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**Datasheet for the decision
of 26 July 2012**

Case Number: T 1273/10 - 3.3.09

Application Number: 02732098.5

Publication Number: 1357801

IPC: A23G 3/20, A23G 4/00

Language of the proceedings: EN

Title of invention:
Three phase confectionary made by extrusion

Patentee:
Cadbury Adams USA LLC

Opponent:
Wm, Wrigley Jr, Company

Headword:
-

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

Keyword:
"Amendments - added subject-matter (yes, main and first auxiliary requests)"
"Inventive step (no, first auxiliary request)"

Decisions cited:
T 0686/91

Catchword:
-



Case Number: T 1273/10 - 3.3.09

DECISION
of the Technical Board of Appeal 3.3.09
of 26 July 2012

Appellant: Wm, Wrigley Jr, Company
(Opponent) 410 North Michigan Avenue, Wrigley Building
Chicago, Illinois 60611 - 4287 (US)

Representative: Davies, Christopher Robert
Dehns
St Bride's House
10 Salisbury Square
London EC4Y 8JD (GB)

Respondent: Cadbury Adams USA LLC
(Patent Proprietor) 2711 Centerville Road
Suite 400
Wilmington, DE 19808 (US)

Representative: Wilson Gunn
Charles House
148/9 Great Charles Street
Birmingham B3 3HT (GB)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
9 April 2010 concerning maintenance of the
European patent No. 1357801 in amended form.

Composition of the Board:

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

Summary of Facts and Submissions

- I. This decision concerns the appeal by the opponent against the interlocutory decision of the opposition division that European patent No. 1 357 801 as amended met the requirements of the EPC.
- II. In the notice of opposition, 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) and that the patent contained subject-matter which extended beyond the content of the application as filed (Article 100(c) EPC).

The documents submitted during the opposition proceedings included:

D2a: English language translation of
JP 60-70036 A (D2); and

D5: US 4,156,740 A.

- III. The opposition division's decision, which was announced orally on 2 March 2010 and issued in writing on 9 April 2010, was based on a main request and a first auxiliary request both filed during the oral proceedings before the opposition division.

Claims 1, 9 and 10 of the main request read as follows:

"1. A method of making a three-phase confectionery product having an outer shell layer of a first candy material, a middle layer of a second candy material,

and an inner core of a semi-liquid material, said method comprising the steps of:

extruding a first layer of a first candy material from a first extruder, said first layer of a first candy material forming the outer shell layer of the confectionery product;

extruding a second layer of a second candy material from a second extruder into said first layer of said first candy material, said second layer of said second candy material forming the inner middle layer of the confectionery product;

injecting into said second layer a third layer of a third candy material, said third candy material being a semi-liquid material and said third layer forming the center core of the confectionery product."

"9. The method as set forth in claim 2 further comprising the step of inserting a lollipop stick into each of the candy tablets."

"10. The method as set forth in claim 9 wherein the stick is only inserted into the first and second layers, maintaining the integrity of the second layer around the centre core of the confectionery product."

The first auxiliary request was identical to the main request except that in claim 1 the second candy material was defined to be "selected from a sugar or sugar-free hard or chewy candy, a toffee or caramel, or a gum or bubble gum".

IV. The opposition division's position can be summarized as follows:

The main request meets the requirements of Article 123(2) EPC. In particular, the embodiments of claim 10, where the middle layer material is different from gum or bubble gum, are based on the application as filed which provides the skilled person with the information that lollipop products can be produced with middle layers made from a material different from gum or bubble gum. The main request is however not novel in view of *inter alia* D2.

The first auxiliary request meets the requirements of Article 123(2) EPC. The subject-matter of the first auxiliary request is novel and inventive over the cited prior art. D5 teaches only a method for producing a two-layered confectionery product and the skilled person would thus not consult this document in order to produce a three-layered confectionery product. Though D2/D2a discloses a method for producing a three-layered confectionery product, the materials defined in claim 1 for the middle layer are not disclosed or suggested in this document.

