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Datasheet for the decision of 10 February 2017

Case Number: T 0491/14 - 3.3.05

Application Number: 06120851.8

Publication Number: 1795263

IPC: B01L3/00

Language of the proceedings: EN

Title of invention:
Method for removing a fluid from a vessel comprising a penetrable cap

Patent Proprietor:
GEN-PROBE INCORPORATED

Opponents:
Germann, Sandra
Becton, Dickinson and Company

Headword:
Method for removing a fluid/GEN-PROBE

Relevant legal provisions:
EPC Art. 54(1), 54(2), 56

Keyword:
Novelty - main, first and fourth auxiliary requests (no)
Inventive step - second and third auxiliary requests (no)

Decisions cited:

Catchword:

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Case Number: T 0491/14 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 10 February 2017

Appellant: (Patent Proprietor)	GEN-PROBE INCORPORATED 10210 Genetic Center Drive San Diego, CA 92121-4362 (US)
Representative:	Hallybone, Huw George Carpmaels & Ransford LLP One Southampton Row London WC1B 5HA (GB)
Respondent: (Opponent 1)	Germann, Sandra Silcherstrasse 20 40593 Düsseldorf (DE)
Representative:	Gille Hrabal Postfach 18 04 09 40571 Düsseldorf (DE)
(Opponent 2 - opposition withdrawn)	Becton, Dickinson and Company One Becton Drive Franklin Lakes, New Jersey 07417-1880 (US)
Representative:	Molnia, David Df-mp Dörries Frank-Molnia & Pohlman Patentanwälte Rechtsanwälte PartG mbB Theatinerstrasse 16 80333 München (DE)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 6 December 2013 concerning maintenance of the European Patent No. 1795263 in amended form.**

Composition of the Board:

Chairman	E. Bendl
Members:	A. Haderlein
	O. Loizou

Summary of Facts and Submissions

I. The present appeal of the proprietor (appellant) lies from the opposition division's interlocutory decision finding that European patent No. 1 795 263 in amended form and the invention to which it relates meet the requirements of the EPC.

II. The opposition division held that the ground for opposition according to Article 100(b) EPC did not prejudice the maintenance of the patent, whereas the ground for opposition according to Article 100(c) EPC did prejudice the maintenance of the patent as granted. The subject-matter of claim 1 of the first auxiliary request underlying the impugned decision was said to lack novelty, whereas the claims according to the second auxiliary request were found to comply with the requirements of the EPC. In particular, their subject-matter was found to be novel in view of

E1: WO 00/69389 A2.

III. Opponent 2 withdrew its opposition before the appellant filed its notice of appeal.

IV. With its grounds of appeal, the appellant filed a main request, corresponding to the first auxiliary request underlying the impugned decision, and an auxiliary request.

V. The board issued a communication pursuant to Article 15(1) RPBA setting out its preliminary opinion.

VI. With its letter dated 7 October 2016, the appellant filed three auxiliary requests and declared its previously filed auxiliary request to be its fourth

auxiliary request. It also filed amended description pages comprising columns 3, 4, 7 to 10 and 13 to 18.

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

"1. A method for removing a fluid substance (100) from a closed system (10) comprising a cap having affixed first and second frangible seals (32, 34A), the first seal (32) being axially aligned with and positioned below the second seal (34A), and a fluid-holding vessel (20) having an open end in sealing engagement with the cap, the method comprising the steps of: penetrating the first and second seals (32, 34A) of the cap with a fluid transfer device (90) so that the first and second seals (32, 34A) tear, thereby forming air passageways (70), between the fluid transfer device (90) and the first and the second seals (32, 34A); drawing at least a portion of the fluid substance (100) into the fluid transfer device (90); and removing the fluid transfer device (90) from the system (10)."

VIII. Claims 1 of the first to fourth auxiliary requests correspond to claim 1 of the main request with the following additional features:

First auxiliary request: ", thereby permitting air to be vented from an interior space of the system;" inserted between "between the fluid transfer device (90) and the second seals (32, 34A)," and "drawing at least a portion...";

Second auxiliary request: ", wherein the first seal is not an integral component of the cap," inserted between "below the second seal (34A)" and "and a fluid-holding vessel (20)";

Third auxiliary request: comprising the additional features of the first and the second auxiliary requests;

Fourth auxiliary request: "; wherein the fluid transfer device (90) is a plastic pipette tip for use with an air displacement pipette" inserted at the end of claim 1.

