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Datasheet for the decision of 9 October 2012

Case Number: T 2542/10 - 3.3.09

Application Number: 02738956.8

Publication Number: 1392126

IPC: A23J 3/14, A23J 1/16, A23J 1/00

Language of the proceedings: EN

Title of invention:
A method for improving a protein product

Patent Proprietor:
Coöperatie AVEBE U.A.

Opponent:
Emsland-Stärke GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 99(1), 114(1), 114(2), 83, 54, 56
EPC R. 106
RPBA Art. 12(2), 13(1), 13(3)

Keyword:
"Admissibility of late-filed documents"
"Admissibility of late-filed objection - no"
"Novelty - no (main request), yes (Auxiliary Claim Request IA)"
"Sufficiency of disclosure - yes (Auxiliary Claim Request IA)"
"Inventive step - yes (Auxiliary Claim Request IA)"
"Objection under Rule 106 EPC - dismissed"

Decisions cited:
G 0001/84, T 0156/84, T 0212/91, T 1002/92, T 0931/06, T 0593/09, T 1635/09

Catchword:
Admittance of documents filed late in appeal proceedings - relevance criterion (yes: point 2.2; no: points 2.3 and 2.4)

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 2542/10 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 9 October 2012

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Decision under appeal:
Interlocutory decision of the Opposition Division of the European Patent Office posted 25 October 2010 concerning maintenance of European patent No. 1392126 in amended form.

Composition of the Board:

Chairman: W. Sieber
Members: M. O. Müller
F. Blumer

Summary of Facts and Submissions

I. This decision concerns the appeals filed by the opponent and the proprietor respectively against the decision of the opposition division that European patent No. 1 392 126 as amended meets the requirements of the EPC.

II. 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 did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC).

The documents submitted during the opposition proceedings included:

D1: M.-C. Ralet et al, "Fractionation of Potato Proteins: Solubility, Thermal Coagulation and Emulsifying Properties", Lebensm.-Wiss. u. Technol., volume 33 (2000), pages 380-387;

D2: GB 1 544 812 A;

D7: WO 97/42834 A1;

D11: WO 97/03571 A1; and

D12: Ullmanns Encyklopädie der technischen Chemie, 4th edition, volume 19 "Polyacryl-Verbindungen bis Quecksilber", Verlag Chemie Weinheim, 1980, pages 495-497, 501.

III. The opposition division's decision announced orally on 14 September 2010 and issued in writing on 25 October 2010 was based on a main request (patent as granted) as well as an auxiliary request filed with letter of 19 January 2009. Granted claim 1 reads as follows:

"1. A method for treating a vegetable protein product, said method comprising adjusting the pH of a protein product to a value between 8 and 10.5, wherein during the pH adjustment the protein product is a cake or a paste or has a semi-dry form, and wherein said treatment results in the improvement of one or more functional properties of said protein product."

Claim 1 of the auxiliary request is identical to granted claim 1 except that the functional properties to be improved are defined as water- and/or fat-binding properties and that it contains the additional feature that the protein product has a solubility in water at a pH in the range of 5-10 of below 5 wt%, based on the weight of the solution.

In its decision, the opposition division argued essentially as follows:

Main request

The invention is sufficiently disclosed. There are six examples showing how to carry out the invention. There is in particular enough guidance to select suitable proteins. Furthermore, the mere fact that a claim is broad is not in itself a ground for considering the patent as not complying

with the requirement for sufficiency of disclosure. Finally the opponent has failed to provide convincing evidence that the invention would not work within the whole range claimed.

The subject-matter of the main request is novel over *inter alia* D2 as this document does not disclose the pH range and the cake, paste or semi-dry form as required by claim 1. However it lacks novelty in view of D12. This document discloses an undissolved protein (peanut) within a pH range of 8 to 10.5. Although the cake, paste or semi-dry form is not explicitly disclosed, it is implicitly derivable from figure 1 of D12. The solubility, a functional property, is improved.

Auxiliary request

The subject-matter of the auxiliary request is novel. In particular, D12 does not disclose the specific solubility and the improvement of the water-binding and/or fat-binding properties as required by claim 1.

The subject-matter of the auxiliary request is also inventive. D11 can be considered to represent the closest prior art. The difference over this prior art is the pH, the solubility in water and the cake, paste or semi-dry form. The objective technical problem is to find an improved alternative method. D11 itself suggests employing a pH of 1-5. D12 actually teaches away from the claimed pH range of 8-10.5 by suggesting staying in a pH range higher than 10.5. Otherwise the

solubility would decrease. There is also no hint to use a cake, paste or semi-dry form.

Inventive step can also be acknowledged over a combination of D2 and D12. These two documents do not solve the same problem as the granted patent. There is no incentive to combine these documents. These documents teach away from the claimed invention since they are interested in the solubility of the product and not in having it at least partly in dry form.

IV. On 23 December 2010, the opponent filed a notice of appeal against the above decision and paid the prescribed fee on the same day. A statement setting out the grounds of appeal was filed on 2 March 2011 together with

D13: USPTO office action of 27 September 2010;

D14: Römpp, 10th edition, volume 2, 1997, keyword "Eiweißhydrolysate"; and

D15: USPTO Advisory Action Before the Filing of an Appeal Brief.

V. On 17 December 2010, the proprietor filed a notice of appeal against the above decision (in Dutch, translation into English received on 29 December 2010) and paid the prescribed fee on 30 December 2010. A statement setting out the grounds of appeal was filed on 10 February 2011 together with a First Auxiliary Claim Request, the main request being maintenance of the patent on the basis of the claims as granted.

VI. As the opponent and the patent proprietor are both appellant and respondent in these appeal proceedings, for simplicity the board will continue to refer to them as the opponent and the proprietor.

VII. By its letter of 12 July 2011, the opponent submitted

D16: US 3,809,767 A;

D17: GB 1 575 052 A; and

D18: Römpp, 9th edition, 1995, keyword "Proteine".

VIII. By its letter of the same date, the proprietor submitted

D19: Food Science Sourcebook, second edition, part 1, "Terms and Descriptions", H. W. Ockerman, Van Nostrand Reinhold, New York, 1991, pages 700, 701 and 807.

IX. By its subsequent letter of 28 November 2011, the proprietor requested that documents D16-D18 not be admitted into the proceedings.

