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**Datasheet for the decision
of 9 November 2018**

Case Number: T 1566/12 - 3.3.08

Application Number: 04011161.9

Publication Number: 1484415

IPC: C12Q1/68, C12N15/63

Language of the proceedings: EN

Title of invention:

Method of alleviating pest infestation in plants

Patent Proprietor:

Devgen NV

Opponents:

BASF SE

Headword:

RNAi nematode feeding plants/DEVGEN

Relevant legal provisions:

EPC Art. 76(1), 113(1)

RPBA Art. 12(2), 15(3)

Keyword:

Main request, auxiliary request I - admitted (yes);
Main request, auxiliary request I - subject-matter extends
beyond content of the earlier application (yes);
Auxiliary request II - admitted (no);

Decisions cited:

T 0756/15

Catchword:



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Case Number: T 1566/12 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 9 November 2018

Appellant: BASF SE
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Respondent: Devgen NV
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
10 May 2012 concerning maintenance of the
European Patent No. 1484415 in amended form.**

Composition of the Board:

Chairman B. Stolz
Members: P. Julià
 J. Geschwind

Summary of Facts and Submissions

- I. European patent no. 1 484 415, with the title "Method of alleviating pest infestation in plants", was granted on the basis of the European patent application no. 04 011 161.9, a divisional application of the earlier European patent application no. 99 932 836.2 (published under the PCT as the International patent application WO 00/01846, hereinafter "the earlier patent application").
- II. Two oppositions were filed on the grounds for opposition under Articles 100(a), (b) and (c) EPC. At the oral proceedings held on 25 January 2012, the opposition division decided that the main request filed with letter dated 20 December 2010 fulfilled all the requirements of the EPC. Accordingly, the patent was maintained in amended form.
- III. Appeals were lodged by opponents 01 and 02 (appellants I and II, respectively). With the statements setting out their grounds of appeal, the appellants maintained the objections raised under Articles 76(1), 83, 54 and 56 EPC.
- IV. In reply thereto, the patent proprietor (respondent) re-submitted the main request underlying the decision under appeal and auxiliary requests I and II that had been originally filed before the opposition division as auxiliary requests 2 and 3, respectively, with submissions dated 24 November 2011.
- V. Oral proceedings were requested by all parties.
- VI. The board summoned the parties to oral proceedings. In a communication pursuant to Article 15(1) of the Rules

of Procedure of the Boards of Appeal (RPBA), the parties were informed of the board's provisional, opinion on some of the issues of the case, in particular that claim 1 of the main request comprised an unallowable generalisation of the original disclosure in the earlier patent application. The board further observed, under the heading "Admission of auxiliary requests I and II", that the proposed amendments to claim 1 went beyond the original disclosure (Article 76(1) EPC).

- VII. In a letter dated 21 August 2018, the respondent, without making any substantive submissions, informed the board of its intention not to attend the oral proceedings.
- VIII. In a letter dated 20 September 2018, appellant II withdrew both its opposition and appeal and ceased to be a party to the proceedings.
- IX. Oral proceedings were held on 9 November 2018 in the presence of appellant I.
- X. Claim 1 of the main request reads as follows:
- "1. A method of alleviating infestation of plant pests, which method comprises
- a) identifying a DNA sequence from said pest which is critical for its survival, growth, proliferation,
 - b) cloning said sequence from step a) or a fragment thereof in a suitable vector in an orientation relative to promoter(s) such that said promoter(s) is capable of initiating transcription of said DNA sequence to dsRNA upon binding of an appropriate transcription factor to said promoter(s), and
 - c) introducing said vector into the plant

wherein the plant pest is a plant pest that feeds on the plant."

- XI. Claim 1 of auxiliary requests I and II differs from claim 1 of the main request by the following amendments:

AR I: "1. [...] wherein the plant pest is a plant pest that feeds on the plant such that when the pest feeds on the plant it will ingest the expressed dsRNA in the plant thus inhibiting the expression of the DNA within the pest which is critical for its survival, growth, proliferation."

AR II: "1. [...] wherein the plant pest is a plant pest that feeds on the plant such that when the pest feeds on the plant the dsRNA can enter the cells of the pest and perform its inhibitory action on the target DNA."

