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**Datasheet for the decision  
of 12 January 2010**

**Case Number:** T 0950/09 - 3.4.02

**Application Number:** 05256976.1

**Publication Number:** 1785722

**IPC:** G01N 25/20

**Language of the proceedings:** EN

**Title of invention:**

Microbial, viral and mammalian susceptibility to agents that affect cell growth and metabolism, and compatibility of compounds

**Applicant:**

Stratos Bio Ltd.

**Opponent:**

-

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 108

EPC R. 99(2)

RPBA Art. 12(2)

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

-

**Keyword:**

"Admissibility (no)"

**Decisions cited:**

T 1382/04

**Catchword:**

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Case Number: T 0950/09 - 3.4.02

**D E C I S I O N**  
of the Technical Board of Appeal 3.4.02  
of 12 January 2010

**Appellant:** Stratos Bio Ltd  
9 Rue Charles Humbert  
CH-1205 Geneva (CH)

**Representative:** -

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 16 January 2009  
refusing European application No. 05256976.1  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** A. G. Klein  
**Members:** F. Maaswinkel  
C. Rennie-Smith

## Summary of Facts and Submissions

- I. The appeal is against the decision of the Examining Division dated 16 January 2009 which refused the European patent application No. 05256976.1 entitled "Microbial, viral and mammalian susceptibility to agents that affect cell growth and metabolism, and mode of action of compounds".
- II. The Examining Division refused the application on the following grounds. It held that the applicant's first request containing 16 claims related to three inventions which were not so linked as to form a single general inventive concept, contrary to Article 82 EPC. While the applicant's second request, containing 11 claims, did meet the requirements of Article 82 EPC, it did not meet the requirements of Article 52(1) EPC because the subject-matter of the independent method claim 1 did not involve an inventive step over document D1 in the sense of Article 56 EPC, and because the subject-matter of the independent apparatus claim 11 was not novel over each of documents D2 to D5 in the sense of Article 54(1) and (2) EPC.
- III. The decision under appeal contained several paragraphs setting out the Examining Division's reasoning which can be summarised as follows:
- (a) As regards unity of invention of the first request, the common concept linking the independent method claims 1, 6 and 8 was the use of calorimetry for detecting heat generated in a biochemical reaction. Since however that common concept was not novel in view of each of D2, D3

and D5, there was no technical relationship involving at least one special technical feature in the sense of Rule 44(1) EPC between the subject-matter of those three independent claims. (See point 3.1.2, first paragraph, of the decision.)

(b) The applicant's argument that "both bacterial growth and antibiotic susceptibility must be measured simultaneously, quantitatively and in Equimolar amounts to give meaningful results" was not convincing for three reasons:

(i) none of the three independent method claims refers to "bacterial growth" or "antibiotic susceptibility";

(ii) even if claim 1 was considered restricted to measuring bacterial growth and claims 6 and 8 to measuring antibiotic susceptibility, there was no indication in any of the three claims that the measurement was performed simultaneously, quantitatively and in Equimolar amounts;

(iii) although the results obtained by the methods of each of the three claims might be used together to advantage, each of the three methods could be carried out independently of the other two. (See point 3.1.2, second paragraph, of the decision.)

(c) The second request (from which claims 6 and 8 of the first request and their immediately dependent

claims were omitted) complied with Article 82 EPC (see point 3.2.1 of the decision).

- (d) The method of claim 1 of the second request differed from that disclosed in document D1 only in that the microorganism growth is detected by calorimetry. Starting from D1, the problem to be solved was providing an alternative way of detecting micro-organism growth. The solution of claim 1 was not inventive as it was already known (e.g. from D2) that microorganism growth can be detected by calorimetry and the skilled person would therefore regard it as a normal option to use instead of the technique of D1. (See point 3.2.2, second paragraph, of the decision.)
  
- (e) The applicant's assumption that the method of D1 does not cover "gram positive organisms specifically, specific quantitative growth regimens, specific media, discrimination between different species of bacteria viruses or cancers", "is not quantitative and has not the ability to discriminate between different mode of action of antibiotica" and "is extremely slow", was irrelevant since such features are not defined in claim 1 (see point 3.2.3(i) of the decision).
  
- (f) Each of documents D2 to D5 anticipated claim 11 of the second request by disclosing a kit suitable for use in the method of claim 1. A "kit for carrying out" is construed to mean a "kit suitable for carrying out"; that in considering the novelty of a claim to a physical entity, its non-distinctive characteristics are disregarded; and

that the patentability of a method claim does not necessarily imply the patentability of a claim for apparatus to carry out that method - a known apparatus does not become new each time it is used for a new method. (See point 3.2.2, third paragraph, of the decision.)

(g) The applicant argued that the microcalorimeter of D2 was very insensitive but neither gave any reasons for that assertion nor explained why that microcalorimeter would not be suitable to carry out the method of claim 1 (see point 3.2.3(ii) of the decision.).

