I. Summary of Facts and Submissions

1 European patent 2 140 023 having the title "INSECT RESISTANT PLANT " is based upon European patent application No. 08 749 952.1 filed on 30-04-2008. It claims priority of EP 07290556 filed on 02-05-2007 and EP 07119649 filed on 30.10.2007.

The mention of the grant of the patent has been published in the European Patent Bulletin of 08-05-2013 . Proprietor of the patent is :
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CH.

2 A notice of opposition has been filed by :
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Swissaid, Caroline Morel (Geschäftsleiterin), Monika Uhlmann (Leiterin Finanzen), Lorystrasse 6a, CH-3000 Bern 5

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Niederlande LTO the Netherlandsir. M.P. Cuijpers (Director), Bezuidenhoutseweg 225, 2594 AL Den Haag, The Netherlands.

Albanien Institute for Environmental Policy (IEP), Edvin Pacara (Executive Director), Rruga Mine Peza 4, Tirana, Albania.

Belgien BioForum Vlaanderen, Lieve Vercauteren (Director), Quellinstraat 42, 2018 Antwerp, Belgium.

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Zypern Movement of Life Cyprus, Dr. George Katsonis (Coordinator of the movement of Life Cyprus), 2A Elia Venezi, 2042 Strovolos, Nicosia, Cyprus.

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Lettland Pure Horticultural Research Centre (Pure HRC), Janis Lepsis (Head of the board), Abavas 2, Pure, Tukuma nov. LV-3124 Latvia.

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Slovenien Institute for Sustainable Development, Anamarija Slabe (Director), Metelkova ulica 6, SI-1000 Ljubliana, Slovenia.

The opponent (O) requested the revocation of the patent in its entirety based on Article 100(a) EPC, Article 100(b) EPC and Article 100(c) EPC. O also requested oral proceedings in any other case.

3 The following evidence has been submitted within the opposition period:

Document D1-D12. Documents D1-D7 are the same as in the examination procedure.

4 In a letter received on 06-08-2014, the proprietor (P) requested the rejection of the opposition (Article 101(2) EPC). P requested oral proceedings in any other case. As an auxiliary request, P requested stay of the proceedings in order to wait the outcomes of decisions G2/12 and G2/13.

5 Oral proceedings were stayed until decision G2/12 and G2/13 have been issued.

6 Two third-party observations have been filed in this opposition on 05.02.2014 and 06.02.2014 respectively.

7 Summons to oral proceedings have been sent on 11.12.2015 for oral proceedings scheduled on 10.06.2016.

8 On 10.05.2016, P filed a response to the summons to oral proceedings as well as a Main Request (MR) and four auxiliary requests (AR1-AR4). P also filed documents D13-D17.

9 On 10.05.2016, O filed a response to the summons to oral proceedings together with documents D18-D31.

10 Oral proceedings were cancelled on 02.06.2016 by decision of the opposition division (OD).

11 In a letter filed in electronic form on 08.06.2016, P commented on the decision of OD to cancel proceedings. P requested (1) the EPO to compensate P for its travel costs and (2) the OD to provide a full reasoning of why a legally qualified member would be necessary for continuation of the proceedings. P confirmed that he maintained all the requests filed in the written submissions dated 10.05.2016. P also maintained his request for oral proceedings in case the opposition would not be rejected.

12 The proceedings were stayed on 03.04.2017 following a decision of the President of the EPO (cf. Notice from the EPO dated 24.11.2016, OJ EPO A104).

13 On 08.01.201, the parties were invited to comment on the following point :

- Exception to patentability in the light of new Rule 28(2) EPC.

The parties were informed of the enlargement of the OD with a legal member and the reasons for this enlargement.

The parties were informed that OD is not competent to deal with or decide on P's claim for costs against the Organisation.

14 On 03.05.2018, O filed a response with comments on the allowability of the claims under Article 53(b) EPC and Rule 28(2) EPC.

In this letter, O requested the right to answer in written form to any modification filed by P before oral proceedings. O also confirmed the request to reject the opposed patent in its entirety and the request for oral proceedings.

