

## **Amicus Curiae Brief for case G 3/19 before the Enlarged Board of Appeal**

FEMIFI is the European Federation of Patent Attorneys and Industrial Property Agents in Industry established in 1971. Its members are the corresponding national organizations of Austria, Denmark, Finland, France, Germany, Luxemburg, Norway, Sweden, Switzerland, the United Kingdom, and the Netherlands. It therefore represents the interests of a great number of the users of the European Patent System.

In this Amicus Curiae Brief FEMIFI wishes to share its view on the Referral of a point of law to the Enlarged Board of Appeal by the President of the European Patent Office (Article 112(1)(b) EPC), as well as its general legal concerns with some proceedings of the European Patent Office leading to this Referral.

The President has submitted two questions to the Enlarged Board of Appeal stemming from the Board of Appeal decision T 1063/18, specifically

“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?”

and

“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?”

As detailed further below, the questions raised in the Referral are to be denied and the Referral is not admissible.

Nevertheless, FEMIFI first wishes to address its concerns regarding the distribution of powers

within the European Patent Organization, here specifically the role of the Administrative Council in the present case, as well as the wider ramifications thereof.

The Enlarged Board of Appeal had decided in decisions G 2/12 and G 2/13, that Article 53 (b) EPC, while excluding essentially biological processes for the production of plants or animals from patentability, does not exclude products obtained from such processes from patentability.

Subsequently and to override decisions G 2/12 and G 2/13, the EU Commission issued a non-binding interpretative Commission Notice on Article 4 (1) (b) of the Biotech Directive (2016/C 411/03) wherein it takes the view that that the EU legislator's intention when adopting Directive 98/44/EC was to exclude products from patentability (plants/animals and plant/animal parts) that are obtained by means of essentially biological processes.

The EU Commission in its Notice on Article 4 (1) (b) of the Biotech Directive, however, admits that:

“The Notice is intended to assist in the application of the Directive, and does not prejudice any future position of the Commission on the matter. Only the Court of Justice of the European Union is competent to interpret Union law.”

In reaction and based on that Notice, the Administrative Council of the European Patent Office issued new Rule 28 (2) EPC, stating that under Article 53 (b) EPC, European patents shall not be granted in respect of plants or animals exclusively obtained by means of an essentially biological process. ,

However, the legislator of the EPC had determined a clear hierarchy between Articles and Rules, which is codified in Article 164 (2) EPC stipulating that in case of conflict between the provisions of the EPC and the Implementing Regulations of the EPC, the provisions of the Convention shall prevail.

In addition, the legislator of the EPC had determined that Articles of the EPC may only be amended or revised by the Contracting States with a majority of three-quarters of the Contracting States represented and voting at the Conference. Only in very specific circumstances, as set out in in Articles 33 (1) b) and (5), and Article 35 (2) EPC, the Administrative Council is empowered to amend the EPC, this being conditional on international treaties or

European Community legislation having entered into force. However, none of these specific circumstances applies in the present case.

The Commission Notice therefore could not empower the Administrative Council with competence on EPC amendments based on "European Community legislation relating to patents" according to Article 33 (1) b), as it is not binding EU Law but rather a non-binding opinion.

In certain cases, the Articles of the EPC need to be interpreted and clarified. . In the European Patent Organisation, this interpretative role is accorded to the judicial branch namely to the Enlarged Board of Appeal.

Such interpretation, entirely in line with the role and power given to the Enlarged Board of Appeal by the EPC is precisely what was done in G 2/12 and G2/13 when the Enlarged Board of Appeal interpreted Article 53 (b) EPC following the principles of the Vienna Convention.

The Administrative Council, on the other hand, is empowered to amend the Implementing Regulations (Rules) without restrictions, thus providing an additional means for clarification of the Articles of the EPC. In case of conflict, this empowerment is, however, limited by Article 164 (2) EPC.

