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Datasheet for the decision of 16 April 2018

Case Number: T 1866/12 - 3.3.08

Application Number: 08155687.0

Publication Number: 2116614

IPC: C12Q1/68

Language of the proceedings: EN

Title of invention:
Simultaneous detection of multiple nucleic acid sequences in a reaction

Applicant:
QIAGEN GmbH
Qiagen Hamburg GmbH

Headword:
Detection multiple nucleic acid sequences/QIAGEN

Relevant legal provisions:
EPC Art. 113(1)
RPBA Art. 12(4)

Keyword:
Claim request filed with statement of grounds of appeal - admission into the appeal proceedings (no)
Right to be heard - non-attendance at oral proceedings and no substantive reply to board's communication

Decisions cited:
T 0361/08, T 0679/09

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

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Case Number: T 1866/12 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 16 April 2018

Appellant: (Applicant 1)	QIAGEN GmbH Qiagen Strasse 1 40724 Hilden (DE)
Appellant: (Applicant 2)	Qiagen Hamburg GmbH Königstrasse 4a 22767 Hamburg (DE)
Representative:	CH Kilger Anwaltspartnerschaft mbB Fasanenstrasse 29 10719 Berlin (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 17 January 2012 refusing European patent application No. 08155687.0 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	B. Stolz
Members:	P. Julià
	R. Winkelhofer

Summary of Facts and Submissions

I. European patent application No. 08 155 687.0 (with publication number 2 116 614, hereinafter "the patent application") was considered by an examining division of the European Patent Office not to fulfil the requirements of the EPC and, accordingly, was refused (Article 97(2) EPC).

II. In reply to a summons to oral proceedings, the applicants informed the examining division with submission dated 23 December 2011 that they would not attend the oral proceedings and that a decision "according to the state of the file" was requested. In the decision of the examining division, reference was made to the communications dated 28 December 2010 and 29 September 2011 for considering the patent application not to meet the requirements of the EPC, which the applicants had left unanswered. No further reasons were set out in the decision.

III. Basis for the refusal was a set of claims 1 to 11 filed on 29 October 2010. Claim 1 read as follows:

"1. Method for simultaneously amplifying and detecting nucleic acid sequences in a reaction comprising the following steps:

(i) providing a sample comprising at least one nucleic acid molecule;

(ii) providing reagents for performing an amplification reaction, wherein the reagents comprise at least two probe sets, wherein

a. each probe set consists of at least three probes;

b. each of the probes is specific for a nucleic acid sequence;

c. each of the probes in a given probe set carries a different label;
d. all of the probes in a given probe set have an identical melting temperature (T_m) when they are dissociated from their target nucleic acid sequence by heating,

(iii) amplifying the nucleic acid sequences in the reaction;

(iv) detecting the amplified nucleic acids by determining whether the labeled probe has bound its nucleic acid sequence;

(v) detecting the temperature at which each given labeled probe dissociates from the nucleic acid sequence to which it has bound, wherein
a. the probes carrying the same label differ in melting temperature (T_m) in a way that they are distinguishable by melting point
b. the labeled probe is a group consisting of a hybridization probe and TaqMan probe,
c. the TaqMan probe carriers the said label,
d. the said label is a fluorescent label
e. the TaqMan probe additionally comprises a quencher,
f. the hybridization probe carries an additional quencher that is able to quench the fluorescence of the label attached to the TaqMan probe,
g. said TaqMan probe and said hybridization probe are able to bind said nucleic acid sequence in such a way that when both probes are bound to their respective sequences, the quencher present on the hybridization probe, at least partially, quenches the fluorescence of the said label on said TaqMan probe, and
h. the melting temperature (T_m) of the hybridization probe is lower than the melting

temperature (T_m) of the TaqMan probe."

IV. An appeal against the decision of the examining division was lodged by the applicants (appellants). With the statement setting out the grounds of appeal, the appellants filed a set of claims 1 to 13 and requested the board to set aside the decision under appeal and to grant a patent on the basis of this set of claims. Oral proceedings were requested as an auxiliary measure.

V. The preamble and steps (i) to (v) of claim 1 of the set of claims filed with appellants' statement of grounds of appeal were identical to those of claim 1 underlying the decision under appeal but instead of features (a) to (h) in step (v), claim 1 of the new set of claims reads as follows:

"1. ... [as in claim 1 underlying the decision under appeal] ...
wherein the probes carrying the same label differ in melting temperature (T_m) in a way that they are distinguishable by melting point."

