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Datasheet for the decision of 25 July 2007

Case Number: T 1060/05 - 3.3.04

Application Number: 00977665.9

Publication Number: 1230392

IPC: C12Q 1/68

Language of the proceedings: EN

Title of invention:
Security System

Applicant:
Crime Solutions Limited

Opponent:
-

Headword:
Security System/CRIME SOLUTIONS

Relevant legal provisions:
EPC Art. 84, 111(1)

Keyword:
"Clarity of claim 1 (yes)"
"Remittal (yes) - sole ground for refusal removed by amended claims"

Decisions cited:
T 0859/97

Catchword:
-

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Case Number: T 1060/05 - 3.3.04

D E C I S I O N
of the Technical Board of Appeal 3.3.04
of 25 July 2007

Appellant: (Applicant)
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Decision under appeal:
Decision of the Examining Division of the European Patent Office posted 15 February 2005 refusing European patent application No. 00977665.9 pursuant to Article 97(1) EPC.

Composition of the Board:

Chair: U. Kinkeldey
Members: G. Alt
G. Weiss

Summary of Facts and Submissions

I. The appeal lies from a decision of the examining division refusing European patent application No. 00 977 665.9 entitled "Security System", which originates from International application No. PCT/GB00/04419, originally published under International publication No. WO 01/36676.

II. The decision under appeal was based on three sets of amended claims.

Claim 1 of the main request and of the second auxiliary request, respectively, read:

"1. A security marker for marking objects and people comprising a nucleic acid molecule, said nucleic acid molecule comprising:
(i) a first primer region substantially identical to a first primer, and linked to the first primer region,
(ii) a marker region comprising a predetermined nucleic acid sequence capable of identifying the source of the security marker, and
(iii) a region which is substantially the reverse complement of a second primer and capable of being bound by this primer
characterised in that the nucleic acid sequence of the first primer and the nucleic acid sequence of the second primer are selected so that there is a probability of less than 95% that their respective primer binding regions occur within 150 bases of each other in native DNA from humans, dog, cat, mouse, rat, insects or prokaryotic organisms."

"1. A method of producing a security marker for marking objects and people, said security marker comprising a nucleic acid molecule, said nucleic acid molecule comprising:
(i) a first primer region substantially identical to a first primer, and linked to the first primer region,
(ii) a marker region comprising a predetermined nucleic acid sequence capable of identifying the source of the security marker, and
(iii) a region which is substantially the reverse complement of a second primer and capable of being bound by this primer
characterised in that the nucleic acid sequence of the first primer and the nucleic acid sequence of the second primer are selected so that there is a probability of less than 95% that their respective primer binding regions occur within 150 bases of each other in native DNA from humans, dog, cat, mouse, rat, insects or prokaryotic organisms."

III. The second auxiliary request was refused for lack of clarity pursuant to Article 84 EPC. The examining division found that the subject-matter was not clear for two reasons:

(i) Although the subject-matter of the claims was directed to a "method of producing", the claims did not comprise any process steps so that the method was in effect only defined by reference to the product to be obtained by the method.

(ii) Moreover, the claims were held to be unclear for reasons set out with respect to

objections of lack of clarity and novelty of claim 1 of the main request.

(a) In this respect, point 9.4 of the chapter "Novelty" of the decision under appeal reads:

"It is to be noted that in view of the unclarity of the claim (see below), the examining division could not assess whether the primers G-18/G-19 or S-27/G19 taught in D3 fall within the definition provided in independent claim 1, i.e. whether there is a probability of less than 95% that the respective primer binding regions occur within 150 bases of each other in native DNA from human, dog, cat mouse, rat insects or prokaryotic organisms.

It is furthermore noted that the applicant has never provided any data which would have clearly demonstrated that the primers of D3 do not fall within the definition present in independent claim 1. On the contrary, the applicant chose to disclaim said primers from independent claim 1 of the first auxiliary request (see below). The novelty (Article 54 EPC) of independent claim 1 is hence questionable (see the Guidelines C-III, 4.7a and C-IV, 7.5)."

(b) Points 10 - 10.3 of the chapter "Clarity" in the decision under appeal read:

"10. As illustrated by the discussion of the novelty of the claims put forward herein-above, the examining division considers that independent claim 1 does not define a product in terms of technical features but in term [sic] of effects that should be achieved by said

technical features in order to solve the technical problem underlying the present application, [...].

10.1 In addition, the applicant argued in his letter dated 29.12.2004 that in order to determine which primer sequences fall within the scope of claim 1, the skilled person would for instance take the sequence of proposed primers and carry out a BLAST search using said sequences against a large nucleic acid databank and compare the co-ordinates of the matched (or nearly) matched regions. [...].

10.2 The examining division notes however that this method will only provide an indication whether the respective primer binding regions occur within 150 bases of each other in native DNA from humans, dog, cat, mouse, rat, insect or prokaryotic organisms. This method will however not provide a probability as defined in the claims, and the applicant has not provided any indication how said probability could be assessed by the skilled person.

10.3 In view of the fact that the subject-matter of independent claim 1 is defined in term [sic] of effects that should be achieved and that the skilled person using its common general knowledge would not be able to assess its subject-matter beyond reasonable doubt, the examining division considers that independent claim 1 does not meet the requirements of Article 84 EPC."

IV. In its statement setting out the grounds of appeal, dated 27 June 2005, the appellant enclosed four sets of amended claims as, respectively, the main request and auxiliary requests I to III. It was noted in the

statement that the claims of the main request were based on the claims of the second auxiliary request before the examining division with amendments to claims 1, 7, 17, 20, 21, 25 and freshly added claims 31 to 35. Oral proceedings were requested in case the board should consider refusing the application.

