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D E C I S I O N
of 21 November 1996

Case Number: T 0058/94 - 3.4.2

Application Number: 86305615.6

Publication Number: 0210071

IPC: G02B 21/34

Language of the proceedings: EN

Title of invention:
Microscope inspection slide

Patentee:
Hycor Biomedical, Inc.

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
"Main and first to third auxiliary requests: subject-matter extended: yes"
"Fourth auxiliary request: subject-matter extended: no"

Decisions cited:
T 0331/87 (HOUDAILLE/Removal of feature, OJ 1991, 22 and
T 0066/85 (AMP/connection, OJ 1989, 167)

Catchword:
-



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Boards of Appeal

Chambres de recours

Case Number: T 0058/94 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 21 November 1996

Appellant: Hycor Biomedical, Inc.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 07 September 1993
refusing European patent application
No. 86 305 615.6 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: E. Turrini
Members: M. Chomentowski
B. J. Schachenmann

Summary of Facts and Submissions

I. European patent application No. 86 305 615.6 (publication No. 0 210 071) was refused on the grounds that the submitted form of the application, which is now the appellant's (applicant's) **main request**, resulted from amendments such that it extended beyond the content of the application as filed. Claim 1 reads as follows:

"1. A slide for use in the examination of a liquid specimen, said slide (10) comprising:

a base plate (14) having at least one flat examination chamber floor surface (16), said examination chamber floor surface being raised above an upper deck surface (20) of said base plate,

a cover plate (12) having at least one flat examination chamber roof surface (24), said examination chamber roof surface being recessed from a lower surface (22) of said cover plate, the said examination chamber roof surface being positioned over the said examination chamber floor surface and being spaced therefrom,

depth-control means (26) for determining the distance by which the said roof surface is spaced from the said floor surface so as to provide an examination chamber (28) having a substantially constant depth, and bonding means (30) whereby the base plate and the cover plate are bonded together,

characterised in that the depth control means is situated adjacent a portion of the perimeter of the examination chamber and in that the bonds between the base plate and the cover plate are at locations spaced from the perimeter of the examination chamber."

The Examining division took the following view:

Two features, which were comprised in the independent original claims 1 and 2, have been removed and are not present in the submitted claim 1:

(a): the examination chamber roof surface has a smaller surface area than the examination chamber floor surface, and there is a depth control ridge extending away from the examination chamber roof surface on all sides, but one, a sufficient distance to provide the combination of the examination chamber roof surface and depth control ridge with a surface area larger than that of the examination chamber floor surface so that when the examination chamber roof is positioned over said examination chamber floor surface, a fixed distance determined by said depth control ridge is maintained between said examination chamber roof and floor surfaces;

(b): the depth control ridge has at least one notch extending between the examination chamber roof and the edge of said depth control ridge furthest from said examination chamber roof.

These two missing features are mentioned in the original application with respect to the two embodiments disclosed therein; moreover, these features (a) and (b) are derivable from the original disclosure as solving problems of the prior art, and no other solution is indicated therefor; thus, it was not derivable from the application as filed that these features (a) and (b) were not essential to the invention. The applicant's arguments based on the

decision T 0331/87 (HOUDAILLE/Removal of feature, OJ 1991, 22) were not considered as convincing because, in particular, in the present case, the conditions mentioned in said decision for removing a feature from a claim were not met.

II. The appellant (applicant) lodged an appeal against this decision. In addition to the main request, the statement of grounds of appeal was accompanied by auxiliary requests, whereby in particular:

Claim 1 of the **first auxiliary request** contains, as compared to the main request, the additional feature that the slide comprises

"means (44) whereby entrapped gases can be bled from the examination chamber (28) and excess specimen fluid can be drained from the examination chamber";

as compared to the first auxiliary request, claim 1 of the **second auxiliary request** does not comprise the feature that the depth control means is "situated adjacent a portion of the perimeter of the examination chamber", but includes the additional feature that the depth control means is

"in the form of a ridge (26) extending away from a first of said flat examination chamber surfaces (16, 24) on all sides but one, said first flat surface having a smaller area than the other of said flat surfaces (24, 16), such that the ridge abuts the said other surface and defines a portion of the perimeter of the examination chamber"; and

in claim 1 of the third auxiliary request, the following feature is substituted for the additional feature in the second auxiliary request:

"the said examination chamber roof surface (24) has a smaller surface area than said examination chamber floor surface (16), and said depth-control means is a depth control ridge (26) extending away from said examination chamber roof surface on all sides, but one, a sufficient distance to extend beyond the edge of said examination chamber floor surface so that positioning said examination chamber roof surface over said examination chamber floor surface results in a fixed distance being determined by said depth control ridge between said examination chamber roof and floor surfaces, " .

