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**Datasheet for the decision  
of 24 July 2008**

**Case Number:** T 0221/06 - 3.4.02

**Application Number:** 94115175.5

**Publication Number:** 0636880

**IPC:** G01N 27/49

**Language of the proceedings:** EN

**Title of invention:**

Quantitative analyzing apparatus

**Patentee:**

MATSUSHITA ELECTRIC INDUSTRIAL CO., LTD., et al

**Opponent:**

Roche Diagnostics Corporation

**Headword:**

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**Relevant legal provisions:**

EPC Art. 54, 56

**Relevant legal provisions (EPC 1973):**

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**Keyword:**

"Main request claim 1 - novelty (no)"

"Auxiliary requests - inventive step (no)"

"Multiple requests, "pick and mix" approach (cf. point 2 of the Reasons)"

**Decisions cited:**

T 0745/03

**Catchword:**

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Case Number: T 0221/06 - 3.4.02

**D E C I S I O N**  
of the Technical Board of Appeal 3.4.02  
of 24 July 2008

**Appellant:**  
(Opponent)

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**Decision under appeal:**

Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
16 December 2005 concerning maintenance of  
European patent No. 0636880 in amended form.

**Composition of the Board:**

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

## Summary of Facts and Submissions

I. Both the opponent and the patent proprietor appealed against the interlocutory decision of the opposition division that European patent No. 636 880 (application number 94115175.5) as amended according to auxiliary request 4 of the patent proprietor meets the requirements of the Convention. The patent concerns quantitative analysing apparatus. The decision under appeal made reference to documents including the following:

E1 WO 89/08713

II. In the decision under appeal, the opposition division considered that document E1 disclosed all the features of claim 1 of the patent as granted, as set out in the following analysis, where the references in parentheses apply to document E1:

a) a quantitative analyzing apparatus for detecting a concentration of an objective substance in a sample liquid (page 12 lines 19-21, claim 12, Figures 1 and 9), the apparatus comprising

b) means for applying a voltage to a sensor in order to detect a change in a resistance value of said sensor (page 16 lines 7-9, page 38 lines 1-4),

c) means for automatically detecting that the sample liquid is supplied to said sensor on the basis of the change in the resistance value of said sensor (page 10 lines 14-17, page 16 lines 9-10, page 38 lines 3-4),

d) means for automatically interrupting the voltage on the basis of output of said detection means in order to allow for a stabilization of a reaction between the

sensor and the sample liquid (page 10 lines 18-20, page 16 lines 10-11),

e) means for automatically reapplying the voltage to said sensor after said interruption means has operated for a specific time period (page 10 lines 22-24, page 16 lines 15) and means for measuring the resultant current (page 10 lines 24-25, page 16 lines 17-18),

f) means for converting the measured current into the concentration of the objective substance in the sample liquid (page 11 lines 2-3, see also page 34 lines 11-13), and

g) means for displaying the concentration of the objective substance in the sample liquid (page 11 lines 3-4, page 12 lines 23-25, page 16 line 18, reference numeral "16" in Figures 1 and 9). Therefore, the opposition division concluded that the subject-matter of claims 1 was not novel.

The division considered the argument of the patent proprietor that document E1 did not disclose a said analyzing apparatus which was arranged to perform features d) and e) of claim 1 automatically. The division did not accept this, however, since from page 10 lines 14-25 of document E1, it considered it clear that, not an operator, but the said analyzing apparatus, i.e. a machine, initiates the different steps (page 10 line 14: "The meter recognizes sample application ..."; page 10 line 18: "the meter begins the reaction incubation step ..."; page 10, line 23: "the instrument then imposes a known potential ..."). The fact that these steps are carried out automatically is additionally supported by the table on page 22 showing that no handling steps are required between the application of sample liquid (blood) and the display of

the measurement results. The automatic operation of the analyzer of Document E1 is even further supported on page 5 line 25, page 6 lines 10-12 and page 8 lines 23-24.

