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Datasheet for the decision of 8 March 2021

Case Number: T 1045/16 - 3.3.04

Application Number: 06835672.4

Publication Number: 1962578

IPC: A01H5/08, C12Q1/68

Language of the proceedings: EN

Title of invention:
Closterovirus-Resistant Melon Plants

Patent Proprietor:
Monsanto Invest N.V.

Opponents:
Nunhems B.V.
C. Then/R.Tippe et al

Headword:
Virus-resistant melons/MONSANTO

Relevant legal provisions:
EPC Art. 83
EPC R. 31

Keyword:
Sufficiency of disclosure - (no)

This datasheet is not part of the Decisior
It can be changed at any time and without notic

Decisions cited:
G 0002/93, T 1338/12, UK Supreme Court in Warner-Lambert v Mylan & Actavis ([2018] UKSC 56

Catchword:

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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 1045/16 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 8 March 2021

Appellant: (Patent Proprietor)	Monsanto Invest N.V. Handelsweg 53 N 1181 ZA Amstelveen (NL)
Representative:	Uexküll & Stolberg Partnerschaft von Patent- und Rechtsanwälten mbB Beselerstraße 4 22607 Hamburg (DE)
Respondent I: (Opponent 1)	Nunhems B.V. Voort 6 6083 AC Nunhem (NL)
Representative:	Majer, Dorothea Nunhems Netherlands B.V. Napoleonsweg 152 6083 AB Nunhem (NL)
Respondent II: (Opponent 2)	C. Then/R.Tippe et al Frohschammerstrasse 14 80807 Munich (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 24 February 2016 revoking European patent No. 1962578 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chair	G. Alt
Members:	A. Chakravarty
	R. Romandini

Summary of Facts and Submissions

I. An appeal was filed by the patent proprietor (appellant) against the decision of the opposition division to revoke European patent No. EP 1 962 578. The patent has the title "*Closterovirus-Resistant Melon Plants*".

II. Opponents 1 and 2 are respondents I and II to this appeal, respectively.

III. In the decision under appeal, the opposition division considered a main and five auxiliary requests. They held that all of these requests failed to meet the requirements of Article 83 EPC.

IV. With the statement of grounds of appeal, the appellant maintained as a main request that the patent be maintained as granted and also submitted sets of claims of auxiliary requests 1 to 7. Both respondents replied to the statement of grounds of appeal.

V. Claim 1 as granted reads:

1. A CYSDV-resistant plant of the species *Cucumis melo*, said plant comprising an introgression from a plant of melon accession PI313970, which introgression comprises a CYSDV-resistance-conferring QTL or a CYSDV-resistance-conferring part thereof linked to at least one marker located on the chromosome equivalent to linkage group (LG) 6 of melon accession PI313970, wherein said marker is E11/M49-239, and wherein said QTL or said part thereof is present in homozygous form.

Claim 1 of each of auxiliary requests 1 to 7 is an amended version of the above claim, but each retains the above language.

VI. The following documents are referred to in this decision:

D1: McCreight J.D., "*Molecular and phenotypic variation in melon Pl 313970*", Proceedings Cucurbitaceae, ISHS 2000 Acta Hort, 510, 235-239.

D3: Printout of web page from http://www.ars-grin.gov/cgi-bin/npgs/acc/display.pl?1234456

D13: McCreight J.D. and Wintermantel W.M., "*Genetic Resistance in Melon PI313970 to Cucurbit yellow stunting disorder virus*", HortScience, 2011, 46, 1582-1587.

D14: Mccreight, J.D. and Wintermantel, W.M., "*Resistance in Melon PI313970 to Cucurbit Yellow Stunting Disorder Virus*", HortScience, 2010, 46(12).

D20: Declaration of Dr de Vries dated 1 July 2016.

VII. The arguments of the appellant, relevant to the decision, are summarised as follows.

Admissibility of the opposition of opponent 2

The opposition of opponent 2 was not admissible because it was not clear if the natural persons who signed the notice of opposition, for example Mr Christoph Then, were acting as an opponent in their own name or as a representative of a group of natural persons or as

representative of the legal persons identified in the notice.

