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**Datasheet for the decision
of 21 September 2018**

Case Number: T 0101/13 - 3.3.01

Application Number: 07836742.2

Publication Number: 2057465

IPC: G01N33/53, C12M1/00,
G01N33/574, G01N33/68

Language of the proceedings: EN

Title of invention:

ORGAN-SPECIFIC PROTEINS AND METHODS OF THEIR USE

Applicant:

Homestead Clinical Corporation
The Institute for Systems Biology

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

Amendments - extension beyond the content of the application
as filed (yes)



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 0101/13 - 3.3.01

D E C I S I O N
of Technical Board of Appeal 3.3.01
of 21 September 2018

Appellant: Homestead Clinical Corporation
(Applicant 1) 1616 Eastlake Avenue East Suite 200
Seattle WA 98102 (US)

Appellant: The Institute for Systems Biology
(Applicant 2) 1441 North 34th Street
Seattle, WA 98103-8904 (US)

Representative: Viering, Jentschura & Partner mbB
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 16 February
2012 refusing European patent application No.
07836742.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman A. Lindner
Members: R. Hauss
P. de Heij

Summary of Facts and Submissions

- I. The decision under appeal is the decision of the examining division, announced on 2 December 2011 and posted on 16 February 2012, refusing European patent application No. 07 836 742.2.

The decision was based on a sole request ("main request") filed during oral proceedings before the examining division on 2 December 2011.

In the decision under appeal, the examining division found that the combinations which were covered by the claims of the then pending request were not based on a common inventive concept, contrary to the requirements of Article 82 EPC.

- II. The applicants (appellants) lodged an appeal against that decision.

With the statement setting out the grounds of appeal the appellants submitted an amended set of five claims as their sole request. Claim 1, which is the sole independent claim of that request, reads as follows:

"1. A method for detecting the health status of an organ in a subject comprising:

a) contacting a sample of blood, serum, or plasma from the subject with a panel of at least 10 detection reagents wherein said each detection reagent detects a different organ-specific protein which organ-specific protein is predominantly expressed in said organ,

b) measuring the amount of the organ-specific protein detected in the sample by each detection reagent; and

c) comparing the amount of the organ-specific protein detected in the sample by each detection reagent to a predetermined normal control amount for each respective organ-specific protein; wherein a statistically significantly altered amount in one or more of the organ-specific proteins in the sample indicates an unhealthy status of said organ in said subject."

The appellants requested that the decision under appeal be set aside and that a patent be granted on the basis of the new set of claims.

III. In a communication pursuant to Rule 100(2) EPC the board advised the appellants of its provisional opinion, mentioning the following points:

- (a) The appellants were invited to indicate the basis for the current claims in the application as filed (Article 123(2) EPC). Since none of the claims in the application as filed related to a "method for detecting the health status of an organ in a subject", as defined in claim 1 of the current request, the board considered that the required basis could not be found in the claims as filed, or in the corresponding passages on page 5, line 6 to page 11, line 9 of the description).
- (b) The decision under appeal concerned only the objection raised under Article 82 EPC against the then pending request. That request had however been replaced by an amended set of claims. If, in the outcome, the appeal was not dismissed for non-compliance with Article 123(2) EPC, the board would be inclined to remit the case to the examining division for further prosecution

(Article 111(1) EPC). Since the appellants had not requested remittal but the grant of a patent on the basis of the new set of claims, they were invited to state whether they wished to introduce, as their highest-ranking request, a request to the effect that the decision under appeal be set aside and the case be remitted to the examining division.

- IV. In their letter of reply, the appellants maintained their request that the decision under appeal be set aside and that a patent be granted on the basis of the new set of claims. The appellants furthermore requested that the case not be remitted to the examining division but be decided by the board.

With regard to the amendments, the appellants indicated, without any further explanation, that the basis for claim 1 was to be found in claims 50, 55, 60, 73, 78, 79 and several passages of the description (viz. page 138, lines 23 to 27; page 140, lines 11 to 12 and page 208, lines 12 to 20).

- V. The board issued a summons to attend oral proceedings. In a communication annexed to the summons the board indicated, *inter alia*, that it was of the preliminary opinion that claim 1 of the current request did not comply with the requirements of Article 123(2) EPC, since the claims and passages of the original application referred to by the appellants did not add up to a direct and unambiguous disclosure of the subject-matter of claim 1.

- VI. In a letter dated 17 September 2018 the appellants advised that they withdrew their request for an oral hearing, would not be attending the oral proceedings scheduled for 21 September 2018 and requested that the

board decide on the merit of the case based on the state of the file.

- VII. Oral proceedings were held on 21 September 2018 in the absence of the appellants, in accordance with Article 15(3) RPBA and Rule 115(2) EPC.

Reasons for the Decision

1. Admissibility of the appeal

The appeal complies with Articles 106 to 108 EPC and Rule 99 EPC and is therefore admissible.

2. Amendments (Article 123(2) EPC)

- 2.1 Each of claims 50, 55, 60, 73, 78, 79 in the application as filed is an independent claim. None of those claims is directed to a method for detecting the health status of an organ in a subject, or describes a step of contacting a sample with a panel of at least 10 detection reagents for organ-specific proteins not restricted to certain organ-specific protein sets. The only mention of the "state of health in an organ" occurs in the isolated passage on page 138 cited by the appellants. The appellants did not provide any explanation at all why those claims (and the further passages cited in the description) could nevertheless be combined, and how those formally unrelated claims and passages might add up to a direct and unambiguous disclosure of the combination of technical features defined in current claim 1.

- 2.2 As a consequence, the board concludes that claim 1 of the sole pending claim request does not meet the requirements of Article 123(2) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. Schalow

A. Lindner

Decision electronically authenticated