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**Datasheet for the decision
of 21 February 2022**

Case Number: T 2734/18 - 3.3.04

Application Number: 13708833.2

Publication Number: 2825024

IPC: A01H5/08, A01H1/04, A01H5/00

Language of the proceedings: EN

Title of invention:
Tomato plants with intense phenotype and TYLCV resistance

Applicant:
Nunhems B.V.

Headword:
Tomato plants with intense phenotype/NUNHEMS

Relevant legal provisions:
EPC Art. 53(b), 111(1), 111(2)
EPC R. 28(2)

Keyword:
Main request: exceptions to patentability (no);
remittal to the examining division for further prosecution
(yes)

Decisions cited:

G 0002/12, G 0002/13, G 0003/19

Catchword:



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Case Number: T 2734/18 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 21 February 2022

Appellant: Nunhems B.V.
(Applicant) Napoleonsweg 152
6083 AB Nunhem (NL)

Representative: BASF IP Association
BASF SE
G-FLP-C006
67056 Ludwigshafen (DE)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 4 June 2018
refusing European patent application No.
13708833.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair G. Alt
Members: R. Morawetz
P. de Heij

Summary of Facts and Submissions

- I. The appeal filed by the applicant (appellant) lies from the examining division's decision refusing European patent application No. 13 708 833.2 (application), which had been filed on 12 March 2013 as an international application published as WO 2013/135726. The title of the application is "*Tomato plants with intense phenotype and TYLCV resistance*".
- II. In the decision under appeal, the examining division held that the subject-matter of claim 1 of the (sole) set of claims on file, filed on 7 October 2016, fell under the exclusions from patentability as defined by Rule 28(2) EPC and that, consequently, the application did not meet the requirements of Article 53(b) EPC.
- III. With the statement of grounds of appeal, the appellant maintained the set of claims underlying the decision under appeal as its main request and, *inter alia*, requested that the decision under appeal be set aside and a patent be granted on the basis of the set of claims of the main request or "*on the basis of the auxiliary request filed herewith*".

Claim 1 of the main request reads:

"1. A *Solanum lycopersicon* plant comprising a TYLCV resistance phenotype and an intense fruit phenotype whereby the locular gel is replaced by fleshy tissue, wherein said plant comprises at least one recombinant chromosome 6 comprising the *intense* allele and an introgression fragment comprising an allele conferring TYLCV resistance in coupling configuration,

wherein said allele conferring TYLCV resistance is selected from the group consisting of the *Ty-1* allele from *S. chilense*, the *Ty-3* allele from *S. chilense* or an ortholog of the *Ty-1* or *Ty-3* allele."

- IV. The board issued a communication pursuant to Rule 100(2) EPC in which it noted that, contrary to the appellant's statement, no auxiliary request had been filed with the statement of grounds of appeal. The appellant was invited to clarify its position as regards the auxiliary request. The board furthermore informed the appellant that it intended to remit the case to the examining division for further prosecution (Article 111(1) EPC).
- V. In response, the appellant confirmed by letter of 3 April 2019 that no auxiliary claim request had been filed and further submitted that, as the board intended to remit the case to the examining division for further prosecution further auxiliary claim requests were not deemed necessary.
- VI. Upon a request of the President of the European Patent Office (President) to be allowed to comment in writing on questions of general interest which arose in the case at hand - namely (1) the appropriateness of a further referral to the Enlarged Board of Appeal (EBA) under Article 112(1)(a) EPC despite the pending referral G 3/19 and (2) the applicability to the present case of Rule 28(2) EPC - the board invited the President to comment (Article 18 RPBA 2007) on the first question and further noted that it would invite for comments on the second question once the EBA had issued its opinion in case G 3/19, if considered necessary at that point in time.

- VII. The President filed comments in writing regarding the first question. They were communicated to the appellant who, in response, requested the referral of questions to the EBA as well and oral proceedings in case that this request was dismissed.
- VIII. In a communication under Article 15(1) RPBA accompanying summons to oral proceedings, the board pronounced its preliminary opinion that the request for the referral of questions to the EBA was to be refused.
- IX. Following the issuance of opinion G 3/19 in May 2020, from the reasons of which it followed that Rule 28(2) EPC was not applicable to the case at hand, the board informed the President that it deemed comments on the second question to be redundant. In response the President informed that, having regard to the conclusions reached by the EBA in opinion G 3/19, further comments were not required.
- X. Subsequently, the appellant withdrew its request for a referral to the EBA and its corresponding conditional request for oral proceedings.

In the same submission the appellant requested that the decision under appeal be set aside and then re-iterated some of its requests already submitted with the statement of grounds of appeal as follows

"that:

- European patent application No.13708833.2 be granted on the basis of the set of claims filed on 7 October 2016, or on the basis of the auxiliary claim request filed herewith, or*
- the application be remitted to the first instance Examining Division with the order that the claims of the main and/or auxiliary are in compliance with*

Article 53(b) EPC.