V. On 9 June 2010, the opponent (in the following: the appellant) filed an appeal and, on the same day, paid the prescribed fee. The statement setting out the grounds of appeal was filed on 6 August 2010 including

D17: EP 0 775 446 A2; and

D18: GB 2 283 699 A.

VI. By its letter of 23 February 2011, the proprietor (in the following: the respondent) filed a reply to the appeal.

VII. With its communication of 31 January 2012, the board issued its preliminary opinion together with

D19: "Mochi Rice Cakes" from "Asian Food Grocer",
<http://www.asianfoodgrocer.com/category/mochi-rice-cakes>.

According to the preliminary opinion, it was questionable whether the specific way of inserting the stick as required by claim 10 in combination with the feature that the middle layer material is selected from toffee or caramel was disclosed in the application as filed. As to inventive step, it was said *inter alia* that D5 represented the closest prior art from which the claimed process differed in that, apart from the centre fill and the middle layer, a further outer layer was applied. It would need to be discussed during the oral proceedings what problem was solved by this distinguishing feature and whether the skilled person confronted with this problem would have arrived at the claimed process in view of D5 in combination with any of the further prior art documents, such as D2. As regards the appellant's objection of insufficiency of disclosure, this constituted a new ground of opposition, which could not be admitted into the proceedings given the respondent's objection.

VIII. With its letter of 26 June 2012, the respondent filed a reply to the board's preliminary opinion including first to third auxiliary requests and

D20: "Glutinous rice", excerpt from Wikipedia,
31 May 2012;

D21: "Pocky, Snacks, & Candy", 9 March 2012, <http://www.asianfoodgrocer.com/category/pocky-snacks-candy>; and

D22: "Wagashi Maniac", 9 March 2012,
<http://blog.wagashi-net.de/2010/05/shiroan-english/>.

IX. Equally by letter of 26 June 2012, the appellant filed its reply to the board's preliminary opinion.

X. On 26 July 2012, oral proceedings were held before the board. At the very beginning of the proceedings, the respondent withdrew its main and first auxiliary requests, so that its second and third auxiliary requests became its main and auxiliary requests, respectively. The appellant stated that it did not pursue its attack under Article 100(b) EPC.

Claims 1 and 10 of the second auxiliary request are identical to claims 1 and 10 of the main request before the opposition division (see point III above), except that in claim 1, the second candy material (forming the middle layer) is defined to be "selected from a sugar or sugar-free toffee or caramel, or a gum or bubble gum".

Claims 1 and 10 of the third auxiliary request are identical to claims 1 and 10 of the second auxiliary request, except that in claim 10, the second layer is defined to be a chewing gum or bubble gum material.

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

The second auxiliary request does not meet the requirements of Article 123(2) EPC. Firstly, the application as filed discloses "sugar or sugar-free" only in the more general context of hard or chewable candies while claim 1 refers now to "sugar or sugar-free toffee or caramel". Apart from that, sugar or sugar-free toffee or caramel appear not to exist. Secondly, claim 1 contains an open wording in the sense that the middle layer can contain additional materials apart from those specified in the claim. By contrast, these materials are presented in "closed wording" in the application as filed. Thirdly, the restriction of the middle layer material to toffee, caramel, gum or bubble gum in claim 1 represents an intermediate generalisation of the list of materials disclosed in the application as filed. Fourthly, the combination of the specific way of inserting the stick as required by claim 10 together with the feature that the middle layer is toffee or caramel and the centre fill is a semi-liquid material is not disclosed in the application as filed.

The third auxiliary request does not meet the requirements of Article 123(2) EPC either. In particular, the definition of the middle layer material in claim 10 as chewing gum is not disclosed in the application as filed.

Furthermore, the third auxiliary request is not inventive. The claimed process differs from the closest prior art D5 by way of the addition of an outer shell layer by coextrusion to the middle layer and centre fill. As the problem addressed in the opposed patent of preventing leakage of the centre fill material is already solved in D5, the objective technical problem can at most be the provision of an additional third taste. The solution to this problem chosen in the opposed patent, namely the addition of a third outer layer by coextrusion, is however obvious in view of D2, which provides a machine for adding a third layer by coextrusion.