III. With respect to claim 4 of the 4th auxiliary request, the division considered document E1 to disclose a quantitative analyzing apparatus comprising all the features thereof, except for the feature "a buzzer for notifying that a sensor has been inserted into the apparatus". The division mentioned that the opponent had argued that document E1 disclosed (in Figure 9) a "buzzer" which was coupled to the display 16 as part of the user interface. Since the claim was not limited to the function of the "buzzer", the addition of a "buzzer" was, in the opponent's view, not novel over document E1. The division did not accept this, however, because, although a said "buzzer" is disclosed in Figure 9 of document E1, the document is completely quiet about the function of said "buzzer". The opposition division was of the opinion, that as formulated, the claim is also limited to the function of the "buzzer", and that no indication is given in Document E1 for using the "buzzer" to notify the user that a sensor has been inserted into the analyzing apparatus. One could think instead of numerous other functions such as indicating a low battery or a defective microprocessor and so on. The subject-matter of claim 4, hence, was thus considered novel by the division. Moreover, the subject-matter of claim 4 of the 4th auxiliary request was also considered to involve an inventive step by the division. The opponent had argued that the objective problem was to provide an audible notification of the sensor insertion to the

user. Facing this problem, the opponent had argued it would then be straight forward to use the "buzzer" for this, what else should the user do except for using the buzzer. The division could not accept this, however, because the problem as formulated by the opponent would already comprise features of the solution. The objective problem rather is to improve the device of document E1 by having means for informing a user that the sensor has been correctly inserted. Since this problem could be solved by a number of (other) different possibilities (haptic means, increased mechanical resistance, a mark, activation of the display, etc.), denying the claim an inventive merit would amount to an ex-post-facto analysis. The subject matter concerned cannot be reached in an obvious way from the teaching of document E1.

- IV. In its appeal, the patent proprietor requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or on the basis of one of auxiliary requests 1 to 15 filed with the statement of appeal, modified with respect to the claims of the main request as mentioned for easier understanding in Annex A, entitled "Claim Combinations in Requests". The patent proprietor also requested that the patent be maintained on the basis of at least one of the independent claims of the auxiliary requests. Oral proceedings were requested on an auxiliary basis.
- V. In its appeal, the opponent requested that the decision under appeal be set aside and the patent be revoked. The opponent agreed with the opposition division that the subject matter of the independent claims of the

main request is not novel. Oral proceedings were requested on an auxiliary basis.

- VI. Consequent to auxiliary requests by both parties, oral proceedings were appointed by the board. In a communication attached to the summons to oral proceedings, the board observed that the complex of requests submitted by the patent proprietor could give the impression of "fishing around" for patentable subject matter in a verbal way, rather than of submissions in support of features of a clearly perceived invention.
- VII. In response to the communication attached to the summons, the patent proprietor declared itself prepared to amend the wording of some of the claims in its requests, should the board consider it appropriate.
- VIII. At the start of the oral proceedings, the Chairman remarked that the board had not changed its view on the filing of auxiliary requests. The Chairman observed that there seemed to be some three hundred and eighty four possibilities involved in the auxiliary and potential auxiliary requests. However, with respect to the filing of possible alternative auxiliary request, the Chairman explained that only requests in an exact form could be considered, since otherwise order and content of potential requests was not known. Moreover, in inter partes proceedings, the board was not in a position to give an indication as to what might be appropriate or acceptable. The board would therefore decide on specific requests put on the table. The Chairman asked the parties for their requests.

IX. The patent proprietor confirmed that its auxiliary requests were the fifteen auxiliary requests already submitted in writing, wherein each request comprises either claim 5A or claim 5B. In some requests, claims 5A and 5B are differently numbered as can be seen in Annex A. Replying to the comments of the Chairman, the patent proprietor observed that the number of auxiliary requests did not amount to "fishing around" for an invention, but were intended to achieve a fair protection for the invention. Nevertheless, with the requests on the table, the patent proprietor commented that there could, for example, be a problem in that all the auxiliary requests contained a claim directed to subject matter involving a buzzer. Should this claim fall, then all the requests would fail. Additional to the existing potential requests, it may therefore be necessary to file further auxiliary requests without this feature.

Having heard the comment of the patent proprietor, the Chairman asked the patent proprietor if any further requests were then to be filed. The patent proprietor replied that no further requests were to be filed at that point.

X. The opponent maintained its request for revocation of the patent. The opponent protested that it was confronted with difficulties in presenting its case should a situation exist where it was not clear which requests were on the table. There were simply too many too unclear requests. Much of the subject matter concerned was mentioned somewhere in the disclosure, perhaps, but not as an invention.



