BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS

BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE

CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN DES BREVETS

Internal distribution code:
(A) [ ] Publication in OJ
(B) [ ] To Chairmen and Members
(C) [ ] To Chairmen
(D) [X] No distribution

Datasheet for the decision of 1 February 2011

Case Number: T 0775/08 - 3.3.08

Application Number: 04702162.1

Publication Number: 1587931

IPC: C12N 15/82

Language of the proceedings: EN

Title of invention:
Glyphosate tolerant alfalfa events and methods for detection thereof

Applicants:
Monsanto Technology LLC, et al

Headword:
Glyphosate tolerant alfalfa/MONSANTO

Relevant legal provisions:
EPC Art. 84, 83, 54, 56, 53(b)
EPC R. 27(b)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Main and sole request - clarity and sufficiency of disclosure (yes); novelty and inventive step (yes); plant variety (no)"

Decisions cited:
T 0737/96, T 1231/01, T 0645/02, T 1329/04

Catchword:
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0775/08 - 3.3.08

D E C I S I O N
of the Technical Board of Appeal 3.3.08
of 1 February 2011

Appellants: Monsanto Technology LLC
800 North Lindbergh Boulevard
St. Louis, Missouri 63167 (US)

Forage Genetics, Inc.
N5292 Gills Coule Road
West Salem, WI 54669 (US)

Representative: von Kreisler Selting Werner
Deichmannhaus am Dom
Bahnhofsvorplatz 1
D-50667 Köln (DE)

Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 26 November 2007 refusing European patent application No. 04702162.1 pursuant to Article 97(1) EPC 1973.**

Composition of the Board:

Chairman: C. Heath
Members: P. Julià
M. R. Vega Laso

Summary of Facts and Submissions

I. The applicants (appellants) lodged an appeal against the decision of the examining division dated 26 November 2007, whereby the European patent application No. 04 702 162.1 published as WO 2004/070020 (hereinafter "*the application as filed*") was refused under Article 97(1) EPC 1973.

II. In the decision under appeal, the examining division considered that the subject-matter of the claims according to the main request and the auxiliary request - filed on 8 October 2007 and on 6 November 2007, respectively - did not involve an inventive step (Article 56 EPC 1973) and it further observed that neither request fulfilled the requirements of Articles 54 and 84 EPC 1973 (cf. point IX *infra*). Claim 1 of these requests read as follows:

"1. A seed of glyphosate tolerant alfalfa plant the genome of which comprising SEQ ID NO:1 and SEQ ID NO:2, a seed of a representative alfalfa plant, alfalfa event J-101 was deposited with American Type Culture Collection (ATCC) with Accession No. PTA-4814." (main request)

"1. A seed of glyphosate tolerant alfalfa plant the genome of which comprises the transgene genetic elements shown in Fig. 1 and junction sequences spanning the insertion site having SEQ ID NO:1 and SEQ ID NO:2, a seed of a representative alfalfa plant, alfalfa event J-101 containing the transgene genetic elements was deposited with American Type Culture

Collection (ATCC) with Accession No. PTA-4814."
(auxiliary request)

III. On 4 April 2008, the appellants filed a statement setting out their grounds of appeal which included two sets of claims as, respectively, main request and auxiliary request. These requests were essentially identical to, respectively, the main request and the auxiliary request underlying the decision under appeal. As a subsidiary request, oral proceedings were requested. A further submission including new evidence was filed with letter dated 9 June 2010.

IV. In a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) annexed to the summons to oral proceedings, the board informed the appellants of its preliminary, non-binding opinion on some of the issues to be discussed at the upcoming oral proceedings, in particular issues concerning Articles 84, 83, 54 and 56 EPC. In connection with possible issues regarding Article 53(b) EPC and Rule 26(5) EPC, the attention of the appellants was drawn to the then pending referrals before the Enlarged Board of Appeal under the reference numbers G 2/07 and G 1/08.

V. On 3 January 2011, the appellants replied to the communication of the board and filed a new set of 15 claims to replace all sets of claims then on file.

VI. Oral proceedings took place on 1 February 2011. In these proceedings, the appellants withdrew their previous requests and filed a fresh set of claims as their main and sole request.

VII. The set of claims of the appellants' main and sole request consisted of 6 claims. Claim 1 read as follows:

"1. A glyphosate tolerant alfalfa plant, or a seed thereof, or a progeny thereof, the genome of said plant, seed or progeny comprises the transgene genetic elements shown in Fig. 1 and junction sequences spanning the insertion site having SEQ ID NO:3 and SEQ ID NO:4, the transgene genetic elements shown in Fig. 1 being present in the alfalfa event J-101 deposited with American Type Culture Collection (ATCC) with Accession No. PTA-4814."

