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Datasheet for the decision of 24 March 2011

Case Number: T 1086/08 - 3.3.09

Application Number: 99830487.7

Publication Number: 1072195

IPC: A23G 3/00

Language of the proceedings: EN

Title of invention:
Process for shaping food products

Patentee:
SOREMARTEC S.A., et al

Opponent:
NESTEC S.A.

Headword:
-

Relevant legal provisions:
EPC Art. 123(2), 56

Relevant legal provisions (EPC 1973):
-

Keyword:
"Amendments - added subject-matter (no)"
"Inventive step (yes)"

Decisions cited:
T 0710/97

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 1086/08 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 24 March 2011

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Decision under appeal:
Interlocutory decision of the Opposition Division of the European Patent Office posted 27 March 2008 concerning maintenance of European patent No. 1072195 in amended form.

Composition of the Board:

Chairman: W. Sieber
Members: M.O. Müller
K. Garnett

Summary of Facts and Submissions

I. This is an appeal by the opponent against the decision of the opposition division that the European patent No. 1 072 195 as amended met the requirements of the EPC.

II. The opponent had requested revocation of the patent in its entirety on the grounds that the claimed subject-matter was neither novel nor inventive (Article 100(a) EPC).

The documents cited during opposition proceedings included:

D1: N. Almond et al., "BISCUITS, COOOKIES AND CRACKERS", volume 3, Elsevier Applied Science, London and New York, 1991, pages 186-189 and 200-203;

D2: WO 95/35037 A1;

D6: GB 416,970 A; and

D7: WO 95/32633 A1.

III. The opposition division's decision was announced orally on 6 March 2008 and issued in writing on 27 March 2008. The main request, on which this decision was based, contained independent claims 1 and 6, of which claim 1 reads as follows:

"1. A process for the manufacture of a moulded half shell of an edible substance, comprising the steps of:

- providing a mould defining a mould cavity (1),
- introducing a certain quantity of an edible moulding material (3) in a fluid state into said cavity (1), said moulding material being susceptible of solidifying on cooling or on drying,
- introducing into said mould cavity (1) a plug (4), the outer surface of which defines within the surface of said cavity a space to be filled by said material (3), whereby the moulding material (3) is caused to be distributed in its fluid state throughout the space to form said half shell, characterised in that a hollow plug (4) of edible material having a low thermal conductivity consisting of wafer or meringue is used as the plug and in that said hollow plug (4) of edible material is left in the moulding cavity as an integral part of the moulded half shell."

Claim 6 refers to a process for the manufacture of a food product in which a moulded half-shell is produced in the same way as in claim 1, which moulded half-shell is then "coupled to a similar shell in a mouth to mouth relationship to form said food product".

IV. In its decision, the opposition division inter alia reasoned as follows:

The main request met the requirements of Article 123(2) EPC since a hollow plug of meringue was disclosed in claim 8 in conjunction with claim 6 as filed. The indication of meringue as a solid body was given in the description only as an example and there was no

indication that meringue would not be suitable for constituting the hollow plug.

Concerning inventive step, the subject-matter of claim 1 differed from D1 in that the plug inserted in the mould cavity was hollow. The objective technical problem could be seen in the provision of a moulded food product which was suitable to be filled by any other product. There was no suggestion in Dl which would lead the skilled person to modify the process disclosed therein such as to obtain a process as defined in claim 1. Among the prior art brought forward by the opponent, the sole disclosure of a hollow wafer plug covered with chocolate was to be found in D6. This document however did not relate to a moulded product, but rather to the different technique of applying a chocolate coating to the wafer. Thus the claimed subject-matter was inventive.

V. On 23 May 2008, the appellant (opponent) filed a notice of appeal against the above decision and paid the prescribed fee on the same day. A statement setting out the grounds of appeal was filed on 6 August 2008.

VI. With letter of 16 December 2008, the joint proprietors (respondent) filed a response to the appeal together with a main request, which corresponds to the main request found allowable by the opposition division, and auxiliary requests 1 to 6, as well as:

D1bis: N. Almond et al., "BISCUITS, COOOKIES AND CRACKERS", volume 3, Elsevier Applied Science, London and New York, 1991, pages 190-193; and

D9: Webster's Third New International Dictionary of the English Language, P. Babcock Gove (ed.), 1993, page 1414.