We also maintain our request for oral proceedings in the event that the Board contemplates a decision that does not meet at least one of these two requests."

No auxiliary claim request was filed with the submission.

XI. The board thereafter cancelled the oral proceedings.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 99 EPC and is admissible.

Main request (set of claims filed on 7 October 2016)

Exceptions to patentability (Article 53(b) EPC)

2. The sole reason given by the examining division for refusing the main request was that the subject-matter of claim 1 was excluded from patentability pursuant to Article 53(b) EPC and Rule 28(2) EPC.
3. Article 53(b) EPC excludes from patentability "*plant or animal varieties or essentially biological processes for the production of plants or animals*" while Rule 28(2) EPC, in force from 1 July 2017, stipulates that under Article 53(b) EPC, European patents shall not be granted in respect of plants or animals exclusively obtained by means of an essentially biological process.
4. The board considers that with the Enlarged Board of Appeal's issuance of opinion G 3/19 of 14 May 2020

(OJ EPO 2020, A119), the legal situation underlying the decision under appeal has substantially changed (see in particular points 6. and 7. below).

5. In decisions G 2/12 and G 2/13 (see OJ EPO 2016, A27 and A28) the Enlarged Board of Appeal had held that the exception to patentability of essentially biological processes for the production of plants in Article 53(b) EPC did not have a negative effect on the allowability of a product claim directed to plants or plant material such as a fruit or plant parts.
6. In opinion G 3/19 (*supra*) the Enlarged Board of Appeal abandoned the interpretation of Article 53(b) EPC given in decisions G 2/12 and G 2/13 (*supra*) and, in the light of Rule 28(2) EPC, held that the term "essentially biological processes for the production of plants or animals" in Article 53(b) EPC is to be understood and applied as extending to products exclusively obtained by means of an essentially biological process (see Reasons, point XXVI.8). The Enlarged Board of Appeal thus concluded that the exception to patentability of essentially biological processes for the production of plants or animals in Article 53(b) EPC has a negative effect on the allowability of product claims and product-by-process claims directed to plants, plant material or animals, if the claimed product is exclusively obtained by means of an essentially biological process (see Conclusion).
7. However, in order to ensure legal certainty and to protect the legitimate interests of patent proprietors and applicants, the Enlarged Board of Appeal considered it appropriate that the new interpretation of Article 53(b) EPC had no retroactive effect on European patents containing such claims which were granted

before 1 July 2017, when Rule 28(2) EPC entered into force, or on pending European patent applications seeking protection for such claims which were filed before that date (see Reasons, point XXIX).

8. Accordingly, as the present application was filed before 1 July 2017, and is still pending (see section I), the new interpretation of Article 53(b) EPC adopted in opinion G 3/19 (*supra*), does not apply.
9. Furthermore, Article 53(b) EPC, as interpreted by decisions G 2/12 and G 2/13 of the Enlarged Board of Appeal (*supra*), does not exclude the subject-matter of the main request from patentability.
10. In view of the above considerations, the board concludes that the subject-matter of the claims of the main request is not excluded from patentability pursuant to Article 53(b) EPC in conjunction with Rule 28(2) EPC.
11. The appeal is thus allowable.

Remittal (Article 111(1) EPC)

12. Pursuant to Article 111(1) EPC the board may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.
13. It is the primary function of appeal proceedings to review the decision under appeal in a judicial manner (see Article 12(2) RPBA and Case Law of the Boards of Appeal, 9th edition 2019, section V.A.1.1, second paragraph and decisions referred to there).

14. As explained in point 2. above, the sole reason for refusing the present application was that the subject-matter of claim 1 of the main request was excluded from patentability pursuant to Article 53(b) EPC and Rule 28(2) EPC, a decision which the board reviews (see points 3. to 10. above).
15. As the examining division has not taken an appealable decision on any other requirement for patentability, the board does not accede to the appellant's request to order that a patent be granted. However, the present circumstances represent special reasons as stipulated in Article 11 RPBA that warrant remittal of the case.
16. In view of the above considerations, the board decides to remit the case to the examining division for further prosecution.
17. Pursuant to Article 111(2) EPC the examining division is bound by the *ratio decidendi* of the board, in so far as the facts are the same. The decision is thus in line with one of the appellant's requests (see section X.) and could be taken without holding oral proceedings.
18. The board's conclusion in point 10. applies to the main request. Accordingly the auxiliary request referred to by the appellant is at present of no relevance. Therefore, the board's decision could be taken without inviting the appellant again to clarify its position as regards the auxiliary request (see section X.) bearing also in mind that the appellant had already indicated that further auxiliary claim requests were unnecessary (see section V.).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.

The Registrar:

The Chair:



I. Aperribay

G. Alt

Decision electronically authenticated