XI. Before taking a break for deliberation on the case by the board, the Chairman asked the parties to confirm their requests, asking the patent proprietor, in particular, if now, further auxiliary requests were to be filed. The parties confirmed their requests, the patent proprietor stating that no further requests were to be filed.

XII. Claim 1 of the main request (patent as granted) is worded as follows

"A quantitative analyzing apparatus for detecting a concentration of an objective substance in a sample liquid, the apparatus comprising means(15) for applying a voltage to a sensor(13) in order to detect a change in a resistance value of said sensor(13),  
means for automatically detecting that the sample liquid is supplied to said sensor(13) on the basis of the change in the resistance value of said sensor(13),  
means for automatically interrupting the voltage on the basis of output of said sample liquid  
detection means in order to allow for a stabilization of a reaction between the sensor(13) and the sample liquid,  
means for automatically reapplying the voltage to said sensor(13) after said interruption means has operated for a specific time period,  
means(16, 17) for measuring the resultant current,  
means(18) for converting the measured current into the concentration of the objective substance in the sample liquid, and

means for displaying the concentration of the objective substance in the sample liquid."

XIII. The claims of the auxiliary requests of the patent proprietor, both in the 5A and 5B version, all include an independent claim, numbered 4 in auxiliary requests 1 to 8 and 15, numbered 3 in auxiliary requests 9 to 12 and numbered 2 in auxiliary requests 13 and 14 as follows

"A quantitative analyzing apparatus for detecting a concentration of an objective substance in a sample liquid, the apparatus comprising a buzzer(59) for notifying that a sensor has been inserted into the apparatus, means(15) for applying a voltage to a sensor(13) in order to detect a change in a resistance value of said sensor(13), means for automatically detecting that the sample liquid is supplied to said sensor(13) on the basis of the change in the resistance value of said sensor(13), means for automatically interrupting the voltage on the basis of output of said sample liquid detection means in order to allow for a stabilization of a reaction between the sensor(13) and the sample liquid, means for automatically reapplying the voltage to said sensor(13) after said interruption means has operated for a specific time period, means(16, 17) for measuring the resultant current, means(18) for converting the measured current into the concentration of the objective substance in the sample liquid, and

means for displaying the concentration of the objective substance in the sample liquid."

The board will refer, in the following, to the above claim as the "buzzer" claim.

XIV. The case of the patent proprietor on substantive patentability can be summarised as follows.

#### Main Request

The patent proprietor maintained its position as advanced before the opposition division, that the features (d) and (e) of claim 1 as granted are not disclosed in document E1. The subject matter of claim 1 is therefore novel. Moreover, as automatic measurement is stable, minimises result variation and alleviates patient burden, this subject matter can be considered to involve an inventive step.

#### "Buzzer" Claims

Document E1 does not disclose a buzzer notifying that a sensor has been inserted into the apparatus. The patent proprietor agreed to the formulation of the problem solved by this feature as made by the opposition division. The patent proprietor also concurred with the opposition division that document E1 did not disclose or suggest a buzzer to solve the problem as a number of other buzzer functions could be thought of. Thus, while buzzers in general are known, it is not a matter of just selecting to use the buzzer as claimed or a buzzer from other possibilities, as there is no motivation for any use in the claimed way in document E1. A buzzer

notifying sensor insertion avoids unnecessary loss of time waiting until concentration display fails and thus alleviates patient burden. Consequently, requests involving claims directed to this subject matter are patentable.

- XV. The case of the opponent on substantive patentability can be summarised as follows.

#### Main Request

The opponent referred to passages of document E1 disclosing the automatic features considered novel by the patent proprietor and dealt with in the proceedings before the opposition division. The opponent concluded the subject matter of claim 1 was not therefore novel.

#### "Buzzer" Claims

The buzzer known from document E1 would be suitable for notifying that a sensor has been inserted into the apparatus, so that this document removes novelty from this feature. Even if the feature were considered novel, the patent does not explain any advantages, the sole disclosure being that "A buzzer indicated by numeral 59 notifies that the sensor 30 has been inserted." Use of the known buzzer is immediately obvious for this purpose to the skilled person as an inventive step cannot be involved in using a buzzer for notifying steps of a process, this being normal practice for the skilled person. In the context of the positive view expressed in the decision under appeal, the selection of a buzzer amounts to no more than an obvious possibility which is not inventive.

Accordingly, independent claims in the auxiliary requests involving this feature cannot be considered to involve an inventive step.

