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**Datasheet for the decision  
of 15 January 2016**

**Case Number:** T 1348/11 - 3.3.04

**Application Number:** 98935398.2

**Publication Number:** 0942643

**IPC:** A01H5/12

**Language of the proceedings:** EN

**Title of invention:**

Multileaf lettuce

**Patent Proprietor:**

Rijk Zwaan Zaadteelt en Zaadhandel B.V.

**Opponents:**

Syngenta Crop Protection AG  
Agri International BV

**Headword:**

Multileaf lettuce/RIJK ZWAAN

**Relevant legal provisions:**

EPC Art. 83, 115  
RPBA Art. 13(1), 13(3)

**Keyword:**

Sufficiency of disclosure - main request (yes)  
Observations by third parties - disregarded

**Decisions cited:**

G 0009/91, T 0256/87, T 1062/98, T 0619/00, T 0943/00,  
T 0452/04, T 1586/05, T 1621/09

**Catchword:**

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

European Patent  
Office  
D-80298 MUNICH  
GERMANY  
Tel. +49 (0) 89 2399-0  
Fax +49 (0) 89  
2399-4465

Case Number: T 1348/11 - 3.3.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.04**  
**of 15 January 2016**

**Appellant:** Syngenta Crop Protection AG  
(Opponent 01 ) Schwarzwaldallee 215  
4058 Basel (CH)

**Representative:** Slaven, John William  
Syngenta International AG  
WRO-1008-Z1-26  
Schwarzwaldallee 215  
4058 Basel (CH)

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

**Representative:** van Someren, Petronella F. H. M.  
Arnold & Siedsma  
Bezuidenhoutseweg 57  
2594 AC The Hague (NL)

**Party as of right:** Agri International  
(Opponent 02 ) Papotweg 1  
4437 PG Ellewoutsdijk (NL)

**Representative:** Brants, Johan P.E.  
Brantsandpatents bvba  
Pauline Van Pottelsberghelaan 24  
9051 Ghent (BE)

**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
29 April 2011 concerning maintenance of the  
European Patent No. 0942643 in amended form.**

**Composition of the Board:**

**Chairwoman**            G. Alt  
**Members:**             B. Claes  
                             M. Blasi

## Summary of Facts and Submissions

- I. European patent No. 0 942 643, having the title "*Multileaf lettuce*", based on European patent application No. 98935398.2 (filed as an international application published as WO 99/03329) was opposed on several grounds as set forth in Article 100 EPC.
- II. The appeal is from opponent 01 (hereinafter "appellant") and concerns the interlocutory decision of the opposition division that the patent could be maintained in amended form on the basis of auxiliary request II filed during oral proceedings before it.

Claim 1 of auxiliary request II read:

"1. Multileaf lettuce plant of the genus *Lactuca* of a particular type having the heritable monogenic recessive multileaf characteristic, which plant is obtainable by conventional crossing-in using a plant of line RZ 97.41561 having the deposit accession number NCIMB 40877 and a second plant, said multileaf plant having at least 1.5 times as many leaves at the ready-to-harvest stage as a lettuce plant of the same type and equal plant weight."

- III. In the statement of grounds of appeal the appellant submitted that the patent as amended did not fulfill the requirements of Article 83 EPC.
- IV. In reply to the appeal the patent proprietor (hereinafter "respondent") submitted a main request (identical to auxiliary request II before the opposition division, see section II) and three auxiliary requests, as well as arguments why the patent with the claims of

the main request fulfilled the requirements of Article 83 EPC.

