

Internal distribution code:

- (A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [-] To Chairmen
(D) [X] No distribution

**Datasheet for the decision
of 30 January 2014**

Case Number: T 2638/11 - 3.3.09
Application Number: 07787191.1
Publication Number: 1893033
IPC: A23C11/10, A23L1/105, C12N1/04
Language of the proceedings: EN

Title of invention:
METHOD FOR PREPARING A DAIRY ANALOGUE

Patent Proprietor:
Alpro Comm. VA.

Opponents:
Sigma-Tau Pharmaceuticals, Inc.
Unilever N.V.
DuPont Nutrition Biosciences ApS
CHR. HANSEN HOLDING A/S

Headword:

Relevant legal provisions:
EPC Art. 54
RPBA Art. 13(1), 13(3)

Keyword:
Novelty - product by process claim (no, main request and auxiliary request 2)
Late-filed auxiliary requests - admitted (no, auxiliary requests 1 and 3)

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 2638/11 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 30 January 2014

Appellant I: Sigma-Tau Pharmaceuticals, Inc.
(Opponent 1) 9841 Washingtonian Blvd. Suite 500
Gaithersburg MD 20878 (US)

Representative: Ferreccio, Rinaldo
Botti & Ferrari S.r.l.
Via Cappellini, 11
20124 Milano (IT)

Appellant II: CHR. HANSEN HOLDING A/S
(Opponent 4) Bøge Allé 10-12
DK-2970 Hørsholm (DK)

Representative: Grünecker, Kinkeldey,
Stockmair & Schwanhäusser
Leopoldstrasse 4
80802 München (DE)

Respondent: Alpro Comm. VA.
(Patent Proprietor) Vlamingstraat 28
8560 Wevelgem (BE)

Representative: Vanhalst, Koen
De Clercq & Partners cvba
E. Gevaertdreef 10a
9830 Sint-Martens-Latem (BE)

Party as of right: Unilever N.V.
(Opponent 2) Weena 455
3013 AL Rotterdam (NL)

Representative: Wurfbain, Gilles L.
Unilever Patent Group
P.O. Box 137
3130 AC Vlaardingen (NL)

Party as of right: DuPont Nutrition Biosciences ApS
(Opponent 3) Langebrogade 1
P.O. Box 17
1001 Copenhagen K (DK)

Representative: Cabinet Plasseraud
52, rue de la Victoire
75440 Paris Cedex 09 (FR)

Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 19 October 2011 rejecting the opposition filed against European patent No. 1893033 pursuant to Article 101(2) EPC.**

Composition of the Board:

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

Summary of Facts and Submissions

- I. This decision concerns the appeals filed by opponent I (Sigma-Tau Pharmaceuticals, Inc.) and opponent IV (CHR. Hansen Holding A/S) against the decision of the opposition division to reject the oppositions against European patent No. 1 893 033.
- II. Oppositions were filed by opponent I, opponent II (Unilever N.V.), opponent III (Danisco A/S, later renamed to DuPont Nutrition Biosciences ApS), and opponent IV requesting revocation of the patent in its entirety on the grounds that the claimed subject-matter was neither novel nor inventive (Article 100(a) EPC; opponents I-IV) 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; opponents I, III and IV).

The documents submitted during the opposition proceedings included:

D13: GB 1 287 379.

- III. In its decision, announced orally on 13 September 2011 and issued in writing on 19 October 2011, the opposition division rejected the oppositions.

Independent process claim 1 and independent product-by-process claims 14, 18 and 19 as granted read as follows:

"1. A method for preparing a dairy analogue comprising the steps of:

- a) isolating one or more lactic acid bacteria from their natural environment or from a culture collection on a suitable animal-free isolation medium;
- b) adapting said isolated bacteria by growing said bacteria on a suitable animal-free adaptation medium;
- c) culturing said adapted bacteria in a suitable animal-free culture medium, and
- d) preparing a dairy analogue by adding to said dairy analogue as a starting material a suitable amount of bacteria obtained in step c);

wherein steps a) to d) are carried out under animal-free conditions."

"14. A dairy analogue obtainable by the method of any of claims 1 to 13."

"18. A bacteria culture comprising one or more lactic acid bacteria that have been isolated and adapted by growing on a 100% vegetable isolation and adaptation medium, respectively."

"19. Lactic acid bacteria that have been isolated and adapted by growing on a 100% vegetable isolation and adaptation medium, respectively."