- XII. The submissions made by the appellant, insofar as relevant to the present decision, may be summarised as follows:

*Main request (claims upheld by the opposition division)
Article 76(1) EPC*

The disclosure on page 7, lines 23 to 30 of the earlier patent application included a causal link between the pests' feeding on the plant, the inhibition of the DNA expression, and the alleviation of pest infestation. However, such causal link was not present in claim 1. According to claim 1, the plant pest feeding on the plant was unrelated to the preceding steps of the claim and to the alleviation of infestation. There was no support in the earlier patent application for a method in which the feeding of the plant pest on the plant had

no causal link with the alleviation of infestation.
Thus, claim 1 contravened Article 76(1) EPC.

Auxiliary request I
Article 76(1) EPC

There was no basis for the term "ingest" in the earlier patent application. The passage on page 7, lines 23 to 30 referred to plant pests that were capable to "digest" the dsRNA expressed in the plant but there was no reference to "ingest" this dsRNA. Both terms had a different meaning and were not interchangeable.

Admission of auxiliary request II

Although auxiliary request II was filed in opposition proceedings, it was not discussed during these proceedings, nor did the opposition division take a decision thereupon. Contrary to auxiliary request I, the subject-matter of auxiliary request II comprised features that differed from those of the main request and thus diverged from that of the main request and auxiliary request I. According to the case law (cf. T 756/15 of 10 July 2018), if the board found the main request to contravene Article 76(1) EPC, it was the respondent's task, not the appellant's, to convince the board that auxiliary request II did not contravene that article. However, in its reply to the statements of grounds of appeal, the respondent did not provide any substantiation at all as regards auxiliary request II, let alone a complete case as required by Article 12(2) RPBA. Therefore, auxiliary request II could not be admitted into the appeal proceedings.

XIII. The submissions made by the respondent in writing and insofar as relevant to the present decision, may be summarised as follows:

*Main request (claims upheld by the opposition division)
Article 76(1) EPC*

The feature "the plant pest is a plant pest that feeds on the plant" in the context of claim 1 was supported by the earlier patent application at page 7, lines 23 to 30. The passage on this page taught that the method of alleviating infestation of plant pests was applicable to pests that feed on the plant, providing thus an explicit basis for the subject-matter of claim 1. It was clear and implicit from the claim language that, as the pest fed on the plant, the dsRNA produced in step b) had to be consumed or ingested by the pest. The dsRNA entered the cells of the pest and performed its inhibitory action on the target DNA, i.e. DNA which was critical for growth, survival or proliferation of the plant pest.

*Auxiliary requests I and II
Admission; Article 76(1) EPC*

No submissions were made in this respect.

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

XV. The respondent (patent proprietor) requested in writing that the appeal be dismissed (main request) or, in the alternative, that the decision under appeal be set aside and that the patent be maintained on the basis of any of auxiliary requests I or II.

Reasons for the Decision

Article 113(1) EPC

1. By its decision not to attend the oral proceedings and not to file substantive arguments in reply to the issues raised in the board's communication, the respondent has chosen not to make use of the opportunity to comment on the board's provisional opinion, either in writing or at oral proceedings, although this opinion was to the respondent's disadvantage. According to Article 15(3) RPBA, the board is not obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned who may then be treated as relying on its written case.

Main request

Admission into the appeal proceedings

2. The main request is identical to the main request underlying the decision under appeal and therefore forms part of the appeal proceedings.

Article 76(1) EPC

3. The objection raised under this article concerns the feature in claim 1 "wherein the plant pest is a plant pest that feeds on the plant". As a basis for this feature, the respondent has indicated the passage on page 7, lines 23 to 30 of the earlier patent application, which reads as follows:

"... the method according to the invention provides a particularly selective mechanism for alleviating pest infestation, and in some cases parasitic infestation of plants, such that when the pest feeds on the plant it will digest the expressed dsRNA in the plant thus inhibiting the expression of the DNA within the pest which is critical for its growth, survival, proliferation or reproduction."

