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**Datasheet for the decision
of 6 November 2006**

Case Number: T 0176/05 - 3.3.09

Application Number: 97922513.3

Publication Number: 0969747

IPC: A23L 2/385

Language of the proceedings: EN

Title of invention:

Color stable iron fortified dry drink mixes, ready-to-drink beverages and foods other than beverages that optionally contain zinc

Applicant:

THE PROCTER & GAMBLE COMPANY

Opponent:

-

Headword:

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Relevant legal provisions:

EPC Art. 54, 84, 123(2) and 111(1)

Keyword:

"Clarity - yes after amendment"

"Novelty - yes"

"Remittal - yes"

Decisions cited:

G 0001/03

Catchword:

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Case Number: T 0176/05 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 6 November 2006

Appellant:

THE PROCTER & GAMBLE COMPANY
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Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 2 September 2004
refusing European application No. 97922513.3
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: P. Kitzmantel
Members: J. Jardon Alvarez
K. Garnett

Summary of Facts and Submissions

- I. This appeal lies from the decision of the Examining Division, issued in writing on 2 September 2004, refusing European patent application No. 97 922 513.3, published as WO - A - 98/48648.
- II. The decision under appeal was based on a set of seven claims filed with letter dated 5 August 2003.

Claim 1 read as follows:

"1. An ingestible composition which has a desirable color and which is free of undesirable aftertaste selected from the group consisting of a ready to drink beverage and an aqueous food other than a beverage, said composition comprising:

- (1) from 5% to 100% of the USRDI of iron;
- (2) optionally from 5% to 100% of the USRDI of zinc;
- (3) from 0.001% to 0.5% of a coloring agent;
- (4) optionally from 0.001% to 10% of a flavoring agent wherein said flavoring agent is selected from fruit or botanical flavors, or mixtures thereof; and
- (5) at least one agent selected from ferric ion reducing agents and agents capable of preferentially complexing ferric ion in the presence of polyphenols, phenolic acids or flavonoids in an amount sufficient such that the beverage or food, in the absence of the coloring agent, has a Hunter-L value of 11 or greater as measured according to the Tannic Acid Test;

(6) wherein the beverage or food has a pH of about 5 or less, as is or when dissolved in an aqueous liquid."

III. The Examining Division refused the application, because Claim 1 was considered to lack clarity with the consequence that it did not fulfil the requirements of Article 84 EPC.

In the Examining Division's view the person skilled in the art was not able to evaluate the matter for which protection was sought; in particular, which components had necessarily to be present in the claimed composition and in what amounts in order to arrive at the desired properties specified by the Hunter-L value.

The Examining Division further stated that, due to this lack of clarity, it was not possible to know if the prior art compositions as disclosed in document

D5: WO - A - 97/15201

were novelty destroying for the claimed subject-matter.

IV. The Notice of Appeal was filed on 5 November 2004 and the appeal fee was paid on the same day. The Statement setting out the Grounds of Appeal was filed on 27 December 2004.

V. On 23 May 2006 the Board dispatched the summons to attend oral proceedings. In the annexed communication pursuant to Article 11(1) of the Rules of Procedure of the Boards of Appeal, the Board indicated that it was to be decided during the oral proceedings if the

claimed subject-matter fulfilled the requirements of Articles 84 and 54 EPC. The Board also pointed out that the claimed subject-matter appeared to lack novelty having regard to the disclosure of D5.

- VI. With a letter dated 5 September 2006, the Appellant requested that the examination proceedings be continued on the basis of sets of claims for three new requests, namely a main request and two auxiliary requests.
- VII. During the oral proceedings held on 6 November 2006, the Appellant filed an amended main request.

Independent Claims 1 and 10 of this request read as follows:

"1. A dry beverage mix which, when reconstituted as a beverage has a desirable color and is free of undesirable aftertaste comprising:

- (1) from 5% to 100% of the USRDI of iron;
- (2) optionally from 5% to 100% of the USRDI of zinc;
- (3) from 0.001% to 0.5% of a coloring agent;
- (4) optionally from 0.001% to 10% of a flavoring agent wherein said flavoring agent is selected from fruit or botanical flavors, or mixtures thereof; and
- (5) at least one agent selected from ferric ion reducing agents and agents capable of preferentially complexing ferric ion in the presence of polyphenols, phenolic acids or flavonoids in an amount sufficient such that the Hunter-L color of a mixture dissolved in 240 ml deionized water containing 240 mg tannic acid, the iron source equivalent to at least 5 mg of iron,

and the complexing and/or reducing agent, is 11 or greater;

wherein the agent capable of preferentially complexing ferric ion is selected from the group consisting of hydroxypolycarboxylic acids, polyphosphates and their respective salts, aminopolycarboxylic acids and their respective partial salts, lactic acid, acetic acid, and mixtures thereof;

