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**Datasheet for the decision
of 15 September 2014**

Case Number: T 0665/10 - 3.3.08

Application Number: 00917213.1

Publication Number: 1171633

IPC: C12Q1/68

Language of the proceedings: EN

Title of invention:
METHODS OF MARKING MATERIALS

Patent Proprietor:
TraceTag International Limited

Opponent:
Johnson Matthey PLC

Headword:
Marking with DNA/TRACETAG

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
Main request, auxiliary requests 1-6, -
extension beyond the content of the application as filed -
(yes)

Decisions cited:
G 0009/92

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 0665/10 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 15 September 2014

Appellant:
(Patent Proprietor)

TraceTag International Limited
Merton House
Croescadarn Close
Cardiff
CF2 7HE (GB)

Representative:

Arends, William Gerrit
Marks & Clerk LLP
90 Long Acre
London
WC2E 9RA (GB)

Respondent:
(Opponent)

Johnson Matthey PLC
40-42 Hatton Garden
London EC1N 8EE (GB)

Representative:

Gibson, Sara Hillary Margaret
Intellectual Property Department
Johnson Matthey Catalysts
P.O. Box 1
Belasis Avenue
Billingham, Cleveland TS23 1LB (GB)

Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted on
19 January 2010 concerning maintenance of the
European Patent No. 1171633 in amended form.**

Composition of the Board:

Chairman M. Wieser
Members: B. Stolz
J. Geschwind

Summary of Facts and Submissions

I. The appeal lies against the decision of the opposition division, posted 19 January 2010, whereby European patent EP 1171633 (based on published international patent application WO 00/61799, hereinafter referred to as the application) was maintained on the basis of auxiliary request 10.

The opposition division decided that the main request and auxiliary requests 1, 5, 6, 7 and 8 lacked novelty (Article 54 EPC), and that auxiliary requests 2, 3, 4 and 9 lacked an inventive step (Article 56 EPC).

II. With its grounds of appeal, the patent proprietor (appellant) filed a main request comprising claims 1 to 36 as granted, and auxiliary requests 1 to 7. Auxiliary request 7 corresponds to auxiliary request 10 before the opposition division.

III. The opponent (respondent) submitted its response to the appellant's grounds of appeal.

IV. The parties were summoned to oral proceedings. A communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) annexed to the summons, informed them of the preliminary non-binding opinion of the board on some of the issues of the appeal proceedings.

With regard to respondent's objections against claim 1 of the main request and of auxiliary requests 1 to 6 under Article 123(2) EPC, the board informed the parties of its doubts whether the application as originally filed indeed disclosed a method as defined in the preamble of claim 1 of each of these requests.

- V. The respondent submitted further comments.
- VI. With letter dated 11 August 2014, the appellant informed the board that it would not attend the oral proceedings scheduled for 9 September 2014.
- VII. Oral proceedings, scheduled for 9 September 2014, were cancelled.
- VIII. Claim 1 of the main request reads:
- "1. A method of detecting whether one out of a plurality of materials has been marked by a marker comprising a nucleic acid tag wherein the sequence of the nucleic acid tag is specific for that material, the method comprising the steps of:
- (a) sampling a portion of the material; and
- (b) detecting the presence of the nucleic acid tag in the sample;
- said method characterised in that the quantity of nucleic acid tag present in the sample is determined to provide an indication of the quantity of marker present in the material."
- IX. The preamble of claim 1 of each of auxiliary requests 1 to 6 also reads:
- "1. A method of detecting whether one out of a plurality of materials has been marked by a marker comprising [...]."

X. The appellant addressed the issue of Article 123(2) EPC neither in its statement of grounds of appeal nor in its letter informing the board that it would not attend oral proceedings.

XI. The respondent's arguments, as far as relevant for the present decision can be summarized as follows:

Claim 1 contravened Art 123(2) EPC because the wording "...detecting whether one out of a plurality of materials has been marked by a marker comprising a nucleic acid tag wherein the sequence of the nucleic tag is specific for that material, ..." in lines 1 to 3 of claim 1 was not supported by the application as filed. There was only basis for claims to "a method of detecting whether a material had been marked". The application as filed contained no reference at all, neither explicit nor implicit, to "a plurality of materials". None of the scenarios for use of the method according to the description, neither the identification of stolen goods, nor the identification of petroleum fluids washed out of carriers at sea, nor the marking of grain, related to the subject matter of claim 1 of the main request and of auxiliary requests 1 to 6. Nor could this subject-matter be found in the last two paragraphs on page 3 of the description, which referred to the desirability of quantifying a marker or tag present in a material.

XII. The patent proprietor requested that the decision under appeal be set aside and that the patent be maintained as granted, or alternatively on the basis of one of auxiliary requests 1 to 6 filed with the grounds of appeal.

XIII. The opponent requested that the appeal be dismissed and oral proceedings be held if the board did not intend to do so.

Reasons for the Decision

Main request and auxiliary requests 1 to 6

Article 123(2) EPC

1. Claim 1 of the main request and of auxiliary requests 1 to 6 refers to a method of detecting whether **one out of a plurality of materials has been marked by a marker.**
2. Throughout the opposition proceedings as well as in its response to the appellant's grounds of appeal, the respondent maintained its objection that the application as originally filed disclosed only methods of detecting whether a material had been marked with a nucleic acid tag but that there was no basis for methods according to the preamble of claim 1.
3. The opposition division decided that the subject matter of claim 1 was implicitly disclosed on pages 1 and 3 of the application as originally filed.
4. The appellant, understandably, saw no need to comment on this issue in its grounds of appeal. However, it did also not comment on this issue in response to the board's communication annexed to the summons to oral proceedings, although the board indicated its doubts whether the application as originally filed disclosed a method according to the preamble of claim 1 (cf. items 9 to 11 of the annex to the summons).

