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Datasheet for the decision of 30 January 2008

Case Number: T 1099/06 - 3.3.08

Application Number: 88105808.5

Publication Number: 0290799

IPC: C12N 15/00

Language of the proceedings: EN

Title of invention:
Transgenic dicotyledonous plant cells and plants

Patentee:
Max-Planck-Gesellschaft zur Förderung der Wissenschaften e.V.

Opponent:
BASF Plant Science GmbH

Headword:
Transgenic plants cells/MAX PLANCK

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
"Earlier decision in examination appeal proceedings binding in current opposition appeal proceedings (no)"
"Main request - compliance with Article 123(2) (no)"

Decisions cited:
T 0167/93, T 0823/96, T 0984/00

Catchword:
see points 1 to 7 of the Reasons.

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 1099/06 - 3.3.08

D E C I S I O N
of the Technical Board of Appeal 3.3.08
of 30 January 2008

Appellant I: (Patent Proprietor)
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Decision under appeal:
Interlocutory decision of the Opposition Division of the European Patent Office posted 2 May 2006 concerning maintenance of European patent No. 0290799 in amended form.

Composition of the Board:

Chairman: L. Galligani
Members: P. Julià
C. Rennie-Smith

Summary of Facts and Submissions

I. European patent No. 0 290 799 with the title "Transgenic dicotyledonous plant cells and plants" was granted with four claims based on European patent application No. 88 105 808.5, which was a divisional application to the European patent application No. 83 112 985.3 (published as EP 0 116 718).

II. The patent was opposed on the grounds as set forth in Articles 100(a),(b) and (c) EPC. The opposition division considered that the main request (claims as granted) did not fulfil the requirements of Article 123(2) EPC and the patent was maintained in amended form on the basis of a first auxiliary request filed on 29 November 2005.

III. Claim 1 of the **main request** (claims as granted) read as follows:

"1. A cell of a dicotyledonous plant, obtainable by Agrobacterium transformation, which contains stably integrated into its genome a foreign DNA which is characterized in that:

(a) it does not contain T-DNA genes that control neoplastic growth and it is substantially free of internal T-DNA sequences of a wild-type Ti-plasmid except for promoter sequences; and
(b) it comprises at least one gene of interest containing:
(i) a coding sequence; and
(ii) a promoter region that contains a promoter sequence other than the natural promoter

sequence of said coding sequence, and wherein said promoter sequence regulates transcription of downstream sequences containing said coding sequence to produce an RNA in said cell."

Claim 2 was directed to a particular embodiment of claim 1. Claims 3 and 4 related, respectively, to a plant composed of the cells of claims 1 or 2 and to a seed of this plant.

IV. Both the patentee (appellant I) and the opponent (appellant II) filed notices of appeal, paid the appeal fees and submitted statements setting out their grounds of appeal. Appellant I maintained the requests underlying the decision under appeal.

V. In a letter dated 30 January 2007, appellant I replied to the statement setting out the grounds of appeal of appellant II.

VI. With the summons to oral proceedings, the board sent a communication pursuant to Article 11(1) (now Article 15(1)) of the Rules of Procedure of the Boards of Appeal (RPBA) indicating to the parties its preliminary, non-binding opinion on substantive matters.

VII. Both parties replied to the board's communication and filed further documents in support of their arguments.

VIII. Oral proceedings took place on 30 January 2008. At the beginning of the oral proceedings, appellant I withdrew its auxiliary request and maintained its main request (claims as granted) as its sole request.

IX. Appellant I's arguments filed in writing and submitted during the oral proceedings, insofar as relevant to the present decision, may be summarised as follows:

Main and sole request
Article 123(2) EPC
Binding effect of the decision T 984/00 of 18 June 2002

The patentee was compelled to introduce the feature "*except for promoter sequences*" in the ex parte appeal proceedings underlying the decision T 984/00 because the then competent board saw an apparent contradiction between parts (a) and (b) of claim 1. Whereas part (a) required the foreign DNA to be substantially free of internal T-DNA sequences, part (b)(ii) contemplated the use of T-DNA promoter sequences as promoter regions of the coding sequences in the genes of interest. In fact, the application as filed was exemplified by a T-DNA promoter, namely the promoter of the nopaline synthase (nos) gene. In decision T 984/00, the then competent board considered that this feature had a formal basis in the application as filed and that it did not represent an extension of the subject-matter beyond that originally filed. Since both the description and the claims (claims as granted) underlying that decision were identical to those now under consideration, the factual situation was exactly the same. It was therefore not justifiable, and contrary to the need for legal certainty, that one board could ignore an earlier decision of another board and render a completely contrary decision based on the very same facts. Such a decision was unfair both to the patentee, who was

compelled to follow the indications of the earlier board, and to the public interest in legal certainty.

