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**Datasheet for the decision
of 22 January 2014**

Case Number: T 2380/10 - 3.3.06

Application Number: 03735002.2

Publication Number: 1483053

IPC: B01J19/00, B01L7/00

Language of the proceedings: EN

Title of invention:
Parallel chemistry reactor with interchangeable vessel
carrying inserts

Applicant:
Bristol-Myers Squibb Company

Headword:
Modular reactor/BRISTOL

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
Amendments (all requests) - added subject-matter (yes)

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 2380/10 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 22 January 2014

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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 26 May 2010
refusing European patent application No.
03735002.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: B. Czech
Members: P. Ammendola
U. Lokys

Summary of Facts and Submissions

- I. This appeal lies from the decision of the examining division to refuse the European patent application No. 03 735 002.2.
- II. The examining division found *inter alia* that the claims according to the then pending main and auxiliary requests complied with the requirements of Article 123(2) EPC, but decided that the claimed subject-matter was not inventive.
- III. On 29 June 2010 the appellant (applicant) filed a notice of appeal and paid the appeal fee on the same day. In its statement setting out the grounds of appeal, received at the EPO on 15 September 2010, the appellant requested the grant of a patent on the basis of one of the two sets of amended claims filed under cover of the statement. As an auxiliary measure, it also requested oral proceedings.
- IV. The board summoned the appellant to oral proceedings to be held on 17 December 2013. In a communication issued in preparation for the oral proceedings, the board commented on some of the issues addressed in the decision under appeal and the statement setting out the grounds of appeal.
- V. In response, the appellant filed *inter alia* three sets of amended claims, respectively labelled "Main Request", "First Auxiliary Request" and "Second Auxiliary Request", under cover of a letter dated 20 November 2013.

VI. Claim 1 according to said **Main Request** reads:

"1. Apparatus for performing chemistry reactions in a plurality of open-mouthed reaction vessels that is adapted for use with a liquid handler of the type having a plurality of individual liquid dispensing means (42) arranged in a pattern and capable of dispensing liquid to a plurality of preset locations,

said apparatus comprising:

- a base (A, 10) defining an insert-receiving space (9),

- sealing means (C) mounted above said base (A, 10) for sealing the mouths of the reaction vessels (16), said sealing means (C) comprising a sealing plate (30, 32) having a plurality of sealable openings (34, 38), each of said sealable openings (34,38) being aligned with a different one of the reaction vessels (16), such that liquid can be dispensed through said sealing plate (30, 32) into the reaction vessels (16) from the liquid dispensing means (42) of the liquid handler;

characterized in that it further comprises:

- at least a first and a second insert (12, 12a, 12b) that are alternatively insertable into said insert-receiving space (9) in said base (A, 10);

- means for causing said at least first and second inserts (12, 12a, 12b) to be received into said insert-receiving space (9) only in a single orientation, each of said inserts (12, 12a, 12b) comprising a plurality of individual recesses (14)

arranged in a different array, said recesses (14) being each suitable to receive a respective reaction vessel (16) that is closed-bottomed, each of said reaction vessel-receiving recesses (14) in each of said insert recess arrays being aligned with a different one of the liquid dispensing means (42) of the liquid handler when the insert (12, 12a, 12b) is received in said insert-receiving space (9) in said base (A, 10)."

Claim 1 according to said **First Auxiliary Request** and claim 1 according to said **Second Auxiliary Request** are identical. They differ from claim 1 according to the Main Request only in that their characterising portion reads:

"characterized in that it further comprises:

- at least a first and a second vessel carrying insert (22, 12a, 12b) that are alternatively insertable into said insert-receiving space (9) in said base (A, 10), each of said inserts (12, 12a, 12b) comprising a different number of individual recesses (14) arranged in a different array, said recesses (14) being shaped so as to receive and support at bottom a respective reaction vessel (16) for solution phase reactions that is closed bottomed;

- means for causing said at least first and second inserts (12, 12a, 12b) to be received into said insert-receiving space (9) only in a single orientation, each of said reaction vessel-receiving recesses (14) in each of said insert recess arrays being aligned with a different one of the liquid dispensing means (42) of the liquid

handler when the insert (12, 12a, 12b) is received in said insert-receiving space (9) in said base (A, 10)."

VII. On 16 December 2013 the board sent a fax informing the appellant that the oral proceedings were rescheduled to 22 January 2014 and issued a communication to the appellant reading as follows:

"Compared to the claims of the application as originally filed, the claims as presently on file are substantially amended and, thus, open to objections under Article 123(2) EPC.

In preparing for oral proceedings, the board noted in this regard that the definition of the sealing means (C) in claim 1 of each of the requests does not appear to find a basis in the relevant parts of the original application (compare originally filed claim 1, page 21, line 6, to page 22, line 4), inter alia because it does not refer to the combination of a plate with a septum. If the used wording was intended to define exclusively the originally described embodiments (comprising the septum), then it is not clear for which reasons a different wording has been used.

Thus it appears necessary to postpone the oral proceedings in order to give to the appellant the possibility to comment on this point."