(h) The decision also drew attention to the fact that the amendments filed by the applicant with its letter of 28 October 2008 introduced subject-matter extending beyond the content of the patent application as filed contrary to Article 123(2) EPC (see point 5 of the decision).

IV. The appellant (the applicant) filed a notice of appeal in an undated manuscript letter received at the EPO on 13 March 2009. The appeal fee was paid on the same date. After identifying the application and the appellant's name and address, the notice of appeal stated:

*"Stratos Bio Limited appeals the decision on grounds of meeting the requirements of Article 82 EPC by amending claims 1-16 accordingly and Article 52(1) EPC.*

*We will also forward argumentation to justify claim 11.*

*The subject-matter introduced 28.10.2008 which goes beyond the content of the application is only an explanation of the figures and thus in no way different to the original application. We withdraw it immediately."*

V. The statement of grounds of appeal was filed in the form of a further manuscript letter dated 20 March 2009, received at the EPO on 2 April 2009 and which read as follows:

*"Hereby the amended claims according to your letter dated 16.1.2009.*

*I also include proof of payment for the appeal of €1120.*

*I have already withdrawn pages 1-7 describing the figures. The information is contained in the patent application and is thus a summary but has been considered new subject matter by the commission. (It appears the appellant used the word "commission" to indicate the EPO.)*

*The claims have been amended to contain*

*1. The issues considered missing on p 3-5 of your rejection*

*2. Specifications have been added for the microcalorimeter used in the application not achieved by anybody else in the world."*



- VI. Enclosed with that letter were copies of page 2 of EPO Form 2007 (the second page of the Examining Division's formal decision to refuse the patent application), a copy of a print-out indicating payment of the appeal fee, and three sets of claims all numbered 1 to 16. These apparently differ from each other in that in the first set several claims have barely legible handwritten amendments marked on what is otherwise the set of claims considered in (and annexed to) the decision under appeal; in the second set some at least of those amendments have been included but there remain some smudges and handwritten markings which make the exact text unclear; and the third set is (in both senses) a "clean" copy of the second.
- VII. On 3 September 2009 the Board sent the appellant a communication containing its provisional and non-binding opinion expressly limited to the issue of the admissibility of the appeal. With reference to comments on the substantiation of the appeal in essentially the same terms as points 2 to 4 of the Reasons below, the communication stated that the Board was of the view that the appeal was likely to be rejected as inadmissible. The purpose of the communication was to give the appellant an opportunity to present arguments to the contrary. Any written submission in reply to the communication was to be received by the Board no later than two months after the deemed date of receipt of the communication (i.e. ten days after the date of posting - see Rule 126(2) EPC). In the absence of any reply within that time limit, the pending patent application would be deemed to be withdrawn (see Rule 100(3) EPC).

The Board added two further observations in the communication in case the appellant (which, the Board noted, was no longer represented professionally) was not aware of the full implications of its present position. First, the apparent inadequacies in the substantiation of the appeal could not be made good by directing the Board's attention to other materials filed at earlier stages of the examination proceedings. This was because the appellant's case must be apparent from the appeal as filed without the need to consider the file further. Moreover, to allow reference to be made out of time to previously filed materials would mean allowing grounds of appeal to be filed in part after the time limit for doing so had expired on 26 May 2009. Second, by reason of that time limit also, the Board could not consider any additional substantiation of the appeal filed out of time: the most the appellant could do was to seek to persuade the Board that the notice of appeal and grounds of appeal filed before 26 May 2009 did in fact contain a sufficiently ascertainable case.

VIII. The communication of 3 September 2009 was posted to the address in Basel given by the appellant and returned marked "not collected" by the Swiss postal service. After a telephone conversation between the Board's registrar and the signatory of the appellant's letters, the communication was re-dated and re-sent to the appellant on 29 September 2009. The time for replying to the communication thus expired on 9 December 2009 (two months after the deemed date of receipt which was ten days after the date of posting - see Rule 126(2) EPC).

IX. The appellant did not reply as such to the communication by the time limit of 9 December 2009 but did send a letter dated 29 November 2009 addressed "To the Head of the Patent Office" which read as follows:

*"Regarding appeal number T 0950/09-3402*

*Dear Sir.*

*I am greatly disappointed with the communication from the board of appeal; which seem biased as I dismissed the poor work of [.....] on the grounds of discrimination of me as a Danish citizen. I hope that this is not the case for the patent office and must insist on unbiased evaluation of the patents. [The text omitted referred to the patent attorneys who had represented the appellant until they withdrew by a letter of 26 June 2007.]*

*The board only commented on a handwritten follow note and did not bother to review the altered claims that clearly distinguish the patent 05256976.1. from other methods and specifically to the cited passage in D1.*

