

# EPO: Plants and Plant Materials Not Patentable if Exclusively Obtained by Essentially Biological Process

May 29, 2020

A recent opinion issued by the Enlarged Board of Appeal (EBoA) of the European Patent Office (EPO) has established that plants and plant materials are *not* patentable if they are exclusively obtained by means of an essentially biological process. This opinion is known as “*Pepper*” (G3/19).

*Pepper* is the latest, and perhaps final, in the long line of legal events addressing this issue. We have previously reported on the ongoing saga in two alerts in December 2018 and March 2019, the latter of which outlined the background surrounding these issues.

The opinion has no retroactive effect on European patents that were granted before *1 July 2017*, or on pending European patent applications that were filed (or have a priority date) before that date.

## Background

The European Patent Convention (EPC) determines the types of subject matter for which a European patent can be granted. Article 53(b) EPC recites:

European patents shall not be granted in respect of: ... (b) plant or animal varieties or essentially biological processes for the production of plants or animals; this provision shall not apply to microbiological processes or the products thereof

As discussed in our aforementioned alerts, the correct interpretation of this article has been heavily scrutinised.

In an early decision<sup>1</sup>, the EBoA adopted an interpretation of Article 53(b) EPC, which meant that European patents *can* be granted where specific plant varieties are not individually claimed, even though the claims may be broad enough to embrace individual varieties.

Later<sup>2</sup>, the EBoA further clarified the interpretation of Article 53(b) EPC to establish that *methods* for producing plants *are* patentable if they work primarily through the purposeful insertion and/or modification of one or more genes in a plant (e.g., methods for making transgenic plants or technically induced mutants). However, methods of producing plants are *not* patentable where a new trait is the result of crossing and selection, even if new or advanced technologies are used to assist the process (e.g., marker assisted breeding). Only if the new trait is introduced or modified by a technical step, and so is not just the result of traditional crossing and selection, are such processes patentable. As such, some methods for producing plants are patentable, whereas others, by their nature, are not (regardless of how new or inventive said methods may be).

Until now, however, the EPO has not adopted a settled approach as to whether plants or plant materials (such as fruits or other plant parts) that have been obtained by an unpatentable essentially biological process are themselves patentable. The problem is that Article 53(b) EPC is silent with regards to this issue. *Pepper* provides an answer to this question.

### Pepper (G3/19)

The road that has led to *Pepper* has been long and legally complex. The EPO has at some points appeared to “firmly” establish that plants and plant materials that have been obtained by an unpatentable essentially biological process *are* patentable and at other times that they are *not* patentable<sup>3</sup>. *Pepper* provides a clear answer to this question, and concludes:

“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”.

Therefore, in light of *Pepper*, plants and plant materials that have a new trait that is exclusively the result of traditional crossing and selection are *not* patentable.

Importantly, *Pepper* has no retroactive effect on European patents that were granted before 1 July 2017 or on pending European patent applications that were filed (or have a priority date) before that date. *Pepper* endorses the EBoA's previous interpretation in *Broccoli/Tomato II*, and so it appears that patents and applications to which *Pepper* does not apply may validly claim plants or plant materials exclusively obtained by means of an essentially biological process. However, the precise wording chosen by the EBoA is interesting, and may give pause to proprietors currently involved in opposition proceedings relating to patents with a filing date before 1 July 2017 but granted before *Pepper* was issued. It is also interesting to note that 1 July 2017 has been chosen because *Pepper* is in accordance with amendments to the rules of the EPC that came into force on this date, but these amended rules *did* have a retroactive effect at the time. As such, the effects of *Pepper* are more complex than they appear and might actually be favourable for some existing patents.

## Settled law?

Given the back-and-forth, many will be wondering if this is the final position that the EPO will adopt. Of course, we cannot see the future, but it appears likely that the law is now settled for the foreseeable future. The EBoA is the highest judicial authority of the EPO and has adopted a position that appears to be in accordance with that of the contracting states to the EPC. It seems, therefore, that the judicial and legislative bodies are in agreement.