X. With its communication of 12 March 2012, the board issued its preliminary opinion. In this opinion, the admissibility of D16 and D17 was addressed. The main request (claims as granted) was considered to lack novelty in view of example XV of D16 but was regarded novel in view of D17. The First Auxiliary Claim Request was considered to lack clarity as claims 1 and 12 contradicted each other. Further, the First Auxiliary

Claim Request was considered to be novel over D12 and D16 as these documents did not disclose any thermocoagulation. As to inventive step, *inter alia* D16 was regarded as the closest prior art.

XI. By its letter of 8 May 2012, the proprietor filed a response to the summons together with a Third and Fourth Auxiliary Claim Request.

XII. By its letter of 7 September 2012, the opponent submitted:

D20: DE 28 19 626 A1.

XIII. On 9 October 2012, oral proceedings were held before the board.

The proprietor maintained its main request. After discussing sufficiency of disclosure, novelty and inventive step of the First Auxiliary Claim Request, the proprietor filed Auxiliary Claim Request IA in order to meet a clarity objection raised against claim 12 of the First Auxiliary Claim Request. This request replaced the previous First Auxiliary Claim Request. The proprietor also confirmed its request that documents D16 and D17 not be admitted into the proceedings. Additionally it requested that D20 not be admitted. The proprietor further requested that in the event that D16 was admitted into the proceedings, the case be remitted to the opposition division on the basis of the main request. The proprietor lastly requested that the opponent's objection raised against the novelty of claim 11 of Auxiliary Claim Request IA not be admitted into the proceedings.

The opponent requested that Auxiliary Claim Request IA not be admitted into the proceedings.

After the board had announced that the First Auxiliary Claim Request fulfilled the requirements of Articles 83, 123(2), 54 and 56 EPC, the opponent raised a first objection under Rule 106 EPC arguing that its right to be heard had been violated since the board had not considered D13 and D15 in the context of sufficiency of disclosure.

After a discussion of the subsequently filed Auxiliary Claim Request IA, the opponent raised a second objection under Rule 106 EPC, arguing that its right to be heard had been violated because the novelty of claim 11 had not been discussed. After the opponent had presented its arguments on novelty of claim 11, the board announced that this new novelty objection was not admitted. The opponent then confirmed its objection under Rule 106 EPC, arguing that its objection against claim 11 of Auxiliary Claim Request IA had not been properly heard.

XIV. The claims of the main request are the claims as granted (see point III above). Auxiliary Claim Request IA contains 4 independent claims, which read as follows:

"1. A method for treating a vegetable protein product isolated by thermal coagulation, said method comprising adjusting the pH of a protein product to a value between 8 and 10.5, wherein during the pH adjustment the protein product is a cake or paste or has a semi-

dry form, and wherein said treatment results in the improvement of the water-binding and/or fat-binding properties of said protein product."

"11. A protein product obtainable by a method according to any of the preceding claims."

"13. A food product comprising a protein product according to any of claims 11-12."

"16. Use of a protein product according to any one of claims 11-12 in a food product, to improve the water- and/or fat-retention of said food product."

XV. The opponent's arguments, in as far as relevant to the present decision, can be summarised as follows:

Admissibility of D16, D17 and D20

According to the opponent, example XV of D16 was *prima facie* relevant to the novelty of the main request. It was established case law that under these circumstances the document had to be admitted into the proceedings to avoid the maintenance of an invalid patent.

As to D17, the opponent argued in the written proceedings that the features of claim 1 were known from this document, alone or in combination with further prior-art documents. During the oral proceedings, the opponent argued that D17 constituted the closest prior art because it also concerned thermocoagulated vegetable proteins with a pH of up to 8.0. This document therefore was

prima facie relevant and should be admitted into the proceedings.

During the oral proceedings, the opponent explicitly stated that he was not using D20 for novelty. However, as this document referred to thermocoagulation and alkaline pHs it was relevant for inventive step and therefore should be admitted into the proceedings.

Main request (claims as granted)

According to the opponent, the main request lacks novelty in view of example XV of D16. Apart from the remaining features of claim 1 of the main request, this example also discloses the required improvement of functional properties. More particularly, as evidenced by figure 1 of D12, by increasing the pH in example XV to a value of 8.4, the solubility of the peanut protein is improved. Furthermore, as evidenced by column 4, line 24 of D16, this document in its entirety aims at an improved protein concentrate.

Auxiliary Claim Request IA

Auxiliary Claim Request IA should not be admitted into the proceedings as it was filed too late.

The opponent stated that it did not have any objections under Article 123(2) and 84 EPC.

According to the opponent, the invention underlying Auxiliary Claim Request IA is insufficiently disclosed for the following reasons:

- The vegetable protein product and the thermocoagulation by which it is obtained are not further defined in claim 1. It is therefore impossible to know the scope of claim 1 and the skilled person therefore could not deduce from the claim which protein products are to be used.
- Not all vegetable protein products, and in particular not all thermally coagulated vegetable protein products, are suitable for the claimed process. A selection of specific thermocoagulated protein products is therefore necessary in order to carry out the invention, while the opposed patent gives no guidance as to how to make this selection. An undue amount of experimentation in the sense of T 1635/09 is therefore required to carry out the invention, which means that the invention is insufficiently disclosed.
- As evidenced by D13 and D15, the proprietor had been forced by the USPTO to narrow down the claims much further than before the EPO. So, the USPTO had an opinion different from the EPO and this opinion is clearly relevant with regard to sufficiency of disclosure (see also the first objection under Rule 106 EPC, point XIII above).
- The dry material content of the protein product of claim 2 and the pH value of claim 17 are insufficiently disclosed.

According to the opponent, the subject-matter of Auxiliary Claim Request IA furthermore lacks novelty in view of D12 and D16.

- Figure 1 of D12 discloses a broad pH range of which the range as required by claim 1 is a sub-range. This sub-range does not meet the criteria established for the novelty of overlapping ranges. Moreover, the paragraph above this figure refers to denatured proteins, implying that the proteins, the water solubility of which is shown in figure 1, are thermally coagulated as required by claim 1.
- Example XV of D16 discloses all the features of claim 1, including the isolation of the protein product by thermocoagulation. Even if this were not the case, D16 in its entirety, in particular column 4, line 37 and column 9, lines 61 to 63, discloses the feature of thermocoagulation. Furthermore, at various places D16 discloses a heat treatment and this treatment is carried out under such conditions that the protein coagulates.

The opponent additionally argued that the product of claim 11 lacked novelty (see second objection under Rule 106 EPC, point XIII above). According to the opponent, this attack was not new but had been presented already on page 9 of the statement setting out the grounds of appeal and page 4 of its letter of 12 July 2011. This attack therefore should be admitted into the proceedings.

