Kluwer Patent Blog

Patentability of plants: EPO referral of decision T1063/18 criticized

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The decision of the Administrative Council of the EPO to refer to the Enlarged Board of Appeal (EBA) decision T 1063/18 on the patentability of plants obtained by essentially biological processes has been criticized from various sides.

A week ago, during the 159th meeting of the EPO Administrative Council, president António Campinos said his referral of the case to the Enlarged Board of Appeal was 'justified and necessary' and, according to a press release, he received 'broad and overwhelming support' for this. Campinos announced that he would 'proceed swiftly to submit the referral (…) to restore legal certainty fully and speedily in the interest of the users of the European patent system and the general public.'

The aim of the referral, according to the press release, was 'to obtain an opinion (…) on the patentability of plants exclusively obtained by essentially biological processes, hereby considering recent legal developments (interpretations and statements of the European Commission, the EU Council, European Parliament and EPO's Administrative Council on the interpretation of the European Patent Convention and the EU Bio-Directive, all of them concluding that there should be no patentability in these cases).'

In case T1063/18, an EPO Board of Appeal decided plants can be patented after all, despite attempts of the European Commission and the EPO Administrative Council to ensure they would nót be patentable. (full background of the case here and here).

Commentators of this blog however, were quick to question the legality of the referral. As *Mouna* pointed out: 'I wonder on which legal basis this referral is made, considering that there are no conflicting decisions. Article 112(1)(b) [EPC]: the President of the European Patent Office may refer a point of law to the Enlarged Board of Appeal where two Boards of Appeal have given different decisions on that question.'

Attentive observer wrote: ' (…) Where is the claimed legal uncertainty? In T 1063/18, the BA has considered that the amendment of R 28, which was carried out in the wake of an opinion of the EU Commission, not even a decision of the CJEU, was against the interpretation of the EPC by the EBA in decisions G 2/12 and G 3/12. A referral would only be legitimate if a different BA, or even the same BA, but in a different composition, would arrive at the opposite conclusion of T 1063/18. The possibility for the President of the EPO to refer questions to the EBA should not be misused for political reasons.

(…) The first question to ask is whether such a referral is at all admissible. (…) The envisaged referral actually requires the Enlarged Board to disregard its own case law. (…) I hope that the EBA will resist this attempt to influence it, as it resisted the attempts of the predecessor of the present president in G2301/15 and G 2302/15. (…)'

And *AM* revealed: 'My wife, who happens to work at that venerable Office, was quite surprised by the wording of the internal communiqué, which reads:

"… Concerning legal matters, most of the debates were dedicated to decision T 1063/18 …, which created much legal uncertainty as it disregarded the clear interpretation provided by different authorities, namely the EPO Member States and the EU institutions. This is why a full support was expressed in favour of the proposal of the Office to refer this decision to the EBA. …"

It is quite surprising to see the executive branch of an institution telling its judiciary that it should have decided differently. The authoritative tone of the statement is rather unpleasant. It seems the separation of powers is not part of the DNA of this organization.'

Epo stakeholder was the only one to show comprehension: 'I understand the critical comments regarding the legality of a referral by the President of the EPO in this case and the concern about independence of the Boards of Appeal. However, independence should not be a synonym for autism. The Boards of Appeal should not ignore other legal components of the overall context such as the existence of statutory protection for plant varieties and the EU biotech directive.and take them into account as much as the case law of national courts.' (more comments below this post).

In a blogpost by Rose Hughes of IP Kat, she concludes it is likely that the EBA will not admit the referral: 'It is also noted that the EBA has form in finding referrals by the President as inadmissible in the absence of conflicting decisions from the Boards of Appeal (e.g. **G 3/95**). The case law therefore suggests that any referral by the President, citing legal developments such as statements from the European Commission, is unlikely to be accepted by the EBA. In fact, it seems highly probable that the EBA will consider the issue to have already been fully decided in **G 2/12** (*Broccoli/Tomato II*).'

CIPA position paper

In the meantime, on 25 March 2019, the Chartered Institute of Patent Attorneys (CIPA) in the UK published a position paper on the patenting of plants; or as CIPA writes: 'on the lawfulness of a number of options for addressing the conflict between decisions of the EPO Boards of Appeal (i.e. G2/12, G2/13 and T1063/18) and Rule 28(2) EPC.'

