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**Datasheet for the decision
of 8 April 2014**

Case Number: T 1813/09 - 3.3.08

Application Number: 00923018.6

Publication Number: 1179089

IPC: C12Q1/68

Language of the proceedings: EN

Title of invention:

Method for obtaining a plant with a lasting resistance to a pathogen

Patent Proprietor:

Enza Zaden Beheer B.V.

Opponents:

Gautier Semences/Institut National de la Recherche Agronomique
Syngenta Participations AG
Seminis Vegetable Seeds, Inc.

Headword:

Dm-resistance markers/ENZA ZADEN BEHEER

Relevant legal provisions:

EPC Art. 123(2), 123(3), 84, 111(1)
RPBA Art. 13(1), 13(3)

Keyword:

Main request - admitted into the proceedings

Main request - added matter (yes)

Auxiliary request - admitted into the proceedings

Auxiliary request - conforms to Articles 123(2)(3) and 84 EPC

Remittal to opposition division (yes)

Decisions cited:

G 0002/07, T 1408/04

Catchword:



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Case Number: T 1813/09 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 8 April 2014

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 6 July 2009
revoking European patent No. 1179089 pursuant to
Article 101(3)(b) EPC.**

Composition of the Board:

Chairman: M. Wieser
Members: M. R. Vega Laso
 J. Geschwind

Summary of Facts and Submissions

- I. European patent No. 1 179 089 with the title "Method for obtaining a plant with a lasting resistance to a pathogen" was granted on European patent application No. 00923018.6, which was filed as international application under the PCT and published as WO 00/63432 (in the following "the application as filed"). The patent was granted with 7 claims.

- II. Four oppositions to the grant of the patent were filed based on the grounds for opposition under Article 100(a), (b) and (c) EPC, in particular on the grounds that the claimed subject-matter lacked novelty (Article 54 EPC) and an inventive step (Article 56 EPC), that the claims were directed to plant varieties or essentially biological processes for the production of plants (Article 53(b) EPC), that the claimed invention was not disclosed in the patent in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art, and that the subject-matter of the claims of the patent as granted extended beyond the content of the application as filed.

- III. The patent was revoked by a decision of the opposition division under Article 101(2), (3) (b) EPC posted on 6 July 2009. The opposition division found that neither the method according to amended claim 1 of the main request filed on 18 February 2008, nor the cultivated lettuce plant according to amended claim 1 of the auxiliary request filed at the oral proceedings, could be derived clearly and unambiguously from the application as filed. Since the claimed subject-matter extended beyond the content of the application as filed, Article 123(2) EPC was contravened.

Additionally, the claims of the auxiliary request were found to lack clarity within the meaning of Article 84 EPC. As *obiter dictum*, the opposition division made some comments on the requirements of Articles 83, 54 and 56 EPC that it regarded as not fulfilled.

- IV. The patent proprietor (appellant) lodged an appeal against the decision of the opposition division. Together with its statement of grounds of appeal, the appellant submitted new evidence and six sets of amended claims as, respectively, main request and auxiliary requests I to V that replaced the requests underlying the decision under appeal.
- V. Opponents 01, 03 and 04 (respondents I, II and III, respectively) replied to the statement of grounds of appeal.
- VI. By letter of 19 September 2012, opponent 02 withdrew its opposition.
- VII. The board summoned the parties to oral proceedings and, in a communication under Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) attached to the summons, provided some observations on procedural and substantive issues, in particular with respect to Article 12(4) RPBA, Rule 80 and Articles 123(2)(3) and 84 EPC. Moreover, the board drew attention to decision G 2/07 of the Enlarged Board of Appeal (OJ EPO 2012, 130) relating to non-microbiological processes for the production of plants.
- VIII. By letter dated 18 March 2014 in reply to the board's communication, the appellant replaced the claims then

on file by two sets of amended claims as its new main and auxiliary request, respectively.

IX. Independent claims 1, 3 and 4 of the **main request** read:

"1. Cultivated *Lactuca sativa* plant comprising two *Dm*-resistance genes derived from *L.virosa*, wherein the presence of said *Dm*-resistance genes is linked to the DNA-markers as shown in figures 1-2.

