

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

D E C I S I O N
of 13 December 2005

Case Number: T 0646/04 - 3.4.02

Application Number: 96928966.9

Publication Number: 0866953

IPC: G01J 3/50

Language of the proceedings: EN

Title of invention:

Method and apparatus for determining characteristics of a sample in the presence of ambient light

Applicant:

American Bioscience, Inc.

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 109(1)

Keyword:

-

Decisions cited:

T 0139/87

Catchword:

-



Case Number: T 0646/04 - 3.4.02

D E C I S I O N
of the Technical Board of Appeal 3.4.02
of 13 December 2005

Appellant: American Bioscience, Inc.
2730 Wilshire Boulevard
Suite 110
Santa Monica, CA 90403 (US)

Representative: Fiener, Josef
Patentanw. J. Fiener et col.
Postfach 12 49
D-87712 Mindelheim (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 26 November 2003
refusing European application No. 96928966.9
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. Klein
Members: A. Maaswinkel
M. Vogel

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division dispatched on 26 November 2003 refusing the European patent application 96 928 966.9.
- II. The appellant (applicant) lodged an appeal on 28 January 2004. The appeal fee was paid on 26 January 2004. The statement setting out the grounds of appeal was received on 29 March 2004.
- III. The examining division objected that the subject-matter of independent claims 1 and 16 of the set of claims then on file set was not novel over the disclosure in document D1 (Article 52(1) and 54 EPC). With respect to the dependent claims the examining division considered that their subject-matter was not novel or lacked inventive step over documents D1 to D4 (Articles 54 and 56 EPC) and referred to its communication of 24 April 2002.
- D1: US-A-4 694 182
D2: US-A-5 376 783
D3: US-A-4 128 760
D4: US-A-5 173 750
- IV. With the letter containing the grounds of appeal the appellant filed amended independent claims 1 and 16 to be considered by the board and furthermore requested oral proceedings. These claims are worded as follows, the amendments made when compared with the independent claims before the examining division shown underlined and deleted features crossed out:

"1. A method for detecting the intensity of light emanating from a sample in a container through which light can pass, wherein the sample is in the presence of periodically varying ambient light, the method comprising:

illuminating the container ~~sample~~ with light from an illuminating light source;

detecting the intensity of light from the sample a first plurality of times to provide a plurality of collective light intensity measurements, while the sample is being illuminated with light from the illuminating light source;

detecting the intensity of light from the sample a second plurality of times to produce a plurality of ambient light intensity measurements, while the sample is not being illuminated with light from the illuminating light source; and

filtering out the effects of the periodically varying ambient light from the collective light intensity measurements to provide a quantitative measurement of how much of each collective light intensity measurement results from the illuminating light source".

"16. An apparatus that determines an optical intensity of light emanating from a sample ~~that~~ in a container through which light can pass, wherein said container is situated under a periodically varying ambient light, comprising:

a selectively illuminating light source which may be switched between on and off states that illuminates the ~~sample~~ container;

a detector that detects optical intensities of the sample a first plurality of times with the effects of

the illuminating light source to produce a plurality of collective light intensity measurements, and a second plurality of times without the effects of the light source to produce a plurality of ambient light intensity measurements; and

a processor that quantitatively determines, based upon said collective light intensity measurements and said plurality of ambient light intensity measurements, the intensity amount of the plurality of collective light intensity measurements that results from said illuminating light source".

- V. The appellant's arguments in the letter of 29 March 2004 may be summarised as follows:

In the amended set of claims, claims 1 and 16 have been amended to define the invention with greater particularity. No new matter is introduced by the subject amendments as the amended claim language is fully supported by the specification (see, for example, page 6, line 30 and page 18, line 15 of the specification). Applicant's invention, as defined by claim 1, distinguishes over reference D1 by requiring a method for detecting the intensity of light emanating from a sample in a container through which light can pass, where the sample is exposed to a periodically varying ambient light. The invention method provides a quantitative measurement of how much of each of the collective light intensity measurements result from the illuminating light source. Similarly, the invention as defined by claim 16 further distinguishes over reference D1 by requiring an apparatus that determines an optical density of light emanating from a sample in a container through which light can pass, wherein the

container is exposed to a periodically varying ambient light.

In contrast document D1 discloses a method of illuminating a bar code using light, detecting the intensity of light from the bar code a first and second plurality of times, while filtering out the effects of ambient light. D1 does not disclose detecting the light emanating from a sample in a container, under varying ambient light, or the use of 3 different filtering techniques. Therefore, D1 does not disclose all the features of independent claim 1 and 16.