During the oral proceedings, the opponent explicitly stated that it was not attacking novelty on the basis of any document apart from D12 and D16.

As to the inventive step of Auxiliary Claim Request IA, the opponent explicitly stated during the oral proceedings that D16 rather than D12 constitutes the closest prior art. The subject-matter of this auxiliary request lacks inventive step in view of D16, taken alone or in combination with D2 (used in the written proceedings in view of the main request), D11 or D12. Any of these three documents discloses the isolation of vegetable proteins by thermocoagulation. Hence it is obvious to use a thermocoagulated protein in the process disclosed of D16.

XVI. The proprietor's arguments, in as far as relevant to the present decision, can be summarised as follows:

Admissibility of D16, D17 and D20

D16 should not be admitted into the proceedings. The opponent has changed its case numerous times by filing novelty objections only after the filing of the notice of opposition and by filing D16 so late in the present appeal proceedings. The opponent's behaviour therefore represents an abuse of proceedings. Furthermore, Article 12(2) RPBA requires the parties to present a complete case in the grounds or reply and this provision has not been met. In the event that D16 is admitted into the proceedings, the case should be remitted to

the opposition division on the basis of the main request.

D17 is not admissible either, because it lacks any relevance for inventive step as it refers to the use of yeasts in bread baking which is entirely different from the object of the opposed patent and as it furthermore does not mention the problem of improving water- and fat-binding properties.

D20 should not be admitted into the proceedings because it had been filed very late and was not relevant, as it does not address water-binding and fat-binding properties lost by thermocoagulation and, unlike the opposed patent, it deals with soluble proteins.

Main request (patent as granted)

The main request is novel in view of D16. Claim 1 requires the improvement of the functional properties to be due to the pH adjustment, while this is not necessarily the case in example XV. More particularly, in this example, prior to the pH adjustment further materials are removed from the raw material and this could equally be responsible for the improvement of the water absorption described in table XV D.

Auxiliary Claim Request IA

Auxiliary Claim Request IA should be admitted into the proceedings. This request constitutes a reaction to the clarity objection raised by the

board, in the summons to oral proceedings, against the First Auxiliary Claim Request then on file. Furthermore the amendment effected in this request was announced in the proprietor's letter of 8 May 2012. Finally, the amendment is merely the deletion of a dependent claim which the opponent could be expected to deal with during the oral proceedings.

The arguments presented by the opponent with regard to sufficiency of disclosure of Auxiliary Claim Request IA are not convincing for the following reasons:

- The opponent's objections merely relate to the broadness of claims, which as such is not a valid objection with regard to sufficiency of disclosure. Furthermore these objections, if anything, concern clarity rather than sufficiency of disclosure and clarity cannot be invoked because the objections relate to features that are part of granted claims.
- The opponent has not provided any evidence for its assertion that not all vegetable protein products are suitable for the claimed process. Furthermore, the description of the opposed patent, in particular paragraphs [0024] to [0026] and [0028], provides sufficient guidance to select suitable proteins and on how to carry out the thermocoagulation.
- The USPTO office actions D13 and D15 are not relevant because they do not relate to sufficiency of disclosure and, in any case, the patentability requirements of US examination are

different from those in EPO opposition proceedings.

The subject-matter as claimed in Auxiliary Claim Request IA is novel:

- Figure 1 of D12 relates to non-denatured proteins, not to the protein products isolated by thermocoagulation as required by claim 1. This is apparent from the passage referring to figure 1 which is clearly directed to soluble, non-denatured proteins. Furthermore, D12 does not disclose an improvement of water-binding and/or fat-binding properties of a protein product. In particular, water solubility as referred to in figure 1 of D12 is different from water-binding and/or fat binding properties.

- Example XV of D16 does not disclose a method for treating vegetable protein products isolated by thermocoagulation. As explicitly stated in column 32, lines 40 to 41 of D16, this example concerns the production of naturally-structured, soluble, peanut proteins. As evidenced by D1 and D7, this implies that no thermocoagulation occurs in this example, as thermocoagulation destroys the natural structure and leads to an insoluble product.

  Furthermore, as evidenced by column 3, lines 17 19 and column 6, line 55, D16, taken as a whole, teaches against thermally coagulating the vegetable proteins. This is consistent with the passages cited by the opponent which make it

clear that denaturation and hence thermal coagulation are to be avoided.

Moreover, even if the passages cited by the opponent disclosed the feature that the vegetable protein product is isolated by thermocoagulation, this feature was not disclosed in D16 in combination with the further features of claim 1.

Lastly, the opponent has not provided any evidence for its allegation that the heat treatment as disclosed in D16 leads to thermocoagulation. Therefore the opponent's argument that thermocoagulation is implicitly disclosed in this document is not convincing.

– The opponent's new novelty attack against claim 11 was put forward for the first time during the oral proceedings and thus was clearly filed late. Therefore it should not be admitted into the proceedings.

The subject-matter of Auxiliary Claim Request IA is inventive.

D7 constitutes the closest prior art. In view of this document, as well as D16, the closest prior-art document used by the opponent, the problem underlying the opposed patent is to provide an economically attractive method that allows the production of a protein product with satisfactory water- and/or fat-binding properties. This problem is solved in the

opposed patent by isolating the vegetable protein product by thermocoagulation and by adjusting the pH of the product to a value of between 8 and 10.5.

The isolation of vegetable protein products by thermocoagulation is an economically attractive method. However, as evidenced by D1 and D7, thermocoagulation destroys the protein's water-binding capacity. It has been found in the opposed patent that by subjecting such a product to the pH adjustment of claim 1, the water-binding properties can be improved. This is confirmed by the experimental data contained in the opposed patent.

As it follows from D16 that thermal coagulation decreases the water-binding capacity of protein products, the skilled person starting from this document and trying to improve water-binding capacity would not use proteins that have been thermally coagulated. The subject-matter of Auxiliary Claim Request IA is thus not obvious in view of D16 alone. There are furthermore no documents available that contain any indication that if one isolates vegetable proteins by thermocoagulation and thereby reduces their water- and fat-binding properties, these properties can be improved if the pH of the product is adjusted as required by claim 1.

XVII. During the oral proceedings, the board made the following observations:

As to novelty of the main request, it is not correct that claim 1 requires the improvement of the functional properties to be due to the pH adjustment. On the contrary, all that claim 1 of the main request requires is that a treatment comprising the pH adjustment leads to the improvement of the functional properties, and this is exactly what is disclosed in example XV of D16.

