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**Datasheet for the decision
of 19 August 2014**

Case Number: T 1785/12 - 3.3.09

Application Number: 01998233.9

Publication Number: 1339291

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A21D13/08, A23L1/164,
A23L1/176, A21D13/00

Language of the proceedings: EN

Title of invention:
EXTRUDED ICE BISCUIT AND COMPOSITE FROZEN CONFECTIONS

Patent Proprietor:
SOCIETE DES PRODUITS NESTLE S.A.

Opponents:
UNILEVER PLC / UNILEVER NV

Headword:

Relevant legal provisions:
EPC Art. 56
RPBA Art. 13

Keyword:
Inventive step - main request (no)
Late-filed auxiliary request 1 - admitted (no)

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 1785/12 - 3.3.09

**D E C I S I O N
of Technical Board of Appeal 3.3.09
of 19 August 2014**

Appellants: UNILEVER PLC / UNILEVER NV
(Opponents) Unilever House, Blackfriars/Weena 455
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Respondent: SOCIETE DES PRODUITS NESTLE S.A.
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
8 June 2012 concerning maintenance of the
European Patent No. 1339291 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 opponents against the interlocutory decision of the opposition division that European patent No. 1 339 291 as amended met the requirements of the EPC.
- II. The joint opponents, Unilever PLC and Unilever NV, had requested revocation of the patent in its entirety on the grounds that the subject-matter of claims 1 to 12 was neither novel nor inventive (Article 100(a) EPC), that the patent did not disclose the invention in a manner sufficiently clear and complete for claims 2 and 4 to be carried out by a person skilled in the art (Article 100(b) EPC) and that the subject-matter of claims 6 to 11 extended beyond the content of the application as filed (Article 100(c) EPC).

The documents cited during the opposition proceedings included:

D2: US 3 508 926 A;

D3: WO 93/03909 A1; and

D5: P. Frank, "Frozen Novelties", Food Product Design, October 2000, pages 39-59.

Fourteen further documents related to the public prior use of the product "Viennetta Maxima Pralina". From these documents the following are referred to in the present decision:

D11: 'Finished product specification' of Viennetta Maxima Pralina' (29.11.96);

D14: 'Mix recipe' for 'MT31 - Biscuit crumb paste for Maxima' (not dated); and

D15: 'Edible Material Specification' for 'BG38' White truffle filling/coating, 21 November 1997.

III. The opposition division held that the subject-matter of claim 1 of the then-pending main request and the first auxiliary request lacked novelty over the disclosure of each of D2, D3, D5 and the public prior use. Furthermore, the subject-matter of claim 12 lacked an inventive step. On the other hand, the opposition division found that the claims of the second auxiliary request filed during the oral proceedings fulfilled the requirements of the EPC.

IV. On 7 August 2012 the opponents (in the following: the appellants) filed an appeal and on the same day paid the prescribed fee. The statement setting out the grounds of appeal was filed on 8 October 2012. The appellants requested that the decision under appeal be set aside and that the patent be revoked in its entirety on the grounds that the subject-matter of the claims lacked novelty and inventive step. The statement of grounds included further experimental evidence and the following further documents:

D23: Datasheet for "DurkexTM 200", dated 2 August 2012

D24: Datasheet for "Fully refined palmolein", dated 8 April 2010; and

D25: Technical data sheet for "Fully refined hydrogenated rapeseed oil 23", dated 18 July 2012.

- V. With its reply dated 18 February 2013 the patent proprietor (in the following: the respondent) no longer pursued the claims maintained by the opposition division. It requested that the patent be maintained in amended form on the basis of the sets of claims according to the newly filed main request or auxiliary requests 1 and 2.

Claim 1 of the main request read as follows:

"1. Biscuit-like mass that looks like a biscuit at 0°C, which is liquid at 15°C and which can be extruded together with ice confectionery while keeping its biscuit-like consistency on storage and consumption, which comprises a mixture of particles of baked biscuit and a fat, wherein the mixture contains 40 to 60% by weight of biscuit particles and 60 to 40% by weight of fat."

