

## CASE G 2/07

### COMING SOON, AN INTERPRETATION OF THE EXPRESSION « ESSENTIALLY BIOLOGICAL PROCESS » BY THE EPO'S ENLARGED BOARD OF APPEAL

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*The question of the patentability of plants was a struggle of the last century. Decision G 1/98, later taken up in the "biotechnologies" directive, validated the patentability of plants produced through genetic engineering and their preparation processes when they are not limited in the strict sense to a single particular variety whose definition refers to the conditions for obtaining the plant variety certificate.*

Consequently, we have seen a rash of European patents claiming methods for the production of plants with particular phenotypic characters, such as resistance to pathogens, these plants being obtained using the usual methods of crossbreeding between species, but selected using molecular biology methods based on the detection of genetic markers associated with the phenotypic characters sought.

As marker identification is the fruit of massive investments in genome research on plants, it is logical for the seed industry and research institutes to seek to protect their results using the widest protections that patents have to offer.

For this, the protection of a process for producing a plant can be used to protect not only the process as such, but also the plant obtained with the process.

Article 53b) EPC, however, stipulates that "European patents shall not be granted in respect of [...] essentially biological processes for the production of plants or animals, [...]."

The question remains as to the patentability of a process for obtaining non-transgenic plants with the usual methods of crossbreeding between species selected using molecular biology techniques to detect genetic markers.

In this case, the claimed processes include at least one non-natural technical step for selecting plants by analyzing their DNA. Rule 23b(5) of the EPC indicates that *"A process for the production of plants or animals is essentially biological if it consists entirely of natural phenomena such as crossing or selection."*

The question is whether the presence in the process of this selection step using "non-natural" techniques is reason enough for said process to escape the exclusion from patentability covering essentially biological processes.

The battle is on in the EPO's opposition divisions, but the question has not been settled so far. In case T 83/05, the Technical Board of Appeal considered that a decision by the Enlarged Board of Appeal would be needed to determine what is covered under the expression *"essentially biological process"*.

This case concerns patent EP 1 069 819 which claims a method of production for Brassica oleracea (broccoli) with high levels of glucosinolates; this method includes crossbreeding species and a selection of interesting lines, characterized in that the selection steps are based on the detection of molecular markers.

This patent was maintained in modified form following an opposition. During the appeal procedure, the opponents claimed that the simple use of molecular markers to select the plants obtained by crossbreeding was not a sufficient technical step for this process to be considered as not essentially biological.

The applicant, on the other hand, responded that rule 23b (5) defines an essentially biological process as consisting entirely of natural phenomena.

The Board of Appeal therefore submitted the following questions to the Enlarged Board of Appeal:

- 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 an additional feature of a technical nature as a further step or as part of any of the steps of crossing and selection?



- 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 to consider where the essence of the claimed invention lies and/or whether the additional feature of a technical nature contributes to the claimed invention beyond a trivial level?

These questions will be examined under case number G 2/07.

All professionals in the genetic improvement of plants eagerly await the decision.

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*Case G 2/07: Coming soon, an interpretation of the expression « essentially biological process » by the EPO's Enlarged Board of Appeal -- Franck TETAZ and Lucile VERNOUX*