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May 24, 2019

Your reference: G 3/19
Our reference: 53 628 K
Re.: Referral of the President of the EPO to the Enlarged Board of Appeal
related to patentability of plants/Art. 53b) EPC

Ladies and Gentlemen,

We file the attached *amicus curiae* brief re case no.: G 3/19.

This *amicus curiae* brief is submitted pursuant to Art. 10(1) of the Rules of Procedure of the Enlarged Board of Appeal following the announcement of the referral under Art. 112(1)b) EPC¹ and the publication of the referred questions and the respective reasoning dated April 4, 2019².

Yours sincerely



Gregor König

¹ <https://www.epo.org/news-issues/news/2019/20190405.html>.

² <https://www.epo.org/law-practice/case-law-appeals/eba/pending.html>.

Amicus curiae re G 3/19

The referral under Art. 112(1)b) EPC submitted by the President of the European Patent Office to the Enlarged Board of Appeal (hereinafter the “Referral”) seeks to exclude patentability of plants exclusively obtained by means of an essentially biological process as already decided in the EBA decisions G 2/12 and G 2/13 of March 25, 2015 and deals with the Board of Appeal decision T 1063/18 of December 5, 2018. Attempting admissibility under Article 112(1)b) EPC, in lack of the required different decisions on the referred question, the Referral raises questions as to the distribution of powers between the Administrative Council and the Boards of Appeal and ultimately the Enlarged Board of Appeal.

Below we show why the Referral (cf. sect. B further below) is not admissible. We submit that

- (i) the questions proposed do not refer to specific points of law as required by Art. 112 EPC, and that
- (ii) the Boards of Appeal have not issued “*different*” decisions on the points of law referred to the EBA by the President as required by Art. 112(1)b) EPC.

Precautionarily, we also deal with the substantive considerations brought forward in the Referral. We show that T 1063/18 has correctly applied the principles of the EPC while the approach suggested in the Referral contradicts the EPC and it contradicts fundamental principles of the rule of law (cf. sect. C further below).

Summary

Question 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?”

The Referral, in order to refer the question on plant patenting as decided in G 2/12 and G 2/13 to the Enlarged Board of Appeal for a second time, raises legal questions that are inadmissible under Article 112(1)b) EPC. Question 1 does not result from case law that would contradict T 1063/18. It is the result of a methodically different understanding of the relationship between the judicative and the limitations of Article 164(2) EPC on the competence of the Administrative Council by the Referral, albeit, not supported by any of the cited case law. Question 1 further does not adequately reflect the reasoning of T 1063/18. This becomes clear upon analysis of the decisions cited by the Referral in comparison with T1063/18. The answer to the Referral’s question raised on the distribution of powers, i.e. whether a new Rule is *a priori* limited by a prior decision of the EBA, is already exhaustively answered in well-established case law on the basis of Article 164(2) EPC.

The approach of the Referral is in contradiction with Article 164(2) EPC. In fact, it is in contradiction with the established principles of the EPC legal system regarding the function, and legislative competence of the Administrative Council in relation to the judicative, and especially in relation to the Enlarged Board of Appeal.

There is no basis for admissibility of this political initiative on the basis of the EPC referral provisions, specifically in view of the limitation to the legislative power of the Administrative Council as foreseen in Article 33 and Article 164(2) EPC.

A positive answer to referred Question 1 would clearly contradict the limitation of legal power of the Administrative Council under Article 33c) EPC to interpret the Articles only within the boundaries of Article 164(2) EPC.

The referred Question 1 relates to an abstract point of law and is inadmissible alone for this reason. It is not related to what has been decided in T 1063/18, i.e. the specific legal points underlying this Board of Appeal decision. If redrafted to reflect a specific point of law decided in T 1063/18, it would need to ask: Is Rule 28(2) of the Implementing Regulations in compliance with Article 164(2) EPC? However, there are no Board of Appeal decisions deviating in this point as required by Article 112(1)b) EPC and the Referral remains inadmissible.

The Referral is not substantiated either. In contradiction with the competence-limiting function of Article 164(2) EPC the referred Question 1 constructs an artificial distinction between “*meaning and scope of an Article*” on the one hand and “*its interpretation*” on the other hand. Such distinction is not consistent with the EPC, the Vienna Convention on the Law of Treaties (hereinafter the “Vienna Convention”) or the legal principles of the member states. Such distinction is certainly not expressed in the case law cited by the Referral in support of this theory (G 9/93, reasons 6, or G 2/08, reasons 7.1.4.). The case law cited in the Referral does not concern any cases as the present one, i.e. a Rule reversing the previous interpretation provided by the EBA under the principles of the Vienna Convention.

Generally, and within the EPC the meaning and scope of an Article can be identified by interpretation provided by the case law and by the legislator on different hierarchy levels. However, in Article 33 EPC the legislator has excluded the Administrative Council from the full legislative power to amend the Articles of the EPC. Article 164(2) EPC safeguards the Articles from any overriding effect of the Implementing Regulations and leaves it to the judicative to decide whether a Rule is in contradiction with an Article.

The Referral in seeking to override the correctly developed interpretation provided by the judicative, attempts to provide the Administrative Council with powers reserved to the Diplomatic Conference (cf. sect. C further below). In answering Question 1 in the positive, the judicative would be left aside in order to overcome the limitations of Article 33 EPC and Article 164(2) EPC.

The alleged legislative intent and the developments in the EU and the contracting states do not meet the principles of Article 33 EPC, especially in view of Article 33(5) EPC. The Referral only relies on a preliminary and non-binding Commission Notice and position papers of the EU Parliament and a Council conclusion as well as the situation in some EPC Contracting States.

Moreover, the Referral simply sweeps aside that G 2/12 and G 2/13 have already considered the initial Parliament's position paper of 2012 and likewise the national situation in the EPC Contracting States. The Referral further tries to hide that a national consensus has precisely not been obtained reflected by the legal inconsistencies as regards the patentability of plants in the national law of the EPC Contracting States. There are simply no "*legal developments*" that would justify a reconsideration – which has been assessed and correctly recognized by the Board in T 1063/18.

What is more, in view of Article 33 (5) EPC none of the raised "*further legal developments*", justify reconsideration, as Article 33(5) indicates that the measure for a change of an Article by the Administrative Council is set very high and requires very special circumstances, including entry into force of the relevant international or EU provisions.

Further the Commission Notice and the position papers of EU Parliament and Council rely on a wrong factual basis when citing the Rothley Report from 1997, which considers patents on plants resulting from essentially biological processes neither reproducible nor inventive. As will be shown in sect. B.II and C further below lack of reproducibility or lack of inventiveness is nothing that could be reasonably maintained for the referred cases in G2/12 and G2/13.

It must be reserved for the EPC legislator to extend the exclusion of Article 53b) EPC in case the political framework will allow for achieving the respective majority in a Diplomatic Conference or a change in the EU legislation should open an alternative implementation via Article 33 EPC. The Implementing Regulations, as a consequence of Article 164(2) EPC, cannot be used to reverse the meaning of the EPC correctly interpreted according to Articles 31 and 32 of the Vienna Convention.

Question 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?

The Referral here attempts to justify the admissibility of Question 2 with the alleged admissibility of Question 1, and alternatively that it is based on an application of Article 112(1)b) EPC by analogy. As will be shown in sect. B further below, we submit there are no lacunae in the law that would allow an application of Article 112(1)b) EPC by analogy and that there are no comparable interests, either.

Irrespective of this, Question 2 has already been exhaustively answered in the EBA decisions G 2/12 and G 2/13. It is further noted that the wording of Question 2 assumes that Article 53b) EPC does not explicitly exclude nor explicitly allow the patentability of the subject-matter referred to in Rule 28(2) of the Implementing Regulations. While the Referral does not provide any arguments counter to G 2/12 and G 2/13 for justifying this assumption, we submit that it is Article 52(1) EPC that allows patentability of the subject-matter referred to in Rule 28(2) of the Implementing Regulations. We further submit that the EBA in G 2/12 and G 2/13, applying the interpretive means pursuant to the Vienna Convention, has precisely concluded that under Article 52 EPC, Article 53b) EPC does not exclude said subject matter from patentability (cf. sect. C further below).

A. BACKGROUND

- [1] The Referral seeks to exclude patentability of *plants exclusively obtained by means of an essentially biological process*. It attempts admissibility under Article 112(1)b EPC by raising questions as to the distribution of powers between the Administrative Council and the Boards of Appeal and ultimately the Enlarged Board of Appeal. To shed light on the background of the Referral, the chain of events leading to the Referral is outlined below.
- [2] In the EPC, the patentability of inventions is governed by Articles 52 *et seq.* with Article 52 EPC stating that “*European patents shall be granted for any inventions, in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial application.*” Article 53 EPC defines the subject-matter and inventions which are excluded from patentability which Article 53b) EPC reads as follows (emphasis added)

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;

- [3] While EBA decisions G 2/07 and G 1/08 of December 9, 2010 dealt with the term “*essentially biological*”, the question as to whether products such as plants resulting from essentially biological processes are patentable has been addressed by the EBA in G 2/12 and G 2/13 of March 25, 2015. The EBA applying the rules of interpretation pursuant to Articles 31 and 32 of the Vienna Convention taking into account a possible dynamic interpretation, came to the conclusion that the exclusion from patentability in Article 53b) EPC does not extend to plants which are produced by or obtainable through essentially biological processes – as long as these inventions are not directed to specific plant varieties or breeds.
- [4] Triggered by EBA decisions G 2/07 and G 1/08, the European Parliament issued a respective position paper on May 10, 2012 emphasizing that it³ (emphasis added)

Calls on the EPO also to exclude from patenting products derived from conventional breeding and all conventional breeding methods, including SMART breeding (precision breeding) and breeding material used for conventional breeding; [...]

³ Patenting of essential biological processes P7_TA(2012)0202, European Parliament resolution of 10 May 2012 on the patenting of essential biological processes (2012/2623(RSP)), 2013/C 261 E/05, marginal no. 4.

- [5] Following EBA decisions G 2/12 and G 2/13, the European Parliament likewise responded with a respective resolution of December 17, 2015⁴ which relies on the above-mentioned position paper of May 10, 2012 and the Biotechnology Directive 98/44/EC, in particular on Article 4. This resolution starts with the false statement that⁵ (emphasis added)

[...] Article 4 [...] states that products obtained from essentially biological processes shall not be patentable, [...]

It finally calls the European Commission⁶ (emphasis added)

[...] as a matter of urgency, to clarify the scope and interpretation of Directive 98/44/EC, and in particular Articles 4, 12(3)(b) and 13(3)(b) thereof, in order to ensure legal clarity regarding the prohibition of the patentability of products obtained from essentially biological processes, and to clarify that breeding with biological material falling under the scope of a patent is permitted; [...]

- [6] The European Commission published a respective document on November 3, 2016⁷. The latter heavily relies on a part of the preparatory work of the Biotechnology Directive, more specifically on an explanatory statement on patentability of plants of the Rapporteur Mr. Rothley in the report of June 25, 1997⁸ which considers such plants not reproducible and not inventive. This Commission Notice also mentions in its introductory statement the final report of May 17, 2016 of the expert group on the development and implications of patent law in the field of biotechnology and genetic engineering⁹, which expert group did, however, not see a need for a clarifying opinion or for possible legislative changes at the European level¹⁰.

The Commission initially points to the nonbinding effect of the notice¹¹

The Notice is intended to assist in the application of the Directive, and does not prejudice any future position of the Commission on the matter. Only the Court of Justice of the European Union is competent to interpret Union law.

⁴ P8_TA(2015)0473, Patents and plant breeders' rights, European Parliament resolution of 17 December 2015 on patents and plant breeders' rights (2015/2981(RSP)).

⁵ Cf. p. 1, second bullet point.

⁶ Cf. p. 3, marginal no. 2.

⁷ Commission Notice on certain articles of Directive 98/44/EC of the European Parliament and of the Council on the legal protection of biotechnological inventions (2016/C 411/03).

⁸ Report on the proposal for a European Parliament and Council Directive on the legal protection of biotechnological inventions (COM(95)0661 - C4-0063/96 - 95/0350(COD)), Committee on Legal Affairs and Citizens' Rights, Rapporteur: Mr. Willi Rothley, DOC_EN\RR\330\330382.

⁹ Commission Notice on certain articles of Directive 98/44/EC of the European Parliament and of the Council on the legal protection of biotechnological inventions (2016/C 411/03), C 411/4, first para.

¹⁰ Final Report of the Expert Group on the development and implications of patent law in the field of biotechnology and genetic engineering (E02973) 17 May 2016, Chapter 3, sect. 3.5, p. 38 to 40.

¹¹ Commission Notice on certain articles of Directive 98/44/EC of the European Parliament and of the Council on the legal protection of biotechnological inventions (2016/C 411/03), C 411/3, last para.

and states that¹²

While these decisions of March 2015 [G 2/12 and G 2/13] are in line with the intentions of the drafters of the EPC, it is questionable whether the same result would have been reached in the EU context.

The Commission Notice finally concludes that¹³

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.

- [7] The former President of the European Patent Office decided with notice dated November 24, 2016 that all pending examination and opposition proceedings before the EPO are automatically suspended as a result of the above-mentioned Commission Notice¹⁴ – a legal basis for such stay was not indicated. The former President further submitted proposals to the Committee on Patent Law for submission to the Administrative Council for an amendment of the Implementing Regulations in which it is acknowledged that¹⁵

An amendment of the EPC Implementing Regulations would only be effective if it was not in conflict with the EPC, in particular Article 53(b) EPC. According to Article 164(2) EPC, in the case of conflict between the provisions of the EPC (the EPC articles) and those of the Implementing Regulations (the EPC rules), the provisions of the EPC will prevail. The boards of appeal are not bound by an amendment of the EPC Implementing Regulations clarifying the scope of an EPC article if they perceive the rule to be in conflict with an article, and can declare the rule invalid and non-enforceable under Article 164(2) EPC. This also applies in case of conflict of an EPC rule with the interpretation of an EPC article as established by a ruling of the Enlarged Board of Appeal.⁵⁵

It is further explained that¹⁶

While decisions of the CJEU on the interpretation of the EU Biotechnology Directive are taken into account as persuasive by the EPO⁴⁴, the EU Commission Notice is

¹² Commission Notice on certain articles of Directive 98/44/EC of the European Parliament and of the Council on the legal protection of biotechnological inventions (2016/C 411/03), C 411/5, first para.

¹³ Commission Notice on certain articles of Directive 98/44/EC of the European Parliament and of the Council on the legal protection of biotechnological inventions (2016/C 411/03), C 411/7, third para.

¹⁴ Notice from the European Patent Office dated 24 November 2016 concerning the staying of proceedings due to the Commission Notice on certain articles of Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions, OJ EPO 2016, A104, item 4.

¹⁵ CA/PL 4/17, marginal no. 46.

¹⁶ CA/PL 4/17, marginal no. 36.

not binding. It does not prejudge any future position of the EU Commission on the matter, and is without prejudice to a decision of the CJEU⁴⁵.

- [8] Although initially discussed as an alternative to amendments to the Implementing Regulations, an amendment of Article 53b) EPC was rejected, wherein it is mentioned that¹⁷

An amendment of Article 53(b) EPC (option 2), if it can be based on Article 33(1)(b) EPC, would avoid issues under Article 164(2) EPC but would require unanimity of the contracting states and a longer time frame before becoming applicable.

- [9] The Implementing Regulations were adapted accordingly with decision of the Administrative Council of June 29, 2017¹⁸. The respective amended Rule 28 of the Implementing Regulations is applicable to patent applications filed on or after July 1, 2017 as well as to patent applications and patents pending at that time before the EPO. More specifically, the following new paragraph 2 was added to Rule 28

(2) 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.

Likewise, the Examination Guidelines were adapted¹⁹.

- [10] Following an appeal against the rejection of European Patent application EP 12756468.0 by the examining division which applied new Rule 28(2) of the Implementing Regulations, the BoA in its decision T 1063/18 of December 5, 2018 found that there is a conflict of new Rule 28(2) with Article 53b) EPC as interpreted by the EBA in G 2/12 and G 2/13²⁰. The Board also analyzed whether the conflict can be resolved by way of interpretation taking into account the Commission Notice²¹. The BoA finally came to the conclusion 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” with the consequence that pursuant to Article 164(2) EPC “it must be concluded that the provisions of the EPC prevail”²².

