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Anmelder / Applicant / Demandeur // Patentinhaber / Proprietor / Titulaire Monsanto Invest N.V.		

Appeal number: **T1045/16-3.3.04**

Communication of the Board of Appeal pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal

The Rapporteur A. Chakravarty
The Registrar I. Aperribay
Tel.: 089 / 2399 - 3341

Registered letter

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Annex(es):

Communication text

1. This communication serves in the preparation for the oral proceedings scheduled for **12 November 2020.** It represents the board's preliminary appreciation of some of the substantive and legal matters concerning the

appeal and is as such not binding on the board (Article 17(2) RPBA).

2. A new version of the Rules of Procedure of the Boards of Appeal (RPBA)) entered into force on 1 January 2020. The transitional provisions are set out in Article 25 RPBA. In the present case the statement of grounds of appeal and the reply thereto were filed before 1 January 2020. Thus, Article 12(4) to (6) RPBA does not apply and, instead, Article 12(4) RPBA 2007 applies to both the grounds of appeal and the reply.

3. Article 13 RPBA applies to all further submissions of the parties.

4. The appeal of the patent proprietor lies from the decision of the opposition division to revoke European patent EP 1 962 578. Opponent 1 and opponent 2 are respondent I and respondent II to this appeal.

5. 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. It follows that a dealing with the appeal will involve reviewing the opposition division's decision on the sufficiency of disclosure of the invention.

6. The appellant's requests as understood by the board are as follows:

- that the decision of the opposition division be set aside and that the case be remitted to the opposition division for the assessment of inventive step;

- alternatively, if the board were to hold that the claims of the main request (claims as granted) meet the requirements of Article 83 EPC, but not of Article 54

or 56 EPC, that the patent be maintained on the basis of one of auxiliary request 1 to 7 submitted with the statement of grounds of appeal;

- that document D20, a declaration of Jeroen de Vries, and document D21, both filed with the statement of grounds of appeal, not be held inadmissible.

7. The requests of respondent I as understood by the board are as follows:

- that the appeal be dismissed;

- that documents D20 and D21 not be admitted into the proceedings.

8. The requests of respondent II as understood by the board are as follows:

- that the appeal be dismissed;

- that documents D22 to D24, filed with the reply to the statement of grounds of appeal, not be excluded from the proceedings.

Admissibility of the opposition of opponent 2

9. The appellant questioned the admissibility of the opposition of opponent 2. In the board's preliminary view, the opponents comprised in the joint opposition are the entities and the individual persons indicated in bold in the notice of opposition of opponent 2, dated 3 February 2012. It also appears that Christopher Then, whose name is indicated in bold in the notice of opposition, is one of the joint opponents. Finally, it is also apparent that Christopher Then is the common representative of the joint opponents.

10. Therefore, the potential unclarity of whether one of the signatories of the opposition signed as individual person or as representative of a group could affect the admissibility of the opposition as whole appears to be irrelevant for the present proceedings.

11. Thus, the board considers that the opposition of opponent 2 is admissible.

Admission of documents D20 and D21 filed with the statement of grounds of appeal

12. As a rule, appeal proceedings are based on a party's case as submitted with the statement of grounds of appeal or the reply thereto (Article 12(1) and (2) RPBA). Pursuant to Article 12(4) RPBA 2007 the board may hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first instance proceedings.

13. Documents D20 and D21 were submitted in response to the finding in the decision under appeal that *"It [...] appears in no way certain that a skilled person would today and over the whole term of the patent be in a position to obtain seed of PI313970 which carries the desired trait without undue burden*" (see decision under appeal, page 12, paragraph 4). The board is therefore inclined to admit these documents.

14. The following concerns the main request. Auxiliary requests 1 to 7 have been filed to address issues under Article 54 or Article 56 EPC. As will become apparent below, the board is of the preliminary view that neither of these provisions will be a topic in the appeal proceedings.

Main request (claims as granted)

Disclosure of the invention - Article 83 EPC - Claim 1

15. The opposition division held that the claimed subject matter did not meet the requirements of Article 83 EPC because - "*it is not credibly proven beyond reasonable doubt that the claimed biological material is available to the public over the whole term of the patent without restrictions*" (decision under appeal, 6.5.7).

