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**Datasheet for the decision
of 5 October 2006**

Case Number: T 0515/04 - 3.3.09

Application Number: 93908281.4

Publication Number: 0633730

IPC: A23G 3/30

Language of the proceedings: EN

Title of invention:

Improved wax-free chewing gums with controlled sweetener release

Patentee:

WM. WRIGLEY JR. COMPANY

Opponents:

PERFETTI SpA
Warner Lambert Company
DANDY A/S

Headword:

-

Relevant legal provisions:

EPC Art. 84, 123(2),(3), 111(1), 102(3)
EPC R. 55(c)

Keyword:

"Late filed request - admitted"
"Objections against a non amended part of the claim - inadmissible"
"Remittal for further prosecution"

Decisions cited:

G 0009/91, T 0525/90, T 0684/95, T 0301/87, T 0367/96,
T 0693/98

Catchword:

-



Case Number: T 0515/04 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 5 October 2006

Appellant:

(Patent Proprietor)

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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 9 February 2004
revoking European patent No. 0633730 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: P. Kitzmantel
Members: J. Jardón Álvarez
M. B. Tardo-Dino
W. Ehrenreich
K. Garnett

Summary of Facts and Submissions

I. The grant of European patent No. 0 633 730 in respect of European patent application No. 93908281.4 in the name of WM. WRIGLEY JR. COMPANY, which had been filed on 2 March 1993, was announced on 19 November 1997 (Bulletin 1997/47) on the basis of 34 claims. Claim 1 read as follows:

"1. A chewing gum free of mineral hydrocarbon wax which also contains no more than 5% natural wax, having controlled sweetener release, comprising from 5 to 35 wt% chewing gum base, which gum base is wax-free, comprising:

from 20 to 60 wt% synthetic elastomer;
from 0 to 30 wt% natural elastomer;
from 5 to 55 wt% elastomer plasticizer;
from 4 to 40 wt% filler; and
from 5 to 40 wt% of at least one softener, at least one of which shall be hydrogenated or partially hydrogenated vegetable oils or a mixture of hydrogenated and partially hydrogenated vegetable oils; said chewing gum further comprising

at least one flavouring agent and water-soluble bulking agent, and
at least one controlled release sweetener ingredient."

Claims 2 to 34 were dependent claims.

II. Three Notices of Opposition requesting the revocation of the patent in its entirety on the grounds of Article 100(a) EPC (by the three Opponents) and on the grounds of Article 100 (b) EPC (by Opponents 01 and 03) were filed against this patent by:

PERFETTI S.p.A (Opponent 01) on 12 August 1998,

Warner Lambert Company (Opponent 02) on 14 August 1998 and by

DANDY A/S (Opponent 03) on 19 August 1998.

III. By its decision announced orally on 9 December 2003 and issued in writing on 9 February 2004, the Opposition Division revoked the patent.

The Opposition Division held that the patent did not meet the requirements of the EPC, because the subject-matter of independent claim 1 was not in agreement with the requirements of Article 84 EPC.

The Opposition Division found essentially that the subject-matter of Claim 1 defining the chewing gum using the functional feature "...said fast release sweetener and slow release sweetener being selected so as to provide a combined sweetener release profile comparable or similar to the release profile of said one or more flavouring agents so that sweetener releases essentially concurrently with flavour both initially and through chewing of the gum" was unclear in the sense that the person skilled in the art, when reading the claim, was not in a position to assess the matter for which protection was sought.

The Opposition Division left open whether further deficiencies under Article 84 EPC might exist. Moreover the Opposition Division in its decision did not deal with the grounds of opposition according to Article 100(a) and (b) EPC.

IV. On 13 April 2004 the Patent Proprietor (Appellant) lodged an appeal against the decision of the Opposition Division and paid the appeal fee on the same day.

With the Statement of Grounds of Appeal filed on 18 June 2004, the Appellant filed three sets of amended claims and requested that the decision under appeal be set aside and that if any of the main request, the first or the second auxiliary request met the requirements of Article 84 EPC the case be remitted to the Opposition Division for further consideration of novelty and inventive step. In all the sets of claims filed by the Appellant the wording objected to by the Opposition Division had been deleted from Claim 1.

V. The Respondents 01 and 02 presented their counterstatements by letters dated 3 November 2004 (Respondent 01/Opponent 01) and 27 December 2004 (Respondent 02/Opponent 02) and requested that the appeal be dismissed.

VI. In response to the Board's communication, issued on 14 July 2006 in preparation for the oral proceedings, the Appellant filed with letter dated 1 September 2006 three amended sets of claims including a main request and two auxiliary requests.

