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**DECISION**  
of 5 March 2004

**Case Number:** T 1026/02 - 3.3.4  
**Application Number:** 97951782.8  
**Publication Number:** 0891130  
**IPC:** A01H 5/10  
**Language of the proceedings:** EN

**Title of invention:**

Oilseed brassica containing an improved fertility restorer gene for ogura cytoplasmic male sterility

**Applicant:**

PIONEER HI-BRED INTERNATIONAL, INC.

**Opponent:**

-

**Headword:**

Oilseed Brassica/PIONEER HI-BRED INTERNAT., INC.

**Relevant legal provisions:**

EPC Art. 54(3), 83, 111(1)

**Keyword:**

"Enablement of prior art document (1) (no)"  
"Remittal to the first instance (yes)"

**Decisions cited:**

T 0206/83, T 0158/91, T 0612/92, T 0694/92, T 0639/95,  
T 0727/95, T 1091/00

**Catchword:**

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Case Number: T 1026/02 - 3.3.4

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.4  
of 5 March 2004

**Appellant:**  
(Applicant)

PIONEER HI-BRED INTERNATIONAL, INC.  
800 Capital Square  
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**Representative:**

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**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 24 May 2002  
refusing European application No. 97951782.8  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairwoman:** U. Kinkeldey  
**Members:** M. Wieser  
S. Hoffmann

## Summary of Facts and Submissions

I. The appeal was lodged by the Applicants (Appellants) against the decision of the Examining Division to refuse under Article 97(1) EPC the patent application EP 97 951 782.8, publication number EP-A-0 891 130 (international publication number WO-A-98/27 806), with title "Oilseed Brassica containing an improved fertility restorer gene for ogura cytoplasmatic male sterility".

II. The Examining Division decided that claim 5 of all requests before them, a main request and three auxiliary requests, was not novel over document (1), WO-A-97/02 737, which belonged to the state of the art according to Article 54(3) EPC.

III. Claim 5 read:

"A Brassica plant, or part thereof, comprising a homozygous fertility restorer gene for ogura cytoplasmatic male sterility, wherein upon pollination the plant yields oilseed defined in any of claims 1 to 3 and preferably also an erucic acid content of no more than 2% by weight based on the total fatty acid content."

The oilseed was defined in claims 1 to 3 by having a glucosinolate content of less than 30, respectively less than 25, respectively less than 20  $\mu\text{mol}$  per gram.

IV. The Examining Division came to the conclusion that document (1) disclosed a homozygous fertility restorer line that produced seeds with a low glucosinolate

content. The teaching of document (1) was considered to be enabling and to allow a skilled person to obtain such plant without undue burden.

- V. The Appellants requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 13, filed at the oral proceedings on 5 March 2004.

Claim 4 of this request is identical with claim 5 of the requests before the Examining Division (see section III above).

- VI. The submissions made by the Appellants, who filed three sworn affidavits by technical experts to substantiate their arguments, may be summarized as follows:

Document (1) was not prior art because there was no disclosure of homozygosity of the restorer gene and low glucosinolate content in a single Brassica plant. On the one hand the document disclosed data relating to low glucosinolate lines (BN0027 and BN0559), however no data were presented to show that any of these lines were homozygous for the fertility restorer gene. On the other hand the document disclosed homozygosity data relating to a doubled haploid line (BN0611) without presenting any data to show that this line was low in glucosinolates.

The disclosure in document (1) was not enabling, as no deposits of seeds or molecular markers have been made. The experimental work of document (1) was considered to be inaccurate and unreliable. The plant lines used in the crosses were proprietary lines which were not

available to the public. The fact that only three out of 700 backcrosses gave rise to seed with low glucosinolate levels showed that the skilled person trying to repeat the experiments was confronted with undue burden, in particular as these three lines were not shown to be homozygous for the restorer gene.

### Reasons for the Decision

1. The disclosure of an invention for which protection is sought is one of the fundamental requirements for the grant of a patent. In the European Patent Convention the disclosure requirement is formulated in Article 83 EPC, which states that a European patent application must disclose the invention in a manner sufficiently clear and complete to be carried out by a person skilled in the art.
2. In the assessment as to whether a European application fulfils the requirement of Article 83 EPC, it is an established principle of law of the Boards of Appeal that, for the disclosure of an invention to be sufficiently clear and complete, the skilled person, on the basis of the information provided in the application itself and by using the general knowledge, has to be able to achieve the desired result without undue burden and without exercising any inventive skill (cf decisions T 694/92 OJ EPO 1997, 408 and T 612/92 of 28 February 1996).
3. According to established case law of the Boards of Appeal, the criteria for examining the reproducibility of a technical teaching are the same in cases where the

disclosure of a prior art document has to be judged (cf T 206/83 OJ EPO 1987, 5 and T 158/91 of 30 July 1991). Consequently, a prior art document whose teaching is not enabling, is not considered for the assessment of novelty of a European patent application.

