

# EIP



## Rare EPO decision regarding biological deposits and biological material used in an invention being "available to the public"

In decision T1045/16, EPO Technical Board of Appeal considered whether a patent relating to virus-resistant melons met the requirements of Article 83 EPC.

### **Legal Provisions**

Article 83 requires the claimed invention to be disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. Rule 31 EPC implements this Article for inventions which involve the use of or concern biological material which is not available to the public and which cannot be described sufficiently within the European patent application. In such cases, Rule 31(a) EPC provides that the invention is regarded as being disclosed as prescribed in Article 83 EPC only if a sample of the biological material has been deposited with a recognised depositary institution on the same terms as those laid down in the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure of 28 April 1977 not later than the date of filing of the application.

### **Facts & Arguments**

Claim 1 of all claim requests pursued by the Patentee related to a virus resistant melon plant comprising genetic material from a plant of melon accession PI313970 which genetic material had certain virus resistance-conferring properties.

It was agreed by all parties that, in order to carry out the claimed invention, the skilled person required access to propagating material containing the virus resistance-conferring properties from melon accession PI313970 (the "relevant biological material"). There was no deposit of such material with a recognised depository institution as set out in Rule 31(a) EPC so the Board had to determine whether or not the relevant biological material in question was already "available to the public" in the context of Rule 31 EPC.

Patentee argued that the plants identified by accession No. PI313970 were publicly available on the priority date of the patent and could be ordered directly from the website of the US National Plant Germplasm System which was tasked with maintaining the accession. Patentee also referred to several scientific publications referring to accession No. PI313970 as evidence of public availability of this deposit. Opponents, on the other hand, argued that the requirement for a biological deposit to satisfy the requirements of Article 83 EPC could only be circumvented if the material was available to the public without restriction over the whole term of the patent and that although plants named PI313970 could be ordered it was unclear if the properties recited in the patent claims were still present in any of the seeds that could be so ordered. Moreover, the depository institution did not guarantee availability in the future.

### **Decision and Take-home Message**

After considering all issues, the Board held that "available to the public" in Rule 31(1) EPC means available in a manner that guarantees that the skilled person can carry out the invention at least over the whole term of the patent and that the availability of plants of the accession PI313970 from the US National Plant Germplasm System is not sufficient to ensure that the relevant person skilled in the art can practice the claimed invention during the term of the patent at issue. The Board also clarified that the mention of the biological material in a scientific publication does not per se establish that said material is available to the public in the sense of Rule 31(1) EPC.

Applicants in such scenarios should, therefore, consider making a biological deposit with a recognised depository under the Budapest treaty or ensure the biological material can be described in their application without needing access to a non-Budapest biological deposit to ensure compliance with Article 83 EPC. For applicants seeking protection before the EPO, it is also important to note that biological deposits as set out in Rule 31(a) EPC should be made by the filing date (priority date if priority claimed) and failure to do so cannot be remedied after that date.