III. In a communication dated 24 May 1996 accompanying the invitation to the oral proceedings requested auxiliarily by the appellant in case that the main request would not be found allowable, the Board of appeal expressed in particular the opinion that the main request and the first to third auxiliary requests appeared to result from amendments in such a way that the European patent application contained subject-matter which extended beyond the content of the application as filed. However, it was added that a further auxiliary request appeared to be allowable, but that it also seemed that, in view of the arguments in the statement of grounds of appeal, a new, amended request, based on the first auxiliary request and somewhat as the example annexed to the communication, could meet these deficiencies.

IV. By a letter dated 11 November 1996, the appellant informed the Board that the appellant would not be represented at the scheduled oral proceedings and that, in particular, the text suggested by the Board in its communication of 24 May 1996 was adopted as appellant's fourth auxiliary request. Moreover, by a further letter

dated 12 November 1996, the appellant submitted inter alia a text of its fourth auxiliary request, which is identical with the text suggested by the Board. In this new claim 1, the feature:

"consists of a depth control ridge (26) situated adjacent all sides of the perimeter of the examination chamber, but one, and comprising at least one notch (44) constituting the means (44) for bleeding gases and draining specimen fluid from the examination chamber (28),"

has been substituted for the first characterising feature of claim 1 of the first auxiliary request "is situated adjacent a portion of the perimeter of the examination chamber". The claim reads as follows:

"1. A slide for use in the examination of a liquid specimen, said slide (10) comprising:

a base plate (14) having at least one flat examination chamber floor surface (16), said examination chamber floor surface being raised above an upper deck surface (20) of said base plate,

a cover plate (12) having at least one flat examination chamber roof surface (24), said examination chamber roof surface being recessed from a lower surface (22) of said cover plate, the said examination chamber roof surface being positioned over the said examination chamber floor surface and being spaced therefrom,

depth-control means (26) for determining the distance by which the said roof surface is spaced from the said floor surface so as to provide an examination

chamber (28) having a substantially constant depth, means (44) whereby entrapped gases can be bled from the examination chamber (28) and excess specimen fluid can be drained from the examination chamber, and

bonding means (30) whereby the base plate and the cover plate are bonded together,

characterised in that the depth control means consists of a depth control ridge (26) situated adjacent all sides of the perimeter of the examination chamber, but one, and comprising at least one notch (44) constituting the means (44) for bleeding gases and draining specimen fluid from the examination chamber (28), and in that the bonds between the base plate and the cover plate are at locations spaced from the perimeter of the examination chamber."

- V. The oral proceedings were cancelled accordingly.

- VI. The appellant requested that the decision under appeal be set aside and that the case be remitted to the Examining Division for further prosecution, whereby in particular for the fourth auxiliary request an adaptation of the description and of the dependent claims was mentioned as being necessary, and submitted the following arguments in support of its requests:

The fact that features (a) and (b) were present in the original independent claims does not determine (i.e. affect) the issue, for, as stated in the headnote of Decision **T 0066/85** (AMP/Connector, OJ EPO 1989, 167), if "a technical feature is deleted from a claim ... in order not to exclude from protection certain embodiments of the invention, the broadening of the claim does not contravene Art. 123(2) EPC as long as there is some basis for a claim lacking that feature in

the application as originally filed. It is immaterial whether or not the feature in question is relevant to the inventive concept of the claimed subject-matter". Having especially regard to feature **(b)**, this feature should be considered as solving some ancillary problem of the prior art, as compared to other features of the invention which are derivable as constituting a "critical requirement" of the invention; thus, it should be readily apparent from the original application that the venting of gases from the examination chamber is not relevant to that critical requirement, which in accordance with the original description is the obtaining and maintaining of accurate spacing between the floor and roof surfaces of the examination chamber, and any means for venting entrapped gases is clearly not essential to the solution of the primary problem and hence must be considered as optional (notwithstanding that it might well be preferable). The statement in item 6 of the decision **T 0331/87** should also be kept in mind, according to which a feature "may be inessential even if it was incidentally, but consistently, presented in combination with other features of the invention". Therefore, the **main request** does not introduce additional subject-matter.

