Enlarged Board of Appeal
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY

For the attention of: Mr Wiek Crasborn, EBAamicuscuriae@epo.org

27 September 2019

Dear Sirs

Amicus Curiae Brief – G 3/19

The IP Federation submits this written statement, in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal, for the assistance of the Enlarged Board in considering case G3/19. In summary, the IP Federation's submission is that the questions referred by the EPO President are inadmissible. In case the Enlarged Board finds they are admissible, the IP Federation also makes observations relating to the substance of question 1.

The questions

In accordance with Article 112(1)(b) EPC, the President of the European Patent Office has referred the following points of law to the Enlarged Board of Appeal:

1. *Having regard to Article 164(2) EPC, can the meaning and scope of Article 53 EPC be clarified in the Implementing Regulations to the EPC without this clarification being a priori limited by the interpretation of said Article given in an earlier decision of the Boards of Appeal or the Enlarged Board of Appeal?*
2. *If the answer to question 1 is yes, is the exclusion from patentability of plants and animals exclusively obtained by means of an essentially biological process pursuant to Rule 28(2) EPC in conformity with Article 53(b) EPC which neither explicitly excludes nor explicitly allows said subject-matter?*

The IP Federation respectfully submits the following observations as *amicus curiae*.

Admissibility

The referral is inadmissible in respect of both questions because the requirement of Article 112(1)(b) EPC is not met. Sub-paragraph (b) states that "the President of the European Patent Office may refer a point of law to the Enlarged Board of Appeal where two Boards of Appeal have given different decisions on that question".

In regard to the first question, there are earlier decisions of the Boards of Appeal that have considered the relationship between the Convention and Implementing Regulations made under it. As the President points out, those decisions have taken different approaches and have been worded differently. However, those decisions did not come to different conclusions, and therefore they are not different decisions in the sense of Article 112(1)(b) EPC. This is true in relation to the general proposition, viz the relationship between any Article and any Rule; but it is even more so the case in specific relation to Article 53 and Rule 28, where there have been no decisions other than T1063/18, and therefore none to conflict with it.

As the second question is specific to Article 53 and Rule 28, the absence of any case on the point other than T1063/18 means there can be no conflict with any other case, and hence no valid basis for a referral by the President.

Despite references in the President's referral to the chapeau of Art 112(1), which says "in order to ensure uniform application of the law, or if a point of law of fundamental importance arises ...", this wording does not create any wider basis for a valid referral. The chapeau provides a statement of purpose for referrals from various sources to the Enlarged Board; sub-paragraph (b) alone defines and entirely circumscribes the legal basis the President must establish.
In case the President's referral is admitted, the IP Federation submits the following observations in relation to the questions.

Legal Hierarchies

In the specific context of this case, viz Art 53 and Rule 28, it is disingenuous for question 1 to speak of Article 53 being "clarified" by an "... Implementing Regulation to the EPC without this clarification being a priori limited by the interpretation of said Article given in an earlier decision of the Boards of Appeal or the Enlarged Board of Appeal". The Enlarged Board's consolidated decision in G2/12 and G2/13 does not limit the new Rule, it obviates the requirement for it. As a result of that decision, Article 53(b) is quite clear in the relevant respects, namely regarding the patentability of plants or animals produced by essentially biological processes. It requires no clarification in this respect.

In fact, Rule 28(2) attempts to change, not clarify, the meaning of Article 53(b). It is a very well established principle of law that legal hierarchies cannot be inverted, such that a procedural rule can amend a statute, unless there is specific provision explicitly granting the power to do so. In the EPC, Article 164(2) makes clear that "In case of conflict between the provisions of this Convention and those of the Implementing Regulations, the provisions of this Convention shall prevail". Rule 28(2) cannot therefore change, by amendment or "clarification", Article 53(b).

Relationship between the EPC and the Law and Policy of the EU and of Contracting States

It cannot be ignored that the wording of Article 53(b) is identical to that Article 4(1)(b) of EU Biotech directive 98/44/EC. The decision of the Enlarged Board of Appeal in G2/12 and 2/13 prompted the EU parliament in 2015 to express concern and to call on EU Member States and the EU Commission to take action. In November 2016 the EU Commission issued a Notice on certain articles of Directive 98/44/EC of the European Parliament and of the Council on the legal protection of biotechnological inventions (2016/C 411/03). It expressed the Commission view that products obtained from essentially biological processes are excluded from patentability by way of the Biotech directive. This Notice was endorsed at a meeting of the EU Competitiveness Council in February 2017, whose conclusions urged Member States to advocate that the practice of the EPO be aligned with the Commission Notice. In due course, and after intensive discussions, the Administrative Council of the EPO amended Rule 28 EPC by inclusion of a new provision, Rule 28(2) EPC (decision of the Administrative Council CA/D 6/17), which entered into force on 1st July 2017.

The Commission explicitly acknowledges in its Notice that the Notice has no legal effect. For example, it says, "The Notice is intended to assist in the application of the Directive, and does not prejudge any future position of the Commission on the matter. Only the Court of Justice of the European Union is competent to interpret Union law." Thus, the Commission's Notice has no legal force even within the jurisdiction of the EU, and certainly can have none under the Articles of the EPC and its subordinate rules. Rather, the Commission Notice, and its endorsement by the EU Competitiveness Council, represent a statement of EU policy, and have no effect on or under EPC law.

Similarly, the positions being taken by EPC Contracting States in their own jurisdictions, whether or not they are also Member States of the EU, do not in themselves bear on the questions referred by the President. The policies and consequent legislative changes being made in some of those states in relation to the patentability of the products of essentially biological processes have no locus in the consideration of purely legal questions under the EPC, such as question 1 in the President's referral.

Proper rule of law

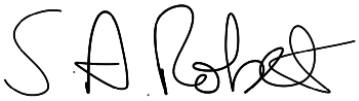
The IP Federation recognises the controversy created in some quarters by the Enlarged Board's decision in G2/12 and 2/13 and continued in T1063/18. We do not, at this time, wish to express a view on the underlying patentability questions. Neither do we see those as being relevant to this referral.

Rather, in the context of this referral, we wish to emphasise the need for legal certainty, and the proper application of the law and interpretative instruments. It is of fundamental importance that the EPC, including its Implementing Regulations and Protocols, is applied reliably, predictably and rigorously at all times. In the interests of legal certainty across all technical fields, the EPO should apply the Convention consistently and in accordance with the decisions of the Enlarged Board – as it has in the past. Crucially, the Boards of Appeal, including and especially the Enlarged Board, should be free to decide cases before them on an impartial interpretation of the law made in and under EPC.

Issues arising from interpretation of EU law must be a matter for the CJEU, as the European Commission itself recognises. Any changes to the Articles of the EPC, for example to take account of changes in policy, should be made through the legislative procedures laid down in the Convention for that purpose, not through procedural devices lacking proper vires. With respect to the evolution of policy and corresponding legislation, the existing processes of good order in respect of legislative change should be followed. These considerations go hand-in-hand with question 1 being answered in the negative.

This submission does not separately address question 2, as we say the answer to question 1 is no.

Yours sincerely



Scott Roberts
Vice-President, IP Federation

IP Federation members 2019

The IP Federation represents the views of UK industry in both IPR policy and practice matters within the EU, the UK and internationally. Its membership comprises the innovative and influential companies listed below. The CBI, although not a member, is represented on the Federation Council, and the Council is supported by a number of leading law firms which attend its meetings as observers. It is listed on the joint Transparency Register of the European Parliament and the Commission with identity No. 83549331760-12.

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