15 On 08.05.2018, P filed a response with comments on the applicability of Rule 28(2) EPC. P also filed a fifth auxiliary request (AR5).

P requested the patent to be maintained as granted. P requested oral proceedings in any other case. As an auxiliary request, P requested the patent to be maintained in amended form on the basis of any of AR1-AR5.

16 On 03.08.2018, OD issued summons to attend oral proceedings on 07.03.2019.

17 Oral proceedings were cancelled on 01.02.2019 by decision of the OD in order to wait for the outcome of referral G 3/19 to the Enlarged Board of Appeal by the President of the EPO.

18 Opposition proceedings were stayed on 27.06.2019.

19 On 06.02.2019, O filed a letter with further arguments together with documents D32-D35.

20 On 13.01.2022, O filed a letter to inquire when opposition proceedings would be resumed.

21 On 04.03.2022, summons to oral proceedings for 16.02.2023 were sent.

22 On 13.01.2022, P filed a letter with further argumentation together with documents D36 and D37.

P also filed six new auxiliary requests (AR1-AR6).

23 On 13.01.2023, O filed a letter with further argumentation together with documents D38 and D39.

24 Oral proceedings took place on 16.02.2023 by videoconference.

25 During oral proceedings, OD came to the conclusion that taking into consideration the amendments made during opposition proceedings the patent and the invention to which it relates meets the requirements for patentability of the EPC. The patent will be maintained in amended form under Article 101(3)(a) EPC on the basis of AR6 filed during oral proceedings and the description adapted thereto, provided that the requirements of Rule 82(2) are fulfilled.

26 The consolidated list of documents cited during oral proceedings can be found in the annex.

II - Reasons for the decision.

27 **Main Request as filed on 10.05.2016 (claims as granted).**

Claim 1 of the MR reads as follows :

A cultivated *Capsicum annuum* plant which is intermediately resistant to *Bemisia* wherein said plant contains a genome comprising a "QTL" which contributes to *Bemisia* resistance, which QTL is located on chromosome 3 and wherein said QTL is genetically linked to at least one marker locus, particularly to at least two marker loci, more particularly to at least three marker loci and even more particularly to a least four marker loci, but especially to at least five and up to six marker loci, which marker loci are on chromosome 3 and co-segregate with the *Bemisia* resistance trait and can be identified by a PCR

oligonucleotide primer or pair of PCR oligonucleotide primers selected from the group of primer pair 1 represented by a forward primer of SEQ ID NO: 1 and a reverse primer of SEQ ID NO: 2, identifying marker locus 1; primer pair 2 represented by a forward primer of SEQ ID NO: 3 and a reverse primer of SEQ ID NO: 4, identifying marker locus 2; primer pair 3 represented by a forward primer of SEQ ID NO: 5 and a reverse primer of SEQ ID NO: 6, identifying marker locus 3; primer pair 4 represented by a forward primer of SEQ ID NO: 7 and a reverse primer of SEQ ID NO: 8, identifying marker locus 4; primer pair 5 represented by a forward primer of SEQ ID NO: 9 and a reverse primer of SEQ ID NO: 10, identifying marker locus 5; primer pair 6 represented by a forward primer of SEQ ID NO: 11 and a reverse primer of SEQ ID NO: 12, identifying marker locus 6.

28 **Discovery; Article 52(2) EPC.**

OD considers that the claims of MR are patentable under Article 52(2) EPC.

According to O, the claims encompass the following scientific information : a QTL on chromosome X of *Capsicum annuum* which is bordered by primers x and y is responsible for the resistance of some *C. annuum* lines to *Bemisia*. This scientific information is of the same nature as the one in the decision of the US Supreme Court regarding the Brca gene. P only identified the QTL in *C. annuum* plants and as such made only a discovery that is not patentable under Article 52(2) EPC.

OD notes that, according to the Guidelines, chapter G-II.3.1. : "[...] if a substance found in nature can be shown to produce a technical effect, it may be patentable]. OD considers that this is the case for the opposed patent where the *C. annuum* plants have been shown to comprise a QTL that can be used for the generation of *C. annuum* plants having resistance to *Bemisia*. Therefore, the claims of the MR are considered to be patentable under Article 52(2) EPC.

