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D E C I S I O N
of 28 November 2002

Case Number: T 0664/00 - 3.3.2

Application Number: 92915753.5

Publication Number: 0594747

IPC: A21D 6/00

Language of the proceedings: EN

Title of invention:
Yeast-leavened refrigerated dough products

Patentee:
THE PILLSBURY COMPANY

Opponent:
Société des Produits Nestlé S.A.

Headword:
Dough Products/PILLSBURY

Relevant legal provisions:
EPC Art. 54, 56, 108, 122(2), 123(2), (3)
EPC R. 57(a), 78

Keyword:
"Inability of a US expert to be present at the oral proceedings: no reason for adjournment"
"Re-establishment of the appellant's right to file its grounds of appeal (yes): loss of rights was an isolated mistake"
"Admissibility of late filed evidence (no): absence of evidence from a respondent no reason for an appellant, having the burden of attacking an appeal decision, for late filing of evidence" "Main request, novelty (no): disclosure of starting cells and their conversion into yeast strains is prejudicial to the novelty of the latter"

"First auxiliary request: disclaimer solely based on Article 54(3) EPC prior art acceptable under Article 123(2) EPC - no referral to the Enlarged Board of Appeal"
"Novelty (yes): distinguishing functional feature
"Remittal to the first instance"

Decisions cited:
G 0010/91, G 0001/93, G 0002/98, J 0005/98, T 0012/81, T 0434/92, T 0526/92, T 0653/92, T 0710/92, T 0426/94, T 0982/94, T 0323/97, T 0318/98, T 0351/98

Catchword:
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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0664/00 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 28 November 2002

Appellant: (Proprietor of the patent)
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 23 May 2000 revoking European patent No. 0 594 747 pursuant to Article 102(1) EPC.**

Composition of the Board:

Chairman: P. A. M. Lançon
Members: G. F. E. Rampold
C. Rennie-Smith

Summary of Facts and Submissions

I. The appellant is proprietor of European patent No. 0 594 747 which was granted with 11 claims on the basis of European patent application No. 92 915 753.5, corresponding to International application No. PCT/US92/05 931, published under the PCT as WO 93/01 724. Independent claims 1 and 7 as granted read as follows:

"1. A method of producing a dough composition, capable of being stored at refrigeration temperatures, said method comprising the steps of mixing yeast, water and flour, the method being such that the yeast will remain substantially inactive at refrigeration temperature, wherein the yeast is not NCIMB 40328, 40329, 40330, 40331 or 40332.

7. A method of producing a dough composition, capable of being stored at refrigeration temperatures, said method comprising the steps of mixing water flour and yeasts, the specific strain of the yeast and the total dough composition being chosen so that the total amount of sugar or sugars within the dough to be fermented by the yeasts is limited, thus limiting the maximum volume of carbon dioxide which the yeast can generate to no more than 100 ml of carbon dioxide per 100 g of dough at 32°C."

II. The respondent filed notice of opposition requesting revocation in full of the European patent pursuant to Article 100(a) EPC for lack of novelty and inventive step of all claims and, additionally, pursuant to Article 100(b) EPC for insufficiency of disclosure of

claim 7. Of the numerous documents cited during the opposition and subsequent appeal proceedings, only the following remains relevant to the present decision:

(1) EP-A-0 487 878.

III. The patent was revoked pursuant to Article 102(1) EPC by a decision of the opposition division posted on 23 May 2000. The stated ground for the revocation was lack of novelty of claim 1 as granted in accordance with the appellant's main request. The appellant's first and second auxiliary requests filed during the oral proceedings before the opposition division were rejected either under Rule 57(a) EPC or as filed too late although the third auxiliary request filed at the same time was also considered unallowable under Article 123(2) EPC.

In its decision, the opposition division stated that citation (1) was part of the state of the art under Article 54(3)EPC. Further, in the decision it was stated that (1) disclosed a method of producing a dough composition, capable of being stored at refrigeration temperature, comprising the steps of mixing yeast, water and flavour. The opposition division considered that citation (1) made available to the public, not only the yeast strains which were explicitly disclaimed from claim 1 of the opposed patent, but also strains which were "substantially inactive" within the meaning of this term as used in the patent in suit and which were accordingly suitable for use in the method disclosed in citation (1). The oppposition division's conclusion was that the content of citation (1) was prejudicial to the novelty of the method of producing a dough claimed in the patent in suit.

IV. In a letter received on 23 June 2000, the Patentee's representative filed a notice of appeal against this decision, the appeal fee being paid on the same date. By a facsimile dated 2 October 2000 and received by the EPO on 3 October 2000, the appellant filed the written statement setting out the grounds of appeal, requesting as main request maintenance of the patent as granted and enclosing four sets of amended claims as its first, second, third and fourth auxiliary requests.

V. In a letter from the appellant dated 1 November 2000 and received by the EPO on 3 November 2000, it was stated that the time limit for filing the statement of grounds of appeal as calculated by Article 108 EPC and Rule 78 EPC was 2 October 2000 and that, accordingly, the statement of grounds of appeal might have been filed outside the time limit. In the same letter, the appellant filed a request for re-establishment of rights and set out the grounds therefor, and the appropriate fee was paid on the same date.

