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Datasheet for the decision of 22 May 2014

Case Number: T 0818/12 - 3.3.08

Application Number: 07000604.4

Publication Number: 1795600

IPC: C12N15/82, C07K14/415, C12N15/29, C12N9/12, C12N9/16

Language of the proceedings: EN

Title of invention:
Cell cycle stress-realted proteins and methods of use in plants

Applicant:
BASF Plant Science GmbH

Headword:
Transgenic plant - Cell cycle stress related protein/BASF

Relevant legal provisions:
EPC Art. 84, 83, 54, 56

Keyword:
Main request - requirements of the EPC met (yes)

Decisions cited:

Catchword:

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Case Number: T 0818/12 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 22 May 2014

Appellant: (Applicant)	BASF Plant Science GmbH Carl-Bosch-Strasse 38 67056 Ludwigshafen (DE)
Representative:	BASF SE Global Intellectual Property GVX - C6 67056 Ludwigshafen (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 27 October 2011 refusing European patent application No. 07000604.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	M. Wieser
Members:	B. Stolz
	J. Geschwind

Summary of Facts and Submissions

I. The appeal lies against the decision of the examining division dated 27 October 2011 whereby European patent application No. 07000604.4, which was filed as a divisional application of European patent application No. 01926730.1, was refused.

II. At oral proceedings, held on 2 February 2011 before the examining division, a main request and auxiliary request 1, both filed on 17 December 2010, were considered.

At the end of the oral proceedings, the examining division informed the applicant that it intended to grant a patent on the basis of the auxiliary request .

The applicant received a communication under Rule 71(3) EPC which comprised the text proposed for grant on the basis of the auxiliary request.

With letter of 1 September 2011, the applicant disapproved the text for grant on the basis of the auxiliary request and informed the examining division that it maintained the main request.

The examining division refused the application because claim 1 of the main request did not meet the requirements of Article 84 EPC and, as a consequence thereof, of Article 54 EPC.

III. Claim 1 of the main request read as follows:

"1. A transgenic plant cell transformed by a Cell Cycle Stress-Related Protein (CCSRP) coding nucleic acid, wherein the CCSRP coding nucleic acid has been

introduced into the plant cell by recombinant expression vectors comprising the CCSRP nucleic acid and codes for a CCSRP selected from the group consisting of Cell Cycle-3 Protein (CC - 3) as defined in SEQ ID NO:9 and a polypeptide being at least 80% identical to the entire amino acid sequence shown in SEQ ID NO:9, and wherein expression of the nucleic acid in the plant cell results in the plant's increased tolerance to drought stress as compared to a wild type variety of the plant cell."

The remaining claims referred to preferred embodiments of the plant cell according to claim 1 (claims 2 to 4) transgenic plants and seed (claims 5-7), the CCSRP protein, the DNA encoding it and expression vectors (claims 8 to 11), and to methods of producing and using the plants, seeds, the CCSRP protein, and the nucleic acid encoding the CCSRP protein (claims 21 to 21).

IV. With its statement setting out the grounds of appeal, dated 17 May 2011, the applicant (appellant) maintained the main request and the auxiliary request that were before the examining division.

V. Appellant's arguments regarding the main request, as far as relevant for the present decision can be summarized as follows:

Article 84 EPC

The wording of claim 1 was clear. The skilled person knew that transformation led to the production of transgenic plants. Therefore, it was clear that the transgenic plant cell of claim 1 was transgenic due to the transformation with and hence the presence of a gene coding for the 14-3-3 protein-1. The presence of

further transgenes was not excluded by the wording of claim 1.

Further, the term "plant cell transformed by" was not a "product by process" type of definition. The claim did not comprise any reference to process steps and the definition of the plant cell included characteristic structural and functional features.

The functional feature specifying that "expression of the CCSRP in the plant results in the plant's increased tolerance to drought stress as compared to a wild type variety of the plant" excluded embodiments in which the transgenic plant cell did not comprise a 14-3-3 transgene due e.g. to unsuccessful transformation or due to only transient transformation.

Procedural violation

By not granting applicant's repeated request for a staying of the proceedings until a final decision in the appeal proceedings of the co-pending European patent application EP060230947 had been taken, the examining division forced the applicant to incur unnecessary costs for the work on the present case and the appeal fee. This constituted a substantial procedural violation of applicant's rights which justified the reimbursement of the appeal fee.

Moreover, one of the reasons in the decision under appeal for refusing the main request was an alleged lack of novelty. However, throughout the examination proceedings, the examining division had never raised a novelty objection against claim 1 of the main request.

VI. The appellant requested that the decision under appeal be set aside and the case be remitted to the first instance with the order to grant a patent on the basis of the main request or on the basis of the auxiliary request, both filed with its statement setting out the grounds of appeal. It also requested reimbursement of the appeal fee.

Reasons for the Decision

Main request

1. The claims of the main request differ from the claims of the auxiliary request, which was held allowable by the examining division, only in claim 1. Claim 1 of the main request is identical to claim 1 of the main request before the examining division, which was found not to be clear and to contravene the requirements of Article 84 EPC.

2. The claim refers to a transgenic plant cell transformed by a vector comprising a nucleic acid encoding a Cell Cycle Stress-Related Protein (CCSRP) wherein expression of the CCSRP coding nucleic acid in the plant cell results in increased tolerance to drought stress of the plant cell.

