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Datasheet for the decision of 19 February 2021

Case Number: T 2840/18 - 3.3.04

Application Number: 05103316.5

Publication Number: 1597965

IPC: A01H5/00

Language of the proceedings: EN

Title of invention:
Broccoli type adapted for ease of harvest

Patent Proprietor:
Seminis Vegetable Seeds, Inc.

Opponents:
C. Then/R.Tippe et al
Syngenta Crop Protection AG

Headword:
Broccoli type/SEMINIS

Relevant legal provisions:
EPC Art. 53(b), 111(1)

Keyword:
Exceptions to patentability - (no)

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It can be changed at any time and without notic

Decisions cited:
G 0002/12, G 0002/13, G 0003/19

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 2840/18 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 19 February 2021

Appellant: (Patent Proprietor)	Seminis Vegetable Seeds, Inc. 800 N. Lindbergh Blvd. St. Louis MO 63167 (US)
Representative:	Uexküll & Stolberg Partnerschaft von Patent- und Rechtsanwälten mbB Beselerstraße 4 22607 Hamburg (DE)
Respondents I: (Opponents 1)	C. Then/R.Tippe et al Frohschammerstrasse 14 80807 Munich (DE)
Respondent II: (Opponent 2)	Syngenta Crop Protection AG Rosentalstrasse 67 4058 Basel (CH)
Representative:	SYNGENTA IP CHBS-B4.8 Rosentalstrasse 67 4058 Basel (CH)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 30 October 2018 revoking European patent No. 1597965 pursuant to Article 101(3)(b) EPC**

Composition of the Board:

Chair	G. Alt
Members:	A. Chakravarty
	M. Blasi

Summary of Facts and Submissions

I. The patent proprietor (appellant) filed an appeal against the opposition division's decision to revoke European patent 1 597 965. In the decision under appeal, the opposition division held that the subject-matter of claim 1 of both the main and auxiliary request fell under the exclusions from patentability as defined by Rule 28(2) EPC and that, consequently, it did not meet the requirements of Article 53(b) EPC.

II. The patent had been opposed by two parties, opponents 1 and 2, who are respondents I and II to the appeal. The respondents have made no submissions in the appeal proceedings.

III. The board issued a communication pursuant to Rule 100(2) EPC in which it informed the parties that "*since the patent in suit was granted before 1 July 2017, the subject-matter of the set of claims of the main request is not excluded from patentability pursuant to Article 53(b) EPC. As the board understands the opinion of the Enlarged Board of Appeal, Rule 28(2) EPC also does not exclude the claimed subject-matter from patentability in the present case*".

IV. It concluded that it considered that the decision under appeal should be set aside and stated that "*As the opposition division did not deal with any other requirement for patentability other than that pursuant to Article 53(b) EPC, the board is currently not inclined to accede to the appellant's request that the case be remitted to the opposition division with the order to maintain the patent in amended form on the basis of the claims of the main request and instead*

would accede to the appellant's further request for remittal of the case to the opposition division for further prosecution". In view of the fact that the appellant's request for oral proceedings was conditional on the appeal not being allowed and that no requests for oral proceedings were made by the respondents, the board concluded that the case could be decided in written proceedings.

V. The appellant was given as period of two months in which to inform the board whether the intended procedure was conform to their requests.

VI. The appellant replied to the board's communication as follows:

"*It is requested that the above application* [sic] *be remitted to the Examining Division* [sic] *for further prosecution without a hearing before the Board as indicated in the communication dated August 26, 2020.*

The request for a hearing is maintained only in case the Board should intend to dismiss the appeal in its entirety".

VII. The requests of the appellant as understood by the board are therefore that the decision under appeal be set aside and that the case be remitted to the opposition division for further prosecution on the basis of the set of claims underlying the decision under appeal.

Reasons for the Decision

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

Set of claims underlying the decision under appeal

Exceptions to patentability (Article 53(b) EPC)

2. In opinion G 3/19 of 14 May 2020 the Enlarged Board of Appeal held (see Conclusion) that:

> "*Taking into account developments after decisions G 2/12 and G 2/13 of the Enlarged Board of Appeal, the exception to patentability of essentially biological processes for the production of plants or animals in Article 53(b) EPC has a negative effect on the allowability of product claims and product-by-process claims directed to plants, plant material or animals, if the claimed product is exclusively obtained by means of an essentially biological process or if the claimed process features define an essentially biological process.*"

3. However the Enlarged Board of Appeal also held that:

> "*This negative effect does not apply to European patents granted before 1 July 2017 and European patent applications which were filed before that date and are still pending*" (*ibid*).

4. Accordingly, as the present patent was granted before 1 July 2017, the subject-matter of the set of claims underlying the decision under appeal is not excluded from patentability pursuant to Article 53(b) EPC in conjunction with Rule 28(2) EPC.

5. Furthermore, the board considers that the provisions applicable before 1 July 2017, i.e. Article 53(b) EPC, as interpreted by decisions G 2/12 and G 2/13 (OJ EPO, 2016, A27 and A28), do not exclude the subject-matter of the set of claims at issue from patentability either.

6. The appeal is thus allowable.

Remittal (Article 111(1) EPC)

7. Pursuant to Article 111(1) EPC the board may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.

8. The sole reason given by the opposition division for revoking the patent was that the subject-matter of claim 1 of both the main and auxiliary request was plants, exclusively obtained by means of an essentially biological process and therefore excluded from patentability pursuant to Rule 28(2) and Article 53(b) EPC.

9. It is the primary function of appeal proceedings to give a judicial decision upon the correctness of the decision under appeal (see Case Law of the Boards of Appeal, 9th edition 2019, section V.A.1.1, second paragraph and decisions referred to there).

10. As the opposition division did not deal with any other requirement for patentability other than that pursuant to Article 53(b) EPC, the board remits the case to the opposition division for further prosecution, in accordance with the appellant's request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the opposition division for further prosecution on the basis of the set of claims underlying the decision under appeal.

The Registrar: The Chair:

I. Aperribay G. Alt

Decision electronically authenticated