- V. First observations filed by a third party pursuant to Article 115 EPC, dated 11 October 2013, were received, to which the appellant responded.
- VI. The parties were summoned to oral proceedings. In the accompanying communication pursuant to Article 15(1) RPBA the board expressed its preliminary opinion that the patent with the claims of the main request fulfilled the requirements of Article 83 EPC and that the third-party observations received had no merit.
- VII. Further third-party observations pursuant to Article 115 EPC were received on 4 January 2016.
- VIII. With a communication from the Registry, the parties were informed of the board's preliminary intention to not take into consideration the further third-party observations.
- IX. Oral proceedings took place on 15 January 2016 in the presence of the appellant and the respondent. Opponent 02 was not present nor represented at the oral proceedings. At the end of the proceedings the chairwoman announced the decision of the board.
- X. The appellant's arguments can be summarised as follows:

*New line of argument under Article 100(b) EPC submitted by the appellant during the oral proceedings*

The reason for submitting a new line of argument under Article 100(b) EPC only at the oral proceedings before the board was that the representative had become

involved in the case only shortly before the oral proceedings and had therefore not had the opportunity to develop the argument earlier.

*Main request - sufficiency of disclosure  
(Article 100(b) EPC)*

The conclusion of the opposition division in the penultimate paragraph of point 3.1.1 on page 6 of the decision under appeal was correct and meant that claim 1 related only to such a multileaf lettuce plant that was multileaf due to the presence of the *very same allele* of the heritable monogenic recessive characteristic as that present in the plants of the deposited line. Indeed, otherwise such plant could not be "obtainable" by crossing-in from the deposited plants.

The applicant (now respondent) had itself earlier described the multileaf trait as "*a 'black box' because there is no sequence information on the underlying genetic element involved*" available (submission dated 2 March 2007, page 2, third full paragraph). Furthermore, neither the genomic position of the genetic element was known, nor marker information. This meant that any potential infringer, having a lettuce plant of the multileaf phenotype, could not determine whether or not the allele contained in that plant was identical to or different from the allele present in the deposited line. Also the so-called "allelic test" could not establish whether a different allele was present or not.

Although, admittedly, the patent disclosed a way of putting the claimed invention into practice, it did not, however, disclose how to do so over the whole scope of the claim, because, on the basis of the disclosure, it

could not be determined whether or not a given allele resulting in the phenotypic trait was identical to the allele for the trait in the deposited line. The patent lacked sufficiency of disclosure for the claimed invention.

XI. The respondent's arguments can be summarised as follows:

*New line of argument under Article 100(b) EPC submitted by the appellant during the oral proceedings*

The new line of argument under Article 100(b) EPC submitted by the appellant during the oral proceedings should not be admitted into the proceedings as it had been submitted at a late stage in the proceedings and had come as a surprise to the respondent.

*Main request - sufficiency of disclosure  
(Article 100(b) EPC)*

The conclusion of the opposition division in the penultimate paragraph of point 3.1.1 on page 6 of the decision under appeal was correct and meant that the multileaf lettuce plant of claim 1 was such a plant which was multileaf due to the heritable monogenic recessive characteristic, *i.e.* the gene, as present in the plants of the deposited strain. The fact that claim 1 described the claimed plant "obtainable" by crossing-in from the deposited plants meant however that the claim was not restricted to such a plant which had the *identical* allele of the gene as present in the deposited line, but covered any allele of that gene providing the required phenotype.

In view of this construction of claim 1, any potential infringer could, for a given multileaf lettuce plant,



determine by means of the "allelic test" whether the same gene was concerned.

The appellant's argument based on the inability to determine whether a given multileaf lettuce plant fell within the scope of claim 1 related rather to the requirements of Article 84 EPC, and was not relevant to the requirements of Article 83 EPC.

XII. Opponent 02 made no substantive submissions in the appeal proceedings.

XIII. The appellant requested that the decision under appeal be set aside and the patent be revoked in its entirety taking into account only the ground of sufficiency of disclosure (Article 100(b) and Article 83 EPC).

The respondent requested that the appeal be dismissed, *i.e.* that the patent be maintained on the basis of the claims as considered allowable by the opposition division (main request) or, alternatively, that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of one of the sets of claims filed as auxiliary requests I to III together with the statement of grounds of appeal.

## **Reasons for the Decision**

1. The appeal is admissible.

### *Scope of the appeal*

2. In the statement of grounds of appeal the appellant only formulated objections under Article 100(b) EPC in relation to the subject-matter of claim 1 of auxiliary

request II pending before the opposition division, which is identical to claim 1 of the main request before the board (see section IV). No arguments in relation to other claims were submitted, nor were any objections formulated under other provisions of the EPC. At the oral proceedings, the appellant again confirmed that it was impugning the decision solely on the point of sufficiency of disclosure. Thus, the scope of the appeal is limited to the requirements of Article 100(b) EPC concerning the invention as formulated in claim 1 of the main request.

