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**Datasheet for the decision
of 30 November 2021**

Case Number: T 2378/18 - 3.4.02

Application Number: 12197989.2

Publication Number: 2573541

IPC: G01N1/28, G01N33/574, G01N15/14

Language of the proceedings: EN

Title of invention:
Improved methods and devices for cellular analysis

Applicant:
Biomarker Strategies, LLC.

Headword:

Relevant legal provisions:

EPC Art. 94(3), 111(1), 113(1)
EPC R. 103(1)(a), 112(2)
RPBA 2020 Art. 11

Keyword:

Decision on the state of the file - reasoned (no)
Right to be heard - opportunity to comment (no)
Remittal to the department of first instance - (yes)
Reimbursement of appeal fee - (yes)

Decisions cited:

T 0278/00, T 0963/02, T 0265/03, T 0897/03, T 0583/04,
T 1182/05, T 1356/05, T 1360/05, T 0750/06, T 1612/07,
T 1614/08, T 0591/17, T 1922/17

Catchword:



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Case Number: T 2378/18 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 30 November 2021

Appellant: Biomarker Strategies, LLC.
(Applicant) 15601 Crabbs Branch way
Rockville, MD 20855 (US)

Representative: Zacco Sweden AB
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 26 April 2018
refusing European patent application No.
12197989.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman R. Bekkering
Members: T.Karamanli
H.-G. von Gronau

Summary of Facts and Submissions

- I. The appeal lies from the examining division's decision to refuse European patent application No. 12 197 989.2.
- II. The course of the proceedings before the examining division may be summarised as follows:
 - (a) In a first communication pursuant to Article 94(3) EPC dated 26 June 2015, the examining division addressed issues under Articles 76(1), 54, 56 and 83 EPC with respect to claims 1 to 9 of the applicant's sole request filed on 26 September 2013.
 - (b) With its reply dated 23 October 2015, the applicant filed reasons why it considered the claims of the request on file to meet the requirements of the EPC. As an auxiliary measure, it requested oral proceedings.
 - (c) In a second communication pursuant to Article 94(3) EPC dated 12 February 2016, the examining division informed the applicant that it had examined the applicant's arguments and explained why it did not find them convincing.
 - (d) With its reply dated 1 June 2016, the applicant filed amended claims 1 to 5, replacing the claims then on file, and explained why it considered the amendments to be admissible and the objections raised by the examining division to have been overcome by these amendments.

- (e) In a third communication pursuant to Article 94(3) EPC dated 22 September 2016, the examining division raised objections under Article 83 EPC against claim 1 of the request then on file and explained why it considered the subject-matter of claim 1 to be insufficiently disclosed.
- (f) With its reply dated 23 March 2017, the applicant maintained the claims then on file as its main request and filed amended claims 1 to 5 according to a new auxiliary request. The applicant took the view that the main request met the requirements of the EPC and, in particular, those of Article 83 EPC. It also explained why it considered the amended claims of the auxiliary request to be admissible and patentable.
- (g) In a communication annexed to the summons to oral proceedings dated 20 December 2017, the examining division introduced new prior-art documents D7 and D8. Regarding the main request, it raised objections under Article 83 EPC against claims 1 and 2, new objections under Article 84 EPC against claim 1, new objections of lack of novelty against the subject-matter of all claims and new objections of lack of inventive step against the subject-matter of all claims. Regarding the auxiliary request, the examining division raised objections under Articles 123(2) and 76(1) EPC against claim 1 and expressed the opinion that the objections raised against the dependent claims of the main request applied *mutatis mutandis* to those of the auxiliary request.
- (h) In response to the summons to oral proceedings, by letter dated 23 March 2018 the applicant filed

amended claims 1 to 4 according to a new main request and new auxiliary requests 1 and 2, which replaced the requests then on file. It explained why it considered that the subject-matter of all the requests met the requirements of the EPC.

