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**Datasheet for the decision
of 24 July 2012**

Case Number: T 1555/10 - 3.3.09

Application Number: 95301641.7

Publication Number: 732056

IPC: A23G 3/30

Language of the proceedings: EN

Title of invention:

Continuous gum base manufacturing using highly distributive mixing

Patentee:

WM. WRIGLEY JR. COMPANY

Opponent:

Cadbury Adams USA LLC

Headword:

-

Relevant legal provisions:

EPC Art. 123(2), 111

Keyword:

"Added subject-matter - no"
"Remittal for further prosecution"

Decisions cited:

-

Catchword:

-



Case Number: T 1555/10 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 24 July 2012

Appellant: WM. WRIGLEY JR. COMPANY
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Respondent: Cadbury Adams USA LLC
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 11 May 2010
revoking European patent No. 732056 pursuant to
Article 101(3)(b) EPC.

Composition of the Board:

Chairman: W. Sieber
Members: J. Jardón Álvarez
K. Garnett

Summary of Facts and Submissions

I. The mention of the grant of European patent No. 0 732 056 in respect of European patent application No. 95301641.7, in the name of WM. WRIGLEY JR. COMPANY, filed on 13 March 1995, was published on 3 July 2002 (Bulletin 2002/27). The granted patent contained seventeen claims, claim 1 reading as follows:

"1. A single continuous process for producing a complete chewing gum base comprising the steps of:

- a) continuously adding first gum base ingredients comprising at least some elastomer, filler, and elastomer solvent into a continuous mixer;
- b) subjecting the elastomer, filler and elastomer solvent to sufficient highly dispersive mixing within the continuous mixer to produce a substantially smooth and lump-free mixture;
- c) adding second gum base ingredients comprising at least one or more fats or oils;
- d) subjecting the first and second gum base ingredients to sufficient highly distributive mixing within the continuous mixer to produce a substantially homogenous mixture; and
- e) continuously discharging the resulting chewing gum base from the continuous mixer while steps a), b), c) and d) are in progress."

Claims 2 to 17 were dependent claims.

II. A notice of opposition was filed by Cadbury Adams USA LLC on 3 April 2003 requesting revocation of the patent in its entirety, reference being made to

Articles 100(a), (lack of novelty and lack of inventive step), (b) and (c) EPC.

III. By its decision announced orally on 8 April 2010 and issued in writing on 11 May 2010, the opposition division revoked the patent because the claims of the main, first and second auxiliary requests contained subject-matter which extended beyond the content of the application as filed.

Claim 1 of the main request was based on claim 1 as granted; the only amendment made was the introduction of the words "as plasticizers" in step (c) after the word "oils".

The opposition division held that the original description required a certain order of incorporating the various components of the gum base, namely

- (most of the) elastomer, elastomer solvent and filler were added first in the continuous mixing process,
- next the intermediate viscosity ingredients were added,
- and finally the relatively low viscosity ingredients (including oils and fats) were added to the extruder.

The original specification hence ruled out any other order of incorporation of the components into the process. Contrary to the application as filed, claim 1 of all requests was held to allow a different order of incorporating the gum base components. In particular the claim allowed that at least some plasticizer be incorporated before or during the highly dispersive mixing step, because the wording of claim 1 did not exclude that step (c) could be performed before step (b).

- IV. On 15 July 2010 the patent proprietor (in the following: the appellant) filed an appeal and on the same day paid the prescribed fee. On 14 September 2010 the appellant filed the statement setting out the grounds of appeal including a main request and five auxiliary requests. The main, first and second auxiliary requests were identical to those before the opposition division. The appellant requested that the decision under appeal be set aside and the case be remitted to the opposition division for consideration of the remaining grounds of opposition.
- V. With its reply dated 16 March 2011 the opponent (in the following: the respondent) disputed the arguments submitted by the appellant and requested that the patent be revoked in its entirety. It maintained that the claims of all requests violated Article 123(2) EPC. Additionally, the respondent also raised objections in relation to novelty and inventive step.
- VI. On 2 February 2012 the board dispatched the summons to attend oral proceedings. In the annexed communication the board indicated the points to be discussed during the oral proceedings. The board also noted that, if any of the requests fulfilled the requirements of Article 123(2) EPC, remittal of the case to the opposition division for consideration of the remaining grounds of opposition appeared to be appropriate, in particular because the appellant requested such remittal despite the age of the patent.
- VII. By letter dated 13 April 2012 the respondent filed additional arguments. By letter dated 25 June 2012 the

appellant filed new first to eleventh auxiliary requests to replace its previous auxiliary requests on file.

