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Aktenzeichen / Case Number / N° du recours : T 39/88 - 3.3.2

Anmeldenummer / Filing No / N° de la demande : 83 110 649.7

Veröffentlichungs-Nr. / Publication No / N° de la publication : 111 683

Bezeichnung der Erfindung: Improved strain of Clostridium acetobutylicum  
Title of invention: and process for its preparation.  
Titre de l'invention :

Klassifikation / Classification / Classement : C 12 P 7/28

**ENTSCHEIDUNG / DECISION**  
vom / of / du 15 November 1988

Anmelder / Applicant / Demandeur : CPC International Inc.

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Micro-organisms/CPC

EPÜ / EPC / CBE Article 83, Rule 28

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

**Leitsatz / Headnote / Sommaire**

There may be a deficiency in complying with Rule 28 EPC when the deposit of a culture of a micro-organism, originally made under other legislation, was not converted into a deposit under Rule 28 EPC on the Budapest Treaty before the filing of a European patent application.

Nevertheless, due to the lack of clarity which was inherent in the system of deposits under Rule 28 in that respect, it is not justified to refuse, on this sole ground, a European patent application filed before the publication of the clarifying notice of the EPO dated 18 July 1986 concerning patent applications and European patents in which reference is made to micro-organisms (OJ EPO 1986, 269) (cf. points 4-6 of the reasons).

Europäisches  
Patentamt

Beschwerdekammern

European Patent  
Office

Boards of Appeal

Office européen  
des brevets

Chambres de recours



Case Number : T 39/88 - 3.3.2

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.2  
of 15 November 1988

**Appellant :** CPC International Inc.  
International Plaza  
P.O. Box 8000  
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New Jersey 07632  
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**Representative :** Dr. Franz Lederer  
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**Decision under appeal :** Decision of Examining Division 023 of the European Patent Office dated 18 August 1987 refusing European patent application No. 83 110 649.7 pursuant to Article 97(1) EPC

**Composition of the Board :**

**Chairman :** P. Lançon

**Members :** E. Persson

U.M. Kinkeldey

## Summary of Facts and Submissions

- I. European patent application No. 83 110 649.7 was filed on 25 October 1983 claiming priority from US application No. 442 805 filed on 18 November 1982. The application was directed to an improved strain of *Clostridium acetobutylicum* and a process for its preparation. It contained 6 claims of which Claim 6 involved the use of a micro-organism, deposited with the American Type Culture Collection (ATCC) on 5 November 1982 and identified by its deposit number being ATCC 39 236. The European application was published on 27 June 1984. The cognate US patent No. 4 521 516 was issued on 4 June 1985, i.e. about 12 months later.
- II. The European patent application was refused by a decision of the Examining Division dated 18 August 1987 pursuant to Article 97(1) EPC. The reason for the refusal was that Claim 6 of the application did not meet the requirements of Article 83 in conjunction with Rule 28 EPC, since there was no certainty that strain ATCC 39 236, which was not sufficiently described in the application documents to make it possible to reproduce it, had been deposited in such a way that it would have been available to the public as required by Rule 28(3) EPC. It was in these circumstances left undecided whether or not another strain referred to in the application (ATCC 4259) was to be considered as available from an independent source for a sufficient period of time.
- III. A notice of appeal was filed against this decision requesting that a patent be granted on the basis of Claims 1-6 or, alternatively, Claims 1-5 as on file. The Appellant submits, in so far as it is still of interest in the present context, that he made a timely deposit of strain ATCC 39 236 with a depositary institution recognised in accordance with Rule 28(9) EPC and communicated to the

EPO the information required under Rule 28(1) EPC. By these acts and in view of Rule 28(2) EPC the Appellant unreservedly and irrevocably consented to the deposited culture being made available to the public in accordance with Rule 28 EPC. Strain ATCC 39 236 has therefore to be considered as deposited in such a way that a delivery of a sample of the strain to the public as required under Rule 28 EPC was possible. It is also submitted by the Appellant and supported by a letter from ATCC that no request for such a sample was actually made during the gap in time between the publication of the European application (27.6.1984) and the issue of the cognate US patent (4.6.1985). Finally, it is contended that the main reasons for the decision by this Board of 11 February 1988 in case T 239/87 are applicable also in the present case irrespective of the fact that the above gap in time was greater than in case T 239/87.

