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D E C I S I O N
of 19 December 2000

Case Number: T 0920/97 - 3.3.4

Application Number: 86907142.3

Publication Number: 0245466

IPC: G06K 9/00

Language of the proceedings: EN

Title of invention:

Analysis method and apparatus for biological specimens

Patentee:

CELL ANALYSIS SYSTEMS, INC.

Opponent:

Alcatel N.V.

Headword:

-

Relevant legal provisions:

EPC Art. 107, 111(1), 114(1), 114(2)

EPC R. 64, 65(2)

Keyword:

"Parties to appeal - entitlement to appeal (yes)"

"Late-submitted document - admitted (yes)"

"Decision re appeals - remittal (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 0920/97 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 19 December 2000

Appellant: Alcatel N.V.
(Opponent) Strawinskylaan 341
NL-1077 XX Amsterdam (NL)

Representative: Sciaux, Edmond
COMPAGNIE FINANCIERE ALCATEL
Dépt. Propr. Industrielle
30, avenue Kléber
FR-75116 Paris (FR)

Respondent: CELL ANALYSIS SYSTEMS, INC.
(Proprietor of the patent) 261 Eisenhower Lane South
Lombard, IL 60148 (US)

Representative: Selting, Günther, Dipl.-Ing.
Patentanwälte
von Kreisler, Selting, Werner
Postfach 10 22 41
D-50462 Köln (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 28 May 1997
rejecting the opposition filed against European
patent No. 0 245 466 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: U. M. Kinkeldey
Members: R. R. K. Zimmermann
C. Holtz
L. Galligani
S. C. Perryman

Summary of Facts and Submissions

- I. The appeal concerns European patent No. 0 245 466 (European patent application No. 86 907 142.3) granted to the respondent on the basis of two independent claims; independent claim 1 reads as follows:
- "1. A method of quantifying an amount of cellular material in an automatic image analysing apparatus (11) including the steps of:
- providing a support means (14) which has calibration material (40) thereon, said calibration material having at least one parameter of a known value and having an optical density which varies in relation to staining concentrations;
 - providing specimen cell objects (12) having an unknown value for at least one parameter on a support means;
 - staining the specimen cell objects and calibration material at the same time with an image enhancing material;
 - calibrating (152) (A100) the automatic analysing apparatus (11) to adjust for variations in the amount of stains on the specimen cell objects in response to analysis of the staining of the calibration material;
 - forming a digitized image from the stained specimen cells on a support;
 - analysing (154) (A200) at least one parameter of said specimen cell objects using the digitized image thereof, said method being characterized by:
- said calibration material having at least one parameter of a known value with said parameter correlating to an optical density which varies in relation to staining concentrations;
- calibrating the automatic image analysing apparatus for variations in light intensity (A24) by adjusting the

apparatus in response to analysis of the intensity of light received by said image analysing apparatus; quantifying at least one parameter of said specimen cell objects using the digitized image thereof; and, reporting (A64) on the analyzed specimen cell objects based on the quantification and analysis."

- II. ALCATEL N.V. (The Netherlands), represented by a professional representative ("representative I"), filed an opposition against the patent, requesting revocation of the patent in its entirety on the ground of lack of inventive step in the light of prior art documents cited in support of the opposition. In the course of the opposition proceedings the opponent authorised a further professional representative ("representative II") to act for the opponent before the EPO, without revoking previous authorisations.

In a decision posted on 28 May 1997, the opposition division rejected the opposition essentially for the reason that the prior art as cited by the opponent did not disclose the steps of determining a parameter of cellular material, other than the cell volume of red blood cells, by measuring the optical density after staining the cellular material and calibrating for varying staining concentrations and did thus not prejudice the maintenance of the patent.

- III. Against this decision a notice of appeal containing a request for revocation of the patent in its entirety was filed by representative I on 12 July 1997; the appeal fee was paid the same day. A written statement setting out the grounds of appeal were subsequently filed on 3 October 1997. This statement of grounds indicated in detail why the decision was incorrect over

the already cited documents, and also cited the following additional prior art documents:

D4: Analytical and Quantitative Cytology vol. 5, No. 2, 1983, pages 112-116, Alan S. Evans et al.

D5: Analytical and Quantitative Cytology vol. 5, No. 4, 1983, pages 263-268, Hyun Y.Pak et al.

D6: Cytometry vol. 5, 1984, pages 217-227, David C. Allison et al.

Documents D4 and D5 were cited to illustrate the general technical knowledge in the field. Document D6 was cited because it specifically disclosed or at least suggested the entirety of features defined in claim 1 as well as the technical problem underlying the subject-matter of the patent in suit.

IV. For filing the notice of appeal representative I used a letterhead of ALCATEL ALSTHOM RECHERCHE (France), identifying himself by signature and the patent department ("Département Propriété industrielle") as his workplace. In view of these particulars, the EPO informed representative II that it had received the appeal "directly from the opponent", asking who was acting "on behalf of the opponent". In a letter dated 21 August 1997, representative I replied that the patent department of ALCATEL ALSTHOM RECHERCHE had taken charge of the opposition ("le Département Propriété Industrielle d'ALCATEL ALSTHOM prend la direction de cette opposition").

The respondent challenged the admissibility of the appeal as being filed by ALCATEL ALSTHOM RECHERCHE

(France) and not by the opponent. In response to this submission representative I confirmed by letter dated 15 December 1997 that the appeal was indeed filed by the opponent and that ALCATEL ALSTHOM RECHERCHE was merely where he was domiciled and asked for a respective correction of the notice of appeal under Rule 65(2) or Rule 88 EPC.