- [11] As mentioned above, the present Referral contends to be based on this decision. While the Referral further contends difficulties in the Office’s practice in the light of new Rule 28(2) of the Implementing Regulations and the result of T 1063/18 the Referral Questions significantly deviate from what has been decided in T 1063/18 (cf. sect. B further below).

¹⁷ CA/PL 4/17, marginal no. 61.

¹⁸ Decision of the Administrative Council of 29 June 2017 amending Rules 27 and 28 of the Implementing Regulations to the European Patent EPC (CA/D 6/17), OJ EPO 2017, A56.

¹⁹ Guidelines for Examination in the European Patent Office, November 2017, sect. G.II.5.2 to 5.4.

²⁰ T 1063/18, reasons 23.

²¹ T 1063/18, reasons 44.

²² T 1063/18, reasons 46.

B. INADMISSIBILITY OF THE REFERRAL

I. ART. 112 REQUIRES “DIFFERENT DECISIONS” FOR ADMISSIBILITY

[12] The Referral attempts to create a conflict in case law within the meaning of Article 112(1)b) EPC by suggesting Question 1 in a way and with a scope that deviates from the specific point of law actually decided in T 1063/18. However, even for the referred Question 1 the alleged conflict of case law does not withstand scrutiny.

[13] In the reasoning of the Referral, the admissibility of Question 1 is argued in marginal nos. 1 to 18 contending a divergence in case law pursuant to Article 112(1)b) EPC. More specifically, the Referral emphasizes in marginal nos. 4 and 17 that there is a difference in case law in the way the existence of a conflict between Article 53 EPC and a Rule in the Implementing Regulations “*clarifying*” its meaning and scope is examined under Article 164(2) EPC.

Specifically, the Referral, attempting to identify a referable point of law in T 1063/18,

- criticizes in marginal nos. 6 and 7 that in T 1063/18 the Board “*equated law [...] with case law*”,
- alleges that T 1063/18 has concluded that an earlier interpretation of Article 53 EPC “*impose[s] an absolute bar*” on the implementation of a newly drafted Rule,
- and, in order to create “*different decisions on that question*” in marginal nos. 9 to 14 the Referral then challenges this alleged conclusion in citing T 315/03, T 272/95, T 666/05, T 1213/05 and G 2/07 and contends in marginal nos. 15 and 16 that
 - these decisions did not consider it decisive under Article 164(2) EPC whether a Rule was in conflict with a prior interpretation of an Article provided by the EBA;
 - there is an *a priori* meaning of an Article that is not case law or interpretation;
 - there is a selection of different possible interpretations in Article 53 EPC;

- a conflicting interpretation was chosen by the EBA in G 2/12;
- there is no *a priori* conflict between Article 53 EPC and Rule 28(2) of the Implementing Regulations.

- [14] We submit that Question 1 is inadmissible for the reason that it factually refers to an abstract point of law.
- [15] We also submit that the Referral is inadmissible for lack of any conflict in the case law of the Boards of Appeal under any aspect of Question 1. There are no conflicting decisions, neither on the specific legal question decided in T 1063/18 which is whether Rule 28(2) is to be applied pursuant to Article 164(2) EPC nor on the abstract points of law raised in the Referral and that T 1063/18 has not deviated from the case law cited by the Referral.
- [16] Further, we submit that admission of the Referral would contravene the legislative intent of Article 112 EPC and purpose of referral proceedings²³.
- [17] Even a Question 1 redrafted to truly focus on what was decided in T 1063/18 would be inadmissible and does not overcome the limitations for a second referral on previously decided matter.

In detail:

Requirements for admissibility under Art. 112 EPC

- [18] The Referral is governed by Article 112 EPC. Article 112 EPC distinguishes between a referral during proceedings by a Board of Appeal and a referral by the President.
- [19] More specifically, Article 112(1)b) EPC stipulates that the President of the European Patent Office may refer a point of law to the EBA in order to ensure uniform application of the law, or if a point of law of fundamental importance arises with the additional requirement that two Boards of Appeal have given different decisions on that question²⁴.
- [20] The existence of “*different decisions on that question*” triggers the need of reestablishing the uniform application of the law²⁵. As to the point of law of fundamental importance under Article 112 EPC, this generally requires relevance for a larger number of comparable cases and public interest, respectively, wherein the criterion of a fundamental importance further requires a need for a clarification which is to be denied

²³ BR/26 e/70 IeI/PA/mk, cf. G 3/08, reasons 7.2.4; Steinbrener, GRUR Int. 2008, 713, 714.

²⁴ E.g., G 3/08, reasons 3.

²⁵ Benkard, Article 112 EPC, marginal no. 5.

if the answer to the question can clearly be derived from EBA decisions – in the absence of reasons justifying a second referral – the EPC or is self-evident²⁶.

- [21] Pursuant to EBA decisions G 3/08 and G 4/98 under the requirement of “*two Boards of Appeal having given different decisions on that question*”, contradictory decisions on the particular question referred must exist requiring a contradiction between specific legal positions taken by two BoAs. There are no such conflicting decisions if the different application of law is the result of different facts and not of a contradictory interpretation of a provision²⁷, or if both decisions relate to and decide, respectively, on different points of law²⁸. These conflicting positions must have arisen in relation to a specific legal question rather than abstract points of law. This is emphasized, for example, in G 3/08. Likewise, the question referred, inevitably has to remain limited to the specific point of law for which two Boards of Appeal have handed down different decisions²⁹.
- [22] In the present case there is no such conflict and accordingly there is no need for ensuring uniform application of the law, either. Further, the answer to a referral question which would actually address the point of law underlying and decided in T 1063/18 – namely whether Rule 28(2) of the Implementing Regulations complies with Article 164(2) EPC – can clearly be derived from the EPC, is self-evident and was answered in G 2/12 and G 2/13 and specifically handed down by T 1063/18 so that there is no need for further clarification either.
- [23] We submit that any referable question under Article 112 EPC needs to be a specific legal point of law in relation to a real issue raised in T 1063/18³⁰, rather than a theoretical question constructed to serve as a vehicle in order to factually refer a question already decided in G 2/12 and G 2/13 to the EBA for the second time.

T 1063/18 considered Rule 28(2) and a second referral

- [24] T 1063/18 recognized the conflicting legal content of Rule 28(2) of the Implementing Regulations and Article 53b) EPC as interpreted by the EBA. It then analyzed whether a potential contradiction can be avoided by interpreting new Rule 28(2) in line with the meaning of Article 53b) EPC or whether there are reasons to deviate from G 2/12 and G 2/13. The Board found that Rule 28(2) of the Implementing Regulations reverses the meaning of Article 53b) EPC so that there is no room for such interpretation, and, following analysis of the available *ex post* facts, that there is no reason to deviate from the prior EBA decisions.

²⁶ Benkard-Günzel/Kinkeldey, 3rd Ed. 2019, Article 112, marginal no. 7.

²⁷ E.g., T 248/1988, BeckRS 1989 30549500, reasons 3.3; cf. Benkard- Günzel/Kinkeldey, 3rd Ed. 2019, Article 112 EPC, marginal no. 6.

²⁸ E.g., G 3/95.

²⁹ G 3/08, reasons 7.2.4 and 7.2.5; Van Empel, 1975, The Granting of European Patents, marginal no. 524.

³⁰ T 1063/18, reasons 25.

- [25] The Board in T 1063/18 also discussed but then denied a second referral to the EBA pursuant to Article 21 of the Rules of Procedure of the Boards of Appeal. Only then it came to the conclusion that it has the obligation to apply G 2/12 and G 2/13.
- [26] The statement in T 1063/18 which the Referral criticizes in marginal no. 5 as a matter of fact relies on what is explicitly provided in the EPC³¹

The board recognises "the Administrative Council's power to lay down provisions concerning substantive law in the Implementing Regulations" as recognised in decision G 2/07 (see Reasons, point 2.2). However, in point 2.2 of this decision it is also noted that "The limits to the Administrative Council's law-making powers by means of the Implementing Regulations can be inferred from Article 164(2) EPC". According to that Article, in case of conflict between the provisions of the EPC and those of the Implementing Regulations, the provisions of the EPC shall prevail. Thus the board agrees with the finding in decision T 39/93 (see Reasons, point 3.2) that "the meaning of an Article of the EPC (...), on its true interpretation as established by a ruling of the Enlarged Board of Appeal cannot, (...), be overturned by a newly drafted Rule of the Implementing Regulations, the effect of which is to conflict with this interpretation". The board concludes that it must apply decisions G 2/12 and G 2/13 unless it has reasons to refer the same question underlying these decisions for reconsideration by the EBA.

T 39/93 only applies Article 164(2) EPC and confirms generally accepted principles

- [27] T 39/93, as relied on by the Referral, was concerned with new Rule 71a that would have overturned the meaning of Article 114 EPC1973 in its interpretation by the EBA. It stated that³²

[...] the Board cannot accept the Appellant's legal proposition that an amendment to a procedural rule (i.e. old Rule 71 EPC) is capable of overriding those well-established legal principles, laid down in the points of law above referred to, that define the nature and function of appeals, and in particular the scope and effect of Article 114(1) EPC in relation to that function. In other words, the meaning of an Article of the EPC (here, Article 114), on its true interpretation as established by a ruling of the Enlarged Board of Appeal cannot, in the Board's view, be overturned by a newly drafted Rule of the Implementing Regulations, the effect of which is to conflict with this interpretation. This is because, according to Article 164(2) EPC, in the case of conflict between the provisions of this Convention (the EPC Article) and those of the Implementing Regulations, the provisions of this Convention shall prevail.

³¹ T 1063/18, reasons 26.

³² T 39/93, reasons 3.2.

- [28] This limitation of powers of the Administrative Council is a result of Article 164(2) EPC and additionally a result of general principles in the law of international organizations as underlined in J 16/96, which explicitly dealt with the extent of authorization of the Administrative Council to provide interpretation under the EPC³³: *"In the law of international organisations, it is a recognised principle that bodies competent to lay down internal law may claim [only] a corresponding degree of competence to interpret that law (see Seidl-Hohenveldern, Das Recht der Internationalen Organisationen (...), 5th ed., p. 233, No.1614)."* The power allocated to the Administrative Council is well-defined in Articles 33 EPC 164(2) EPC and cannot violate the hierarchy of norms principle without explicit empowerment, such as under the conditions of Article 33(1)b) EPC (cf. also President's submission CA/PL 4/17 marginal no. 42).

No basis for a distinction between "Article 53 EPC itself" and "interpretation of Article 53" and limitation of the Administrative Council's power by Art. 164(2) EPC

- [29] The Referral correctly recognizes in marginal no. 5 and the first sentences of marginal no. 6 that T 1063/18 found that new Rule 28(2) of the Implementing Regulations reverses the meaning of Article 53b) EPC. This finding in T 1063/18 was based on comprehensive interpretive work by the EBA and Rule 28(2) of the Implementing Regulations was thus to be set aside for the reason that Article 53b) EPC prevails pursuant to Article 164(2) EPC.
- [30] The Referral then, however, attempts to distinguish in its marginal no. 6, last sentence, between *"Article 53 EPC itself"* and the *"interpretation of Article 53 EPC"* (emphasis added)

Following this decision [T 1063/18] a clarification of the meaning and scope of Article 53 EPC by means of an EPC Rule would therefore not only be limited by law, i.e. Article 53 EPC itself, but also by case law, i.e. an interpretation of Article 53 EPC given in an earlier decision of the Enlarged Board.

- [31] It seems that the Referral attempts to introduce two levels of content into Article 53 EPC. The provision itself on the one hand, and its interpretation on the other hand. There is no basis for such distinction in Article 164 EPC, in any other Article of the EPC, in the Vienna Convention, or in any case law. In T 1063/18 *"meaning and scope"* of Article 53b) EPC have been assessed under the established principles and based on G 2/12 and G 2/13 and no distinction between law and case law can be derived from G 2/12 and G 2/13 either.

³³ J 16/96, reasons 2.1.

- [32] An existing provision (Article) needs to be interpreted in order to acquire a meaning. The judicative is competent to provide such interpretation. The legislative can also provide interpretation of a provision within the framework of its legislative empowerment. The EPC in Article 33 EPC in fact empowers the Administrative Council to provide its own interpretation of Articles of the EPC by way of Implementing Regulations. The extent of such legislative interpretation or clarification by way of the Implementing Regulations is, however, clearly and conclusively limited by Article 164(2) EPC. Any impact of Rule 28(2) on the judicative interpretation of Article 53b) EPC is thus limited by Article 164(2) EPC.
- [33] Consequently, when the Board in T 1063/18 assessed whether there are reasons to deviate from G 2/12 and G 2/13, it correctly took into account the development since G 2/12 and G 2/13 but it could not apply an overriding effect of Rule 28(2) as this would have violated Article 164(2) EPC. It would have interfered with the distribution of powers on which the EPC legal system is based (cf. sect. C further below). T 1063/18 discussed the Administrative Council's implementation as a type of subsequent agreement in the sense of the Vienna Convention³⁴ and correctly assessed its consideration on the hierarchy level the EPC has allocated to it.
- [34] It is thus incorrect when the Referral states that “[...] *the Board [T 1063/18] considered it irrelevant that the earlier decision of the Enlarged Board of Appeal did not and could not take into account the Administrative Council's implementation of Article 53 EPC in an EPC Rule*” (marginal no. 7). In fact, in the light of the conclusion of the Board in T 1063/18, that new Rule 28(2) of the Implementing Regulations in fact reverses the meaning of Article 53b) EPC as identified by case law and further confirmed by its own analysis, the Board could not go any further and attribute a modifying effect as a “*subsequent agreement*” to Rule 28(2) of the Implementing Regulations.
- [35] The Board in T 1063/18 even explicitly acknowledged that it needed to assess whether there were reasons for reconsideration of the interpretation the EBA had provided. The Board's specific conclusion under Article 164(2) EPC was thus handed down after thorough examination that “*the Enlarged Board's interpretation would exclude any subsequent clarification by means of a Rule which would conflict with said interpretation*” (marginal no. 7 in the Referral).
- [36] T 1063/18 then assessed whether there are any of the reasons for a second referral based on Article 21 of the Rules of Procedure of the Boards of Appeal and as established in case law. In doing so it again considered the Administrative Council's implementation but it did not identify sufficient reason for a repeated referral.

³⁴ T 1063/18, reasons 31 to 35.

The decisions raised by the Referral are not “different decisions” under Art. 112(1)b) EPC

[37] None of the decisions cited in sect. A.I of the Referral actually refers to or deals with the point of law specifically dealt with in T 1063/18, i.e. the viability of Rule 28(2) of the Implementing Regulations under Article 53b) EPC. Consequently, the conditions of Article 112(1)b) EPC are not met. For the sake of completeness we nevertheless provide detailed comments below on the further arguments in the Referral as regards the alleged conflict with other decisions.

T 315/03: No procedural basis for a referral under Art. 112(1)b) EPC and no conflict of T 1063/18 with earlier case law

[38] The Referral in marginal nos. 9 and 10 intends to rely on T 315/03 arguing that the Board of Appeal in this decision 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.

[39] First of all, procedurally, T 315/03 does not provide any basis for a conflict with T 1063/18 within the meaning of Article 112(1)b) EPC. T 315/03 does not refer to new Rule 28(2) of the Implementing Regulations or Article 53b) EPC or deal with the issue of a newly introduced rule completely reversing the meaning of an Article as thoroughly interpreted by the EBA applying the principles of the Vienna Convention.

Contradicting position re T 315/03 taken by the President in his submission to the Committee on Patent Law in March 2017

[40] Further, the Referral’s understanding of T 315/03 is surprising, had the former President taken just the opposite position in his submission to the Committee on Patent Law in March 2017 and interpreted T 315/03 perfectly in line with T 39/93. There the President stated³⁵

In reviewing an amendment of the Implementing Regulations to the EPC (option 3), the boards of appeal may have regard to the hierarchy of norms principle set forth in Article 164(2) EPC. Under this article the provisions of the Convention will prevail in case of conflict with the Implementing Regulations. On this basis, the boards of appeal have jurisdiction to refuse enforcement of a rule of the EPC Implementing Regulations if it is considered to conflict with an EPC article.²⁰

Stating this, the President points to reasons 5.8 in T 315/03 in his footnote 20 and then further states pointing in his footnote 21 to T 39/93 reasons 3.2

³⁵ CA/PL 4/17, marginal no. 23.