29 **Exceptions to patentability; Article 100(a) EPC / Article 53(b) EPC.**

OD considers that claims 7-9 of the MR are not patentable under Article 53(b) EPC whereas claims 1-6 and 11-12 are acceptable under Article 53(b) EPC.

29.1 **Admissibility of the presentation of Mr. Haring.**

O requested Mr. Haring to be allowed to present comments on the essential biological nature of the process.

P objected to Mr. Haring being heard. According to P, the members of OD are technically qualified and it would not be necessary to hear the presentation of Mr. Haring.

OD considered the requirements of decision G 4/95 to be fulfilled and decided to allow Mr. Haring to speak as technical expert under the supervision of the representative of O.

29.2 **Product claims 1-6 and 11-12.**

OD considers that claims 1-6 and 11-12 of the MR are patentable under Article 53(b) EPC.

29.2.1 According to O, claims 1-6 and 11-12 should not be considered as patentable under Article 53(b) EPC in combination with Rule 28(2) EPC since these claims are directed to plants obtained by an essentially biological process. According to O, the retroactivity for Rule 28(2) EPC has been requested by the Administrative Council. This has not been accepted by the Enlarged Board of Appeal in G 3/19. However, according to O, the intention of the Administrative Council, that represents the legislative power, should be followed.

Another line of argumentation used by O in the written procedure is that claims 1-6 and 11-12 should not be considered as patentable in the light of decision G1/98. According to O, the plant claimed in the opposed patent is defined by reference to its taxonomy. O considers that there is a limited number of *C. annuum* varieties. Therefore, using the terminology of decision G1/98, the claims of the opposed patent are directed to individual, identifiable varieties that are not patentable under Article 53(b) EPC. This is especially true for the plants derived from line 016M4387.

29.2.2 As far as the applicability of Rule 28(2) EPC is concerned, the Enlarged Board of Appeal has concluded in opinion G3/19 that :

"Taking into account developments after decision G2/12 and G2/13 of the Enlarged Board of Appeal,

the exception to patentability of essentially biological processes for the production of plants and 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 and 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.

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."

The opposed patent has been granted on 08.05.2013, i.e. before the entry into force of Rule 28(2) EPC. Therefore, in line with decision G3/19, OD considers that Rule 28(2) EPC does not apply to the claims of the opposed patent.

As far as the patentability of claims 1-6 and 11-12 under Article 53(b) EPC in combination with decision G1/98 is concerned, OD considers that G1/98 does not apply here since the claims refer to generic *C. annuum* plants and not to any specific varieties. The exclusion in Article 53(b) EPC was made to serve the purpose of excluding from patentability subject-matter which is eligible for protection under the plant breeder's rights. A generic *C. annuum* plant, without further specification of the variety would not be eligible for protection under the plant breeder's rights. Furthermore, OD considers that the technical teaching of the invention is not confined to a particular variety (Rule 27(b) EPC) since the resistance can be introduced into many *C. annuum* plants. In accordance with decision G1/98, Article 53(b) EPC does not exclude from patentability claims wherein a specific plant variety is not individually claimed even though the claims may embrace plant varieties (see also Guidelines G-II.5.4.1.).

29.3 **Process claims 7-9.**

OD considers that claims 7-9 are not patentable under Article 53(b) EPC.

According to P, claim 7 of the opposed patent is not directed to an essentially biological process for the production of plants. P considers that claim 7 does not disclose any step of an essentially biological process nor does it imply that such a process is used. P considers that the exclusion under Article 53(b) EPC should be interpreted narrowly. According to P, G3/19 confirms that a difference should be made between patentability and extent of protection. P further contests that the whole content approach referred to in G2/06 should apply in the present case since the situation is completely different. P further considers that claims 8 and 9 are directed to methods for obtaining fruits and seeds. Such methods do not need stages of sexual crossing or selection as referred to in decision G1/08.

