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Aktenzeichen / Case Number / N° du recours : T 361/87 - 3.3.2

Anmeldenummer / Filing No / N° de la demande : 83 106 388.8

Veröffentlichungs-Nr. / Publication No / N° de la publication : 00 97 973

Bezeichnung der Erfindung: Process for preparing fructose
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement : C12P 19/24

ENTSCHEIDUNG / DECISION

vom / of / du 15 June 1988

Anmelder / Applicant / Demandeur : NABISCO BRANDS INC.

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Micro-organisms/Nabisco

EPÜ / EPC / CBE Article 83, Rule 28 EPC

Kennwort / Keyword / Mot clé : "Micro-organisms, deposit not required"

Leitsatz / Headnote / Sommaire

The non-availability (here:temporary) of some particular effective strains in a class of micro-organisms is immaterial as such to sufficiency as long as there are other suitable strains available to the skilled person through the disclosure (further to T 292/85, Polypeptide expression/GENENTECH I; to be reported). Additional information relating to such temporary non-available strains remains a valuable technical information and may be left in the description.

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Case Number : T 361/87 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 15 June 1988

Appellant : NABISCO BRANDS INC.
Nabisco Brands Plaza
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USA

Representative : Brauns, Hans-Adolf, Dr. rer. nat.
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Decision under appeal : Decision of Examining Division 023 of the European Patent Office dated 22 April 1987 refusing European patent application No. 83 106 388.8 pursuant to Article 97(1) EPC

Composition of the Board :

Chairman : P. Lançon
Members : A.J. Nuss
E. Persson

Summary of Facts and Submissions

I. European patent application No. 83 106 388.8 was filed on 30 June 1983 and published with publication number 0 097 973, claiming priority of three prior US applications of 30 June 1982. The application was related to a process for preparing fructose involving, inter alia, the use of alpha-amylase, glucoamylase and glucose isomerase obtained by cultivating an organism of the Basidiomycetes class of fungi. It was published on 11 January 1984.

II. The application was refused by a decision of the Examining Division dated 22 April 1987 pursuant to Article 97(1) EPC. The reason given for the refusal was that certain strains to be used in the claimed process and mentioned on pages 7 and 8 of the description, i.e. strains ATCC 20 632 to 20 642, were not available to the public during certain periods of time after the publication of the application, which therefore did not meet the requirements of Rule 28(3) to (8) EPC. The application had therefore to be rejected in its entirety according to Article 97 EPC.

It was further stated in the decision that there were no objections to the claims under Articles 54 and 56 EPC.

III. The Appellant lodged an appeal against this decision on 11 June 1987. The appeal fee was paid in due time. The grounds for appeal filed on 5 August 1987, were essentially as follows:

(i) The invention is not limited to the use of specific strains defined by the ATCC deposit numbers, but is to be seen in the finding that the Basidiomycetes class of fungi can be used for cultivating alpha-amylase, glucoamylase and glucose isomerase to be

used in the claimed process. The Examining Division, moreover, acknowledged novelty and inventive step of the present claims.

(ii) It is stated in the specification on page 8, line 22 ff. that the determination of other suitable fungi of the Basidiomycetes class than the deposited ones can be carried out by using simple test procedures which are described on pages 8 and 9 of the present specification, providing thus all the information necessary to work the invention. All what has to be done is to check whether, among the well known Basidiomycetes class of fungi, a known Basidiomycetes fungi could be used in the present invention.

IV. The Appellant requested reversal of the decision and grant of a patent.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.

2. The Examining Division considered the deposit of the strains mentioned in the description (i.e. ATCC 20 632 to 20 642) to be deficient essentially for the reason that it was not made according to the provisions of Rule 28 EPC.

However, the Board satisfied itself that the description contains detailed information which allows the determination of other glucose isomerase producing fungi without difficulty. As correctly pointed out by the Appellant the determination of suitable fungi of the well known Basidiomycetes class to be used in the claimed process can be carried out by using simple test procedures

as described on pages 8 and 9 of the description. It follows from this that, although some preferred strains to be used had been deposited with the American Type Culture Collection (ATCC) where they were accorded ATCC (accession) numbers 20 632 to 20 642, the claimed invention is in no way limited to the use of these strains and that even without a reference thereto and also without present examples I and III in which they are used, the description alone provides all the information necessary for a man skilled in the art to carry out the invention.

The fact is that Rule 28 EPC requires a deposit of a micro-organism in order to satisfy Article 83 EPC only if the invention concerns a micro-biological process or the product thereof and involves the use of a micro-organism which is not available to the public and which cannot be described in the European application in such a manner as to enable the invention to be carried out by a man skilled in the art. In view of what is said in the preceding paragraph, these special provisions obviously do not apply in the present situation where the determination of suitable enzyme producing fungi of the Basidiomycetes class to be used in the claimed processes can be carried out using simple test procedures entirely indicated in the description. Furthermore, these processes are in no way limited to any deposited strains. The Board therefore considers that in the present case the requirements of Article 83 EPC are met.

3. It nevertheless remains that the Appellant submitted with his letter filed on 12 June 1986 a letter from ATCC dated 30 May 1986 which shows that strains ATCC 20 632 to 20 642 were not available to the public during certain periods of time after the publication of the present application, the release for general distribution of these strains being bound to the publication of some US patents citing them.

However, the Board has held in its decision T 292/85 ("Polypeptide expression/GENENTECH I", 27 January 1988, to be reported in OJ), inter alia, that an invention is sufficiently disclosed if at least one way is clearly indicated enabling the person skilled in the art to carry out the invention. Then the non-availability of some particular variants is immaterial to sufficiency as long as there are suitable variants known to the skilled person through the disclosure or common general knowledge which provide the same effect for the invention (see in particular point 3.1.5 of the Reasons for the Decision). This fully applies in the present case, since the sufficiency of disclosure is indubitably guaranteed through the test procedures described on pages 8 and 9 of the description (see point 2 above). The objections of the Examining Division therefore concern in fact some additional technical information contained in the description which goes beyond what is required by Article 83 EPC.

As to the question whether the deposited strains and the examples based on them may remain in the description, the view of the Board is that an applicant is free to include in his application more technical information concerning a claimed invention than what is legally required. Even if one considers that in the present case the information in question is in fact superfluous, it remains undoubtedly a valuable technical information provided freely by the appellant which, moreover, does not infringe any disposition of the EPC.

Under these circumstances, the Board considers it as justified to leave the description unamended, i.e. as originally filed.

4. The Examining Division obviously considered that in the present case the assessment of novelty and inventive step was not touched by the question of deficiency in the deposit of the strains since it did not object to the claims which it considered to be both novel and inventive.

The Board has no reason to see this differently. For the rest, novelty and inventive step are not matters at issue.

5. It follows from the above considerations that the decision under appeal has to be set aside.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.

2. The application is remitted to the Examining Division for further prosecution on the basis of the claims and description as originally filed.

The Registrar The Chairman

F.Klein P.Lançon