In other words, an amendment of the EPC Implementing Regulations is only effective if it does not conflict with the meaning of an article of the EPC on its true interpretation as established by a ruling of the Enlarged Board of Appeal.²¹

The position of the Referral fails to reflect the facts underlying T 315/03

- [41] In T 315/03 the new Rule was not found to be in conflict with the earlier case law T 19/90. T 315/03 deals with new Rule 23d(d) EPC1973³⁶ which, compared to a test developed by the Board of Appeal in T 19/90, only made one parameter developed in T 19/90 more specific (“*medical benefit*”) and provided an additional test. T 315/03 emphasizes that the test provided in T 19/90 does not exclude a specification of criteria. More specifically, T 315/03³⁷ states (emphasis added)

Lastly, it is said in T 19/90 that a decision under Article 53(a) EPC would depend “mainly” on the test. This allows for other considerations to be taken into account, either by way of adapting the test - if, for example, other issues than animal suffering or environmental risk were advanced as contrary to “ordre public” or morality - or by way of considering other matters outside the framework of the test. For example, in the present case the arguments under Article 53(a) EPC included an alleged threat to evolution, alleged increased trade in genetically manipulated animals and alleged moral unacceptability of such manipulation (see paragraphs 13.2.10 et seq below).

- [42] Thus, in contrast to the present case, the criteria set with newly introduced Rule 23d(d) EPC1973 were not found to reverse the earlier interpretation of Article 53a) EPC in T 19/9038. Rather, the statement in T 315/03 that³⁹ (emphasis added)

[...] 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.

confirms that T 315/03 found no inconsistency between Rule 23d(d) EPC1973 and the interpretation of Article 53a) EPC by T 19/90. T 315/03 also indicates that the new Rule “*did not mark an entire change of régime as regards animal patents*”⁴⁰ – thus rejecting the argument of appellants 3 and 6 that the new Rule had led to a “*fundamental amendment or addition*”⁴¹ in this regard. The Board also refers to and implicitly confirms what is stated in the decision of the Administrative Council of July 1, 1999⁴². The latter

³⁶ Corresponding to Rule 28(1)d) EPC2000 and Article 53a) EPC1973.

³⁷ T 315/03, reasons 10.7.

³⁸ T 315/03, reasons 7.4.

³⁹ T 315/03, reasons 7.3.

⁴⁰ T 315/03, reasons 5.1.

⁴¹ T 315/03, sect. XXVI(2).

⁴² T 315/05, reasons 4.5, 5.1 and 5.7.

explains that the provisions in Chapter I of the Biotechnology Directive (emphasis added) “[...] are based on the relevant provisions of the EPC and essentially reflect current practice as developed by the Office and its boards of appeal in applying the EPC” with “some extensions and clarifications” intended with Rules 23b to e EPC1973⁴³.

- [43] The Board in T 315/03 further confirms in reasons 7.3 that “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*”.

It then concludes that Rule 23d does not go beyond Article 53a) EPC as the term “*ordre public*” in Article 53a) EPC did not preclude the interpretation in T 19/90 leading to the test criterion “*usefulness to mankind*” or its further specification in Rule 23d) (“*substantial medical benefit*”). Therefore, there was no contradiction between T 19/90 and Rule 23d). In its assessment, T 315/03, as judicative, in fact provides its own case law interpretation of Article 53a) EPC in order to examine a conflict under Article 164(2) EPC. It does distinguish between the Article and its interpretation.

- [44] This is completely in line with the approach of T 1063/18. As confirmed in T 315/03 the EPC in Article 164(2) provides for the limitations of an interpretation or clarification by the Administrative Council if a provision of the EPC precludes such interpretation. However, whether the wording of an Article in question limits or excludes certain interpretation can only be identified by interpretation of precisely this Article, which is exactly, what T 315/03 did.

- [45] “*Article 53 itself*”, as the Referral attempts to distinguish over “*case law*”, as a matter of principle, has no absolute content detached from interpretation. It is rather to be interpreted according to the accepted principles of the Vienna Convention, which start from the ordinary meaning of the text. Interpretation is the science of understanding a (legal) text⁴⁴. What may be meant by the Referral is a kind of first line interpretation, interpreting the immediate meaning of the words within a provision which is still an interpretation and does not answer the decisive question: Who is competent to provide such interpretation.

- [46] Undisputedly, the EPC empowers both the Boards of Appeal and the Administrative Council to interpret the Articles of the EPC. However, Articles 33 and 164(2) EPC limit the competency of the Administrative Council in this respect. It may not provide interpretation/Rules which contradict the Articles of the EPC. As a matter of logic this excludes that the Administrative Council in the case of a conflict with an Article reverses the prior interpretation. Otherwise, Article 164(2) EPC would never be applicable

⁴³ Notice dated 1 July 1999 concerning the amendment of the Implementing regulations to the European Patent EPC, sect. 6.

⁴⁴ Reinhold Zippelius: Das Wesen des Rechts, 6. Auflage 2012, Kap. 8.

because the effect of a Rule would always be to modify the Article to the extent that there is no conflict.

- [47] This does not mean that a Rule could not specify a case law interpretation or such specification would immediately be *ultra vires* simply because it is not identical to prior case law. T 315/03 in this respect states that (emphasis added) “[...] *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**”⁴⁵. This is quoted by the Referral in marginal no. 10 but it is not in conflict with T 1063/18. It only excludes artificially constructed *vires* by comparison of case law with a subsequent Rule outside of the actual Article 164(2) EPC limitation. This is clearly confirmed in T 315/03 which states that the Boards

[...] 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.

- [48] It then for the specific case comes to the conclusion that

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

Like T 1063/18, T 315/03 interpreted Article 53a) EPC in order to assess whether there is a conflict under Article 164(2) EPC. In the present case T 1063/18 came to the conclusion that Rule 28(2) reverses Article 53b) EPC as previously interpreted by the Enlarged Board of Appeal in G 2/12 and G 2/13. This is no contradiction in the legal approach of the two decisions but rather they are based on different facts of the cases.

- [49] Finally, the case law basis in T 315/03, T 19/90, cannot be compared with G 2/12 and G 2/13 in terms of the relevance of the interpretation. In addition to the fact that T 19/90 was not an EBA decision and was handed down prior to the Biotechnology Directive which Rule 23d) had followed, and that *ordre public* is an undefined legal term, T 19/90 only provided a very short statement on the interpretation of *ordre public* in Article 53a) EPC which had not considered the Biotechnology Directive. This is different from the present case where the EBA in G 2/12 and G 2/13, following extensive discussion and consideration of various positions and arguments – including the Biotechnology Directive – provided a well-founded express interpretation of Article 53b) EPC in accordance with the Vienna Convention. In contrast, T 19/90 while referring the case back to the examining division only stated that⁴⁶ (emphasis added)

⁴⁵ T 315/03, reasons 7.3.

⁴⁶ T 19/90, reasons 5.

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.

This is not a fully developed interpretation of an Article of the EPC under the Vienna Convention as provided by the EBA in G 2/12 and G 2/13 and in further case law⁴⁷.

- [50] Consequently, the Board of Appeal in reasons 7.3 of T 315/03 was precisely not confronted with a newly introduced Rule that reverses a carefully developed case law interpretation by the EBA under the Vienna Convention.
- [51] T 1063/18 effectively relied on the interpretative guidance provided by the EBA and on Article 21 of the Rules of Procedure of the Boards of Appeal further supplemented by an analysis of the criteria developed in case law for a second referral before it gave effect to Article 164(2) EPC.
- [52] The Board of Appeal in T 315/03 did not intend to question such interpretative guidance of the EBA which can be inferred from T 315/03 endorsing the reasoning in T 272/95⁴⁸ (emphasis added)

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).

- [53] This is further supported by the reception of T 39/93 and T 315/03 provided in T 83/05 (cited by the Referral in marginal no. 5). T 83/05 in fact took both T 39/93 and T 315/03 into consideration with regard to the consequence of the amended Implementing Regulations (R 23b(5) EPC1973) in the light of the interpretation of Article 53b) EPC1973. The Board of Appeal explicitly endorsed the view expressed in T 39/93 (and T 1063/18) as *"the most important [line of argument]"* for the Board⁴⁹. It cites decision T 315/03 in the subsequent paragraph that provides a complementary line of arguments semantically indicated by the term *"secondly"*⁵⁰. Quite clearly the decisions T 39/93 and T 315/03 were in no way perceived as contradictory by the Board in T 83/05 – and likewise by the former President as shown above.

⁴⁷ E.g., G 1/83, G 2/07, G 1/08; cf. also J 16/96, reasons 3 cited in the President's Referral.

⁴⁸ T 315/03, reasons 7.6.

⁴⁹ T 83/05, reasons 57.

⁵⁰ T 83/05, reasons 58.

T 272/95, T 666/05 and T 1213/05

- [54] The Referral in marginal no. 11 further refers to T 272/95, which allegedly “[...] fully acknowledged the Administrative Council’s competence to give “a more detailed interpretation of the meaning of Article 53 EPC” and which assessed the “conformity with said Article”. The Referral alleges that T 666/05 and T 1213/05 have drawn the same conclusion.
- [55] T 272/95, T 666/05 and T 1213/05 refer to Rules 23b) to e) EPC1973 corresponding to Rules 26, 27, 28(1) and 29 EPC2000 and they refer to Articles 52 and 53a) EPC. Neither did these decisions thus assess Rule 28(2) in the light of Article 164(2) EPC nor did they face the legal question of a newly introduced Rule completely reversing the meaning of an Article as interpreted by the EBA. Rather, the mentioned decisions find no conflict of the new Rules 23b) to e) EPC1973 with Articles 53a) and 52(2)a) EPC, and, what is more, they rely on the interpretation of Article 53 EPC in the same way T 1063/18 did. In the absence of any available interpretation of Article 53a) by the EBA they take into account that the EBA in G 1/98 interpreted Article 53b) EPC and concluded that its interpretation corresponds to the one of Article 4(1)b and (3) of the Biotechnology Directive considering the corresponding language and Recital 32 of the Biotechnology Directive. Specifically, T 272/95, on which T 666/05 and T 1213/05 rely, states⁵¹ (emphasis added)

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. In decision G 1/98 (OJ EPO 2000, 11, point 5.3) dealing with the interpretation of Article 53(b) EPC, the EBA stated that Article 4(1)b and (3) of the EU biotechnology directive 98/44 (see supra) was intended to be interpreted in the same sense as the EBA interpreted the scope of Article 53(b) EPC (G 1/98, points 3.10, 5 and 6, see supra). This latter interpretation corresponds entirely to the new Rule 23(c) adopted by the Administrative Council, which in turn is based on the EU directive. The EBA, thus, found this Rule related to Article 53(b)EPC to be only interpretative. The present Board adopts this view, considers that the same holds true for the new rules as far as they relate to the interpretation of Article 53(a) EPC and, thus, will apply Rules (e) and (d) to the present case.

This makes clear that in T 272/95 the requirement of examination in “conformity with this article”, refers to the limitations of Article 164(2) EPC which is nothing else than what T 39/93 (and T 1063/18) examined. T 39/93 likewise uses the expression “conflict between the provisions of this Convention (the EPC Article)”⁵².

⁵¹ T 272/95, reasons 5.

⁵² T 39/93, reasons 3.2.

- [56] The Referral intends to derive from the expressions “*more detailed interpretation of the meaning of Article 53 EPC*”⁵³ as well as the statement that “*Article 52(2)(a) EPC is to be interpreted in accordance with the implementing Rule 23e(2) EPC*”⁵⁴ or “*Article 52(2)(a) EPC is to be interpreted in accordance with the implementing Rule 29(2) EPC (corresponding to Rule 23e(2) EPC 1973)*”⁵⁵ that these decisions acknowledge a broad competence of the Administrative Council to set Rules even if they reverse an interpretation of an Article by the EBA. However, we submit that such conclusion cannot be drawn from these decisions – and that there is no respective *obiter dictum*, either. Again, what is meant in these decisions seems to be quite clear in reasons 4 and 5 in T 272/95 to which T 666/05 and T 1213/05 refer: a clarification of the meaning of Articles 52 and 53a) EPC rather than a reversal of their meaning as identified by case law. Notably, an interpretation of the Article by an EBA decision in this case was not available.
- [57] In sum, neither is Rule 28(2) of the Implementing Regulations addressed in the decisions raised by the Referral, nor do they propose an approach to compare Article 53 EPC and a Rule that contradicts this Article as in T 1063/18, and neither do they pertain to a new Rule the content of which reverses the meaning of an Article as identified under the principles of the Vienna Convention. This is not changed by the fact that the Referral attempts to qualify Rule 28(2) as clarification.

G 2/07

- [58] In the Referral in marginal no. 12, reference is made to G 2/07, in particular its reasons 2.4. The Referral argues that this decision followed an approach that differs from the one in T 1063/18 because the Enlarged Board of Appeal did not endorse the reasoning underlying decision T 39/93 that under Article 164(2) EPC a previous interpretation of Article 53 EPC by the Enlarged Board of Appeal would a priori preclude its clarification by means of a newly drafted Rule of the Implementing Regulations.
- [59] Firstly, clarification is not reversal and as opposed to clarification, reversal is in conflict with 164(2) EPC. Further, this is not a correct representation of what was not endorsed in G 2/07. G 2/07 explains in the points following reasons 2.4 that it did not endorse the assumption of the referring Board that Rule 26(5) was in conflict with Article 53b) EPC because Rule 26(5) lacked clarity. Consequently, Article 164(2) EPC was not even examined by the EBA. This has nothing to do with the allegation of the Referral that the notion of a previous interpretation of Article 53 EPC by the Enlarged Board of Appeal a priori precluding its “*clarification*” by means of a newly drafted Rule of the Implementing Regulations was not endorsed by the EBA. That the Referral is incorrect not only in confusing “*clarification*” with “*reversal*” but also as regards the assumptions that were

⁵³ T 272/95, reasons 4.

⁵⁴ T 1213/05, reasons 44.

⁵⁵ T 666/05, reasons 75.

actually not endorsed becomes clear from what is additionally stated in the final paragraph in reasons 2.4 in G 2/07 (emphasis added)

As will be set out below, this reasoning is based on assumptions which are not endorsed by the Enlarged Board, so that a problem of conflict between Rule 26(5) EPC and Article 53(b) EPC in the sense described by the referring Board does not arise.

[60] It can be clearly derived which “assumptions” of the referring Board of Appeal the EBA had in mind, i.e. which “assumptions” are not endorsed from the actual reasoning in G 2/07.

[61] Specifically, the EBA in G 2/07 explains that there is no conflict between Rule 26(5) and Article 53b) EPC⁵⁶

However, in order to enable the Article to which a Rule pertains to be interpreted by means of the Rule, such Rule must at least be clear enough to indicate to those applying it in what way the legislator intended the Article to be interpreted by means of that Rule. This is not the case for Rule 26(5) EPC.“

and⁵⁷

It is notable, furthermore, that, as is to be derived from document CA/PL/ 3/99, point 23, the legislator of the EPC did not intend to overrule any jurisprudence of the boards of appeal.

The EBA interpreted Article 53b) EPC following the principles of the Vienna Convention as did G 2/12 and G 2/13⁵⁸.

[62] The legal theory in T 39/93 “[...] that, in view of Article 164(2) EPC, the meaning of an Article of the EPC on its true interpretation as established - in that case - by a ruling of the Enlarged Board of Appeal cannot be overturned by a newly drafted rule of the Implementing Regulations”⁵⁹ which T 1063/18 endorsed was thus not rejected by G 2/07 but rather the assumption of a conflict between the Rule and the Article in the first place was rejected in lack of clarity of the assessed Rule.

[63] There was consequently no need to even assess Article 164(2) EPC after concluding that there was no conflict between Rule 26(5) and Article 53b) EPC in the case of

⁵⁶ G 2/07, reasons 5.

⁵⁷ G 2/07, reasons 5.

