication). Only then, after considering all the issues already mentioned, did the Board assess patentability. As is well-known, it concluded²⁴ that claims to rodents did not satisfy the Rule 23d(d) EPC1973 test, but that claims to mice satisfied both that test and the earlier T 19/90 test, that the oncomouse was not an animal species (the broadest of the terms used in any of the three language versions of Article 53(b)), and that the method of its production was not an essentially biological process. None of the other grounds of opposition were upheld in respect of the mice claims.

8. T 315/03 AND THE REFERRAL

8.1 As will be apparent from the previous section of this opinion, there were several issues in T 315/03 which required careful analysis by the Board in the light of the parties’ arguments. Rules 23b to 23e EPC 1973 had at the time been relatively recently introduced and the Board was required to consider and

²³ See points 8 to 11.

²⁴ See points 12 and 13.

decide the application of some of these Rules to Article 53 EPC1973. The Referral compares T 315/03 and T 1063/18 and attempts to establish a difference in the way new Rules were dealt with. However, there are three major differences between T 315/03 and T 1063/18 which do not allow them to be compared or contrasted in the way the Referral has done.

- 8.2 First, in T 315/03 the Board was not faced with considering new Rules in relation to previous decisions of the EBA. In fact, it was not even faced with considering new Rules in relation to earlier case law of the Boards of Appeal. Rather, in T 315/03 the Board was faced with considering new Rules in relation to one single statement in one earlier decision on the same patent made to give guidance to the Examining Division to which that decision remitted the case. The Board's short statement in T19/90 was as follows:

“The decision as to whether or not Article 53(a) EPC is a bar to patenting the present invention would seem to depend mainly on a careful weighing up of the suffering of animals and possible risks to the environment on the one hand, and the invention's usefulness to mankind on the other. It is the task of the department of first instance to consider these matters in the context of its resumed examination of the case.”²⁵

This was beyond doubt a statement of value as a means of assessing Article 53(a) EPC1973 issues of morality and “ordre public” but it was none the less of a completely different nature and effect to an EBA decision. In any event, that earlier decision could only be binding on the Examining Division for its consideration of the remitted case²⁶.

- 8.3 Second, as is clear from the decision in T 315/03, the Board was not faced with deciding whether or not the new Rules were valid. The respondent did argue that the Rules might be invalid (or, as it was incorrectly argued, ultra vires) but that argument was not upheld (and even not entirely maintained by the respondent²⁷). Again as the decision itself shows, the Rules, or at least Rule 23d(d), was held to have made only a limited addition to the existing law²⁸.
- 8.4 Third, in T 315/03 the Board was not making any assessment under Article 164(2) EPC. To the very best of my recollection that Article was never mentioned by any party. The Board only mentions it in point 5.8 of its decision – and by reference to this point in point 7.6 - as part of the Board's explanation why the argument that the subject-matter of the new Rules should have been enacted in the EPC and not in the Implementing Regulations failed. Article 164(2) EPC is only mentioned there as a power the Board would have to consider legislation invalid if such a situation should arise. However, the

²⁵ See point 5 of the Reasons of T 19/90.

²⁶ Article 111(2) EPC.

²⁷ See T 315/03, Summary of Facts and Submissions, XXXI.(6).

²⁸ Whereas Rule 28(d) (and the Referral) seek to overturn completely the previous firmly-established interpretation of an Article by the EBA.

decision is clear that the question of whether Articles or Rules should be used for amending legislation was not an issue for the Board. The reference to Article 164(2) EPC is thus obiter dicta.

8.5 I shall now consider the references to the decision T 315/03 in the Referral in the light of my detailed explanation of that case. I have identified seven such references each of which I shall address below.