By a further letter, dated 26 September 2006, the Appellant filed a new main request to replace all its previous requests on file. The only claim of this request read as follows:

"1. A chewing gum free of mineral hydrocarbon wax and natural wax, having controlled sweetener release, comprising from 5 to 35 wt% chewing gum base, which gum base is free of mineral hydrocarbon wax and natural wax, comprising:

from 20 to 60 wt% synthetic elastomer;

from 0 to 30 wt% natural elastomer;

from 5 to 55 wt% elastomer plasticizer selected from the group consisting of glycerol esters of rosin, glycerol esters of partially hydrogenated rosin, glycerol esters of polymerized rosin, glycerol esters of partially dimerized rosin, partially hydrogenated methyl esters of rosin, glycerol esters of tall oil rosin, pentaerythritol esters of rosin, methyl esters of rosin, pentaerythritol esters of partially hydrogenated rosin, synthetic terpene resin, natural terpene, and combinations thereof;

from 4 to 40 wt% filler; and

from 5 to 40 wt% of at least one softener, at least one of which shall be hydrogenated or partially hydrogenated vegetable oils or a mixture of hydrogenated and partially hydrogenated vegetable oils;

said chewing gum further comprising at least one flavouring agent and water-soluble bulking agent, and at least one controlled release sweetener ingredient comprising a slow release sweetener selected from sucralose, thaumatin and monellin or

from a slow release sweetener provided by modification of the release characteristics of a high intensity fast release sweetener, and a fast release sweetener."

VII. During the oral proceedings held before the Board on 5 October 2006, the Appellant filed an amended version of its main request and withdrew its previous main request. The only claim of the request reads now as follows:

"A chewing gum free of mineral hydrocarbon wax which also contains no more than 5% natural wax, having controlled sweetener release, comprising from 5 to 35 wt% chewing gum base, which gum base is wax-free, comprising:

from 20 to 60 wt% synthetic elastomer;
from 0 to 30 wt% natural elastomer;
from 5 to 55 wt% elastomer plasticizer selected from the group consisting of glycerol esters of rosin, glycerol esters of partially hydrogenated rosin, glycerol esters of polymerized rosin, glycerol esters of partially dimerized rosin, partially hydrogenated methyl esters of rosin, glycerol esters of tal oil rosin, pentaerythritol esters of rosin, methyl esters of rosin, pentaerythritol esters of partially hydrogenated rosin, synthetic terpene resin, natural terpene resin, and combinations thereof;
from 4 to 40 wt% filler; and
from 5 to 40 wt% of at least one softener, at least one of which shall be hydrogenated or partially hydrogenated vegetable oils or a mixture

of hydrogenated and partially hydrogenated vegetable oils;
said chewing gum further comprising at least one flavouring agent and water-soluble bulking agent, and at least one controlled release sweetener ingredient comprising a slow release sweetener selected from sucralose, thaumatin and monellin or from a slow release sweetener provided by modification of the release characteristics of a high intensity fast release sweetener, and a fast release sweetener."

VIII. The arguments presented by the Appellant during the proceedings may be summarized as follows:

- The newly filed single claim resulted from a combination of granted claims 1, 17, 4, 9 and 6. The claim only included features which were present in the granted claims and as a consequence Article 84 could not be invoked. It mentioned in support of its arguments the decisions T 301/87 of 16 February 1989 and T 367/96 of 3 December 1997, none of them published in OJ EPO.

- Concerning Article 123(2) EPC, it pointed out that the amendments made did not add anything new from the description and taking into account that Article 100(c) had not been raised as ground of opposition in the notices of opposition it could not be considered by the Board without the approval of the Appellant. Moreover it did not give its approval to the introduction of this fresh ground for opposition into the proceedings.

IX. The arguments presented by the Respondents 01 and 02 in their written submissions and at the oral proceedings may be summarized as follows:

- The amended claim needed not only to be directed to patentable subject-matter, but, pursuant to the requirements of Article 102(3) EPC, it must also satisfy the requirements of Article 84 EPC. Respondent 02 mentioned in support of this argument the decisions T 525/90 of 17 June 1992 and T 684/95 of 13 November 1996, none of them published in OJ EPO.
- The claimed subject-matter lacked clarity because it was not possible to distinguish clearly and reliably between fast release sweeteners and slow release sweeteners. The terms did not have a recognized meaning in the field and there was no definition of how the release of sweetness should be determined. Moreover the claim gave no information about how the modification of the release characteristics of a high intensity fast release sweetener were to be achieved.
- The Respondents further objected to some of the features of the claim as not being supported by the application as filed and therefore failing to meet the requirements of Articles 100(c) and 123(2) EPC.
- The Respondents did not object to the admissibility of the request filed by the Appellant on 26 September 2006, but objected to the admissibility of the amendment made to this request during the oral proceedings. In its opinion this request should

be considered as late filed and not admitted into the proceedings.

