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**Datasheet for the decision
of 17 March 2015**

Case Number: T 2068/11 - 3.3.08
Application Number: 05720034.7
Publication Number: 1726638
IPC: C12N1/20, A23K1/18, A23L3/3463,
A23L3/3571
Language of the proceedings: EN
Title of invention:
NOVEL LACTIC ACID BACTERIUM
Applicant:
Biobalance Co., Ltd.
Headword:
Lactic acid bacterium/BIOBALANCE
Relevant legal provisions:
EPC 1973 Art. 83
EPC 1973 R. 28
PCT Rule 13bis
"Budapest Treaty on the International Recognition of the
Deposit of Microorganisms for the Purpose of Patent Procedure"
of 28 April 1977
Keyword:
All claim requests -
sufficiency of disclosure (no), see points 5 and 6
Decisions cited:
G 0002/93, T 0039/88, T 0815/90, T 0184/91, T 0107/09,
J 0002/08

Catchword:



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Case Number: T 2068/11 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 17 March 2015

Appellant: Biobalance Co., Ltd.
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 19 April 2011 refusing European patent application No. 05720034.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman M. Wieser
Members: B. Stolz
D. Rogers
M. R. Vega Laso
C. Heath

Summary of Facts and Submissions

- I. European patent application No. 05720034.7, filed on 4 March 2005, is based on international patent application PCT/JP2005/003762. It claims priority rights from Japanese patent application No. 2004059912, which was filed on 4 March 2004 and published on 15 September 2005. Entry into the European regional phase took place on 2 October 2006. The European patent application was published on 29 November 2006.
- II. The applicant (appellant) filed an appeal against the decision of the examining division to refuse the European patent application. The examining division decided that the main request and the first auxiliary request before it did not meet the requirements of Article 83 EPC in conjunction with Rule 31 EPC (former Rule 28 EPC 1973), and that the second and third auxiliary request did not meet the requirements of Article 83 EPC.
- III. The appellant was summoned to oral proceedings. A communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) annexed to the summons, informed it of the preliminary non-binding opinion of the board on some of the issues of the appeal proceedings.
- IV. The appellant submitted further arguments and evidence.
- V. Oral proceedings were held on 17 March 2015.
- VI. The claim requests on file are those of the appealed decision.

Claim 1 of the main request reads:

"1. Lactobacillus delbrueckii ANTI MUFFA FERM BP-10663."

Claim 1 of the 1st auxiliary request reads:

"1. Lactobacillus delbrueckii ANTI MUFFA FERM P-19705."

VII. Claim 1 of the 2nd auxiliary request reads:

"1. Lactobacillus delbrueckii ANTI MUFFA FERM P-19705 wherein ..." the microorganism is further defined by a list of morphological and physiological features.

Claim 1 of the 3rd auxiliary request differs from claim 1 of the 2nd auxiliary request as follows (differences underlined):

"1. Lactobacillus delbrueckii ANTI MUFFA FERM P-19705 having 99.5% homology to Lactobacillus delbrueckii subspecies Lactis as a result of a lineage analysis by 16s rDNA base sequence analysis, wherein ...".

VIII. The European patent application as originally filed and published refers to a microorganism with the accession number FERM P-19705. This was the national accession number given to the microorganism when it was deposited with the Japanese International Patent Organism Depositary (IPOD), on 27 February 2004. The deposit was made under the terms of the Japanese law governing such deposits.

IX. The "Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purpose of Patent Procedure" of 28 April 1977 is hereafter referred to as the "Budapest Treaty".

A request under the Budapest Treaty to convert this Japanese national deposit to an international deposit was made at the latest on 15 August 2006. This led to the microorganism being given the international accession number FERM BP-10663.

X. The following document is cited in this decision:

BP/A/II/11: WIPO, WORLD INTELLECTUAL PROPERTY ORGANIZATION, UNION FOR THE INTERNATIONAL RECOGNITION OF THE DEPOSIT OF MICROORGANISMS FOR THE PATENT PROCEDURE (BUDAPEST UNION), ASSEMBLY, Second Session (2nd extraordinary), Geneva, January 12 to 20, 1982, "REPORT adopted by the Assembly".

