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D E C I S I O N
of 6 September 1994

Case Number: T 0657/92 - 3.3.4

Application Number: 86302122.6

Publication Number: 0200344

IPC: A01N 63/00

Language of the proceedings: EN

Title of invention:
Micro-organisms as pesticides

Applicant:
MYCOGEN CORPORATION

Opponent:
-

Headword:
Microorganisms/MYCOGEN

Relevant legal norms:
EPC Art. 54(3) EPC

Keyword:
"Novelty - after amendment - (yes)"

Decisions cited:
T 0056/87, T 0004/80, T 0274/88

Catchword:
-



Case Number: T 0657/92 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 6 September 1994

Appellant: MYCOGEN CORPORATION
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Decision under appeal: Decision of the Examining Division of the European
Patent Office dated 11 February 1992 refusing
European patent application No. 86 302 122.6
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: U. M. Kinkeldey
Members: D. D. Harkness
W. Moser

Summary of Facts and Submissions

- I. European patent application No. 86 302 122.6 published under No. 200 344 filed on 21 March 1986 claims three priorities, the earliest being 28 March 1985, was refused by the Examining Division.

The decision was taken on the basis of Claims 1 to 10 filed on 2 October 1989 (Claims 1 to 9) and 6 September 1990 (Claim 10).

Claim 1 reads as follows:

"1. A method for protecting vegetation from a eukaryotic pest, which comprises administering to the phylloplane a live micro-organism containing a heterologous gene which is expressed in the micro-organism and which codes for a proteinaceous parasporal crystal toxin of *B. thuringiensis* var. *kurstaki* or *B. sphaericus*."

Claims 2 to 10 are appendant to Claim 1.

An auxiliary request which comprises an amendment to Claim 1, namely the inclusion of the words "in the field" after the word "phylloplane" was filed.

The above set of claims and the auxiliary request were discussed by the Examining Division and applicant at oral proceedings.

The applicant admitted during oral proceedings that Example 5 of the citation is novelty destroying for the main request.

The applicant maintained that the auxiliary request was allowable under Article 54(3) and (4) EPC as only prior

art which explicitly discloses the claimed subject-matter may be considered and greenhouse tests do not equate with "in the field" applications.

II. In it's decision the Examining Division considered document

(1) EP-A-192 319

to be a relevant citation under Article 54(3) and (4) EPC and reasoned the objection as follows:

The citation describes the recombinant micro-organisms used in the method of the present application and Table 6 indicates that mixtures of viable and killed cells could be used. Since the definition of "live" micro-organisms of the main claim does not define the degree of "liveliness" this definition includes those micro-organisms described by said citation. Also the micro-organisms could be applied to the phylloplane in view of the disclosure in Example 5 and reference to "leaf affinity" of the micro-organism. As the object of the process of the citation was to "improve the field longevity" the auxiliary request was also not allowable. The "whole contents" approach was employed and it was considered that the expression "in the field" was not limited to open air applications and also included greenhouse tests as the term was related to the environment of the target pests.

III. The Appellants lodged an appeal, paid the appeal fee and filed Statements of Grounds. They requested cancellation of the decision on the basis of a main request or three auxiliary requests, oral proceedings being required in the event that the main request is refused by the Appeal

Board. However the Appellant expressed willingness to forego the oral proceedings should any of the auxiliary requests be accepted.

The main request is the auxiliary request rejected by the Examining Division with the deletion of the particular B. thuringiensis varieties, auxiliary request I corresponds to the main request with a limitation to distinguish from document (1), auxiliary request II is the same as the rejected auxiliary request and auxiliary request III is the rejected auxiliary request with the same disclaimer as in auxiliary request I.

In the grounds of the appeal it is submitted that the phrase "in the field" distinguishes clearly from the greenhouse procedure of Example 5 of the citation and is well understood in the art. The disclaimer of auxiliary requests I and III relates to the treatment of more than three plants if lettuce plants are in question, which established novelty over the disclosure of Example 5 of document (1).

- IV. On 16 June 1994, the Board sent a communication to the Applicant indicating that a disclaimer directed to lettuces in general would be acceptable in auxiliary request I.

A fourth auxiliary request was filed in a letter of 30 June 1994 also indicating revised pages 2, 14 to 16 and 18.

- V. The Appellant requests that a patent be granted on the basis of the main or one of the four auxiliary requests.

Reasons for the Decision

1. The appeal is admissible.

2. Document (1) designates the same Contracting States as the application in suit and forms part of the state of the art within the meaning of Article 54(3) and (4) EPC because the earliest date out of three claimed priorities is 22 January 1985, whilst the applicant's earliest priority is later (see paragraph I above), and document (1) was published only after the filing date of this application.

An investigation of the priorities of document (1) has shown that the relevant disclosure of document(1) is entitled to the priority date 22 January 1985 thus the objection under Article 54(3)(4) is supported by the earliest priority date.

