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**Datasheet for the decision  
of 28 February 2013**

**Case Number:** T 0808/09 - 3.2.07

**Application Number:** 04250365.6

**Publication Number:** 1440908

**IPC:** B65D 81/00

**Language of the proceedings:** EN

**Title of invention:**

Cartridge and method for the preparation of beverages

**Patent Proprietor:**

Kraft Foods R&D. Inc.

**Opponents:**

DEMB Holding B.V. (Opponent 1)  
Friesland Brands B.V. (Opponent 2)  
NESTEC S.A. (Opponent 3)

**Headword:**

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**Relevant legal provisions:**

EPC Art. 83, 100(b)

**Keyword:**

"Sufficiency of disclosure: all requests - no" (the viscosity of the liquid chocolate ingredients represents an essential feature which cannot be measured due to lacking information)

**Decisions cited:**

G 0001/10, T 1250/01, T 0805/93, T 0083/01

**Catchword:**

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Case Number: T 0808/09 - 3.2.07

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.07  
of 28 February 2013

**Appellant:** Kraft Foods R&D, Inc.  
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**Decision under appeal:**            **Decision of the Opposition Division of the European Patent Office posted 13 February 2009 revoking European patent No. 1440908 pursuant to Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman:**            H. Meinders  
**Members:**            H. Hahn  
                             E. Kossonakou

## Summary of Facts and Submissions

I. The appellant (patent proprietor) lodged an appeal against the decision of the Opposition Division to revoke the European patent EP-B-1 440 908.

II. The following documents cited in the impugned decision are relevant for the present decision:

D1 = Brookfield Engineering Laboratories Inc: More Solutions to Sticky Problems, May 1985

D8 = US-A-4 334 640

D9 = WO-A-02/00031

as well as the following documents which, although being submitted during the opposition procedure, were not cited in the impugned decision:

D24 = US-A-6 139 896

D25 = Affidavit of Prof. Ton van Vliet dated 7 June 2007

III. Three oppositions had been filed against the patent in its entirety under Article 100(a) EPC, for lack of novelty (opponents 01, 02, 03) and inventive step (opponents 01, 02, 03), under Article 100(b) EPC, that the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by the person skilled in the art (opponents 01, 02), and under Article 100(c) EPC for extending beyond the content of the application as originally filed (opponent 01).

The Opposition Division held amongst others that claim 1 as granted does not contravene Article 100(b) EPC but that the subject-matter of claim 1 as granted lacks novelty over the disclosures of D8 and D9. Consequently, the patent was revoked.

- IV. With a communication dated 3 May 2012 and annexed to the summons to oral proceedings the Board presented its preliminary opinion with respect to claims 1-17 of the patent as granted according to the main request and claims 1-16 of the first auxiliary request as filed together with the statement of the grounds of appeal dated 5 June 2009.

With respect to the issue of Article 83 EPC it remarked amongst others that it appeared - taking account of the teachings of D1 and/or of D25 - that the patent in suit provides insufficient information enabling the person skilled in the art to carry out the invention with respect to the feature "the liquid chocolate ingredient has a viscosity between 70 and 3900 mPas at ambient temperature".

This insufficiency appeared to be due to the fact that the patent is totally silent with respect to the device and all the parameters determining the measuring of the viscosity of the chocolate concentrate, let alone at a specific single temperature ("ambient temperature"). The reasoning of the Opposition Division to the contrary could not hold since, as correctly and plausibly argued by respondent 02 (opponent 02), there is firstly no indication in the patent in suit concerning the device to be used for the viscosity measurement and secondly, there exists no standard

method for measuring the viscosity of such thixotropic suspensions. The appellant has, however, not discharged its burden of proof for the opposite, namely that the skilled person has the relevant knowledge and that there exists a standard procedure for the determination of the viscosity of such thixotropic liquid concentrates.

Therefore it appeared that product claim 1 of the patent as granted as well as process claim 1 of the first auxiliary request do not comply with Article 83 EPC.

V. With letter dated 28 January 2013 submitted by fax on the same date the appellant submitted, as a response to the summons to oral proceedings, arguments with respect to sufficiency of disclosure and the admissibility of the auxiliary request.

VI. Oral proceedings before the Board were held on 28 February 2013. As announced with their letters dated 31 January 2013 and 28 January 2013, respectively, respondent 02 and respondent 03 (opponent 03) did not attend so that the oral proceedings took place in their absence in accordance with Rule 115(2) EPC and Article 15(3) RPBA. The issue of sufficiency of disclosure was discussed with respect to the claims 1 of the main and the first auxiliary requests, particularly in the light of D1 and D25.