## The political situation

*Pepper* is of obvious importance to those interested in the patentability of plants, but is also of great importance to those interested in the political and legal aspects of European patent law. It is beyond the scope of this alert to go into too much detail, but many commentators are discussing what this opinion reveals in relation to:

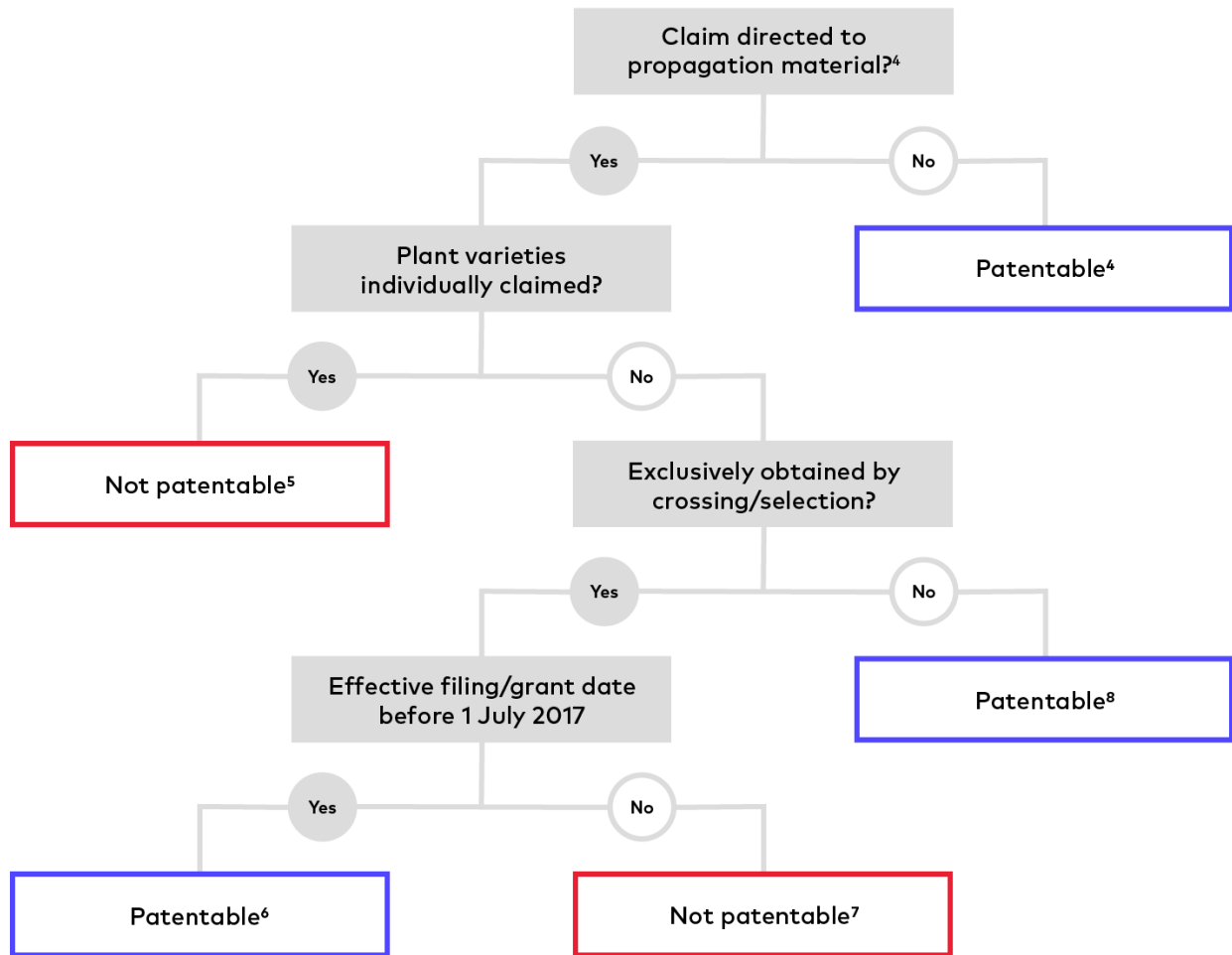
- i. the EU's influence – the EU Commission issued a much-discussed “Notice of Interpretation”;
- ii. the power of the EPO's Administrative Council – the Administrative Council amended an EPC rule in a manner that contradicted an EBoA interpretation;
- iii. the power of the EPO's president – the present opinion results from a referral from the president, which many predicted to be inadmissible; and
- iv. the EBoA's independence – ultimately the EBoA has overruled itself and has adopted the position of the EU Commission, the EPO's president and the EPO's Administrative Council. Of course, this does not *prima facie* reveal a lack of independence but, as expected for politicised issues, it has caused a great deal of debate.

