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**Datasheet for the decision
of 10 October 2014**

Case Number: T 1744/12 - 3.3.09

Application Number: 97944392.6

Publication Number: 0948264

IPC: A23G4/00

Language of the proceedings: EN

Title of invention:

METHOD FOR AUTOMATED CONTINUOUS PRODUCTION OF CHEWING GUM

Patent Proprietor:

WM. WRIGLEY JR. COMPANY

Opponent:

Cadbury Holdings Limited

Headword:

Relevant legal provisions:

EPC Art. 100(c), 123(2), 56

RPBA Art. 12(2), 13(1)

Keyword:

Late submitted ground of opposition - not admitted

Added subject-matter - no

Inventive step - new attack

Statement of grounds of appeal - party's complete case

Decisions cited:

T 0986/93

Catchword:



**Beschwerdekammern
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Case Number: T 1744/12 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 10 October 2014

Appellant: Cadbury Holdings Limited
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
10 July 2012 concerning maintenance of the
European Patent No. 0948264 in amended form.**

Composition of the Board:

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

Summary of Facts and Submissions

- I. This decision concerns the appeal filed by the opponent against the interlocutory decision of the opposition division that European patent No. 0 948 264 as amended met the requirements of the EPC.
- II. The opponent, Cadbury Holdings Limited, had requested in its notice of opposition 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). At a later stage of the opposition proceedings, with a letter dated 23 April 2012, the opponent raised a new ground of opposition, namely that the subject-matter of the patent extended beyond the content of the application as filed (Article 100(c) EPC).

The documents cited during the opposition proceedings included:

D1: EP 0 732 055 A1;

D6: E. Strebelt, "Kontinuierlicher Misch- und Knetprozeß - eine Neuheit?" Zucker- und Süßwaren Wirtschaft; 7 August 1988, pages 252 to 254;

D6A: Translation of D6 into English;

D9: FR 2 745 521 A1; and

D9A: Automated translation of D9 into English.

III. The opposition division's decision announced orally on 23 May 2012 and issued in writing on 10 July 2012 acknowledged the allowability of the set of claims 1 to 11 of auxiliary request 2 filed during the oral proceedings.

Claim 1 as maintained by the opposition division, (with references to features F1 to F8 added by the board), read as follows:

"1. A method for automatically and continuously producing chewing gum (*Feature F1*), the method comprising the steps of:
inputting operational parameters (*Feature F2*);
automatically and continuously feeding ingredients into a single continuous mixer (322, 324) (*Feature F3*), wherein the ingredients are necessary for continuous production of chewing gum (*Feature F4*);
automatically and continuously mixing the ingredients in the mixer (*Feature F5*);
monitoring actual feed rate of the ingredients fed during production (*Feature F6*);
providing a signal to the programmable controller (316) indicative of the actual feed rate (*Feature F7*); and
transmitting real-time instructions representative of the operational parameters from the programmable controller (316) to control the automatic and continuous feeding and mixing based on the operational parameters (*Feature F8*)."

IV. The opposition division's position can be summarized as follows:

- Late-filed documents D9 and D9A were admitted into the proceedings due to their relevance.

- The late-filed ground of opposition under Article 100(c) EPC was not admitted into the proceedings, because the amendments were unambiguously derivable from the application documents as published.
- The subject-matter of claim 1 of the main request lacked novelty over the disclosure of D9/D9A and the subject-matter of claim 1 of the first auxiliary request was not clear.
- The claims of the second auxiliary request met the requirements of the EPC, because the claimed subject-matter:
 - was clear (Article 84 EPC);
 - fulfilled the requirements of Articles 123(2) and 123(3) EPC;
 - fulfilled the requirements of Articles 100(b)/83 EPC;
 - was novel over the disclosure of D6 (D6A); and
 - involved an inventive step starting from D1 as the closest prior art document.

V. On 27 July 2012 the opponent (in the following: the appellant) lodged an appeal and on the same day paid the prescribed fee. The statement setting out the grounds of appeal was filed on 20 November 2012 together with the following document:

D13: "Extrusion Cooking", edited by C. Mercier *et al.*, American Association of Cereal Chemists, Inc., 1989, pages 178 to 200.

