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D E C I S I O N
of 28 September 2001

Case Number: T 0280/99 - 3.3.4

Application Number: 90903729.3

Publication Number: 0425597

IPC: C12N 15/60

Language of the proceedings: EN

Title of invention:

A tryptamine producing tryptophan decarboxylase gene of plant origin

Applicant:

MAJESTY (HER) IN RIGHT OF CANADA as represented by THE
NATIONAL RESEARCH COUNCIL OF CANADA

Opponent:

-

Headword:

Tryptophan decarboxylase/CANADA

Relevant legal provisions:

EPC Art. 84

Keyword:

"Claim 1 - clarity (no)"

Decisions cited:

G 0010/93

Catchword:

-



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Boards of Appeal

Chambres de recours

Case Number: T 0280/99 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 28 September 2001

Appellant: MAJESTY (HER) IN RIGHT OF CANADA as represented
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 28 October 1998
refusing European patent application
No. 90 903 729.3 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: U. M. Kinkeldey
Members: L. Galligani
S. U. Hoffmann

Summary of Facts and Submissions

- I. The applicant lodged an appeal against the decision of the examining division issued on 28 October 1998 whereby the European patent application 90 903 729.3 (published as WO-A-90/10073 = EP 0 425 597) was refused. Basis of the refusal were claims 1 to 11 of which claim 1 was filed with letter dated 16 January 1998 and claims 2 to 11 were filed with letter dated 23 May 1995.

Claim 1 read as follows:

"A DNA fragment comprising an isolated and purified DNA sequence encoding a plant tryptophan decarboxylase, wherein the plant decarboxylase has the following DNA sequence:

CTCTCT [...] AAAAAAA"

- II. In the view of the examining division, the subject-matter of the claims was obvious to a person skilled in the art having regard to the following document:

(B) Plant Molecular Biology, 1984, Vol. 3, pages 281 to 288,

which represented the closest prior art, in combination with the following documents:

(C) Proc. Natl. Acad. Sci. USA, March 1983, Vol. 80, pages 1194 to 1198;

(D) Science, 18 November 1983, Vol. 222, pages 778 to 782.

- III. With the statement of grounds of appeal, the appellant filed the affidavit of Dr Brian E. Ellis and a new document. It was essentially submitted that there were in the prior art significant obstacles which had to be overcome in order to isolate a DNA encoding tryptophan decarboxylase (TDC) and thus there was no reasonable expectation of success in cloning such a DNA. Document (B) disclosed the purification of plant TDC, but the amino acid sequence of the protein was not predictable from the said reference. Nor was it predictable from an analogy with TDC sequences from animal sources. Therefore, the isolation of the specific DNA sequence referred to in the claims was not obvious. The experimental data (Schedule A) filed during prosecution before the examining division showed that the claimed subject-matter could be used for the successful transformation of plants and thus had an unexpected usefulness.
- IV. The examining division did not rectify its decision under Article 109(1) EPC, and remitted the appeal to the board of appeal, cf Article 109(2) EPC.
- V. In view of the appellant's request for oral proceedings, the board issued the summons to oral proceedings scheduled to take place on 28 September 2001. A communication with a provisional, non-binding opinion on the issues to be discussed was annexed to the summons. Therein, the board drew the appellants' attention inter alia to the fact that it was not clear from claim 1 on file whether the whole sequence recited therein was meant to be claimed or any sequence within that recited, and that, consequently, the said claim seemed not to be allowable under Article 84 EPC.

- VI. On 13 September 2001, the appellant informed the board of the intention not to attend oral proceedings on 28 September 2001. No amendments to the claim request on file were submitted.
- VII. Oral proceedings took place on 28 September 2001. No one appeared on behalf of the appellant. It was established that the appellant had requested in writing that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 11 on file. After deliberation, the decision of the board was announced.

Reasons for the Decision

1. The present application was refused by the examining division for lack of inventive step.
2. As stated in decision G 10/93 (OJ EPO, 1995, 172), "[i]n an appeal from a decision of an examining division in which a European patent application was refused the board of appeal has the power to examine whether the application or invention to which it relates meets the requirements of the EPC. The same is true for requirements which the examining division did not take into consideration in the examination proceedings or which it regarded as having been met. If there is reason to believe that such a requirement has not been met, the board shall include this ground in the proceedings."
3. In the present case, the board noted that claim 1 is not clearly formulated because, firstly, a plant decarboxylase cannot **have** a DNA sequence (either it has

an amino acid sequence, or it is encoded by a given DNA sequence), and, secondly, it is not clear from its wording whether by the term "DNA fragment" the whole sequence recited in the claim is meant or any sequence within that recited.

4. This lack of clarity objection under Article 84 EPC was officially communicated to the appellant as a provisional view of the board in the annex to the summons to oral proceedings (cf Section V above).
5. The appellant, who had indicated in the statement of grounds of appeal that "*the claims of record are restricted to one such nucleotide and one such amino acid sequence*" (cf page 12, fourth paragraph), decided not to reply to the board's objection and not to propose any amendment to the claims on file. Moreover, the appellant decided not to attend oral proceedings where the question might have been clarified.
6. In respect of the first clarity problem of claim 1, it can be seen as being caused by an unfortunate formulation which the skilled person would be able to recognise and put in the correct perspective. However, the board cannot of its own motion adopt a clearer formulation of the claim.
7. The second clarity problem is a more serious one as it leaves the addressee guessing as to what exactly falls within the terms of the claim. In fact, the wording "a DNA fragment comprising an isolated and purified DNA sequence encoding a plant tryptophan decarboxylase, wherein the plant decarboxylase has the following DNA sequence" does not unambiguously indicate that the claim is limited to a DNA fragment comprising only the

entire sequence CTCTCT....AAAAAAA recited therein. The claim leaves open to interpretation the exact structure of the DNA sequence encoding a plant tryptophan decarboxylase which is comprised in the claimed DNA fragment.

8. For these reasons, the board considers that claim 1 on file does not meet the requirements of Article 84 EPC.
9. Under these circumstances, it is not necessary to enter into the merit of the inventive step question.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairperson:

U. Bultmann

U. Kinkeldey