

no patents on seeds



Procedure G 2 / 12, Comment Prof Dr Fritz Dolder, Basel

Short summary of arguments put forward by No Patents on Seeds:

According to Professor Dolder the examination of a patent application should follow a so called *whole content approach* and not only consider the wording of the claims. This basic principle has already been applied by the European patent office in connection with the patenting of human embryonic stem cells (G/06). The European Parliament confirmed this basic principle in its resolution of 10 May 2012.

Against this background, Professor Dolder answers the three questions forwarded to the Enlarged Board of Appeal as follows:

(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 a fruit?

Patent protection for the product would unavoidably lead to indirect patent protection for the process. For technical and scientific reasons, the product and process are so interconnected that patent prohibition for one part would necessitate patent prohibition for another. This in turn would make Art. 53 b (in regard to plant breeding) redundant or pointless and leave it with no practical area of application.

It would in effect mean that patent prohibitions for such plant breeding processes could easily be evaded by clever wording of the patent claims.

Question 1 must therefore be answered with YES

(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 a consequence it also follows that the patent prohibition for biological processes of plant breeding can in fact have a negative effect on whether a product claim could be granted when the only - on the day of registration - available process of production of the claimed object in the patent application is an essentially biological process of plant breeding. Otherwise Art 53 b would lose its legal function.

Question 2 must therefore be answered with No

(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?

If this question were answered in the negative it would enable those filing patent applications in the field of plant breeding to easily circumvent patent prohibitions in Art. 53 by. Just by using product claims a far reaching legal protection can be obtained encompassing monopolistic rights which would otherwise be the object of prohibited process claims.

This would lead to a contradictory situation in which legislation would prohibit narrower legal protection of process claims whilst at the same time allowing the usual wider legal protection resulting from product claims.

In consequence of such an undesirable outcome, it is apparent that process claims can not be ignored when assessing product claims according to Art. 53b). They should in fact be considered in the sense of a *whole content approach*.

Therefore the scope of protection holds a further argument against granting claims on products derived from conventional breeding.

Question 3 must therefore be answered with YES