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D E C I S I O N
of 13 November 2002

Case Number: T 0848/00 - 3.3.2

Application Number: 94904635.3

Publication Number: 0679060

IPC: A23D 9/00

Language of the proceedings: EN

Title of invention:
Modification of edible oil flavour

Patentee:
UNILEVER PLC, et al

Opponent:
NATEC Institut GmbH

Headword:
oil flavour/UNILEVER

Relevant legal provisions:
EPC Art. 107, 56, 113(2), R. 76(1)(3)

Keyword:
"Admissibility of the appeal of the patentee (no),
not adversely affected by the First Instance decision-
inventive step - no: obvious measure"

Decisions cited:
T 0234/89, T 0506/91, T 0155/88

Catchword:
-



Case Number: T 0848/00 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 13 November 2002

Appellant:
(Opponent)

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Representative:

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Appellant:
(Proprietors of the patent)

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Representative:

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Decision under appeal:

Interlocutory decision of the Opposition Division
of the European Patent Office posted 20 June 2000
concerning maintenance of European patent
No. 0 679 060 in amended form.

Composition of the Board:

Chairman: U. Oswald
Members: J. Riolo
S. U. Hoffmann

Summary of Facts and Submissions

- I. European patent No. 0 679 060 based on international application No. PCT/EP94/00024 was granted on the basis of 9 claims.

Independent claims 1 and 8 as granted read as follows:

"1. Method for shifting the flavour balance of olive oil by a mild treatment, characterised in that the treatment comprises sparging the oil with an inert gas at a temperature of 20°C -65°C.

8. Olive oil containing octanol-1 and hexanol-1, characterised in that the ratio of the octanol-1 and hexanol-1 concentrations is higher than 1.

- II. Notice of opposition was filed against the granted patent by the appellant opponent (opponent).

The patent was opposed under Article 100(a) EPC for lack of novelty and lack of inventive step and under Article 100(b) EPC for insufficiency of disclosure of the invention.

The following documents were *inter alia* cited during the proceedings.

- (1) EP-A-0 405 601
- (2) EP-A-0 475 573
- (4) DE-A-3 643 848.

III. The interlocutory decision of the Opposition Division established that the patent could be maintained on the basis of the main request of the patent in suit, as supplemented during the oral proceedings, ie the set of claims as granted without the product claims.

As to Article 83 EPC, the Opposition Division considered that having regard to the description and in particular working example 1, sufficient instructions were given to carry out the steps of the process for shifting the flavour balance of olive oil as defined in the claims of the patent in suit.

It also acknowledged novelty over document (1) because it found that the skilled person would not seriously contemplate working within the temperature range overlapping with the temperature range of the process of the contested patent in the light of the disclosure in this document. Concerning document (4), it held that it was not relevant for novelty as it did not mention olive oil at all.

Regarding inventive step, the Opposition Division found that the claimed subject-matter was inventive because nothing in the available prior art taught the skilled person to attempt to partly deodorise olive oil at or below 65°C.

IV. The appellant opponent and the appellant patentee (patentee) both lodged appeals against the said decision.

V. Oral proceedings were held before the Board on 13 November 2002.

VI. The appellant opponent held that the appeal filed by the patentee was not admissible as the patentee was not adversely affected by the Opposition Division's decision. It submitted that the Opposition Division maintained the patent on the base of the patentee's main request, as apparent from the minutes of the oral proceedings and from the fact that the patentee requested of its own motion that the description be adapted to the set of claims of this main request.

As to the sufficiency of disclosure, the appellant opponent did not maintain its grounds of opposition under Article 100 (b) EPC during the oral proceedings.

However, it maintained its novelty objection over document (1). In that respect it considered that, contrary to the Opposition Division's opinion, the overlapping temperature range disclosed in this document was novelty-destroying for the claimed subject-matter.

It further considered that the subject-matter of the patent in suit did not fulfil the requirement of inventive step since the problem to be solved by the claims of the contested patent was merely to achieve a flavour change in the flavour balance in olive oil irrespective of any improvement in its quality. This problem was obviously solved in the light of document (1) in combination with document (2) which taught that volatile flavours from olive oil can be extracted by using an inert gas stream at a temperature as low as 65,6°C.