The appellant requested that the decision under appeal be set aside and the patent be revoked. It maintained that the ground of opposition under Article 100(c) EPC

should be admitted into the proceedings; that the amendments made to the patent during the opposition proceedings did not fulfil the requirements of Article 123(2) EPC and that the claimed subject-matter lacked inventive step starting from D9/D9A as the closest prior art document.

- VI. With its reply dated 27 March 2013 the patent proprietor (in the following: the respondent) disputed the arguments of the appellant and requested that the appeal be dismissed (main request) or, alternatively, that the patent be maintained on the basis of the claims of the first auxiliary request therein enclosed. It further requested that document D13 be not admitted into the proceedings.
- VII. In a communication issued on 2 April 2014 the board indicated the points to be discussed during the oral proceedings.
- VIII. On 10 September 2014 the appellant filed a further submission including the following document:
- D14: A. Lawal *et al.*, "Mechanisms of Mixing in Single and Co-Rotating Twin Screw Extruders", POLYMER ENGINEERING AND SCIENCE, MID-SEPTEMBER 1995, Vol. 35, No 17, pages 1325 to 1338.
- IX. On 10 October 2014 oral proceedings were held before the board. During the oral proceedings, after the board had announced its conclusion that D1 represented the closest prior art and that the inventive step objection based on D9 failed, the appellant requested amendment of its case to make an inventive step attack based on D1 as representing the closest prior art. This

amendment to the appellant's case was not admitted into the proceedings.

X. The arguments of the appellant, insofar as they are relevant for the present decision, may be summarised as follows:

- The opposition division's decision not to admit the late-filed ground of opposition under Article 100(c) EPC into the proceedings was not justified. There were strong *prima facie* reasons why the amendments in claim 1 made during examination proceedings introduced subject-matter which extended beyond the content of the original application. In particular features F3 and F8 added to claim 1 during examination proceedings were disclosed in the application as filed always in connection with other process features which had not been incorporated into the claim.
- There was no support in the application as filed for the step of providing a signal indicative of the feed rate to the programmable controller (feature F7). This amendment represented an unallowable intermediate generalisation. In contrast to the embodiment disclosed in the description, claim 1 did not define the signal received by the programmable controller as being transmitted from ingredient feeders via an ingredient feeder controller, and claim 1 did not define an operator interface computer. The amendment was therefore not allowable under Article 123(2) EPC).
- The claimed subject-matter lacked inventive step starting from D9/D9A as the closest prior art

document. D9 was a more appropriate starting point than D1 as it disclosed a method for producing a chewing gum which was both automated and continuous.

- Even if D9 was not seen as the closest prior art document, the claimed subject-matter lacked inventive step starting from D1 as the closest prior art document. The inventive step attack was already in the proceedings and the appellant should be allowed to present such an attack based on D1.

XI. The arguments of the respondent may be summarised as follows:

- The opposition division correctly concluded that there was no reason to introduce the late-filed ground of opposition under Article 100(c) EPC into the proceedings. In the absence of any evidence that the opposition division exercised its discretion wrongly, there was no basis for this ground to form part of the appeal proceedings. The respondent stated that it did not consent to the admission of this new ground of opposition into the proceedings.
- The amendments made to claim 1 during the opposition proceedings were fully supported by the application as filed. Amended claim corresponded essentially to the combination of the subject-matter of claims 19 and 22 of the application as filed.
- D9 related to the subsequent production of a batch of pre-mixed chewy confectionery. The extruder of

D9 was supplied with extrusion paste from a separate preparation and cooking unit. By contrast, the claimed invention was directed to the production of chewing gum. The teaching of D9 was far-removed from the invention. The choice of D9 as closest prior art represented a contrived and artificial starting point for the assessment of inventive step.

- The appellant should not be allowed to amend its case and start from D1 as closest prior art document during the oral proceedings. The Rules of Procedure of the Boards of Appeal required that the appellant's complete case should be contained in its statement of grounds of appeal. In its statement of grounds of appeal the appellant used D9 as the only document for its inventive step attack. There was no reason to allow the appellant to amend its case now.

