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**Datasheet for the decision  
of 22 July 2020**

**Case Number:** T 0452/19 - 3.3.04

**Application Number:** 13184376.5

**Publication Number:** 2708115

**IPC:** A01H5/10, A01H1/04, C12Q1/68,  
C12N15/11

**Language of the proceedings:** EN

**Title of invention:**

Brassica oleracea plants with improved nutritional value

**Applicant:**

Seminis Vegetable Seeds, Inc.  
Plant Bioscience Limited

**Headword:**

Brassica oleracea plants with improved nutritional value/  
SEMINIS VEGETABLE SEEDS, PLANT BIOSCIENCE

**Relevant legal provisions:**

EPC Art. 53(b), 111(1)  
EPC R. 28(2)

**Keyword:**

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

**Decisions cited:**

G 0003/19, T 1242/06, T 1384/06

**Catchword:**



**Beschwerdekammern**

**Boards of Appeal**

**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

**Case Number: T 0452/19 - 3.3.04**

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.04**  
**of 22 July 2020**

**Appellant:** Seminis Vegetable Seeds, Inc.  
(Applicant 1) 800 N. Lindbergh Blvd.  
St. Louis MO 63167 (US)

**Appellant:** Plant Bioscience Limited  
(Applicant 2) Norwich Research Park,  
Colney Lane  
Norwich,  
Norfolk NR4 7UH (GB)

**Representative:** Uexküll & Stolberg  
Partnerschaft von  
Patent- und Rechtsanwälten mbB  
Beselerstraße 4  
22607 Hamburg (DE)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 27 September  
2018 refusing European patent application No.  
13184376.5 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chair** G. Alt  
**Members:** R. Morawetz  
L. Bühler

## Summary of Facts and Submissions

- I. The appeal filed by the applicants (appellants) lies from the examining division's decision refusing European patent application No. 13 184 376.5, filed on 13 September 2013. The title of the application is "*Brassica oleracea plants with improved nutritional value*".
- II. In the decision under appeal the examining division held that the subject-matter of the set of claims of the main request filed by letter dated 17 August 2018 was directed to "*plants which are exclusively obtained by means of an essentially biological process, and therefore are excluded from patentability under Article 53(b) EPC (Rule 28(2) EPC)*" (see point 18 of the Reasons).
- III. With the statement of grounds of appeal, the appellants maintained the set of claims of the main request at issue in the decision under appeal as their sole claim request.

Claim 1 of that request reads as follows:

"1. A *Brassica oleracea* plant comprising a *Myb28* allele from *Brassica villosa* and lacking an ELONG allele from *Brassica villosa* genetically linked to said *Myb28* allele, wherein the *Myb28* allele confers elevated glucosinolates when compared to a plant that lacks the *Myb28* allele."

- IV. In their statement of grounds of appeal the appellants requested that the decision under appeal be set aside and that a patent be granted on the basis of the set of

claims of the main request filed by letter dated 17 August 2018. In the event that the board came to the conclusion that the subject-matter claimed in that main request met the requirements of Article 53(b) EPC, but that a patent could not be granted, because examination of the substantive patentability requirements of the EPC had not been completed by the examining division, they instead requested that the application be remitted to the examining division for further examination. Oral proceedings were requested *"in case the Board of Appeal should not intend to comply with the previous requests in the written proceedings"* (see point 4 of the statement of grounds of appeal).

- V. In the statement of grounds of appeal it was furthermore submitted that in *"the summons to oral proceedings before the examining division (ED), no objections other than objections of non-compliance with the requirements of Article 53(b) EPC in view of new Rule 28(2) EPC were raised against the subject matter claimed in the MR by the ED. In fact none of the examination reports [...] raises objections other than non-compliance with the requirements of Article 53(b) EPC in view of the subject-matter of the MR."*

*This shows that the ED was of the opinion that the subject matter claimed meets all other requirements of the EPC"* (see point 3).

- VI. On 22 June 2020 the rapporteur contacted the appellants' representative to inform him that the board intended to set aside the decision under appeal and to remit the case to the examining division for further prosecution and that the board was not inclined to accede to the appellants' request that the case be

remitted to the examining division with an order to grant a patent on the basis of the set of claims of the main request filed by letter of 17 August 2018, since it could not be concluded that the examination of the substantive patentability requirements of the EPC had been completed by the examining division.

The representative confirmed that point 4 of the statement of grounds of appeal was to be understood to mean that oral proceedings were not requested in the event that the board intended to comply with any of the appellants' requests.

### **Reasons for the Decision**

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

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

2. 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."*

3. 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."*

4. Accordingly, as the present application was filed before 1 July 2017 and is still pending (see section I), the subject-matter of the claims of the sole claim request is not excluded from patentability pursuant to Article 53(b) EPC in conjunction with Rule 28(2) EPC.
5. The appeal is thus allowable.

*Remittal (Article 111(1) EPC)*

6. 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.

*Remittal for granting of a patent*

7. The sole reason given by the examining division for refusing the main request was that its subject-matter was excluded from patentability pursuant to Article 53(b) EPC and Rule 28(2) EPC.
8. The appellants submitted that neither the summons nor any of the examination reports issued by the examining division for the present application raised objections other than non-compliance of the claimed subject-matter

with the requirements of Article 53(b) EPC and that this showed that the examining division was of the opinion that the claimed subject-matter met all the other requirements of the EPC (see section V. above).

9. The board notes that the assessment as to whether claimed subject-matter is excluded from patentability normally precedes the assessment of other substantive requirements such as novelty or inventive step (see also decision T 1384/06, point 5 of the Reasons; and decision T 1242/06, point 68 of the Reasons).
10. Accordingly, in the board's judgement, in this case it cannot be concluded from the absence of objections other than those pursuant to Article 53(b) EPC and Rule 28(2) EPC in the examination reports that the examining division considered all the patentability requirements of the EPC to be fulfilled. Hence, the appellants' request that the case be remitted to the examining division with the order to grant a patent cannot be allowed.

*Remittal for further prosecution*

11. 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).
12. As explained in point 7 above, the sole reason for refusing the main request was that its subject-matter was excluded from patentability pursuant to Article 53(b) EPC and Rule 28(2) EPC and the board reviews this decision (see point 2 to 5 above).



13. Accordingly, in line with the appellants' further request, the board decides to remit the case to the examining division for further prosecution.

## 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:



A. Nielsen-Hannerup

G. Alt

Decision electronically authenticated