Claims 2 and 3 were directed to isolated DNA polynucleotide primer molecules comprising at least 30 contiguous nucleotides of SEQ ID NO: 3 or 4, respectively, or their complements that, when used in a DNA amplification method, produced amplicons comprising SEQ ID NO:1 or 2, respectively. Claim 4 related to a DNA detection kit comprising at least one molecule as defined in claims 2 and 3. Claims 5 and 6 were directed to methods of detecting the presence of DNA corresponding to alfalfa plant J-101 DNA in a sample.

VIII. The following documents are cited in the present decision:

D3: WO 92/04449 (published on 19 March 1992);

D6: WO 02/36831 (published on 10 May 2002);

EMBL database entry AC099233 archived version of 17 November 2002 ("EMBL Sequence Version Archive" at the EMBL-EBI Website);

Declaration of S. Fitzpatrick signed on 25 September 2007 and filed as Exhibit D with appellants' letter dated 8 October 2007 during the examination proceedings (in the following "Exhibit D").

IX. The reasoning which led the examining division to the refusal was briefly the following:

Document D3, the closest prior art, taught the production of transgenic glyphosate tolerant alfalfa carrying a modified 5-enolpyruvyl-shikimate-3-phosphate synthase (EPSPS). With the teachings of document D3, the skilled person was in a position to obtain glyphosate tolerant alfalfa plants - as shown by prior art available since 1997. The technical problem to be solved was the provision of a further (alternative) glyphosate tolerant alfalfa plant. However, in view of the fact that the alfalfa event J-101 was characterized by the applicants as having a "superior performance", the technical problem could also be formulated as the provision of an alfalfa plant with a high level of glyphosate tolerance.

As for the main request (cf. point II *supra*), the claimed subject-matter did not solve the technical problem over the whole claimed scope because it was not credible that any alfalfa plant comprising the defined transgene genetic elements would have the very same properties as those of the disclosed alfalfa event

J-101. It was known in the art that the locus of integration, the number of transgenes in the plant, the genetic background, etc. influenced the properties of the plant. None of these features were defined in the claims.

As for the auxiliary request (cf. point II *supra*), the technical problem was solved by the claimed alfalfa plants because they had the characteristics of the alfalfa event J-101 represented by the deposited PTA-4814. However, the provision of a further glyphosate tolerant alfalfa plant could not be regarded as inventive because document D3 provided guidance to obtain glyphosate tolerant plants and, since no unsurmountable difficulties were encountered in their production, the specific deposited plant was a mere arbitrary selection from all possible glyphosate tolerant plants. The presence of some variation in the degree of tolerance, transgene expression, etc. in transgenic plants was expected by the skilled person, and it was obvious to select those transgenic plants having a high glyphosate tolerance. It was a matter of trivial routine experimentation for a skilled person to analyse the insertion site of the T-DNA vector used for transformation, to use the sequences of the insertion sites for designing primers and probes and use them in kits for identifying plants containing the specific transformation event. No inventive contribution was required to obtain any of these products and/or methods.

Although not as part of the reasoning for the refusal, the examining division further remarked that document D6 disclosed primers (SEQ ID NO:3) that were identical to at least 30 contiguous residues of SEQ ID NO:4 of

the application and suitable for amplifying the T-DNA insert of the transformation event J-101. The document "EMBL database entry AC099233" anticipated the subject-matter of a claim directed to a DNA molecule comprising SEQ ID NO:1, SEQ ID NO:2, SEQ ID NO:3, or SEQ ID NO:4.

X. The appellants' arguments may be summarized as follows:

In view of the teachings of document D3, the problem to be solved was the provision of an alfalfa plant with a high level of glyphosate tolerance. This problem was solved by the claimed subject-matter. The provision of a superior glyphosate tolerant alfalfa plant out of a large group of possible transformants was not obvious to a skilled person.

First, it was uncertain whether, by a mere screening among all potential variations referred to in document D3, the skilled person would have arrived at a transformed plant having properties comparable to those of the alfalfa plant represented by event J-101. In view of the long and time-consuming selection process reported in "Exhibit D" (cf. point VIII *supra*), there was no guarantee that the skilled person, by repeating the random integration method used in the application, would have arrived at an advantageous transgenic alfalfa plant as claimed. Even though the use of the random integration method was obvious to the skilled person, the actual isolation of an advantageous and surprising transformed plant was, in the light of the case law of the Boards of Appeal (cf. T 737/96 of 9 March 2000), to be considered inventive.