XII. The appellant requested that the decision under appeal be set aside and that European patent No. 0 948 264 be revoked.

XIII. The respondent requested that the appeal be dismissed (main request) or, alternatively, that the patent be maintained on the basis of the set of claims of the first auxiliary request filed on 27 March 2013.

Reasons for the Decision

1. The appeal is admissible.

MAIN REQUEST

2. *Fresh ground of opposition (Article 100(c) EPC)*
 - 2.1 During the opposition proceedings, after expiry of the opposition period, the appellant raised objections that the subject-matter of the patent extended beyond the content of the application as filed. The objections raised in this context, namely against the wording "single continuous mixer" in feature F3 and "transmitting real-time instructions representative of the operational parameters from a programmable controller" in feature F8, were not admitted into the proceedings by the opposition division as they constituted a new ground of opposition under Article 100(c) EPC which was late-filed and, in its view, not *prima facie* relevant. This aspect of the decision was challenged by the appellant.
 - 2.2 If the way in which an opposition division has exercised its discretion on a procedural matter is challenged in an appeal, it is not the function of the board to review all the facts and circumstances of the case as if it were the department of first instance, and to decide whether or not it would have exercised such discretion in the same way. A board of appeal should only overrule the way in which a department of first instance has exercised its discretion if the board concludes that the department did so according to the wrong principles, or without taking into account the right principles, or in an unreasonable way (see

Case Law of the Boards of Appeal of the European Patent Office, 7th edition 2013, IV.E.3.6).

- 2.3 From the above it follows that the board is limited in the present case to examine whether or not the opposition division exercised its discretion on a correct basis in considering the opposition ground of Article 100(c) EPC to be *prima facie* not relevant.
- 2.4 This issue is discussed in detail in point 13 of the reasons in the appealed decision. The arguments raised by the opponent are summarized and reasons why these arguments were not accepted are given; the parts of the specification as filed wherein support was seen for the objected features are identified. Whether or not the conclusion was correct is irrelevant: the opposition division approached the issue correctly and reached a conclusion that cannot be characterised as unreasonable.
- 2.5 In view of these facts, there are no reasons for the board to overturn this part of the opposition division's decision.
- 2.6 Decision T 986/93, cited by the appellant, states that a board of appeal is not barred from considering a belatedly submitted ground of opposition which had been disregarded by the opposition division if the opposition division exercised its discretion wrongly. This is, however, not the case here for the reasons given above.
- 2.7 For these reasons the objections raised by the appellant under Article 100(c) EPC concerning features F3 and F8 (see point 2.1 above) are not relevant for these appeal proceedings.

3. *Amendments (Article 123(2) EPC)*

3.1 The appellant further objected to the amendments made to claim 1 during the opposition proceedings because in its view feature F7 ("providing a signal to the programmable controller (316) indicative of the actual feed rate") did not find a basis in the application as filed.

3.2 It was common ground that claim 1 corresponds essentially to the combination of claims 19 and 22 as filed. It was also accepted by the appellant that claim 22 as filed supports the step of providing a signal indicative of the feed rate.

3.3 The objection of the appellant was that claim 22 as filed does not define the step of providing a signal indicative of the feed rate "to a programmable controller", and the description does not provide basis for this step without also defining:

- a) that the programmable controller receives the signal from ingredient feeders (cf. page 33, lines 10 to 12, which read: "Further, the ingredient feeder controller 326 allows for relay of data from the feeders 328 to the programmable controller 316."), and
- b) the data is transmitted from the programmable controller to an operator interface computer (cf. page 31, lines 23 to 26, which read: "Further, the programmable controller 316 may receive real-time data from the device controllers and relay the real-time data to the operator interface computer 310.").

Thus, in the appellant's view, feature F7 represented an unallowable intermediate generalisation since claim 1 does not define the signal received by the programmable controller as being transmitted from ingredient feeders via an ingredient feeder controller, and claim 1 does not define an operator interface computer.

