

**Enlarged Board of Appeal EPO, 27 November 1995,
Inadmissible referral**



PATENT LAW

Inadmissible referral by President of EPO

- [The referral of the question of law to the Enlarged Board of Appeal by the President of the EPO is inadmissible under Article 112\(1\)\(b\) EPC : no conflict between findings in decisions of Boards of Appeal.](#)

As stated in paragraph VI above, in his statement of reasons for referring the question of law to the Enlarged Board, the President of the EPO has relied upon the statement in paragraph 24 of decision T 356/93 as being in conflict with what was decided in decisions T 49/83 and T 19/90. In the Enlarged Board's view, when paragraph 24 is read in its context, which is in conjunction with paragraphs 40.3 to 40.8, the true meaning of paragraph 24 is essentially the same as what is said in the first three lines of paragraph 40.8: namely that claim 21 is not allowable if (as it does) it encompasses ("embraces", "includes within its scope") a "plant variety" as defined in paragraph 23, such as the genetically transformed plants which are defined in claim 21.

The finding in decision T 356/93 as set out in paragraph 5 above, corresponding to objection (2) above, clearly concerns an important point of law, but this point of law is not the subject of the question which the President has referred to the Enlarged Board. In the Enlarged Board's judgment there is no conflict between this finding and what was decided in decisions T 49/83 and T 19/90, because (as is apparent from paragraphs III, IV, 2 and 3 above) neither of decisions T 49/83 and T 19/90 were concerned with the point of law which was decided in decision T 356/93. In other words, two boards of appeal have not given different (ie conflicting) decisions on the question of law which the President has referred to the Enlarged Board of Appeal, as required by Article 112(1)(b) EPC.

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Enlarged Board of Appeal EPO, 27 November 1995

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Opinion of the Enlarged Board of Appeal dated 27 November 1995

G 3/95

[...]

Headword: Inadmissible referral

Summary of the procedure

I. On 28 July 1995 the President of the EPO referred the following question to the Enlarged Board of Appeal, pursuant to Article 112(1)(b) EPC:

"Does a claim which relates to plants or animals but wherein specific plant or animal varieties are not individually claimed contravene the prohibition on patenting in Article 53(b) EPC if it embraces plant or animal varieties?"

The first half-sentence of Article 53(b) EPC is relevant to this question, and reads as follows:

"European patents shall not be granted in respect of ... plant or animal varieties ..."

II. In the reasons which accompanied this referral, the President explained that he considered that different boards of appeal had given different decisions on the referred question: in particular, he considered that decision T 356/93 (OJ EPO 1995, 545), which was issued by Technical Board of Appeal 3.3.4 on 21 February 1995, was in conflict with decision T 49/83 (OJ EPO 1984, 112), issued by Technical Board of Appeal 3.3.1 on 26 July 1983, and with decision T 19/90 (OJ EPO 1990, 476), issued by Technical Board of Appeal 3.3.2 on 3 October 1990, in relation to the point of law which is the subject of the referred question.

III. Decision T 49/83 concerns an appeal from a decision of an examining division which rejected an application under the first half-sentence of Article 53(b) EPC. The invention which was the subject of the application related to the chemical treatment of propagating material (for example, seeds) for plants in order to make the plants resistant to agricultural chemicals such as herbicides. The application contained inter alia two product claims, which defined "Propagating material for cultivated plants" treated with a chemical compound in accordance with a particular formula. The two claims read as follows:

"13. Propagating material for cultivated plants, treated with an oxime derivative according to formula I in Claim 1.

14. Propagating material according to Claim 13, characterised in that it consists of seed."

The description included examples of such chemical treatment carried out on certain known plant varieties, which made it clear that the two claims related to the propagating material of any cultivated plants which had been chemically treated in accordance with the invention: that is, including known cultivated plant varieties which had been so chemically treated. The examining division consequently held that the subject-matter of these two claims was excluded from patentability under Article 53(b) EPC, which was regarded as applicable both to new and to known plant varieties. However, Technical Board of Appeal 3.3.1 allowed the appeal, on the basis that Article 53(b) EPC was intended only to exclude new individual plant varieties from patentability. The board of appeal held that even though the two claims included within their scope the propagating material for all kinds of cultivated plants and plant varieties which had received the defined chemical treatment, nevertheless, the subject-matter of the claims

is not an individual variety, and there was therefore no contravention of Article 53(b) EPC.

IV. Decision T 19/90 also concerns an appeal from a decision of an examining division which had rejected an application *inter alia* under the first half-sentence of Article 53(b) EPC. The invention which was the subject of this application related to a specific genetic treatment of animals for the purpose of cancer research, and the application included claims to animals which had been so treated. The examining division held that although the wording of Article 53(b) EPC excluded "animal varieties" from patentability, the intention of the legislator had been to exclude animals in general from patentability. However, Technical Board of Appeal 3.3.1 held that the examining division was wrong to reject the application on the basis that animals as such were excluded from patentability, and that the proper issue to be decided was whether or not the subject-matter of the application is an "animal variety". The case was remitted to the examining division for further prosecution, including consideration of this issue.

