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**Datasheet for the decision
of 4 February 2014**

Case Number: T 0634/10 - 3.4.02

Application Number: 01116681.6

Publication Number: 1167977

IPC: G01N35/04

Language of the proceedings: EN

Title of invention:

Method and structure for determination of item of interest in
a sample

Applicant:

ABBOTT LABORATORIES

Relevant legal provisions:

EPC Art. 123(2)
EPC 1973 Art. 84

Keyword:

Claims - clarity (no)
Amendments - added subject-matter (yes)



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 0634/10 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 4 February 2014

Appellant: ABBOTT LABORATORIES
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Representative: Modiano, Micaela Nadia
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 15 October 2009
refusing European patent application No.
01116681.6 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: A. G. Klein
Members: F. J. Narganes-Quijano
L. Bühler

Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal against the decision of the examining division refusing European patent application No. 01116681.6 (publication No. 1167977).

In its decision the examining division held that the set of claims of the request then on file contravened the requirements of Articles 123(2), 76(1) and 84 EPC.

The examining division also expressed in an *obiter dictum* of the decision its view that the claimed subject-matter was anticipated by the prior art on file.

- II. With the statement setting out the grounds of appeal the appellant filed an amended set of claims and requested that the decision under appeal be set aside and a patent be granted. Oral proceedings were also requested on an auxiliary basis.

The set of claims 1 to 30 amended according to the appellant's request included independent claims 1 and 20 and dependent claims 2 and 21 referring back to claims 1 and 20, respectively. The wording of claims 1, 2, 20 and 21 is the following:

"1. A structure for performing a process for determining an item of interest in a sample the structure comprising:

a process step performance lane (62) accepting a container (15) for the sample and arranged to perform a process step for determining the item of interest on the sample in the container (15); and

a process step avoidance lane (64) accepting the container (15) where the process step is avoided."

"2. The structure as defined in claim 1 further comprising a process path (10), said process path (10) comprising a process lane (28) accepting the container (15), the process lane (28) including the performance lane (62) and the avoidance lane (64)."

"20. A method of performing a process for determining an item of interest in a sample, the method comprising the steps of:

positioning a container (15) for the sample in a process step performance lane (62), the process step performance lane (62) being arranged to perform a process step for determining the item of interest on the sample in the container (15) and performing the same; and

positioning the container (15) in a process step avoidance lane (64) where a process step that is not required to be performed for determining the item of interest is avoided."

"21. The method as defined in claim 20 further comprising the steps of:

providing a process path (10) comprising a process lane (28) accepting the container (15) for the sample, the process lane (28) including the process step performance lane (62) and the process step avoidance lane (64);

introducing the container (15) in the process lane (28); and

selectively, automatically positioning the container (15) in a selected one of the process step performance lane (62) and the process step avoidance lane (64)."

III. Oral proceedings were appointed by the Board. In a communication annexed to the summons to attend oral proceedings the Board gave a preliminary assessment of the appellant's case on appeal. In particular, as regards independent claims 1 and 20 and dependent claims 2 and 21, the Board reasoned as follows:

"Article 84 EPC 1973 and Article 123(2) EPC

[1] According to independent claim 20, while a predetermined step of the process referred to in the claim is performed in the "process step performance lane", in the so called "process step avoidance lane" "a process step that is not required to be performed ..." is avoided. Accordingly, the process step that is avoided is not necessarily the process step referred to previously in the claim and performed in the performance lane, but may also be any other step.

However, according to the content of the application as originally filed (see in particular independent claims 1, 20, 25 and 35) and to the description of the application (see in particular all the embodiments defined in section "Summary" on pages 1 to 8; see also page 22, lines 11 to 33, and page 23, line 18 to page 24, line 12 together with steps 40, 63 and 86 on pages 33 to 37, steps 17 and 40 on pages 70 to 73, and step 17 on pages 95 to 97) the step that is avoided in the "process step avoidance lane" corresponds to the process step that is performed in the performance lane, and not to an arbitrary "process step that is not required to be performed for determining the item of interest". Therefore, the subject-matter of

independent claim 20 appears to contravene the requirements of Article 123(2) and, in addition, does not appear to be supported by the description within the meaning of Article 84 EPC 1973.

It is also noted that claim 20 refers to a "process for determining an item of interest in a sample" and that it is unclear in the context of the claim in what sense "a process step that is not required to be performed for determining the item of interest" constitutes "a process step" of the process referred to in the claim (Article 84 EPC 1973). As a matter of fact, any possible, arbitrary step not required by the process falls within the category of "a process step that is not required to be performed for determining the item of interest", with the consequence that the claimed method step of "positioning the container in a process step avoidance lane ..." would be satisfied by any positioning of the container in an arbitrary lane because any lane lacks at least means for carrying out a great number of imaginable steps. The subject-matter of claim 20 is therefore indefinite and thus unclear (Article 84 EPC 1973).

