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| Veröffentlichung im Amtsblatt | Ja/Nein |
| Publication in the Official Journal | Yes/No |
| Publication au Journal Officiel | Oui/Non |

Aktenzeichen / Case Number / N^o du recours : T 118/87
Anmeldenummer / Filing No / N^o de la demande : 81 300 578.2
Veröffentlichungs-Nr. / Publication No / N^o de la publication : 0 034 470

Bezeichnung der Erfindung: Genetically engineered micro-organisms for massive
Title of invention: production of amylolytic enzymes and process for
Titre de l'invention : preparing same

Klassifikation / Classification / Classement : C12N 15/00

ENTSCHEIDUNG / DECISION
vom / of / du 25 August 1989

Anmelder / Applicant / Demandeur : CPC International Inc., USA

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Amylolytic enzymes - CPC INT.

EPO/EPC/CBE Article 83 EPC
Rule 28(2), 3rd sentence, EPC

Schlagwort / Keyword / Mot clé : "Deposit of a micro-organism"
"Identity of applicant and depositor"
"Parent company and subsidiary"

Leitsatz / Headnote / Sommaire

I. Rule 28(1) EPC stipulates that a culture of the micro-organism must have been deposited with a recognised depository institution not later than the date of filing of the application.

II. The applicant of an invention for a microbiological process and the depositor of a micro-organism must in principle be one and the same. Exceptionally it is justified to consider the parent company and subsidiary as one entity for the purposes of Rule 28 EPC, if the parent company has full control of the deposits made by the subsidiary company.

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Boards of Appeal

Chambres de recours

Case Number : T 118/87- 3.3.2



D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 25 August 1989

Appellant : CPC International Inc.
International Plaza
Englewood Cliffs, N.Y. 07632
US

Representative : P. Pennant
Stevens, Hewlett and Perkins
5 Quality Court
Chancery Lane
London WC2 A1HZ
GB

Decision under appeal : Decision of Examining Division 023
of the European Patent Office
dated 11 November 1986 refusing
European patent application
No. 81 300 578.2 pursuant to
Article 97(1) EPC

Composition of the Board :

Chairman : P. Lançon
Members : R. Schulte
U. Kinkeldey

Summary of Facts and Submissions

- I. European patent application No. 81 300 578.2 filed on 12 February 1981 and published under No. 34 470 was refused by a decision of the Examining Division dated 11 November 1986.
- II. The application relates to genetically engineered micro-organisms which produce amylolytic enzymes and to processes for preparing them. Claims 4, 7 and 11 refer to micro-organisms deposited with the National Collection of Industrial Bacteria (NCIB), a depositary institution.
- III. The micro-organisms were deposited with the NCIB not by the appellant, CPC International Inc., USA, but by CPC Europe Ltd., Brussels.
- IV. The contested decision of 11 November 1986 refused the application on the grounds that the deposits effected with the NCIB did not comply with the requirements of Rule 28 EPC. The applicant had failed to show that the micro-organisms deposited with the NCIB had been made available to the public in accordance with Rule 28(3) to (8) EPC since applicant and depositor were different legal entities, which meant the applicant was unable to guarantee that the deposited cultures were available to any person upon request as required by Rule 28(3) EPC. The Examining Division therefore refused the application under Article 97 EPC.
- V. The applicant appealed against this decision on the grounds that Rule 28(1) EPC did not require the deposit to be effected by the applicant and that any third party could act as depositor. Under Rule 28(2), 3rd sentence, EPC, an indication of the depositary institution and the file number of the culture deposit pursuant to Rule 28(1)(c) EPC was

considered as constituting the unreserved and irrevocable consent of the applicant to the deposited culture being made available to the public. An applicant could not be asked to do more; in particular, he could not be asked to produce further evidence that samples of the deposit were available to the public.

Furthermore the depositor, CPC Europe Ltd., was a wholly owned subsidiary of the applicant and thus obliged to comply with all the applicant's instructions, especially those relating to the release of deposited cultures. The applicant was authorised to take decisions regarding the issue of samples deposited by CPC Europe Ltd. In evidence the appellant submitted an affidavit from Ellen Trevors dated 5 March 1987 showing that CPC Europe Ltd. acts as co-ordinator for the appellant in Europe and in particular is empowered to deposit with the NCIB micro-organisms of importance to patent applications filed by the applicant.

In 1982 and 1985 samples of the deposited cultures were issued to requesters in four instances.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is admissible.
2. In the contested decision the patent application was refused under Article 97 EPC because it did not comply with Rule 28 EPC, which requires the deposited culture to be made available to the public. This requirement was deemed not to have been met on the grounds that applicant and depositor were different entities.

The appellant, on the other hand, takes the view that the identity of applicant and depositor is not an issue. And indeed, it has to be conceded that the wording of Rule 28 EPC does not explicitly state whether applicant and depositor have to be one and the same.

Rule 28(1) EPC merely stipulates that a culture of the ~~micro-organism must have been deposited with a recognised~~ depository institution not later than the date of filing of the application, a formulation which does not specify whether the depositor also has to be the applicant.

Nevertheless Rule 28(1) EPC does lay down that the invention can only be regarded as being disclosed as prescribed in Article 83 EPC if a deposit has been effected not later than the date of filing of the application. This means that the deposit is no more than a special form of disclosure. Under Article 83 EPC, however, the invention must be disclosed in the European patent application, the drafting of which is naturally the responsibility of the applicant alone. Since the deposit is only a surrogate description of the invention, which cannot be described otherwise, it could be inferred that, being a substitute for the description, the deposit also has to be undertaken by the applicant. This is not an inevitable conclusion, however, since for the purposes of disclosure an applicant may also refer to a micro-organism deposited by a third party and made available to the public before the application was filed. In this event it is not necessary for the applicant to deposit the micro-organism anew.