- (i) On 16 April 2018, the first examiner and the applicant's representative held a consultation by telephone.
- (j) By letter dated 19 April 2018, the applicant withdrew its request for oral proceedings and requested a "Written Decision on the basis of the prosecution history as it currently stands".
- (k) By communication dated 23 April 2018, the applicant was informed that the oral proceedings scheduled for 25 April 2018 had been cancelled.
- (l) By a further communication dated 23 April 2018, a copy of the result of the telephone consultation with the date "16.04.2018" was sent to the applicant. The examiner had expressed the opinion that the subject-matter of claim 1 of the main request and of auxiliary requests 1 and 2, filed by letter dated 23 March 2018, did not meet the requirements of Article 123(2) EPC and that the subject-matter of claim 1 of the main request did not involve an inventive step under Article 56 EPC in view of document D7.
- (m) On 26 April 2018, the examining division issued a refusal decision "*according to the state of the file*" on EPO Form 2061. It reads as follows:

"In the communication(s) dated 16.04.2018 the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was also informed of the reasons therein.

The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on 19.04.2018.

The application must therefore be refused."

- III. The applicant filed notice of appeal. With the statement setting out the grounds of appeal, the appellant filed claims according to a main request and first to eleventh auxiliary requests. It requested that the contested decision be set aside and that a European patent be granted on the basis of the claims of the main request or one of the first to eleventh auxiliary requests. As an auxiliary measure, the appellant requested oral proceedings.
- IV. On 22 June 2021, a summons to oral proceedings was issued. In a communication under Rule 15(1) of the revised version of the Rules of Procedure of the Boards of Appeal (RPBA 2020, OJ EPO 2021, A35) accompanying the summons, the board gave its preliminary opinion that the decision under appeal did not fulfil the requirements for a reasoned decision under Rule 111(2), first sentence, EPC, and that this failure constituted a substantial procedural violation that required remittal to the department of first instance and refund of the appeal fee under Rule 103(1)(a) EPC. The appellant was also informed that, in view of the board's preliminary opinion, oral proceedings before

the board might be unnecessary if the appellant agreed to a remittal of the case to the examining division for further prosecution.

- V. By letter dated 28 September 2021, the appellant accepted remittal of the case to the examining division for further prosecution without oral proceedings before the board.
- VI. By a Registrar's communication dated 11 November 2021, the appellant was informed that the oral proceedings had been cancelled.

Reasons for the Decision

1. The appeal is admissible.
2. Even though the appellant has not challenged the examining division's decision on the grounds of a substantial procedural violation, the board is entitled to examine whether or not any such violation occurred during the examination proceedings (see for instance decision T 405/12, point 3 of the Reasons).
3. The board is of the view that the decision under appeal does not meet the requirements of Rule 111(2), first sentence, EPC and that, therefore, a fundamental deficiency is apparent in the proceedings at first instance within the meaning of Article 11 RPBA 2020, which applies in the case in hand according to Article 25(1) RPBA 2020.
4. Rule 111(2), first sentence, EPC (former Rule 68(2), first sentence, EPC 1973) stipulates that decisions of the European Patent Office which are open to appeal

must be reasoned.

The boards of appeal have consistently ruled that a decision must contain a logical sequence of arguments and that all facts, evidence and arguments essential to the decision must be discussed in detail in order to meet these legal requirements (see for instance T 278/00, OJ EPO 2003, 546, T 1182/05 and T 1612/07, point 4 of the Reasons). The duty to provide reasons in administrative decisions, as enshrined in Rule 111(2) EPC, is considered to be a fundamental principle in all contracting states, and is also indispensable from the point of view of the practical functioning of the appeal system envisaged in the EPC (see decision T 1356/05, point 17 of the Reasons).

If a decision is reasoned by reference to one or more previous communications, the requirement of Rule 111(2), first sentence, EPC is only met if the referenced communications themselves fulfil the above-mentioned requirements (see for instance decisions T 963/02, point 2.1 of the Reasons, T 1612/07, T 1614/08, T 591/17 and T 1922/17). The decisive reasons for refusal must be clear to the party and to the board of appeal from the reference. The referenced communications must address the arguments presented by the party. It must not be left to the board and the appellant to speculate as to which of the reasons given in preceding communications might be essential to the decision to refuse the application (see T 963/02, point 2 of the Reasons). Therefore, communications referred to in a decision "*according to the state of the file*" on EPO Form 2061 must contain a fully reasoned exposition of the examining division's objections to the current application text and refutation of any rebuttal by the applicant (see for

instance T 583/04, points 4 to 6 of the Reasons).

