

European Patent Office
Registry of the Enlarged Board of Appeal
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Amicus curiae brief of epi concerning case G 2/13

Dear Sirs,

Please find enclosed, in accordance with Art 10 of the Rules of Procedure of the Enlarged Board of Appeal, an amicus curiae brief with regard to case G 2/13 of the Biotechnological Inventions Committee of the Institute of Professional Representatives before the European Patent Office (**epi**).

Best regards,



Antonius Tangena

Encl.: Amicus curiae brief of **epi** concerning case G 2/13

Annex: List of documents cited in the amicus curiae brief of **epi** (attached on DVD)

Amicus curiae brief of **epi** concerning case G 2/13

epi is highly interested in the questions presented to the Enlarged Board of Appeal in the case of G 2/13 and therefore presents its position in relation to the patentability of inventions pertaining to plants obtainable by essentially biological processes for the production of plants.

epi is the professional organisation of currently around 11,000 European Patent Attorneys (Professional Representatives before the EPO). A specialised body within the **epi**, the Biotechnological Inventions Committee, deals with various issues relating to patents on biotechnological inventions. It is of major concern to this Committee that the Enlarged Board of Appeal examines the questions raised in the present referral with due respect for the law and settled expectations. The patentability of inventions pertaining to plants obtainable by essentially biological processes for the production of plants has never constituted a problem in the past. In the interest of predictability, the **epi** is of the opinion that industry should be able to continue to rely on the unambiguous wording of the EPC.

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1. INTRODUCTION

1.1 Preliminary Remarks

1.1.1 Herein, it is assumed that the Enlarged Board of Appeal proceedings G 2/12 (“tomato”; referral T 1242/06 II) and G 2/13 (“broccoli”; referral T 83/05 II) will be joined into consolidated proceedings. This would reflect the close relationship of both cases, as is for instance evident from the overlap of the referred points of law and the fact that, in the referral T 83/05 II, the Board directly incorporates points 40 to 66 of the Reasons of T 1242/06 II by cross-reference into its decision (see T 83/05 II, point 20 of the Reasons). In view of this, the present brief will refer to both referrals, but with a focus on G 2/13.

1.1.2 Before going into the details of the present case, a general remark appears to be necessary given the highly emotive debates in the public, the press and the political sphere revolving around the “broccoli” and “tomato” cases.

Campaigners and politicians put much pressure on the EPO trying to force it to generally ban the patenting of plants. This is supported for instance by a corresponding resolution of the EU-Parliament dated May 10, 2012 or national legislation in Germany (see for details section 3.7, *infra*). However, as the Enlarged Board of Appeal will be perfectly aware of, in the present proceedings, the relevant law is to be applied in accordance with the established principles of its interpretation. The correct application of the law includes the possibility of legal development, e.g., taking into account technological developments (see corresponding discussion in G 3/08, points 7 to 7.3.8 of the Reasons). However, on the other hand, in judging on the patentability of inventions, the EPO as an executive body and the Boards of Appeal as quasi-judicial bodies, cannot go beyond the codified law (see G 3/98, point 7.2.7 of the Reasons). That is, it is not possible to make new law.

Thus, **epi** firmly requests that the Enlarged Board of Appeal shield itself from any political pressures and apply the existing law based on the established rules for interpretation.

1.2 The claims

In the case underlying T 83/05 II, the following claim 1 of the Main Request is pending:

- "1. An edible *Brassica* plant produced according to a method for the production of *Brassica oleracea* with elevated levels of 4-methylsulfinylbutyl glucosinolates, or 3-methylsulfinylpropyl glucosinolates, or both, which comprises:
- a) crossing wild *Brassica oleracea* species selected from the group consisting of *Brassica villosa* and *Brassica drepanensis* with broccoli double haploid breeding lines;
 - b) selecting hybrids with levels of 4-methylsulfinylbutyl glucosinolates, or 3-methylsulfinylpropyl glucosinolates, or both, elevated above that initially found in broccoli double haploid breeding lines;
 - c) backcrossing and selecting plants with the genetic combination encoding the expression of elevated levels of 4-methylsulfinylbutyl glucosinolates, or 3-methylsulfinylpropyl glucosinolates, or both; and
 - d) selecting a broccoli line with elevated levels of 4-methylsulfinylbutyl glucosinolates, or 3-methylsulfinylpropyl glucosinolates [sic], or both, capable of causing a strong induction of phase II enzymes, wherein molecular markers are used in steps (b) and (c) to select hybrids with genetic combination encoding expression of elevated levels of 4-methylsulfinylbutyl glucosinolates, or 3-methylsulfinylpropyl glucosinolates, or both, capable of causing a strong induction of phase II enzymes."

Claims 2 and 3 relate to an edible portion and to seed of a broccoli plant produced by a method defined as in claim 1. Claims 4 and 5 relate to a broccoli plant and a broccoli inflorescence.

1.3 The referred Questions

The following questions of law have been referred to the Enlarged Board of Appeal in the decision T 83/05 II:

1. Can the exclusion of essentially biological processes for the production of plants in Article 53(b) EPC have a negative effect on the allowability of a product claim directed to plants or plant material such as plant parts?
2. In particular:
 - (a) Is a product-by-process claim directed to plants or plant material other than a plant variety allowable if its process features define an essentially biological process for the production of plants?
 - (b) Is a claim directed to plants or plant material other than a plant variety allowable even if the only method available at the filing date for generating the claimed subject-matter is an essentially biological process for the production of plants disclosed in the patent application?
3. Is it of relevance in the context of questions 1 and 2 that the protection conferred by the product claim encompasses the generation of the claimed product by means of an essentially biological process for the production of plants excluded as such under Article 53(b) EPC?
4. If a claim directed to plants or plant material other than a plant variety is considered not allowable because the plant product claim encompasses the generation of the claimed product by means of a process excluded from patentability under Article 53(b) EPC, is it possible to waive the protection for such generation by "disclaiming" the excluded process?

2. SUMMARY OF THE ARGUMENTS

- 2.1 The **epi** is of the view that an interpretation of Article 53(b) EPC in compliance with Articles 31 and 32 of the Vienna Convention on the Law of Treaties precludes extending the process exclusion of essentially biological processes for the production of plants to product claims directed to plants. Any other interpretation would deviate from the ordinary meaning of the relevant terms in

- their context and in the light of their object and purpose. (See *infra*, section 3.2).
- 2.2 It is moreover argued that the scope of protection should not be taken into account in the examination of patentability. Only the subject-matter of the claim is relevant in this context. This general principle also applies to Article 53(b) EPC. It is thus irrelevant that the scope of protection of a claim directed to a plant could indirectly provide protection with regard to the process used to obtain such plant. (See *infra*, section 3.3).
- 2.3 The **epi** stresses the dominance of a product claim directed to plants over an essentially biological process for the production of such plants. The invention of a novel and inventive plant deserves adequate protection. Also in view of the well-established doctrine of absolute compound protection, it is entirely acceptable that a breeder should only be able to use the patented plant with the consent of the patentee. (See *infra*, section 3.4).
- 2.4 A remarkable decision of the Dutch court confirms the **epi**'s opinion that Article 53(b) EPC is not applicable to product claims directed to plants. Since the facts and issues in this case are nearly identical to those in the present referral, the decision is of significant relevance. (See *infra*, section 3.5).
- 2.5 An extension of the process exclusion of Article 53(b) EPC to products derived from the excluded processes would have drastic and clearly unsatisfactory consequences, particularly when combined with the overly broad interpretation of the process exclusion in case G 2/07. It could, for instance, result in the exclusion of patentability of claims to transgenic plants where a step of crossing and selection is included in the process of obtaining such plant. A positive answer to question 1 could thus be highly detrimental to the European plant industry. (See *infra*, section 3.6).
- 2.6 The fact that the German Patent Act contains, besides the exclusion of essentially biological processes for the production of plants, an exclusion of plants exclusively obtained by such processes, does not alter the view expressed by the **epi**. On the contrary, the fact that the German legislator

obviously considered it necessary to amend the law in order to insert the exclusion for plants produced by essentially biological processes demonstrates that the process exclusion in Article 53(b) EPC does not cover such plants. (See *infra*, section 3.7).

