

**Patenting of Plants in Europe  
Position Paper  
by The Chartered Institute of Patent Attorneys (CIPA)**

1. Background

The Enlarged Board of Appeal of the European Patent Office (EPO) decided last year in cases G2/12 (“Broccoli II”) and G2/13 (“Tomatoes II”) that the Article 53(b) of the European Patent Convention (EPC) which excludes the patentability of essentially biological processes for the production of plants does not impact on the patentability of plants or plant material *per se* obtained from such processes.

Whilst many in the patent profession accepted these Enlarged Board decisions as merely clarifying and confirming the scope of the Article 53(b) EPC exclusions, others including several plant breeders’ organisations have reacted against the decisions as being an improper intrusion of patents into traditional plant breeding activities. There have been calls on and by members of the European Commission to introduce changes to European patent law and/or binding rules on the interpretation of the EPC in relation to plants and their overlap with plant variety protection (PVP).

In this paper, we set out and provide our position on selected issues concerning the patentability of plants and the scope of protection afforded by plant patents.

The Chartered Institute of Patent Attorneys (CIPA) is the professional and examining body for patent attorneys (also known as patent agents) in the United Kingdom. The Institute was founded in 1882 and was incorporated by Royal Charter in 1891. It represents virtually all of the 1,700 registered patent attorneys in the United Kingdom, whether they practice in industry or private practice. The total membership is over 3,000 and includes trainee patent attorneys and other professionals with an interest in intellectual property matters. CIPA maintains the Register of Patent Attorneys under statutory authority on behalf of the UK Department of Trade and Industry and reports to the Comptroller-General of Patents, Trade Marks and Designs at the UK Intellectual Property Office. Nearly all registered patent attorneys in the UK are also professional representatives before the EPO (i.e. they are also European patent attorneys).

2. The Issues

Plant breeding is important to food production. Plant breeders require protection for the varieties they produce but this is traditionally (since the 1960’s) provided by plant variety protection (PVP). Breeders whose plant varieties have obtained PVP have the sole right to multiply those varieties for sale – buyers may plant the seed and sell it for consumption only, not replanting. Plant breeders may freely cross the protected varieties of others to produce new varieties (the so-called “breeder’s exemption”), which may then be protected and/or commercialised. Traditional plant breeders greatly value the breeder’s exemption, and many regard it as a foundation of their business. The lack of any breeder’s exemption in the EPC is of concern to traditional breeders, and may set them against any patenting on plants. However, the EPC and more recently national legislation in various European countries include limitations on the patenting of plants and related breeding methods.

The EPC itself in Article 53(b) does stipulate that European patents shall not be granted in respect of “plant or animal varieties or essentially biological processes for the production of plants or animals”. The EPO’s Enlarged Board clarified in G1/98 that a patent claim in which specific plant varieties are not individually claimed is not excluded from patentability under Article 53(b) EPC even though it may embrace plant varieties. Subsequent Enlarged Board cases G2/07 (“Broccoli”) and G1/08

("Tomato") clarified that an essentially biological processes for the production of plants encompassed a method which contained or consisted of the steps of sexually crossing the whole genomes of plants and of subsequently selecting plants. Such a method would be considered an essentially biological process even if the method also contained a step of a technical nature which served to enable or assist the performance of the steps of sexually crossing. However, if the method contained an additional step of a technical nature, which by itself introduced a trait into the plant genome or modified a trait in the genome of the plant produced, so that the introduction or modification of that trait was not the result of the mixing of the genes of the plants chosen for sexual crossing, then the method would not fall under the Article 53(b) EPC exclusion from patentability.

As mentioned above, the Enlarged Board in G2/12 ("Broccoli II") and G2/13 ("Tomatoes II") decided that Article 53(b) EPC does not rule out a product claim directed to plants or plant material *per se*. This was true even if the only method available at the filing date of the patent application for generating the claimed subject-matter was itself an excluded essentially biological process for the production of plants. Such product claims could if required be worded as product-by-process claims, i.e. the plant or plant material could be defined in a claim with reference to an essentially biological process for their production. The Enlarged Board emphasised that their decision was based on an accepted legal principle of narrow interpretation of patentability exclusions, and that the remaining strict requirements of the EPC – including novelty, inventive step and industrial applicability – would still need to be fulfilled in order for a European patent to be granted.

The G2/12 and G2/13 decisions impact on examination practice at the EPO and hence the granting of European patents. However, the EPC member states Germany, France and the Netherlands have introduced or approved changes to their national patent laws to expressly exclude from patentability plants (or animals) resulting from essentially biological processes. The scope of protection afforded by a European patent brought into effect in those member states and claiming a plant obtainable by an essentially biological process is thus in doubt.

Although the EPC does not include any breeder's exemption, the Agreement on a Unitary Patent Court (UPC) - which envisages a new legal framework applicable within EU (but not non-EU EPC) member states - does. Specifically, Article 27(c) excludes from patent infringement the use of biological material for the purpose of breeding, or discovering and developing other plant varieties. Switzerland and also various EU member states including Germany, France and the Netherlands have introduced a parallel breeder's exemption into their national legislation<sup>1</sup>. Irrespective of national law changes, if and when the UPC Agreement comes into force, the breeder's exemption will apply to European patents and the envisaged Unitary patents in all EU states at least. Within the EU, plant breeders will thus be free to breed using, and discover and develop new plant varieties from, plants protected by European or Unitary patents.

CIPA's perspective is that, given the EU-wide breeder's exemption which is in force nationally or expected via the UPC system, as well as other legal provisions such as the experimental use exemption and compulsory licencing under patents (not discussed here), there is or will be a reasonable balance within the EU between on the one hand innovators being able to protect their plant inventions (other than plant varieties) using patent rights and on the other hand plant breeders who wish to use patent-protected plants to develop new plant varieties. We do not consider that any changes to the EPC are warranted, as this might deter plant innovators from developing commercially or ethically valuable new plants or plant material. Furthermore, we note

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□ The United Kingdom has introduced a plant breeders exemption that will come into effect if and when the Agreement on a Unified Patent Court comes into force.

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that suggestions for the European Commission to produce a updated Biotech Directive or new rules on interpretation of the EPC so as to override the Enlarged Board's G2/12 and G2/13 decisions may not be worthwhile as the EPO is not an EU institution and is not bound by rulings of the European Commission.

### 3. Conclusion

Plant variety protection covering specific plant varieties and plant patents covering plants at a more generic level have co-existed for decades in Europe. Until recently, there was little cause for concern about potential overlap between patent rights and the activities of traditional plant breeders who develop (and protect) plant varieties. EPO Enlarged Board of Appeal decisions G2/12 and G2/13 have further clarified the meaning of the Article 53(b) EPC concerning the production of plants by essentially biological processes. CIPA's position is that there is (or shortly will be) a reasonable balance within the EU between the rights of plant innovators using patents and the rights of plant breeders who wish to continue with their traditional plant breeding practices. Accordingly, we support the current position in this area and do not promote changes to the EPC or national patent laws.

CIPA  
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