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**Datasheet for the decision
of 8 July 2011**

Case Number: T 0839/09 - 3.3.09

Application Number: 02078597.8

Publication Number: 1287744

IPC: A32C 19/032

Language of the proceedings: EN

Title of invention:

Method for preparing a half-hard or hard cheese, and cheese thus obtained

Patentee:

Friesland Brands B.V.

Opponent:

FROMAGERIE BEL

Headword:

-

Relevant legal provisions:

EPC Art. 54, 83, 104(1), 111(1)

Keyword:

"Sufficiency of disclosure - yes"
"Novelty: Main request - no; Auxiliary request I - yes"
"Remittal - yes"
"Apportionment of costs - no"

Decisions cited:

T 1091/00

Catchword:

-



Case Number: T 0839/09 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 8 July 2011

Appellant: Friesland Brands B.V.
(Patent Proprietor) Pieter Stuyvesantweg 1
NL-8937 AC Leeuwarden (NL)

Representative: Marsman, Hermanus Antonius M.
Vereenigde
Postbus 87930
NL-2508 DH Den Haag (NL)

Respondent: FROMAGERIE BEL
(Opponent) 16 Boulevard Malesherbes
F-75008 Paris (FR)

Representative: Holtz, Béatrice
Cabinet Lavoix
2, place d'Estienne d'Orves
F-75441 Paris Cedex 09 (FR)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 6 February 2009
revoking European patent No. 1287744 pursuant
to Article 101(2) EPC.

Composition of the Board:

Chairman: W. Sieber
Members: J. Jardón Álvarez
F. Blumer

Summary of Facts and Submissions

I. European patent No. 1 287 744 was granted to Friesland Brands B.V. on the basis of European patent application No. 02078597.8 which was filed on 30 August 2002. The mention of grant was published on 29 March 2006 in Bulletin 2006/13. The patent was granted with nine claims, independent claims 1 and 9 reading as follows:

"1. A method for preparing a foil-ripened cheese of the hard or half-hard type said cheese being of the Gouda or Edam type, wherein to cheese milk, in addition to a conventional amount of starter, an adjunct starter is added, which adjunct starter, compared with conventional starters, has a higher proteolytic and/or peptidolytic capacity, subsequently, in a conventional manner, a young cheese of the hard or half-hard type is formed, which young cheese, after brining, is packaged in foil and evacuated, and wherein the foil-packed cheese is subjected to a ripening at a temperature in the range of 10 to 16°C."

"9. A foil-ripened cheese of the Gouda or Edam type, obtainable using the method according to any one of the preceding claims."

Claims 2 to 8 were dependent claims.

II. A notice of opposition was filed by FROMAGERIE BEL (opponent) on 29 December 2006 requesting revocation of the patent in its entirety on grounds pursuant to Articles 100(a) (lack of novelty and inventive step) and 100(b) (insufficiency of disclosure) EPC.

Another notice of opposition was filed by Campina Nederland Holding B.V on 21 December 2006, relying on Article 100(a) EPC only. This opposition was withdrawn during the opposition proceedings by letter dated 5 January 2009.

The documents cited during the opposition proceedings included the following:

- D1: G. Trépanier *et al.*, "Accelerated Maturation of Cheddar Cheese: Influence of Added Lactobacilli and Commercial Protease on Composition and Texture", *Journal of Food Science*, 57(4), 1992, pages 898-902;
- D5: H.J. Bartels *et al.*, "Accelerated ripening of Gouda cheese. I. Effect of heat-shocked thermophilic lactobacilli and streptococci on proteolysis and flavor development", *Milchwissenschaft* 42(2), 1987, pages 83-88;
- D8: E. Høier, "Adjunct cultures in semi-hard cheese", *The Australian Journal of Dairy Technology*, 53, 1998, page 123; and
- D11: P.F. Fox "Fundamentals of Cheese Science" published by Gaithersburg, 2000, Chapter 15 "Acceleration of Cheese Ripening", pages 349-362.

III. With its decision announced orally on 27 January 2009 and issued in writing on 6 February 2009, the opposition division revoked the patent.