*Procedural issues*

3. Opponent 02, a party as of right which did not attend the oral proceedings, was duly summoned. In accordance with Rule 115(2) EPC and Article 15(3) RPBA, the board decided to continue the proceedings in the absence of opponent 02.
4. Two sets of third-party observations were filed during the appeal proceedings (see sections V and VII).
5. Article 114(1) EPC, pursuant to which the EPO shall consider facts of its own motion, is to be applied in a more restrictive manner in *inter partes* appeal proceedings because they are considered to be less investigative than (administrative) opposition proceedings (see decision G 9/91, OJ EPO 1993, 408, point 18 of the reasons). In addition, submissions provided by a third party should not be given a more favourable status than submissions of a party to the proceedings to whom Article 114(2) EPC applies. Hence, the boards have discretion to take third-party observations into consideration or to disregard them. When exercising this discretion the boards consider

*inter alia* the relevance of the observations or at which stage of the proceedings they were filed.

6. In the present case, the first observations suggested that patentability should be denied in the light of the respondent's withdrawal of the corresponding Dutch patent granted on the priority application. The board considered this fact as being of no relevance to the case pending before it. The second observations were filed only some days prior to the oral proceedings, concerned a ground of opposition which was not within the scope of the appeal and relied on a post-published document. The board therefore decided to disregard the observations.

*New line of argument under Article 100(b) EPC submitted by the appellant during the oral proceedings*

7. The sole line of argument on which the appellant relied for arguing its case under Article 100(b) EPC was submitted for the first time during the oral proceedings before the board. This line of argument was furthermore based on a "narrow" construction of claim 1, likewise submitted for the first time during the oral proceedings.
8. The appellant has not denied that both the argument and the construction of claim 1 forming the basis for it differed from the arguments and claim construction it had submitted in the statement of grounds of appeal. The representative explained the lateness of the submission as due to the fact that he had become involved in the case only shortly before the oral proceedings and had therefore not had the opportunity to develop the argument earlier. The respondent requested that the new line of argument should not be admitted into the

proceedings as it had been submitted at a late stage in the proceedings and had come as a surprise.

9. The board considers that, in the present case, the new line of argument advanced by the appellant amounts to an amendment of the appellant's case within the meaning of Articles 12(2) and 13(1) RPBA, because it represented a departure from its initial line of argument and not just a further development of it (see also decision T 1621/09, points 6 to 9 of the reasons).
10. Article 13(1) RPBA lists, in a non-exhaustive manner, some aspects which the board takes into account when exercising its discretion as to whether or not to admit an amendment to a party's case, namely the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.
11. Even though the new line of argument was submitted by the appellant at the latest possible stage, namely at the oral proceedings, the board considered the new line to be straightforward and not to add complexity to the case. The board accepts that the respondent was surprised at the moment at which the new line of argument was advanced by the appellant. However, once it was raised, the respondent was in a position to present counter-arguments after having been given time to study the new line of argument and prepare its position. The respondent also confirmed that it had had enough time during the break to deal with the new issue.
12. In the light of the above, the board admitted the new line of argument into the proceedings (Article 13(1) and (3) RPBA)

*Main request - claim 1 - sufficiency of disclosure  
(Article 100(b) EPC)*

13. The appellant has argued that in view of the fact that the plant of claim 1 was "obtainable" by crossing-in of the trait from the particular plants of the deposited line, claim 1 related only to such plants which were multileaf due to the presence of the *very same allele* of the heritable monogenic recessive characteristic as was present in the plants of the deposited line (referred to hereafter as the "narrow" construction of the claim). The patent, however, did not structurally characterise, e.g. by its sequence, the allele responsible for the multileaf trait in the plants of the deposited line. This had been admitted by the respondent who had referred to it as a "black box". Therefore, a potential infringer, in relation to a given lettuce plant of the multileaf phenotype, was not able to determine whether or not the particular allele of the heritable monogenic recessive characteristic contained in such a (potentially infringing) plant was identical to different from the particular allele present in the deposited line. Indeed, the so-called "allelic test" available to the skilled person could not distinguish between alleles of the same gene if they were located at the same genomic position. The requirements of Article 100(b) EPC were therefore not met for the claimed invention over the whole scope of claim 1.
  
