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## T 1063/18 is out. A Peppery Decision!

Thorsten Bausch (Hoffmann Eitle) · Tuesday, February 5th, 2019

The much awaited decision T 1063/18 by Technical Board of Appeal 3.3.04 in a five-member composition has been published today. The patent application under appeal related to new pepper plants and fruits with improved nutritional value, and the decision did indeed turn out to be quite peppery, at least in regard to the EPO Administrative Council's attempt to prohibit the patenting of plants by way of the addition of the "interpretative" Rule 28(2) EPC.

To begin with, the Board reminded itself of the existing case law of the Enlarged Board of Appeal (EBA) on Art. 53(b) EPC, which stipulates that European Patents are not to be granted for plant or animal **varieties** or essentially biological **processes** for the production of plants or animals. The question then put before the EBA was whether this exclusion also extends to **plants** or plant material or part of plants **other than a plant variety**. TBA 3.3.04 summarized the EBA's case law as follows:

> Thus, in decisions G 2/12 and G 2/13, the EBA concluded that the scope of application of the term "essentially biological processes for the production of plants" in Article 53(b) EPC is interpreted to the effect that product inventions where the claimed subject-matter is directed to plants or plant material such as a fruit or plant parts other than a plant variety, as such, are not excluded from being patented (see Reasons, point IX.(1)).

These two decisions by the Enlarged Board have always been controversial, and it is probably fair to say that both the majority of the EU Parliament and the EU Commission did not like them too much. A Notice issued by the EU Commission on the patent protection of plants was quoted by the Board as stating the following:

> "While these decisions of March 2015 [G 2/12 and G 2/13 of the EBA] 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" and furthermore that "When trying to assess the intentions of the EU legislator when adopting the Directive, the relevant preparatory work to be taken into

> consideration is not the work
> which preceded the signature of the EPC in 1973, but that which relates to the adoption of the Directive."

and

> "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."

Thus, there was a divergence between EPC law and the intentions of the EU legislator issuing the Biotech Directive, according to the Commission.

The EPO's Administrative Council tried to bridge this divergence by adding a new paragraph 2 to Rule 28, reading:

> "(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."

This addition was viewed by the Examining Division as a "clarification of the scope of Art. 53(b) EPC". But the Board of Appeal vehemently disagreed with this interpretation:

> The board however cannot deduce from decisions G 2/12 and G 2/13 any other interpretation of Article 53(b) EPC than that plants are not excluded from patentability, even if they can only be obtained by an essentially biological process. Since Rule 28(2) EPC excludes plants or animals exclusively obtained by means of an essentially biological process from patentability, its meaning is in conflict with the meaning of Article 53(b) EPC as interpreted by the EBA.

While the Board conceded that there are cases where possible contradictions between a rule of the implementing regulations and a provision of the EPC can be resolved by interpretation, it saw no way to do this here in view of the crystal clear case law of the Enlarged Board. The Board of Appeal was of the view that in the present case, Rule 28(2) EPC in fact reverses the meaning of Article 53(b) EPC as interpreted by the EBA. It also saw no reason to deviate from G 2/12 and G 2/13 and concluded 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.

Such a reason might have been a later subsequent agreement between the parties in the sense of the Vienna Convention. However, in the Board's pretty outspoken view, the AC's addition of Rule 28(2) EPC was no such subsequent agreement. It would in fact represent an amendment of an Article of the Convention, for which the Administrative Council simply is not empowered in the light of Articles 33(1)(b) and 35(3) EPC.

Thus, to put it briefly and in my words, the Administrative Council acted *ultra vires* in adding Rule 28(2) EPC. For what it's worth, I have to confess that this is exactly the suspicion that I had from the first day when I saw the Administrative Council's decision introducing this rule. The proper way to implement such a substantive change of the European Patent Convention would have been by way of a diplomatic conference.

It will be interesting to see whether this laborious project will now be initiated. If so, there is certainly more on at least my personal wish list for legislative amendments, in particular the wish for a strong and truly independent judiciary within the European Patent Organisation that satisfies constitutional standards in regard to a proper separation of powers and, inter alia, protects members of the EPO from executive overreach.

Nonetheless, decision T 1063/18 shows that the Technical Boards of Appeal and the Enlarged Board are at least able to reach independent decisions when it comes to provisions of the EPC, even if these decisions will not always be popular or uncontroversial. In the end, though, the judiciary is bound to the law, and in this case Article 164(2) EPC clearly stipulates that the provisions of the Convention prevail.

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