9. (1) THE REFERRAL PARAGRAPHS 9-10

9.1 These paragraphs read as follows:

“9. In decision T 315/03 (relating to what has become Rule 28(1)(d) EPC) the Board fully acknowledged the Administrative Council’s competence to interpret Article 53(a) EPC by amendment to the Implementing Regulations based on Article 33(1)(c) EPC without being limited in this regard by an interpretation of the Article set forth in earlier case law.

10. In particular, the Board found in point 7.3 of the Reasons for the Decision:

“An administrative action or rule of subsidiary legislation is ultra vires if it falls outside the scope of a law which precludes or limits the legal power of the person or body doing the act or making the rule which is consequently invalid - the term ultra vires denotes an "excès de pouvoir". That is quite clearly not the case here. The law in question, Article 53(a) EPC, contains nothing which precludes or limits its own subsequent interpretation whether by case-law [...] or by legislation [...]. The respondent appears to have argued that the law in question is not simply Article 53(a) EPC but that Article as interpreted in T 19/90. Not only is this a legal impossibility - one cannot combine a legislative provision with case-law interpretation to construct an artificial vires by which to judge an action or rule as ultra vires [...]” (emphasis added).”

9.2 Both the statement in paragraph 9 in the Referral and the abridged version of point 7.3 of T 315/03 are misleading. As mentioned above²⁹, in point 7 of T 315/03 the Board was considering the respondent’s arguments that Rule 23d(d) was inconsistent with T 19/90, even arguing (incorrectly, as the Board thought and as the respondent conceded³⁰) that the Rule might be ultra vires. Since T 19/90 offered a broader version of the “balancing test” than that in Rule 23d(d), the respondent’s argument was quite understandable. But, as I have explained above, the Board did not accept it, because Rule 23d(d) was held to have made only a limited addition to the existing law.

9.3 It is in my opinion unjustified to state, as paragraph 9 of the Referral does, that the Board in T 315/03

²⁹ See paragraphs 6.10 to 6.12

³⁰ See footnote 27 above.

“...fully acknowledged the Administrative Council’s competence to interpret Article 53(a) EPC by amendment to the Implementing Regulations based on Article 33(1)(c) EPC without being limited in this regard by an interpretation of the Article set forth in earlier case law”.[Emphasis added]

While the words I have emphasised might suggest that the Board was considering and decided upon an interpretation of Article 53(a) EPC1973 in the light of Rule 23d(d) which might have been different if earlier case law had been taken into account, that was not the case. Instead, the Board was considering an argument of inconsistency between a new provision and an earlier decision and decided there was no inconsistency. The new provision was an addition to the previous law and the earlier decision was an interpretation of the previous law.

- 9.4 The abridged version of point 7.3 of T 315/03 should be compared with the entire point 7.3 which I set out in paragraph 7.10 above. That comparison shows that the complete text explains why the respondent was using the concept of ultra vires incorrectly. The sentence which the Referral emphasises, for reasons one can understand, namely

“one cannot combine a legislative provision with case-law interpretation to construct an artificial vires by which to judge an action or rule as ultra vires”

referred to the proprietor’s suggestion that T 19/90 was a measure which could be used to judge the new legislative provision, i.e. the new Rule. That was refuted in the final sentence of point 7.3 which has been omitted in the abridged version in the Referral:

“Ultra vires requires an inconsistency but there is none - Article 53(a) EPC as previously interpreted by T 19/90 remains unaffected by Rule 23d(d) EPC save that, as already indicated (see paragraph 6.1 above), the Rule deems four limited categories of inventions to fall within Article 53(a) EPC. That has been achieved in a perfectly valid - i.e. intra vires - manner.”

The outcome might have been different, had there been an inconsistency between the case-law interpretation of Article 53(a) EPC by T 19/90 and the new Rule; and would certainly have been different had there been³¹ an inconsistency between the case-law interpretation of Article 53(a) EPC by an earlier EBA decision and the new Rule. Since this was not the case, the respondent’s alleged vires was “artificial”.

