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**Datasheet for the decision
of 16 December 2013**

Case Number: T 1060/13 - 3.5.05

Application Number: 02764326.1

Publication Number: 1390900

IPC: G06F19/00, G01N33/48

Language of the proceedings: EN

Title of invention:

Systems and methods for testing a biological sample

Applicant:

SEQUENOM, INC.

Headword:

Real-time processing of biological samples/SEQUENOM

Relevant legal provisions:

EPC 1973 Art. 109, 111(1)
EPC Art. 123(2)
RPBA Art. 20(2)
Guidelines for examination, E-X, 7

Keyword:

Added subject-matter - main request (no, after amendment)
Obligation to grant interlocutory revision - (yes)
Immediate remittal to department of first instance - (yes)
Inconsistency between Guidelines and Case Law

Decisions cited:

G 0003/03, J 0032/95, T 0139/87, T 0047/90, T 0219/93,
T 0647/93, T 0180/95, T 0794/95, T 0919/95, T 0041/97,
T 0685/98, T 0704/05, T 1640/06, T 0726/10, T 1034/11,
T 1994/11, T 2528/12

Catchword:

See point 4



**Beschwerdekammern
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Case Number: T 1060/13 - 3.5.05

**D E C I S I O N
of Technical Board of Appeal 3.5.05
of 16 December 2013**

Appellant: SEQUENOM, INC.
(Applicant) 3595 John Hopkins Court
San Diego,
California 92121 (US)

Representative: Boulton Wade Tennant
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 11 December 2012 refusing European patent application No. 02764326.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair: A. Ritzka
Members: K. Bengi-Akyuerek
G. Weiss

Summary of Facts and Submissions

I. The appeal is against the decision of the examining division, posted on 11 December 2012, to refuse European patent application No. 02764326.1 on the grounds of added subject-matter (Article 123(2) EPC) as a sole ground for refusal with respect to a main request and a first auxiliary request, and lack of clarity with respect to a second auxiliary request.

In an *obiter dictum*, the decision under appeal also stated that the main request as well as the auxiliary requests lacked clarity and support by the description (Article 84 EPC), and lacked sufficient disclosure (Article 83 EPC).

II. Notice of appeal was received on 8 February 2013. The appeal fee was paid on the same day. With the statement setting out the grounds of appeal, received on 18 April 2013, the appellant filed amended claims according to a new main request (claims 1 to 7), based on the former first auxiliary request, a first auxiliary request (claims 1 to 5), and a second auxiliary request (claim 1). It requested that the decision under appeal be set aside and that a patent be granted on the basis of the main or any of the auxiliary requests. The appellant further requested that the case be remitted back to the examining division for any issues not yet considered by the examining division. In addition, oral proceedings were requested as an auxiliary measure.

III. By EPO Form 2701 of 29 April 2013, the examining division ordered that the decision under appeal would not be rectified and that the case was to be referred

to the Board of Appeal without delay.

IV. Claim 1 of the main request reads as follows:

"A system for obtaining and displaying real time results of assays performed on biological samples, comprising:

a mass spectrometer instrument for data acquisition from the biological samples; and

a processor that includes software for data collection and data processing to assess the collected data, wherein the software for data collection and data processing are integrated so that real-time results of the assays are used in directing operation of the mass spectrometer for data acquisition."

Reasons for the Decision

1. The appeal is admissible.
2. MAIN REQUEST

This request differs from the first auxiliary request underlying the appealed decision, apart from minor re-wordings and claim re-numberings, essentially in that

- A) the feature "to determine testing is needed" has been removed from **claim 1**;
- B) the features of former claims 3 and 4 have been completely deleted;
- C) the feature "the output of the results of the assays is a diagnosis" of former claim 6 has been changed to "the real time results comprise a diagnosis" in present **claim 4**;

- D) the feature "the diagnosis is based upon a genotype or allelic frequency" of former claim 7 has been changed to "the real time results comprise a genotype or an allelic frequency" in present **claim 5**;
- E) the newly added **claim 6** further specifies that "the software for data collection controls data acquisition by the mass spectrometer and determines if data is of suitable quality for data processing".

2.1 Article 123(2) EPC

The examining division held with regard to the former first auxiliary request that previous claims 1, 3, 4, 6, and 7 did not fulfil the requirements of Article 123(2) EPC (cf. appealed decision, section 2).

- 2.1.1 As to former claim 1, the wording of claim 1 with respect to the feature "to determine if repeated testing is needed" could not be readily understood and it was unclear from the claim who is "determining if repeated testing is needed", i.e. which of the technical components of claim 1 is performing the determination. It was also unclear how this feature fits into the functionality of the claim, i.e. whether or not it is part of the "directing operation" of the mass spectrometer.

By way of amendment A), i.e. removing the above feature, this objection has been clearly overcome.

- 2.1.2 As to former claims 3 and 4, the passages of the original disclosure, cited by the applicant, did not relate to the same features as in those claims.

