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**Datasheet for the decision
of 20 May 2022**

Case Number: T 0913/20 - 3.2.04

Application Number: 07826750.7

Publication Number: 2077712

IPC: A01G1/06

Language of the proceedings: EN

Title of invention:

METHOD FOR PRODUCING PROPAGATING MATERIAL TO BE USED IN TREE
CULTIVATIONS OF DOUBLE-TRUNK TYPE

Applicant:

Societa' Agricola Vivai Mazzoni Società Semplice

Headword:

Relevant legal provisions:

EPC Art. 54(2), 115

EPC R. 103(1)(a)

RPBA 2020 Art. 13(1)

Keyword:

Novelty - (no)

Observations by third parties - relevant (yes)

Admission criteria - prima facie allowability - all requirements of the EPC can be examined by the Board

Reimbursement of appeal fee - (no)

Decisions cited:

Catchword:



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Case Number: T 0913/20 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 20 May 2022

Appellant: Società Agricola Vivai Mazzoni Società Semplice
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 10 October 2019
refusing European patent application No.
07826750.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman G. Martin Gonzalez
Members: J. Wright
T. Bokor

Summary of Facts and Submissions

- I. The appeal was filed by the appellant (applicant) against the decision of the Examining Division to refuse the patent application in suit.

The Examining Division held *inter alia* that claim 1 of the main request was not new over D1, D5 and D8.

- II. Third party observations were received on 29 December 2020. The appellant filed a reply to the third party observations on 13 April 2021.

In preparation for oral proceedings the Board issued a communication setting out its provisional opinion on the relevant issues.

With letter of 26 April 2022 the appellant replied to the Board's provisional opinion. The appellant withdrew their request for oral proceedings and further informed the Board that they would not attend the scheduled oral proceedings.

The Board cancelled the scheduled oral proceedings and decided in writing.

- III. The appellant requests that the decision under appeal be set aside and that a patent be granted on the basis of an unchanged main request (filed before the Examining Division on 15 April 2019) or auxiliarily according to auxiliary requests 1-2 as filed with letter of 26 April 2022.

- IV. The wording of claim 1 of the requests relevant to this decision is as follows:

(a) Main request

"A method for producing fruit tree plants belonging to the family of pome fruit of double trunk type in a nursery, comprising the following steps:

- a. transplant of a rootstock in soil in a nursery for cultivation and cultivation thereof;
- b. graft onto said rootstock of propagating material of the variety to be reproduced for producing shoots;
- c. selection and/or modification of the position of said shoots with the aim of obtaining two shoots placed opposite each other on each one of said plants, and
- d. cultivation of said plants until the stadium wherein they can be planted out for the fruit production and planting out for such purpose."

(b) First auxiliary request (26 April 2022)

Claim 1 as in the main request with the following amendment (emphasis added by Board to indicate amendment):

"A method for producing apple and/or pear ~~fruit-tree~~ plants ~~belonging to the family of pome fruit~~ of double trunk type..."

(c) Second auxiliary request (26 April 2022)

Claim 1 as in the first auxiliary request with the following features added at the end of the claim (emphasis added by Board to indicate amendment):

"... wherein in said step b) the graft of propagating material is carried out by means of a so-called "chip"-like graft of two buds onto the same rootstock."

V. In the present decision, reference is made to the following documents:

(D1) NL 1 001 636 A1

(D5) Carpenter E. D.: "Espaliers for Connecticut", Connecticut Cooperative Extension Service, College of Agriculture and Natural Resources, The University of Connecticut; pages 2 to 12; 1972

(D8) Jager H.: "Illustrierte Bibliothek des landwirtschaftlichen Gartenbaus", Die Baumschule, dritte Auflage; pages 114, 150, 151, 157; 1868

(D10) Dittrich: "Die vollkommene Obstbaumschule", 1839, cited in the impugned decision in section 7.2 (third party observations of 15 December 2017) as NPL1 and refiled with third party observations of 29 December 2020, in appeal.

