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D E C I S I O N
of 13 September 2004

Case Number: T 0161/02 - 3.3.8

Application Number: 92111827.9

Publication Number: 0513849

IPC: C12N 5/04

Language of the proceedings: EN

Title of invention:
Method of preparing transgenic Zea mays plants regenerated from protoplasts or protoplast-derived cells

Patentee:
Syngenta Participations AG

Opponents:
Bayer CropScience S.A.
Bayer BioScience N.V.
Advanta Seeds B.V.

Headword:
Transgenic Zea mays plants/SYNGENTA

Relevant legal provisions:
EPC Art. 123(2), 84

Keyword:
"Main and auxiliary requests - disclaimer - offence against Article 123(2) EPC (yes) - unclear (yes)"

Decisions cited:
G 0001/93, G 0001/03, G 0002/03, T 0507/99

Catchword:
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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0161/02 - 3.3.8

D E C I S I O N
of the Technical Board of Appeal 3.3.8
of 13 September 2004

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Decision under appeal:
Decision of the Opposition Division of the European Patent Office posted 7 December 2001 revoking European patent No. 0513849 pursuant to Article 102(1) EPC.

Composition of the Board:

Chairman: L. Galligani
Members: M. R. Vega Laso
S. C. Perryman

Summary of Facts and Submissions

I. European patent No. 0 513 849 with the title "Method of preparing transgenic Zea mays plants regenerated from protoplasts or protoplast-derived cells" was granted with 66 claims based on European patent application No. 92 111 827.9, filed as a divisional application of the European patent application No. 88 810 309.0 which claimed the priority of four US applications.

II. Four notices of opposition were filed. Opponent 2 withdrew its opposition when the case was pending before the opposition division.

III. By a decision within the meaning of Article 102(1) EPC dated 7 December 2001 the opposition division revoked the patent. In its decision, the opposition division held *inter alia* that claim 35 of the main request and claim 1 of the auxiliary request then on file offended against both Article 123(2) EPC and Article 123(3) EPC.

IV. The patentee (appellant) lodged an appeal against the decision of the opposition division, and together with the statement of grounds of appeal filed a new main request (claims 1 to 66) and a new auxiliary request (claims 1 to 13) in place of the requests previously on file.

In the new **main request** amendments to claims 1, 5, 35, 36, 37, 38, 60 and 62 as granted were introduced. Amended claim 35 read as follows:

"35. A method for protecting a *Zea mays* plant against damage caused by insects, fungi or viruses or a herbicidal chemical, which does not involve an *Agrobacterium* transfer microorganism and wherein a chimeric gene encoding a protein is stably incorporated into the genome of the *Zea mays* plant to be protected by means other than contacting plant cell material with a transformation solution comprising exogenous DNA which does not contain parts or all of the T-DNA border sequences of an *Agrobacterium* Ti plasmid and a membrane permeating agent in the presence of an electric current and wherein upon expression in the cells of said plant an amount of the encoded protein is produced that is sufficient to provide the *Zea mays* plant with the respective resistance."

In the **auxiliary request** claims 1 to 34, 36 to 45 and 51 to 59 as granted were deleted and the remaining claims renumbered accordingly. New claim 1, which included features of claims 35 and 45 as granted, read as follows:

"1. A method for protecting a *Zea mays* plant against damage caused by insects, which does not involve an *Agrobacterium* transfer microorganism and wherein a chimeric gene is stably incorporated into the genome of the *Zea mays* plant to be protected by means other than contacting plant cell material with a transformation solution comprising exogenous DNA which does not contain parts or all of the T-DNA border sequences of an *Agrobacterium* Ti plasmid and a membrane permeating agent in the presence of an electric current and wherein the transformed plant including the progeny thereof expresses the encoded polypeptide in an amount

sufficient to render the plant unattractive to insect larvae."

V. Respondents I and III (opponents 1 and 4) submitted comments on the statement of grounds of appeal and the new requests filed by the appellant.