V. Decision T 356/93 concerns an appeal in opposition proceedings. The invention which is the subject of the opposed patent relates to the genetic engineering of plants. According to this invention, the genes of a plant are modified in a particular way so as to make the plant resistant to a herbicide.

The patent contains a number of independent claims, including claim 21, which defines a "plant" which has been genetically modified, and thus transformed, as set out in the claim. Claim 21 reads as follows:

"Plant, non biologically transformed, which possesses, stably integrated in the genome of its cells, a foreign DNA nucleotide sequence encoding a protein having a non-variety-specific enzymatic activity capable of neutralizing or inactivating a glutamine synthetase inhibitor under the control of a promoter recognized by the polymerases of said cells."

The description of the patent includes a number of working examples, in all of which known varieties of tobacco plants are genetically transformed in accordance with the invention as defined in claim 21. It is shown that the plants which are transformed in this way display normal fertility, and that the second generation seedlings are homozygous for the resistance gene.

A number of objections were raised against the patent by the opponent, including objections under the first half-sentence of Article 53(b) EPC. The opposition division rejected the opposition, and maintained the patent with text as granted (the decision is published in 1993 IIC 618).

In its decision in the subsequent appeal proceedings, with reference to the concept of "plant varieties" in the first half-sentence of Article 53(b) EPC, Technical Board of Appeal 3.3.4 began by noting that both decision T 49/83 and decision T 320/87 (OJ EPO 1990, 71) had been concerned with this exclusion from patentability, and had interpreted the meaning of this concept with reference to the International Convention for the Protection of New Varieties of Plants, 1961

(hereafter referred to as the "UPOV Convention"). Following what was stated in these two decisions, the board of appeal set out in paragraph 23 of its decision an interpretation of the concept of plant varieties under Article 53(b) EPC, as referring to "any plant grouping within a single botanical taxon of the lowest known rank which, irrespective of whether it would be eligible for protection under the UPOV Convention, is characterised by at least one single transmissible characteristic distinguishing it from the other plant groupings and which is sufficiently homogeneous and stable in its relevant characteristics" (emphasis added). The board then stated its conclusion in paragraph 24 that "A product claim which embraces within its subject-matter "plant varieties" as just defined ... is not patentable under Article 53(b) EPC, first half-sentence ..." (emphasis added).

The board went on to consider the allowability of claim 21 having regard to the first half-sentence of Article 53(b) EPC, in the light of this definition, in paragraphs 40.3 et seq. of the decision. It stated at the beginning of paragraph 40.4 that "The subject-matter of claim 21 differs decisively from the subject-matter dealt with in decisions T 49/83 and T 320/87 ... in that it relates to genetically modified plants which remain stable in their modified characteristic(s). The stated characterising feature of the claimed plant is, in fact, transmitted in a stable manner in the plants and seeds throughout succeeding generations ..." (emphasis added). It noted that the working examples of the patent relate to the production of transformed plants from known varieties and show that "the plants transformed in this way display normal fertility and that the second generation seedlings are homozygous for the resistance gene", and concluded that "Thus, the transformed plants or seeds of the working examples, irrespective of whether they would meet the conditions for the grant of a breeder's right, are plant varieties as they comply with the definition of the concept of "plant varieties" (cf. points 21 to 23 supra) being distinguishable, uniform and stable in their relevant characteristics". Furthermore, such exemplified varieties could be construed as "essentially derived varieties", see Article 14(5)(c) of the UPOV Convention as revised in Geneva in 1991.

In paragraph 40.5 the board went on to state that claim 21 defines plants which are distinguished from all other plants by the stated specific characteristic which is transmitted in a stable manner to the progeny. It pointed out that while claim 21 defines the distinctive feature common to all plants within the claim, the working examples show practical forms of realisation of the invention according to claim 21, which are "genetically transformed" plant varieties.

Consequently it held that "the subject-matter of claim 21 encompasses genetically transformed plant varieties showing said single distinctive feature ..."; and that claim 21 was therefore "only allowable, if the exception to patentability under Article 53(b) EPC, first half-sentence, concerning plant varieties does not apply, because the subject-matter of this claim is to be regarded as the product of a microbiological process" (paragraph

40.8). In paragraphs 40.9 to 40.11 the board held that the claimed plants were not products of a microbiological process, and that claim 21 was therefore not allowable.

