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**D E C I S I O N**  
**of 27 July 2006**

**Case Number:** T 0243/03 - 3.3.04

**Application Number:** 91907897.2

**Publication Number:** 0474857

**IPC:** C07K 14/37

**Language of the proceedings:** EN

**Title of invention:**

Method for the protection of plants against pathogens

**Patentee:**

MOGEN INTERNATIONAL N.V.

**Opponent:**

KWS Saat AG

**Headword:**

Plant pathogens/MOGEN

**Relevant legal provisions:**

EPC Art. 123(2)

EPC R. 67

**Keyword:**

"Added subject-matter (yes)"

"Reimbursement of the appeal fee (no)"

**Decisions cited:**

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**Catchword:**

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Case Number: T 0243/03 - 3.3.04

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.04  
of 27 July 2006

**Appellant:**  
(Opponent 01)

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**Decision under appeal:**

Decision of the Opposition Division of the  
European Patent Office posted 5 December 2002  
rejecting the opposition filed against European  
patent No. 0474857 pursuant to Article 102(2)  
EPC.

**Composition of the Board:**

**Chairman:** U. Kinkeldey  
**Members:** M. Wieser  
D. Rogers

## Summary of Facts and Submissions

- I. The appeal was lodged by Opponent 01 (Appellant) against the decision of the Opposition Division to reject the opposition against European patent No. 0 474 857 under Article 102(2) EPC.
- II. The patent had been opposed by two parties (Opponents 01 and 02) under Article 100(a) EPC on the grounds of lack of inventive step (Article 56 EPC), under Article 100(b) EPC on the ground of lack of sufficient disclosure (Article 83 EPC) and under Article 100(c) on the ground of added subject-matter (Article 123(2) EPC).
- III. Claim 1 as granted read:
- "Method for the induction of pathogen resistance in plants characterized by transforming a plant with polynucleotide sequences encoding a pair of pathogen-derived-avirulence-gene/plant-derived-resistance-genes wherein the expression of both the elicitor peptide and the resistance gene or one of both is regulated by a pathogen inducible promoter."
- IV. Opponent 02 withdrew its opposition with a letter dated 13 March 2003.

The Board expressed its preliminary opinion in a communication dated 27 January 2006.

Oral proceedings were held on 27 July 2006 in the absence of the Patent Proprietor (Respondent) who had

informed the Board with a letter dated 7 June 2006 that he would not attend.

- V. The Appellant requested that the decision under appeal be set aside and that the patent be revoked. Moreover he requested that the appeal fee be reimbursed.

The Respondent requested in writing on 3 November 2003 that the appeal be dismissed.

- VI. The submissions made by the Appellant, as far as they are relevant to the present decision, may be summarised as follows:

Claim 1 as granted referred to a method for the induction of pathogen resistance in plants using a "pathogen inducible promoter". The application as originally filed did not contain a basis for a promoter being defined in such broad way. Thus, the patent has been amended in such a way that it contained subject-matter which extended beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC.

The decision under appeal, when deciding that the requirements of Article 83 EPC were met by the patent in suit, did not contain reasoning as to why Appellant's arguments, which were not even referred to in the decision, were not followed. This lack of reasoning in the decision was a substantial procedural violation that justified the reimbursement of the appeal fee.

VII. The submissions made by the Respondent, as far as they are relevant to the present decision, may be summarised as follows:

In accordance with Article 69 EPC the claims had to be read in the light of the description. The essential technical features of a promoter useful for the claimed method were repeatedly expressed throughout the description as originally filed, which on page 3, lines 17 to 24, contained a list of features (a) to (c) which a pathogen inducible promoter according to the claimed invention was required to have. Therefore, a claim referring to a promoter, which claim did not explicitly contain said essential technical features, had to be interpreted as referring to a promoter having the features set out in the description as originally filed.

### **Reasons for the decision**

1. By withdrawing its opposition with a letter dated 13 March 2003, Opponent 02 has ceased to be a party to the procedure in respect of substantive issues.

#### *Amendments - Article 123(2) EPC*

2. According to Article 123(2) EPC a European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.

The method according to claim 1 as granted uses a promoter for the regulation of the expression of one or

both of a pair of specified genes (pathogen-derived-avirulence-gene/plant-derived-resistance-gene). The promoter is defined in the claim as being "pathogen inducible".

3. The following passages in the application as originally filed are concerned with, and describe, this promoter:

Page 2, lines 19 to 23:

"... and providing means for regulating the expression of said genes in such a manner that simultaneous expression occurs only at the site of infection and induction of said simultaneous expression can be achieved by a broad range of pathogens."

Page 2, lines 28 to 32:

"In this case the avirulence gene (E) must be regulated by a promoter that is induced by a pathogen and only permits expression at the site of infection, in order to avoid the induction of the hypersensitive response in the whole plant."

Page 2, line 35 to page 3, line 2:

"The hypersensitive response must not or hardly be inducible by other exterior stimuli and should be restricted to an area surrounding the site of infection. Without these restrictions the activation would result in the virtual destruction of the plant."

Page 3, lines 7 to 12:

"... it is possible to introduce a polynucleotide sequence comprising at least a sequence of a resistance gene (R) or a portion thereof, and a plant promoter (P) that can be induced by a broad range of pathogens and

in such a manner that the product of resistance gene (R) is only expressed at the site of the infection."