- 2.7 In conclusion, the **epi** suggests that the exclusion of essentially biological processes for the production of plants in Article 53(b) EPC cannot have any negative effect on the allowability of a product claim directed to plants or plant material. Thus, Questions 1 and 3 are to be answered in the negative. (See *infra*, section 3.8).
- 2.8 Question 2(a) is to be answered in the affirmative since there is no apparent reason for treating product-by-process claims differently from other product claims to plants. (See *infra*, section 4).
- 2.9 Question 2(b) is to be answered in the affirmative. Even if no other method is available at the filing date than an essentially biological process for the production of the claimed subject-matter, the process exclusion Article 53(b) EPC cannot negatively affect product claims directed to plants or plant material. (See *infra*, section 5).
- 2.10 Question 4 does not need to be answered because the contained pre-condition does not apply. However, assumed that it applied, the question is to be answered in the negative. Firstly, there is no support in the EPC for a disclaimer which restricts the rights conferred by a patent. Secondly, a process cannot be excluded from a product claim since the process is not the subject-matter of the claim. The issues of patentability and scope of protection should clearly be distinguished in this respect. (See *infra*, section 6).
- 2.11 As an alternative, the **epi** proposes that the Enlarged Board of Appeal revises its interpretation in case G 2/07 of the term “essentially biological processes for the production of plants” in Article 53(b) EPC in such a way as to refer to plant production methods that result in a plant variety. (See *infra*, section 8).

3. QUESTIONS 1 AND 3

Questions 1 and 3 can be dealt with together since, as is derivable from T 1242/06 II, the formulation of Question 1 relies on the logic expressed in Question 3.

3.1 Reasoning of the referring Board

3.1.1 The referral T 1242/06 II can be summarized as follows:

After the Enlarged Board had decided in G 1/08 on the patentability of essentially biological processes for the production of plants, the case was remitted to Technical Board 3.3.04 for further consideration. In view of the results of G 1/08, Patentee deleted the process claims. However, with regard to the remaining claims directed to the tomato fruit, the Opponent argued that these claims violated Art. 53(b) EPC (i) because they related to unallowable plant varieties and (ii) because the finding of G 1/08 necessitates that products of unallowable breeding methods can likewise not be patentable. The latter was justified by the argument that allowing such a product claim would counteract the process exclusion of Article 53(b) EPC as interpreted in G 1/08, thereby frustrating the legislator's aim not to provide patent protection for the excluded plant breeding processes.

The Board did not follow the first part of Opponent's argumentation. (T 1242/06 II, points 27 to 37 of the Reasons), but gave some credit to the Opponent's argumentation that the process exclusion of Article 53(b) EPC may have an impact on the patentability of products obtained thereby. In particular, the following was considered:

- (a) The Board observes that the method for breeding tomato plants as claimed in the granted patent cannot be performed without producing and using the claimed tomato fruits (T 1242/06 II, points 45 to 46).
- (b) From the above, the Board derives that "[d]isregarding the process exclusion in the examination of product claims altogether would have the general consequence that, for many plant breeding inventions, patent applicants and proprietors could easily overcome the process

exclusion of Article 53(b) EPC by relying on product claims providing a broad protection which encompasses that which would have been provided by an excluded process claim.” According to the Board, this seems to be “[a]t least *prima facie* [...] at odds with a purposive construction of Article 53(b) EPC” (T 1242/06 II, point 47).

- (c) According to the Board, the findings of G 1/98 do not already answer the questions at stake since then the Enlarged Board solely considered the exclusion of plant varieties and not any impact of the process exclusion (T 1242/06 II, point 48).
- (d) The Board observes that Rule 28(c) EPC and G 2/06 provide an example where the exclusion of a process or use may have an impact on the allowability of product claims (T 1242/06 II, points 50 to 52).
- (e) The Board makes some considerations on the basic distinction between the claim categories “product” and “process” and questions that there could be a distinctive “inventive quality” of product inventions justifying their general allowability notwithstanding the general non-allowability of process claims (T 1242/06 II, points 53 to 56).
- (f) The Board addresses the finding of G 1/98 that, when a claim to a process for the production of a plant variety is examined, Article 64(2) EPC 1973 should not be taken into consideration. The Board questions relevance of this finding for the present case by pointing to the fact that the protection conferred by a process claim to the immediate product under Article 64(2) EPC is narrower than the protection conferred by a product claim. (T 1242/06 II, points 57 to 59).
- (g) The Board considers the possible relevance of the fact that, e.g., medicinal products can be patented, but methods of treatment using such products are excluded under Article 53(c) EPC. A difference is said to lie in the fact that doctors are normally free to carry out their work since tablets are purchased on the market and patent protection is exhausted, whereas no such exhaustion is possible for breeding methods since a breeder carrying out such a method would always be covered by a product patent (T 1242/06 II, points 60 to 64).
- (h) The Board concludes: “Serious concerns remain that allowing claims to plant material which, according to the disclosure of the patent, is obtained by means of an essentially biological breeding process would

de facto frustrate the legislator's intentions in framing the process exclusion, which were emphasized in decision G 1/08 (*supra*), and make the circumvention of the exclusion in many cases a matter of skilful claim drafting, thereby diminishing the consistency and persuasiveness of the legislative framework of the EPC as regards patentable subject-matter" (T 1242/06 II, point 65).

- (i) Finally, the Board refers to the possibility to introduce specific exemptions for plant breeding activities into their national infringement provisions (e.g. Article L613-5-3 French Intellectual Property Code and § 11 No. 2a German Patent Law). The Board, however, points out that courts should aim at interpreting the EPC provisions on patentable subject-matter in a consistent manner, wherever possible, and that, to rely on the possibility that inconsistencies might be partially remedied by national infringement provisions appears to be the second-best solution (T 1242/06 II, point 66).

Based on the above-summarized considerations, Technical Board 3.3.04 referred the case T 1242/06 II to the Enlarged Board with the questions of law basically corresponding to Questions 1, 2(b) and 3 quoted in section 1.3 (*supra*).

- 3.1.3 In referral T 83/05 II, Technical Board 3.3.04 considered that the reasoning set forth in T 1242/06 II is directly applicable also to the "broccoli" case (T 83/05 II, points 13 to 20 of the Reasons). It was decided to opt for a referral to the Enlarged Board (rather than merely staying the case), *inter alia* because this case contains additional relevant aspects not yet covered by the "tomato" case (i.e. the product-by-process and the disclaimer aspect; see above Questions 2(a) and 4; T 83/05 II, points 21 to 29 of the Reasons).