IV. In its decision, the opposition division essentially reasoned as follows:

The invention underlying the opposed patent was sufficiently disclosed.

The claimed subject-matter was also novel. As regards D13, there was no unambiguous disclosure of an isolation step on an animal-free medium. The wording "isolated from spontaneously fermenting vegetable material" in D13 did not provide any detail about any potential medium for the isolation of the lactic acid bacteria. The carrot juice in D13 was used in a later step, after the bacteria had been isolated. Thus, it could not be concluded that the isolation step was carried out on carrot juice as the animal-free medium. Further, the lactic acid bacteria strains that were selected and adapted in D13 were not necessarily selected for an animal-free medium. Thus, there was no proof or indication that these would have survived an isolation in an animal-free medium. Therefore it could not be unambiguously established that the lactic acid bacteria strains and cultures of D13 were as required by claim 1. This document therefore also did not disclose the dairy analogue of independent claim 14 which comprised the lactic acid bacteria obtained by the method of claim 1.

The claimed subject-matter finally was also inventive.

- V. On 19 December 2011, opponent I (hereinafter: "appellant I") filed an appeal and, on the same day, paid the prescribed fee. As communicated to opponent I on 19 March 2012, it appeared from the file that a written statement of grounds of appeal had not been filed and that it was therefore to be expected that the appeal would be rejected as inadmissible pursuant to Article 108 EPC in conjunction with Rule 101(1) EPC.

- VI. On 28 December 2011, opponent IV (hereinafter: "appellant II") filed an appeal and, on the same day,

paid the prescribed fee. With the statement setting out the grounds of appeal, which was filed on 29 February 2012, appellant II requested that the appealed decision be set aside and the patent be revoked. Additionally, the reimbursement of the appeal fee was requested.

- VII. With its letter of 19 July 2012, the proprietor (Alpro Comm. VA.; hereinafter: "the respondent") filed a response together with a retyped version of the claims as granted (main request) as well as auxiliary requests 1 to 6.
- VIII. On 20 June 2013, the board communicated its preliminary opinion to the parties. As regards the product-by-process claims, ie claims 14 to 23 as granted, the board noted that while D13 appeared to disclose adaptation in an animal-free medium, it did not disclose any isolation in such a medium. As regards the product-by-process claims the relevant question was whether the difference in the process referred to in the claims over that disclosed in D13 always and unequivocally led to a distinguishing product feature. The examples of the opposed patent did not establish the presence of any such distinguishing product feature, since in the comparative examples of the patent adaptation was done in an animal-derived rather than in an animal-free medium as in D13.
- IX. With letter of 6 December 2013, the respondent re-filed the claims as granted (main request) and replaced the previous auxiliary requests by new auxiliary requests 1 to 3.
- X. With letter of 30 December 2013, a response was filed by appellant II.

XI. On 30 January 2014, oral proceedings were held before the board. During the oral proceedings, the respondent maintained its main request filed during the written proceedings and submitted new auxiliary requests 1 to 3 as replacement of all previous auxiliary requests. Appellant II withdrew its request for reimbursement of the appeal fee.

Claim 1 of auxiliary request 1 reads as follows:

"1. A method for preparing a dairy analogue comprising the steps of:

- a) isolating one or more lactic acid bacteria from their natural environment or from a culture collection on a suitable animal-free isolation medium;
- b) adapting said isolated bacteria by growing **and at least once re-plating** said bacteria on a suitable animal-free adaptation medium, **wherein during said re-plating operations the largest bacterial colonies are selected;**
- c) culturing said adapted bacteria in a suitable animal-free culture medium, and
- d) preparing a dairy analogue by adding to said dairy analogue as a starting material a suitable amount of bacteria obtained in step c);

wherein steps a) to d) are carried out under animal-free conditions." (differences to main request highlighted).

Claims 1 and 14 of auxiliary request 2 read as follows:

"1. A method for preparing a dairy analogue comprising the steps of:

- a) isolating one or more lactic acid bacteria from their natural environment or from a culture collection on a suitable animal-free isolation medium;
- b) adapting said isolated bacteria by growing **and at least once re-plating** said bacteria on a suitable animal-free adaptation medium;
- c) culturing said adapted bacteria in a suitable animal-free culture medium, and
- d) preparing a dairy analogue by adding to said dairy analogue as a starting material a suitable amount of bacteria obtained in step c);

wherein steps a) to d) are carried out under animal-free conditions."