5. The decision contested in the case in hand does not specify the grounds upon which it is based or contain any facts, evidence or arguments that justify the refusal of the application. The decision merely contains a reference to a single communication, i.e. "*the communication(s) dated 16.04.2018*".
6. The board notes that according to the file, there was no communication with the date "16.04.2018" sent to the applicant. However, a telephone consultation between the first examiner and the applicant did take place on that date, and the result of that telephone consultation, a copy of which was sent to the applicant with the communication of 23 April 2018, also has that date. The board therefore assumes that the decision under appeal refers to the result of the telephone consultation of 16 April 2018.
7. The "state of the file" is not restricted to those documents on file which were issued by the EPO, but also includes all those documents and arguments which were filed by the applicant prior to (or even simultaneously with) its request for a decision "on the state of the file" (see for instance decisions T 265/03 and T 1360/05). A copy of the result of a telephone consultation is *stricto sensu* not a communication pursuant to Article 94(3) EPC (see for instance decisions T 583/04, point 9 of the Reasons, and T 750/06, point 4.1 of the Reasons, both of which refer to the corresponding former Article 96(2) EPC 1973). A communication under Article 94(3) EPC should contain the factual and legal reasoning why an application does not fulfil the requirements of the EPC and should invite the applicant to file its observations, with a

reference to deemed withdrawal under Article 94(4) EPC in the event that the deficiencies are not duly remedied. Whereas the result of a telephone consultation is a record of a telephone conversation between the first examiner and the applicant, a communication pursuant to Article 94(3) EPC constitutes a unilateral legal notice to a party. The two documents serve quite different purposes. This does not exclude the possibility of the statements made orally by telephone being confirmed and adopted in a formal communication from the examining division inviting observations within a period set for reply. However, as mentioned above, the use of standard Form 2061 is only appropriate where the examining division has fully expressed and reasoned its objections to the current requests in one or more preceding communications, taking into account all the arguments put forward by the applicant and doing so in a manner which does not leave it to the board and the appellant to speculate as to which of the reasons given in preceding communications might be essential to the decision to refuse the application (see decisions T 897/03, points 5 and 6 of the Reasons, and T 583/04). This makes it transparent that the decision is being taken on the agreed text and that nothing is being said in the decision which has not already been communicated to the applicant with an opportunity to present comments, thus guaranteeing that the right to be heard under Article 113(1) EPC is observed.

However, this was not the case here. After the telephone consultation between the first examiner and the applicant's representative on 16 April 2018, the applicant requested a decision on the state of the file by letter dated 19 April 2018. The oral proceedings scheduled for 25 April 2018 were then cancelled. For

the above reasons, the examining division should then have sent a (formal) communication under Article 94(3) EPC with respect to the new requests filed by letter dated 23 March 2018, inviting the applicant to file its observations. Instead, the examining division issued the communication of 23 April 2018 with the copy of the result of the telephone consultation without inviting the applicant to file its observations, and on 26 April 2018, i.e. only three days later, it issued the contested decision according to the state of the file. It follows that the decision under appeal in the case in hand is based on grounds on which the applicant had no opportunity to comment. The applicant's right to be heard enshrined in Article 113(1) EPC has therefore been infringed.

8. Furthermore, it is established case law that a request for a decision on the state of the file cannot be construed as a waiver of the right to a fully reasoned first-instance decision (see Case Law of the Boards of Appeal of the EPO ("Case Law" below), 9th edition 2019, III.K.3.5.3).
9. For these reasons, the decision under appeal does not fulfil the requirements for a reasoned decision under Rule 111(2), first sentence, EPC.
10. According to the established case law of the boards of appeal, this failure constitutes a substantial procedural violation which is considered a fundamental deficiency of first-instance proceedings (see Case Law, V.A.7.7.2 b)). There are thus special reasons within the meaning of Article 11, second sentence, RPBA 2020. Therefore, in exercising its discretion under Article 111(1), second sentence, EPC, a board will normally remit the case to the department of first

instance for further prosecution. The board cannot see any reasons against remittal in the case in hand. The appellant has not put forward any such reasons either and has agreed to a remittal. Therefore, the board considers it appropriate to set aside the decision under appeal and to remit the case to the department of first instance for further prosecution in accordance with Article 111(1), second sentence, EPC and Article 11 RPBA 2020.

11. In view of the above, the refund of the appeal fee in full is equitable by reason of a substantial procedural violation pursuant to Rule 103(1)(a) EPC.

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.
3. Reimbursement of the appeal fee in full is ordered.

The Registrar:

The Chairman:



L. Gabor

R. Bekkering

Decision electronically authenticated