VIII. With a letter of 10 January 2014 the appellant announced that it would not be attending the oral proceedings scheduled for 22 January 2014 but maintained its request for oral proceedings. The letter contained no comment as to the issue under Article

123(2) EPC raised in the board's communication (point VII supra).

- IX. The appellant requested that the decision of the examining division be set aside and that a patent be granted on the basis of the claims according to one of the three sets of claims filed as Main, First Auxiliary and Second Auxiliary Requests under cover of its letter dated 23 November 2013.
- X. Oral proceedings took place as scheduled in the absence of the duly summoned appellant.

Reasons for the Decision

Main Request

1. Allowability of the amendments - Article 123(2) EPC
 - 1.1 Claim 1 of the Main Request requires the provision of "*sealing means(C) ... for sealing the mouths of the reaction vessels*" comprising a "*sealing plate .. having a plurality of sealable openings*" (see point V supra).
 - 1.2 As already pointed out in the communication sent to the appellant on 16 December 2013 (see point VII supra), this definition of sealing means (C) finds no literal basis in the relevant parts of the application as filed (published as WO 03/064042 A1). In particular, the latter does not contain any of the expressions "*sealing means*", "*sealing plate*" or "*sealable openings*".
 - 1.3 The board notes further that the only parts of the description of the application as filed describing the

sealing of the mouths of the reaction vessels are the following two passages:

Page 5, line 24, to page 6, line 3 (emphasis added):

"A solvent introduction module which includes a pressure **plate** having an array of openings and a **septum**, is received over the reactor module. The downwardly projecting rim defining each pressure **plate** opening cooperates with the **septum** to engage the mouth of the aligned reactor vessel to maintain a fluid tight **seal**."

and

Page 21, line 7, to page 22, line 10 (emphasis added):

"Module **C seals** the open mouths of the reactor vessels 16 and at the same time permits the introduction of various fluids into the vessels. Module **C consists** of a lower **plate** 30, an upper **plate** 32 and a **septum** mat 40.

....

Situated over and attached to plate 30 is upper plate 32. Plate 32 also has a plurality of openings 38. Openings 38 are arranged in the same pattern as and aligned with openings 34 in plate 30.

...

Septum mat 40 is situated below plate 30, between plate 30 and the rims of vessels 16.

...

Mat 40 is preferably 5mm thick, consisting of tan case PTFE Teflon bonded to white silicone rubber.

For applications not requiring inert gas, plate 32 is replaced by a blank plate 32a and plate 30 is eliminated. Mat 40 is clamped between plate 32a and the tops of vessels 16.

Fluids are introduced into the vessels from above by a needle 42. Needle 42 is inserted through each set of

aligned openings 38 in plate 32 and openings 34 in plate 30 and penetrates the septum mat 40 such that the tip of the needle is received within the reaction vessel, as shown in Figure 4."

- 1.4 These two passages describe exclusively the sealing produced when the mouths of the reaction vessels are engaged with a perforable "septum mat" located below the (lower) plate comprising an array of openings aligned with the mouths of the reaction vessels.

It is also consistent with these passages of the original description that:

- each of the figures in the original application depicting module "(C)", i.e. Figures 1, 2 and 4, describe embodiments in which a septum mat 40 is located between plate 30 and the mouths of the reaction vessels 16, which are aligned with the openings in the plate

and

- each of the claims of the application as filed comprising features possibly related to "sealing means (C)", i.e. independent claims 1 and 2, require not only the presence of a plate with an array of openings but also that of a septum; they are thus narrower in scope as regards the sealing means.

- 1.5 The board thus finds that the application as filed discloses exclusively the sealing of the reaction vessel mouths obtained by placing thereupon a perforable septum mat and, on the top of this latter, a plate having an array of aligned openings.

1.6 In contrast, the definition of the "*sealing means (C)*" in claim 1 of the Main Request is not limited to means comprising a septum. The functional and rather vague expressions "*sealing means*", "*sealing plate*" and "*sealable openings*" do not exclude design options relying on other means than a "*septum*". However, the originally filed application as a whole does not contain elements from which the skilled person could directly and unambiguously derive the possibility to provide sealing means for sealing the mouths of the reaction vessels which comprise a sealing plate having sealable openings but which do not necessarily comprise a septum.

1.7 By virtue of some of the amendments made, claim 1 at issue is thus also directed to subject-matter extending beyond the content of the application as filed and does not, hence, meet the requirements of Article 123(2) EPC.

1.8 Therefore, the main request is not allowable.

First and Second Auxiliary Requests

2. Allowability of the amendments - Article 123(2) EPC

2.1 The definition of the "*sealing means (C)*" in the respective claims 1 of the First and Second Auxiliary Requests is identical to the one given in claim 1 of the Main Request. The further amendments to claim 1 do not further qualify said definition.

3. Hence, the considerations under points 1.2 to 1.6 supra apply *mutatis mutandis* to amended claims 1 of the two auxiliary requests: both are also directed to subject-

matter extending beyond the content of the application as filed and therefore do not comply with Article 123(2) EPC.

4. Thus, the First and Second Auxiliary Requests are not allowable either.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



D. Magliano

B. Czech

Decision electronically authenticated