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March 2011

The Enlarged Board of Appeal discusses what makes an Invention Patentable

Background

The European Patent Convention (EPC) does not define what it means by an "invention". However, some categories of invention are not patentable, including "essentially biological" processes for the production of plants. There is no precise definition in the EPC of what makes an invention patentable, nor of what is meant by an "essentially biological" process.

The Enlarged Board of Appeal (EBA) has issued a decision (G2/07) addressing both of these issues.

The decision

The decision considers two cases, concerning processes of producing broccoli and tomatoes, respectively. The two processes have in common the steps of selecting particular plants, for subsequent sexual crossing. The broccoli process includes a further technical step, of using molecular markers to aid selection, while the tomato process has the additional step of leaving the tomato on the vine longer than normal.

The EBA decided that an invention is patentable if it contains a technical step which *adds to* (as opposed to merely facilitating) the unpatentable process.

Therefore, the EBA decided that a process, in which the only human intervention is selection of particular plants, is "essentially biological". Additionally, if the process only uses technical means to enable or assist such a process (for example, housing the plants in a suitable greenhouse, or using molecular markers to select plants), that process is still "essentially biological".

A patentable process of producing a plant (and, by extension, an animal) must include a technical step which *by itself* changes the genome in some way. In other words, it must have a step which alters the genetic make-up of the product plant in a way that is not dependent on sexual crossing.

The Effect of the Decision

In future it will be more difficult to obtain patents to processes for producing plants. Only those which include a genetic engineering step are likely to be patentable. The novelty and inventive step of such a process will depend on the novelty and inventiveness of that genetic engineering step.

The EBA has established a principle, that an invention is patentable if it contains technical subject matter which *adds to* (as opposed to merely facilitating) the unpatentable subject matter of the remainder of the invention. It seems highly likely that the European Patent Office will start to apply this test in other areas involving unpatentable subject matter, such as computer-implemented inventions and business methods.

If you would like more information about this decision, please contact Jon Gowshall, partner in our Life Sciences team.