In addition, the description contains a disclosure relating to performing or not a predetermined process step depending on whether the process step is required under the particular circumstances (see in particular page 22, lines 11 to 33, and page 23, line 18 to page 24, line 12). However, the essential features of this disclosure are not defined in independent claim 20 and in this respect the claim is not supported by the description within the meaning of Article 84 EPC 1973.

[2] Claim 1 defines a "process step avoidance lane accepting the container" where the process step performed in the "process step performance lane" is "avoided". It is unclear in the formulation of the claim how "avoiding" a predetermined process step in a "process step avoidance lane" should be construed,

- whether only in the sense that there is a lane devoid of means for carrying out the predetermined process step,
- or in the sense that the "process step avoidance lane" actually has means for carrying out the predetermined process step but these means can be selectively inhibited according to some unspecified criteria,
- or in the sense that the structure includes some unspecified means for selectively feeding the container either to the "process step performance lane" in which the predetermined process step is carried out or to another lane so as to bypass the performance lane,
- or in some other sense (see also point [3] below).

In addition, only the third of these alternative interpretations appears to be supported by the description of the application (see in particular all the embodiments defined in section "Summary" on pages 1 to 8; see also present dependent claims 3 and 19).

Accordingly, claim 1 is formulated in so broad, general terms that its subject-matter is not clear and not supported by the description (Article 84 EPC 1973).

- [3] Dependent claim 2 refers to a "process lane including the performance lane and the avoidance lane". According to this formulation, a single lane may be considered to be constituted by a plurality of lanes and therefore a plurality of lanes can be considered to constitute sections of a single lane. As a consequence, the two lanes defined in claim 1 may be construed as two sections of a single lane and therefore claim 1 can also be interpreted as merely requiring that the process step performance lane is sufficiently long as to have a predetermined section located beyond the position at which the means for performing the process step are located, this section constituting then a "process step avoidance lane". This interpretation is however at variance with the invention as disclosed in the description and claims 1 and 2 are therefore not supported by the description (Article 84 EPC 1973).
- [4] Analogous objections to those raised in points [2] and [3] apply to independent claim 20 and dependent claim 21 (Article 84 EPC 1973)."

In the communication the Board also gave reasons why the prior art on file appeared to anticipate the subject-matter of independent claims 1 and 20 within at least one of the meanings mentioned in points [2] and [3] above (Article 52(1) EPC).

- IV. In reply to the summons to oral proceedings, the appellant informed the Board by fax dated 30 January 2014 that it would not attend the oral proceedings.

- V. Oral proceedings were held before the Board on 4 February 2014. As previously announced, the appellant was neither present nor represented at the oral proceedings. At the end of the oral proceedings the Board announced its decision.
- VI. During the written proceedings, no substantive submission was submitted by the appellant in response to the preliminary opinion of the Board given in the communication annexed to the summons to oral proceedings. The arguments in the statement of grounds of appeal in support of the appellant's requests predate, and have no bearing on the issues subsequently raised by the Board in the aforementioned communication.

Reasons for the Decision

1. The appeal is admissible.
2. In the communication annexed to the summons to oral proceedings the Board *inter alia* explained in detail (see point III above) why in its preliminary opinion the set of claims amended according to the appellant's request did not satisfy the requirements of Article 84 EPC 1973 and Article 123(2) EPC. In the course of the proceedings the appellant made no substantive submissions in reply to the detailed objections raised by the Board in the aforementioned communication. In particular, the appellant chose neither to attend the oral proceedings nor to take a written position on the matters raised by the Board. The appellant has

therefore not availed itself of the opportunity to reply to the preliminary assessment of the case given by the Board in the aforementioned communication.

After consideration of the assessment advanced in the communication, and in the absence of any attempt by the appellant to refute or overcome the objections raised by the Board with regard to the claim request on file, the Board saw no reason during the oral proceedings to depart from the preliminary opinion expressed in the communication, which therefore becomes final.

Accordingly, noting that the appellant has had, and has failed to use, the opportunity to present comments on the objections raised by the Board in its communication (Article 113(1) EPC 1973), the Board concluded during the oral proceedings that the application as amended according to the appellant's request did not comply with the requirements of the EPC within the meaning of Article 97(2) EPC, and that consequently the request was not allowable.

The appeal must therefore be dismissed for the reasons already communicated to the appellant and reproduced in point III above (Rule 66(2)(g) EPC 1973).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. Kiehl

A. G. Klein

Decision electronically authenticated