Internal distribution code:

(A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [X] To Chairmen
(D) [-] No distribution

Datasheet for the decision of 18 March 2016

Case Number: T 0133/12 - 3.4.03

Application Number: 05813979.1

Publication Number: 1820202

IPC: H01J49/04, H01J49/40

Language of the proceedings: EN

Title of invention:
MASS SPECTROMETER

Applicant:
Micromass UK Limited

Headword:

Relevant legal provisions:
EPC 1973 Art. 111(1), 116
EPC 1973 R. 71(2)
RPBA Art. 12(4), 13(1), 13(3), 15(3), 15(6)

Keyword:
Oral proceedings - non-attendance of party
Late-filed requests - admitted (no)
Remittal to the department of first instance - (no)

Decisions cited:
T 1587/07

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

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 0133/12 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 18 March 2016

Appellant: (Applicant)	Micromass UK Limited Stamford Avenue Altrincham Road Wilmslow SK9 4AX (GB)
Representative:	Jeffrey, Philip Michael Dehns St Bride's House 10 Salisbury Square London EC4Y 8JD (GB)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 12 September 2011 refusing European patent application No. 05813979.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	G. Eliasson
Members:	T. M. Häusser
	C. Heath

Summary of Facts and Submissions

I. The appeal concerns the decision of the examining division refusing the European patent application No. 05 813 979 for lack of novelty of the subject-matter claimed at the time in view of the following document:

D1: US 2004/0094702 A1.

II. The examination proceedings can be summarized as follows:

- The International application underlying the present European application was published comprising 100 claims, of which claims 8 and 18 read as follows:

"8. A mass spectrometer comprising:
a first mass filter or mass analyser;
an ion mobility spectrometer or separator, said ion mobility spectrometer or separator being arranged downstream of said first mass filter or mass analyser; and
a second mass filter or mass analyser arranged downstream of said ion mobility spectrometer or separator."

"18. A mass spectrometer as claimed in any of claims 8-17, wherein in a mode of operation said first mass filter or mass analyser and/or said second mass filter or mass analyser is scanned in synchronism with said ion mobility spectrometer or separator."

- With the letter dated 14 May 2007 in respect of the entry into the regional phase before the EPO, a

replacement set of claims was filed corresponding to the claims of the International application, except that several claims were deleted. The new set comprised 37 claims, wherein claims 5 and 9 corresponded to published claims 8 and 18, respectively.

- On 13 June 2007 the International Preliminary Report on Patentability was issued, in which it was indicated that the combination of the additional features of published claim 18 with the features of any claim to which that claim referred did not meet the requirements of inventive step.

- With the letter dated 26 September 2007 the appellant filed by way of voluntary amendment a new set of 27 claims, in which previous claims 5 and 9 were deleted. The wording of the new independent claim 1 was as follows:

"1. A mass spectrometer comprising:

a first collision, fragmentation or reaction device (8) arranged and adapted to fragment or react ions and to produce product, daughter, adduct or fragment ions; and

an ion mobility spectrometer or separator (10) arranged downstream of said first collision, fragmentation or reaction device (8), said ion mobility spectrometer or separator (10) being arranged to temporally separate product, daughter, adduct or fragment ions according to their ion mobility which emerge from or which have been transmitted from said first collision, fragmentation or reaction device (8);

wherein said collision, fragmentation or reaction device (8) is arranged and adapted to

pulse ions out of said collision, fragmentation or reaction device (8) and into or towards said ion mobility spectrometer or separator (10);

said mass spectrometer further comprising a mass filter (16) arranged downstream of said ion mobility spectrometer or separator (10)."

- In the communication of 25 February 2010 the examining division raised the objection that the subject-matter of claim 1 filed with the letter received at the EPO on 27 September 2007 was not new over document D1. The appellant's reply dated 3 November 2011 contained arguments concerning the lack of novelty objection but no claim amendments.

- In the communication of 4 March 2011 annexed to the summons to oral proceedings the examining division essentially repeated the previous objection of lack of novelty over document D1. In reply the appellant withdrew its request for oral proceedings which were subsequently cancelled.

- In the decision under appeal the examining division refused the application because the subject-matter of claim 1 filed with the letter received at the EPO on 27 September 2007 was not new over document D1.