10. (2) THE REFERRAL PARAGRAPH 15

- 10.1 This is the paragraph of the Referral which appears to draw a conclusion on the suggested difference between T 1063/18 and earlier decisions including T

³¹ As in T 1063/18.

315/03. Although I set it out in paragraph 6.4 above, I now do so again with each of the three passages I then comment on underlined.

“15. In assessing the conformity of a Rule of the EPC the above-mentioned decisions took into account the available guidance from the Enlarged Board of Appeal and the Boards of Appeal on the interpretation of Article 53 EPC (A footnote reads “See, for example, T 315/03, OJ EPO 2006, 15, point 7.6 of the Reasons for the Decision”). The difference, though, is that unlike T 1063/18 none of these decisions considered an earlier interpretation of Article 53 EPC to impose an absolute bar on its implementation by a newly drafted EPC Rule subsequently adopted by the Administrative Council. In a nutshell, none of these decisions considered it decisive under Article 164(2) EPC whether a Rule was in conflict with an Article “as interpreted by the Enlarged Board of Appeal” in an earlier decision and thus whether the Rule was in conflict with case law.”

- 10.2 In T 315/03 the Board with one exception could not take account of any guidance from the EBA because, on the issues which fell to be decided, there was no such guidance. There was certainly no guidance from the EBA as to how to interpret new Rules which affect Article 53 EPC. Point 7.6 of T 315/03 referred to in the Referral (and which is set out in full at 7.11 above) merely explained why, again, an argument of the proprietor was incorrect. The proprietor had argued that, in the earlier case T 272/95, the Board had followed the EBA decision G 1/98 without making an independent assessment. In T 315/03, the Board found that this assertion was incorrect but that it was only to be expected that a Board of Appeal should follow an EBA decision.
- 10.3 The exception I mentioned above was that, in point 11 of T 315/03 relating to the application of Article 53(b) EPC1973 to animal varieties, the Board proposed to follow the EBA decision G 1/98 relating to plant varieties although, as regards animals, the differences of wording between the different language texts of the EPC added a complication.
- 10.4 It is true that in T 315/03 the Board did not consider that any earlier interpretation of Article 53 EPC1973 imposed “an absolute bar on its implementation by a newly drafted EPC Rule subsequently adopted by the Administrative Council”. No such bar was suggested or considered because – as I have explained – the then “newly drafted EPC Rule under consideration” was held by the Board in T 315/03 to have added to the law and not to be inconsistent with it.
- 10.5 Similarly, T 315/03 did not consider “it decisive under Article 164(2) EPC whether a Rule was in conflict with an Article “as interpreted by the Enlarged Board of Appeal” in an earlier decision and thus whether the Rule was in conflict with case law”. This is because there was no need to consider any such conflict in T 315/03. As already mentioned, an interpretation of the EBA on a quite separate point was taken into account and indeed followed. Nothing was decided under Article 164(2) EPC in T 315/03.

10.6 In short, while T 315/03 did take into account the guidance of an earlier EBA decision on a completely separate issue (animal varieties), none of the things that paragraph 15 of the Referral suggests were considered or not considered to be decisive were in fact considered at all. As regards the earlier EBA decision taken into account, this was followed – as happened in T 315/03, in T 272/95 and T 1063/18 and many other cases.

10.7 It follows from my comments above that I cannot see how an argument that T 1063/18 takes a different approach to T 315/03 can be sustained.

11. **(3) THE REFERRAL PARAGRAPH 45**

11.1 This and the remaining references in the referral to T 315/03 all occur in part B “Substantive considerations”. Paragraph 45 reads:

“The correct approach to follow under Article 164(2) EPC when examining the conformity of a Rule which implements Article 53 EPC should be the one underlying decisions T 315/03 and T 272/95 (together with decisions T 666/05 and T 1213/05) of the Boards of Appeal as well as decisions G 2/06 and G 2/07 of the Enlarged Board of Appeal, i.e. a Rule clarifying the meaning and scope of Article 53 EPC is not a priori limited by earlier case law from the Boards of Appeal or the Enlarged Board of Appeal.”

