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**Datasheet for the decision
of 29 May 2008**

Case Number: T 0133/06 - 3.3.09

Application Number: 00947469.3

Publication Number: 1196050

IPC: A23L 2/39

Language of the proceedings: EN

Title of invention:

Compositions for providing and maintaining energy and mental alertness

Patentee:

THE PROCTER & GAMBLE COMPANY

Opponent:

Unilever PLC

Headword:

-

Relevant legal provisions:

EPC Art. 114, 111(1), 104(1)

EPC R. 88, 116

RPBA Art. 13

Relevant legal provisions (EPC 1973):

-

Keyword:

"Late filed document - admitted"

"Remittal for further prosecution"

Decisions cited:

T 1002/92, T 0326/87, T 0758/99

Catchword:

See point 4.1



Case Number: T 0133/06 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 29 May 2008

Appellant:
(Opponent)

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Decision under appeal:

Interlocutory decision of the Opposition
Division of the European Patent Office posted
30 November 2005 concerning maintenance of
European patent No. 1196050 in amended form.

Composition of the Board:

Chairman: P. Kitzmantel
Members: J. Jardón Álvarez
M-B. Tardo-Dino

Summary of Facts and Submissions

I. The grant of European patent No. 1 196 050 in respect of European patent application No. 00947469.3 in the name of THE PROCTER & GAMBLE COMPANY which had been filed on 14 July 2000 as International application PCT/US00/19469 (WO 01/05253) was announced on 23 April 2003 (Bulletin 2003/17) on the basis of 10 claims. Claim 1 read as follows:

"1. A beverage composition **characterized by:**

- (a) from 0.1% to 15% of one or more monosaccharides, by weight of the composition;
- (b) from 0.1% to 15% of one or more disaccharides, by weight of the composition;
- (c) from 0.1% to 15% of one or more complex carbohydrates, by weight of the composition;
- (d) a component selected from the group consisting of bracers, flavanols, and mixtures thereof; and
- (e) more than about 60% water."

Claims 2 to 8 were dependent claims. Independent Claims 9 and 10 were directed to beverage concentrates and dry compositions comprising a mixture of carbohydrates and bracers and/or flavanols.

II. A Notice of Opposition was filed against the patent by Unilever PLC on 21 January 2004. The Opponent requested the revocation of the patent in its entirety based on Article 100(a) EPC (lack of novelty and inventive step).

The opposition was supported, *inter alia*, by the following documents:

D1: US - 5 114 723 and

D9: US - 5 571 441

III. By its interlocutory decision announced orally on 9 November 2005 and issued in writing on 30 November 2005, the Opposition Division held that the grounds for opposition raised by the Opponent did not prejudice the maintenance of the patent in amended form.

This decision was based on an amended set of claims filed by the Patent Proprietor with letter dated 8 September 2005. Claim 1 read as follows:

"1. A beverage composition characterized by:

- (a) from 0.1% to 15% of one or more monosaccharides, by weight of the composition;
- (b) from 0.1% to 15% of one or more disaccharides, by weight of the composition;
- (c) from 0.1% to 15% of maltodextrin, by weight of the composition;
- (d) a component selected from the group consisting of bracers, flavanols, and mixtures thereof; and
- (e) more than about 60% water; and

wherein the ratio of the monosaccharide to maltodextrin is from 1:5 to 10:1, by weight of the composition."

The Opposition Division in its decision acknowledged the novelty of the claimed subject-matter over document D1 because this document did not disclose the combination of all the technical features of independent Claims 1, 8 and 9. On the contrary, in

order to obtain a beverage composition comprising the specified carbohydrate system and a bracer, the skilled person would have to carry out at least two selections: first, select example 1 from the various embodiments disclosed in D1 and, second, decide to add caffeine as a further ingredient.

Concerning inventive step, the Opposition Division starting from D1 as the closest prior art document saw the problem to be solved by the invention as being to develop an improved formulation for supplying and maintaining energy to a user which provides a delayed glycaemic response. In its opinion this problem was effectively solved in a non-obvious manner by the inclusion of a bracer and/or of a flavanol to the compositions of Example 1 of D1. Neither D1 alone, nor its combination with D9, offered any clue towards this solution of that problem, which was unrelated to the well-known use of caffeine for the improvement of mental alertness.

- IV. On 26 January 2006 the Opponent (Appellant) lodged an appeal against the decision of the Opposition Division and paid the appeal fee on the same day.