3.4 The board finds these arguments unpersuasive for the following reasons:

3.4.1 Concerning (a) it is correct that, in the passages cited by the appellant, an embodiment is disclosed in which the programmable controller receives real-time data from the device controllers, such as the ingredient feeder controller 326 (see also figures 9 and 10). However, the specification as filed also discloses an alternative embodiment wherein the devices are directly controlled by the programmable controller. Thus, on page 31, lines 26 to 28 it is disclosed that **"Alternatively, devices may be directly controlled by the programmable controller 316"** (emphasis by the board) and in the same paragraph it is explained that instead of "an embodiment [in which] control functions [are] handled by dedicated controllers, e.g., ingredient feed rate control, [they] may **alternatively** be handled by the programmable controller 316" (page 31, lines 30 to 33, emphasis by the board). Clearly, in this second embodiment, signals from the various devices can be transmitted directly to the programmable controller as represented, for example, by the arrow in figure 9 which extends from the extruder 324 directly to the programmable controller 316 and which bypasses the extruder controller 322. No unallowable intermediate

generalization is made, the direct transmission of the signal device to the programmable controller is an embodiment disclosed in the application as filed.

3.4.2 The same considerations apply to (b), the specification as filed discloses two embodiments: (i) the use of an operator interface computer as pointed out by the appellant and an alternative embodiment (ii) wherein the devices are directly controlled by the programmable controller (cf.: page 31, lines 26 to 28 wherein it is stated "Alternatively, devices may be **directly** controlled by the programmable controller 316" (emphasis by the board)) without an operator interface computer as already explained above.

3.4.3 In summary, the description as filed supports the amendments made to claim 1 during the opposition proceedings.

3.5 Hence, the subject-matter of claim 1 fulfils the requirements of Article 123(2) EPC.

4. *Inventive step (Article 56 EPC)*

4.1 The only inventive step objection made by the appellant in its statement of grounds of appeal was that the subject-matter of claim 1 lacked inventive step starting from D9 as closest prior art, a new objection raised for the first time in the appeal proceedings. The appellant did not contest the finding of the opposition division that the subject-matter of claim 1 involved an inventive step starting from the disclosure of document D1 as closest prior art document (see also below, point 5).

4.2 The patent in suit relates to a method for automated continuous production of chewing gum (see paragraph [0001] of the specification). It aims to simplify and minimize the cost of chewing gum manufacture, by providing an integrated continuous manufacturing process having the ability to combine chewing gum base ingredients and other chewing gum ingredients in a single mixer, which can be used to manufacture a wide variety of chewing gums automatically, with minimal or no human intervention (see paragraph [0008]). The claimed method for automatically and continuously producing chewing gum is said to reduce waste material, errors and variability in manufacturing (see paragraphs [0016], [0017] and [0126]).

4.3 Closest prior art

4.3.1 The board, in agreement with the opposition division and the respondent, sees the disclosure of D1 as representing the closest prior art document. D1 discloses a closely related method for the continuous manufacture of chewing gum products using a single high efficiency mixer (column 2, lines 15 to 18; see also the working examples). Document D1 is conceived for the same purpose and aims at the same objective as the present invention, namely the continuous manufacture of chewing gum in a single continuous mixer. It also has the most relevant technical features in common. It differs from the claimed process essentially in that it is not carried out automatically.

4.3.2 Contrary to this, the appellant relied on D9 as the closest prior art document, essentially because D9 discloses in its view "an automated method for producing chewing gum" (point 3.2 of page 7 of the statement of grounds of appeal).

- 4.3.3 In the board's judgement the disclosure of D9 does not represent a suitable starting point for the assessment of inventive step. According to EPO jurisprudence, the closest prior art for assessing inventive step is a prior art document disclosing subject-matter conceived for the same purpose or aiming at the same objective and having the most relevant technical features in common. Contrary to the assertion of the appellant, D9 does not disclose an automated method for producing chewing gum.
- 4.3.4 D9 in fact relates to the subsequent processing of a batch of pre-mixed chewy confectionery. D9 aims to avoid drawbacks of known packaging processes by controlling the speed of the extruder in such a way as to control the dimensions of the extruded product (see claim 1). Thus, D9 is concerned with the downstream division and wrapping of the extrudate. As disclosed on page 5, lines 29 to 36 of D9 the extruder used there is supplied with extrusion paste from a separate preparation cooking unit. There is no disclosure in D9 of a step whereby the ingredients for the production of chewing gum are fed into the extruder (i.e. the mixer) as required by claim 1 of the patent in suit. In D9 a pre-prepared paste is provided to an extruder for subsequent processing but, by that time, the chewy confectionery has already been prepared and cooked, having been supplied from a preparation and cooking unit (see cooking unit 2 in figures 1 and 2 of D9).
- 4.3.5 Moreover, the most relevant technical features of the invention are not shared by D9. In fact, D9 does not disclose any of the relevant features of the invention directed to the mixing of the ingredients and/or monitoring their actual feed rate.