Claim 1 of the main request read:

"1. A method of producing a security marker for marking objects and people, said method comprising:

(A) providing a nucleic acid molecule having a sequence of 40-230 nucleotides, said sequence comprising
(i) a first primer region consisting of 15-50 nucleotides, wherein said first primer region is substantially identical to a first primer, and linked to the first primer region,
(ii) a marker region comprising a predetermined nucleic acid sequence capable of identifying the source of the security marker; and
(iii) a second primer region consisting of 15-50 nucleotides which is substantially the reverse complement of a second primer and wherein said second primer region is capable of being bound by the second primer; and
(B) screening the nucleic acid sequence of the first primer region (or the first primer) and the nucleic acid sequence of the second primer region (or the second primer) against a publicly available database to confirm that the nucleic acid sequences of the first and second primer regions do not occur within 150 bases of each other in a native DNA sequence from humans, dog, cat, mouse, rat, insects or prokaryotic organisms."

The claim set contained further independent claims directed to the use of a security marker, a method of marking an object, a method of detecting a security marker, a security kit, a security system, a security device and a security marker.

V. In a telephone conversation which took place on 4 April 2007, the rapporteur informed the appellant's representative of the board's view that claim 1 of the main request was considered as overcoming the reasons for refusal and that the board wished to remit the case to the examining division for further prosecution.

VI. In response to the telephone conversation the appellant's requests were as follows:

- that the decision of the examining division be set aside and

- that the case be remitted to the department of first instance for further examination based on claims 1 to 35 of the main request.

VII. The oral proceedings, that were to take place on 19 April 2007, were cancelled.

VIII. The appellant argued essentially that Claim 1 now recited specific method steps (A) and (B) and that the primers were now defined by structural features.

Reasons for the Decision

1. According to the decision under appeal the reason for refusing the application was that "at least independent claim 1 of the second auxiliary request is not clear in the sense of Article 84 EPC". In view of the unspecific indication "at least claim 1" the board can only speculate which other claims might, in addition to claim 1, be concerned by the objection. Hence, the decision is only reasoned in relation to claim 1. The decision therefore fulfils the requirements of Rule 68(2) EPC because according to established case law (for example, decision T 859/97 of 2 March 2001, Reasons, point 8.1.3) it is sufficient for the examining division when deciding to refuse a European patent application under Article 97(1) EPC to state in a sufficiently reasoned manner one ground which in their opinion would prejudice the grant of the European patent. Consequently, in the following, the board will review the only reason for the decision and therefore examine whether the amended claim 1 of the main request overcomes the objections of lack of clarity under Article 84 EPC raised with respect to claim 1 of the second auxiliary request.

2. The method of claim 1 of the present main request is characterized by two separate process steps, namely step A), referring to the provision of a nucleic acid molecule having a sequence of 40-230 nucleotides and step B), referring to the screening of the nucleic acid molecule provided in step A) against a publicly available database.

Hence, the examining divisions first reasoning for the lack of clarity, i.e. the absence of process features (see section III(i) above), is overcome.

3. For the sake of the second reasoning, the examining division refers in its decision to the reasoning given in the course of objections of lack of clarity and novelty raised with respect to claim 1 of the main request before them.

3.1 When taking the argumentations in points 9.3 and 9.4 of the chapter "Novelty" and in points 10 to 10.3 of the chapter "Clarity" in the appealed decision (see section III(ii) above), in combination and after having it adapted to the method of claim 1 of the second auxiliary request, the board understands the following reasoning of lack of clarity: The method is not characterized in the claim by any process feature, but exclusively by reference to the product to be produced by it. This product is, inter alia, characterized in the claim in terms of effects to be achieved, namely that "the nucleic acid sequence of the first primer and the nucleic acid sequence of the second primer are selected so that there is a probability of less than 95% that their respective primer binding regions occur within 150 bases of each other in native DNA from humans dog, cat, mouse rat insects or prokaryotic organisms", i.e. the product is defined by functional features. However, the skilled person does not know, how the functional features translate into structural features, or, in other words, the indication of the function does not give an indication about the structure of the product. Therefore, since it is not clear which product is to be produced, the method

claimed in claim 1 of the second auxiliary request, is not clearly defined, too.

3.2 The functional language objected to by the examining division is deleted from claim 1 of the present main request.

4. Thus, amended claim 1 overcomes the specific objections under Article 84 EPC raised before the examining division.

5. In the present case substantial amendments to the claims were introduced on appeal. For example, many of the features introduced into the claims are derived from the description. Some of the amendments cannot be found literally in the description. Due to the nature of the amendments, the subject-matter now claimed differs from the previously claimed subject-matter to an extent that the examining division's evaluation of novelty in the appealed decision, as well as the additional comments given on inventive step may no longer be directly applicable to the fresh subject-matter. Moreover, a number of new claims have been added.

5.1 The appellant requested remittal of the case for further prosecution to the examining division.

Pursuant to Article 111(1) EPC remittal to the department of first instance is at the discretion of the board.

It is established case law that in case of substantial amendments the boards exercise their discretion in

favour of remittal (Case Law of the Boards of Appeal of the European Patent Office, 5th edition 2006, Chapter VII.D.9).

5.2 Therefore, in the light of the substantial amendments made to the claims and in accordance with this case law the board considers it to be justified and appropriate to allow the claims of the main request to be examined by two instances for further issues.

Order

For these reasons it is decided that:

1. The decision of under appeal is set aside.

2. The case is remitted to the department of first instance for further prosecution based on the main request filed on 27 June 2005.

The Registrar: The Chair:

P. Cremona U. Kinkeldey