VII. The annex to the summons for oral proceedings included the board's preliminary comments on inventive step. With regard to D2, it was noted that this document provided a product wherein the hollow space was located within the chocolate shell of the food product but not in the plug.

VIII. On 24 March 2011, oral proceedings were held before the board. No new requests were filed by the parties. During the oral proceedings, the objection presented in the written proceedings against paragraph [0042] of the opposed patent was withdrawn by the appellant. This was a clarity objection concerning a passage that was already present in the granted patent.

IX. The appellant's arguments can be summarized as follows:

Claims 1 and 6 of the main request did not meet the requirements of Article 123(2) EPC as there was no basis in the application as filed for a combination of the features whereby the plug was hollow and also consisted of wafer or meringue. Claims 6 and 8 as filed could not provide a basis for a hollow plug of wafer or meringue. Furthermore, the skilled person reading the opposed patent as a whole would not have combined the feature of a hollow plug with a plug made of meringue as, firstly, the description as filed disclosed meringue only in the context of a solid plug and, secondly, it was known that meringue was unsuitable to

form a hollow plug since it was a brittle and friable material.

With regard to inventive step, D1 and not D7 formed the closest prior art as D1 required the least amount of modification to arrive at the claimed process, which differed from D1 only in that a hollow plug instead of a solid one was used. The objective technical problem was the modification of the plug of D1 in such a way that it could be filled. The solution to this problem was obvious as it was common general knowledge that there existed only one way of modifying the product of D1 in order to arrive at a moulded product that could be filled, namely making the wafer plug used in D1 hollow. Moreover, the solution was also known from D6, where a hollow wafer was coated with chocolate. The skilled person would have transferred this technique to the process of D1 as in both the process of D6 and the process of D1 exactly the same movement was carried out, namely that of dipping the wafer into a hot chocolate bath. The claimed subject-matter thus lacked inventive step in view of D1 alone as well as D1 in combination with D6. Irrespective of this, inventive step would have to be denied also when starting from D7 as closest prior art. In this case, the difference would be the use of an edible plug of wafer or meringue instead of the cooling member of D7 and this use was already known from D1 or D6.

X. The respondent's position can be summarized as follows:

Claims 1 and 6 of the main request were based on claims 6 and 8 as filed. Moreover, the description as filed did not imply that the meringue material could be

used only when the plug was a solid body. Finally, Webster's Dictionary (D9) in the context of the term "meringue" specifically referred to "a shell" made of meringue which was filled, and thereby confirmed that meringue could be a suitable material for a hollow plug.

With regard to inventive step, D7 had to be considered to represent the closest prior art since this document, in the same way as the opposed patent, aimed at providing a hollow moulded half-shell. The claimed subject-matter differed from D7 in that a hollow plug of wafer or meringue was used instead of the cooling member of D7. This led to the various advantages referred to in the opposed patent. The achievement of these advantages thus represented the objective technical problem. The skilled person confronted with this problem would not have been induced by the prior art to modify the process of D7 such as to arrive at the claimed process. Consequently, the claimed subject-matter was inventive in view of D7 as closest prior art document.

Moreover, even if D1 were taken as the closest prior art, inventive step would still have to be acknowledged. In view of D1, the objective technical problem consisted in the provision of a moulded food product which could be filled and the shell of which was crack-free. The skilled person confronted with this problem would not have considered the coating process of D6 as this had nothing to do with shell moulding, but would rather have taken the shell moulding process of chapter 6.10.1.2. of D1 into account. The latter process was however different from the claimed one in

that no hollow plug was applied, which meant that the claimed process was inventive.

XI. The appellant (opponent) requested that the decision under appeal be set aside and that the European patent No. 1 072 195 be revoked.

XII. The respondent (patent proprietors) requested that the appeal be dismissed, alternatively that the decision under appeal be set aside and the patent be maintained on the basis of auxiliary requests 1 to 6 filed with letter dated 16 December 2008.