OD considers that the only way to introduce the QTLs of resistance to *Bemisia* disclosed in the opposed patent into other *C. annuum* plants is by introgression. Therefore, OD considers that claim 7 encompasses an implicit breeding step that is excluded from patentability under Article 53(b) EPC in combination with decision G1/08 even if other methods like protoplast fusion could theoretically be used. OD considers that the method of claims 8 (production of fruits) and 9 (production of seeds) imply a step of crossing of the genomes that is necessary for fertilization. Such a step is considered to be excluded from patentability under Article 53(b) EPC in combination with decision G1/08. Moreover, seed

and fruit production are processes that happen in nature without any human intervention and have, therefore, to be considered as essentially biological processes excluded under Article 53(b) EPC. An essentially biological process as in claims 8 and 9 cannot be rendered technical by the omission of the step of selection, i.e. the only step requiring human intervention.

29.4 **Method of identification : claim 10.**

OD considers that claim 10 is not excluded from patentability under Article 53(b) EPC.

According to O, the method of claim 10 only makes sense as part of a method of breeding. Said method cannot be isolated from a breeding process and the opposed patent does not provide any example where the process of claim 10 could be used other than in breeding.

OD considers that the method of claim 10 is clearly a method of detection that does not refer explicitly or implicitly to any breeding step. While this method can be used in a breeding process, said method is not considered to be inextricably linked to the breeding process. Therefore, claim 10 is not considered to be excluded from patentability under Article 53(b) EPC.

30 **Auxiliary Request 1 (AR1) as filed on 13.01.2023.**

The claims of AR1 correspond to the claims of the MR with deletion of claims 8 and 9.

31 **Admissibility.**

O had no objections on the admissibility of the claims of the MR.

OD considers that the claims of AR1 represent a genuine attempt to overcome an objection under Article 53(b) EPC raised by O. The claims of AR1 are considered to be admissible.

32 **Exceptions to patentability; Article 53(b) EPC.**

OD considers that claim 7 of AR1 is not patentable under Article 53(b) EPC.

Claim 7 of AR1 corresponds to claim 7 of the MR.

Said claim cannot be considered as patentable under Article 53(b) EPC for the reasons already mentioned in point 29.3 above.

33 **Auxiliary Request 2 (AR2) as filed on 13.01.2023.**

The claims of AR2 correspond to the claims of the MR with the deletion of claim 7.

34 **Admissibility.**

O had no objections on the admissibility of the claims of AR2.

OD considers that the claims of AR2 represent a genuine attempt to overcome an objection under Article 53(b) EPC raised by O. The claims of AR2 are considered to be admissible.

35 **Exceptions to patentability; Article 53(b) EPC.**

OD considers that claims 7-8 of AR2 are not patentable under Article 53(b) EPC.

Claims 7-8 of AR2 correspond to claims 8-9 of the MR.

Said claims cannot be considered as patentable under Article 53(b) EPC for the reasons already mentioned in point 29.3 above.

36 **Auxiliary Request 3 (AR3) as filed on 13.01.2023.**

The claims of AR3 correspond to the claims of the MR with the deletion of claims 7-9.

37 **Admissibility.**

O had no objections on the admissibility of the claims of AR3.

OD considers that the claims of AR3 represent a genuine attempt to overcome an objection under Article 53(b) EPC raised by O. The claims of AR3 are considered to be admissible.

38 **Sufficiency of disclosure; Article 83 EPC.**

OD considers that the claims of AR3 do not comply with the requirements of Article 83 EPC.

38.1 **Admissibility of the submission of Mr. Haring.**

O requested the authorisation to let Mr. Haring speak as technical expert.

P requested that Mr. Haring is not allowed to speak during proceedings since it would be unclear what would be presented by Mr. Haring.

OD considers that the presence of Mr. Haring as technical expert has already been announced in the letter of 10.05.2016. OD considered the requirements of decision G 4/95 to be fulfilled and decided that Mr. Haring should be allowed to speak under the supervision of the representative of O.

38.2 According to P, the opposed patent provides two sources for the QTL : wild-type line CGN 16975 (previously AC 1979) and deposited line 061M4387 of the opposed patent. This QTL could be introgressed in different backgrounds as

shown in Tables 4 and 5 of the opposed patent. Moreover, the expert declaration D16 shows that it would be possible to put the application into practice using the markers of the opposed patent.