The present case was different from those considered in the case law of the Boards of Appeal. In particular, it differed from the case underlying the decision T 167/93 (OJ EPO 1997, 229), in which a first board delivered a decision in examination proceedings and a second board delivered a decision in subsequent opposition proceedings. In that case also, in the first appeal proceedings the claims differed significantly from those before the opposition division and therefore the basis for the two decisions was completely different. However, in the case now under consideration, neither the claims (claims as granted) nor the corresponding description (as originally filed) had been changed.

While acknowledging the different nature of examination and opposition proceedings - the public having a role to play in opposition proceedings - it would be unfair in this case for the board to penalise the patentee for a feature in a claim it had to adopt in order for an earlier board to allow it to have a patent at all.

Formal basis for the feature "except for promoter sequences"

The essential teaching of the patent in suit was that substantially all internal T-DNA could be removed without harming the transfer of a gene of interest into plant cells and thereby obtaining morphologically normal plants. This teaching was clearly illustrated in the figures of the application as filed. In particular, Figure 4 showed an "A-like" acceptor Ti-plasmid with

T-DNA border sequences (1) and (2) and appropriate intermediate cloning vectors with a gene of interest (5, 7) and no T-DNA border sequences. Similarly, Figures 9 and 10 showed an intermediate cloning vector with the gene of interest (5) and T-DNA border sequences (1) and (2) and a "B-like" acceptor Ti-plasmid with DNA sequences (9) and (10) homologous to Ti sequences just outside the border sequences (1) and (2). In both cases, the corresponding hybrid Ti-plasmids contained only and exclusively the T-DNA border sequences (1) and (2). The application as filed also taught the skilled person that the coding region of the foreign gene could be placed under the control of any promoter. This teaching was explicitly mentioned in the context of Figures 1 and 2 (column 14, lines 18 to 35 of the application as published) and, more particularly, in Example 4 when describing the construction of the gene of interest (column 28, lines 14 to 39). Furthermore, Example 4 stated that the T-DNA nos promoter only exemplified the more general teaching. Therefore, a mind willing to understand immediately derived therefrom that the nos promoter was just an illustration of the invention and that any other T-DNA promoter (such promoters being known to be functional in plants) could be used to control the expression of any foreign gene. Accordingly, it was clearly and directly derivable from the application as filed that not only the nos promoter but any other T-DNA promoter could be used to drive the expression of the gene of interest.

X. Appellant II's arguments filed in writing and submitted during the oral proceedings, insofar as relevant to the present decision, may be summarised as follows:

Main and sole request
Article 123(2) EPC
Binding effect of the decision T 984/00 of 18 June 2002

There was no evidence on file showing that the patentee was compelled to introduce the contentious feature in the ex parte appeal proceedings underlying decision T 984/00. Moreover, it was always the patentee's responsibility to formulate the claims and to accept or disregard any suggestion from a department of first instance or a board of appeal, in particular as regards possible objections under Articles 123(2) and (3) EPC.

There was no provision in the EPC or its implementing regulations stipulating that a board of appeal was bound by previous decisions of the same or another board. Under the EPC, a decision of a board of appeal had a binding effect only in one specific event, namely if the case was remitted to the EPO department of first instance whose decision was appealed - in so far as the facts were the same (Article 111(2) EPC). In line with the established case law, as laid out in decision T 167/93 (*supra*), a decision of a board of appeal in ex-parte appeal proceedings had no binding effect on subsequent opposition proceedings. The "*res judicata*" principle was not of unlimited scope but only constituted a bar to a subsequent legal action involving the same claim, demand or cause of action, and the same parties. Since the parties to opposition proceedings were necessarily not the same as those to ex parte proceedings, the "*res judicata*" principle did not apply. Moreover, the documents and arguments submitted in opposition proceedings changed the factual

situation which was thus different from that of the ex parte proceedings. Furthermore, in ex parte appeal proceedings only the applicant had a chance to argue, whereas the public had to await the granting of the patent to safeguard its interests by way of an opposition. Therefore, the general interest of the public in legal certainty did not apply to a decision taken in an ex parte appeal proceedings.

