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**Datasheet for the decision
of 21 July 2021**

Case Number: T 2452/18 - 3.5.05

Application Number: 11770358.7

Publication Number: 2628109

IPC: G06F19/00

Language of the proceedings: EN

Title of invention:

HANDHELD DIABETES MANAGEMENT DEVICE HAVING TESTING IN PAIRS
BLOOD GLUCOSE TEST

Applicant:

Roche Diabetes Care GmbH
F. Hoffmann-La Roche AG

Headword:

Testing in pairs/ROCHE

Relevant legal provisions:

EPC Art. 123(2)
RPBA Art. 12(4)
EPC R. 103(4)(c)

Keyword:

Amendments - added subject-matter (yes)

Late-filed request - request could have been filed in first instance proceedings (yes)

Reimbursement of appeal fee - (no)



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Case Number: T 2452/18 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 21 July 2021

Appellant: Roche Diabetes Care GmbH
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68305 Mannheim (DE)

Appellant: F. Hoffmann-La Roche AG
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Representative: Bittner, Thomas L.
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 7 May 2018
refusing European patent application No.
11770358.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair A. Ritzka
Members: E. Konak
F. Blumer

Summary of Facts and Submissions

- I. The appeal is against the examining division's decision to refuse the application on the grounds that the sole request did not meet the requirements of Article 56 EPC.
- II. With their statement setting out the grounds of appeal, the appellants maintained the sole request on which the decision under appeal was based as their main request and filed an auxiliary request. They requested that the decision be set aside and that a patent be granted on the basis of one of these requests. They requested oral proceedings as an auxiliary measure.
- III. In its preliminary opinion issued on 26 May 2021 in preparation for the oral proceedings, the board raised objections under Articles 123(2) and 56 EPC and informed the appellants that it was minded not to admit the auxiliary request filed with the statement setting out the grounds of appeal.
- IV. With a letter received on 20 July 2021, the appellants withdrew their request for oral proceedings. They further requested partial reimbursement of the appeal fee. The scheduled oral proceedings were cancelled.
- V. Claim 1 of the main request reads as follows:

"A method for conducting a Testing In Pairs (TIPs) blood glucose (bG) test using a handheld diabetes management device carried by a user, the method comprising:

- using a processing subsystem (22) to implement a software module (22a) for managing the TIPs test, the software module (22a) controlling the generation of a plurality of predetermined bG acceptance time windows corresponding to different user defined events;
- using the processing subsystem (22) to generate a first reminder for an event of the user defined events;
- using the processing subsystem (22) to check whether a time stamped bG test value was entered within a reminder time window;
- if a time stamped bG test value was not provided, using the processing subsystem (22) to check whether additional reminders are available in the acceptance time window of the event, and, if the check is positive, generate an additional reminder;
- using the processing subsystem (22) to identify specific ones of a plurality of bG test values read by the device, which are obtained during said predetermined bG acceptance time windows, as being related pairs of accepted bG test values that correspond to specific ones of the user defined events, wherein the processing subsystem (22) detects that two ones of the bG acceptance windows are open simultaneously and overlapping, and signals the user to mark a just obtained bG test result as being preprandial or postprandial;
- using the processing subsystem (22) to store the related pairs of accepted bG test values in a database (26);
- using the processing subsystem (22) to conclude the TIPs test when a predetermined number of pairs of accepted bG test values has been stored in the database (26); and
- using the processing subsystem (22) to retrieve and use the accepted bG test values

stored in the database (26) in providing results of the TIPS test."

- VI. Claim 1 of the auxiliary request differs from claim 1 of the main request as follows (with the additions underlined):

"A method for conducting a Testing In Pairs (TIPs) blood glucose (bG) test using a handheld diabetes management device carried by a user, the method comprising:

- using a processing subsystem (22) to implement a software module (22a) for managing the TIPS test, the software module (22a) controlling the generation of a plurality of predetermined bG acceptance time windows corresponding to different user defined events, wherein the user is prevented from directly altering or editing the acceptance time windows while a test is in progress;
[...]"

Reasons for the Decision

1. Main request - added subject-matter (Article 123(2) EPC)
- 1.1 Claim 1 of the main request was amended during the examination proceedings such that the claimed method now comprises steps for checking whether a time-stamped bG value was entered within a reminder time window and, if not, generating an additional reminder (i.e. features 3.4 and 3.4.1, using the feature numbering in section II.3 of the contested decision), as well as steps for signalling the user to mark a just obtained

bG test result as being preprandial or postprandial when it is detected that two bG acceptance windows are simultaneously open and overlapping (i.e. feature 3.5.1).

- 1.2 However, there is no embodiment in the application as filed which has both of these groups of features. The embodiments with an additional reminder (e.g. 116 in Fig. 4, 220 in Fig. 5, 326 in Fig. 6B or 426 in Fig. 7B) do not detect whether two acceptance windows are simultaneously open and overlapping or signal the user to mark a bG test result as preprandial or postprandial. The embodiments which have the latter group of features (e.g. the paragraph from page 18, line 28 to page 20, line 8, which has this feature in the last sentence, or the next paragraph from page 20, line 9 to page 21, line 10, which again has this feature in the last sentence) do not have the group of features involving additional reminders.
- 1.3 The board raised this objection in its preliminary opinion, to which the appellants did not reply in substance. Under these circumstances, the board sees no reason to change its preliminary opinion.
- 1.4 Therefore, claim 1 of the main request contains subject-matter which extends beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC.
2. Admissibility of the auxiliary request (Article 12(4) RPBA 2007)
 - 2.1 According to Article 12(4) RPBA 2007, the board has discretion to hold inadmissible requests which could have been presented in the examination proceedings.

- 2.2 In this case, the appellants were informed of the examining division's preliminary opinion that their sole request (the current main request) did not meet the requirements of Article 56 EPC in a telephone consultation on 28 March 2018. The minutes of this consultation were dispatched on 3 April 2018, in advance of the oral proceedings scheduled for 18 April 2018, and included the entire section of the contested decision giving the reasons for refusal (section II), with some editorial changes. The appellants replied by withdrawing their request for oral proceedings and requested a decision based on the file as it stood. Even though they were aware of the entire reasoning for the imminent refusal of their application, they did not file any auxiliary requests, nor did they attend the scheduled oral proceedings before the examining division (held in their absence), which would have been the last opportunity to file auxiliary requests. It follows that the auxiliary request filed with the statement setting out the grounds of appeal could and should have been filed in the examination proceedings.
- 2.3 Therefore, the board does not admit the auxiliary request (Article 12(4) RPBA 2007).
3. Request for partial reimbursement of the appeal fee
- 3.1 Since the appellants did not withdraw their appeal, the only possibility of partial reimbursement would be under Rule 103(4)(c) EPC. Pursuant to this rule, the appeal fee is reimbursed if any request for oral proceedings is withdrawn within one month of notification of the communication issued by the Board of Appeal in preparation for the oral proceedings, and

no oral proceedings take place. The appellants withdrew their request for oral proceedings on 20 July 2021, thus after the one-month period following the notification of the communication dated 26 May 2021 had expired. Therefore, there is no legal basis for partial reimbursement of the appeal fee.

- 3.2 The request for partial reimbursement of the appeal fee is thus refused.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for partial reimbursement of the appeal fee is refused.

The Registrar:

The Chair:



L. Stridde

A. Ritzka

Decision electronically authenticated