VI. Both the appellant and respondent I requested oral proceedings, should their respective requests not be accepted by the board. The parties were summoned to oral proceedings to be held on 21 September 2004, and in a communication pursuant to Rule 11(1) of the Rules of Procedure of the Boards of Appeal sent with the summons, the board expressed its preliminary non-binding opinion on the issues of Article 123(2) and (3) EPC, indicating in particular that there were objections against the amended claim 35 of the main request and amended claim 1 of the auxiliary request, and drawing the parties attention to decisions G 1/03 and G 2/03 (OJ EPO 2004, 413 and 448) in relation to the introduction of disclaiming features.

VII. On 31 August 2004, the appellant withdrew its request for oral proceedings and informed the board that it would not be represented at the oral proceedings. The appellant requested that a decision be taken on the basis of its written submissions.

VIII. The oral proceedings were cancelled by the board on 10 September 2004 since no request remained which would have necessitated oral proceedings to be held.

IX. The documents referred to in the present decision are the following:

(R39): EP-A-0 267 159

(R43): EP-A-0 290 395

X. The appellant's submissions in writing were as follows:

The opposition division erred in its finding that the application as filed neither explicitly nor implicitly disclosed methods for protecting plants in the general terms set out in claim 35 of the main request or claim 1 of the auxiliary request. When the wording of a claim could be found in the application - as admitted by the opposition division -, it was wrong to conclude that the application did not disclose what could be found in the application. Claim 97 of the application as originally filed covered subject-matter identical to that of claim 1 of the auxiliary request.

The objection to the disclaimer of the subject-matter of document (R39) under Article 123(2) EPC was met by the specific mention of *"an Agrobacterium transfer microorganism"* in the amended claim 35 of the main request (and claim 1 of the auxiliary request).

The re-introduction of the feature *"does not contain T-DNA border sequences"* into claim 35 of the main request and claim 1 of the auxiliary request responded to the objection raised by the opposition division under Article 123(3) EPC. And yet it made no sense to include T-DNA border sequences in the absence of a transfer organism.

XI. Respondent I's arguments, as far as they are relevant to the present decision, can be summarized as follows:

The objections under Article 123 EPC which the patentee tried to overcome with the new requests were already raised by the opponents at the outset of the proceedings. In spite of the negative preliminary opinion of the opposition division in its communication under Rule 71a EPC, the patentee had chosen not to attend the oral proceedings and yet to pursue the defence of the patent in appeal, thus protracting the proceedings and generating unnecessary costs for the opponents. Patentee's approach amounted to a tactical abuse of procedure. The patentee should not be given a further opportunity to introduce new amendments. Thus, the board was requested to exercise its discretion under Article 114(2) EPC to not admit the requests filed on appeal. Besides, the new main request was not admissible under Rule 57a EPC.

Claim 35 of the main request and claim 1 of the auxiliary request contravened Article 123(2) EPC. Firstly, the disclaimer introduced in an attempt to distinguish over the subject-matter of document (R39) did not reflect the disclosure of this document. Secondly, the disclaimers for the subject-matter of documents (R39) and (R43) were combined together to produce a "chimeric disclaimer" reflecting neither the subject-matter of (R39) nor that of (R43). And thirdly, claim 35 did not include a step of protoplast production. Support for claim 1 of the auxiliary request as indicated by the patentee (claim 97) could

not be found in the present divisional application, but only in the parent application.

The disclaimer relating to T-DNA border sequences in claim 35 was already present in the claims as granted, but in a different context. The change in the context of the disclaimer gave rise to an extension of the scope of protection (Article 123(3) EPC).

The only positive features of claim 35 of the main request were defined in terms of a result to be achieved. Also, in the disclaimer for the subject-matter of document (R39) it was not clear what was meant by *"Agrobacterium transfer microorganism"*, and consequently the scope of the claim could not be determined. The term "unattractive" in claim 1 of the auxiliary request had no clearly defined meaning. Thus, the new requests offended against Article 84 EPC.

XII. Respondent III fully endorsed the decision of the opposition division. In the respondent's view the new requests filed in appeal were clearly not allowable because they did not overcome the objections raised by the opposition division in connection with the requests then on file. The new requests were also late-filed. The appellant had full opportunity to put forward alternative requests in the opposition procedure. Therefore, the new requests should not be considered by the board.

XIII. The appellant requested that the decision under appeal be set aside und that the patent be maintained on the basis of either the main request or the auxiliary

request as filed with the statement of grounds of appeal.