III. The appeal proceedings can be summarized as follows:

- With the letter dated 23 January 2012 setting out the grounds of appeal the appellant requested as a main request (of 23 January 2012) that a patent be granted with claims as refused by the examining division. As first and second auxiliary requests (of 23 January 2012) amended claim sets were filed

in which the respective claim 1 comprised the following additional feature over claim 1 of the main request:

First auxiliary request (of 23 January 2012):

The claimed mass filter was defined to be a "quadrupole rod set mass filter".

Second auxiliary request (of 23 January 2012):

"wherein said mass filter is configured to switch to a number of pre-selected mass to charge ratio transmission windows at pre-selected times."

- In a communication pursuant to Article 15(1) RPBA annexed to the summons to oral proceedings, the board made preliminary remarks that the subject-matter of claim 1 of the main request (of 23 January 2012) lacked novelty over document D1, in view of a different embodiment than that pointed out in the appealed decision. It was also mentioned that it would be discussed at the oral proceedings whether the first and second auxiliary requests (of 23 January 2012) would be admitted into the appeal proceedings in view of Article 12(4) RPBA. Moreover, it was mentioned that, in case one or both of these auxiliary requests were admitted into the proceedings, novelty and inventive step of the claimed subject-matter might be discussed in view of document D1 and the following documents:

D4: US 2003/0020012 A,
D6: US 2003/0213900 A.

The appellant was also reminded of the provisions of Article 13 RPBA.

- In its reply to the summons to oral proceedings dated 18 February 2016 the appellant submitted three new sets of claims as a main request and first and second auxiliary requests, respectively, and withdrew the previously filed claim requests. The appellant also withdrew its request for oral proceedings and stated that it would not be attending the hearing.

- Oral proceedings were held on 18 March 2016 in the absence of the appellant.

IV. The appellant requests to set the decision aside and to grant a patent on the basis of the main request or alternatively the first or second request, all filed with the letter dated 18 February 2016. Furthermore, the appellant requests to remit the case to the examining division.

V. The wording of independent claim 1 of the main request and the first and second auxiliary requests is as follows:

Main request:

"1. A mass spectrometer comprising:

a first collision, fragmentation or reaction device (8) arranged and adapted to fragment or react ions and to produce product, daughter, adduct or fragment ions; and

an ion mobility spectrometer or separator (10) arranged downstream of said first collision, fragmentation or reaction device (8), said ion mobility

spectrometer or separator (10) being arranged to transmit substantially all ions and to temporally separate product, daughter, adduct or fragment ions according to their ion mobility which emerge from or which have been transmitted from said first collision, fragmentation or reaction device (8);

wherein said collision, fragmentation or reaction device (8) is arranged and adapted to pulse ions out of said collision, fragmentation or reaction device (8) and into or towards said ion mobility spectrometer or separator (10);

said mass spectrometer further comprising a mass filter (16) arranged downstream of said ion mobility spectrometer or separator (10) ; and

a) wherein said mass filter (16) is configured to switch between pre-selected mass to charge ratio transmission windows at pre-selected times during the ion mobility separation; or

b) wherein the spectrometer is configured to scan said mass filter (16) in synchronism with said ion mobility spectrometer or separator (10) such that the scan function of the mass filter (16) is arranged to match the relationship between the mass to charge ratio of an ion and its exit time from the ion mobility spectrometer or separator (10) such that a substantial number of ions exiting the ion mobility spectrometer or separator (10) are subsequently transmitted through the mass filter (16)."

First and second auxiliary requests:

Claim 1 of the first auxiliary request and claim 1 of the second auxiliary request correspond to claim 1 of the main request with the only difference that in the first auxiliary request alternative a) is deleted and

in the second auxiliary request alternative b) is deleted.

VI. The appellant's arguments made in writing, as far as they are relevant to this decision, can be summarized as follows:

(a) Remittal of the case to the examining division

The appellant had not had the opportunity to be heard at first instance on two new objections concerning added matter and lack of novelty raised by the board of appeal in its communication indicating its preliminary opinion. The appellant requested therefore that the case be remitted to the examining division to deal with these objections.

(b) Admission of the main request and first and second auxiliary requests

The requests had been filed in response to the two new objections concerning added matter and lack of novelty raised by the board of appeal in its communication indicating its preliminary opinion.

Reasons for the Decision

1. Oral proceedings before the board

1.1 With letter dated 18 February 2016, one month before the date arranged for oral proceedings before the board, the appellant withdrew its request for oral proceedings and stated that it would not be attending the hearing.