VI. VII. The appellant's arguments can be summarised as follows:

The third party observations of 29 December 2020 should not be admitted for having been filed during the appeal proceedings. Claim 1 of the main request is new over the cited prior art. New auxiliary requests 1-2 of 26 April 2022 should be admitted. The novelty objection based on D10 of the Board's preliminary opinion are special circumstances that justify their filing. How the Examining Division arrived at the conclusion of lack of novelty over D1 and D8 represents a procedural violation. The appeal fee should be reimbursed for reasons of equity. The case should be remitted to the Examining Division for the remaining issue of inventive step.

Reasons for the Decision

1. The appeal is admissible.
2. The invention relates to a method for producing propagating material, in particular pome fruit tree plants, to be used in tree cultivations, see application (PCT publication) page 1, lines 4-8 and lines 19-28. The claimed method provides a technique for producing double trunk plant type (bicaulis) in a nursery, see page 2, lines 25 - page 3, line 1. The use of bicaulis instead of monocaulis (single trunk) plants in the fruit production at orchards has several advantages in terms of branches positioning, layout of the different layers of branches, fruit shading, fruit homogeneity, photosynthetic effectiveness, plant strength control and reduction of vegetating apices, see application page 2, lines 2-24.
3. Admission of third party observations of 29 December 2020.

As noted by the Board in its written communication, section 4:

"The appellant submits that the third party observations based on D10 (cited in section 7.2 of the impugned decision as NPL1) should be disregarded by the Board together with document D10 for not being part of the impugned decision, Article 12(2) RPBA2020.

It is indeed true that these objections were not part of the impugned decision. However, following the principles set out in G 10/93, OJ EPO, 1995, 172 (Reasons 3 and 4), the Board has in ex parte

proceedings the power to examine whether the application or the invention to which it relates meets the requirements of the EPC, including requirements, objections or evidence which the Examining Division did not take into consideration, cf. CLBA V.A.4.2.2.

The fact that the Examining Division's decision is silent on the relevance of D10 or that the issue has been raised in a new third party observations does not prevent the Board from introducing it into the proceedings of its own motion."

The appellant did not submit any further arguments in their response to the Board's preliminary opinion. Absent any further submissions the Board sees no reason to change its point of view. It thus admits the third-party observations of 29 December 2020 of its own motion, Article 114(1) EPC.

4. Oral proceedings and right to be heard

With letter of 26 April 2022, the appellant withdrew their request for oral proceedings and also informed the Board that they would not take part of the scheduled oral proceedings in case the Board decided to maintain them. The Board thus cancelled the oral proceedings.

The Board is satisfied that by its communication dated 18 March 2022 the appellant was made aware of the central points underlying this decision and that they have therefore had sufficient opportunity to take a position thereon. The requirements of Article 113(1) EPC have been met.

5. Main request - Novelty over D10

5.1 The Board noted the following in its written communication, section 5:

"It appears that claim 1 of all requests lacks novelty since D10 clearly and directly anticipates their subject-matter.

D10 title is "Die vollkommene Obstbaumschule" (The complete/perfect fruit tree nursery). The skilled person therefore understands that all contents and methods in the book, unless expressly stated to the contrary, are to be performed in a nursery. D10 describes a method for producing a double trunk tree, starting by grafting propagating material onto a rootstock, see page 120, lines 30-ff.: "Bei der Erziehung des Fächerbaums ist es notwendig, den jungen Baum auf zwei Hauptäste zu ziehen, welches durch die Kopulation [whip grafting] des Edelreises [scion] mit zwei Augen schon eingeleitet wird. Die okulierten [grafted] Stämmchen aber...". The main growing scion is pruned to leave only three buds, see page 120, lines 33-36. From the three growing shoots, select two placed opposite each other and remove the third one as useless or unnecessary (i.e. prune the third one off), see page 121, lines 2-4: "...; man erwählt in diesem Falle die einander gegenüberstehenden zu den Hauptästen, und nimmt den dritten als unnütz ab", that is shoots selection and modification as recited by feature b) of the claim. As the appellant submits in bridging paragraph of pages 7-8 of grounds of appeal dated 10 February 2020, the claimed feature "modification" can be understood in the context of the application as pruning or pinching after grafting, as exemplified on page 7, lines 11-12. The following lines 4-14 and 22-30

on page 121 of D10 describe further selection and modification of the growing shoots. That the method can be used for producing pome fruit trees ("Kernobst") together with step d) of the claim (planting the produced tree out for fruit production) is described on page 121, lines 15-21. This paragraph recites: "Hat man den Espalierbaum auf zwei Hauptzweige erzogen, so kann er nun auf seinen Standort verpflanzt werden, wobei man einen Abstand von..., für das Kernobst [pome fruit] aber von 16 bis 20 Fuß...". The above described different stages are depicted in D10, Tab. IV, figs 1-4."