⁵⁸ E.g., G 2/07, reasons 5.

⁵⁹ G 2/07, reasons 2.4.

G 2/07. The Referral fails to establish even just a methodically deviating assessment of a newly introduced Rule under Article 164(2) EPC in G 2/07 compared to T 1063/18.

- [64] As regards the Enlarged Board requiring consideration of Rule 26(5) when interpreting Article 53b) EPC, T 1063/18 has in fact met this requirement and discussed the Administrative Council's implementation of Rule 28(2) when interpreting Article 53b) EPC.
- [65] In addition, G 2/07 was not concerned with reconsideration of an EBA interpretation or with a second referral so that it could not address the point of law of a newly introduced Rule, as in T 1063/18, reversing the meaning of an Article as interpreted by a former decision of the EBA.
- [66] We further note that the argument in marginal no. 14 in the Referral that T 1063/18 did not decide to refer the question to the EBA does not and cannot have an impact on the admissibility of the present Referral under Article 112(1)b) EPC as Article 112 does not foresee the option for the President to refer in the event he does not agree to the outcome regarding a non-referral by a Board. The requirements for Referral by the President are intentionally distinct from the requirements set for the Boards of Appeal.

T 1063/18 did not impose an absolute bar but examined Article 164(2) EPC

- [67] The Referral admits in marginal no. 15 that all the decisions mentioned in its previous marginal nos. took into account available guidance from the EBA and BoAs on the interpretation of Article 53 EPC. Reference is made to T 315/03, reasons 7.6. The latter precisely admits the function of the EBA to "*ensure uniform application of the law*" and Article 112(1) EPC confirming its interpretative supremacy. The Referral thereby effectively confirms the significance and *de facto* binding effect of an interpretation provided by the EBA for determining the meaning and scope of an Article.
- [68] However, the Referral argues in marginal no. 15 that none of the decisions – except T 1063/18 – considered an earlier interpretation of Article 53 EPC to "*impose an absolute bar*" on the implementation of a new Rule. This misrepresents the reasoning of T 1063/18.
- [69] T 1063/18, rather than imposing an "*absolute bar*", strictly followed the requirements provided by the EPC. Article 21 of the Rules of Procedure of the Boards of Appeal requires the Board to apply the EBA decisions unless it has reasons to deviate in which case it must then refer the question to the EBA. Consequently, T 1063/18 examined whether there were reasons to deviate in consideration of subsequent developments and thus to refer to the EBA, which it negated.

None of the cited decisions faced a Rule that was in direct contradiction with an existing EBA decision

[70] It is important to note that none of the above decisions cited by the Referral actually faced a Rule that was in direct contradiction with an existing Enlarged Board of Appeal decision. This again confirms that there is no divergence in the case law in this respect, either, not even on a methodical level. The Referral in further arguing in marginal no. 15 that

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”¹¹ in an earlier decision and thus whether the Rule was in conflict with case law.

again remains silent on the fact that none of the decisions faced a clear conflict of a Rule with previous EBA decisions.

[71] The argument in the Referral that there could be no conflict as Article 53b) EPC did not explicitly exclude the relevant subject-matter and was open to different interpretations, respectively, has no bearing on the question of admissibility of the Referral. T 1063/18 has not dealt with such legal question and there is no difference in existing case law in this regard.

[72] We note at this point that the actual conflict of Rule 28(2) under Article 164(2) EPC is with Article 52(1) EPC. Article 52(1) EPC is clear in that it allows patentability of plants and animals – in line with the wording of the Directive – and the exceptions of Article 53b) EPC do not explicitly change this as will be shown in sect. C below. The conflict of Rule 28(2) of the Implementing Regulations is thus with Article 52(1) EPC as it does not allow exclusion of matter not clearly excluded by the EPC. The Referral only focusses on Article 53b) EPC and takes the position that Article 53b) EPC was not clear.

T 1063/18 applied all elements of interpretation under the Vienna Convention

[73] The point raised in the Referral in marginal no. 16, that an Article needs to be interpreted by considering all elements including earlier case law, EBA decisions and the Administrative Council’s implementation of the new Rule is without merit. T 1063/18, as a matter of fact, applied all these elements of interpretation, as well as its own assessment of a deviation from such case law and of the necessity of a subsequent second referral. It additionally considered whether the Administrative Council’s implementation has an effect on the result in G 2/12 and G 2/13 which corresponds to the approach in reasons 2.3 in J 16/96 cited in the Referral. Finally, the extent to which

a Rule may form part of such interpretation is limited by Article 164(2) EPC as also correctly assessed in T 1063/18 (cf. sect. C further below).

Article 164(2) EPC does not allow for the overriding effect of a Rule in case of a conflict with the content of an Article as identified by the EBA

- [74] Further the Referral in marginal no. 17, footnote 15 relies on a commentary statement and alleges that “*scholars have also suggested that the approach underlying decision T 39/93 and followed in decision T 1063/18 is in conflict with other case law.*”¹⁵ Factually, the position from the Benkard commentary is from a single attorney and suggests that where a Rule contradicts an Article as interpreted by the EBA such interpretation could simply be cancelled by the contradicting Rule. In other words the Rule would have an overriding effect on the Article. The attorney does not reason his (extreme) position and does not cite or provide any source that would support his hypothesis which underlines that the statement does not even have the character of a scholar’s statement.
- [75] Such overriding effect of a Rule on the Article in case of a conflict would be exactly the opposite of the intention of Article 164(2) EPC and furthermore would exclude any case of applying Article 164(2) EPC in the first place.
- [76] The Referral than states that the limited competence of the EBA, not being a constitutional court in relation to the legislative competence of the Administrative Council, did not exclude such overriding effect of a Rule. This simply ignores Articles 33 and 164(2) EPC. In fact, what the Referral does not state is that the same Benkard commentary under Article 33 marginal no. 6 confirms that Article 164(2) EPC is an immanent barrier for the power of the Administrative Council in any amendment and that the supremacy of the EPC obviously also persists, if the Administrative Council enters into interpreting the EPC by way of the Implementing Regulations.
- [77] What remains, are the clear provisions in Articles 33 and 164(2) EPC which limit the competence of the Administrative Council and subordinate the Rules in relation to the Articles. The EPC legislator has decided to require a three-quarter majority vote of the Contracting States in a revision conference for any change of the EPC (Article 172 EPC) and that the Administrative Council’s legislative competence be limited by Articles 33 and 164(2) EPC. More specifically, the EPC legislator has only allocated the power of interpretation of the Implementing Regulations to the Administrative Council to the extent reflected in Articles 33, 35, 164(2) EPC – and even an amendment of certain Articles as foreseen in Articles 33(1)b) and (5), 35(3) EPC is conditional on international treaties or European Community legislation having entered into force (cf. Article 33(5) EPC).

A contradicting Rule overriding case law would circumvent the principle Article 164(2) EPC is intended to safeguard

[78] If such limitation of the Administrative Council's power could simply be circumvented by aligning the interpretation of the Article in question with the contradicting Rule to result in the opposite of what the judiciary interpretation has come up with, as in the present case of Article 53b), this would effectively provide the Administrative Council with the overriding competence of interpreting the EPC in the cases of conflict meant to be regulated by Article 164(2) EPC. This leaves no room for Art. 164(2) EPC and the addressee, that Art. 164(2) intends to control, would control itself. In fact, as the EPC foresees no distinct constitutional court that would supervise any conflicts of lower ranked law with higher ranked law, the EPC would lack a fundamental judiciary function if the Enlarged Board of Appeal would not have an overriding competence in relation to the interpretation of the Articles of the EPC *vis-à-vis* the Implementing Regulations, albeit within the limitations of Article 164(2) EPC.

[79] In sum, we cannot identify any divergence in the case law of the Boards of Appeal as regards the specific point of law on which Question 1 can, if at all, be based. Additionally, we cannot identify any Board of Appeal decision pertaining to a conflict between a newly introduced Rule that in fact reverses the meaning of an Article as interpreted by the EBA, and no basis for the alleged methodical contradiction in case law either.

II. NO APPLICABILITY OF ARTICLE 112(1)B) EPC BY ANALOGY TO THE PRESENT SITUATION

[80] In the Referral, the admissibility of Question 2 is argued to be justified with the admissibility of Question 1. It is argued in marginal no. 18 that the conflict of Rule 28(2) of the Implementing Regulations with Article 53b) EPC is the direct consequence of the "*approach*" taken in T 1063/18. Alternatively, it is suggested in marginal nos. 19 and 20 in the Referral that Article 112(1)b) EPC be applied by analogy based on the assumption of lacunae in the law.

[81] As the Referral of Question 1 is inadmissible, the Referral of Question 2 is equally inadmissible for the same reasons. We submit that for Article 112(1)b) EPC in the light of the meaning to be given to the terms, the context, object and purpose confirmed by the preparatory work support a narrow interpretation of this provision. Moreover, we submit that there are no lacunae in the law, i.e. neither has a respective provision been deliberately omitted nor is there a legal gap that has not been taken into account and could provide the basis for an application of Article 112(1)b) EPC by analogy.

In detail:

- [82] For the application of a provision by analogy there must be an unintentional gap and lacunae, respectively, and the interests in the particular case must correspond to those in the provision to be applied by analogy. The application of the provision by analogy must lead to a generally applicable provision which the legislature would presumably have ordered if it had been aware of the lacunae⁶⁰.
- [83] While the reasoning of the Referral heavily relies on an allegedly comparable situation and interests, respectively, it seems that it does not apply the respective principles of interpretation and instead simply concludes with reference to G 4/98 and G 3/08 that there is a gap – which actually does not exist. Further, we submit that its existence is precisely not supported by these EBA decisions.
- [84] Finally, we submit that Article 33(5) EPC leaves no room for an unintended gap in the present case.

No unintended legal gap

- [85] Article 112 EPC explicitly distinguishes between a referral based on pending appeal proceedings and a referral by the President. The provision explicitly sets different requirements for both types of referrals. The intended distinction between the two types of referrals is further supported by the difference in the nature of the outcome. The referral under Article 112(1)a) EPC leads to a decision (Article 22(1)a) EPC), while a referral pursuant to Article 112(1)b) EPC can only trigger an opinion of the EBA pursuant to Article 22(1)b) EPC.
- [86] More specifically, Article 112(1)b) EPC states that “*two Boards of Appeal [must] have given different decisions on that question*”, i.e. it requires two final decisions. Such requirement cannot be found in Article 112(1)a) EPC, i.e. for the referral of a BoA in pending appeal proceedings.
- [87] While there are no further provisions in the EPC or in the Implementing Regulations on the admissibility of referrals, Article 20(1) of the Rules of Procedure of the Boards of Appeal supplements Article 112(1)b) EPC. Namely in the light of the lack of a binding effect of Board of Appeal decisions on other Boards of Appeal, this provision requires that the President of the European Patent Office is informed in case a Board of Appeal decides to deviate from an earlier decision or interpretation of another Board of Appeal.
- [88] In respect of the *ratio legis* of Article 112(1)b) EPC, the latter serves the purpose of re-establishing disrupted legal uniformity and ensuring uniform application of the law in

⁶⁰ J 1/09, reasons 15.

phases of legal uncertainty⁶¹ – as expressed by Teschemacher “[...] wenn die Grundlagen der verfahrensrechtlichen Mechanismen in Zweifel geraten.” Such referral must however not interfere with the development of the law⁶². More specifically, the President should be able to refer a question to the EBA if uniform application of law can only be achieved and re-established by means of the referral⁶³ with the EBA having the function to ensure a uniform interpretation of the EPC⁶⁴. The EBA should be given the “last word”⁶⁵.

Preparatory work and legislator’s intent as regards Art. 112(1)b) EPC

[89] While the reasoning in marginal nos. 21 and 26 in the present Referral briefly touches the preparatory work and intention of the legislator, it ignores that a broad power of the President without the limitation to the presence of two deviating Board of Appeal decisions was discussed and even suggested in a preliminary draft of Article 116(1)b) EPC⁶⁶. The drafted paragraph b) of Article 116 in the initial draft reads as follows

*b) the President of the European Patent Office may:
[- at any time ask the Enlarged Board of Appeal for an opinion on any question, except where such question arises in proceedings on a case]
- refer a point of law to the Enlarged Board of Appeal where two Boards of Appeal have given different decisions on that question.*

[90] According to the first alternative in paragraph b), the President of the EPO would have had the right to refer questions to the EBA with the sole requirement that there are no pending proceedings. The Conference was however unable to agree to such broad power of the President. It is stated in the preparatory documents⁶⁷ (emphasis added)

The Conference agreed that the President should in any event have the power to ask the Enlarged Board of Appeal for an opinion in the case referred to in the second sub-section of sub-paragraph (b). On the other hand, there was no agreement on the question whether the President should also be given such a power in the other cases referred to in the first sub-section, which are not covered by the second sub-section.

⁶¹ G 3/08, reasons 7.3.1; Teschemacher, GRUR 1993, 320, 326.

⁶² Schulte-Moufang, 10th Ed., Article 112, marginal no. 10; Benkard-Günzel/Kinkeldey, 3rd Ed., Article 112, marginal no. 6.

⁶³ Singer/Stauder-Bühler, 7th Ed., Article 112, marginal no. 25.

⁶⁴ Singer/Stauder-Bühler, 7th Ed., Article 112, marginal no. 1.

⁶⁵ G 3/08, reasons 7.2.5.

⁶⁶ BR/132e/71 Ior/AV/1b (marginal no. 45); BR/12 e/69 ern/PA/mk (marginal no. 55); cf. Steinbrener, GRUR Int 2008, 713, 714; Beier/Haertel/Schricke-Moser, Europäisches Patentübereinkommen, Münchner Gemeinschaftskommentar, Article 112, marginal nos. 6-10.

⁶⁷ BR/70 e/70 gc (p. 149).

[91] In the light of serious concerns⁶⁸, the first alternative was deleted later on, i.e. the President was precisely not to be given such power in cases not covered by the second sub-section. The Dutch delegation was the only delegation voting in favor of the widely drafted first alternative⁶⁹. The preparatory documents for example mention concerns as regards a “quasi-legislative power” and the intention to bring only specific individual cases to the EBA but no interpretation issues not related to a specific case⁷⁰. This finds reflection in the adopted requirement of pending appeal proceedings in Article 112(1)a) EPC and the requirement of the presence of two different BoA decisions in Article 112(1)b) EPC. The preparatory documents include the following statement⁷¹ (emphasis added)

With regard to paragraph 1(b), the Working Party agreed by a majority that the President of the European Patent Office may only call upon the Enlarged Board of Appeal when two Boards of Appeal have given different decisions on the same question; the more widely drafted first sub-section of this sub-paragraph was therefore deleted. The Netherlands delegation voted against this deletion, as it considered the wider wording more suitable.

A suggestion to completely delete paragraph b) and thus to completely exclude referrals of the President in the presence of two different decisions of Boards of Appeal was also discussed but not adopted⁷².

[92] The legislator thus specifically voted for a limitation of the President’s power in the form of the specific requirement of the existence of a conflicting interpretation of the EPC in two BoA decisions⁷³.

[93] Likewise, referrals not connected with a specific case, as for example questions regarding the interpretation of provisions, were intentionally excluded. The scope of Article 112 EPC has been recognized and the provision was deliberately drafted as it stands. From the above it becomes clear that Article 112 EPC was not erroneously drafted too narrowly. Consequently, there is no unintended legislative gap as regards scenarios not mentioned in Article 112(1)b) EPC because those situations have been discussed and excluded intentionally. This means that the requirements for an application by analogy are not fulfilled alone for this reason and Article 112(1)b) EPC cannot be applied by analogy to settings in which two different Board of Appeal decisions are not available.

⁶⁸ BR/12 e/69 ern/PA/mk (marginal no. 55); BR/26 e/70 kel/PA/mk (marginal no. 36); cf. Steinbrenner, GRUR Int 2008, 713, 714.

⁶⁹ BR/132 e/71 lor/AV/1b (marginal no. 45).

⁷⁰ BR/12 e/69 ern/PA/mk (marginal no. 55); BR/26 e/70 kel/PA/mk (marginal no. 36).

⁷¹ BR/132 e/71 lor/AV/1b (marginal no. 45).

⁷² BR/168 e/72 oyd/KM/prk (marginal no. 137).