According to Article 116 EPC 1973, oral proceedings must take place either at the instance of the EPO if it considers this to be expedient or at the request of any party to the proceedings. Since the board considered oral proceedings to be expedient in the present case, it refrained from cancelling the scheduled oral proceedings, which thus took place in the appellant's absence and were continued without the appellant in accordance with Rule 71(2) EPC 1973.

1.2 According to Article 15(3) and (6) RPBA, the board shall "not be obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned who may then be treated as relying only on its written case" and "ensure that each case is ready for decision at the conclusion of the oral proceedings, unless there are special reasons to the contrary."

Furthermore, the purpose of oral proceedings is to give the party the opportunity to present its case and to be heard. However, a party gives up that opportunity if it does not attend the oral proceedings. This view is supported by the explanatory note to Article 15(3) RPBA (former Article 11(3) RPBA) which reads: "This provision does not contradict the principle of the right to be heard pursuant to Article 113(1) EPC since that Article only affords the opportunity to be heard and, by absenting itself from the oral proceedings, a party gives up that opportunity" (see CA/133/02 dated 12 November 2002).

Moreover, the board agrees with the finding of the decision T 1587/07 that an appellant who submits amended claims as a new request after oral proceedings have been arranged but does not attend these proceedings

must expect a decision not admitting the new request into the appeal proceedings pursuant to Article 13 RPBA in its absence (point 2.2 of the Reasons).

1.3 In the present case, the main request and the first and second auxiliary requests were filed with the letter dated 18 February 2016 and mentioned under point 1.1 above, i. e. after the oral proceedings before the board had been arranged, and were not admitted into the appeal proceedings for the reasons set out under point 2. below.

The appellant had to expect a discussion on the admission of these newly filed requests during the oral proceedings, in particular because reference had been made to Article 13 RPBA in the board's communication pursuant to Article 15(1) RPBA annexed to the summons to oral proceedings. By not attending the oral proceedings the appellant gave up the opportunity to present its case as to why the requests should be admitted into the appeal proceedings and could thus be treated as relying only on its written submissions.

The board's decision not to admit the newly filed requests was therefore in conformity with the requirements of Article 113(1) EPC 1973 that the decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

Accordingly, the case was ready for decision at the conclusion of the oral proceedings in accordance with Article 15(6) RPBA.

2. Admission of the main request and first and second auxiliary requests

2.1 According to Article 12(2) RPBA, the statement of the grounds of appeal must contain a party's complete case. Any amendment to a party's case after it has filed its grounds of appeal may, according to Article 13(1) RPBA, be admitted and considered at the board's discretion. The discretion must be exercised in view of, *inter alia*, the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

The sets of claims submitted as main request and first and second auxiliary request were filed with the letter dated 18 February 2016, i. e. after the board's communication under Article 15(1) RPBA and one month before the oral proceedings. Hence the amendment to the appellant's case was filed after the statement of the grounds of appeal. The new requests are therefore an amendment to the appellant's case within the meaning of Article 13(1) RPBA and the admission of these requests is at the board's discretion.

2.2 When exercising its discretion under Article 13(1) RPBA, the board may take into account the course of the proceedings before the examining division.

2.2.1 In its reply to the summons to oral proceedings before the board the appellant submitted three new sets of claims as main request and first and second auxiliary request, respectively.

Claim 1 of the main request relates to two specific alternatives claimed using features a) and b), respectively, relating to selecting by means of the mass filter specific ions separated by the ion mobility spectrometer or separator (see the wording of features

a) and b) under point V. above). Claim 1 of the first and second auxiliary request relates to one of these alternatives, namely to the alternative of feature b) and feature a), respectively.

Alternative features a) and b) of claim 1 of the main request are closely related to the additional feature of claim 18 as published (see point II. above), which also relates to selecting by means of the mass filter specific ions separated by the ion mobility spectrometer or separator. This claim 18 refers to independent claim 8, which concerns the combination of an ion mobility spectrometer or separator and a mass filter arranged downstream of said ion mobility spectrometer or separator and is thus in turn closely related to the other features of claim 1 of the main request. In the International Preliminary Report on Patentability it was indicated that the combination of the additional features of published claim 18 with the features of any claim to which that claim referred did not meet the requirement of inventive step (see the report's separate sheet, Re Item V, point 2).