Second, it was not routine in the art to generate and to screen the large number of events as done for selecting the single event J-101 which yielded the unexpected and advantageous results shown in the application. This process involved great time and cost investments for generating and screening the necessary number of transgenic plants. Unlike simple organisms, plants required not only an initial transformation and culture but time, space and resources (personnel and equipment to run the trials, water, herbicide, etc.) to fully develop so as to allow their screening and evaluation. "Exhibit D" showed the efforts undertaken for the generation and selection of the claimed event J-101 and referred to the production and analysis of thousands of individual plants over six years of testing, including trials in five different states and comprehensive molecular and phenotypic testing, which were all necessary for arriving at the event J-101. The breeding and selection processes that led to event J-101 showed that they were highly cumbersome and time consuming. It was not obvious for a skilled person which of the potential events was the most promising and inventive skills were required to identify it.

Third, there was no reference in document D3 to the presence of a heat shock protein 70 (HSP70) leader sequence within the transgene genetic elements of the disclosed transformation plant vectors nor was any suggestion to use such a sequence in those vectors. However, the transformation alfalfa vectors used in the application contained a HSP70 leader sequence. In the absence of any indication in document D3, the use of this HSP70 leader sequence was not obvious.

In absence also of any evidence to the contrary, it was completely credible that the surprisingly advantageous effects and properties shown in "Exhibit D" for the deposited alfalfa variety J-101 were not limited to this specific variety but would be present in other alfalfa varieties - as long as the specific insertion site and the transgene genetic elements were those specified in the claims.

XI. The appellants requested that the decision under appeal be set aside and a patent be granted on the basis of the main and sole request filed during the oral proceedings, consisting of claims 1 to 6.

Reasons for the Decision

Article 123(2) EPC

1. No objections were raised by the examining division under Article 123(2) EPC 1973 in the decision under appeal. Nor does the board see any reason to raise such objection against the present claims which are considered to have a basis in the application as filed. Thus, the requirements of Article 123(2) EPC are considered to be fulfilled.

Articles 84 and 83 EPC

2. The board shares the view of the examining division that both the transgene genetic elements and their insertion site into the alfalfa genome are essential features for obtaining the characteristics and properties of the transformation event J-101 described

in the application. Both features are included in the present claims.

2.1 The genome of the transgenic alfalfa plant according to claim 1 comprises the transgene genetic elements which are necessary for the expression of the EPSPS gene (cf. page 18, lines 9 to 22 of the application) and the "*junction sequences spanning the insertion site having SEQ ID NO:3 and SEQ ID NO:4*" (cf. point VII *supra*), which is understood by the board not only to require the presence of the specific sequences SEQ ID NOs:3 and 4 in the alfalfa genome, but to define also the position of these transgene genetic elements within those sequences - as shown in Figure 1 of the application.

2.2 This is directly derivable not only from the wording used in claim 1 but also from SEQ ID NO:3 - a 678 nucleotide base pair segment representing the 5' transgene/genomic sequence of alfalfa event J-101 which consists of 393 bases of alfalfa genomic DNA and 285 bases of the transgene insert (cf. page 23, lines 6 to 8 and 11 to 13, Figures 1 and 2 of the application), and from SEQ ID NO:4 - a 581 nucleotide base pair segment representing the 3' transgene/genomic sequence of alfalfa event J-101 which consists of 317 bases of the transgene insert and 264 bases of the alfalfa genomic DNA sequence (cf. page 23, lines 9 to 11 and lines 14 to 17, Figures 1 and 3 of the application).

3. It is observed that a possible objection for lack of clarity of claim 1 could arise from the reference to Figure 1 for characterizing the transgene genetic elements mentioned in that claim. However, this

objection is considered not to be relevant in view of the fact that claim 1 further defines all those elements as being present in the specific alfalfa event J-101 deposited with ATCC accession No PTA-4814.

