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D E C I S I O N
of 16 June 2004

Case Number: T 0274/00 - 3.3.2

Application Number: 91905180.5

Publication Number: 0580570

IPC: A23L 1/00

Language of the proceedings: EN

Title of invention:

Two-stage process for cooking/browning/crusting food by
microwave energy and infrared energy

Patentee:

Levinson, Melvin L.

Opponent:

WHIRLPOOL Corporation

Headword:

Process for cooking/browning food/WHIRLPOOL

Relevant legal provisions:

EPC Art. 69, 84, 123(2), 123(3)
EPC R. 29(1)

Keyword:

"Amendment of claim 1 after grant: infringement of
Article 123(3) EPC (yes)"

Decisions cited:

G 0002/88, G 0006/88, G 0001/98, J 0004/85, T 1149/97

Catchword:

-



Case Number: T 0274/00 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 16 June 2004

Appellant: WHIRLPOOL Corporation
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
3 February 2000 concerning maintenance of
European patent No. 0580570 in amended form.

Composition of the Board:

Chairman: U. Oswald
Members: G. F. E. Rampold
J. H. P. Willems

Summary of Facts and Submissions

I. This appeal lies against an interlocutory decision in opposition proceedings pronounced at the close of the oral proceedings on 13 December 1999 and posted on 3 February 2000, maintaining European patent No. 0 580 570 ("the patent") in amended form. The patent was granted on 26 June 1996 to its proprietor (hereinafter referred to as the "respondent") with 11 claims, based on European patent application No. 91 905 180.5 and concerning a "Two-stage process for cooking/browning/crusting food by microwave energy and infrared energy". The independent claim of the patent as granted read as follows:

- "1. A method for browning/crusting food, in two stages, comprising:
- In a first stage: placing a microwave-lossy browning/crusting device in a microwave chamber, said browning/crusting device including a metal food contacting surface on a metal tray supporting a non-metal food contacting surface;
- said browning/crusting device further being resistant to heat damage when exposed to infrared energy from an infrared broiler; exposing said browning/crusting device to microwaves until said food contacting surface is heated to a food browning/crusting temperature; placing said food to be browned/crusted on said food contacting surface to brown/crust said food in contact with said food contacting surface; and
- In a second stage: exposing said browning/crusting device and said food to infrared energy by placing

said browning/crusting device, with said food on said food contacting surface, beneath an infrared broiler whereby a surface of said food, opposed to said food contacting surface, is browned/crusted by said infrared energy from, said broiler.

Dependent claim 4 as granted was worded as follows:

"4. The method of claim 1 wherein said browning/crusting device includes a metal plate which has a metal food contacting surface and has a microwave-lossy composition in contact with the opposite surface of said food contacting surface."

II. The opponent (hereinafter referred to as the "appellant") gave notice of opposition on 7 March 1997, seeking revocation in full of the patent on the grounds of lack of novelty and inventive step (Articles 54, 56 and 100(a) EPC), and also on the ground of insufficient disclosure (Articles 83 and 100(b) EPC).

III. Of the numerous documents cited during the first-instance opposition and subsequent appeal proceedings against the patentability of the claimed subject-matter in the patent in suit, the following citation is referred to in this decision:

(1) US-A-3 881 027.

IV. In its interlocutory decision, the opposition division found that the first auxiliary request before it consisting of an amended claim 1, received on 21 October 1999 with the respondent's letter dated 7 October 1999, and dependent claims 2 to 8, filed

during oral proceedings, and a consequentially amended description met the requirements of the EPC. Claim 1 as maintained by the opposition division reads as follows, with the **amendments after grant** being highlighted in bold italics below:

"1. A sequential method for browning/crusting food, in two stages, comprising:

In **the** first stage **wherein**

cooking/browning/crusting is carried out: placing

a microwave-lossy browning/crusting device in a microwave chamber, said browning/crusting device

comprising a metal plate having an exposed metal

food contacting surface and having another metal

surface which is coated with a microwave-lossy

composition which is in a heat transferring

relationship with the metal plate; said

browning/crusting device further being resistant

to heat damage when exposed to infrared energy

from an infrared broiler; exposing said

browning/crusting device to microwaves until said

food contacting surface is heated to a food

browning/crusting temperature; placing said food

to be browned/crusted on said food contacting

surface to brown/crust said food in contact with

said food contacting surface;

in **the** second stage **wherein the top surfaces of**

the food are browned/crusted: exposing said

browning/crusting device and said food to infrared

energy by placing said browning/ crusting device,

with said food on said food contacting surface,

beneath an infrared broiler whereby a surface of

said food, opposed to said food contacting

surface, is browned/crusted by said infrared energy from said broiler."