VI. In a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) annexed thereto, the board informed the appellants that it was, in the exercise of its discretion, minded not to admit the new set of claims 1 to 13 into the appeal proceedings (Article 12(4) RPBA).

VII. In reply thereto, the appellants, without filing substantive arguments, withdrew their request for oral proceedings.

VIII. Oral proceedings took place on 16 April 2018 in the absence of the appellants. At the end of these proceedings, the board announced its decision.

IX. The appellants request that the decision under appeal be set aside and that a patent be granted on the basis of the set of claims 1 to 13 filed with their statement of grounds of appeal.

Reasons for the Decision

Article 113(1) EPC

1. In reply to the communication of the board, the appellants withdrew their request for oral proceedings but did not respond in substance (cf. points VI and VII *supra*). The board did not cancel the scheduled oral proceedings.

2. By their decision not to attend the oral proceedings and not to file substantive arguments in reply to the board's communication, the appellants have chosen not to make use of the opportunity to comment on the board's provisional opinion, either in written form or at oral proceedings, although the board's provisional opinion was clearly in appellants' disfavour, i.e. the board was "*of the provisional, non-binding opinion that the appeal will likely have to be dismissed*" (cf. page 5, point 14 of the board's communication).

3. In the light thereof, the present decision is based on the same grounds, arguments and evidence on which the provisional opinion of the board was based.

Admission of the new set of claims 1 to 13

4. According to the established case law (cf. "Case Law of the Boards of Appeal of the EPO", 8th edition 2016, IV.E.1, 1065 ff; cf. also IV.E.4, 1127 ff), the function of an appeal is to give a judicial decision upon the correctness of a separate earlier decision taken by a department of first instance. Appeal proceedings are not an opportunity to re-run the proceedings before the first instance.
Article 12(4) RPBA furthermore empowers the board not to consider facts, evidence or requests which could have been presented in the first instance proceedings. This applies all the more to requests that were filed and subsequently withdrawn in the first instance proceedings, since such a course of events clearly shows that these requests could have been presented in the first instance proceedings (cf. *inter alia*, T 361/08 of 3 December 2009, point 13 of the Reasons, and T 679/09 of 13 November 2012, point 12 of the Reasons).

5. In examination, the applicants were summoned to attend oral proceedings and informed of the provisional opinion of the examining division on the set of claims 1 to 11 filed on 29 October 2010. In reply to the summons, the applicants/appellants neither submitted substantive arguments nor filed a new set of claims, but requested a decision "according to the state of the file". Thus, the set of claims filed on 29 October 2010 underlies the decision under appeal (cf. points II and III *supra*).

6. The new set of claims 1 to 13 filed with the appellants' statement of grounds of appeal differs from the set of claims underlying the decision under appeal.

Whilst claim 1 of the set of claims underlying the decision under appeal was a combination of claims 1, 3, 5, 10 and 12 as originally filed, claim 1 of the set of claims filed with the statement of grounds of appeal is a combination of only claims 1 and 3 as originally filed. The set of claims 1 to 11 underlying the decision under appeal replaced the set of claims 1 to 15 as originally filed and, in the examining division's view, overcame objections raised under Articles 84 and 54 EPC (against claim 10 and against claims 1-2, 4-9 and 15 as originally filed, respectively) (cf. points 2 and 3 of the examining division's communication dated 15 September 2008 and point 3 of the communication dated 28 December 2010; see also points 2 and 3 of the applicants/appellants' submission dated 29 October 2010).

7. The set of claims filed with the statement of grounds of appeal reintroduces into the appeal proceedings subject-matter that was before the examining division at an earlier stage of the examination procedure and which was thereafter not further prosecuted during the examination procedure. Hence, the subject-matter claimed upon appeal does not converge to subject-matter of the claims underlying the decision under appeal, which is more restricted as compared with the subject-matter of the previous version. No reasons have been provided by the appellants to justify and/or to explain the reintroduction of this subject-matter at this stage of the proceedings and why it could not have been presented and/or further prosecuted in the first instance proceedings. This course of action is not in line with the case law referred to above.

8. The board, exercising its discretion under Article 12(4) RPBA, decides therefore not to admit the

set of claims 1 to 13 filed by the appellants with their statement of grounds of appeal, into the appeal proceedings.

9. In the absence of an allowable request, the appeal has to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

L. Malécot-Grob B. Stolz

Decision electronically authenticated