The opposition division found that the application disclosed the invention in a manner sufficiently clear and complete for it to be carried out by the skilled person. However, it also held that document D5 anticipated the subject-matter of claims 1 and 9 of the patent as granted (main request) and the subject-matter of claim 1 of auxiliary request I (claims 1 to 8 as granted).

IV. On 14 April 2009 the patent proprietor (appellant) lodged an appeal against the decision of the opposition division and paid the prescribed fee on the same day. With the statement setting out the grounds of appeal, filed on 15 June 2009, the appellant requested that the decision under appeal be set aside, a decision that the claims as granted (main request) were novel over the prior art, and remittal of the case to the opposition division to have the issue of inventive step discussed. The appellant also filed sets of claims for five auxiliary requests.

Auxiliary request I was directed to claims 1 to 8 of the main request.

Auxiliary requests II and III were based on the main request and auxiliary request I but further specifying that the cheese was a foil-ripened "**rindless**" cheese.

Auxiliary requests IV and V were also based on the main and auxiliary request I but further specifying that an adjunct starter was added "**simultaneously with or after the conventional starter**".

- V. With its reply dated 30 November 2009 the opponent (respondent) disputed all the arguments submitted by the appellant and requested that the patent be revoked in its entirety. It maintained that the claims of all requests did not comply with Article 83 EPC and were contrary to Article 54 EPC and/or Article 56 EPC. Furthermore, the amendments made to claim 1 of auxiliary requests II to V were contrary to Article 84 EPC. The respondent further requested that auxiliary requests IV and V not be admitted into the proceedings because their introduction at this stage would constitute a procedural abuse and, if they were admitted, that the inventive step of these two requests be decided during the appeal proceedings. The respondent also filed four fresh documents in support of its arguments.
- VI. On 31 May 2010 the appellant filed further arguments in support of its requests, and three new documents.
- VII. On 7 February 2011 the board dispatched the summons to attend oral proceedings. In a communication dated 30 March 2011 the board expressed its preliminary opinion that the requirement of sufficiency of disclosure was met and noted that the main point to be discussed during the oral proceedings would be the novelty of the claimed subject-matter. Finally, the board noted that, if novelty were acknowledged, remittal to the opposition division to consider inventive step appeared to be appropriate.
- VIII. By letters dated 7 June 2011 both the appellant and the respondent filed additional arguments. The respondent also submitted four new documents.

IX. Oral proceedings before the board were held on 8 July 2011. During the oral proceedings the respondent requested for the first time that if the claims of auxiliary request I were seen as novel, the case should not be remitted to the opposition division for further prosecution, or, if remitted, that a different apportionment of costs be ordered.

X. The arguments presented by the appellant, insofar as they are relevant for this decision, may be summarised as follows:

- Concerning sufficiency of disclosure, the objections raised by the respondent were at best clarity objections. In any case the skilled person would know whether the bitterness of a given cheese had been reduced or not.
- The opposition division had decided incorrectly that D5 anticipated claims 1 and 9 as granted. In particular claim 1 of the patent required that an adjunct starter was added to cheese milk, a step which was not taught in D5.
- Concerning the product claim, the cheese prepared by the claimed process differed from both natural cheese and conventional foil-ripened cheese. In particular compared to natural cheese the claimed cheese lacked a rind and compared to standard foil-ripened cheese showed a better flavour.

XI. The arguments presented by the respondent may be summarised as follows:

- The respondent disagreed with the opposition division's finding that the opposed patent was sufficiently disclosed and argued that the scope of the claims was not commensurate with the contribution of the invention to the state of the art. Furthermore, the skilled person could not carry out the claimed invention because of the presence of an unclear functional feature. The patent failed to define the conventional starter and the method used for measuring proteolytic and peptidolytic capacity. Moreover, the claims encompassed the use of adjunct starters for which the bitterness would not be reduced.