Dependent claims 4 to 6 as granted have been deleted. Dependent claims 2, 3 and 7 to 11 as granted have been maintained by the opposition division as consecutively numbered dependent claims 2 to 8, with the dependencies amended as necessary.

V. The essence of the reasoning in the opposition division's interlocutory decision was as follows:

As regards the respondent's main request that the opposition be rejected, the opposition division considered that claim 1 as granted, although satisfying the requirements of sufficiency of disclosure in accordance with Article 83 EPC, lacked novelty. In the opinion of the opposition division, a method of browning/crusting a food product comprising all the features of claim 1 as granted had already been disclosed in citation (1).

As regards the respondent's first auxiliary request, the opposition division found that the amended claims were admissible under Rules 57a and 71a EPC and that such claims also complied with the formal requirements of Articles 84 and 123(2) and (3) EPC.

Concerning novelty, the opposition division referred to the combination of the following technical features in claim 1 as amended: *"said browning/crusting device comprising a metal plate having an exposed metal food contacting surface and having another metal surface which is coated with a microwave-lossy composition*

which is in a heat transferring relationship with the metal plate". It pointed out that none of the cited documents had made available to the public either directly or implicitly this newly introduced combination of technical features in the context of a method for browning/crusting food claimed in claim 1 as amended.

As to inventive step, the opposition division saw the problem which the patent purported to solve in the provision of a process enabling a sequential browning and crusting of the underside and the upper side of a food piece. It found that the solution to this problem proposed in claim 1 of the first auxiliary request involved an inventive step in the light of the cited state of the art.

VI. Oral proceedings before the board were held on 16 June 2004. In his introductory remarks, the chairman drew the parties' attention to the fact that the claims as maintained by the opposition division had been substantially amended after grant and that the question of compliance of the amended claims with Article 123(3) EPC had already played a major role in the proceedings before the opposition division and remained a key issue to be decided in this appeal.

VII. The appellant's submissions, **so far as relevant to this decision**, can be summarised as follows:

The appellant argued that amended claim 1 as maintained by the opposition division extended the protection of the claims conferred by the claims as granted. It strongly contested the opposition division's

interpretation of claim 1 as amended in the decision under appeal, namely "that claim 1 would be interpreted by the skilled person as meaning nothing else than that either a metal food contacting surface or a non-metal food contacting surface is contacted by the food". Further, it referred in this context to the decision under appeal saying "that nothing else than that was intended by drafting the claim has also been confirmed by the Proprietor of the patent". The decisive criterion for the determination of the scope of protection of a granted claim was not, in the appellant's opinion, the subjective interpretation of its own claim by the respondent but the objective interpretation based on the skilled person's understanding of the claim. The appellant submitted that the respondent had essentially focussed his observations on an independent claim covering the embodiment of the claimed invention shown in Figures 4 to 6 of the patent. The conclusion drawn from these figures that "a device including a metal food contacting surface on a metal tray supporting a non-metal food contacting surface", as defined in claim 1, should be construed as meaning that either a metal or a non-metal surface in contact with the food would not only seem illogical but also incorrect.

The skilled reader of the patent as granted would immediately understand that it was the respondent's intention to claim the embodiment of the invention shown in Figures 4 to 6. In the appellant's judgment, claim 1 as maintained covered a more general version of the claimed method, wherein a browning dish having a food contacting surface consisting of only one single material, namely metal, was used. Since claim 1 as

granted stipulated the use of a browning dish having a food contacting surface consisting of two different materials, namely metal and non-metal, claim 1 as amended offended against Article 123(3) EPC.