XIV. The respondents requested that the appeal be dismissed.

Reasons for the Decision

Admissibility of the appeal and of the new requests into the proceedings

1. The respondents have questioned the admissibility into the proceedings of the new main request and auxiliary request submitted by the appellant with its statement of grounds of appeal, alleging that the new requests are late-filed and clearly not allowable, and that its submission constitutes an abuse of procedure. The Board cannot see here an abuse of procedure by the appellant such as would throw doubt on the admissibility of the appeal, for which all the formal requirements have been fulfilled, or on the admissibility of the appellant's requests into the proceedings other than for the reason that these requests do not meet the substantive requirements of the European Patent Convention. This latter issue is discussed below.

Main request - Article 123(2) and (3) EPC

2. In decisions G 1/03 and G 2/03 (*supra*), the Enlarged Board of Appeal established the criteria to be applied for assessing the allowability of a disclaimer which is not disclosed in an application as filed. In response to question 2(b) in decision T 507/99 (OJ EPO 2003, 225) of the referring board, as to how a disclaimer

occasioned by prior art should be drafted, the Enlarged Board of Appeal decided that a disclaimer should not remove more than is necessary to restore novelty, and that the fact that a disclaimer is required cannot be seen as an opportunity for the applicant (or patentee) to reshape its claims arbitrarily. Moreover, claims containing disclaimers must, as any other claims, meet the requirements of conciseness and clarity of Article 84 EPC (see point 3 of the Reasons for the decision).

3. It follows from the well-established jurisprudence of the boards of appeal that both the question as to whether or not a limiting feature introduced into a claim, for instance an undisclosed disclaimer, is to be considered as added subject-matter within the meaning of Article 123(2) EPC, and the question as to whether a claim containing such a limitation fulfils the requirements of conciseness and clarity, can only be decided on the basis of the facts of each individual case (with respect to Article 123(2) EPC see, for instance, decision G 1/93 of the Enlarged Board of Appeal, OJ EPO 1994, 514, point 17 of the Reasons).

4. In the present case, claim 35 of the main request includes two undisclosed disclaimers incorporated by way of amendment, these disclaimers being intended to exclude from the scope of the claim subject-matter which was disclosed in prior art under Article 54(3) and (4) EPC cited in the opposition procedure. The first disclaimer reads:

> *"... which does not involve an Agrobacterium transfer microorganism..."*,

and its introduction aims at excluding from the scope of claim 35 methods involving an *Agrobacterium* transfer microorganism as disclosed in document (R39).

The second disclaimer reads:

> *"... by means other than contacting plant cell material with a transformation solution comprising exogenous DNA* ***which does not contain parts or all of the T-DNA border sequences of an Agrobacterium Ti plasmid*** *and a membrane permeating agent in the presence of an electric current ..."* (emphasis added by the board)

and is intended to exclude from the claim subject-matter that has been disclosed in document (R43). However, this disclaimer includes a negative feature (in bold) which was introduced into claim 35 during the examination of the application for delimiting the claimed subject-matter against document (R39), and was thus present in claim 35 as granted, yet in a different context.

5. Thus, the second disclaimer in claim 35 of the main request combines features that arise from two different documents of the prior art, the combination of these features resulting in a disclaimer that corresponds to neither the disclosure of document (R39) nor that of document (R43), and that – as acknowledged by the appellant – does not make any technical sense. In the view of the board, such a disclaimer not only does not meet the requirements of Article 123(2) EPC, but also renders claim 35 of the main request unclear within the

meaning of Article 84 EPC, as it does not allow the public to find out what is protected and what it is not protected.

6. Moreover, in view of said lack of clarity the board cannot exclude that the combination of the negative feature already present in claim 35 as granted, with features reflecting the disclosure of document (R43) may lead to an extension of the protection conferred by the patent as granted (cf. Article 123(3) EPC).

Auxiliary request

7. Since claim 1 of the auxiliary request includes the same disclaimers discussed above, the findings with respect to the main request apply *mutatis mutandis* also to the auxiliary request.

Conclusion

8. Neither the main request nor the auxiliary request as presently on file can be allowed as at least one claim therein does not meet the requirements of the EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

A. Wolinski L. Galligani