In agreement with O, OD considers that the opposed patent only provides for one specific QTL. The QTL present in line 061M4387 is considered to be the same as in the wild-type line CGN 16975. The claims of the opposed patent are not restricted to this specific QTL but would encompass QTL for resistance to Bemisia located at approximately the same position on chromosome 3 from any other source. The opposed patent does not provide any further source for such a QTL. Therefore, claim 1, 8 and 9 of AR3 are not considered to be sufficiently disclosed over the whole scope of the claim, i.e. as far as other sources for the QTL are concerned.

39 **Auxiliary request 4 as filed during oral proceedings.**

The claims of AR4 correspond to the claims of AR3 as filed on 13.01.2023 wherein the subject-matter of claim 3 has been integrated in claims 1, 7 and 8.

40 **Admissibility.**

O had no objection regarding the admissibility of the claims of the AR4.

OD considers that the claims of AR4 represent a genuine attempt to overcome an objection under Article 83 EPC raised by O. The claims of AR4 are considered to be admissible.

41 **Sufficiency of disclosure; Article 83 EPC.**

OD considers that claim 6 of AR4 does not comply with the requirements of Article 83 EPC whereas claims 1, 7 and 8 meet the requirements of Article 83 EPC.

41.1 **Product claims 1, 7 and 8.**

O considered that the claims of AR4 are not sufficiently disclosed because (1) at least some of the markers used in the claims are also present in plants that are not resistant to *Bemisia*, (2) the identification of the QTL of resistance to *Bemisia* using the markers would represent an undue burden of experimentation because information on the link between the QTL and the claimed markers is missing, (3) the markers are not sufficient to identify the QTL, (4) there is no information on the linkage between the markers and the QTL.

Claims 1, 7 and 8 of AR4 have been restricted to the QTL for resistance to *Bemisia* present in line 061M4387. This *C. annuum* line has been deposited for the purpose of the opposed patent. Therefore, a source for the QTL of the

present application has been disclosed. OD is convinced that the introgression of this specific QTL can be followed using the claimed primer pairs as illustrated in document D16 since these primer pairs will generate amplification fragments of different sizes depending on the genetic background of the plant observed. Moreover, it has been demonstrated in the opposed patent that the QTL for resistance to *Bemisia* can be introgressed in different *C. annuum* genetic backgrounds (Tables 4 and 5 of the opposed patent). Consequently, claims 1, 7 and 8 are considered to be sufficiently disclosed (Article 83 EPC).

41.2 **Method claim 6.**

O raised an objection of lack of sufficiency of claim 6 in relation to the feature "any other primer or primer pair that identifies a marker locus on chromosome 5 that is statistically correlated to *Bemisia* resistance trait".

According to P, claim 6 is very broad but the objection of O is not a matter of sufficiency.

OD agrees with O that claim 6 of AR4 is not sufficiently disclosed as far as the further markers are concerned. The opposed patent discloses several specific pairs of markers linked to the QTLs on chromosome 3 or 5 respectively. The opposed patent does however not provide any information how further primer pairs could be identified that would be linked to the QTLs of resistance to *Bemisia* on chromosome 3/5. Absent such information, the identification of further primer pairs linked to the QTLs would amount to a complete research program and consequently represents an undue burden of experimentation for the skilled person. Consequently, claim 6 of AR4 is not considered as sufficiently disclosed as far as it refers to general "other primer or primer pair that identifies a marker locus on chromosome 3/5 that is statistically correlated to *Bemisia* resistance trait" (Article 83 EPC).

42 **Auxiliary request 5 as filed during oral proceedings.**

The claims of AR5 differ from the claims of AR4 in that the feature "or any other primer or primer pair that identifies a marker locus on chromosome 3/5 that is statistically correlated to the *Bemisia* resistance trait" in claim 6 has been deleted.

43 **Admissibility.**

O did not object to the admissibility of the claims of AR5.

OD considers that the claims of AR5 represent a genuine attempt to overcome an objection under Article 83 EPC raised by O. The claims of AR5 are considered to be admissible.