VIII. The respondent's arguments, **so far as relevant to this decision**, are summarised below:

In the respondent's opinion, claim 1 as maintained by the opposition division resulted in a limitation of the extent of protection conferred by claim 1 as granted. Claim 1 as maintained simply resulted from the inclusion of the subject-matter of dependent claim 4 as granted in granted claim 1. In claim 4 the browning-crusting device was defined as "including a metal plate which has a metal food contacting surface and has microwave-lossy composition in contact with the opposite surface of said food contacting surface". A corresponding embodiment was also mentioned in the patent specification at column 2, lines 37 to 46. In order to arrive at claim 1 as amended the skilled reader would, based on the provisions of Article 69 EPC and its Protocol, simply replace the following features in claim 1 as granted "said/browning crusting device including a metal food contacting surface on a metal tray supporting a non-metal food contacting surface" with the particular preferred embodiment as defined in claim 4. In doing so it would become immediately evident to the skilled reader that this embodiment did not contain a non-metal food contacting surface. A violation of Article 123(3) EPC could thus not be seen by the respondent.

- IX. The appellant requested that the decision under appeal be set aside and that the patent be revoked.
The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

Background and introductory remarks

2. The substantive provision set out in Article 123(3) EPC (prohibition of extension of protection) is specifically limited in its application to the amendment of *claims in opposition proceedings* before the EPO ("The claims of the European patent may not be amended during opposition proceedings in such a way as to extend the protection conferred.").
- 2.1 This article is directly aimed at protecting the interests of third parties by prohibiting any broadening of the claims of a granted patent, *even if there should be a basis for such broadening in the application as filed* (see G 1/93, OJ EPO 1994, 541). The guiding principle under Article 123(3) EPC may therefore be summarised by the finding that "once a European patent has been granted, an act by a third party which would not infringe the patent as granted should not be able to become an infringing act as a result of amendment after grant". This is the essential purpose and guiding principle underlying Article 123(3) EPC (see eg T 1149/97, OJ EPO 2000, 259).

2.2 It follows that, when considering Article 123(2) EPC, the question of *extension of subject-matter* depends upon a comparison with the "*application as filed*". When considering Article 123(3) EPC, however, the question of *extension of the protection conferred* depends upon a comparison with the "*claims as granted*".

2.3 When considering whether a proposed amendment to the claims is such as to extend the protection conferred

- **a first step must** be to determine the extent of protection which is conferred by the claims as granted before the amendment: it is necessary to be quite clear as to what is the protection conferred by the claims without amendment, before one can decide whether a proposed amendment is such as to extend it;

- **the second step** to be considered under Article 123(3) EPC is then whether the subject-matter defined by the claims is more or less narrowly defined as a result of the amendment. A proposed amendment may involve a change of category, or a change in the technical features of the invention, or both. Each type of amendment requires separate consideration. In the present case of a change in the technical features of the invention, if the technical features of the claimed invention after amendment are more narrowly defined, the extent of the protection conferred is less; and if such technical features are less narrowly defined as a result of amendment, the protection conferred is therefore extended. Clearly, if technical features are

changed by an amendment, in that the subject-matter of the claims after amendment is outside the scope of the subject-matter before amendment, there is then necessarily an extension of protection (see G 2/88, G 6/88, OJ EPO, 1990, 93, 114).

Interpretation of claims under the EPC

3. The EPC contains a set of provisions (Article 84 and Rule 29(1) EPC in conjunction with Article 69 EPC and its Protocol) which reflect **the central importance of the claims** of a European patent application or patent for determining the scope of protection conferred by it.

3.1 Determination of the extent of protection has to be carried out in accordance with Article 69(1) EPC and its Protocol. The protection conferred by a patent is determined by the terms of the claims (Article 69(1) EPC and its Protocol), and in particular by the categories of such claims and their technical features. The **main role of the claims** is emphasised in the first sentence of Article 69(1) EPC. The **subsidiary role of the description and the drawings** is set out in the second sentence of said Article. The nature of the relationship between the claims on the one hand, and the description and the drawings on the other hand is further explained in the Protocol to Article 69 EPC which provides a guide to the manner in which the technical features of the claim are to be interpreted, if necessary.

3.2 The object of the Protocol, which provides a guide to the manner in which the technical features of the claim

are to be interpreted, is clearly to avoid too much emphasis on the literal wording of the claims when considered in isolation from the remainder of the text of the patent in which they appear; and also to avoid too much emphasis upon the general inventive concept disclosed in the text of the patent as compared to the relevant prior art, without sufficient regard also to the wording of the claims as a means of definition. This approach to the interpretation of claims must be adopted by the EPO when determining the protection conferred for the purpose of Article 123(3) EPC.

