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**Datasheet for the decision  
of 22 October 2015**

**Case Number:** T 0967/10 - 3.3.04

**Application Number:** 05759731.2

**Publication Number:** 1781793

**IPC:** C12N15/82, A01H5/00

**Language of the proceedings:** EN

**Title of invention:**

Reduced susceptibility towards pathogens, in particular comycetes, such as downy mildew in lettuce and spinach

**Applicant:**

Rijk Zwaan Zaadteelt en Zaadhandel B.V.

**Headword:**

Bremia resistant lettuce/RIJK ZWAAN

**Relevant legal provisions:**

EPC Art. 84

**Keyword:**

Claim - clarity (no)

**Decisions cited:**

G 0002/88, G 0010/93, G 0002/13, T 0150/82, T 0815/93,  
T 0525/98, T 1854/07, T 0768/08, T 0915/10

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 0967/10 - 3.3.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.04**  
**of 22 October 2015**

**Appellant:** Rijk Zwaan Zaadteelt en Zaadhandel B.V.  
(Applicant) Burgemeester Crezeelaan 40  
2678 KX De Lier (NL)

**Representative:** van Someren, Petronella F. H. M.  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted on 15 December  
2009 refusing European patent application No.  
05759731.2 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairwoman** G. Alt  
**Members:** A. Chakravarty  
M.-B. Tardo-Dino

## **Summary of Facts and Submissions**

- I. An appeal was filed by the applicant (appellant) against the decision of the examining division to refuse European patent application number 05759731.2. The application was filed as an international application and published as WO 2005/124108 (the application as filed) with the title "*Reduced susceptibility towards pathogens, in particular comycetes, such as downy mildew in lettuce and spinach*".
- II. The examining division considered that the subject-matter of main request and auxiliary request 1 did not meet the requirements of Article 123(2) EPC, while the subject-matter of auxiliary request 2 related to a plant variety pursuant to Article 53(b) EPC and was therefore held as not being patentable. Moreover, the subject-matter of auxiliary request 2 was held to lack inventive step.
- III. The board issued a summons to oral proceedings and later, a communication pursuant to Article 15(1) RPBA in which it set out its preliminary appreciation of substantive and legal matters concerning the appeal. The board was of the preliminary opinion that claim 1 of the main request lacked clarity because the claimed lettuce plants were not defined by any identifiable features which would allow the skilled person to distinguish the claimed plant from one of the prior art in a straightforward manner. The resistance phenotype itself could not serve this purpose, as the same phenotype could potentially arise from various different genetic origins. Nor was there any additional disclosure in the application of the genetic cause of the resistance phenotype in the deposited seeds. In other words, the trace left in the claimed plant by the process mentioned

in the claim was unknown. The board also noted that lettuce varieties with field resistance to *B. lactuca* were known in the art.

- IV. The appellant replied to this communication and submitted two auxiliary requests.
- V. Oral proceedings before the board took place on 22 October 2015 during which all requests other than the main request were withdrawn.
- VI. During the oral proceedings, as a part of the discussion on the clarity of the claim, the question of whether or not the claimed subject-matter was defined in such a way as to allow a third party, such as a potential infringer, to determine whether or not he is working in the scope of the claim, was raised.
- VII. At the end of the oral proceedings the chairwoman announced the decision of the board.
- VIII. The sole claim of the main request reads:

"1. A lettuce plant (*Lactuca sativa* L.) showing a reduced susceptibility towards infection with *Bremia lactucae*, which plant is obtainable by crossing a susceptible lettuce plant with a lettuce plant grown from the seed as deposited with NCIMB on 9 June 2005 and having one of the accession numbers numbers 41294, 41295, 41296, 41297, 41298, 41299, 41300, 41301, 41302, 41303, 41304, 41305, 41306, 41307, 41308, 41309, 41310, 41311, 41312, 41313, 41314, 41315, 41316, 41317, 41318, 41319, 41320, 41321, 41322, 41323 and selecting for a plant that shows a reduction or absence of sporulation of the pathogen in a seedling test as plants having a reduced susceptibility phenotype".

IX. The requests of the appellant were that the decision of the examining division be set aside and that a patent be granted on the basis of the main request as filed before the examining division on 7 December 2009.

