

Expert opinion of Prof. Fritz Dolder (Faculty of Law, University of Basel) on the case G2/07 (Broccoli-Patent)

Summary

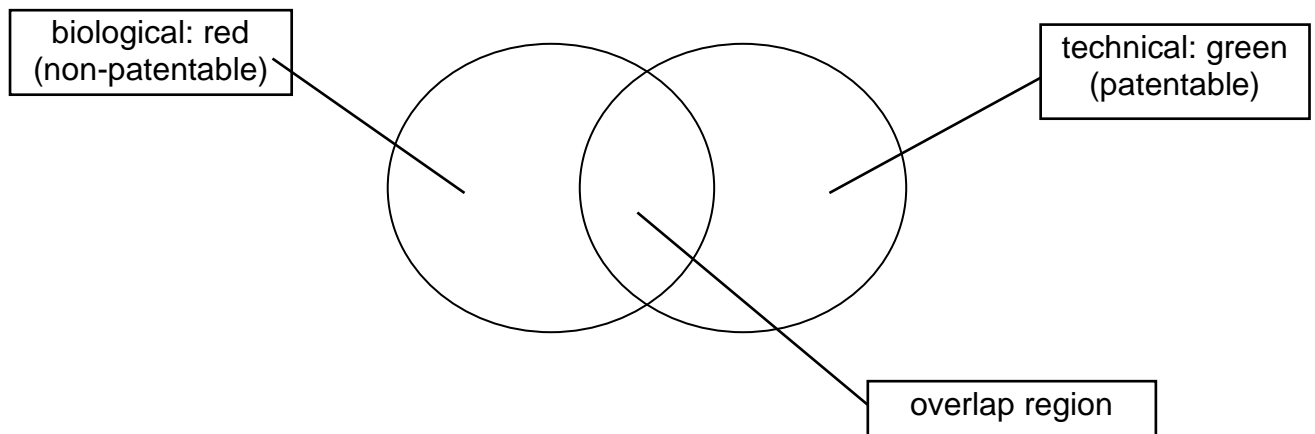
(the complete text of the position is only available in German)

This expert opinion has been mandated by the Berne Declaration, Swissaid, Misereor, Greenpeace and Kein Patent auf Leben (No Patents on Life), Prof. Dolder answers the legal questions that were formulated by the Technical Board of Appeal of the European Patent Office in the matter T 83/05 (Broccoli-Patent, Plant Bioscience Ltd.).

Question 1: *Does a non-microbiological process for the production of plants which contains the steps of crossing and selecting plants escape the exclusion of Article 53(b) EPC merely because it contains, as a further step or as part of any of the steps of crossing and selection, an additional feature of a technical nature?*

Starting Point

The questions that need to be answered have arisen from a widespread legal point of departure: The facts of a case under scrutiny complies two (or more) legal matters of fact A and B (red and green). Within the context of the available case of a plant production process it can be illustrated as follows:



If one opts for a solution according to Art. 53 (b) EPC (which says in essence that essentially biological processes for the production of plants or animals cannot be patented), then there are red spots in the overlap region. In contrast, the solution according to rule 23b (5) of the Implementing Regulations (A process for the production of plants or animals is essentially biological if it consists entirely of natural phenomena such as crossing or selection.) makes the overlap region turn completely green.

It would not be intellectually honest to reject the existence of contradictions in term of content between Art. 53 b and the rule 23 b (5) – of course always in relation to breeding processes of plants and animals. This contradiction (or: the „different nature“) in terms of content probably goes back to the relatively rushed acceptance of the standards (legal source) of the Bio Tech-Directive 98/ 44 of a *different* legislator (the EU) by the board of directors of the European Patent Office EPO in June of 1999. This unusual hast aimed at circumventing a democratic decision-making in a broader context of the EPO member states and avoid protests of opponents to biopatents and their organisations.