IX. The appellant's arguments may be summarised as follows:

Main request

The subject-matter of claim 1 was new over E1 because an integrally formed seal as disclosed in E1 was not encompassed by the feature "affixed". In particular, the latter expression should be construed such as to refer to a product that was obtained by affixing two previously separate parts together. Therefore, this expression did not encompass an integrally formed seal as in E1.

First and fourth auxiliary requests

The additional features of claim 1 of the first and fourth auxiliary requests, as compared to the main request, were disclosed in E1. Therefore, the same arguments as for the main request applied.

Second auxiliary request

The subject-matter of claim 1 was novel over E1 because in the latter document the first seal was an integral component of the cap. While E1 could be considered to represent the closest prior art, it was not obvious to arrive at the subject-matter of claim 1. The skilled

person faced with the problem of providing an improved method for removing a fluid substance while having the cap sealably remain on the vessel would not make the second seal of E1 a non-integral component of the cap. In particular, the first seal was a central feature of the cap of E1, and there was no incentive in E1 or in any other document to replace it and to make it a non-integral component of the cap.

Third auxiliary request

The additional features of claim 1 of the third auxiliary request were disclosed in E1. Therefore, the same arguments as for the second auxiliary request applied.

X. The arguments of the respondent (opponent 1) may be summarised as follows:

Main, first and fourth auxiliary requests

The subject-matter of claims 1 was not new over E1 because the expression "affixed" also encompassed an integrally formed seal as disclosed in E1.

Second and third auxiliary requests

While the subject-matter of claim 1 was novel over E1 because of the feature "wherein the first seal is not an integral component of the cap", it did not involve an inventive step. The problem of providing an improved method for removing a fluid substance while having the cap sealably remain on the vessel was already solved in E1. Thus, the problem to be solved was to provide an alternative method. Solving this problem by providing the first seal as a non-integral component of the cap

was however obvious in view of E1 alone.

XI. Requests

The appellant requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the set of claims of the main request as filed with the statement of grounds of appeal or, in the alternative, on the basis of the set of claims of one of the first to third auxiliary requests filed with letter dated 7 October 2016 or the fourth auxiliary request (previously the sole auxiliary request) filed with its statement of grounds of appeal, all requests comprising amended description pages comprising columns 3, 4, 7 to 10and 13 to 18, as filed with letter dated 7 October 2016.

The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. Main request - novelty

1.1 E1 discloses a method for removing a fluid from a closed system (see in particular Figure 6) comprising a cap having first (33) and second (80) seals. Apart from the feature "affixed", the appellant does not contest that all features of claim 1 are disclosed in E1. Conversely, the respondent argues that E1 discloses all features of claim 1 of the main request in common.

1.2 In this respect the appellant essentially argued that the first seal (33) of E1, being an integral component of the cap, cannot be said to be "affixed" to the cap. This expression implied a device that was obtained by affixing or coupling two separate parts which are in

existence before being affixed or coupled. In contrast, a cap comprising a first seal integrally formed with the cap as in E1 was obtained by forming the seal and the cap in a single step. Moreover, as the passage in paragraph 0034 (lines 13 et seq.) in the description as granted suggesting that claim 1 also encompassed caps with an integrally formed first seal had been deleted, claim 1 should be construed such that it did not cover such a configuration.

1.3 The board is not persuaded by this argument. Claim 1 refers to a "cap having affixed first and second frangible seals". Nothing in the claim indicates that this expression is to be construed so narrowly as to read "being obtained by affixing (separate) first and second seals to the cap". Rather, the contentious expression refers to the cap in the state when it is used in the method according to claim 1. This means that it also extends to caps having a first seal being integrally formed with and thereby being affixed to the cap. Since in E1 the first seal (33) is integrally formed with the cap (see in particular Figure 6), E1 discloses "a cap having affixed first and second frangible seals". The board arrives at this conclusion even without taking the description into account, using only the general meaning of the term at issue. Therefore whether parts of the description are deleted or amended does not affect the board's findings.

1.4 The board thus concludes that the subject-matter of claim 1 is not new in view of E1 (Article 54(1), (2) EPC).

1.5 For the sake of argument, the board notes that, even if the contentious expression were construed as narrowly as submitted by the appellant, i.e. with the expression

"affixed" being construed as referring to a configuration in which the first seal is not an integral component of the cap, the subject-matter of claim 1 would lack inventive step (see point 3 *infra*).

