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**Datasheet for the decision
of 26 October 2016**

Case Number: T 1265/13 - 3.3.05

Application Number: 05778182.5

Publication Number: 1737573

IPC: B01L3/00, C12Q1/68, G01S13/00,
G06K19/07

Language of the proceedings: EN

Title of invention:

INTEGRATION OF SAMPLE STORAGE AND SAMPLE MANAGEMENT FOR LIFE
SCIENCE

Applicant:

Biomatrica, Inc.

Headword:

Biological sample storage/BIOMATRICA

Relevant legal provisions:

EPC Art. 84, 113(1)
EPC R. 137(5)
RPBA Art. 15(3)

Keyword:

Main request and auxiliary requests 1 to 4 - amended claims
relating to unsearched subject-matter
Right to be heard - non-attendance at oral proceedings
Auxiliary requests 5 to 9 - lack of clarity of the claims

Decisions cited:

T 1129/97, T 0708/00, T 2459/12

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

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Case Number: T 1265/13 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 26 October 2016

Appellant: Biomatrica, Inc.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 18 January 2013
refusing European patent application No.
05778182.5 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman G. Glod
Members: J.-M. Schwaller
O. Loizou

Summary of Facts and Submissions

- I. This appeal lies from the decision of the examining division to refuse European patent application No. 05 778 182.5 on the ground that the claims of the eight requests then on file did not meet the requirements of Article 123(2) EPC.

Claim 1 of the main request read as follows:

- "1. A method for storing biological sample, comprising:*
- (1) loading a biological sample or biological material onto a matrix that is formed by the steps of:*
 - (a) contacting a liquid solution or a liquid suspension to one or a plurality of sample wells of a biological sample storage device, said biological sample storage device comprising (A) a lid, and (B) a sample plate containing one or a plurality of sample wells, wherein the liquid solution or liquid suspension comprises (i) a first solvent which is water, and (ii) a matrix material that dissolves or dissociates in the first solvent, to adhere the matrix material to the one or the plurality of sample wells, wherein the matrix material is selected from polyvinyl alcohol, polyethylene glycol, poly-N-vinylacetamide, polyvinylpyrrolidone, poly(4-vinylpyridine), polyphenylene oxide, reversibly crosslinked acrylamide, polymethacrylate, polylactide, lactide/glycolide copolymer, hydroxymethacrylate copolymer, calcium pectinate, hydroxyectoine and hydroxypropyl methylcellulose acetate succinate;*
 - (b) drying one or more of the sample wells, and thereby forming the matrix before contacting the matrix with the sample;*
 - (2) drying the matrix after said step (1) of loading;*
- and*

(3) maintaining the matrix without refrigeration subsequent to the steps (1) and (2) of, respectively, loading and drying, and thereby storing the biological sample or biological material,

wherein the matrix can be resuspended or redissolved in a second solvent which is water to substantially or completely recover the stored biological sample or biological material."

- II. In its decision, the examining division held in particular that the features "a first solvent which is water" and "a second solvent which is water" infringed Article 123(2) EPC because there was no basis in the application as filed for the first **and** the second solvent being water.

The examining division further held the omission of the feature "(c) at least one radio frequency transponder device", which in the application as filed characterised the biological sample storage device, to extend the subject-matter beyond its content as filed, because this feature was essential to perform the invention originally claimed.

- III. With its statement of grounds of appeal dated 28 May 2013, the appellant filed ten amended sets of claims as a main request and as auxiliary requests 1 to 9.

Neither the main request nor auxiliary requests 1 to 4 recite feature "(c) at least one radio frequency transponder device".

Claim 1 of auxiliary request 5 reads as follows:

"1. A method for storing biological material, comprising:

(1) loading a biological sample or biological material onto a matrix that is formed by the steps of:

(a) contacting a liquid solution or a liquid suspension to one or a plurality of sample wells of a biological sample storage device, said biological sample storage device comprising (A) a lid, (B) a sample plate containing one or a plurality of sample wells and (C) at least one radio frequency transponder device, wherein the liquid solution or liquid suspension comprises (i) a first solvent, and (ii) a matrix material that dissolves or dissociates in the first solvent, to adhere the matrix material to the one or the plurality of sample wells;

(b) drying one or more of the sample wells, and thereby forming the matrix before contacting the matrix with the sample;

(2) drying the matrix after said step (1) of loading; and

(3) maintaining the matrix without refrigeration subsequent to the steps (1) and (2) of, respectively, loading and drying, and thereby storing the biological sample or biological material,

wherein the matrix can be resuspended or redissolved in a second solvent which is water to substantially or completely recover the stored biological sample or biological material."

The claims 1 of auxiliary requests 6 to 9 all recite the feature "*to substantially or completely recover the stored biological sample or biological material*".

IV. In a communication pursuant to Article 15(1) RPBA, the board expressed its preliminary opinion that the main and first to fourth auxiliary requests infringed Rule 137(5) EPC, and so they should not be admitted into the appeal proceedings.

The board furthermore held the expression "substantially recover" in all requests to be not well-defined and so to lack clarity under Article 84 EPC.

- V. The appellant did not respond to the communication but announced by letter dated 20 October 2016 that it did not wish to attend the oral proceedings scheduled for 26 October 2016.

