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**Datasheet for the decision
of 19 November 2019**

Case Number: T 0819/16 - 3.3.04

Application Number: 03078990.3

Publication Number: 1433378

IPC: A01H5/00

Language of the proceedings: EN

Title of invention:

Resistance to powdery mildew infection and absence of necrosis
in cucumber, Cucumis sativus

Patent Proprietor:

Nunhems B.V.

Opponents:

Enza Zaden Beheer B.V.
Monsanto Company

Headword:

Cucumis/NUNHEMS

Relevant legal provisions:

EPC Art. 53(b), 84, 100(c), 123(2), 123(3)
RPBA Art. 13

Keyword:

Main request (patent as granted) - added subject-matter (yes)

Auxiliary request - admitted in proceedings (no)

Decisions cited:

Catchword:

-



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 0819/16 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 19 November 2019

Appellant: Enza Zaden Beheer B.V.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 18 February
2016 rejecting the opposition filed against
European patent No. 1433378 pursuant to Article
101(2) EPC.**

Composition of the Board:

Chairwoman G. Alt
Members: B. Claes
 P. de Heij

Summary of Facts and Submissions

I. European patent No. 1 433 378, having the title "*Resistance to powdery mildew infection and absence of necrosis in cucumber, Cucumis sativus*", was granted on European patent application 03 078 990.3.

II. Claim 1 of the granted patent read:

"1. A plant of the species *Cucumis sativus* L, **characterized by** the combination of the properties:

(a) complete resistance for powdery mildew of the fungus *Sphaerotheca fuliginea*, and

(b) complete absence of necrosis when cultivated under necrosis inducing conditions, wherein said complete resistance for powdery mildew means that the plant is both hypocotyl resistant and completely leaf resistant, as determined in the powdery mildew resistance test set forth in the description; and wherein complete absence of necrosis when cultivated under necrosis-inducing conditions means that no necrosis symptoms are seen on any of the leaves as determined in the necrosis test set forth in the description,

said complete resistance for powdery mildew and said complete absence of necrosis being obtainable from seed deposited under deposit number NCIMB 41133."

III. Claims 4 and 5 of the application as filed read:

"4. A cucumber plant having the characteristics of the plant deposited under deposit number NCIMB 41133.

5. A plant derived from the plant of claim 4 and comprising the characteristics of:
(a) complete resistance for powdery mildew, and
(b) complete absence of necrosis when cultivated under necrosis inducing conditions."

- IV. The patent was opposed as a whole by two parties on the grounds for opposition in Article 100(a) EPC, relating to novelty (Article 54 EPC) and inventive step (Article 56 EPC), Article 100(b) EPC and Article 100(c) EPC. The opposition division rejected the oppositions and this decision was appealed by both opponents 1 and 2 ("appellant I" and "appellant II", respectively).
- V. In their respective statements of grounds of appeal, the appellants submitted arguments to the effect that the claims as granted related to added subject-matter, the claimed subject-matter lacked novelty and inventive step, and the patent did not sufficiently disclose the claimed invention.
- VI. The respondent replied to the appeals and argued that none of the invoked grounds justified revoking the patent in suit.
- VII. In a further round of written submissions, both appellants responded to the replies of the respondent to the respective appeals, who subsequently replied anew to the submissions of the appellants with a further letter.
- VIII. The board issued a "Summons to oral proceedings pursuant to Rule 115(1) EPC" dated 14 February 2019.

- IX. With a letter dated 17 June 2019, appellant I requested the postponement of the scheduled oral proceedings in view of the pending referral to the Enlarged Board of Appeal (Case G 3/19) "*concerning the patentability of plant obtained by an essentially biological method*".
- X. In a communication, the board addressed appellant I's request for postponement of oral proceedings and invited the parties to submit comments on the matter by 31 August 2019. Both the respondent and appellant II replied to the communication in due time. Appellant I also replied.
- XI. In a further communication, the board informed the parties that it saw no reason justifying postponement of the oral proceedings as requested by appellant I. The board also expressed its preliminary opinion on substantive issues in the appeal.
- XII. With their reply to the latter communication of the board, the respondent submitted four auxiliary requests.

In claim 1 of the 3rd and 4th auxiliary request, as compared to the wording of the claim of the patent as granted (main request), the wording "said complete resistance for powdery mildew and said complete absence of necrosis being obtainable from seed deposited under deposit number NCIMB 41133" was amended.