Reasons for the Decision

1. The appeal is admissible.

Main request

2. *Amendments - Article 123(2) EPC*

2.1 Claims 1 and 6 of the main request correspond to claims 1 and 8 as granted except that the plug consisting of wafer or meringue has been defined as a hollow plug. The appellant contested that a hollow plug consisting of wafer or meringue was clearly and unambiguously derivable from the application as filed.

2.2 The application as filed contains claims 6 and 8 which read as follows:

"6. A process according to any of the preceding Claims, characterised in that the said plug (4) is a hollow plug."

"8. A process according to any of the preceding Claims, characterised in that the said plug (4) is constituted by wafer or meringue."

Claim 8 as filed hence discloses the feature of a plug consisting of wafer or meringue. Claim 6 as filed discloses the feature that the plug is hollow. The reference in claim 8 to "any of the preceding claims" creates a clear and unambiguous disclosure for the combination of the two features. Therefore, a hollow plug consisting of wafer or meringue is clearly and unambiguously derivable from claims 6 and 8 of the application as filed. Consequently, the appellant's argument that these claims do not form a proper basis for the amendment cannot be followed.

2.3 The appellant made the further submission that the skilled person reading the application as filed as a whole would not have combined meringue disclosed in claim 8 as filed with the hollow plug of claim 6 as filed, because the only material disclosed in the description as filed for a hollow plug was wafer while meringue was disclosed in the description as filed only in combination with a solid plug.

The board concedes that the only material disclosed in the description as filed for a hollow plug is a wafer

material. It is furthermore true that the only disclosure of meringue in the description as filed can be found on page 10, lines 1-8 and that in this passage, meringue is disclosed as a solid plug ("For example, instead of being a hollow shell, or a cap, the plug 4 could be constituted by a solid body: it could be, for example, a half-egg shape (with a view to the generally ovoid shape referred to here by way of example) of meringue ..."). However, nowhere in the description can any indication be found that the hollow plug must be made of a wafer material and could not be made of meringue as well. In particular, the wafer material that is disclosed for a hollow plug is exclusively presented as an example or preferred embodiment, but not as the sole embodiment for a hollow plug. Reference can be made in this context to the last sentence of the penultimate paragraph on page 8 where it is stated that the "preferred choice at the moment is a wafer material" and to the first sentence of the second paragraph on page 9 where "a hollow plug 4 constituted, for example, by a wafer cap" is mentioned.

Consequently, there is no reason to ignore the clear and unambiguous disclosure of a hollow plug of meringue in original claims 6 and 8 when reading the application as filed as a whole.

2.4 Finally, the appellant argued that the skilled person would not combine meringue as disclosed in claim 8 as filed with the hollow plug of claim 6 as filed because the application as filed did not provide an enabling disclosure for this combination. More particularly, according to the appellant, meringue was a brittle and

friable material and thus unsuitable to form a hollow plug.

However, this allegation is not substantiated by any evidence. Moreover, Webster's Dictionary (D9) in the context of the term "meringue" specifically refers to "a shell made of meringue and filled with fruit or ice cream". This confirms that contrary to the appellant's allegation, meringue is in fact a suitable material for a hollow plug. The appellant's argument thus is not convincing.

2.5 For the above reasons, the application as filed in the form of claims 6 and 8 creates a proper basis for the feature of a hollow plug consisting of wafer or meringue in claims 1 and 6 of the main request.

2.6 The further claims 2-5 and 7 of the main request correspond to claims 2, 5, 6, 7 and 9 as granted with claim 5 of the main request having been adapted to amended claim 1.

2.7 The amendments effected in the claims of the main request during opposition proceedings therefore meet the requirements of Article 123(2) EPC.

3. *Amendments - Articles 84 and 123(3) EPC*

The appellant did not raise any objections under Articles 84 or 123(3) EPC and the board is satisfied that the amendments do not lead to any lack of clarity or any extension of the protection conferred by the opposed patent and thus that the requirements of Articles 84 and 123(3) EPC are met.

4. *Novelty*

The appellant did not raise any objections under Article 54 EPC and the board is satisfied that the subject-matter of the main request is novel over the cited prior art.