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

The claimed microorganism was sufficiently disclosed according to the requirements of Article 83 EPC, and there was no need to satisfy the further requirements of Rule 28 EPC 1973. The Japanese national deposit was available to the public as at the publication date of the Japanese patent application, and Japanese law placed no restriction on the availability of such deposits to the public, Japanese law being identical to the Budapest Treaty in this respect. Moreover, the application as filed sufficiently disclosed the invention, even without a reference to the microorganism deposit number.

If the provisions of Rule 28 EPC 1973 did apply, then it was first to be noted that Rule 28 EPC 1973 contains no reference to the Budapest Treaty. Under Rule 28(9) EPC 1973 the President of the EPO was entitled to

publish in the Official Journal a list of depositary institutions recognised for the purposes of Rule 28 EPC 1973 (see OJ EPO 10/1980, 380). The IPOD is such a listed institution. The President was not in a position to import any further requirements into Rule 28 EPC 1973 by publishing such a list, for example such as requiring that the deposit of microorganisms at such listed depositary authorities was to be done in accordance with the Budapest Treaty. Such an action would have been *ultra vires*. The appellant did not accept the view that the requirements of the Budapest Treaty are imported into Rule 28 EPC 1973 as a result of the "Notice of the European Patent Office dated 18 July 1986 concerning European patent applications and European patents in which reference is made to microorganisms", (OJ EPO 8/1986, 269 - hereafter the "1986 Notice"). Such notices are not legal norms, (see decision J 2/08 of 10 December 2010), and the board does not have to follow them. The purpose of this notice was to facilitate the work of the Examining Division and to assist applicants; it should not be used to create requirements additional to those in Rule 28 EPC 1973 that are then applied to the detriment of applicants. From the *travaux préparatoires* for Rule 28 EPC 1973, it is clear that the requirement of a "recognized depositary institution" relates solely to the scientific and technical competence of the institution for fulfilling the requirement of making the deposited sample available to the public, not to fulfilling legal requirements under the Budapest Treaty. Support for such a view is provided by reference to the German regulation regarding the deposit of biological material, which concentrates on the scientific and technical competence of an institution.

Moreover, the present application is an international application under the PCT. Rule 13*bis* PCT applied to the application in suit up until the entry into the European regional phase. This rule of the PCT concerns inventions relating to biological material. Rule 13*bis*. 2 PCT provides that any reference to biological material shall be made in accordance with Rule 13*bis* PCT, and if so made shall be considered as satisfying the national law of each designated state. Article 150(2) EPC provides that in case of a conflict between the provisions of the EPC and the PCT, the PCT shall prevail. The provisions of the 1986 Notice are in conflict with Rule 13*bis* PCT as they add extra requirements beyond those in Rule 13*bis* PCT. Only after the entry into the European regional phase on 2 October 2006 could the 1986 Notice be considered as applying to the application in suit. By this date the appellant had satisfied the conditions of the 1986 Notice as the request to convert the Japanese national microorganism deposit into an international deposit under the Budapest Treaty had been made, at the latest, on 15 August 2006.

Even if it is accepted that the provisions of the 1986 Notice, and hence the Budapest Treaty are imported into Rule 28 EPC 1973, this cannot provide a basis for the requirement to file a request to convert a national microorganism deposit into an international deposit under the Budapest Treaty by the filing date of the European application. Neither Rule 28 EPC 1973, nor the Budapest Treaty itself have such a requirement. A more reasonable time limit for filing a conversion request would be the publication date of the European patent application. The lack of a time limit in the Budapest Treaty is demonstrated by paragraphs 21 and 29 of the WIPO document BP/A/II/11. Thus, when a request to

convert a deposit with an international depositary institution, which had been made outside of the Budapest Treaty, into a deposit under the Treaty was filed, the effect is to make the date of the deposit the date the microorganism had been received by the international depositary institution without requiring a further deposit. Thus the appellant had fulfilled the requirements of Rule 28 EPC 1973 and the Budapest Treaty.

The appellant referred to the case law of the Boards of Appeal, principally to T 815/90 (OJ EPO 1994, 389), G 2/93 (OJ EPO 1995, 275) which answered the questions of law raised in referral T 815/90, and T 39/88 (OJ EPO 1989, 499). The appellant argued that from these decisions it could be inferred that in the case of a microorganism, a deposit under the Budapest Treaty was not the only way to satisfy the requirements of Article 83 EPC. These cases provide support for the position that a deposit under purely national regulations can fulfil the requirements of Rule 28 EPC 1973.