4. In the decision under appeal, the opposition division decided that the disclosure on page 7, lines 23 to 30 of the earlier patent application "provides an explicit basis for the claim language of the patent", since this disclosure "clearly teaches that the method of alleviating infestation of plant pests is applicable to pests that feed on the plant". Moreover, the opposition division considered that "it is clear and implicit from the claim language that as the pest feeds on the plant, the dsRNA produced in step b) will be consumed or ingested by the pest. The dsRNA will enter the cells of the pest and will perform its inhibitory action on the target DNA". Therefore, claim 1 was considered not to contravene Article 76(1) EPC (cf. page 5, point 2.1.3.1 of the decision under appeal).
5. In a communication pursuant to Article 15(1) RPBA, the parties were informed that the board, contrary to the opposition division, considered the contested feature in claim 1 to represent an unallowable generalization of the disclosure on page 7, lines 11 to 30 of the earlier patent application.
- 5.1 The paragraph on page 7 of the earlier patent application refers not only to plant pests feeding on the plant but it further defines these plant pests as "digest[ing] the expressed dsRNA in the plant thus

inhibiting the expression of the DNA within the pest which is critical for its growth, survival, proliferation or reproduction" (underlined by the board). In the board's view, this definition excludes: i) plant pests which, even though feeding on the plant, may not be capable to "digest" (i.e. uptake, process, etc.) the expressed dsRNA in the plant, and ii) expressed dsRNA in the plant which, even though being derived from a critical DNA sequence from the pest, result solely in off-target inhibition and which may nevertheless alleviate plant pest infestation (by non-specific effects of the expressed dsRNA in the plant). The disclosure in the earlier patent application is thus clearly limited to a particular group of plant pests and dsRNA sequences. However, none of these limitations has been introduced into claim 1. The proposed amendment thus represents an unallowable generalisation of the original disclosure in the earlier patent application.

- 5.2 Contrary to the opposition division, the board does not consider these limitations to be implicit. There is no limitation in claim 1, neither explicit nor implicit, to any particular group of plant pests, certainly not to those which are capable of "digest[ing] the expressed dsRNA in the plant". Nor is the DNA sequence from the plant pest which is critical for its survival, growth, and proliferation (or a fragment thereof) as defined in step a) of claim 1, limited, either explicitly or implicitly, to those DNA sequences (or fragments thereof) which, upon transcription in the plant and in the right orientation, result in an expressed dsRNA that inhibits - in a specific manner - the expression of a DNA sequence critical for the plant pest's growth, survival and proliferation. Therefore,

claim 1 comprises subject-matter that extends beyond the content of the earlier patent application.

6. Thus, the main request contravenes Article 76(1) EPC.

Auxiliary request I

Admission into the appeal proceedings

7. Auxiliary request I was originally filed as auxiliary request 2 in reply to the preliminary opinion of the opposition division issued in preparation for the oral proceedings held on 25 January 2012. Since at these proceedings, the opposition division considered the main request to fulfil all the requirements of the EPC and decided to maintain the patent on the basis of that main request, there was no need to discuss any auxiliary request then on file, not even their admission into the opposition proceedings.
8. The amendment to claim 1 of auxiliary request I intends to overcome the objection raised under Article 76(1) EPC against claim 1 of the main request by introducing additional features disclosed on page 7, lines 23 to 30 of the earlier patent application. The amendment is of a simple and straightforward nature and, allegedly, has the same basis or support in the earlier patent application as claim 1 of the main request. Thus, the subject-matter of auxiliary request I is fully convergent with that of the main request.
9. The admission of auxiliary request I into the appeal proceedings is not contested by the appellant, nor does the board, in the light of the above considerations, see any reason for not admitting auxiliary request I into the proceedings.

