



Newsletter 6/2018 Edition

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T 1063/18: Board of Appeal Declares Rule 28(2) EPC Invalid

In a startling decision, on 5 December 2018 the European Patent Office's Board of Appeal 3.3.04 declared Rule 28(2) EPC to be invalid, since it manifestly was in conflict with Article 53 (b) EPC.

The subject matter of Appeal T 1063/18 was the Syngenta company's application [EP 2 753 168](#) relating to pepper plants. This application was refused by the European Patent Office on 22 March 2018 on the grounds that claims 1 and 2 fall under the patentability exclusion of Article 53 (b) in conjunction with Rule 28(2).

Article 53 (b) governs the exclusion of plants and animals from patentability. Rule 28(2), which was not added to the Implementing Regulations until 2017,¹ clarifies this Article to the effect that

“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.”

Syngenta appealed the decision of the examining division, arguing that the newly introduced Rule 28(2) conflicted with Article 53 (b) – especially in view of the “Tomato II” [G 2/12](#) and “Broccoli II” [G 2/13](#) decisions of the Enlarged Board of Appeal. Because Article 164(2) EPC states that the provisions of the Convention take precedence over the provisions of the Implementing Regulations, then Rule 28(2) either would have to be declared inapplicable or would have to be interpreted differently. As an auxiliary request, Syngenta asked that the case be referred to the Enlarged Board of Appeal.

After initially indicating in its provisional opinion that it was likely to dismiss the appeal, the Board of Appeal ultimately ruled otherwise. In fact, the Board declared that Rule 28(2) was in conflict with Article 53 (b) and, on the basis of Article 164(2), is consequently inapplicable. As a result, the claims of the application in question do not fall under the patentability exclusion.

And in our own affairs...

We wish you happy holidays and all the best in 2019!

Dr. Aloys Hüttermann will speak at [Patente 2019](#) on 26 February 2019 on the topic “Current Status of the Unitary Patent (EU Patent) and of the Unified Patent Court (EU Patent Court)” (event in German).

Proposals and Questions

If you have any proposals or questions, please don't hesitate to contact us [here](#).

¹ Decision of the Administrative Council of 29 June 2017, see [here](#)

With regard to further examination for patentability (clarity and inventive step) the matter was remitted to the examining division. The reasoning for the decision has not yet been issued, but is sure to be scrutinized closely.

This decision is remarkable in several respects – aside from its practical importance for companies active in the field – and is likely to cause a tremendous stir. To start with, it is the first case in which a Board of Appeal has declared a rule of the EPC to be incompatible with the EPC itself, and hence invalid. Furthermore, the Board of Appeal is standing in opposition to the obvious political pressure that led to the amendment of Rule 28 in the past year.

The history of how Rule 28(2) came into being makes evident, firstly, why the Board of Appeal could arrive at such a result, and secondly how politically contentious the issue is. Rule 28 was originally adopted² into the Rules of Procedure in response to the Biopatent Directive 98/44/EC; Rule 26 explicitly mentions this. Nonetheless, in the “WARF/Stem cells” proceedings [G2/06](#), the Enlarged Board of Appeal expressly declined to involve the Court of Justice of the European Union, citing its own independence.

The decisions G 2/12 and G2/13, mentioned above, were then issued in 2015. These decisions basically declared that plants obtained with essentially biological production methods (even conventional methods) were patentable.

Subsequently, however, in response to a request from the European Parliament, the EU Commission published a [Notice](#) in November 2016, in which it stated that the EU legislator's intention in Directive 98/44/EC was to exclude such plants and animals from patent protection. The Administrative Council of the EPO then responded to this by incorporating precisely this Rule 28(2) into the Implementing Regulations.

It seems unlikely that this matter will be brought to the Enlarged Board of Appeal any time soon. All referrals to the Enlarged Board of Appeal in the area of plant breeding in recent decades have been made by the very Board of Appeal 3.3.04 that considered it unnecessary in these proceedings to refer the issue to the Enlarged Board of Appeal. A referral to the president would require another Board of Appeal to reach a conflicting decision. This is not on the horizon. Consequently, this decision is likely to stand for the foreseeable future.