XII. The respondent's arguments can be summarized as follows:

The appellant's arguments with regard to Article 123(2) EPC in view of the second auxiliary request are wrong. In particular, gum or bubble gum can be sugar-free and hence, the expression "sugar or sugar-free" in the application as filed also refers to gum or bubble gum. Furthermore, the expression "can be" used in the application as filed with regard to the middle layer material is open rather than closed. There is also no intermediate generalisation as alleged by the appellant as all that has been done in claim 1 is to include certain alternative embodiments disclosed for the middle layer in the application as filed. As to the objection raised against claim 10, the entire application as filed concerns lollipops and discloses also materials for the middle layer that are different from gum. It is thus clear that the middle layer of the

lollipops does not need to be a gum material in the application as filed.

The appellant's objection raised under Article 123(2) EPC against claim 10 of the third auxiliary request is also wrong as a gum as disclosed in the application as filed clearly implies a chewing gum.

As to inventive step of the third auxiliary request, D5 does not address the problem of leakage of the centre fill material and hence, in line with decision T 0686/91, cannot represent the closest prior art. Furthermore, this document does not indicate any interest in a three-layer product. It is true that D5 illustrates a possibility of leakage prevention by encapsulating a centre fill by a gum. However, in addition to leakage prevention, the three-layer product of the opposed patent gives a different taste experience as it releases three different flavours. If the skilled person were to try to make a three-layer product starting from D5, he would just coat the chewing gum layer of D5 with an additional material rather than adding a third layer by coextrusion. If coextrusion would have been so obvious, then it would have been done long before the priority date of the opposed patent.

XIII. The appellant requested that the decision under appeal be set aside and the patent be revoked.

XIV. The respondent requested that the decision under appeal be set aside and the patent be maintained on the basis of the claims of the second, alternatively the third auxiliary request filed with letter dated 26 June 2012.

Reasons for the Decision

1. The appeal is admissible.

Main request (previous second auxiliary request)

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

- 2.1 Claim 1 of this request differs from claim 1 as granted in that the middle layer material ("second candy material") is defined to be "selected from a sugar or sugar-free toffee or caramel, or a gum or bubble gum".

The only place in the application as filed where reference is made to toffee, caramel, gum and bubble gum as middle layer material is on page 13, lines 3-5. This passage reads as follows:

"The middle part or inner layer can also be a sugar or sugar-free hard or chewable candy, a toffee or caramel, or a gum or bubble gum material."

In this passage, the expression "sugar or sugar-free" clearly refers to the hard or chewable candy only (otherwise no indefinite article would be present before "toffee or caramel" such that the above passage would read "The middle part or inner layer can also be a sugar or sugar-free hard or chewable candy, toffee or caramel, or a gum or bubble gum material").

Consequently, this passage cannot create a basis for the feature "sugar or sugar-free toffee or caramel" in claim 1 of this request.

- 2.2 Claim 10 of this request contains the feature that a stick is inserted into the outer shell ("first") and middle ("second") layers of candy tablets made from the three-phase confectionery products.

The application as filed discloses two ways of inserting sticks into candy tablets, namely firstly inserting it into the outer shell layer of the candy tablet only (see figure 12) and, secondly, inserting it into the outer shell and the middle layer (see page 9, lines 28-29 and figure 3 in combination with the description of this figure on page 7, lines 2-5).

However, this second option, which is the one referred to in claim 10 of the present request, is disclosed only together with the embodiment that the middle layer is formed of a gum material. More particularly: (a) the passage on page 9 states that "*... the stick member S is only inserted into the candy portion C and gum portion G [which is the middle layer] of the lollipop 46.*" (emphasis and insertions added by the board); and (b) in the passage on page 7, the material G is described as soft gum or bubble gum.