3. Seeds of a cultivated *Lactuca sativa* plant as claimed in claim 1 or 2 which seeds comprise two *Dm*-resistance genes derived from *L.virosa*, wherein the presence of said *Dm*-resistance genes is linked to the DNA-markers as shown in figures 1-2.

4. DNA-marker comprising a DNA-sequence which is at least 70%, preferably at least 80%, more preferably at least 90% and most preferably at least 95% homologous to any of the sequences as shown in figures 1-2, which DNA-marker is specifically linked to one or more *Dm*-resistance genes."

Dependent claims 2 and 5 relate to particular embodiments of the plant of claim 1 and the DNA marker of claim 4, respectively.

X. Claims 1 and 2 of the auxiliary request corresponded to claims 4 and 5 of the main request (see section IX above).

XI. Respondents I to III replied to the board's communication. Respondents I and II requested that, should the board decide to admit the new requests, the proceedings were stayed until a decision on the

referrals G 2/12 and G 2/13 to the Enlarged Board of Appeal was taken.

- XII. In a further communication, the board expressed its provisional opinion on the admission of the amended claims filed on 18 March 2014, as well as on the respondents' request to stay the proceedings.
- XIII. At the oral proceedings, which were held on 8 April 2014, the appellant replaced the claims of its previous auxiliary request by a new **auxiliary request** consisting of amended claims 1 and 2 reading as follows:

"1. DNA-marker comprising a DNA-sequence which is at least 70%, preferably at least 80%, more preferably at least 90% and most preferably at least 95% homologous to any of the sequences as shown in figures 1-2, which DNA-marker is specifically linked to one *Dm*-resistance gene.

2. DNA-marker as claimed in claim 1, comprising a DNA-sequence as shown in figures 1-2."

- XIV. The following documents are cited in this decision:

(10): Experimental report by J. de Haas and J. Gielen, dated 27 February 2007;

(60): Declaration of Marion van de Wal, dated 19 January 2009;

(61): Declaration of Henk Verbakel, dated 19 January 2008.

- XV. The submissions made by the appellant concerning issues relevant to this decision, were essentially as follows:

Main request

Admission into the proceedings - Article 13(1)(3) RPBA

The amended set of claims was submitted in response to changes in the jurisprudence of the Enlarged Board of Appeal. The purpose of the amendments introduced into claim 1 was to restore consistency within the claim.

Article 123(2) EPC

A basis for the generalization in claim 1 to any cultivated *L. sativa* plants comprising the markers in figures 1 and 2 could be found in the passages on page 8, lines 29 to 33; page 5, lines 9 and 10; page 6, line 27 to page 7, line 3; and page 9, lines 13 and 14 of the application as filed.

Both the general description and the experimental part of the application provided a direct and unambiguous disclosure identifying *Lactuca virosa* as the source of the *Dm*-resistance genes and the identified markers linked thereto. The general description in the application repeatedly identified wild lettuce species, and specifically *L. virosa*, as the source of the *Dm*-resistance genes. For example, on page 7, lines 6 to 8; page 7, lines 8 to 12; and page 7, lines 30 to 37, *L. virosa* was directly and unambiguously identified as the most preferable source of the resistance genes. Also, the description as filed disclosed in example 3, at page 15, lines 7 to 14 a crossing between two *Lactuca* species, for instance butterhead lettuce (*L. sativa*) with *L. virosa*. Reference was also made to the headings of the crosses described in Example 2. The theoretical observation that it could not be excluded,

in view of the experimental data presented, that the markers originated from the cultivated *L. sativa* plant did not alter the skilled person's technical understanding of these parts of the disclosure. The test of added matter under Article 123(2) EPC was solely based on whether or not information may be derived directly and unambiguously from the application as filed. This was certainly the case for the subject-matter of the amended claims.

Auxiliary request - Articles 123(2) and 84 EPC

The subject-matter of the claims did not extend beyond the content of the application as filed, and the claims were clear and concise.

Remittal to the opposition division

The board should exercise its discretion under Article 111(1) EPC and remit the case to the opposition division for further prosecution. Since the requests underlying the decision under appeal had been found not to be allowable because the claims directed to either methods or plants were considered to offend against Article 123(2) EPC, the opposition division had not decided yet on the claims directed to the DNA markers. Nor had it considered the contradictory experimental evidence in documents (10), (60) and (61) put forward in support of the objection of lack of sufficient disclosure. Any delay due to the remittal would prejudice the appellant, rather than the respondents.