Formal basis for the feature "except for promoter sequences"

The figures of the application as filed did not provide a formal support for the contentious feature since they did not illustrate the claimed subject-matter. These figures only showed the construction of hybrid Ti plasmids and of other intermediate products (acceptor Ti plasmids and intermediate cloning vectors) used in the method of the application. Example 4 did not provide a basis for T-DNA promoters since it referred only to the specific T-DNA nos promoter. The nos promoter was the sole T-DNA promoter mentioned in the application as filed, both in the context of acceptor Ti plasmids and of intermediate cloning vectors, and it was always linked to further sequences, either to the coding region of the gene of interest or to the coding region of the T-DNA nos gene. There was no indication or hint of any other T-DNA promoter in the application as filed nor any formal basis for embodiments comprising the T-DNA nos promoter alone or any other T-DNA promoter alone, i.e. without regulating the expression of a coding region - be it the gene of interest or the nos gene itself.

XI. The appellant I (patentee) requested that the decision under appeal be set aside and the patent be maintained as granted.

XII. The appellant II (opponent) requested that the decision under appeal be set aside and that the patent be revoked.

Reasons for the Decision

Main and sole request
Article 123(2) EPC
Binding effect of the decision T 984/00 of 18 June 2002

1. The binding effect of Board of Appeal decisions is extremely limited. In the legal system established under the EPC there is no principle of binding case-law. This is demonstrated in several ways - by the presence in the EPC and its subsidiary legislation of provisions to deal with the inevitable differences of opinion non-binding case-law may produce (Article 112(1)(b) EPC; Articles 20 and 21 RPBA); by the presence of provisions as to when, exceptionally, decisions do have a binding effect (Articles 111(2) and 112(3) EPC); and by the fact that the Enlarged Board considered it necessary, on three occasions when it reversed previous law or practice, to exempt pending cases commenced in reliance on the previous law or practice, a measure which would not have been necessary if case-law had a binding effect (G 5/88 OJ EPO 1991, 137; G 5/93 OJ EPO 1994, 447; G 9/93 OJ EPO 1994, 891).

2. A further exception to the principle of non-binding case-law, strictly limited to previous decisions in the same proceedings, can be found in the principle of *res judicata* which prevents the further litigation of issues already finally decided. As was held in decision T 167/93 (*supra*), to which both Appellants referred, to the extent this principle is recognised in the law of the EPC, it is of extremely narrow scope and must meet six criteria, namely the issue in question must have been:

(a) judicially determined,
(b) in a final manner,
(c) by a tribunal of competent jurisdiction,
(d) where the issues of fact are the same,
(e) the parties (or their successors in title) are the same, and
(f) the legal capacities of the parties are the same.

In T 167/93, which like the present case concerned an appeal in opposition proceedings following an earlier appeal in examination proceedings, the board observed that at least criterion (e) was not met since the opponents had not been party to the ex parte proceedings in which the earlier decision had been given (cf. T 167/93, *supra*, points 2.5 and 2.6 of the Reasons).

3. Decision T 167/93 continued (cf. point 2.7 of the Reasons) to explain the limited role of the *res judicata* principle in EPC proceedings thus:

"The principle of *res judicata* is based on public policy that there should be an end to litigation. But

the European Patent Convention specifically provides that the grant of a patent should be considered both at a first examination stage (Articles 96 and 97) and at an opposition stage (Articles 99 to 102), and Article 113(1) EPC provides that "The decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments". In the Board's view these explicit provisions of the Convention preclude any implicit public policy preventing a matter being considered a second time in judicial proceedings, that is estoppel *per rem judicatam*, from being applicable. Further, to consider in opposition proceedings whether certain lines of argument are precluded on some principle of *res judicata*, would itself be an undue complication. As a party in opposition proceedings is free to adopt as its own argument the reasons given in a decision of a Board of Appeal in ex parte proceedings, it is this Board's view that the aim of speedy proceedings is best served, if all the issues in opposition proceedings are decided by the relevant tribunal on its own view of the facts, free from *res judicata* considerations relating to decisions made during the examination proceedings."

