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D E C I S I O N
of 9 September 2004

Case Number: T 0184/02 - 3.3.2

Application Number: 91202693.7

Publication Number: 0486076

IPC: A23B 4/10

Language of the proceedings: EN

Title of invention:

Material for covering or coating food products and method for the production thereof

Patentee:

Meester B.V.

Opponent:

Vink Vleeswaren

Headword:

Material for covering food products/MEESTER B.V.

Relevant legal provisions:

EPC Art. 111(1)

Keyword:

"Remittal to the first instance - yes: new feature in the claims to be assessed for inventive step"

Decisions cited:

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Catchword:

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Case Number: T 0184/02 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 9 September 2004

Appellant:
(Opponent)

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Representative:

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Respondent:
(Proprietor of the patent)

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Representative:

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 18 December 2001
rejecting the opposition filed against European
patent No. 0486076 pursuant to Article 102(2)
EPC.

Composition of the Board:

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

Summary of Facts and Submissions

- I. European patent No. 0 486 076 based on application No. 91 202 693.7 was granted on the basis of 11 claims.

Independent claim 1 as granted read as follows:

"1. Edible material for covering or coating food products such as meat and meat products, characterized in that the material has the following composition:
10-50% animal or vegetable fat
35-70% milk and/or water
5-30% animal protein
0-25% starch and other binders and/or thickeners
0-5% salt."

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

The patent was opposed under Article 100(a) EPC for lack of novelty and lack of inventive step.

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

A2/A2a Dutch patent application NL-80-01969 and its English translation

A3/A3a Dutch patent application NL-68-15057 and its English translation

(5) US-A-2161029 (Exhibit B)

- III. The decision of the Opposition Division established that the patent could be maintained as granted under Article 102(2) EPC.

In its decision, the Opposition Division took the view that the patent as granted met the requirements of novelty and inventive step in accordance with Articles 52(1), 54 and 56 EPC.

As regards novelty, the Opposition Division was of the opinion that the composition disclosed in citation A2/A2a fell outside the range of claim 1 of the patent under opposition, and that the generic composition disclosed in claim 1 of said citation did not anticipate the subject-matter of the contested patent either.

Also with regard to novelty, the opposition division reached a similar conclusion concerning citation A3/A3a.

Accordingly, compliance with Article 54 EPC was acknowledged by the Opposition Division.

The latter defined the problem to be solved over the closest prior art, namely citation A2/A2a, which concerned a bacon-based material which can be arranged as a coating layer on, or around, a meat product, as the provision of an improved coating or covering material which has not only the desired white colour and good adherence properties, but which can also easily be folded around the meat product.

The Opposition Division considered that there was nothing in the available prior art to suggest to the skilled person that this problem could be solved by increasing the amount of milk and/or water in the

- composition. Its conclusion was that the proposed solution to the problem was not obvious and deserved the acknowledgment of an inventive step.
- IV. The appellant (opponent) lodged an appeal against the said decision and filed document (5) EP-A-536 823 as appendix B together with its grounds of appeal.
- V. Two sets of claims as first and second auxiliary requests were filed on 6 August 2004 by the respondent (patentee).
- VI. In a fax of 29 July 2004, the appellant's authorised representative informed the board that the appellant would be neither present nor represented at the hearing before the board.
- VII. Oral proceedings were held before the Board on 9 September 2004. During the oral proceedings, the respondent filed a new main request as sole request.
- VIII. The appellant maintained the grounds of opposition under Article 100(a) EPC as to the lack of novelty over documents A2/A2a, A3/A3a and inventive step over documents A2/A2a, A3/A3a in combination with document (5) of the patent in suit.
- IX. The respondent shared the Opposition Division's conclusion with respect to documents A2/A2a and A3/A3a and requested the remittal of the case in view of the relevance of document (5) as pointed out by the Board.

- X. The appellant requested in writing that the decision under appeal be set aside and that patent No. 0 486 076 be revoked.

The respondent requested that the decision under appeal be set aside and that the case be remitted to the first-instance department, and alternatively that the patent be maintained in amended form on the basis of the set of claims filed as the main request during the oral proceedings.

Reasons for the Decision

1. The appeal is admissible.
2. *Admissibility of the main request*

During the oral proceedings, the Board expressed its view that, whereas it could share the Opposition Division's conclusions concerning novelty over documents A2/A2a and A3/A3a, it could not understand why novelty over citation (5) had been acknowledged by both parties and by the department of first instance during examination and opposition proceedings. The novelty-destroying character of (5) became immediately evident to the respondent after a closer inspection of the citation.

After a short break, the respondent filed a new main request in order to establish novelty over document (5), which, in its opinion, had not been taken into account with respect to novelty by both parties and the

first-instance department presumably because it was cited as "A" document in the search report.

The subject-matter of independent claim 1 of this request differs from claim 1 of the set of claims as granted in that the animal protein used in the material for covering or coating food products is now restricted to **meat** protein.

In addition, the subject-matter of claim 1 constitutes a limitation of the scope of the claims as granted, which is occasioned by the objection of lack of novelty raised during the opposition and appeal proceedings. During the hearing before the Board, lack of novelty was discussed in the light of document (5) for the first time in these proceedings, although this citation was already in the procedure before the department of first instance and was reintroduced by the appellant in the appeal proceedings. The Board is of the opinion that the relevance of citation (5) has been recognised for the first time at the appeal stage.

Accordingly, the Board considers that this set of claims fulfil the requirements of Rule 57a EPC and cannot be regarded as late-filed.

3. *Remittal to the department of first instance*

In the present case, the subject-matter examined during the grant proceedings and during the opposition proceedings related to an edible material containing 5-30% animal protein of any type.

The new feature introduced into claim 1, ie a feature from the description, constitutes a restriction of the claims since meat protein is now the only type of protein used in the material. As such, the amendment of the claims now falls to be considered as an essential substantive issue in the present case which needs to be assessed with respect to inventive step.

Moreover, during the oral proceedings, the respondent sought to demonstrate that the choice of meat protein was not an arbitrary choice, but that it was the key feature of the claim leading to an improved elasticity and sturdiness of the material over the prior art and that these properties were essential for an industrial use of the material. However, the respondent acknowledged that it had no evidence with it to show that this alleged effect was indeed achieved over the prior art.

Finally, the Board notes that the appellant was not in a position to present arguments either with respect to the amended set of claims or with respect to the alleged effects as it did not attend the oral proceedings and as it obviously also overlooked the relevance of document (5) for novelty.

Although the EPC does not guarantee the parties an absolute right to have all the issues in the case considered by two instances, it is well-recognised that any party may be given an opportunity for two readings of the important elements of a case.

In the present case, the filing at a very late stage of the procedure of a new set of claims wherein a new

feature from the description, which had not been considered *per se* before and which might be decisive for the assessment of inventive step make it necessary to remit the case to the Opposition Division for further prosecution (Article 111(1) EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first-instance department for further prosecution.

The Registrar:

The Chairman:

A. Townend

G. Rampold