- (6) wherein the beverage has a pH of 5 or less when the dry mix is dissolved in an aqueous liquid;

wherein said dry beverage mix is not a dry free-flowing beverage composition which, when reconstituted, is of desirable color and free of undesirable aftertaste, comprising:

- (1) from 5% to 100% of the USRDI for iron, wherein said iron is selected from the group consisting of chelated iron and encapsulated ferrous sulfate;
- (2) from 5% to 100% of the USRDI of zinc;
- (3) from 0.001% to 0.5% of a coloring agent;
- (4) from 0.001% to 10% of a flavoring agent wherein said flavoring agent is selected from fruit or botanical flavors, or mixtures thereof; and
- (5) from 1% to 50% of an edible acid sufficient to lower the pH between 3 and 4.5 in the finished beverage."

"10. An aqueous food other than a beverage which has a desirable color and which is free of undesirable aftertaste comprising:

- (1) from 5% to 100% of the USRDI of iron;
- (2) optionally from 5% to 100% of the USRDI of zinc;
- (3) from 0.001% to 0.5% of a coloring agent;

- (4) optionally from 0.001% to 10% of a flavoring agent wherein said flavoring agent is selected from fruit or botanical flavors, or mixtures thereof; and
- (5) at least one agent selected from ferric ion reducing agents and agents capable of preferentially complexing ferric ion in the presence of polyphenols, phenolic acids or flavonoids in an amount sufficient such that the Hunter-L color of a mixture dissolved in 240 ml deionized water containing 240 mg tannic acid, the iron source equivalent to at least 5 mg of iron, and the complexing and/or reducing agent, is 11 or greater; wherein the agent capable of preferentially complexing ferric ion is selected from the group consisting of hydroxypolycarboxylic acids, polyphosphates and their respective salts, aminopolycarboxylic acids and their respective partial salts, lactic acid, acetic acid, and mixtures thereof;
- (6) wherein the food has a pH of 5 or less as is or when dissolved in an aqueous liquid;

wherein the aqueous food is selected from the group consisting of dairy product, artificial dairy product, baby food or formula, pudding, ice cream, syrup, dessert filling, emulsified spread, soup, dip, sauce and gravy."

VIII. The arguments put forward by the Appellant can be summarized as follows:

- The subject-matter of the amended claims fulfilled the requirements of Article 84 EPC. The "agent capable of preferentially complexing ferric ion in the presence of polyphenols, phenolic acids or flavonoids" had been clarified by introducing the list of agents to be used. Moreover, the oxidation reduction potential of the ferrous/ferric system was well known and the skilled person would have no difficulty in determining which agents fall under the scope of the term "ferric ion reducing agent".
- The amount of the reducing or complexing agent can be easily determined by performing the Tannic Acid Test. The determination of the Hunter-L value of a mixture was a routine technique for a person skilled in the art and the conditions for performing the Tannic Acid Test had been introduced into Claims 1 and 10 as recommended in the Guidelines for Examination in the European Patent Office, Part C, Chapter III, 4.7 and 4.10.
- The subject-matter of D5 had been disclaimed from Claims 1 to 9 and consequently the subject-matter of the claims was novel.
- Concerning inventive step, the Appellant argued that the problem underlying the present application, namely to provide beverages and foods free of undesirable after-taste and suffering no discoloration, was solved by using specific agents in certain amounts as defined by feature (5) of

Claims 1 and 10. However, taking account that none of the examples in the specification illustrated the invention as now claimed and that no experimental evidence showing the claimed effect was present on file, the Appellant requested remittal of the file to the Examining Division for further prosecution.

- IX. The Appellant requested that the decision under appeal be set aside and that the case be remitted to the Examining Division for continuation of the examination proceedings on the basis of Claims 1 to 16 of the main request filed during the oral proceedings.

