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**Datasheet for the decision
of 22 March 2012**

Case Number: T 0106/09 - 3.3.08

Application Number: 95926253.6

Publication Number: 777744

IPC: C12Q 1/10, C12M 1/16,
C12M 1/26, C12N 1/20

Language of the proceedings: EN

Title of invention:

Culture medium and device for detection and enumeration of
Enterobacteriaceae

Patentee:

MINNESOTA MINING AND MANUFACTURING COMPANY

Opponent:

BioMérieux

Headword:

Culture medium/MINNESOTA

Relevant legal provisions:

EPC Art. 54, 56, 83, 84, 123(2)(3)

Keyword:

"Sole request on file: compliance with the requirements of the
EPC (yes)"

Decisions cited:

T 0190/99

Catchword:

-



Case Number: T 0106/09 - 3.3.08

D E C I S I O N
of the Technical Board of Appeal 3.3.08
of 22 March 2012

Appellant: MINNESOTA MINING AND MANUFACTURING COMPANY
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Respondent: BioMérieux
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 27 October 2008
revoking European patent No. 0777744 pursuant
to Article 101(3)(b) EPC.

Composition of the Board:

Chairman: M. Wieser
Members: T. J. H. Mennessier
C. Heath

Summary of Facts and Submissions

- I. The patent proprietor (appellant) lodged an appeal against the decision of the opposition division dated 27 October 2008, whereby European patent No. 0 777 744, which had been granted on European application No. 95 926 253.6 (published under the international publication No. WO 96/06183), was revoked. Basis for the revocation was the main and the second auxiliary requests filed at the oral proceedings held on 16 September 2008 (the first auxiliary request filed on the same date had not been admitted into the proceedings).
- II. The main request was refused for reasons of lack of novelty (Article 54 EPC), and the second auxiliary request for reasons of lack of inventive step (Article 56 EPC).
- III. The patent had been opposed by one opponent (respondent) on the grounds as set forth in (i) Article 100(a) EPC that the invention was neither new nor inventive, (ii) Article 100(b) EPC and (iii) Article 100(c) EPC.
- IV. The appellant filed its statement setting out the grounds of appeal. A new main request and six auxiliary requests were attached thereto. In addition, an experimental report was submitted.
- V. The respondent replied with a letter dated 28 September 2009. It argued that the requests then on file did not comply with the requirements of Article 123(2) EPC and were unclear (Article 84 EPC). Furthermore, claim 1 of the main request was considered to lack novelty

- (Article 54 EPC). In support of the respondent's views, two experimental reports were submitted.
- VI. Together with a letter dated 19 July 2010, the appellant filed a new main request and a further experimental report.
- VII. With a letter dated 22 December 2010, the opponent argued that claim 1 of the main request of 19 July 2010 did not comply with the requirements of Article 123(3) EPC and lacked novelty. In support of its views, the respondent also filed two further experimental reports.
- VIII. The Board issued a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) expressing preliminary and non-binding views, to which the appellant replied by filing, under cover of a letter dated 22 February 2012, a main and 14 auxiliary requests which replaced all the previous requests.
- IX. Both parties attended the oral proceedings which took place as scheduled on 22 March 2012 and at which the appellant made the 10th auxiliary request of 22 February 2012 its main and sole request, and withdrew all the other requests then on file.
- X. The request consisted of seven claims of which claim 1 read as follows:
- "1. A method of detecting and enumerating Enterobacteriaceae in a sample comprising the steps of adding an aliquot of a sample in an aqueous diluent to a culture medium containing selected amounts of glucose,

pH indicator and buffer to prevent colored indicator zones from excessively diffusing in the medium, adjusting the pH of the aliquot to 6.5-7.5, growing Enterobacteriaceae in the presence of the culture medium, **pH indicator changing color in response to organic acids produced by growing Enterobacterioaceae colonies**, and detecting the color change of the pH indicator in the medium, wherein the sample is added to a thin film containing the medium using a device having a self-supporting, waterproof substrate, a foam spacer and a transparent cover sheet, wherein the culture medium is coated on the waterproof substrate and then dried." (emphasis in bold added by the Board)

Claims 2 to 7 were dependent on claim 1 and directed to particular embodiments thereof.

Claim 1 differed from claim 2 of each of the requests on which the decision under appeal is based only in that it additionally contained the newly added phrase as emphasised by the Board (see above).

XI. The following document is referred to in the present decision:

(D4) Handbook of Microbiological Media, R. M. Atlas and L. C. Parks Ed., CRC press, London, 1993, pages 10 and 977

XII. The appellant (patent proprietor) requested that the decision under appeal be dismissed and the patent be maintained on the basis of claims 1 to 7 of the request filed at the oral proceedings held on 22 March 2012.

XIII. The respondent (opponent) made no request.

Reasons for the decision

Admissibility of the claim request filed at the oral proceedings held on 22 March 2012

1. Claims 1 to 7 are identical to the claims of auxiliary request 4 filed with the statement of grounds, which are almost identical to claims 2 to 6, 8 and 9 as granted - main request in opposition (see point 8 *infra*).
2. Therefore, the present claim request represents an amendment to the appellant's case which may be admitted and considered at the Board's discretion (see Article 13(1) RPBA). In view of the identity of the claims with claims filed at the onset of the appeal proceedings, the Board exercising its discretion decides to admit the claim request into the proceedings.

