Subject: Enlarged Board of Appeal Case G 3/19

Dear Sirs,

Please find enclosed, in accordance with article 10 of the Rules of Procedure of the Enlarged Board of Appeal of the European Patent Office, an amicus curiae submission by the Portuguese National Institute of Industrial Property in respect of Case G 3/19.

Our Office looks forward with considerable interest to the Enlarged Board’s decision.

Yours sincerely,

Ana Bandeira
President of the Directive Council
Portugal Observations Case G 3/19

Referral of a point of law to the Enlarged Board of Appeal by the President of the European Patent Office (Article 112(1)(b) EPC)

Amicus curiae submission of the Portuguese National Institute of Industrial Property

Introduction

1. These are the amicus curiae submission of the Portuguese National Institute of Industrial Property in case G 3/19 in accordance with article 10 of the Rules of Procedure of the Enlarged Board of Appeal.

2. On 4 April 2019, the President of the EPO referred points of law to the Enlarged Board of Appeal under Article 112(1) (b) of the EPC on the interpretation of article 164(2) and the assessment of Rule 28(2) under said provision.

3. This referral follows the decision T 1063/18 of a Technical Board of Appeal of 5 December 2018 and is related to the patentability of plants exclusively obtained by essentially biological processes.

4. The points of law raised by the President of the European Patent Office were:

i) Having regard to Article 164(2) EPC, can the meaning and scope of Article 53 EPC be clarified in the Implementing Regulations to the EPC without this clarification being a priori limited by the interpretation of said Article given in an earlier decision of the Boards of Appeal or the Enlarged Board of Appeal?

ii) If the answer to question 1 is yes, is the exclusion from patentability of plants and animals exclusively obtained by means of an essentially biological process pursuant to Rule 28(2) EPC in conformity with Article 53(b) EPC which neither explicitly excludes nor explicitly allows said subject-matter?
Context

5. In decision T1063/18 of 5 December 2018 a Technical Board of Appeal concluded that Rule 28(2) EPC, which excludes from patentability plants or animals exclusively obtained by means of an essentially biological process, is in conflict with Article 53(b) EPC as interpreted by the Enlarged Board of Appeal and set aside the examining division's decision of exception to patentability of Article 53(b) EPC, based on Rule 28(2) EPC. In summary, in its decisions G 2/12 and G 2/13 this Board concluded that the exclusion of essentially biological processes for the production of plants in Article 53(b) EPC does not have a negative effect on the allowability of a product claim directed to plants or plant material.

6. Although we respect the decisions of the Boards and appreciate their autonomy, we cannot agree with this decision, both in substance and in process. It is our strong belief that Boards of Appeal should not disregard the recent legal developments in this subject-matter and take them into account when deciding on cases that are related to products exclusively obtained by means of an essentially biological process. These recent legal developments include the Notice from EU Commission endorsed by the EU Council and European Parliament, and EPO's Administrative Council decision on the interpretation of on this subject-matter, all concluding that products obtained by means of an essentially biological process are excluded from patentability.

7. On 8 November 2016 the EU Commission published a Notice on certain articles of Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions. In this Notice 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. This conclusion, among other aspects, took into account the set of texts prepared during the negotiation of the Directive and the provisions of the Directive.

8. This Notice had its origin in a resolution adopted by the European Parliament, on 17 December 2015, asking the EU Commission to clarify the patentability of conventional plants under the EU Biotechnology Directive, and to communicate its clarification regarding the patentability of products obtained by essentially biological processes to the EPO so that it could be used as a supplementary means of interpretation.
9. Although the non-binding nature of the Notice, one cannot disregard the role of the EU Commission as the EU Institution responsible for proposing and enforcing legislation.

10. The Notice by the EU Commission was endorsed by the EU Council and by the European Parliament.

11. Following the publication of the EU Commission Notice, the President of the EPO decided in November 2016 to stay all proceedings before EPO examining and opposition relating to plants or animals obtained by an essentially biological process while the discussions with the EPC’s Contracting States were ongoing.

12. Following discussions in the Committee on Patent Law, the Administrative Council decided in June 2017 to clarify, by amending Rules 27(b) and 28 EPC, that under Article 53(h) EPC plants and animals exclusively obtained by means of an essentially biological process are excluded from patentability.

13. As it is said in Referral to the Enlarged Board of Appeal by the President of the European Patent Office (…) since the European Commission Notice was published in November 2016, all 38 Contracting States of the European Patent Convention have indicated and declared that under their national law and practice the products (plants and animals) of essentially biological processes are excluded from patentability. The 28 EPC Contracting States which are members of the EU have declared their national law and practice to be in line with the interpretation of Article 4(1)(b) of the EU Biotechnology Directive set forth in the European Commission Notice. This results in the first place from the conclusions of the EU Council of the Ministers in which the Commission Notice was welcomed. The 10 EPC Contracting States which are not members of the EU, too, have indicated that under their national law and practice plants and animals obtained by essentially biological breeding processes are not patentable.(…).

14. It is our opinion that these efforts to harmonise procedures within Europe and between EPC and national law or practice of all the EPC Contracting States cannot be disregarded by the Enlarged Board of Appeal.

15. Also, based on the EU Biotechnology Directive and based on the recent legal developments (the Notice from the EU Commission and the amendments on Rules 27 and 28 of the Implementing Regulations to the EPC) several Member States have dispositions on their national law, or will have soon, a patentability exclusion for the
products obtained by essentially biological processes (just to name a few: Portugal, The Netherlands, Germany, France, Austria, Italy and Belgium).

Conclusion

16. Bearing in mind the above, the Portuguese National Institute of Industrial Property asks the Enlarged Board of Appeal, when deciding on the present Referral, to:

- Take into account the recent legal developments to re-assessed the exclusion from patentability of products obtained by essentially biological processes (including notice from the EU Commission endorsed by the EU council and the European Parliament, and EPO's Administrative Council decision on the interpretation of on this subject-matter) and, therefore, restore legal certainty for the users of the European Patent System by concluding that plants and animals exclusively obtained by means of an essential biological process are excluded from patentability.

- Recognize the importance of an uniform interpretation and harmonised European Patent Law and take into account that further national laws of Contracting States of the EPC provide for an explicit exclusion from patentability for plants or animals exclusively obtained by an essentially biological process.