In claim 1 of the 3rd auxiliary request, it was amended to read: "said plant, comprising the characteristics of said complete resistance for powdery mildew and said complete absence of necrosis, being obtainable from seed deposited under deposit number NCIMB 41133." (Emphasis added by the board.)

In claim 1 of the 4th auxiliary request, it was amended to read: "said plant, comprising the characteristics of said complete resistance for powdery mildew and said complete absence of necrosis, being derived from seed deposited under deposit number NCIMB 41133." (Emphasis added by the board.)

XIII. At the end of the oral proceedings, the respondent withdrew the 1st and 2nd auxiliary requests. Subsequently, the chair announced the board's decision.

XIV. The final requests of the parties were:

The appellants requested that the 1st to 4th auxiliary requests not be admitted into the proceedings, that the decision under appeal be set aside and that the patent be revoked.

The respondent requested that the 3rd and the 4th auxiliary requests be admitted into the proceedings and that the appeals be dismissed or, alternatively, that the patent be maintained on the basis of the set of claims of the 3rd or of the 4th auxiliary request. They further requested that document D18 be admitted into the proceedings.

Reasons for the Decision

1. The appeals are admissible.

Patent as granted (main request) - claim 1
Added subject-matter (Article 100(c) EPC)

2. Pivotal to this appeal is whether the claimed subject-matter extends beyond the content of the application as filed in respect of the feature "said complete resistance for powdery mildew and said complete absence of necrosis being obtainable from seed deposited under deposit number NCIMB 41133", i.e. the last part of the claim (see section II).
3. The parties were in agreement that the contentious feature defined the specific combination of traits of the claimed plant, i.e. complete resistance for powdery mildew and complete absence of necrosis, in a wording which was in a "product-by-process" format, stipulating that the combination of features was "obtainable from seed deposited under deposit number NCIMB 41133".
4. The board concurs with the respondent that the contentious feature did not restrict the claimed subject-matter to plants which had identical genetic information as contained in the genome of the deposited seeds providing the specified trait combination. Indeed, the feature "obtainable from" specific deposited seed means that genetic information providing the functionally defined traits *can* be obtained from the deposited seeds.

5. However, in the present situation, the wording "being obtainable from" cannot be interpreted to exclude that genetic information providing the functionally defined traits is also obtainable from sources other than the deposited seeds.

6. Thus, besides plants being progeny of plants obtained from the deposited seeds which include the particular event comprised in the deposited seeds, the claim is also directed to plants having no relation with the deposited seed, such as plants displaying complete resistance for powdery mildew and the complete absence of necrosis, in which the combination of traits originates from a different genetic event than that in the deposited seeds ("non-genetically related plant embodiments").

7. Whereas the opposition division held in the impugned decision that claims 4 and 5 as filed (see section III) provided a basis for the contentious feature and considered therefore that it did not relate to added subject-matter, the appellants reiterated on appeal that neither these claims nor the application as filed as a whole provided a basis for holding the claim to not relate to added subject-matter. They argued that the whole disclosure of the application as filed, including the claims, was limited to plants being progeny of the plants obtained from the deposited seeds which include the particular event comprised in the deposited seeds. However, the application failed to disclose plants which display the combination of traits in which this combination originates from a different genetic event than contained in the disclosed deposited seeds, i.e. the non-genetically related plant embodiments.

8. In a first line of defence, the respondent argued that claims 4 and 5 as filed, in particular claim 5, provided a basis for the non-genetically related plant embodiments. Whereas claim 4 was for the particular deposited plants, claim 5 was for plants "derived from" the plant of claim 4 and comprising the two characteristics. Since this claim was formulated in the "product-by-process" format, it was for the plant per se and disclosed therefore also plants having the two traits but originating from a different, independent genetic event.
9. Claim 5 of the application as filed is, as correctly pointed out by the respondent, for a plant "derived from" the deposited plant of claim 4 and comprising the two characteristics. However, the contentious feature in the claim does not specify the claimed plant to be derived from the deposited seed but rather that the particular trait combination is obtainable from it and thus, as considered above, includes non-genetically related plant embodiments. Accordingly, the board comes to the conclusion that claim 5 as filed, contrary to the finding of the opposition division, does not clearly and unambiguously disclose the contentious feature.
10. In a further line of defence, the respondent referred to a number of passages in the description of the application as filed which allegedly disclose the contentious feature in clear and unambiguous terms. These passages read:

on page 4, lines 26 to 30:

