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**Datasheet for the decision
of 2 September 2008**

Case Number: T 1272/05 - 3.3.09

Application Number: 97203350.0

Publication Number: 0913096

IPC: A23L 1/168

Language of the proceedings: EN

Title of invention:

Rice grains to be reconstituted

Patentee:

SOCIÉTÉ DES PRODUITS NESTLÉ S.A.

Opponent:

KAMPFFMEYER FOOD SERVICE GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 108
EPC R. 101(1)

Relevant legal provisions (EPC 1973):

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Keyword:

"Admissibility of appeal (yes)"
"Remittal of the case"

Decisions cited:

J 0022/86, T 0934/02

Catchword:

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Case Number: T 1272/05 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 2 September 2008

Appellant: SOCIÉTÉ DES PRODUITS NESTLÉ S.A.
(Patent Proprietor) Case postale 353
CH-1800 Vevey (CH)

Representative: Thomas, Alain
55, avenue Nestlé
CH-1800 Vevey (CH)

Respondents: KAMPPFMEYER FOOD SERVICE GmbH
(Opponent) Tretaustrasse 32-34
D-21107 Hamburg (DE)

Representative: Schildberg, Peter
Hauck Patent- und Rechtsanwälte
Neuer Wall 50
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office orally announced
14 July 2005 and posted 28 July 2005 revoking
European patent No. 0913096 pursuant to
Article 102(1) EPC.

Composition of the Board:

Chairman: P. Kitzmantel
Members: W. Ehrenreich
W. Sekretaruk

Summary of Facts and Submissions

I. Mention of the grant of European patent No. 0 913 096 in respect of European patent application No. 97 203 350.0, filed on 28 October 1997 in the name of *Société des Produits Nestlé S.A.*, was announced on 26 March 2003 (Bulletin 2003/13).

The patent, entitled "*Rice grains to be reconstituted*" was granted with ten claims. Independent process claim 1 and independent product Claim 8 read as follows:

"1. Process for the preparation of reconstitutable rice grains comprising:

- cooking a mixture of rice flour, water and hydrogenated oil in a cooker-extruder operated at 100-500 rpm and at a temperature of 70-150°C, to produce a partly gelatinized mixture,
- forming the partly gelatinized mixture into rice-grain shaped pieces, and
- drying and cooling the pieces to room temperature to provide the reconstitutable rice grains.";

"8. Rapidly reconstitutable rice grains comprising a partly gelatinised matrix of a rice flour which contains a hydrogenated oil."

Claims 2 to 7 were dependent on Claim 1 and Claims 9 and 10 were dependent on Claim 8.

II. Notice of opposition was filed by

Kampffmeyer Food Service GmbH

on 23 December 2003.

The opposition, based on Article 100(a) EPC, alleged that the claimed subject-matter was neither novel nor based on an inventive step. The objection as to lack of novelty of the product claimed in Claim 8 was *inter alia* based on document

E8 Derwent abstract of JP-A 62 155059.

III. With its decision announced in the oral proceedings on 14 July 2005 in the absence of both parties (who had been duly summoned but had informed the Opposition Division that they would not attend the oral proceedings) and issued in writing on 28 July 2005, the Opposition Division revoked the patent.

The decision was based on the claims as granted and two sets of claims according to auxiliary requests 1 and 2 submitted with the letter dated 10 August 2004.

The only reason for revocation was that the product claimed in independent Claim 8 of all requests was not novel over the disclosure in E8. No consideration was given in the decision to novelty and/or inventive step of the processes claimed in Claims 1 to 7.

IV. On 23 September 2005 the patent proprietor (hereinafter: the Appellant) filed a notice of appeal against the decision of the Opposition Division. Enclosed with this

notice of appeal was a set of process Claims 1 to 7 which correspond exactly with process Claims 1 to 7 as granted. The Appellant requested that the decision be cancelled in its entirety and the patent be maintained with the enclosed set of claims. A separate statement of grounds of appeal was not filed.

- V. In a communication pursuant to Article 108 and Rule 101(1) EPC (Rule 65(1) EPC 1973) dated 16 January 2006 the Appellant was informed that a written statement of grounds of appeal against the decision of the opposition division had not been filed and that it was therefore to be expected that the appeal would be rejected as inadmissible.

In its letter of response to this communication dated 1 February 2006 the Appellant argued that the written statement of grounds of appeal had been included in the notice of appeal dated 23 September 2005 and that the appeal was based on a new set of claims containing only 7 claims, ie with the last 3 claims (ie the product claims refused by the decision under appeal) deleted.

The Appellant requested that the appeal be allowed.

- VI. In its letter dated 12 May 2006 the Opponent (Respondent) replied with reference to decision J 22/86 that the Appellant's notice of appeal did not set out any reasons why the appeal should be allowed and the decision under appeal should be set aside. A written statement of grounds of appeal in accordance with Article 108 EPC had therefore not been filed.

The Respondent requested that the appeal be rejected as inadmissible.

Reasons for the Decision

1. *Admissibility of the appeal*

With its notice of appeal the Appellant filed a set of process Claims 1 to 7 and requested maintenance of the patent on the basis of these new claims.

The Board observes that this set of claims no longer seeks protection for the subject-matter which was considered by the Opposition Division to be not novel over E8.

By filing this new set of claims the Appellant has eliminated the circumstances which led to the revocation of the patent and has removed the basis underlying the appealed decision. Hence, it is not necessary to file grounds in support of product claims which the Appellant no longer defends in the appeal proceedings.

The notice of appeal therefore meets the requirements for an admissible appeal in accordance with Article 108, third sentence EPC, because

- (i) the subject of the proceedings has changed, since the new subject (ie the subject-matter of the claims attached to the appeal brief) is different from that underlying the decision under appeal; and

- (ii) it is immediately apparent that due to this change the reasons for the appealed decision no longer apply.

(See decision T 934/02 (catchword I, reasons 2), and also Case Law of the Boards of Appeal of the European Patent Office, 5th edition 2006 VII.D.7.5.2).

2. *Remittal of the case*

In the decision under appeal novelty and inventive step of the processes claimed in Claims 1 to 7 of the opposed patent, which now constitute the only points at issue in the appeal proceedings, were not considered.

It is not in accordance with the nature of appeal proceedings that in such a situation the Board should assess for the first time the respective arguments submitted by the parties before the first instance tribunal. Rather this should be carried out by the Opposition Division (see also Case Law of the Boards of Appeal of the European Patent Office, 5th edition 2006, VII.D.14.4).

Order

For these reasons it is decided that:

1. The appeal is admissible.
2. The decision under appeal is set aside.
3. The case is remitted to the first instance for further prosecution on the basis of Claims 1 to 7 submitted with the notice of appeal.

The Registrar

The Chairman

G. Nachtigall

P. Kitzmantel