4. The appellant bases his view primarily on Rule 28(2), 3rd sentence, EPC.

This stipulates that an indication of the name of the depositary institution and the file number of the culture deposit pursuant to Rule 28(1)(c) EPC is considered as constituting the unreserved and irrevocable consent of the applicant to the deposited culture being made available to the public in accordance with Rule 28 EPC. Rule 28(2), 3rd sentence, EPC is thus a legal fiction whose purpose is to ensure that a deposited culture required for disclosure of a micro-biological invention is made available to the public and that, as a result, microbiological inventions are made as readily available to the public as any other invention for which a patent application is filed and which can be described using words alone in such a way that it can be carried out by a skilled person. This provision, then, is clearly intended to enable third parties to reproduce micro-biological inventions involving a micro-organism which cannot be described. This is done by means of a strictly regulated procedure under which third parties obtain samples of the micro-organism on request. The consent of the party depositing the culture with the depositary institution is an essential prerequisite for the issue of samples to third parties. Such consent is granted under the legal fiction of Rule 28(2), 3rd sentence, EPC, so that the specific consent of the applicant to the issue of a culture is not normally required.

5. The legal fiction of Rule 28(2), 3rd sentence, EPC can only fulfil its legal purpose, however, if applicant and depositor are one and the same. If a third party - not the applicant - has deposited the culture, that legal fiction ceases to apply since consent actually granted by the applicant or assumed under the legal fiction cannot oblige the depositor who is not also the applicant to make the deposited culture available to the public. The power to

dispose of a culture deposited with a depositary institution always belongs to the depositor alone. The fiction of Rule 28(2), 3rd sentence, EPC therefore applies only if applicant and depositor are one and the same. The resulting logical need for applicant and depositor to be identical within the meaning of that provision is expressed very clearly in the German version, which expressly states that the communication of the information shall be considered as constituting the consent of the applicant to the culture deposited ("von ihm") being made available to the public.

6. In principle, therefore, applicant and depositor must be one and the same. If this is not the case, suitable measures must be taken to ensure that the deposited culture is nevertheless available to the public in accordance with Rule 28 EPC on the date the application is filed. As the Examining Division has rightly said, the European Patent Office must check that this requirement has been met; if not, the invention in question has not been sufficiently disclosed within the meaning of Article 83 EPC since a skilled person cannot carry it out using only the description in words. The application must then be refused.

7. The question, however, is whether in the present case this basic requirement that applicant and depositor be identical for the purposes of Rule 28 EPC has not nevertheless been met despite applicant and depositor being two legally independent trading companies. The Board attached particular importance to the fact that the companies are a parent and subsidiary and that the depositor (subsidiary) is wholly owned by the applicant (parent). The appellant/applicant has convinced the Board that the depositor - as its subsidiary - is obliged to comply with all its instructions, in particular those relating to deposits and the release of

samples of deposited cultures. Furthermore - as the affidavit submitted shows - the parent company had authorised the subsidiary to deposit micro-organisms on its behalf for patent applications which the parent company intended to file. This demonstrates that, although the subsidiary is the formal depositor, the parent company alone has control of the deposits. These special circumstances therefore seem, exceptionally, to justify considering the parent company and subsidiary as one entity for the purposes of Rule 28 EPC since the applicant has full control of the deposits and the actual depositor has acted only as executive organ for the applicant.

8. If the applicant alone has control of the deposited cultures their availability to the public is established. Admittedly, the micro-organisms were initially deposited with the NCIB on condition that samples of the deposited cultures could be issued to third parties only with the depositor's consent. This deposit, however, was converted before the date of filing - 12 February 1981 - to a deposit in accordance with Rule 28 EPC. In a letter dated 17 November 1980 the depositary institution informed the depositor that, to ensure equal treatment and avoid misunderstandings, it was issuing receipts for existing deposits under its agreement with the European Patent Office. The depositor accordingly obtained receipts for the micro-organisms which are the subject of the present patent application. This made it clear that from that time the deposit was in accordance with the agreement between the European Patent Organisation and culture collections for the deposit of micro-organisms (cf. OJ EPO 1978, 301 and 1980, 4). Point 18 of this agreement states that the authority (i.e. culture collection) agrees to furnish samples of the deposited micro-organisms to persons legally entitled in accordance

with Annex III of the agreement. Annex III, point 2, states that the authority, upon request to it by any person, shall furnish to that person a sample of a culture of any deposited micro-organism provided that the Office has certified on the request form that the requirements of Rule 28 EPC have been complied with and that the person making the request is entitled to obtain the sample. This ensures that third parties can obtain samples of deposited micro-organisms. Thus the requirement that deposited cultures must be available to the public in accordance with Rule 28 EPC is met.

9. For these reasons the contested decision is to be set aside since the fifteen NCIB deposits are available to the public. The case is therefore to be remitted to the Examining Division so that examination proceedings can be resumed.

Order

1. The Examining Division's decision dated 11 November 1986 is set aside.
2. The case is remitted to the Examining Division for resumption of examination proceedings.

The Registrar:

The Chairman:

M. Beer

P. Lançon