XVI. The submissions made by the respondents, as far as they related to the decisive issues, may be summarized as follows:

Main request

Admission into the proceedings - Article 13(1)(3) RPBA

The amended claims of the new main request had been filed late and addressed issues that had been raised in opposition proceedings. Moreover, they raised numerous issues under Article 123(2) EPC. Therefore, they should not be admitted into the proceedings.

Article 123(2) EPC

The amendments introduced into claims 1 and 3 offended against Article 123(2) EPC. There was no basis in the application as filed for a generalisation of the *Dm*-resistance genes to genes derived from any *L. virosa* plant. Due to the omission of a reference to the resistance to *B. lactucae* in the claims, the claimed subject-matter extended beyond the content of the application as filed. The same applied to the omission of a reference to the method used for obtaining the plant according to claim 1. Claim 4, as regards the wording "one or more", had no basis in the application as filed.

Auxiliary request - Articles 123(2) and 84 EPC

Claim 1 contravened Article 123(2) EPC and did not fulfil the requirement of Article 84 EPC because it did not specify which *Dm*-resistance genes the DNA markers were linked to.

Remittal to the opposition division

Respondent I submitted that a remittal was not justified because the opposition division had expressed

its view on the substantive issues under Articles 83, 54 and 56 EPC in the decision under appeal. The remittal would unduly delay the proceedings.

XVII. The appellant requested that the decision under appeal be set aside and that the case be remitted to the opposition division for further prosecution on the basis of the main request filed with letter of 18 March 2014 or, in the alternative, the new auxiliary request (claims 1 and 2) filed during the oral proceedings.

XVIII. Respondents I, II and III requested that the appeal be dismissed. Additionally, respondent I requested to dismiss the appellant's request for remittal of the case to the opposition division.

Reasons for the Decision

Main request

Admission into the proceedings - Article 13(1)(3) RPBA

1. The set of claims according to the main request was submitted in reply to the communication by the board under Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) sent together with the summons to oral proceedings, in particular as a reaction to an observation on Article 84 EPC in paragraph 44 of the board's communication.
2. According to Article 13(3) RPBA, amendments to a party's case sought to be made after oral proceedings have been arranged shall not be admitted into the proceedings if they raise issues which the board or the

- other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings.
3. In the board's judgement, the set of claims of the present main request does not raise any **new** issues that may have required the scheduled oral proceedings to be adjourned. The amended claims differ from the corresponding claims of the auxiliary request V filed by the appellant together with its statement of grounds of appeal solely in that the wording "or more" in claims 1 and 3 has been deleted, thus limiting these claims to, respectively, a cultivated *Lactuca sativa* plant or a seed comprising **two** *Dm*-resistance genes (see section IX above). These amendments are straightforward and do not increase the complexity of the claimed subject-matter, but remedy a deficiency under Article 84 EPC.
 4. Contrary to the respondents' view, the admission of the new main request into the proceedings does not run counter to the principle of procedural economy, because, as regards Article 123(2) EPC, the issues to be discussed remain essentially the same as those dealt with by the opposition division in the decision under appeal with respect to the auxiliary request then on file.
 5. For these reasons, the board, exercising its discretion under Article 13(1) RPBA, decides to admit and consider the claims of the new main request.

Article 123(2) EPC

6. Claims 1 to 5 of the new main request differ from the claims of the auxiliary request underlying the decision

under appeal in that the wording "*cultivated lettuce plant (Lactuca sativa)*" in claims 1 to 3 has been replaced by "*cultivated Lactuca sativa plant*", and that the wording "*or more*" in claims 1 and 3 has been deleted. Compared to claims 3 to 7 of the patent as granted, from which they are derived, the present claims refer solely to the DNA sequences shown in figures 1 and 2, the reference to figures 3 to 6 having been deleted. Additionally, the features characterizing the plant of claim 1 have been introduced into the amended claim 3.