(a) The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted, or alternatively be maintained in amended form on the basis of the

first auxiliary request filed together with the statement of the grounds of appeal dated 5 June 2009.

- (b) Respondent 01 (opponent 01) requested that the appeal be dismissed.
- (c) Respondent 02 and respondent 03 requested in the written proceedings that the appeal be dismissed.

At the end of the oral proceedings the Board announced its decision.

VII. Independent claims 1 and 12 of the patent as granted (main request) read as follows:

"1. A cartridge (1) for use in a beverage preparation machine, the cartridge containing one or more beverage ingredients (200) and being formed from substantially air- and water-impermeable materials, wherein the one or more beverage ingredients is a liquid chocolate ingredient, characterised in that the liquid chocolate ingredient has a viscosity between 70 and 3900 mPas at ambient temperature."

"12. A method of dispensing a beverage from a cartridge (1) as claimed in any preceding claim containing one or more liquid chocolate ingredients during an operation cycle, comprising the steps of passing an aqueous medium through the cartridge to form a beverage by dilution of said one or more chocolate ingredients, and dispensing the beverage into a receptacle, wherein the one or more liquid chocolate ingredients is diluted by a ratio of between 2 to 1 and 10 to 1."

VIII. Independent claim 1 of the first auxiliary request reads as follows:

"1. A method of dispensing a beverage from a sealed machine-insertable cartridge (1) for use in a beverage preparation machine during an operation cycle, wherein the cartridge is sealed prior to insertion into the beverage preparation machine and contains one or more beverage ingredients (200) and is formed from substantially air- and water-impermeable materials, and wherein the one or more beverage ingredients is a liquid chocolate ingredient having a viscosity of between 70 and 3900 mPas at ambient temperature, wherein the method comprises the steps of passing an aqueous medium through the cartridge to form a beverage by dilution of said one or more chocolate ingredients, and dispensing the beverage into a receptacle, wherein the one or more liquid chocolate ingredients is diluted by a ratio of between 2 to 1 and 10 to 1."

IX. The appellant argued, insofar as relevant for the present decision, essentially as follows:

The viscosity feature was included in claim 1 at the suggestion of the Examining Division. The appellant accepted this amendment in good faith with a view to expediting allowance of the application. At that time no objection of insufficiency was raised because it was apparently clear to the Examining Division that the disclosure of the invention was reproducible without undue burden. This conclusion was also reached by the Opposition Division who found that the requirements of Article 83 EPC were fulfilled.



The sufficiency of disclosure needs to be assessed on the basis of the patent as a whole and not on the claims alone. The specification provides clear guidance to the person skilled in the art as to how to select suitable chocolate ingredients for use in the invention (see paragraphs [0011] to [0015] and [0069]). The latter paragraph [0069] provides further guidance concerning suitable ingredients and the viscosity change shows that the viscosity at 0°C is different from that at ambient temperature. Therefore claim 1 of the patent as granted complies with Article 83 EPC.

If the skilled person can use anything for making the concentrates then he can repeat the invention.

It is noted that viscosity values are mentioned in a number of prior art documents relied on by the respondents to support their arguments on novelty and inventive step. The fact that the prior art contains such information without further information on the apparatus and parameters used, supports the view that the person skilled in the art would have no difficulty selecting suitable, conventional chocolate ingredients for use in the invention and would therefore be able to repeat the invention without undue experimentation.

D1 describes the common Brookfield viscometer and the person skilled in the art knows, with the instructions for use, how to use it, as considered in point 2 of the impugned decision. Therefore the skilled person would be enabled, by using the common Brookfield viscometer and the information in the patent specification, to carry out the invention.

With respect to the declaration D25 it seems that Prof. van Vliet focused only on the claims. It is not known which instructions were given to him, but Article 83 EPC considers the whole specification and not the claims alone. Furthermore, no experimental data were provided by the expert showing that he could not repeat the invention.

D8 and D9 refer to certain viscosity measurements but also do not provide in explicit detail how these viscosities are measured.

Any objection to the feature "at ambient temperature" comes under Article 84 EPC which is not a ground of opposition.

It is admitted that D1 does not disclose a standard method for determining the viscosity of liquid chocolate concentrates. It is also admitted that no evidence of such a standard method is at hand.

The above applies equally to claim 1 of the first auxiliary request which comprises the feature in the preamble only, so that there is no such strong focus on the viscosity feature.