"14. A dairy analogue obtainable by the method of any of claims **2** to 13."(differences to main request highlighted).

The claims of auxiliary request 3 differ from those of auxiliary request 2 in that all product claims have been deleted.

XII. So far as relevant to the present decision, appellant II's arguments can be summarised as follows:

- Main request

The product of claim 14 of the main request lacked novelty in view of example 1 of D13. This example disclosed the step of mixing a seeding culture with carrot juice, which corresponded to the claimed process step (d) of preparing a diary analogue. The previous step of mixing a parent culture with carrot juice corresponded to the claimed culturing step (c) with the carrot juice being an animal-free medium. The steps prior to this culturing step, in which bacteria derived from an older batch of carrot juice were adapted to a new carrot juice batch, corresponded at the same time to the claimed isolation and adaptation steps (a) and (b). It was important in this respect that, contrary to the respondent's assertion, the claimed isolation step did not require any streaking or re-plating operation since, according to the patent, isolation was one single handling step. In the same way, the claimed adaptation step did not require any re-plating operation since adaptation was defined in the claim itself purely to mean growing. Irrespective of this, even if re-plating operations would be part of the claimed process, this would not lead to a novel product. Contrary to the respondent's assertion, re-plating did not necessarily mean that only the largest colonies were selected. On the contrary, this was a preferred embodiment in the patent only, such that the claims included re-plating operations, in which half or more of the

bacterial colonies were selected. Consequently, the result of the claimed process was a variety of differently adapted bacterial colonies, as was the case in the process disclosed in example 1 of D13.

- Auxiliary request 1

Auxiliary request 1 should not be admitted into the proceedings. It was filed late and not caused by any new objections. Furthermore, this request raised new issues, since the feature inserted into claim 1, namely that during the re-plating operations the largest bacterial colonies were selected, lacked clarity. More specifically, it was not clear whether in each re-plating operation the largest colony or the largest colonies had to be selected. In the latter case it was furthermore not clear how many of the colonies had to be chosen. Furthermore, this newly introduced feature raised new issues as regards Articles 123(2) and (3) EPC.

- Auxiliary request 2

The claims of auxiliary request 2 did not meet the requirements of Articles 84 and 123(3) EPC. Furthermore, as regards novelty, nothing had changed compared to the main request. D13 already disclosed the new feature that the dairy analogue was fermented and in the same way as with regard to the main request, the re-plating operation did not mean the selection of the largest colonies. Consequently, the product of claim 14 was not novel in view of D13.

- Auxiliary request 3

This auxiliary request should not be admitted into the proceedings since it was filed too late. Furthermore, until this request was filed, appellant II had only needed to concentrate on the product claims whereas, by the deletion of these claims, the focus of the proceedings had changed.

XIII. So far as relevant to the present decision, the respondent's arguments can be summarised as follows:

- Main request

The product obtained by the claimed process was novel over example 1 of D13. Firstly, it was difficult to compare the bacteria of D13 with those used in the claimed process since it was unclear what the process in D13 actually started from (this argument was put forward during the written proceedings only). Secondly, the process by which the bacteria were prepared according to claim 14 differed from that of D13 in terms of the isolation and adaptation steps and therefore the bacteria resulting from the claimed process were different from those obtained in D13. More specifically, the claimed isolation step (a) and the subsequent adaptation step (b) each implied a re-plating operation, which implied in turn the steps of first diluting the bacteria on a medium by a streaking procedure, subsequently letting the bacteria grow into individual bacterial colonies and finally selecting among these colonies the largest and thus most adapted one. Consequently, unlike in D13, a double selection of bacteria was

carried out in the claimed process and this double selection implied that only one bacterial strain being the one that was most adapted to the animal-free medium was obtained and hence present in the claimed dairy product. Contrary thereto, the bacteria in the carrot juice of D13 were a mixture of different strains with different degrees of adaptation. Finally, it was confirmed by the examples of the opposed patent that the bacteria in the claimed product were different from those of D13.

- Auxiliary request 1

The insertion of the feature that the largest colonies were selected in each re-plating operation was a response to the board's finding during the oral proceedings that this selection could not be considered to be implied by the claimed adaptation step. Hence, this restriction could not have been made at an earlier stage of the proceedings. Furthermore, this insertion did not give rise to any deficiency under Article 84 EPC. No matter how this feature was interpreted, ie whether this feature required the selection of one or more colonies in each re-plating operation, each interpretation in itself was clear.