VII. As regards the admissibility of its appeal, the appellant patentees held that their intention was not to abandon the product claims but rather to have a prompt decision from the Opposition Division in order to be in a position to appeal said decision and try to

defend the product claims during the appeal procedure. They pointed out moreover that the main request, on which the Opposition Division's decision was based, was not signed. In that respect, they contended that it would not have signed this request as a main request if it had had such an opportunity.

They were moreover of the opinion that document (1) did not disclose the treatment of olive oil with an inert gas at low temperature. They therefore considered that document (1) was not novelty destroying for the claimed subject-matter.

During the oral proceedings, they sought however to introduce two sets of claims as auxiliary requests 2 and 3 with a restricted temperature range in order to suppress the overlapping temperature range with document (1). These sets of claims were not admitted to the procedure as late-filed as the novelty objection over document (1) had been known for years.

Concerning inventive step, they maintained that the subject-matter of the patent in suit was inventive because nothing in the available prior art taught the skilled person that the flavour balance of olive oil could be shifted by sparging the oil with an inert gas at low temperature.

VIII. The appellant opponent requested that the decision of the Opposition Division be set aside and that patent No. 0 679 060 be revoked.

The appellant patentees finally requested:

(1) Main request: to allow the patent proprietors' appeal and to remit the case to the first instance for further prosecution.

(2) First auxiliary request: to dismiss the opponent's appeal and to maintain the decision under appeal.

(3) Second auxiliary request: to dismiss the opponent's appeal and to maintain the patent on the basis of the set of claims as attached as second auxiliary request.

(4) Third auxiliary request: to dismiss the opponent's appeal and to maintain the patent on the basis of the set of claims as attached as third auxiliary request.

Reasons for the Decision

1. The appellant opponent's appeal is admissible.
2. *Main request: Admissibility of the appellant patentees' appeal*

As regards the appellant patentee's appeal, the notice of appeal, appeal fee and the statement of grounds were all submitted in due time under Article 108 EPC.

Before the appeal can be declared admissible for the purposes of Article 107 EPC, it has to be established whether or not the appellant patentee was adversely affected by the impugned decision maintaining the patent in amended form.

Under Article 107 EPC, any party to proceedings adversely affected by a decision may appeal. A party is adversely affected if the decision does not accede to its main request or to auxiliary requests preceding the auxiliary request granted (T 234/89 not published in OJ EPO).

This is not the case if the patent proprietor withdraws its main request or preceding auxiliary request (T 506/91, not published in OJ EPO). In this respect, the Board has to compare in a purely formal way what has been requested by the proprietor and what has been ordered by the decision.

Therefore, the present Board first of all has to examine exactly which requests were submitted by the appellant patentee during the oral proceedings before the Opposition Division.

According to the minutes concerning the oral proceedings before the Opposition Division, the chairman announced *inter alia* that the subject-matter of claims 8 and 9 did not meet the requirements of Article 83 EPC and added that the same would apply to the first and second auxiliary requests. Furthermore, it is recorded that in reply to this statement the proprietor requested the deletion of claims 8 and 9 of the main and second auxiliary requests and that the first auxiliary request be dropped. In the subsequent proceedings, the subject-matter of claims 1 to 7 of the main request was discussed under Articles 83, 54 and 56 EPC and regarding each Article the chairman announced after deliberation that claims 1 to 7 of the main request met the requirements of the EPC. At the end of the proceedings, the proprietor requested that lines 4 and 5 on page 3 of the specification be deleted so as to bring the text into line with the claims.

The appellant patentee did not dispute that the minutes reflected the course of the proceedings and the wording of the requests made by the appellant patentee.

The appellant patentee argued however that it has never abandoned the subject matter of the product claims when it requested the deletion of claims 8 and 9 of the main

and second auxiliary requests before the Opposition Division and that it had no intention of abandoning the possibility of reverting to the subject-matter of claims 8 and 9 of the earlier requests. Such a limitation could not be interpreted as an irrevocable abandonment of the broader subject matter previously claimed or granted. Referring to decision T 155/88 (not published in OJ EPO), the appellant submitted that the proprietors must be free in appeal proceedings to reinstate their patent as granted, even if they had explicitly and unconditionally withdrawn all requests apart from the one finally allowed in the opposition proceedings. Therefore, the admissibility could not be contested in the present case.

