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**Datasheet for the decision
of 20 February 2013**

Case Number: T 0378/09 - 3.3.02

Application Number: 03773259.1

Publication Number: 1549224

IPC: A61B 10/00

Language of the proceedings: EN

Title of invention:

Sample collection system with caspase inhibitor

Applicant:

Becton Dickinson and Company

Headword:

Collection system with caspase inhibitor/BECTON DICKINSON

Relevant legal provisions:

EPC Art. 111, 123(2)

Keyword:

"Claim 1 of request: added subject-matter (no); wording derived directly and unambiguously from original application"

Decisions cited:

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Catchword:

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Case Number: T 0378/09 - 3.3.02

D E C I S I O N
of the Technical Board of Appeal 3.3.02
of 20 February 2013

Appellant:
(Applicant)

Becton Dickinson and Company
1 Becton Drive
Franklin Lakes
NJ 07414-1880 (US)

Representative:

von Kreisler Selting Werner
Deichmannhaus am Dom
Bahnhofsvorplatz 1
D-50667 Köln (DE)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 26 September 2008
refusing European patent application
No. 03773259.1 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: U. Oswald
Members: H. Kellner
R. Cramer

Summary of Facts and Submissions

- I. European patent application No. 03 773 259.1, based on PCT/US2003/032261 and published as WO 2004/032750, was refused by a decision of the examining division on the basis of Article 97(2) EPC for lack of inventive step under Article 56 EPC.

The wording of claim 1 of the single request before the examining division was:

"Use of a stabilizing agent comprising at least one caspase inhibitor in the reservoir portion of a container of an apparatus for receiving a biological sample for inhibiting cell apoptosis in said biological sample immediately upon collection of said biological sample."

- II. The applicant lodged an appeal against the decision of the examining division and filed grounds of appeal together with a new main and an auxiliary request.
- III. Oral proceedings took place on 20 February 2013 in the presence of the appellant's representative.

During the oral proceedings, the requests submitted in writing were replaced by one single set of claims as a main request. Claim 1 of this main request reads:

"Use of an apparatus for containing a whole blood sample, comprising a container having a reservoir portion for receiving said whole blood sample, said reservoir portion containing a stabilizing agent comprising a caspase inhibitor for inhibiting DNA

fragmentation in said whole blood sample by admixing said stabilizing agent with said whole blood sample immediately on collection of said whole blood sample."

- IV. The appellant requested that the decision under appeal be set aside and that the case be remitted back to the department of first instance for further prosecution on the basis of the main request filed during the oral proceedings.

Reasons for the Decision

1. The appeal is admissible.
2. The filing of the amended claims of the single main request during the oral proceedings on 20 February 2013 is recognised as a *bona fide* attempt to respond to the arguments discussed during the oral proceedings. This request is therefore admitted into the proceedings.
3. *Article 123(2) EPC (added subject-matter)*

In the following, references to the "application as originally filed" refer to the PCT publication WO 2004/032750 or equally to PCT/US2003/032261 as published.

The subject-matter of claim 1 of the main request can be derived directly and unambiguously from claim 1 of the application as originally filed, in connection with page 8, line 22 to page 9, line 2 together with page 2, lines 7 to 10.

In claim 1 of the new main request the full wording of original claim 1 is connected with the full wording of a passage in the original description, a passage relating to the "present invention" and not to "another" or any "further" or "additional" embodiment (see lines 22 and 25 to 26 on page 8 of the application as originally filed).

The stabilising effect by "inhibiting cell apoptosis" contained in claim 1 before the examining division is now represented by "inhibiting DNA fragmentation", the latter according to page 2, lines 7 to 10 of the application as originally filed being one characterising feature of apoptosis. This characterisation is in accordance with the common general knowledge of the skilled person.

Consequently, there are no objections under Article 123(2) EPC with respect to claim 1 of the main request.

4. Although the EPC does not guarantee the parties an absolute right to have all the issues in a case considered by two instances, it is recognised that any party may be given an opportunity for two readings of the important elements of a case.

In the present case, the subject-matter of claim 1 of the current main request has changed completely in comparison with the subject-matter decided on by the examining division. This claim 1 has been found to formally meet the requirements of Article 123(2) EPC. Thus, a new situation has been created with respect to

the requested subject-matter, which should now be examined on its merits.

The board has therefore decided to exercise its discretion under Article 111 EPC, and remits the case to the first instance for further prosecution on all formal and substantive aspects of the EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted back to the department of first instance for further prosecution on the basis of the main request filed during the oral proceedings.

The Registrar:

The Chairman:

N. Maslin

U. Oswald