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Datasheet for the decision of 2 February 2015

Case Number: T 1320/11 - 3.4.02

Application Number: 02748208.2

Publication Number: 1525534

IPC: G01N21/27, G01N21/35

Language of the proceedings: EN

Title of invention:
ON-SITE ANALYSIS SYSTEM WITH CENTRAL PROCESSOR AND METHOD OF ANALYSING

Applicant:
Cognis IP Management GmbH

Headword:

Relevant legal provisions:
EPC Art. 123(2), 111(1)
EPC R. 137(5)

Keyword:
Amendments - added subject-matter (no) - after amendment
Remittal to the department of first instance - (yes)

Decisions cited:

Catchword:

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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 1320/11 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 2 February 2015

Appellant: (Applicant)	Cognis IP Management GmbH Henkelstrasse 67 40589 Düsseldorf (DE)
Representative:	Fabry, Bernd IP2 Patentanwalts GmbH Schlossstrasse 523 41238 Mönchengladbach (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 26 January 2011 refusing European patent application No. 02748208.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	A. Hornung
Members:	F. Maaswinkel
	L. Bühler
	A. Hornung

Summary of Facts and Submissions

I. The applicant appealed against the decision of the examining division refusing European patent application No. 02748208.2 on the basis of Article 123(2) EPC and Rule 137(5) EPC.

II. The applicant requested that the decision of the examining division be set aside and a patent be granted on the basis of the main request or of the first auxiliary request, both requests filed with the letter setting out the grounds of appeal.

III. In a telephone conversation on 13 October 2014, the board informed the appellant of the provisional opinion that it agreed with the decision of the examining division (see the appealed decision, points 3.6 and 3.7) that claim 1 of the main request and the auxiliary request had been amended so as to relate to unsearched subject-matter which did not combine with the originally claimed invention to form a single general inventive concept. The board invited the appellant to provide a clear basis in the originally filed application documents for the claimed subject-matter. In reply, the appellant filed a new main request and a new first auxiliary request with its letter of 12 December 2014.

IV. Independent claim 1 according to the main request on which the present decision is based, reads as follows:

"1. A method of predicting a value of a property of interest of a material from data acquired on an unknown sample of material by means of NIR spectroscopy using a calibration model being configured to compensate for instrument variance comprising:
(i) obtaining a preliminary model for predicting the property of interest, the model developed from a training set using at least one instrument;

(ii) identifying at least one factor which may influence the predictive ability of the preliminary model for the property of interest;
(iii) determining the at least one factor which influences the predictive ability of the preliminary model outside a limit of defined precision; and
(iv) revising the preliminary model to compensate for variation in the at least one factor which influences the property of interest to generate the calibration model, the models predicting the value of the property of interest within the limits of defined precision."

Reasons for the Decision

1. Article 123(2) EPC

The board is of the opinion that present claim 1 does not contain subject-matter which extends beyond the application as filed.

1.1 Firstly, the introductory portion of claim 1 is generally based on claim 1 as originally filed.

The feature in the introductory portion of claim 1 according to which the data is acquired by means of NIR spectroscopy has a basis in the description as a whole, exemplified by the statement on page 33, lines 3-6. Moreover, many figures show NIR spectra, such as figure 23 showing the absorbance spectra of a 1% squalane validation sample provided by a NIR spectroscope (page 122, line 1 to page 124, line 17), figure 23 being related to example 7 in which instrument variance is corrected by using the calibration model of the invention.

1.2 Secondly, it is evident that the claimed method steps (i) to (iv) are literally identical to the method steps of claim 98 as originally filed.

1.3 Thirdly, figure 4 and the corresponding description on page 66, line 10 to page 78, line 10, disclose how the calibration model of the invention is generated by implementing the steps of claim 98 as originally filed.

1.4 In the decision underlying the appeal, the examining division expressed its opinion that the claimed subject-matter then on file contained added subject-matter. The examining division argued essentially as follows:

(i) The alleged basis for the amendments given by applicant (i.e. claim 98; page 39, paragraph 2; numerous figures) does not comprise the wording "predicting a value of a property of interest of a material from data acquired on an unknown sample of material by means of NIR spectroscopy using a calibration model".

(ii) Doubts about directness and unambiguity, as well as overly contorted justifications, are to the detriment of the applicant.

(iii) The examining division concludes that the hybrid subject-matter of claim 1 then on file was not originally disclosed.

In the board's view, the argumentation underlying the appealed decision does not apply to present claim 1. Concerning point (i), the examining division is correct in its factual finding, however, Article 123(2) EPC does not require that the exact wording is disclosed in the application as originally filed. Point (ii) of the examining division's reasoning is merely a general statement, which is

neither applied to the concrete case at stake, nor underpinned with supporting evidence. Therefore, the board cannot follow the examining division's conclusion of point (iii).

1.5 It follows that the board is satisfied that claim 1 is compliant with Article 123(2) EPC.

2. Rule 137(5) EPC

Amended claim 1 of the main request is compliant with the requirement of Rule 137(5) EPC.

2.1 Present claim 1 corresponds to claim 1 as originally filed whose scope has been narrowed by introducing the aspect of NIR spectroscopy and the method steps (i) to (iv). The subject-matter of claim 1, therefore, relates to group 1 of inventions, which has been defined by the examining division as including claim 1 as originally filed and relating to a "method for predicting a value of a property of interest in a material in which the calibration model is configured to compensate for instrument variance". In other words, present claim 1 combines with group 1 of the inventions to form a single general inventive concept. Hence, the requirement of Rule 137(5) EPC is fulfilled.

2.2 The examining division considered that claim 1 then on file related to group 2 of the inventions because claim 1 then on file lacked the feature according to which the calibration model is configured to compensate for instrumental variance. Since present claim 1 of the main request has been amended to include the feature according to which the calibration model is configured to compensate for instrumental variance, the objection of the examining division became moot.

3. Further prosecution

3.1 Since the applicant filed amendments overcoming the reasons of the first instance for refusing the application under Article 123(2) EPC and Rule 137(5) EPC, the appealed decision must be set aside.

3.2 On the one hand, the decision under appeal did not deal with the subject-matter as presently claimed.

On the other hand, with respect to the subject-matter as presently claimed, the board decided only on the objections underlying the refusal of the application by the first instance, i.e. Article 123(2) EPC and Rule 137(5) EPC.

The remaining requirements of the EPC have not been considered by the board.

3.3 Therefore, in order to give the applicant the opportunity to have the claimed subject-matter examined by two instances, the board decides to make use of its discretion under Article 111(1) EPC in remitting the case to the examining division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance for further prosecution.

The Registrar: The Chairman:

M. Kiehl A. Hornung

Decision electronically authenticated