XVI. The board gave its decision at the end of the oral proceedings.

### **Reasons for the Decision**

1. The appeal is admissible.

2. Sets of Claims

2.1 As can be seen from the facts and submissions above, the patent proprietor filed fifteen auxiliary requests each of which had an alternative form, which means, in other words, that effectively thirty auxiliary requests were filed. Each set of claims contained a number of independent claims. During the appeal proceedings, including the oral proceedings, the parties presented their cases in respect of all of the independent claims in these requests.

2.2 The patent proprietor pointed out that all of the auxiliary request contained the "buzzer" claim, remarking that if this claim were to fall, then all the auxiliary requests would fail in consequence. The board considers this analysis of the patent proprietor to be correct and refers, in this respect, to sections 2.2 of the reasons for decision T 745/03, taken by the present board in a different composition, the relevant part of which is worded as follows:-

"Generally speaking, it is up to a party to decide on presentation of its case, and, a party can be assumed to know in the final instance proceedings upon what requests it requires a decision. When filing several sets of claims, a party usually lists them in order of preference (auxiliary request I, II, etc). Parties tend to file the least limited claims as a main request and more limited versions as auxiliary requests. The idea behind this approach is that if a higher order request should fail, then a lower more limited request would still have a chance of success. ... in the present proceedings ... this changed ... to an approach which could more aptly be designated as "pick and mix", as independent claims present in higher order requests are also to be found in lower order requests in differing permutations of independent claims, some of which are exclusive of others. Apart from a possibility of giving an impression of fishing around for something patentable, this "pick and mix" approach can give rise to a situation where the final decision given does not refer to some independent claims because if even just one of the independent claims in a particular request repeated from a higher order request does not meet the requirements of the Convention, the particular request concerned fails for this reason without a decision being necessary on the other independent claims, whatever the board may think of the merits of those other independent claims."

2.3 Just the situation envisaged by the patent proprietor as well as that set out in the last sentence quoted in section 2.2 above arose in the present case. Although, the patent proprietor adopted an approach which

attempted to avoid the situation by making conditional requests for filing separate requests to each independent claim or to sets of claims without the "buzzer" claim, this approach was doomed to failure because it tried to "flush out" a pre-decision of the board in advance of defining its requests. Had the board cooperated with the approach, i.e. more or less told the patent proprietor to tailor the number and content of claims to the maximum permissible, it would have been detrimental to its impartiality, given that the proceedings were before the appeal instance in an inter partes case. In practice, the board hears the case before it decides, which means that a decision cannot be given until the parties have had a chance to comment. Cooperating with the patent proprietor would have meant this would not have been the case, as is illustrated by the other party justifiably protesting that it had difficulties in presenting its case before the board until the requests of the other side were definitively presented.

- 2.4 In fact, a kind of pressure might be considered exerted on the board to give a pre-decision without the other party having a fair hearing, because otherwise a further mass of requests would be filed, to be added to some 97 pages (already around four times the size of the original description and claims!) of the fifteen auxiliary requests already on file. Yet, leaving that aspect aside, despite having the opportunity to file further requests in writing and even twice during the oral proceedings, the patent proprietor did not take this opportunity. While the board cannot, given the acknowledged doubt expressed by the patent proprietor about the "buzzer" claim, know the reasoning behind

this, it could imagine a strategy therein, for instance, to defend the patent proprietor's interests for fear that as a consequence of filing a single independent claim in a higher order request, should it turn out acceptable, several different independent claims in lower order requests would be lost. Were this conjecture the case, it might tend to illustrate that an impression can be given that the lower order requests were not really fall back positions in the usual sense but involve some different positions, relating to subject matter referred to by the opponent as perhaps mentioned somewhere in the disclosure, but not as an invention, or referred to by the board as "fishing around". At all events, applying strategies, such as that conjectured, may have a place in day to day prosecution in pre-grant proceedings, but once the appeal instance in inter parties proceedings has been reached, the parties should be aware, especially near the end of those proceedings, that the case should be ripe for decision on the basis of the requests presented.

3. Main Request - Patentability

With respect to the subject matter of claim 1 of the patent as granted, only novelty of the features designated during the first instance proceedings as (d) and (e) is in dispute. This issue was dealt with by the opposition division and no fresh argument was introduced by the patent proprietor against the negative conclusion on novelty reached by the opposition division. The board has reviewed the novelty analysis made and the conclusion reached by the division and concurs with both. Accordingly, the board



reached the conclusion that the subject matter of claim 1 of the main request cannot be considered novel. The request therefore fails.

