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**Datasheet for the interlocutory decision
of 8 July 2013**

Case Number: T 0083/05 - 3.3.04

Application Number: 99915886.8

Publication Number: 1069819

IPC: A01H 5/10

Language of the proceedings: EN

Title of invention:

Method for selective increase of the anticarcinogenic glucosinolates in Brassica species

Patent Proprietor:

Plant Bioscience Limited

Opponents:

Syngenta Participations AG
Groupe Limagrain Holding

Headword:

Broccoli II/PLANT BIOSCIENCE

Relevant legal provisions:

EPC Art. 53(b), 100, 112(1)(3)
RPBA Art. 8(2), 13(1)

Keyword:

"Exclusion of essentially biological processes for the production of plants - possible effect on allowability of product claim for plants or plant material - important point of law - referral of questions to the Enlarged Board of Appeal"

Decisions cited:

G 0002/88, G 0009/91, G 0001/93, G 0001/95, G 0001/98,
G 0001/03, G 0002/06, G 0002/07, G 0001/08, T 0219/83,
T 1242/06

Catchword:

Questions 1 to 4 as formulated in the Order are referred to the Enlarged Board of Appeal for decision.



Case Number: T 0083/05 - 3.3.04

INTERLOCUTORY DECISION
of the Technical Board of Appeal 3.3.04
of 8 July 2013

Appellant: Syngenta Participations AG
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Appellant: Groupe Limagrain Holding
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted
23 November 2004 concerning maintenance of
European patent No. 1069819 in amended form.**

Composition of the Board:

Chairwoman: G. Alt
Members: R. Moufang
B. Claes

Summary of Facts and Submissions

- I. The present appeal concerns European patent No. 1 069 819 with the title "Method for selective increase of the anticarcinogenic glucosinolates in Brassica species". The patent was granted on application No. 99915886.8 (published as WO-A-99/52345). It contained process claims directed to methods for the production of *Brassica oleracea* with elevated levels of certain glucosinolates as well as product claims directed to certain *Brassica* and broccoli plants and to parts of such plants (edible portion, seed, inflorescence, plant cell).
- II. The patent was opposed by two opponents. The oppositions were based on several grounds, *inter alia* exclusion from patentability of the subject-matter of method claims of the patent in view of Article 53(b) EPC. During the proceedings before the opposition division, none of the opponents challenged the product claims of the patent on the basis of Article 53(b) EPC. The opposition division decided that the European patent could be maintained in amended form based on claims 1 to 11 of the patent proprietor's then main request, including both method and product claims.
- III. The decision was appealed by opponent 01 (appellant I) and opponent 02 (appellant II). The appellants were of the opinion that the patent as amended and the invention to which it related did not meet the requirements of the EPC. They relied on the opposition grounds of lack of enabling disclosure, lack of novelty, lack of inventive step, and added subject-matter. Appellant II also argued that the subject-matter of the

method claims of the proprietor's (respondent's) main request before the opposition division was excluded from patentability under Article 53(b) EPC.

IV. During the first oral proceedings before this board (in a different composition), the respondent submitted a new main request and an auxiliary request, each consisting of 9 claims. The independent claims of said main request read as follows:

"1. A method for the production of *Brassica oleracea* with elevated levels of 4-methylsulfinylbutyl glucosinolates, or 3-methylsulfinylpropyl glucosinolates, or both, which comprises:

- a) crossing wild *Brassica oleracea* species selected from the group consisting of *Brassica villosa* and *Brassica drepanensis* with broccoli double haploid breeding lines;
- b) selecting hybrids with levels of 4-methylsulfinylbutyl glucosinolates, or 3-methylsulfinylpropyl glucosinolates, or both, elevated above that initially found in broccoli double haploid breeding lines;
- c) backcrossing and selecting plants with the genetic combination encoding the expression of elevated levels of 4-methylsulfinylbutyl glucosinolates, or 3-methylsulfinylpropyl glucosinolates, or both; and
- d) selecting a broccoli line with elevated levels of 4-methylsulfinylbutyl glucosinolates, or 3-methylsulfinylpropyl glucosinolates [sic], or both, capable of causing a strong induction of phase II enzymes,

wherein molecular markers are used in steps (b) and (c) to select hybrids with genetic combination encoding expression of elevated levels of 4-methylsulfinylbutyl glucosinolates, or 3-methylsulfinylpropyl glucosinolates, or both, capable of causing a strong induction of phase II enzymes.