44 **Sufficiency of disclosure; Article 83 EPC.**

In the claims of AR5, the features that had been considered to contravene Article 83 EPC in claim 6 of AR4 has been deleted. Consequently, the claims of AR5 are considered to comply with the requirements of Article 83 EPC.

45 **Novelty; Article 54 EPC.**

45.1 OD considers that the claims of AR5 lack novelty over the ancestor line CGN 16975 (Article 54 EPC).

Document D20 is a declaration of Mr. Visser that is considered to demonstrate the public availability of the wild-type line CGN 16975.

According to P, the claims of AR5 should be considered as novel over the wild-type ancestor line CGN 16975 because :

- the claims refer to a cultivated line whereas the ancestor wild-type line would not be considered as cultivated line. P cited documents D17 (point 7), D14 (page 3) and D15 (page 2).
- the material that has been deposited is a seed, not a plant as claimed.
- there is no evidence that the resistance of wild-type ancestor line CGN 16975 to *Bemisia* was available to the public at the date of filing of the opposed patent. P considers that document D20 and its annex are not clear about when the resistance to *Bemisia* of line CGN 16975 was known.
- the claimed plants present an intermediate resistance to *Bemisia*. According to paragraph [0095] of the opposed patent, this would mean a resistance should be between 6 and 8 whereas the wild-type ancestor present a resistance of 8.8 to 8.9 as illustrated in Table 2 of the opposed patent.

OD considers that the claims 1, 7 and 8 of AR5 lack novelty over the teaching of the wild-type ancestor line CGN 16975 because said line is considered to comprise the same QTLs of resistance to *Bemisia* as the deposited line 061M4387 since said line has been obtained by introgression of the QTLs present in ancestor line CGN 16975.

The feature "cultivated" is open to interpretation and cannot, therefore, be considered to represent a clear technical characteristic which would allow to distinguish the claimed plant from the ancestor line CGN 16975. Most of the characteristics disclosed in D15 for wild pepper could also be present in the cultivated pepper plants Moreover, OD is of the opinion that the ancestor line has also been "cultivated" as it has been grown for seed replication.

OD does not make any distinction between seed (as propagation material) and plant as a seed can be grown into a plant and the plant will produce seeds after fertilisation. Therefore, the fact that the deposited material is a seed is irrelevant for novelty. Moreover, it is clear that the seeds that have been made available to the public would be used for the generation of plants.

OD agrees with P that D20 does not unambiguously disclose that the resistance to *Bemisia* of line CGN 16975 was available to the public at the filing date of the present application. However, the presence of a QTL according to the opposed patent and the corresponding resistance to *Bemisia* are considered as implicit features of the ancestor line.

OD considers that the feature "intermediately resistant to *Bemisia*" as present in claims 1, 7 and 8 of AR5 is vague since no value have been given in the claims for the intermediate resistance and, more importantly, the nature of the assay to determine the resistance is not given. Without this information, it is impossible to unambiguously assess if a plant according to claims 1, 7 or 8 of AR5 will differ from the ancestor line CGN 16975 in terms of its resistance. OD also notes that in Table 2 of the opposed patent, it is not clear if the assays for the ancestor line have been done under the same conditions as the assays for deposited line 061M4387 since the experiments have been realised in different years and it is not clear from Table 1 if the assays have been done under the same insect pressure. At least the assay for the ancestor line in Dec. 2002 seems to have been done under relatively low insect pressure whereas the assays for deposited line 061M4387 seem to have been done under moderate to very high insect pressure. Therefore, it is not possible to conclude from Table 1 of the opposed patent if the *Bemisia* resistance of the ancestor line differs from the *Bemisia* resistance of line 061M4387.

Therefore, claims 1, 7 and 8 of AR5 are considered to lack novelty over the ancestor line CGN 16975 (Article 54 EPC).

46 **Auxiliary Request 6 as filed during oral proceedings.**

The claims of AR6 correspond to the claims of AR5 with the further feature that the "cultivated *Capsicum annuum* plant is a sweet pepper, a bell pepper, a big rectangular pepper, a conical pepper, a long conical pepper or a blocky-type pepper plant".