The EBoA in *Pepper* was clearly aware of the above factors and directly addresses many of them in the opinion. These aspects of *Pepper* could have a broader relevance to European patent law.

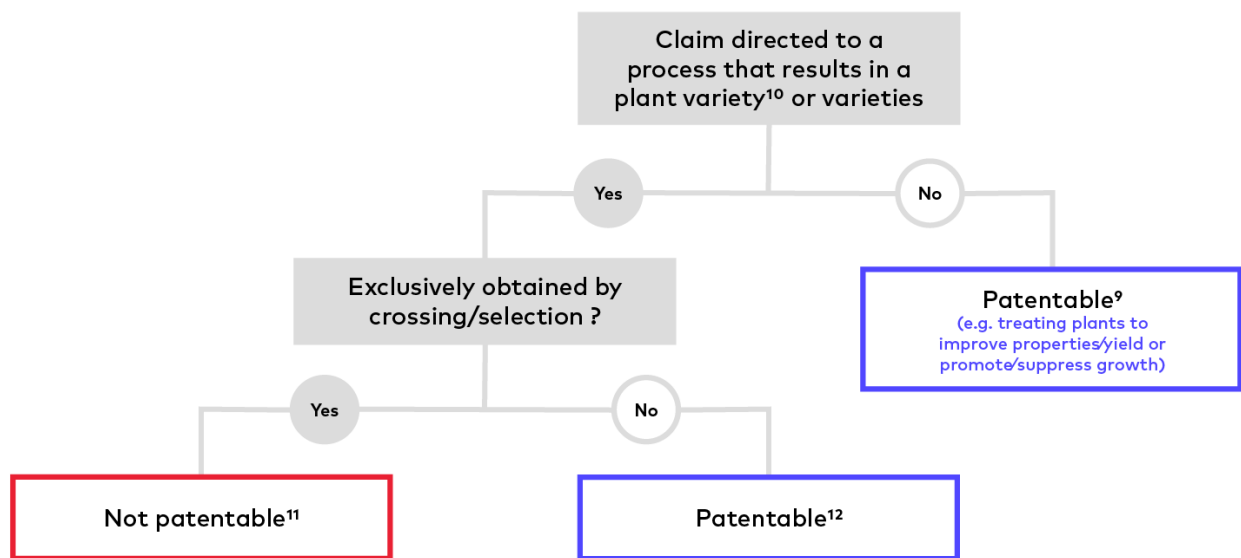
## Overall picture

Considering the number of overlapping and conflicting plant-related decisions, the overall picture can be hard to see. The overall effects of the case law, up to and including *Pepper*, are collated below.

Claims directed to plant products



Claims directed to methods relating to plants



Key takeaways

This latest development should be taken into account for companies seeking to protect plant innovation in Europe. It is important to note that it is still possible to protect plants and plant products with a European patent if a new trait is introduced or modified by a technical step. However, it is no longer possible to protect plants and plant products if the new trait is exclusively the result of traditional crossing and selection without an additional step of a technical nature. (As noted above, *Pepper* does not have retroactive effect before 1 July 2017).

Of course, many naturally occurring mutations could also be artificially induced, and many artificial mutations could have occurred naturally. The EPO's current guidance is that protection can still be obtained if a disclaimer delimits the claimed subject matter to the technically produced product<sup>13</sup>. As such, applicants should carefully consider whether their inventions are truly excluded.

#### Notes

1. G1/98
2. G 2/07 and G 1/08 (*Broccoli/Tomato I*)
3. See: G2/12 and G2/13 (*Broccoli/Tomato II*); OJ EPO 2017, A56 (amendment of Rule 28 EPC); and T1063/18.
4. EPO Guidelines for Examination; G-II 5.4
5. G1/98
6. G2/12 and G2/13 (*Broccoli/Tomato II*)
7. G3/19 (*Pepper*)
8. G 2/07 and G 1/08 (*Broccoli/Tomato I*)
9. EPO Guidelines for Examination; G-II 5.4.2
10. G1/98; EPO Guidelines for Examination; G-II 5.4.1
11. G 2/07 and G 1/08 (*Broccoli/Tomato I*)
12. G 2/07 and G 1/08 (*Broccoli/Tomato I*)
13. EPO Guidelines for Examination; G-II 5.4.

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