4.3.6 In the board's view the objection of the appellant is based on a wrong interpretation of the wording of claim 1. According to the appellant, the wording "feeding ingredients into a single continuous mixer" would be understood by the skilled person to mean no more than that at least some of the chewing gum ingredients are fed into the same continuous mixer. The wording would thus cover methods in which a pre-prepared mixture of ingredients is fed into a continuous mixer.

This is in the board's view not correct, because the wording of claim 1 undoubtably requires that chewing gum is produced in the mixer. Claim 1 is directed to "a method for automatically and continuously producing chewing gum" including, *inter alia*, "monitoring actual feed rate of the ingredients during production". Claim 1 is not directed to methods such as the one disclosed in D9 wherein an already produced chewing gum is further treated.

4.3.7 It follows from the above that D9 does not qualify as the closest prior art document because it is not directed to the same purpose or effect as the invention. D9 does not represent a realistic starting point from which the skilled man would try to arrive at the claimed subject-matter and it cannot lead the skilled person in an obvious manner to the claimed invention.

4.4 For these reasons, the inventive step objection of the appellant based on D9 must fail.

5. *Further issues*

5.1 During the oral proceedings before the board and after the chairman announced the conclusion of the board that D1 represented the closest prior art and that document D9 could not be used as a starting point for a valid inventive step objection, the appellant requested amendment of its case so as to make an inventive step attack based on D1 as representing the closest prior art.

5.2 Article 12(2) RPBA requires that the statement of grounds of appeal contains the appellant's complete case. The appellant in its grounds of appeal did not dispute the finding of the opposition division that the claimed subject-matter involved an inventive step starting from D1 as closest prior art. The only inventive step objection raised was that the claimed subject-matter lacked inventive step starting from D9 as closest prior art document. The appellant also did not react to the arguments of the respondent in its reply to the grounds of appeal that D9 could not be seen as closest prior art and that D1 indeed represented the closest prior art document.

5.3 It follows from the above that the appellant must be taken, for the purposes of these proceedings, as having accepted the conclusions of the opposition division and as not wanting them to be revised during the appeal proceedings. Instead, the attack was to be based on D9.

5.4 The board's communication in preparation for oral proceedings summarised the points to be discussed during the oral proceedings and, in relation to inventive step, it was stated *inter alia* that "if D9 is held by the board not to represent the closest prior

art then this will be the end of the inventive step discussion on this request". This statement was a simple reflection of how the case stood.

5.5 The request to amend the appellant's case during the oral proceedings was made at a very late stage of the proceedings, indeed at a very late stage of the oral proceedings, without any valid reason being given for why the attack had not been made earlier. Any grounds on which the appellant relied for saying that the the decision was wrong should have been filed much earlier, in particular, of course, with the statement of grounds of appeal. Although in its letter filed one month before the oral proceedings the appellant had presented some arguments based on D1 as representing the closest prior art, no indication was given there that the appellant in fact wished to make this an alternative line of attack. Both the respondent and the board could have been expected to prepare for the oral proceedings on the basis of the statements of the parties' cases as they then stood and as summarised in the board's communication (see above). It was not procedurally expedient or even fair to allow the appellant to alter its case in this way.

5.6 Accordingly, the board exercised its discretion under Article 13(1) RPBA and did not admit the requested amendment to the appellant's case into the proceedings.

AUXILIARY REQUEST

6. As the main request of the respondent is allowed, there is no need for the board to deal with the auxiliary request.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



D. Hampe

W. Sieber

Decision electronically authenticated