3.2 Interpretation of Article 53(b) EPC

- 3.2.1 It is commonly established that Articles 31 and 32 of the Vienna Convention (VC) on the Law of Treaties provide guidance for how to interpret the EPC (see, e.g., G 5/83, points 3 to 6 of the Reasons; G 2/06, point 16 of the Reasons; G 1/07, point 3.1 of the Reasons; G 2/07 and G 1/08, point 4.3 of the

Reasons; G 2/08, points 4.1 and 4.2 of the Reasons; and G 3/08, point 7.2 of the Reasons). These Articles read as follows:

“Article 31: General rule of interpretation

1. A treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose.
2. The context for the purpose of the interpretation of a treaty shall comprise, in addition to the text, including its preamble and annexes:
 - (a) any agreement relating to the treaty which was made between all the parties in connection with the conclusion of the treaty;
 - (b) any instrument which was made by one or more parties in connection with the conclusion of the treaty and accepted by the other parties as an instrument related to the treaty.
3. There shall be taken into account, together with the context:
 - (a) any subsequent agreement between the parties regarding the interpretation of the treaty or the application of its provisions;
 - (b) any subsequent practice in the application of the treaty which establishes the agreement of the parties regarding its interpretation;
 - (c) any relevant rules of international law applicable in the relations between the parties.
4. A special meaning shall be given to a term if it is established that the parties so intended.

Article 32: Supplementary means of interpretation

Recourse may be had to supplementary means of interpretation, including the preparatory work of the treaty and the circumstances of its conclusion, in order to confirm the meaning resulting from the application of Article 31, or to determine the meaning when the interpretation according to Article 31:

- (a) leaves the meaning ambiguous or obscure; or
- (b) leads to a result which is manifestly absurd or unreasonable.”

3.2.2 The keywords in Article 31(1) VC for defining the way a treaty is to be interpreted are “good faith”, “ordinary meaning”, “context” and “object and purpose”. Article 31(2) VC further defines the term “context” as referring to agreements made by the parties in connection with the treaty. Article 31(3) VC defines further factors to be taken into account, such as subsequent agreement or practice established by the parties. Importantly, Article 31(4) VC foresees that, to give a term a special meaning (obviously as opposed to the “ordinary meaning”), it must be clear that this was so intended.

Article 32 VC defines situations when supplementary means of interpretation (such as preparatory work or circumstances of the treaty’s conclusion) are to be taken into account, namely to confirm the meaning resulting from the application of Article 31, or to determine the meaning when the interpretation according to Article 31 leads to unsatisfactory results.

3.2.3 Without wishing to analyse the judicial implications of Articles 31 and 32 VC in detail, it appears undisputable that a fair, good faith reading of the treaty is the primary source of interpretation. “Good faith”, in the EPO case law also understood as “protection of legitimate expectations”, or in other contexts of international civil law as “a principle of fair and open dealing”, should mean that a provision of the EPC should be given the meaning as it directly transpires to the unbiased competent addressee from its terms. An interpretation that can be drawn from the provision only indirectly, by putting up certain intermediate conclusions should generally be avoided. This way of interpreting a treaty also seems to be reflected by the term “ordinary meaning” in Article 31(1) VC.

3.2.4 In view of these principles alone, it is already clear that Article 53(b) EPC cannot provide a basis for excluding from patentability plants other than individual plant varieties. The Article contains two exclusions relevant to plant-related matter:

- (i) the product exclusion of “plant varieties”; and
- (ii) the process exclusion of “essentially biological processes for the production of plants”.

It is generally undisputed and belongs to established case law that the product exclusion cannot be extended to a definition of plants going beyond plant varieties (G 1/98; acknowledged by referral T 1242/06 II, points 33 to 39 of the Reasons). Moreover, following the approach of a fair, good faith reading as demanded by Article 31(1) VC, a process exclusion cannot be applicable to anything else but a process. It would be against the principle of legitimate expectations if a process exclusion were to take effect on a product claim. Such an interpretation would also go against the requirement to interpret the terms according to their “ordinary meaning”. A specific basis would be required in the law, or in a documentation of the legislator’s intentions, for a deviating practice giving a special meaning to a term according to Article 31(4) VC. However, such basis does not exist.

Thus, already by duly interpreting the text of Article 53(b) EPC, an exclusion of plants other than plant varieties is not derivable therefrom.

3.2.5 The above interpretation of Article 53(b) EPC is further supported by the treaty’s context in the sense of Article 31(1) VC. In this regard, the Biotech Directive 98/44/EC (in the following “Directive”) is relevant (see accordingly G 2/06, point 16 of the Reasons). Thus, the Directive can be seen as subsequent agreement or practice in accordance with Article 31(3) VC to be taken into account for interpreting Article 53(b) EPC. The same should also apply to Rules 26 to 29 EPC which are directly based on Articles 2 to 6 of the Directive. Rule 26(1) EPC expressly requires that the Directive shall be used as a supplementary means for interpreting the EPC in connection with biotechnological inventions.

The Directive leaves no doubt that it is generally desired to provide patent protection for biological inventions in the broadest sense (see, e.g., Recitals (1) and (3) and Article 3(1) of the Directive).

In Article 4(1), the Directive excludes plant varieties and essentially biological inventions from patentability, and explicitly clarifies in Article 4(2) that inventions which concern plants shall be patentable if the technical feasibility is not confined to a particular plant variety (see correspondingly Recital (29)).

Thus, the Directive clearly provides for the general patentability of plant-related inventions except for specifically excluded matters (i.e. plant varieties and essentially biological processes for the production of plants).

There is no indication in the Directive from which one could derive that the process exclusion in Article 4(1)(b) shall extend to products of such processes. Quite to the contrary, Article 4(2) and Recital (29) positively foresee the patentability for plants more broadly defined than plant varieties (without specifying anyhow the way in which the plants are produced). Hence, in the sense of Article 31(3) VC, the Directive corroborates that the process exclusion of Article 53(b) EPC does not provide any basis for denying patentability for plants other than plant varieties.

3.2.6 Coming to the “object and purpose” criterion of Article 31(1) VC: It appears to be common ground that the product exclusion of Article 53(b) EPC was included in the law in the context of avoiding double protection by patents and plant variety protection (PVP). This was clearly determined by the Enlarged Board of Appeal in its decision G 1/98 (see points 3.4 to 3.10 and 5.3 of the Reasons). For instance, the Enlarged Board of Appeal derived the following conclusions:

“3.6 This background suggests that the purpose of Article 53(b) EPC corresponds to the purpose of Article 2(b) SPC: European patents should not be granted for subject-matter for which the grant of patents was excluded under the ban on dual protection in the UPOV Convention 1961.”
 (G 1/98, point 3.6 of the Reasons; emphasis added)

“[...]Article 53(b) EPC defines the borderline between patent protection and plant variety protection. The extent of the exclusion for patents is the obverse of the availability of plant variety rights. The latter are only granted for specific plant varieties and not for technical teachings which can be implemented in an indefinite number of plant varieties.”
 (G 1/98, point 3.10 of the Reasons)

In arriving at this finding, the Enlarged Board also analyzed whether the way in which a plant variety is produced is of any relevance for the applicability of the product exclusion and clearly denied this (G 1/98, Headnote III and section 5).

As further evidence, we herewith refer to the Legal Opinion by Prof. Straus which was filed in the appeal proceedings T 1054/96 (referral to G 1/98) and which certainly had an important impact on the final result of the decision G 1/98 (see the enclosed Opinion (document A), e.g. B.I.2, as well as the annexed documents 1 to 34).