X. Opponent 03 did not file any submissions during the present appeal proceedings.

XI. The **Appellant** requested:

- that the decision under appeal be set aside, and
- that the case be remitted to the Opposition Division for further prosecution on the basis of the new main request (single claim) filed during the oral proceedings.

The **Respondents** 01 and 02 requested:

- that the new main request, filed during the oral proceedings, be not admitted and
- that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

2. *Admissibility of the late filed request*

2.1 The single claim of the only request was filed by the Appellant at a late stage of the proceedings, namely during the oral proceedings before the Board of Appeal. The only amendment made to the claim compared with the previous version filed with letter dated 26 September 2006 and not objected to by the Respondents, was the replacement of the terms "free of ... natural wax" (for the chewing gum) and "free of mineral hydrocarbon wax and natural wax" (for the gum base) by the literal

wording of granted Claim 1 for the definition of the wax content. This amendment takes account of the objections by Respondent 02 under Article 123(2) EPC to the wording previously used.

2.2 The Respondent 02 objected formally to the admission of the request as late filed but did not submit any arguments suggesting that it could not deal with the amended subject-matter at the oral proceedings.

2.3 The Board decided to admit the request into the proceedings because the amendments made (i) amount to the reinsertion of the language of granted Claim 1 concerning the definition of the term wax-free, thereby (ii) addressing observations made by the Respondents and the Board, because (iii) the Claim in all other respects corresponds to the single claim filed with the letter dated 26 September 2006 whose admissibility had not been contested by the Respondents, and because (iv) in the circumstances the amended Claim does not confront the Respondents with facts, evidence and arguments not yet in the proceedings.

3. *Amendments*

3.1 The Appellant has deleted from Claim 1 underlying the decision under appeal the functional feature added during the first instance opposition proceedings, this feature being the reason for the revocation of the patent by the Opposition Division.

3.2 The Appellant has further made the following amendments to the Claim:

- The elastomer plasticizer is defined as "selected from the group consisting of glycerol esters of rosin, glycerol esters of partially hydrogenated rosin, glycerol esters of polymerized rosin, glycerol esters of partially dimerized rosin, partially hydrogenated methyl esters of rosin, glycerol esters of tal oil rosin, pentaerythritol esters of rosin, methyl esters of rosin, pentaerythritol esters of partially hydrogenated rosin, synthetic terpene resin, natural terpene resin, and combinations thereof" in accordance with the definition given in granted Claim 17;
- the "at least one controlled release sweetener ingredient" is now defined as "comprising a slow release sweetener and a fast release sweetener" as in granted Claim 4, and
- the "slow release sweetener" is further defined as "selected from sucralose, thaumatin and monellin" or "provided by modification of the release characteristics of a high intensity fast release sweetener" in accordance with granted Claims 9 and 6.

3.3 In summary, the Claim under consideration corresponds to the chewing gum of independent granted Claim 1 wherein some of the components of the chewing gum or the chewing gum base have been specified using definitions given in dependent Claims 4, 6, 9 and 17.

4. *Procedural matters. Extension of examination*

4.1 As stated in G 9/91, OJ 1993, 408 (order and point 7), the power of the Opposition Division or a Board of Appeal to examine and decide upon the maintenance of a patent under Articles 101 and 102 EPC is, pursuant to Rule 55(c) EPC, dependent upon two distinct requirements: the indication of the extent to which a patent is opposed and the grounds of opposition. So far as the powers of the Boards of Appeal are concerned, it is also made clear in the same decision (point 18) that the purpose of the appeal procedure inter parties is mainly to give the losing party the possibility of challenging the decision of the Opposition Division on its merits. It is therefore inconsistent with this purpose for a Board of Appeal to consider grounds for opposition on which the decision of the Opposition Division was not based, unless the Patent Proprietor agrees.

4.2 When it comes to amendments of claims or other parts of the patent in the course of opposition or appeal proceedings, it is also pointed out in G 9/91 (point 19) that in accordance with Article 102(3) EPC such amendments are to be fully examined as to their compatibility with the requirements of the EPC. However, this principle does not affect the wider principles stated in paragraph 4.1 above. Thus the fact that amendments are made to a claim in the course of the opposition or appeal proceedings does not allow an Opponent to raise objections which were not originally raised and substantiated as grounds of opposition (cf. T 693/98 of 25 April 2002, not published in OJ EPO, point 2 of the reasons).