4. The method of detecting the presence of DNA corresponding to alfalfa plant J-101 DNA of claim 6 relies on a probe which is structurally defined as being homologous or complementary to SEQ ID NO:1 and SEQ ID NO:2 (both found within the sequences of SEQ ID NO:3 - nucleotides 385 to 402, and of SEQ ID NO:4 - nucleotides 309 to 326, respectively) and which is further defined in functional terms by requiring it to hybridize under stringent conditions with genomic DNA from alfalfa plant event J-101 but not with a control alfalfa plant (cf. page 14 of the application). Although the method of claim 5 - which has the same purpose as claim 6 - relies on a primer pair which is not structurally defined, the primer pair is nevertheless required to produce an amplicon comprising SEQ ID NO:1 and 2 when used in a nucleic acid amplification reaction with genomic DNA from alfalfa plant event J-101 (cf. page 15, line 12 to page 16, line 12 of the application). In the absence of any evidence on file showing that SEQ ID NO:1 and 2 - both sequences contain 9 nucleotides from the alfalfa genome and 9 nucleotides from the transgene insert - are present in the wild-type alfalfa genome, the board considers this functional definition of the primer pair used in the method of claim 5 to be appropriate.

5. The disclosure of the transgene genetic elements of Figure 1 (cf. page 18, lines 9 to 22 of the application) and of the junction sequences spanning the insertion

site (SEQ ID NOs:3 and 4) allows a skilled person to carry out the invention as claimed without undue burden. No objection was raised by the examining division under Article 83 EPC 1973 in the decision under appeal nor does the board see any reason of its own to do so.

6. In view of the above considerations, the claims and the invention to which they relate are considered to fulfil the requirements of Articles 84 and 83 EPC.

Article 54 EPC

7. In the remarks found in the decision under appeal (cf. point IX *supra*), the examining division referred to document D6 and to EMBL database entry AC099233 as anticipating the claimed subject-matter. However, the board fails to see any evidence to support such an objection.

7.1 The examining division considered that the subject-matter which is now claimed in claim 3 was anticipated by SEQ ID NO:3 of document D6. This sequence is disclosed on page 13, lines 30 to 32 of that document as being a PCR primer 3 sequence for detecting a transgenic canola RT73 event insert and as having a length of only 28 nucleotides. Whereas there is no doubt that these 28 nucleotides are found within SEQ ID NO: 4 of the present application (nucleotides 236 to 263; cf. Figure 3 of the application), the isolated DNA polynucleotide primer molecule of claim 3 must comprise at least **30** contiguous nucleotides of SEQ ID NO: 4.

7.2 The subject-matter which the examining division considered to lack novelty in view of document EMBL database entry AC099233 (cf. point VIII *supra*), namely a DNA molecule comprising SEQ ID NO:1, SEQ ID NO:2, SEQ ID NO:3, or SEQ ID NO:4, is no longer claimed.

8. It follows from the foregoing that the appellants' main request fulfils the requirements of Article 54 EPC.

Article 56 EPC

9. Like the appellants and the examining division, the board considers document D3 to be the closest prior art. Except for the HSP70 leader sequence, document D3 discloses the same transgene genetic elements as those used in the application, in particular the full-length transcript promoter from figwort mosaic virus (P-FMV35S) (cf. paragraph bridging pages 10 and 11 and page 47, line 27 to page 48, line 7), the mutated *Arabidopsis thaliana* chloroplast transit peptide (CTP2) (cf. page 40, line 29 to page 41, line 10), the synthetic CP4 EPSPS gene from *Agrobacterium* (cf. page 39, line 20 to page 40, line 26) as well as their fusion (CTP2-CP4 EPSPS) (cf. page 41, line 11 to page 42, line 3) and the 3' non-translated region from the ssRUBISCO gene from pea (E9) (cf. page 11, lines 23 to 24). Plant transformation vectors containing these transgene genetic elements are also disclosed in document D3 (cf. *inter alia* page 66, lines 5 to 17 and Figure 16) which further describes the use of these vectors for plant transformation and production of glyphosate tolerant plants. Although the examples of document D3 describe transformed tobacco plants (cf. page 52, Example 1, page 65, Example 4 and page 71, Example 6), canola

plants (cf. page 55, Example 2), soybean plants (cf. page 63, Example 3), Black Mexican Sweet (BMS) corn cells (cf. page 68, Example 5), there are also explicit references to other plants, including alfalfa (cf. page 44, line 27 and page 49, line 23).