- The subject-matter of claim 1 lacked novelty having regard to the disclosures of documents D1, D5 and D8.
D5 disclosed explicitly all the steps of the process of claim 1 of the patent. Concerning the addition of an adjunct starter to the milk, this feature was taught by D5 wherein the thermophilic cultures were added to hot milk, this milk being also part of the cheese milk in the process of D5. The process of D5 was also carried out in a conventional manner and resulted in a Gouda cheese which anticipated the subject-matter of claim 9. Concerning D1, the respondent admitted that this document was directed to the preparation of Cheddar cheese but argued that claim 1 of the patent did not reflect the process steps that would ensure that a Gouda or Edam type cheese was obtained.

Finally, D8 related to the preparation of a Danbo type cheese in a standard way. As the Danbo cheese was a Gouda type cheese the disclosure of D8 should also be seen as novelty-destroying.

- As regards remittal of the case, the right to two instances was not absolute. In the present case the appellant had waived its right to two instances when it withdrew its previous auxiliary requests (now auxiliary requests IV and V) before the opposition division.
 - The respondent also requested a different apportionment of costs as the remittal to the opposition division would occasion extra costs.
- XII. The appellant requested that the board set aside the decision under appeal, decide that the claims as granted (main request) were novel over the prior art, and remit the case to the opposition division to have the issue of inventive step discussed.

As an auxiliary request, the appellant requested that the board set aside the decision under appeal, decide that the claims of one of the auxiliary requests I to V as filed with the statement setting out the grounds of appeal on 15 June 2009 were novel over the prior art, and remit the case to the opposition division to have the issue of inventive step discussed.

- XIII. The respondent requested that the appeal be dismissed. The respondent further requested that the case not be remitted to the opposition division for further prosecution or, if remitted, that a different

apportionment of costs according to Article 104 EPC be ordered.

The respondent also requested that auxiliary requests IV and V not be admitted into the proceedings, or, if they were admitted, that the issue of inventive step be decided during the appeal proceedings.

Reasons for the Decision

1. The appeal is admissible.

MAIN REQUEST (claims as granted)

2. *Sufficiency of disclosure*

- 2.1 The patent relates to a method for preparing a foil-ripened Gouda or Edam type cheese and to the cheese obtainable using said method. The invention aims to obviate disadvantages of prior-art methods of foil-ripening and thus to obtain a foil-ripened cheese having the flavour properties and consistency of standard conventionally ripened cheese.

To achieve this object the method of claim 1 requires the use of an "adjunct starter" in a conventional process for the preparation of foil-ripened Gouda or Edam cheese. This adjunct starter is used in addition to a conventional starter and is defined as having a higher proteolytic and/or peptidolytic capacity than conventional starters.

2.2 It is undisputed that processes for the preparation of Gouda or Edam cheese by using a conventional starter are already well known. The question to be answered in relation to sufficiency of disclosure in the present case is thus whether the patent specification provides sufficient guidance for the skilled person, being aware of the general common knowledge in the field, to choose suitable adjunct starters.

The respondent maintained that this information was lacking because the patent failed to define the appropriate reference point, namely the conventional starter(s), and the method for measuring the proteolytic and/or peptidolytic activity.

2.3 The board is, however, satisfied that the requirement of sufficiency is fulfilled for the following reasons:

2.3.1 The patent specification in paragraphs [0016]-[0017] indicates suitable adjunct starters to be used in the preparation of the cheese. These include known ripening accelerating starters which are commercially available and thermophilic and/or mesophilic species such as *Lactobacillus*. The examples in the patent in suit describe how Gouda or Edam cheeses are prepared using these adjunct starters (see Examples 1 to 3).

2.3.2 Moreover, the term "adjunct starter" for species having high proteolytic and peptidolytic activity is commonly used in the field. The patent itself makes reference in paragraph [0008] to D1, which discloses the use of adjunct starters in addition to conventional starters for making Cheddar cheese. Furthermore, the prior art cited in the proceedings uses the same terminology (see,

for instance, D5, Introduction; D11, pages 358-359, paragraph "15.5 ADJUNCT STARTERS"). Consequently, the skilled person is provided with the information necessary to choose suitable adjunct starters for the claimed process.

