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**Datasheet for the decision
of 10 September 2015**

Case Number: T 0083/05 - 3.3.04

Application Number: 99915886.8

Publication Number: 1069819

IPC: A01H5/10

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 III/PLANT BIOSCIENCE

Relevant legal provisions:

EPC Art. 53(b)
EPC R. 26(4)

Keyword:

Exceptions to patentability - (no)

Decisions cited:

G 0002/07, G 0002/13

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 0083/05 - 3.3.04

**D E C I S I O N
of Technical Board of Appeal 3.3.04
of 10 September 2015**

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

Composition of the Board:

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

Summary of Facts and Submissions

- I. Both opponent 01 (appellant I) and opponent 02 (appellant II) filed appeals against the interlocutory decision of the opposition division maintaining European patent No. 1 069 819 in amended form.
- II. The appellants submitted that the patent as amended and the invention to which it related did not meet the requirements of the EPC. They relied in particular on the opposition grounds of added subject-matter, lack of enabling disclosure, lack of novelty, lack of inventive step and that the subject-matter of the method claims was not patentable pursuant to Article 53(b) EPC.
- III. During the first oral proceedings before this board (albeit in a different composition), the patent proprietor (respondent) submitted a new main and auxiliary request. Claims 1 to 4 of the main request were directed to a method for the production of *Brassica oleracea* with elevated levels of particular glucosinolates comprising a number of steps of crossing, selecting and backcrossing.

The other claims of the main request were all independent and read as follows:

"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."

IV. In its first interlocutory decision dated 22 May 2007 (published in part in OJ EPO 2007, 644) the board dealt with all but one of the objections raised by the appellants thus far in the appeal proceedings. The board held in particular that none of the objections other than that under Article 53(b) EPC precluded the maintenance of the patent as amended on the basis of the respondent's main request (see points 1 to 4 of the reasons: no added subject-matter in claims 8 and 9; see points 5 to 7: sufficiency of disclosure of the claimed subject-matter; see points 12 to 18: novelty; see

points 19 to 35: inventive step). The board, however, referred two questions of law to the Enlarged Board of Appeal relating to the interpretation of the process exclusion contained in Article 53(b) EPC.

V. The Enlarged Board of Appeal answered the referred questions in its decision G 2/07 of 9 December 2010 (OJ EPO 2012, 130).

VI. With a letter dated 29 April 2011 the respondent submitted a new main (claims 1 to 5) and a new auxiliary request replacing all previous requests.

Claim 1 of the new main request read:

"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-ethylsulfinylbutyl 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."

Claims 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 previous main request (see section III) with which the board had dealt in its interlocutory decision dated 22 May 2007 (see section IV above).

- VII. During the second oral proceedings before this board, held on 1 March 2013, the respondent submitted new auxiliary requests 1 and 2, with auxiliary request 2 being identical to the previous auxiliary request (see section VI above).
- VIII. In its second interlocutory decision dated 8 July 2013 (OJ EPO 2014, A39) the board admitted the main and the two auxiliary requests into the proceedings (see points 1 to 3 of the reasons).

Furthermore, the board held (see points 4 to 6 of the

reasons) that, as compared to the claims of the main request before the board at the time of the first interlocutory decision dated 22 May 2007 (see section III above), the amendments in the claims of the present main request (see section VI above) limited the protection sought but did not change the factual and legal framework within which this board in its first interlocutory decision had 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 this first decision therefore still applied. According to Article 8(2) RPBA, each new member of a board of appeal was bound to the same extent as the other members by an *interim* decision already taken by the board. The board concluded that the respondent's main request fulfilled the requirements of Articles 54, 56, 83 and 123(2) EPC.

Finally, the board also held that the plants and parts of plants claimed did not fall under the exclusion of plant varieties as laid down in Article 53(b) EPC and defined in Rule 26(4) EPC (see point 16 of the reasons). The board held, nevertheless, that a second issue needed to be addressed, namely whether the process exclusion contained in Article 53(b) EPC had a negative impact on the allowability of the product claims of the respondent's requests. It therefore referred the following questions 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?"*

IX. The referred questions were answered by the Enlarged Board of Appeal in its decision G 2/13 of 25 March 2015 (to be published in the OJ of the EPO; see Order) as follows:

"1. The exclusion of essentially biological processes for the production of plants in Article 53(b) EPC does

not have a negative effect on the allowability of a product claim directed to plants or plant material such as plant parts.

2. (a) The fact that the process features of a product-by-process claim directed to plants or plant material other than a plant variety define an essentially biological process for the production of plants does not render the claim unallowable.

(b) The fact that 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 does not render a claim directed to plants or plant material other than a plant variety unallowable.