⁷³ cf. Steinbrenner, GRUR Int. 2008, 713, 718.

G 3/08 and G 4/98

- [94] Neither G 3/08 nor G 4/98 cited in the Referral in marginal nos. 20 to 23 came to the conclusion that Article 112(1)b) EPC is to be interpreted broadly such that it does not require two Boards having handed down deviating decisions or that Article 112(1)b) EPC could be applied by analogy to settings in which there are no such different decisions available. Instead, both EBA decisions heavily rely on the legal requirement of two different decisions of Boards of Appeal. We refer to G 3/08⁷⁴ and G 4/98⁷⁵.
- [95] This is also reflected in the case law of the Enlarged Board of Appeal that has consistently examined whether there are two incompatible decisions⁷⁶ and likewise in the legal literature leaving no doubt that the requirement of two different decisions of the Boards of Appeal is the decisive requirement specifically and intentionally distinguishing Article 112(1)b) EPC from Article 112(1)a) EPC⁷⁷.
- [96] As briefly mentioned in the Referral in marginal nos. 21 and 23, both decisions have dealt with and interpreted the meaning of “different” narrowly and “Boards of Appeal” broadly, i.e. irrespective of the internal organizational structure. The EBA concluded that it also covers decisions of a Legal Board of Appeal and two decisions of one Board of Appeal in a different composition in view of the object and purpose of Article 112(1)b) EPC. However, the EBA has precisely not adopted an interpretation that does not require two decisions of (Legal) Boards of Appeal or considered an application by analogy⁷⁸.
- [97] Further, it is emphasized in G 4/98⁷⁹ which is also quoted in the Case Law of the Boards of Appeal⁸⁰ and in the legal literature⁸¹ that the deviation from case law in the practice of the EPO whether or not reflected in the Examination Guidelines cannot justify a referral, more specifically⁷⁹ (emphasis added)

⁷⁴ G 3/08, reasons 7.2.5.

⁷⁵ G 4/98, reasons 1.2.

⁷⁶ G 2/98, reasons 1; G 3/04, reasons 1.

⁷⁷ Singer/Stauder-Bühler, 7th Ed., Article 112, marginal no. 25 “Anders als eine Beschwerdekammer kann er [der Präsident des Europäischen Patentamts] dies aber nur, wenn **zwei Beschwerdekammern voneinander abweichende Entscheidungen getroffen haben.**”; Schulte-Moufang, 10th Ed., Article 112, marginal no. 10 and 36 „Diesem Ziel dient insbesondere die Vorlage des Präsidenten, da sie nach Art 112 (1) b) nur möglich ist, wenn 2 Kammern die gleiche Rechtsfrage unterschiedlich entschieden haben.“; cf. Steinbrener, GRUR Int. 2008, 713, 717 „Klar ist, dass ein allgemeines Vorlagerecht des Präsidenten und eine damit verbundene präjudizierende Richtlinienfunktion der Großen Beschwerdekammer verworfen wurde, Artikel 112 Absatz 1)b) EPÜ insofern restriktiv auszulegen ist⁴⁵.“; Teschemacher, GRUR 1993, 320, 321 „Zum anderen sind die Voraussetzungen der Vorlage des Präsidenten strenger: Eine Kammer kann die Große Beschwerdekammer befassen, wenn sie dies zur Sicherung einer einheitlichen Rechtsanwendung, oder wenn sich eine Rechtsfrage von grundsätzlicher Bedeutung stellt, für erforderlich hält. Demgegenüber setzt die Vorlage des Präsidenten stets eine Divergenz voraus, d.h. daß zwei Kammern über die Frage voneinander abweichende Entscheidungen getroffen haben.“; Visser, 2017 Ed., Article 112, marginal no. 3; Benkard-Günzel/Kinkeldey, 3rd Ed., Article 112, marginal no. 6 „Deshalb begründen nur widersprüchliche Entscheidungen ein Vorlagerecht des Präsidenten“.

⁷⁸ G 4/98, reasons 1.2.

⁷⁹ G 4/98, reasons 1.1.

⁸⁰ 8th Ed., July 2016, sect. IV.F.2.4.3.

⁸¹ Schulte-Moufang, 10th Ed., Article 112, marginal no. 36.

A discrepancy between office practice of the EPO and the case law of the Boards of Appeal is not in itself sufficient to justify a referral by the President of the EPO to the Enlarged Board of Appeal, if the practice of the EPO is not warranted by the case law.

The Enlarged Board of Appeal further states⁸²

Given its object and purpose, the right of referral does not extend to allowing the President, for whatever reason, to use an Enlarged Board referral as a means of replacing Board of Appeal rulings on CII patentability with the decision of a putatively higher instance.

This also finds reflection in the legal literature⁸³

Die Vorlagebefugnis des Präsidenten wurde nach dem Willen der Gesetzgeber vielmehr ausdrücklich auf eine konkrete Auslegungsdivergenz in der Rechtsprechung der Beschwerdekammern beschränkt. Eine anderweitig motivierte Vorlage, die sich beispielsweise auf eine andere Rechtsauffassung, politische Erwägungen oder abweichende nationale Rechtsprechung stützt, sollte somit unzulässig sein.

The “analogy-attempt” must fail under Art. 112(1)b) EPC

- [98] The reasoning provided for an application of Article 112(1)b) EPC by analogy in marginal no. 20 in the Referral, in particular that “[i]n a codified legal system such as the EPC the judge [...] may certainly find occasion to fill lacunae in the law, in particular where situations arise for which the legislator has omitted to provide.”, fails to consider that the legislator has explicitly decided to limit the President’s power to the particular requirements laid down in Article 112(1)b) EPC. The latter excludes any application by analogy due to a lack of unintended lacunae in the law. Nothing else can be derived from G 3/08 and G 4/98 which have not been correctly considered in marginal nos. 22 to 24 in the Referral. The Referral implying that the limitation to the specific requirements in Article 112(1)b) EPC was merely based on the legislative intent to avoid that abstract points of law are referred to the EBA also ignores that the presently referred questions actually address such abstract i.e. purely methodical points of law.
- [99] The argumentation in marginal no. 23 that a (narrow) interpretation “unduly restricts” the President’s right of referral again ignores the clear intention of the legislator. It also fails to take into account that the legislator has specifically foreseen Article 112(1)a) EPC with a broad power of a Board of Appeal to refer questions to the Enlarged Board

⁸² G 3/08, reasons 7.2.7.

⁸³ Steinbrener, GRUR Int. 2008, 713, 718.

of Appeal which is open to situations not covered by Article 112(1)b) EPC once there are pending appeal proceedings.

[100] Consequently, the further argumentation in marginal nos. 24 to 30 in the Referral does not add anything. It has no impact on the above result.

[101] Whether Question 2 referred to the EBA is a specific (or abstract) legal question and whether such question concerns a significant number of relevant cases can be left open. As a matter of fact the Referral simply relies on an inconsistency between one Board of Appeal decision T 1063/18 endorsing the reasoning of the EBA decisions G 2/12 and G 2/13 on the one hand and the Office practice based on new Rule 28(2) of the Implementing Regulations on the other hand. Article 112(1)b) EPC can neither be interpreted to cover such situation nor has the legislator unintentionally omitted to regulate such situation as shown above. For the sake of completeness we will nevertheless comment on the further arguments in the Referral and show – in the event the Enlarged Board of Appeal would assume a legal gap – that there are still no comparable interests or a comparable situation so that it is our view that an application by analogy must fail alone for this reason.

No comparable interests and situation, respectively

[102] The Referral in marginal nos. 27 to 30 heavily relies on the allegation of a comparable legal situation and interests, namely that it would be similar to a situation of two contradicting Board of Appeal decisions each with *inter partes* effect making it difficult for the Office to align its practice with both of them. In this context, the reasoning in the Referral states in marginal no. 28 that

There is no legal basis not to apply a provision enacted by the Administrative Council on the basis of a single decision of one Technical Board of Appeal which is only binding in the specific case at issue (Article 111(2) EPC) and in the absence of a decision of the Enlarged Board of Appeal on the conformity of Rule 28(2) EPC with Article 53(b) EPC.

However, new Rule 28(2) of the Implementing Regulations is solely based on a nonbinding preliminary Commission Notice on the Biotechnology Directive⁸⁴ which stands against a Board of Appeal decision on the non-conformity of Rule 28(2) of the Implementing Regulations with Article 53(b) EPC (T 1063/18) and decisions of the EBA on every aspect covered by Rule 28(2). The Board in T 1063/18, based on the comprehensive interpretive work of the EBA, as only decision on Rule 28(2) found that new Rule 28(2) specifically reverses the respective meaning of Article 53b) EPC.

⁸⁴ CA/PL 4/17, marginal nos. 15 and 17; CA/PL 65/17, marginal no. 59.

[103] Likewise, the reference to the competence under Article 33(1)c) EPC ignores that the legislator intentionally and explicitly distinguishes between the power of the Administrative Council to amend Implementing Regulations as lower-ranking rules – further limited by Article 164(2) EPC – and the power to amend the EPC Articles under strict requirements and voting rules limited by the interpretation of the respective international treaty or European Community legislation. An amendment of the Convention by means of an adaption of the Implementing Regulations actually reversing the meaning of an Article as interpreted by the EBA clearly exceeds the legislative competence of the Administrative Council as acknowledged by the former President of the EPO in the proposal for an amendment of the Implementing Regulations⁸⁵ (cf. sect. C further below).

[104] The present setting is not one for which the legislator has foreseen the President's right to refer questions to the EBA, namely in which a uniform application of the law needs to be and can actually be re-established serving the purpose to ensure predictability of jurisdiction and hence legal certainty by preventing arbitrariness⁸⁶.

[105] The present situation is only caused by the changes to the Implementing Regulations which are in conflict with former EBA decisions. Such situations are not those the legislator intended to resolve or have resolved by means of a referral by the President under Article 112(1)b) EPC⁸⁷.

Conclusion

[106] The outcome of T 1063/18 in view of G 2/12 and G 2/13 requires the Administrative Council to delete Rule 28(2) or otherwise the legislator to change Article 53b) EPC or the legislator to delete Article 164(2) EPC, in the event the required majorities support this.

[107] In the meantime, the EBA decisions G 2/12 and G 2/13 have to be applied unless there are reasons for a second referral to reconsider – which is acknowledged in marginal no. 35 in the Referral with reference to T 297/88. T 1063/18 assessed in detail whether there are any reasons for a second referral with the result that there are no such reasons – in particular that the preliminary Commission Notice does not provide such reason.

[108] Consequently, Rule 28(2) of the Implementing Regulations is to be deleted by the Administrative Council – and until its deletion, it must not be applied as a result of the

⁸⁵ CA/PL 4/17, marginal nos. 31, 46 and 54.

⁸⁶ G 3/08, reasons 7.2.2 to 7.2.4; in particular reasons 7.2.2 „Like the judiciary of any democratic entity based on the separation of powers principle, the EPO's Boards of Appeal as an independent judiciary guarantee the due process of law within the Organisation. They are also assigned interpretative supremacy with regard to the EPC in terms of its scope of application (see also Article 23(3) EPC). Under Article 21(1) EPC they are responsible for reviewing decisions taken by the Office in grant and opposition proceedings. Their interpretation of the EPC is the basis for the practice established by the Office for the examination of patent applications and oppositions to granted patents. Otherwise there would be no need for the President's right of referral.”.

⁸⁷ cf. also G 3/08, reasons 7.2.1 and 7.2.2.

de facto binding effect of T 1063/18 as well as G 2/12 and G 2/13⁸⁸. For any other outcome, an amendment of Article 53b) EPC would be required. The latter has in fact been considered by the former President but was set aside as the voting rules and time frame were considered unfavorable for the outcome⁸⁹. We submit that the present development, including the stay of proceedings following the filing of the Referral amounts to a drastic circumvention of the limitations of the Administrative Council's powers and of the exclusive allocation of power regarding any amendment of an Article of the EPC.

[109] Further, we refer to J 1/09 which has emphasized in reasons 16 that⁹⁰

Das Begehren des Beschwerdeführers ist daher letztlich auf eine Korrektur der Gesetzeslage gerichtet, worüber aber ausschließlich der Gesetzgeber und nicht die Beschwerdekammer durch analoge Anwendung der Regel 107(2) EPÜ 1973 zu entscheiden hat.

No second Referral justified

[110] The Referral then turns to the question as to whether a second referral to the EBA would be justified with reference to T 297/88 for further supporting the position that there are comparable interests.

[111] As it would be up to a BoA in pending appeal proceedings to decide on such second referral in accordance with Article 112(1)a) EPC this has no bearing on the admissibility of the present Referral. Nevertheless, we comment on the arguments provided in the Referral further below. In any event, T 1063/18 has in the absence of reasons justifying a second referral not referred questions to the EBA.

[112] Surprisingly, the Referral highlights the particular role and function of the EBA in marginal no. 31 which it has quite obviously ignored in the preceding paragraphs. Namely, it is stated that

The Enlarged Board of Appeal is “the highest judicial authority of the EPO”.²⁹ [...] In the context of referrals by the Boards of Appeal and the President of the EPO under Article 112(1) EPC the Enlarged Board of Appeal has interpretative supremacy with regard to the EPC.³⁰ Its decisions have a de facto binding effect on the Boards of Appeal who may not deviate therefrom.³¹

⁸⁸ cf. G 3/08, reasons 7.2.2; cf. Singer/Stauder, Article 112, marginal no. 33 “ Da jedoch die Beschwerdekammern aufgrund Art 21 VerfOBK verpflichtet sind, die von der Großen Beschwerdekammer vorgegebene Linie nicht ohne erneute Vorlage und ohne eine anderweitige Entscheidung der Großen Beschwerdekammer zu verlassen, ergibt sich auch für die erstinstanzlichen Organe eine faktische Bindung, da die Beschwerdekammern auf eine Beschwerde hin abweichende Entscheidungen aufheben würden. Eine ständige Rechtsprechung der Beschwerdekammern kann die erste Instanz nicht ignorieren”; cf. Benkard, Article 112, marginal no. 17

⁸⁹ CA/PL 4/17, marginal no. 61.

⁹⁰ J 1/09, reasons 16.

and that

The Enlarged Board's status and its specific role and competence are a clear indication of the significance for legal certainty and uniformity that, in those cases foreseen by Article 112(1) EPC, the Enlarged Board of Appeal indeed has the possibility to clarify the point of law at issue or, in the Enlarged Board's own words "to take action".³²

[113] Turning to T 297/88 in marginal no. 35 in the Referral, it is argued that

[...] resubmitting to the Enlarged Board a question already decided by it was in general necessary and appropriate if legal developments which had occurred since the earlier decision let it appear desirable in the public interest to have the issue reassessed by the Enlarged Board of Appeal.³⁵

It is correct that T 297/88⁹¹ suggests three alternative sub-groups of situations in which a reconsideration and thus a second referral might be justified.

[114] Marginal nos. 35 to 42 in the Referral then specifically deal with the third alternative suggested in T 297/88 that requires (i) legal or technical developments that occurred in the interim and (ii) that these developments made it desirable in the public interest to have the question reviewed again by the EBA. More specifically, it is stated in marginal no. 37 in the Referral that

In the specific case at issue it raises fundamental questions of legal interpretation, i.e. the impact of subsequent legal developments on the interpretation of Article 53(b) EPC and the significance of an earlier decision of the Enlarged Board of Appeal on the operation of Article 164(2) EPC.

Neither has the Referral attempted to show that the required legal or technical developments put forward by it contain anything that has effectively not been considered in G 2/12 and G 2/13 nor has it provided any evidence regarding the public interest or points of public interest that have not been considered in the EBA decisions. Further, a second referral has specifically been assessed (and rejected) in T 1063/18.

Preliminary and non-binding Commission Notice no such "further legal development"

[115] The Commission Notice put forward in marginal no. 40 of the Referral is no such "*further development*" that requires reconsideration by the EBA. This follows from its nonbinding and preliminary character – the European Court of Justice is not bound by the interpretation in the Commission Notice, either. This is not only acknowledged by the

⁹¹ 8th Ed., July 2016, sect. IV.F.2.5.1.

former President in his proposal for an amendment to the Implementing Regulations⁹² but also in the Commission Notice itself⁹³. We submit that in case such nonbinding position was qualified as “*further development*” justifying a second referral, this would completely contravene what is precisely intended with the criteria set for a further referral in T 297/88: legal certainty (cf. sect. C further below). The Board of Appeal in T 1063/18 has endorsed this view (“*The Notice therefore has no legal authority*”)⁹⁴.

