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**Datasheet for the decision
of 27 June 2013**

Case Number: T 2471/09 - 3.3.08
Application Number: 02731454.1
Publication Number: 1456360
IPC: C12N 9/00, C07H 21/04
Language of the proceedings: EN

Title of invention:

Methods and Composition for the Production of Orthogonal tRNA-
Aminoacyl-tRNA Synthetase Pairs

Applicants:

The Scripps Research Institute
The Regents of the University of California

Headword:

Aminoacyl-tRNA Synthetase/SCRIPPS

Relevant legal provisions:

EPC Art. 83, 84, 111(1)

Keyword:

"Sufficiency of disclosure - after amendment (yes)"
"Clarity (yes)"
"Remittal to the department of first instance (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 2471/09 - 3.3.08

D E C I S I O N
of the Technical Board of Appeal 3.3.08
of 27 June 2013

Appellants:
(Applicants)

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Decision under appeal:

**Decision of the Examining Division of the
European Patent Office posted on 16 July 2009
refusing European patent application
No. 02731454.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: M. Wieser
Members: T. J. H. Mennessier
R. Moufang

Summary of Facts and Submissions

- I. The applicants (appellants) lodged an appeal against the decision of the examining division dated 16 July 2009, whereby the European patent application No. 02731454.1 with publication number 1 456 360 was refused. The application, entitled "*Methods and Composition for the Production of Orthogonal tRNA-Aminoacyl-tRNA Synthetase Pairs*" [sic], originated from an international application published as WO 02/086075.
- II. Basis for the refusal was the main request filed on 8 September 2008, and the first and second auxiliary requests filed on 26 March 2009.
- III. The requests were all refused for reasons of non-compliance with the requirements of Articles 83 and 84 EPC.
- IV. Under cover of a letter of 25 November 2009, the appellants filed a statement setting out the grounds of appeal which was accompanied by a main request and three auxiliary requests. The main request, and auxiliary requests 1 and 2 were identical to the requests on which the decision under appeal was based. Auxiliary request 3 was new. Oral proceedings were requested as an auxiliary measure.
- V. In a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) attached to the summons to the oral proceedings, the Board expressed its preliminary and non-binding views.

VI. In reply to the Board's communication, the appellants filed further submissions with a letter dated 24 May 2013. The submissions were accompanied by a main request, which was identical to auxiliary request 3 of 25 November 2009, and newly filed auxiliary requests 1 and 2.

VII. Auxiliary request 2 of 25 May 2013 consisted of 3 claims which read as follows:

"1. A polypeptide comprising an amino acid sequence selected from SEQ ID NOs: 35-64."

"2. A polynucleotide encoding the polypeptide of claim 1."

"3. An *E. coli* cell comprising the polypeptide of claim 1."

VIII. At the oral proceedings which took place on 27 June 2013, the appellants withdrew the main request and auxiliary request 1. Auxiliary request 2 of 24 May 2013 was re-filed as their only request.

IX. The submissions made by the appellants, insofar as they are relevant to the present decision, may be summarised as follows:

The amendments made in the request did not constitute a fresh case. The specific sequences SEQ ID NO:35 to SEQ ID NO:64 represented a class of mutant *Methanococcus jannaschii* aminoacyl-tRNA synthetases that were encompassed by the claims before the examining division.

The subject-matter of claims 1 to 3 was literally referred to in the application as published (WO 02/086075), in particular in Table 5 of Appendix 1. The claims were clear and their subject-matter was sufficiently disclosed.

- X. The appellants requested that the decision under appeal be set aside and the case be remitted to the examining division for further prosecution on the basis of claims 1 to 3 of the request filed at the oral proceedings.

Reasons for the Decision

Admissibility of the request into the proceedings

1. The request was first submitted - as auxiliary request 2 - on 24 May 2013 in direct reaction to the objections raised by the Board in its communication issued under Article 15(1) RPBA. The subject-matter of claims 1 to 3 constitutes a precisely defined sub-group of mutant aminoacyl-tRNA synthetases falling within the scope of the claims that were before the examining division and were the basis for the appealed decision. This sub-group has an explicit basis in the application as published. Therefore, the claims do not add any complexity to the case and the Board, exercising the discretion conferred to it by Article 13(1) RPBA, decides to admit this request into the proceedings.

Article 123(2) EPC

2. Literal support for the polypeptides of claim 1 is found in Table 5 (see Appendix 1) of the application published as WO 02/086075 (the content of which is considered to be identical to the content of the application as filed). These polypeptides, which comprise an amino acid sequence selected from SEQ ID NO:35 to SEQ ID NO:64, are also referred to in claim 7(b) and in paragraphs [0025], [0194] and [0320] of the application as published (see pages 11, 61 and 107, respectively).

3. Polynucleotides encoding these polypeptides are generally referred to in paragraphs [0025] and [0110] on page 11 and 33, respectively, of the application as published and a preferred polynucleotide sequence encoding each of the polypeptides of sequences SEQ ID NO:35 and SEQ ID NO: 37 to SEQ ID NO:64 is described in Table 5 (see sequences SEQ ID NO:4 to SEQ ID NO:32). These preferred sequences are also referred to in claim 7(a) and in paragraphs [0025] and [0110] of the application as published (see pages 11 and 33, respectively).

4. Paragraph [0174] on page 56 of the application as published, which describes *E. coli* cells used as a host containing *inter alia* a mutant aminoacyl-tRNA synthetase, when read in combination with any of paragraphs [0025], [0194] and [0320] of the application as published (see point 2 *supra*), provides a basis for the subject-matter of claim 3.

5. Accordingly, the request meets the requirements of Article 123(2) EPC.

Articles 83 and 84 EPC

6. The Board is satisfied that, owing to the amendments carried out to define the claimed subject-matter, the request complies with the requirements of Articles 83 and 84 EPC.

Conclusion

7. Other substantive requirements of the EPC, in particular novelty and inventive step (Articles 54 and 56 EPC), have not yet been assessed by the examining division. In order to allow the request to be examined at two instances, the Board, in accordance with Article 111(1) EPC, decides to remit the case to the examining division for further prosecution.

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 for further prosecution on the basis of claims 1 to 3 of the request filed at the oral proceedings on 27 June 2013.

The Registrar

The Chairman

A. Wolinski

M. Wieser