The **first to fourth auxiliary requests** do not, in appellant's opinion, introduce additional subject-matter either, for the following reasons:

Concerning the **first auxiliary request**, it is readily apparent to the skilled reader that **various alternatives** are possible to the **notch** disclosed in the illustrated embodiments. In claim 1 of the **second auxiliary request**, features, for instance the orientation of the depth control-ridge, i.e. whether it extends from the base plate or from the cover plate,

are missing which would be directly and unambiguously perceived by the skilled person as being nonessential to the construction of the slide and as being an obvious alternative solution to the one mentioned in the original claims 1 and 2. Claim 1 of the **third auxiliary request** comprises in substance the disputed feature (a) except for the feature concerning the examination chamber roof surface being larger than the examination chamber floor surface, which is directly derivable from in particular the original Fig. 4 and 5 as being only optional. Claim 1 of the **fourth auxiliary request**, wherein only this last feature is missing, is allowable for the same reasons.

Reasons for the Decision

1. The appeal is admissible.

2. *Main request*

2.1 *Allowability of the amendments*

2.1.1 The slide according to claim 1 of the main request is for use in the examination of a liquid specimen; said slide (10) comprises:

a base plate (14) having at least one flat examination chamber floor surface (16), said examination chamber floor surface being raised above an upper deck surface (20) of said base plate;

said slide (10) also comprises:

a cover plate (12) having at least one flat examination chamber roof surface (24), said examination chamber roof surface being recessed from a lower surface (22)

of said cover plate, the said examination chamber roof surface being positioned over the said examination chamber floor surface and being spaced therefrom;

said slide (10) further comprises:

depth-control means (26) for determining the distance by which the said roof surface is spaced from the said floor surface so as to provide an examination chamber (28) having a substantially constant depth, and bonding means (30) whereby the base plate and the cover plate are bonded together;

in said slide (10), the depth control means is situated adjacent a portion of the perimeter of the examination chamber and the bonds between the base plate and the cover plate are at locations spaced from the perimeter of the examination chamber.

- 2.1.2 It has not been contested that the two following features, which read in substance as follows and which were disclosed in the original application (see in particular independent claims 1 and 2), are not comprised in present claim 1:

"(a)": the examination chamber roof surface has a smaller surface area than the examination chamber floor surface, and there is a **depth control ridge extending away from the examination chamber roof surface on all sides, but one, a sufficient distance** to provide the combination of the examination chamber roof surface and depth control ridge with a surface area larger than that of the examination chamber floor surface so that when the examination chamber roof is positioned over said examination chamber floor surface **a fixed distance**

determined by said depth control ridge is maintained between said examination chamber roof and floor surfaces;

"(b)": the depth control ridge has at least one notch extending between the examination chamber roof and the edge of said control ridge furthest from said examination chamber roof.

- 2.1.3 The appellant has submitted that the fact that features (a) and (b) were present in the original independent claims does not determine (i.e. affect) the issue, for, as stated in the headnote of the above-mentioned decision T 0066/85, if "a technical feature is deleted from a claim ... in order not to exclude from protection certain embodiments of the invention, the broadening of the claim does not contravene Art. 123(2) EPC as long as there is some basis for a claim lacking that feature in the application as originally filed. It is immaterial whether or not the feature in question is relevant to the inventive concept of the claimed subject-matter".