3. The examining division has not disputed that transgenic plants can be obtained by the process of transformation.

The examining division was however of the opinion that claim 1 of the main request was not limited to plant cells comprising a nucleic acid encoding an CCSRP protein. It interpreted the term "transformed by a

CCSRP encoding nucleic acid" as a feature merely requiring that a plant cell had (at some point in time) been transformed with the nucleic acid, which was not necessarily meaning that the nucleic acid was still present in the claimed plant cell. According to the examining division the CCSRP encoding nucleic acid could be lost after transformation (transient transformation) or the transformation procedure could result in plant cells with a non-functional CCSRP gene. Such a plant cell could still be a "transgenic plant cell" according to claim 1 as the result of transformation procedures unrelated to the transformation with the nucleic acid encoding the CCSRP protein. The examining division was of the opinion that the functional feature "wherein expression of the CCSRP coding nucleic acid in the plant cell results in increased tolerance to drought stress of the plant cell" did not exclude these possibilities. It concluded therefore that claim 1 did not meet the requirements of Article 84 EPC. As a consequence thereof, it also lacked novelty.

4. The board does not agree with the examining division's interpretation of the claim because the functional feature at the end of claim 1 excludes plant cells which were unsuccessfully transformed or which have lost the transgene after the transformation event from the scope of protection. This functional feature specifies that expression of **the** (definite article) nucleic acid in the plant cell results in the plant cell's increased tolerance to drought stress. In the context of claim 1, "the nucleic acid" can only refer to the CCSRP coding nucleic acid that was used for transformation, since no other nucleic acid is mentioned. Moreover, expression of this sequence only **results** (present tense) in the claimed property if it

is present and functional in the plant cell. If the sequence is, for whatever reason, no longer present in the transgenic plant cell and only **resulted** (past tense) in the claimed property, it cannot do this. The functional limitation, therefore, rules out the ambiguities which the examining division considered to result from the use of the term "transformed".

Claim 1 therefore meets the requirements of Article 84 EPC. In consequence, the novelty objection based on a lack of clarity is moot.

5. The subject matter of claim 1 of the main request is thus a plant cell comprising a nucleic acid encoding the CCSRP protein. The subject matter of claims 2 to 21 of the main request is literally identical to claims 2 to 21 of the auxiliary request before the examining division.

The board shares the positive findings of the examining division with regard to the auxiliary request concerning the requirements of Articles 123(2), 83, 54 and 56 EPC (see communication according to Rule 71(3) EPC).

Since the nucleic acids encoding the CCSRP according to claim 9 of the main request (and of the auxiliary request) meet the requirements of the EPC, the same is true for claim 1 of the main request directed to transgenic plant cells comprising the nucleic acids.

6. The main request therefore meets the requirements of the EPC.

Procedural violation

7. The appellant requests reimbursement of the appeal fee on the basis that its repeated requests to stay the proceedings until a final decision in the pending appeal proceedings concerning European Patent application No. 060230947 (the parallel case) was issued, were refused.

8. According to Rule 71(1) EPC, the examining division defines the period within which amendments to the description, claims and drawings have to be submitted. Rule 132(2) EPC stipulates that in special cases and upon request, this period may be extended. Since it is the examining division which sets the period according to Rule 71(1) EPC, extensions according to Rule 132(2) EPC are granted at the examining division's discretion.

9. Contrary to appellant's submissions, the examining division has not simply ignored the requests. According to item I.1.12 of the decision under appeal, the examining division refused appellant's first request for postponing the oral proceedings until a written decision in the parallel case was issued, because at the date of the request, the decision was already written and the appellant could expect to receive it before the scheduled oral proceedings (cf. also the minutes of "Consultation by telephone" of 11 January 2011). A further request was filed with the response to the communication under Rule 71(1) EPC. According to item I.1.17 of the decision under appeal, the examining division did not grant the request at this late stage of the proceedings.

10. The EPC does not provide a legal basis that would guarantee the granting of a request for delaying examination proceedings. Although the board can understand the appellant's motivation for filing such a

request in the present case, it cannot recognize any procedural violation by the examining division. Consequently, the request for reimbursement of the appeal fee is rejected.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

1. The case is remitted to the examining division with the order to grant a patent on the basis of claims 1 to 20 of the main request filed on 17 May 2011 and a description to be adapted thereto.

2. The request for reimbursement of the appeal fee is rejected.

The Registrar: The Chairman:

A. Wolinski M. Wieser

Decision electronically authenticated

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Case Number: T 0818/12 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
# of correcting an error in the decision
of 22 May 2014

Appellant: (Applicant)	BASF Plant Science GmbH Carl-Bosch-Strasse 38 67056 Ludwigshafen (DE)
Representative:	Popp, Andreas BASF SE Global Intellectual Property GVX - C6 67056 Ludwigshafen (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 27 October 2011 refusing European patent application No. 07000604.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	M. Wieser
Members:	B. Stolz
	J. Geschwind

Item IV of the Summary of Facts and Submissions is substituted by:

IV. With its statement setting out the grounds of appeal, dated 2 March 2012, the applicant (appellant) maintained the main request and the auxiliary request that were before the examining division.

The Order is substituted by:

Order

For these reasons it is decided that:

The decision under appeal is set aside.

1. The case is remitted to the examining division with the order to grant a patent on the basis of claims 1 to 21 of the main request filed on 2 March 2012 and a description to be adapted thereto.

2. The request for reimbursement of the appeal fee is rejected.

The Registrar: The Chairman

A. Wolinski M. Wieser

Decision electronically authenticated