As to the novelty of claim 11 of Auxiliary Claim Request IA, the only argument made by the opponent in the written proceedings is that lack of novelty of a process automatically entails lack of novelty of the product obtainable by this process. However, the objection raised in the oral proceedings *de facto* implies that although the method differs from that disclosed in the prior art, the product obtainable by this method nevertheless lacks novelty. Such an objection is clearly different from the one raised in the written proceedings.

XVIII. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claims as granted (main request), or, subsidiarily, on the basis of Auxiliary Claim Request IA as filed during the oral proceedings before the board.

The appellant (opponent) requested that the decision under appeal be set aside and the patent be revoked.

Reasons for the Decision

1. The appeals are admissible.

2. *Admissibility of D16, D17 and D20*

2.1 The proprietor argued that the opponent has not provided any reason why the new documents were filed outside the nine-month period defined by Article 99 EPC. The documents were also not filed with the opponent's grounds of appeal, contrary to Article 12(2) RPBA. Furthermore, the new documents were *prima facie* clearly not more relevant than the documents already on file. Therefore, they should be not admitted into the proceedings.

2.2 It is true that D16 was submitted by the opponent well outside the nine-month period defined by Article 99(1) EPC, namely only with its letter of 12 July 2011 at the appeal stage.

2.2.1 However, according to Article 114(1) and (2) EPC, the European Patent Office shall examine the facts of his own motion while it may disregard facts or evidence which are not submitted in due time by the parties concerned. In the present case, it is thus at the board's discretion whether or not to admit D16.

2.2.2 According to decision G 1/84 of the Enlarged Board of Appeal (OJ EPO 1985, 299, point 3, first sentence) "… the elaborate provisions in the EPC for substantive examination and opposition are designed to ensure that only valid European patents should be granted and

maintained in force, so far as it lies within the power of the European Patent Office to achieve this."

This is confirmed by decision T 156/84 (OJ EPO 1988, 372), where the following is stated in the headnote: "The principle of examination by the EPO of its own motion (Article 114(1) EPC) takes precedence over the possibility of disregarding facts or evidence not submitted in due time. This follows from the EPO's duty vis-à-vis the public not to grant or maintain patents which it is convinced are not legally valid."

From the above, it follows that a document filed late in opposition-appeal proceedings may be admitted by the board, in particular in a situation where it is *prima facie* prejudicial to the maintenance of the patent (see also T 1002/92, OJ EPO 1995, 605, headnote; T 212/91 of 16 May 1995, point 2; and T 931/06 of 21 November 2008, point 3).

2.2.3 In the present case, example XV of document D16 is clearly novelty-destroying to the subject-matter of the main request (for details, see point 4 below). In view of its relevance, D16 therefore has to be admitted into the proceedings.

2.2.4 The proprietor's argument that the filing of D16 did not comply with the requirements of Article 12(2) RPBA, is debatable. According to this article, the statement of grounds of appeal and the reply shall contain a party's complete case. However, of significance in the present case is that both parties have appealed and the filing of D16 could be viewed as a reply to the proprietor's appeal.

But even assuming in the proprietor's favour that the filing of D16 is not in line with the requirements of Article 12(2) RPBA, the board has to take Article 13(1) RPBA into account, according to which any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the board's discretion, this discretion being exercised in view of *inter alia* the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

Concerning these criteria of Article 13(1) RPBA, the board takes the view that the disclosure of D16 is not so complex and the state of proceedings at which it was submitted is not so late as to justify non-admittance. As will be set out in point 4 below, the only relevant passage of D16 is the explicit disclosure in example XV, the relevance of which was specifically set out in the annex to the summons to oral proceedings dated 12 March 2012. The proprietor has not put forward any reason why the time remaining till oral proceedings (roughly half a year) was insufficient to deal with this disclosure of D16. In fact, the proprietor had ample time to react and did so by filing the Third and Fourth Auxiliary Claim Requests with its letter of 8 May 2012. Hence, the criteria referred to in Article 13(1) RPBA do not speak against the admittance of D16.

2.2.5 The proprietor further argued that an abuse of procedure has occurred, since the opponent has changed its case numerous times by filing novelty objections only after the filing of the notice of opposition and

by filing D16 so late in the present appeal proceedings. However no reason was given as to why this behaviour prevented the proprietor from defending its case properly. Therefore, no abuse of proceedings has occurred that could justify non-admittance of D16.

2.2.6 In view of the above, the board decided to admit document D16 into the proceedings.

2.3 D17 has been submitted by the opponent together with D16.

2.3.1 D17 describes a process comprising the steps of

- preparing an aqueous slurry of a protein material selected from a single-cell protein material, plant protein material, whey solids, or mixtures thereof,
- heating the slurry,
- adjusting the pH of the heated slurry to 6.6 to 8.0, and
- drying (page 2, lines 24 to 44).

2.3.2 As already set out in the annex to the summons to oral proceedings, a multiple selection is necessary in order to arrive at the subject-matter of claim 1 of the main request on the basis of D17, namely the selection of a plant protein material, a pH of 8.0, and a cake, paste, or semi-dry form during pH adjustment. Thus, in contrast to D16, D17 does not *prima facie* destroy the novelty of the claimed subject-matter.

Furthermore, D17 focuses on problems arising when using yeasts in bread baking (page 1, line 22 to page 2, line 23). This is entirely different from the aim of

the opposed patent, namely the improvement of water- and fat-binding properties of vegetable protein products. D17 thus is also not relevant to inventive step.

2.3.3 As no further arguments were advanced by the opponent as to why D17 would be *prima facie* prejudicial to the maintenance of the opposed patent, the board decided not to admit D17 into the proceedings.

2.4 D20 was submitted by the opponent with its letter of 7 September 2012, ie roughly one month prior to the oral proceedings.

2.4.1 During the oral proceedings before the board, the opponent explicitly stated that it was not using D20 against novelty and in fact exclusively presented arguments relating to lack of inventive step.

However, D20 clearly has no bearing on the inventive step assessment of the claimed subject-matter. While the opposed patent focuses on proteins with very low solubility in water (page 5, lines 21 to 22), D20 has the opposite objective, namely proteins that have been made soluble (page 4 of this document). Furthermore, D20 does not address the problem of the opposed patent, namely the improvement of water- and fat-binding properties.