VI. The respondent filed arguments in support of dismissal of the re-establishment request in its letters of 17 April 2001 and 15 June 2001 to which the appellant replied in letters of 25 May 2001 and 10 July 2001 respectively. No request for oral proceedings in respect of this issue was made other than by the appellant if the Board should consider refusing the request.

VII. In a communication of 10 June 2002, sent with the summons to oral proceedings, fixed for 28 November 2002, the Board gave its decision that the re-establishment request was allowed.

VIII. In two letters of 13 and 22 August 2002 the appellant requested an adjournment of the oral proceedings in order to allow the attendance at those proceedings of an expert from the United States which would not be possible on the date appointed by the Board, since this is a public holiday (Thanksgiving) in the USA.

IX. In a communication of 12 September 2002, the Board stated that, once made, its procedural directions cannot be changed unless, exceptionally, a compelling change of circumstances so requires and no such new circumstances had even been indicated. It was open to the appellant either to attend the oral proceedings with a non-US expert or to file written evidence from a US expert; in either case, subject to the respondent's submissions and the Board's discretion as to who it hears or to admit late-filed evidence.

In the above communication, the Board also expressed the provisional view that, since at first instance the patent in suit was only revoked for lack of novelty of claim 1 under Article 54(3) EPC over citation (1), novelty over other cited documents, sufficiency of disclosure and inventive step all remained to be decided if the appeal should succeed in which case the likely result would be remittal of the case to the first instance. The Board was thus unconvinced that the presence of experts was necessary to deal with the limited issues raised by the appeal.

X. Under cover of a letter dated 24 September 2002 and received on 26 September 2002, the appellant filed two declarations and its fifth to eighth auxiliary requests. One of these declarations, by Mr Citti (an employee of the appellant), supported the appellant's

arguments as to the meaning of the expression "substantially inactive" (see XIII below); and the other, by Ms Levin (also an employee of the appellant), reported an experiment conducted with all five yeast strains disclosed in citation (1) and disclaimed from claim 1 as granted. The claims of the additional requests were the same as those of the appellant's main and first to third auxiliary requests but with claim 7 and subsequent claims deleted.

XI. In its letters of 17 April 2001 and 16 October 2002, the respondent presented arguments in support of its requests for the appeal to be dismissed and for the appellant's new evidence (the two declarations referred to in X above) to be held inadmissible. In the later of those letters the respondent referred to T 323/97 (OJ EPO 2002, 476) concerning the allowability of disclaimers.

In its letter in reply of 13 November 2002, the appellant requested, if the Board should consider the arguments presented by the respondent on the basis of T 323/97 (*loc. cit.*) to be pertinent, a postponement of the oral proceedings until such time as the Enlarged Board of Appeal should issue an opinion on the allowability of disclaimers. No such case being currently pending before the Enlarged Board and no question for referral to the Enlarged Board having been presented in this case, the Board did not postpone the oral proceedings which took place on 28 November 2002.

XII. At the oral proceedings the respondent did not pursue its questions about the re-establishment request, the appellant withdrew its request for reimbursement of the appeal fee and also withdrew all its previous auxiliary

requests and filed two new auxiliary requests. The differences between claim 1 as granted (see paragraph I above) and claim 1 of the appellant's current first auxiliary request are indicated in italics below:

"A method of producing a dough composition, capable of being stored at refrigeration temperatures *ranging between 0°C and 12°C"*, said method comprising the steps of mixing yeast, water and flour, the method being such that the yeast will remain substantially inactive at refrigeration temperatures, *wherein, the dough is capable of being stored for 90 days at refrigeration temperatures without the pressure in a spirally wound container rising above 40 psi, wherein the yeast is not NCIMB 40329, 40330, 40331 or 40332".*

Claim 1 in the second auxiliary request was essentially the method of claim 7 as granted (see I above), amended by the insertion of the following additional process steps indicated in italics below:

"A method .....comprising the steps of mixing water, flour and yeast, *packaging the dough in a container, proofing the dough in the container and storing the dough within the container, at refrigeration temperatures ranging between 0°C and 12°C,* the specific strain .....".

XIII. The appellant's arguments presented in writing and at the hearing can be summarised as follows:

(A) By virtue of Article 108 and Rule 78 EPC, the time limit for filing the grounds of appeal expired on 2 October 2000. The statement of grounds of appeal

was prepared and ready for transmission by fax to the EPO on that date and, the appellant's representative not being present in his firm's London office on that date, he instructed his assistant to attend to the filing. The assistant gave the fax to the fax machine operator who made a mistake of adding one extra digit in dialling the EPO fax number. The assistant subsequently checked that the fax had been sent but, without realising then that he did so, looked at the fax transmission slip of another fax from the firm to the EPO. The failure to transmit the grounds of appeal was discovered the following day, 3 October 2002, and sent correctly and received on that date. Declarations from both the assistant and the fax operator confirming these events were filed by the appellant. Although sent from the London office, the covering letter bore the address of the firm's Munich office since this ensures a more reliable transmission of correspondence from the EPO. There was no inter-communication between the London and Munich offices as the respondent sought to suggest. The delay of one day in filing the grounds of appeal was the result of an isolated mistake in an otherwise satisfactory system.