The process exclusion of Article 53(b) EPC follows the same object and purpose as the product exclusion. This was so determined by the Enlarged Board of Appeal in G 2/07 (see point 6.4.2.3 of the Reasons). In particular, the Enlarged Board of Appeal derives the following from the travaux préparatoires:

“Although the explanations given with regard to plants are rather rudimentary, they nevertheless contain some indication that at that point in time the legislator was concerned with excluding from patentability the processes applied by plant breeders in connection with the creation of new plant varieties, for which a special property right was going to be introduced under the UPOV Convention. It must be concluded that the legislator's intention was to exclude from patentability the kind of plant breeding processes which were the conventional methods for the breeding of plant varieties of that time. These conventional methods included in particular those (relevant for the present referrals) based on the sexual crossing of plants (i.e. of their whole genomes) deemed suitable for the purpose pursued and on the subsequent selection of the plants having the desired trait(s).”

(G 2/07, point 6.4.2.3, third paragraph of the Reasons)

Thus, the legislative intention to avoid double protection by patents and PVP was the starting point for the Enlarged Board of Appeal to derive the presence of a crossing and selection step as the decisive criterion for the process exclusion under Article 53(b) EPC.

This means that, for the purposes of interpreting Article 53(b) EPC, the mentioned “essentially biological processes for the production of plants” are generally meant to correspond to the activities of a breeder to produce new

plants susceptible to plant variety protection. Otherwise, the reference of the Enlarged Board of Appeal to UPOV would not make sense.

3.2.7 In this context, it is sometimes pointed out that the legislator intended to also exclude from patentability processes which produce known plant varieties (see e.g. T 83/05 I, point 40 of the Reasons). However, this aspect is certainly of minor significance given the fact that, once a new plant variety is obtained, one would normally propagate that one rather than taking the cumbersome efforts to reproduce the breeding of the very same variety. If at all, the breeding of known varieties has significant impact in the production of hybrid seed starting from well-defined starting inbred lines (such as the method dealt with in T 320/87), where however plant variety rights may be of interest with regard to the starting lines. In any case, breeding methods that produce known plant varieties would not be relevant for the questions at stake since, if a known plant variety is bred, this can hardly be covered by a product patent.

Thus, it is reasonable to assume, and in fact fully in line with the findings in G 2/07, that the object and purpose of the process exclusion of Article 53(b) EPC must be seen in the context of avoiding an overlap with the PVP system. In other words, the process exclusion serves to free the breeder from patent coverage insofar as his activities aim at obtaining plant varieties.

3.2.8 In G 2/07, the Enlarged Board of Appeal pointed to the conceptual difference between the term “plants” in the process exclusion and the term “plant varieties” in the product exclusion and derived therefrom that the exclusion of Article 53(b) EPC cannot be restricted to processes of producing plant varieties (see G 2/07, point 6.1.1 of the Reasons). However, this view would be at odds with the object and purpose of the Article and needs to be revised. The Enlarged Board of Appeal itself pointed to the travaux préparatoires discussing the process exclusion in which the terms “plants” and “plant varieties” are exchangeably used (see G 2/07, point 6.4.2.2, second paragraph of the Reasons). Moreover, the omission of the word “varieties” in the formulation reflecting plant breeding methods might be explainable by the legislator’s intention to cover any kind of breeder’s activity ultimately leading to a plant variety, such as those including, e.g., the generation of inbred lines or

initial interspecific crosses (see, e.g., step (a) in the method recited in claim 1 in section 1.2, *supra*), which do not immediately result in a plant variety according to the established definitions (see e.g. Rule 26(4) EPC and the Legal Opinion by Prof. Straus).

3.2.9 Furthermore, as is reported by Prof. Straus, in the course of preparing the 1991 UPOV revision, the involved delegations rejected a suggestion according to which holders of PVP rights should be exempted from dominance by plant-related patents (see Legal Opinion by Prof. Straus, B.IV.2). Thus, it was obviously intended by the legislator that patents may dominate PVP. In the context of the present case, this means that a generic claim to a plant may not only embrace plant varieties, but also the results of essentially biological processes for the production of plants.

3.2.10 In view of the above, it is the position of **epi** that the logic applied in G 1/98 why a generic claim to a plant cannot fall under the product exclusion of Article 53(b) EPC, even if it embraces individual plant varieties, also applies to such a generic claim insofar as it covers products of an excluded breeding process. Thus, it is in line with the overall object and purpose of the plant-related provisions of Article 53(b) to avoid double protection with PVP when a generic patent claim to plants embraces individual products of an essentially biological process for the production of plants.

3.2.11 To conclude: An interpretation of Article 53(b) EPC in accordance with Articles 31 and 32 VC reveals that its process exclusion does not affect patentability of product claims to plants.

3.3 The scope of protection should not be considered in the substantive examination of a claimed subject-matter

3.3.1 The approach to suggest that the process exclusion of Article 53(b) EPC should bar products of an excluded process from patentability must also fail for the reason that the EPC does not provide any basis for taking into account, in the substantive examination of the patentability of a claimed invention, the scope of protection conferred by a patent claim. What is relevant in this regard

is the subject-matter of the claim, defined by the claim category and the recited technical features. This is supported by the following parts of the Case Law book, 7th edition, II.A.1:

“1.1. Purpose of claims

The Enlarged Board explained in decision **G 2/88** (OJ 1990, 93, Corr. 469) that the primary aim of the wording used in a claim must be to satisfy the requirements under Art. 84 and R. 29(1) EPC 1973 (R. 43(1) EPC), having regard to the particular nature of the invention, and the purpose of the claims. The purpose of claims under the EPC is to enable the protection conferred by the patent or patent application to be determined (Art. 69 EPC), and thus the rights of the patent owner within the designated contracting states (Art. 64 EPC), having regard to the patentability requirements of Art. 52 to 57 EPC.

1.3. Technical features

Under the EPC the claims must define the matter for which protection is sought "in terms of the technical features of the invention" (R. 43(1) EPC). In **G 2/88** the Enlarged Board described the technical features of the invention as being the physical features which are essential to it. The technical features of a claim to a physical entity are the physical parameters of the entity, and the technical features of a claim to an activity are the physical steps which define such activity. The Enlarged Board of Appeal also pointed out, however, that the boards of appeal had in a number of cases allowed the technical features to be defined functionally in certain instances (e.g. **T 68/85**, OJ 1987, 228; **T 139/85**).“

3.3.2 Thus, for the examination as to whether a claim meets Article 53(b) EPC, its subject-matter defined by technical features is to be considered, and not the scope of protection conferred by the claim. This principle was also applied by the Enlarged Board of Appeal in G 1/98 when it had to decide on the question of law:

“3. Should the provisions of Article 64(2) EPC be taken into account when considering what claims are

allowable?”
(G 1/98, point I)

The question was answered in the following way:

“II. When a claim to a process for the production of a plant variety is examined, Article 64(2) EPC is not to be taken into consideration.”
(G 1/98, Headnote II)

In its underlying reasoning, the Enlarged Board of Appeal referred to the established principle “according to which the protection conferred by a process patent is extended to the products obtained directly by the process, even if the products are not patentable per se” and accordingly observed the systematics of the EPC: i.e. the requirements on patentability to be examined by the EPO are contained in Part II, Chapter I EPC (Articles 52 to 57); whereas Article 64(2) EPC belongs to Part II, Chapter III, containing provisions concerning the effects of patents and patent applications and is to be applied by the Courts responsible for deciding on infringement cases (G 1/98, point 4 of the Reasons). Thus, G 1/98 clearly supports the principle that it is the subject-matter of a claim and not the scope of protection which is to be considered in the examination of Article 53(b) EPC.

