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**Datasheet for the decision
of 24 November 2011**

Case Number: T 1251/09 - 3.4.02
Application Number: 05010660.8
Publication Number: 1577668
IPC: G01N33/487, C12Q1/00, G01N27/30
Language of the proceedings: EN

Title of invention:

Improved elektrochemical biosensor test strip

Applicant:

Roche Diagnostics Operations, Inc.

Relevant legal provisions:

EPC Art. 123(2), 76(1)

Keyword:

No extension of the amended divisional application beyond the content of the divisional application as originally filed and the earlier (parent) application as originally filed.

Decisions cited:

Catchword:



Case Number: T1251/09 - 3.4.02

D E C I S I O N
of the Technical Board of Appeal 3.4.02
of 24 November 2011

Appellant: Roche Diagnostics Operations, Inc.
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted 13 January 2009
refusing European patent application No.
05010660.8 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: A. Klein
Members: M. Stock
D.S. Rogers

Summary of Facts and Submissions

- I. The applicant (in the following: "the appellant") has appealed against the decision of the examining division refusing European patent application number 05010660.8, published as EP 1 557 668 A2, which is a divisional application from the earlier application 98960645.4, published as international application WO99/30152, in the following: "the parent application".

The examining division reasoned in particular that the subject-matter of claim 1 according to the main request and an auxiliary request ("auxiliary request 1") then on file infringed the requirements of Article 76(1) EPC. A further auxiliary request ("auxiliary request 2") was found allowable by the examining division. However, the appellant did not agree to the grant of a patent on the basis of allowable auxiliary request 2. Accordingly, the application was refused under Article 97(2) EPC.

- II. In its statement of grounds of appeal the appellant requested the Board to set aside the decision of the examining division and to grant a patent on the basis of the main and first to fifth auxiliary requests, the fifth auxiliary request being directed to subject-matter of the former auxiliary request 2 found allowable by the examining division, as it communicated to the appellant in a communication under Rule 71(3) EPC.

- III. In preparation for oral proceedings requested by the appellant, the Board made the following preliminary comments:

The Board was of the opinion that it is evident from the three independent claims of the parent application, repeated as items (1) to (3) in the present divisional application, that subject-matter which can be considered as disclosed in the original parent application comprises features which are common to items (1) to (3) also including the following features (definition abbreviated):

- a second substrate;
- a vent hole being in the first insulating substrate.

These two features were only contained in claim 1 according to the fifth auxiliary request the allowability of which would not be questioned by the Board.

IV. With its letter dated 11 November 2011 the appellant submitted a new main, and sole, request corresponding to the former fifth auxiliary request found allowable by the Board.

Claim 1 according to the main, and sole, request underlying this decision reads as follows:

1. An electrochemical biosensor test strip comprising:
a first insulating substrate (1) having first (22) and second (23) surfaces and a vent hole (4);
at least two conductive tracks (5, 6) disposed on the first surface (22) of the first insulating substrate (1);
a second insulating substrate (7) having first (8) and second (9) surfaces and first and second openings (10,11), the second surface (9) being affixed to the conductive tracks (5, 6) and the first surface (22) of

the first insulating substrate (1), the first opening (10) exposing a portion of the electrically conductive tracks for electrical connection to a meter capable of measuring an electrical property, the second opening (11) exposing a different portion of the conductive tracks (5, 6) and the vent hole (4); a test reagent (12) overlaying at least a portion of the conductive tracks (5, 6) exposed by the opening (11); and a roof (13) having first (16) and second (17) surfaces, the second surface (17) of the roof (13) being affixed to the first surface (8) of the second insulating substrate (7) and positioned so that the second surface (17) of the roof (13) and the first surface (22) of the first insulating substrate (1) form opposing walls of a capillary test chamber; characterized in that the roof (13) further includes a transparent or translucent window (18) dimensioned and positioned so that the window extends from the edge where a test sample will be applied to the test strip, overlays the entire width of one of the electrically conductive tracks and at least about ten percent of the width of the other electrically conductive track.

Reasons for the Decision

1. Claim 1 and dependent claims 2 to 19 of the main request are identical to claim 1 and claims 2 to 19 of the auxiliary request 2 that was before the examining division, and that the examining division considered to be allowable.
2. The Board has no reason to question the allowability of these claims not only as to the formal requirements of the EPC, in particular, as to clarity under Article 84

EPC and original disclosure of the claimed subject-matter under Article 123(2) EPC in the present divisional application as originally filed, and under Article 76(1) EPC in the parent application as originally filed, but also as to its substantive requirements as to their patentability regarding Article 52(1) EPC.

3. The dependent claims 2 to 19 are related to embodiments of the invention defined in claim 1 and as such are also allowable.
4. Moreover, the Board is satisfied that the description as amended for clarity and consistency reasons also meets the requirements of the Convention.
5. Since the appellant's main request is allowable, there is no need to conduct the oral proceedings envisaged which are cancelled, accordingly.

Order

For these reasons it is decided that:

1. The decision of the examining division is set aside.
2. The case is remitted to the first instance with the order to grant the patent in the following version:

Description:

Pages 1, 4, 5, 6, 12, 13, 16 to 19 filed with letter dated 11 November 2011.

Pages 2, 3, 7 to 11, 14 and 15 as originally filed.

Claims:

Nos.: 1 to 19 filed with letter dated 11 November 2011.

Drawings:

Sheets 1/5 to 5/5 as originally filed.

The Registrar:

The Chairman:



M. Kiehl

A. Klein

Decision electronically authenticated