Claims 5 and 9 filed with the letter dated 14 May 2007 in respect of the entry into the regional phase before the EPO correspond to published claims 8 and 18, respectively. However, with the letter dated 26 September 2007, received at the EPO on 27 September 2007, the appellant filed by way of voluntary amendment a new set of 27 claims, in which previous claims 5 and 9 were deleted. This set of claims formed the basis for the appealed decision.

The claims of the main request and the first and second auxiliary requests therefore raise issues which could have been dealt with in the decision under appeal, had

the appellant not chosen beforehand to delete the corresponding claims. In particular, in view of the content of the International Preliminary Report on Patentability, the decision could have contained indications concerning the requirement of inventive step in relation to the subject-matter of these claims.

2.2.2 The board considers it also appropriate, when exercising its discretion under Article 13(1) RPBA, to take into account the provisions of Article 12(4) RPBA, according to which the board has the discretionary power to hold inadmissible requests which were presented by the appellant with the notice of appeal or the statement of grounds of appeal, but which could have been presented in the first instance proceedings (see also T 1587/07, point 3.7 of the Reasons). The fact that the appellant had filed the requests after it filed the statement of grounds of appeal should not put the appellant in a better position than if it had filed them with the statement of grounds of appeal. Otherwise it would be easily possible for the appellant to circumvent the provisions of Article 12(4) RPBA.

As indicated above, claim 1 of the main request is closely related to the combination of the features of independent claim 5 and dependent claim 9 as filed with the letter in respect of the entry into the regional phase before the EPO. The same holds for the corresponding method claim 26 of the main request. Since the dependent claims define fall-back positions in case the independent claims are not allowable, the board is of the opinion that the main request and hence also the first and second auxiliary requests could have been presented in the first instance proceedings.

2.3 The appellant argued that the new requests were filed in response to the two new objections concerning added matter and lack of novelty raised by the board of appeal in its communication under Article 15(1) RPBA indicating its preliminary opinion.

However, in response to the board's added-matter objection in relation to independent claims 1 and 27 of the previous main request (point 2.1.1 of the communication) the appellant merely submitted counter-arguments but no claim amendments. Moreover, in response to the board's added-matter objection in relation to claim 3 of the previous main request (point 2.1.2 of the communication), the appellant deleted indeed that claim. However, claim 3 of the previous main request was merely a dependent claim and therefore not crucial for defining the desired scope of protection.

The board's preliminary opinion that the subject-matter of claim 1 of the previous main request lacked novelty was based on a different embodiment of document D1 than that mentioned in the decision under appeal. However, that embodiment was described in paragraph [0114] of document D1 which had already been highlighted in the decision under appeal. Moreover, documents D1, D4, and D6 were merely briefly mentioned in the context of possible discussions at the oral proceedings before the board concerning novelty and inventive step of the subject-matter claimed according to the previous first and second auxiliary requests (point 4.2 of the communication).

The board is therefore not persuaded by the appellant's argument that solely the remarks in the board's communication prompted the relevant amendments of the

claims according to the main request and the first and second auxiliary requests.

It is also noted that claim amendments closely related to alternative features a) and b) of claim 1 of the main request were filed in relation to the second auxiliary request submitted with the grounds of appeal (see point III. above). In its communication the board remarked that the admissibility of the auxiliary requests filed with the statement of the grounds of appeal would have to be discussed, in particular in the light of the fact that the appellant had not availed himself of the opportunity to discuss the main request and file new requests as appropriate at the oral proceedings before the examining division.

2.4 In addition, the present main request and first and second auxiliary requests were submitted at a very late stage of the appeal proceedings, namely one month before the oral proceedings before the board, and in view of the considerations above under point 2.2.1 it might well be expected that new issues concerning inventive step (Article 56 EPC 1973) would arise. The board takes therefore the view that the appellant's behaviour counteracts procedural economy.

2.5 In view of the above, the board does not admit the main request and the first and second auxiliary requests to the appeal proceedings, exercising its discretion pursuant to Article 13(1) RPBA.

3. Conclusion

3.1 The appellant stated in the letter dated 18 February 2016 that the previously filed claim requests were withdrawn. As the board does not admit the main request

and the first and second auxiliary requests into the proceedings, there is no admissible request.

3.2 Under these circumstances remittal of the case to the department of first instance under Article 111(1) EPC 1973 would serve no purpose. Therefore, the board rejects the appellant's request for remittal of the case to the examining division.

3.3 Consequently, the appeal must fail.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

S. Sánchez Chiquero G. Eliasson

Decision electronically authenticated