By way of amendment B), i.e. deleting the features of these claims, those objections have been clearly overcome.

- 2.1.3 As to former claim 6, the passage of the original application, cited by the applicant (appellant), did not correspond to the claimed features.

By way of amendment C), this objection has been clearly overcome (cf. application as filed, page 4, line 29 to page 5, line 5: "... The data collection and data processing routines are integrated so that tests are performed on a sample and the output from an instrument that includes such integrated software is a diagnosis ...").

- 2.1.4 As to former claim 7, the diagnosis according to the original application was presented as being an alternative to genotype or allelic frequency, not as a derivation from them.

By way of amendment D), this objection has been clearly overcome (cf. application as filed, page 5, lines 2-5: "... a system that displays ... real time biological results, such as a genotype and allelic frequency.").

- 2.1.5 In conclusion, the examining division should have considered the objections under Article 123(2) EPC raised in the decision under appeal as manifestly overcome.

- 2.1.6 Furthermore, amendment E), which is related to an entirely new feature, is also fully supported by the application as filed (cf. page 8, line 28 to page 9, line 2: "... a data collection routine refers to a process, that can be embodied in software, that

controls data acquisition by an instrument, such as a mass spectrometer ... and determines if output data ... is of suitable quality for analysis ...") and is therefore also allowable within the meaning of Article 123(2) EPC.

- 2.1.7 Following the above amendments, the board therefore concludes that the above objections under Article 123(2) EPC no longer apply and that thus the subject-matter of the main request does not extend beyond the content of the application as filed.
- 2.2 Since the sole ground for the refusal with respect to the former main and first auxiliary request is considered to be remedied by the new main request, the board finds that the appeal is considered allowable. Consequently, the decision under appeal is to be set aside.
3. *Request for grant of a patent*
 - 3.1 The appellant requested that a patent be granted on the basis of the main or any of the auxiliary requests (cf. point II above). In the decision under appeal, the issues of novelty and inventive step (Articles 54 und 56 EPC 1973) were neither decided nor discussed in any form, having regard to the cited prior art. In these circumstances, the board is presently not in a position to pass final judgment on the patentability of this case, in particular on novelty and inventive step, with respect to the claims in question.
 - 3.2 For the above reasons, the board cannot accede to the appellant's request for grant of a patent based on any of the main or auxiliary requests at this stage.

3.3 As the appealed decision has to be set aside by reason of the new main request alone (cf. point 2.2 above) and since the board cannot proceed to assess novelty and inventive step of the underlying subject-matter, it is neither necessary nor appropriate to consider the present auxiliary requests.

4. *Immediate remittal to the department of first instance*

4.1 Article 109(1) EPC 1973 (applicable here as the application was filed before 13 December 2007; see e.g. J 10/07, point 1) stipulates that, if the department whose decision is contested considers the appeal to be admissible and well founded, it **shall** rectify its decision. The main purpose of this provision is to shorten the appeal proceedings to the benefit of procedural expediency and economy and to avoid unnecessary workload for the Boards of Appeal in the interest of both the appellant and the EPO (cf. G 3/03, OJ EPO 2005, 344, point 2; J 32/95, OJ EPO 1999, 713, point 2.2.3; T 919/95 of 16 January 1997, point 2.1).

It is established case law of the Boards of Appeal that, in the event that the appeal is objectively to be considered as admissible and well founded, the first-instance department is obliged to grant interlocutory revision (cf. T 139/87, OJ EPO 1990, 68, point 4; T 180/95 of 2 December 1996, point 3; T 2528/12 of 12 April 2013, point 3.1). Hence, if the appeal is admissible and clearly well founded, there is no room for discretion of the first-instance department in applying the provision of Article 109 EPC 1973 in order to rectify its decision. In this context, an appeal is to be considered "well founded" if at least the main request submitted with the appeal includes amendments which clearly meet the objections on which

the decision relies, such that the first-instance department could reasonably be expected to recognise this and thus rectify its decision. That there are other objections which have not been removed but which were not the subject of the contested decision cannot preclude the application of Article 109(1) EPC 1973 (cf. T 139/87, point 4; T 47/90, OJ EPO 1991, 486, point 6; T 219/93 of 16 September 1993, point 4; T 919/95, point 2.1, second paragraph). Thus, even if the amendments raise new objections not yet discussed, interlocutory revision must be allowed since an applicant should have the right to examination at two instances.

4.2 Moreover, objections or remarks made in an *obiter dictum* of a decision under appeal cannot be taken into account in deciding whether or not to grant interlocutory revision, since they are to be regarded as voluntary information to an applicant on the preliminary opinion of the first-instance department and therefore do not form part of the grounds for refusal (see e.g. T 1640/06 of 15 June 2007, point II; T 726/10 of 6 September 2013, point 9). In this regard, the board thus cannot follow the conclusion reached in decision T 1034/11 that the first-instance department could regard objections raised in an *obiter dictum* of the appealed decision as being an integral part of the reasons for refusing an application in the event of interlocutory revision being denied (cf. T 1034/11 of 30 November 2012, point 5.2).