In the Statement of Grounds of Appeal filed on 23 February 2006, the Appellant requested the revocation of the patent in its entirety on the grounds of lack of novelty and inventive step.

- V. With its reply dated 18 August 2006 the Patent Proprietor (Respondent) requested that the appeal be dismissed. It also filed a set of claims for an auxiliary request, Claim 1 reading as follows:

"1. A beverage composition characterized by:

- (a) from 1% to 10% of one or more monosaccharides, by weight of the composition;
- (b) from 1% to 15% of one or more disaccharides, by weight of the composition;
- (c) from 1% to 10% of maltodextrin, by weight of the composition;
- (d) a component selected from the group consisting of bracers, flavanols, and mixtures thereof; and
- (e) more than about 80% water; and

wherein the ratio of the monosaccharide to maltodextrin is from 1:5 to 10:1, by weight of the composition."

VI. On 20 December 2007 the Board dispatched a summons to attend oral proceedings on 29 May 2008. In the attached annex the Board drew the attention of the parties to the points to be discussed during the oral proceedings.

VII. By letter dated 18 April 2008, the Appellant submitted the following further prior art documents:

E1: EP - A - 0 259 167

E2: Y. Shahkhalili *et al.* "Effects of Foods Rich in Polyphenols on Nitrogen Excretion in Rats", *J. Nutr.* 120(4), 346 - 352 (1990)

E3: D. Makris *et al.* "Carob Pods (*Ceratonia siliqua L.*) as a Source of Polyphenolic Antioxidants", *Food Technol. Biotechnol.* 42(2), 105 - 108 (2004)
and

E4: S. Ito *et al.* "Presence of Several Phenolic Components in Fruit Proanthocyanidins" *Nature*, 204, 475 - 476 (1964).

VIII. The arguments presented by the Appellant in its written submissions and at the oral proceedings may be summarized as follows:

- The Appellant contested in its Statement setting out the Grounds of Appeal the decision of the Opposition Division. The Appellant denied the novelty of Claim 1 having regard to the disclosure of D1 and argued further that the subject-matter of all the claims lacked inventive step in view of D1 alone or in combination with D9.

- The Appellant argued that the filing of documents E1 to E4 at a late stage of the proceedings was due to the auxiliary request filed for the first time by the Respondent during the appeal proceedings. The narrowing of the carbohydrate mixture in accordance with this request required a further search concerning the amended subject-matter. During this search, document E1 was found and it turned out to be novelty destroying for the subject-matter of Claim 1 of the main request. It regretted the late filing of these documents but insisted that they had been submitted immediately after they had been discovered by this further search, which had been triggered by the Respondent's newly filed auxiliary request.

- The Appellant requested the admittance of E1, as well as the ancillary documents E2, E3 and E4, into the proceedings because of their relevance.

- The Appellant alleged that Examples 1 and 4 of E1 were novelty destroying for the subject-matter of Claims 1, 2, 4, 5 and 6 of the main request. In its opinion the beverages disclosed in these examples included all the features of Claim 1 of the main request. It pointed out that the Carob Powder and Hershey's cocoa used therein contained the bracers and flavanols required by Claim 1 of the patent, as shown by E2 - E4. The fact that these substances were not present in isolated form but as intrinsic components of the above ingredients could not establish novelty, especially when considering that the patent itself referred on page 7, line 41 to the use of cocoa as a source of caffeine. Finally, it pointed out that the fact that said compounds were added in E1 as flavouring agents was irrelevant, as Claim 1 of the main request was directed to a composition *per se* and not limited to any use.

IX. The Respondent essentially argued as follows:

- It agreed with the finding and the reasoning of the decision of the Opposition Division concerning the non-anticipatory character of D1. Moreover, in its view the claimed subject-matter also involved an inventive step over D1 and D9 because these documents would not suggest the claimed solution of the existing technical problem, which was the provision of a composition able to maintain a

desirable blood glucose level for an extended period of time after consumption in order to provide energy and mental alertness. The solution to this problem as recited in Claim 1 was not suggested by D1 and/or D9, essentially because these documents addressed different problems.

- The Respondent, conceding that there had been no abuse of procedure, requested nevertheless that documents E1 to E4 should not be admitted into the proceedings as they had been filed four years after the expiry of the opposition period and two years after the filing of the appeal. Document E1, being a patent document, could and should have been found within the time limits set by the EPC.