7. In the decision under appeal, the opposition division held that the application as filed did not clearly and unambiguously disclose that the markers were linked to *Dm*-resistance genes derived from or contained in *L. virosa*, because based on the experimental part of the application (cf. examples 2 and 3, in particular page 16) it could not be ruled out that the marker sequences originated from *L. sativa* instead of *L. virosa* (see section 2.3 of the decision). Moreover, the opposition division found that, contrary to the view of the patent proprietor - the present appellant - neither the passage on page 16 of the description nor claims 17, 4 and 10 of the application as filed provided a basis for the generalization in claim 1 relating to any cultivated *L. sativa* plant comprising markers A and B, because the examples in the application as filed related to very specific crosses of particular plants (see section 2.4 of the decision under appeal).
8. This finding was contested by the appellant in its statement of grounds of appeal by pointing to various passages of the application as filed (page 8, lines 29 to 33; page 5, lines 9 and 10; page 6, line 27 to

page 7, line 3; and page 9, lines 13 and 14 of the application as filed) that, in its view, provided a basis for a generalization to any cultivated *L. sativa* plant.

9. However, none of the passages indicated by the appellant describes a cultivated *L. sativa* plant comprising two *Dm*-resistance genes derived from **any** *L. virosa* plant, the presence of the *Dm*-resistance genes in the *L. sativa* plant being linked to the specific markers A and B. Even though it is disclosed in the application as filed that *L. virosa* is a possible source of *Dm*-resistance genes (see page 7, lines 4 to 12; page 7, line 36 of the application as filed), the sole specific disclosure of a cultivated *L. sativa* plant with *Dm*-resistance genes A and B, which are said to be linked to markers A and B, is found in Example 3, in particular in the passage on page 16, lines 15 to 29 under the heading "Selection of plant with gene A and B". This passage describes the crossing of a plant homozygous for *Dm*-resistance gene A with a plant homozygous for *Dm*-resistance gene B as described previously in Example 2.
10. Example 2 describes crossing schemes for four different populations of cultivated *L. sativa* plants, three of them being obtained by crossing different types of cultivated *L. sativa* plants with specific *L. virosa* plants. In particular, population A of plants homozygous for gene A is obtained by crossing a *L. sativa* plant of the iceberg lettuce type with *L. virosa* CGN9365 (IVT1398) (see page 11 of the application as filed), and population B of plants homozygous for gene B by crossing a *L. sativa* plant of the butterhead lettuce type with *L. virosa* CGN4683 (IVT280) (see page 12 of the application as filed).

11. In the board's judgement, a cultivated *L. sativa* plant comprising a *Dm*-resistance gene A and a *Dm*-resistance gene B which are derived from a *L. virosa* plant **other than** *L. virosa* CGN9365 (gene A) and *L. virosa* CGN4683 (gene B) is not apparent from the application as filed. Thus, claim 1 specifies an undisclosed combination of features lying between the broad disclosure of cultivated *L. sativa* plants that are obtained by introgression of *Dm*-resistance genes from wild lettuce species like *L. virosa* (see, for instance, the passage on page 7, lines 4 to 12 of the application as filed), and the more limited specific disclosure of *L. sativa* plants comprising two *Dm*-resistance genes A and B derived from specific *L. virosa* plants in Example 3, in particular the passage on page 16, lines 15 to 29 referring to the crossing schemes on pages 11 and 12 of the application as filed.
12. The board is not convinced that the additional feature included in claim 1 specifying that the presence of the *Dm*-resistance genes derived from *L. virosa* in the cultivated *L. sativa* plant is linked to the DNA markers shown in figures 1 and 2, represents a limitation to the specific *Dm*-resistance genes A and B derived from *L. virosa* CGN9365 and *L. virosa* CGN4683, respectively. In the board's view, the feature in question is vague because it does not require a close genetic link between the *Dm*-resistance gene and the respective marker, but merely requires that *Dm*-resistance gene and marker are present in the same plant. It should be noted that, according to Example 2 in the application, markers A and B were identified in cultivated *L. sativa* plants which had been obtained by crossing a particular type of cultivated *L. sativa* with specific *L. virosa* plants and subsequently back crossing of the progeny

with a *L. sativa* plant of the parent type. Thus, although it is possible that the markers A and B originate from the respective *L. virosa* plant described in Example 2, with regard to the experimental data provided in the application this cannot be ascertained.