(B) The declarations filed with the appellant's letter of 24 September 2002 (see X above) should be admitted because these supported the position it had maintained throughout the oppposition and appeal proceedings, merely clarified points challenged by the respondent, raised no new arguments, and, as regards the Levin declaration, provided evidence on an issue as to which the respondent, although bearing the burden of proof,

had provided none.

(C) The appellant argued, as regards novelty of claim 1 of its main request, that the opposition division had incorrectly construed the breadth of disclosure of citation (1) for novelty purposes and, on a correct interpretation, claim 1 of the opposed patent was novel. According to the correct and restrictive interpretation of prior art disclosures for novelty purposes, the content of citation (1) was limited to enabling disclosures provided in its examples which were explicitly disclaimed from claim 1 and, accordingly, did not fall within the scope of the claim.

The proceedings before the opposition division turned primarily on whether or not a person skilled in the art would interpret the term "substantially inactive" by reference to the description. The opposition division was incorrect to overlook the meaning of "substantially inactive" in the description and decide, instead, to equate "substantially inactive" with the wording "pratiquement inactives" in citation (1). The opposition division had wrongly concluded that, because of that similarity of wording, the meaning behind the words must be equivalent. A person skilled in the art would immediately interpret claim 1 on the basis of the description as referring to a yeast, which, within the dough, generates insufficient CO_2 during ninety days refrigerated storage to raise the internal pressure within a spirally wound can to above 40 to 45 psi.

The opposition division concluded that the disclosure of citation (1) did not extend solely to the specific strains taught by citation (1) but, rather, to all

strains enabled by that document. It would thus appear that the opposition division had confused the teachings of a prior art document with the enablement of such document. However, when considering novelty it was important to distinguish what is taught by the document from what is enabled by the document. Thus, for the purposes of novelty, only the specific embodiments that are actually taught in the document may be considered as novelty destroying disclosures. There was no evidence available that any of the strains disclosed in citation (1) might be "substantially inactive" as defined in the patent's specification. The respondent itself had admitted that at least the deposited strain NCIMB 40328 of citation (1) did not meet the requirement of being "substantially inactive" in accordance with the teaching in the patent. Therefore one could probably conclude that none of the five strains taught in citation (1) were "substantially inactive" as required by claim 1 in accordance with the teaching in the patent. Therefore, the objection of the opposition division that (1) enabled yeast strains which would fall within the scope of the claims was seemingly without foundation.

XIV. The respondent's arguments can be summarised as follows:

(A) As regards the re-establishment request, the appellant took a risk by waiting until the last day of the time for filing the grounds of appeal, did not explain why the grounds of appeal were sent from London when the representative's firm also has a Munich office, did not explain the apparent inter-communications between the two offices, entrusted the fax transmission to a part-

time employee who was supervised by an assistant and not the representative himself, and did not identify the other fax to the EPO which the assistant mistakenly looked at when checking the fax had been transmitted. Thus the appellant has not provided all the facts on which it relies and has not taken all due care.

(B) The appellant's late-filed declarations should not be admitted into the proceedings because, being from employees of the appellant, they could have been filed earlier. The Citti declaration was not relevant and the Levin declaration as to experiments took the respondent by surprise and left it insufficient time before the oral proceedings to conduct its own experiments.

(C) Claim 1 of the main request related to a method for the preparation of a dough composition, capable of being stored at refrigeration temperatures for an undefined period of time, involving the standard procedure of mixing yeast, water and flour. The characterising feature in claim 1 intended to render this claim novel over the prior art of citation (1) related to the use of a specific type of yeast having the property of remaining "substantially inactive" at refrigeration temperatures. The respondent concurred with the appellant’s submissions that the term "*substantially inactive*" in claim 1 should be interpreted in the light of the description. The only correct interpretation of the term in question in the description could undoubtedly be found in column 3, lines 35 to 41, where it was said that "as used herein [in the

patent in suit], the term "inactive" as applied to yeast means that the leavening action of the yeast is substantially stopped, as indicated by the fact that very little or no carbon dioxide is produced in the dough at refrigeration temperatures". To achieve this goal the patent in suit suggested either using a lts (low temperature sensitive) yeast strain (claim 1) or controlling the amount of substrate in the dough fermentable by the yeast (claim 7). There was nothing in the patent specification to support the appellant’s argument that the term "substantially inactive" in claim 1 should generally be given the meaning that there is no package failure of the dough composition, due to an excess production of gas, over a 90-day storage period. This was only a specific embodiment of the claimed method in the patent in suit.

Citation (1) disclosed a process for constructing lts/lti (low temperature inactive) yeast strains which were characterised by the fact that they became essentially dormant or inactive at refrigeration temperatures but survived such low temperatures and behaved essentially normally at elevated temperatures (see column 1, lines 29 ff.). Such lts yeasts were used in (1) in a method of producing a dough, capable of being stored by refrigeration temperatures, involving the steps of mixing water, flour and yeast (see column 7, lines 40 ff.). It was settled jurisprudence that for novelty purposes the disclosure of a prior patent document was not confined to the detailed information given in the examples but comprised any technical teaching in the claims and the

description, enabling a person skilled in the art to carry out the invention. Since citation (1) taught in great detail a method enabling a person skilled in the art to obtain lts/lti yeast strains in addition to those explicitly disclaimed from claim 1, such yeast strains had been made available to the public prior to the priority date of the patent in suit. The content of (1) was thus prejudicial to the claimed subject-matter in the patent in suit.