10. Starting from this closest prior art, the objective technical problem to be solved can be seen in the provision of alfalfa plants with high tolerance to glyphosate. Although there is no detailed experimental data in the application, the post-published experimental evidence provided by the appellants, namely "Exhibit D" (cf. point VIII *supra*), is considered by the board - in line with the examining division's view regarding the auxiliary request then on file (cf. page 6, last two paragraphs in the decision under appeal and points II and IX *supra*) - to support the appellants' argument that the technical problem is solved by the claimed glyphosate tolerant alfalfa event J-101 deposited with ATCC accession No. PTA-4814. It is observed that the experimental evidence shown in post-published "Exhibit D" is used only to support information that is already derivable from the application itself, namely the presence of an advantageous high glyphosate tolerance and the physiological and morphological characteristics of the alfalfa event J-101 (cf. point 12.1 *infra*), and thus, according to the case law of the Boards of Appeal, it can be taken into consideration when assessing whether or not the objective technical problem has been solved (cf. *inter alia* T 1329/04 of 28 June 2005).

11. The board also shares the view of the examining division that the state of the art, in particular

documents D3 and D6, provide a clear guidance to the skilled person for obtaining glyphosate tolerant alfalfa plants. All technical (transgene genetic) elements required for obtaining these plants were available and close at hand to the skilled person, as well as the integration method and the criteria for selecting these glyphosate tolerant alfalfa plants. Although, as rightly stated by the appellants, the selection of such alfalfa plants may require important resources and be extremely costly and time consuming (cf. point X *supra*), the board considers that none of these factors justifies the acknowledgement of any inventive merit.

12. However, in line with the case law of the Boards of Appeal concerning the use of random methods (cf. *inter alia* T 737/96, *supra*, T 645/02 of 16 July 2003, points 7 to 8 of the Reasons, T 1231/01 of 14 September 2005, point 11 of the Reasons), the actual isolation of a glyphosate tolerant alfalfa plant having the desired properties and containing elements of surprise may justify the recognition of an inventive step. Thus, the question arises whether the claimed glyphosate tolerant alfalfa event J-101 deposited with ATCC accession No. PTA-4814 contains these elements of surprise or not.

12.1 Although the application refers explicitly to glyphosate tolerant alfalfa plants having "*all of the physiological and morphological characteristics of the alfalfa event J-101*" (cf. page 4, lines 6 to 9 and page 6, lines 12 to 14), none of these characteristics are disclosed therein but only in the post-published experimental evidence shown in document "Exhibit D". This document refers to the deficiencies detected in 98

events of (approximately) 100 original events, such as "*irregularities and aberrations in vegetative or floral morphology*", "*unstable genetic segregation ratio unreliable or unacceptable*", "*extraneous or truncated DNA sequences surrounding the cp4-epsps insertion site (unacceptable presence of vector backbone sequences, duplications of all or part of the insertion at a single ...* (or) *... at multiple insertion sites in the genome, incomplete (truncated) inserts)*" and "*inconsistent expression of the CP4 protein*" (cf. point 6 of "Exhibit D"). These characteristics are summarized in Table 3 in which it is shown that only four events have high glyphosate tolerance (> 100) and no negative agronomic attributes associated therewith. However, only two events, namely events J-101 and J-163, are commercially viable, one of the other two events is indicated as having no tolerance stability and the other as not being completely characterized (cf. Table 3 of "Exhibit D"). Importantly, it is also shown in Table 3 that not all transformed alfalfa plants having a high glyphosate tolerance have also the "*physiological and morphological characteristics*" that make the alfalfa event J-101 appropriate for an agronomic (commercially viable) purpose.

12.2 None of the above characteristics referred to in Table 3 of "Exhibit D" is mentioned in document D6 which, even though it explicitly refers to "*methods of biotechnology* (that) *have been applied to canola for improvement of the agronomic traits and the quality of the product*" (cf. page 1, lines 17 to 19), is only concerned with the tolerance to glyphosate herbicide and does not provide any data on (physiological and morphological characteristics of) whole canola plants -

not even for the specific transgenic canola event PV-BNGT04(RT73) disclosed therein (cf. *inter alia* page 13, Example 1 of document D6).