[116] What is more, the EBA in G 2/12 (and likewise in G 2/13) was already well aware of the positions underlying the Commission Notice. In substance, the Commission Notice relies on a report of a Rapporteur (the “Rothley Report”) of June 25, 1997 and the Parliament’s position paper of May 10, 2012 in which the European Parliament “*Calls on the EPO also to exclude from patenting products derived from conventional breeding and all conventional breeding methods [...]*”⁹⁵ which the EBA had considered.

[117] Consequently, the position papers of the European Parliament on which the Commission Notice is based and the subsequent Council’s statement welcoming the Commission Notice do not qualify as further development either.

[118] Further, we submit that the interpretive basis of the Commission Notice is not sufficiently reasoned.

Wrong “Rothley statements” as basis for the conclusion of the Commission

[119] Firstly, the interpretation provided by the Commission fails to apply the principles for interpretation provided for in Articles 31 and 32 of the Vienna Convention which are to be applied for interpreting the EPC⁹⁶. Rather, it consists of a short statement on some historical background (1 page) and a further page on the wording of the Directive as compared to the extensive reasoning in G 2/12 and G 2/13 which also considered the Biotechnology Directive.

[120] In substance, the Commission Notice relies to a large extent on statements from the 1997 Rothley report and quotes the relevant paragraph from the Report⁹⁷

⁹² CA/PL 4/17, marginal nos. 17, 31 and 36, e.g., in marginal no. 31 “*Under the EU Treaties the CJEU alone is accorded interpretative supremacy for EU law and the EU Commission Notice is without prejudice to the interpretation that could be given to the issues addressed by the CJEU.*”³⁷”.

⁹³ C 411/4 “*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.*”.

⁹⁴ cf. T 1063/18, reasons 29 and 43 “*The view that Rule 28(2) EPC served to ensure consistency between the Biotech Directive and the EPC and with that legal certainty, is based on the presumption that the Biotech Directive has to be interpreted as set out in the Notice. As explained under point 29 above, such a presumption is not valid unless the CJEU has decided on the matter, which it has not. In fact, adopting the interpretation of the Notice in the absence of a decision of the CJEU on the matter, creates a risk of misaligning the provisions of the EPC with the Biotech Directive, should the CJEU later concur with the analysis of the EBA.*”.

⁹⁵ G 2/12, reasons VIII.2.(6)c).

⁹⁶ E.g. G 2/12, section V.

⁹⁷ Report on the proposal for a European Parliament and Council Directive on the legal protection of biotechnological inventions (COM (95)0661 - C4-0063/96 - 95/0350(COD), June 25, 1997 (Rothley Report), sect. B.II.6, p. 38.

Essentially biological procedures', i.e. crossing and selection of the whole genome [...] do not meet the general conditions for patentability, as they are neither inventive nor reproducible. Breeding is a reiterative process, in which a genetically stable end-product with the required characteristics is attained only after much crossing and selection. This process is so strongly marked by the individuality of the initial and intermediate material that an identical result will not be obtained upon its repetition. Patent protection is not appropriate for such procedures and their products.

[121] If this was and is the understanding of the Commission and the Parliament they should certainly reconsider their position because the Rothley statement is wrong. This can be shown in a simple way. The Rothley Report states that “*Essentially biological procedures [...] do not meet the general conditions for patentability, as they are neither inventive nor reproducible*”. This is factually wrong as immediately derivable from the invention underlying the tomato patent in G 2/12. There is not the least doubt that the tomato fruit as claimed in that patent regarding its claimed features could be reproduced and it was further clearly inventive as it was not obvious from any disclosure of the prior art alone or in combination⁹⁸. The invalidity of this fundamental piece of evidence the Parliament and the Commission rely upon therefore strongly questions the substantive argument of the Commission Notice.

Wrong understanding of the “isolation requirement” by the Commission

[122] Further, the Commission in its analysis of the provisions of the Directive relies on the substantive statement that a product obtained by essentially biological processes could definitely not be considered as isolated from its natural environment. This is equally wrong. The isolation requirement refers to the fact that the subject-matter claimed needs to have been provided for use outside of its natural environment if it previously existed in nature. Again the tomato example shows that this Commission argument misses the point. The tomato, only created for industrial use, with its new properties did not previously exist in any natural environment and thus there is nothing from which it could be isolated.

[123] In marginal no. 54 of the Referral, reference is made to the significance of uniform interpretation of harmonized European patent law and the Biotechnology Directive as supplementary means for interpretation pursuant to Rule 26(1) of the Implementing Regulations. It is argued that Rule 28(2) was adopted to align the EPC with the EU Biotechnology Directive. This completely ignores that Rule 28(2) of the Implementing Regulations is exclusively based on the preliminary Commission Notice, rather than on any EU case law or legislature. The further reasoning of the Referral fails to mention that the EBA in its interpretation in G 2/12 and G 2/13 has actually considered the Biotechnology Directive as additional means of interpretation pursuant to Rule 26(1) and even considered a dynamic interpretation.

⁹⁸ cf. Decision of the BoA in T 1242/06 of December 8, 2015.

[124] Likewise, T 1063/18 in its decision has fully considered the fact that the Administrative Council decided to introduce Rule 28(2) as well as the implications thereof.

National law of EPC contracting states already considered in G 2/12 and G 2/13

[125] The Referral further points to the national law of the EPC contracting states which, however, has been considered in G 2/12 and G 2/13, as well⁹⁹. The argument of a number of EPC Contracting States presently considering and having legislative initiatives on the way for excluding the presently concerned products from patent protection in their national law cannot qualify as “*further development*” within the meaning of T 297/88 (cf. sect. C further below). What is more, it does not allow any conclusions as regards the interpretation of the Biotechnology Directive¹⁰⁰. Presently, it seems 8 of 38 EPC Contracting States actually have provisions in the national law excluding the relevant products from patentability¹⁰¹, wherein three of them had those provisions in their national law even before G 2/12 and G 2/13 and were thus considered. There seems to be no basis for the statement made in marginal no. 40 of the Referral that “[...] *all Contracting States consider the products (plants and animals) of essentially biological processes to be excluded from patentability under harmonised European patent law.*”

Summary

[126] In sum, there are no conflicting decisions and there are no relevant “*further developments*” within the meaning of T 279/88 that could justify a further referral – and all this has been assessed and considered in T 1063/18. Additionally, such second referral could only be based on pending appeal proceedings under Article 112(1)a) EPC. Even if one assumed a public interest – on which the reasoning heavily relies in marginal nos. 37 to 39 and 42 but which has not been shown – this could as such not justify such reconsideration because this still requires a “*further development*” which criterion is presently not met.

[127] The final conclusion in marginal no. 43 in the Referral that (emphasis added)

The present situation is thus most closely comparable to the one explicitly foreseen in Article 112(1)(b) EPC. The legislator cannot be presumed to have advertently left out the possibility of a presidential referral in the present scenario, taking into account that under the intended operation of Article 112(1) EPC a situation as the one at stake would have been presumed to give rise either to different Board of Appeal decisions as explicit basis for a presidential referral or to a referral by one of several Boards of Appeal under Article 112(1)(a) EPC.

⁹⁹ G 2/12, reasons VIII.2.c).

¹⁰⁰ Article 288(3) of the Treaty on the Functioning of the European Union.

¹⁰¹ Cf. President’s Referral, marginal nos. 105 *et seq.*

contradicts the actual facts, relies on unfounded speculations and in particular ignores the actual analysis provided in T 1063/18 and the intention of the legislator. And again as emphasized in G 3/08¹⁰²

It is another matter if the Boards themselves see a need to refer points of law to the Enlarged Board in the light of a change in their practice.

III. CONCLUSION

[128] We respectfully submit that the Referral is inadmissible and does not meet the requirements of Article 112(1)b) EPC neither directly nor by analogy. This applies to referred Question 1 and referred Question 2.

C. SUBSTANTIVE CONSIDERATIONS

[129] Effectively, in the section “*Substantive considerations*” the Referral advocates that the Administrative Council could reverse prior decisions of the Enlarged Board of Appeal. It becomes clear that the Referral does not correctly assess the (clarifying) competence of the Administrative Council in relation to the judicative because it ignores the boundaries of Article 164(2) EPC.

[130] In Article 33(1)c) EPC, the Administrative Council is accorded the competence to clarify Articles of the EPC by providing or amending Rules in the Implementing Regulations. At the same time, the Boards of Appeal and ultimately the Enlarged Board of Appeal have the power to interpret the Articles of the EPC. Consequently, there can be a competency conflict between these institutions in interpretation of the Articles of the EPC. The conflict is resolved by Article 164(2) EPC which subordinates the Rules of the Implementing Regulations and thus the Acts of the Administrative Council under Article 33(1)c) EPC in relation to the Articles. Such subordination cannot be overcome by reversing the prior interpretation of the Articles provided by the judicative. Otherwise, the Administrative Council could – as done in the present case – make Article 164(2) EPC ineffective. Therefore, the Referral is wrong, when it suggests the Administrative Council may disregard prior case law and reverse the interpretation of the Enlarged Board of Appeal under Article 33(1)c) EPC.

¹⁰² G 3/08, reasons 7.3.5.

I. LIMITATION OF A RULE BY CASE LAW

[131] The Referral contends in marginal no. 45 that the correct approach to follow under Article 164(2) EPC when examining the conformity of a Rule which implements an Article of the EPC (specifically Article 53 EPC) should be that a *Rule clarifying* the meaning and scope of the Article is not *a priori* limited by earlier case law from the *Boards of Appeal or the Enlarged Board of Appeal*. It cites a number of decisions in support. What is more relate to the case at hand, is the question if a *Rule reversing* the meaning of the Article is not *a priori* limited by earlier case law from the Enlarged Board of Appeal.

Case law confirms competence limiting function of Article 164(2) EPC

[132] The case law brought forward by the Referral does not support its argument.

[133] The case law cited by the Referral in marginal nos. 45 *et seq.* rather, confirms that Article 164(2) EPC limits the Administrative Council's competence to amend the Implementing Regulations in view of prior case law. As regards the analysis of the decisions G 2/07, T 315/03, T 272/95, T 666/05 and T 1213/05 we refer to sect. B.I above and also the additional comments provided further below. These decisions clearly confirm the limitation of the Administrative Council's power by Article 164(2) EPC.

[134] We further submit that the same understanding can be inferred from J 20/84 as well as from G 2/06.

[135] J 20/84 only deals with Rules adopted by the Diplomatic Conference. Therefore, the statement in marginal no. 52 of the Referral that "[...] *the Legal Board of Appeal not only recognised the Administrative Council's power to implement Articles of the EPC, but even implied that a Rule may exclude a legal effect provided for in the EPC on the condition that it was "unambiguous" both in its wording and as regards the recognisable intention of the legislator*" is without merit. Nothing can be inferred from reason 5 of this decision as regards the competency of the Administrative Council. The decision deals with Rules set by the Diplomatic Conference.

[136] In G 2/06 the EBA found Rule 23d EPC1973 well within the scope of Article 53a) EPC (cf. reasons 13, 31 and 32). The decision thus does not teach anything as regards the Administrative Council's power to reverse prior interpretation of an Article provided by case law of the EBA.

The Referral ignores the competence limiting function of Article 164(2) EPC

[137] Nevertheless, the Referral in marginal nos. 53 to 55 takes the position that under Article 164(2) EPC the Administrative Council's power was not limited by an interpretation in

an earlier decision of the EBA. Article 164(2) EPC did not provide a basis to examine the compatibility of a Rule of the Implementing Regulations with earlier case law. This allegedly followed from the wording of Article 164(2) EPC which “[...] refers to *“provisions of this Convention”* but not to an earlier interpretation by case law”. The Referral thus attempts to distinguish between a provision and its interpretation.

[138] The position taken by the Referral amounts to ignoring the competence limiting function of Article 164(2) EPC. Reference is made to sect. B.I above. In addition, contrasting *“provisions of the EPC”* with *“interpretation by case law”* and contrasting *“law”* with *“case law”* ignores the legal function of interpretation under the accepted methodical principles and under the Vienna Convention.

[139] Reversing the interpretation of an originally contradicting Article *a posteriori* by means of a newly introduced Rule would deprive Article 164(2) EPC from any legal effect as any conflict would always be resolved by reinterpreting the Article in the light of an amended or new Rule. It is the interpretation under the principles of the Vienna Convention that safeguards the proper application of Article 164(2) EPC and that sets the boundaries for any clarification attempted by the Administrative Council.

[140] The Referral attempts to circumvent these boundaries by limiting the application of Article 164(2) EPC to *“extreme and obvious cases”* of contradiction. There is no basis for this limitation in the EPC as shown below.

[141] Under the rule of law, it cannot be the Administrative Council itself that decides whether the limitations of Article 164(2) EPC are violated by a specific Rule, and if so, reverses the interpretation of the respective Article to avoid such violation.

II. ARTICLE 164(2) EPC AND COMPETENCE OF THE ENLARGED BOARD OF APPEAL

[142] The Referral does accept the interpretive supremacy of the EBA but it ignores the legal consequences thereof. It nevertheless attempts to justify for the Administrative Council to reverse the case law interpretation of Article 53b) EPC as provided by the Enlarged Board of Appeal. However, a right to reverse the EBA case law interpretation of an Article in such way would extend the legislative power of the Administrative Council without basis in the EPC and severely weaken the judiciary’s interpretative supremacy.

[143] Rather, Article 33 EPC (supplemented by Article 35 EPC) limits the legislative power of the Administrative Council to amend the Implementing Regulations. This empowerment of the Administrative Council includes clarification of the Articles but Article 164(2) EPC introduces judicative control over these legislative acts. Therefore, the Referral does not correctly assess the competence of the Administrative Council.

In detail:

Article 164(2) EPC part of fundamental and overarching provisions

- [144] The Referral, based on systematic context, in marginal no. 56 attempts to limit the effect of Article 164(2) EPC. It argues that Article 164(2) EPC is a provision of Part XII of the European Patent Convention that does not concern the relation between *interpretation in case law* and the *legislative implementation* of an Article of the EPC by the Administrative Council but rather concerns the relation between Articles adopted by the Diplomatic Conference and Implementing Regulations adopted by the Administrative Council.
- [145] This ignores that Part XII contains the “FINAL PROVISIONS” which includes the very fundamental and overarching provisions that affect the EPC in its totality like Article 172 EPC that stipulates who has the competence to revise the EPC. It is impossible to detach Article 164(2) EPC from *interpretation in case law*. Excluding interpretation correctly and extensively provided under the Vienna Convention principles from the assessment of the relation between Articles adopted by the Diplomatic Conference and Implementing Regulations adopted by the Administrative Council would result in leaving it to the Administrative Council to judge its own violation of Article 164(2) EPC. This contradicts the principles of the rule of law.

Statement from the Benkard commentary without merit

- [146] In the same marginal no. in footnote 55, the Referral again relies on the alleged scholarly statement from the Benkard commentary also cited in its footnote 15. As set out in sect. B.I above, the commentary position of a single attorney (not scholar) is without merit. Without any support, the position effectively suggests that where a Rule contradicts an Article as interpreted by the EBA such interpretation could simply be cancelled out by a contradicting Rule thus resolving the conflict. In other words the Rule would have an overriding effect on the Article which is exactly the opposite of the intention of Article 164(2) EPC.

Judicative must be able to control acts of the Administrative Council for Article 164(2) EPC to be effective

- [147] The Referral reasons in marginal no. 57 that the EBA is not a constitutional court and its decisions only have *de facto* binding effect and not the force of law. Whether the EBA is a constitutional court and what extent of guidance the EBA decisions should have can be left open here as in any event the judicative must be able to control the

acts of the Administrative Council in relation to the Articles of the EPC for Article 164(2) EPC to be effective. It would be wrong to allow the Administrative Council to reverse the interpretation of the EBA without any of the developments addressed in Article 33(1)b EPC and outside of the limitations of Article 33(5) EPC, i.e. based only on a non-binding notice of the EU Commission. Articles 33 and 164(2) EPC limit the competence of the Administrative Council and subordinate the Rules in relation to the Articles. Whether qualified as constitutional function or not, the rule of law requires that Article 164(2) EPC is properly applied and any violation is controlled by the judiciary.