XV. The appellant requested that its right to file its grounds of appeal be re-established, that the decision under appeal be set aside and that the patent be maintained as granted (main request) or on the basis of the first or second auxiliary requests filed during the oral proceedings.

The respondent requested that the re-establishment request be dismissed and, in the absence of such dismissal, that the appeal be dismissed and (as auxiliary request) that the case be remitted to the first instance for further prosecution.

Reasons for the Decision

1. The appellant's request for re-establishment being allowed (see point 2 below), the appeal is admissible.

The appellant's request for re-establishment

2. This request is admissible, having been made in a letter from the appellant received on 3 November 2000. The cause of the non-compliance with the time limit for filing the grounds of appeal was removed on 3 October

when the grounds of appeal were successfully transmitted by fax. Thus the re-establishment request was filed both within two months of the removal of the cause of non-compliance and within one year of the unobserved time limit (Article 122(2) EPC).

2.1 The appellant has also shown that "all due care required by the circumstances" was taken. Despite the respondent's questioning of the appellant's representative's arrangements between its London and Munich offices, this appears to be irrelevant - there is no evidence to suggest that the appellant's account of the relevant facts (see XIII(A) above) is other than correct. The respondent observes that the appellant took a risk by waiting until the last available day to file the grounds of appeal but, however unwise that approach may be, it would not have led to the time limit being missed but for the combination, in itself highly unlikely, of two mistakes of the type which can arise in any office however well-ordered - the one digit dialling error by the fax machine operator and the reading by the representative's assistant of the fax transmission slip of, not the fax sending the grounds of appeal but of another fax sent to the EPO on that day by the representative's firm. The respondent's suggestion that the representative himself, and not an assistant, should have checked the fax had been sent is unreasonable. There is no basis for suggesting the assistant was other than perfectly competent and indeed, by arranging for the assistant to make the check, the representative did his best to ensure a check was made; it would be unreasonable to expect the representative to attend the office to check all the other staff involved if they are competent. The respondent's further criticism that no details have

been given of the "wrong" fax which the assistant checked is also unreasonable - if the assistant did not realise he looked at the wrong fax, he cannot be expected to identify it subsequently. Accordingly, the re-establishment request is allowed.

The appellant's request for adjournment of the oral proceedings

3. As regards the inability of a US expert to be present at the oral proceedings due to a public holiday in the United States, the Board observes that national holidays in individual Contracting States are not usually recognised by the EPO for practical reasons (see J 5/98 of 7 April 2000, unpublished in OJ EPO, paragraph 7). To allow for national holidays in non-contracting states throughout the world would be even less practical; and to allow for such holidays in just one country, such as the USA, would discriminate against parties from other states.

Admissibility of the appellant's late-filed evidence

4. It is well-established by the jurisprudence of the Boards of Appeal that, in considering the admissibility of late-filed evidence, account is to be taken of *inter alia* whether it could have been filed earlier and if so the reason why not, and of its relevance and in particular whether it has a greater relevance to the issues than the material already on file (see generally, "Case Law of the Boards of Appeal of the European Patent Office", 4th edition, 2001, pages 324 to 333).

4.1 The Citti declaration can at best be described of

minimal probative value. It purported to offer the interpretation which a person skilled in the art would place on the words "substantially inactive" and concluded this would be that advanced, throughout the opposition and appeal proceedings, by the appellant. That an employee of the appellant should give such an opinion is, with no disrespect to him, only to be expected and his opinion has no greater value than the same opinion as advanced by the appellant's representative in argument. Indeed, it could be said that the opinion of the representative who, although engaged to argue the appellant's case, has a professional duty to satisfy himself of the propriety of the case he makes, should carry more weight than the opinion of an employee who, however sincere his views, is under no such duty and is inevitably likely to give the opinion his employer wants.

4.2 As to the relevance of the Levin declaration, the Board has no reason to doubt the accuracy of the experiments the declarant reports. However, it would be unjust to admit experimental evidence from one party at such a late stage of the proceedings that the other party could not repeat the experiments to verify their results or otherwise reply. The appellant's case on the issue to which this declaration relates has been the same throughout the appeal and, if evidence in support of that case was to be produced, it should have been produced earlier. Although not a decisive factor in itself, the Board notes Ms Levin is also an employee of the appellant and has been so for much longer than the life of these proceedings, so her evidence could easily have been prepared and filed much sooner.

4.3 As to both declarations, no reason was offered by the

appellant as to why they were filed when they were and why this could not have been done earlier. The nearest the appellant came to providing such an explanation was to say these declarations supported its position as maintained throughout the oppposition and appeal proceedings, merely clarified points challenged by the respondent, raised no new arguments, and, as regards the Levin declaration, provided evidence as to an issue on which the respondent had provided none but for which the respondent bore the burden of proof.