In the present case, Rule 28 (2) is in conflict with Article 53 (b) EPC as interpreted by the Enlarged Board of Appeal. According to Article 164 (2), the provisions of the EPC shall prevail in such a case, as explicitly stated in decision T 1063/18.

It is therefore impossible for a Rule to override and reverse the meaning of an Article, since a Rule is secondary to the Articles of the EPC by law. Only an amendment of the respective Article, be it by means of a Diplomatic Conference or, in special circumstances, by the Administrative Council, can have this effect.

This holds true in the present case, where the amendment of Rule 28(2) EPC does not entail a mere "clarification" of the meaning of Article 53 (b) EPC, but where the new Rule 28(2) EPC is in direct contradiction to Article 53 (b) of the EPC.

To act otherwise would erode the system of checks and balances in the European Patent

# FEMIFI

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Established in 1971

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Organisation, effectively stripping Article 164 (2) EPC of its legal effect, and eroding the Judicative (ultimately the Enlarged Board of Appeal) and its power to verify acts of the Administrative Council. In this scenario the Administrative Council could effectively circumvent the restrictions of Article 164 (2) EPC and/or the tedious process of a Diplomatic Conference, which is precisely what has been attempted in the present case.

Such a course of action would lead to a lack of judicial control over the actions of the Administrative Council. Judicial control is, however, one of the fundamental pillars of any acceptable judicial system. Any concerns about new tendencies in the European Patent Organisation in this regard would not be limited to the present case, but would indeed extend to all other technological areas as well as all aspects of the European Patent Convention.

As a consequence, the trust in the European Patent Office and its conformance to essential principles of rule of law would be severely eroded. There is a severe risk that this loss of trust would also extend to the patents granted by the European Patent Office, including future Unitary Patents.

Therefore Question 1 of the Referral has to be denied. This means that Question 2 will not be dealt with, but it goes without saying that Question 2 of the Referral would likewise have to be answered in the negative, too. To do otherwise would mean to effectively remove the role of the judicative to easily overcome the limitations imposed on the powers of the Administrative Council by Article 33 EPC and Article 164 (2) EPC

It is FEMIFI's view that the Referral is also inadmissible.

Article 112 (1) b) EPC stipulates that the President of the European Patent Office may only refer a point of law to the Enlarged Board of Appeal in order to ensure uniform application of the law, or if a point of law of fundamental importance arises where two Boards of Appeal have given different decisions on that question.

However, in the present case, there are no different decisions of two Boards of Appeal on the question whether Rule 28(2), in its relation to Article 53(b) EPC, complies with Article 164(2) EPC. This question was discussed only in T 1063/18, taking into account decisions G 2/12 and G 2/13. None of the other decisions mentioned in the Referral deals with the same point of law. Actually, none of the other decisions concerns the issue that a new Rule is in direct contradiction with an Article of the EPC, as interpreted by the Enlarged Board of Appeal, i.e. a situation at least similar

to the one in the present case.

Therefore, the requirements of Article 112 (1) b) EPC for a Referral are clearly not met.

The Referral should thus be rejected as either not admissible or not substantiated.

In addition, in the interest of legal certainty for the users of the European patent system and the general public, as well as to preserve trust in the European patent system (and the future Unitary Patent and Unitary Patent Court system), we strongly advise to accept the current interpretation of Article 53(b) EPC by the Enlarged Board of Appeal and delete Rule 28(2) EPC.

If an amendment of Article 53b) EPC is still desired, this would need to be done either by way of a Diplomatic Conference or, the issuance of a ruling of the Court of Justice of the European Union on the question of the patentability of plants and animals as products from essentially biological processes or the entry into force of amended EU law governing the patentability of plants.

As a concluding remark, this Referral is an opportunity to demonstrate that the Judicative of the EPO (in this case the Enlarged Board of Appeal) is indeed independent. Dismissal of the Referral could help dispelling doubts voiced in the past in this regard, strengthening the trust in the EPO and in the Unitary Patent System, also with a view to the pending procedure before the German Constitutional Court.