- The admittance of E1 was moreover not justified by its particular relevance. Indeed, E1 related to a different technical field and aimed to solve a different problem, namely it was directed to sport drinks for athletes under stress conditions. While the Respondent admitted that the carbohydrate system of the drinks of E1 was embraced by the claims of the patent in suit it argued that the flavouring agents therein used (Carob Powder and Hershey's cocoa) could not be considered a direct and unambiguous disclosure of the bracers and flavanols required by Claim 1 of the patent because the latter were extracted from the natural source and/or synthetically prepared; it was doubtful whether these compounds when still contained in the raw materials as according to E1 would be bioavailable under the conditions of use. This doubt was supported by documents E2 - E4,

according to which the bracers and flavanols were also extracted from the natural source.

- The Respondent further requested that if the documents E1 - E4 were admitted into the proceedings, the case be remitted to the Opposition Division in order to clarify if the flavouring agents as used in E1 would have the same bioavailability as the bracers/flavanols of Claim 1. It also pointed out that it had been difficult for the representative to communicate with the Patentee in order to clarify this point and no appropriate defence could therefore be prepared until now in response to the newly filed documents.
 - Finally the Respondent requested a different apportionment of costs. The filing of E1 to E4 necessitated more time for preparing the oral proceedings and would require further oral proceedings after remittal.
- X. The Appellant requested that the decision under appeal be set aside and that the European patent No. 1 196 050 be revoked.

The Respondent requested that the appeal be dismissed or, auxiliarily, that documents E1 to E4 be not admitted. It further requested, in case that documents E1 to E4 were admitted, that the case be remitted to the Opposition Division; furthermore it requested a different apportionment of costs.

Reasons for the Decision

1. The appeal is admissible.
2. *Documents not submitted in due time (Article 114 EPC).*
 - 2.1 Document E1 (and the ancillary documents E2 - E4) were submitted after the nine-month period allowed for opposition pursuant to Article 99(1) EPC and to this extent must be regarded as not submitted in due time under Article 114(2) EPC. The Board accepts, and this was not questioned by the Respondent, that there was no abuse of procedure by the Appellant in the sense that it withheld these documents intentionally, as a procedural tactic.
 - 2.2 According to Article 13 of the Rules of Procedure of the Boards of Appeal (OJ EPO 2007, pages 536 - 546); any amendment to a party's case shall be considered and admitted at the Board's discretion. The application by the Board of the criteria enumerated therein is intended to avoid any delay in the course of the appeal proceedings, particularly with regard to amendments sought to be made after oral proceedings have been arranged. In the same way, Rule 116 EPC (Rule 71a EPC 1973) provides that new facts and evidence presented after the date for oral proceedings has been fixed need not to be considered unless admitted on the grounds that the subject of the proceedings has changed. The application of these procedural principles, including the admittance of late filed documents, is left to the discretionary power of the organs of the EPC (see Article 114(2)EPC). According to established jurisprudence, a late filed document should only be

exceptionally admitted if it is *prima facie* highly relevant in the sense that it can be expected to change the outcome of the decision and is highly likely to prejudice the maintenance of the patent (see e.g. T 1002/92, OJ EPO 1995, 605, Reasons, point 3.4).

2.3 Admissibility of E1 - E4.

2.3.1 E1 discloses sport drinks for athletes comprising amino acids, nutrient factors, carbohydrates, electrolytes and flavouring aids (see abstract). Example 1 describes the preparation of a dry nutrient blend containing, *inter alia*, 100 grams of sucrose, 20 grams of fructose, 100 grams of Lodex 10 DE (maltodextrin) and 10 grams of glucose as carbohydrates and also including 90 grams of Carob Powder as flavouring aid. This blend is brought up to two litres final volume with water to form a beverage composition. Example 4 of E1 discloses a similar drink but using Hershey's Cocoa as flavouring aid. It is thus immediately apparent that the disclosure of E1 is very pertinent for the assessment of the novelty of Claim 1 of the main request.

Moreover E1 discloses on page 10, lines 41 - 50 that it is preferable to use a mixture of carbohydrates to provide a sustained energy source and a more stable blood glucose level and is therefore also relevant for inventive step.

Documents E2 - E4 were cited by the Appellant in support of its novelty objection merely to show that Carob Powder and Hershey's cocoa contain both bracers and flavanols.