- X. Respondent 01 argued, insofar as relevant for the present decision, essentially as follows:

With respect to the introduction of the viscosity feature during the grant proceedings reference is made to the decision G 1/10 (not yet published in OJ EPO) which in point 11 of the reasons states: "If, given the

opportunity to check the patent text before approving it, an applicant does not draw any errors to the attention of the examining division and thus ensure his approval is limited to the correct text, then the responsibility for any errors remaining in that text after grant should be his alone, whether the error was made (or introduced) by him or by the examining division". Thus the responsibility for this amendment remains with the appellant who apparently accepted the introduction of this feature in order to make the claimed subject-matter novel over the prior art.

The person skilled in the art knows of D1 but also knows from it that it is essential to record the parameters necessary for measuring the viscosity (see D1, page 8, section 3.3.1 "Recordkeeping"). A viscosity range associated with a thixotropic material makes only sense if the specific measurement conditions are given. All this critical information is missing in the patent in suit so that the person skilled in the art is left without information to carry out the invention.

The declaration D25 is relevant since there is hardly any difference between the subject-matter of the claims mentioned and the disclosure of paragraphs [0011] to [0015] of the patent in suit mentioned by the appellant. They contain exactly the same features and information. Hence the appellant's argument that D25 would not be relevant cannot hold.

Likewise the argument concerning the missing "hard data" cannot hold in view of the experiments carried out by respondent 02 who demonstrated the effect of the shear rate onto the viscosity values of 13 different

liquid chocolate concentrates belonging to the prior art, which viscosities were measured at two different shear rates, of  $100 \text{ s}^{-1}$  and  $1000 \text{ s}^{-1}$ , see opposition brief of opponent 02 dated 16 May 2007, page 10, figures 2 and 3. This comparison illustrates that already without this important information the invention is not sufficiently disclosed.

The patent description and particularly the passages quoted by the appellant (i.e. paragraphs [0011] to [0015] and [0069]) are silent on how the viscosity of between 70 and 3900 mPas is to be determined, except for the reference to "at ambient temperature" and the reference to a different temperature of  $0^\circ\text{C}$ , yet only for a viscosity range of 5000 to 10000 mPas of an embodiment with a solids content of  $67 \text{ Brix} \pm 3$  (see paragraph [0069]). This viscosity difference between 1700 and 3900 mPas at ambient temperature and between 5000 and 10000 mPas at  $0^\circ\text{C}$  leads to a difference in viscosity of 3300-6100 mPas, i.e. a factor of 2.56-2.94. The liquid chocolate material, however, may have a high solids content and may even be a gel (see paragraphs [0011] to [0014]) but the patent does not contain any description of how to prepare such liquid chocolate ingredients that at the same time also have viscosities in the range of 70-3900 mPas at ambient temperature. It could be anything but the specification does not hold in this respect.

It needs also to be considered that none of the working examples is an example within the scope of the claims of the patent as granted since they were made with ground **coffee** extract.

The patent does additionally not indicate what "ambient temperature" is, for which no clear and generally recognized definition exists. Ambient temperature represents rather a temperature which is comprised between, say 15-30°C. Since the viscosity generally decreases with increasing temperature the non-definition of said "ambient temperature" also shows that Article 83 EPC is not complied with.

D8 and D9 were considered by the Opposition Division for the novelty issue only **after** dealing with the Article 100(b) EPC objection so that the viscosity ranges in these documents were not relevant.

With respect to claim 1 of the first auxiliary request it is remarked that the claim has to be read as a whole so that the viscosity feature is still relevant, contrary to the appellant's allegation that it merely reflected the prior art.

XI. Respondent 02 argued in the written proceedings, insofar as relevant for the present decision, essentially as follows:

The viscosity of the chocolate concentrate to be used is presented as an essential feature of both requests.

Viscosity is a measure of fluids resistance which depends on a variety of parameters, such as temperature and the composition of the fluid in question.

D1 explains the special characteristics of multiphase liquids, such as dispersions and emulsions.

D1 explains on page 17 the special characteristics of multiphase liquids. Chocolate concentrates are dispersions of various ingredients and include a high content of dispersed cacao solids.

The declaration D25 refers to such concentrates as "concentrated suspensions" (see paragraph 6). It explains that these dispersions typically show a complex rheological behaviour which cannot simply be presented by a single viscosity value (see paragraph 8).