13. In view of the above, the board concludes that the subject-matter of claim 1 represents an impermissible "intermediate" generalisation (see, *inter alia*, decision T 1408/04 of 17 November 2006) from the disclosure of a specific example in the application as filed. Thus, albeit for reasons that differ partly from those given by the opposition division in the decision under appeal, the board judges that the claimed subject-matter extends beyond the content of the application as filed and, therefore, offends against Article 123(2) EPC.
14. For this reason, the patent cannot be maintained on the basis of the claims according to the main request.

Auxiliary request

Admission into the proceedings

15. The set of claims according to the auxiliary request was filed during the oral proceedings before the board. Claims 1 and 2 of this request differ from claims 6 and 7 as granted, from which they are derived, in that they are restricted to DNA markers comprising a DNA sequence which is homologous (claim 1) or identical (claim 2) to one of the sequences in figures **1 or 2**, and that the DNA marker is specifically linked to **one** *Dm*-resistance gene.

16. As the first amendment had been introduced already in the claims of the auxiliary request underlying the decision under appeal, and in the auxiliary request V filed together with the statement of grounds of appeal, it does not give rise to **new** issues. The restriction to "one" *Dm*-resistance gene (instead of "one or more" as in the granted claims 6 and 7) was triggered by a clarity issue that arose during the discussion of the main request at the oral proceedings. Any issues arising from either amendment can be dealt with by the board and the parties without adjournment of the oral proceedings (cf. Article 13(3) RPBA). Therefore, exercising the discretion conferred by Article 13(1) RPBA, the board decides to admit and consider the auxiliary request.

Articles 123(2) (3) and 84 EPC

17. Respondent II contended that claim 1 offended against Articles 123(2) and 84 EPC because it does not specify which particular *Dm*-resistance gene is specifically linked to the claimed DNA marker. The board cannot accept this objection. In the passage on page 8, lines 23 to 28 of the application as filed, which is considered to be an appropriate basis for the present claims, the claimed DNA markers are characterized as being specifically linked to **a** *Dm*-resistance gene. Particular *Dm*-resistance genes are not mentioned in this passage, nor is there any disclosure in the application as a whole of a particular *Dm*-resistance gene linked to any of the markers. Thus, the subject-matter of the claims does not contain subject-matter which extends beyond the content of the application as filed (cf. Article 123(2) EPC).

18. The present claims have been restricted to DNA markers comprising a DNA sequence which is homologous or identical to one of the sequences in figures 1 and 2. They do not extend the protection conferred by the patent as granted. Hence, Article 123(3) EPC is not contravened.

19. With regard to the clarity requirement of Article 84 EPC, the board is convinced that the matter for which protection is sought is clearly defined in the claims by reference to the DNA sequences of figures 1 and 2.

Remittal to the opposition division

20. Pursuant to Article 111(1) EPC, following the examination as to the allowability of the appeal, the board of appeal may decide on the appeal and either exercise any power within the competence of the department which was responsible for the decision under appeal, or remit the case to that department for further prosecution.

21. Since the claims according to the auxiliary request are formally allowable, the board decides to grant the appellant's request and remit the case to the opposition division for further prosecution, in particular as regards substantive matters. When exercising its discretion under Article 111(1) EPC, the board takes into account that, in respect of the claims directed to DNA markers the issues of sufficiency of disclosure, novelty and inventive step have not been dealt with in the decision under appeal, not even as an *obiter dictum*. The appellant should not be deprived of the opportunity to have these issues and the relevant evidence considered at two instances. In particular,

the experimental evidence in documents (60) and (61), on which respondent III has relied in support of an objection under Article 83 EPC, and document (10) may have to be considered by the opposition division when assessing whether or not the claimed invention is sufficiently disclosed in the application as filed (cf. Article 83 EPC), and whether or not the claimed subject-matter involves an inventive step (cf. Article 56 EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution on the basis of the new auxiliary request (claims 1 and 2) filed during the oral proceedings.

The Registrar:

The Chairman:



A. Wolinski

M. Wieser

Decision electronically authenticated