- Auxiliary request 2

It could be deduced from the examples of the opposed patent that re-plating affected the obtained product. Since such a re-plating operation was not disclosed in D13, the claimed product was novel over this document. Furthermore,

it would have been for the opponent to show that the claimed product was identical to that of D13.

- Auxiliary request 3

Auxiliary request 3 should be admitted into the proceedings. All that had been done was to delete the product claims that had caused problems. The request was not divergent and it was legitimate to defend the patent as broadly as possible. Furthermore, the claims of auxiliary request 3 did not present any new issues since the claimed method, to which the request was now restricted, had already been discussed in detail.

XIV. During the oral proceedings, the board made the following additional observations:

As regards the admissibility of auxiliary request 1, the feature that the largest colonies were selected could already have been introduced with the response to the grounds of appeal and at the latest in reply to the board's preliminary opinion, where it had been made clear that the claimed adaptation step might be considered anticipated by D13.

This feature could also not be considered to represent a reaction to a new objection introduced by the board during the oral proceedings. Firstly, this allegedly new objection, namely the finding that the selection of the largest colonies could not be read into the adaptation step of claim 1, was a reaction to an argument presented by the respondent itself. Secondly, this finding could have been expected by the respondent since appellant II had already explained in the written

proceedings that the claimed adaptation step did not imply any selection.

XV. Appellant II requested that the decision under appeal be set aside and the patent be revoked.

XVI. The respondent requested that the appeal be dismissed, alternatively that the decision under appeal be set aside and the patent be maintained on the basis of auxiliary requests 1, 2 or 3, all as filed during the oral proceedings before the board.

Reasons for the Decision

Admissibility of the appeals

Appellant I did not file any statement of grounds of appeal. Therefore, pursuant to Rule 101 EPC, the appeal of appellant I is inadmissible.

The appeal of appellant II is admissible.

Main request (claims as granted)

1. Novelty

1.1 Claim 14 of the main request is a product-by-process claim that refers to a dairy analogue obtainable by the method of *inter alia* claim 1. This method comprises the steps of:

- a) isolating one or more lactic acid bacteria from their natural environment or from a culture collection on a suitable animal-free isolation medium;

- b) adapting said isolated bacteria by growing said bacteria on a suitable animal-free adaptation medium;
- c) culturing said adapted bacteria in a suitable animal-free culture medium, and
- d) preparing a dairy analogue by adding to said dairy analogue as a starting material a suitable amount of bacteria obtained in step (c);

wherein steps (a) to (d) are carried out under animal-free conditions (for the exact wording of claims 1 and 14, see point III above).

It was a matter of dispute between the parties whether the claimed product is novel over the product obtained by the process of example 1 of D13.

1.2 This example discloses a product obtained by:

- (i) isolating a mixture of strains of the genera *Lactobacillus salivarius*, *Lactobacillus casei*, *Streptococcus lactis* and *Streptococcus cremoris* (which are all lactic acid bacteria, see claims 8 and 9 of the main request) from spontaneously fermenting vegetable material or from human mucous tissues and breeding the isolated bacteria in 500 ml Erlenmeyer flasks which contain 300 ml previously sterilised carrot juice;
- (ii) propagating the bacteria by seeding a new flask containing carrot juice with 1 ml of the old culture of step (i) every three days to obtain a parent culture;

- (iii) seeding three flasks each containing 10 litres of carrot juice with 300 ml of the parent culture;
- (iv) breeding the seeded juice of step (iii) at 37°C for 14 hours to obtain a secondary culture;
- (v) adding 30 litres of this secondary culture to 100 litres of pasteurised, unfermented carrot juice to obtain a seeding culture; and
- (vi) adding 120 litres of this seeding culture to 4000 litres of carrot mash to ferment this mash.

1.3 As not disputed by the respondent, breeding step (iv) in the above sequence of D13 corresponds to the claimed culturing step (c).

As not disputed by the respondent either, steps (v) and (vi) each correspond to the claimed process step (d) with the carrot juice and mash used in these steps corresponding to the dairy analogue of step (d) (see the definition of dairy analogues on page 7, line 58 to page 8, line 1 of the opposed patent).

1.4 The issue of novelty over example 1 of D13 therefore boils down to the question of whether steps (i) to (iii) of this example are different from the claimed process steps (a) and (b) and, if so, whether any difference in these process steps leads to a difference as regards the obtained products.

