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**Datasheet for the decision
of 3 December 2021**

Case Number: T 2796/18 - 3.3.04

Application Number: 14702508.4

Publication Number: 2950634

IPC: A01H5/08, A01H1/04

Language of the proceedings: EN

Title of invention:

Solanum lycopersicum plants having pink fruits

Applicant:

Nunhems B.V.

Headword:

Solanum lycopersicum plants having pink fruits/NUNHEMS

Relevant legal provisions:

EPC Art. 53(b), 111(1), 111(2)
EPC R. 28(2)

Keyword:

Main request: exceptions to patentability (no);
remittal to the examining division for further prosecution
(yes)

Decisions cited:

G 0002/12, G 0002/13, G 0003/19

Catchword:



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Case Number: T 2796/18 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 3 December 2021

Appellant: Nunhems B.V.
(Applicant) Napoleonsweg 152
6083 AB Nunhem (NL)

Representative: BASF IP Association
BASF SE
G-FLP-C006
67056 Ludwigshafen (DE)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 13 August 2018
refusing European patent application No.
14702508.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair G. Alt
Members: R. Morawetz
M. Blasi

Summary of Facts and Submissions

- I. The appeal filed by the applicant (appellant) lies from the examining division's decision refusing European patent application No. 14 702 508.4 (application). The application is entitled "*Solanum lycopersicum plants having pink fruits*" and has been filed on 28 January 2014.
- II. By a communication under Rule 71(3) EPC the appellant was informed that the examining division intended to grant a European patent on the basis of the set of claims of auxiliary request 2 filed on 13 March 2018. The higher ranking claim requests, i.e. the main request and auxiliary request 1, both filed with the same letter, were considered to relate to subject-matter excluded from patentability under Article 53(b) EPC.
- III. In reply, the appellant withdrew auxiliary request 2 and requested a reasoned decision on the main request and on auxiliary request 1.
- IV. In the decision under appeal the examining division held that the subject-matter of the set of claims of the main request and of auxiliary request 1 fell under the exclusions from patentability as defined by Rule 28(2) EPC and that, consequently, the application did not meet the requirements of Article 53(b) EPC.
- V. With the statement of grounds of appeal, the appellant submitted sets of claims of auxiliary requests 1 to 3 and various procedural and substantive requests.

VI. The board summoned the appellant to oral proceedings as requested, and issued a communication under Article 15(1) RPBA dated 25 June 2020, informing it of its preliminary opinion with respect to the allowability of the appeal. The board furthermore invited the appellant to clarify its requests.

VII. With letter dated 17 August 2020, the appellant withdrew its previous requests, stated its new requests (see section X. below) and confirmed that its main claim request was the set of claims of the main request filed with letter dated 13 March 2018.

Claim 1 of the main request reads:

"1. A cultivated plant of the species *Solanum lycopersicum* comprising a *myb12* allele having one or more mutations, said mutations resulting in production of a mutant *myb12* protein, wherein said mutant *myb12* protein has a G50R amino acid substitution in SEQ ID NO: 1 or in variants thereof, said variants having at least 85% amino acid sequence identity to SEQ ID NO: 1; or wherein said mutant *myb12* protein comprises a deletion of the amino acids 61 to 338 in SEQ ID NO: 1, or invariants [sic] thereof, said variants having at least 85% amino acid sequence identity to SEQ ID NO: 1."

VIII. The oral proceedings were cancelled.

IX. The appellant's arguments are summarised as follows:

Main request

Exceptions to patentability (Article 53(b) EPC)

In accordance with opinion G 3/19 the subject-matter of the claims was not excluded from patentability pursuant to Article 53(b) EPC.

Remittal (Article 111(1) EPC)

The examining division had already issued a communication under Rule 71(3) EPC for a claim set wherein the only difference with the claims of the main request was a disclaimer, which the examining division had deemed necessary to overcome the exclusion from patentability pursuant to Article 53(b) EPC and Rule 28(2) EPC. Therefore, the case should be remitted to the examining division with an order to grant a patent on the basis of the set of claims of the main request.

X. The appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the set of claims of the main request filed on 13 March 2018, or alternatively, that the case be remitted to the examining division with the order that the claims of the main request are in compliance with Article 53(b) EPC. Oral proceedings were requested in the event that the board contemplated a decision that did not meet at least one of these two requests.