5. An edible *Brassica* plant produced according to the method of any one of claims 1 to 4.

6. An edible portion of a broccoli plant produced according to the method of any one of claims 1 to 4.

7. Seed of a broccoli plant produced according to the method of any one of claims 1 to 4.

8. A broccoli plant having elevated levels of 3-methylsulfinylpropyl glucosinolates, or 4-methylsulfinylbutyl glucosinolates, or both, wherein the broccoli plant is a hybrid plant following crossing of broccoli double haploid breeding lines with wild *Brassica oleracea* species selected from the group consisting of *Brassica villosa* and *Brassica drepanensis* and the levels of 3-methylsulfinylpropyl glucosinolates, or 4-methylsulfinylbutyl glucosinolates, or both, are between 10 and 100 μ moles per gram of dry weight of said plant.

9. A broccoli inflorescence having elevated levels of 3-methylsulfinylpropyl glucosinolates, or 4-methylsulfinylbutyl glucosinolates, or both, wherein the broccoli inflorescence is obtained from a hybrid plant following crossing of broccoli double haploid breeding lines with wild *Brassica oleracea* species

selected from the group consisting of *Brassica villosa* and *Brassica drepanensis* and the levels of 3-methylsulfinylpropyl glucosinolates, or 4-methylsulfinylbutyl glucosinolates, or both, are between 10 and 100 μ moles per gram of dry weight of the inflorescence."

- V. In its interlocutory decision dated 22 May 2007 the board referred two questions of law to the Enlarged Board of Appeal. Both questions related to the interpretation of the process exclusion contained in Article 53(b) EPC, namely to the circumstances under which processes for the production of plants have to be regarded as "essentially biological". The interlocutory decision furthermore dealt with all other objections raised by the appellants up to then in the course of the appeal proceedings. The board concluded that none of these other objections precluded maintenance of the patent as amended on the basis of the respondent's main request (see point 4 of the reasons: no added subject-matter; point 7: sufficiency of disclosure, point 18: novelty; points 28 and 35: inventive step).
- VI. The Enlarged Board of Appeal answered the referred questions in its decision G 2/07 of 9 December 2010. On 24 March 2011 the board summoned the parties to oral proceedings to be held on 26 October 2011.
- VII. In a letter dated 29 April 2011 the respondent submitted a new main and a new auxiliary request replacing all previous requests. These new requests did not contain method claims. The main request comprised five independent claims 1 to 5. Claim 1 read as follows:

"1. An edible *Brassica* plant produced according to a method for the production of *Brassica oleracea* with elevated levels of 4-methylsulfinylbutyl glucosinolates, or 3-methylsulfinylpropyl glucosinolates, or both, which comprises:

- a) crossing wild *Brassica oleracea* species selected from the group consisting of *Brassica villosa* and *Brassica drepanensis* with broccoli double haploid breeding lines;
- b) selecting hybrids with levels of 4-methylsulfinylbutyl glucosinolates, or 3-methylsulfinylpropyl glucosinolates, or both, elevated above that initially found in broccoli double haploid breeding lines;
- c) backcrossing and selecting plants with the genetic combination encoding the expression of elevated levels of 4-methylsulfinylbutyl glucosinolates, or 3-methylsulfinylpropyl glucosinolates, or both; and
- d) selecting a broccoli line with elevated levels of 4-methylsulfinylbutyl glucosinolates, or 3-methylsulfinylpropyl glucosinolates [sic], or both, capable of causing a strong induction of phase II enzymes,

wherein molecular markers are used in steps (b) and (c) to select hybrids with genetic combination encoding expression of elevated levels of 4-methylsulfinylbutyl glucosinolates, or 3-methylsulfinylpropyl glucosinolates, or both, capable of causing a strong induction of phase II enzymes."

Claim 2 and 3 of the new main request were directed to an edible portion and to the seed of a broccoli plant produced by a method defined in the same manner as in

claim 1. Claims 4 and 5 were identical to claims 8 and 9 of the respondent's then main request, with which the board dealt in its interlocutory decision dated 22 May 2007 (see Section IV above).

VIII. The respondent requested oral proceedings only if the board did not intend to maintain the patent on the basis of the new main request. With letters dated 27 September 2011 and 11 October 2011, appellant II and appellant I, respectively, requested oral proceedings only if the board intended to maintain the patent on the basis of any claim request other than the respondent's then pending requests. The board cancelled the oral proceedings scheduled on 26 October 2011 and indicated its intention to issue a decision in writing.