X. The appellant's arguments may be summarised as follows:

The claim was clear without the need for a disclosure of the structural basis for the trait of reduced susceptibility towards infection with *Bremia lactucae*. This was firstly because lettuce plants having the resistance phenotype defined in the claim were new and unique. The trait of reduced susceptibility to *Bremia lactucae* of the plants claimed was different from the resistance (R-)gene mediated tolerance known in the art. It was also different from the constitutive expression of defence response genes and from the known field resistances. Thus, although lettuce varieties resistant to *B. lactucae* were known in the art, any lettuce plant having a resistance not based on R-genes (a non-host type resistance) or on a constitutive defence response and that can be detected already in the seedling stage could be assumed to have the new resistance type of the invention and thus constitute claimed subject-matter. The fact that the plants had been selected by a seedling test allowed the identification of plants at an early stage in their development and having a trait not previously recognised in the art. It had previously been thought that a seedling test would not reliably allow identification of a resistance trait in lettuce plants which was retained when these plants were grown in the field.

Secondly, the skilled person had access to the seed deposited according to Rule 31 EPC. This allowed the potential infringer to carry out an allelism test as "an

*extra check*", to determine if any specific plant fell within the scope of the claim. This test would allow the skilled person to know whether the resistance (the reduced susceptibility trait) found in a given plant had the same genetic basis as a plant of the deposits. The allelism test was a well known tool of the skilled breeder.

In previous decision T 1854/07, the board of appeal had allowed claims which relied on a reference to deposited biological material for establishing a technical feature of the claimed subject-matter. It followed that the board considered the claims as being clear and not objectionable under Article 84 EPC. The present board should therefore avoid the creation of a conflicting decision.

## Reasons for the Decision

### Article 111(1) EPC

1. In an appeal relating to a decision of an examining division refusing a European patent application, the board of appeal has the power to examine whether the application or the invention to which it relates meets the requirements of the EPC. Hence the board can consider requirements that the examining division did not take into consideration in the examination proceedings or which it regarded as having been met (decision G 10/93, OJ EPO 1995, 172, Headnote). The objections under Article 84 EPC below, were raised in view of Article 111(1) EPC.

### Article 84 EPC

2. In the present case, the subject-matter of claim 1 is a lettuce plant of the species *Lactuca sativa* L.. It is characterized firstly by the property of "showing a reduced susceptibility towards infection with *Bremia lactucae*" and secondly by a process, namely, "which plant is obtainable by crossing a susceptible lettuce plant with a lettuce plant grown from the seed as deposited with NCIMB on 9 June 2005 and having one of the accession numbers [...] and selecting for a plant that shows a reduction or absence of sporulation of the pathogen in a seedling test as plants having a reduced susceptibility phenotype".
  - 2.1 Since the product claimed is, at least partly, defined by a process for its production, claim 1 is a so-called product-by-process claim. According to the established case law of the boards, such claims are considered to be directed to the product as such, in which a process



instead of, for example, its structure or composition, is used to define a feature or features of that product. In fact, product-by-process claims are generally allowable only in cases where it is not possible to define the claimed product satisfactorily other than in terms of its process of manufacture (see for example, G 2/13, reasons IV (2) and (5); T 150/82, reasons 10, OJ 1984, 309; Case Law of the Boards of Appeal of the European Patent Office, 7th edition, 2013, II.A. 7.3).

3. A product-by-process claim must fulfil the clarity requirement of Article 84 EPC, as must any other type of claim.
4. Article 84 EPC stipulates *inter alia*, that "the claims shall define the matter for which protection is sought" and that "they shall be clear". The purpose of claims under the EPC is to enable the determination of the protection conferred by the patent or patent application (Article 69 EPC) and thus the rights of the patent owner within the designated contracting states (Art. 64 EPC), having regard to the patentability requirements of Art. 52 to 57 EPC. Therefore, the claimed subject-matter must be defined so that the public is left in no doubt about what the subject-matter for which protection is sought actually is (cf. (Case Law of the Boards of Appeal of the European Patent Office, 7th edition, 2013, II.A 1.1 and decision G 2/88, OJ EPO 1990, 93, reasons 2.5)).
5. Thus, the requirement for clarity means that the skilled person should be able to determine, either from the claim alone or, by construction of the claim in the light of the description, or by construction in the light of the skilled person's common general knowledge, which identifiable and unambiguous technical features are imparted to the product by the process by which it

is defined (see for instance, T 815/93, reasons 4.3; T 525/98, reasons 2; T 768/08, reasons 4.9).