5. *Inventive step*

5.1 The opposed patent relates to a process for the manufacture of a moulded half shell and a food product, respectively (paragraph [0001]). The food product is produced by joining two moulded half shells together thereby defining a hollow space, which can contain a quantity of filling (paragraphs [0024] and [0048] as well as figures 4 and 5).

5.2 It was a matter of dispute between the parties whether D7 or the "standard moulding process" of chapter 6.10.1.1. of D1 forms the closest prior art.

5.2.1 The closest prior art for assessing inventive step is normally the prior art document disclosing subject-matter conceived for the same purpose and aiming at the same objective as the claimed invention.

5.2.2 D7 refers to a method for the production of shells of fat-containing, chocolate-like masses as well as food articles having shells produced thereby (title). In this process, a mould cavity is filled with a chocolate mass, and a cooling member (ie a plug) having a temperature below 0°C is subsequently immersed in the mass to define a predetermined shell volume between the

member and the mould cavity (page 1, lines 5-12 and claim 1). After removal of the cooling member, the resulting hollow shell is joined together with a second shell to a hollow body (page 4, lines 11-12). Before joining the shells, they are frequently provided with a centre mass of a food material which differs from that from which the actual shell is made (page 5, lines 1-7).

Hence, in the same way as the opposed patent, D7 is directed to the production of shells and food products, the latter being obtained by joining two shells thereby defining a hollow space, which can contain a quantity of a food material as filling.

5.2.3 Chapter 6.10.1.1 of D1 discloses a "standard moulding process" to prepare a moulded biscuit product. The process comprises the steps of pouring liquid chocolate into a mould, subsequently placing a solid centre biscuit in the mould and pressing down the biscuit thereby forcing the chocolate evenly up between the sides of the mould and the biscuit and finally "backing off" the product with a further deposit of chocolate thereby filling in all the remaining space in the top of the mould, over and around the biscuit.

Unlike the opposed patent, the standard moulding process of chapter 6.10.1.1. of D1 does not aim at the production of half shells that can be joined together to a final product. Moreover, contrary to the opposed patent, D1 is not concerned with the preparation of hollow food products that can be filled. More particularly, the product of D1 contains no hollow space but consists of a solid, ie non-hollow, biscuit

and chocolate such that no empty space remains in the product.

In the board's view, it is thus evident that in terms of the purpose achieved by the process of D7 and that of chapter 6.10.1.1. of D1, D7 is much closer to the opposed patent.

5.2.4 The appellant in this context argued that the standard moulding process of chapter 6.10.1.1. of D1 constituted the closest prior art as, when starting with this process, the fewest modifications would be needed to arrive at the claimed process. However, it is the purpose or effect aimed at by a claimed invention, and not the number of modifications needed, that is decisive for the selection of the closest prior art (see, eg, T 710/97 of 25 October 2000; point 3.2.1; not published in OJ EPO). The appellant's argument therefore must fail.

5.2.5 For the above reasons, D7 forms the closest prior art.

5.3 As set out in the opposed patent, the process of D7 has various disadvantages (paragraphs [0002] and [0007] to [0012]). Firstly, the structure of the cooling member in D7 is rather complex. Secondly, the shape of the cooling member of D7 must complement the internal shape of the product being formed, such that when production is changed to a different product geometry, the machine must be fitted with a differently shaped cooling member. Thirdly, in order to provide for the hollow space of the shell in D7, the plug must be removed from the shell. This is only possible when the shell material has at least become partially solid which means that

the process time in D7 is rather long. Fourthly, due to the fact that the cooling member is cooled, water condenses on the surface of the cooling member and creates a source of contamination for the product.

5.4 As a solution to the above problems, the opposed patent proposes a process according to claim 1 which is characterised by using a hollow edible plug consisting of wafer or meringue wherein this plug is left as an integral part in the finished food product. This is different from D7 where the plug consists of a cooling member and is removed from the shell.

