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**Datasheet for the decision
of 13 September 2007**

Case Number: T 1873/06 - 3.5.01
Application Number: 01943736.7
Publication Number: 1326641
IPC: A61K 45/06, A61P 43/00
Language of the proceedings: EN

Title of invention:

System and methods for optimized drug delivery and progression
of diseased and normal cells

Applicant:

Optimata Ltd.

Opponent:

-

Headword:

Optimized drug delivery/OPTIMATA

Relevant legal provisions:

EPC Art. 52(2), (4), 84
EPC R. 45

Keyword:

"Mathematical method (no)"
"Presentation of information (no)"
"Diagnostic method (no)"
"Additional search - remittal (yes)"

Decisions cited:

T 0712/93, T 0258/03

Catchword:

If an application for which no search has been carried out, inter alia for lack of clarity of the claims, has been refused for the same reason, a board of appeal need only examine whether the claims fail to comply with the clarity requirement of Article 84 EPC to such an extent that it is not possible to carry out a meaningful search (reasons, point 4.2).



Case Number: T 1873/06 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 13 September 2007

Appellant:
(Applicant)

Optimata Ltd.
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Representative:

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Decision under appeal:

**Decision of the Examining Division of the
European Patent Office posted 5 July 2006
refusing European application No. 01943736.7
pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: S. Steinbrener
Members: S. Wibergh
G. Weiss

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division to refuse European patent application No. 01943736.7.
- II. The present application was filed as an international application. It then contained 509 claims. The EPO, acting as International Searching Authority, issued a "declaration of non-establishment of international search report" under Article 17(2)(a) PCT. The declaration stated that "in view of the large number and also the wording of the claims presently on file, which render it difficult, if not impossible, to determine the matter for which protection is sought, the present application fails to comply with the clarity and/or conciseness requirements of Article 6 PCT... to such an extent that a meaningful search is impossible".
- III. On entering the regional phase the appellants filed a set of amended claims 1 to 21. Claim 1 read:
- "A system for recommending an optimal treatment protocol for treating cancer using drugs, including chemotherapy, for an individual, said system comprising: a cancer system model; a plurality of treatment protocols for treating cancer using chemotherapy; a system model modifier, wherein said cancer system model is modified by the system model modifier based on parameters specific to the individual; and a selector to select an optimal treatment protocol from said plurality of treatment protocols based on the modified system model."

Claim 15 was directed to a method for recommending an optimal treatment protocol for treating cancer.

In the course of the examination proceedings these claims were maintained as main request.

IV. The examining division refused the main request pursuant to Articles 52(2),(4) and 84 EPC. Two auxiliary requests were refused both under Article 123(2) and Rule 86(4) EPC. No additional search had been performed.

V. Together with the grounds of appeal, the appellants filed a new set of amended claims 1-21 and requested that the decision be cancelled in its entirety and the application be remitted back to the examining division for search and examination on the basis of the new claims. Should anything else be contemplated by the Board, oral proceedings were requested.

VI. Claim 1 of this set of claims reads:

"A computer system for recommending an optimal treatment protocol for treating cancer using drugs, including chemotherapy, for an individual, said computer system comprising: a cancer model; a plurality of treatment protocols for treating cancer using drugs including chemotherapy; a model modifier configured to modify said cancer model based on parameters specific to the individual; and a selector to select an optimal treatment protocol from said plurality of treatment protocols based on the modified model."

Claim 15 is directed to a corresponding "computer-implemented method for recommending an optimal treatment protocol for treating cancer".

Reasons for the Decision

1. The reason for the refusal of the then main request was that claim 1 in the version before the examining division was not clear (Article 84 EPC) and that its subject-matter was a mathematical as well as diagnostic method and thus not patentable pursuant to Article 52(2),(4) EPC. The method of claim 15 was regarded as a presentation of information under Article 52(2) EPC.

2. *Exclusion under Article 52(2) EPC*

Claims 1-14 are now directed to a "computer system" and claims 15-21 to a "computer-implemented method". Thus all claims require the presence of a computer. Since a computer is a technical means all claims define "inventions" within the meaning of Article 52(1) EPC (cf decision T 258/03 - Auction method/HITACHI, OJ EPO 2004,575).

3. *Diagnostic methods (Article 52(4) EPC)*

The examining division was of the opinion that the system of claim 1 was, because of the feature "a plurality of treatment protocols for treating cancer using chemotherapy", a method of therapy. Whether or not this objection was justified with respect to the claims before the examining division, it can in any

case not be raised against the present amended claim 1, which is directed to a technical system and not a method (cf T 712/93, point 3, not published in OJ EPO).

4. *Clarity (Article 84 EPC)*

4.1 The examining division objected to the expressions "system for recommending an optimal treatment protocol", "cancer system model", "system model modifier" and "selector" in claim 1 as unclear "to the point of being incomprehensible" (decision, p. 2). With slight modifications these expressions remain in the present claim 1. The appellants have argued that all these terms are clear for the skilled person.

4.2 The Board first notes that the examining division has raised the objection of lack of clarity without a search having been performed, *inter alia* for the same reason. Rule 45 EPC stipulates that a search division should declare that search is not possible (only) if the application does not comply with the provisions of the EPC to such an extent that it is not possible to carry out a meaningful search. It follows from this rule that an application for which a search has not yet been carried out should not be refused because of minor obscurities in the claims. In such cases the examining division should instead perform an additional search pursuant to the "Guidelines for Examination in the European Patent Office" C-VI, 8.5. The Board will therefore only examine whether claim 1 fails to comply with the clarity requirement of Article 84 EPC to such an extent that it is not possible to carry out a meaningful search.

4.3 In the Board's view the claims are well understandable. For example, a "system for recommending an optimal treatment protocol" is exactly that, namely a system for recommending an optimal treatment protocol. The generality of the expressions is not a matter of clarity. Thus, the examining division's objection under Article 84 EPC is not justified, at least at this stage of the examination.

5. It follows that the claims fulfil the requirements of the EPC to such an extent that it should be possible to carry out a search. The application is therefore remitted to the examining division for an additional search to be performed and the substantive examination to be continued.

Since the appellants' main request is allowed, the auxiliary request for oral proceedings need not be considered.

6. The present application is now in its seventh year. The Board has therefore treated it with priority and assumes that the examining division will do the same.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

P. Cremona

S. Steinbrener