

NEW REFERRALS RELATING TO THE PATENTABILITY OF PLANTS

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In previous issues we have discussed the influence of G2/07 and G1/08, also known as the ‘broccoli’ and ‘tomato’ cases, on the patentability of plants which have been, or could have been, obtained by methods excluded from patentability.

These cases both related to the production of plants in which a trait was introduced into the plants by crossing and selection steps. The Enlarged Board of Appeal (EBA) decided that since crossing and selection necessarily involve human intervention, the conclusion to be drawn is that a process for the production of plants which is based on the sexual crossing of whole genomes and on the subsequent selection of plants, in which human intervention, including the provision of a technical means, serves to enable or assist the performance of the process steps, is excluded from patentability as being “essentially biological” within the meaning of Article 53(b) of the European Patent Convention (EPC).

On this basis, if a patent claim is related to a process for obtaining plants based on sexual crossing and selection, these claims are not patentable irrespective of what other steps may be included in the claims.

In order to counter the result of the G2/07 and G1/08 decisions, the proprietor of the ‘tomato’ case withdrew the claims relating to the breeding processes used to produce the plants, only maintaining claims relating to the plants and the plant material. The involved Technical Board of Appeal (TBA) found that the patentability of plants and plant material obtained using a non-patentable breeding process had not been settled by the previous decisions, and the TBA therefore referred new questions to the EBA, resulting in G2/12 (called ‘tomato II’).

The questions in the ‘tomato II’ referral can be summarised as follows: while it is clear from G2/07 and G1/08 that selection and breeding processes comprising sexually crossing the whole genomes of plants cannot be patented under the EPC, are products that directly result from such processes also non-patentable?

The TBA in the ‘broccoli’ case made a similar conclusion, and even though the plant claims in the G2/07 were not originally opposed, the proprietor agreed to allow the introduction of a new ground into the opposition, resulting in the ‘broccoli II’ case, G2/13.

“THE DECISIONS OF THE EBA IN THE PRESENT REFERRALS WILL BE VERY IMPORTANT FOR PRACTICE, AS THEY WILL IMPLY AN IMPORTANT IMPACT ON THE PATENTABILITY OF PLANTS AND SEEDS.”

There is significant overlap between the questions to the EBA in G2/13 and G2/12, but the key different questions in G2/13 are:

- 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?
- 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?

In both referrals, briefs have been filed in support and against the patentability of plants, which have been obtained, or could have been obtained, by methods which are excluded under Article 53(b) EPC.

One of the briefs refers to the decision of the Court of the District Court of The Hague issued in May 2013 in the *Cresco v Taste of Nature* case. The case is ongoing but the Dutch national courts have taken the approach that, in the absence of an explicit exclusion in Article 53(b) EPC, product claims to plants, other than individual plant varieties, obtainable by an essentially biological process for the production of plants, are in principle allowable, even if the essentially biological processes themselves are not.

The decisions of the EBA in the present referrals will be very important for practice, as they will imply an important impact on the patentability of plants and seeds. The Dutch court gave its decision without awaiting the outcome of G2/12 as both parties had requested an early decision, but the approach taken by the Dutch national courts may change should the EPO’s EBA decide in G2/12 and G2/13 that such claims are not allowable under Article 53(b) EPC. ■

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