Reasons for the Decision

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

Main request

Exceptions to patentability (Article 53(b) EPC)

2. The sole reason given by the examining division for rejecting the main request was that the claimed plants were exclusively obtained by means of an essentially biological process and that the subject-matter of claim 1 was therefore excluded from patentability pursuant to Article 53(b) EPC and Rule 28(2) EPC.
3. Article 53(b) EPC excludes from patentability "*plant or animal varieties or essentially biological processes for the production of plants or animals*" while Rule 28(2) EPC, in force from 1 July 2017, stipulates that under Article 53(b) EPC, European patents shall not be granted in respect of plants or animals exclusively obtained by means of an essentially biological process.
4. The appellant did not dispute that the claimed plants were exclusively obtained by means of an essentially biological process but submitted that in accordance with opinion G 3/19 of 14 May 2020 (OJ EPO 2020, A119), the subject-matter of the claims was not excluded from patentability pursuant to Article 53(b) EPC.
5. The board considers that with opinion G 3/19 (*supra*), the legal situation underlying the decision under appeal has substantially changed (see in particular

points 7. and 8. below).

6. In decisions G 2/12 and G 2/13 (see OJ EPO 2016, A27 and A28) the Enlarged Board of Appeal had held that the exception to patentability of essentially biological processes for the production of plants in Article 53(b) EPC did not have a negative effect on the allowability of a product claim directed to plants or plant material such as a fruit or plant parts.
7. In opinion G 3/19 (*supra*) the Enlarged Board of Appeal abandoned the interpretation of Article 53(b) EPC given in decisions G 2/12 and G 2/13 (*supra*) and, in the light of Rule 28(2) EPC, held that the term "essentially biological processes for the production of plants or animals" in Article 53(b) EPC is to be understood and applied as extending to products exclusively obtained by means of an essentially biological process (see Reasons, point XXVI.8). The Enlarged Board of Appeal thus concluded that the exception to patentability of essentially biological processes for the production of plants or animals in Article 53(b) EPC has a negative effect on the allowability of product claims and product-by-process claims directed to plants, plant material or animals, if the claimed product is exclusively obtained by means of an essentially biological process (see Conclusion).
8. However, in order to ensure legal certainty and to protect the legitimate interests of patent proprietors and applicants, the Enlarged Board of Appeal considered it appropriate that the new interpretation of Article 53(b) EPC had no retroactive effect on European patents containing such claims which were granted before 1 July 2017, when Rule 28(2) EPC entered into force, or on pending European patent applications

seeking protection for such claims which were filed before that date (see Reasons, point XXIX).

9. Accordingly, as the present application was filed before 1 July 2017, and is still pending (see section I), the new interpretation of Article 53(b) EPC adopted in opinion G 3/19 (*supra*), does not apply.
10. Furthermore, Article 53(b) EPC, as interpreted by decisions G 2/12 and G 2/13 of the Enlarged Board of Appeal (*supra*), does not exclude the subject-matter of the main request from patentability.
11. In view of the above considerations, the board concurs with the appellant that the subject-matter of the claims is not excluded from patentability pursuant to Article 53(b) EPC in conjunction with Rule 28(2) EPC.
12. The appeal is thus allowable.

Remittal (Article 111 EPC)

13. 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.
14. It is the primary object of the appeal proceedings to review the decision under appeal in a judicial manner (see Article 12(2) RPBA and Case Law of the Boards of Appeal, 9th edition 2019, section V.A.1.1, second paragraph and decisions referred to there).

15. As explained in point 2. above, the sole reason for refusing the present application was that the subject-matter of claim 1 of the main request was excluded from patentability pursuant to Article 53(b) EPC and Rule 28(2) EPC, a decision which the board reviews (see points 3. to 11. above).
16. The communication under Rule 71(3) EPC (see section II.) informing the appellant of the examining division's intention to grant a patent is not binding on the examining division. Indeed, Rule 71a(2) EPC makes it clear that, until the decision to grant the European patent is issued, the examining division may resume the examination proceedings at any time.
17. As the examining division has not taken an appealable decision on any other requirement for patentability, the board does not accede to the appellant's request that the case be remitted to the examining division with the order to grant a patent on the basis of the set of claims of the main request filed with letter dated 13 March 2018.
18. In view of the above considerations, the board decides to remit the case to the examining division for further prosecution.
19. Pursuant to Article 111(2) EPC the examining division is bound by the ratio decidendi of the board, in so far as the facts are the same. The decision is thus in line with one of the appellant's requests and could be taken without holding oral proceedings.

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