3. In the circumstances, it is of no relevance 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. Not applicable."

X. The proceedings before this board were resumed with a communication pursuant to Rule 100(2) EPC dated 28 April 2015. In this communication the board noted the requests of the parties on file (see point 2 of the communication). These were as follows:

Appellant I requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the respondent's new auxiliary request 2 filed in the oral proceedings held on 1 March 2013;

Appellant II requested that the decision under appeal be set aside and that the patent be revoked.

The respondent requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of claims 1 to 5 of the main request filed with letter dated 29 April 2011 or, in the alternative, claims 1 to 5 of new auxiliary request 1 or claims 1 and 2 of the new auxiliary request 2, both submitted in the oral proceedings held on 1 March 2013.

The board furthermore expressed its preliminary opinion that, in view of the guidance given by the Enlarged Board of Appeal in its decision G 2/13 (*supra*), Article 53(b) EPC was not a bar to the patentability of subject-matter as claimed in claims 1 to 5 of the main request (see point 3 of the communication). The board therefore envisaged to set aside the decision and to remit the case to the department of first instance with the order to maintain the patent on the basis of claims 1 to 5 of the main request filed with letter dated 29 April 2011, a description yet to be adapted thereto and the Figures 1 to 5 as granted (see point 4 of the communication). The parties were invited to comment on the preliminary opinions of the board (see point 6 of the communication).

- XI. The respondent filed pages of an amended description with a letter dated 22 May 2015.

- XII. With a letter dated 8 June 2015 appellant I announced that in the light of decision G 2/13 it was "*not raising any objections against the Main Request of the Respondent/Patent Proprietor any more.*"

XIII. With a letter dated 8 July 2015 appellant II announced that *"In the light of decision G2/13, and the amendments made by the Patentee ... it has no further objections. Should the Board intend to proceed in any way other than that indicated in its communication of 28th April, OII reserves the right to provide further comments and requests."*

XIV. The final requests of the respondent as submitted with a letter dated 30 July 2015 were (1) to set aside the decision and to remit the case to the department of first instance with the order to maintain the patent on the basis of claims 1 to 5 of the main request filed with letter dated 29 April 2011, a description yet to be adapted thereto and the Figures 1 to 5 as granted; (2) oral proceedings if the board intended to deviate from the request under (1).

In the same letter the respondent noted in relation to its requests that *"these requests provide room for a decision by the Board of Appeal, wherein the adapted description filed with letter dated May 22, 2015 is included into the documents for maintenance of the patent as specified in the order to the Department of First Instance"*. In that context the respondent *"requested that the Board also takes into consideration that none of the Appellants/Opponents have raised objections against the amendment of the description submitted in May 2015"*.

Reasons for the Decision

1. The board ruled in its second interlocutory decision, *supra*, that the *ratio decidendi* of its first interlocutory decision (see section IV above), according to which the main request fulfilled the

requirements of Articles 54, 56, 83 and 123(2) EPC, applied (see also section VIII above). In the same decision the board also held that the plants and parts of plants claimed did not fall under the exclusion of plant varieties as laid down in Article 53(b) EPC and defined in Rule 26(4) EPC (see section VIII above and the second interlocutory decision of 8 July 2013, *supra*, point 16). The *ratio decidendi* of this *interim* decision of the board also applies to the main request.

2. The ruling in decision G 2/13 of the Enlarged Board of Appeal of 25 March 2015, *supra*, has clarified that the process exclusion contained in Article 53(b) EPC has no negative impact on the allowability of product claims as contained in the respondent's main request.
3. The appellants have not submitted any arguments that the ruling in decision G 2/13 of the Enlarged Board of Appeal of 25 March 2015, *supra*, does not apply to the subject-matter of the claims of the main request. The board has none either.
4. Accordingly, the board decides that the main request complies with the requirements of the EPC.
5. In view of the fact that the order of the present decision is in line with the respondent's final request (1) (see section XIV above) and that the appellants have no further objections (see sections XII and XIII above), no further oral proceedings are required.
6. Irrespective of whether or not the appellants' latest submissions before the board can be interpreted as implying - as argued by the respondent (see section XIV above) - that the appellants had no objections to the

pages of the amended description submitted by the respondent with the letter dated 22 May 2015 (see section XI above), the board exercises its discretion under Article 111(1) EPC to remit the case to the department of first instance to adapt the description in order to avoid a further prolongation of the appeal proceedings and consequent delay in the final decision of the board in this case.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance with the order to maintain the patent on the basis of the following documents:
 - claims 1 to 5 of the main request filed with the letter dated 29 April 2011,
 - a description yet to be adapted thereto, and
 - figures 1 to 5 as granted.

The Registrar:

The Chairwoman:



P. Cremona

G. Alt

Decision electronically authenticated