

Veröffentlichung im Amtsblatt
Publication in the Official Journal
Publication au Journal Officiel

Ja/Nein
Yes/No
Oui/Non



Aktenzeichen / Case Number / N° du recours : T 239/87 - 3.3.2

Anmeldenummer / Filing No / N° de la demande : 83 106 389.6

Veröffentlichungs-Nr. / Publication No / N° de la publication : 98 533

Bezeichnung der Erfindung: Process for production of glucosone
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement : C 12P 7/26

ENTSCHEIDUNG / DECISION

vom / of / du 11 February 1988

Anmelder / Applicant / Demandeur : Nabisco Brands, Inc.

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Micro-organisms/Nabisco

EPÜ / EPC / CBE Article 83, Rule 28

Kennwort / Keyword / Mot clé : "Micro-organisms, deficiency in deposit"

Leitsatz / Headnote / Sommaire

Europäisches
Patentamt
Beschwerdekammern

European Patent
Office
Boards of Appeal

Office européen
des brevets
Chambres de recours



Case Number : T 239 /87 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 11 February 1988

Appellant : Nabisco Brands, Inc.
Nabisco Brands Plaza
Parsippany New Jersey 07054
USA

Representative : Dr. H.-A. Brauns
Hoffman, Eitle & Partner
Arabellastraße 4
D-8000 München 81

Decision under appeal : Decision of Examining Division 023 of the European
Patent Office dated 30 March 1987 refusing
European patent application No. 83 106 389.6
pursuant to Article 97(1) EPC

Composition of the Board :

Chairman : P. Lançon
Members : E. Persson
A. Nuss

Summary of Facts and Submissions

- I. European patent application No. 83 106 389.6 was filed on 30 June 1983, claiming priority from US application No. 393 850 filed on 30 June 1982 on the basis of which US patent 4 442 207 was issued on 10 April 1984. The application was related to a process for production of glucosone involving, inter alia, the use of three micro-organisms of the Basidiomycetes class identified by their deposit numbers (NRRL 15093, 15094 and 15095). It was published on 18 January 1984.

- II. The application was refused by a decision of the Examining Division dated 30 March 1987 pursuant to Article 97(1) EPC. The reason given for the refusal was that the said micro-organisms had not been properly deposited under Rule 28 EPC and, as a consequence, not been available to the public without any restrictions as required by Rule 28(3) EPC from the date of publication of the European patent application, i.e. on 18 January 1984, but only on 10 April 1984 when the cognate US patent was issued. The requirement for disclosure of the invention under Article 83 EPC was, therefore, not met.

- III. The applicant, appealing against this decision, submits essentially as follows:
 - (a) The micro-organisms in question were deposited with the Agricultural Research Culture Collection (NRRL), US Department of Agriculture, Science and Educational Administration, Illinois, USA, on 29 May 1982 in connection with the above priority US application and added to the permanent collection of micro-organisms maintained at that depositary institution.

- (b) It may be true that, according to the standard rules applied by NRRL, strains of the deposited organisms would not have been freely distributed to the public before the issuance of the US patent 4 442 207, i.e. on 10 April 1984. However, as appears from a letter dated 2 June 1982 from NRRL, access to such strains would, even before that date, have been granted upon receipt of written authorisation from the depositor and, furthermore, if such a distribution "under other circumstances" had been deemed "appropriate".

- (c) When a cognate European patent application is filed and published and access to deposited micro-organisms is mandated under Rule 28 EPC, this is clearly such an "appropriate circumstance" as just referred to warranting distribution of the organisms to the public even before the issuance of the US patent at stake. By filing such an application, the applicant implicitly accedes to the rules of the EPC.

- (d) During the relevant period between 18 January 1984 and 10 April 1984 no request from the public was actually made for access to the deposited micro-organisms, having such a request been made it had not been refused by the applicant who obviously otherwise had destroyed his chances of obtaining a European patent. A third party who had wanted to have access to the deposited organisms during this period could have obtained that by just writing a letter to the applicant who would then have authorised the release of the requested strains.

IV. At oral proceedings on 11 February 1988 the appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the claims presently on file (i.e. claims filed by letter of 6 December 1985). As a first auxiliary request it was requested that a

patent be granted on the basis of the claims as originally filed and as a second auxiliary request that a patent be granted on the basis of these claims subject to the deletion of all references in the application as filed to the deposited micro-organisms in question.