Solutions:

- The regulation of Art. 164 (2) EPC reorganizes the *precedence* of the article of EPC as a *lex superior* over the Implementing Regulations (IR); it is unequivocal – which is not self-evident – and can only be explained that the EPO legislator of 1973 obviously reckoned that the IR will be often amended in the future and thus, contradictions could be created which had to be solved.
- The regulation of *lex posterior* provides for giving priority of the newer over the older standard. However, this does not mean to allow the newer regulation 23 b (5) to take precedence over the regulation of Art. 53 b EPC, as this would be opposed by the explicit regulation of Art. 164 (2) EPC. With other words: in the case of a interference of *lex superior* (Art. 164) with *lex posterior*, the regulation of *lex superior* takes precedence.
- In the Novartis case (T 1054/96), the long jurisdiction as to the combinations of therapeutic and cosmetic processes was analysed and it was recorded that the Boards of Appeal in all these cases rejected the patenting of the processes, giving the substantiation that they *could* also serve as therapeutic processes and that such processes are excluded from patenting by Art. 52 (4). The judgement PGS Nr. 40.7 also shows a consent with this jurisdiction (T 290/86) and states that a claim will fall under the patenting ban of Art. 52 (4), if the invention that is claimed therein is *not only* geared to a cosmetic effect but inevitably *also* defines a therapeutic treatment of the human body.

This analogy between the patenting ban of Art. 53 b and the old Art. 52 (4) is *even more emphasized* because of the Revision 2000 which now classifies Art. 52(4) systematically as the new Art. 53 c); thus approaching the already existing patenting ban of Art. 53 b).

In the end, this analogy should favour the fact that the *overlap region* for combined breeding processes from biological and technical elements could be even fully attributed to the red area of the patenting ban. At least, this should be applicable for those situations in which the additional technical features *cannot* be separated in an appropriate way from the biological process steps; thus this would *inevitably* lead to a biological breeding process.

R E S U L T

All these deliberations lead to the conclusion that the *overlap region* of Art. 53 b EPC is either completely situated in the red ban area of that there are some red sections in this *overlap region*.

Thus, question 1 has to be absolutely answered by a clear NO.

Question 2: *If question 1 is answered in the negative, what are the relevant criteria for distinguishing non-microbiological plant production processes excluded from patent protection under Article 53(b) EPC from non-excluded ones? In particular, is it relevant where the essence of the claimed invention lies and/or whether the additional feature of a technical nature contributes something to the claimed invention beyond a trivial level?*

If the *overlap region* is completely subject to the patenting ban of art. 53 b) (red area), then this would lead to the fact that the *incidence of biological steps* would function as demarcation criterion in the breeding process under scrutiny. This would anyhow lead to a patenting ban regardless whether there is an incidence of additional technical elements in the breeding process under scrutiny (see above: dispensation of justice in the framework of Art. 52(4)). From a legal and methodical viewpoint, this solution would be perfectly desirable, as it would contribute to the legal homogenous implementation of the application of the law within the new Art. 53. On the other hand, this solution would enable the patentee to get an independent patent – if such would exist – by an appropriate disclaimer for the use outside of the *overlap region*.

If only certain parts of the *overlap region* should be subjected to the patenting ban of Art. 53 b, then there must be a boundary drawn within the *overlap region* and relevant reasons must be given to justify the drawing up of such a demarcation.

In this connection, there is an urgent warning to use the **essence of the claimed invention** or the **essentiality/ inessentiality** of the contribution of the additional technical features as delimitation criteria – as has been proposed in the question of the Board of Appeal. Yet, the present procedure makes it already clear: If the essentiality in the text of Art. 53 b EPC was an appropriate delimitation criterion, then the present dispute would probably not have been created.

In the following situation, the breeding processes should be attributed to the area of patenting bans (red area) *despite* their additional technical features:

- The additional technical features are *exclusively* characterized as a means to *circumvent* the patenting ban of Art. 53 b) EPC.
- The additional technical features are *superfluous (redundancies)* and have no effect on the result of the combined process.
- The additional technical features *cannot be used in functionally appropriate way* outside of a combined process to breed plants (or animals) in the sense of Art. 53 b). Here, the criterion of what is *functionally appropriate or useless* should be judged according to technical and scientific viewpoints.

Competition: It could be probably sufficient if one of the above-mentioned criteria is fulfilled in an **alternative** way in order to have a process falling under the patenting ban of Art. 53 b). Accordingly, all criteria would have to be every time negated **cumulatively**, in order for a process to be attributed to the green area of patentability within the *overlap region*.

R E S U L T

In case the *overlap region* should entirely be subjected to the patenting ban of Art. 53 b) (red area), then the mere *incidence of biological steps* in the breeding process under scrutiny would serve as demarcation criterion.

In case of only sections of the *overlap region* being subjected to the patenting ban of Art. 53 b), then various alternative delimitation criteria are proposed. However, these do *not* form a consistent system in themselves.

There is an advise against the use of the term *essentiality* (of the questionable technical features) as a delimitation criteria.