The viscosity of these dispersions is dependent on the applied shear rate and the variation in viscosity values measured with different shear rates is substantial as e.g. shown in figure 1 of the notice of opposition. Moreover, these suspensions are generally also thixotropic (see D25, paragraph 7), i.e. there is a time-dependent change in viscosity, the longer the fluid undergoes shear stress the lower will be its viscosity. A single viscosity value for such a concentrate without any indication of the shear rate and of the measurement time is therefore meaningless.

The patent in suit is silent with respect to the shear rate at which the viscosity should be measured or what the measurement time should be. In the examples of the opposed patent viscosity is discussed only in paragraph [0069] but without an indication of these parameters. In decision T 1250/01 (not published in OJ EPO) it was ruled that an inadequately described measuring method for an essential product parameter means an incomplete disclosure, not enabling the skilled person to carry out the invention. The same holds for the present case.

The examples do not disclose any formulation of a suitable chocolate concentrate and the patent only mentions some solids content without specifying whether wt.% or vol.% are meant and this information of the solids content is not sufficient to reproduce such a formulation since nothing is said about the type of cacao solids or the nature of the other ingredients.

The reasoning in the decision that the skilled person would use a standard method for measuring the viscosity, which would e.g. be disclosed by the handbook of the device to be used, cannot hold since the patent does not mention which device is to be used. Moreover, this reasoning ignores the teachings of D1 and the declaration D25, the latter stating that there exists no standard shear rate or standard measuring time for such concentrated dispersions (see D25, page 2, last paragraph).

According to D1 there are several ways of analyzing the rheological behaviour of non-Newtonian fluids (see paragraphs 5.3 and 5.4) and none of them is a "standard" method and none of them results in a single viscosity value. All methods require measurements at different, but well-specified shear rates. No standard viscosity measurement method exists for the measurement of chocolate concentrates, or concentrated suspensions in general, so that the decision is incorrect in this respect.

A person skilled in the art trying to reproduce the cartridge as claimed would not be able to succeed since the shear rate and the measurement time are not given, and the patent does not give any information how the

concentrate should be formulated. Therefore Article 83 EPC is not complied with.

XII. Respondent 03 did not submit any argument concerning sufficiency of disclosure in the written proceedings.

### **Reasons for the Decision**

1. *Admissibility of amendments (Articles 100(c) and 123(2) EPC)*

Since the Board considers that the claims 1 of the main and the first auxiliary request do not comply with Article 83 EPC (see point 2 below) there is no need to consider in this decision whether these claims comply with Article 123(2) EPC.

2. *Sufficiency of disclosure (Articles 100(b) and 83 EPC)*

2.1 Concerning the issue of sufficiency of disclosure the Board has to criticise the rather short reasoning given in point 2 of the reasons of the impugned decision:  
*"The Opposition Division is of the opinion that the skilled person trying to reproduce a cartridge of claim 1 would use a standard method for measuring the viscosity, which would e.g. be disclosed by the hand book of the device to be used, and thus obtain a cartridge according to claim 1".*

This reasoning is considered to be insufficient with respect to the plurality of different arguments as well as the evidence D1, D24 and D25 submitted by the two opponents 01 and 02 in support of their objection of



insufficiency. None of these find any treatment in the impugned decision. It is also not apparent, neither from the decision nor from the minutes of the oral proceedings, why the Opposition Division changed its provisional negative opinion with respect to the viscosity feature as communicated to the parties, into the positive opinion expressed in the decision.

Indeed, the impugned decision is silent with respect to document D25, which has been timely submitted during the opposition procedure by opponent 02 and which both the appellant and respondent 01 confirmed as having been discussed at the oral proceedings before the Opposition Division.

By the same token four other documents submitted during the opposition proceedings (US-A-1 887 905, US-A-3 821 420, EP-A-0 324 072 and D24) have not been mentioned in the impugned decision either.

- 2.2 Taking proper account of the user's manual D1 and the declaration D25 the Board reaches the opposite conclusion, for the following reasons.

*Main request*

- 2.3 Product claim 1 of the main request comprises the feature of a **"liquid chocolate ingredient having a viscosity of between 70 and 3900 mPas at ambient temperature"**.

It is, however, evident that the patent in suit provides **insufficient** information to enable the person

skilled in the art to carry out the invention with respect to this feature of the viscosity.

2.4 In the first place, the patent in suit does **not** contain a single working example executed with a liquid **chocolate** concentrate within the scope of the claims as granted; they concerned exclusively ground coffee extract.