4. Auxiliary Requests - Patentability

4.1 All of the auxiliary requests contain the "buzzer" claim as set out in section XIII of the Facts and Submissions above. This claim differs from the not novel claim 1 of the main request solely by the feature relating to the buzzer. A buzzer "for notifying that a sensor has been inserted into the apparatus" is not disclosed in document E1 because, although a buzzer is shown in Figure 9 of documents E1 as controlled by the microprocessor and connected to the display, exactly what function the buzzer has, is not disclosed. Neither is the feature implicitly disclosed, because, as the opposition division indicated, the buzzer could notify other functions. The subject matter of the claim is therefore novel.

4.2 The buzzer is shown as block 59 in the block diagram in Figure 9 of the patent in dispute and it is only mentioned in one sentence in the description thereof as follows "A buzzer indicated by numeral 59 notifies that the sensor 30 has been inserted". The patent proprietor, in agreement with the opposition division, considered that the objective problem solved by the buzzer is to improve the device of document E1 by having means for informing a user that the sensor has been correctly inserted. The board can agree to this assessment of the problem to be solved.

- 4.3 The patent proprietor emphasised that the user, using apparatus of document E1, may, for one reason or another, not realise a sensor had not been inserted. The board does not understand this line of argument as meaning that realising, as such, that the sensor had not been inserted is not known to the user, because the patent proprietor went on to say, that the user of the apparatus of document E1 does realise insertion had not taken place when displaying the concentration of the objective substance in the sample liquid does not take place. In other words, the board has no reason to doubt that status of the sensor, in relation to its insertion, is a known matter of interest to the user.
- 4.4 The board agrees with the opponent that it is an obvious design matter to notify process steps of interest to a user, concluding therefore that just considering this a problem to be solved is not generally a credible basis for an inventive step. In the present case, the insertion step is just one of the process steps of interest and, accordingly, just notifying it to the user cannot be considered to involve an inventive step. On the implementation of the notification, both the patent proprietor and the opponent agreed that buzzers, as such, are well known, a conclusion with which the board fully concurs. This means that the properties of buzzers are well known, in particular, that an audible buzzer attracts attention, i.e. notifies. Accordingly, the board agrees with the patent proprietor, that use of the buzzer saves time. However, implementation of this notification does not contribute to inventive step, because no more than known buzzer properties are involved. Moreover, it is not necessary for there to be a "motivation" in

document E1 to make it obvious to the skilled person to apply the buzzer disclosed in a standard way to notify any particular step as, in agreement with the argument of the opponent, this is an obvious design matter. Notifying the insertion step with a buzzer is, therefore, considered obvious in view of general knowledge of its function and the presence of a buzzer in the device of document E1.

- 4.5 The opposition division saw an inventive step not so much in notification, but in that use of a buzzer could only be reached, in its view, by ex post facto analysis, as a number of other means could have been used. The problem with this viewpoint is that all the means mentioned by the opposition division, i.e. haptic means, mechanical resistance, a mark, display activation and the like, are themselves, in that generality, also obvious possibilities. The board therefore concurs with the view of the opponent, that it just a matter of obvious choice for the skilled person to select and use the already present buzzer within the framework of usual design measures. This is not to say that some special further constructional feature of any of the obvious possibilities might not be inventive, but speculation as to what any such special constructional feature might be, may indeed involve ex post facto analysis and goes beyond the scope of the present decision. At all events, this issue does not arise because the feature of the claim in dispute was dug out from a teaching of the patent in dispute amounting to only the single sentence given in section 4.2 above, concerning just standard known buzzer use without any special further possibility, for instance, special configuration to the CPU, at all.

- 4.6 The board was not therefore persuaded by the view of the patent proprietor or the opposition division as to inventive step, concluding, therefore, that the subject matter of the "buzzer" claim cannot be considered to involve an inventive step.
5. Accordingly, since all the auxiliary requests contain a claim directed to subject matter which is not patentable, they all fail. On the other hand, the case of the opponent is persuasive and its requests succeed.

## **Order**

### **For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar

The Chairman

M. Kiehl

A. G. Klein