The appellant argued that the "date of filing the application" in Rule 28(1)(a) EPC 1973 was 2 October 2006, as this was the date that the requirement for according a date of filing set out in Article 80(d) EPC 1973 was fulfilled. Hence, as the request to convert the deposit into a deposit under the Budapest Treaty was filed at the latest on 15 August 2006, the request for conversion had been filed no later than the date of filing the European patent application. The appellant had therefore complied with the 1986 Notice.

The requirements for sufficiency of disclosure under Article 83 EPC should be interpreted consistently with

the requirements for a document to be considered as part of the state of the art. It would be a somewhat artificial approach to treat the Japanese patent application as part of the state of the art as at its publication date, but on the other hand deny that it was a disclosure under Article 83 EPC due to the mere formal error of not having requested conversion to a Budapest Treaty deposit on or prior to the date of filing of the European patent application.

XII. As regards its request to refer questions to the Enlarged Board of Appeal, the appellant argued that the case concerned an important point of law. In addition, the approach taken by the Boards of Appeal to the issue of deposited microorganisms and Article 83 EPC could be seen as divergent and a clear line on this issue from the Enlarged Board was needed.

XIII. The appellant requested that the decision under appeal be set aside and the case be remitted to the examining division for further prosecution upon the basis of the Main Request submitted on 26 May 2008, or upon the basis of one of Auxiliary Requests 1 - 3, submitted on 4 October 2010.

In addition, the appellant requested to refer the following questions of law to the Enlarged Board of Appeal:

"I. Is the question of sufficiency of disclosure of an invention using or concerning biological material under the EPC 1973 a factual question or a formal question?

II. Does a patent application using or concerning biological material fulfill the requirements of the EPC 1973 regarding the availability of the biological

material if a sample of the biological material is deposited only as a domestic deposit conforming with the requirements of the national patent law, not as a deposit under the Budapest Treaty

- a) if the regulations of the domestic deposit guarantee comparable access to the material as a deposit under the Budapest Treaty?*
- b) if the domestic depository institution is a depository institution recognized by the EPO?*
- c) if both a) and b) above apply?*
- d) in any case?*

III. If a deposit under the Budapest Treaty is necessary in the case of question II above, must a (domestic) deposit be converted into a deposit under the Budapest Treaty on or before

- a) the date of filing the priority application (where applicable)?*
- b) the date of filing the International application under the PCT (where applicable)?*
- c) the date of entering into the European regional phase?*
- d) the date of publication of the priority application?*
- e) the date of publication of the international application?*
- f) the date of publication of the European application (or the date of mention in the European Patent Bulletin according to Article 153(3) EPC, where applicable)?*
- g) expiry of the time limit specified in Rule 28(2) EPC 1973 (Rule 31(2) EPC)?*
- h) or another date? If so, which date?*

IV. If a patent application (P1) is deemed to be insufficiently disclosed due to a deficiency of the

deposit of biological material under the EPC 1973, is this patent application (P1) nevertheless prior art for the assessment of novelty and, where applicable, inventive step of a later European patent application (EP2) despite the fact that P1 does not contain an enabling disclosure (at the time of filing of EP2),

a) provided that P1 is a European patent application?

b) provided that P1 is not a European patent application?

V. Are the additional requirements of Rule 28 EPC 1973 overruled by the PCT, specifically Rule 13bis.2 PCT, provided that requirements regarding deposition of biological material laid down in the PCT are fulfilled?

VI. What are the answers to questions I to V above provided that the corresponding provisions of the EPC 2000 apply (in their present form)."

Reasons for the Decision

Applicability of EPC 2000

1. On 13 December 2007, the EPC 2000 entered into force. According to the transitional provisions on the applicability of the EPC 2000, Article 83 EPC shall not apply to European patent applications pending at the date of entry into force of the EPC 2000. Accordingly, Article 83 EPC 1973 together with Rule 28 EPC 1973 apply to the present case. As Article 83 EPC 1973 and Article 83 EPC 2000 differ only by a minor editorial change, for convenience all references to Article 83 will be to Article 83 EPC 2000, which shall be referred to as "Article 83 EPC".