The Board does not agree with the appellant patentee's view that the legal issue of whether or not the appellant abandoned a subject matter before the first-instance department can be used to justify the admissibility of the appeal under Article 107 EPC. The intentional abandonment of a subject-matter includes a (partial) waiver of the right to a patent established by the application as originally filed. The requirement under Article 107 EPC, according to which the appellant must be adversely affected by the decision under appeal, concerns the question of the formal admissibility of the appeal. The separate issues must not be confused. The Board agrees with the reasoning of decision T 155/88 (supra) that if a patentee proposed amendments to its claims which arise out of the opposition and which are intended to meet the grounds of objection raised in the opposition by limiting the scope of protection sought, this should not normally be interpreted as an abandonment of the subject-matter protected by the claims of the patent as granted. But this statement does not influence how the amended set of claims is to be read because a restriction of claims is possible without abandoning the subject-matter of

the patent specification as originally filed. Otherwise the Opposition division would always have to decide first on the set of claims granted as a (fictitious) main request, regardless of whether or not the patentee voluntarily requested a restriction of the scope of protection before the Opposition Division. It is obvious that such a view violates Article 113(2) EPC.

The Board holds that the wording of the appellant patentee's requests recorded in the minutes is clear and unambiguous in that "The proprietor requested to delete claims 8 and 9 of the main and second auxiliary request and drop the first auxiliary request". In fact, the appellant patentee did not contest this wording but only disputed that by means of these actions the original main request containing claims 1 to 9 was surrendered and replaced by a new main request containing claims 1 to 7. Thus by deleting claims 8 and 9, a new auxiliary request was created in the appellant patentee's opinion (claims 1 to 7).

The appellant patentee's interpretation of the wording of its requests submitted during the oral proceedings conflicts with the meaning of the words as well as the fact that at the end of the oral proceedings the appellant patentee requested the adaptation of the description to the main request limited to claims 1 to 7. The appellant patentee's assertion that its actions recorded in the minutes introduced a new auxiliary request contradicts the fact that he expressly requested an amendment of the main request and, furthermore, that the new auxiliary request allegedly submitted was not consistent with the numbering of the requests used by the appellant patentee during the oral proceedings. Therefore, the Board is convinced that the wording of the appellant patentee's requests as recorded in the minutes

reflected what he actually requested and that the circumstances in the course of the oral proceedings left no room for an interpretation other than according to the literal sense.

The appellant patentee submitted that the amendment was not signed by the representative, contrary to the established practice in proceedings before the EPO, and that had the representative been allowed to sign the amendments, the indication "main request" would have been noted and corrected. In the Board's view the missing signature has no detrimental effect on the legal validity of the requests presented during the oral proceedings since the minutes recorded what it had requested as a "relevant statement" (Rule 76(1) EPC). "Relevant statements" are *inter alia* new and amended procedural submissions or the withdrawal thereof, the fresh submission or amendment or withdrawal of application documents, such as claims, description and drawings. Rule 76(2) EPC does not apply to the present case since it only concerns the minutes of taking evidence. According to Rule 76(3) EPC, the minutes are to be authenticated by the employee who drew them up and by the employee who conducted the oral proceedings. A countersignature of the parties is not prescribed by Rule 76 EPC. In the present case, the signatures of the employees are not contested and therefore the legal validity of the requests recorded in the minutes is established. The established EPO practice of accepting a new set of claims only if it is signed is designed to avoid any subsequent discussion about the wording but does not prevent the applicants from making requests which may not be in their best interest.

As a result of the considerations set out above, the Board considers that the appellant patentee is bound by its requests submitted during the oral proceedings and correctly recorded in the minutes.

Consequently, in the decision under appeal the Opposition Division granted the appellant patentee's main request and the appellant patentee is thus not adversely affected by said decision.

The fact that the appellant patentee's representative was not accompanied by the patentee or by their managing director during the oral proceedings before the Opposition Division and the representative (allegedly) was not able to confer with its client has to be disregarded since the Board is not empowered to exercise any discretion under Article 107 EPC.

In summary, the appellant patentee's appeal does not fulfil the requirement of Article 107 EPC of being adversely affected and, therefore, the appellant patentee's appeal is not admissible.