- 2.3.2 The Respondent admitted during the oral proceedings that the carbohydrate system used in the examples of E1 fulfils the requirements of Claim 1 of the main request but argued that the claimed subject-matter was novel because the bracers and flavanols used according to the claim concerned substances extracted from the corresponding botanical sources. It alleged that the Carob Powder and Hershey's Cocoa used in E1 contained the bracers and flavanols in a non-bioavailable form and stated that it required more time to refute the Appellant's contrary allegation.
- 2.3.3 The Board refrains from commenting on this issue, since this might risk prejudicing the first instance consideration which is ordered below.
- 2.3.4 Nevertheless, for the reasons given above, E1 comes closer, in the Board's judgment, to the subject-matter of the present claims than documents D1 and D9 referred to in the decision under appeal and is therefore *prima facie* sufficiently relevant to consider its admittance into the proceedings despite its late filing. Since, in the Board's view, the relevance of E1 is such that it might even lead to revocation of the patent in suit, it is admitted into the proceedings. Documents E2 and E4, which contain information supplementary to the disclosure of E1, are also admitted into the proceedings.
- 2.4 Document E3 is not admitted into the proceedings as it was published in 2004, after the filing date of the patent in suit.

3. *Remittal (Article 111(1) EPC)*

3.1 After admitting documents E1, E2 and E4 into the proceedings, the Board has to consider its discretion under Article 111(1) EPC to remit the case to the Opposition Division for further prosecution, as requested by the Respondent.

3.2 It is established jurisprudence of the Boards of Appeal that any necessary fresh assessment of a case should normally be carried out at the first level (cf. T 326/87, OJ EPO 1992, 522, point 2.2). This is especially so when, as in the present case, having regard to the high degree of relevance of the late-filed documents, the maintenance of the patent in suit would be at risk. In such a situation, further examination should be undertaken by the Opposition Division so as to afford the parties two levels of jurisdiction, all the more so when, as in the present case, the Respondent has expressly asked for this and the Appellant has not objected to such remittal.

3.3 Accordingly, the Board decides that it is appropriate to remit the case to the Opposition Division for further consideration.

4. *Apportionments of costs Article 104(1).*

4.1 Preliminary remarks

4.1.1 According to Article 1 (2) of the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the EPC of 29 November 2000, Article 104 EPC

shall apply to European Patents already granted at the time of their entry into force and to European Patents granted in respect of applications pending at that time. This is an application of the general principle of the immediate application of a new law.

- 4.1.2 The Board adds that Article 104 EPC belongs to procedural provisions in the sense that it does not regulate any substantive issue about a patent application or a granted patent, but only issues raised during opposition or appeal proceedings, related to them. It is a general principle of law that a new procedural law is immediately applicable but has no retrospective effect unless otherwise provided.

In other words, when deciding whether the new Article 104 EPC is applicable in appeal proceedings initiated under EPC 1973, the Board must take into consideration not only the fact that, according to the transitional provisions, the new Article 104 EPC is applicable to granted patents, but also the date of the event which gives rise to the application of this article. This is the only way to give the new procedural provision an immediate application without giving it a retrospective effect.

- 4.2 In the present case, the late filing of the document on which the request for apportionment of costs is based occurred after 13 December 2007. Consequently, according to the general principle that the procedural law is immediately applicable, the new article and its implementing Rule 88 EPC are applicable.

- 4.3 The Respondent requested apportionment of costs under Article 104(1) EPC, arguing that the late filing of documents E1 - E4 resulted in a longer preparation of the case for the oral proceedings and that the further prosecution of the case will generate extra costs.
- 4.4 Article 104(1) EPC stipulates that each party to the proceedings shall meet the costs he has incurred. A departure from this principle requires special circumstances.
- 4.5 In the Board's judgment, in the present case the study of documents E1 - E4 by the Respondent falls within the usual preparation of a case before oral proceedings. Document E1 is a patent citation and the Appellant has cited the parts of the document which it considered relevant for the claimed subject-matter. Documents E2 - E4 are ancillary documents in support of the novelty objection based on E1. No such difficulty arises as would necessitate an unusually long time for their study. Thus, the costs incurred by the Respondent did not go beyond the costs normally incurred by a Patentee defending its patent.

As regards future costs, they have not yet been incurred and the Board cannot foresee whether or to what extent additional costs directly referable to the late filed document will arise (see for instance T 758/99 of 25 January 2001 not published in the OJ EPO).

- 4.6 For these reasons, the Respondent's request for an apportionment of costs under the provisions of Article 104 EPC is refused.

Order

For these reasons it is decided that:

- The decision under appeal is set aside.
- The case is remitted to the Opposition Division for further prosecution.
- The request for a different apportionment of costs is refused.

The Registrar

The Chairman

G. Röhn

P. Kitzmantel