5.5 By using a hollow edible plug consisting of wafer or meringue and leaving this plug as an integral part in the finished food product, the above disadvantages mentioned in the opposed patent with regard to the process of D7 are avoided. More particularly, due to the fact that the hollow plug of wafer or meringue as used in the claimed process does not contain any cooling means, its structure is much simpler and more easily adaptable to differently shaped product geometries. Furthermore, as the plug stays in the final product, there is no need to wait until the shell has at least partly solidified and thus the process time is shorter. Finally, it is self evident that no condensation of water occurs in the claimed process and hence the contamination of the final product is avoided.

The problem addressed in the opposed patent thus is credibly solved by the process according to claim 1. This problem therefore constitutes the objective technical problem. It can be summarised as the provision of a process for the manufacture of a moulded

half shell wherein the process time is shortened, the equipment needed is less complex and more easily adaptable to changing product geometries, and any product contamination is avoided.

5.6 D7 neither discloses nor suggests a process wherein a hollow edible plug is used that stays as an integral part in the final product.

Moreover, none of the further documents provides an indication that by the use of a hollow edible plug that stays as an integral part in the final product, the above-identified objective technical problem can be solved.

Consequently, inventive step of the subject-matter of claim 1 in view of D7, taken alone or in combination with any of the further documents, must be acknowledged. As all remaining claims, including independent claim 6, are more restricted than claim 1, the subject-matter of these claims must be inventive as well.

5.7 But even if one were to accept the appellant's argument that the standard moulding process of chapter 6.10.1.1. of D1 constitutes the closest prior art, the claimed subject-matter would still be based on an inventive step.

5.7.1 As acknowledged by the appellant, the objective technical problem in view of D1 is the provision of a process that leads to a moulded product that can be filled. The solution to this problem is the moulding process according to claim 1, which is characterised by

the use of a hollow wafer plug instead of the solid sandwiched wafer disclosed in chapter 6.10.1 of D1. Due to the presence of the hollow space in the wafer plug used in the claimed process, the final food product has an empty space that can be filled.

5.7.2 The appellant argued that this solution is already known from D6. This document discloses a process comprising the step of coating the exterior of a hollow shell of wafer biscuit with chocolate by means of an enrober, by dipping or by spraying (page 1, lines 21-25 and lines 87-90).

However, as set out in the paragraph bridging pages 186 and 187 of D1, coated products have an indistinct surface treatment while, in contrast, moulded products have a very precise shape and pattern and there is generally significantly more chocolate on a moulded product. Hence, coated products as those obtained in D6 are clearly different from moulded products. The skilled person confronted with the objective technical problem of finding a process that leads to a moulded product that can be filled would therefore not turn to the coating process of D6.

In fact, he would try other moulding processes that lead to moulded products that can be filled.

Such a moulding process is disclosed in chapter 6.10.1.2. of D1 itself. This chapter describes a shell moulding process in which a hollow chocolate shell is formed into which warm centres such as caramel can be deposited (second and third paragraph of page 189).

A further moulding process that results in a product that can be filled is disclosed in D2. This moulding process leads to a hollow chocolate shell that contains a hollow space next to a solid wafer plug (claim 1 and figure 4).

Contrary to the claimed solution, the hollow chocolate shells of chapter 6.10.1.2. of D1 and of D2 do not contain any hollow plug of wafer or meringue. The skilled person trying to modify the moulding process of chapter 6.10.1.1 of D1 by that of chapter 6.10.1.2. of D1 or that of D2 in order to obtain a product that can be filled would thus not arrive at the subject-matter of claim 1.

5.7.3 The appellant finally argued that it was common general knowledge that there is only one way of modifying the product of chapter 6.10.1.1 of D1 such as to arrive at a moulded product that can be filled, namely that of making the wafer of the product of chapter 6.10.1.1 of D1 hollow. In the appellant's view this represented a one-way street situation when starting from chapter 6.10.1.1 of D1. First of all, it appears that this approach is based on hindsight. Secondly, as has been set out above, there exist at least two further possibilities to arrive at moulded products that can be filled when starting from chapter 6.10.1.1 of D1, namely that disclosed in chapter 6.10.1.2. of D1 and that of D2. Consequently, no one-way street situation is present and the appellant's argument must fail.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

G. Röhn W. Sieber