

Decision G 03/19 of the Enlarged Board of Appeal – Dynamic interpretation of Article 53(b) EPC in view of the alteration of Rule 28 EPC

The headnote of decision G 03/19 of the Enlarged Board of Appeal (EBA) of the European Patent Office (EPO) reads as follows:

“Taking into account developments after decisions G 2/12 and G 2/13 of the Enlarged Board of Appeal, the exception to patentability of essentially biological processes for the production of plants or animals in Article 53(b) EPC has a negative effect on the allowability of product claims and product-by-process claims directed to plants, plant material or animals, if the claimed product is exclusively obtained by means of an essentially biological process or if the claimed process features define an essentially biological process. This negative effect does not apply to European patents granted before 1 July 2017 and European patent applications which were filed before that date and are still pending.”

Summarized Conclusions

- The EBA confirmed that the decisions G 2/12 and G 2/13 of the EBA are still generally applicable and that the European Patent Convention (EPC) overrules the Implementing Regulations if there is incompatibility (Article 164(2) EPC).
- Notably, in contrast to the preceding decision T 1063/18 of the Technical Board of Appeal, the EBA states that Rule 28(2) EPC is not incompatible with the wording of Article 53(b) EPC.
- Interpretation of the EPC can be adapted in view of alterations of the Implementing Regulations. This is designated as “dynamic interpretation”. Legal intent of the Contracting States is acknowledged.
- In the present case, the EBA decided that for applications filed after it has been entered into force, the revised version of Rule 28 EPC applies. Accordingly, for applications filed after July 1, 2017, under Article 53(b) EPC,

European patents shall not be granted in respect of plants or animals exclusively obtained by means of an essentially biological process (Rule 28(2) EPC).

- Thereby, the EBA partly overrules the preceding decision T 1063/18 of the Technical Board of Appeal that had declared the paragraph Rule 28(2) EPC widely meaningless in view of preceding interpretation of Article 53 (b) EPC.

Legal Background

Article 53(b) EPC generally excludes “plant or animal varieties or essentially biological processes for the production of plants or animals” from patent protection and is related to EU Directive 98/44/EC. Due to the wording that literally excludes two alternatives from patentability, in the past, there has been a controversial discussion whether this legal norm is to be interpreted literally or with a teleological interpretation. In particular, it was discussed whether product-by-process claims for plants or animals obtainable from exclusively biological process steps should be patentable.

Plant Patents—A Previously Settled Situation?

This discussion seemed settled by the decisions G 2/12 and G 2/13. Briefly summarized, in these decisions, it was decided that Article 53(b) EPC is to be interpreted restrictively. The EBA concluded that product-by-process claims which refer to plants or animals obtainable from exclusively

biological process steps can generally be patentable.

In several countries the political desire to generally exclude biological plants and animal from patentability was articulated and in 2017 the Administrative Council of the EPO, established Rule 28(2) EPC:

“Under Article 53(b), European patents shall not be granted in respect of plants or animals exclusively obtained by means of an essentially biological process.”

Preceding Decision T 1063/18

In preceding decision T 1063/18 of the Technical Board of Appeal (TBA) of December 5, 2018, of EPO saw a conflict between case law of the EBA and the Implementing Regulations. In T 1063/18, the following decision was made (cf. catchwords thereof):

“Rule 28(2) EPC is in conflict with Article 53(b) EPC, as interpreted by the Enlarged Board of Appeal in decisions G 2/12 and G 2/13. In accordance with Article 164(2) EPC, the provisions of the Convention prevail.”

Thus, de facto, T 1063/18 declared Rule 28(2) EPC essentially meaningless in view of preceding case law of the EBA.

Due to a discrepancy in application of the law, the President of the EPO referred the matter to the EBA because Boards of Appeal have given different decisions on the interpretation of Article 53(b) EPC (Article 112(1)(b) EPC).

Clarification by the Recent Decision of the EBA

Now, the EBA found a way out of the troublesome situation. The EBA states that Rule 28(2) EPC is not incompatible with the wording of Article 53(b) EPC. It is clarified that the decisions G 2/12 and G 2/13 are still generally applicable. However, for applications filed after July 1, 2017, Rule 28(2) EPC applies and, thus, under Article 53(b) EPC, European patents shall not be granted in respect of plants or animals exclusively obtained by means of an essentially biological process. The interpretation of Articles of the EPC is dynamic in view of alterations of the Implementing Regulations.

- ▶ **Further information: Press Communiqué of 14 May 2020 concerning opinion G 3/19 of the Enlarged Board of Appeal**



Dr. Ivo Ruttekolk
Patentanwalt
European Patent Attorney
Associate

Büro Mannheim
Eastside One
Seckenheimer Landstr. 4
D-68163 Mannheim
+49 621 42 271-0
ruttekolk@ib-patent.de