- VI. At the oral proceedings, which, according to Rule 115(2)EPC and Article 15(3) RPBA, took place in the absence of the duly summoned appellant, the chairman ascertained its requests in writing to be that the decision under appeal be set aside and that a patent be granted on the basis of the set of claims according to the main or one of the first to ninth auxiliary requests dated 28 May 2013. At the end of the proceedings the board decided to dismiss the appeal.

Reasons for the Decision

- 1. Main and first to fourth auxiliary requests

- 1.1 With respect to the legal provision mentioned in the decision under appeal, it is noted that according to Article 2(2) of the decision of the Administrative Council of 25 March 2009 amending the Implementing Regulations to the European Patent Convention (OJ EPO 2009, 299), Rule 137 EPC as amended by Article 1(7) of said decision applies to European patent applications for which the European search report or the supplementary European search report is drawn up on or after 1 April 2010. For these applications, Rule 137 EPC as amended entered into force on 1 April 2010, according to Article 2(1) of said decision. However, since the

international search report for the present application was drawn up before 1 April 2010 by the European Patent Office as International Search Authority, the applicable law is Rule 137(4) EPC as in force from 13 December 2007 until 31 March 2010 (henceforth referred to as Rule 137(4) EPC as in force before 1 April 2010) that was applicable to European patent applications pending at the time of its entry into force (see Article 1, point 1. of the decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000, OJ EPO 2003, special edition No 1, 202), and which is identical to Rule 86(4) EPC that was in force before 13 December 2007 and identical to the first sentence of current Rule 137(5) EPC.

According to the international search report drawn up by the EPO, the search was carried out for the invention defined by the subject-matter of claims 1, 2, 8-41 and 54 as originally filed, all of which - and in particular independent claims 1, 9, 23, 25, 27, 34 and 38 - contained the feature "at least one radio frequency transponder device", which feature at the date of filing of the application was held to be essential for the performance of the invention.

- 1.2 In the amendments to independent claim 1 of the main and first to fourth auxiliary requests at issue, the above feature, however, was deliberately omitted, with the consequence that the new invention not originally claimed is now defined by subject-matter which was not covered by the search.

- 1.3 According to Rule 137(4) EPC as in force before 1 April 2010, amended claims may not relate to unsearched subject-matter which does not combine with the

originally claimed invention or group of inventions to form a single general inventive concept (see also T 708/00, Reasons 8, and T 2459/12, Reasons 4.2).

1.4 In the present case, this requirement is not satisfied because, as explained at page 13, lines 8 to 11 of the application as filed, the biological sample storage device which comprises a radio frequency transponder device is supposed **to receive, store and/or transmit data to a system for processing sample data**, while the subject-matter of claim 1 of the main and first to fourth auxiliary requests - which does not comprise the required radio frequency transponder device - cannot receive, store and transmit data, and so does not form a single general inventive concept with the invention originally disclosed and searched.

1.5 The appellant argued that the passage at page 12, line 29 to page 13, line 15 described a biological sample device comprising only a sample plate and a lid, with the consequence that the radio frequency transponder device was not indispensable for the function of the invention, since the presence of a radio frequency transponder device had no bearing on the ability of the device to dry store biological samples.

For the board, this argument is irrelevant since the dry storage of biological samples relates to the problem of how to improve storage of biological material and is a different invention from the one originally defined in the searched claims, the purpose of which included the functions of receiving, storing and transmitting data with the goal of creating an inventory system.

1.6 It follows that the five requests, which in their independent claim 1 omit the feature "at least one radio

frequency transponder device", are contrary to the requirements of Rule 137(4) EPC as in force before 1 April 2010, with the consequence that they are not allowable.

2. Amendments - auxiliary requests 5 to 9

2.1 Procedural matters

2.1.1 Since the appellant was not represented at the oral proceedings, the board had to consider the requirements of Article 113(1) EPC (right to be heard) in order to ascertain whether it was in a position to take a final decision in respect of issues which had not been raised before.

2.1.2 According to Article 15(3) RPBA, a board is not obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of a party duly summoned **who may then be treated as relying only on its written case**. The explanatory notes to this article (see CA/133/02 dated 12.11.2002) further state that this provision does not contradict the principle of the right to be heard since Article 113(1) EPC only affords the opportunity to be heard and, by absenting itself from the oral proceedings, a party gives up that opportunity.

2.2 Article 84 EPC

As indicated in the communication pursuant to Article 15(1) RPBA, a lack of clarity arises from the presence in claim 1 of auxiliary requests 5 to 9 of the undefined expression "**substantially** [...] **recover** the stored biological sample". As a matter of fact, this expression is clarified at page 18, lines 13 ff. of the description

("recovery of at least 50 percent, preferably at least 60 percent, [...], still more preferably 97, 98 or 99 percent"), but from the claims wording alone the skilled person does not know which quantity of stored biological sample is supposed to be recovered, let alone whether the sample is to be recovered as such or with its biological activity, as indicated e.g. at page 18, line 25 of the application as filed. In any case, the explicit disclosure of the exact meaning of the unclear term in the description alone and not in claim 1 is not sufficient per se for that claim to meet the clarity requirement (T 1129/97, Reasons 2.1.3).

It follows from the above considerations that claim 1 at issue - i.e. of auxiliary requests 5 to 9 - does not meet the requirements of Article 84 EPC.

3. As none of the sets of claims underlying the proposed requests meets the requirements of the EPC, the appeal cannot succeed and the decision to refuse the application is confirmed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Vodz

G. Glod

Decision electronically authenticated