IX. On 8 November 2011 second oral proceedings took place in appeal case T 1242/06 (Tomatoes/STATE OF ISRAEL). In that case the board had previously also referred questions of law concerning the interpretation of the process exclusion contained in Article 53(b) EPC. This referral had led to the Enlarged Board's decision G 1/08 (OJ EPO 2012, 206), the facts and reasons of which were identical to those of decision G 2/07 referred to above (see Section VI). While, similarly to the present case, the patent proprietor in case T 1242/06 also took the Enlarged Board's decision into account by deleting all process claims, the opponent nevertheless maintained that the proprietor's requests, which now only contained product claims, still did not comply with the requirements of Article 53(b) EPC. At the end of the second oral proceedings in case T 1242/06 the board announced its intention to refer again questions of law to the Enlarged Board of Appeal.

- X. Third-party observations were received in the present case on 1 November 2011.
- XI. With a letter dated 22 November 2011, appellant I requested the board to stay the proceedings until the board dealing with the appeal in case T 1242/06 had formulated questions to be referred to the Enlarged Board and the Enlarged Board had decided whether to "accept" them. Oral proceedings were requested if the board intended to reject the request for stay.
- XII. With a letter dated 22 December 2011, the respondent argued that the new submission of appellant I seemed to introduce a fresh ground of opposition into the appeal proceedings, *i.e.* an objection under Article 53(b) EPC against product claims. If the Enlarged Board should find that the second referral in case T 1242/06 were not admissible, the respondent would oppose the admission of this new ground into the proceedings. Otherwise, however, it would agree to it. The respondent furthermore suggested that the board issue its next communication only once the decision of the Enlarged Board on the admissibility of the second referral in case T 1242/06 was available. It requested oral proceedings if the board intended to issue a decision at odds with the requests in its submission.
- XIII. On 31 May 2012 in case T 1242/06 the board handed down a second interlocutory decision in which it referred the following questions of law to the Enlarged Board of Appeal:

- "1. Can the exclusion of essentially biological processes for the production of plants in Article 53(b) EPC have a negative effect on the allowability of a product claim directed to plants or plant material such as a fruit?
2. In particular, is a claim directed to plants or plant material other than a plant variety allowable even if the only method available at the filing date for generating the claimed subject-matter is an essentially biological process for the production of plants disclosed in the patent application?
3. Is it of relevance in the context of questions 1 and 2 that the protection conferred by the product claim encompasses the generation of the claimed product by means of an essentially biological process for the production of plants excluded as such under Article 53(b) EPC?"

The referral is pending as case G 2/12 before the Enlarged Board (see OJ EPO 2012, 468).

- XIV. With a communication dated 15 June 2012 the board invited the parties to clarify their requests. After receiving substantive submissions within the set time limit from appellant I only, the board summoned for oral proceedings. All the parties then made further submissions. Third-party observations were also received.
- XV. With its letter dated 31 January 2013 the respondent gave its unconditional consent to the examination of

the objection raised under Article 53(b) EPC against the product claims of its requests. It requested that this objection be admitted into the proceedings and that the board refer anew questions of law to the Enlarged Board of Appeal. Three of them should be the same as those referred in interlocutory decision T 1242/06 of 31 May 2012. In addition, one or both of the following questions should also be referred:

- "4. If a claim directed to plants or plant material other than a plant variety is considered not allowable because the plant product claim encompasses the generation of the claimed product by means of a process excluded from patentability under Article 53(b) EPC, is it possible to disclaim the excluded process?
 5. If the exception for essentially biological processes impacts the patentability of products obtained therefrom, is the impact limited to product-by-process claims which incorporate the essentially biological process or does it also apply to product claims which characterize the product by structural features?"
- XVI. Oral proceedings took place on 1 March 2013 in the presence of all parties. Appellant I filed a set of questions to be referred to the Enlarged Board, of which questions 2, 3 and 5 read as follows:
- "2. If the exception for essentially biological processes impacts the patentability of products obtained therefrom, is the impact limited to product-by-process-claims which incorporate the

essentially biological process or does it apply to product claims which characterize the product by structural features? Does it matter if the later [sic] claims in addition to structural features comprises [sic] process steps such as sexual crossing. [sic]

3. If the exception from patentability extends [sic] to product claims in general, does it matter if the product could have been obtained by a technical (non-essentially biological) process not except [sic] from patentability? Does such process have to be explicitly described and/or exemplified in the patent application or is a description is [sic] the prior art sufficient?