For example, Mr Then signed the opposition on behalf of the organisation "No Patents on Seeds" but the notice of opposition did not identify whether "No Patents on Seeds" was a member of the joint opposition or if Mr Then himself was a member of the joint opposition.

The position of the "Arbeitsgemeinschaft bäuerliche Landwirtschaft" was even less clear. The group of persons or legal person named "Arbeitsgemeinschaft bäuerliche Landwirtschaft" was identified as a member of the joint opposition in the notice of opposition, however, it was unclear which natural person represented the group of persons or the legal person.

According to the established case law of the Boards of Appeal, it had to be clear throughout the opposition procedure who the individual members of the common opponents were (see headnote 3 of decision G 3/99). In the present case, it was not known, if each of the natural persons, legal persons or organizations listed in the opposition, was a member of the joint opposition.

It was highly relevant to know whether a group of the natural or legal persons identified still existed or wished to participate in the opposition proceedings.

Disclosure of the invention - Article 83 EPC
All claim requests - claim 1

The opposition division's conclusions with regard to insufficiency of disclosure were incorrect. The plants identified by the melon accession No. PI313970 were

publicly available on the priority date of the patent and at the filing date of the opposition, as evidenced by document D3 and were publically available on the date of writing the statement of grounds of appeal, as evidenced by the patent itself and by documents Dl, D13 and D14. In fact, plants of the accession PI313970 could be ordered directly from the website of the US National Plant Germplasm System.

It was the task of Institutes like the US National Plant Germplasm System (NPGS) to maintain the accession. This task included maintaining genetic diversity in the accessions. These Institutes implemented special measures to avoid genetic drift or loss.

Document D3 showed that the melon accession in question was maintained by the NPGS genebank located at the North Central Regional PI Station of the US Department of Agriculture (the USDA was cited repeatedly in document D3, for example at the end of page 2; North Central Regional PI Station was cited in the first paragraph of document D3).

The US National Plant Germplasm System which was tasked with maintaining the accession saw its mission as safeguarding genetic diversity of agriculturally important plants. Thus, assuming that the plants were maintained by this Institute in manner causing genetic drift or trait loss was not reasonable.

VIII. The arguments of the respondent I, relevant to the decision, are summarised as follows.

Disclosure of the invention - Article 83 EPC
All claim requests - claim 1

The claimed invention was not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. The opposition division had been right to hold that the rationale for deposits of biological material was to ensure availability of the biological material to the public.

The requirement for a deposit to satisfy the requirements of Article 83 EPC could therefore only be circumvented if the material was available to the public without restriction (Guidelines for Examination, F-III, 6.2 and 6.3) over the whole term of the patent (see decision under appeal, point 6.5.7).

It was therefore not sufficient to show that plants with the name PI313970 were available before the priority date. Instead, there should also be evidence that plants with the resistance-conferring QTL and the marker were and would remain available over the entire period of the patent term.

Although plants named PI313970 could be ordered from the North Central Regional PI Station of the US Department of Agriculture after the effective date of the opposed patent, it was unclear if the resistance QTL and marker were still present in any of the seeds that could be so ordered. Moreover, the depository institution did not guarantee availability in the future.

Furthermore, none of the seed lots mentioned in any of documents cited by the patent proprietor provided evidence of the availability of a plant having the resistance and could certainly not ensure availability over the entire term of the patent.

None of the documents mentioning PI313970 related to seeds deposited under the Budapest Treaty and could therefore, by definition, not ensure availability of a seed lot over the entire term of the patent, even if the QTL and the AFLP marker were present in any of the seed lots mentioned.

IX. The arguments of respondent II, relevant to the present decision, are summarised as follows:

Disclosure of the invention - Article 83 EPC
All claim requests - claim 1

To answer the question of whether the biological material of the invention was made available to the public and would remain available as required by Article 83 EPC it was necessary to compare the terms and conditions of the Budapest Treaty with those of the institution US National Plant Germplasm System, which maintained the PI313970 accession.

