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**Datasheet for the decision  
of 29 January 2015**

**Case Number:** T 1868/12 - 3.3.06  
**Application Number:** 02293198.4  
**Publication Number:** 1302242  
**IPC:** B01J19/00, B01J4/00, B01L3/00,  
B01L11/00  
**Language of the proceedings:** EN

**Title of invention:**

Apparatus for synthesis of multiple organic compounds with  
pinch valve block

**Applicant:**

Bristol-Myers Squibb Company

**Headword:**

Apparatus for synthesis/BRISTOL-MYERS

**Relevant legal provisions:**

EPC Art. 123(2), 76(1), 84, 111(1)

**Keyword:**

Claims clarity - main request (no) - auxiliary request (yes)  
Allowability of amendments - added matter (no)  
Remittal to the department of first instance (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern  
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Chambres de recours**

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Case Number: T 1868/12 - 3.3.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.06**  
**of 29 January 2015**

**Appellant:** Bristol-Myers Squibb Company  
(Applicant) Route 206 and Province Line Road  
Princeton, NJ 08543 (US)

**Representative:** Thinat, Michel  
CABINET WEINSTEIN  
176 avenue Charles de Gaulle  
92200 Neuilly sur Seine (FR)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 20 March 2012  
refusing European patent application No.  
02293198.4 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** B. Czech  
**Members:** E. Bendl  
S. Fernández de Córdoba

## Summary of Facts and Submissions

- I. The appeal lies from the decision of the examining division to refuse the European patent application No. 02293198.4. The refused application is a divisional application of European patent application No. 98402287.1 (parent application hereinafter).
- II. In the decision under appeal, the examining division came to the conclusion that the then pending set of claims did not meet the requirements of Articles 123(2) and 84 EPC. More particularly it held that the then pending claims generalised the arrangement of the individual components defining the claimed apparatus in a way which went beyond the original disclosure.
- III. With its statement of grounds the appellant (applicant) submitted two amended sets of claims supposed to overcome the reasons given in the decision under appeal.
- IV. The appellant was summoned to oral proceedings. In the communication issued in preparation for oral proceedings the board called into question the allowability of the amended claims under Articles 123(2) and 76(1) EPC, since they appeared to contain features generalised in a non-allowable manner. The board also called into question clarity and support by the description (Article 84 EPC) of the claims on file considering *inter alia*
- that the meaning of some of the functional terms used, *inter alia* of "alignment plate (18)", was so vague and general that it was not clear to the skilled person what the claimed apparatus actually

looked like and how the different components could be used, and

- that claim 1 was ambiguous as to the possible presence of both "alternative immediate [sic] components", i.e. of a temperature control block B and an alignment plate, as parts of one and the same apparatus.

Furthermore, the board announced its intention to remit the case to the examining division for further prosecution in case the requirements of Articles 76(1), 123(2) and 84 EPC were met.

- V. With its reply dated 16 January 2015, the appellant submitted two amended claims 1 as main and auxiliary request, respectively, to replace the requests previously on file. It held that the objections raised by the board were overcome and agreed to the remittal of the case to the first instance for examination of the patentability requirements.
- VI. Said newly filed requests both consist of a single claim. Their exact wording is as follows:

*Main request(clean copy; emphasis added by the board)*

*"1. Apparatus useful for the synthesis of multiple organic compounds comprising functional components in the form of blocks and plates stacked to form the apparatus and defining at least a valve block (C), a pressure plate (14) and two alternative intermediate components comprising respectively a temperature control block (B) and an **alignment plate (18)**, the apparatus further comprising four alignment standoffs (20) cooperating with said functional components to*

align same and each comprising a shaft with three following sections of different diameters, said alignment standoffs (20) being mounted on the valve block (c), the pressure plate (14) being spaced from the valve block (C) so as to permit a plurality of reactor vessels (10) to be situated there between, characterized in that each standoff (20) has a lower, larger diameter section (22), an intermediate mid-sized diameter section (24) and a top, bullet shape section (26), the temperature control block (B), when used, resting on the lower, larger diameter sections of the standoffs (20), and the **alignment plate (18)**, when the temperature control block (B) is absent, resting on the intermediate sections as an alternative intermediate component to the temperature control block (B), wherein the pressure plate (14) is mounted above said temperature control block (B), when the temperature control block (B) is used, and above said **alignment plate (18)**, when the temperature control block (B) is absent."