Consequently, the specific method of inserting the stick into the candy tablets as required by claim 10 of the present request is disclosed in the application as filed exclusively with gum as the middle layer material. Contrary thereto, claim 10 of the request, by way of indirectly referring back to claim 1, covers

this method also for candy tablets with toffee or caramel as middle layer. These embodiments of claim 10 are therefore not based on the application as filed.

- 2.3 Consequently, claims 1 and 10 of this request do not meet the requirements of Article 123(2) EPC. The request is therefore for this reason alone not allowable.

During the oral proceedings, the respondent offered to delete the expression "sugar or sugar-free" in claim 1 of this request. However, in view of the fact that claim 10 was found not to meet the requirements of Article 123(2) EPC, the respondent in the end did not make this amendment.

Auxiliary request (previously third auxiliary request)

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

- 3.1 Claim 1 of this request is identical to claim 1 of the main request. For the same reasons as given above with regard to claim 1 of the main request, the feature "sugar or sugar-free toffee or caramel" in claim 1 of the auxiliary request does not meet the requirements of Article 123(2) EPC.

- 3.2 Compared to the main request, claim 10 of the present request has been amended by adding the wording "wherein the second layer is a chewing gum or bubble gum material".

The application as filed however exclusively discloses gum or bubble gum materials but does not contain any

disclosure of chewing gum. Therefore the definition of the second layer to be chewing gum is not based on the application as filed.

- 3.3 During the oral proceedings, the respondent offered to delete the expressions "sugar or sugar-free" and "chewing" from claims 1 and 10 of this request in order to meet the above objections. However, in view of the fact that the request was found not to be inventive (see point 5 below), the respondent in the end did not make these amendments.

4. *Novelty*

Novelty was not contested by the appellant and the board is also satisfied that the subject-matter as claimed in this request is novel.

5. *Inventive step*

- 5.1 The invention underlying the opposed patent concerns the preparation of three-layered confectionery products in which a semi-liquid centre fill material is encapsulated by a coextruded middle and outer shell layer with one of the preferred materials of the middle layer being a gum or bubble gum material (claim 1 and column 3, lines 47-49). The opposed patent addresses the problems of constraining the semi-liquid core from leaking during manufacture of the product (column 1, lines 29-33) and of providing a confectionery product that is able to release three flavours when being consumed (column 2, lines 19-33).

5.2 D5 relates to the preparation of a sugarless centre-filled gum wherein the sugarless gum composition can be extruded and wherein the sugarless liquid fill is not absorbed into the chewing gum shell (column 1, lines 6-9).

5.2.1 Consequently, D5 is directed to the preparation of the same type of product as the opposed patent, namely a product where a centre fill material is encapsulated by a gum shell. Furthermore, the problem addressed in D5, ie the prevention of the absorption of the centre fill material into the gum shell, is at least related to one of the problems dealt with in the opposed patent, namely the prevention of leakage of the centre fill material through the gum and outer shell layer. Therefore, D5 can be considered to represent the closest prior art.

5.2.2 Contrary to the respondent's assertion, this finding is in line with decision T 0686/91 of 30 June 1994 (not published in OJ EPO), which merely requires the closest prior art to refer to a problem that is related, and thus not necessarily identical, to that of the opposed patent (see point 4 of the Reasons: "*... a document not mentioning a technical problem that is at least related to that derivable from the patent specification, does not normally qualify as the description of the closest prior art on the basis of which the inventive step is to be assessed.*" (emphasis added)).

5.2.3 The sugarless centre-filled gum of D5 is produced by feeding a chewing gum containing a certain pre-mix composition into a gum extruder and extruding it through an orifice as a hollow-centred rope of chewing

gum and by injecting a centre fill formulation equally containing the premix composition into the hollow centre of the rope (column 3, lines 33-43 and column 4, lines 29-34).

In the same way as the gum-containing products of the opposed patent, the centre filled gum of D5 is a confectionery product. The method of preparing the centre filled gum in D5 thus corresponds to a method of making a confectionery product as required by claim 1.

The step described in D5 of extruding a chewing gum through an orifice as a hollow-centered rope of chewing gum corresponds to the step of "extruding a second layer of a second candy material selected from ... a gum ... from a second extruder" as required by claim 1.