4. The present board agrees. Proceedings concerning oppositions differ from those concerning the examination of patent applications in several ways. First, the two types of proceedings must by legislative provision (see Articles 18 and 19 EPC) be conducted by different bodies, namely the examining division and the opposition division respectively. Neither body is a tribunal competent to decide issues within the exclusive jurisdiction of the other - so criterion (c)

in T 167/93 is not satisfied. Second, the parties in inter partes opposition proceedings cannot be the same as in ex parte examination proceedings since, by definition, there are one or more opponents in opposition proceedings who were not parties to the examination proceedings, so criterion (e) in T 167/93 is not satisfied. Third, the legal capacity of the parties is not the same - in examination proceedings the only party is an applicant who is seeking to obtain the grant of a patent whereas in opposition proceedings that party has the entirely different capacity of a patent proprietor defending a granted patent, so criterion (f) in T 167/93 is not satisfied.

5. As appellant II argued, and as appellant I acknowledged, opposition proceedings are separate and distinct from examination proceedings and are characterised by the nature of the public interest. Thus, for example, anyone may oppose a granted patent and an opponent may rely on any grounds of opposition and may adduce facts, evidence or arguments not considered in the examination proceedings. There can be no question of the decision T 984/00 being *res judicata* in the present opposition appeal proceedings. In fact, appellant I's submission was not so much that the board is bound by decision T 984/00 as a matter of law by virtue of the doctrine of *res judicata*, but rather that a different decision would be unfair and contrary to the public interest in legal certainty (cf. Section IX *supra*). The core of this argument was that the factual situation underlying decision T 984/00 has not changed and that consequently the board should come to the same conclusion as in that decision. The board cannot accept this argument. While one can readily understand the feelings of a party

which finds that a step it took in earlier proceedings is now prejudicial to its case in later proceedings, close consideration of the matter shows that the alleged inconsistency would be more apparent than real.

6. The starting point of appellant I's argument is the suggestion that it was, as applicant in the examination appeal proceedings, compelled to incorporate the feature in claim 1 to which the present board now objects. That must however be an overstatement: an applicant or patentee is always master of its own application or patent (see Article 113(2), Article 97(1) and Rule 71 and Article 101(3)(a) and Rule 82 EPC). While objections from the responsible department of the EPO or from an opponent may apply pressure to make amendments to the text of an application or patent, ultimately the decision whether or not to make any amendment must always be one for the applicant or patentee alone (Article 113(2) EPC). Thus the form in which the claims were granted, namely the form which emerged in the appeal proceedings of decision T 984/00, was a form accepted and approved by the patentee. Moreover, in accepting and approving that form of its claims, the patentee knew that its patent in that form would be exposed to opposition and could be opposed by anyone and that, in any such opposition proceedings, any issue already decided in the examination proceedings and capable of also being raised in the opposition proceedings might be so raised and might be decided differently. That being the nature of opposition, as compared to examination, proceedings, it can be of no avail to plead that a public interest in legal certainty requires the same result in both proceedings. The legislative and procedural framework

has quite clearly been designed to allow the public interest in challenging granted patents by opposition to take priority over any considerations of certainty or, as it might perhaps be more appropriately expressed, of apparent consistency.

7. Similar considerations apply to appellant I's argument when put on the basis that there was, as regards the feature of claim 1 in issue, no change in the factual situation between the two appeals. This can however only reflect the appellant's own, and necessarily subjective, viewpoint. The specific factual situation must be seen in the broader procedural context and this means the context of opposition proceedings which are considerably different from the examination proceedings in which the appellant accepted and approved the amendment to give claim 1 its present form. In opposition proceedings, the opposition division is entitled to assess a granted patent against all the grounds of opposition, even those not relied on by an opponent (Article 101(1) and Rule 80 EPC). Such grounds include extension beyond the application as filed (Articles 100(c) and 123(2) EPC) and thus any amendments made after filing of that application may be called into question. The same would be true of more substantive issues - if a patent was granted after the examination division or Board of Appeal had held its subject-matter was novel over a particular item of prior art and an opponent subsequently pleaded lack of novelty over that same prior art with no new arguments than those previously canvassed, the opposition division would be perfectly entitled to find a lack of novelty. Seen in context therefore, the factual situation will hardly ever if at all be the same in

