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**Datasheet for the decision
of 22 July 2011**

Case Number: T 0688/09 - 3.3.09

Application Number: 02775608.9

Publication Number: 1446025

IPC: A23L 1/302

Language of the proceedings: EN

Title of invention:
Method of producing a foodstuff supplement

Patent Proprietor:
Vita Power Limited

Opponent:
BASF Personal Care and Nutrition GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 56

Relevant legal provisions (EPC 1973):
-

Keyword:
"Inventive step (no)"

Decisions cited:
-

Catchword:
-

Case Number: T 0688/09 - 3.3.09

**DECISION
of the Technical Board of Appeal 3.3.09
of 22 July 2011**

Appellant: BASF Personal Care and Nutrition GmbH
(Opponent) Postfach 13 01 64
D-40551 Düsseldorf (DE)

Representative: -

Respondent: Vita Power Limited
(Patent Proprietor) 200 Main South Road
Wanganui 5021 (NZ)

Representative: Lees, Kate Jane
Marks & Clerk LLP
27 Imperial Square
Cheltenham
GL50 1RQ (GB)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office
posted 30 January 2009 concerning
maintenance of European patent No. 1446025
in amended form (Article 101(3)(a) and 106
(2) EPC).

Composition of the Board:

Chairman: W. Sieber
Members: N. Perakis
K. Garnett

Summary of Facts and Submissions

I. Mention of the grant of European patent No. 1 446 025 in respect of European patent application No. 02775608.9 in the name of Vita Power Limited, which had been filed as international application No. PCT/NZ2002/000220 on 18 October 2002, was published on 8 March 2006 (Bulletin 2006/10). The patent was granted with 12 claims, claim 1 reading as follows:

"1. A method of producing a foodstuff supplement including the steps of:-

- (a) forming a liquid phase;
- (b) adding vitamins to the liquid phase at a temperature below that at which significant depletion and/or degradation of the vitamins will occur;
- (c) heating oil in a vessel;
- (d) adding an emulsifier to the heated oil;
- (e) cooling the oil/emulsifier mixture; and
- (f) adding the liquid phase of step (b)."

II. The opponent, Cognis Deutschland GmbH & Co. KG, now BASF Personal Care and Nutrition GmbH, requested revocation of the patent in its entirety relying on Article 100(a) EPC arguing that the subject-matter of the claims as granted lacked novelty and did not involve an inventive step.

Together with the notice of opposition, the opponent filed *inter alia* the following document:

D1: WO 02/24165 A2.

III. By an interlocutory decision which was announced orally on 13 November 2008 and posted on 30 January 2009 the opposition division decided that the subject-matter of auxiliary request 5, filed during the oral proceedings of 13 November 2008, met the requirements of the EPC.

Claim 1 of this request differs from claim 1 as granted in that the following process step was added at the end of the claim:

- "... and
- (g) upon reaching a temperature of substantially 36°C, the mixture is moved through a heat exchanger to reduce the temperature of the mixture further."

IV. The opponent (appellant) filed an appeal against the decision of the opposition division on 21 March 2009 and paid the appeal fee on the same day.

V. The statement setting out the grounds of appeal was filed on 8 June 2009. The appellant reiterated the objections raised before the opposition division that the subject-matter of the amended claims upheld by the opposition division did not

- satisfy the requirements of Articles 123(2), 84 and 56 EPC. It thus requested the revocation of the patent.
- VI. The respondent patent proprietor did not file any reply to the appeal. With letter dated 5 April 2011, it announced that it would not be represented at the oral proceedings scheduled to take place on 2 August 2011.
- VII. In a letter dated 14 April 2011 the appellant considered that the oral proceedings were unnecessary, and requested that a written decision be issued revoking the patent.
- VIII. With a communication dated 21 July 2011 the board cancelled the oral proceedings.
- IX. The relevant arguments put forward by the appellant in its written submissions may be summarised as follows:
- The insertion of step (g) in the subject-matter of granted Claim 1 offended Article 123(2) EPC.
 - Moreover, the use of the expression "substantially 36°C" in this additional step (g) introduced lack of clarity.
 - Finally the subject-matter of Claim 1 lacked an inventive step over D1.

Reasons for the Decision

1. The appeal is admissible.
2. Article 56 EPC
 - 2.1 The opposed patent relates to a method of producing a foodstuff supplement, in particular to the incorporation of multivitamins and possibly certain minerals in an oil emulsion environment without any substantial loss in vitamin potency, and in a resultant product, which exhibits good shelf-life capability (paragraphs [0001] and [0002] of the patent specification).
 - 2.2 The board concurs with the opposition division and the appellant that D1 should be considered to represent the closest state of the art, relating as it does likewise to a method of producing a vitamin-containing emulsion useful as foodstuff supplement with long storage stability (i.e., shelf-life stability) not only of the emulsion itself but also of the degradable components contained therein, such as the vitamins.
 - 2.2.1 D1, published on 28 March 2002, is state of the art under Article 54(2) EPC because the patent in suit is not entitled to the oldest priority date of 19 October 2001 but only to that of 23 April 2002. This has been explained in the appealed decision (page 10, third paragraph) and has not been contested by the patent proprietor.

