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T 1063/18: EPO wants ‘solution in the short term’ concerning plant patentability

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The European Patent Office and representatives of the 38 Member States organised a meeting last week of the Committee on Patent Law to discuss next steps following decision T 1063/18 of an EPO Board of Appeal on plant patentability. Representatives of the European Commission were present as observer.

In its landmark decision of 5 December 2018, the Board of Appeal decided that 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 discussion on the patentability of plants has a long history within the EPO. In the so-called Broccoli-II and Tomato-II cases (**G 2/12** and **G 2/13**) of 2015, the EPO Enlarged Board of Appeal ruled that ‘plant products such as fruits, seeds and parts of plants are patentable even if they are obtained through essentially biological breeding methods involving crossing and selection.’

But in 2016, the European Commission issued a Notice, indicating that the **Biotech Directive 98/44** should have been interpreted as that plants obtained by essentially biological processes are *not* patentable. Taking into account this notice, the EPO Administrative Council amended its Regulations in 2017, in vain however, according to decision T 1063/18, which has led to a lot of uncertainty.

According to the EPO report on last week’s meeting, the EPO Committee on Patent Law ‘addressed different potential options for the way forward and particularly particularly supported measures to obtain an opinion from the Enlarged Board of Appeal on the matter. The need for legal certainty in the interest of the users of the European patent system and the general public was strongly underlined in the debate. Discussions will continue with the intention to find a

solution in the short term.'

The text of the T 1063/18 decision was published on 5 February 2019. Some relevant paragraphs can be found below.

21.

(…) any interpretation of the EPC by the EBA implies that the law should always have been read in conformity with that interpretation (…). An interpretation of the EPC by the EBA is thus to be applied to all cases pending before the departments of the European Patent Office and before the Boards of Appeal and in all subsequent cases, unless the EBA provides transitional provisions.

22.

By decision of the Administrative Council of 29 June 2017, Rule 28(2) EPC was introduced into the Implementing Regulations (see point 17, above) with a view of aligning them with the interpretation of the Biotech Directive set forth in the Notice by clarifying that "plants and animals as well as propagation materials thereof are covered by the exclusion from patentability" (CA/56/17, points 59 and 64).

23.

In the decision under appeal, the examining division reasoned that Rule 28(2) EPC constitues a "clarification of the scope of Article 53(b) EPC". 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.

24.

(…) in the present case, Rule 28(2) EPC in fact reverses the meaning of Article 53(b) EPC, as interpreted by the EBA. In view of this direct contradiction, interpreting Rule 28(2) EPC in such a way that no contradiction exists is not possible.

25.

The board therefore concurs with the appellant's view, (…), that Rule 28(2) EPC is in conflict with Article 53(b) EPC as interpreted by the EBA.

29.

The interpretation of the Biotech Directive as put forward in the Notice cannot be seen as a relevant development because it has not been confirmed in a legally binding way. Within the legal framework of the European Union (EU), a binding interpretation of provisions of EU law such as the Biotech Directive are decided in last instance by the CJEU (Article 267(b) Treaty on the Functioning of the European Union). This was recognised in the Notice itself (…). The Notice therefore has no legal authority.

34.

(…) the Administrative Council is not (…) competent to amend the Convention, here Article 53(b) EPC, by amendment of the Implementing Regulations, here Rule 28(2) EPC.

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.

46.

Having established 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, it must be concluded that the provisions of the Convention prevail.

47.

Thus, the decision under appeal, holding the subject matter of claims 1 and 2 to be within the exception to patentability of Article 53(b) EPC and Rule 28(2) EPC, is to be set aside. The appeal is found to be allowable.

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