1.4.1 The respondent argued in this respect as follows: The claimed isolation and adaptation steps (a) and (b) each implied a re-plating operation, which implied in turn the steps of first diluting the bacteria on a medium by a streaking procedure, subsequently letting the bacteria grow into individual bacterial colonies and finally selecting from among these colonies the largest and thus most adapted one. Consequently, unlike in D13, a double selection of bacteria was carried out in the claimed process and this double selection implied that only one bacterial strain being the one that was most adapted to the animal-free medium was obtained and hence present in the claimed dairy product. Contrary thereto, the bacteria in the carrot juice of D13 were composed of a mixture of different strains with different degrees of adaptation.

1.4.2 As regards the outcome of process steps (i) to (iii) in D13, the board shares the respondent's view that this will be a mixture of differently adapted strains. More specifically, by being repeatedly grown and sub-cultured in carrot juice (an animal-free medium) in steps (i) to (iii) of D13, the bacteria's metabolism will become gradually adapted to the carrot juice with some strains adapting more rapidly than others such that after steps (i) to (iii), a mixture of differently adapted strains results.

1.4.3 As regards the claimed step (a), it is at least debatable whether this step indeed implies a re-plating operation, in particular in view of the fact that claim 1 is silent about re-plating and since the isolation step in the patent (page 4, lines 52 to 56) is defined as one single handling step of bringing the bacteria on the isolation medium, without any re-plating operation being mentioned either. For the sake

of argument, the board will however assume in the respondent's favour that the claimed isolation step indeed comprises a re-plating operation.

- 1.4.4 In the same way, it is debatable whether the claimed adaptation step (b) implies a re-plating operation since this step is defined in the claim to be done "by growing", without mentioning any re-plating. However, again, for the sake of argument, the board assumes in the respondent's favour that this step in claim 1 implies that a re-plating operation to be carried out.
- 1.4.5 Finally, the board acknowledges that re-plating implies **some** selection of bacterial colonies among those formed during re-plating.
- 1.4.6 However, the board does not agree with the respondent's further argument that re-plating implies the selection of the largest, and thus most adapted, bacterial colony only. This feature of selecting the largest colony only is not contained in any of the claims and, in fact, the patent (page 5, line 36) discloses the selection of the largest colonies as a preferred, and hence non-mandatory embodiment only.

Therefore, even if one reads the re-plating operations referred to by the respondent into the claimed process, this process clearly covers embodiments where not only the largest and thus most adapted colony or colonies but also smaller and thus less adapted ones are selected. The resulting product of these process embodiments therefore will contain a mixture of colonies with different degrees of adaptation. It is exactly such a mixture that is obtained by the process of D13.

Hence, even if one assumes in the respondent's favour that the claimed isolation and adaptation steps (a) and (b) each imply a re-plating operation, the bacteria resulting from the claimed process are not always and unequivocally different from those of D13.

- 1.5 The respondent argued that the lactic acid bacteria obtained by the claimed process have been shown in the examples of the opposed patent to be different from lactic acid bacteria that have not been isolated and adapted on an animal-free medium.

The board acknowledges that the examples of the opposed patent indeed show that bacteria obtained after isolation and adaptation on an animal-free medium (examples with S medium) are different from bacteria obtained after isolation and adaptation on a non-animal-free medium (examples with MRS medium). However, contrary to the examples with the MRS medium of the opposed patent, D13 discloses adaptation in an animal-free medium (see point 1.4.2 above). The findings in the examples of the opposed patent referred to by the respondent thus have no relevance to the question whether the bacteria contained in the claimed dairy analogue are different from the ones disclosed in D13.

- 1.6 During the written proceedings, the respondent had additionally argued that it was difficult to compare the bacteria of D13 with those used in the claimed process since it was unclear what the process in D13 actually started from. The board has difficulties in understanding this argument (which was not repeated during the oral proceedings), since D13 discloses in example 1 the specific genera, namely *Lactobacillus salivarius*, *Lactobacillus casei*, *Streptococcus lactis* and *Streptococcus cremoris*, from which the bacteria are

selected. Secondly, claim 1 is not restricted to any specific starting material but simply refers to "one or more lactic acid bacteria" which clearly includes any strain of the species disclosed in example 1 of D13.

