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**Datasheet for the decision
of 23 October 2012**

Case Number: T 2401/11 - 3.3.09

Application Number: 07843196.2

Publication Number: 2068651

IPC: A23L 1/236

Language of the proceedings: EN

Title of invention:

Calorie reduced beverages employing a blend of neotame and acesulfame-K

Applicant:

PepsiCo, Inc.

Headword:

-

Relevant legal provisions:

EPC Art. 109(1)
EPC R. 103(1)(a)

Keyword:

"Reimbursement of appeal fee after rectification of decision (no) "

Decisions cited:

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Catchword:

-



Case Number: T 2401/11 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 23 October 2012

Appellant:
(Applicant)

PepsiCo, Inc.
700 Anderson Hill Road
Purchase
New York 10577 (US)

Representative:

Duxbury, Stephen
Arnold & Siedsma
Pettenkoferstraße 37
D-80336 München (DE)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 3 March 2011
refusing European patent application
No. 07843196.2 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: W. Sieber
Members: W. Ehrenreich
K. Garnett

Summary of Facts and Submissions

- I. European patent application No. 07 843 196.2 filed as international application No. PCT/US2007/079483 on 26 September 2007 in the name of *PepsiCo, Inc.* was refused by the decision of the examining division issued in writing on 3 March 2011. The decision was based on the set of claims 1 to 15 filed by fax on 24 February 2010.
- II. The examining division essentially held that the applicant had failed to address the issue of conciseness in respect of claims 1 and 9 in view of Article 84 EPC in combination with Rule 43(2) EPC, either by submitting arguments as to why the claims complied with Rules 43(2)(a), (b) or (c) EPC or by filing amended claims. The examining division stated that the applicant had had the opportunity to comment on the above point and had made no request for oral proceedings.
- III. On 21 April 2011 the applicant (hereinafter: the appellant) filed a notice of appeal and a statement setting out the grounds of appeal including new claims 1 to 8. The prescribed fee was paid on the same day. The appellant requested:
- that the examining division rectify its decision according to Article 109(1) EPC on the basis of amended claims 1 to 8;
 - oral proceedings if the examining division did not rectify the decision according to Article 109(1) EPC;

- costs.

IV. In the event, the examining division rectified the decision and examination proceedings were continued. The only remaining issue in the appeal is a request for reimbursement of the appeal fee based on an alleged procedural violation.

V. On 20 March 2012 the board issued a communication in which the provisional and non-binding opinion of the board was set out. The Board stated its view that no procedural violation had occurred. With a letter dated 18 May 2012 the appellant informed the board that its request for oral proceedings was withdrawn but otherwise has not filed any further submissions in the appeal.

VI. In the statement of grounds of appeal the appellant submits that a convincing argument had been advanced in the examination proceedings why the relevant claims which it had filed (i.e. claims 1 and 9 of the set of claims 1 to 15 underlying the appealed decision) were allowable and argues further that all other substantive objections had been overcome or were not relied on by the examining division in its decision. In addition to this the appellant argues as follows:

(a) The examining division's communication dated 2 October 2009 did not contain a statement saying that a failure to provide an amended set of claims complying with Rule 43(2) EPC or to submit convincing argument as to why the current set of claims did so comply would lead to refusal;

- (b) If such a statement had been made, the appellant would have requested oral proceedings;
- (c) Oral proceedings were not requested since a fully substantive response had been filed;
- (d) In fact the majority of the objections and all the substantive objections had been overcome;
- (e) No opportunity to comment on the objection to the newly filed claims 14 and 15 had been provided;
- (f) In fact there was a clear distinction between the independent product claims;
- (g) Generally, the issuing of a decision after only one communication, when the appellant had filed a substantive response, went against the legitimate expectations of the appellant that a further communication would be issued substantiating the opinion that the product-by-process claim (i.e. claim 9) was unallowable.

Reasons for the Decision

1. The appeal is admissible.
2. The only issue remaining in the appeal is whether a reimbursement of the appeal fee pursuant to Rule 103(1)(a) EPC would be equitable by reason of a substantial procedural violation made by the examining division in the impugned decision. The appellant's case

and its arguments are set out in the statement of the grounds of appeal, summarised at Point VI, above.

3. These arguments are not accepted by the board for the following reasons, which correspond to the reasons given by the Board in its preliminary opinion of 20 March 2012 (Point V, above).
 - 3.1 In the communication of the examining division sent to the appellant on 2 October 2009 an objection was raised (in point 2.4) that claims 1 and 9 of the set of claims submitted with the letter of 16 June 2009 did not comply with Article 84 EPC in combination with Rule 43(2) EPC. In this respect the examining division said that an application could contain more than one independent claim in a particular category only if the subject-matter claimed fell within one or more of the exceptional situations set out in paragraphs (a), (b) or (c) of Rule 43(2) EPC. It was noted that this was not the case since claim 1 was, strictly speaking, a preferred embodiment of claim 9. The examining division then warned the appellant that failure to file an amended set of claims which complied with Rule 43(2) EPC, or to submit convincing arguments as to why the then current set of claims did not in fact comply with these provisions, might lead to refusal of the application under Article 97(2) EPC.
 - 3.2 In its letter dated 24 February 2010 the appellant did not respond in substance to the above objections. With reference to point 2.4 of the examining division's communication, it was merely submitted that product-by-process claims (i.e. claim 9 of the set of claims) were common practice at the European Patent Office, and in

no way presented a skilled person reading the claims with an unclear situation. No amendment to claim 9 was made in the new set of claims enclosed with this letter of response, nor did the appellant address the point that claims 1 and 9 were both product claims (and therefore were of the same category).

3.3 The decision of the examining division was therefore based on a ground on which the appellant had had an opportunity to comment and the appellant had no legitimate reason to expect a further communication relating to this issue before refusal of the application on the ground of Article 84 EPC in combination with Rule 43(2) EPC. The right to be heard pursuant to Article 113(1) EPC was therefore not infringed by the appealed decision.

3.4 The new points raised in the appealed decision about new claims 14 and 15 of the set of claims underlying this decision do not appear to affect this conclusion. The points were new, but the examining division took the view that the problem which it had with claims 1 and 9 remained and was only exacerbated by the new claims 14 and 15.

Order

For these reasons it is decided that:

The request for reimbursement of the appeal fee is refused.

The Registrar

The Chairman

M. Canueto Carbajo

W. Sieber