3.3.3 The referral T 1242/06 II, however, held that the above reasoning of G 1/98 may not be applicable to the situation dealt with herein because a distinction is to be made between the broad compound protection that would be allowable despite the process exclusion and the narrow compound protection conferred by a process for producing a plant variety under Article 64(2) EPC despite the exclusion of plant varieties (T 1242/06 II, points 58 and 59 of the Reasons). It is the position of **epi** that, for such a distinction to be made, there is no basis in the EPC. As outlined above, the overriding principle is that only the subject-matter of a claim, and not the scope of protection, is relevant for the patentability examination.

3.4 The concept of absolute compound protection supports dominance of product claims on plants over essentially biological processes for the production of plants

3.4.1 The dominance of a product claim directed to plants over an essentially biological process which produces such plants is fully in line with the established principles applied by the EPO and codified in the Directive. If an invention relates to generically defined novel and inventive plants, then this contribution merits broad compound protection. In view of this, and in line with the generally applied doctrine of absolute compound protection, it would be difficult to understand why a breeder should be free to work in the area claimed by a product patent on a plant without patentee's consent. In particular, why should it be justified that the breeder be allowed to generate a plant variety sharing the advantageous inventive properties of the protected plant? In line with the established system, said breeder should be able to do so only with the consent of proprietor of the product patent. Under such circumstances, said breeder would also be able to acquire plant variety protection.

3.4.2 The issue of patent dominance over breeder's activities can also occur when a breeder wants to use a patented plant as starting material for developing a new plant variety. Then, it may likewise happen that a breeder depends on the consent of a patentee. There is nothing wrong about it. And actually, the Directive indirectly sanctions this practice by foreseeing in Article 12 regulations of compulsory cross-licensing for the case that a patent owner unjustifiably withholds granting a licence to a breeder aiming at acquiring a plant variety right (see also G1/98, point 3.9 of the Reasons).

3.5 The Dutch Court confirms that the process exclusion of Article 53(b) EPC does not affect product claims

3.5.1 The **epi** would like to point out an important decision of a Dutch court in the area of patentability of plants derived by essentially biological processes. This decision is of major relevance for the present referral since the issues in the Dutch case are nearly identical to those discussed in case G 2/13.

The litigated patent in the Dutch case contained a product-by-process claim concerning a *Raphanus sativa* plant with a certain minimum level of anthocyanins. The described process could be considered as an essentially

biological process within the meaning of Article 53(b) EPC. Also in the Dutch case, it was disputed whether the exclusion of Article 53(b) EPC of essentially biological processes for the production of plants could have a negative effect on the allowability of product claims concerning plants.

- 3.5.2 The judge in the interim proceedings (“kort geding”) had denied injunctive relief. He was of the preliminary opinion that the invoked claims fell under the exclusion of Article 53(b) EPC (see the enclosed document E, decision of the Court of First Instance in The Hague from 31 January 2012, *Taste of Nature v. Cresco*, points 4.7 to 4.13).
- 3.5.3 On the merits, however, the court concluded that plants, such as the one in dispute, are not excluded from patentability (see the enclosed document F, decision of the Court of First Instance in The Hague from 8 May 2013, *Taste of Nature v. Cresco*, points 5.1 to 5.11). For an English translation of the relevant parts of the decision, we refer to the Third Party Observation filed on behalf of Taste of Nature in case G 2/12 (dated 3 July 2013).
- 3.5.4 Even though the court was aware of the fact that the referral in case G 2/12 was still pending before the Enlarged Board of Appeal, it decided not to stay the proceedings on the express request of both parties. The court noted that it was uncertain whether case G 2/12 would be decided at all since the opponent had withdrawn the appeal. Furthermore, both parties had estimated that it would take years before a judgment in case G 2/12 would be rendered. (See point 5.1).
- 3.5.5 In line with the argumentation in section 3.2 of this amicus curiae brief (*supra*), the Dutch court regarded Article 31 of the Vienna Convention on the Law of Treaties as the yardstick for the interpretation of Article 53(b) EPC. This provision states that a treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose. On this basis, the court concluded that the claimed plant did not fall under Article 53(b) EPC for the reasons explained below. (See point 5.3).

- 3.5.6 The court confirmed the **epi**'s opinion expressed in section 3.2.4 (*supra*) regarding the ordinary meaning of the relevant terms in their context. The court reasoned that the applicable part of Article 53(b) EPC, according to its wording, exclusively relates to “processes”, whereas the claimed plant concerned a product. In the court’s view, it made no difference in this regard that the claimed plant was partly defined by its production method. In light of the consistently used distinction between the terms “process” and “product” in the EPC, the court concluded from the use of the term “process” that the drafters of the Convention had consciously chosen to exclude products from the scope of the applicable part of Article 53(b) EPC. Moreover, the court found that the importance of the distinction between processes and products was emphasised by the fact that this distinction can also be found in Article 53(b) EPC itself. Apart from the exclusion of processes, this provision contains a specific exclusion for certain products, namely plant or animal varieties. (See point 5.4).
- 3.5.7 The court rejected the argument that patentability of plants obtainable through essentially biological processes would undermine the exclusion of these processes. The court found it unlikely that this exclusion could easily be circumvented by replacing a process claim by a product-by-process claim. In this respect, it explained that fundamentally different requirements apply to patentability of a breeding method, on the one hand, and of a plant claimed as a product-by-process, on the other hand. The latter concerns a product invention for which a patent can only be granted if the plant is new and inventive. The mere fact that the process by which the plant is obtained is new and inventive does not make the plant new and inventive. Hence, an inventor who has merely developed a new and inventive variant of an essentially biological process cannot avoid the exclusion by formulating his invention as a product-by-process claim. In other words, the inventor can only overcome the exclusion by making another invention which is not excluded from patentability. This would not result in an erosion of the exclusion. (See point 5.5). The **epi** endorses this reasoning of the Dutch court, which acknowledges the fundamental distinction between the different types of subject-matter.
- 3.5.8 In accordance with the **epi**'s position as stated in section 3.3 (*supra*), the

Dutch court indicated that only the subject-matter of a claim, and not the scope of protection, is relevant for the patentability examination. The court did not accept the argument that the process exclusion should apply because the patent would give the patentee the right to enjoin the production of the claimed plant and would thus indirectly protect the process by which the plant is derived. Merely the claimed subject-matter, i.e. the invention as defined by the claims, must fulfil the patentability requirements. The fact that the production of the claimed subject-matter belongs to the exclusive domain of the patentee does not make it part of the claimed subject-matter. A contrary assessment would have the absurd consequence that no product would be patentable anymore since there will always be reserved acts which do not satisfy the patentability requirements, not least because many reserved acts are not new and inventive. (See point 5.7).

Along the same lines, the court denied the relevance of Article 64(2) EPC with regard to the interpretation of the exclusion of Article 53(b) EPC. Article 64(2) EPC provides that the protection conferred by a process patent extends to the products directly obtained by such process. This provision does not relate to the validity of patents but to the legal effects of a patent. Hence, the court (also referring to case G 1/98) concluded that Article 64(2) EPC is not applicable in the context of Article 53(b) EPC. The court did not see any reason for applying Article 64(2) EPC by analogy either. From the fact that the legislator intended to protect a product where its production method is protected, it does not follow that if the legislator did not wish to protect a process, also the products derived therefrom shall not be protected. Such a conclusion can in any case not be drawn with regard to the specific exclusion in question. That such a conclusion is moreover generally incoherent, is evident from the fact that the principle that non-novel processes are not patentable does not preclude that patents are granted for new products of those processes. (See point 5.9). These considerations of the Dutch court support the **epi's** opinion put forward in section 3.3 (*supra*).