Auxiliary request

"1. Apparatus useful for the synthesis of multiple organic compounds comprising functional components in the form of blocks and plates stacked to form the apparatus and defining at least a valve block (C), a pressure plate (14) of a reactor block (A) of the apparatus and two alternative intermediate components comprising respectively a temperature control block (B) and an alignment plate (18), the apparatus further comprising four alignment standoffs (20) cooperating with said functional components to align same and each comprising a shaft with three following sections of different diameters, said alignment standoffs (20) being mounted on the valve block (C), the reactor block

*(A) being adapted to retain a plurality of tube-like reactor vessels (10) , the pressure plate (14) being spaced from the valve block (C) so as to permit said plurality of reactor vessels (10) to be situated there between, the valve block (C) being for controlling the discharge from reactor vessels (10) into collection vessels of a collection block (D) of the apparatus situated under the valve block (C), the alignment plate (18), when present, having openings each of which receives a reactor vessel (10) so as to retain the reactor vessels (10) in the correct position relative to the pressure plate (14), characterized in that each standoff (20) has a lower, larger diameter section (22), an intermediate mid-sized diameter section (24) and a top, bullet shape section (26), the temperature control block (B), when used, resting on the lower, larger diameter sections of the standoffs (20), and the alignment plate (18), when the temperature control block (B) is absent, resting on the intermediate sections as an alternative intermediate component to the temperature control block (B), the pressure plate (14) receiving the top bullet shape sections of the standoffs (20) and resting on the rims of the reactor vessels (10), wherein the pressure plate (14) is mounted above said temperature control block (B), when the temperature control block (B) is used, and above said alignment plate (18), when the temperature control block (B) is absent."*

VII. The appellant requested in writing that the decision under appeal be set aside and that the patent be granted on the basis of the main request or, alternatively, on the basis of the auxiliary request, both requests submitted with letter of 16 January 2015.

VIII. Oral proceedings took place on 29 January 2015 in the absence of the appellant, as announced in its letter of 16 January 2015.

IX. The arguments of the appellant can be summarised as follows:

Articles 123(2) and 76(1) EPC

- The claims according to both requests at issue were significantly amended on the basis of the disclosure of the application as originally filed and of the parent application as originally filed to overcome the objections raised by the board.

Article 84 EPC

- The features "*valve block*", "*pressure plate*" and "*alignment plate*" were clear and gave functional definitions of the various elements of the claimed apparatus. Hence, there was no need for further clarification, and no further amendment in this respect was made in claim 1 according to the main request.
- To "*facilitate the prosecution*", claim 1 according to the auxiliary request was completed with features further explaining the function of the various blocks.

## **Reasons for the Decision**

### *1. Admissibility of the appellant's requests*

The requests at issue were filed in reaction to various objections raised by the board in its communication pursuant to Article 15(1) RPBA. They raised no new issue of particular complexity and contributed to the

convergence of the debate.

The board thus decided to admit them into the proceedings despite their late filing (Article 114(2) EPC and Article 13(3) RPBA).

*Main request*

2. The board notes that the two versions (with "tracked changes" and clean copy) of claim 1 labelled "Main Request" are not identical. They are, however, both objectionable for lack of clarity for essentially the same reason (see *infra*).
3. Clarity of claim 1 - Article 84 EPC
  - 3.1 Article 84 EPC requires that claims shall *inter alia* be clear and supported by the description. According to the established jurisprudence of the boards of appeal, claims must be clear by themselves when read by the person skilled in the art, without any reference to the content of the description.
  - 3.2 Claim 1 at issue defines an apparatus for the synthesis of multiple organic compounds comprising stacked functional components in the form of blocks and plates, including a "valve block, a "pressure plate" and either a "temperature control block" or an "alignment plate".
  - 3.3 In response to the objections of the board concerning the lack of clarity of *inter alia* these features of the then pending version of claim 1 (see IV and V, *supra*), the appellant merely stated the following:

*"The appellant is of the opinion that the features "valve block", "pressure plate" and "alignment plate"*



*are clear and give functional definitions of the various elements of the claimed apparatus. It is believed that there is no need to further define said elements, since the claim does not need to recite features that are known and understandable in the context of the claimed subject-matter. The claim (main request) recites an apparatus for synthesis of multiple organic compounds, and in such a context, the feature "valve" and "pressure plate" are perfectly clear. Furthermore, the feature "alignment plate" is also perfectly clear in the context of an apparatus formed with stacked blocks and plates. Further, the claim also recites that the blocks and plates are to be stacked and aligned to form the apparatus, and this is a clear teaching, allowing to define the scope of the claimed subject-matter."*

3.4 The board accepts that some of the functional definitions of particular components of the apparatus according to claim 1 pose no problem as to the meaning that will be given to them by the skilled person. For instance, while the function of a temperature control block and its interaction with the other parts of the claimed synthesis apparatus is at least implicitly defined by its designation, this is less apparent for a "valve block", as its function or structure in the context of the claimed apparatus is left open.