[148] Fundamentally, the EPC legislator has decided that it requires a three-quarter vote of the Contracting States in a revision conference to change the EPC (Article 172 EPC) and that the Administrative Council's legislative competence is limited by Articles 33, 35 and 164(2) EPC. If such limitation could simply be circumvented by the Administrative Council aligning the interpretation of the Article in question with the contradicting Rule to result in the opposite of what the judiciary interpretation has come out with, as in the case of Article 53b) EPC and Rule 28(2), this would effectively provide the Administrative Council with the overriding competence of interpreting the EPC even in cases of conflict. This leaves no room for Article 164(2) EPC and again: then the addressee that Article 164(2) intends to control, would control itself. In fact, as the EPC foresees no distinct constitutional court the EPC would lack a fundamental judiciary function if the Enlarged Board of Appeal would not have an overriding competence in relation to the interpretation of the Articles of the EPC *vis-à-vis* the Administrative Council.

[149] Therefore, should the Referral suggest that it is up to the Administrative Council itself to identify the content of the "*Provisions of the EPC*" as contrasted to "*interpretation by case law*", this would ignore that under the rule of law the competence of interpretation by the Administrative Council is confined, in the hierarchy of provisions, to the level of its legislative power. This is explained in J 16/96 and reflected in Articles 33, 164(2) EPC and anything else would ignore that Articles 21 to 23 EPC accord the interpretive supremacy to the Enlarged Board of Appeal.

[150] J 16/96 explicitly dealt with the extent of authorization of the Administrative Council to provide interpretation under the EPC. It found that in the law of international organizations¹⁰³

[...] it is a recognised principle that bodies competent to lay down internal law may claim a corresponding degree of competence to interpret that law (see Seidl-Hohenveldern, Das Recht der Internationalen Organisationen (...), 5th ed., p. 233, No.1614).

¹⁰³ J 16/96, reasons 2.1.

- [151] As mentioned, the Referral in fact confirms that the EBA “*beyond any doubt*” under Articles 21 to 23 EPC has interpretative supremacy and that “[i]n general, the interpretation of legal terms lies within the competence of the Boards of Appeal because of their judicial function [...]” (marginal nos. 58 and 59).
- [152] The result of this interpretative supremacy is that the judicative, i.e. the existing case law *a priori* limits the Administrative Council in its legislative acts of a clarification of Articles unless the very specific conditions of Article 33(1)b) complemented by Article 33(5) EPC apply (alignment with International or EC Regulations after their entry into force). The case law of the Boards thus provides the basis to decide whether the limitation under Article 164(2) EPC has been violated by the Administrative Council, as correctly concluded in T 1063/18.
- [153] The Referral in marginal no. 58 further states that Article 164(2) EPC does not provide the basis for disregarding a Rule correctly enacted by the Administrative Council. This is correct but the term “*correctly enacted*” as confirmed in T 315/03 and T 991/04 includes “*without violation of Art. 164(2) EPC*”. Thus, whether a Rule is in fact correctly enacted, needs to be decided on the basis of the case law interpretation of the respective Article, as done by T 1063/18.
- [154] Nevertheless, the Referral seems to suggest that T 1063/18 has disregarded an allegedly correctly enacted Rule 28(2) of the Implementing Regulations on the basis that it deviated from an earlier interpretation in case law. However, (i) Rule 28(2) of the Implementing Regulations is in conflict with Articles 52(1) and 53 EPC as understood by the EBA and is thus precisely a Rule that has not been correctly enacted; (ii) T1063/18 has considered all factual developments, including those subsequent to the EBA decision, and (iii) G 2/12 and G 2/13 have additional weight by virtue of their comprehensive and complete interpretation and by virtue of the legal function of the EBA.
- [155] When examining whether a Rule has been correctly enacted under Article 164(2) EPC, the deciding Board must identify the content of the respective Article under the principles of the Vienna Convention. This includes consideration of all competent sources of interpretation and this has precisely been done in G 2/12 and G 2/13. The Implementing Regulations can only be considered within the boundaries of Article 164(2) EPC.
- [156] As already emphasized in sect. B.I above, T 1063/18 followed exactly this logic and came to the conclusion that Rule 28(2) of the Implementing Regulations was not correctly enacted in view of Articles 52(1) and 53b) EPC and their methodically correct interpretation in G 2/12 and G 2/13. This was based on the Board’s assessment as to whether a deviation from this earlier case law was justified under any subsequent development. The Board in T 1063/18 correctly found that the Administrative Council

was *a priori* limited by this interpretation of Articles 52 and 53 EPC after considering all *a posteriori* facts and developments and finding them insignificant.

[157] To the extent the Boards of Appeal are bound by the Implementing Regulations as part of the EPC, as the Referral points out in marginal no. 59 citing T 991/04, Article 164(2) EPC makes an exception from this Rule. Accordingly, T 991/04 confirms that Article 164(2) EPC limits the effect of the Implementing Regulations and it thus confirms the outcome of T 1063/18¹⁰⁴

The framework set by the Convention means that, if any provision of the Implementing Regulations violates a procedural principle laid down in the Convention itself, such a provision has to be disregarded by the Board of Appeal according to Article 164(2) EPC [...].

[158] The same is confirmed in T 315/03 further quoted by the Referral, since also in T 315/03 the conclusions explicitly hinge on Article 164(2) EPC and the requirement for “*correctly enacted legislation*”. “*Correctly enacted*” certainly includes that the resulting Rule is not in conflict with the EPC or even reverses the interpretation of an Article as provided by the EBA. If this is not the case¹⁰⁵

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.

[159] Thus, it cannot be the Rules that correct the Articles to justify themselves under Article 164(2) EPC, or the Administrative Council that provides the basis for the decision whether it has violated Article 164(2) EPC.

III. CONTRADICTION BETWEEN RULE 28(2) AND ARTICLE 52(1) EPC (MUTUALLY EXCLUSIVE IN THEIR LEGAL CONSEQUENCES)

[160] While the Referral never explains on which basis other than based on methodically correct case law interpretation a conflict under Article 164(2) EPC should be determined (other than in the case of Article 33b) EPC) it seems to additionally want to limit such conflicts to “*extreme and obvious cases*” in marginal no. 61: “*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.*” This still leaves open who would identify such extreme and obvious cases. What is more, there is no basis for such limitation of Article 164(2) EPC to extreme and obvious cases in the EPC.

¹⁰⁴ T 991/04, reasons 6.

¹⁰⁵ T 315/03, reasons 5.8.

[161] The allegedly supportive case law cited by the Referral in marginal no. 61, namely G 2/95, only states that if a Rule (Rule 88) was construed to an extent where the Rule and the respective Article (Article 123(2) EPC) would have mutually exclusive consequences then this would violate Article 164(2) EPC. Nothing in the decision, however, states that Article 164(2) EPC would be limited to extreme and obvious cases of conflict.

[162] What the Referral has completely overlooked, is that the legal consequences of Article 52(1) EPC and Rule 28(2) of the Implementing Regulations are in fact mutually exclusive so that this would effectively even constitute an extreme and obvious case under the approach of the Referral.

Article 52(1) EPC provides for general patentability

[163] Article 52(1) EPC provides that patents shall be granted in all fields of technology (cf. G 2/12 and G 2/13)¹⁰⁶. More specifically, it provides for European patents to be granted for any inventions, in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial application. Rule 28(2) is in conflict with this Article of the EPC and Article 53b) EPC does not provide for a clear exclusion of plants and animals derived from essentially biological processes. The EBA has emphasized in G 2/12 that¹⁰⁶

Article 52(1) EPC expresses the fundamental principle of a general entitlement to patent protection for any invention in all technical fields (see G 5/83, supra, 66, Reasons, point 21 et seq.; G 1/98, supra, 135, Reasons, point 3.9; G 1/03, supra, 435, Reasons, point 2.2.2; G 1/04, supra, 350, Reasons, point 6; T 154/04 (OJ EPO 2008, 46, 62, Reasons, point 6).

[164] The EBA in G 2/07 has thoroughly reasoned that this extends to plants and animals¹⁰⁷

For biotechnological inventions this is now explicitly enshrined in the EPC and in the Biotech Directive. Biotechnological inventions are inventions relating to biological material, Rule 26(2) EPC. Plants are biological material within the meaning of Rule 26(3) EPC. Plants and their parts are a material substrate which can be processed by man to achieve a desired result by using natural forces, i.e. by systematically using the biological mechanisms underlying the process steps suggested in the claim. The enormous progress in knowledge in this field has brought about processes which can be controlled by man in a manner sufficient to make them reproducible.

¹⁰⁶ G 2/12 and G 2/12, reasons VII.2.(3)b).

¹⁰⁷ G 2/07, reasons 6.4.2.1.

[165] Rule 28(2) of the Implementing Regulations explicitly excludes certain plants and animals. This is in contradiction with Article 52(1) EPC, Rule 27 and with the Biotechnology Directive, which explicitly allow such matter. The legal consequences of Rule 28(2) of the Implementing Regulations are thus mutually exclusive with the explicit legal consequences of Article 52(1) EPC unless Article 53b) EPC clearly excluded such products. Since the exclusion of Rule 28(2), however, has no clear basis in Article 53b) EPC it provides an obvious and extreme case of contradiction with Article 52(1) EPC.

[166] G 2/12 and G 2/13 require a clear legal basis in the EPC for any limitation of the entitlement to patent protection. The EBA explicitly states that¹⁰⁸

Any limitation to the general entitlement to patent protection is thus not a matter of administrative or judicial discretion, but must have a clear legal basis in the European Patent Convention.

[167] In the present case, clear legal basis for exclusion is found in Article 53b) EPC only for “essentially biological processes”. Undisputedly, Article 53b) EPC does not contain any specific language as to equally exclude the products of such methods. Therefore, even when limiting the application of Article 164(2) EPC to extreme and obvious cases, as the Referral promotes, it becomes immediately clear that Article 53b) EPC cannot resolve the obvious conflict between Article 52(1) EPC and Rule 28(2).

[168] As shown in G 2/12 and G 2/13 the correct approach, i.e. interpretation of Article 53b) EPC under the principles of the Vienna Convention, confirms that Article 53b) EPC contains no immediate language and cannot be further interpreted to exclude from the general patentability principle of Article 52(1) EPC and Rule 27 products derived from essentially biological processes.

[169] Therefore, not even “Article 53b) EPC itself”, ignoring prior case law interpretation, as the Referral would like to have it, could change the outcome under Article 164(2) EPC that there is an extreme and obvious conflict between Article 52(1) EPC and Rule 28(2) of the Implementing Regulations. Article 52(1) EPC provides for patentability of plants and animals while Article 53b) EPC only excludes plant varieties and animal races as well as certain processes from this principle. Consequently, under any approach, Rule 28(2) of the Implementing Regulations violates the EPC and, under Article 164(2) EPC, must be disregarded.

G 2/07 and T 39/93

[170] The Referral in marginal no. 66 contends that in decision G 2/07 the Enlarged Board, with regard to Rule 26(5) of the Implementing Regulations, stated that an Article had to be interpreted in the light of a Rule of the Implementing Regulations as long as the latter

¹⁰⁸ G 2/12 and G 2/12, reasons VII.2.(3)b).

was clear enough. As put forward in detail above, this again includes as a condition that the respective Rule does not violate Article 164(2) EPC. And as already shown in sect. B.I above, what the Referral does not mention, is that the EBA in G 2/07 did not see any conflict under Article 164(2) EPC for the reason that it found that Rule 26(5) of the Implementing Regulations was not clear enough from the start. It could simply not be taken into account when interpreting Article 53b) EPC¹⁰⁹.

[171] Consequently, the Referral is wrong in marginal no. 64 when it suggests that the EBA in G 2/07 (reasons 2.4) did not endorse the principle *that the interpretation of an Article adopted by the Boards of Appeal prior to the introduction of a new Rule would reflect the true meaning of that Article, and that the Rule if impossible to reconcile with the previous interpretation of that Article, was in conflict with the Article* - as also supported by T 39/93.

[172] T 39/93 is in close alignment with Article 164(2) EPC when it states in reasons 3.2 that

[...] the meaning of an Article of the EPC [...], on its true interpretation as established by a ruling of the Enlarged Board of Appeal cannot [...] be overturned by a newly drafted Rule of the Implementing Regulations, the effect of which is to conflict with this interpretation. This is because, according to Article 164(2) EPC, in the case of conflict between the provisions of this Convention (the EPC Article) and those of the Implementing Regulations, the provisions of this Convention shall prevail.

This point was not “*explicitly discarded by the Enlarged Board of Appeal in decision G 2/07*”, as the Referral alleges in marginal no. 64, either. Rather, in no contradiction with T 39/93, the EBA had to ignore Rule 26(5) for other reasons, as explained above.

J 16/96

[173] Finally, the Referral contends in marginal no. 68 that in decision J 16/96 the Legal Board of Appeal confirmed that in the examination under Article 164(2) EPC the Boards of Appeal have to consider all elements relevant to interpretation, including *a fortiori* an amendment of the Implementing Regulations by the Administrative Council. J 16/96 does not help here because it only refers to the interpretation of a Rule and not of an Article when it requires consideration of a subsequent Administrative Council’s interpretation of a Rule¹¹⁰.

Here, the Administrative Council’s decision regarding the interpretation of Rule 101(9) EPC has essentially the same significance as a subsequent agreement, under the Vienna Convention on the Law of Treaties, between the parties regarding

¹⁰⁹ G 2/07, reasons 5.

¹¹⁰ J 16/96, reasons 3.2.

the interpretation of the treaty or the application of its provisions (Article 31(3)(a) of the Vienna Convention).

- [174] Again, to the extent the Rule is to be considered under the EPC when interpreting an Article this is limited by Article 164(2) EPC and requires that the Rule was correctly enacted and does not violate Article 164(2) EPC. T 1063/18 in fact did explicitly consider Rule 28(2) of the Implementing Regulations and the further facts in its analysis regarding the conflict of an exclusion of plants derived from essentially biological processes with Articles of the EPC, albeit not with the outcome the Referral promotes.
- [175] In J 16/96 the Board concluded that the Administrative Council had acted within the scope of its authority by providing an interpretation of a Rule. In the present case the Administrative Council has exceeded the scope of its authority in amending the Implementing Regulations in contradiction with the EPC by reversing an Article. In consequence, J 16/96 if anything supports the finding that the Administrative Council is limited in its legislative and interpretative power

IV. NO CONFORMITY OF RULE 28(2) WITH ARTICLES 52 AND 53B) EPC

- [176] In sect. B.II the Referral takes the position that Rule 28(2) of the Implementing Regulations is in conformity with Article 53b) EPC because Article 53b) EPC does not preclude its application to the subject-matter defined in Rule 28(2). The Referral confirms that decisions G 2/12 and G 2/13 interpreted Article 53b) EPC in respect of, primarily, its wording and, secondarily, considered also the legislator's intention and the aspects of systematic and historical interpretation in accordance with the principles provided for in Articles 31 and 32 of the Vienna Convention. It then argues that on this basis the EBA did not conclude or even imply that Article 53b) EPC itself explicitly acknowledges the patentability of plants (or plant material such as a fruit) exclusively generated by an essentially biological process and that the EBA did not consider Article 53b) EPC to be sufficiently obvious, to provide explicit support or a solid basis to extend the process exclusion also to the products obtained by such processes. The Referral then draws the conclusion that (i) Article 53b) EPC itself does not explicitly allow(!) the patentability of plants (or animals) exclusively obtained by essentially biological processes, (ii) Article 53b) EPC leaves room for its further clarification by means of Implementing Regulations to the EPC and, (iii) the other means of interpretation do not provide a clear result.
- [177] The Referral in terms of allowability of subject matter confuses the systematic function of Article 53b) with the systematic function Article 52(1) EPC. It is not the systematic function of Article 53b) EPC to allow anything. It is Article 52(1) EPC that allows the patentability of the mentioned plants, as explained above. The approach is thus flawed and the conclusions of the Referral suffer a fundamental error. When the Referral states

that the applied means of interpretation did not provide a clear result as regards Article 53b) EPC then this without doubt means that Article 52(1) EPC providing for patentability of plants and animals must prevail in lack of a clear exclusion.

