Kluwer Patent Blog

Patentability of plants: EPO reacts to decision T1063/18 Board of Appeal

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The European Patent Office 'will consider possible next actions' together with the EPO Member States after a high-profile decision of a Board of Appeal earlier this week, concerning the patentability of plants. In case T 1063/18, the BoA decided that EPC Rules which were introduced by the EPO Administrative Council in 2017 to exclude plants or animals from patentability, were in conflict with 53(b) of the European Patent Convention and they can therefore be considered void.

The decision opens a new chapter in the debate concerning the patentability of plants or animals exclusively obtained by means of an essentially biological process. Late October the European Patent Office revoked a Bayer patent covering a type of broccoli adapted to make harvesting easier, because of the 2017 amendment of the Rules (27 and 28 EPC) by the EPO's Administrative Council.

Earlier this week however, Technical Board of Appeal 3304 decided in case T 1063/18 (on a patent on pepper plants owned by Syngenta (EP2753168)) 'that Rule 28(2) EPC (…) is in conflict with Article 53(b) EPC as interpreted by the Enlarged Board of Appeal in decisions G 2/12 and G 2/13' – also known as the Tomatoes II and Broccoli II cases. In practice this means that plants and animals are to be held patentable again. Today, the BoA published a report about its decision here; the text is available at the bottom of this blogpost.

In reaction to a query by Kluwer IP Law, the EPO came with a statement as well: 'Following the adoption in November 2016 of a Notice by the European Commission on the patentability of plants produced by non-technical processes, the EPO's Administrative Council amended the relevant legal regulations, which took effect on 1 July 2017. Just as the EPO and its Member States have responded effectively to such developments previously, they will now consider possible next actions following Wednesday's decision in case T 1063/18. The European Patent Office played no part in the Board of Appeal's (BoA) decision, which was taken by the BoA in its capacity as a fully independent body.'

Chaotic

What will happen next is not clear. The organization No Patents On Seeds, which had hailed the revocation of the Bayer broccoli patent as 'an important success for the broad coalition of civil society organizations against patents on plants and animals', said a 'chaotic legal situation' has been created by the BoA decision. It declared: 'This has put the EPO into conflict with its 38 member states that decided to stop these patents, such as those on broccoli and tomatoes derived from conventional breeding.' No Patents On Seeds is clear about what it thinks should be the consequence of the BoA decision: 'The EPO must suspend all pending patent applications on plants and animals until sufficient legal certainty and clarity is achieved.'

The exclusion of plants and animals from patentability was introduced by the EPO's Administrative Council in the EPC two years ago, following a Notice of the European Commission, clarifying that the Directive on Biotechnological Inventions (98/44/EC) intended to exclude these products 'exclusively obtained by means of an essentially biological process'. Earlier, in the decisions G2/12 and G 2/13 of 2015, the Enlarged Board of Appeal had ruled that certain tomatoes and broccoli were patentable.

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BoA Communication: Decision in case T 1063/18 on the patentability of plants

7 December 2018

Case T 1063/18 concerns the appeal by the applicant against the decision of the examining division to refuse European patent application no. 12 756 468.0 (publication no. EP 2 753 168) for the sole reason that the claimed subject-matter falls within the exception to patentability according to Article 53(b) and Rule 28(2) EPC (here: plants exclusively obtained by means of an essentially biological process).

At the oral proceedings, which took place on 5 December 2018, Technical Board of Appeal 3304, in an enlarged composition consisting of three technically and two legally qualified members, held that Rule 28(2) EPC (see OJ 2017, A56) is in conflict with Article 53(b) EPC as interpreted by the Enlarged Board of Appeal in decisions G 2/12 and G 2/13. The Board referred to Article 164(2) EPC, according to which the provisions of the Convention prevail in case of conflict with the Implementing Regulations, and decided to set the decision under appeal aside and to remit the case to the examining division for further prosecution.

The written decision containing the board's full reasons is expected to be issued early next year.

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