Article 76(1) EPC

10. The features introduced into claim 1 of auxiliary request I are literally identical to those found on page 7, lines 26 to 30 of the earlier patent application, except for the term "ingest" which is not mentioned on page 7 (cf. point XI *supra*).
11. Although the board, in the communication pursuant to Article 15(1) RPBA, drew the parties' attention to this difference and its possible relevance under Article 76(1) EPC, the respondent made no submissions in this respect.
12. The board shares the appellant's view that the terms "digest" and "ingest" have different meanings and, in the context of claim 1, allow for different interpretations. In the board's view, the definition in claim 1 of a specific route or pathway (such as digest, ingest, enter, etc.) on which the dsRNA expressed in the plant relies for its transfer to - or for arriving at - the plant pest feeding on said plant, intrinsically defines a specific group of plant pests, namely those which have - or are capable of using - this specific route or pathway, excluding thereby other plant pests which, for whatever reasons, do not have - or are not capable of using - said route or pathway. Thus, the replacement of the term "digest" by the term "ingest" is not directly and unambiguously derivable from the disclosure on page 7, lines 23 to 30 of the earlier patent application.
13. No other paragraph has been indicated in the earlier patent application as a possible basis for the term "ingest" or for the "ingestion" of a dsRNA expressed in

the plant by a pest feeding on said plant. The board fails to see any basis in the earlier patent application for the selection of a group of plant pests that are able to "ingest" the dsRNA expressed in the plant. In the absence of such a basis, amended claim 1 of auxiliary request I comprises subject-matter extending beyond the content of the earlier patent application.

14. Auxiliary request I contravenes thus Article 76(1) EPC.

Auxiliary request II

Admission into the appeal proceedings

15. Auxiliary request II was originally filed as auxiliary request 3 with the patent proprietor's (respondent's) reply to the preliminary opinion of the opposition division issued in preparation for the oral proceedings held on 25 January 2012. The procedural situation of auxiliary request II is thus, in principle, identical to that of auxiliary request I (cf. point 7 *supra*).
16. The amendments introduced into claim 1 of auxiliary request II broadly refer to the fact that the dsRNA expressed in the plant "can enter" the cells of the plant pest and perform its inhibitory action on "the target DNA" (cf. point XI *supra*).
17. When re-filing auxiliary requests I and II with its reply to the statements of grounds of appeal (cf. point IV *supra*), the respondent did not indicate, where, in its view, the earlier patent application directly and unambiguously disclosed the subject-matter of claim 1. Nor did the respondent reply in substance to the board's communication pursuant to Article 15(1) RPBA.

18. The board observes that the amendments introduced into claim 1 neither relate to the term "digest" nor to the inhibition "of the expression of the DNA within the pest which is critical for its growth, survival, proliferation or reproduction", both features mentioned in the paragraph on page 7 of the earlier patent application. Therefore, said paragraph cannot serve as a basis for the proposed amendments to claim 1. Moreover, since the characterization of the plant pest in claim 1 significantly deviates from the characterization in claim 1 of the main request and auxiliary request I, the board shares appellant's view that the subject-matter of auxiliary request II does not converge with that of the main request or auxiliary request I.

19. The board has noticed the disclosure on page 29, lines 28 to 30 of the earlier patent application explicitly mentioning that "[t]he RNA and/or dsRNA can enter the cells of the nematode and perform its inhibitory action on the target DNA" (underlined by the board). This disclosure is however limited to nematodes as the plant pest feeding on plants without any reference to plant pests in general or to plant pests other than nematodes. This part of the description does therefore not directly and unambiguously disclose the feature of the proposed amendment to claim 1.

20. Article 12(2) RPBA requires a respondent's reply to the statement of grounds of appeal to contain its complete case, i.e. to set out clearly and concisely the reasons why it is requested that the decision under appeal be upheld, and to specify expressly all the facts, arguments and evidence relied on. There is a large body of case law defining the requirements of a sufficient

substantiation for a party's submissions (cf. "Case Law of the Boards of Appeal", 8th edition 2016, IV.E.2.6.4.a), 1102; IV.E.2.6.8.a), 1107; and IV.E.3.2.1.h), 1122). It is not the board's function to fill the gaps in a party's case by reviewing on its own motion facts, arguments and evidence, in particular those which were not specifically put forward by the party in appeal proceedings.

21. In view of the complete lack of submissions as regards auxiliary request II in the appeal proceedings, this request is not admitted into the appeal proceedings.

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:



L. Malécot-Grob

B. Stolz

Decision electronically authenticated