- 1.7 Consequently, the product of claim 14 lacks novelty over D13 even if, in the respondent's favour, it is assumed that the claimed isolation and adaptation steps (a) and (b) each imply a re-plating operation. The main request is thus not allowable. In view of this, there is no need to discuss appellant II's further attacks as regards novelty of the subject-matter of claims 18 and 19 and insufficiency of disclosure.

Auxiliary request 1

2. *Admissibility*

- 2.1 Auxiliary request 1 was filed during the oral proceedings before the board. Appellant II requested that this request be not admitted into the proceedings.
- 2.2 Claim 1 of this auxiliary request differs from claim 1 of the main request in that features are now inserted into step (b) such that adaptation is done "by growing **and at least once re-plating** said bacteria on a suitable animal-free adaptation medium, **wherein during said re-plating operations the largest bacterial colonies are selected**" (inserted features in bold type).
- 2.3 The feature of selecting the largest bacterial colonies was inserted into claim 1 in order to establish novelty over D13, which according to the respondent did not

disclose bacteria obtained by selecting only the largest bacterial colonies during adaptation.

However, in the grounds of appeal, appellant II had argued that the bacteria obtained by the adaptation step of D13 were perfectly adapted to carrot juice and did not exhibit a metabolism different to a metabolism of bacteria encompassed by the claims of the opposed patent (page 14, point 5.1.2.3: "... there is no technical hint derivable from D13 that the lactic acid bacteria of D13 which are perfectly adapted to carrot juice exhibit a metabolism different to a metabolism of a microorganism encompassed by the claims of the opposed patent.").

Furthermore, in the preliminary opinion of the board (point 3.3), it was stated that D13 appeared to disclose the claimed adaptation step in an animal-free medium.

Hence, in its response to the grounds of appeal or at the very latest in direct reply to the board's preliminary opinion, the respondent could have restricted the adaptation step by inserting the feature of selecting the largest bacterial colonies.

- 2.4 The respondent argued that the insertion of this feature was a response to the board's new objection during the oral proceedings that the selection of the largest bacterial colonies could not be considered to be implied by the claimed adaptation step. Hence, this feature could not have been inserted at an earlier stage of the proceedings.

However, the board's allegedly new objection in fact constitutes a rejection of an argument put forward **by**

the respondent for the first time during oral proceedings, namely that the claimed adaptation step implies the selection of the largest bacterial colony in each re-plating step. So, the lateness is on the respondent's and not the board's.

Furthermore, the respondent could have expected that adaptation step (b) would not necessarily be interpreted as implying a selection of bacterial species since in its letter of 30 December 2013, appellant II had stated that "[a]ccordingly, **the step of once replating** as now referred to in the claims only guarantees viability of the microorganisms and **does not lead to a selection** or the introduction of a feature suitable to distinguish the products of claims 14, 18, and 19 from those of the prior art." (emphasis added by the board).

The board's conclusion reached during the oral proceedings was not a development of a kind that justified any late amendment of the claims.

2.5 The inserted feature furthermore appears to render claim 1 unclear. More specifically, it is not clear whether the wording "during said re-plating operations the largest bacterial colonies are selected" means that during each re-plating operation, the largest colony (singular) is selected or whether it means that during each operation, the largest colonies (plural) are selected and if so whether "the largest colonies" refer to the largest two, three or some other number of largest colonies.

2.6 Finally, the feature of selecting the largest bacterial colonies has been taken from the description (page 5, line 36 of the patent specification) and was not

contained in any of the claim requests filed during the appeal proceedings.

- 2.7 Consequently, the insertion of this feature into claim 1 was not only late, but additionally raised new issues so far not the subject of the appeal proceedings.

The board therefore decided not to admit auxiliary request 1 into the proceedings (Article 13(1) and (3) RPBA).

Auxiliary request 2

3. *Admissibility*

- 3.1 The claims of auxiliary request 2 differ from those of the main request in that adaptation step (b) of claim 1 is now defined to be done "by growing **and at least once re-plating** said bacteria on a suitable animal-free adaptation medium" (inserted feature in bold type). Furthermore product-by-process claim 14 now refers back to claims 2 to 13 rather than to claims 1 to 13. Finally, claims 18 to 25 of the main request have been deleted.

- 3.2 Appellant II did not make any objections as regards the admissibility of this request. Since the objected feature of selecting the largest bacterial colonies is no longer contained in claim 1, and since the remaining part of auxiliary request 2 is similar to the previous auxiliary and main requests, the board did not see any reason not to admit auxiliary request 2 into the proceedings.