4.4 None of these reasons explain the lateness of the evidence or whether it could have been filed earlier or not. On the contrary, they largely support the Board's view that the evidence is inadmissible. If the late evidence supported a case made throughout, it would have been in the appellant's own interest to file it in the opposition proceedings. If it was mere clarification of points challenged by the respondent, whose last such "challenge" was in its letter of 17 April 2001, it could clearly have been filed earlier than late September 2002. If it raised no new arguments, its relevance must, on the appellant's own view, be questionable. And the absence of evidence from a respondent is no reason for an appellant, on whom the burden of attacking an appealed decision rests, for late filing of evidence to support its own case. Contrary to the appellant's assertion, the respondent, who at first instance bore the primary burden of proof to show why the patent should be revoked, bears no such burden in the appeal and can defend the decision under appeal as it chooses. On appeal it is the appellant who bears the primary burden of demonstrating that the decision under appeal was incorrect.

4.5 For the reasons set forth above, the Board finds the two declarations filed by the appellant with its letter of 24 September 2002 (see X above) inadmissible.

Main request

5. Claim 1 in the main request is that of the patent as granted (see I above). Although this claim contains at its end a series of disclaimers ("wherein the yeast is not NCIMB 40328, 40329, 40330, 40331 or 40332"), the board considers it neither necessary nor appropriate to give a decision on the allowability of these disclaimers, because the appellant's main request must fail for other reasons referred to below.

Novelty

5.1 As a preliminary point it appears useful and necessary to recall that the respondent cited in the course of the opposition and subsequent opposition appeal proceedings document (1), *viz* EP-B-0 487 878, as state of the art under Article 54(3) EPC against the novelty of claim 1. Document (1) was also referred to as state of the art under Article 54(3) EPC in the decision under appeal. EP-B-0 487 878 (1) is based on European patent application No. 91 117 479.5. Having ensured that the content of application No. 91 117 479.5 as filed is identical with that of patent EP-B-0 487 878 as granted, the Board has decided for consistency and to avoid possible misunderstanding to refer in this decision also to the granted patent (1).

5.2 As regards novelty, the appellant's principal argument was that the yeast strains disclosed in citation (1) are not "substantially inactive" at refrigeration

temperatures as that term is to be understood in the patent in suit. Therefore the first question to be decided is whether or not, as the appellant maintains, those skilled in the art would in the light of the disclosure in the patent in suit necessarily interpret the feature *"the yeast will remain substantially inactive at refrigeration temperatures"* in claim 1 as referring to the use of a yeast which, within the dough made by the claimed process, generates insufficient carbon dioxide during ninety days refrigerated storage to raise the internal pressure within a spirally wound can to above 40 to 45 psi and to cause the can to burst.

5.2.1 Those skilled in the art, consulting the description of the patent in suit to determine what is meant by "substantially inactive", would find a satisfactory explanation of what the contested patent actually means by the term "inactive" as applied to yeast. In column 3, lines 35 to 40, it is stated that "as used herein, the term "inactive" as applied to yeast means that the leavening action of the yeast is substantially stopped, as indicated by the fact that very little or no carbon dioxide is produced in the dough at refrigeration temperatures". It is thus clear that, contrary to the appellant's assertions, the term "substantially inactive" as applied to yeast in the patent in suit **cannot** properly be construed in such a way that it necessarily implies storage of the dough containing yeast for a 90-day period, or a definite limit of the volume of carbon dioxide produced so as to

avoid packaging failure, or the 40 to 45 psi limit of the pressure generated by the yeast during the storage period, or the use of a particular kind of container for the storage of the dough.

5.2.2 This view is also confirmed elsewhere in the patent in suit. For example in column 2, lines 50 to 52, in which it is stated that "preferably the low temperature sensitive yeast is of a genotype selected from the group comprising lts1, lts2, lts3, lts4, lts5, lts6, lts7 and lts8". According to claim 4, which is dependent on claim 1, the low temperature sensitive yeast, defined in accordance with claim 1 as being "substantially inactive" at refrigeration temperatures, is likewise of a genotype selected from lts1, lts2, lts3, lts4, lts5, lts6, lts7 and lts8. In column 25, lines 26 to 27, it is however stated that Figure 23 depicts the data collected for samples classified as having "poor" can stability, ie lts1, lts5, lts6 and lts7 (see Figure 25), all claimed in the patent in suit as being "substantially inactive".

In column 25, lines 36 to 39 it is further stated that "referring first to Figure 23, it can be seen that the doughs containing lts1, lts5 or lts 7 would be expected to meet the 40-45 psi limit well before the end of the 90-day storage at refrigeration temperatures". It is thus clear that even yeasts which are according to the disclosure in the description and the claims preferred and which are therefore "substantially inactive" as this term is used in the patent, would not necessarily meet the 40 to 45 psi limit after ninety days refrigeration; and it is equally clear that all references in the patent in suit to this limit without packaging failure during a 90-day storage period are in

relation **to a preferred embodiment**.

5.2.3 Citation (1) discloses a process for constructing lts/lti (low temperature inactive) yeast strains which will remain substantially inactive (*"pratiquement inactives"*) at refrigeration temperatures ranging between 3°C and 9° or 10°C, but survive such low temperatures and regain their activity at elevated temperatures, for example, at temperatures of 13° to 14°C (see column 1, lines 29 to 39; column 2, lines 33 to 39). Such lts/lti yeasts are used in (1) in a method of producing a dough, capable of being stored for extended periods of time at refrigeration temperatures (eg storage for 21 days at 8°C), involving the steps of mixing water, flour and yeast (see column 7, lines 40 to 50). From Figures 2 to 7 in (1) it can be seen, for instance, that yeast strains used in the cited document do **not** generate any detectable amount of carbon dioxide at refrigeration temperatures during at least the 7-day period indicated in these Figures and are thus for an extended period of time "substantially inactive" at refrigeration temperatures as this term is used in the patent in suit. Moreover, as has been demonstrated in (1), a dough prepared using yeasts disclosed in (1) can be stored, for instance, for a period of 21 days at 8°C, apparently without causing packaging failure (see (1), column 7, lines 40 to 48).

