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**Datasheet for the decision
of 31 May 2011**

Case Number: T 1548/10 - 3.3.09

Application Number: 04746600.8

Publication Number: 1645197

IPC: A23L 1/221

Language of the proceedings: EN

Title of invention:

Full-bodied taste enhancer containing product of decomposition
of long-chain highly unsaturated fatty acid or containing
extract therefrom

Applicant:

J-Oil Mills, Inc.

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

Relevant legal provisions (EPC 1973):

-

Keyword:

"Amendments - not allowable"

Decisions cited:

-

Catchword:

-



Case Number: T 1548/10 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 31 May 2011

Appellant:

J-Oil Mills, Inc.
8-1, Akashi-cho, Chuo-ku
Tokyo 104-0044 (JP)

Representative:

Strehl, Peter
Patentanwälte
Strehl Schübel-Hopf & Partner
Maximilianstrasse 54
D-80538 München (DE)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 19 February 2010
refusing European patent application
No. 04746600.8 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: W. Sieber
Members: N. Perakis
R. Menapace

Summary of Facts and Submissions

I. European patent application No. 04746600.8, based on international application PCT/JP2004/009131 and filed on 29 June 2004 in the name of J-Oil Mills, Inc., was refused by decision of the examining division announced orally on 28 January 2010 and issued in writing on 19 February 2010.

II. The decision was based on a main request (Claims 1-9) filed with letter dated 13 August 2009 and an auxiliary request (Claims 1-10) filed with letter dated 17 December 2009. The examining division held that the claimed subject-matter of both requests lacked novelty over prior art document D1: EP-A1-0 463 660.

III. On 22 April 2010 the applicant (appellant) lodged an appeal against the decision of the examining division and paid the appeal fee on the same day.

The statement setting out the grounds of appeal was received on 11 May 2010 including a new main (sole) request, new documents (References 1-4) and arguments regarding the amendments to the claims and the issues of novelty and inventive step.

IV. By its communication dated 19 January 2011 the board raised *inter alia* objections as regards the support of the amended claims and the clarity of the claimed subject-matter.

V. By letter of 14 March 2011 the appellant filed a new main request (Claims 1-6), which replaced the previous

request, and provided arguments in reply to the issues raised by the board.

Claim 1 of the new main request reads as follows:

"1. Use of decomposed substances of vegetable fat and oil composition comprising 1% by weight or more of an n-6 long-chain highly unsaturated fatty acid having 18 or more of carbon atoms and 3 or more of double bonds and/or an ester thereof, wherein the decomposed substances are obtainable by oxidation by heating at 80°C to 180°C for 0.5 to 72 hours, as a body taste improver."

VI. Oral proceedings were held before the board on 31 May 2011. During these proceedings the appellant requested that Claim 6 of the previously filed request be deleted in order to overcome a clarity objection raised by the board. Thus Claims 1 to 5 as filed with letter dated 14 March 2011 became the appellant's final (sole) request.

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of its sole request.

VII. The arguments of the appellant, as far as they are relevant for this decision, may be summarised as follows:

The subject-matter of Claim 1 met the requirements of Article 123(2) EPC. The fact that the fat and oil composition was a vegetable fat and oil composition, which was objected to by the board, was supported by

the originally filed application when considered as a whole, and in particular by the disclosure on page 4, paragraph 3 of the description. Furthermore, the examples disclosed compositions based on a PL oil (pure light oil) of vegetable origin.

Reasons for the Decision

1. The appeal is admissible.
2. Amendments of Claim 1 - Article 123(2) EPC
 - 2.1 Claim 1 is based on originally filed product Claim 3, which reads as follows:

"A body taste improver consisting of decomposed substances of fat and oil composition comprising a long-chain highly unsaturated fatty acid and/or ester thereof in an amount of 1% by weight or more."

The conversion of this product claim to a **use claim** as it now stands is not objectionable under Article 123(2) EPC.

- 2.2 As regards the further amendments to Claim 1, namely
 - the specification of the long-chain highly unsaturated fatty acid as a "n-6 long-chain highly unsaturated fatty acid having 18 or more of carbon atoms and 3 or more of double bonds", and
 - the reaction conditions under which the fat and oil composition is decomposed,

these amendments are clearly supported by the disclosure on page 5, third full paragraph, page 6, third full paragraph, and page 7, first full paragraph. Thus, the board is satisfied that the description provides the required support for these limitations.

2.3 However, there is no clear and unambiguous disclosure in the originally filed application which provides support for the limitation of the originally disclosed fat and oil composition to a **"vegetable"** fat and oil composition.

2.3.1 The appellant argued that this amendment is supported by the disclosure on page 4, paragraph 3 of the description. This passage reads as follows:

"However, there is a problem that the added flavor is volatilized during a heating treatment so that the given body taste can not be maintained. There is also a concern that cholesterol or saturated fatty acids contained in the animal fat and oil may adversely affect health. On the other hand, since the vegetable fat and oil contain a small amount of cholesterol or saturated fatty acids, foods cooked (*sic*) with the vegetable fat and oil would taste simple or plain, making foods that need body taste unsatisfactory."

It is apparent from this passage that the reference to "vegetable fat and oil" relates to the composition of a "healthy" food product, i.e. comprising no cholesterol, to which a flavour will be added in order to improve its taste. It does not relate to a composition which will be submitted to thermal oxidation in order to

generate decomposed substances. Thus, this part of the description does not relate to the subject-matter claimed and cannot arbitrarily be used to provide support of the feature in question.

- 2.3.2 The appellant's argument that the amendment is supported by the application as originally filed **when considered as a whole** is not convincing. Though the term "vegetable" is indeed recited many times in the application, it is never used in order to characterise the fat and oil composition, considered in its broadest definition, which will be subjected to oxidation by heating.

On the contrary, the general part of the description does not refer to the decomposition of a vegetable fat and oil composition. Page 6, last full paragraph, for example, refers to thermal decomposition, which "is conveniently done on a fat and oil composition comprising" the long-chain highly unsaturated fatty acid and/or the ester thereof. Neither this passage nor any other passage of the subsequent description specifies that the fat and oil composition is a vegetable one.

- 2.3.3 Finally, as regards the argument that a vegetable fat and oil composition is used in the examples, the board acknowledges that preparations 2, 4 and 6 (page 10, lines 7-14) use a vegetable oil in admixture with the required fatty acid of Claim 1. However, only a single type of vegetable oil is used in these preparations, namely PL oil, which is a low linolenic acid-containing rape seed oil (page 9, lines 19-20). In the board's view, this very specific disclosure cannot form a

proper basis for the generalisation to any vegetable fat and oil as required by Claim 1. Consequently, preparations 2, 4 and 6 are also unable to support the amendment in Claim 1.

2.4 In conclusion, the subject-matter of Claim 1 of the sole request of the appellant does not meet the requirements of Article 123(2) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Röhn

W. Sieber