- 3.5.9 As will be argued below in section 5.2.2, the **epi** is of the view that case G 2/06 is not relevant for the interpretation of Article 53(b) EPC. In conformity with the **epi's** opinion, the Dutch court held that it cannot be concluded from the

judgments in case G 2/06 and the *Brüstle* case (CJEU, 18 October 2011, case C-34/10, *Brüstle v. Greenpeace*) that an exclusion related to processes always includes the products obtained by such processes.

The exclusion of uses of human embryos for commercial purposes within the meaning of Article 6(2)(c) of the Biotech Directive and Rule 28(c) EPC is not a process exclusion but an exclusion for all inventions (thus processes *and* products) which relate to the use of human embryos. The question in these cases was not whether the products of an excluded process could fall under the exclusion but whether a claim which does not explicitly mention the use of embryos could nonetheless relate to such use within the meaning of the above mentioned provisions.

In addition, the court emphasised the fundamentally different purposes of the exclusion of commercial uses of human embryos, on the one hand, and the exclusion of essentially biological processes for the production of plants, on the other hand. The commercial use of human embryos is deemed to be contrary to morality within the meaning of Article 53(a) EPC and therefore serves to avoid that the excluded technologies are applied. The process exclusion of Article 53(b) EPC has an opposite purpose. This exclusion is meant to give breeders the possibility to develop new plant varieties with classical breeding methods (also referring to case G 1/08, p. 66).

The court concluded that the above mentioned decisions address such a fundamentally different legal question that they do not provide any guidance for the interpretation of Article 53(b) EPC. (See point 5.8).

3.5.10 It is noted that the Dutch Patent Act of 1995 (“Rijksoctrooiwet 1995”) in Article 3(1)(d) does not only exclude from patentability essentially biological processes (entirely consisting of natural phenomena such as crossings and selections) for the production of plants (or animals) but also the products obtained as a result. However, the Dutch court assessed the patent in dispute on the basis of the EPC. It did not regard the text of a national law, such as the Dutch Patent Act of 1995, to be relevant for the interpretation of the Convention. (See point 5.10).

The court concluded that under the existing law, plants, such as the ones claimed in the patent in dispute, are not excluded from patentability. The court refused to consider political arguments against the patentability of plants, such as those put forward in the resolution of the EU-Parliament. Apart from the fact that there also exist political arguments in favour of patentability, the court acknowledged that taking such political arguments into account would go beyond the task of the judge. (See point 5.11).

This reasoning is in line with the **epi**'s view as expressed in section 1.1.2 (*supra*) and in section 3.7 (*infra*) concerning the German Patent Act. The Enlarged Board of Appeal should resist political pressure and respect the current wording of the EPC.

3.5.11 In conclusion, the **epi** entirely endorses the Dutch decision, which provides a logical and consistent reasoning with regard to the questions at issue.

3.5.12 This decision has been confirmed by the Court of Appeal in the interim proceedings (see the enclosed document G, decision of the Court of Appeal in The Hague from 28 May 2013, *Taste of Nature v. Cresco*, point 5.3). The Court of Appeal annulled the preliminary judgment and granted injunctive relief to the patentee (see point 5.14).

3.6 Additional problem arising from the broad interpretation of the process exclusion of Article 53(b) EPC in G 2/07

3.6.1 A further problem arises from the broad scope of the process exclusion as determined by the Enlarged Board of Appeal. In G 2/07, the Enlarged Board of Appeal held that the presence of additional technical steps (e.g. genetic engineering) either upstream or downstream of the steps of sexual crossing and selection does not bring a plant production process out of the process exclusion of Article 53(b) EPC (G 2/07, point 6.4.2.3, penultimate paragraph). This has a paradoxical consequence: Should the notion prevail that products of an excluded essentially biological process for the production of plants in the sense of G 2/07 are also not patentable, genetically engineered plants may

also not be patentable under Article 53(b) EPC. Of particular concern are for instance mixed processes comprising both technical (i.e. non-biological) and biological steps.

3.6.2 The following hypothetical claims illustrate this:

- “1. Process for producing a transgenic plant having property X, comprising:
 - (a) genetically engineering a plant by introducing into its genome heterologous gene Y; and
 - (b) crossing the transgenic plant obtained in step (a) with an elite line of the same species and selecting for property X.
2. Transgenic plant obtainable by the process of claim 1.
3. Process for producing a transgenic plant having property X, comprising the step of genetically engineering a plant by introducing into its genome heterologous gene Y.
4. Transgenic plant obtainable by the process of claim 3.
5. Transgenic plant having property X comprising in its genome heterologous gene Y.”

3.6.3 First of all, according to G 2/07, process claim 1 would certainly fall under the exclusion of Article 53(b) EPC because, by step (b), it comprises sexual crossing and selection. The presence of additional step (a) being clearly of technical nature does not escape the claim from the exclusion.

3.6.4 At first glance, the conclusion might be different for claim 3 since it does not recite any crossing and selection step. However, even this is not certain. Of relevance is the following assessment of the Enlarged Board of Appeal:

“For the previous or subsequent steps *per se* patent protection is available. This is the case, for example, for genetic engineering techniques applied to plants which techniques differ profoundly from conventional breeding techniques as they work primarily through the purposeful insertion and/or modification of one or more genes in a plant (cf T 356/93 *supra*). However, in such cases the

claims should not, explicitly or implicitly, include the sexual crossing and selection process.”

(G 2/07, point 6.4.2.3 of the Reasons, penultimate paragraph; emphasis added)

Hypothetical claim 3 does not explicitly include crossing and selection. However, whether or not the claimed process “implicitly includes” such steps is difficult to say. At least, the process is defined by using the “comprising” language which means according to the usual interpretation of method claims having “comprising” language that the process may contain, apart from the recited genetic engineering step, one or more additional steps (such as crossing and selection). Thus, it cannot be excluded that claim 3 would likewise fall under the process exclusion. To avoid this safely, the claim would have to be amended to “consist of” the genetic engineering step. Evidently, such a claim would be of limited value.

3.6.5 Turning to the hypothetical product claims: If one applied the approach suggested in referral T 1242/06 II, i.e. that a product of a prohibited process must not be patentable, this would mean that claim 2, though explicitly referring to a “transgenic plant”, would violate Article 53(b) EPC. Interestingly, the violation would not be caused by the Article’s product exclusion since the claim is not directed to one or more individual plant varieties (G 1/98). The violation would be caused by the provision in Article 53(b) EPC that “patents shall not be granted in respect of essentially biological processes for the production of plants”. This vividly shows how far the law would be stretched if the suggested product exclusion on the basis of the process-related provision in Article 53(b) EPC will be accepted by the Enlarged Board of Appeal.

3.6.6 Regarding hypothetical claim 4, the uncertainty as to the applicability of the exclusion clause mentioned above for process claim 3 would also extend to the corresponding product-by-process claim. That this is a realistic risk is another striking problem about the suggested extension of the process exclusion as defined in G 2/07 to products obtained thereby.

3.6.7 Finally, one may wonder whether claim 5, being a classical structurally defined product claim, could possibly have a problem under Article 53(b) EPC. The

definition is clearly broader than individual plant varieties so that, in accordance with G 1/98, the product exclusion would not apply. However, the claim is totally open as regards the way in which the plant is produced. Claim 5 would therefore cover plants that have undergone steps of crossing and selection, before or after the genetic engineering step. Thus, it appears as if even this classical structurally defined transgenic plant claim would not be safe from falling under the Article 53(b) process exclusion, should this exclusion be expanded to plants obtained by an excluded process.