- VI. In a telephone conversation on 16 November 2005 with the representative the rapporteur observed that it appeared that by the amendments introduced in the independent claims the ground of the refusal reasoned in the decision, i.e. lack of novelty, had been overcome. Furthermore that by the mere reference to the prior communication of the examining division it was not clear into which extent the objections pertaining to Articles 54 and 56 EPC would still be valid. In particular it would be questionable whether document D1 could be considered as the closest prior art for the question of inventive step which in any case had not been analysed following the problem and solution approach. Therefore it was the intention of the board to remit the case to the first instance for resuming the examining procedure. Since the appellant had requested oral proceedings the representative was asked whether the appellant insisted on oral proceedings to discuss the issue of remittal. The representative announced that he would contact the applicant, and that, should the applicant insist on oral proceedings, the

board would be contacted before 26 November 2005. No such response was received by the board.

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments (Article 123(2) EPC)*

The board is satisfied that the new features in claims 1 and 16 are disclosed in the original application, as illustrated by the passages indicated by the appellant and, for instance, Figure 2. Therefore the provisions of Article 123(2) EPC are met.

3. *Interlocutory revision (Article 109(1) EPC)*
 - 3.1 The present appeal had been filed against the decision of the examining division according to which the subject-matter of independent claims 1 and 16 lacked novelty over the disclosure in document D1. The board does not contest this assessment of the division with respect to the former claims. Indeed, by filing amended claims intending to overcome the objection under Article 54 EPC the applicant/appellant implicitly has accepted the reasoning of the examining division.
 - 3.2 During the examination procedure the applicant had provided arguments in a letter dated 19 February 2003 why the subject-matter of claims 1 and 16 was novel over the disclosure in D1. In point 2 of the Grounds for the Decision these arguments are addressed. In particular the applicant had argued that D1 did not

disclose "detecting light emanating from a sample in a container". In point 3 of the Grounds the examining division observed that this feature was "...not defined in the claims and can therefore not be taken into account when assessing novelty of the claimed subject-matter".

3.3 In contrast to the set of claims on which the objection under lack of novelty over the disclosure in document D1 was based, leading to the refusal, the set of claims filed with grounds of appeal does include the above feature. Therefore it appears that, having regard to the disclosure in document D1, this objection is no longer valid, or at least the decision does not contain a reasoning that the new features would be disclosed in D1.

3.4 The decision itself does not contain any further reasoned objections within the meaning of Rule 68(2) EPC. The mere reference to the communication of 24 February 2002 is of no avail, since that communication only mentioned in its point 2 that document D4 disclosed "a further example of such a detection apparatus/method", however without comparing the features of the claims with this disclosure in detail. In point 3 of that communication the dependent claims were cursorily addressed, mentioning that their further features did not contribute to novelty and inventive step, without providing a reasoned analysis (i.e. by following the problem and solution approach).

3.5 Hence it appears that the set of claims submitted with the grounds of appeal overcomes the only reasoned objection in the decision. In consequence, it is the

opinion of the board that the examining division should have rectified its decision, as explained in the Guidelines, Part E, Chapter XI, Point 7.1, in particular under (iii):

"the decision of the department concerned does not appear to be incorrect, but the applicant presents new information or evidence or files amendments to the application, which overcome the objections of the decision under appeal (see T 139/87, OJ 3/1990, 68)". According to this 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 EPC".

4. *Further prosecution*

- 4.1 In the grounds of appeal the appellant has argued that the invention relates to a method and an apparatus for detecting the intensity of light emanating from a sample in a container, wherein the container is used in the method and forms a feature of the apparatus. Although the examining division will have to consider whether document D1 would still disclose relevant subject-matter for the issue of Article 52(1) EPC, it is noted that according to the description of the present patent application (see, e.g. page 1, line 4) the invention relates to determining colorimetric or fluorescent light intensity of a sample. Therefore, provisionally, for the issue of patentability (Article 52(1) EPC) it should be considered whether document US-A-5,070,244 (cited in the European Search Report) or US-A-4,863,265 (known to the board and introduced of its own motion into the procedure)

disclose subject-matter to be considered as a more relevant prior art.

- 4.2 Since these documents so far have not been considered by the examining division it appears appropriate to remit the case to the first instance for resuming the examining procedure.

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 Chairman:

P. Martorana

A. Klein