5.2.4 The Board therefore concurs with the opposition division's opinion in the decision under appeal that the reference in claim 1 to "the method being such that the yeast which will remain **substantially inactive** at refrigeration temperatures" cannot be regarded as a distinguishing feature over citation (1) such as to

confer novelty upon the method of producing a dough composition in accordance with claim 1 as presented in the main request.

5.2.5 In its written and oral submissions, the appellant advanced the further argument that, for the purpose of novelty, the disclosure of citation (1) extended solely to the deposited yeast strains. According to the appellant the teaching of citation (1) was limited to enabling disclosures provided in its examples, which examples were explicitly disclaimed from claim 1 and, accordingly, did not destroy the novelty of the subject-matter of the present claims.

5.2.6 According to the consistent case law of the Boards of Appeal (see, as an example only, T 12/81; OJ EPO 1982, 296), the teaching of a cited document is not confined to the detailed information given in the examples of how the invention is carried out but embraces any information in the claims and the description enabling a person skilled in the art to carry out the invention. The disclosure of the ingredients as well as the method of their conversion into end products is, in general, prejudicial to the novelty of the latter, because teaching as to the nature and use of ingredients necessarily serves to define the end products. It is immaterial for the purpose of novelty, if the end products themselves are described, not in full detail but chiefly by the exact method of their preparation.

5.2.7 Citation (1) discloses a process for constructing diploid or polyploid lts/lti strains of baking yeast having the three desired phenotypic properties, ie a growth potential, an lti property and an ability to raise a dough (see claims 1 and 3). Such yeasts are

described in (1) as being "substantially inactive" ("pratiquement inactives") within the meaning of this term as used in the patent in suit and are, accordingly, suitable for use in the method of producing a dough claimed in the patent in suit and likewise the method disclosed in (1) (see 5.2.1 to 5.2.5 above). Examples of such yeasts obtainable by the process of (1) are, *inter alia,* the disclaimed, deposited strains NCIMB 40328, 40329, 40330, 40331 and 40332 which are specifically referred to in Examples 1 to 3 of (1).

However, in addition to the deposited strains, citation (1) teaches suitable starting strains and several protocols enabling those skilled in the art to construct and identify further strains of Saccharomyces cerevisiae having the desired phenotypic characteristics specified in (1).

The person skilled in the art is taught in (1) that the process starts from a traditionally used, commercially available haploid strain of Saccharomyces cerevisiae (see column 2, lines 55 to 58; Examples 1, 2) for the construction of a diploid strain of baking yeast having the desired lti/lts property or from a commonly traditionally used, commercially available polyploid strain of Saccharomyces cerevisiae (see column 2, line 58 to column 3, line 3; Example 3) for the construction of a polyploid strain of baking yeast having the desired lti/lts property.

A mutagenic treatment of haploid strains is described in column 3, lines 4 to 16; column 10, lines 1 to 19 and Examples 1,2. Mutagenic treatment is optional in the case of polyploid strains and is described in

column 4, lines 37 to 43. If polyploid starting cells are employed, they are sporulated and germinated as described in column 4, lines 44 to 58, and column 13, lines 22 to 38.

A stable mutant strain identified as an lti candidate may selectively be hybridised as described in column 3, lines 17 to 36 and column 4, lines 44 to 58 and in Examples 1 to 3. A screening procedure for identifying strains having a growth potential is disclosed in column 1, line 55 to column 2, line 6 and column 6, lines 10 to 39. Strains having a growth potential are screened to determine whether they have the desired, specified carbon dioxide production characteristics at low temperature, thereby verifying or confirming by qualitative tests their "lti" characteristics. A test for determining the carbon dioxide characteristics of a selected strain is described in column 6, line 40 to column 7, line 38. Strains identified as having a growth potential and the specified low temperature carbon dioxide characteristics are finally identified by being screened "for their ability to raise a dough", as described in column 2, lines 7 to 17 and column 7, lines 40 to 56.

In the Board's view, the above teaching and that of the examples taken as a whole constitutes a prior description of further lts/lti yeast strains having the same kind of phenotypic characteristics as the deposited strains, because this teaching supplies those skilled in the art with all the information they need regarding the starting cells (strains) and the successive procedural steps for constructing further lti/lti yeast strains with the phenotypic characteristics described in (1).

5.2.8 This conclusion is reinforced by the results reported in Examples 1 to 3. These examples make it sufficiently clear that the skilled person, **repeating any of these examples**, would inevitably arrive in each example at a **representative number** of lts/lti yeasts all having the three phenotypic characteristics specified in (1) from which the respective deposited strain(s) is (are) only chosen as an example [see Example 1: "Parmi diverses souches ainsi obtenues, on a déposé, à titre d'exemple la souche NCIMB 40328" (see column 10, lines 54 to 56); Example 2:"Parmi diverses souches ainsi obtenues, on a déposé, à titre d'exemple les souches NCIMB 40329 et NCIMB 40330" (see column 12, lines 25 to 28); Example 3: "Parmi diverses souches ainsi obtenues, on a déposé, à titre d'exemple les souches NCIMB 40331 et 40332" (see column 13, lines 51 to 52)].