VIII. Oral proceedings before the board were held on 24 July 2012. At the very beginning of the proceedings the appellant withdrew its previous main request (filed with the statement of grounds of appeal dated 14 September 2010). After the discussion of the first auxiliary request, the appellant filed a new first auxiliary request as a basis for maintenance of the patent, which it then made its main request.

The new main request corresponds to the main request before the opposition division except that in step (a) of claim 1 the word "extruder" is inserted between the words "continuous" and "mixer", and previous dependent claims 2 and 6 are deleted. Claim 1 reads as follows:

"1. A single continuous process for producing a complete chewing gum base comprising the steps of:

- a) continuously adding first gum base ingredients comprising at least some elastomer, filler, and elastomer solvent into a continuous extruder mixer;
- b) subjecting the elastomer, filler and elastomer solvent to sufficient highly dispersive mixing within the continuous mixer to produce a substantially smooth and lump-free mixture;
- c) adding second gum base ingredients comprising at least one or more fats or oils as plasticizers;
- d) subjecting the first and second gum base ingredients to sufficient highly distributive

- mixing within the continuous mixer to produce a substantially homogenous mixture; and
- e) continuously discharging the resulting chewing gum base from the continuous mixer while steps a), b), c) and d) are in progress."

IX. The arguments presented by the appellant may be summarised as follows:

- The opposition division was incorrect in its finding that none of the requests met the requirements of Article 123(2) EPC. There was a clear basis in the application as filed for all the features of claim 1. Moreover, it was normal practice to interpret the claims in a sensible manner. It was clear that claim 1, in referring to separate steps (a) to (e), and with the reference at the end of the claims to steps (a), (b), (c), and (d) being progressed at the same time as step (e), that the steps were carried out in that order in a "single continuous process".

- The suggestion of the opposition division that steps (b) and (c) could be reversed was clearly an interpretation of the claim which was not appropriate. Firstly, it was excluded by the language used. Secondly, it was technically very difficult to carry out highly dispersive mixing when fats and oils were present because these tended to lubricate the mixture and stop the filler being used as a processing aid, as explained in the application as filed. Thus one skilled in the art reading claim 1, and especially in the light of the application taken as a whole,

would readily understand that steps (a) to (e) were to be carried out in the listed order in the claimed process.

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

- The respondent did not object to the new main request being admitted into the proceedings but maintained that this request also included added subject-matter, exactly for the same reasons as the requests before the opposition division.

- The respondent did not dispute that the single features of the process steps had a basis in the application as filed. However, the claim wording did not require a specific order of the steps of the claimed process and therefore included an embodiment that the application as filed did not allow for. In particular the claim included within its scope the embodiment that step (c) can be performed before step (b), i.e. that fats and oils can be subjected to highly dispersive mixing. This embodiment had no basis in the application as filed. The "sensible" interpretation suggested by the appellant was not the only interpretation of claim 1. The skilled person could also interpret claim 1 as saying that steps (b) and (c) could be carried out in the reverse order.

- The respondent further supported this argument by reference to granted claims 3 and 4. In these claims it was specified that step (c) (or (d)) was

performed after step (b). Taking account of the repercussive effect of these dependent claims on claim 1 it was implicit that claim 1 also covered the embodiment where step (c) was performed before step (b), *i.e.* the fats and oils were added before the dispersive mixing step and were thus subjected to highly dispersive mixing.

XI. The appellant requested that the decision under appeal be set aside and the case be remitted to the opposition division for further prosecution on the basis of the main request filed during the oral proceedings, alternatively on the basis of one of the second to eleventh auxiliary requests filed with its letter dated 25 June 2012.

XII. The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

MAIN REQUEST

2. *Amendments*

2.1 Claim 1 is directed to a continuous process for producing a chewing gum base in which a portion of chewing gum base ingredients is subjected to a highly dispersive mixing operation prior to a highly distributive mixing operation. The process includes steps (a) to (e) as recited in claim 1.