2.3.3 Concerning the further objections of the respondent that the scope of the claims was not commensurate with the contribution of the invention to the state of the art and that the claims might encompass methods in which the bitterness was not reduced, it appears that these objections relate rather to Article 56 and/or Article 84 EPC than to sufficiency of disclosure. In particular it is noted that claim 1 relates to a method of preparing foil-ripened cheese but not to the reduction of bitterness in a given product. Nor has any experimental evidence been provided showing that an embodiment covered by the claims could not be carried out.

2.4 For these reasons the board agrees with the finding in the appealed decision that the requirements of sufficiency of disclosure are met.

3. *Novelty (Article 54 EPC)*

3.1 The opposition division revoked the patent because in its opinion the disclosure of D5 anticipated all the technical features of claims 1 and 9 of the granted patent. The respondent raised further novelty objections in view of the disclosure of documents D1 and D8.

3.2 Claim 1 of the main request is directed to a method for preparing a foil-ripened cheese of the Gouda or Edam type having the following features:

- a) addition to cheese milk of
 - a1) a conventional amount of starter,
 - a2) an adjunct starter having a higher proteolytic and/or peptidolytic capacity,
- b) forming, in a conventional manner, a young cheese of the hard or half-hard type, which young cheese
- c) after brining,
- d) is packaged in foil and evacuated, and wherein
- e) the foil-packed cheese is subjected to a ripening at a temperature in the range of 10 to 16°C.

3.3 Document D5

3.3.1 In document D5 the effect of heat-shocked thermophilic species on proteolysis and flavour development in Gouda cheeses is studied (see title). Foil-ripened Gouda cheeses are prepared using a lactic starter culture and, as an adjunct to the lactic starter, several heat-shocked thermophilic species (see page 83, left column, "1. Introduction", last paragraph; page 83, right column, "2.2 Cheese manufacturing").

3.3.2 According to the disclosure of D5, thermophilic species such as *Str. thermophilus* 110, *L. bulgaricus* subsp. *jugurti* ATCC 12278, etc. were subcultured in non-fat dry milk before use and their growth was stopped by cooling the medium to 5°C or by immediately heat-shocking the culture. The cells were heat-shocked by adding 1.8 or 3.6 kg thermophilic culture to about 18 kg of whole milk at 70°C. After 18 sec, 77 kg of milk at 9°C were added for rapidly cooling the heated

milk to about 37°C (page 83, paragraphs bridging left and right column, "2.1 Culture preparation").

After heat shock, a lactic starter culture was added at the rate of 1% to the milk (page 83, right column, "2.2 Cheese manufacture").

3.3.3 The board agrees with the appellant that if one can speak about an adjunct starter in D5, then this adjunct starter is the heat-shocked thermophilic species obtained by adding a cultured thermophilic species to hot milk at 70°C. This is quite clear from the last paragraph of the introduction on page 83 of D5, where it is stated that "In the present study, whole cells of several thermophilic species were heat-shocked and added as an adjunct to lactic starter to determine their effect on proteolysis and flavor development in Gouda cheese."

Thus, the board cannot accept the respondent's argument that the addition of the cells to the hot milk is equivalent to the step required in claim 1, namely that the adjunct starter is added to cheese milk. In the process described in D5 the adjunct starter is formed *in situ* in hot milk to which further milk (in fact the majority of the milk) is added, followed by the addition of the lactic starter in order to start the cheese manufacturing process. Hence, contrary to the claimed process where an adjunct starter is added to the cheese milk (see above features a), a2)), in the process of D5 the milk is added to the adjunct starter formed *in situ*. Therefore, the process of claim 1 is not anticipated by the disclosure of D5.

- 3.3.4 The respondent also argued that the fact that the milk in D5 was added to the adjunct starter rather than the adjunct starter to the milk was a mere semantic issue without any technical relevance.

It may well be that the order of addition, namely A to B or B to A, does not have any technical relevance. Nevertheless, as far the assessment of novelty is concerned, it cannot be denied that in a process as set out in claim 1 the addition of A to B is not the same as the addition of B to A. Thus, the order of addition is not a mere semantic issue. Whether or not the different order of addition yields a different result is a question which may have to be discussed when evaluating inventive step.