4. *Novelty*

- 4.1 Product-by-process claim 14 of auxiliary request 2 differs from claim 14 of the main request in that, firstly, in as far as this claim refers back to claim 2, the dairy analogue must now be fermented and, secondly, at least one re-plating operation must be carried out during the adaptation step (b).
- 4.2 As not disputed by the respondent, in example 1 of D13 the carrot mash is fermented after addition of the seed culture (see step (vi) in point 1.2 above). Consequently, the restriction of the product of claim 14 to a fermented product cannot render the product novel over that disclosed in example 1 of D13.
- 4.3 Furthermore, when discussing the main request, it has already been assumed in the respondent's favour that adaptation step (b) includes a re-plating operation (see point 1.4.4 above). Therefore, in the same way as for the main request, product-by-process claim 14 covers embodiments with a mixture of colonies with different degrees of adaptation, which mixture is the same as that obtained by the process of D13. Hence, the insertion of the feature of "at least once re-plating" in adaptation step (b) cannot change the previous finding that the claimed product lacks novelty.
- 4.4 Consequently, the product of claim 14 of auxiliary request 2 is not novel over example 1 of D13. Auxiliary request 2 is thus not allowable. In view of this, appellant II's further objections under Articles 84 and 123(3) EPC need not be discussed.

Auxiliary request 3

5. *Admissibility*

5.1 Auxiliary request 3 was filed by the respondent very late during the oral proceedings, namely at the point when the chairman of the board had started to summarize what the board understood to be the party's final requests. Appellant II in turn requested that this request be not admitted into the proceedings.

The claims of auxiliary request 3 differ from those of auxiliary request 2 in that all product claims were now deleted, the only claims present in auxiliary request 3 thus being method claims.

5.2 During the entire appeal proceedings up to the filing of auxiliary request 3, the key issue was the allowability of the product claims contained in all previous claim requests. The respondent therefore knew from the beginning that it was a possibility that claim requests containing these product claims might not be allowed, even though it no doubt hoped, perhaps even expected otherwise. Consequently, the present auxiliary request 3, in which these product claims have been deleted, could reasonably have been filed at a much earlier stage during the present proceedings. Waiting till the very last moment during the oral proceedings to do so constitutes a wait-and-see approach that by itself goes a long way to justify the non-admittance of auxiliary request 3.

The respondent argued that a claim request restricted to the process claims had not been filed at an earlier stage since it was legitimate to defend the patent as

broadly as possible. However, this legitimate interest does not preclude the filing of more restricted **auxiliary** requests at an earlier stage, since any auxiliary request limits the patent only if any higher ranking request is refused.

- 5.3 If auxiliary request 3 had been admitted into the proceedings, the focus of the proceedings would have shifted from the allowability of the product claims contained in all previous requests to the allowability of the process claims. Appellant II argued that it had come prepared to fight the appeal on the issue of the product claims and had not focused any attack on the process claims. The board has sympathy with this submission. The purpose of the Rules of Procedure of the Boards of Appeal, in particular in opposition cases, is draw up clear battle lines between the parties so that each side knows how to prepare its case, what instructions to give its representative before oral proceedings, and so on. Changing the order of battle at the very last minute is not consistent with this.

The respondent argued in this respect that the previous discussion of the allowability of the product claims had covered the discussion of the process claims, since the products were defined by the process by which they were obtained. Hence, no new issues would arise by admitting auxiliary request 3.

The board acknowledges that the discussion of the claimed process played an important role when dealing with the allowability of the product claims in the previous requests. Nevertheless, the allowability of process claims **as such** is an issue that is clearly

different from the allowability of product-by-process claims.

5.4 The respondent also argued that the auxiliary request was convergent over the previous requests and therefore should be admitted into the proceedings. While it is true that the request was convergent in this sense, the question of convergence is not, however, the sole issue to be considered when deciding on the admissibility of a claim request. Other criteria such as the lateness of the request and the question of whether new issues arise are important as well.

5.5 The board therefore decided not to admit auxiliary request 3 into the proceedings (Article 13(1) and (3) RPBA).

Order

For these reasons it is decided that:

1. The appeal of appellant I is rejected as inadmissible.
2. The decision under appeal is set aside.
3. The patent is revoked.

The Registrar:

The Chairman:



M. Cañueto Carbajo

W. Sieber

Decision electronically authenticated