*I.e. claim 1 addition: Using a micro calorimeter with a baseline stability of 0.2 uW and a sensitivity of 02 uW and its susceptibility to antibiotics or anti organism agents simultaneously and quantitatively in a timeframe of 2 to 12 hours.*

*Claim 2 addition;*

*To determine these micro organisms susceptibility to antibiotics by applying equimolar amounts to the sample*

*Claim 6.8.13 and 16 additions;*

*using a micro calorimeter with a baseline stability of 0.2 uW and a sensitivity of 0.2 uW (Emphasis as in original letter)*

*They did not review the accompany letter from October 2008 that contained the argumentation for allowing the patent and should be reviewed together with the final changes submitted in March 2009.*

*Furthermore as required by the patent office I submitted the pages that had been changed and iii addition the original pages with the markings of alterations which they obviously did not bother to compare or even read.*

*The people evaluating the patent seem to have no experience in evaluating either instrument specifications or bacteriology which may explain the extraordinary difficulty in their understanding of the subject and their totally irrelevant comments.*

*I demand a re-evaluation by an expert in instrument development and bacteriology."*

- X. Enclosed with the letter were a further set of claims with various handwritten markings of which at least

some appear to indicate words have been crossed out, a copy of a letter to the Examining Division of 28 October 2008 substantial passages of which appear to be taken from the patent application itself, and a copy of Form 3346 (the covering letter accompanying the Board's communication).

XI. No request as such is specified in either the notice of appeal or the grounds of appeal but by implication the appellant requests that the decision under appeal be set aside and that a patent be granted on the basis of amendments referred to in the grounds of appeal. There is no request for oral proceedings.

XII. The fifth renewal fee of €700 in respect of the pending patent application fell due on 30 November 2009. The sum of €326.27 was paid by the appellant on 25 November 2009. On 9 December 2009 the EPO sent the appellant a standard form communication (Form 2525) drawing its attention to the under-payment and observing that the renewal fee could still be validly paid if the unpaid balance and the additional fee of 50% of the renewal fee (i.e. a total of €723.73) are paid by the last day of the sixth calendar month after the due date (i.e. by 31 May 2010).

### **Reasons for the Decision**

1. While the appellant's letter to the "Head of the Patent Office" makes no attempt to answer the Board's communication or to deal in any other manner with the question of the admissibility of the appeal, the Board has decided to consider it and to issue this decision

rather than just treat the patent application as deemed to be withdrawn as would be possible in the absence of a reply to the communication, as indeed the appellant was warned both in the communication itself (see point VII above) and in the EPO form 3346 under cover of which it was sent. There are two reasons for doing this. First, although the appellant's letter of 29 November 2009 does not make any substantive response to the Board's communication, it does at least indicate that the appellant has not lost interest in its patent application. Accordingly, although the salient facts are slightly different, the position is comparable with that described in T 1382/04 of 30 July 2009 (see point 1 of the Reasons), and the Board has the power to issue a decision on the appeal. Second, this decision will hopefully ensure that the appellant (which is no longer represented professionally and is apparently unfamiliar with European patent proceedings) understands that, by virtue of this decision dismissing the appeal, the decision of the Examining Division to refuse the patent application becomes final and therefore no purpose would be served by payment of the unpaid part of the fifth renewal fee (see point XII above).

2. The appellant complied with the time limits for filing the notice of appeal and written statement of grounds of appeal and paying the appeal fee (see Article 108 EPC). However, the appeal is inadmissible as regards the requirement of substantiation. Article 108, third sentence, EPC provides that, within four months of the notification of the decision in question, an appellant must file a statement setting out the grounds of appeal. In the present case the decision under appeal was dated

- 16 January 2009, the notification was deemed to be delivered ten days later (see Rule 126(2) EPC), and the four month period from then ended on 26 May 2009.
3. Rule 99(2) EPC requires an appellant to indicate in its statement of grounds the reasons for setting aside the decision impugned, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based. Additionally, Article 12(2) of the Rules of Procedure of the Boards of Appeal ("RPBA" - see Supplement to OJ EPO 1/2009, page 45) requires that a statement of grounds of appeal shall contain a party's complete case and set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on. Similarly, the case-law of the Boards of Appeal has consistently considered it to be incumbent on an appellant to file, by the end of the four month time limit, a statement of grounds which (either in itself or together with the notice of appeal) presents the Board with the appellant's case why it considers the decision under appeal to be wrong (see generally "Case Law of the Boards of Appeal of the European Patent Office", 5th edition 2006, Section VII.D.7.5 "Statement of grounds of appeal", pages 621 to 625).
  4. Having compared the contents of the notice of appeal (see point IV above) and the statement of grounds of appeal (see point V above) with the content of the decision under appeal (see point III above), the Board cannot ascertain from the notice or grounds of appeal any substantive arguments or reasons why the appellant disagrees with the reasons for rejecting its patent

application or, apart from some unexplained amendments to the claims, how it proposes to overcome those objections. In particular the Board notes the following.