"Another embodiment of the invention provides the DC1 plants, seeds, plant cells or cell cultures, plant

*tissue and **any plant derived from DC1** by asexual propagation or cloning, by selfing of DC1 or by crossing DC1 with other Cucumis sativus L. plants and selecting for the unique characteristics of DC1, namely the combination of complete mildew resistance with absence of necrosis in the winter cultivation."*

on page 7, lines 28 to 30:

*"The **DC1 plants, as obtainable from the seeds deposited** under NCIMB 41133, can be used to produce cucumber plants and to breed cucumber varieties with the characteristics of DC1."*

and on page 18, line 22 to 25:

*"To this invention also belong plants, varieties, lines, derived varieties or lines, doubled haploids and hybrids of the species Cucumis sativus, **which contain the same unique combination of DC-1 characteristics**, i.e., complete mildew resistance and complete freedom of necrosis."*

11. The board is unable to derive from these passages a clear and unambiguous disclosure of plants which display the combination of traits in which this combination originates from a different genetic event than that contained in the disclosed deposited seeds, here the DC1 plants of the invention, i.e. the non-genetically related plant embodiments. In fact, whereas the passages on pages 4 and 7 clearly relate to plants obtained from the deposited DC1 plant seeds, the passage on page 18, in particular by the use of the expression "which contain the same unique combination of DC-1 characteristics", is not a clear and unambiguous disclosure of plants not comprising

identical genes as present in the DC1 plant for the trait combination.

12. In view of the above considerations the board decided that the claim relates to added subject-matter (Article 100(c) EPC).

3rd and 4th auxiliary requests - admittance in the appeal proceedings

13. According to Article 13(1) RPBA 2007, any amendment to a party's case after it has filed its grounds of appeal/reply to the grounds of appeal may only be admitted and considered at the board's discretion. This discretion is to be 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. Furthermore, Article 13(3) RPBA 2007 additionally requires that amendments sought to be made after oral proceedings have been arranged not be admitted if they raise issues the board or the other parties cannot reasonably be expected to deal with without adjournment of the oral proceedings.
14. In the case at hand, the claim requests were not filed by the respondent with its reply to the appeals (see section VI). Therefore, the filing of the requests was at the time of the oral proceedings governed by Article 13 RPBA 2007.
15. The respondent also did not file the requests with a further reply to a further round of written submissions of both appellants (see section VII). They did so only after the parties had been summoned to oral proceedings and the board had issued a communication in which it had expressed its preliminary opinion on substantive issues in the appeal, *inter alia*, that claim 1 of the

patent as granted was considered to relate to added subject-matter.

16. The respondent justified filing the requests in this late stage of the proceedings and not earlier by the fact that they, as the opposition division had, considered that the main request satisfied the requirements of Article 123(2) EPC and that the board's negative opinion on this issue in its communication had been the first indication that claim 1 of the patent as granted might have a problem. However, the board notes that the corresponding assessment presented by the board in its communication introduced no new issue in the context of added subject-matter as compared to the earlier submissions of the appellants' on the same subject that would have justified the filing, as a response, of the amended claims of the 3rd and 4rd auxiliary requests.
17. The respondent further submitted that the auxiliary requests constituted a *bona fide* attempt to overcome the deficiencies in claim 1 of the main request and *prima facie* did not raise new problems.
18. The board notes, however, that the amended claims of the auxiliary requests are not merely based on features of granted, dependent claims and that, in addition, as submitted by the appellants, they raise new issues that if admitted would raise questions which seemed inappropriately complex at this stage of the proceedings. In particular, it was argued, and the board agrees, that it was not clear that the amendments in the auxiliary requests solved the deficiencies of claim 1 of the main request and that the amendments in addition raised serious concerns in view of the exclusion from patentability of plant varieties

pursuant to Article 53(b) EPC, about clarity and about the extension of the scope of protection (Article 123(3) EPC).

19. In view of these considerations, the board, in the exercise of its discretion under Article 13(1) and (3) RPBA, considered it appropriate not to admit the 3rd and the 4th auxiliary request into the appeal proceedings.
20. In the absence of any allowable request, the patent must be revoked.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chair:



I. Aperribay

G. Alt

Decision electronically authenticated