"Date of filing"

2. The arguments put forward by the appellant (see point XI, above) leave out of consideration that the application in question is an international application under the PCT. As a consequence of Article 150(2) EPC 1973, the date of filing of the application is determined by Article 11 and Rule 20 PCT. The application of these provisions gives a filing date of 4 March 2005 for the application. The board therefore rejects the appellant's arguments in favour of a filing date of 2 October 2006 for the purposes of Rule 28 EPC 1973 and Article 83 EPC.

Disclosure of microorganisms under Article 83 EPC

3. Article 83 EPC requires that the subject matter claimed be disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. This requirement must be complied with as from the date of filing of the European patent application (see G 2/93, (OJ 1995, 275) and "Case Law of the Boards of Appeal", 7th edition 2013, II.C.1, page 305).
 - 3.1 The Board acknowledges that the disclosure of a microorganism need not depend on a deposit according to Rule 28 EPC 1973 where the microorganism is sufficiently disclosed by other means.
 - 3.2 In the present case the Japanese patent application was published on 15 September 2005. The board has no reason to doubt that as of 15 September 2005 anyone was entitled to obtain a sample of the microorganism from IPOD, while there is no evidence that this was the case before such date. The filing date of the European patent application was 4 March 2005 and the filing date

of the Japanese patent application from which priority is claimed was 4 March 2004. The *de facto* public availability date of the deposited microorganism therefore postdates any relevant filing date.

3.3 In its statement of grounds of appeal the appellant also argued that the lactobacillus strain of the patent application could be found by screening lactic acid bacteria originating from milk produced in Japan for the characteristics disclosed in the application. The appellant did not expand upon this argument in its subsequent written and oral submissions. The Examining Division had rejected this argument upon the basis that without a deposit there was not a sufficient disclosure concerning the route to isolation, such as what material to start with. In addition, the technical features relating to the biochemical characteristics of *Lactobacillus delbrueckii* strain mentioned in the claims were not causally linked to its specific antifungal properties.

3.4 The board notes that "milk produced in Japan" encompasses a significant quantity of milk. It is not clear from which sample from this milk the search should start. Furthermore, the re-isolation of the claimed strain represents an undue burden because there is no evidence that the observed anti-fungal activities are linked to the assimilation or non-assimilation of any of the substrates listed in the description. Thus, even if the skilled person could re-isolate a strain with all the physiological and morphological properties disclosed in the patent, it could not be certain that it had the disclosed anti-fungal activities. The fact that the physiological and morphological features are included in claim 1 of auxiliary requests 2 and 3 does not change this finding.

In essence, the appellant is providing a research programme rather than an enabling disclosure.

- 3.5 The board therefore finds that, without a deposit under the terms of Rule 28 EPC 1973, claim 1 of the Main request and all Auxiliary requests does not satisfy the requirements of Article 83 EPC.

Rule 13bis PCT does not take precedence over the EPC

4. Article 150(2) EPC provides that in the event of a conflict between the provisions of the PCT and the EPC, the provisions of the PCT prevail.
- 4.1 Rule 13bis PCT concerns the requirements for references to deposited biological material. It addresses the formal requirements for such references. It is not concerned with the substantive patentability requirement of sufficiency of disclosure under Article 83 EPC, read in conjunction with Rule 28 EPC 1973. The board therefore sees no contradiction between these provisions as they deal with different aspects of patentability. In the appellant's submission, the European patent application contained all the information as required by Article 13bis.3 PCT. Therefore, the EPO could not require any further act or information from the applicant, particularly not a conversion from a national to an international deposit. This argument assumes that the conversion (and the allocation of an international deposit number as a consequence thereof) is of a merely formal nature. This is incorrect. In so far as a microorganism deposited under the Budapest Treaty is deemed to have been properly disclosed, the formal requirements under the Budapest Treaty, including the act of conversion,

become material requirements of disclosure that as such are not addressed in Article 13bis PCT. The appellant has further argued that "it would be unreasonable to expect that an applicant must consider any administrative instruction issued by any Patent Office". This might be a valid argument against the approach taken by decision T 107/09 of 12 July 2012, where requirements of European law were imposed in relation to the foreign priority filing. The board, however, cannot agree that a Patent Office cannot legitimately require compliance with domestic law when it is a matter of filing a domestic application. The board therefore rejects the appellant's submission that the requirements of Article 83 EPC and Rule 28 EPC 1973 are superseded by those of Rule 13bis PCT.