2.2 The specific features of steps (a) to (e) are supported by the disclosure of the application as filed, in particular by claims 1 and 5 as filed in combination with the passage starting at page 4, line 23 up to page 5, line 29 of the description as filed and by claims 7 and 8 as filed.

2.3 The opposition division did not object to the support in the description as filed for the specific features of steps (a) to (e), but revoked the patent for the single reason that the process of claim 1 of all requests did not explicitly required any particular order for the steps (a) to (e) to be carried out. In the opposition division's opinion a different sequence was technically possible and still meaningful within the wording of the claim.

2.4 The board disagrees with this interpretation of claim 1 and considers that the only sensible interpretation of the claim is that the steps have to be carried out in the specified order (a) to (e).

As already acknowledged by the opposition division it is clear that step (a) must be carried out at the initial stage before any other step, that step (d) requires the presence of all the gum base ingredients (i.e. steps (b) and (c) must have been carried out at this stage), and that step (e), i.e. the discharging of the resulting chewing gum base, is carried out at the very end of the process.

In fact the only dispute between the parties was the order of steps (b) and (c). However, as explained below, it is clear that step (b) has to be carried out prior

to step (c). The board considers that the alternative embodiment suggested by the opposition division and the respondent, that step (c) could be performed before step (b), would be ruled out by the skilled person. Carrying out step (c) before step (b) would result in the following process:

"A single continuous process for producing a complete chewing gum base comprising the steps of:

- a) continuously adding first gum base ingredients comprising at least some elastomer, filler, and elastomer solvent into a continuous extruder mixer;
- c) adding second gum base ingredients comprising at least one or more fats or oils as plasticizers;
- b) subjecting the elastomer, filler and elastomer solvent to sufficient highly dispersive mixing within the continuous mixer to produce a substantially smooth and lump-free mixture;
- d) subjecting the first and second gum base ingredients to sufficient highly distributive mixing within the continuous mixer to produce a substantially homogenous mixture; and
- e) continuously discharging the resulting chewing gum base from the continuous mixer while steps a), b), c) and d) are in progress.

This process requires the addition of "second" gum base ingredients to the "first" gum base ingredients and then "subjecting" only the "first" gum ingredients, namely the elastomer, filler and elastomer solvent, but not the fats or oils, to highly dispersive mixing as required by step (b). This is illogical because all the gum base ingredients have already been added to the

extruder mixer. Consequently, this possibility is not in fact within the scope of the claim, and the skilled person reading claim 1 would understand that steps (a) to (e) are carried out in the listed order.

- 2.5 As to the argument of the respondent concerning the repercussive effect of granted claims 3 and 4 in the interpretation of granted claim 1 (granted claim 3 states that step (c) is performed after step (b), which, according to the respondent, clearly shows that the order could also be reversed), these claims have been deleted from the present request and therefore do not assist in the interpretation of the claim.

Moreover granted claims 3 and 4 were not present in the application as filed and cannot therefore be used for the interpretation of the content of the application as originally filed.

Similar considerations apply to granted claims 2 and 9, which have been also deleted from the present set of claims.

- 2.6 In summary, claim 1 has to be interpreted as directed to a continuous process wherein steps (a) to (e) are carried out in the specified order, something which is directly and unambiguously derivable from the application as filed. Any interpretation of the claim as including a process with the steps (a) to (e) carried out in different order is ruled out from the scope of the claim for the reasons given above.

- 2.7 Consequently, the subject-matter of claim 1 of the main request fulfils the requirements of Article 123(2) EPC.

3. *Remittal*

3.1 The board thus decides that the subject-matter of claim 1 of the main request overcomes the objections under Article 123(2) EPC forming the basis of the decision under appeal.

3.2 Since, however, the opposition division has not yet taken a decision on the other patentability issues, the appellant has requested remittal of the case to the opposition division for further consideration. Even the respondent considered the remittal to be appropriate in the present case.

3.3 Under these circumstances, the board considers it appropriate to exercise its discretion under Article 111(1) EPC to remit the case to the opposition division for further prosecution on the basis of the main request.

SECOND TO ELEVENTH AUXILIARY REQUESTS

4. In view of the fact that the the board has decided to remit the case to the first instance for further prosecution, there is no need to say anything about 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 the main request filed during the oral proceedings before the board.

The Registrar

The Chairman

G. Röhn

W. Sieber