- (a) The appellant does not say why the Examining Division's view that the first request did not comply with Article 82 EPC was wrong.
- (b) The appellant does not say why the Examining Division's view that the method claim 1 of the second request was not inventive was wrong.
- (c) The appellant does not say why the Examining Division's view that the apparatus claim 11 of the second request was anticipated by each of D2 to D5 was wrong, let alone indicate how claim 11 might differ from any of those items of prior art.
- (d) The grounds of appeal say "Hereby the amended claims according to your letter dated 16.1.2009" but give no further information. The words "according to your letter dated 16.1.2009" (i.e. the decision under appeal) are of no assistance at all - they simply direct the reader to the decision without any indication how the amendments relate to the objections therein. The later statement in the grounds of appeal that the claims have been amended to contain "the issues considered missing on p 3-5 of your rejection" adds nothing since those pages contain all the substantive reasoning of the decision under appeal. The further statement that the claims have also been amended to contain "specifications for the microcalorimeter used in the application" at



least appears to refer to certain amendments (rather than all amendments in general) but no attempt is made to indicate which of the Examining Division's objections is thereby addressed. The Board notes that claim 16 (corresponding to claim 11 of the second request before the Examining Division) has apparently been amended but there is no explanation at all as to how that may overcome the Examining Division's objections. Indeed, there is no reference to, let alone explanation of, any one amendment at all.

- (e) As regards the Examining Division's objection under Article 123(2) EPC, the notice of appeal and the grounds of appeal say respectively that the relevant material is or has already been withdrawn but no further information is given and no amended text has been filed.
- (f) After referring to the unexplained amendments to the claims, the grounds of appeal state that the added specifications have not been achieved by anybody else in the world. However, in the absence of any reference to the decision under appeal or to prior art cited therein, this is no more than a mere assertion which does not make any case against the decision.
- (g) There is no other statement whatsoever which can be read as argument against the reasons set out in the decision under appeal. The notice of appeal says "We will also forward argumentation to justify claim 11". However, no indication is given as to what that argumentation may be and, while

the grounds of appeal refer in the most general way to the amended claims, there is no other reference in either the notice of appeal or the grounds of appeal to any individual claim.

5. The Board's communication quite specifically stated that it was confined to the issue of admissibility of the appeal and was intended to give the appellant an opportunity to present arguments on that issue. Unfortunately, the appellant's letter of 29 November 2009 is not only not addressed to the Board but also shows no attempt to explain how the notice of appeal and grounds of appeal contain a sufficiently ascertainable case. The appellant's complaints that the Board is biased and not expert in its evaluation of the case is irrelevant since no evaluation of the substance has yet taken place in the appeal proceedings and cannot take place unless or until the admissibility of the appeal has been established. Similarly, the complaint that the Board "did not bother to review the altered claims" is wholly misconceived: as the Board's communication observed to the appellant, its appeal as presented did not explain at all the claims filed (in three separate but unexplained versions) with the statement of grounds of appeal (see point 4(d) and (e) above).
  
6. The letter of 29 November 2009 also complains that the Board "did not review the accompany letter from October 2008" which is also irrelevant. That letter formed no part of the appeal and no copy of it was enclosed with either the notice or grounds of appeal. The only reference made to it was the oblique comment in the notice of appeal about withdrawal of "the subject-

matter introduced 28.10.2008" (see points IV and 4(e) above). It must be highly questionable whether any more particularized reference would have made any difference to the admissibility of the appeal since the letter of October 2008 contained submissions which were considered by the Examining Division (see points 1.6 and 2 of its decision) and formed the basis of its decision to refuse the patent application. To have repeated those submissions on appeal, rather than to present submissions as to why the decision under appeal was wrong, would not have assisted the appellant. The appellant is somewhat more correct in saying the Board "only commented on a handwritten follow note" since the only submissions made by the appellant on appeal were in the minimal "handwritten notes" forming its notice of appeal and statement of grounds of appeal which thus formed the only submissions the Board could consider in the context of admissibility.

7. Taken as a whole, the appellant's letter of 29 November 2009 shows that it expected the Board to piece together its case from a number of documents including earlier correspondence and versions of claims. That however is exactly the exercise the Board is not required to undertake because the appellant is required to substantiate its case adequately in its grounds of appeal (see points 2 and 3 above). In the circumstances, the only possible conclusion is that the appeal is unsubstantiated and therefore does not comply with Article 108 EPC, Rule 99(2) EPC and Article 12(2) RPBA (see points 3 and 4 above). Accordingly the appeal is inadmissible.

**Order**

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

The appeal is rejected as inadmissible.

The Registrar:

The Chairman:

M. Kiehl

A. Klein