Rule 28 EPC without the Budapest Treaty

5. Rule 28(1) (a) EPC 1973 requires that *"If an invention involves the use of or concerns biological material which is not available to the public and which cannot be described in the European patent application in such a manner as to enable the invention to be carried out by a person skilled in the art, the invention shall only be regarded as being disclosed as prescribed in Article 83 if: a sample of the biological material has been deposited with a recognised depositary institution not later than the date of filing of the application."*
- 5.1 As discussed above at point 2, the combination of Rule 28 EPC 1973 and Article 150(1) EPC 1973 gives a filing date for the European patent application of 4 March 2005.
- 5.2 The only confirmed deposit before that date is for a strain of *Lactobacillus delbruecki*, designated FERM

- P-19075, which was received by the Japanese IPOD on 27 February 2004. The deposit was made under the terms of the Japanese law governing such deposits.
- 5.3 Rule 28(1)(a) EPC 1973 does not specify the conditions under which a deposit has to be made. It makes no mention of the terms of Budapest Treaty which is designed to assist patent applicants by providing them with a sure and certain route to satisfy the requirements of Article 83 EPC by the legal fiction that a deposited microorganism that *de facto* was only sufficiently disclosed as of the publication date of the patent application, is considered, *de jure*, to be sufficiently disclosed as of the filing date of the application.
- 5.4 If the appellant does not wish to take this route he has to convince the board that Rule 28 EPC 1973, when read on its own, allows the board to apply the corresponding legal fiction that exists under Japanese law. It is assumed for present purposes that Japanese domestic law has identical provisions to the Budapest Treaty, adapted for national patent applications.
- 5.5 There is nothing in Rule 28 EPC 1973 that suggests that the provisions on this issue of the national laws of the state in which the applicant made his original microorganism deposit (which could be almost any country on earth) are to be incorporated into the EPC. To do so would either require the EPO to carry out *ex officio* investigations into a wide variety of national legal provisions, research that it is ill equipped to carry out, or that it simply accept an applicant's submissions on this point, an obviously unsatisfactory approach.

5.6 The appellant in this respect refers to point 4.2 of decision T 815/90 to support its contention that the deposit of a microorganism under purely national regulations, that is a deposit made outside of the Budapest Treaty, can satisfy the requirements of Rule 28(1) (a) EPC 1973. The board notes that T 815/90 concerned a European patent application with a filing date of 18 September 1985 and a priority date of 19 September 1984, that is prior to the publication of the 1986 Notice. Point 4.2 of the above decision, on which the appellant relies, reads as follows:

"The...virus had been deposited with the American Type Culture Collection (ATCC) under the patent procedures prior to the filing of this application, thus affording permanency of the deposit and ready availability to the public upon issuance of the patent. Thus, the requirement of Rule 28(1) (a) EPC is fulfilled."

5.7 The decision in T 815/90 suggests that if the actual national deposit of the microorganism with the ATCC (a US depositary authority) had been made at the correct time, the requirements of Rule 28 EPC 1973 would have been satisfied. The appellant therefore invites the board to treat the deposit with the IPOD in the present case in the same way. For the board to accept this approach would require it to accept the legal fiction under Japanese law discussed at point 5.4 above. As noted above, this approach is unsatisfactory. It was presumably accepted in T 815/90 for lack of any clearly defined procedural route for recognising a deposit of a microorganism. It should be borne in mind that 1984 was early days for both the European patent and the Budapest Treaty systems. The board in T 815/90 may have been motivated to give the applicant the benefit of the

doubt. Prior to the 1986 Notice, applicants were in considerable uncertainty as to how to prosecute applications involving deposited microorganisms. The uncertainty surrounding the system of deposit under Rule 28 EPC 1973 in the early days of its operation is discussed in T 39/88 - (see Headnote and point 6). The present case, however, takes place in a rather different legal and factual framework due to the 1986 Notice and several years of settled practice. Thus, the appellant was faced with no general uncertainty as to how applications involving microorganism deposits should be prosecuted. In addition, it should be noted that the underlying rationale of decision T 815/90, namely that a sufficient disclosure under the EPC must be affirmed because the rules of sufficient disclosure have been complied with under US law, is problematic. It is not only inconsistent with the principle of territoriality and independence of rights (Article 4bis Paris Convention), but also with case law on the requirements of sufficient disclosure in general. A more recent decision, T 107/09, dealt with a case where a disclosure that was deemed sufficient under US law, did not imply a sufficient disclosure under the EPC. Points 21 and 23 of T 107/09 state:

"21. In the present case - and this is undisputed - the hybridoma cell line producing the antibody MR1 has been deposited with the ATCC on 22 May 1992, i.e. only after the filing date of the US application No. 835,799.