2.4.2 The board therefore decided not to admit D20 into the proceedings.

3. *Request for remittal*

The proprietor requested during the oral proceedings that the case be remitted to the first instance on the basis of the main request, in the event that D16 was admitted into the proceedings. However, there is no absolute right to two instances, and in view of the fact that the proprietor had sufficient time to react to the filing of D16 (see point 2.2.4 above), the board decided not to remit the case to the first instance.

Main request (granted claims)

4. *Novelty*

4.1 D16 refers to a method of producing comestible, uniformly palatable, vegetable protein concentrates (column 1, lines 15 to 16).

Example XV of this document discloses a process comprising the steps of preparing an aqueous slurry of defatted, coarsely ground peanut meal, centrifuging the obtained slurry, re-slurrying the resulting solid, and centrifuging the obtained slurry. By way of this process, eight pounds ("lbs") of a wet protein material having 35% by weight solids (corresponding to 2.8 pounds of solid protein) is obtained. After being partly dried to a moisture content of 30.1 weight percent, the material is mixed with 70g of sodium hydroxide solution such that a pH of 8.4 is obtained, and the resulting product is dried.

As shown by table XV D of D16, this product has a cold and hot water absorption that is improved compared to

that of the defatted coarsely ground peanut meal starting material.

4.2 The defatted coarsely ground peanut meal used as starting material in the process of example XV corresponds to the vegetable protein product referred to in claim 1.

The step of mixing the partly dried product (obtained from the starting material by the centrifugation-re-slurrying sequence) with sodium hydroxide such that a pH of 8.4 is obtained corresponds to the step of adjusting the pH of the protein product to a value between 8 and 10.5 as required by claim 1.

At the start of the pH treatment, the partly dried material contains 2.8 pounds of solid protein and has a solids content of 69.9 wt% (moisture content of 30.1 wt%) (see point 4.1 above). The partly dried product is thus present in a paste, cake or semi-dry form. To this are added 70g of sodium hydroxide, which amount is low compared to the 2.8 pounds of solid protein. Hence, also during pH adjustment, the partly dried product is present in a paste, cake or semi-dry form, as is required by claim 1.

The improved cold and hot water absorption in D16 corresponds to the improvement of functional properties as required by claim 1. This is confirmed by column 4, lines 24 to 26 of D16, where it is stated that "our invention includes or relates to improved, edible, uniformly palatable, bland, nutritious, highly proteinaceous, vegetable protein concentrates" (emphasis added by the board).

Example XV of D16 thus discloses all features of granted claim 1.

4.3 While not disputing that the above features of claim 1 are disclosed in D16, the proprietor argued that claim 1 additionally required the improvement of the functional properties to be due to the pH adjustment, and that this was not necessarily the case in example XV. More particularly, in this example further materials are removed from the raw material prior to the pH adjustment, so that the improvement of the water absorption described in table XV D could be due to this removal rather than the pH adjustment.

The board does not accept this line of argument because, first of all, claim 1 does not require that the improvement of the functional properties is due to the pH adjustment. On the contrary, claim 1 refers to a "method for treating", said method comprising adjusting the pH wherein "said treatment results in the improvement of the one or more functional properties of said protein product". There can be no doubt that "said treatment" refers to the "method for treating" and this method **comprises** rather than **consists of** the pH adjustment. Hence all that claim 1 of the main request requires is that a treatment comprising the pH adjustment leads to the improvement of the functional properties, and this is exactly what is disclosed in example XV of D16. More particularly, the method disclosed in this example comprises a pH adjustment and, as evidenced by table XV D of D16, leads to an improvement of water absorption, an improvement of a functional property.

But even if claim 1 were to link the improvement of the functional properties to the pH treatment, this feature would still be disclosed in example XV of D16. As evidenced by figure 1 of D12, by increasing the pH of peanut protein to a value of 8.4 the solubility of the peanut protein increases. This finding is equally valid for the peanut protein of example XV of D16. As the improvement of functional properties in claim 1 is not further defined, this solubility increase would represent an improvement of functional properties as required by claim 1.

4.4 The main request (granted patent) therefore clearly lacks novelty in view of D16.

Auxiliary Claim Request IA

5. *Admissibility*

Auxiliary Claim Request IA was filed by the proprietor during the oral proceedings before the board. The opponent requested that this request not be admitted into the proceedings.

Auxiliary Claim Request IA differs from the proprietor's First Auxiliary Claim Request filed with its grounds of appeal in that claim 12 was deleted and the claim numbers and dependencies of the subsequent claims were adapted accordingly.

This amendment was already proposed by the proprietor on page 2 of its letter of 8 May 2012 and constitutes a reaction to the board's clarity objection raised

against the First Auxiliary Claim Request in the annex to the summons to oral proceedings. Furthermore, the deletion of one dependent claim (claim 12) does not raise any new issues which the opponent could not have been expected to deal with during the oral proceedings.

The board therefore decided to admit Auxiliary Claim Request IA into the proceedings.

6. *Amendments - Articles 123(2) EPC*

6.1 The opponent did not raise any objections and the board is satisfied that the requirements of this article are met.

More specifically, apart from the deletion of granted claims, the only amendments effected after grant in Auxiliary Claim Request IA are the introduction of the requirement that the vegetable protein product is isolated by thermal coagulation, and the definition of the functional properties as water-binding and/or fat-binding properties. These amendments are based on page 6, lines 21 to 22 and claim 4 (isolation by thermal coagulation) and on page 10, line 16 and claim 5 of the application as filed (definition of functional properties).

7. *Amendments - Article 84 EPC*

The opponent did not raise any objections under Article 84 EPC and the board is satisfied that the requirements of this article are met. The board notes in this respect that the opponent's objections raised with regard to sufficiency of disclosure, namely that

the vegetable protein product and the isolation by thermocoagulation are not further defined, cannot give rise to any clarity objection under Article 84 EPC. More specifically, any alleged lack of clarity would not arise out of an amendment but would have already been present in granted claims 1 and 4 and hence cannot be objected to under Article 84 EPC in opposition appeal proceedings.

8. *Sufficiency of disclosure*

8.1 The opponent argued that the claimed subject-matter is insufficiently disclosed because the vegetable protein product and the thermal coagulation by which it is obtained are not further defined in claim 1. According to the opponent, it was therefore impossible to know the scope of claim 1 as the skilled person could not deduce from the claim which protein products are to be used.

8.1.1 The board does not consider this argument convincing. It may well be that the claims are broad with regard to the definition of the thermally coagulated vegetable protein product. However, the broadness of a claim as such is not a valid objection with regard to sufficiency of disclosure.