4.3 The obligation to grant interlocutory revision in certain, well-defined circumstances is, in principle, also clearly reflected in the Guidelines for Examination in the European Patent Office in the applicable version of June 2012 (cf. E-X, sections 7.1

and 7.4). However, pursuant to Article 20(2) RPBA, the board considers it appropriate to point out that there are some inconsistencies between the Guidelines and the established case law as to the interpretation of Article 109 EPC 1973. According to those Guidelines, "interlocutory revision should not be granted" if amendments made to the independent claims "clearly do not meet the requirements of Art. 123(2)" EPC or, in the affirmative, if the amended claims fail to overcome the grounds for refusal "as well as all previous objections to patentability to which the applicant has had an opportunity to respond" such as "objections mentioned in an *obiter dictum* of the decision, or objections mentioned in previous communications, during personal consultation or at oral proceedings" (cf. E-X, section 7.4.2, first and fifth paragraphs). Conversely, based on the established case law, interlocutory revision **must** be granted if the amendments clearly overcome the grounds for refusal, *even if* further new objections arise (which is also reflected in E-X, section 7.4.2, second paragraph, thereby also giving rise to an inconsistency within the Guidelines themselves), i.e. irrespective of whether new objections under Article 123(2) EPC or whether previous objections or objections mentioned in an *obiter dictum* were raised by the first-instance department. The above applies equally to the Guidelines in the current version of September 2013.

- 4.4 Despite the fact that the board may only speculate as to the actual reasons on the basis of which interlocutory revision of an appealed decision was not granted by the first-instance department, given that it is bound to silence as to its grounds pursuant to Article 109(2) EPC 1973 ("without comment as to its merit"), refusing interlocutory revision in the case of

an admissible and well founded appeal constitutes a violation of the duty to grant interlocutory revision in such a case and thus a breach of the principle of procedural efficiency (contrary to the finding in T 704/05 of 31 July 2007, point 5.3).

4.5 It is well worth noting that, normally, failure to grant interlocutory revision cannot in itself be regarded as a substantial procedural violation within the meaning of Rule 103 EPC (see e.g. T 794/95 of 7 July 1997, point 5), since wrongly refusing interlocutory revision in the event of an admissible and well founded appeal - after the appeal has been lodged - may self-evidently neither have substantially affected the appealed decision nor be causally linked with the filing of an appeal, as it is also true in the present case. However, denying rectification of a first-instance decision which itself was tainted with a substantial procedural violation (see e.g. T 647/93, OJ EPO 1995, 132, point 2.6; T 685/98, OJ EPO 1999, 346, point 6.2) or refusing interlocutory revision before receipt of the statement setting out the grounds of appeal (cf. T 41/97, point 4; T 1994/11 of 5 October 2012, point 3; T 1891/07 of 13 March 2009, point 1.2) may amount to a substantial procedural violation at the stage of interlocutory revision.

4.6 In the present case, the objections raised under Article 123(2) EPC were the sole ground for refusal with respect to the former main and first auxiliary requests according to the decision under appeal (cf. point I above). In response to those objections, the appellant has manifestly overcome those defects by the amendments made, i.e. by deleting the previous main request and by removing and/or amending the contested features in the respective claims of the previous first

auxiliary request with the - undoubtedly admissible - appeal. This has resulted in a new main request. Consequently, the examining division should have objectively considered the appeal "admissible and well founded". Pursuant to Article 109(1) EPC 1973, it therefore had the obligation to grant interlocutory revision in this case. However, for whatever reasons, it did not do so (cf. point III above).

4.7 As a consequence, the examining division's refusal of interlocutory revision represents a clear breach of Article 109(1) EPC 1973 under the given circumstances. Moreover, the board finds that, due to the infringement of Article 109(1) EPC 1973, the Boards of Appeal has had unnecessarily to deal with this case, with negative consequences for procedural efficiency.

4.8 From all the above it follows that an immediate remittal of the case to the department of first instance is the most appropriate course of action in this case. Furthermore, no special reasons against a remittal are apparent to the board, since no substantial delay in the present appeal proceedings has been incurred due to the relatively expeditious treatment of this case and, moreover, since the appellant conditionally requested such a remittal, i.e. did not object to any remittal to the first instance (cf. point II above).

4.9 In conclusion, the board has decided to remit the case immediately - without any further examination as to its merits - to the department of first instance for further prosecution pursuant to Article 111(1) EPC 1973, based on the main request as filed with the statement setting out the grounds of appeal.

5. *Request for oral proceedings*

Since the board intends to allow (at least some of) the appellant's higher-ranking requests, there has been no need to appoint oral proceedings, which were only requested on an auxiliary basis in the present case.

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 Chair:



K. Götz

A. Ritzka

Decision electronically authenticated