3.4 Documents D1 and D8

- 3.4.1 Document D1 is directed to a process for the accelerated maturation of foil-ripened Cheddar cheese using a conventional starter and an adjunct starter (see page 898, right column, under "cheesemaking").

The respondent conceded that D1 was directed to a process for preparing Cheddar cheese but still argued that this disclosure was novelty-destroying for the subject-matter of claim 1 of the patent because the claim merely indicated that a Gouda or Edam cheese was prepared but did not specify this feature in one of the process steps (cf. feature b) of the claimed method).

The board cannot follow the respondent's objection. Claim 1 is directed to a method **for** preparing a cheese of the Gouda or Edam type, which is the same as a

method **of** preparing a cheese of the Gouda or Edam type. Thus, the indication of the product to be prepared is not just a purely subjective feature. On the contrary, the process must be carried out in such a way that a Gouda or Edam type cheese is indeed obtained. Therefore, the preparation of the product is in the board's view a feature of present claim 1 and constitutes a limitation of the claimed process.

Consequently, the process of claim 1 is novel over D1.

- 3.4.2 Document D8 relates to adjunct cultures in semi-hard cheeses, in particular Danbo cheeses (left column, first paragraph of "Experimental approach"). Danbo cheeses are cheeses of the Gouda type, as acknowledged by the appellant during the oral proceedings. In D8 different types of adjunct cultures are used to create different flavour notes in the cheese. D8 however does not indicate the process steps carried out in the preparation of the cheese (for instance no conventional starter is mentioned and the way in which the starters are added to the milk is not described). The board therefore agrees with the appellant that the rather general disclosure cannot anticipate the subject-matter of claim 1. At best, D8 might be an invitation to a skilled person to test particular adjunct cultures in preparing Danbo cheeses.

The board can also not accept the argument of the respondent that the skilled person, when carrying out the production of cheese according to D8, would automatically arrive at a method as presently claimed. Firstly, as pointed out above, there is no clear and unmistakable disclosure in D8 itself relating to the

method of producing the cheeses. Secondly, the respondent has not provided any evidence for this assertion.

3.5 For these reasons the board concludes that the subject-matter of claim 1 is not anticipated by the disclosures of D1, D5 or D8.

3.6 Claim 9 is directed to a foil-ripened cheese of the Gouda or Edam type, obtainable using the method according to any one of the preceding claims. Claim 9 is drafted in the form of a "product-by-process" claim. According to EPO practice this type of claim is allowed if the process parameters result in a product different from the known product. In order to acknowledge novelty for such a product claim it is therefore necessary to show that distinct differences exist in the properties of the products.

3.6.1 It is stated in the present specification that the obtained cheeses are not "significantly distinguished" from traditionally ripened cheeses (see example 1, paragraphs [0025]-[0027]; see also similar comments for the cheeses of examples 2 and 3). Thus the cheeses obtainable by the process of claim 1 cannot be distinguished from Gouda and/or Edam cheeses prepared by traditional methods and consequently the subject-matter of claim 9 lacks novelty against Gouda or Edam type cheeses obtained by conventional methods.

3.6.2 Although the issue relating to product-by-process claim 9 was raised by the board in its communication sent pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal of the EPO (OJ EPO

2007, 536), the appellant merely argued that the cheeses prepared by the claimed process differed from both natural cheeses and conventional foil-ripened cheeses as indicated on paragraph [0006] of the specification, but failed to indicate the properties which would allow the claimed cheeses to be distinguished from the known ones. In particular, the appellant noted that the claimed foil-ripened cheese lacked a rind, contrary to normal natural cheese, and that conventional foil-ripened cheeses had a rather flat flavour.

However, novelty for the claimed cheeses cannot be acknowledged by the absence of a rind. Firstly, the process of claim 1 is not limited to the preparation of rindless cheeses. Secondly, even if one concedes that foil-ripened cheeses are usually rindless, not every foil-ripened Gouda cheese is rindless, as can be seen from the disclosure of D5 where a foil-ripened Gouda cheese is prepared with a "light rind" (D5, page 83, right column, "2.2 Cheese manufacturing"). Nor can a possible unidentified different flavour justify the novelty of the claimed cheeses, as the flavour development depends on various factors, in particular the process conditions, which are not specified in the method claim.