8.1.2 Furthermore, even if it were true that the thermally coagulated protein product was so ill-defined that it was impossible to know the scope of claim 1, this, by itself, would not be a reason to deny sufficiency of disclosure as required by Article 83 EPC. What is decisive for insufficiency within the meaning of Article 83 EPC is whether the lack of definition of the

thermally coagulated protein products is such that the skilled person is not able, on the basis of the disclosure as a whole and using his common general knowledge, to identify (without undue burden) protein products that are suitable for the claimed process (see T 593/09; not published in OJ EPO; point 4.1.4 of the Reasons).

This condition is however not met in the present case. First of all, the opponent has not provided any evidence that not all vegetable protein products, and in particular not all thermally coagulated vegetable protein products, are suitable for the claimed process. Furthermore, the description of the opposed patent, in particular paragraphs [0024] to [0026] and [0028], provides sufficient guidance to select suitable thermocoagulated proteins. More specifically, paragraphs [0024] and [0025] set out in detail which additional materials may be comprised in the protein product, paragraph [0026] gives examples of specific protein products and paragraph [0028] contains details about how the thermocoagulation is to be carried out.

8.1.3 In support of its argument, the opponent cited decision T 1635/09. This decision is however of no relevance as it relates to second medical use claims in the field of biotechnology and refers *inter alia* to the question of the conditions under which experiments that may be objected to from an ethical point of view, but are necessary to carry out the invention, represent an undue burden. The board does not see the relevance of this question for the present case.

8.1.4 For all these reasons, the opponent's arguments must fail.

8.2 The opponent further argued that as evidenced by D13 and D15, the proprietor had been forced by the USPTO to narrow down the claims much further than before the EPO. So, the USPTO had an opinion different from the EPO and this opinion was clearly relevant with regard to sufficiency of disclosure.

D13 is a USPTO office action and D15 a USPTO Advisory Action before the Filing of an Appeal Brief, both issued by the USPTO examiner during the examination of the US counterpart of the opposed patent.

The patentability requirements of US examination are however not identical to those in EPO opposition proceedings. So if, for some reason, the US examiner found that the claims were too broad, this does not necessarily apply to the present proceedings. Furthermore, the US office actions focus on the relevance of a certain prior-art document and no arguments have been provided by the opponent why this should be relevant to sufficiency of disclosure.

The USPTO office actions can hence not support any insufficiency argument.

8.3 The opponent additionally argued in its letter of 2 March 2011 (page 7) that the dry material content of the protein product of claim 2 was insufficiently disclosed. However, this assertion was not supported by any argument, let alone evidence, and hence must fail.

8.4 Lastly, the opponent argued in its letter of 2 March 2011 (page 9) that the pH value of claim 16 was insufficiently disclosed. Again no argument or evidence was provided for this allegation and, if anything this allegation concerns lack of clarity rather than insufficiency of disclosure. Consequently, this argument must fail too.

8.5 Sufficiency of disclosure hence has to be acknowledged.

9. *Novelty*

9.1 During the oral proceedings, the opponent attacked the novelty of Auxiliary Claim Request IA on the basis of D12 and D16.

9.2 Novelty in view of D12

9.2.1 In the opponent's view, figure 1 of D12 was novelty-destroying for the subject-matter of claim 1.

Figure 1 of D12 shows the water solubility of peanut protein at various pH values in the range between 0 and 14. In the text relating to this figure (starting at the thirteenth line of the left-hand column on page 497), the following is stated (translation by the board):

"Non-denatured vegetable proteins have physico-chemical properties, which make them particularly suitable for certain functional applications. Apart from water solubility, the most important properties have been mentioned already in chapter 2.1.1. The solubility of

the proteins in water is dependent on the pH value. This is shown in figure 1 for peanut protein."

It is nowhere stated in this paragraph that the proteins, the solubility of which is shown in figure 1, have been isolated by thermocoagulation. On the contrary, the fact that they are described as non-denatured and water-soluble implies rather that they are not thermally coagulated.

9.2.2 To rebut this argument, the opponent referred to the paragraph subsequent to the passage discussed above where it is stated that by means of heating under moisture, too extensive drying and other processing treatments, proteins can be denatured, whereby their specific functional properties are usually lost (translation by the board). On the basis of this passage, the opponent argued that the proteins, the water solubility of which is shown in figure 1, are thermally coagulated.

In fact, the passage referred to by the opponent does not relate to figure 1 but teaches the reader that denaturation should be avoided in order not to lose the functional properties of the proteins.

9.2.3 The features of claim 1 that the vegetable protein has been isolated by thermal coagulation and that the method comprises adjusting the pH of the protein product to a value between 8 and 10.5 are thus not disclosed in D12.

9.2.4 Moreover, all that figure 1 of D12 discloses is that the water solubility of proteins can be modified by

adjusting the pH to certain values. Water solubility is however not the same as water- or fat-binding properties as referred to in claim 1. If, for example, the water solubility of a protein is too high, the protein completely dissolves and thereby exhibits zero water- and/or fat-binding properties. Consequently, the feature of claim 1 of a treatment that comprises the adjustment of the pH and that leads to the improvement of the water- and/or fat-binding properties is also not disclosed in D12.

9.2.5 The subject-matter of claim 1 and by extension of all remaining claims which directly or indirectly depend on claim 1 is thus novel in view of D12.

9.3 Novelty in view of D16

9.3.1 As has been set out above for the main request, example XV of D16 discloses the features of claim 1 of a method for treating a vegetable protein product, said method comprising adjusting the pH to a value of 8.4, wherein during the pH adjustment the protein product is a paste, cake or has a semi-dry form.

As has been further set out above, the treatment of example XV leads to improved cold and hot water absorption (table XV D), corresponding to the requirement of claim 1 that the treatment results in the improvement of the water-binding properties.

9.3.2 It was a matter of dispute between the parties whether novelty of the subject-matter of claim 1 could be acknowledged on the basis of the only further feature of claim 1 of Auxiliary Claim Request IA, namely that

the vegetable protein product is isolated by thermal coagulation.

