



Long-awaited decisions on plant patentability.

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A month ago the European Patent Office wound up the long lasting saga regarding plant related inventions by making it clear that plants can be patentable even if the methods of producing them are not.

Back in 1998, the Enlarged Board of Appeal established that plants may constitute patentable subject matter even though plant varieties are excluded from patentability – these are in fact explicitly excluded in the European Patent Convention. Instead specific plant varieties can be protected by Community plant variety right (CPVR). In the view of the Board the concept of “a plant” encompasses several plants which only share a part of their genome. In contrast, a plant variety was defined as a plant grouping within a single botanical taxon of the lowest rank. Thus, the term “plant variety” covers individual plants sharing essentially all their characteristics and is much narrower than the term “plant” – and plant varieties cannot be patented individually.

Essentially biological processes for the production of plants are also excluded from patentability by the European Patent Convention. Two referrals to the Enlarged Board of Appeal, in 2007 (broccoli case) and in 2008 (tomato case), sought clarification as to the definition of “essentially biological processes”. In these cases the board found that processes for the production of plants containing steps of crossing and selection in principle are excluded from patentability. However, if the process contains an additional step of a technical nature, which introduces or modifies a trait into the genome of the plants, then the process is not excluded from patentability.

Although the first tomato/broccoli decisions clarified the requirements for the patentability of a process for the production of plants, they failed to address whether claims directed to products of such processes were also excluded. Accordingly, the claims of the tomato and broccoli application were amended to cover the tomato and broccoli plants, and the question of patentability of the plants was referred back to the Enlarged Board of Appeal as the Broccoli II and Tomato II cases.

The decisions of the Enlarged Board in the “Broccoli II” and “Tomato II” cases were published only last week. The Board found that the exclusion from patentability of essentially biological processes is limited to the processes themselves. A product or a product-by-process resulting from an essentially biological process is different subject-matter and is patentable if the other requirements for patentability are met. This holds true even if the product, e.g. a plant, can only be obtained by a process excluded from patentability. The Enlarged Board of Appeal points out that these requirements include restrictive conditions established by the case law of the boards of appeal.

The referrals induced quite a debate and numerous Amicus Briefs were filed, among these an Amicus brief from FICPI (International Federation of Intellectual Property Attorneys), which HØIBERG participated in the drafting. It was pleasing to see that the decision of the Enlarged Board of Appeal largely follows FICPI’s recommendations.

If you have any questions you are very welcome to contact your patent attorney at HØIBERG A/S.



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