23.1 ... whether an earlier application and a subsequent European application disclose the "same invention" is assessed in accordance with the EPC and not, in respect of the earlier application, in

accordance with the law of the state in which this earlier application is filed."

- 5.8 In contrast to decision T 107/09, the Board in the present case does not impose the requirements of Rule 28 EPC on the priority application, but only on the subsequent European application. This is perfectly in line with the principle of territoriality and with the common principle that national law should apply to a domestic (here: EPC) filing.
- 5.9 Decision T 815/90, in its turn, was based upon the legal uncertainty surrounding the proper procedure for depositing a microorganism and the apparent attempt to give the applicant the benefit of the doubt. By way of further historical background it is to be noted that the Budapest Treaty entered into force on 9 August 1980. The ATCC, the depositary authority of which it is a question in T 815/90, had concluded a bilateral agreement with the EPO in 1978 (see OJ 4/1978, 272 and OJ 5/1978, 301) and became an international depositary authority under the Budapest Treaty from 1 January 1981, (see "Announcement by the President of the EPO dated 2 February 1981 concerning microorganism depositary institutions recognised for the purpose of Rule 28 EPC", OJ 4/1981, 1). The board notes that T 815/90 mentions neither the Budapest Treaty nor a bilateral agreement. The decision can no longer assist the appellant.
- 5.10 The appellant also argued that T 39/88, which concerned a US priority application, in particular at point 4, was authority for its view that if it can be proved that a microorganism, that is deposited under purely national regulations, is available to third parties, independent of the consent of the depositor, then the

requirements of Rule 28 EPC 1973 are satisfied. The factual situation before the board in T 39/88 was that the US deposit could not fulfil the requirements of Rule 28 EPC 1973, and that the applicant had not requested conversion under either a bilateral agreement, or the Budapest Treaty, within the required time limits. Points 5 and 6 of T 39/88 indicate that the board in this case was decisively influenced by the uncertainty surrounding the system of deposits under Rule 28 EPC 1973 prior to the publication of the 1986 Notice. Thus T 39/88 is a somewhat isolated case that stands upon the then board's appreciation of a legal and factual situation that is no longer relevant. The board therefore considers that this case does not assist the appellant.

- 5.11 The 1986 Notice clearly leads away from an interpretation of Rule 28 EPC 1973 as put forward by the appellant as it restricts the acceptance of such a legal fiction to the case of deposits made under the Budapest Treaty. The residual category of bilateral agreements mentioned in the 1986 Notice is not relevant to the present case.
- 5.12 The appellant has argued (see paragraph XI) that the President of the EPO was acting *ultra vires* when he imported requirements taken from the Budapest Treaty into Rule 28 EPC 1978 via the 1986 Notice. Rule 28(9) EPC only provided that the President could issue a list of depositary institutions. The board notes that Article 10(2)(a) EPC 1973 gave the President the power to undertake, "...publication of guidance for the public to ensure the functioning of the European Patent Office". Hence the President was entitled to issue the 1986 Notice. The *ultra vires* question that remains open is whether the 1986 Notice can be considered to amend

the Implementing Regulations, something that was only within the power of Administrative Council under Article 33(1)(b) EPC 1973.

- 5.13 Clearly it is difficult to lay down rules which will enable a determination to be made in any case whether a Notice "amends" the Implementing Regulations, or "provides guidance" as to their interpretation. A case by case approach has to be taken.

In the case of a microorganism deposit, applicants, without the benefit of the Budapest Treaty, would face difficult, and in many cases, insoluble problems regarding showing sufficiency of disclosure as at the filing date of the application. The effect of the 1986 Notice is therefore to provide assistance to applicants by setting out a clear procedure to follow, and to provide them with a procedural fiction of sufficient disclosure that would otherwise not be available to them. It sets out not so much extra requirements to Rule 28 EPC 1978, but rather clear requirements for satisfying Rule 28 EPC 1978, whereas prior to the 1986 Notice applicants were somewhat in the dark on how to do this.