According to the Budapest Treaty, a deposit at an International Depository Authority ensures that the relevant biological material is available and viable during the entire term of the patent. This was set out in the Regulations, published in the Annex of the Treaty. These regulations governed the deposition, storage, viability testing, furnishing of samples, the termination, limitation or discontinuance of the deposit. These measures were necessary to safeguard the

availability of the biological material over the minimum period of 30 years as specified by the Treaty. However, these rules and regulations were not adequately provided for in the US National Plant Germplasm System. Even if the US National Plant Germplasm System were in a position to prevent the loss of genetic features, it did not have any obligations in relation to deposition, storage, furnishing of samples, or the potential termination, limitation or discontinuance of the deposit, in contrast to those obligations provided to the entitled parties of the Budapest Treaty.

In addition, the EPC required a deposit according to the Budapest Treaty. This requirement could not simply be replaced by a deposition at a genebank which had no obligations as those under the Budapest Treaty.

Therefore, the invention did not fulfill the requirements of Article 83 EPC and the patent had to be revoked.

X. The board appointed oral proceedings and informed the parties of its preliminary appreciation of the appeal. In its communication pursuant to Article 15(1) RPBA, the board stated that "*It appears to be common ground that, to carry out the invention in the sense of Article 83 EPC, the person skilled in the art requires access to propagating material (e.g. seeds) containing the CYSDV-resistance-conferring QTL and marker, identical to or derived from melon accession PI313970. It is further not in dispute that there has been no deposit of such material with a recognised depositary institution as set out in Rule 31(1)(a) EPC* ".

The board also stated that it understood "*that the appellant's position is that the relevant biological material was and remains publically available in the sense of Rule 31(1)(a) EPC at the US National Plant Germplasms System*" and went on to identify "*that a relevant question in this context was whether "available to the public" in the sense of Rule 31(1)(a) EPC means the same as in Article 54 EPC, and if the meaning is not the same then whether the biological material must be generally publically available, such as e.g. E. coli bacteria, or whether a deposit of a specific biological material at the US National Plant Germplasms System could equally fulfill the notion of "public availability" within the meaning of the provision at issue*".

XI. Both the appellant and respondent I informed the board in writing that they would not attend the oral proceedings and that their requests for oral proceedings were withdrawn.

XII. The board cancelled the oral proceedings and informed the parties that the procedure would be continued in writing.

XIII. The requests of the appellant are that the decision of under appeal be set aside and that the case be remitted to the opposition division for further prosecution. Alternatively, the patent should be maintained on the basis of one of auxiliary requests 1 to 7 submitted with the statement of grounds of appeal.

XIV. The requests of the respondents are that the appeal be dismissed. Respondent II further requested oral proceedings in case their request that the appeal be dismissed was not allowed.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 99 EPC and is admissible.

Admissibility of the opposition of opponent 2

2. In the board's view, the opponents comprised in the joint opposition are the legal and natural persons indicated in bold in the notice of opposition of opponent 2, dated 3 February 2012, at pages 1 to 2. It is apparent that Christoph Then, whose name is indicated in bold in the notice of opposition, is one of the joint opponents and, at the same time, the common representative of them. Therefore, the Board agrees with the assessment of the opposition division that the identity of the persons participating in the joint opposition is clear, and the opposition is admissible.

Main request - claim 1

Disclosure of the invention (Article 83 EPC/Rule 31 EPC)

3. The requirements of Article 83 EPC are met if the European patent discloses the claimed invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. Special provision is made in Rule 31 EPC for inventions which involve the use of or concern biological material which is not available to the public and which cannot be described in the European patent application in such a manner as to enable the invention to be carried out by a person skilled in the art. In such cases, Rule 31(a) EPC provides that the invention is regarded

as being disclosed as prescribed in Article 83 EPC only if a sample of the biological material has been deposited with a recognised depositary institution on the same terms as those laid down in the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure of 28 April 1977 not later than the date of filing of the application.

4. It was common ground that, to carry out the invention in the sense of Article 83 EPC, the person skilled in the art required access to propagating material (e.g. seeds) containing the CYSDV-resistance-conferring QTL and marker, identical to or derived from melon accession PI313970 (the "relevant biological material"), see Section X., above. It was further not in dispute that there was no deposit of such material with a recognised depositary institution as set out in Rule 31(1)(a) EPC.

