

ESA\_12.0823

Brussels, November 30, 2012

**Subject: written statement in respect of case G 2/12**

Dear Madam / Sir,

ESA the European Seed Association appreciates the opportunity offered to third parties to file written statements in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal regarding the points of law referred to the Enlarged Board of Appeal by the Technical Board of Appeal with interlocutory decision of 31 May 2012 in case T 1242/06.

ESA is the voice of the European seed industry, representing the interests of those active in research, breeding, production and marketing of seeds of agricultural, horticultural and ornamental plant varieties. Protection of intellectual property is a matter of high importance for the European seed industry. In this respect we refer to the ESA position paper on Intellectual Property Protection for Plant-related Inventions in Europe (ESA\_12.0100) adopted in October 2011, which is attached to the present letter.

ESA considers the 1991 Act of the UPOV Convention to be the most suitable existing *sui generis* intellectual property system for the protection of plant varieties *per se*: on the one hand it provides for effective protection of plant varieties of all genera and species in order to obtain return on investment; and on the other hand it guarantees the continuous flow of improved plant varieties by safeguarding access to genetic variability through the so-called breeder's exemption which is a key cornerstone of the system. At the same time ESA is of the view that besides plant breeder's rights also patents play an increasing and important role in the European seed and plant breeding sector. Nevertheless, it has to be underlined that while in theory plant varieties as such are excluded from patent protection, in practice – as a result of the specific nature of plant-related patents – plant varieties often fall under the scope of certain patents. As the current European patent system does not provide for a breeder's exemption this blocks access to biological material for further breeding which material otherwise would be free for such purposes under plant breeder's rights.

ESA is of the opinion that in order to safeguard the necessary access to genetic variability for the development of new, improved plant varieties the questions asked to the Enlarged Board of Appeal should be answered as follows:

### Ad question 1)

*Can the exclusion of essentially biological processes for the production of plants in Article 53(b) EPC have a negative effect on the allowability of a product claim directed to plants or plant material such as fruit?*

This question must be answered in the affirmative.

If claims on products obtained by a non-patentable essentially biological process would still be allowable, this would make the exclusion of Article 53 (b) EPC meaningless. This is because the protection on the product would also hinder the use of the essentially biological process. Therefore the exclusion of essentially biological processes can and should have a negative effect on the allowability of a product claim directed to plants or plant material resulting from the application of such essentially biological process.

### Ad question 2)

*In particular, is a claim directed to plants or plant material other than a plant variety allowable even if the only method available at the filing date for generating the claimed subject-matter is an essentially biological process for the production of plants disclosed in the patent application?*

As described above, allowability of such a claim would make the exclusion of essentially biological processes meaningless. Therefore this question has to be answered negatively.

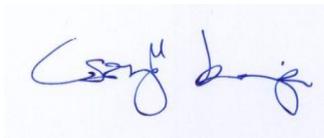
### Ad question 3)

*Is it of relevance in the context of questions 1 and 2 that the protection conferred by the product claim encompasses the generation of the claimed product by means of an essentially biological process for the production of plants excluded as such under Article 53(b) EPC?*

ESA is of the view that it is of relevance because in the case a claim is directed to plants obtained by a **non** essentially biological process, for example, a process consisting of genetic modification, technically induced mutagenesis, protoplast fusion or another technical process not based on crossing and selection, such claim is allowable even if the same plants could be obtained by an essentially biological process. However in such a case ESA is of the opinion that the effect of patents granted on such plants should not extend to biological material having the same properties as the patented material but produced independently, without the use of the patented material, and by an essentially biological process.

ESA would like to thank you once again for the opportunity to contribute to the discussion on this important topic. We are confident that you will give due attention to the considerations presented above.

Yours sincerely,

A handwritten signature in blue ink, appearing to read 'Szonja Csörgő', is displayed on a light blue rectangular background.

Szonja Csörgő

Manager Intellectual Property and Legal Affairs

Annex:

ESA position on Intellectual Property Protection for plant-related inventions in Europe (ESA\_12.0100)