16. 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 PI 313970. 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.

17. Rule 31(1)(a) EPC stipulates that if an invention involves the use of biological material which is not publicly available, for this invention to be considered as being sufficiently disclosed a sample of that material has to be deposited with a recognised institution on the same terms as those laid down in the Budapest Treaty.

18. The board understands 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 (see statement of grounds of appeal, page 13).

19. In this context it may be asked whether "available to the public" in the sense of Rule 31(1)(a) EPC means the same as in Article 54 EPC. If the meaning is not the

same then it may be asked 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.

20. A further question is whether the deposited biological material is actually that required to guarantee that the skilled person can carry out the invention in the sense of Article 83 EPC. If the board comes to the conclusion that a deposit of a specific biological material at the US National Plant Germplasms System could fulfill the notion of "public availability", then it may be asked whether the biological material is maintained by the depository institution such that it reliably comprises the required QTL and marker (see decision under appeal, 6.5.7 and point 43 of the respondent II's reply to the statement of grounds of appeal).

21. The parties will therefore be heard on these matters at the oral proceedings.

All claims

Article 53(b) EPC - Exceptions to patentability

22. Respondent II considers that the claimed subject-matter relates to plant varieties, which are excepted from patentability. In this context, the board has noted that claim 3 refers to an inbred plant, which due to its inbred nature would appear to fulfil the definition of plant variety set out in Rule 26(4) EPC.

23. Respondent II also considers that the claimed subject-matter relates to the products of an essentially

biological process excepted from patentability. This issue has been settled by the Enlarged Board of Appeal in opinion G 3/19, according to which Article 53(b) EPC has a negative effect on the patentability of plants exclusively obtained by means of an essentially biological process, but that this negative effect does not apply to European patents containing such claims which were granted before 1 July 2017, when Rule 28(2) EPC entered into force. In the present case therefore Rule 28(2) EPC does not apply to the patent in suit.

Article 53(a) EPC - Exceptions to patentability

24. Respondent II has also argued that the claimed invention is in contravention of the morality and *ordre public* requirements of Article 53(a) EPC because the source of the biological material used in the invention was obtained without prior informed consent in accordance with the Nagoya protocol on access and benefit sharing.

25. To the boards its knowledge, at least for the EU member states, the corresponding access and benefit sharing regulation, which implements the Nagoya Protocol at the EU level, entered into force on 9 June 2014 and has applied since the Nagoya Protocol itself entered into force for the EU, on 12 October 2014. The patent in suit has an effective date of 21 December 2005.

26. Article 53(a) EPC provides that European patents shall not be granted in respect of inventions **the commercial exploitation of which** would be contrary to "*ordre public*" or morality (emphasis added by the board). Thus, Article 53(a) EPC seems to refer to the future exploitation of an invention, after it has been made, and not to acts performed in developing claimed subject-matter.

27. In the board's preliminary opinion, the commercial exploitation of the presently claimed invention would not be contrary to morality and *ordre public* requirements, since such exploitation would not require accessing genetic resources in a provider country.

Novelty - Article 54 EPC

28. In relation to Article 54 EPC, Article 56 EPC and Article 123(2) EPC respondent I stated: "*We rely on the facts and arguments as we have previously submitted before the first instance Opposition Division in our Notice of Opposition or in our written submissions before the first instance Opposition Division*". This statement is not considered by the board to constitute a substantiated reasoning why the decision under appeal is wrong.

29. Respondent II's reply to the statement of grounds of appeal contains no objection to the opposition division's finding on novelty.

30. Thus, the board does not presently intend to deal with the issue of novelty in this appeal.

Inventive step - Article 56 EPC

31. The opposition division did not take a decision on the obviousness of the claimed subject matter. Should the board decide that the subject matter of a claim request meets the requirements of Article 83 EPC and of Article 53(a) and (b) EPC, it is inclined to remit the case to the opposition division for further prosecution.