5. Does it make a difference for the exception from patentability as an essentially biological process whether a process which comprises steps or crossing and selection is as a whole of technical nature? If NO: What is the impact and meaning of R.27(c) on Art.53b [sic] (if any)?"

Appellant II submitted the following question to be considered for referral to the Enlarged Board:

"If question n° 1 (as referred in T 1242/06) is answered in the positive, what remains patentable under the EPC in terms of plants?"

The respondent submitted new auxiliary requests 1 and 2. New auxiliary request 1 was identical to the main request filed with the letter dated 29 April 2011, except that at the end of each claim a "wherein" clause

was introduced starting with "wherein the claim does not encompass an essentially biological process for producing" and continuing in claims 1 and 4 with "the plant", in claim 2 with "the portion of a plant", in claim 3 with "the seed of the plant" and in claim 5 with "the inflorescence".

New auxiliary request 2 was identical to the auxiliary request filed with the letter dated 29 April 2011 and differed from the main request only by deletion of claims 1 to 3 and the renumbering of the remaining claims 4 and 5.

XVII. Appellant I (opponent 01) requested that the decision under appeal be set aside and that European patent No. 1 069 819 be maintained in amended form on the basis of new auxiliary request 2 submitted by the respondent in the oral proceedings. It furthermore requested that the following questions of law be referred to the Enlarged Board of Appeal:

- (a) Questions 1 to 3 as already referred to the Enlarged Board in decision T 1242/06 of 31 May 2012;
- (b) Questions 4 and 5 filed by the respondent with its letter dated 31 January 2013;
- (c) Questions 2, 3 and 5 of the set of questions submitted by appellant I during the oral proceedings.

XVIII. Appellant II (opponent 02) requested that decision under appeal be set aside and that the European patent No. 1 069 819 be revoked. It furthermore requested that the following questions of law be referred to the Enlarged Board of Appeal:

- (a) Questions 1 to 3 as already referred to the Enlarged Board in decision T 1242/06 of 31 May 2012;
- (b) Questions 4 and 5 filed by the respondent with its letter dated 31 January 2013;
- (c) The question submitted by appellant II during the oral proceedings.

XIX. The respondent requested that the decision under appeal be set aside and the patent maintained in amended form on the basis of claims 1 to 5 of the main request filed with letter dated 8 April 2011 or, in the alternative, claims 1 to 5 of new auxiliary request 1 submitted at the oral proceedings of 1 March 2013 or claims 1 and 2 of new auxiliary request 2 submitted at the oral proceedings of 1 March 2013. It furthermore requested that the following questions of law be referred to the Enlarged Board of Appeal:

- (a) Questions 1 to 3 as already referred to the Enlarged Board in decision T 1242/06 of 31 May 2012;
 - (b) Questions 4 and 5 filed by the respondent with its letter dated 31 January 2013,
- or, in the alternative, the questions under (a) above only.

XX. At the end of the oral proceedings the chairwoman announced the board's intention to refer to the Enlarged Board at least the three questions already referred in decision T 1242/06. She then declared the debate closed.

XXI. The arguments put forward by appellants I and/or II during these appeal proceedings and relevant for the present decision can be summarised as follows:

- The objection under Article 53(b) EPC against the product claims was not a new ground of opposition the examination of which would require the consent of the patentee.
- The pending questions in case G 2/12 concerned legal issues of high relevance for the present case. They should be reiterated in a second referral. Further questions should be added in order to allow the Enlarged Board to address all the problems in a holistic and comprehensive manner.
- In particular it should be clarified whether the term "available" in the referred question No. 2 meant a theoretical possibility, a concrete disclosure or even an exemplification in the patent.

XXII. The arguments put forward by the respondent during these appeal proceedings and relevant for the present decision can be summarised as follows.

- Although the objection raised by appellant I against the product claims represented a fresh ground of opposition, it should be admitted into the proceedings.
- Since the plants of the present invention could at least also be produced by a method comprising

essentially biological steps, the reasoning which had been developed by the board in the second interlocutory decision in case T 1242/06, and with which the respondent did not agree, could also apply to the present case.

- Any opinion issued by the Enlarged Board in referral G 2/12 would be highly relevant also for the validity of the opposed patent. The respondent should be given an opportunity to address the Enlarged Board on this subject. For this purpose the board should reiterate the questions pending in referral G 2/12 in the context of a second referral in the present case.