Having especially regard to feature (b), the appellant has argued that this feature should be considered as solving some ancillary problem of the prior art, as compared to other features of the invention which are derivable as constituting a "critical requirement" of the invention; thus, it should be readily apparent from the original application that the venting of gases from the examination chamber is not relevant to that critical requirement, which in accordance with the original description (see page 3, line 22 to page 4, line 24) is the obtaining and maintaining of accurate spacing between the floor and roof surfaces of the examination chamber, and any means for venting entrapped gases is clearly not essential to the

solution of the primary problem and hence must be considered as optional (notwithstanding that it might well be preferable).

- 2.1.4 However, the appellant's argument with respect to feature **(b)** is not convincing for the following reasons:

According to the original application (see in particular page 6, lines 10 to 17), the **notches** in the depth control ridges provide channels for **bleeding entrapped gases from the examination chambers and for draining excess specimen fluids from the examination chambers**. Thus, a definite function is indicated originally in relation to feature **(b)**.

According to the above-mentioned headnote of Decision **T 0066/85**, it may be possible, under certain conditions, to delete a technical feature from a claim in order not to exclude from protection certain **embodiments** of the invention; indeed, in said decision **T 0066/85** (see points 7 and 8 of the reasons), for allowing an amendment, reference is made to an originally illustrated embodiment which could be excluded from protection by the original claims. However, in the present case, the appellant has not specified which embodiments in the original description could be considered as being excluded from protection by the original claims 1 and 2, and none could be detected by the Board.

Moreover, according to said same above-mentioned headnote of Decision **T 0066/85**, there must be **some basis** for a claim lacking that feature in the application as originally filed, and such basis has neither been indicated by the appellant nor could it be detected by the Board.

Since as also mentioned in the cited headnote of Decision T 0066/85 it is immaterial whether or not the feature in question is relevant to the inventive concept of the claimed subject-matter, the appellant's considerations about the **optional** significance of the feature do not concern directly the objection about the deletion of corresponding features from original claims. In any case, it is to be noted that, as indicated here above, the invention is disclosed originally (see page 4, lines 25 to 31) as having **examination chambers** from which entrapped gases can be **readily bled**, and from which excess specimen fluids can be **readily drained**, and that, contrary to the slide with notches in the depth control ridges of feature (b) in original claims 1 and 2, the slide of present claim 1 does not comprise any feature which can be related to this function.

- 2.1.5 The appellant has submitted the additional argument, by reference to the statement in item 6 of the decision T 0331/87, that a feature "may be inessential even if it was incidentally, but consistently, presented in combination with other features of the invention". However, this argument is not convincing for the following reasons:

As indicated here above, the invention is disclosed originally (see page 4, lines 25 to 31) as having **examination chambers** from which entrapped gases can be **readily bled**, and from which excess specimen fluids can be **readily drained**, without any derivable indication that this function is inessential. Yet, contrary to the slide with notches in the depth control ridges of feature (b) in the original application (see in particular claims 1 and 2), the slide of present claim 1 does not comprise any feature which can be related to this function.

2.1.6 Therefore, since present claim 1 in particular does not comprise the originally disclosed capability related to the feature with notches in a depth control ridge, it corresponds to slides which were not disclosed originally and, thus, the main request does not satisfy the requirement of Article 123(2) EPC) that a European patent application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.

3. *First auxiliary request*

3.1 Claim 1 contains as compared to the main request the additional feature that

the slide comprises means (44) whereby entrapped gases can be bled from the examination chamber (28) and excess specimen fluid can be drained from the examination chamber.

3.2 It is to be noted that, in particular, the above-mentioned original feature (a) is not comprised in claim 1 of the first auxiliary request. Said feature (a) consists of two partial features, i.e.

(a'), that the examination chamber roof surface has a smaller surface area than the examination chamber floor surface, and

(a''), that there is a **depth control ridge extending away from the examination chamber roof surface on all sides, but one, a sufficient distance** to provide the combination of the examination chamber roof surface and depth control ridge with a surface area larger than that of the examination chamber floor surface so that when the examination chamber roof is positioned over said examination chamber floor surface **a fixed distance**

determined by said depth control ridge is maintained between said examination chamber roof and floor surfaces.

Moreover, the above-mentioned further original feature (b) is not comprised either in claim 1 of the first auxiliary request, i.e., it is not specified that the depth control ridge has at least one **notch** extending between the examination chamber roof and the edge of said control ridge furthest from said examination chamber roof.