3.5 However, at least as regards the feature "alignment plate", its precise function or purpose it still not apparent, not even when considered in the context of claim 1 at issue in its entirety. Although the skilled person will understand that the function of this "plate" is to align some parts of the apparatus, it is not clear from the three references to the alignment plate comprised in claim 1 (highlighted in point VI

*supra*) which specific parts of the claimed apparatus are actually to be aligned with each other, let alone in which way, or, viewed functionally, for which purpose.

3.6 In this respect, the skilled person can only take from claim 1 at issue that the stacked plates and blocks themselves are aligned by means of the four alignment standoffs (20). For the board, even the indication, in the clean copy version of claim 1, reading "*the pressure plate being spaced from the valve block so as to permit a plurality of reactor vessels (10) to be situated there between*" does not necessarily imply a clear limitation of said "*alignment means*" to other means provided, more specifically, for the purpose of retaining the mentioned "*reactor vessels*" (of unspecified shape/construction) in the correct position relative to the pressure plate, as for instance expressly required by claim 1 according to the auxiliary request only.

3.7 These findings likewise apply to the version of claim 1 at issue in its version with "*tracked changes*", which does not even comprise the indication quoted in point 3.6.

3.8 Therefore, in the board's judgement, none of the two claims 1 labelled "*Main Request*" meets the requirement of clarity (Article 84 EPC).

3.9 Hence, the main request (both versions) is not allowable.

#### *Auxiliary request*

4. Clarity - Article 84 EPC

4.1 Considering the amendments made, the board is satisfied that claim 1 at issue is sufficiently clear for the skilled person and supported by the description. In particular, due to the incorporation of a substantial number of additional features claim 1 now clearly expresses

- (a) that the apparatus contains a reactor block adapted to retain a plurality of tube-like reactor vessels;
- (b) that the pressure plate is part of this reactor block, in the sense that it receives the top sections of the standoffs and rests on the rims of the reactor vessels;
- (c) that the valve block controls the discharge from the reactor vessels into a collection block, which is located under the valve block;
- (d) that the alignment plates, when present, have openings for receiving the reactor vessels and retaining them in the correct position relative to the pressure plate; as well as
- (e) the relative positioning of the components within the apparatus and that the apparatus either contains the temperature control block or, alternatively, the alignment plate as an intermediate component between the pressure plate and the valve block.

In the board's judgement, claim 1 no longer contains unclear or unsupported functional features.

- 5. Claim 1 according to the auxiliary request at issue thus meets the requirements of Article 84 EPC.
- 6. Allowability of the amendments - Article 123(2) EPC

- 6.1 The board is satisfied that the amended claim 1 at issue is fairly based on the contents of the application as filed, in particular on claims 1, 4, 6 and 8 to 10 in combination with the general disclosure in the description on page 10, lines 1 to 28, page 13, lines 11 to 19, page 14, lines 2 to 17 and page 15, lines 1 to 5 and 19 to 22, which is illustrated by the more specific apparatuses shown in Figures 1 to 3. Claim 1 at issue does no longer comprise unallowable intermediate generalisations of features stemming from the description and/or drawings and being inextricably linked to some further features which were not incorporated into claim 1.
- 6.2 In the board's judgement claim 1 at issue thus meets the requirements of Article 123(2) EPC.
7. Allowability of the amendments - Article 76(1) EPC
  - 7.1 The board is satisfied that claim 1 at issue is also fairly based on the contents of the parent application as filed, which contains essentially the same disclosure as the present application in its version as originally filed. Reference is made in particular to claims 33, 36, 38 in combination with the general teaching on page 18, line 19, page 21, lines 7 to 19, page 22, lines 4 to 25, page 23, lines 1 and 17 and the illustration of more preferred embodiments in Figures 1 to 3 of the parent application as filed.
  - 7.2 In the board's judgement claim 1 of the auxiliary request at issue also meets the requirements of Article 76(1), second sentence, EPC.
8. Remittal of the case

In accordance with the indication given in its communication, the board considers it appropriate to remit the case, pursuant to Article 111(1) EPC, to the department of first instance for further examination of patentability and, should the grant of a patent be envisaged, for the adaptation of the description. In its letter of 16 January 2015 the appellant explicitly agreed with this course of action.

## 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:



D. Magliano

B. Czech

Decision electronically authenticated