4.3 So, for example, a clarity objection pursuant to Article 84 EPC which does not arise from the amendments themselves is not allowable (see decision T 301/87, OJ 1990, 335, point 3.8 of the Reasons). In the same way, and directly relevant in the present case, an objection under Article 123(2) EPC is not allowable if it is raised for the first time at the appeal stage and does not arise from an amended part of the claim. It is thus not allowable if it arises from a granted claim or a feature already present in the granted claims which was neither challenged in the Notice of Opposition under Article 100(c) EPC nor examined by the Opposition Division on its own motion (cf. T 693/98).

5. *Article 84 EPC*

5.1 Concerning Article 84 EPC, in the present case the Respondents argued that the terms "fast release sweetener", "slow release sweetener", "high intensity fast release sweetener" lacked clarity as there was no clear definition of these terms in the specification and there was no generally acknowledged method to establish if a sweetener was a fast or a slow release sweetener. Additionally, the expression "modification of the release characteristics" was also unclear as the nature of the modification could not be determined.

5.2 As explained above (see 3.3) the present claim is a direct combination of claims 1, 4, 6, 9 and 17 of the patent as granted, i.e. its subject-matter corresponds to that of a claim of the patent as granted.

The terms and expressions objected to by the Respondents were all already in the granted claims (see granted claims 4 and 6) and consequently these objections have no connection with the amendments made. They cannot be objected to under Article 84 EPC at this stage of the proceedings.

5.3 This finding is not in contradiction with the decisions T 525/90 and T 684/95 cited by Respondent 02 (see point IX above). In T 525/90 it is stated that objections to clarity of the claims under Article 84 EPC must be taken into account in opposition proceedings whenever the granted claims have been amended, but it is not concerned with clarity objections already present in the claims, as in the present case. In T 684/95, T 301/87 is followed in that it is said that only objections resulting from the amendments are to be considered (see point 2.1 of the Reasons of T 684/95).

6. *Article 123 EPC*

6.1 The ground of opposition under Article 100(c) EPC was not originally invoked by any of the three Opponents in their respective grounds of opposition and during the oral proceedings held before the Board of Appeal the Appellant refused to give its approval to the introduction of the ground of opposition under Article 100(c) EPC into the proceedings. Consequently, this ground for opposition cannot be considered by the Board of Appeal (cf. point 4.3 above).

6.2 Nevertheless, it remains to be assessed whether any objection arises out of the amendments specifying some

of the ingredients of the chewing gum on the basis of information already present in the granted claims. Thus, while in granted Claim 1 it was specified that "at least one controlled release sweetener ingredient" was present, this ingredient is now defined as comprising a fast release sweetener and a slow release sweetener in accordance with dependent granted Claim 4, and the slow release sweetener is further specified as selected from sucralose, thaumatin and monellin (granted Claim 9, dependent on Claim 4) or as provided by modification of the release characteristics of a high intensity fast release sweetener (granted Claim 6, also dependent on Claim 4). Additionally, the elastomer plasticizer has been defined as in granted Claim 17, which was also dependent on claim 4.

These amendments are not objectionable under Article 123(2) EPC as they only limit the scope of Claim 1 by restricting the choice of the ingredients concerned in accordance with the disclosure in granted dependent claims but without singling out a particular combination of ingredients of the chewing gum.

The further objections raised by the Respondents concerning Article 123(2) EPC do not arise from these limitations made to the claim during the opposition or appeal proceedings but arise from amendments made before grant which cannot be examined at this stage (see point 4.3).

6.3 Accordingly the objections of the Respondents based upon Article 123(2) EPC are rejected as inadmissible.

- 6.4 The claim as at present amended contains all the features of granted Claim 1 and its scope is clearly limited over the granted Claim 1. It therefore meets the requirements of Article 123(3) EPC.
- 6.5 Therefore the amendments fulfil the requirements of the EPC in the sense of Article 102(3) EPC to the extent that they may be examined for such compliance.
7. *Remittal (Article 111 EPC)*
- 7.1 The Board considers that the subject-matter of the single claim of the request overcomes the objection of lack of clarity forming the basis of the decision under appeal.
- 7.2 The patent in suit was revoked solely for lack of clarity of the then pending Claim 1. The Opposition Division has not yet taken a decision on the other patentability issues raised by the Opponents, namely sufficiency of disclosure, novelty and inventive step.
- 7.3 The Appellant has requested the remittal of the case to the Opposition Division for further consideration of these issues and during the oral proceedings the Respondents 01 and 02 did not object to such remittal.
- 7.4 Under these circumstances, the Board considers it appropriate to exercise its discretion under Article 111(1) EPC to refer the case back to the Opposition Division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The new main request is admitted.
3. The case is remitted to the Opposition Division for further prosecution on the basis of the single claim of the main request, filed during the oral proceedings.

The Registrar:

The Chairman:

C. Moser

P. Kitzmantel