- 3.7 For these reasons the subject-matter of claim 9 lacks novelty.
4. Since the subject-matter of claim 9 lacks novelty, the main request (claims as granted) is not allowable.

AUXILIARY REQUEST I

5. The claims of auxiliary request I are identical to the claims of the main request except that granted claim 9, the claim relating to a foil-ripened cheese of the Gouda or Edam type, has been deleted.

As set out above, the process of claim 1 of auxiliary request I is novel over the cited prior art (points 3.3 to 3.5) and fulfils the requirements of sufficiency of disclosure (point 2). Claims 2 to 8 are dependent claims and therefore also fulfil both requirements.

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

- 6.1 The board informed the parties in its communication dated 30 March 2011 that, if novelty were to be acknowledged, the board intended to remit the file to the opposition division for further prosecution in accordance with the appellant's request, because the issue of inventive step had not yet been dealt with by the opposition division.
- 6.2 Only during the oral proceedings before the board, that is to say at a very late stage of the proceedings, did the respondent request for the first time that a final decision be made by the board in relation to auxiliary request I, i.e. that the case not be remitted to the opposition division for the evaluation of inventive step. It argued that remittal would unnecessarily delay the proceedings.
- 6.3 Although Article 111(1) EPC does not guarantee the parties an absolute right to have all the issues of a

case considered by two instances (see in this respect e.g. decision T 1091/00, point 4 of the reasons), it is also well recognised that any party should if possible be given the opportunity of two readings of the important elements of the case.

In the present case the following points have to be considered:

- the opposition division only decided on novelty;
- the appellant has not commented on inventive step during the appeal proceedings;
- inventive step appears to be a crucial point in the present case; and
- the respondent was aware of the intention of the board to remit the case to the first instance and requested a final decision in relation to auxiliary request I only during the oral proceedings, thereby preventing an adequate preparation of this issue by the appellant.

6.4 Under these circumstances, the board considers it appropriate to allow the set of claims according to the appellant's auxiliary request I to be examined by two instances, and therefore exercises its discretion under Article 111(1) EPC to remit the case to the opposition division for further prosecution.

7. *Apportionment of costs (Article 104 EPC)*

- 7.1 The respondent requested a different apportionment of the costs. It argued that extra costs would arise due to remittal to the opposition division and that these costs could have been avoided if the appellant had maintained its auxiliary requests (cf. present auxiliary requests IV and V) before the opposition division.
- 7.2 Under Article 104(1) EPC, each party to the opposition or appeal proceedings must in general bear the costs it has incurred. The board cannot see any basis for ordering a different apportionment of costs in the circumstances of the present case. A departure from the principle requires special circumstances, such as improper behaviour, which makes it equitable to award costs against one of the parties.
- 7.3 It is clear that additional costs will be occasioned by a remittal. However, the board cannot see an abuse of procedure in the appellant's behaviour. It was the understanding of the appellant that the subject-matter of the claims of the main request and auxiliary request I before the opposition division was novel, and it had the right to defend these requests before the board of appeal. A different situation could have arisen if the board had not acknowledged the novelty of the claims of auxiliary request I. This not being the case, there is no need for the board to consider that possibility.
- 7.4 Therefore in the present situation the board does not see a compelling ground for departing from the

provisions of Article 104(1) EPC stipulating that, as a rule, each party bears the costs it has incurred.

7.5 The respondent's request cannot therefore be allowed.

AUXILIARY REQUESTS II TO V

8. In view of the fact that auxiliary request I is considered novel and that the board has decided to remit the case to the first instance for further prosecution, there is no need to decide on these requests.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution on the basis of claims 1-8 of auxiliary request I, filed with letter dated 15 June 2009.
3. The request for apportionment of costs is refused.

The Registrar:

The Chairman:

G. Röhn

W. Sieber