- V. In a communication to the parties the Board informed the parties of its preliminary view that the appeal appeared to be admissible.

In a further communication the Board indicated that it considered documents D4 to D6 as sufficiently relevant to be admitted into the appeal proceedings. Document D6, in particular, would be so relevant that the maintenance of the patent in suit might be prejudiced. The parties, therefore, were invited to indicate whether they preferred to have the case remitted to the first instance for further prosecution or to have the documents introduced and fully considered by the Board as final instance.

- VI. The appellant requested that the decision under appeal be set aside and the patent be revoked, and that oral proceedings be appointed if the board did not follow this request; the matter should not be remitted to the first instance for new consideration.

The respondent requested that documents D4, D5, and D6 not be admitted into the proceedings, that the appeal be dismissed and that the patent be maintained unamended, and that oral proceedings be appointed if the board intended to refuse its substantive request. If the Board was prepared to allow documents D4, D5 and

D6 into the proceedings, the respondent wished the case to be remitted to the first instance without holding any oral proceedings.

Reasons for the Decision

Admissibility of the appeal

1. The appeal complies with the requirements of Articles 106, 108 and Rules 1(1) and 64(b) EPC.

However, the respondent raised the objection that the appeal was not valid since the representative who filed the appeal (representative I) had been acting on behalf of ALCATEL ALSTHOM RECHERCHE and not on behalf of ALCATEL N.V. who was the opponent and the only party adversely affected by the decision under appeal. In fact, it follows from the provisions of Article 107 and Rule 65(1) EPC that an appeal filed by a person other than a party to the proceedings is inadmissible.

According to the submissions of representative I however, he filed the notice of appeal on behalf of ALCATEL N.V.; ALCATEL ALSTHOM RECHERCHE was merely where he was domiciled. The circumstances of the case do not argue against these submissions since neither the notice of appeal nor his letter of 21 August 1997 explicitly identify a different person than ALCATEL N.V. as appellant. Both documents only indicate the identity of the representative, and the business unit, the patent department of ALCATEL ALSTHOM RECHERCHE, within which representative I apparently practised.

In the absence of any clear indication to the contrary,

a professional representative who was authorised to act for a party adversely affected by a decision and then filed an appeal against this decision must be presumed to be acting on behalf of the very same party that he acted for in the first instance proceedings, and not on behalf of someone else not entitled to appeal.

Therefore, the Board is convinced that the notice of appeal has indeed been filed on behalf of ALCATEL N.V., a party to the first instance proceedings who is undisputedly entitled to appeal in the present case.

Nevertheless, the notice of appeal did not indicate the name and address of the appellant in accordance with the provisions of Rule 26(2)(c) EPC as required by Rule 64(a) EPC. As set out in Rule 65(2) EPC, failure to comply with Rule 64(a) EPC, however, leads to inadmissibility of the appeal only if the appellant fails to remedy this deficiency within the time set in an invitation from the Board to do so. As here the appellant corrected the notice of appeal before any such invitation was even issued with its letter dated 15 December 1997, this deficiency has been remedied.

Therefore, the appeal complies with all the requirements set out in Articles 106 to 108 and in Rules 1(1) and 64 EPC and is thus admissible.

Admission of new documents

2. Documents not filed within the nine month time limit of Article 99(1) EPC for filing an opposition may, pursuant to Article 114(2) EPC, be disregarded by the Board, in its discretion, as not submitted in due time. However, it has been the practice of the boards to exercise their discretion in particular so as to allow

in new documents filed with the grounds of appeal if they are *prima facie* so relevant as to determine the outcome of the case.

Document D6 apparently discloses a type of automatic absorption cytometric DNA measurements which meets the combination of features on which the opposition division based its positive assessment of inventive step. Therefore, document D6 invalidates the reasoning given in the decision under appeal concerning inventive step, which warrants the admission of document D6 to the proceedings.

Documents D4 and D5 serve the illustration of the general technical knowledge in the field relating to staining, which in the view of the appellant has not been fully acknowledged in the decision under appeal, and thus seem to be also relevant enough to be admitted into the proceedings.

A more detailed discussion of the new documents is inappropriate, in the light of the following considerations.

Remittal to Opposition Division

3. Remittal to the Opposition Division, rather than consideration by the Board itself, is an exercise of discretion by the Board under Article 111(1) EPC. The indicated requests or wishes expressed by the parties are not decisive of how this discretion should be exercised, and it can be exercised even contrary to the wishes of one or more parties.

Here one party has expressed a desire for remittal if,

as is the case, the Board admits the documents into the proceedings. The Board also considers that the case is not ripe for a decision by it as final instance, given that it has not had the benefit of any reasoning of the first instance in relation to prima facie relevant documents D4, D5, and D6, nor in relation to any amended claims the respondent might wish to put forward to take account of these documents. Accordingly the Board exercises its discretion under Article 111(1) EPC in favour of remittal of the case to the first instance.

4. On the substantive issues which now remain to be decided, it is open to the parties to request oral proceedings before the first instance and on any appeal therefrom. The Board interprets the existing auxiliary requests for oral proceedings as being applicable only if the Board wished to take a decision on the substantive issues, and as the Board is not deciding these, no oral proceedings before the Board were required at this stage.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution with documents D4 to D6 admitted into the proceedings.

The Registrar:

The Chairwoman:

U. Bultmann

U. Kinkeldey