VI. In his statement of reasons for referring the above question of law to the Enlarged Board of Appeal, the President has regarded the conclusion of Technical Board of Appeal 3.3.4 in paragraph 24 of decision T 356/93 (ie "A product claim which embraces within its subject-matter "plant varieties" as just defined ... is not patentable under Article 53(b) EPC ...") as a general statement of legal principle which is in contradiction to what was held in decision T 49/83 (paragraphs 2 to 2.5 of his statement) and in decision T 19/90 (paragraph 2.6). In particular, the President has considered that according to the above-quoted statement in decision T 356/93, a claim which defines a plant which has been treated in accordance with the invention, and which embraces known plant varieties which have been so treated within its scope, is not allowable under Article 53(b) EPC. Accordingly, he has argued in favour of an interpretation of Article 53(b) EPC in accordance with decision T 49/83, to the effect that the first half-sentence of Article 53(b) EPC is only intended to exclude from patentability a claim which defines specific plant varieties individually.

VII. In the course of these proceedings, the following written statements concerning the referred question of law were sent to the Enlarged Board of Appeal pursuant to Article 11(b) of the Rules of Procedure of the Enlarged Board of Appeal:

Greenpeace, (letter dated 6 September 1995).

Compassion in World Farming (25 September 1995).

UNICE (Union of Industrial and Employers' Confederations of Europe) (7 November 1995, updated version 20 November 1995).

Ian Armitage, Mewburn Ellis (8 November 1995).

Büro der Kampagne "Kein Patent auf Leben!" (9 November 1995). Greenpeace (9 November 1995).

The Chartered Institute of Patent Agents (9 November 1995).

The British Society of Plant Breeders Ltd (10 November 1995).

Sandoz Technology Ltd (16 November 1995).

EPI (Institute of Professional Representatives before the European Patent Office) (16 November 1995).

Reasons for the opinion

1. The first question which the Enlarged Board of Appeal has to consider is the actual nature and extent of the conflict between decisions T 49/83 and T 19/90 on the one hand, and decision T 356/93 on the other hand, in relation to the question of law which has been referred to the Enlarged Board, bearing in mind that according to Article 112(1)(b) EPC the President "may refer a point of law to the Enlarged Board of Appeal where two boards of appeal have given different decisions on that question".

2. Decision T 49/83 is summarised in paragraph III above. The examining division in that case had held that the exclusion from patentability under the first half-sentence of Article 53(b) EPC applied to the two

product claims in question simply because these claims included within their scope "propagating material" both for plants which were (known) plant varieties and for plants which were not varieties, which had received the claimed chemical treatment. In other words, because these claims conferred protection inter alia upon known plant varieties which had received the claimed chemical treatment, Article 53(b) EPC was applicable to such claims, even though the claimed invention was directed to and lay in the particular chemical treatment which was specified in the claims. However, the board of appeal in this case overruled the examining division and held that Article 53(b) EPC was only applicable to claims which defined new individual plant varieties which were distinguishable from other varieties, the breeding of which could be protected under the UPOV Convention. The board of appeal stated in particular that "Article 53(b) EPC prohibits only the patenting of plants or their propagating material in the genetically fixed form of the plant variety".

Decision T 49/83 makes it plain that the claimed chemical treatment, which was "the innovation claimed", "does not lie within the sphere of plant breeding, which is concerned with the genetic modification of plants". Such chemical treatment of course did not cause genetic modification of the treated plants, nor was the effect of such treatment transmissible to future generations.

3. As summarised in paragraph IV above, in decision T 19/90 Technical Board of Appeal 3.3.2 simply held that the term "animal varieties" in Article 53(b) EPC did not have the effect of excluding "animals as such" from patentability. The case was remitted to the department of first instance in order that the examining division should decide whether or not the claimed genetically engineered mammalian animals were within the meaning of the term "animal varieties".

In the Enlarged Board's view, nothing can properly be implied from what was said by Technical Board of Appeal 3.3.2 in decision T 19/90 in relation to the first half-sentence of Article 53(b) EPC as to the true meaning of the term "animal variety" ("race animale", "Tierart"), other than that "animals as such" are not excluded from patentability by this provision.

4. In order to determine whether decision T 356/93 is a "different decision" from either of decisions T 49/83 and T 19/90 with respect to the referred question of law, it is relevant to consider the objections which were actually raised by the opponent under Article 53(b) EPC, in the opposition which is the subject of decision T 356/93.

The file record of the case shows that the objection to claim 21 under Article 53(b) first half-sentence, EPC, was put by the opponent in two different ways:

(1) Claim 21 includes within its scope known plant varieties which have been genetically modified so as to be herbicide-resistant - see the working examples in the description of the patent. Because the claim embraces and thus confers protection upon such known plant varieties, it is not allowable under Article 53(b) EPC.

