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Datasheet for the decision of 30 August 2020

Case Number: T 1030/19 - 3.3.04

Application Number: 10793168.5

Publication Number: 2512217

IPC: A01H1/08, A01H5/12

Language of the proceedings: EN

Title of invention:
Tetraploid corn salad

Applicant:
Nunhems B.V.

Headword:
Tetraploid corn salad/NUNHEMS

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

Keyword:
Exceptions to patentability - (no)

Decisions cited:
G 0003/19

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

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 1030/19 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 30 August 2020

Appellant: (Applicant)	Nunhems B.V. 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 28 November 2018 refusing European patent application No. 10793168.5 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairwoman	G. Alt
Members:	A. Chakravarty
	L. Bühler

Summary of Facts and Submissions

I. The patent applicant (appellant) filed an appeal against the examining division's decision to refuse European patent application No. 10 793 168.5, filed as an international application under the PCT, on 16 December 2010. The title of the application is "*Tetraploid corn salad*".

II. In the decision under appeal, the examining division held that the subject-matter of the set of claims of the main request and of auxiliary requests 1 to 4 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 re-filed the set of claims of the main request at issue in the decision under appeal and also re-filed the claim requests as filed on 2 February (auxiliary request 4) and 9 October 2018 (auxiliary requests 1 to 3). The appellant's requests, as understood by the board, were:

- that the appeal fee be refunded;

- that decision under appeal be set aside and that a patent be granted on the basis of the main claim request as filed on 3 August 2016, re-filed with the statement of grounds of appeal;

- alternatively, that the application be remitted to the examining division with the order that the claims of the main request are in compliance with Article 53(b) EPC;

- alternatively, that a patent be granted on the basis of one of the claim requests as filed on 2 February and 9 October 2018, which are re-filed with the statement of grounds of appeal as auxiliary requests 1 to 4;

- alternatively, that the application be remitted to the examining division with the order that the claims of these auxiliary requests are in compliance with Article 53(b) EPC.

- that the case be handled on an expedited basis; and

- finally, that oral proceedings be appointed in case a decision is taken that does not fully meet any of the requests.

IV. The board issued a communication pursuant to Rule 100(2) EPC in which it informed the appellant that it was of the view that "*Since the present application was filed before 1 July 2017 and is still pending, the subject-matter of the set of claims of the main request is not excluded from patentability pursuant to Article 53(b) EPC. As the board understands the opinion of the Enlarged Board of Appeal, Rule 28(2) EPC also does not exclude the patentability in the present case*".

The board concluded that it considered that the decision under appeal should be set aside.

The board further stated that it envisaged allowing the appellant's third request, i.e. setting the decision under appeal aside and remitting the case to the examining division for further prosecution on the basis of the set of claims of the main request filed with the statement of grounds of appeal but that it intended to

reject the appellant's request for reimbursement of the appeal fee.

V. The appellant replied to the board's communication with a letter dated 26 August 2020. In this letter the appellant stated: "*We herewith withdraw our request for the refund of the appeal fee and we also withdraw our request for oral proceedings. Please remit the case to the examining division for further prosecution on the basis of the set of claims of the main request filed with the statement of grounds of appeal*".

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 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" (*ibid*).

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 main 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.

7. The sole reason given by the examining division for refusing the application was that the subject-matter of the set of claims of the main request and of auxiliary requests 1 to 4 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.

8. The examining division did not take a decision on any other requirement for patentability with respect to the set of claims of any claim request, including the present main request.

9. Accordingly, in line with the appellant's request, the board has decided 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 main request re-filed with the statement of grounds of appeal.

The Registrar: The Chair:

I. Aperribay G. Alt

Decision electronically authenticated