47 **Admissibility.**

O had no objections against the admissibility of the claims of AR6.

OD considers that the claims of AR6 represent a genuine attempt to overcome an objection under Article 54 EPC raised by O. The claims of AR6 are considered to be admissible.

48 **Added subject-matter; Article 123(2) EPC.**

OD considers that the claims of AR6 comply with the requirements of Article 123(2) EPC.

According to O, the different pepper forms now claimed have been mentioned in the description in a speculative form. Therefore, the introduction of these features in claims 1, 7 and 8 would contravene Article 123(2) EPC.

OD considers that the new features of claims 1, 7 and 8 find basis on p. 32 of the application as published. It is clear that this feature was meant to be combinable with any plant of the application.

49 **Clarity; Article 84 EPC.**

OD considers that the claims of AR6 lack clarity in the sense of Article 84 EPC.

According to P, the claimed forms allow to distinguish what is claimed from the ancestral line and should be considered as clear enough for the skilled person. According to P, D14 shows that this is how pepper plants are characterized.

OD considers that the terms used to characterize the pepper plant in claims 1, 7 and 8 of AR6 are relative and open to interpretation. Therefore, these terms are considered unclear.

50 **Auxiliary Request 7 (AR7) as filed during oral proceedings.**

The claims of AR7 correspond to the claims of AR6 with the deletion of the features relating to the form of the pepper plant. The pepper plant is now characterized as being a sweet pepper.

51 **Admissibility.**

O had no objections to the admissibility of the claims of AR7.

OD considers that the claims of AR7 represent a genuine attempt to overcome an objection under Article 84 EPC raised by O. The claims of AR7 are considered to be admissible.

52 **Clarity; Article 84 EPC.**

OD considers that the claims of AR7 as filed during oral proceedings lack clarity (Article 84 EPC).

According to P, the term "sweet pepper" is clear for the skilled person. P considers that this would be assessed by reference to an European person.

In agreement with O, OD considers that the term "sweet pepper" is open to interpretation and might have different definitions depending on the cultural background of those assessing the term. Therefore, no clear distinction exists between sweet pepper of the claims and the so-called hot peppers. Consequently, the feature "sweet pepper" is considered to lack clarity contrary to the requirements of Article 84 EPC.

53 **Auxiliary Request 8 (AR8) as filed during oral proceedings.**

The claims of AR8 correspond to the claims of AR5 with the additional feature "and wherein said plant is an inbred, a dihaploid or a hybrid and/or male sterile" in claims 1, 7 and 8.

54 **Admissibility.**

O had no objections to the admissibility of the claims of AR8.

OD considers that the claims of AR8 represent a genuine attempt to overcome an objection under Article 84 EPC raised by O. The claims of AR8 are considered to be admissible.

55 **Clarity; Article 84 EPC.**

OD considers that the claims of AR8 comply with the requirements of Article 84 EPC.

According to O, the terms inbred, dihaploid, hybrid and/or male sterile are vague feature and have no clear definition in the description.

OD considers that the features inbred, dihaploid, hybrid and/or male sterile are clear features for the skilled person in the field of plant breeding. Therefore, the claims of AR8 are considered to be clear.

56 **Novelty; Article 54 EPC.**

OD considers that the claims of the MR are novel in the sense of Article 54 EPC.

According to O, the additional features do not allow to distinguish the claimed plants from the the ancestor line CGN 16975. O considers that the claims of AR8 cover all the possibilities disclosed in the opposed patent and cannot, therefore, contribute to novelty.

OD considers that the feature inbred, dihaploid, hybrid and male sterile are valid distinguishing technical features. There is no evidence on file that the ancestor line CGN 16975 is an inbred line, a dihaploid line, a hybrid or male sterile. Therefore, the claims of AR8 are considered to be novel over the ancestor line CGN 16975.

57 **Inventive step; Article 56 EPC.**

OD considers that the claims of AR8 are inventive in the sense of Article 56 EPC.

57.1 **Admissibility of the presentation of Mr. Haring.**

O requested Mr. Haring to be allowed to comment about inventive step.