Requirements of Article 123(2) EPC

3. The method of claim 1, except the technical feature "*pH indicator changing color in response to organic acids produced by growing Enterobacteriaceae colonies*" is disclosed in claim 8 and 9 as filed (see the international application WO 96/06183). The said additional feature is found on page 3, lines 6 to 7 as filed.
4. A sample as referred to in the method of claims 2 and 4 is disclosed in, respectively, claims 2 and 4 as filed.

5. A culture medium as referred to in the method of claims 3 and 5 is disclosed in, respectively, claims 3 and 5 as filed.
6. A pH indicator as referred to in the method of claims 6 and 7 is disclosed in, respectively, claims 6 and 7 as filed.
7. Therefore, the Board reaches the conclusion that the claim request meets the requirements of Article 123(2) EPC.

Requirements of Article 123(3) EPC

8. Due to the limiting effect of the additional feature, which is the only difference between present claim 1 and claim 2 as granted, it does not result in the patent being amended in such a way as to extend the protection it confers. This conclusion applies de facto to dependent claims 2 to 7 as their wording is encompassed in claims 3 to 6, 8 and 9 as granted.
9. Therefore, the Board reaches the conclusion that the claim request meets the requirements of Article 123(3) EPC.

Requirements of Article 84 EPC

10. The amendment introduced in claim 2 as granted to arrive at present claim 1 (see point 8 *supra*) is clear and supported by the description. Therefore, claim 1 is considered to meet the requirements of Article 84 EPC.

Requirements of Article 83 EPC

11. In its preliminary communication attached to the summons for oral proceedings (see points 11 to 13 thereof), the Board had expressed some doubts as regards the composition of the culture medium to be used in a method according to claim 1. Having reviewed the file in depth, the Board is now convinced that a skilled person willing to understand claim 1 and trying to arrive at an interpretation which is technically meaningful and takes into account its entire disclosure (cf. decision T 190/99 of 6 March 2001) will arrive at the conclusion that a culture medium as referred to in claim 1, even if not explicitly mentioned, contains the necessary ingredients which will favour the growth of Enterobacteriaceae by inhibiting the growth of other bacteria possibly present in the sample to be tested. He will also conclude that a buffer, as referred to in claim 1 is, as generally accepted by those working in the field of chemistry and as illustrated in the examples, an aqueous solution consisting of a mixture of a weak acid and its conjugate base or a weak base and its conjugate acid. Such a buffer may consist of monobasic potassium phosphate and dibasic potassium phosphate as explicitly referred to in paragraphs [0010] and [0011] of the patent specification.

12. Consequently, the Board is satisfied that the method according to claim 1 is sufficiently disclosed. The conclusion extends to the subject-matter of dependent claims 2 to 7 and, therefore, the request meets the requirements of Article 83 EPC.

Requirements of Article 54 EPC

13. In its decision, the opposition division did not take position as to novelty regarding the method claims of the requests then on file. The Board is satisfied that none of the cited prior art documents discloses a method according to claim 1 and, therefore, reaches the conclusion that the request meets the requirements of Article 54 EPC.

Requirements of Article 56 EPC

14. In its decision, the opposition division also did not take position as to inventive step regarding the method claims of the requests then on file.
15. Document D4, describing the 'violet red bile agar', a medium to be used for the isolation and cultivation of members of the Enterobacteriaceae family (see page 977), is the closest state of the art (as already mentioned in point 16 of the aforementioned Board's communication). Starting from document D4, the technical problem faced by the skilled person is the provision of a means which permits to control the diffusion of the colour indicator around the bacterial colonies.
16. As a solution to said problem the patent provides a method according to claim 1, i.e. a method which is so featured that it involves the use of a pH indicator in combination with selected amounts of glucose in presence of a buffer. As illustrated in the experimental part of the description which reports assays where a medium was tested with either various

concentrations of both glucose and a pH indicator (see Example 1) or with different combinations of buffers and pH indicators (see Example 2), the problem has credibly been solved.

17. The method according to claim 1 cannot be derived in an obvious manner from the disclosure in document D4, either taken alone or in combination with any other prior art document on file.
18. Therefore, the Board reaches the conclusion that the method of claim 1 involves an inventive step. This conclusion extends to dependent claims 2 to 7. Consequently, the request as a whole meets the requirements of Article 56 EPC.

Conclusions

19. As the request meets the requirements of the EPC, the Board concludes that the patent may be maintained on its basis.
20. The Board is satisfied that, by filing amended description pages 2, 3, 3a and 4 to 9 at the oral proceedings, the description was satisfactorily amended in accordance with the 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 maintain the patent in the following version:

claims 1 to 7 of the request filed at the oral proceedings held on 22 March 2012,

description pages 2, 3, 3a and 4 to 9 filed at the oral proceedings held on 22 March 2012, and

Figure 1 of the patent as granted.

The Registrar

The Chairman

A. Wolinski

M. Wieser