9.3.3 This question has to be answered in the affirmative.

As explicitly stated in column 32, lines 40 to 41 of D16, example XV "concerns the production of a natural structured *[sic]*, soluble, peanut protein concentrate". The fact that the product of this example is "natural structured" and soluble clearly implies that no thermocoagulation occurs in this example, as thermocoagulation destroys the natural structure and leads to an insoluble product. This is confirmed by D1 (page 380, right hand column on the bottom) where it is stated that heat coagulation, which is equivalent to thermocoagulation, leads to "proteins that are denatured to an extreme extent, resulting in low nitrogen solubility and complete loss of the functional properties". The same conclusion can be drawn from D7 (page 1, lines 29 to 35), where it is said that "due to the heat coagulation, potato protein becomes denatured and as a consequence becomes devoid of functional properties ..." and that "even the most essential requirement for its application in the food industry, i.e. solubility in water, cannot be met".

Consequently, example XV of D16 does not disclose the feature of claim 1 that the vegetable protein product is isolated by thermal coagulation.

9.3.4 The opponent argued in this respect that D16 in its entirety disclosed the feature of thermocoagulation. The opponent specifically referred to column 4, line 37 where reference is made to "minimized denatured protein

characteristics" and to column 9, lines 61 to 63 according to which "the use of such controlled drying conditions does not present as severe a denaturation problem."

However, when taken as a whole, D16 in fact teaches not to thermally coagulate the vegetable proteins. Already when discussing the prior art, D16 (column 3, lines 17 to 19) states that "denaturation of vegetable protein decreases its ability to bind water and emulsify fat, which are important shortcomings." Also from column 6, line 55, it directly follows that denaturation of the protein is considered "undesired". This is consistent with the passages cited by the opponent which make it clear that denaturation and hence thermal coagulation is to be avoided.

Moreover, even if the passages cited by the opponent disclosed the feature that the vegetable protein product is isolated by thermocoagulation, this feature would not be disclosed in D16 in combination with the further features of claim 1. More particularly, in this case a multiple selection would be necessary to arrive at the claimed subject-matter, namely the pH as required by claim 1, the state of the protein (cake, paste, semi-dry) and, if disclosed at all, the isolation by thermocoagulation.

9.3.5 The opponent lastly argued that D16 disclosed at various places the drying of the protein product by a heat treatment and that this treatment was carried out under such conditions that the protein coagulates.

However, no evidence was provided for this statement, which is why the opponent's assertion must be disregarded.

9.3.6 In view of the above, it must be concluded that the subject-matter of claim 1 and by extension of all remaining claims which directly or indirectly depend on claim 1 differs from D16 in that the vegetable protein product, the pH of which is adjusted, is isolated by thermal coagulation. Novelty over D16 can hence be acknowledged.

9.4 During the oral proceedings, the opponent explicitly stated that it was not attacking novelty on the basis of any document apart from D12 and D16.

9.5 The subject-matter of claim 1 of Auxiliary Claim Request IA and by the same token of all remaining claims which directly or indirectly depend on claim 1 is thus novel.

10. *Inventive step*

10.1 The invention underlying the opposed patent concerns a method for preparing a protein product with improved functional properties, in particular improved water- and/or fat-binding properties (page 2, lines 3 and 52 to 55; page 5, lines 28 to 29; page 9, lines 1 to 2; table 2 and claim 5 of the opposed patent).

10.2 In the same way as the opposed patent, D16 deals with the provision of proteins with good water-binding properties (column 1, lines 51 to 52). In line with the

opponent's arguments, this document can therefore be considered to represent the closest prior art.

10.3 The problem underlying the opposed patent in the light of D16 is to provide an economically attractive method that allows the production of a protein product with satisfactory water- and/or fat-binding properties (page 2, line 58 to page 3, line 2 of the opposed patent in conjunction with the text passages mentioned in point 10.1 above).

10.4 As a solution to this problem the patent proposes a process according to claim 1 which is characterised in that a vegetable protein product isolated by thermocoagulation is treated by a method comprising adjusting the pH of the product to a value of between 8 and 10.5.

10.5 As set out by the proprietor during the oral proceedings and as not disputed by the opponent, the isolation of vegetable protein products by thermocoagulation is an economically attractive method. However, as evidenced by D1 (page 380, right-hand column, paragraph at the bottom) and D7 (penultimate paragraph on page 1), thermocoagulation destroys the proteins' functional properties, including their water-binding capacity. It has been found in the opposed patent that by subjecting such a thermocoagulated product to a pH adjustment as required by claim 1, the water-binding properties can be improved. This is confirmed by table 2 of the opposed patent. As shown in this table, a potato protein (Protastar), the pH of which has been adjusted to 8 and 9 (ie as required by claim 1), has a water-binding capacity of 4.6 and

5.8 (gram water/gram dry substance), compared to a water-binding capacity of 3.7 of the same potato protein adjusted to a pH of 7 (ie outside of the claimed range) and a water-binding capacity of 3.2 for the untreated protein. Additional evidence comes from table 6 of the opposed patent. This table shows the cooking loss of various potato proteins (Protastar), which is directly linked to the proteins' water-binding capacity (the higher this capacity, the lower the cooking loss). It follows from this table that if the pH of the potato protein is adjusted to 8.5 (ie within the claimed range), the cooking loss after sterilisation is significantly lower (14.2), ie better than if the pH of the protein is adjusted to 7.5 (ie outside of the claimed range) or if the protein is not treated at all (cooking loss of 16.1 and 21.0 respectively).

Consequently, the problem underlying the opposed patent has been credibly solved.

10.6 It remains to be examined whether in view of this problem, it was obvious to start from a vegetable protein isolated by thermocoagulation and to adjust its pH to a value as required by claim 1.

The opponent argued in this respect that the subject-matter of Auxiliary Claim Request IA was obvious in view of D16 alone or in combination with D2, D11 or D12.

10.6.1 As already set out above in point 9.3.4, D16 (column 3, lines 17-19) states that "denaturation of vegetable protein decreases its ability to bind water and

emulsify fat, which are important shortcomings." Also from column 6, line 55, it directly follows that denaturation of the protein is considered "undesired".

The skilled person starting from this document and trying to improve water-binding capacity would thus clearly not use proteins that have been thermally coagulated and hence denatured.

The subject-matter of Auxiliary Claim Request IA is thus not obvious in view of D16 alone.

10.6.2 Furthermore, neither D2 nor D11 discloses any adjustment of the pH to values as required by claim 1, let alone that such an adjustment improves the water-binding properties of thermally coagulated proteins.

10.6.3 Such an indication is also not derivable from D12. As has already been set out above when discussing novelty with regard to D12, this document does not refer to any improvement of water-binding properties. Nor does it contain an indication that these properties can be improved in thermally coagulated proteins by adjusting the pH as required by claim 1.

10.7 The subject-matter of claim 1 of Auxiliary Claim Request IA and by extension of all remaining claims which directly or indirectly depend on claim 1 is thus inventive.