- 5.2 The appellant's further arguments submitted with their reply of 26 April 2022 have not convinced the Board to change its preliminary opinion for the following reasons:
- 5.3 The appellant understands the term "rootstock" in the claim as specifically implying a graft support with a small trunk segment, not just any type of graft support. The graft support described in D10 also meets this limitation. Tab. IV, figures 1 and 2 on page 122 clearly shows that the used graft support has a very small trunk segment, similar to the rootstock trunk segments depicted in figures 1-4 of the present application.
- 5.4 The appellant also argues that cultivation in a nursery is not described. It is, on the contrary, an expressly disclosed feature in D10. This is evident from the book title "*Die vollkommene Obstbaumschule*" (The complete/perfect fruit tree nursery) as was explained in the preliminary opinion, see above. The feature of transplanting the rootstock is implicit in the method of D10. In tree nurseries the seeds germinate in

seedbeds. The growing plant is transplanted as they increasingly need more soil space for further development, as is the case for producing a double trunk tree as described in D10. An initial step of transplanting the rootstock is therefore necessarily implicit in the prior art method.

- 5.5 The appellant also submits in their reply of 26 April 2022 that the text of D10 is obscure for being written in old German. The appellant raised a similar objection in the grounds of appeal for D8, also written in old German (year 1868). The same comments as for D8, see section 7 of the Board's written opinion, hold for D10. Indeed, the 1839 German language of document D10, while not corresponding to "correct" or modern German, does not appear to pose an undue burden on the reader to fully understand its technical contents.

In this respect, the appellant has spotted two Board's errors of transcription when quoting D10 in its preliminary written opinion. They are namely "Fächerbaum" for "Fächerform" and "den jungen Baum" for "den jungen Stamm". This is seen by the Board as a confirmation that the appellant, and thus also a skilled reader, correctly understands D10's technical contents without undue effort.

- 5.6 The appellant also submits that D10 uses contradictory technical terms. This, so they argue, would prevent the skilled person from understanding it. The Board disagrees. With their mind willing to understand and using normal reading skills the skilled person easily sees beyond such minor inconsistencies and understands the disclosed method as falling within the subject-matter of claim 1 as defined by its broad terms.

Specifically, the appellant submits that it is unclear in D10 whether whip-grafting ("Kopulation") or bud-grafting ("Okulation") is used for the grafting step. This would be due to the use of the terms "Die oculirten Stämmchen" in line 33 of D10 for referring to the result of the "Copulation des Edelreises" described in the preceding sentence. This argument does not convince the Board for two reasons. Firstly, it is clear to the Board that, notwithstanding the inconsistency, the cited passage describes grafting of a scion ("Edelreis") and thus unambiguously whip-grafting and not bud-grafting. Secondly, it is immaterial what type of grafting technique is used for the anticipation of the claimed feature. Claim 1, step b only generally requires to "graft onto said rootstock of propagating material...". It does not require any specific grafting technique.

The Board is unable to see any inconsistency or contradiction in the use of the different terms *Edelreis*, *Stämmchen*, *Zweig* or *Hauptäste* (scion, little stem, branch or main branches). These designate different parts of the plant or in some cases the same part at different growing stages and are used in pages 120-121 in D10 consistently and according to their normal meaning in the corresponding contexts.

- 5.7 The Board is also not convinced by the argument that whip-grafting is incompatible with obtaining the double trunk tree as described in D10. The appellant refers to the steps described in the bridging phrase between pages 120 and 121. There, D10 describes pruning the grafted scion to leave three buds. Such a scion, so the appellant's argument goes, can itself develop into a three -or more- trunk tree and not into the desired double trunk tree. However, this possible development

is also considered in D10, see page 121 lines 1-5. As also described in that passage, in the possibility that all three buds develop and result in three branches, the two ones on opposite sides are selected and the third one pruned off. Further shoot selections and modifications for obtaining two equally grown branches are described in lines 10-14 of that page. These result in the double trunk tree, as claimed, as also depicted in Tab IV. of D10 that illustrates the different method steps.

