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Tomatoes and Broccoli at the Enlarged Board again – patent protection is available for plants and fruit

In its second bite at the Tomatoes and Broccoli cases, the Enlarged Board has confirmed that plants and plant materials produced by biological processes are not excluded from patentability.

In combined cases G2/12 and G2/13, known as the Tomatoes II and Broccoli II cases, the EPO's Enlarged Board of Appeal has held that the exclusion from patentability provided in Article 53(b) EPC of essentially biological processes for the production of plants does not have a negative effect on the allowability of product claims to plants and plant materials that are produced by such processes, even if the claims are formulated as product-by-process claims.

This is the second time that the Enlarged Board has considered these cases, after it held in 2010 in G2/07 and G1/08 that processes for the production of plants based on steps of sexually crossing genomes and selecting plants are excluded from patentability under Article 53(b) EPC. In these cases, the Enlarged Board held that such processes cannot escape the exclusion of Article 53(b) EPC by merely having a technical step that enables or assists the process of crossing the genomes; this conclusion had been a significant concern to innovators in the agriculture and plant genetics fields. Following these decisions, the two patent proprietors deleted claims directed to processes and instead proceeded with claims reciting, on the one hand, a tomato fruit with the desirable characteristics provided by the process that was deemed to be excluded and on the other, claims reciting a broccoli plant produced according to the excluded process. Both cases were then referred back to the Enlarged Board to clarify what effect the exclusion of essentially biological processes for the production of plants has on product claims directed to plants and plant material.

Article 53 EPC sets out subject matter that is excluded from patentability and paragraph (b) refers to: "essentially biological processes for the production of plants or animals". In the recent decision, the Enlarged Board carried out a detailed and methodical analysis of the language used in Article 53(b) EPC and its legislative history and came to the conclusion that the term "essentially biological processes for the production of plants or animals" should not be interpreted as extending to products defined or obtained by such processes. The Enlarged Board therefore concluded that the exclusion of essentially biological processes for the production of plants does not have a negative effect on the allowability of a product claim directed to plants or plant material per se, such as fruit. This is true even if the claim is a product-by-process claim defining an essentially biological process, or if the only method available at the filing date for generating the claimed subject matter is an essentially biological process.

The Enlarged Board's decision is not unexpected because it follows the submissions and suggestions of the President of the EPO and it follows the previous practice of the Enlarged Board to interpret exclusions from patentability narrowly. Nevertheless, innovators in the agriculture and plant genetics fields will welcome this decision and the clarity it brings regarding the patent protection that is available at the EPO for plants and plant materials. However, patent applicants should keep in mind that any claims to plants and plant materials will still need to meet the patentability requirements of the EPC, which may be difficult if the products themselves do not exhibit unexpected technical effects. In addition, certain European states, including Germany and the Netherlands, have legislation that excludes from patentability claims to products generated by essentially biological processes, so complex claim strategies are likely to be necessary to obtain optimal protection for many new developments.

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