[178] The Referral thus does not perform the correct analysis when it exclusively considers whether Rule 28(2) of the Implementing Regulations is in conformity with Article 53b) EPC. It ignores that the actual violation under Article 164(2) EPC is the conflict with Article 52(1) EPC.

[179] The Referral in fact confirms that the EBA by reference to Rule 27 EPC considered that Article 53b) EPC was to be interpreted on account of a “*rather wide notion of the patentability of biotechnological inventions concerning plant-related processes and products other than plant varieties*”. Rule 27, however, is precisely the Implementing Regulation supplementing Article 52(1) EPC.

[180] As set out above, under Article 164(2) EPC there is a (even “*extreme and obvious*”) conflict between Article 52(1) EPC and Rule 28(2). Article 53 EPC does not change this and only excludes plant varieties and animal races as well as certain methods from this principle. Consequently, Rule 28(2) of the Implementing Regulations violates Article 52 (1) EPC and, under Article 164(2) EPC, must be disregarded.

Legislative intent

[181] In marginal no. 77 the Referral promotes that the EBA should re-interpret Article 53b) EPC in the light of an alleged clarified legislative intent. The Administrative Council, however, confuses (objective) legislative intent with a present intent of the Commission and of the Administrative Council. Any legislative intent that can be provided by the Administrative Council is limited by Article 164(2) EPC.

[182] The Referral also points to the EPC legislator’s intention to align the EPC with the EU Biotechnology Directive.

[183] In doing this, the Referral in marginal no. 79 again limits itself to an analysis of Article 53b) EPC and attempts to rely on the fact that the EBA concluded that the *ratio legis* behind the patentability exclusion for essentially biological processes for the production of plants or animals was “*not sufficiently obvious*” and that the *travaux préparatoires* did not provide a clear result either.”, which, however, only supports the understanding that Art. 52(1) EPC allows patentability of such plants or animals and Art. 53b) EPC is not sufficiently clear to then exclude such subject matter.

[184] The Referral correctly explains in marginal nos. 78 and 79 the EPC legislator’s intent to ensure the uniformity of harmonized European patent law and to fully align the European Patent Convention with the EU Biotechnology Directive. In marginal nos. 80 to 84 the Referral refers to the intended alignment of the EPC to the EU Biotechnology

Directive and states that all Contracting States to the EPC indicated their clear will and intention that when considering whether or not a European patent should be granted, the relevant provisions of the European Patent Convention be interpreted in the same manner as the corresponding provisions of the EU Biotechnology Directive.

[185] On this background the Referral contends the EU legislator's intent to exclude plants of essentially biological processes from patentability thereby relying on the Commission Notice in conjunction with the resolutions of the European Parliament and conclusions of the Council of Ministers.

[186] First of all, the three mentioned institutions do not represent the objective legislative intent. Rather, the notion of the legislative intent is a fiction as identifiably by certain methodical steps and is not the present opinion of any institution (irrespective of its previous involvement in legislative acts).

Commission Notice relies on an incorrect factual basis

[187] Further, even if the opinion of the Commission, the Council and the Parliament was to be given weight, as requested by the Referral, the points brought forward in the Commission Notice as regards the exclusion of plants and animals from patenting rely on an incorrect factual basis.

[188] The short interpretation of the Commission in its Notice fails to apply the principles for interpretation provided for in Articles 31 and 32 of the Vienna Convention, as explained in sect. B.II above, and it relies to a large extent on statements from the 1997 Rothley Report which are verifiably wrong¹¹¹ – we have shown this in detail in sect. B.II above with reference to the invention underlying the tomato patent in G 2/12.

[189] Where the Rothley Report states that "*Essentially biological procedures do not meet the general conditions for patentability, as they are neither inventive nor reproducible*", there is no doubt that the tomato fruit as claimed in the respective patent could be reproduced and was not obvious, i.e. inventive as decided by the Board in its decision of December 8, 2015¹¹². This practical outcome in the case at hand shows that much less can there be a principle non-reproducibility and non-inventiveness as promoted by Mr. Rothley. This fundamental lack of, or at least outdated understanding of some aspects of Patent law in the Rothley Report strongly questions the substantive argument of the Commission Notice.

[190] Likewise, the assumption of the Commission that a product obtained by essentially biological processes could "definitely" not be considered as isolated from its natural environment must fail – the tomato with its new properties did not previously exist in nature and thus it is not clear from what it should be isolated (cf. sect. B.II above).

¹¹¹ Report on the proposal for a European Parliament and Council Directive on the legal protection of biotechnological inventions (COM (95)0661 - C4-0063/96 - 95/0350(COD)), June 25, 1997 (Rothley Report), sect. B.II.6, p. 38.

¹¹² T 1242/06.

[191] Last but not least, the Parliament seems to have misread or misunderstood Article 4 of the Biotechnology Directive when it alleged in its resolution of December 17, 2015¹¹³ that¹¹⁴ (emphasis added)

[...] Article 4 [...] states that products obtained from essentially biological processes shall not be patentable.

[192] In truth Article 4 states: *The following shall not be patentable: (a) plant and animal varieties;(b) essentially biological processes for the production of plants or animals.*

[193] Again, this cannot be sufficient basis for any legislative intent.

Alleged legislative intent of the EU legislator

[194] The Referral in marginal no. 93 simply alleges a legislative intent of the EU legislator that the products (plants and animals) exclusively obtained by essentially biological processes shall not be patentable. No methodically sound reasons are provided. All historical aspects have already been dealt with in G 2/12 and G 2/13. Equally, the statement that the decisions G 2/12 and G 2/13 did not refer to the *travaux préparatoires* is wrong and in marginal no. 97 the Referral actually states the opposite, i.e. that in decisions G 2/12 and G 2/13 the Enlarged Board ultimately tried to establish the legislator's intent based on the *travaux préparatoires*. The Referral does not rely on the *travaux préparatoires* itself and leaves open what specifically the *travaux* would add to the issue.

[195] In marginal nos. 96 and 97 the Referral contends that the ordinary meaning, context, object and purpose of Article 53b) EPC were not sufficiently clear and this would call for more weight of the legislator's intent which allegedly was to exclude from patentability also the products (plants and animals) of essentially biological processes. Again, no basis for the alleged legislator's intent is provided. Should the Referral have had the Rothley Report, or the misunderstanding of Article 4 of the Biotechnology Directive by the Parliament in its resolution of 2015, or the misunderstanding of the concept of "*isolated from its environment*" by the Commission in its Notice in mind, we refer to our statements above and in sect. B.II which completely disqualify all of these approaches.

Subsequent agreement and practice between the EPC Contracting States

[196] The Referral in marginal nos. 100 *et seq.* points to a "*subsequent agreement and practice between the EPC Contracting States*" as an aspect to be considered when interpreting Article 53b) EPC. The Referral argues that consideration of the national

¹¹³ P8_TA(2015)0473, Patents and plant breeders' rights, European Parliament resolution of 17 December 2015 on patents and plant breeders' rights (2015/2981(RSP)).

¹¹⁴ Cf. p. 1, second bullet point.

laws of the EPC Contracting States further support that Rule 28(2) of the Implementing Regulations is in conformity with Article 53b) EPC.

[197] Neither do the considerations given in the preceding sections in the Referral support this view nor does a factual consideration of the national law of the EPC Contracting States support the above conclusion.

[198] The aspect of harmonization of European patent law has been put forward in G 1/83 and G 5/83 as aspect of interpretation to be considered when interpreting the EPC – which has since then only rarely been consulted¹¹⁵. It has been raised in these decisions as an aspect *“particularly important where, as is the case with European patent law, provisions of an international treaty have been taken over into national legislation”*¹¹⁶. It is based on the fact that despite the autonomous legal character of the EPC as a legal system coexisting with the national patent law of the individual EPC Contracting States, many provisions in the national law have been adopted from the EPC. It serves to avoid that the development of the law is different in the absence of a supranational court which preserves the unity of the law¹¹⁷.

[199] The Referral’s argument, however, remains limited to the fact that there are solutions in the national law of a number of EPC Contracting States which differ from the solution taken in the EPC, namely the meaning of Article 53b) EPC as interpreted by the EBA. The latter is raised in order to allege a common position of all EPC Contracting States which is then according to the Referral to be considered when interpreting Article 53b) EPC.

[200] However, only 8 of 38 EPC Contracting States actually exclude plants obtained by essentially biological processes from patent protection in their national law as in force (see below). Consistently, there can be no *“fully aligned”* situation in the national law of the EPC Contracting States. This forms no basis for reversing an interpretation that has been obtained after carefully considering the means of interpretation pursuant to Articles 31 and 32 of the Vienna Convention. Likewise, the EBA in G 2/12 emphasized in response to the various ethical, social and economic aspects raised¹¹⁸

It has to be borne in mind that the role of the Enlarged Board of Appeal is to interpret the EPC using generally accepted principles of interpretation of international treaties. It is not mandated to engage in legislative policy.

¹¹⁵ Schachenmann, GRUR Int. 2008, 702, 706.

¹¹⁶ G 5/83, reasons 6 and G 1/83, reasons 6; cf. also G G 3/98, reasons 2.6; e.g. G 5/83, reasons 6: *“In the interpretation of international treaties which provide the legal basis for the rights and duties of individuals and corporate bodies it is, of course, necessary to pay attention to questions of harmonisation of national and international rules of law. This aspect of interpretation, not dealt with by the provisions of the Vienna Convention, is particularly important where, as is the case with European patent law, provisions of an international treaty have been taken over into national legislation. The establishment of harmonised patent legislation in the Contracting States must necessarily be accompanied by harmonised interpretation. For this reason, it is incumbent upon the European Patent Office, and particularly its Boards of Appeal, to take into consideration the decisions and expressions of opinion of courts and industrial property offices in the Contracting States.”*

¹¹⁷ Benkard, Grundsätze zur Auslegung des EPÜ, marginal nos. 9 and 11.

¹¹⁸ G 2/12, reasons VIII.2.c).

[201] Should the legislative policy lead to an amendment of Article 53b) EPC then this is the way foreseen by the EPC for implementing such policy. Otherwise, Article 52(1) EPC clearly allows for patentability of what is not excluded and Article 53b) EPC by recognized interpretation under the Vienna Convention principles does not exclude plants and animals as products from essentially biological processes.

[202] Considering national law when interpreting the EPC, such consideration of national law can by no means be used for actually reversing the meaning of a provision in the autonomous EPC¹¹⁹ and, additionally, there seems to be no consensus as regards the exclusion of the relevant products in the national law of the EPC Contracting States.

Continued legal inconsistencies across the EPC member states

[203] Specifically, the Referral in marginal no. 102 acknowledges that there are legal inconsistencies across the EPC member states. Marginal no. 103 then states

However, since the European Commission Notice was published in November 2016, all 38 Contracting States of the European Patent Convention have indicated and declared that under their national law and practice the products (plants and animals) of essentially biological processes are excluded from patentability.

[204] While there is no evidence provided for support of this allegation, it seems in marginal nos. 104 and 105 that the Referral intends to base this general statement on the EU Council's conclusion of March 1, 2017 and on the Administrative Council's implementation of new Rule 28(2). Marginal nos. 106 *et seq.* do not support such statement in any case.

[205] However, it cannot be derived from the EU Council's conclusion that "*The 28 EPC Contracting States which are members of the EU have declared their national law and practice to be in line with the interpretation of Article 4(1)(b) of the EU Biotechnology Directive set forth in the European Commission Notice*", as the Referral states. There is no such statement in the conclusion.

[206] The Referral in marginal no. 105 then argues that the 10 EPC Contracting States which were not members of the EU had indicated that under their national law and practice plants and animals obtained by essentially biological breeding processes were not patentable and all of these 10 Contracting States had voted in favour of the introduction of Rule 28(2) EPC in June 2017, as well.

¹¹⁹ cf. for example J 9/07, reasons 18.

[207] While no evidence is provided for this statement, the reference to voting results of the Administrative Council when implementing Rule 28(2) cannot be used to circumvent Article 164(2) EPC, i.e. the allocation of power to change an Article of the EPC¹²⁰. In any event Implementing Regulations cannot replace the three-quarter vote requirement in a Diplomatic Conference which would be necessary for a change of an Article if there was a respective political will for such change.

J 9/07

[208] Further, decision J 9/07, cited in this context in the Referral, specifically emphasizes in reasons 20 that “[a]lthough in general a high degree of harmonization between the EPC and national laws is desirable and has indeed been achieved, differences between national legislation and the EPC are not excluded by Article 2(2) or Article 66 EPC 1973 in this regard”.

[209] More specifically, it is emphasized in J 9/07 that neither Article 2(2) EPC nor Article 66 EPC can lend support for disregarding a provision in the EPC concerning the grant procedure. These Articles¹²¹ “[...] relate to the effects of either a European patent or a European patent application in the national legal system, with the intention that, as regards these effects, a certain degree of harmonization can be reached unless the EPC permits certain specific national provisions to be taken into consideration”.

[210] Accordingly, the reference in the Referral to Article 2(2) EPC and likewise to Article 64(3) EPC does not lead anywhere and likewise the reference to Article 138 EPC. These provisions do not concern the conditions for the grant of a European Patent but its effects in each Contracting State for which it is granted or the conditions applicable to granted EP patents in the Contracting States, unless the Convention provides otherwise¹²². Neither can a specific national provision be applied in the grant proceedings that is more favorable for the application than the EPC provision as emphasized in J 9/07 nor a provision in a national law that is more disadvantageous for the applicant than a provision in the EPC.

G 2/12 and G 2/13 already considered the national situation

[211] Marginal nos. 106 to 108 then refer to provisions in 12 of the 38 EPC Contracting States, where in three of them there is only mentioning of legislative initiatives and a discussion of amendments, respectively. As regards Norway, only changes to examining guidelines are mentioned. This legal situation does clearly not support the Referral’s conclusion that the national law of all EPC Contracting States excludes the relevant products from patent protection or that the situation is fully aligned¹²³.

¹²⁰ The voting rules in Article 35(2) EPC only require a majority of three-quarters of the votes of the EPC Contracting States represented, wherein abstentions are not considered as votes pursuant to Article 35(4) EPC

¹²¹ J 9/07, reasons 24.

¹²² J 9/07, marginal nos. 21 to 24.

¹²³ cf. referral, marginal no. 101.

[212] The Referral further mentions that G 2/12 could not yet take into account the amendments and discussions in eight EPC Contracting States but could only consider the national situation in Germany and The Netherlands. However, as in G 2/12 the majority of EPC Contracting States does still not exclude the respective products from patentability in the national law – nothing else can be derived from marginal nos. 105 *et seq.* Even if all Contracting would exclude the respective products in their national law this could not even provide basis for the change of Article 53b) EPC by the Administrative Council under Article 33(1)b) EPC, let alone under Article 33(1)c) EPC.

[213] Any amendments or initiatives in further EPC Contracting States would not have had an impact on the central consideration of the EBA that “[i]t is not mandated to engage in legislative policy”¹²⁴. The mandate for changing an Article is allocated to the Diplomatic Conference.

Article 33(5) EPC

[214] What is more, Article 33(1)b) EPC provides for very distinct conditions under which the Administrative Council can amend the EPC, complemented by Article 33(5) EPC that even requires entry into force. This means that even existing EU legislation not yet entered into force or before the expiry of an implementing period is no sufficient basis for the Administrative Council prior to its entry into force. How can then a non-binding and preliminary Commission Notice or certain national acts, declarations or initiatives allow the Administrative Council to effectively act as if under Article 33(1)b) EPC?

V. CONCLUSION

[215] It would thus be up to the EPC legislator to adapt Article 53b) EPC in order to exclude plants from patentability if this corresponds to the position of all EPC Contracting States. Amendments to Implementing Regulations can however not be used as a vehicle to reverse the meaning of Articles of the Convention adopted in line with Articles 31 and 32 of the Vienna Convention. Thus the Referral is not substantiated.

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¹²⁴ G 2/12, reasons VIII.2.(6)(c).