3.6.8 From the above considerations on the hypothetical claims, one could consider as a possible way out to define a transgenic plant in the claim as the product of a process which consists of the genetic engineering step (and maybe other steps other than crossing and selection). However, whether this indeed would solve the problem is still unclear given the principle of absolute compound protection. Moreover, as everyone working in this technical field would immediately understand, such a claim would be of limited value. Presumably, there is no example of a transgenic plant that was marketed without having undergone at least one round of crossing and selection after the genetic engineering. Thus, a claim solely defining a transgenic plant as the product of a genetic engineering step would not provide an effective scope of protection.

3.6.9 To conclude, the example of the above-discussed hypothetical claims shows which extreme, and obviously undesirable, consequences an extension of the process exclusion of Article 53(b) EPC to products of the excluded processes would have. In the light of the above-described consequences to be expected from combining the overly broad process exclusion determined in G 2/07 with the suggested extension of the process exclusion to so-produced products, it is evident that a positive answer to Question 1 would likely have a devastating effect on the plant industry active in Europe.

3.7 Implications of the amendment of the German Patent Act

3.7.1 With enactment of June 27, 2013, the German Parliament (Bundestag) agreed to an amendment of Section 2a of the German Patent Act so as to read as follows:

“Section 2a

(1) Patents shall not be granted for

1. plant or animal varieties;
2. essentially biological processes for the production of plants or animals **and plants and animals exclusively obtained by such processes;**

[...]”

(wording added by the amendment is highlighted in bold type)

Thus, the German legislator decided to deviate from the Directive (see Article 4(1)(b)) by supplementing the existing product and process exclusions (as in Article 53(b) EPC) with another product exclusion directed to plants (and animals) exclusively obtained by essentially biological processes.

3.7.2 At face value, this legislative act indicates that the process exclusion without the supplement would not provide a basis for generally banning the products of essentially biological processors from patentability. One could argue that, otherwise, there would have been no need for the amendment.

3.7.3 On the other hand, the officially stated reasoning behind this amendment seems to be different (see enclosed documents B and C, copy of Bundestagsdrucksache 17/14222, see part IV, “Zu Nummer 1” and English translation of that part). In particular, the opinion is expressed that the amendment has merely clarifying quality; see:

“The Federal Government is of the opinion that, according to the object and purpose of Article 4 of the Biopatent Directive, the patentability exclusion should mandatorily also apply to such animals and plants. The non-patentability of conventional breeding processes could otherwise be easily circumvented.

...

Products derived from biologically bred animals or plants, such as plant oils, should remain patentable provided they comply with the other patentability requirements. Only with a formulation which clearly relates the patentability exclusion of processes and products to the same matter, i.e. “plants and animals”, it will be possible to comply with the available scope for national regulations defined by the EU-Biopatent Directive which is particularly restricted to clarifications.”

(document C)

However, to call the amendment a mere clarification of something that was there beforehand obviously serves the purpose of avoiding an impermissible discordance with the Directive, potentially bearing the risk of a trial before the ECJ. That the legislator's assessment is correct may be questioned. In support, we refer to a Legal Opinion by Prof. Kraßer of the Max-Planck-Institute for Intellectual Property and Competition Law on the draft amendment (see enclosed document D; last page, penultimate paragraph).

- 3.7.4 From the legislator's reasoning furthermore transpires that the added product exclusion is intended to solely cover purely conventionally bred plants; see:

“The use of the term “exclusively” shall safeguard that undisputably patentable, especially genetically modified plants and animals will not be covered by the patentability prohibition because of the fact that they additionally underwent an essentially biological crossing and selection process.”
(document D)

However, whether the term “exclusively” indeed fulfils the intended purpose appears to be questionable. At least if the interpretation of G 2/07 is applied to the term “essentially biological processes for the production of plants”, transgenic plants may well be covered by the exclusion (see also section 3.6, *supra*).

- 3.7.5 To conclude: The fact that the German legislator saw a need for introducing a specific exclusion clause for plants produced by essentially biologically processes clearly supports the notion that the process exclusion as such does not exclude such plants from patentability.

3.8 Conclusion

In view of the above, it is clear that, for various reasons, the exclusion of essentially biological processes for the production of plants in Article 53(b) EPC cannot have any negative effect on the allowability of a product claim directed to plants or plant material. Thus, Questions 1 and 3 are to be answered in the negative.

4. QUESTION 2(A)

4.1 Reasoning of the referring Board

The idea to raise a specific question addressing product-by-process claims was suggested in referral T 83/05 II. It reflects the fact that this case concerns true product-by-process claims, whereas in the parallel tomato case the claimed tomato fruit are differently defined.

4.2 The view of the epi

It is not apparent why product-by-process claims should be treated differently from other product claims to plants. Following the doctrine of absolute compound protection generally applied by the EPO, a claimed plant defined as a product-by-process may also be produced in a manner different from said process. It is decisive that the plant as such fulfils the requirements of novelty and inventive step. In view of this, **epi** does not see any reasons why such a claim should be treated in the context with the Questions relating to Article 53(b) EPC at stake any different than other product claims to plants. Thus, Question 2(a) is to be answered in the affirmative.

5. QUESTION 2(B)

5.1 Reasoning of the referring Board

Referral T 1242/06 II does not seem to contain an express justification for Question 2(b). It particularly refers to situations in which, for the production of a claimed plant, only essentially biological methods were available at the filing date. However, the mere existence of Question 2(b) implies that such a fact situation could require special considerations. For instance, it could be argued that, in such a situation, reproducibility in the sense of Article 83 EPC (i.e. based on the patent's teaching and common general knowledge of the skilled person) necessarily requires to practice a process excluded from patentability.

Moreover, T 1242/06 II refers in points 50 to 52 to G 2/06 as an example where the Enlarged Board of Appeal ruled the following:

“Rule 28(c) EPC forbids the patenting of claims directed to products which – as described in the application – at the filing date could be prepared exclusively by a method which necessarily involved the destruction of the human embryos from which the said products are derived, even if the said method is not part of the claims.”

(G 2/06, Headnote, Answer to Question 2; emphasis added)

5.2 The view of the epi

5.2.1 It has been shown above (sections 3.2 to 3.8, *supra*) that, fundamentally and for various reasons, the process exclusion of Article 53(b) EPC can have no negative effect on the allowability of product claims on plants. This also applies to the specific fact situation that no other teaching is provided at the filing date than excluded processes.

5.2.2 Furthermore, G 2/06 is not a model for the issues to be considered in the present case. The gist of that decision was that a product must not be patentable if its production, according to the teaching made available at the filing date, necessitates the destruction of human embryos, which was considered unethical and, therefore, against Article 53(a) EPC. However, no such ethical concerns arise when one has to perform an essentially biological process in order to produce a patented plant. There is also no other reason derivable from the EPC or the legislator's intentions why this should be the case (see sections 3.2. to 3.7, *supra*). Thus, even if no other process is available at the filing date than essentially biological ones, the conclusion can only be that product claims cannot be negatively affected by the process exclusion of Article 53(b) EPC.

5.2.3 In view of the above, Question 2(b) is to be answered in the affirmative.

6. QUESTION 4

6.1 Reasoning of the referring Board

6.2 Referral T 83/05 II discusses the question whether a potential negative effect of the process exclusion on the allowability of plant claims could be resolved by the use of a disclaimer (points 26 to 28 of the Reasons). As regards the effect of such a disclaimer, the Board considers the following:

“The wording of the clauses indicates that the respondent does not intend to disclaim all **plants or plant parts** that are produced by an essentially biological process. Rather the respondent appears to seek to waive **a part of the prerogatives of the owner of a product patent** which encompass the right to prohibit others from producing the claimed product in any manner. The possible effect of the respondent's proposed disclaimer is that producing the claimed product by an essentially biological process could no longer be prohibited.”

