

EPO Board of Appeal decides plants can be patentable after all

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Plants which are produced according to essentially biological processes need to be held patentable, despite EPO Guidelines which were introduced in 2017 to exclude them from patentability. The EPO Board of Appeal came to this remarkable decision earlier today in case T 1063/18.

By *Frits Michiels and Bart van Wezenbeek*

Those who thought that the battle on patenting of plants had gotten a final blow by the amendment of the European Patent Convention last year and the approach of the EPO examination following that ([see this post](#)), have not counted on the EPO Boards of Appeal.

The discussion on the patentability of plants has a long history within the EPO, which culminated in the amendment of Rules 27 and 28 EPC by the Administrative Council entering into force on 1 July 2017 ([see this post](#)). This amendment followed a [Notice of the European Commission](#) of 3 November 2016, indicating that the [Biotech Directive 98/44](#) should have been interpreted as that plants obtained by essentially biological processes are not patentable.

Amended Rules 27 and 28 EPC were considered as clarifying the interpretation of Article 53(b) EPC, which excludes essentially biological processes from patentability, but which does not provide for an exclusion for the products thereof. According to the Administrative Council, the clarifying nature of the amendments implies that the law has always been in conformity with that interpretation and may hence be applied to pending cases and thus even to granted patents in opposition.



The present case, however, dealt with a patent application, European Patent Application EP 2753168, entitled "New pepper plants and fruits with improved nutritional value", filed in the name of Syngenta Participations AG. This was rejected by the Examining Division in view of amended Rules 27 and 28 EPC. Syngenta Participations AG filed an appeal against this rejection (T1063/18), for which the Oral Proceedings were held today, 5 December 2018.

The Board of Appeal 3.3.04 of the European Patent Office chaired by Ms. Gabriele Alt was extended to 5 members for the purpose of this appeal. The Board decided that amended Rules 27 and 28 EPC are in conflict with Article 53(b) EPC. The correct interpretation of Art. 53(b) has been provided by the Enlarged Boards of Appeal in the cases G2/07 and G1/08 and the corresponding cases G2/12 and G2/13 (tomato and broccoli cases), after an extensive study of the legislative history of this provision and following the interpretation standards that have to be applied to the European Patent Convention. Article 164(2) EPC stipulates that in such cases, the Articles shall prevail over the Rules. This would mean that plants that are produced according to essentially biological processes need to be held to be patentable and can no longer be refused because they would not comply with the requirement of Rule 28(2) EPC. Hence, the practical consequence of this is that the amendment of Rules 27 and 28 EPC as introduced in 2017 is void.

The appeal further did not finally conclude on the patentability of the invention, since the case was remitted back to the Examining Division to consider other patentability requirements (Art. 56, inventive step, and Art. 83, clarity).



Apparently, today's Board found the matter so crystal clear that they did not see a need for referring the question to the Enlarged Board of Appeal. It also means that Bayer, who saw its broccoli patent refused in opposition now probably can successfully appeal that decision.

The ball is now back in the court of the legislator and, if they want to ensure that no patents are granted on plants (and animals) produced by essentially biological processes, such as breeding, they have to change Art. 53(b) EPC, which can only be done via an intergovernmental conference. A further issue is whether they could introduce a retroactive effect as has been done with the amendments on Rule 27 and 28. It has already been pointed out in the comments on the Bayer broccoli case that this would effectively need to be considered *contra legem*. Further, novel discussion on this case may also trigger considerations on the patentability of mushrooms, seaweed and tissue cultures, like organoids.