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**Datasheet for the decision  
of 12 February 2021**

**Case Number:** T 0281/19 - 3.3.04

**Application Number:** 10770643.4

**Publication Number:** 2493286

**IPC:** A01H1/02, A01H5/04

**Language of the proceedings:** EN

**Title of invention:**

Hybrid seed potato breeding

**Applicant:**

Agventure B.V.

**Headword:**

Hybrid seed potato breeding/AGVENTURE

**Relevant legal provisions:**

EPC Art. 53(b), 111(1)

EPC R. 28(2)

RPBA 2020 Art. 13(1)

**Keyword:**

Main request - exceptions to patentability (no); remittal to the examining division (yes)

**Decisions cited:**

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



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Case Number: T 0281/19 - 3.3.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.04**  
**of 12 February 2021**

**Appellant:** Agventure B.V.  
(Applicant) Delhorstpad 1A  
6703 BE Wageningen (NL)

**Representative:** V.O.  
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**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 4 December 2018  
refusing European patent application No.  
10770643.4 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chair** G. Alt  
**Members:** A. Schmitt  
R. Romandini

## Summary of Facts and Submissions

- I. The appeal of the applicant (appellant) lies from the decision of the examining division refusing European patent application No. 10 770 643.4 ("the application"), which had been filed on 26 October 2010 as an international application published as WO 2011/053135. The title of the application is "*Hybrid seed potato breeding*".
- II. In the decision under appeal, the examining division held that the subject-matter of the claims of the main request and auxiliary request 1, both filed with the letter dated 9 November 2018, was "*excluded from patentability pursuant to Article 53(b) EPC and Rule 28(2) EPC*" (point 4 of the decision).
- III. With the statement of grounds of appeal, the appellant submitted a set of claims of a new main request.
- IV. In two communications, the board raised concerns regarding admittance of the newly filed main request, *inter alia* because the claims comprised "*substantial amendments*" which "*do not [...] represent a reaction to the appealed decision*".
- V. With a letter dated 23 October 2020, the appellant submitted sets of claims of a main request and an auxiliary request 1, corresponding to the requests that had been considered in the decision under appeal.

The appellant stated that "*[t]he claims on file are thus the claims as filed on 03 May 2016 (and maintained with Applicant's submissions of 09 November 2018), i.e. the claims of the MR and AR1 as refused by the ED,*

*because the impugned decision to refuse was based on these claim requests."*

The appellant submitted further that *"MR and AR1, as refused by the Examining Division, are part of these proceedings."*

The appellant also stated that *"the Claim Request filed with the Grounds of Appeal on 18 January 2019 was unintentionally called "Main request" [...]. It was intended to be a further auxiliary request."*

VI. In a further communication in reply to the appellant's submission, the board stated as follows: *"The board is not in the position to assess the true intention of the appellant at the time the appeal was filed. The appellant has defined the claim request [...] as "main request". Absent any express indication to the contrary in the statement of grounds of appeal, the only interpretation which appears reasonable to the board is that this main request replaces the previous main request and auxiliary request underlying the decision under appeal."*

The board therefore further stated *"that the main request and auxiliary request 1 submitted with letter of 23 October 2020 constitute an amendment to the appellant's appeal case after it has filed its grounds of appeal. Such an amendment may be admitted only at the discretion of the Board (Article 13(1) RPBA)."*

The board informed the appellant that it was inclined to admit the main request and the auxiliary request into the appeal proceedings, and asked the appellant *inter alia* to clarify the status of the previous main request.

VII. In response, the appellant clarified that its main request and auxiliary request 1 were the sets of claims filed with the letter of 23 October 2020, and that the main request filed with the statement of grounds was auxiliary request 2.

VIII. Claim 1 of the main request reads:

"1. A diploid, fertile, self-compatible and essentially homozygous potato line comprising plants having an average tuber yield expressed in grams of fresh weight of at least 200 grams per plant, wherein at least 25% of the plants of said line produce fertile seed-carrying berries, wherein the term essentially homozygous indicates that at least 50% of the genetic loci in the genome of a plant of said potato line are homozygous, and wherein said potato line is of the species *Solanum tuberosum* or *Solanum tuberosum* comprising introgression segments of other tuber-bearing *Solanum* species crossable to *Solanum tuberosum*."

IX. The appellant's arguments, where relevant to the present decision, can be summarised as follows.

*Admittance (Article 13(1) RPBA 2020)*

The main request and auxiliary request 1 underlying the decision under appeal were not withdrawn. They were thus part of the appeal proceedings. The new claim request submitted with the statement of grounds of appeal had unintentionally been called "main request", but it was actually intended to be a further auxiliary request.

*Exceptions to patentability (Article 53(b) EPC)*

In view of decision G 3/19 of the Enlarged Board of Appeal, the decision to refuse the application on the basis of Article 53(b) EPC could not be maintained, as it had been filed prior to 1 July 2017. This decision should thus be set aside.

- X. The appellant requested that the decision of the examining division be set aside and that the application be remitted to the examining division for further prosecution.

**Reasons for the Decision**

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

*Main request*

*Admittance (Article 13(1) RPBA 2020)*

2. The current main request was submitted with a letter of 23 October 2020, i.e. after the statement of grounds of appeal had been filed (see section V above). Consequently, it constitutes an amendment to the appellant's appeal case. Such an amendment may be admitted only at the discretion of the board (Article 13(1) RPBA 2020).
3. The claims of the present main request overcome the issues raised by the board with respect to admittance of the claim request submitted with the statement of grounds of appeal. Further, these claims are identical to the claims of the main request on which the examining division's decision was based. Therefore,

they do not confront the board with new issues not underlying the appealed decision.

4. The board sees no reason to hold the main request filed with letter of 23 October 2020 inadmissible, and therefore decided to admit the main request into the appeal proceedings.

*Exceptions to patentability (Article 53(b) EPC)*

5. The sole reason given by the examining division for refusing the application was that the subject-matter of the claims of the main request was excluded from patentability pursuant to Article 53(b) EPC and Rule 28(2) EPC.
6. In opinion G 3/19 of 14 May 2020, the Enlarged Board of Appeal held (see Conclusion) that:

*"Taking into account developments after decisions G 2/12 and G 2/13 of the Enlarged Board of Appeal, 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 or if the claimed process features define an essentially biological process."*

7. However, the Enlarged Board of Appeal also held (ibid.) that:

*"This negative effect does not apply to European patents granted before 1 July 2017 and European patent*



*applications which were filed before that date and are still pending."*

8. Accordingly, as the present application was filed before 1 July 2017 and is still pending, 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.
  9. Furthermore, the board considers that the provisions applicable before 1 July 2017, i.e. Article 53(b) EPC, as interpreted by decisions G 2/12 and G 2/13 (OJ EPO, 2016, A27 and A28), do not exclude the subject-matter of the claims of the main request from patentability either.
  10. The appeal is thus allowable.
- Remittal (Article 111(1) EPC)*
11. 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.
  12. It is the primary function of appeal proceedings to give a judicial decision upon the correctness of the decision under appeal (see Case Law of the Boards of Appeal, 9th edition 2019, section V.A.1.1, second paragraph and decisions referred to there).
  13. As explained in point 5. above, the sole reason for refusing the application was that the subject-matter of the claims 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 6. to 10. above).

14. Accordingly, in line with the appellant's request, the board decides to remit the case to the examining division for further prosecution.

## Order

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

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

The Registrar:

The Chair:



I. Aperribay

G. Alt

Decision electronically authenticated