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File Number: W 39/90 - 3.4.2

Application No.: PCT/GB89/01420

Publication No.:

Title of invention: Sensor for optical assay

Classification: G01N 21/77, G01N 21/64, G01N 33/53

D E C I S I O N
of 12 February 1991

Applicant: Ares-Serono Research & Development Limited
Partnership et al.

Proprietor of the patent:

Opponent:

Headword:

EPC Rules 13.1, 13.2(ii) PCT

Keyword: "No lack of unity a priori between the independent claims"

Headnote



Case Number : W 39/90 - 3.4.2
International Application No. PCT/GB89/01420

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 12 February 1991

Applicants : Ares-Serono Research & Development
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Subject of the Decision : Protest according to Rule 40.2(c) of the Patent
Cooperation Treaty made by the applicants against
the invitation (payment of two additional fees)
of the European Patent Office (branch at The
Hague) dated 7 May 1990.

Composition of the Board :

Chairman : E. Turrini
Members : W. Hofmann
C. Payraudeau

Summary of Facts and Submissions

- I. Following the filing of this international application, the EPO, acting as International Searching Authority (ISA), issued an invitation pursuant to Article 17(3)(a) and Rule 40.1 PCT to pay two additional search fees.

- II. The reasoning of the ISA accompanying this invitation is as follows:

The subjects, defined by the problems and their means of solution, as listed below are so different from each other that no technical relationship or interaction can be appreciated to be present so as to form a single general inventive concept.

- 1. Claims 1-5: Optical sensor.

- 2. Claims 6-10, 12-14: Method of assay in which a surface of the sensor or the sample is irradiated with light and apparatus and kit therefor.

- 3. Claim 11: Sample collecting and testing device.

- III. The Applicants paid the two additional search fees under protest and argued in particular that Claim 11 was part of the same general inventive concept as Claims 1 to 5, that all of these claims related to sensors and that Claim 11 was concerned with a preferred embodiment of the sensors claimed in Claims 1 to 5.

With respect to Claims 6 to 10 and 12 to 14 the Applicants submitted that the present application sought to provide a method of carrying out an improved optical assay, together

with the means for doing so. Rule 13.2 PCT permitted an independent claim for a product and, in the same international application, an independent claim for the use of said product. The facts of the present case were similar to the case W 32/88 (OJ 4/1990, 138) where the Board of Appeal held that an invitation to pay an additional fee was not justified since the claims concerned a process and an apparatus specifically designed for carrying out the process.

Reasons for the Decision

1. The protest conforms with the formal requirements of Rule 40.2(c) PCT and is, therefore, admissible.
2. In its reasoning, the ISA does not refer to any state of the art, which means that, in the view of the ISA, the lack of unity is a lack of unity a priori. It suffices therefore that the Board also confines its considerations to the question of unity a priori.
3. The set of claims of the international application comprises six independent claims, i.e. Claims 1, 6, 11, 12, 13 and 14. Claim 1 is directed to a sensor, Claims 6 and 14 to methods of using the sensor specified in Claim 1, and Claims 11, 12 and 13 to three devices each comprising the sensor specified in Claim 1 (Claims 12 and 13 additionally referring to the use in a method of assay as claimed in Claim 6).

Contrary to the opinion of the ISA, the Board sees a technical relationship between the subjects of these claims, forming a single general inventive concept in the sense of Rule 13.1 PCT. This single concept consists in the fact that all of these claims relate to subject-matter

comprising or making use of the specific construction of a sensor as defined in Claim 1, for the purpose of improving the intensity of the emitted light (cf. page 2, lines 31 and 32) when measuring fluorescence or absorption for the assay of chemical or biochemical entities (cf. page 1, line 4).

4. Moreover, the claims correspond to the example given in Rule 13.2(ii) PCT for permitted combinations of claims of different categories in one international application.

Claims 6 and 14 each relate to a process of assay for a ligand, differing in the way how the sensor is irradiated, but having in common the main points, in particular the use of the sensor defined in Claim 1.

Claims 1, 11, 12 and 13 relate to four devices (based on the same concept) all being specifically designed for carrying out the process defined in Claim 6. The latter is apparent since the sensor defined in Claim 1 is directly the sensor mentioned in Claim 6, and the devices according to Claims 11, 12 and 13 comprise as main elements the features of Claim 1, and in addition further features useful for the performance of the process defined in Claim 6.

This finding is in full agreement with Board of Appeal decision W 32/88 cited by the Applicant. The Board agrees with the opinion of the Applicant that it is not the formal choice of words or back references, but the actual content of the claims which establishes technical relationships between the subject-matter of different claims, and which is thus decisive for the question of unity.

Order

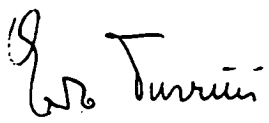
For these reasons, it is decided that:

Reimbursement of the two additional search fees is ordered.

The Registrar:


P. Martorana

The Chairman:


E. Turrini

140

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