- The case pending as G 2/12 and the rulings of the Enlarged Board in decisions G 2/07 and G 1/08 had created significant uncertainty about basic questions of patentability. In order to resolve these questions, additional questions should be referred to the Enlarged Board.

Reasons for the Decision

Admissibility of the respondent's requests

1. The respondent's main request (see Section VII above) was submitted with the letter dated 29 April 2011 after the Enlarged Board had answered the questions referred to it by this board concerning the meaning and scope of the process exclusion in Article 53(b) EPC. The amendments made essentially consist in the deletion of all method claims contained in the previous main

request. The submission of the main request can therefore be regarded as an appropriate reaction to the Enlarged Board's decision. The same holds true for the respondent's auxiliary request II which was submitted with the same letter (as "auxiliary request") and in which three further independent claims were deleted (see Sections VII and XVI above).

2. Current auxiliary request I was filed only at the second oral proceedings (see Section XVI above). Compared to the main request, it contains a disclaimer aiming at avoiding a possible application of the patentability exclusion of Article 53(b) EPC with respect to the product claims. This can be considered an attempt to react to an objection raised only at a very late stage by appellant I (see point 7 below) and to the discussion of that objection during the oral proceedings.
3. The appellants did not object to the admissibility of any of the respondent's substantive requests. Exercising its discretion under Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA), the board therefore admits all these requests into the proceedings.

Main request

Grounds of opposition other than Article 100(a) in conjunction with Article 53(b) EPC

4. In its interlocutory decision dated 22 May 2007 referring questions of law relating to the interpretation of Article 53(b) EPC to the Enlarged

Board (OJ EPO 2007, 644), the present board already considered all other grounds of opposition raised by the appellants against the allowability of the respondent's then main request, *i.e.* Article 100(a) in conjunction with Articles 54 and 56, and Article 100(b) and (c) EPC (see Section V above). It came to the conclusion that none of them prejudiced the maintenance of the patent in suit in amended form on the basis of that request.

5. The respondent's current main request (see Section VII above) differs from its previous main request (see Section IV above) only in that
 - all the method claims 1 to 4 have been deleted,
 - the previous product claims 5 to 9 have been renumbered as claims 1 to 5, and
 - the back-reference in previous independent product claims 5 to 7 to the method as defined in previous claims 1 to 4 has been replaced in new claims 1 to 3 by the explicit definition of the method of previous claim 1.

6. The above amendments limit the protection sought but do not change the factual and legal framework within which this board in the interlocutory decision dated 22 May 2007 (*supra*) reached its conclusions (favourable to the respondent) on all opposition grounds other than Article 100(a) in conjunction with Article 53(b) EPC. The *ratio decidendi* of the decision therefore still applies. None of the parties has argued otherwise.

According to Article 8(2) RPBA, each new member of a board of appeal is bound to the same extent as the other members by an interim decision which has already

been taken by the board. It follows that the respondent's main request fulfils the requirements of Articles 54, 56, 83 and 123(2) EPC.

Admissibility of the objection raised under Article 53(b) EPC against the product claims

7. During the proceedings before the opposition division the appellants never argued that the exclusionary provision of Article 53(b) EPC prohibited the allowability of the product claims of the patent as granted or as amended by the respondent. This objection was raised only at a very late stage in the appeal proceedings, by appellant I in a written submission, after the board had already cancelled the second oral proceedings originally scheduled for 26 October 2011 (see Sections VIII, XI and XII).
8. According to Article 13(1) RPBA any amendment to an appellant's case after it has filed its grounds of appeal may be admitted and considered at the board's discretion. That discretion is exercised in view of *inter alia* the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.
9. In addition, it may be argued that the examination of the objection raised under Article 53(b) EPC against the pending product claims amounts to the introduction of a fresh ground of opposition at the appeal stage. According to the Enlarged Board's case law (see decisions G 9/91, OJ EPO 1993, 408, point 18 of the reasons, and G 1/95, OJ EPO 1996, 615, points 1.2 and 5 to 7 of the reasons), such a ground can be introduced

only if the proprietor agrees to it and if it is *prima facie* highly relevant.

10. On the one hand, it is highly unfortunate that appellant I raised the objection at such a late stage. Admitting and examining it now would have the consequence that the final decision in the present case, which the board intended to give after it cancelled the oral proceedings in October 2011, would be further delayed. The current state of the proceedings and the need for procedural economy therefore speak against admitting it.