5.2.9 It is thus clear that those skilled in the art following the teaching referred to in points 5.2.7 and 5.2.8 above and, in particular, that of Examples 1 to 3 in citation (1) would inevitably arrive at a variety of lts/lti yeasts which all have the three phenotypic characteristics specified in (1) and from which the respective deposited strains are only chosen as specific candidates for deposition. It is thus also clear that the disclosure of citation (1) is not only an enabling one within the meaning of Article 83 EPC, but makes available to the public, in addition to the deposited strains, other yeast strains having the phenotypic characteristics specified in (1). The Board's conclusion is therefore that, irrespective of whether or not the disclaimers in claim 1 are to be considered allowable within Article 123(2) EPC, the disclosure of citation (1) is prejudicial to claim 1. The appellant's main request must accordingly fail.

First auxiliary request

Admissibility

6. Despite its strong disapproval of the appellant's conduct in presenting new requests for the first time during oral proceedings and mindful of its discretionary power to disregard any requests filed at such a very late stage of the proceedings, the Board decided to admit the appellant's current first auxiliary request largely because the Board and the respondent were clearly able to deal with it at the hearing without delaying the proceedings. This request is the same as the appellant's third auxiliary request in the proceedings before the opposition division, except that present claim 1 has been amended so as to delete the strain NCIMB 40328 from the disclaimer present in claim 1 of the third auxiliary request before the opposition division (see XII above).

6.1 The amendments to the appellant's current first auxiliary request can fairly be said to be occasioned by grounds for opposition specified in Article 100(a) EPC and are accordingly allowable under the terms of Rule 57(a) EPC.

Allowability of the amended claims under Article 123(2) and (3) EPC

6.2 The preferred range of 0°C to 12°C for the refrigeration temperatures of the dough during storage is disclosed, *inter alia*, on page 2, line 6 and page 7, line 3 from the bottom. The newly introduced functional feature ("*the dough is capable of being stored for 90 days at refrigeration temperatures without the pressure*

in a spirally wound container rising above 40 psi") is based on the disclosure in the first full paragraph on page 21. Further support for this functional feature can be found in the paragraph bridging pages 32 and 33 and in Figure 24.

6.2.1 Dependent claim 4 has been restricted to the use of a lts yeast of a genotype selected from lts2, lts3, lts4, lts6 and lts 8. This limitation is necessary to bring dependent claim 4 into line with the amendments made to claim 1 and is based on the results presented in Example 10 and Figures 23 and 24 of the application as filed and the patent as granted.

6.2.2 Dependent claims 2, 3, 5 and 6 are identical with the corresponding dependent claims in the patent as granted. The embodiments of the independent claim 7 and dependent claims 8 and 9 have been claimed in identical form in claim 7 and dependent claims 9 and 10 of the patent as granted.

6.2.3 All four disclaimers present in claim 1 were originally introduced before grant in claim 1 as it then stood (see claim 1 of the appellant's current main request). These are maintained in claim 1 of the appellant's current first auxiliary request to delimit the claimed subject-matter in the patent in suit against the state of the art under Article 54(3) EPC according to (1), by explicitly excluding from claim 1 certain deposited yeast strains which are specifically disclosed in the examples of citation (1) and which were considered as prejudicial to the novelty of present claim 1 on the basis of the evidence available in the proceedings (see points 4 to 4.5 above). Provided there is no evidence demonstrating that the excluded yeast strains would not

satisfy all the criteria set out in claim 1 as it now stands, these disclaimers fulfil *a priori* all the requirements for the allowability of a disclaimer under Article 123(2) EPC set forth in a series of decisions of the Boards of Appeal (see, as an example only, T 982/94 of 16 September 1997, decision not published in OJ EPO).

6.2.4 In its written submissions, the respondent cited, *inter alia,* decision T 323/97 (*loc. cit.*) and concluded therefrom that no disclaimers at all should be allowed in any of the appellant’s requests.

6.2.5 The Board observes that inadmissible extension of the patent's subject-matter under Article 100(c) EPC (which is of course based on Article 123(2) EPC) was neither raised in the notice of opposition nor introduced in the proceedings by the opposition division under Article 114(1) EPC as a ground for opposition. In accordance with the ruling of G 10/91 (OJ EPO 1993, 420), this ground could thus not be considered on appeal without the consent of the patentee (appellant), and this consent has not been given.

