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Appeal number: **T0420/19-3.3.04**

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

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Annex(es):

Communication text

1. This communication serves in the preparation for the oral proceedings scheduled for **25 June 2021.** It represents the board's preliminary appreciation of substantive and legal matters concerning the appeal and is as such not binding on the board (Article 17(2) RPBA).

The decision under appeal and the appeals

2. In an interlocutory decision, the opposition division decided that, account being taken of the amendments in the form of auxiliary request 8, the patent and the invention to which it related met the requirements of the EPC (Article 101(3)(a) EPC).

With regard to the higher ranking claim requests, the opposition division held that:

- the subject-matter of claim 6 of the main request and of auxiliary requests 1, 3, 4, 6 and 7 was excepted from patentability pursuant to Article 53(b) EPC; and

- the subject-matter of claim 6 of auxiliary requests 2 and 5 did not meet the requirements of Article 83 EPC.

3. The patent proprietor (appellant I) and the opponents (appellant II) filed appeals against this decision.

Rules of Procedure

4. Unless otherwise indicated, reference to the RPBA in this communication is to the RPBA (OJ EPO 2020, supplementary publication no. 1, III.2) which entered into force on 1 January 2020 and apply to any appeal case pending on that date (Article 24(1) and Article 25(1) RPBA).

5. Pursuant to Article 25(2) RPBA, new Article 12(4) to (6) does not apply to appeals where the statement of grounds of appeal was filed before 1 January 2020. Instead, Article 12(4) RPBA 2007 continues to apply. This is the case for the present appeal.

6. Any further submissions of the parties are subject to the provisions of Article 13 RPBA.

Requests

7. With the statement of grounds of appeal, appellant I filed sets of claims of auxiliary requests 1 to 10. A set of claims of auxiliary request 11 was filed with the reply to the statement of grounds of appellant II.

8. Appellant I's requests are:

As the main request, that the decision under appeal be set aside and that the opposition be rejected. Alternatively, the patent should be maintained on the basis of one of auxiliary requests 1 to 11.

Moreover, only grounds raised and properly substantiated in the notice of opposition i.e. only the ground under Art. lOO(a) and Art. 53(b) should be examined during the appeal proceedings.

9. Appellant II's request is that the decision under appeal be set aside and that the patent be revoked in its entirety.

Preliminary comments of the board

10. To aid their preparation for the requested oral proceedings, the board provides the following information to the parties on its preliminary view on some key issues.

Main request - claim 6

Exceptions to patentability (Article 53(b) EPC)

11. 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."

12. 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).

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

14. The above applies to all claims in all sets of claim requests whose subject-matter is plants or plant material.

Admission of ground of opposition pursuant to Article 100(b)/83 EPC

15. Appellant I has requested the board to reverse the opposition division's decision to admit the ground of opposition under Article 100(b) EPC.

16. The decision to admit, or not, grounds of opposition which are allegedly new, is a discretionary decision. In such cases the boards of appeal generally restrict their review to whether or not opposition division exercised its discretion correctly (see Case Law of the

Boards of Appeal of the European Patent Office, 9th edition 2019, IV.C.4.5.2). In view of the reasons given in the decision under appeal (see point 19ff), the board is of the preliminary view that the opposition division's exercise of discretion was according to the right principles and reasonable and thus is inclined not to reverse the opposition division's decision and thus to reject appellant I's request.

Disclosure of the invention (Article 83 EPC)

17. It appears that the reasoning given by the opposition division for claim 6 of auxiliary request 2 would apply equally to the subject-matter of claim 6 of the main request and of auxiliary request 1. However, the board is in preliminary agreement with appellant I that this subject-matter meets the requirements of Article 83 EPC, essentially for the reasons set out in their statement of grounds of appeal, page 11, second paragraph ff.

Inventive step (Article 56 EPC)

18. Appellant I also argued that the ground of opposition pursuant to Article 100(a) EPC and Article 56 EPC should not have been examined by the opposition division due to lack of substantiation.

19. The board is of the preliminary view that the opposition division was right to consider this ground of opposition as having been substantiated, essentially for the reasons set out in the decision under appeal at point 35.

20. The subject-matter of claim 6 of the main request is an MMT null mutant barley plant (in this communication, the board will use plant to refer to both plants and

parts thereof). The plant is not characterised further, e.g. by a specific mutation.

21. The board considers that document D1 can be taken to represent the closest prior art for the subject-matter of claim 6 because it discloses MMT null mutant plants, namely maize and Arabidopsis. The difference between the claimed plant and those described in document D1 is the plant species, i.e. barley rather than maize or Arabidopsis.

22. In view of this difference, the problem to be solved can be seen as the provision of a null mutant MMT plant of a different species.

23. It appears that the skilled person starting from the disclosure in document D1 and seeking to solve the above problem would have been able to provide an MMT null mutant in any transformable plant species simply by adapting the scheme set out in document D1 (see page 1809, right-hand column). The board is therefore of the preliminary view that the claimed subject matter lacks an inventive step.

Auxiliary requests 1 to 11 - claim 6

24. The subject-matter of all of these claims is an MMT null mutant barley plant. In auxiliary requests 3 to 11, the mutation in the plant is further structurally characterised. However, no particular technical effect appears to be be associated with these claimed embodiments, which may therefore be regarded as selections from a range of equally obvious alternatives. A selection under those circumstances is often referred to in the case law as "arbitrary". Arbitrary selections are considered to lack an inventive step for that very reason (cf. Case Law of

the Boards of Appeal of the European Patent Office, I.D.9.19.7).

25. In view of the above, no claim request appears allowable. Thus the appeal of appellant I would be dismissed, whereas that of appellant II would be allowed.

26. The parties are reminded of Rule 103(3)(a) EPC.