- 5.14 In the light of the above considerations, the board therefore concludes that the 1986 Notice provides guidance on the application of Rule 28 EPC 1978, rather than being an *ultra vires* amendment of the Implementing Regulations.
- 5.15 To sum up, the approach suggested by the appellant is not supported by the wording of Rule 28 EPC 1973, is contrary to the practical administration of patent applications and is contradicted by the 1986 Notice.

The board therefore rejects the appellant's above submissions on this point.

Time limit for requesting conversion

6. The appellant is correct in stating that nowhere in the EPC or the Budapest Treaty can a time limit be found for requesting conversion of a deposit made outside of the Budapest Treaty into one made under the Treaty. The only mention of such a time limit is found in footnote 2 and paragraph A.7. of the 1986 Notice. Rules 6 and 7 of the Budapest Treaty are concerned with deposit of a microorganism and receipt. The only reference these rules make to converting a non-Budapest Treaty deposit into a Budapest Treaty deposit is in Rule 6.4(d). This rule concerns conversion in a situation that is now of only historical interest and is not relevant to the present case. Nevertheless, despite this apparent lack of a formal legal basis, conversions in situations such as those of this case have taken place for over 30 years, see paragraph 29 of WIPO document BP/A/II/11 of 20 January 1981. They are a settled practice of international patent law.

6.1 Clearly, if the provisions of the Budapest Treaty are to apply at all to a deposit made outside of the Treaty, a request for such a conversion must be made at some point in time. The EPO with its 1986 Notice set a time limit of the date of filing of the European patent application. This time limit does not contradict the EPC or the Budapest Treaty which are silent on this point. The board is, of course, not bound by this 1986 Notice. The appellant has suggested that the board should substitute for this time limit the date of publication of the European application. The board can see no reason why it should do so. It is a common principle of

patent law that the patenting requirements must be complied with and will be examined as of the filing date. This principle is somewhat modified by the right of priority under the Paris Convention. However, the appellant has not demonstrated why this principle should not apply to the case of a microorganism which can only be sufficiently disclosed by way of deposit under the terms of Rule 28 EPC 1973 (see above). As has been explained above, the deposit of a microorganism under Japanese law may create the legal fiction of sufficient disclosure in the context of a Japanese patent application procedure. But it does not do so under the EPC. For the fiction to be applied to a European application, the deposit must have been made under the Budapest Treaty (with some exceptions that are not relevant for the present case), see paragraph 5.11 above. A domestic deposit, albeit with an institution recognised under the Budapest Treaty, only becomes a "Budapest" deposit once the domestic deposit has been converted. If conversion then equals sufficient disclosure, it is standard case law that this requirement must be fulfilled at the filing date. Every other interpretation would overturn a time limit that has been established for several decades and would disturb a long established legal certainty. Compelling reasons would need to be presented by the appellant to convince the board to take such a step. The board has not been presented with such reasons.

- 6.2 The appellant has also referred to decisions G 2/93 and T 815/90, T 815/90 being the referring case in this Enlarged Board of Appeal decision. The appellant refers to point 2 of the reasons of G 2/93. Point 2 of the reasons of G 2/93 sets out what the Enlarged Board of Appeal was not going to consider, these being points vital to the appellant's current appeal. The language

used by the Enlarged Board of Appeal explicitly not to consider a point cannot serve as authority on that point. The Enlarged Board of Appeal was saying they had nothing to say. The board is not persuaded that it can draw a conclusion from this negative language as to what position the Enlarged Board of Appeal would have taken if they had positively considered the point.

- 6.3 The certificate of the international deposit FERM BP-10663 carries a date of issuance of 15 August 2006 (section V), which is after the filing date of the patent application of 4 March 2005. In section IV of the certificate, entitled *"Receipt of Request for Conversion"*, the following is stated: *"The organism identified under I above was received on February 21, 2004 (Date of Domestic Receipt) and was received by this International Depositary Authority. (Transferred from FERM P-19705 deposited on February 27, 2004) "*

From the information provided by this certificate, it can only be concluded that the conversion of the national deposit into an international deposit took place on 15 August 2006 at the latest. It provides however no evidence, at what date the request for conversion was received or the conversion took effect.

- 6.4 Hence the board finds that the appellant has failed to file its conversion request within the time limit set out in the 1986 Notice, and has thus not fulfilled the requirements of Article 83 EPC and Rule 28 EPC 1973 as regards the microorganism referred to in claim 1 of the Main Request. This conclusion applies to all the claim requests before the board.