Nonetheless, it remains to be seen how the executive bodies of the European Patent Office, in particular the president and the Administrative Council, as well as the EU will deal with this decision. The possibility that all of this will be taken as an open provocation cannot be ruled out entirely, however, and could ultimately lead to a result such as a revision of the Biopatent Directive.

² Originally as Rule 23 (d), in force since 1 September 1999

[T 1914/12](#): Board of Appeal Declares Article 13(1) of the Rules of Procedure of the Boards of Appeal Partially Invalid

Just a few months before the planned completion of the new Rules of Procedure of the Boards of Appeal, a Board of Appeal (Board 3.2.05) has come to the conclusion that even the current version of Article 13(1) of the [Rules of Procedure](#) now in force is partially inconsistent with the EPC.

The first sentence of said Article 13(1) reads: “*Any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion.*” In the draft of the future Rules of Procedure, expected to enter into force in 2020, the sentence reappears in a similar form: “*Any amendment to a party's appeal case after it has filed its grounds of appeal or reply is subject to ... and may be admitted only at the discretion of the Board.*”³ The future sentence additionally includes the proviso that the party in question must justify the belated submission.

In the case at hand, the patent holder did not plead until the appeal proceedings that, for evaluating inventive step, a previously undiscussed additional distinction over the closest prior art existed of the subject matter of auxiliary petitions. In its provisional opinion with the summons to the oral proceedings, the Board of Appeal communicated that it was currently of the opinion that this belated submission was inadmissible under Article 13(1) of the Rules of Procedure.

The patent holder warned that the Board could not seriously intend to knowingly ignore facts, and thus potentially arrive at an incorrect evaluation of inventive step. Moreover, a new argument should not be considered an amendment to the case. Referring to Decision G 4/92 of the Enlarged Board of Appeal, the patent holder argued that until the current Rules of Procedure went into force it had been generally accepted that, pursuant to the EPC, the discretion of Boards of Appeal did not apply to arguments.

The Board of Appeal initially stated that in the case, for example, of an attack on novelty, the submission that the subject matter of the patent is not novel would be an objection, whereas the reference to a passage in a document as an anticipatory disclosure would be an argument. The copy of the document itself would be evidence.

The Board further stated that the EPC differed in the three official languages in Article 114 with respect to the question raised. Only the English version distinguished “facts, evidence and arguments” in Article 114(1). The English version of Article 114(2), in contrast, which relates to the discretion of the EPO, only mentions facts and evidence, but not arguments. After analyzing the Implementing Regulations and the preparatory documents for the current Rules of Procedure, the Board came to the conclusion that the English version of the EPC apparently reflected the intent of the legislator most closely.

³ Quote from draft of the revision

On this basis, the Board of Appeal drew the conclusion⁴ that recent decisions of the established case law of the Boards of Appeal had not taken into account that the EPC itself does not grant a Board of Appeal any discretion with regard to the submission of arguments by the parties. The Rules of Procedure, as a subordinate rule, cannot grant the Boards any authority that was not granted to them by the EPC as the higher-level rule. The Rules of Procedure themselves, in Article 23, define the spirit and purpose of the EPC as their own confines.

The headnote of the decision thus states the conclusion that the Boards of Appeal have no discretion regarding the admissibility of belated arguments relying on facts already present in the proceedings.

It remains to be seen whether this pleasantly surprising decision will continue to be an isolated case. It has already become clear from the remarks of chairmen of the Boards of Appeal at the recent “User consultation conference on the Rules of Procedure of the Boards of Appeal” that the interpretation of Article 114(2) EPC expressed in this decision is by no means shared by all Boards of Appeal.

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⁴ Under section 7.2.3 of the reasoning for the decision