- 3.3 The appellant has submitted that it is readily apparent for the skilled reader that **various alternatives** are possible to the **notch** disclosed in the illustrated embodiments. However, this argument is not convincing because no such alternative is clear to the Board and because, in any case, no basis could be detected in the original application for such alternative.

With respect to the same feature of the notch in the depth control means, the appellant has also submitted arguments that said feature is not an **essential feature** of the invention as originally disclosed and that, taking into account the conclusions of the Decision **T 0331/87**, said feature can thus be removed. However, since Decision **T 0331/87** (see point 7.5 of the reasons) requires that the removal of a specific embodiment which is not indispensable to the function of the invention should not require any modification of the other features of the invention, and since as mentioned here above there is no clear alternative to said feature and thus a modification of the other features of the invention, i.e. of features which are not related to the depth control ridges or to the notches,

cannot be excluded, the conclusions of Decision T 0331/87 cannot be directly transposed to the present case.

- 3.4 Therefore, since claim 1 of the first auxiliary request in particular does not comprise the originally disclosed feature concerning notches in a depth control ridge, it corresponds to slides which were not disclosed originally and, thus, the first auxiliary request does not satisfy the requirement of Article 123(2) EPC.

4. *Second auxiliary request*

Claim 1 contains as compared to the first auxiliary request the additional feature that

the depth control means is in the form of a ridge (26) extending away from a first of said flat examination chamber surfaces (16, 24) on all sides but one, said first flat surface having a smaller area than the other of said flat surfaces (24, 16), such that the ridge abuts the said other surface and defines a portion of the perimeter of the examination chamber.

However, contrary to the slide of the original application (see in particular page 4, lines 25 to 31 and page 6, lines 10 to 17) wherein there is at least one notch cut into each depth control ridge which provide channels for bleeding entrapped gases from examination chambers and for draining excess fluids from the examination chambers, the slide according to present claim 1 comprises means for the same function, but which can be different from the depth control

ridges and the at least one notch therein. Therefore, since present claim 1 concerns slides which were not disclosed originally, it is not allowable for the same reasons as those mentioned here above in relation to the first auxiliary request.

5. *Third auxiliary request*

5.1 Since as in claim 1 of the second auxiliary request the slide of the third auxiliary request comprises means for the function of bleeding entrapped gases from examination chambers and of draining excess fluids from the examination chambers which can be different from the depth control ridges and the at least one notch therein derivable from the original application, it is not allowable for the same reason as those mentioned here above in relation to the second auxiliary request.

6. *Fourth auxiliary request*

It is to be noted that, contrary to claims 1 and 2 of the application as originally filed, claim 1 of the fourth auxiliary request indeed comprises the features (a'') and (b) mentioned here above in paragraphs 2.1.2 and 3.2, respectively, but does not include the feature (a') mentioned in said same last paragraph,

that the examination chamber roof surface has a smaller surface area than the examination chamber floor surface area.

As convincingly argued by the appellant, there are parts of the application as originally filed (see page 11, line 31 to page 12, line 7; Fig.4 and 5) which clearly teach that the examination chamber roof may be extended beyond the limit of the examination chamber floor and, thus, clearly contemplate embodiments having

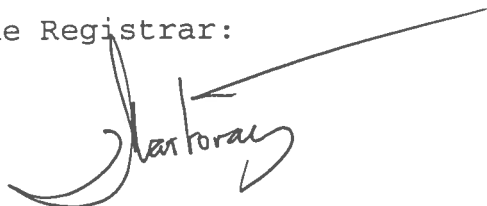
an increased surface area of the examination chamber roof. Therefore, there is a basis, in the application as filed, for a slide wherein the examination chamber roof surface has **not** a smaller surface area than the examination chamber floor surface area. Thus, claim 1 of the present fourth auxiliary request satisfies the requirement of Article 123(2) EPC that a European patent application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed, so that consideration of the further request is not necessary and the patent application may be remitted to the Examining Division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution on the basis of claim 1 of appellant's fourth auxiliary request submitted with appellant's letter dated 12 November 1996.

The Registrar:



P. Martorana

The Chairman:



E. Turrini

MGA

B. Sch.

