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**Datasheet for the decision
of 13 January 2009**

Case Number: T 1374/07 - 3.3.02

Application Number: 99904634.5

Publication Number: 1056345

IPC: A21D 10/00

Language of the proceedings: EN

Title of invention:

Granulated bread improver for the preparation of bakery products

Patentee:

PURATOS N.V.

Opponent:

Cognis GmbH
Lesaffre International
CSM Nederland B.V.

Headword:

Bread improver/PURATOS N.V.

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"Added matter - yes: A selection of two components from one list is in fact equivalent to a twofold selection from two identical lists

Decisions cited:

T 0007/86, T 0201/83, T 0811/96

Catchword:

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Case Number: T 1374/07 - 3.3.02

DECISION
of the Technical Board of Appeal 3.3.02
of 13 January 2009

Appellant: PURATOS N.V.
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Decision under appeal: Decision of the Opposition Division of the European Patent Office posted 1 June 2007 revoking European patent No. 1056345 pursuant to Article 102(1) EPC.

Composition of the Board:

Chairman: U. Oswald
Members: J. Riolo
J. Van Moer

Summary of Facts and Submissions

- I. European patent No. 1 056 345, based on European application No. 99 904 634.5, was granted on the basis of 12 claims.

Independent claim 1 as granted read as follows:

"1. Bread improver in the form of a powder, characterised in that it is made of agglomerated particles having a mean particle size of at least 250 µm, said particles being made of at least fat and enzymes."

- II. Oppositions were filed by respondents 1, 2 and 3 against the patent under Article 100(a) EPC for lack of novelty and inventive step, Article 100(b) EPC for insufficiency of disclosure and under Article 100(c) EPC.
- III. By decision pronounced on 23 April 2007, the Opposition Division revoked the patent under Article 102(1) EPC because the claims as granted contravened the requirements of Article 123(2) EPC.

The Opposition Division held that there was no direct and non-ambiguous disclosure in the application as originally filed for the feature "made of at least fat and enzymes", which was added in claim 1 during the examination procedure.

- IV. The appellant (patentee) lodged an appeal against the said decision.

- V. In its communication faxed on 8 January 2009, the Board informed the parties of its intention to dismiss the appeal on the basis of the written submissions on file.
- VI. Oral proceedings were held on 13 January 2009. None of the parties attended.
- VII. In its written submissions, the appellant mainly submitted that the case law relating to a selection from two lists, referred to by the Opposition Division in its decision, was not applicable in the present case because it related to the assessment of novelty and not to inadmissible broadening.

It also argued that the selection of two members was made within not two lists but only a single list.

Finally, it pointed out that, according to decision T 7/86 (OJ 1988, 381), the two lists forming the basis of a selection had to have "a certain length" to be applicable.

- VIII. The respondents essentially supported the Opposition Division's arguments and conclusions in writing.
- IX. The appellant requested in writing that the decision under appeal be set aside.

The respondents requested in writing that the appeal be dismissed.

Reasons for the decision

1. The appeal is admissible.
2. Article 123(2) EPC

The Board agrees with the Opposition Division's negative conclusions and argumentation regarding Article 123(2) EPC with respect to the feature "made of at least fat and enzymes" of claim 1 of the set of claims as granted.

- 2.1 In fact, fat and enzymes are mentioned in two places in the description as originally filed:

- On page 1, 1.30 to page 2, 1.1, concerning the background of the invention it is indicated that "it is obvious that the skilled person knows that bread improvers may contain emulsifiers and fats, enzymes, sugars, organic acids, minerals, polysaccharides and proteins."
- Under the general description of the invention on page 5, lines 10-18, it is also stated that "the particles are made of at least 2 different active ingredients" and that "the improver according to the invention can further comprise one or more ingredients selected from the group consisting of emulsifiers, fat, enzymes, sugar, organic acids, minerals, polysaccharides, proteins and/or a mixture thereof."

From these two passages, it appears that the original application neither disclosed nor suggested that the

bread improver must advantageously be made of "at least fat and enzymes".

In that respect, the expression "and/or a mixture thereof" at the end of the list cannot be seen as a basis for the combination of "at least fat and enzymes", because this expression covers not only the combination of two ingredients (28 combinations of two ingredients possible) but also the combinations of three ingredients, the combinations of four ingredients, etc....

Thus, when starting from the description of the application as originally filed, the skilled person has to choose among a huge number of possible combinations and there is no teaching in the application as filed that would lead him to choose specifically a combination of two ingredients or would indicate that these two ingredients are "fat and enzymes". As a consequence, this feature adds matter vis-à-vis the description as originally filed.

The same conclusion applies when starting from the disclosure as originally filed in the claims.

Indeed, starting from claim 4 as filed, the skilled person would consider that the two active ingredients of the bread improver are fat and proteins.

According to claim 5 as filed, the bread improver can contain additional ingredients, among them enzymes.

Thus, enzymes appear to be an optional ingredient and fat and proteins essential ingredients (claim 4: "at least fat and proteins").

But, on the contrary, in claim 1 as granted, proteins disappeared as essential ingredients and were replaced by enzymes, although there is no direct and unambiguous disclosure in the application as originally filed of a bread improver made of at least fat and enzymes, without the obligatory presence of proteins.

This also constitutes an infringement of Article 123(2) EPC.

- 2.2 The Board does not agree with the appellant's main lines of argument that the well-established case law - that a selection from two lists of a certain length is novel - is not applicable for several reasons.

In that respect, the appellant firstly stated "That case law relates to the assessment of novelty and does not relate to the question of inadmissible broadening".

The Board notes however that this statement is irrelevant, as the introduction of the feature "said particles being made of at least fat and enzymes" in claims 1 and 7 represents not a broadening but a limitation of the claimed subject-matter.

Moreover, there is clear case law stating that the so-called "novelty test" can be applied when determining whether an amendment is originally disclosed or not, at least where the amendment is by way of addition (see e.g. T 201/83, OJ 1984, 481, point 3).

Secondly, the appellant argued that there was only one list and not two lists as required by several decisions and that a preferred selection of two members from one list had nothing to do with the selection of two members out of two lists.

This statement is however not correct since a selection of two components from one list is in fact equivalent to a twofold selection from two identical lists (see e.g. T 811/96, point 1.6, last paragraph). Therefore this argument cannot be followed.

Finally, referring to T 7/86, the appellant asserted that this decision had ruled that the selection had to be from a "huge number" of options in order to contravene Art. 123(2) EPC.

In fact, the two lists considered in T 7/86 were respectively Met, Et, Pr, Bu, lower alkyl on the one hand and H, lower alkyl on the other. This situation is very much comparable with the present one, which amounts to a twofold selection from two identical lists of 8 members. Again, the appellant's argument cannot succeed.

3. In the light of these facts, the Board can only conclude that the subject-matter of claim 1 contravenes the requirements of Article 123(2) EPC.

Under these circumstances, there is no need to consider the remaining claims.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

N. Maslin

U. Oswald