(2) Claim 21 defines plants (whether or not they are

"plant varieties" in the sense of the UPOV Convention before they are genetically transformed) which have been genetically modified so that they are herbicide-resistant. This characteristic of genetic herbicide-resistance is distinctive and stable in succeeding generations of the plants. Thus the claimed genetic modification itself makes the plants "plant varieties" in the sense of the revised UPOV Convention, 1991, and for this reason claim 21 defines unpatentable subject-matter within the meaning of Article 53(b) EPC.

The decision of the opposition division deals primarily with objection (1) (see paragraphs 10 and 13 of the "Facts and Submissions", and paragraphs 4.1 to 4.3 of the "Reasons for the Decision"). During the appeal proceedings, objection (2) became more prominent than objection (1), however. Thus in its communication which accompanied the summons to oral proceedings, Technical Board of Appeal 3.3.4 only referred to objection (2), and pointed out that the circumstances which give rise to this objection are different from the circumstances which were considered in decisions T 49/83 and T 320/87. Paragraph IX(d) of the "Summary of Facts and Submissions" of decision T 356/93 states, in summary of the opponent's submissions, that "the said claims [including claim 21] related to a very narrow group of plants with a particular characteristic (herbicide-resistance) which was transmitted in a stable manner down the generations ... which was intended to be part of the genetic modification of the relevant plants. This corresponded de facto to the definition of a plant variety, as defined by the [UPOV Convention]. Thus, the claims were not allowable under Article 53(b) EPC. In fact, when a claim covered something which was unpatentable, the whole claim was bad."

5. The relevant parts of the "Reasons for the Decision" in decision T 356/93 are summarised in paragraph V above. In the view of the Enlarged Board of Appeal, the essential basis for the finding in this decision that claim 21 is not allowable under Article 53(b) EPC corresponds to what is summarised above as objection (2). Thus it is clear from a careful reading of paragraphs 20 to 24 and 40.3 to 40.5 of decision T 356/93 in their context that claim 21 was held to be contrary to Article 53(b) EPC, not because the claim embraces known plant varieties (objection (1)), but because the claimed genetic modification of a plant itself makes the modified or transformed plant a new "plant variety" within the meaning of the revised UPOV Convention, 1991, and Article 53(b) EPC (ie objection (2)).

This interpretation of decision T 356/93 is supported by the fact that paragraph 40.4 of the decision states that the subject-matter of claim 21 "differs decisively" from the subject-matter dealt with in decision T 49/83 - see paragraph V above.

6. Paragraph 40.6 states that the patent proprietor admitted "that the said working examples were carried out on existing varieties", and did not deny "that claim 21 encompasses also plant varieties". This paragraph goes on to state that since the proprietor could not see "any possibility of introducing an appropriate disclaimer", he submitted that the claimed "specific plant

variety" (which the Enlarged Board understands as referring to the claimed genetic modification) should be considered as a kind of "selection invention". Board 3.3.4 did not accept this submission because, as already held in paragraph 40.5, such an invention is a "plant variety" within the meaning of Article 53(b) EPC whether or not it is a "selection invention". Thus the contents of paragraph 40.6 are consistent with and support the finding in paragraph 40.5.

The Enlarged Board does not understand anything that is said in paragraph 40.6 of decision T 356/93 as constituting a finding to the effect that claim 21 is not patentable in the sense of objection (1).

7. As stated in paragraph VI above, in his statement of reasons for referring the question of law to the Enlarged Board, the President of the EPO has relied upon the statement in paragraph 24 of decision T 356/93 as being in conflict with what was decided in decisions T 49/83 and T 19/90. In the Enlarged Board's view, when paragraph 24 is read in its context, which is in conjunction with paragraphs 40.3 to 40.8, the true meaning of paragraph 24 is essentially the same as what is said in the first three lines of paragraph 40.8: namely that claim 21 is not allowable if (as it does) it encompasses ("embraces", "includes within its scope") a "plant variety" as defined in paragraph 23, such as the genetically transformed plants which are defined in claim 21.

8. The finding in decision T 356/93 as set out in paragraph 5 above, corresponding to objection (2) above, clearly concerns an important point of law, but this point of law is not the subject of the question which the President has referred to the Enlarged Board. In the Enlarged Board's judgment there is no conflict between this finding and what was decided in decisions T 49/83 and T 19/90, because (as is apparent from paragraphs III, IV, 2 and 3 above) neither of decisions T 49/83 and T 19/90 were concerned with the point of law which was decided in decision T 356/93. In other words, two boards of appeal have not given different (ie conflicting) decisions on the question of law which the President has referred to the Enlarged Board of Appeal, as required by Article 112(1)(b) EPC.

Conclusion

For these reasons it is decided that:

The referral of the question of law set out in paragraph I above to the Enlarged Board of Appeal by the President of the EPO is inadmissible under Article 112(1)(b) EPC.