12.3 While document D3 provides more experimental data than document D6, in the board's view, these data are not enough to cast doubts on the evidential value of the data shown in "Exhibit D". As stated in point 9 above, document D3 discloses high glyphosate tolerant tobacco, canola, soybean and corn plants and provides further experimental data for some of the (fertile) progeny of these transformed plants. As rightly observed by the examining division in the decision under appeal, these data certainly show the presence of a high variance in the level of glyphosate tolerance achieved - see, for instance, Table VIII with an EPSPS tolerance as low as 18% and as high as 97% for transformed canola plants (cf. page 60 of document D3). However, none of these plants nor the corresponding transformation events are completely characterized in document D3 (single or multiple insertion sites, presence of extraneous or truncated DNA sequences, genetic segregation ratio, reproductive tolerance and glyphosate tolerance stability under several conditions, etc.). Nor are these advantageous characteristics necessarily associated with the presence of a high glyphosate tolerance - as shown for the transformed alfalfa plants in Table 3 of "Exhibit D" (cf. point 12.1 *supra*). It is also noted that none of these (physiological and morphological) characteristics - apart from glyphosate tolerance - has been addressed by the examining division in the decision under appeal nor is any other information or data to be found in the prior art on file.

12.4 Thus, in the absence of this information and in view of the fact that the claimed alfalfa plant event having all these characteristics has been obtained by a random technique method for which the expectations always range from nil to high (cf. point 12 *supra*), the board concludes that the combination of all these characteristics with the desired high glyphosate tolerance in alfalfa event J-101 as deposited with the ATCC accession number PTA-4814 is an element of surprise justifying the acknowledgement of inventive merit.

13. The appellants have also pointed to the *Petunia hybrida* HSP70 leader sequence present in the transformation plant vectors of the application as contributing to the inventive merit (cf. page 18, lines 13 to 15 and Figure 1 of the application). In this respect, it is noted that the disclosure of document D3 is not intended to be limited to the specific transformation plant vectors disclosed therein but it explicitly suggests to add other genes and/or genetic elements (cf. *inter alia* page 66, lines 13 to 17, Figure 16 of document D3), including a 5' non-translated leader sequence (cf. page 10, lines 16 to 29 of document D3). Although there is no reference to the HSP70 leader sequence in document D3 and there is mention of any prior art concerning this sequence in the decision under appeal, the presence of this HSP70 leader sequence in the application is not disclosed as being associated to any particular effect, nor is it characterized as being essential for obtaining the desired properties of the transformed alfalfa plants. Under these circumstances, the contribution of the HSP70 leader sequence to the

inventive merit of the application appears to be doubtful, even though, in the present case and in the light of the conclusion achieved by the board in point 12.4 above, an inventive merit may well be acknowledged for other reasons.

14. The isolated polynucleotide primer molecules of claims 2 and 3 are used in the DNA detection kit of claim 4 for detecting DNA corresponding to alfalfa plant event J-101 in the methods of claims 5 and 6 (cf. point VII *supra*). Although the examining division considered these products to contravene Article 56 EPC, this finding was based only on the fact that "*... it would be a matter of trivial routine experimentation ... to analyse the insertion site of the T-DNA vector used for transformation ...*" (cf. page 7, last paragraph of the decision under appeal). In view of the fact that the characteristics of the alfalfa event J-101 are directly associated to this insertion site, and that their combination renders this event inventive (cf. point 12.4 *supra*), the board concludes that an inventive merit for the subject-matter of all claims derives from that of the glyphosate tolerant alfalfa plant of claim 1.

15. Therefore, the appellants' main request is considered to fulfil the requirements of Article 56 EPC.

Article 53(b) EPC and Rule 27(b) EPC

16. It is acknowledged that the alfalfa event J-101 deposited with ATCC accession number PTA-4814 is a specific alfalfa variety which, as such, is excluded from patent protection by Article 53(b) EPC and

Rule 27(b) EPC (cf. G 1/98 OJ EPO 2000, page 111). However, the subject-matter of claim 1 is not limited to the specific deposited alfalfa variety but encompasses all possible alfalfa varieties having in their genome the transgene genetic elements shown in Figure 1 of the application and the junction spanning insertion site characterized by SEQ ID NOs:3 and 4 as in the deposited alfalfa variety.

17. Although the advantageous (physiological and morphological) characteristics described in the application and shown in "Exhibit D" have been demonstrated, only and exclusively, for the deposited glyphosate tolerant alfalfa plant event J-101, the board in the absence of any evidence to the contrary has no reason to question the appellants' assertion that these characteristics are also obtained in other alfalfa varieties when they fulfil all the requirements mentioned in claim 1 of the main request (cf. point X *supra*).

18. Thus, the claimed subject-matter is considered not to contravene Article 53(b) EPC and Rule 27(b) EPC.

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 with the order to grant a patent on the basis of the main and sole request consisting of claims 1 to 6 filed during the oral proceedings, and a description and drawings to be adapted thereto.

The Registrar: The Chairman:

A. Wolinski C. Heath