Extent of protection conferred before the amendment

- 4. The application of the principles set forth above to the present case leads to the following conclusions:
 - 4.1 The extent of protection conferred by the broadest claim of the patent in suit, ie claim 1 as granted, encompasses "A method for browning/crusting food, in two stages, comprising: "In a first stage: placing a microwave-lossy browning/crusting device in a microwave chamber, **said browning/crusting device including a metal food contacting surface on a metal tray supporting a non-metal food contacting surface** ."
 - 4.2 The aforementioned technical features defining the browning crusting device, when being read with the normal skills including the knowledge about the prior art, are in their technical meaning in the given context sufficiently clear in themselves that they can be used to determine the extent of protection **without** interpretation by reference to the description and the

drawings of the patent. The skilled reader would immediately understand that said browning/crusting device **includes** in its broadest aspect as claimed in claim 1 as granted a **metal food contacting surface** on a metal tray **and** a **non-metal food contacting surface** supported by that metal tray. In this respect it should be noted that neither the examining division during the examination proceedings, nor the opposition division during opposition proceedings indicated that there had been a problem understanding the technical meaning of the features of claim 1 as granted in the given context. On the contrary, from the opposition division's reasoned statement in the decision under appeal to the effect that claim 1 as granted lacks novelty over the state of the art according to citation (1) it would seem that it was in itself in no real doubt as to the clarity of the technical meaning of the claim in question in its given context.

- 4.3 In particular, the wording and terminology of the features used in claim 1 of the patent in suit are sufficiently clear and technically meaningful to exclude the interpretation given by the opposition division in paragraph 2 of the decision under appeal, namely "that claim 1 would be interpreted by the skilled person as meaning nothing else than that either a metal food contacting surface or a non-metal food contacting surface is contacted by the food. That nothing else than that was intended by drafting the claim has also been confirmed by the proprietor of the Patent."

The wording of claim 1, on its proper construction (ie when its meaning for the skilled man is determined),

leaves no room for the interpretation by the opposition division according to which this claim would cover, beyond its wording, two distinct alternatives for the browning/crusting device, that is to say **a first alternative** of a browning/crusting device which includes only a metal food contacting surface and **a second alternative** including only a non-metal food contacting surface. On the contrary, the wording and terminology used in the granted claim clearly stipulate the use of a browning/crusting device including both

- a metal and
- a non-metal food contacting surface, the latter being supported by a metal tray.

4.4 In the decision under appeal (see Reasons, point 2, last two paragraphs) the opposition division emphasised *"that the embodiment of figure 6 shows a device having both materials (emphasis added by the board) as food contacting surface. In connection with this, it is considered that the rim of the metal tray in the embodiment of figure 6 is small, but still a surface which can be contacted by the food. Thus even by applying a strict literal interpretation of the wording of the claims support can be found in the description"* (emphasis added by the board).

Although the above observations of the opposition division regarding the embodiment shown in Figure 6 (and similarly the embodiments shown in Figures 3 to 5 of the patent in suit) appear correct, namely that in the above-mentioned figures devices are shown "having both materials as food contacting surface" (ie a metal

and a non-metal food contacting surface, these observations do not, of course, support the opposition division's attempt to interpret claim 1 as granted "*as meaning nothing else than that either a metal food contacting surface or a non-metal food contacting surface is contacted by the food*".

On the contrary, when using, in accordance with Article 69 EPC and its Protocol, the description and drawings, in particular Figures 3 to 6 in the context of the disclosure in column 6, lines 53 to 57, of the patent, to determine the subject-matter which is protected by claim 1, as defined by its technical features before amendment (emphasis added), the opposition division itself concluded that the patent confers protection on a browning/crusting device "having both materials as food contacting surface", ie a metal and a non-metal food contacting surface.

- 4.5 During the oral proceedings before the board the respondent argued that the amendment did not offend Article 123(3) EPC because it served to remove an inconsistency between claim 1 and dependent claim 4 as granted (see I above). Such an inconsistency was, however, neither mentioned by the examining division during the examination proceedings or by the opposition division during opposition proceedings, nor can the board find the alleged inconsistency.

In this respect it is noted that, by using the terminology "including" (claim 1), "includes" (claim 4), the definition of the browning/crusting device is **open-ended** in both claims 1 and 4.

The relevant portion of claim 1 reads as follows: "*said browning/crusting device including a metal food contacting surface on a metal tray supporting a non-metal food contacting surface*";

The relevant portion of claim 4 reads as follows: "*said browning/crusting device includes a metal plate which has a metal food contacting surface and has a microwave-lossy composition in contact with the opposite surface of said food contacting surface*".