5. According to established case law, the purpose of the method of claim 1 is a technical feature of the claim (Case Law of the Board's of Appeal, 7th edition, I.C. 6.3, pages 154 to 155).
6. The board sees a clear distinction between the purpose underlying a method of detecting whether a material has been marked and a method of detecting whether one out of a plurality of materials has been marked. In the first case, the method delivers a yes or no answer to the question whether a marker is present in the analysed material. In the second case several samples have to be analysed to answer the question whether at least one of them contains a marker. This answer, which may serve statistical or other purposes, in any case serves a different purpose.
7. It needs therefore to be established whether the application as filed discloses a method of detecting whether one out of a plurality of materials has been marked.
8. The opening statement on page 1 of the patent application reads: *"This invention relates to methods and kits for marking materials and the detection of such marking."* The next paragraph refers to a *"widespread requirement to be able to trace the path taken by a given material as it moves from one location to another"* and that it may be necessary to do so without the knowledge of the transporters.

Paragraph 3 refers to examples where the detection of a marker is helpful. For instance if articles of manufacture have been stolen it is important to establish that the goods have been stolen or resold from a particular distributor. Another example is the

marking of liquids such as petroleum which are routinely washed out of carriers into the sea. In this case it is important to identify the source of the petroleum. Yet another example is the marking of natural goods in order to monitor their movement, for example the movement of grain, if it is particularly difficult to distinguish one batch of such natural materials from another.

The next paragraph and all of page 2 refer to known methods of marking and detecting materials, many of which use labels made of DNA.

The paragraph bridging pages 2 and 3 refers to technical properties of the DNA labels used. The second paragraph on page 3 refers to the fact that prior art methods essentially provided a Yes/No answer to the question whether a sample had been marked and that it would be desirable to determine the quantity of tag present.

In the final two paragraphs on page 3, the inventors state that *"the quantity of a tag in a material can give valuable clues as to the past history and movements of the material"* and that *"by measuring the actual quantity of a tag in a material and comparing this to the amount initially used to mark the material, it may be possible to tell whether a customer (whether deliberately or inadvertently) has diluted the material. The quantity of tag in the material can also indicate whether contamination has taken place, and the appropriate action can then be taken. Determining the quantity of a particular marker is also useful when there are multiple sources of an environmental contamination. Here, different suspected sources of contamination, for example, material at different*

factories or plants, may be marked by different tags. A sample is taken from the polluted effluent stream, and the presence of each of the different tags may be detected to determine if the pollution is caused by a particular factory. Importantly, by measuring the relative concentrations of each tag in the effluent stream, information is provided on the relative contribution of each source to the environmental pollution."

9. None of these recited paragraphs, either explicitly or implicitly, discloses more than methods for detecting whether an article has been marked.

For instance, in the detection of stolen goods, it is necessary to determine whether a particular sample (material) has been stolen or not, or, possibly, whether each and every one out of a plurality of materials has been stolen. If the method is used to track the origin of discharged oil, the question asked is whether the sample carries a particular tag (has been marked) and not whether a sample out of a plurality of samples (of sea water) carries a particular tag. If the method is used to track dilution of goods, the question asked is whether a sample has been diluted and not whether a sample out of a plurality of samples has been diluted. If the method is used to identify a source of environmental pollution in an effluent stream, the question asked is whether a particular factory is the source of the pollution found in a particular sample and not whether one of several samples has been polluted by a particular factory.

10. The remainder of the description or the application as a whole, refer to various aspects of detecting whether a material has been marked.

According to a first aspect, a method is provided of marking a material and subsequently detecting that it has been marked (page 4, last paragraph). Similarly, the second aspect of the invention (page 5, paragraph 2) provides a method of detecting whether a material has been marked by a marker comprising a nucleic acid tag. Also the third (page 7, last paragraph), the fourth (page 8, first paragraph), the sixth (page 8, last paragraph), the seventh (page 9, paragraph three), and the eighth aspect of the invention (page 8, last paragraph) all relate to methods of marking a material and subsequently detecting whether it has been marked.

According to the fifth aspect of the invention the quantity of marker in a material is detected (page 8, third paragraph), and according to the tenth (page 10, last paragraph) and eleventh aspect (page 11, first paragraph) of the invention, methods are provided for determining which particular tag from a known pool of tags has been used to mark a material.

11. In the same way, the claims as originally filed referred to methods of marking a material and determining whether it has been marked but not to methods of determining whether one out of a plurality of materials has been marked.

12. Since neither pages 1 to 3 nor any other parts of the application as filed directly and unambiguously disclose the subject matter as defined in the preamble of claim 1, the board decides that the main request and auxiliary requests 1 to 6 do not meet the requirements of Article 123(2) EPC.

Auxiliary request 7

13. The patent proprietor is the sole appellant. The opposition division decided that the patent could be maintained on the basis of auxiliary request 10 before it which corresponds to auxiliary request 7 before the board.

If the patent proprietor is the sole appellant against an interlocutory decision maintaining a patent in amended form, neither the Board of Appeal nor the non-appelling opponent as a party to the proceedings as of right under Article 107, second sentence, EPC, may challenge the maintenance of the patent as amended in accordance with the interlocutory decision (decision G 009/92 OJ EPO 1994, 875, Headnote I).

14. Since the main request and auxiliary requests 1 to 6 are not allowable the appeal is dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



A. Wolinski

M. Wieser

Decision electronically authenticated