3. *Main request*

- 3.1 The main request corresponds with the auxiliary request rejected by the Examining Division and in support of this the Appellant argues that the phrase "in the field" is well understood in the art and distinguishes the process from testing or application procedures conducted in the laboratory. The disclosure in Example 5 of document (1) relates to a comparison made between processes in which P. fluorescent (dead/live) in presence or absence of BT toxin is applied to three lettuce plants by spraying. It is the application using the live micro-organisms which anticipates the method of the invention. The results of Example 2 of the application (Tables 1 and 2) are identical with those of document (1) [Tables 3 and 4 (Bioassay 1, 2, 4)] thus it

is concluded that the technical features of both processes are the same when considering the live microorganisms.

- 3.2 In relying upon the restriction to "in the field" applications the Appellant has chosen to highlight the laboratory or greenhouse application of Example 5 of document (1) without considering the whole contents of the citation. According to Technical Board of Appeal Decision T 56/87 (OJ EPO 1990,188), it is necessary to consider the entire technical teaching in a prior art document as it would be done by a person skilled in the art thus it is not justified to isolate Example 5 in order to derive a technical teaching distinct from the integral teaching of the document.
- 3.3 Document (1) is not limited to a laboratory or greenhouse procedure as there are several references to field applications including page 1, line 19 "improvements in the field longevity", line 25 "long residual activity in the field", page 2, lines 17 to 19 "methods are disclosed for protecting agricultural crops" all of which indicate that the method as described in document (1) is applicable in the manner now claimed by the Appellant. Accordingly the subject-matter of the main request is not novel having regard to document (1). In support of this finding it is to be noted from American Society for Microbiology, Washington, 1985. L. S. Watrud, "Cloning of the Bacillus thuringiensis subsp. kurstaki Delta-Endotoxin Gene into Pseudomonas fluorescent", that laboratory efficacy data would be useful to predict the potential for efficacy under field conditions (see page 42, last line first column), thus the skilled person would associate laboratory results with expectations in the field.

4. *Auxiliary request I*

4.1 The first auxiliary request corresponds to the main request with the additional feature that "if the vegetation comprises lettuce plants, there are more than three." this disclaimer providing a literal distinction from document (1), Example 5. An amendment of this kind relates essentially to the scale upon which the method of the invention is carried out, as such there is no new distinguishing technical feature. It has the effect of disclaiming the method when carried out in a field containing three lettuce plants or less than three.

4.2 For the reasons given in paragraphs 3.2 and 3.3 above the disclosure of document (1) is considered to extend to lettuce plants grown in a field no matter how many plants are planted in the field. Accordingly this disclaimer is not suitable to distinguish the subject-matter of the application from prior art document (1).

5. *Auxiliary request II*

This is the same as the rejected auxiliary request which includes the specific technical feature B. thuringiensis var. kurstaki, this being the only feature which differentiates this request from the main request. Example 5 of document (1) describes this feature as B. thuringiensis HD73 (see page 21, lines 3 to 4 and page 5, line 7) and makes use of it. Accordingly the claim of this request does not relate to novel subject-matter.

6. *Auxiliary request III*

This is the same as auxiliary request II with the same disclaimer as in auxiliary request I which is not allowable for the reasons given in paragraphs 4.1 and 4.2 above. The claim of this request is also not novel.

7. *Auxiliary request IV*

7.1 Auxiliary request IV relates to a main claim of which all the features save for the disclaimer to "lettuces" are to be found in the original disclosure. In accordance with the established practice of the Boards of Appeal (T 4/80; OJ EPO 1982, 149) a specific prior art may be disclaimed. In the present instance a general reference to "leaves of lettuce plants" is to be found in document (1) at page 17, lines 18 to 19 and this reference equates with the disclaimer. In these circumstances the subject-matter of this auxiliary request complies with Article 123(2) EPC.

7.2 For novelty purposes the subject-matter of the main claim has now been distinguished from the disclosure of document (1), in particular Example 5 which relates only to the treatment of lettuces with live/dead micro-organisms there being no other Example of the treatment of any other plant with live or dead micro-organisms.

8. In decision T 274/88 of 6 June 1989 (not published in the OJ EPO), the Board of Appeal held that if an irregularity has been remedied during appeal proceedings the matter should normally be remitted to the department of first instance and only in exceptional cases, where the Board is convinced of the patentability of newly claimed subject-matter and the Appellant has expressis verbis abandoned its right to two instances and above all the Examining Division has already indicated its

positive position as to patentability of that subject-matter the Board may already take a final decision to grant a patent. This is not the case here, although the Examining Division in its decision under paragraph 5 stated that it recognised patentable matter; it did, however, not specify this subject-matter and the practice of remittal according to Article 111(1) EPC is therefore to be followed in order that examination of inventive step, Article 56 EPC, may be carried out on the basis of the Claims 1 to 10 and pages 2, 14 to 16 and 18 filed on 4 July 1994 (auxiliary request IV).

Order

For these reasons it is decided that:

1. The decision of the Examining Division is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of auxiliary request IV.

The Registrar:

The Chairperson:

L. P. McGarry

U. M. Kinkeldey