

ESA_13.0693.2

Brussels, November 27, 2013

Subject: written statement in respect of case G 2/13

Dear Madam / Sir,

ESA the European Seed Association appreciates the opportunity offered to third parties to file written statements in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal regarding the points of law referred to the Enlarged Board of Appeal by the Technical Board of Appeal with interlocutory decision of 8 July 2013 in case T 83/05.

On November 30, 2012 ESA sent a written statement regarding the questions of law asked to the Enlarged Board of Appeal in case G 2/12. Given that the questions referred to the Enlarged Board of Appeal in case G 2/13 are partially overlapping with those referred in case G 2/12, by the present statement ESA wishes to reiterate the views expressed in its letter of November 30, 2012 and complement it with additional elements where necessary. For your convenience please find attached to the present letter our letter of November 30, 2012

ESA is of the opinion that in order to safeguard the necessary access to genetic variability for the development of new, improved plant varieties the questions asked to the Enlarged Board of Appeal should be answered as follows:

Ad question 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?

This question is essentially the same as question no. 1 referred to the Enlarged Board of Appeal in case G 2/12 therefore, we reiterate our views provided on question 1 in document ESA_12.0823 (attached).

Ad question 2 (a)

In particular: 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?

This question must be answered negatively.

If such claims directed to products obtained by a non-patentable essentially biological process would still be allowable, this would make the exclusion of Article 53 (b) EPC meaningless. This is because the protection on the product would hinder also the use of the essentially biological process.

Ad question 2 (b)

In particular: 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?

This question is the same as question no. 2 referred to the Enlarged Board of Appeal in case *G 2/12* therefore, we reiterate our views provided on question 2 in document ESA_12.0823 (attached).

Ad question 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?

This question is essentially the same as question no. 3 referred to the Enlarged Board of Appeal in case *G 2/12* therefore, we reiterate our views provided on question 3 in document ESA_12.0823 (attached).

Ad question 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?

In principle, ESA is not against the idea of disclaimers in case such practice is considered to be compatible with European patent law as also raised in points 26 and 28 of the Interlocutory decision of the Boards of Appeal of July 8, 2013 in case T 0083/05.

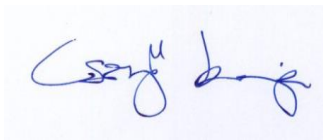
ESA is of the view that a claim directed to plants obtained by a **non** essentially biological process, such as, a process consisting of genetic modification, technically induced mutagenesis, protoplast fusion or another technical process not based on crossing and selection, is allowable even if the same plants could be obtained by an essentially biological process. However the effect of the patent protection granted on such plants should not extend to biological material obtained by an essentially biological process excluded under Article 53(b) EPC. Otherwise such exclusion would be meaningless.

ESA understands the referral in case G 2/13 as being aimed at finding an answer to the question whether patentability of plants or plant material other than a plant variety obtained by an essentially biological process should be allowable. However, the present question 4 does not seem to offer a solution to this issue as it only mentions waiving protection for “such generation by disclaiming the excluded process”, i.e. for the process itself but not for the resulting product. This would result in a situation whereby the use of an essentially biological process for the production of the plants or plant material would in theory not infringe the patent but since the resulting product is not disclaimed and thus would still remain in the scope of the patent, in such a scenario the exclusion would still be meaningless.

Therefore, should the Enlarged Board of Appeal consider disclaimers possible under European patent law, in order to allow patent protection on inventions which merit such protection and –at the same time - safeguard the meaning of the exclusion under Article 53(b) EPC, it is not enough to disclaim the essentially biological process excluded under Article 53(b) but also the products directly obtained by such process should be disclaimed.

ESA would like to thank you for the opportunity to contribute to the discussion on this important topic. We are confident that you will give due attention to the considerations presented above and in the attached documents.

Yours sincerely,

A handwritten signature in blue ink, appearing to read 'Szonja Csörgő', is shown on a light blue background.

Szonja Csörgő

Director Intellectual Property and Legal Affairs

Annexes:

- ESA written statement of November 30, 2012 (ESA_12.0823)
- ESA position on Intellectual Property Protection for plant-related inventions in Europe (ESA_12.0100)