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**Datasheet for the decision
of 2 October 2020**

Case Number: T 0959/19 - 3.3.04

Application Number: 11186853.5

Publication Number: 2412232

IPC: A01H5/06, A01H5/10

Language of the proceedings: EN

Title of invention:

Low pungency, long day onion

Applicant:

Seminis Vegetable Seeds, Inc.

Headword:

Onion seed/SEMINIS

Relevant legal provisions:

EPC Art. 53(b), 123(2), 111(1)
EPC R. 28(2)

Keyword:

Amendments - allowable (yes)
Exceptions to patentability - (no)
Remittal to the department of first instance - (yes)

Decisions cited:

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

Catchword:



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Case Number: T 0959/19 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 2 October 2020

Appellant: Seminis Vegetable Seeds, Inc.
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St. Louis MO 63167 (US)

Representative: Uexküll & Stolberg
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 13 November
2018 refusing European patent application No.
11186853.5 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman B. Claes
Members: B. Rutz
L. Bühler

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. 11186853.5 entitled "*Low pungency, long day onion*".
- II. In the decision under appeal the examining division found that claim 1 of the main request contravened the requirements of Article 123(2) EPC. In addition, the subject-matter of claims 1 to 16 was considered to be excepted from patentability by virtue of Article 53(b) EPC and Rule 28(2) EPC.
- III. With their statement setting out the grounds of appeal, the appellant submitted claims of new auxiliary requests 1 and 2 in addition to the main request dealt with in the decision under appeal.

Claim 1 of the main request reads:

"1. A container of hybrid onion seeds wherein hybrid onion plants grown from greater than 50% of said hybrid onion seeds require 14 or more contiguous hours of daylight to initiate bulb formation and comprise bulbs having an average pyruvic acid development (PAD) value of less than 5.5 μ M pyruvic acid/gram fresh weight (μ M/g FW pyruvate) at harvest, wherein said bulbs are capable of being stored for two months under suitable conditions without an increase of greater than 20% in their average PAD value, and wherein said average PAD value is measured from a population of five or more onion bulbs."

- IV. The board issued a communication pursuant to Rule 100(2) EPC and informed the appellant of its preliminary opinion on the appeal. The new understanding/interpretation of Article 53(b) EPC given in opinion G 3/19 of the Enlarged Board of Appeal of 14 May 2020 had no retroactive negative effect on the present European patent application. Furthermore, the subject-matter of the newly submitted claims appeared not to extend beyond the content of the application as filed.
- V. With a letter dated 17 September 2020, the appellant requested remittal of the case to the examining division for further prosecution *"without a hearing before the Board"* and stated that *"[t]he request for a hearing is maintained only in case the Board should intend to dismiss the appeal in its entirety"*.

Reasons for the Decision

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

Main request - claims 1 to 16
Amendments (Article 123(2) EPC)

2. In the decision under appeal the wording "wherein said average PAD value is measured from a population of five or more onion bulbs" in claim 1 was found to contravene the requirements of Article 123(2) EPC. In the statement of grounds of appeal the appellant referred to paragraphs [0043], [0044] and [0063] of the (parent) application as filed as basis.
3. In paragraph [0043] it is stated that *"pungency may be measured as an average PAD measurement in a population*

of onion bulbs". The same paragraph notes "*a population of onion bulbs may be 5, 10, 15, 20, 25, 30, 35, 40, 45, 50, or more onion bulbs*". The board interprets this as a disclosure of the above indicated feature. This view is supported by the disclosure of open-ended ranges of the number of onion bulbs in paragraphs [0044] and [0063].

4. The claims therefore comply with the requirements of Article 123(2) EPC.

Exceptions to patentability (Article 53(b) EPC)

5. In view of the provisions made by the Enlarged Board of Appeal for European patent applications pending before 1 July 2017, the new interpretation of Article 53(b) EPC given in opinion G 3/19 of 14 May 2020, being consequential to the introduction of new Rule 28(2) EPC on 1 July 2017, has no retroactive negative effect on the present European patent application (see opinion G 3/19, points XXVIII and XXIX).
6. Furthermore, Article 53(b) EPC, as interpreted by decisions G 2/12 and G 2/13 (OJ EPO 2016, A27 and A28), does not exclude the subject-matter of claims 1 to 16 from patentability.
7. The board thus considers the appeal allowable.

Remittal (Article 111(1) EPC)

8. 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.

9. 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).
10. As explained in point II. above, the reasons for refusing the application were that the amendment of claim 1 contravened the requirements of Article 123(2) EPC, and the subject-matter of claims 1 to 16 was excepted from patentability by virtue of Article 53(b) EPC and Rule 28(2) EPC. The board reviews this decision (see points 2. to 7. above).
11. Accordingly, in line with the appellant's request, the board remits 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 Chairman:



I. Aperribay

B. Claes

Decision electronically authenticated