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**Datasheet for the decision  
of 21 January 2014**

**Case Number:** T 2362/10 - 3.3.08

**Application Number:** 07871115.7

**Publication Number:** 2059601

**IPC:** C12N15/82

**Language of the proceedings:** EN

**Title of invention:**

METHODS FOR HYBRID CORN SEED PRODUCTION AND COMPOSITIONS  
PRODUCED THEREFROM

**Applicant:**

Monsanto Technology, LLC

**Headword:**

Hybrid corn seed/MONSANTO

**Relevant legal provisions:**

EPC Art. 84

**Keyword:**

Main and sole request - clarity (no)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern  
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Case Number: T 2362/10 - 3.3.08

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.08**  
**of 21 January 2014**

**Appellant:** Monsanto Technology, LLC  
(Applicant) 800 North Lindbergh Boulevard  
St. Louis, MO 63167 (US)

**Representative:** Helbing J.  
von Kreisler Selting Werner  
Deichmannhaus am Dom  
Bahnhofsvorplatz 1  
50667 Köln (DE)

**Decision under appeal:** **Decision of the Examining Division of the European Patent Office posted on 1 July 2010 refusing European patent application No. 07871115.7 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman:** M. Wieser  
**Members:** B. Stolz  
D. Rogers

## **Summary of Facts and Submissions**

- I. The applicant (appellant) filed an appeal against the decision of the examining division to refuse European patent application No. 07871115. The examining division decided that the set of claims filed on 2 March 2010 did not meet the requirements of Articles 54, 56, 82 and 84 EPC.
- II. With its grounds of appeal the appellant submitted a main request comprising claims 1 to 11.
- III. In a communication annexed to the summons to oral proceedings, the board informed the appellant of its preliminary, non-binding opinion on some of the issues to be discussed at the oral proceedings.
- IV. With its final submissions, dated 20 December 2013, the appellant filed a new main request comprising claims 1 to 8.
- V. Oral proceedings were held on 21 January 2014.
- VI. Claim 1 of the main request reads as follows:  
  
"1. A hybrid corn seed produced by a method comprising:  
(a) providing a female parent comprising at least one transgenic herbicide tolerance trait and a male parent comprising at least three transgenic traits selected from insect resistance, drought tolerance, disease resistance, cold tolerance and a combination thereof, wherein the difference between the number of said transgenic traits on either parent is no greater than two;  
(b) pollinating said female parent with pollen only from the male parent; and

(c) allowing the female parent to produce hybrid seeds."

Dependent claims 2 to 6 refer to specific embodiments of claim 1, and independent claims 7 and 8 to products of the planted seed.

VII. The arguments of the appellant, as far as relevant for the present decision, can be summarized as follows:

Article 84 EPC

The hybrid corn seed of claim 1 represented a mixed population of seed grains in which the proportion of grains comprising all of the desired traits was increased as a result of the particular production method when compared to a seed produced in a different way. It was therefore possible, by comparison with seed produced in other ways, to establish whether the difference in specific traits on either one of the parents was no greater than two.

VIII. The final request of the appellant was that the decision under appeal be set aside; and that a patent be granted in the following version:

claims 1 to 8, submitted under cover of a letter dated 20 December 2013, or

alternatively that the Board stay the proceedings pending the outcome of cases G 2/12 and G 2/13, or

alternatively that the Board refers questions to the Enlarged Board of Appeal, similar to the questions in referrals G 2/12 and G 2/13.

## **Reasons for the Decision**

1. The main request was filed to address several objections raised by the board in its communication attached to the summons to oral proceedings. It is therefore admitted into the proceedings.

### Article 84 EPC

2. The subject matter of claim 1 is a hybrid corn seed produced by a method consisting of crossing a female parent comprising at least one transgenic herbicide tolerance trait and a male parent comprising at least three transgenic traits selected from insect resistance, drought tolerance, disease resistance, cold tolerance and a combination thereof. The method of crossing is characterized by a difference between the number of said transgenic traits on either parent of no greater than two.
3. According to established case law of the Boards of Appeal a claim to a product characterized as being the result of a particular process ("product-by-process claim") only meets the requirements of the EPC if the product itself meets the requirements of the EPC (Case Law of the Board of Appeal of the EPO, 7th Edition 2013, Chapter II.A.7.1). In order to establish whether the claimed hybrid corn seed does so, it is necessary to assess its technical properties resulting from the specified process.
4. The hybrid corn seed according to claim 1 comprises several transgenic traits obtained from its male and/or female parent.

According to the appellant, the process feature relating to the difference between the number of traits on each parent leads to a hybrid corn seed distinguishable from other seeds due to an increased proportion of seed grains comprising all the desired transgenic traits. In essence, his argument is that seed obtained from parents where the difference of the number of the specified traits on either parent is no greater than two has properties distinct from the properties of seed where the difference of said numbers is greater than two.

5. However, firstly, there is no evidence on file and the Board is not aware of any method to identify in a population of hybrid seeds, each containing a specific number of transgenic traits, which seeds were obtained from parents where the difference between the number of said transgenic traits obtained from either parent is no greater than two, and which seeds were obtained from parents where this difference was greater than two.

Secondly, whether a hybrid corn seed comprises an increased proportion of grains yielding plants with all the desired traits can only be established by comparison with other seeds. The result of such a comparison depends not only on the seeds used for comparison but also on the conditions under which the seeds are planted for comparison. Neither the claim nor the description make any mention of any reference seeds, of any specific values of the required proportion of desired grains or of the conditions under which a comparison should be performed. It is therefore not possible to unambiguously establish the technical characteristics conferred on the claimed hybrid corn seed by the process features specified in claim 1.

6. Thus, the board decides that claim 1 lacks clarity within the meaning of Article 84 EPC.
7. Since the only request on file is not allowable under the provisions of Article 84 EPC, the board sees no need to stay the proceedings or to refer any questions of law to the Enlarged Board of Appeal as requested by the appellant as an auxiliary measure (see section VII above).

## Order

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

The appeal is dismissed

The Registrar:

The Chairman:



A. Wolinski

M. Wieser

Decision electronically authenticated