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**Datasheet for the decision
of 12 July 2023**

Case Number: T 1532/21 - 3.5.05

Application Number: 08725772.1

Publication Number: 2255313

IPC: G06F19/00

Language of the proceedings: EN

Title of invention:

SYSTEMS AND METHODS FOR DETERMINING AN AMOUNT OF BLOOD IN A
BLOOD CULTURE

Applicant:

Becton, Dickinson and Company

Headword:

Substantial procedural violation

Relevant legal provisions:

EPC R. 111(2), 103(1) (a)
RPBA 2020 Art. 11

Keyword:

Appealed decision - sufficiently reasoned (no) - substantial procedural violation (yes)

Remittal - fundamental deficiency in first-instance proceedings (yes)

Reimbursement of appeal fee - equitable by reason of a substantial procedural violation



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1532/21 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 12 July 2023

Appellant: Becton, Dickinson and Company
(Applicant) 1 Becton Drive
Franklin Lakes, NJ 07417-1880 (US)

Representative: dompatent von Kreisler Selting Werner -
Partnerschaft von Patent- und Rechtsanwälten mbB
Deichmannhaus am Dom
Bahnhofsvorplatz 1
50667 Köln (DE)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 24 March 2021
refusing European patent application No.
08725772.1 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. The examining division decided that the main request and auxiliary requests 1 and 2 did not meet the requirements of Article 56 EPC with regard to the following document:

D3: WO 2006/023470

Auxiliary request 1 was furthermore found not to meet the requirements of Articles 53(c) and 84 EPC.

II. In its statement setting out the grounds of appeal, the appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the main request or auxiliary request 1 or 2. As an auxiliary measure, it requested oral proceedings.

III. The board summoned the appellant to oral proceedings.

In its preliminary opinion pursuant to Article 15(1) RPBA, the board informed the appellant that it was minded to remit the case to the examining division, since fundamental deficiencies in the examination proceedings were apparent to the board (Article 11 RPBA).

In reply, the appellant withdrew its request for oral proceedings and requested a decision based on the board's preliminary opinion.

The scheduled oral proceedings were thus cancelled.

- IV. The wording of the claims of the requests is not relevant for this decision.

Reasons for the Decision

1. Rule 111(2) EPC requires that decisions which are open to appeal be reasoned. According to the established case law of the boards of appeal, in order to fulfil the requirements of Rule 111(2) EPC, a decision should contain arguments justifying its finding in a logical sequence. This is to enable the applicant and - in the event of an appeal - the board of appeal to examine whether or not the decision could be considered justified. As also submitted by the appellant, the applicant and/or the board should not be forced to speculate as to the possible reasons for a negative decision.

2. In the case in hand, the board agrees with the appellant that the examining division did not provide any reasoning for its assertion in the contested decision that the technical effect of the distinguishing features was not achieved over the whole scope of claim 1 of the requests on file. Nor does the contested decision indicate the part of the scope of the claims over which the technical effect is not achieved. Under these circumstances, the appellant is forced to speculate how the claims have to be limited so as to ensure that the technical effect is achieved over their whole scope.

As to the statement that "the skilled person [is left] unable to deduce the causal relationship between the [...] distinguishing features and the technical effect", this would normally mean that the technical effect is not achieved at all, which is different from

the objection that the technical effect is not achieved over the whole scope.

Irrespective of which one of these objections was meant by the examining division, it remains a mere unsubstantiated assertion. Instead of providing a logical sequence of arguments justifying this assertion, the examining division raises a number of questions. The board agrees with the appellant that they sound rather like clarity objections or objections to sufficiency of disclosure and have nothing to do either with the objection that the technical effect is not achieved over the whole scope or with the objection that the technical effect is not achieved at all.

The board will not speculate, as the appellant had to do, on the relevance of the enigmatic statement "as an orientation, see T 784/06 and T 2050/07 for examples of claims which are insufficiently respectively sufficiently defined in this respect [sic]". The examining division merely gives the numbers of two decisions without explaining their relevance and, as the appellant noted, these decisions are not related to the technical effect not being achieved over the whole scope of the claims.

3. Such reasoning does not meet the requirements of Rule 111(2) EPC, which gives parties to EPO proceedings a fundamental procedural right to be provided with the reasons for a decision. A breach of Rule 111(2) EPC is a fundamental deficiency constituting special reasons for remittal within the meaning of Article 11 RPBA (see Case Law of the Boards of Appeal of the European Patent Office, 10th Edition, July 2022, V.A.9.4.4(b)).

4. Therefore, the decision under appeal must be set aside and the case remitted to the examining division for further prosecution (Article 11 RPBA).

5. In view of the substantial procedural violation (see Case Law of the Boards of Appeal of the European Patent Office, 10th Edition, July 2022, V.A.9.4.3) in the examination proceedings, reimbursement of the appeal fee in full is equitable (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 examining division for further prosecution.

3. The appeal fee is to be reimbursed in full.

The Registrar:

The Chair:



K. Götz-Wein

A. Ritzka

Decision electronically authenticated