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**Datasheet for the decision
of 27 July 2020**

Case Number: T 1028/19 - 3.3.04

Application Number: 14766735.6

Publication Number: 3046410

IPC: A01H5/08, C07K14/415, C12Q1/68

Language of the proceedings: EN

Title of invention:
Plants with an intense fruit phenotype

Applicant:
Nunhems B.V.

Headword:
Plants with an intense fruit phenotype/NUNHEMS

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

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

Decisions cited:
G 0003/19

Catchword:



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Case Number: T 1028/19 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 27 July 2020

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 23 November
2018 refusing European patent application No.
14766735.6 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 applicant (appellant) lies from the examining division's decision refusing European patent application No. 14 766 735.6, filed on 18 September 2014. The title of the application is "*Plants with an intense fruit phenotype*".
- II. In the decision under appeal the following grounds for refusing the application were given by the examining division:

"The present application is refused according to Article 97(2) EPC on the grounds of claiming subject-matter excluded from patentability following Article 53(b) and Rule 28(2) EPC because claims 1-8, 11 and 12 of the main request; claim 11 of the auxiliary request 1; claims 1-8, 11 and 12 of the auxiliary request 3 and claims 1-8, 11 and 12 of the auxiliary request 4 relate to a plant exclusively obtained by an essentially biological process.

Moreover, the present application is refused according to Article 97(2) EPC on the grounds of claiming subject-matter excluded from patentability following Article 53(b) EPC because claim 10 of the main request; claim 10 of the auxiliary request 1; claim 2 of the auxiliary request 2; claim 10 of both the auxiliary requests 3 and 4 implicitly comprises an essentially biological process for the production of plants.

The present application is refused according to Article 97(2) EPC on the grounds of lack of clarity in the sense of Article 84 EPC because claim 10 of the main request; claim 10 of the auxiliary request 1;

claim 2 of the auxiliary request 2; claim 10 of both the auxiliary requests 3 and 4 lack all the technical features essential to the definition of the invention." (see points 30 to 32).

- III. With the statement of grounds of appeal, the appellant filed sets of claims of a new main request and of new auxiliary requests 1 to 4.
- IV. The set of claims of the new main request and of new auxiliary requests 1 to 4 differ from the set of claims of the main request and of auxiliary requests 1 to 4 underlying the decision under appeal in that claim 10 (or the claim corresponding thereto) has been cancelled and the remaining claims renumbered accordingly.

Claim 1 of the new main request reads as follows:

"1. A plant comprising a reduced amount, activity or function of AGL11-like protein, wherein the plant has an *intense* fruit phenotype and wherein the plant is a member of plant family *Cucurbitaceae* and the AGL11-like protein is an ortholog of TAGL11-like protein represented by SEQ ID NO: 3 and the *intense* fruit phenotype is a phenotype wherein the inner fruit tissue is more solid than in normal fruits;
or
wherein the plant is of species *Solanum lycopersicum* and wherein the AGL11-like protein has at least 90% amino acid sequence identity to SEQ ID NO: 3 and wherein the *intense* fruit phenotype is a phenotype wherein the locular gel in the fruit is replaced by fleshy tissue;
characterized in that the plant is not a *Solanum lycopersicum* plant having a deletion from

nucleotide 1042 to nucleotide 637 upstream of the ATG start codon of SEQ ID NO: 1."

- V. In their statement of grounds of appeal the appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the set of claims of the new main request or, alternatively, on the basis of one of the set of claims of new auxiliary requests 1 to 4, or further alternatively "*that the application be remitted to the first instance ED with the order that the claims of the new main request or those of the new auxiliary requests are in compliance with Article 53(b) EPC*". Furthermore the appellant requested the refund of the appeal fee and oral proceedings "*in the event the Board contemplates a decision that does not fully meet any of our requests.*"
- VI. On 22 June 2020 the rapporteur contacted the appellant's representative to enquire whether the board had correctly understood the appellant's requests and to inform him that the board intended to reject the appellant's request for refund of the appeal fee.
- VII. With letter dated 9 July 2020 the appellant confirmed that the appellant requests "*that the decision under appeal be set aside and the case be remitted to the examining division for further prosecution on the basis of the set of claims of the new main request filed with the statement of ground of appeal, with the order that the claims of this request are not excluded from patentability pursuant to Article 53(b) EPC*". The request for the refund of the appeal fee was withdrawn and the appellant noted that "*it is our understanding that oral proceedings would no longer be required for the appeal proceedings to be concluded.*"

Reasons for the Decision

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

New main request

Exceptions to patentability (Article 53(b) EPC)

2. As a result of the cancellation of claim 10, the sole remaining ground of the examining division's decision to refuse the application is that the claimed subject-matter falls under the exclusions from patentability as defined by Rule 28(2) EPC and that, consequently, the application does not meet the requirements of Article 53(b) EPC (see section II).
3. 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."

4. 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."

5. 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 new main request is not excluded from patentability pursuant to Article 53(b) EPC in conjunction with Rule 28(2) EPC.
6. The appeal is thus allowable.

Remittal (Article 111(1) EPC)

7. 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.
8. 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).
9. The sole reason given by the examining division for refusing the set of claims of the main request is not applicable to the subject-matter of the set of claims of the new main request (see points 2 and 6 above) and the board reviews this decision. The examining division

has not taken an appealable decision on any other requirement for patentability with respect to the set of claims of the new main request.

10. 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:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution on the basis of the set of claims of the new main request filed with the statement of grounds of appeal.

The Registrar:

The Chair:



A. Nielsen-Hannerup

G. Alt

Decision electronically authenticated