11. *First objection under Rule 106 EPC*

After the announcement of the board's conclusion on sufficiency of disclosure, novelty and inventive step

with regard to the then First Auxiliary Claim Request (which was eventually replaced by Auxiliary Claim Request IA), the opponent raised an objection under Rule 106 EPC that its right to be heard had been violated because it had not been given the opportunity during the discussion of sufficiency of disclosure to present its arguments with regard to documents D13 and D15.

The board allowed the objection under Rule 106 EPC and gave the opponent the opportunity to present its arguments on sufficiency of disclosure on the basis of the two documents. After having heard the parties' submissions on D13 and D15 and an interruption of the oral proceedings for deliberation, the board indicated that the arguments based on D13 and D15 could not alter its conclusion with regard to sufficiency of disclosure.

12. *Second objection under Rule 106 EPC*

12.1 After having discussed the patentability issues raised by the parties with respect to the First Auxiliary Claim Request and Auxiliary Claim Request IA, which had been filed in order to overcome a clarity objection to the First Auxiliary Claim Request and eventually replaced this request, the opponent raised a second objection under Rule 106 EPC. Allegedly its right to be heard had been violated because the novelty of the subject-matter of claim 11 of Auxiliary Claim Request IA had not been discussed. This claim reads as follows:

"11. A protein product obtainable by a method according to any of the preceding claims."

12.2 After the opponent having been invited to clearly identify the objection against claim 11, it was a matter of dispute whether this attack had already been made in the written proceedings or whether it was being put forward for the first time during the oral proceedings. Thus, before deciding on the objection under Rule 106 EPC, the board had to decide on the admissibility of the "new novelty attack" first.

12.2.1 The opponent argued in this respect that it had already attacked the novelty of the product claim on page 9 of its grounds of appeal (letter of 14 December 2010) and on page 4 of its letter of 12 July 2011.

On page 9 of the grounds of appeal, the following is stated with regard to claim 12 of the request maintained by the opposition division:

"Anspruch 12:
Ein Produkt eines aus D2 oder auch D11 bekannten Verfahrens ist als direktes Verfahrensproduct nicht schutzfähig." (translation by the board: "Claim 12:
A product of a process known from D2 or D11 is not protectable as a direct result of this process")

On page 4 of the letter of 12 July 2011: the following is said:

"Da in D13 (now D16) bzw. D14 (now D17) die gleichen Verfahrensschritte wie im Streitpatent angewendet werden, ist davon auszugehen, dass das direkte

Verfahrensprodukt die gleichen Eigenschaften wie das Verfahrensprodukt des Streitpatentes hat." (insertions in brackets by the board) (translation by the board: "As in D13 (now D16) and D14 (now D17), the same process steps are applied as in the contested patent, it must be assumed that the product directly resulting from this process has the same properties as the product obtained by the process of the contested patent").

12.2.2 As explained by the board during the oral proceedings and as not disputed by the opponent, the argument presented in the above passages during the written proceedings is merely that lack of novelty of a process automatically entails lack of novelty of the product obtainable by this process. But the objection raised now in the oral proceedings *de facto* implies that, although the method differs from that disclosed in the prior art, the product obtainable by this method nevertheless lacks novelty. Such an objection is clearly different from the one raised in the written proceedings.

Consequently, the opponent's objection made during the oral proceedings represents a new objection that has not been raised before in the appeal proceedings.

12.2.3 According to Article 13(3) RPBA, such an objection is not admitted into the proceedings if it raises issues which the board or the other party cannot reasonably be expected to deal with without adjournment of the oral proceedings.

The opponent's new novelty attack is based on the argument that the difference between the claimed process and that disclosed in the prior art does not affect the properties of the obtained product. With regard to D16, this implies, for example, that despite the fact that no thermocoagulation is carried out in D16, the product obtained in this document is identical to that of claim 11.

If one were to admit the opponent's new novelty attack into the proceedings, sufficient time would have to be given to the proprietor to react, eg by filing corresponding experimental counter-evidence in order to rebut the opponent's argument, ie to show that the difference between the claimed process and that of the prior art in fact results in a difference in the obtained products. To do so, the oral proceedings would have had to be adjourned.

12.2.4 The board therefore decided not to admit the opponent's new novelty attack into the proceedings.

12.3 Nevertheless, the opponent maintained its objection under Rule 106 EPC, arguing that the objection against claim 11 of Auxiliary Claim Request 1A had not been properly heard.

12.4 However, the opponent had the opportunity to present its arguments on its new novelty attack, and in fact did so, when discussing the admissibility thereof. Consequently, the opponent's right to be heard cannot have been violated.

12.5 Furthermore, the board notes that the opponent presented its new novelty attack only (i) after both parties had discussed sufficiency of disclosure, novelty and inventive step of the First Auxiliary Claim Request, (ii) after the board had announced its opinion that the subject-matter of the First Auxiliary Claim Request was sufficiently disclosed, novel and inventive, (iii) after the opponent had declared that it had no further objections with regard to subsequently filed Auxiliary Claim Request IA (which differed from the First Auxiliary Claim Request basically in the deletion of a dependent claim), and (iv) only after the board had indicated that Auxiliary Claim Request IA would be allowable.

The opponent thus had the opportunity to present its arguments on novelty of the subject-matter of claim 11 of Auxiliary Claim Request IA at least twice during the oral proceedings, namely when discussing novelty of the First Auxiliary Claim Request (which contained an identical claim 11) and when asked as to whether it had further objections with regard to Auxiliary Claim Request IA (see penultimate paragraph on page 6 of the minutes). These discussions were in no way restricted by the board to any specific claim, and the board at no point during this discussion cut the opponent short. On the contrary, as set out above, the board even asked the opponent in the context of the newly filed Auxiliary Claim Request IA whether it had any further objections. It is not clear to the board why the opponent did not raise its objection against claim 11 at the appropriate time during the oral proceedings. It is noted in this context that it is the parties' duty and responsibility to raise all

objections they consider relevant for a certain issue when this issue is being discussed. If a party chooses not to do so, it cannot later claim that it had no opportunity to raise the objection.

12.5.1 The board therefore dismissed the opponent's second objection under Rule 106 EPC.

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 with the order to maintain the patent on the basis of claims 1-17, filed as Auxiliary Claim Request IA during the oral proceedings before the board, and a description yet to be adapted.

The Registrar: The Chairman:

M. Cañueto Carbajo W. Sieber