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Datasheet for the decision of 2 September 2020

Case Number: T 1430/19 - 3.3.04

Application Number: 08425721.1

Publication Number: 2183964

IPC: A01H5/10, A21D2/18, C08B30/00

Language of the proceedings: EN

Title of invention:
High amylose durum wheat grains, meal and starch

Applicant:
Barilla G. e R. Fratelli S.p.A.

Headword:
High amylose durum wheat grains/BARILLA

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

Keyword:
Main request - exceptions to patentability (no); remittal to the examining division (yes)

Decisions cited:
G 0003/19

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

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Case Number: T 1430/19 - 3.3.04

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

Appellant: (Applicant)	Barilla G. e R. Fratelli S.p.A. Via Mantova, 166 43100 Parma (IT)
Representative:	Ferreccio, Rinaldo Botti & Ferrari S.r.l. Via Cappellini, 11 20124 Milano (IT)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 7 January 2019 refusing European patent application No. 08425721.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair	G. Alt
Members:	A. Schmitt
	L. Bühler

Summary of Facts and Submissions

I. The appeal filed by the applicant (appellant) lies from the decision of the examining division refusing European patent application No. 08 425 721.1, filed on 11 November 2008. The title of the application is "*High amylose durum wheat grains, meal and starch*".

II. In the decision under appeal, the examining division held that the subject-matter of claims 1, 2 and 7 of the sets of claims of the main request and auxiliary request 1, both filed with letter dated 19 April 2016, "*falls under the exclusion from patentability as defined by new Rule 28 (2) EPC*" and that, consequently, the application did not meet the requirements of Article 53(b) EPC in conjunction with Rule 28(2) EPC (point 16, last two paragraphs).

III. With the statement of grounds of appeal, the appellant maintained the sets of claims of the main request and auxiliary request 1 underlying the decision under appeal.

IV. Claim 1 of the main request reads as follows:

"1. Grain of tetraploid *Sgp-1* double mutant homozygote durum wheat selected for the characteristic of not expressing the *Sgp-A1* and *Sgp-B1* forms of the *Sgp-1* gene, containing a durum wheat starch having an apparent amylose content comprised between 40.0 and 43.6%, by weight on the weight of the starch."

V. In their statement of grounds of appeal, the appellant requested that "*the refusal decision by the Examining Division be set aside in its entirety and that European*

patent application No. 08425721 be granted on the basis of the set of claims filed on 19.04.2016" (see statement of grounds of appeal, point 2).

VI. The board issued a communication pursuant to Article 15(1) RPBA setting out its preliminary opinion with respect to the appeal and invited the appellant to reconsider their requests.

VII. In response, the appellant requested "*that the refusal decision by the Examining Division be set aside and that European patent application No. 08425721 be remitted to the Examining Division for further prosecution pursuant to Art 111(1) EPC*" (see letter dated 6 August 2020).

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 reason given by the examining division for refusing the application was that the subject-matter of claims 1, 2 and 7 was excluded from patentability pursuant to Article 53(b) EPC and Rule 28(2) EPC.

3. In opinion G 3/19 of 14 May 2020 the Enlarged Board of Appeal held (see Conclusion) that:

"*Taking into account developments after decisions G 2/12 and G 2/13 of the Enlarged Board of Appeal,*

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 or if the claimed process features define an essentially biological process."

4. However the Enlarged Board of Appeal also held (*ibid.*) that:

"*This negative effect does not apply to European patents granted before 1 July 2017 and European patent applications which were filed before that date and are still pending.*"

5. Accordingly, as the present application was filed before 1 July 2017 and is still pending, the subject-matter of the claims of the main request is not excluded from patentability pursuant to Article 53(b) EPC in conjunction with Rule 28(2) EPC.

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. As explained in point 2 above, the sole reason for refusing the application was that the subject-matter of claims 1, 2 and 7 of the main request was excluded from patentability pursuant to Article 53(b) EPC and Rule 28(2) EPC and the board reviews this decision (see points 3 to 6 above).

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 on the basis of the set of claims of the main request filed on 19 April 2016.

The Registrar: The Chair:

I. Aperribay G. Alt

Decision electronically authenticated