11. On the other hand, there are several factors which support a different view. First and most importantly, the respondent has given its unconditional consent to the examination of the objection (see Section XV above). Second, the objection appears to be highly relevant for the maintenance of the patent as amended since, as explained below in more detail (see points 13-20), there are strong arguments that the process exclusion in Article 53(b) EPC might affect the allowability of certain product claims for plants and plant material. Third, the recent developments in case T 1242/06, in particular the second referral of questions of law to the Enlarged Board, were difficult to foresee for the parties and have cast doubts on the allowability of the product claims also in the present case. It appears to be the common understanding of the parties that the opposition appeal proceedings should not be terminated without deciding this legal point of crucial importance for the opposed patent and without giving the parties an opportunity to put forward their arguments in

respect of it in the framework of a further referral to the Enlarged Board.

12. Using its discretion under Article 13(1) RPBA the board has weighed up the above considerations and admits the new objection into the appeal proceedings. In view of the proprietor's consent and the high relevance of the objection, there is no need to decide whether or not the objection constitutes a fresh ground for opposition, since the additional conditions required by the relevant case law of the Enlarged Board (see point 9 above) are met.

Article 53(b) EPC - substantive aspects

13. In the area of plant breeding, Article 53(b) EPC provides for two exceptions from patentability. It prohibits the patenting of, on the one hand, plant varieties and, on the other hand, essentially biological processes for the production of plants.
14. In the second interlocutory decision in case T 1242/06 (OJ EPO 2013, 42) the present board, in a different composition, considered both of these exceptions when assessing the patentability of **product** claims directed to certain tomato fruits. While the board found the exclusion of plant varieties not to be applicable, it considered that the process exclusion in Article 53(b) EPC might well have an impact on the allowability of the claimed products and decided to refer further questions of law concerning this latter issue to the Enlarged Board.

15. In the present case, the subject-matter of claim 1 of the respondent's main request (see Section VII above) is defined as an edible *Brassica* plant produced according to a certain method for the production of *Brassica oleracea* with elevated levels of certain glucosinolates. The method features of this product-by-process claim include steps of crossing and selecting plants. Claims 2 and 3 which are directed to an edible portion and the seed of a broccoli plant contain identical method features. Claims 4 and 5 of the main request (see Sections IV and VII above) define the claimed broccoli plant or inflorescence *inter alia* by the product-by-process feature of crossing broccoli double haploid breeding lines with *Brassica villosa* or *Brassica drepanensis*.
16. For the same reasons as set out in great detail in the second interlocutory decision in case T 1242/06 (*supra*, points 25 to 39 of the reasons), the board considers that the plants or parts of plants claimed in the present case do not fall under the exclusion of plant varieties as stipulated in Article 53(b) EPC and defined by Rule 26(4) EPC. Apart from the fact that these plants and parts of plants are, in view of the process features of the claims (see point 15 above), defined as the result of crossing specific plant species, they are not further defined by a multitude of characteristics resulting from a given genotype or combination of genotypes (see decision G 1/98, OJ EPO 2000, 111, point 3.1 of the reasons), but, directly or indirectly, only by a particular trait, *i.e.* an increased level of specific glucosinolates. A single trait is, however, in general not sufficient to define a plant variety without providing, apart from an

indication of the species, further adequate information about the actual genotype of the plant grouping. The exclusion of plant varieties does therefore not apply in the present case. None of the appellants has argued otherwise.

17. There is nevertheless, similarly to case T 1242/06 (*supra*), a second issue which needs to be addressed, namely the question as to whether the process exclusion contained in Article 53(b) EPC has a negative impact on the allowability of the respondent's product claims. In the board's view, at least the method steps referred to in claims 1 to 3 of the main request for the definition of the claimed plants and plant parts (see point 15 above) have to be regarded as essentially biological processes for the production of plants and would fall, if claimed as such, under the process exclusion of Article 53(b) EPC. These claims therefore cover plants and plants parts which are produced by an excluded process. The board is fully aware that according to the established case law the subject-matter of a product-by-process claim is not limited to products actually produced by the relevant process but also extends to products which are structurally identical to such products and which are produced by a different process (see decisions G 1/98, *supra*, point 4 of the reasons; T 219/83, OJ EPO 1986, 211, point 10 of the reasons). However, neither the patent application as originally filed nor the patent appears to disclose any method for the production of the claimed plants and plants parts which does not include steps of crossing and selection.