both examination and opposition proceedings (which would also mean criterion (d) in T 167/93 is absent - see points 2 to 4 above). Appellant I's argument, however attractive superficially, cannot be sustained in view of the different nature of examination and opposition proceedings. Accordingly, decision T 984/00 has no binding effect and there is nothing to prevent the Board considering the issue of Article 123(2) EPC anew.

Formal basis for the feature "except for promoter sequences"

8. The application as filed discloses the construction of "A-like" and "B-like" acceptor Ti-plasmids. The "A-like" plasmids contain the right and left T-border sequences (1),(2) (cf. Figures 1 and 6, exemplified by pGV3850 in Figure 13) and the "B-like" plasmids contain only sequences (9),(10) located just outside these T-border sequences (cf. Figure 8, exemplified by pGV2260 in Figure 17). The cross-over of these acceptor Ti-plasmids with appropriate intermediate cloning vectors (without and with T-border sequences for "A-like" and "B-like" acceptor Ti plasmids, respectively) (cf. Figures 2 and 3 for "A-like" and Figure 9 for "B-like" which is also exemplified by pGV700 and pGV750 in Figures 14 and 15) containing a gene of interest (5),(7) (with the natural or an exogenous promoter) results in the production of hybrid Ti-plasmids (cf. Figures 4 and 10 for "A-like" and "B-like", respectively). These hybrid Ti-plasmids are used to introduce the gene of interest into the genome of a dicotyledonous plant. The construction of these hybrid Ti-plasmids - using helper plasmids of *E. coli*

for directly transferring the cloning plasmids into *Agrobacterium* - is outlined in Figure 5.

9. There is no reference in these schematic Figures 1 to 10, which illustrate the method disclosed in the application and the products used therein, to any internal T-DNA sequence or to any T-DNA promoter sequence, and only the T-DNA border sequences (1),(2) and the sequences (9),(10) located just outside these T-border sequences are illustrated. They cannot thus provide any formal support for the contentious feature under consideration.

10. Example 1 of the application as filed discloses the construction of the "A-like" acceptor Ti-plasmid pGV3850 (cf. Figure 13). In this construction, use is made of plasmid pAcgB which contains "*only the borders of the T-DNA (see Figure 11) ...* (and) *the nopaline synthase gene since this genetic information maps very close to the right T-DNA border*" (cf. column 19, lines 27 to 41 of the application as published). Thus, plasmid "*pGV3850 still contains the gene encoding nopaline synthase ...* (and has) *the ability to synthesize nopaline*" (cf. column 21, lines 3 to 8 and 26 to 30). There is no reference to the presence of any other T-DNA gene or T-DNA promoter in plasmid pG3850, which recombines into *Agrobacterium* with "*an intermediate cloning vector containing oncogenic functions of the octopine T-DNA in pBR325*" and "*the resulting hybrid Ti-plasmid in Agrobacterium ... is inoculated onto wounded tobacco plants*" (cf. column 22, lines 5 to 16). These oncogenic functions are not contemplated in the intermediate cloning vectors that are described in the application as being appropriate

for the "A-like" acceptor Ti-plasmids (cf. Figures 2 and 3).