5.8 Since none of the appellant's arguments convinces the Board, it sees no reason to change its point of view as expressed in its preliminary opinion. It thus holds that claim 1 of the main request lacks novelty, Article 54(2) EPC.

6. Auxiliary requests 1-2 - Admission

6.1 Auxiliary requests 1 and 2 attempt to address the above lack of novelty objection. These were filed with letter of 26 April 2022, thus after the Board's written preliminary opinion and the summons to oral proceedings. Admission of these requests is thus at the discretion of the Board, Article 13(1) and (2) RPBA 2020.

6.2 A crucial criterion at this late stage of the proceedings is the *prima facie* allowability of the new claims, Article 13(1) RPBA 2020. The new auxiliary requests do not meet this criterion because they appear, *prima facie*, to lack an inventive step.

6.3 The Board is aware that the decision under appeal did not examine the question of inventive step, and the appellant requested remittal to the Examining Division

for this reason. However, the Board holds that this fact in itself cannot prevent the Board from examining all relevant admission criteria, including the prima facie allowability of a late request with respect to all requirements of the Convention. Otherwise in a case as the present one parties could be seen as enjoying an advantage, in the sense that their requests would be subjected to less strict admission criteria. This would appear to the Board as a paradoxical result, in particular in view of the fact that the original claims of the appellant were found to lack novelty over several documents, i.e. appeared manifestly unallowable. Under such circumstances the Board sees no good reason to apply a lower admission threshold.

- 6.4 In the first auxiliary request the method is restricted to produce apple and/or pear trees. This is an obvious choice for the skilled person when carrying out the known method of D10, which is generally described for pome fruit trees, of which apples and pears are by far the most common. The second auxiliary request adds "chip"-like graft of two buds for the grafting step. "Chip"-like graft is part of the skilled person's playbook of techniques for grafting propagating material to a rootstock. A double "chip"-like grafting is thus an obvious alternative to the whip-grafting described in D10 for obtaining the double trunk tree described there. The appellant submits that the skilled person would not regard it as an obvious alternative due to the "chip"-grafting's well known very low rate of success. However, inventive step cannot be based on the mere replacement of a known feature by a disadvantageous new one, specially when such disadvantage is known to the skilled person, see CLBA, I.D.9.19.1 regarding foreseeable disadvantageous modifications.

6.5 Hence, the Board does not admit auxiliary requests 1-2 of 26 April 2022 into the appeal proceedings.

7. Request for reimbursement of the appeal fee

7.1 The appellant requests reimbursement of the appeal fee due to a procedural violation, Article 103(1)(a) EPC. They submit that the way how the Examining Division arrived at the conclusion of lack of novelty over D1 and D8 represents a procedural violation. The appellant does not raise any procedural violation objection in respect of the Division's novelty finding based on D5.

7.2 As noted by the Board in section 7 of its written communication:

"Reimbursement of the appeal fee for a substantial procedural violation is conditional on the appeal being allowable, Rule 103(1)(a) EPC. However, the Board intends at present to dismiss the appeal, so that the request would fail. Should the Board arrive at a conclusion other than dismissal of the appeal, this request may need to be discussed.

In this respect, as variously stated in case law the violation must be substantial and affect the entire proceedings. An error which would not have led to a different outcome of the proceedings is not a substantial procedural violation, cf. CLBA V.A.9.5.2. In the present case, the Division would have arrived at the same result of refusing the application on the novelty objection over D5, which is neither open to a procedural violation objection nor has such objection been raised. Thus the procedural violation, if it has at all been committed, would not be substantial so that

no reimbursement of the appeal fee on the basis of Rule 102(1)(a) EPC can be given."

7.3 In their reply of 26 April 2022 the appellant refrained from further comment. The Board therefore sees no reason to change its position. The appellant's request for reimbursement of the appeal fee is refused.

8. The appellant's main request fails and the remaining requests have not been admitted. Thus, a remittal for the issue of inventive step, as requested by the appellant, is moot. The Board therefore confirms the decision of the Examining Division.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Magouliotis

G. Martin Gonzalez

Decision electronically authenticated