18. In view of the principle of absolute product protection (see decision G 2/88, OJ EPO 1990, 93, point 5 of the

reasons), a claim to a product provides the patent proprietor with protection that generally encompasses the protection provided by a patent claim for the process of making the product (see decision G 2/06, OJ EPO 2009, 306, point 25 of the reasons). If the product claims were allowed in the present case, any act of making the claimed *Brassica* and broccoli plants or plant parts would in principle fall under the prerogative of the patent proprietor. This would have the consequence that the proprietor could prevent others from carrying out the breeding method taught in the description of the patent and referred to in the claims, although this method might be regarded as an essentially biological process for the production of plants and excluded *per se* from patentability under Article 53(b) EPC.

19. When confronted with a similar situation in case T 1242/06 (*supra*), this board in a different composition expressed serious concerns about the allowability of product claims directed to plant material obtained by means of an essentially biological breeding process. It considered that such claims might *de facto* frustrate the legislator's intentions in framing the process exclusion and make the circumvention of the exclusion in many cases a matter of skilful claim drafting, thereby diminishing the consistency and persuasiveness of the legislative framework of the EPC as regards patentable subject-matter. In view of these concerns, the board considered it necessary to refer further questions of law to the Enlarged Board.

20. The board in its present composition fully endorses the detailed analysis of the relevant issues in the second referral decision in case T 1242/06 (*supra*). Points 40 to 66 of the reasons of that decision are therefore expressly incorporated into the present decision and form part of it.

The board is aware of the comments made by the President of the EPO and by several *amici curiae* in the pending referral G 2/12. However, since none of the parties in the present proceedings has relied on these comments in detail or requested that they be considered at this stage, *i.e.* in the context of a further referral decision, the board believes it neither necessary nor appropriate to expand on the analysis above.

Referral under Article 112(1) EPC

21. The answer to the above question as to whether the process exclusion contained in Article 53(b) EPC has a negative impact on the allowability of the respondent's product claims is decisive for the present appeal. It would be clearly inappropriate for the board to decide this issue on its own before the Enlarged Board has responded to the referred questions in case G 2/12. The board can therefore either stay the proceedings or refer again questions of law to the Enlarged Board. In view of the following considerations the board opts for the second alternative.
22. All the parties explicitly requested a further referral. Such a referral will provide them with the opportunity to address the Enlarged Board on a very important legal

issue which is decisive for the outcome of the present case. They may thus put forward their own arguments and emphasise supplementary aspects, thereby enriching the basis on which the Enlarged Board will take its decision. Furthermore, in view of the respondent's pending claim requests, the present case contains relevant additional aspects which can be integrated into the referral by formulating supplementary questions of law (see points 24 to 28 below). Finally, recent developments in case T 1242/06 and in the pending referral G 2/12, *i.e.* the withdrawal of its opposition by appellant II and the repeated requests by appellant I/proprietor for termination of the proceedings, raise the possibility that that case may end without a decision on the merits. This strongly speaks against a stay of the proceedings in the present case.

23. All the parties were of the opinion that the same questions as were referred in the second interlocutory decision in case T 1242/06 (*supra*) should be reiterated in the present referral decision. The board agrees in principle. It considers that, for the reasons set out above (points 17 to 20), an answer to these questions is required according to Article 112(1) EPC. A slight modification of question 1 is, however, necessary in order to reflect the fact that in the present case the proprietor's claims are directed to plants and certain plant parts (seed, edible portion, inflorescence) but not to fruits.

24. The parties have furthermore requested the referral of additional questions of law in order to allow the Enlarged Board to address the decisive issue in a

comprehensive manner. In the board's view, the present case does indeed present additional aspects which should be taken into account in formulating the questions to be referred. However, this does not mean that all the additional questions proposed by parties can or need to be referred to the Enlarged Board under Article 112(1) EPC.

25. Two of the questions proposed by the parties, *i.e.* question 5 filed by the respondent with its letter dated 31 January 2013 (see Section XV above) and question 2 of the set of questions submitted by appellant I during the oral proceedings (see Section XVI above), address the issue that all the respondent's claims define the products by process features. This circumstance can be of importance when answering the question whether and to what extent the process exclusion in Article 53(b) EPC has a negative impact on the allowability of product claims. The board therefore considers it appropriate to incorporate the issue into question 2 of the present referral.