11. Example 3 of the application as filed discloses the construction of the "B-like" acceptor Ti-plasmid pGV2260 (Figure 17). In this construction, use is made of the Ti plasmid pGV2217 which "*contains a deletion substitution mutation of the entire TL-region of the octopine Ti plasmid*" (cf. column 26, lines 10 to 14). Plasmid pG2260 does not contain the nopaline synthase (nos) gene, the nos promoter or any other internal T-DNA gene or T-DNA promoter and it is used with intermediate cloning vectors of the type illustrated in Figure 9 and in Example 2, i.e. pGV700 or pGV750 (cf. Figures 14 and 15, respectively and column 27, line 48 to column 28, line 4). Whereas the vector outlined in Figure 9 only contains the T-DNA border sequences (1),(2) and a gene of interest (5), both pGV750 and pGV700 contain genetic information of different internal T-DNA products, namely the ocs gene (pGV750) and the ocs gene with transcripts 3, 4, 6a and 6b (pGV700) (cf. column 25, lines 19 to 35). Although "*a gene of interest can be easily inserted into these vectors as they contain single restriction endonuclease sites for cloning within their modified T-regions*" (cf. Example 2, column 25, lines 41 to 44), co-integration of pGV2260 and pGV700 and transformation of plant cells results thus in plants exhibiting tumors, since the hybrid Ti-plasmid is not substantially free of internal T-DNA sequences and contains internal T-DNA genes that control neoplastic growth. These neoplastic T-DNA genes are however not contemplated in the intermediate cloning vectors that are described in the application as being appropriate for the "B-like" acceptor

Ti-plasmids (cf. Figure 9) nor is the presence of any internal T-DNA sequences, let alone a "*T-DNA promoter sequence*", derivable from Figure 9 (cf. point 8 *supra*).

12. Example 4 discloses the construction of intermediate cloning vectors containing a gene of interest and states that "*according to the process of this invention, the coding region of (any) foreign gene(s) of interest is linked to transcriptional initiation and termination signals which are known to be functional in the plant cell*". This is exemplified using the T-DNA nos promoter and it is further stated that "*the protein-coding region of any foreign gene can be inserted adjacent to the nos promoter*" (cf. column 28, lines 14 to 31). There is however no reference to any other T-DNA promoter.

13. It is in the context of the intermediate cloning vectors illustrated in Figures 2 and 3 that reference is also made to the use of a "*natural or an exogenous promoter sequence*" (cf. column 14, lines 18 to 32), in particular, to the use of those promoters directing the expression of the inserted genes of interest in a regulated fashion. Several types of regulation are also explicitly mentioned, namely "*(i) tissue-specific expression, i.e. leaves. roots, stem, flowers; (ii) level of expression, i.e. high or low; and (iii) inducible expression, i.e. by temperature, light, or added chemical factors*"(cf. column 14, lines 32 to 41). However, there is no reference to any internal T-DNA promoter sequence.

14. It follows from the above that the application as filed discloses the use of generic promoters and of the

specific T-DNA nos promoter for regulating the transcription of a gene of interest. There is also a disclosure of promoters directing the expression of the inserted gene in a regulated fashion. However, there is no disclosure, indication or hint in the application as filed of any type, class or group of promoters other than these generic promoters and the very specific T-DNA nos promoter. It is arguable that, as suggested by appellant I, the fact that the teachings of the application as filed are exemplified by the T-DNA nos promoter and that internal T-DNA promoters are known to be functional in dicotyledonous plants, might immediately direct the skilled person towards other internal T-DNA promoters. However, in the absence of any hint towards these promoters in the application as filed and in line with the case law of the Boards of Appeal (cf. "Case Law", *supra*, III.A.2.1, page 259, in particular T 823/96 of 28 January 1997, point 4.5 of the Reasons), this question has no bearing on the issue of added subject-matter.

15. The board further notes that claim 1 does not necessarily require the T-DNA promoter sequences and the promoter sequence regulating the expression of the coding sequence of the gene of interest to be the same sequences. Therefore, the claim covers embodiments in which one or more internal T-DNA promoter sequences is present in the foreign DNA stably integrated into the genome of the dicotyledonous plant cell but it is not the promoter sequence required to regulate the transcription of the gene of interest. In these embodiments, one or more internal T-DNA promoter sequences without the corresponding coding region(s) must be between the T-DNA border sequences so as to be

integrated into the genome of the plant cell with - but functionally independent of - an exogenous promoter sequence and the coding region of the gene of interest. For these embodiments, particularly those contemplating the presence of several T-DNA promoter sequences, the board fails to see any formal basis, either explicit or implicit, in the application as filed.

16. For all these reasons, the board concludes that the claimed subject-matter does not fulfil the requirements of Article 123(2) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is revoked.

The Registrar: The Chairman:

A. Wolinski L. Galligani