

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

D E C I S I O N
of 18 January 2005

Case Number: T 0799/03 - 3.4.2

Application Number: 97116256.5

Publication Number: 0831330

IPC: G01N 35/04

Language of the proceedings: EN

Title of invention:
Method of automatic analysis of samples

Applicant:
Abbott Laboratories

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 56, 84, 123(2)

Keyword:
"Amended claims allowable"

Decisions cited:
-

Catchword:
-



Case Number: T 0799/03 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 18 January 2005

Appellant: Abbott Laboratories
Chad 0377/AP6D-2
100 Abbott Park Road
Abbott Park,
Illinois 60064-3500 (US)

Representative: Modiano, Guido, Dr.-Ing.
Modiano, Josif, Pisanty & Staub
Baaderstrasse 3
D-80469 München (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 11 February 2003
refusing European application No. 97116256.5
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. G. Klein
Members: M. A. Rayner
M. J. Vogel

Summary of Facts and Submissions

- I. European Patent Application N° 97 116 256.5 (Publication N° EP 0 831 330) was refused by the examining division on the grounds that the amendments made to independent claim 1 offended against the provisions of Article 123 EPC, and that this claim lacked clarity within the meaning of Article 84 EPC.
- II. The applicant (appellant) filed an appeal against the decision refusing the patent application.

At oral proceedings held before the board on 18 January 2005 the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of an amended set of claims of which claim 1, the only independent claim, reads as follows:

"1. A method of operating different apparatuses for performing a process for determining an item of interest in a sample on the different apparatuses with the same reagent, each apparatus having a respective process lane (28) with a different physical length, the method comprising the steps of:

(a) accepting a container (15) for holding the sample in a process lane (28) where each process step is selectively automatically performed on the sample in the container (15) within the same time frame at one process position,

(b) selectively automatically performing all determination processes on the sample in the container (15) while moving the container (15) along the process

lane (28) in discrete steps in the same direction only along the process lane so that each container moves to a process position along the process lane previously occupied by the adjacent container; and

(c) maintaining an effective length of the process lane (28) constant, wherein the effective length represents the total distance traveled by the container (15) on the process lane (28), such that each apparatus provides for the same effective length for the determination of the item of interest."

III. In support of its request the appellant stressed that the invention consisted in exploiting the idea of subjecting containers for samples to be analysed to a continuous, stepped progression along a process line, each step lasting the same amount of time. It was thus possible to perform the same progression of containers, using *inter alia* the same reagents, in different apparatuses having process lanes of a different physical length, simply by providing in each apparatus for the same number of steps having the same duration, so as to achieve a constant effective length of the different process lanes. Claim 1 as amended during the oral proceedings now clearly defined the simultaneous use of different apparatuses for performing a same determination process. No such method of operating different apparatuses was disclosed nor even suggested in any of the prior citations on the file.

Reasons for the Decision

1. The appeal is admissible.
2. *Admissibility into the procedure of the amended set of claims*

Amended claim 1 as filed during the oral proceedings of 18 January 2005 now defines the invention as a method of operating different apparatuses having respective process lanes of a different physical length.

The amended claim 1 in the Board's view constitutes a reasonable attempt to overcome the grounds for the refusal, in the light of the discussion of the case during the oral proceedings.

The amended set of claims is therefore admissible into the procedure, despite its late filing.

3. *Compliance with the requirements of Article 123(2) and 84 EPC*

As a consequence of the new presentation of the invention as a method of operating different apparatuses having respective process lanes of a different physical length, claim 1 no longer includes the features objected to by the examining division under Article 123(2) EPC and Article 84 EPC relating to "the process lane (28) having a first physical length and a second physical length which is different from the first physical length and which includes the first physical length" (see points 12 and 13 of the decision).

Amended claim 1 in the Board's view is now adequately clear and supported by the passages of the description as originally filed which expressly stress the advantage of providing a constant effective length of the process lanes in the apparatuses of the different embodiments described, which have different physical lengths, such as to allow for the performance with these different embodiments of same assay formats using same reagents (see page 114, line 1 to page 115, line 9).

Dependent claims 2 and 3 are as originally filed.

Pages 1 and 2 of the description have merely been supplemented with a short acknowledgement of the relevant content of the closest prior art document and amended for consistence with the wording of the amended claim 1, as required by the provisions of Rule 29(1) (b) and (c) EPC.

For these reasons the present application complies with the requirements of Articles 123(2) and 84 EPC.

4. *Patentability*

None of citations on the file actually discloses or hints at a method of operating **different apparatuses** for performing a process for determining an item of interest in a sample, the method being performed on the different apparatuses with the same reagent and each apparatus having a respective process lane (28) with a different physical length. Even less do these citations suggest the specific steps set out in claim 1.

In particular, document EP-A-0 712 000, which was referred to by the examining division during the examination procedure and appears to disclose the closest prior art, essentially describes an automatic immunoassay analyser with a ring shaped incubation chamber. In one passage of the description it is stated that a different shape may be selected for the incubation chamber in view for instance of different size, cost or space requirements (see column 6, lines 26 to 36). This statement cannot however without hindsight be considered to hint at actually providing such different apparatuses and operating them all in the claimed way so as to achieve a same effective length of the process lane for them all with a same reagent. Neither are the containers in these prior art apparatuses moved in a single direction as required by the present claim 1.

For these reasons the subject-matter of claim 1 in the board's view is novel and it implies an inventive step, in conformity with the requirements of Articles 54 and 56 EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the first instance with the order to grant a patent on the basis of the following documents:
 - claims 1 to 3 filed during the oral proceedings;

 - description pages 1 and 2 filed during the oral proceedings; pages 3 to 115 as originally filed;

 - drawings figures 1 to 32B as originally filed.

The Registrar:

The Chairman:

P. Martorana

A. Klein