3. *First auxiliary request*

The set of claims of this request corresponds to the set of claims as maintained by the Opposition Division.

No objection under Articles 123(2) and (3) and 84 EPC was raised with respect to this set of claims and the Board sees no reason to differ.

3.1 Articles 83 and 54 EPC

The Board agrees with the findings of the Opposition Division as to the objections regarding the sufficiency of the disclosure and novelty.

Moreover, having regard to the Board's conclusions in the assessment of inventive step (see below, point 3.2), there would appear to be no need to develop further these aspects.

3.2. Inventive step

- 3.2.1 The patent provides for a method of shifting the flavour balance of olive oil by a treatment, characterised in that the treatment comprises sparging the oil with an inert gas at a temperature of 20-65°C (page 2, lines 29 to 31), the aim of said treatment being to eliminate a peculiar flavour which may not be appreciated by certain consumers not accustomed to that flavour (page 2, lines 8 to 13).

Example 5 of document (1) discloses a method of deodorising olive oil by a treatment, characterised in that the treatment comprises sparging the oil with an inert gas at a temperature of 180, 200, 220 and 240°C so as to eliminate the substances which give bad odour and taste (page 3, lines 20 to 22). Document (1) mentions, moreover, without reference to any particular type of oil, that temperatures between 60°C and 270°C can be used (page 4, lines 30 to 33). Example 4 of the description of document (1) describes the treatment of a fish oil at a temperature of 60°C.

The Board agrees with the parties that document (1) might be considered as the closest available prior art.

- 3.2.2 Although the contested patent is silent about the precise definition of "shifting the flavour balance", the Board accepts in favour of the patentees, as held by the appellant patentees' representatives during the oral proceedings, that "shifting the flavour balance" implies only that the respective amounts of the various flavour substances in olive oil are modified (changed) and that none of them is totally eliminated.

It is however clear that the treatment performed in document (1) also leads to an oil having a flavour balance which is changed in a more drastic way since certain substances are totally removed.

Accordingly, the problem to be solved *vis-à-vis* document (1) can only be seen as the provision of a milder process for changing the flavour balance in olive oil.

3.2.3 This problem is solved by the subject-matter of claim 1 and, in the light of the working examples of the patent in suit, the Board is satisfied that the problem has been plausibly solved.

3.2.4 Thus, the question to be answered is whether the proposed solution, ie the treatment of olive oil at a lower temperature (ie between 20 and 65°C), was obvious to the skilled person in the light of the prior art.

Having regard to document (1), which already teaches a mild process for treating another oil, namely a fish oil, merely by reducing the treatment temperature - which process does also not lead to a complete elimination of the unpleasant flavour either - the Board can only conclude that it would be obvious to the skilled person faced with the problem of providing a mild treatment for olive oil according to the contested patent to envisage carrying out the process disclosed in example 5 of document (1) at a lower temperature, ie at a temperature within the overlapping temperature range 60°C to 65°C (example 4, page 9, lines 35 to 38).

3.2.5 The main arguments raised by the appellant patentees were that the subject-matter of claim 1 was inventive over document (1) because said document was not relevant as, contrary to the patent in suit, it concerned neither the change of taste of Spanish oil, whose organoleptic properties were appreciated in Spain but not elsewhere, nor the treatment of virgin oil.

3.2.6 As to these arguments, the Board notes that they concern elements which are not reflected in the claim under consideration and which cannot therefore be taken into account for the assessment of the inventive step of this set of claims.

Since, as is apparent from point 3.2.4 above, document (1) contains an incentive to use lower temperature where the full amount of a substance in an oil is not to be removed, and as no particular effect has been demonstrated for the overlapping temperature range, the Board considers that the subject-matter of claim 1 not to involve an inventive step as required by Article 56 EPC.

Since claim 1 of the only set of claims under consideration is not allowable, there is no need for the Board to consider the remaining claims.

4. For the reasons given under VII, third paragraph, there are no further requests to consider.

Order

For these reasons it is decided that:

1. The appellant patentees' appeal is rejected as inadmissible.
2. The decision under appeal is set aside.
3. The patent is revoked.

The Registrar:

The Chairman

A. Townend

U. Oswald