Remarkably, CIPA rejects all options for resolving the conflict which were proposed by António Campinos in a communication of early March:

‘In response to the ruling finding Rule 28(2) EPC unenforceable, the President of the EPO issued a communication (CA/26/19, dated 7 March 2019) indicating an intention to analyse the following as “potential options for next steps”:

(A) a referral to the Enlarged Board of Appeal by the President of the EPO;
(B) an amendment of Article 53(b) EPC by the AC based on Article 33(1)(b) EPC; and
(C) additional actions in pending appeal cases related to Rule 28(2) EPC.

(….) In short, CIPA’s position is that:
– there are no valid grounds upon which Option A or Option C could resolve the current conflict;
– at least Option B would be unlawful (under the EPC); and
– Options A to C should therefore not be pursued.’

*Also (…) CIPA’s position is that, in contrast to Options A to C above, the following options are capable of resolving the conflict in a manner that is **lawful** and that **preserves legal certainty** (and, in particular, the legal certainty of rights holders):*

(D) acceptance of the current interpretation of Article 53(b) of the European Patent Convention (EPC), and development of best practice and further case law that takes account of that interpretation;
(E) an amendment of EU law governing the patentability of plants, followed by an amendment of Article 53(b) EPC to bring it into line with (amended) EU law; and
(F) postponement of further action unless and until the Court of Justice of the EU (CJEU) issues a ruling on the interpretation of Article 4(1)(b) of the Biotech Directive (and then, if necessary, an amendment of the EPC to bring it into line with the CJEU’s interpretation of the Biotech Directive).’

The conclusion of the CIPA position paper:

‘CIPA’s position is that the above-mentioned conflict (between judicial interpretations of the EPC and Rule 28(2) EPC) should be solved in a lawful manner.

Whilst CIPA has no wish to prescribe any one particular solution to that conflict, we cannot support any actions that:
– are unlawful (either under the European Patent Convention or under EU law); or
– undermine legal certainty, in particular legal certainty relating to the legitimate expectations of rights holders.

For the reasons discussed above, our position is that, at this time:
*– there are no valid grounds upon which a further EBA opinion can be obtained under either Article 112(1)(b) EPC (**Option A**) or Article 112(1)(a) EPC (**Option C**);*
– there are also no valid grounds upon which the EBA could be persuaded (by the Commission Notice) to arrive at an interpretation of Article 53(b) EPC that differs from that set out in G2/12 and G2/13; and
*– amendment of Article 53(b) EPC under **Option B** would be **unlawful**, regardless of whether that amendment were made under Article 33(1)(b) EPC (which would be unlawful under the EPC) or under Article 172 EPC (which would be unlawful under EU law, and which might also misalign the EPC with a future ruling of the CJEU)*

Our position is therefore that the only viable options at this time are as follows.
*– Accept the current interpretation of Article 53(b) EPC (**Option D**).*
*– Amend EU law and then the EPC (**Option E**).*
*– Await the issuance of a ruling of the CJEU (**Option F**).'*

It is not clear whether EPO president Campinos has already submitted the referral of case T 1063/18 to the Enlarged Board of Appeal and when the EBA will decide about it. But considering the reactions in just one week's time, one can conclude that the referral will unlikely lead to Campinos' proclaimed aim of restoring 'legal certainty fully and speedily in the interest of the users of the European patent system and the general public.' And it is a reason for concern that the Administrative Council, which has often been criticized in the last years for not controlling the president (for instance in the deep social conflicts, which unfortunately are far from over at the EPO) has given this obviously legally very questionable measure its 'overwhelming support'.

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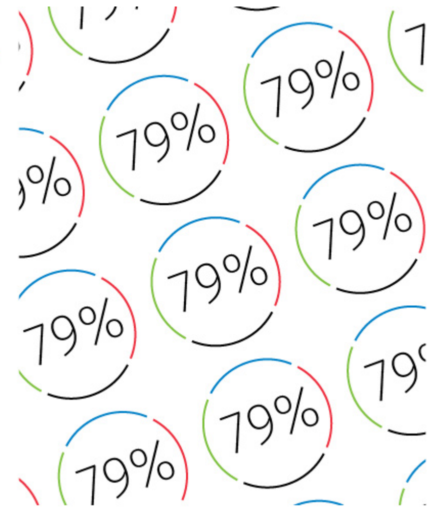

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