By purposely choosing the terminology "including" or "includes" the respondent made it, in the board's judgment, unambiguously clear that neither in claim 1 nor in claim 4 as granted the browning/crusting device had ever been intended to be restricted to one alternative only, namely that either a metal food contacting surface or a non-metal food contacting surface is present on said browning/crusting device. According to "Webster's Ninth New Collegiate Dictionary", Springfield, Mass, 1987, page 609, "*syn include, comprehend, embrace, involve mean to contain within as part of the whole. Include suggests the containment of something as a constituent, component, or subordinate part of a larger whole.*"

The board cannot thus agree with the respondent's argument that claim 4 relates to an embodiment (alternative) of the claimed invention, excluding a non-metal food contacting surface as a compulsory component of the browning/crusting device as defined in claim 1. On the contrary, dependent claim 4 could, in the board's opinion, only be interpreted by the skilled reader as relating to a specific embodiment of the

metal food contacting surface mentioned in claim 1 as one component of the browning/crusting including both a metal food contacting surface and a non-metal food contacting surface as stipulated by claim 1.

The notional skilled person, familiar with the basic principles of patent law, would arrive at the following wording of claim 1 when including the features of claim 4:

"said browning/crusting device including a metal plate which has a metal food contacting surface and has a microwave-lossy composition in contact with the opposite surface of said food contacting surface on a metal tray supporting a non-metal food contacting surface".

In view of the above, the board sees no sound reason justifying the deletion of the features "on a metal tray supporting a non-metal food contacting surface" in claim 1 as amended, when including in the claim the subject-matter of dependent claim 4, even when applying the principles of Article 69 and its Protocol.

4.6 During the hearing before the board, the respondent argued for the first time in the present case that the relevant wording in claim 1 as granted "..... metal food contacting surface on a metal tray" resulted from an unintentional transcription error for "..... metal food contacting surface or a metal tray"

In order to make credible an obvious error in a document filed at the EPO, two matters must be established:

(i) that an error is indeed present in that document;

(ii) that the proposed correction of the error is obvious in "in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction".

4.7 In order to establish condition (i), which is a subjective matter, reference may be made to any relevant documents or other evidence, including in appropriate cases the file history (see in this connection, *inter alia*, decision J 4/85, paragraph 7, third sub-paragraph, OJ EPO, 1986, 205). In the present case, in the board's view, having regard to the file history, there is absolutely no indication that the text of the granted version of claim 1 might indeed have resulted from the above-mentioned unintentional transcription error. In this respect reference is made, *inter alia*, to the following relevant episodes of the file history:

- the text of the claims and the description as granted and the drawings are identical with the corresponding parts of the application as originally filed, ie the international application as published under the PCT (WO 92/14369);
- the respondent's unambiguous approval with its letter of 10 May 1995 to the text of the claims and the description as granted and the drawings accompanying the Rule 51(4) EPC communication dated 27 February 1995 ("*In connection with the above application, the applicant approves the text*

and drawings accompanying the Rule 51(4) Communication dated 27th February");

- the respondent's sole request in the written opposition proceedings on 18 September 1998 that the patent be maintained in the form as granted;
- the repetition of the above request as **the main request** in the oral proceedings before the opposition division;
- the finding of the opposition division in the decision under appeal that claim 1 as granted lacked novelty over the prior art of (1);

In view of the above, no indication can be found on the basis of the file history that claim 1 as granted contained the alleged unintentional transcription error. In the board's opinion, the alleged error could not have remained unnoticed by the respondent until such a late stage of the appeal proceedings.

4.8 As regards condition (ii), the observations in points 4.1 to 4.5 above made it sufficiently clear that a skilled reader of the granted patent would not have recognised that nothing else would have been intended by the respondent than what it offered as the correction during oral proceedings before the board.

5. *Conclusion:* In view of the above, there can be no doubt that the technical features of the claimed subject-matter in claim 1 as amended after grant are less narrowly defined as a result of the proposed amendments and that the protection conferred is therefore extended.

Clearly, the technical features have been changed by the proposed amendment, in that the technical subject-matter of claim 1 after amendment is outside the scope of the technical subject-matter before amendment and there is then necessarily an infringement of Article 123(3) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

A. Townend

U. Oswald