

**PLANTS (AND, BY ANALOGY, ANIMALS)
ARE PATENTABLE AT THE EPO**

At last, the debate which has been raging for the last 12 years seems to be over.

Our last newsletter on this topic alerted you to the introduction of new EPO rules, effective from 1 September 1999, which mirrored the EU Biotechnology Directive. By means of these, the President of the EPO effectively instructed the examiners to regard plants and animals as potentially patentable subject matter, provided that the claims did not define a “variety”. However, these rules could have been deemed to be *ultra vires* if the Enlarged Board of Appeal, in the pending *Novartis* case (G1/98), construed the EPC to exclude plants and animals from patentability.

The Enlarged Board rendered its decision on 20 December, and we are pleased to report that it is favourable for innovative industry. In particular, there is no bar to patentability just because a claim *embraces* plant varieties (as virtually all claims to transgenic plants do), provided that the claims do not *define* a variety. In practice, any claim which embraces a whole species (with the novel modification), or larger taxonomic groups such as genera or families, will be potentially patentable. By analogy, the same applies to claims for animals.

The examiners have been examining pending claims to plants and animals since 1 September 1999 but applicants can now be more confident that such claims will be regarded as potentially valid.

The decision can be viewed at the EPO’s web site (www.european-patent-office.org) or we should be pleased to e-mail it to you in pdf format on request to our information officer, Karen Pegg (kpegg@eric-potter.com).

The information in this Newsletter was correct at the date of release. More up to date information is available by contacting Eric Potter Clarkson. All comments contained here are of a general nature and full professional advice should be sought on any specific problem.