2.4.1 Further, the patent description and particularly the passages quoted by the appellant (paragraphs [0011] to [0015] and [0069]) are silent on how the viscosity of between 70 and 3900 mPas is to be determined and which device and which parameters necessary for measuring the viscosity of the liquid chocolate concentrate have to be used:

Paragraphs [0011] to [0014] only specify certain total solids content values of the liquid chocolate concentrates, which may contain a high solids content of cocoa solids and which may be a gel (i.e. thixotropic).

The dilution ratio of between 2 to 1 and 10 to 1 of said liquid chocolate concentrate (see paragraph [0015]) is not helpful either. The presence of the concentrate to be diluted is a prerequisite for said dilution.

The viscosity difference between 1700 and 3900 mPas at ambient temperature and between 5000 and 10000 mPas at 0°C of an embodiment with a solids content of 67 Brix ± 3 mentioned in paragraph [0069] only leads to a huge difference in viscosity of 3300-6100 mPas at different temperatures but likewise does not enable the person

skilled in the art to formulate such a liquid chocolate concentrate.

2.4.2 The patent also does **not** contain any description how such liquid chocolate ingredients or concentrates should be prepared - there exists no formulation which cocoa solids and which other components need to be blended to achieve a composition having the high total solids content as e.g. specified in paragraphs [0011] to [0014] or [0069] - which at the same time also has a viscosity in the range of 70-3900 mPas at ambient temperature. It could be any combination of ingredients known from the prior art (compare in this context the formulation of D9, page 4, lines 21 to 28, which includes the blending of 8 ingredients to produce the liquid concentrate) but the specification does not help in this respect and therefore places an undue burden on the person skilled in the art.

2.4.3 It belongs to the common general knowledge of the person skilled in the art that liquid chocolate concentrates are typically both shear-thinning and thixotropic so that their viscosity is dependent on the temperature, applied shear rate as well as the shear time. This means that there is a time-dependent change in viscosity: the longer the fluid undergoes shear stress the lower is its viscosity (see e.g. D25, points 6 to 8).

As a consequence of these properties a single viscosity value for such a concentrate, without any indication of the shear rate and of the measurement time, is meaningless and not enabling a determination of its viscosity.

2.4.4 D1 does **not** disclose such a standard method for liquid chocolate concentrates. This fact was also admitted by the appellant at the oral proceedings. D1 only discloses information necessary to make meaningful viscosity measurements, with the emphasis on Brookfield viscometers (see page 7, chapter "3.1 Why You Should Read This Chapter"). It states that it is **necessary to record** the viscometer model, spindle (or accessory), rotational speed, container size or dimensions, sample temperature, sample preparation procedure (if any), and whether or not the spindle guard was used to ensure reproducibility of the test results (see page 8, chapter "3.3.1 Recordkeeping"; and page 16, chapter "4.7.3 Measuring Conditions"). The patent in suit does not mention any of these parameters.

Thus D1 teaches the person skilled in the art the essential parameters which have to be considered when performing a viscosity measurement but it is silent which device components and which specific parameters have to be selected when in particular the viscosity of a liquid chocolate concentrate is to be measured.

2.4.5 The reasoning of the Opposition Division in its decision to the contrary cannot hold since there is firstly no indication in the patent in suit concerning the device to be used - there exist several manufacturers of viscometers and the Brookfield viscometer mentioned in D1 is only one of them, see e.g. D24, column 1, lines 52 to 55 - so that the person skilled in the art **cannot** consult the corresponding viscometer manual for the viscosity measurement (see point 2.4.1 above). Secondly there exists **no** standard

method for measuring the viscosity of such thixotropic suspensions as stated in the decision. The declaration D25 states that there exists no standard method with a standard shear rate or standard measuring time for such concentrated dispersions (see D25, page 2, last paragraph).

However, the appellant did **not** discharge its burden of proof for the existence of such a standard method for shear-thinning and/or thixotropic liquid chocolate concentrates (see Case Law of the Boards of Appeal of the European Patent Office, 6<sup>th</sup> edition 2010, sections VI.H.5.1.1 and VI.H.5.2). This deficiency has been mentioned in the Board's communication annexed to the summons to oral proceedings; when asked at the oral proceedings by the Board the appellant admitted that it had **no** evidence for the existence of a standard method for measuring the viscosity of such liquid chocolate concentrates.

2.4.6 The appellant's further arguments cannot hold for the following reasons.

The arguments concerning the case history of the incorporation of the viscosity feature during the examination proceedings are not relevant for the issue of sufficiency of disclosure. Furthermore, as correctly argued by respondent 01 the responsibility for this amendment remains with the appellant.