4. The examination as to the sufficiency of a disclosure in a patent application, as well as in a prior art document, has to be conducted in each case on its own merits, and it depends on the correlation of the facts of the case to certain general parameters, eg the amount of reliable technical details disclosed, the time when the disclosure was presented to the public and the corresponding common general knowledge, as well as the character of the technical field and the average amount of effort necessary to put into practice a certain written disclosure in that technical field (cf decisions T 158/91 supra, and T 639/95 of 21 January 1998).
5. Document (1) and the present patent application both are concerned with plant breeding, based on the natural phenomenon of crossing and selection, for the production of a Brassica line comprising a homozygous fertility restorer gene for ogura cytoplasmatic male sterility and a low glucosinolate content (document (1), page 2, lines 8 to 17 and 28 to 30; page 3, lines 4 to 9 and 24 to 30; page 4, lines 7 to 10 and 19 to 26; claims 1, 2 and 4).
6. Prior art "restorer material", containing a fertility restorer gene for ogura cytoplasmatic male sterile plants, that has been transferred from Raphanus sativus to Brassica, suffers from the drawback that it produces

oilseed having elevated glucosinolate levels (see application page 3, last paragraph and document (1), page 6, first paragraph).

This disadvantage results from a linkage between the restorer gene introduced from Raphanus sativus and high glucosinolate genes from the same source (see application page 4, lines 3 to 8).

7. Document (1) claims to have broken this strong linkage through an intensive crossing program (page 24, lines 28 to 32). It is stated that the break in the linkage between the restorer gene and the adjacent high glucosinolate genes occurred as the result of a specific meiotic event which was "captured" in one cross (page 10, lines 4 to 8 and Figure 1).
8. The intensive crossing program is disclosed in document (1) as follows:

The three lines (out of 700 backcrosses) that were found to give rise to seed with low glucosinolate levels "were BC2 progeny of the proprietary Zeneca Seed line BN0559 originally crossed to a restorer gene source KH in November 1993. The restorer gene source KH for the line was a BC1 plant of the original restorer source from INRA (RF) crossed twice to a Zeneca inbred 4372 (RF<2<4372)"; (page 7, lines 14 to 22).

Page 14, lines 34 to page 15, line 2, refers to doubled haploid restorer lines with low glucosinolate content being designated 94-0186 and 94-0187, which were obtained by crossing "a source of the improved restorer gene ... to improved germplasm".

Moreover, "material containing the improved restorer gene was crossed to selected Zeneca Seed's inbred lines", (page 15, lines 6 to 7). Twenty F3 rows of the original BN06111 (a BC2 line) were chosen for being homozygous for the restorer gene (page 16, lines 7 to 8).

Thus, the disclosure in document (1) refers to a crossing program using proprietary seed lines.

9. The separation of two closely linked genes by meiotic crossing over events using a plant breeding program based on crossing and selection, and the segregation of the traits in question into the progeny, is a fortuitous event.

The chances of a skilled person to successfully repeat the crossing program of document (1) and to obtain an improved Brassica plant having the characterizing features of claim 4 are further reduced by the fact that proprietary seed lines are used.

10. Relying on fortuitous events or chance for reproducibility amounts to undue burden in the absence of evidence that such chance events occur and can be identified frequently enough to guarantee success (cf decision T 727/95 OJ EPO 2001, 1).

Therefore, the disclosure in document (1) is not considered to be enabling. Thus, its content cannot be considered for judging the novelty of the subject-matter of the claims of the present patent application.



11. According to Article 111(1) EPC the Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to the department for further prosecution.

Remittal to the department of first instance is at the discretion of the board (cf decision T 1091/00, 2 July 2002).

Although Article 111(1) EPC does not guarantee an absolute right to have all the issues in the case considered by two instances, it is well recognised that any party should preferably be given the opportunity to have two readings of the important elements of the case. The essential function of appeal proceedings is to consider whether the decision which has been issued by the first instance department is correct. Hence, a case is normally remitted, if essential questions regarding the patentability of the claimed subject-matter have not yet been examined and decided by the department of first instance.

In particular, remittal is taken into consideration by the boards in cases where a first instance department issues a decision solely upon one particular issue which is decisive for the case against a party and leaves other essential issues outstanding. If, following appeal proceedings, the appeal on the particular issue is allowed, the case is normally remitted to the first instance department for consideration of the undecided issues.

12. The Examining Division in the decision under appeal has only dealt with the question of novelty in relation to document (1), without comprehensively touching any other substantial requirements of the EPC.

Thus, fundamental requirements for the grant of a patent, like sufficiency of disclosure according to the principles of law as discussed in points (1), (2) and (4) above, have not yet been examined by the first instance. Consequently, the examination was not carried out in a way to put the Board in a position to decide now, on the basis of a comprehensive examination of the first instance, whether or not the substantial requirements of the EPC are met by the present patent application, which, considering the economical aspect of the procedure, would be the most preferable situation.

Therefore, although being aware that this could lead to a considerable delay of the procedure, the Board considers it to be justified and appropriate to allow the present set of claims to be examined by two instances, and decides therefore, at its discretion under Article 111(1) EPC, to remit the case to the first instance for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of the new main request filed at the oral proceedings (claims 1 to 13).

The Registrar:

The Chairwoman:

P. Cremona



U. Kinkeldey