#### 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 5 November 1982, i.e. before the date of filing of the European application, with the ATCC in the USA. This institution was at that time, and is still, recognised by the EPO for the purpose of Rule 28 EPC both in its capacity as international depository authority under the Budapest Treaty and by virtue of a special agreement with the EPO of 23 June 1978 (see OJ EPO 1978, 272 and 301; 1981, 29-30; cf. OJ EPO 1983, 35, note 4). However, it has never been so much as suggested that the deposit was accompanied by a written statement indicating that it was made under the Budapest Treaty, as required by Rule 6.1(a)(i) of that Treaty, or for the particular purpose of Rule 28 EPC, as foreseen under point 13(a) of the special agreement referred to above (see OJ EPO 1978, 303). Nor is there any indication that a reference to the Budapest Treaty or Rule 28 EPC was ever made in any other way. It appears from a letter dated 9 November 1982 from the ATCC to the Applicant that the deposit was made "in connection with the filing of an application for patent" without any further precision. In the circumstances of the present case, the deposit can therefore only be considered to have covered the US application No. 442 805 filed shortly after the deposit was made, i.e. on 18 November 1982, and not the subsequent European application filed within the priority year, i.e. on 25 October 1983.
4. 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 relating to the deposit is granted. This is in contrast to the European system according to which a deposited organism shall always be made available upon request to the public from the date of publication of the European patent application irrespective of whether or not a European patent is subsequently granted and regardless of any

consent by the depositor. In the present case, when the European application was published on 27 June 1984, the cognate US application was still pending and the US patent was not issued until 4 June 1985. This created a gap in time of almost one year.

During this period there was no legal guarantee that the deposit would have been made available to the public as required by Rule 28(3) EPC. Although there is in the present case no reason to believe that the Appellant, had a request for the issue of a sample of the deposited organism actually been made, would not have given his consent to such release, it has to be kept in mind that one important purpose of Rule 28 EPC is just to make the availability of deposited organisms independent of any such subsequent consent by the depositor and to create a legal guarantee that the requirement for availability of such organisms from the date of publication of European patent applications is already fulfilled on the date of filing of such applications. Thus, the Board is unable to accept the Appellant's argument that the deposit in this case fulfilled all the requirements under Rule 28 EPC.

5. It would seem that the inherent risk of complications arising out of the situation in which 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 (although not affecting the ATCC agreement), 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, only from that time was it made quite clear that the proper way of bringing a deposit originally filed for another purpose into line with the requirements of the EPC-system was formally to convert the deposit into a deposit under Rule 28 EPC not later than the date of filing of the European application (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. Such a conversion has not been made in the present case.

6. However, the present European application had already been filed on 25 October 1983, i.e. at a time when the situation was still at least rather unclear as how to cope with deposits originally filed for the purpose of national US applications which were then used for claiming priority for subsequent European applications. It would seem to be unfair to let the Applicant in such a case bear the whole risk of this lack of clarity which was inherent in the system of deposits at that time. This view is in line with the decision by this Board of 11 February 1988 in case T 239/87, referred to by the Appellant. In that case, the critical gap in time (3 months) was shorter than in the present case. However, the length of the gap in time as such should not be decisive. What really matters from a legal point of view is the inherent unclarity of the system under Rule 28 EPC, as described above, before the clarification made in 1986. The Board, therefore, now takes the more general view, that it is not justified to refuse a European patent application, filed before the publication of the notice of the EPO dated 18 July 1986 concerning patent applications and European patents in which reference

is made to micro-organisms (OJ EPO 1986, 269), on the sole ground, that there was a deficiency in complying with Rule 28 EPC due to the fact that the deposit of a culture of a micro-organism, originally made under other legislation, was not converted into a deposit under Rule 28 EPC or the Budapest Treaty before the filing of the European application.

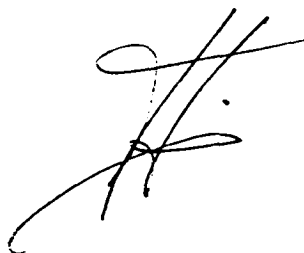
7. It follows from these considerations that the decision under appeal has to be set aside. In view of the issue of strain ATCC 4259 being left undecided in the decision, the case must be referred back to the Examining Division for further prosecution.

**Order**

**For these reasons, it is decided that:**

1. The decision under appeal is set aside.
2. The application is referred back to the Examining Division for further prosecution on the basis of Claims 1-6 presently on file.

**The Registrar:**



**The Chairman:**