(T 83/05 II, point 27 of the Reasons; emphases in the original)

The Board already expresses some doubts as to the basis in the EPC for qualifying the rights which may be derived from the presence of a particular technical feature in a claim of that patent (T 83/05 II, point 28 of the Reasons). However, the Board nevertheless referred the disclaimer question to the Enlarged Board of Appeal since it saw some justification in the respondent's argument that the proposed disclaimer/waiver could solve the conflict between the patentability of plants (other than plant varieties) and the exclusion of essentially biological processes for the production of plants (T 83/05 II, point 28 of the Reasons).

6.2 The view of the epi

6.2.1 The **epi** fully supports the doubts expressed by the referring Board as regards support in the EPC for a disclaimer limiting the rights conferred by a patent claim.

6.2.2 Moreover, in the light of the above explanations, the process exclusion of Article 53(b) EPC can have no negative effect on the allowability of a product

claim directed to plants. Thus, the pre-condition for the potential applicability of a disclaimer in Question 4 does not exist. Therefore, Question 4 does not need to be answered.

6.2.3 Even if the pre-condition applied, the disclaimer could not be useful for resolving the problem. Here again, the principle needs to be considered that the European patent law clearly distinguishes between issues of patentability, which are governed by the EPC, and issues of infringement, which are a matter for the legislation of the contracting states (see e.g. T 1242/06 II, point 60 of the Reasons). According to Article 84 EPC, the claims shall define the matter for which protection is sought. Thus, the wording of a claim cannot define anything else but the claimed subject-matter. In particular, it cannot define any instructions for a national court to interpret the scope of protection conferred by the claim. Disclaimers are defined in the EPO case law as follows:

“In accordance with consistent practice, the term "disclaimer" is used hereafter as meaning an amendment to a claim resulting in the incorporation therein of a "negative" technical feature, typically excluding from a general feature specific embodiments or areas.”
(G 1/03, point 2 of the Reasons)

The same definition was used by the Enlarged Board of Appeal in G 2/10 (see point 2.2 of the Reasons).

Thus, a disclaimer excludes something specific from what is generically defined in a claim in terms of subject-matter. Accordingly, since a process is not the subject-matter of a product claim (even in the case of a product-by-process claim), a disclaimer can logically not exempt a process from a product claim. Therefore, the suggestion to resolve a possible negative effect of the process exclusion of Article 53(b) EPC on product claims to plants by way of a disclaimer must fail.

6.2.4 To summarize, Question 4 does not need to be answered because the contained pre-condition does not apply. In the hypothetical case it applied, the answer should be no.

7. SUGGESTED ANSWERS TO THE QUESTIONS OF LAW

To summarize the **epi**'s suggested answers to the Questions of Law referred to in G 2/13:

- Question 1: No (see section 3, *supra*)
Question 2(a): Yes (see section 4, *supra*)
Question 2(b): Yes (see section 5, *supra*)
Question 3: No (see section 3, *supra*)
Question 4: Not applicable, otherwise no (see section 6, *supra*)

8. ALTERNATIVE SUGGESTION

The Enlarged Board of Appeal may consider, as an alternative to the above-suggested answers to the Questions of law, to establish consistency between the product exclusion and the process exclusion of Article 53(b) EPC by revising its finding set out in G 2/07. The suggestion would be to re-interpret the term “essentially biological processes for the production of plants” so as to refer to plant production methods that result in a plant variety. This type of processes was for instance discussed in G 1/98 (see e.g. Headnote II).

This approach would have the advantage that it would resolve the legal points that led to referrals T 1242/06 II and T 83/05 II by making the plant-related exclusion clauses fully compatible. Apart from improving legal certainty and simplifying the matters, such a revised interpretation would also eliminate any potential drawbacks that currently arise from the overly broad interpretation of the process exclusion (see sections 3.6 and 3.7, *supra*). Moreover, it would comply with the fact that both exclusion clauses serve the object and purpose to avoid double protection by the patent and the PCP system (see section 3.2.6, *supra*).

ANNEX

List of documents cited in the amicus curiae brief of epi (attached on DVD)

A. Legal opinion by Prof. Straus dated October 31, 1996

- Following documents cited in the Legal opinion by Prof. Straus:

1. Adler, GRUR Int. 1988, 11 ff.
2. Brownlie, Principles of Public International Law, 4. Aufl. Oxford 1990, S. 628 ff.
3. Bruchhausen, GRUR Int. 1983, 205 ff.
4. Bruchhausen (in Benkard), 9. Aufl. München 1993, S. 222-226
5. Crespi, (1986) EIPR, 262 ff.
6. Christie, (1989) EIPR, 394 ff.
7. Greengrass, (1991) EIPR, 466 ff.
8. Jestaedt, GRUR 1982, 595 ff.
9. Lange, GRUR Int. 1985, 88 ff.
10. Lange, GRUR Int. 1996, 586 ff.
11. Neumeier, Sortenschutz und/oder Patentschutz für Pflanzenzüchtungen, Köln etc. 1990, S. 77 f., 208 ff., 220
12. Papke, Mitt. 1988, 61 f.
13. Pfanner, GRUR Int. 1962, 545 ff.
14. Schennen, Mitt. 1991, 129 ff.
15. Schrell, GRUR Int. 1995, 986 ff.
16. Schulte, 4. Aufl. Köln etc. 1987, S. 53-54
17. Schulte 5. Aufl. Köln etc. 1994, S. 61-63
18. Straus, GRUR Int. 1983, 591 ff.
19. Straus, Gewerblicher Rechtsschutz für biotechnologische Erfindungen, Köln etc. 1987, S. 74-77
20. Straus, Industrial Property 1987, 433 ff.

21. Straus, GRUR Int. 1990, 617 ff.
 22. Straus, GRUR 1993, 794 ff.
 23. Teschemacher, GRUR Int. 1987, 303 ff.
 24. Teschemacher, in FS Rudolf Nirk zum 70. Geburtstag, München 1992, S. 1005 ff.
 25. van de Graaf, GRUR Int. 1990, 632 ff.
 26. von Pechmann, GRUR 1985, 717 ff.
 27. von Pechmann, GRUR 1987, 475 ff.
 28. von Pechmann/Straus, GRUR Int. 1991, 507 ff.
 29. White/Brown, (1996) EIPR 419 ff.
 30. Aufzeichnungen über die Diplomatische Konferenz zur Revision des Internationalen Übereinkommens zum Schutz von Pflanzenzüchtungen, Genf 1991, Genf 1992, (Auszüge der zitierten Stellen).
 31. Records of the Luxembourg Conference on the Community Patent 1975, Luxemburg 1981, (Auszüge der zitierten Stellen).
 32. Schweizerisches Bundesgericht, BGE 121 EIII 125 ff.
 33. SchwMMB1. 1986 I 36-38
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- B. Bundestags-Drucksache 17/14222
 - C. English translation of part of document B
 - D. Opinion by Prof. Dr. Rudolf Kraßer
 - E. Decision of the Court of First Instance in The Hague from 31 January 2012, *Taste of Nature v. Cresco*
 - F. Decision of the Court of First Instance in The Hague from 8 May 2013, *Taste of Nature v. Cresco*
 - G. Decision of the Court of Appeal in The Hague from 28 May 2013, *Taste of Nature v. Cresco*