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**Datasheet for the decision
of 2 October 2020**

Case Number: T 0958/19 - 3.3.04

Application Number: 06787541.9

Publication Number: 1915049

IPC: A01H5/06, A01H5/10

Language of the proceedings: EN

Title of invention:

Low pungency, long day onion

Applicant:

Seminis Vegetable Seeds, Inc.

Headword:

Onion plant/SEMINIS

Relevant legal provisions:

EPC Art. 53(b), 123(2), 111(1)
EPC R. 28(2)

Keyword:

Amendments - allowable (yes)
Exceptions to patentability - (no)
Remittal to the department of first instance - (yes)

Decisions cited:

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

Catchword:



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Case Number: T 0958/19 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 2 October 2020

Appellant: Seminis Vegetable Seeds, Inc.
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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 29 November
2018 refusing European patent application No.
06787541.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman B. Claes
Members: B. Rutz
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. 06787541.9 entitled "*Low pungency, long day onion*".
- II. In the decision under appeal the examining division found that claims 1 to 9 of the pending claim request contravened the requirements of Article 123(2) EPC. In addition, the subject-matter of claims 1 to 9 was considered to be excepted from patentability by virtue of Article 53(b) EPC and Rule 28(2) EPC.
- III. With their statement setting out the grounds of appeal, the appellant submitted a new set of claims 1 to 10 as a main request.

Claim 1 of the main request reads:

"An onion plant wherein said onion plant requires 14 or more contiguous hours of daylight to initiate bulb formation and comprises a bulb having less than 5.5 μM pyruvic acid/gram fresh weight ($\mu\text{M}/\text{g}$ FW pyruvate) at harvest, wherein the plant is a progeny of a plant selected from WYL 77-5128B (NCIMB Accession No. 41329) and WYL 77-5168B (NCIMB Accession No. 41330) and wherein said bulb is capable of being stored for two months at about 4 degrees centigrade to about 6 degrees centigrade and at a relative humidity in the range from about 50% to about 65% without an increase in pyruvic acid development (PAD) of greater than 20%."

- IV. The board issued a communication pursuant to Rule 100(2) EPC and informed the appellant of its

preliminary opinion on the appeal. The new understanding/interpretation of Article 53(b) EPC given in opinion G 3/19 of the Enlarged Board of Appeal of 14 May 2020 had no retroactive negative effect on the present European patent application. Furthermore, the subject-matter of the newly submitted claims appeared not to extend beyond the content of the application as filed.

- V. With a letter dated 3 September 2020, the appellant requested remittal of the case to the examining division for further prosecution "*without a hearing before the Board*" and stated that "[t]he request for a hearing is maintained only in case the Board should intend to dismiss the appeal in its entirety".

Reasons for the Decision

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

Main request - claims 1 to 10
Amendments (Article 123(2) EPC)

2. The wording "method of selecting an onion plant" objected to under Article 123(2) EPC in the decision under appeal no longer appears in the claims, and the claimed subject-matter does not extend beyond the content of the application as filed.
3. The claims therefore comply with the requirements of Article 123(2) EPC.

Exceptions to patentability (Article 53(b) EPC)

4. 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, being consequential to the introduction of new Rule 28(2) EPC on 1 July 2017, has no retroactive negative effect on the present European patent application (see opinion G 3/19, points XXVIII and XXIX).
5. Furthermore, Article 53(b) EPC, as interpreted by decisions G 2/12 and G 2/13 (OJ EPO 2016, A27 and A28), does not exclude the subject-matter of claims 1 to 10 from patentability.
6. The board thus considers the appeal 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. As explained in point II. above, the reasons for refusing the application were that the amendments of claims 1 to 9 contravened the requirements of

Article 123(2) EPC, and the subject-matter of claims 1 to 9 was excepted from patentability by virtue of Article 53(b) EPC and Rule 28(2) EPC. The board reviews this decision (see points 2. to 6. above).

10. Accordingly, in line with the appellant's request, the board remits 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 Chairman:



I. Aperribay

B. Claes

Decision electronically authenticated