This is incorrect. In T 315/03 there was no approach followed under Article 164(2) EPC. The question was not one of “conformity” – by which I assume the Referral means validity under Article 164(2) EPC – but of alleged inconsistency with the previous law³².

12. **(4) THE REFERRAL PARAGRAPH 50**

12.1 Paragraph 50 of the Referral reads:

“In decision T 315/03 the Board of Appeal acknowledged the Administrative Council’s power to establish Rules in the Implementing Regulations to the EPC in order to “supply provisions for the application and interpretation of pre-existing provisions of the EPC”.

Footnote 49 then refers to points 5.1 and 7.7 of T 315/03.

While I would certainly not dispute that the Administrative Council can make such Rules, point 5.1 of T 315/03 did not contain the suggested acknowledgment. After quoting Rule 23b(1), the following sentence appears in point 5.1 of T 315/03:

“The Board notes that it is clear from that sentence that the only function of the new Rules is to supply provisions for the application and interpretation of pre-existing provisions of the EPC.”

³² See T 315/03, headnote 3 and point 7 of the Reasons (explained in paragraphs 7.6 to 7.12 above).

Thus, in T 315/03 the words “supply provisions for the application and interpretation of pre-existing provisions of the EPC” were used in relation to the stated function of a Rule and not by way of any acknowledgment as suggested.

- 12.2 Point 7.7 of T 315/03 summarises the Board’s treatment of the arguments of the respondent on the alleged inconsistency between Rule 23d(d) and T 19/90. Again, there is no such acknowledgement. Point 7.7 reads as follows:

“The relationship between Rule 23d(d) EPC and the earlier case law can be summarised as follows. The introductory provision of the new Rules - Rule 23b(1) EPC - states those Rules are interpretative (see paragraph 5.1 above). The established and authoritative statement of the case law is to the same effect (see the previous paragraph). None of the arguments presented to the contrary are accepted by the Board for the reasons in this section. As regards cases such as the present which fall within Rule 23d(d) EPC, the effect of this interpretation is to insert a test which, depending on the facts and thus on the outcome of the test, may be either additional or alternative to that previously established by the case law.”

- 12.3 In short, while I do not disagree with the substance of paragraph 50, it is plainly inaccurate as regards the cited passages of decision T 315/03.

13. **(5) THE REFERRAL PARAGRAPHS 58, 60, 61**

- 13.1 Paragraph 58 of the Referral states:

“As regards the Boards of Appeal, they have interpretative supremacy with regard to the EPC; it derives from Articles 21 to 23 EPC and is beyond any doubt. But neither these provisions nor Article 164(2) EPC provide the basis for disregarding a Rule correctly enacted by the Administrative Council on the sole basis that it deviates from an earlier interpretation in case law. This has been confirmed, in particular, in decisions T 315/03 and T 991/04.”

- 13.2 After paragraph 59 which deals with T 991/04, paragraph 60 says of T 315/03:

“In decision T 315/03 the Board clarified: “Article 164(2) EPC provides that, in the case of conflict between the EPC and the Implementing Regulations, the EPC shall prevail. Thus, Article 164(2) EPC might, in the event of such a conflict, affect the application of the new Rules but it does not and cannot affect how changes in the law may be made, namely by amending Articles of the EPC and/or by amending the Implementing Regulations. Further, in the absence of any such provision, the Boards of Appeal have no power within their existing jurisdiction to pronounce upon such matters. The Boards do have jurisdiction inter alia to interpret the EPC - whether Articles enacted by the Contracting States in conference or Rules enacted by the Administrative Council [...]The Boards also have jurisdiction to give effect to Article 164(2) EPC - to refuse enforcement of a Rule of the Convention which conflicts with an Article. But none of these powers mean that the Boards have any power, express or

necessarily implied, to prevent the operation of correctly enacted legislation and, as regards the passage of legislation, the choice between Articles and Implementing Regulations is one exclusively for the legislator.”

