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**Datasheet for the decision
of 19 January 2022**

Case Number: T 2774/18 - 3.3.04

Application Number: 05764293.6

Publication Number: 1765059

IPC: A01H5/00, A01H5/08, A01H1/02

Language of the proceedings: EN

Title of invention:
Watermelon with improved processing qualities

Applicant:
Seminis Vegetable Seeds, Inc.

Headword:
Watermelon/SEMINIS

Relevant legal provisions:
EPC Art. 53(b), 111(1)
EPC R. 28(2)

Keyword:
Exceptions to patentability - (no)
Remittal to the department of first instance - (yes)

Decisions cited:
G 0002/12, G 0002/13, G 0003/19

Catchword:

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Case Number: T 2774/18 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 19 January 2022

Appellant: Seminis Vegetable Seeds, Inc.
(Applicant) 800 North Lindbergh Blvd.
St. Louis MO 63167 (US)

Representative: Uexküll & Stolberg
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 10 July 2018
refusing European patent application No.
05764293.6 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair G. Alt
Members: B. Claes
L. Bühler

Summary of Facts and Submissions

- I. The appeal of the applicant ("appellant") lies from the decision of the examining division refusing European patent application No. 05 764 293.6 entitled "*Watermelon with improved processing qualities*". The application was filed on 1 July 2005 as an international patent application and published as WO2006/014463.
- II. The examining division based its decision to refuse the patent application solely on the ground that, in relation to the main request filed with a letter dated 14 May 2018, "*the presently claimed plants are excluded from patentability pursuant to Article 53(b) EPC and Rule 28(2) EPC, since they are exclusively obtained by an essentially biological process*". The same objection applied *mutatis mutandis* to the claims of auxiliary requests 1 to 3, filed with the same letter.
- III. With the statement setting out the grounds of appeal, the appellant maintained the sets of claims of the main request and auxiliary requests 1 to 3 at issue in the decision under appeal.

All independent claims 1, 15 to 20 and 30 of the main request (claims 1 to 36) are for plants or plant material and read:

"1. A watermelon plant that produces a mature fruit having flesh with soluble solids of at least 6 brix wherein said flesh resists pressure of at least 15.568 N, and said flesh is measured from the center of a cut fruit with a penetrometer having an 8 millimeter diameter probe and expressed as an average of three to

five measurements, and wherein the plant is a triploid or tetraploid plant.

15. The seed for a watermelon plant of any one of claims 1 to 14, wherein said seed is a hybrid seed having as a parent inbred watermelon line 3347 wherein a representative sample of seed of said line has been deposited with the NCIMB under NCIMB Accession No. 41230.

16. Pollen from a plant grown from the seed of claim 15.

17. Ovules from a plant grown from the seed of claim 15.

18. Vegetative tissue derived from a triploid or tetraploid [*sic*] watermelon plant that produces a mature fruit having flesh with soluble solids of at least 6 brix wherein said flesh resists pressure of at least 15.568 N, wherein said flesh is measured from the center of a cut fruit with a penetrometer having an 8 millimeter diameter probe and expressed as an average of three to five measurements.

19. The watermelon flesh of the watermelon fruit of the watermelon plant of any one of claims 1 to 14.

20. A plurality of watermelon plants according to one of claims 1 to 14, grown in a field.

30. The fruit of any one of claims 1 to 14, and 21 to 29, wherein said flesh of said mature fruit resists pressure of at least 17.792 N."

The remaining claims 2 to 14, 21 to 29 and 31 to 36 are all dependent on an independent claim.

- IV. The board issued a communication pursuant to Rule 100(2) EPC and informed the appellant of its preliminary opinion on the appeal. The board informed the appellant that it intended to set aside the decision under appeal and to remit the case to the examining division for further prosecution.
- V. With a letter dated 4 September 2020, the appellant informed the board that they agreed, and thus requested, that the board set aside the decision under appeal and remit the case to the examining division for further prosecution. They withdrew their request for oral proceedings.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 99 EPC and is therefore admissible.

Main request - exceptions to patentability (Article 53(b) EPC)

2. The sole reasons given by the examining division for refusing the patent application was that the claimed plants were excluded from patentability pursuant to Article 53(b) EPC and Rule 28(2) EPC (see section II).
3. In view of the provisions made by the Enlarged Board of Appeal for European patent applications pending before 1 July 2017, the new interpretation of Article 53(b) EPC given in opinion G 3/19 of 14 May 2020 (OJ EPO 2020, A119), being consequential to

the introduction of new Rule 28(2) EPC on 1 July 2017, has no retroactive negative effect on pending European patent applications filed before 1 July 2017 (see opinion G 3/19, points XXVIII and XXIX).

4. Accordingly, as the present application was filed before 1 July 2017 and is still pending (see section I) the claimed subject-matter is not excluded from patentability pursuant to Article 53(b) EPC in conjunction with Rule 28(2) EPC.
5. Furthermore, Article 53(b) EPC, as interpreted by the Enlarged Board of Appeal in decisions G 2/12 and G 2/13 (OJ EPO 2016, A27 and A28), does not exclude the subject-matter of claims 1 to 36 from patentability either.
6. The appeal is thus allowable.

Remittal (Article 111(1) EPC)

7. Pursuant to Article 111(1) EPC, the board may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.
8. It is the primary function of appeal proceedings to give a judicial decision upon the correctness of the decision under appeal (see Case Law of the Boards of Appeal, 9th edition 2019, section V.A.1.1, second paragraph, and decisions referred to there).
9. The sole reasons for refusing the patent application were that the claimed plants were excluded from patentability pursuant to Article 53(b) EPC and

Rule 28(2) EPC (see section II) and the board reviews this decision (see point 4).

10. Accordingly, in line with the appellant's request, the board decides to remit the case to the examining division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.

The Registrar:

The Chair:



A. Chavinier-Tomsic

G. Alt

Decision electronically authenticated