14. Article 100(b) EPC requires a European patent to "disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art". It has furthermore been established by the case law that the disclosure must be reproducible without undue burden (see Case Law of the Boards of Appeal of the EPO, 7th Edition 2013, II.C.5.6). In the

present case this means that in order to assess whether the requirement of sufficiency of disclosure is fulfilled, it must be evaluated whether the patent as a whole in the form now requested, that is, the claims, description and figures, makes available to the skilled person, in the light of his general common knowledge, all the information necessary for obtaining the claimed multileaf lettuce plant without undue burden.

15. The board notes that the appellant has not argued that the patent in suit lacked clear and complete instructions for the skilled person on how to produce the plant which is the subject-matter of claim 1, which according to the appellant's narrow construction of the claim is a plant which is multileaf due to the presence of the *very same allele* of the heritable monogenic recessive characteristic as that present in the plant of the deposited line. Accordingly, the principle set forth above has not been challenged by the appellant in relation to the invention as defined in claim 1 when interpreted in accordance with the appellant's own narrow construction. For this reason alone therefor the appellant's argument on insufficiency of disclosure must fail.
  
16. The appellant's submission that the multileaf trait of the plant of claim 1 constituted a so-called "black box" because at the relevant date of the patent no sequence information was available for the underlying genetic element does not have any implications for the assessment of sufficiency of disclosure and the conclusion of the board, in view of the fact that seeds of plants having the multileaf trait were deposited and are therefore available to the skilled person. The skilled person is thus in a position, on the basis of the disclosure of the patent as a whole, including the

information about the deposited line and using his common general knowledge, to identify without undue burden the technical measures necessary to carry out the claimed invention.

17. The line of argument of the appellant is essentially that, in order for a patent to be sufficiently disclosed, the person skilled in the art reading it should know if he is infringing the patent or not or, in other words, if he is working within the "forbidden area" of a given claim. The appellant argues that if this is not the case then the patent fails to comply with the requirement that the patent should sufficiently disclose the claimed invention over the whole scope claimed.
  
18. The board notes that indeed it has been held in e.g. decision T 256/87 of 26 July 1988 (see point 17, which has been followed in a number of subsequent decisions) that "all that is necessary is that the skilled person reading the specification be put in the position of being able to carry out the invention in all its essential aspects and of knowing when he is working within the forbidden area of the claims" (see also Case Law of the Boards of Appeal of the EPO, *supra*, II.C. 5.6.5).
  
19. The board considers, however, that the question of knowing when a claim is infringed is rather a question of its scope of protection and - as an auxiliary consideration - associated with the assessment of the requirements of Article 84 EPC that the claim must clearly define the matter for which protection is sought. The board's view finds ample support in the case law (see e.g. decisions T 943/00 of 31 July 2003, point 10.5.1; T 619/00 of 11 September 2003, point 5.3;

T 452/04 of 12 January 2006, point 5.7.1 and T 1586/05 of 6 February 2006, point 6.3.1 and Case Law of the Boards of Appeal of the EPO, *supra*, II.C.7.2). Moreover, whether or not there is infringement is a matter to be decided by the national courts (see also decision T 1062/98 of 17 January 2002, point 2.1.4). Thus, also for this reason the appellant's line of argument must fail.

20. From the above it follows that no case for lack of sufficiency of disclosure has been made. Consequently, the board has come to the conclusion that the ground of opposition under Article 100(b) EPC does not prejudice the maintenance of the patent in accordance with the main request.

## Order

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

The appeal is dismissed.

The Registrar:

The Chairwoman:



P. Cremona

G. Alt

Decision electronically authenticated