The further argument that the Examining Division considered that the disclosure was reproducible without undue burden is not particularly relevant for the appeal proceedings since this issue was actually raised

in the opposition proceedings by opponents 01 and 02 who submitted in this context amongst others the documents D1 and D25.

The fact that the Opposition Division reached the conclusion that Article 83 EPC is complied with, is likewise not considered to be particularly relevant, in view of the extremely short reasoning given (see point 2.1 above) which does not take account of any of the opponents' arguments and evidence.

The argument that the combined knowledge of D1 and the specification of the patent in suit would enable the person skilled in the art to carry out the invention cannot hold either since the patent does not give the information to use one of the Brookfield viscometers mentioned in D1.

The argument that the declaration D25 would not be relevant as it focuses only on the claims while Article 83 EPC requires to take account of the entire specification cannot hold since there is **no** difference between the subject-matter of claims 1, 2 and 4-12 as discussed in D25 and the disclosure of paragraphs [0011] to [0015] of the patent in suit. The additional viscosity range at 0°C for an embodiment with a specific total solids content according to paragraph [0069] of the patent does not resolve the sufficiency problem either (see point 2.4.2 above).

Likewise the argument concerning the missing "hard data" that the invention does not work or that the claimed viscosities cannot be determined cannot hold since the patent in suit already fails at the prior

requirement of not disclosing the method, apparatus and the parameters for determination of the viscosity, in particular for the claimed liquid chocolate suspension. In any case, the appellant did not produce any counter-evidence against the experiments carried out by opponent 02 demonstrating the effect of the shear rate on the viscosity of 13 different liquid chocolate concentrates belonging to the prior art which viscosities were measured at shear rates of  $100 \text{ s}^{-1}$  and  $1000 \text{ s}^{-1}$  (see opposition brief of opponent 02 dated 16 May 2007, page 10, figures 2 and 3). This comparison clearly shows the effect of different shear rates on the measured viscosity.

The absence of any reference to viscosity measurements in D8 or D9, which do not explain in explicit detail how these viscosities were measured, cannot alter this conclusion. While not wishing to enter into a detailed discussion of these documents the Board notes that D8, though a granted patent, is not granted according to the EPC and D9 is a mere application, not a granted European patent.

- 2.5 Taking account of the above the Board considers that the patent in suit fails to enable the measurement of the essential parameter of the invention, i.e. the viscosity of the liquid chocolate ingredient.

Considering this fact and in line with the longstanding jurisprudence of the Boards of Appeal (see Case Law of the Boards of Appeal of the European Patent Office, 6<sup>th</sup> edition 2010, section II.A.1 to II.A.7; compare e.g. T 805/93 (dealing with viscosity measurement at "room temperature") and T 83/01 and T 1250/01 (both

concerning the measurement of an essential parameter, i.e. a specific mean diameter or the Sears number, respectively), all not published in OJ EPO), the Board concludes that claim 1 of the main request does not comply with Article 83 EPC. The main request is therefore not allowable.

*First auxiliary request*

3. Method claim 1 of the first auxiliary request comprises the identical term "**liquid chocolate ingredient having a viscosity of between 70 and 3900 mPas at ambient temperature**" as product claim 1 of the main request (see points VII and VIII above).

3.1 Consequently, the objection valid under Article 83 EPC in point 2.5 above applies *mutatis mutandis* to claim 1 of the first auxiliary request.

The first auxiliary request is therefore not allowable either for the same reasons.

3.2 The appellant's further arguments to the contrary cannot hold for the following reasons.

First of all there is the argument that with the amended wording is less focus on the viscosity feature of claim 1 because this feature is now comprised in the preamble.

However, method claim 1 is drafted in the one-part form ("wherein ..."), so that it does not contain a preamble.



Secondly, even if this viscosity feature would have been shifted into a preamble of method claim 1 and supposing this preamble were to be directed to the prior art, this shifting of the feature would still not have solved the problem of insufficiency. For a reference to a prior art in the preamble to adequately serve this purpose the patent in suit still needs to contain all the necessary information in sufficient detail in order to enable the person skilled in the art to perform the invention. In the present case this would require information as to the viscosity measurement device to be used and the parameters to be observed. As all this information is missing, the person skilled in the art still does not have the teaching for reproducing the present invention.

The other arguments fail for the same reasons as given with respect to claim 1 of the main request in points 2.3 to 2.4.6 above.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders