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**Datasheet for the decision
of 7 January 2008**

Case Number: T 0788/07 - 3.3.04

Application Number: 97951782.8

Publication Number: 0891130

IPC: A01H 5/10

Language of the proceedings: EN

Title of invention:

Oilseed Brassica containing an improved fertility restorer gene for ogura cytoplasmic male sterility

Applicant:

PIONEER HI-BRED INTERNATIONAL, INC.

Headword:

Brassica/PIONEER

Relevant legal provisions:

EPC Art. 53(b), 54, 56, 83, 84, 123(2)
EPC R. 26(4)(c)

Keyword:

"Added subject-matter - (no), patentable subject-matter, novelty, inventive step, sufficiency, clarity - (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 0788/07 - 3.3.04

D E C I S I O N
of the Technical Board of Appeal 3.3.04
of 7 January 2008

Appellant: PIONEER HI-BRED INTERNATIONAL, INC.
(Applicant) 800 Capital Square
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Representative: Perry, Robert Edward
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 30 November 2006
refusing European patent application
No. 97951782.8 pursuant to Article 97(1) EPC
(1973).

Composition of the Board:

Chairman: U. Kinkeldey
Members: M. Wieser
G. Weiss

Summary of Facts and Submissions

- I. The appeal was lodged by the Applicant (Appellant) against the decision of the Examining Division dated 30 November 2006 to refuse under Article 97(1) EPC (1973) the patent application EP 97 951 782.8 (published as WO 98/27 806), having the title: "Oilseed Brassica containing an improved fertility restorer gene for ogura cytoplasmic male sterility".
- II. The present application has been refused for the first time by the Examining Division with a decision dated 24 May 2002. At oral proceedings held on 17 April 2002 it had been decided that the subject-matter of claim 5 of all requests then on file (a main request and three auxiliary requests) was anticipated by the disclosure in WO 97/02 737 contrary to the requirements of Article 54(3) EPC.
- III. This decision was set aside by Board 3.3.04 in a different composition in decision T 1026/02 of 5 March 2004. It was decided that the subject-matter of WO 97/02 737 was not described in an enabling manner and its content could not be considered for judging novelty of the claimed subject-matter.
- The case was remitted to the department of first instance for further prosecution on the basis of claims 1 to 13 of the new main request filed at the oral proceedings before the Board of Appeal.
- IV. With letter dated 18 April 2005 the Applicant filed a new main request (claims 1 to 16) in response to a written communication of the Examining Division.

V. In response to summons to attend oral proceedings before the Examining Division the Applicant replaced this main request by claims 1 to 16 submitted with letter dated 9 January 2006.

VI. The second oral proceedings before the Examining Division were held on 25 January 2006.

According to the minutes of these oral proceedings, the Chairman of the Examining Division informed the Applicant that the claims of the main request submitted on 9 January 2006 were found not to meet the requirements of Articles 56 and 83 EPC. The Applicant maintained his main request and filed an auxiliary request (claims 1 to 5), which the Examining Division considered to fulfil the requirements of the EPC.

VII. The Examining Division dispatched on 16 March 2006 the communication according to Rule 51(4) EPC (1973) wherein it proposed claims 1 to 5 according to the auxiliary request for grant. A reasoning as to why claim 1 of the main request did not meet the requirements of Articles 56 and 83 EPC was provided.

VIII. Within the given time limit the Applicant informed the Examining Division that he maintained his main request and asked for an appealable decision.

With decision dated 30 November 2006 the Examining Division refused the application for a second time. It was decided that claim 1 of the main request did not meet the requirements of Articles 56 and 83 EPC.

- IX. An appeal was filed with letter dated 3 January 2007 and in the grounds of appeal, submitted with letter dated 30 March 2007, the Appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the main request, claims 1 to 16 filed with letter dated 9 January 2006, or on the basis of claims 1 to 21 of auxiliary request 1, filed with the grounds of appeal, or on the basis of claims 1 to 5 filed on 25 January 2006 at the second oral proceedings before the Examining Division.
- X. The Board expressed its preliminary opinion in a communication dated 27 July 2007.
- XI. With letter dated 19 December 2007 the Appellant requested to set aside the decision under appeal and to grant a patent on the basis of claims 1 to 5 of his new main request, submitted with the letter.

The claims of Appellant's new main request are identical to claims 1 to 5 filed on 25 January 2006 at the second oral proceedings before the Examining Division, which the Examining Division in its communication according to Rule 51(4) EPC (1973) proposed for grant.

- XII. Claim 1 of Appellant's new main request read:

"A hybrid seed comprising an inheritable and stable fertility restorer gene for ogura cytoplasmic male sterility, or hybrid plant thereof, produced by a cross between a plant obtained from seed deposited as *Brassica napus olifera* 97SN-1650, 97SN-1651, 97FNW-1792-03 or 96FNW-1822-07 having the respective ATCC

accession numbers 97838, 97839, 209001 or 209002 as a male parent and a second *Brassica* plant as a female parent, wherein the second *Brassica* plant has a glucosinolate level that is sufficiently low to ensure that the hybrid plant yields oilseeds having a total glucosinolate content of less than 30 μmol per gram dry weight."

Dependent claims 2 to 5 referred to preferred embodiments of the subject-matter of claim 1.

XIII. The present decision refers to the following document:

- (1) 9th International Rapeseed Congress, Cambridge, UK, 4 to 7 July 1995; Chapter A3:F₁ Hybrid Technology, pages 6 to 8

Reasons for the decision

1. Claim 1 is based on page 8, lines 4 to 12, page 11, line 21 to page 12, line 16 and claims 7, 11, 18 and 22 of the application as published. Additional basis for claims 2 to 5 can be found in claims 7, 12 to 14, 19 and 20 of the application as published.

Thus, the requirements of Article 123(2) EPC are met.

The claims are clear and supported by the description, as required by Article 84 EPC.

2. The invention, namely a hybrid seed, or hybrid plant thereof, produced by a cross between a plant obtained from one of four seeds deposited in accordance with the

- requirements of Rules 31 to 33 EPC as male parent and a second Brassica plant as female parent, is disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 83 EPC).
3. Hybrid seed or plants thereof according to claims 1 to 5 are not considered as units with regard to their "suitability for being propagated unchanged" (Rule 26(4)(c) EPC) and are therefore not regarded as plant varieties which are excluded from patentability (Article 53(b) EPC).
 4. The subject-matter of claims 1 to 5 is not disclosed in the prior art on file and is therefore novel within the meaning of Article 54 EPC.
 5. The deposited male parent seed claimed in claim 1 as one of the two crossing-partners for producing the hybrid seed with the desired traits is homozygous for the restorer gene for ogura cytoplasmic male sterility (CMS) and has low glucosinolate level (less than 30 μmol per gram dry weight).

Document (1), which is considered to represent the closest prior, teaches that it is possible to break the linkage between high glucosinolate content and restorer gene. The document discloses low glucosinolate lines which are heterozygous for the restorer gene and concludes that the *Ogu*-INRA CMS system can be additionally improved by further elimination of radish genetic information (see the passage bridging pages 7 and 8, figure 1 and "Conclusion").

Thus, the teaching in document (1) can be considered as being a first suggestion for obtaining restorer lines similar to those of the present application.

However, the exact nature of the radish fragment in the plants obtained from the **deposited** seeds representing an individual, selective choice, which has to be of a structure to allow stable transmission and to retain activity, arises as a chance event requiring many individual meiotic cross-over events, a suitable selection and eventual luck.

Neither document (1) nor any other prior art document on file contains information that would allow a skilled person to arrive at the result of this lucky chance event, namely the deposited seeds and plants obtained therefrom, in an obvious way. As a consequence the hybrid seeds and hybrid plants thereof according to claims 1 to 5 involve an inventive step.

The requirements of Article 56 EPC are met.

Order

For these reasons it is decided:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance with the order to grant a patent on the basis of the following documents:

Claims: 1 to 5 filed with letter dated 19 December 2007

Description: Pages 1 to 6, 9, 15 to 21, 24 to 29, 31 to 34 as published, and

pages 7, 8, 10 to 14, 22, 23 and 30 as filed on 25 January 2006, at the oral proceedings before the Examining Division

Figures: 1/5 to 5/5 as published.

Registrar:

Chair:

D. Meyfarth

U. Kinkeldey