2. First auxiliary request - novelty

The appellant does not contest that the additional features of claim 1 of the first auxiliary request ("thereby permitting air to be vented ...") are also disclosed in E1. Thus, the method according to claim 1 of the first auxiliary request is not new for the same reasons as for the main request (see point 1 *supra*).

3. Second auxiliary request - inventive step

3.1 The invention concerns a method for removing a fluid substance from a closed system.

3.2 It is common ground among the parties that E1 can be considered the closest prior art. E1 relates to caps which are penetrable by a fluid transfer device used to transfer fluids to or from a fluid-holding vessel, where the vessel and cap remain physically and sealably associated during the fluid transfer (page 1, lines 9 to 14). E1 discloses a method for removing a fluid substance from a closed system comprising a cap having a first frangible seal (33) which is an integral component of the cap and having affixed a second frangible seal (80).

3.3 According to the patent in suit, the problem to be solved was to improve a method for removing a fluid substance from a closed system in order to avoid any potential contamination (paragraph [0010]). According to the appellant, the problem to be solved was to

improve a method for removing a fluid substance from a vessel while maintaining the cap sealably on the vessel. Further according to the appellant, the method according to claim 1 had the advantage of providing for the possibility of having the first seal made of a different material.

3.4 The patent proposes to solve this problem by a method for removing a fluid substance from a closed system according to claim 1 of the main request, characterised in that the first seal is not an integral part of the cap.

3.5 As to the success of the solution, the board observes that the problem mentioned in the patent in suit and the problem referred to by the appellant (see point 3.3 *supra*) are already solved in E1. According to E1, potential contamination due to aerosols is avoided (see in particular page 3, lines 13 et seq., and page 4, lines 5 et seq.). Also, the problem of providing a method for removing a fluid substance from a vessel while maintaining the cap sealably on the vessel is already solved in E1 because it allows for having the cap remain sealably on the vessel (page 1, lines 11 to 13). It follows that the method according to claim 1 does not provide an improvement in this respect. Furthermore, the board does not agree with the appellant that an advantage of the method according to claim 1 resided in the possibility of having the first seal made of a material different from that of the cap, because the method according to claim 1 still encompasses configurations in which the first seal is made of the same material as the cap itself.

3.6 The problem to be solved therefore needs to be reformulated and consists in the provision of an

alternative method for removing a fluid from a closed system.

3.7 As to obviousness, the board finds that the skilled person faced with the problem of providing an alternative method, i.e. with the least ambitious problem to be solved, would readily consider providing the first seal of E1 as a non-integral component of the cap.

3.7.1 The skilled person would consider this possibility in particular in view of the fact that the cap disclosed in E1 comprises inner and outer walls between which the vessel's rim is snap-fitted (see Figure 6). Using a process such as injection moulding to manufacture the cap might, depending on the circumstances, require the inner wall to be manufactured along with the first seal as a separate component, which would then be affixed to the cap. Reference is also made to page 4, lines 13 et seq., of E1, where it is explicitly stated that affixing using a fixing agent such as an adhesive is an alternative to integrally forming the components by moulding. It was therefore obvious to the skilled person to arrive at the claimed subject-matter in view of document E1 alone.

3.7.2 The board agrees with the appellant to the extent that the conical first seal of E1 is indeed one of its central features, and the skilled person would therefore not replace it. But as set out above, the skilled person would arrive at the subject-matter of claim 1 in an obvious way even without replacing the first seal of E1.

3.8 As a consequence, claim 1 of the main request does not comply with the requirement set forth in

Article 56 EPC.

4. Third auxiliary request - inventive step

The appellant does not contest that the additional features of claim 1 of the first auxiliary request ("thereby permitting air to be vented ...") are also disclosed in E1. Thus, the method according to claim 1 of the third auxiliary request does not involve an inventive step for the same reasons as for the second auxiliary request (see point 3 *supra*).

5. Fourth auxiliary request - novelty

The appellant does not contest that the additional features of claim 1 of the fourth auxiliary request ("wherein the fluid transfer device (90) is ...") are also disclosed in E1. Thus, the method according to claim 1 of the fourth auxiliary request is not new for the same reasons as for the main request (see point 1 *supra*).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

C. Vodz E. Bendl

Decision electronically authenticated