5. A deposit according to the Budapest Treaty is necessary under Rule 31(1)(a) EPC only in cases where the relevant biological material is not available to the public. Hence, it must be determined whether or not the relevant biological material in question was available to the public. This requires that the meaning of the expression "available to the public" in the context of Rule 31(1) EPC is first established.

6. According to decision G 2/93 of the Enlarged Board of Appeal, Rule 28(1) EPC 1973 [Rule 31(1) EPC 2000] refers to Article 83 EPC and serves to substantiate and to supplement the general requirements of that Article for a specific group of inventions for which a mere written description is not sufficient to enable a person skilled in the art to carry out the invention.

Therefore, its provisions are subordinate to the requirements of Article 83 EPC (see Reasons, point 9).

7. It follows from the subordination of Rule 31 EPC to Article 83 EPC that the requirement that a biological material be "available to the public" in the sense of Rule 31(1) EPC serves to ensure that the person skilled in the art can carry out the invention.

8. It is also evident that the requirements of Article 83 EPC are not time limited. The skilled person must be able to carry out the invention at least over the entire term of the patent. This concept is fundamental to patent law: for example, the UK Supreme Court, in Warner-Lambert v Mylan & Actavis ([2018] UKSC 56, point 17) held that "*the juridical basis on which patents are granted, [is] sometimes called the "patent bargain". [According to which] The inventor obtains a monopoly in return for disclosing the invention and dedicating it to the public for use after the monopoly has expired*".

9. Thus, "available to the public" in Rule 31(1) EPC means available in a manner that guarantees that the skilled person can carry out the invention at least over the whole term of the patent.

10. To be considered "available to the public" in the sense of Rule 31(1) EPC, a biological material must therefore be available in a manner that allows the skilled person to be certain that they can obtain it at least over the term of the patent. By way of illustration, examples of such biological material are brewers yeast and *Escherichia coli* in general, or indeed melon plants in general. Non-examples are specific, non-generic strains of microorganism or indeed accessions of plants only

available from a non-Budapest Treaty institution. Deposit with a non-Budapest Treaty institution cannot ensure availability to the public because Rule 31(1) EPC stipulates that biological material which is "not available to the public" is to be "deposited with a recognised depositary institution on the same terms as those laid down in the Budapest Treaty".

11. Thus, in the the light of Rule 31(1) EPC, the availability of plants of the accession PI313970 from the US National Plant Germplasm System is not sufficient to ensure that the relevant person skilled in the art can practice the claimed invention during the term of the patent at issue.

12. According to the appellant, the mention of accession PI313970 in documents D1, D3 and D13 proves the availability of plants of the accession PI313970 to the public at the points in time of these publications. However, it follows from the considerations in point 7 above and from the established case law of the Boards of Appeal that the mention of the biological material in a scientific publication does not *per se* establish that said material is available to the public in the sense of Rule 31(1) EPC (see Case Law of the Boards of Appeal of the European Patent Office, 2019, 9th edition, I.C.3.2.5 and T 1338/12, Reasons, point 15.1).

13. In view of the above, the board concludes that the relevant biological material (plants of accession PI313970) was neither available to the public in the sense of Rule 31(1) EPC nor was a sample of the biological material deposited with a recognised depositary institution as provided for in Rule 31(1)(a) EPC. Thus, the claimed invention does not meet the requirements of Article 83 EPC.

Auxiliary requests 1 to 7

14. As was the case for claim 1 of the main request, claim 1 of each of these requests relates to an invention which requires that, in order to carry it out, the person skilled in the art has access to relevant propagating material (e.g. seeds) containing the CYSDV-resistance-conferring QTL and marker, identical to or derived from melon accession PI313970. It follows from the decision concerning the main request that none of these claims relate to an invention which meets the requirements of Article 83 EPC.

15. No claim request is allowable. The appeal must therefore be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chair:

I. Aperribay G. Alt

Decision electronically authenticated