The quoted passage is an abridged version, in two respects, of point 5.8 of the Reasons for the decision³³. First, the passage is preceded by this introductory sentence which explains the context:

“As regards the argument of appellants 3 to 6 that changes of such significance as those made by the new Rules should be made in the EPC itself and not in the Implementing Regulations, the Board can see no legal basis for the proposition, nor did the appellants cite any principle or legal provision to support it.”

Second, the Referral omits , as indicated by square brackets, a part of paragraph 60 of T 315/03. The omitted part reads:

“...and must have jurisdiction to refuse enforcement of, and to declare invalid, legislation which has been defectively enacted (for example, if passed by an insufficient number of States or Administrative Council delegations), since otherwise parties could be prejudiced by "laws" which in fact do not exist.”

In my opinion that omission is significant. “Defectively enacted” embraces the issue which arose, for the first time that I am aware, in T 1063/18.

- 13.3 Paragraph 61 of the Referral then draws a conclusion from the previous paragraphs in these words:

“Thus, it is in line not only with Article 164(2) EPC but also with the interpretative supremacy of the Boards of Appeal that a Rule implementing Article 53 EPC must be taken into account and cannot be a priori disregarded on the grounds that it deviates from an earlier interpretation in case law. Exceptions are only conceivable in extreme and obvious cases of conflict, i.e. if the Rule and Article 53 EPC would have mutually exclusive legal consequences.”

- 13.4 In my opinion, paragraph 61 of the Referral contains a statement which simply cannot be found in point 5.8 of T 315/03. In its full text, point 5.8 is clearly concerned with, and dismisses, an argument that certain amendments to the EPC should be in Articles rather than Rules. The full text also makes clear the view of the Board that, in certain circumstances, a Board of Appeal can refuse to enforce, and declare invalid, defective legislation including legislation that is in conflict with an Article of the EPC. This is what actually happened in T 1063/18.

³³ I set out the entire text of point 5.8 at paragraph 7.6 above.

14. **(6) THE REFERRAL PARAGRAPH 63**

14.1 Under the sub-heading

“c) Correct approach under Article 164(2) EPC confirmed by predominant case law”

paragraph 63 of the Referral says:

“The approach under Article 164(2) EPC set out above finds confirmation not only in decisions T 315/03 and T 272/95 (as well as T 666/05 and T 1213/05) but also in case law not specifically related to Article 53 EPC and above all in decisions from the Enlarged Board of Appeal.”

The “approach under Article 164(2) EPC set out above” is of course that advanced by the Referral. In my opinion it is not confirmed by T 315/03, which did not have an approach under Article 164(2) EPC. As already mentioned, the only reference in T 315/03 to that Article is obiter.

15. **(7) THE REFERRAL PARAGRAPH 67**

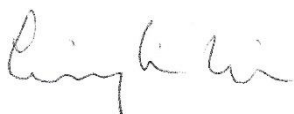
15.1 The final reference in the Referral to T 315/03 is in paragraph 67 which reads:

“In decisions G 2/06, G 2/12 – G 2/13 as well as T 315/03 the Enlarged Board of Appeal and the Board of Appeal respectively took into account the Rules enacted by the Administrative Council when interpreting Article 53 EPC.”

As regards T 315/03, that is no more than a statement of fact. The Board had to consider, for the first time, new Rules which of course had to be taken into account. But the Board did not interpret Article 53(a) EPC1973 using the Rules, rather it interpreted the new Rules and decided how they affected the law. The Board did suggest an interpretation of Article 53(b) EPC1973 by reference to and following an earlier EBA decision.

16. **CONCLUSION**

The conclusion of my opinion is as set out in the summary on the first page.



Christopher Rennie-Smith

Date: 20 September 2019