6. The skilled person reading the process feature of present claim 1 "which plant is obtainable by crossing a susceptible lettuce plant with a lettuce plant grown from the seed as deposited with NCIMB on 9 June 2005 and having one of the accession numbers [...] and selecting for a plant that shows a reduction or absence of sporulation of the pathogen in a seedling test as plants having a reduced susceptibility phenotype" would understand, based on common general knowledge, and also on the description of the application (see page 7, line 26 to line 31) that "[t]he invention relates to plants, which have **in their genome genetic information which is responsible for the reduced susceptibility for oomycetes and is as found in the genome of a lettuce plant [...] of which seed was deposited with the NCIMB on 9 June 2005 [...]**"; (emphasis added by the board).
7. Hence, the skilled person would understand that the process feature recited in claim 1 imparts two characterising technical features to the claimed lettuce plants, firstly, the presence in the genome of the claimed plants of genetic information identical to that present in the genome of plants grown from the deposited seeds and secondly, a reduced susceptibility to infection by *Bremia lactucae*.
8. In relation to the technical feature of the presence in the genome of the claimed plants of genetic information identical to that present in the genome of plants grown from the deposited seeds, it has to be determined which technical information is conveyed by it.

9. It is undisputed that the skilled person cannot derive from the claim *per se* the explicit structural or informational nature of this genetic information, in terms of, e.g. its sequence or genetic markers for its identification. Neither the description, the skilled person's common general knowledge nor the deposit numbers, convey such information.
10. Consequently, it is unknown what the genetic information present in the genome of the claimed plants, and one of the characterising technical features imparted to the claimed plants by the process, actually is.
11. Hence, the process feature of claim 1 as such is considered as unclear.
12. In the present case, the missing technical information is particularly crucial because plants having a phenotype of "reduced susceptibility towards infection with *Bremia lactucae*" were known in the prior art (see Section X., above) and it was also because, according to the description of the application, the phenotype can have more than one genetic basis (see page 6, lines 10 to 27).
13. The board concludes that claim 1 lacks clarity and thus does not fulfil the clarity requirement of Article 84 EPC.
14. In the course of the assessment of the clarity of a claim, the boards sometimes consider, as has the board in the present case, the question of whether or not claimed subject-matter is defined in such a way as to allow a third party, such as a potential infringer, to determine whether or not he is working in the scope of the claim (see Section VI.). However, in view of the

board's finding above that claim 1 is unclear, this secondary consideration and the appellant's arguments submitted in relation to it need not be assessed in the present decision.

15. With respect to the question of whether decision T 1854/07 came to a position on clarity in conflict with the considerations set out above, it is true that the decision concerned a patent in which claims for plants (sunflower seeds) defined *inter alia* by reference to deposited seeds ("*Sunflower seeds [...] obtainable by crossing the high stearic line CAS-3, deposited on 14 December 1994 with the ATCC under deposit accession number ATCC-75968 [...]*") were allowed. However, no objection with respect to clarity was raised by the opponent and the decision itself provides no reasoning on the subject of clarity of the claim. In such a case, the present board cannot determine if there was a genuine difference in approach or provide reasons as to why a *prima facie* different outcome has been reached.
16. The board further notes that in its recent decision T 915/10 (by the board in a different composition), a claim for plants defined by a process feature was considered clear. However, in contrast to the present case, the technical features imparted by the process feature were further explicitly stated in the claim as follows: "A soybean plant [...], **the genome thereof containing SEQ ID NO:9**, wherein the plant is obtainable by crossing a plant obtained from soybean seed deposited under ATCC accession number PTA-6708 and another plant" (emphasis added by the board).
17. It follows from the above that the claim of the only request lacks clarity. The appeal must be dismissed.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairwoman:



P. Cremona

G. Alt

Decision electronically authenticated