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**Datasheet for the decision
of 1 March 2019**

Case Number: T 1167/17 - 3.3.05

Application Number: 04770390.5

Publication Number: 1663497

IPC: B01L7/00, B01L3/00, C12Q1/68

Language of the proceedings: EN

Title of invention:
A MICROFLUIDIC ANALYSIS SYSTEM

Patent Proprietor:
Stokes Bio Limited

Former Opponent:
Molnia, David

Headword:
Microfluidic analysis system/Stokes

Relevant legal provisions:
EPC Art. 123(2), 123(3), 111(1)

Keyword:
Amendments - allowable (yes)
Appeal decision - remittal to the department of first instance
(yes)

Decisions cited:

Catchword:



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Case Number: T 1167/17 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 1 March 2019

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 27 March 2017
revoking European patent No. 1663497 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman A. Haderlein
Members: G. Glod
O. Loizou

Summary of Facts and Submissions

- I. The appeal lies from the decision of the opposition division revoking European patent EP 1 663 497 B1. The opposition division held that the requests underlying the impugned decision did not comply with the requirements of Article 123(2) or (3) EPC.
- II. With the statement of grounds of appeal, the appellant (patent proprietor) filed a main request (patent as granted) and several auxiliary requests.
- III. In a communication under Article 15(1) RPBA, the board was of the preliminary opinion that the main and first to third auxiliary requests were not allowable under Article 123(2) and/or (3) EPC, while the fourth auxiliary request appeared to meet the requirements of this article.
- IV. On 25 January 2019 the opponent withdrew its opposition. Previously, by letter dated 10 October 2018, it had informed the board that it would not attend oral proceedings.
- V. On 14 February 2019 the appellant filed a new main request, which was identical to the previous fourth auxiliary request, and new first to fourth auxiliary requests and withdrew all previously filed requests.

The only independent claim of the main request is as follows:

"1. A biological sample analysis system (11) comprising: a carrier fluid supply (4); a sample supply; a channel; a sample preparation stage (6, 7) for providing in the channel a flow of sample enveloped

in a primary carrier fluid, said primary carrier fluid being biologically non-reactive; at least one analysis (9, 10) stage for performing analysis of the sample while controlling flow of the sample while enveloped within the primary carrier fluid without the sample contacting a solid surface; a controller (2) for controlling the system, including controlling flow of the sample while enveloped within the primary carrier fluid without the sample contacting a solid surface."

VI. The appellant requested that the impugned decision be set aside and that the patent be maintained in amended form on the basis of the main request or of one of the first to fourth auxiliary requests submitted on 14 February 2019. By its letter of 25 February 2019, with reference to the board's preliminary opinion, it conditionally withdrew its request for oral proceedings.

VII. The oral proceedings scheduled to be held on 1 April 2019 were cancelled.

Reasons for the Decision

Main request

1. Article 123(2) EPC

The only point under debate was claim 1. The requirements of Article 123(2) EPC are met for the following reasons:

Claim 1 is directly and unambiguously derivable from the following passages of the application as filed:

Claims 1 and 16 as filed, page 2, lines 4 to 11, and page 5, lines 26 and 27, from which it is clear that the system contains a channel, since the goal of the system is to avoid contamination of the channel surfaces. The board agrees with the opposition division that the enveloped sample is prepared in the preparation stage and that consequently said sample is provided in the channel (see impugned decision, page 4, first paragraph). Page 5, lines 17 and 18, in combination with figure 2 of the application as filed, mentions that the controller is active at all stages.

The board disagrees with the opposition division regarding the last feature of claim 1, which reads "including controlling flow of the sample while enveloped within the primary carrier fluid without the sample contacting a solid surface".

The controller interfaces with various stages (page 5, lines 17 and 18). Claim 1 as filed and current claim 1 indicate that at the analysis stage the flow of the sample is controlled while enveloped within the primary carrier fluid. The skilled person understands that the controller must be able to exercise this control.

The enveloping of the sample in the carrier fluid occurs at the sample preparation stage and in particular in the centrifuge device (see figure 2). Control of the flow of the sample while enveloped can thus only start at the earliest at the outlet of the centrifuge. It is unambiguously derivable from the application as filed that the controller is able to control the fluid from the outlet of the centrifuge until the last stage of the system (optical detection), which is reflected in the last feature of claim 1. The macro pump 5 delivers the carrier fluid to the

centrifuge, which allows adjustment of the centrifugal force (page 6, line 21), which as a consequence allows adjustment of the flow leaving the sample preparation stage. Furthermore, the flow controller 7 is also suitable for controlling the flow of the enveloped sample (page 5, lines 21 to 23). The board does not share the conclusion reached by the opposition division that the current wording of claim 1 also requires the controller to control the flow of the sample at the sample preparation stage but that this was not disclosed in the application as filed (see decision under appeal, paragraph bridging pages 7 and 8). This is because the passage cited by the opposition division (page 3, line 9) in fact relates to the preparation of the enveloped sample and not to the "sample while enveloped" as referred to in current claim 1.

2. Article 123(3) EPC

Claim 1 has been restricted by limiting the feature relating to the analysis stage. The requirements of Article 123(3) EPC are therefore met.

3. Article 111(1) EPC

The impugned decision was based only on Article 123(2) and (3) EPC. Only this article was under debate during the appeal proceedings. The board therefore considers it appropriate to remit the case to the opposition division for further prosecution.

Since the opposition has been withdrawn, on remittal the opposition division will need to decide whether to pursue the former opponent's objections raised with respect to other provisions.

The remittal should not be taken as indicative of the conclusion to be reached in this respect.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



C. Vodz

A. Haderlein

Decision electronically authenticated