The further step described in D5 of injecting the centre fill formulation into the hollow centre of the chewing gum rope in D5 corresponds to the step of claim 1 of "injecting into said second layer a third layer of a third ... material, ... and said third layer forming the centre core of the confectionery product".

Finally, the centre fill of D5 corresponds to the third material of the above process step of claim 1, ie a semi-liquid candy material. The centre fill of D5 is a "semi-liquid" as it is a moderately viscous liquid (column 2, lines 55-56). In this context, it should be noted that the opposed patent merely requires the semi-liquid centre fill to have "various viscosities" (column 8, lines 1-2). The centre fill of D5 is also a candy material as it contains exclusively edible components including at least one with a sweet taste

(sorbitol and optionally synthetic sweeteners). More particularly, the centre fill of D5 contains, as constituents of a "pre-mix composition", a natural or synthetic gum, glycerine humectant, sorbitol and optionally propylene glycol (column 1, lines 55-62), and optionally in addition flavour, colour and synthetic sweeteners (column 3, lines 15-19).

5.2.4 The method of claim 1 thus differs from D5 only by way of a further step of "extruding a first layer of a first candy material from a first extruder, said first layer of a first candy material forming the outer shell layer of the confectionery product".

5.3 As pointed out by the appellant and not disputed by the respondent, the problem of preventing leakage of the inner core material addressed by the opposed patent (see point 5.1 above) is already solved in D5 by encapsulating the centre fill by way of the hollow chewing gum rope. This problem thus cannot constitute the objective technical problem in view of D5.

As to the further problem addressed in the opposed patent, ie that of providing a confectionery product that is able to release three flavours when being consumed (see point 5.1 above), this problem is not solved by D5 as the product of D5 only releases two flavours when being consumed, namely that of the centre fill and that of the gum layer.

The problem underlying the opposed patent in the light of D5 thus is to provide a method that allows the preparation of confectionery products which are able to release three flavours when being consumed.

- 5.4 As a solution to this problem, the opposed patent (claim 1 of the present request) proposes a process for preparing a confectionery product characterized in that an additional outer shell layer ("first layer of a first candy material") is coextruded during the preparation of this product.
- 5.5 By way of this coextrusion step, a third layer is added to the confectionery product and thus a product is prepared which contains three materials and hence is able to release three flavours when being consumed, namely the flavour of the centre fill, that of the gum layer ("gum or chewy inner layer") and additionally that of the outer shell layer. The above problem thus is credibly solved.
- 5.6 The solution proposed by the opposed patent is however already known from D2 which discloses a process of preparing a three-layered frozen confection, by simultaneously extruding a bean jam as the centre fill, ice cream as the middle layer and a frozen confection as the outer shell layer (last paragraph on page 3 and the paragraph bridging pages 5 and 6 of the translation D2A).

Consequently, the skilled person starting from the product of D5 and looking for a method to prepare a product that releases three flavours would know from D2 that in order to achieve this, he simply needs to coextrude an outer shell layer, such as a frozen confection, on top of the gum layer in D5. He would thereby arrive at the process of claim 1.

5.7 With regard to inventive step, the respondent argued that the skilled person wanting to add an additional layer to the product of D5 would have simply coated this product with an additional layer rather than coextruding this layer onto the product. The respondent in particular pointed out that if it had been so obvious to add a third layer to the product of D5 (published in 1979) by coextrusion rather than by coating, then this would have been done long before the priority date of the opposed patent.

This argument is however not convincing. More particularly, it is not known why coextrusion was not used instead of coating in order to add a third layer. In fact, rather than being due to any required inventive ingenuity, it could also simply be that coextrusion is more complicated and/or more expensive than coating. The respondent's argument hence is nothing more than speculation and therefore cannot support any inventive step.

5.8 The subject-matter of claim 1 of the auxiliary request consequently lacks inventive step in view of D5 in combination with D2. The auxiliary request thus is not allowable.

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