P was opposed to the hearing of Mr. Haring and considered that the opinion of a technical expert would not be relevant for questions relating to inventive step.

OD considered the requirements of decision G 4/95 to be fulfilled and decided to allow Mr. Haring to present his comments on inventive step under the responsibility of the representative of O.

57.2 **Ancestor line CGN 16975 as the closest prior art.**

According to O, the ancestor line CGN 16975 was known and accessible to the public at the filing date of the opposed patent. According to O, the fact that this ancestor line was resistant to *Bemisia* must have been known at the date of filing of the opposed patent. Therefore, according to O, the problem to be solved by the opposed patent can be seen as the identification of markers associated to *Bemisia* resistance. This would be obvious in the light of document D10 that already discloses the use of markers to identify *C. annuum* plants resistant to other pathogens. O considers that the skilled person would need no inventive step to apply the teaching of D10 to the *Bemisia* resistant ancestor line CGN 16975.

OD considers that, based on the evidence on file, it is not clear if the resistance to *Bemisia* of ancestor line CGN 16975 was known to the public at the relevant filing date of the opposed patent. Without this information, the skilled person would not have any motivation to isolate a QTL for resistance to *Bemisia* in this specific line. Therefore, the claims of AR8 are considered to be inventive over the ancestor line CGN 16975.

57.3 **Document D1 as the closest prior art.**

O considers that document D1 discloses in Table 4 *C. annuum* plants resistant to *Bemisia*. Therefore, the problem to be solved by the opposed patent in the light of D1 is the identification of markers associated to *Bemisia* resistance. According to O, this would be obvious in the light of document D10 that already discloses the use of markers to identify *C. annuum* plants resistant to other pathogens. O considers that the skilled person would need no inventive step to apply the teaching of D10 to the *Bemisia* resistant *C. annuum* plants disclosed in Table 4 of D1.

OD is not convinced that document D1 discloses *Bemisia* resistant plants. OD considers that resistance to ToLCBV cannot be equated to resistance to *Bemisia* since the plant could be resistant to the virus without necessarily being resistant to the host *Bemisia*. Moreover, OD considers that the teaching of D1 on tomato will not necessarily apply to *C. annuum*. OD also notes that D1 does not contain any information on the QTL that would be responsible for the observed resistance. Therefore, starting from D1, the skilled person would not be able to identify a QTL for *Bemisia* resistance and the markers associated thereto without inventive activity.

57.4 **Document D28 as the closest prior art.**

O also raised an objection of lack of inventive step based on document D28 that discloses markers of the present application. According to O, the problem to be solved in the light of this document would be the identification of a QTL associated with the known markers.

OD considers that document D28 does not represent the closest prior art because this document does not disclose resistance to *Bemisia.* The person skilled in the art would thus not use the markers disclosed in D28 to obtain *C. annuum* plants resistant to *Bemisia*.

58 **Adaptation of the description.**

P adapted the description of the opposed patent to the claims of AR8.

The representative of O voluntarily left oral proceedings before the adaptation of the description. Consequently, no objections on the adapted description were raised by O.

OD considers that the description has been sufficiently adapted to the claims of AR8.

59 **Request to address the Administrative Council with regard to Rule 28(2) EPC.**

In the written procedure, O requested to address the EPO's Administrative Council on the question of retroactive applicability of Rule 28(2) EPC. An EPO opposition division is not competent to deal with such a request under the EPC.

As a consequence, the request is rejected as inadmissible.

60 **Claims for cost.**

In the letter filed in electronic form on 08.06.2016, P requested the EPO to compensate P for its travel costs. This request has been formally maintained by P during oral proceedings.

The P's claim for cost is a claim against the Organisation falling under Article 9 EPC. OD is not competent to deal with or decide such requests.

61 **Decision.**

The opposition has come to the conclusion that taking into consideration the amendments made during opposition proceedings, the patent and the invention to which it relates meet the requirements for patentability of the EPC. The patent will be maintained in amended form under Article 101(3)(a) EPC on the basis of the claims of AR8 and the description adapted thereto as filed during oral proceedings, provided that the requirements of Rule 82(2) EPC are fulfilled.