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments (Article 123(2) EPC)*
 - 2.1 Claim 1 on which the decision under appeal was based was directed to ingestible compositions selected from a ready to drink beverage and an aqueous food other than a beverage. It has now been divided in two independent claims, Claim 1 directed to a dry beverage mix and Claim 10 directed to an aqueous food, to take account of the fact that dry beverage mixes were already disclosed in D5 and needed to be disclaimed.
 - 2.2 The amended claims are supported by the original disclosure:
 - 2.2.1 Claim 1 has its main basis in the original disclosure on page 4, lines 11 to 26. Additionally, the "agents

capable of preferentially complexing ferric ion in the presence of polyphenols, phenolic acids or flavonoids" have been defined as on page 12, lines 8 - 14, and the conditions for performing the Tannic Acid Test have been added as per the information on page 12, lines 19 - 28 of the original description.

- 2.2.2 Claim 1 as amended includes further a disclaimer not having a basis in the application as originally filed, introduced in order to exclude the dry free-flowing beverage compositions disclosed on page 3, lines 16 - 28 of document D5. D5 was published on 1 May 1997, after the filing date of the present application, 29 April 1997, and is therefore state of the art having regard to Article 54(3) EPC.

Such a disclaimer, only excluding subject-matter for legal reasons, has no bearing on the technical information in the application and is therefore not in contravention of Article 123(2) EPC (see Decision of the Enlarged Board of Appeal G 1/03, OJ EPO, 2004, 413, point 2.1.3 of the reasons).

- 2.2.3 Claims 2 to 7 have their basis in the corresponding original Claims 21 to 28 and Claims 8 and 9 are supported by page 5, lines 22 - 23 of the description.

- 2.2.4 Claim 10 is also mainly based on the original disclosure on page 4, lines 11 to 26, to which the "agents capable of preferentially complexing ferric ion in the presence of polyphenols, phenolic acids or flavonoids" and the conditions for performing the Tannic Acid Test have been added as for Claim 1.

Additionally, the aqueous food has been defined using the passage on page 14, lines 5 - 14.

2.2.5 Claims 11 to 16 find their support in the corresponding original Claims 41 to 48.

2.3 Therefore, the subject-matter of the claims meets the requirements of Article 123(2) EPC.

3. *Clarity (Article 84 EPC)*

3.1 The Examining Division rejected the application because of lack of clarity of the subject-matter of the then pending Claim 1.

3.2 The amended claims overcome the clarity objections raised by the Examining Division concerning feature (5). The complexing agents and the method of performing the Tannic Acid Test are now clearly specified in the independent Claims 1 and 10. In the Board's judgment, the skilled person having recourse to general common knowledge is able to identify which materials will fulfil the required criteria and to ascertain if a given compound falls within the specifications of the claims.

3.3 Also features (1) and (2) are clear. The USRDIs (United States Recommended Daily Intake) are defined standards (see page 5, lines 34 - 36) for each nutrient and therefore represent objectively verifiable data. This finding is not affected by the fact that different RDIs are recommended for children, older persons and for pregnant and lactating women. The skilled person would choose the recommended amount, taking appropriate

account of the intended use of the composition to be prepared.

3.4 For these reasons, the amended claims fulfil the requirements of Article 84 EPC.

4. *Novelty (Article 54 EPC)*

4.1 Document D5 discloses dry free-flowing beverage compositions containing iron and zinc as embraced by original Claim 1, but these known compositions have now been disclaimed from the subject-matter of operative Claim 1 (see above point 2.2.1). D5 does not disclose aqueous foods as claimed in Claim 10 and therefore a disclaimer is not needed for this claim.

The subject-matter of the claims is therefore novel over D5.

4.2 None of the other documents cited in the Search Report discloses compositions with the components and the amounts as specified on Claims 1 and 10.

4.3 The subject-matter of the claims is thus novel over all available citations (Article 54 EPC).

5. *Remittal to the first instance (Article 111(1) EPC)*

5.1 The Examining Division relied only on the non-compliance of the claimed subject-matter with Article 84 EPC for refusing the application. The Examining Division further pointed out that due to this lack of clarity it was not possible to know if a given disclosure was novelty destroying or not.

5.2 As explained above, these objections have been overcome by the amendments made. It therefore appears appropriate, in agreement with the Appellant's request, to remit the case to the first instance for further substantive examination.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for continuation of the examination proceedings on the basis of Claims 1 to 16 of the main request filed during the oral proceedings.

The Registrar:

The Chairman:

D. Sauter

P. Kitzmantel