6.2.6 According to established case law of the Boards of Appeal, the introduction of disclaimers, which have no basis in the application as filed, into a claim has been exceptionally permitted as an acceptable way of making a claimed subject-matter novel by delimiting it against an accidental anticipation [see e.g. T 434/92 of 28 November 1995, reasons, point 2, (decision not published in OJ EPO); T 653/92 of 6 November 1996, reasons, points 2.1 and 2.2, (decision not published in OJ EPO); T 710/92 of 11 October 1995, reasons, point 5, (decision not published in OJ EPO); T 426/94 of 22 May

1996, reasons, point 3, (decision not published in OJ EPO); T 982/94 of 16 September 1997, reasons, point 2.1, (decision not published in OJ EPO) and T 318/98 of 8 August 2000, reasons, point 2.2, (decision not published in OJ EPO)]. This legal practice has been continued after decision T 323/97 (*loc. cit.*) had been issued, at least in cases where the disclaimer is based solely on prior art under Article 54(3) EPC [see e.g. T 351/98 of 15 January 2002, reasons, points 11, 45, (decision not published in OJ EPO)].

6.2.7 The Enlarged Board has decided in G 1/93 (OJ EPO 1994, 541) that in a case, such as the present, a feature which had not been disclosed in the application as filed but which had been added to the application during examination was not to be considered as subject-matter which extended beyond the content of the application as filed within the meaning of Article 123(2) EPC, if it merely limited the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, without providing a technical contribution to the subject-matter of the claimed invention.

In decision T 323/97 (*loc. cit.*) the deciding Board found, however, "that the restriction of a feature [by means of a disclaimer] (here: of the list of possible components of a composition of matter), which has to be considered when it comes to the evaluation of inventive step, cannot be seen as a mere waiver of protection. On the contrary, when the disclaimer (as in the present case) aims at distancing the patent further from the state of the art (here: as disclosed in documents (9),

(10) or (11)) which has to be considered when assessing inventive step, its admissibility would give the patent proprietor an unwarranted advantage (see also T 526/92, not published in the OJ EPO, reasons, point 6.3). This aspect assumes even more importance when the possibility, pointed out in G 2/98, of a modification of the technical problem underlying the alleged invention is born in mind. It is therefore the Board's view that any amendment of a claim not having support in the application as filed and aiming at distancing the claimed subject-matter further from the state of the art, in particular by way of a disclaimer, contravenes Article 123(2) EPC and is consequently inadmissible."

The Board considers that the principles of G 1/93 (*loc. cit.*) are applicable to the present case. In view of the fact that the disclaimed yeast strains form part of the state of the art under Article 54(3) EPC, introduction of the disclaimers in claim 1 has to be seen, in the Board's judgment, as a mere waiver of protection, and not as the provision of any technical contribution to the subject-matter of the claimed invention. The present case is also in this respect entirely different from the case considered in T 323/97 (*loc. cit.*), where the disclaimer was introduced to restrict the list of possible components of a composition of matter **and** aimed at distancing the patent further from the state of the art which had to be considered when assessing inventive step.

6.2.8 No question concerning the allowability of disclaimers not based upon the application as filed is currently pending before the Enlarged Board. The Board is presently not aware if and when such a question will be

referred to the Enlarged Board and what such question(s) might be. Having regard to the jurisprudence referred to in point 6.2.6 above and no question for referral to the Enlarged Board having been presented by the parties, this Board sees in the present case no reason for a referral.

6.2.9 To conclude, the above observations make it, in the Board's judgment, clear that T 323/97 (*loc. cit.*) is a decision on the particular facts of that case but is **not** generally applicable. In the present case the state of the art is formed by a third party patent application under Article 54(3) EPC so that the appellant could not know of its content and could not formulate his originally filed claims so as to avoid an overlap. The Board therefore considers that in a case such as the present it is justifiable to allow the appellant to limit its present claim 1 to what is novel over the prior art of (1) and that allowing this limitation is consistent with an appropriate interpretation of the Convention without contravention of Article 123(2) EPC.

6.2.10 To summarise: the current version of the claims in the first auxiliary request is therefore adequately supported by the disclosure in the application as filed and complies in this formal respect with Articles 84 and 123(2) EPC.

6.2.11 Further, as admitted by the respondent itself in the proceedings before the opposition division and confirmed at the hearing before the Board, the deposited yeast strain NCIMB 40328 is unsuitable for producing a dough which would meet the specific criteria laid down in the functional feature in claim 1

("*the dough is capable of being stored for 90 days at refrigeration temperatures without the pressure in a spirally wound container rising above 40 psi")*. Deletion of strain NCIMB 40328 from the disclaimer in present claim 1 cannot therefore result in an extension of the granted scope. Article 123(3) EPC is thus also satisfied.

Novelty

6.3 The newly introduced functional feature in claim 1, relating to the capability of the dough to be stored at refrigeration temperatures without the pressure in a spirally wound container rising above 40 psi, is nowhere disclosed in citation (1).

6.3.1 The embodiment of independent claim 7, wherein the dough composition and the yeast used therein are chosen to limit the total leavening action of the yeast by controlling the amount of substrate in the dough fermentable by the yeast, is likewise nowhere disclosed in citation (1). In this respect it is noted that in the notice of opposition citation (1) has not been cited against the novelty of claim 7.

6.3.2 The board thus finds that the subject-matter in the first auxiliary request is novel over (1). Since novelty was not disputed by the respondent, it is not necessary to consider this matter in detail.

7. Since the first auxiliary request is acceptable there is no need to discuss the second auxiliary request.

Order

For these reasons it is decided:

1. The appellant is re-established in its rights.

2. The decision under appeal is set aside.

3. The case is remitted to the first instance for further prosecution.

The Registrar: The Chairman:

A. Townend P. Lançon