Page 3, lines 14 to 16:

"It is also possible for gene (E) and gene (R) to be regulated by identical promoters provided they are strictly inducible at the site of the infection and only by a pathogen".

Page 3, lines 17 to 24:

"In the above mentioned embodiments the pathogen-inducible promoter to be employed is required to:

- a) be induced by all or most of the plant's pathogens or aspecific elicitors produced by said pathogens;
- b) be virtually only inducible by pathogens and not or hardly inducible by other exterior stimuli;
- c) be only able to express the genes that are controlled by the promoter very locally and never systemically."

Page 3, lines 25 to 33:

"In another embodiment of the invention gene (E) or (R) can be tissue specific and the other gene must be pathogen inducible at the site of the infection only in tissue for which the first gene is tissue specific. In this instance it is for example possible to introduce a gene (R) that is expressed only in the roots of the plant and a gene (E) that is induced locally by a pathogen in the roots yet constitutively in other tissues, whereby protection against pathogens is obtained for the roots."

Page 4, lines 16 to 20:

"In the whole plant kingdom pathogen inducible plant promoters are known that are induced by a broad range of pathogens and by aspecific elicitors produced by these pathogens. Such plant promoters are also known that are only expressed very locally and never systemically."

Claim 1:

" A method for the protection of plants against pathogens, wherein a polynucleotide sequence comprising at least a sequence of a pathogen avirulence gene (E) encoding a specific elicitor protein molecule (e) or a portion thereof is introduced into the genome of a plant containing a corresponding resistance gene (R), in which genes (E) and (R) are regulated in such a manner that expression of said genes is only simultaneous at the site of infection and said simultaneous expression can be induced by a broad range of pathogens."

4. Thus in all these passages the promoter is defined as being only able to express the controlled genes either "at the site of infection" (as in claim 1 as originally filed), or at least "very locally and never systemically" (page 3, lines 23 to 24), or at the site of infection only in tissue for which one of the two controlled genes is tissue specific (page 3, lines 25 to 32).

Contrary to this, claim 1 as granted refers to a promoter, defined only by the feature of being "pathogen inducible". The claim embraces pathogen inducible promoters whose regulatory power on the expression of genes under their control is not



restricted to a specific site, area or tissue of a plant.

The application as originally filed does not contain a basis for this generalization. Accordingly, the claim refers to subject-matter extending beyond the application as filed.

5. The Respondent argues that, according to Article 69 EPC, the claims have to be read in the light of the description. Thus, the reference to a promoter in claim 1 has to be interpreted as meaning a promoter having all the technical features attributed to promoters in the description as originally filed, even though these technical features are not explicitly set out in the claim.

The Opposition Division followed this line of argumentation (see point (2.2) of the decision under appeal).

6. In the present case, as outlined in point (4) above, claim 1 as granted has been amended when compared with the application as filed by the deletion of the feature "at the site of infection" in respect of the regulation of the expression of the genes controlled by the used promoter. This deletion has the consequence that the claim now reads also onto promoters devoid of this technical feature which, in the application as originally filed, is said to be essential in order to carry out the method of claim 1.
7. Article 69(1) EPC refers to the **extent of protection** of a European patent or a European patent application

which shall be determined by the terms of the claims, whereby the description and the figures shall be used to interpret the claims.

Article 123(2) EPC refers to the **content** of a European patent or a European patent application which shall not be extended beyond the content of the application as filed.

In contrast to this, Article 123(3) EPC prohibits amendments to granted claims during opposition procedure in such a way as to **extend the protection** conferred by a European patent.

Therefore, an amendment which violates the requirements of Article 123(2) EPC in that it contains subject-matter extending beyond the content of the application as filed cannot be justified by a reference to Article 69 EPC.

8. Claim 1 as granted, by referring to the use of promoters not originally disclosed, extends beyond the content of the application as originally filed.

Therefore, the Board decides that claim 1 as granted does not meet the requirements of Article 123(2) EPC.

*Reimbursement of the appeal fee - Rule 67 EPC*

9. The relevant passage of the decision under appeal, which according to the Appellant does not meet the requirement of Rule 68(2) EPC, saying that decisions of the European Patent Office shall be reasoned, reads as follows:

"The answer to the question whether the invention is sufficiently disclosed is difficult and rather borderline. In opposition proceedings, however, the burden of proof that the invention would not work is on the opponents. The opposition division does not find enough evidence to decide against the patentee. Furthermore, the opposition division is of the opinion that the invention is a conceptual invention for which the scope of the claims is justified."

10. The Board notes that the decision under appeal in this point is tersely formulated, but it does not agree that it gives no reasoning at all, or that it indicates that the Opposition Division totally failed to take into account the Appellant's arguments.
  
11. Accordingly, the Board does not find a failure to comply with Rule 68(2) EPC, and hence does not find a substantial procedural violation that would justify reimbursement of the appeal fee according to Rule 67 EPC.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside and the patent is revoked.
2. The request for reimbursement of the appeal fee is rejected.

Registrar:

Chair:

C. Moser

U. Kinkeldey