2.2.2 As pointed out by the appellant - and not disputed by the respondent - the disclosure of D1 differs from the claimed method only in that D1 does not disclose step (g), namely that upon reaching a temperature of substantially 36°C, the mixture is moved through a heat exchanger to reduce the temperature of the mixture further.

In particular, D1 discloses in Example 1 a method of producing a liquid syrup, said method comprising the steps of:

- Dispersing a vitamin powder mixture together with ascorbic acid and citric acid in a batch of water in a high intensity mixer thereby forming an aqueous liquid phase (H) (page 35, lines 11-17). Although the temperature is not mentioned, it can be reasonably assumed that the mixing was carried out such that no degradation of the vitamins occurred, the more so because according to page 19, lines 13 -16, vitamins should not be exposed to a temperature higher than 40°C, more preferably not to a temperature above 30°C. *(Thus disclosing steps (a) and (b) of the contested claim).*
- Heating an oil (citrus oil) to about 30°C and adding an emulsifier (lecithin) to the heated oil to form a liquid (F) (page 35, lines 4-7). It goes without saying that such a procedure must be carried out in a vessel. *(Thus disclosing steps (c) and (d) of the contested claim).*
- Adding the oil/emulsifier mixture (F) in the form of the pre-emulsion (G) and liquid (H) to the main liquid (D), which has a temperature of about 25°C (page 35, lines 17-18). *(Thus disclosing steps (e) and (f) of the contested claim).*

2.3 The opposed patent discloses as the technical problem to be solved the provision of a method of producing a foodstuff supplement without any substantial loss in vitamin potency, which supplement exhibits good shelf-life capability (paragraph [0002]). The board, in agreement with the appellant, considers that this technical problem has already been solved by D1. This document (page 2, lines 18-23; page 7, lines 12-24; page 19, lines 14-16) discloses that the aim is on the one hand the enhanced stability of the emulsion and on the other hand the avoidance of vitamin degradation, the latter being achieved by exposing the vitamins to a temperature not higher than 40°C. Under these circumstances the objective technical problem to be solved over D1 has to be redefined as the provision of a method allowing the further reduction of the temperature of the mixture once the emulsion has been formed.

- 2.4 The question which remains to be answered is whether the skilled person starting from the method of D1 and aiming at a further reduction of the emulsion temperature would envisage the use of a heat-exchanger. The board in agreement with the appellant considers that the use of a heat-exchanger for cooling a liquid belongs to the general knowledge of the skilled person in the art since it is a basic technical operation. Furthermore, no technical advantage has been referred to related to the use of a heat-exchanger according to the claimed method which would not be expected from its conventional use.

Furthermore, as explained by the appellant, certain emulsions need to be cooled to a temperature below that of emulsion formation, such as for example 36°C, so that they become stable for longer times. It is, however, not plausible to consider that the realisation of this cooling, only when carried out in a heat-exchanger, will contribute to the sought-after shelf-life stability. It could be that particular flow conditions would be required (e.g. turbulent flow through intensive mixing) and in particular a specific cooling rate (such as e.g. a very rapid cooling, corresponding to quenching) in order to achieve a specific high stability. Nevertheless a heat-exchanger operating under undefined conditions cannot guarantee that a very high stability will be obtained. In a heat-exchanger a fluid can in principle be cooled down quickly or slowly under exactly the same flow conditions (laminar or turbulent) as e.g. in a container with an agitator. Thus the use of a heat-exchanger alone is not sufficient to warrant that during the cooling no phase separation will occur and cannot safeguard a long shelf-life stability.

- 2.5 The opposition division considered in the interlocutory decision (page 11, fourth paragraph) that Claim 1 as maintained involves an inventive step because, among other reasons, contrary to the disclosure of D1, it has as subject-matter a simpler method involving fewer steps. The opposition division recognised a specific difference in that, according to D1, water soluble vitamins are added to a water phase and oil soluble vitamins to an oil phase. However this argument is not persuasive. The method, as disclosed by D1, pages 20-21, which encompasses 18 steps, is indeed more complicated than that of Claim 1. However, the method described in D1 comprises steps (a) to (f) and is thus encompassed by the claimed method, which allows by its "open wording" the presence of further process steps.
- 2.6 Consequently no inventive step can be acknowledged for use of a heat-exchanger in order to reduce the temperature of the emulsion of D1.
3. Under these circumstances there is no need to discuss the issues relating to clarity and added subject-matter.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

G. Röhn

W. Sieber