26. Question 4 filed by the respondent with its letter dated 31 January 2013 (see Section XV above) raises the further issue of the possibility of a specific kind of disclaimer should the process exclusion affect the allowability of product claims. This issue is of importance in the context of the claims of the respondent's auxiliary request I, which all contain disclaimer clauses such as "wherein the claim does not encompass an essentially biological process for producing [the plant, the portion of a plant, the seed of the plant or the inflorescence]".

27. The board does not understand the disclaimer clauses in the respondent's auxiliary request I as intended to be a usual disclaimer, *i.e.* to exclude part of the subject-matter defined in the claim (see the definition provided in decision G 1/03, OJ EPO 2004, 413, point 2 of the reasons). The wording of the clauses indicates that the respondent does not intend to disclaim all **plants or plant parts** that are produced by an essentially biological process. Rather the respondent appears to seek to waive **a part of the prerogatives of the owner of a product patent** which encompass the right to prohibit others from producing the claimed product in any manner. The possible effect of the respondent's proposed disclaimer is that producing the claimed product by an essentially biological process could no longer be prohibited.
28. It is doubtful whether European patent law allows such a disclaimer or waiver. The board is not aware of case law dealing with this specific issue. When the Enlarged Board considered possible conflicts between the requirements of Article 123(2) and (3) EPC in its decision G 1/93 (OJ EPO 1994, 541), it considered that there was no basis for the so-called "footnote solution" which had been used in German case law and consisted in a statement that an undisclosed feature remaining in the claim represented an inadmissible extension **from which no rights could be derived** (see point 6 of the reasons). The provisions of the EPC did not envisage or allow a statement to be included in the description of a particular patent, qualifying the rights which may be derived from the presence of a particular technical feature in a claim of that patent. These conclusions, albeit made in a context different

from the present one, might be interpreted as pointing to a general unallowability of disclaimers or waivers of rights derived from a European patent. The board nevertheless sees some justification in the respondent's argument that the proposed disclaimer/waiver could solve the conflict between the patentability of plants (other than plant varieties) and the exclusion of essentially biological processes for the production of plants. The board has therefore decided to formulate a corresponding question of law in the present referral.

29. None of the other questions proposed by the parties will be referred to the Enlarged Board. Question 3 suggested by appellant I (see Section XVI above) addresses the issue as to whether, in the context of the possible impact of the process exclusion on product claims, it matters if the product could have been obtained by a process not excluded under Article 53(b) EPC. This question is however merely hypothetical in the present case, since it has never been argued by any of the parties in the aftermath of decision G 2/07 (*supra*) that the claimed plants or plant parts could have been produced otherwise than by an excluded process (see also point 17 above). Question 5 suggested by appellant I (see Section XVI above) focuses on the meaning of the term "essentially biological process" in Article 53(b) EPC. However, this meaning has already been elucidated by the Enlarged Board in its decision G 2/07 which is binding on the board according to Article 112(3) EPC. The question submitted by appellant II (see Section XVI above) is very broadly formulated and therefore encompasses many aspects which are not

relevant for deciding the issues under Article 53(b) EPC which arise in the present case.

For the above reasons the board considers that no answer by the Enlarged Board to these further questions proposed by the parties is required pursuant to Article 112(1) EPC.

Order

For these reasons it is decided that:

The following questions are referred to the Enlarged Board of Appeal for decision:

1. Can the exclusion of essentially biological processes for the production of plants in Article 53(b) EPC have a negative effect on the allowability of a product claim directed to plants or plant material such as plant parts?
2. In particular:
 - (a) Is a product-by-process claim directed to plants or plant material other than a plant variety allowable if its process features define an essentially biological process for the production of plants?
 - (b) Is a claim directed to plants or plant material other than a plant variety allowable even if the only method available at the filing date for generating the claimed subject-matter is an essentially biological process for the production of plants disclosed in the patent application?
3. Is it of relevance in the context of questions 1 and 2 that the protection conferred by the product claim encompasses the generation of the claimed product by means of an essentially biological process for the production of plants excluded as such under Article 53(b) EPC?

4. If a claim directed to plants or plant material other than a plant variety is considered not allowable because the plant product claim encompasses the generation of the claimed product by means of a process excluded from patentability under Article 53(b) EPC, is it possible to waive the protection for such generation by "disclaiming" the excluded process?

The Registrar:

The Chairwoman:

P. Cremona

G. Alt