Consistent approach to disclosure - some remarks by the board

7. In its submissions on the consistency of the concept of disclosure, the appellant made some points (see paragraph XI, seventh paragraph above). Although it is not necessary for the board to address these points in order to make a decision in this case, the board considers that, in the light of the appellant's substantial submissions, it should address them *obiter*. The board would like to address them in the context of the hypothetical examples submitted in the written procedure (appellant's letter of 12 February 2015, p. 8/9). The appellant starts with the case that the deposit of a microorganism has not been converted according to the Budapest Treaty. Such microorganism would thus not be considered as prior art under the EPC. So far, this is indeed the result of the case at issue. The appellant then writes that "this means that a direct EP application could have been filed (after depositing the microorganism under the Budapest Treaty) while the present international application is no prior art, although anybody could have procured the deposited microorganism".

8. This is only partly correct. Someone (the Japanese applicant, or a third person) could have filed a direct European patent application with a corresponding deposit of the microorganism under the Budapest Treaty. This filing would be considered novel unless the microorganism had been disclosed prior to the European patent application date. The Japanese deposit would be considered prior art if it had been made public prior to the EP filing (the Board assumes that this was not the case), if it had been deposited under the Budapest Treaty (this apparently was not the case, either), or if it was deemed to have been made public under domestic Japanese law (this is what the appellant seems to assume). Yet it appears that in Japan, any

interested person can only make a request for a sample after the publication of the application. The mere deposit does not make the microorganism public prior art as of the date of deposit. Thus, it seems that a domestic Japanese deposit corresponding to an unpublished Japanese patent application is no more and no less prior art than an unpublished patent application in general. Under the EPC, such application counts as prior art for the assessment of novelty, Article 54(3) EPC, but only where such filing has been made under the EPC. An unpublished Japanese application would not be considered prior art under the EPC (unless there is a corresponding PCT application under Article 153(5) EPC). If indeed a member of the public would have been able to obtain a sample of the microorganism deposited in Japan even before the European filing date, such microorganism would be considered prior art under Article 54(2) EPC.

9. The appellant further points out that if, subsequent to the Japanese deposit of the microorganism, the Japanese application was published, it would be considered prior art for later patent applications. This is correct, as also under Japanese rules, any interested party could then obtain a sample of the microorganism. The appellant then continues as follows in relation to such application: "...whereas an EP application having the same content and relating to the same deposit is no reproducible prior art." This is certainly so where the Japanese deposit has not been converted into an international deposit under the Budapest Treaty by the European patent application date, because the requirements of an enabling disclosure as set out in the Budapest Treaty have not been met. But once the Japanese application is made public, any interested parties can obtain samples of the microorganism, and

the latter becomes public prior art under Article 54(2) EPC. Also for this case, the Board fails to see any contradiction with the established rules of enabling disclosure.

10. Finally, the example where a microorganism is described in a scientific paper and only available from the applicant, has to be resolved by applying the general rules of disclosure and the question whether such on-demand availability is sufficient to make the microorganism publicly available.
11. The board notes that several decades of experience with the Budapest Treaty have not led to any great practical difficulties, but, rather have provided applicants with great practical advantages. The board therefore acknowledges the appellant's submissions on this point, but for the given hypothetical examples does not see any inconsistencies with the disclosure requirements in general, and the Budapest treaty.

Referral to the Enlarged Board of Appeal

12. Under Article 112(1) EPC it is within the discretion of a board to refer any question to the Enlarged Board of Appeal if this appears necessary
 - (a) for ensuring uniform application of the law; or
 - (b) if a point of law of importance arises.

It is to be noted that only questions on a specific point, not entire cases, can be referred to the Enlarged Board of Appeal, (see decision T 184/91 of 25 October 1991).

12.2 In the present case the board sees no conflicting case law. Only a handful of cases that tangentially approach the issues in this case were cited by the appellant. Several of these cases are over 20 years old and turn upon the fact that at the time of the facts in question the Budapest Treaty had only just entered into force and/or the 1986 Notice had not been issued. The paucity of case law on the issues at hand, despite the passage of almost 30 years, is also an indication of the lack of substantial importance of the questions raised. The board therefore exercises its discretion not to refer any question to the Enlarged Board.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



A. Wolinski

M. Wieser

Decision electronically authenticated