Reasons for the Decision

1. The appeal is admissible.
2. In order to meet the requirements of Article 83 in conjunction with Rule 28 EPC, a culture of a micro-organism, which is not available to the public and which cannot be described in the European application in such a manner as to enable the invention to be carried out by a man skilled in the art, must, inter alia, be deposited with a depositary institution recognised by the EPO not later than the date of filing of the application. Furthermore, such a deposited culture shall be available upon request to any person from the date of publication of the European patent application (Rule 28(3) EPC) subject to the observance of certain formal requirements (cf. Rule 28(7 and 8) EPC).
3. In the present case, the deposit was made on 29 May 1982, i.e. before the date of filing of the European application, with the Agricultural Research Culture Collection (NRRL; as to change of name, see OJ EPO 1987, 396) in the USA. This institution was, at that point of time, recognised by the EPO for the purpose of Rule 28 EPC both in its capacity as international depositary authority under the Budapest Treaty on the International Recognition of the Deposit of Micro-organisms for the Purposes of Patent Procedure (see OJ EPO 1981, 29) and on the basis of a special agreement with the EPO of 29 October 1979 (see OJ EPO 1980, 4; cf. OJ EPO 1983, 35, note 4).

4. However, the deposit was not accompanied by a written statement indicating that the deposit was made under the Budapest Treaty (as required under Rule 6.1(a)(i) of that treaty) or under Rule 28 EPC (as required under the special agreement referred to under paragraph 3 above; cf. OJ EPO 1980, 5, point 3, and OJ EPO 1978, 303, point 13(a)). This was obviously due to the fact that the deposit, when it was actually made, was primarily aimed at satisfying the requirements in the USA with regard to the US application No. 393 850 from which priority is claimed in the present case.

5. According to US practice a deposited micro-organism is normally not made available to the public without the consent of the depositor unless (and until) a US patent related to the deposit is granted. However, under the EPC-system a deposited organism shall always be made available to the public from the date of publication of the European patent application irrespective of whether or not a European patent will subsequently be granted and when such a grant becomes effective. When, in the present case, the publication of the European application was made on 18 January 1984, the corresponding US application was still pending and the US patent was not issued until 10 April 1984. This created a gap in time of almost three months.

6. The Board cannot accept the appellant's submission that the mere fact that he had filed a European application should automatically have been considered as such an "appropriate circumstance" which would have given rise to a release of the deposited micro-organisms by the NRRL even before the grant of the US patent in question. There has been produced no evidence in support of this submission. Nor is it, in principle, of any importance that the appellant might have been willing to give his consent to a request for samples of the deposited organisms at any time after the publication of the European application, had such a request been made. In

fact, one important purpose of Rule 28 EPC is just to make the availability of deposited organisms independent of any such consent by the depositor.

7. It would seem that the inherent risk for complications arising out of the situation that a European patent application is based on a deposit of micro-organisms originally made for another purpose than the filing of this application (e.g. the filing of a national application) was not foreseen when the system of deposit of such organisms was introduced. This is indicated, inter alia, by an amendment of the special agreements between the EPO and certain depositary institutions, made at a later stage, providing for the "conversion" of a deposit originally made for another purpose into a deposit under Rule 28 EPC (see e.g. OJ EPO 1982, 458, point 15; cf. OJ EPO 1986, 269-270, note 2, and the reference there to the Budapest Treaty). Comprehensive information on this matter (and on other matters related to micro-organisms as well) was published by the EPO in 1986 (see OJ EPO 1986, 269). Thus, it was from that time made clear that the proper way of bringing a deposit originally filed for another purpose into line with the requirements of the EPC-system is to formally convert the deposit into a deposit under Rule 28 EPC (in case of a deposit made on the basis of a special agreement between the EPO and the depositary institution) or into a deposit under the Budapest Treaty (which automatically covers Rule 28 EPC), as the case may be.

8. However, the present European application was filed already on 30 June 1983, i.e. during a period when the situation was still at least rather unclear as how to cope with deposits originally filed for the purpose of a national US application which was then used for claiming priority for a subsequent European application. It would seem to be unfair to let the appellant in this case bear the whole risk of this lack of clarity which was inherent in the system of deposits at that time. In this particular case it has also to be noted

that the gap in time was less than three months and that - according to the declaration made by the appellant which the Board sees no reason to distrust - no request for access to the deposited organisms was actually made during this gap. In the view of these special circumstances the Board considers it not as justified to refuse the application on the sole ground that, due to the deficiency in the deposit of the micro-organisms concerned, there was a temporary lack of disclosure of the invention.

9. The Board having, of its own motion, considered that the NRRL might earlier not have been obliged to accept the specific type of Basidiomycetes deposited in this case, has come to the conclusion that this is of no importance for the further prosecution of the present application, since NRRL has subsequently agreed to accept also this kind of micro-organisms (cf. OJ 1987, 396 where no exception is made for Basidiomycetes). Nor are there, in the Board's view, any other circumstances related to the deposit of micro-organisms preventing such a prosecution.
10. It follows from the above considerations that the decision under appeal has to be set aside and that there is no need to deal with the auxiliary requests.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The application is referred back to the Examining Division for further prosecution on the basis of the claims presently on file.

The Registrar:

The Chairman:

F.Klein

P.Lançon