- VI. On 7 April 2014 the board dispatched a summons to oral proceedings. In the attached communication the board indicated the points to be discussed during the oral proceedings.
- VII. On 19 August 2014 oral proceedings were held before the board. During the oral proceedings the respondent withdrew its previous auxiliary requests 1 and 2 and filed an amended auxiliary request 1. Claim 1 of this request resulted from the combination of claims 1 and 2 of the main request and read as follows:

"1. Biscuit-like mass that looks like a biscuit at 0°C, which is liquid at 15°C and which can be extruded together with ice confectionery while keeping its biscuit-like consistency on storage and consumption, which comprises a mixture of particles of baked biscuit

and a fat, wherein the mixture contains 40 to 60% by weight of biscuit particles and 60 to 40% by weight of fat, in which the fat is a high oleic partially hydrogenated vegetable oil."

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

- The claimed subject-matter lacked inventive step. Starting from the public prior use as closest prior art, the only distinguishing feature of claim 1 was the use of a higher amount of fat. Taking into account that no technical effect was associated with the particular range of 60% to 40% fat, the appellants saw the objective technical problem as being the provision of alternative amounts of fat and biscuit crumbs. The claimed solution was obvious for the skilled person. In fact, the skilled person would automatically increase the amount of fat to obtain a liquid product at 15°C as required by the claim. He would discard the only other possible alternative, namely the reduction of the amount of fat, as this alternative would result in a more solid product not fulfilling the requirements of claim 1.

- The auxiliary request should not be admitted into the proceedings. It was filed at a very late stage of the proceedings and was a surprise to the appellants: the relevance of the use of a high oleic partially hydrogenated vegetable oil had not been discussed at all during the written proceedings. Moreover it was not clear whether such a fat was used in the examples of the patent.

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

- Starting from the public prior use or from D3 as closest prior art, the problem to be solved by the patent in suit was the provision of an improved biscuit-like mass being both easily processable at room temperature and still having a biscuit-like crispy consistency when cooled. There was no hint in the prior art that this problem could be solved by increasing the amount of fat, so that the claimed subject-matter involved an inventive step.

- Even if no improvement were to be acknowledged, the claimed subject-matter was still not hinted at in the prior art. The public prior use was merely a recipe and did not suggest any variation thereof. Also D3 gave no motivation to increase the amount of fat in the biscuit-mix. The arguments of the appellants were merely speculative and they were based on a hindsight interpretation of the prior art.

- Auxiliary request 1 should be admitted into the proceedings. It was filed in order to streamline the proceedings by combining the subject-matter of claims 1 and 2 of the main request. It aimed at bringing the claimed subject-matter closer to the working examples.

X. The appellants requested that the decision under appeal be set aside and the patent be revoked.

The respondent requested that the patent be maintained on the basis of its main request as filed with its letter dated 18 February 2013, alternatively on the

basis of its first auxiliary request filed during the oral proceedings of 19 August 2014.

Reasons for the Decision

1. The appeal is admissible.

MAIN REQUEST

2. *Inventive step*

- 2.1 The invention is concerned with a biscuit-like mass to be used in ice confectionery. Claim 1 of the main request is directed to a biscuit-like mass with the following features:

- (a) it looks like a biscuit at 0°C,
- (b) it is liquid at 15°C and
- (c) can be extruded together with ice confectionery
- (d) while keeping its biscuit-like consistency during storage and on consumption,
- (e) it comprises a mixture of particles of baked biscuit and fat,
- (f) the mixture contains 40 to 60% by weight of biscuit particles and 60 to 40% of fat.

- 2.2 Closest prior-art

- 2.2.1 The appellants relied on the public prior use of the product "Viennetta Maxima Pralina" (D11 and related documents) as closest prior-art. The respondent also referred to D3, as being similar to the prior use product.

- 2.2.2 It is common ground that both the public prior use and document D3 disclose a biscuit-like mass presenting features (a) to (e) of claim 1.

Concerning feature (f), D3 discloses a biscuit mix containing 54.6% digestive biscuit, 22.7% golden syrup and 22.7% margarine (page 5 right column, lines 18 to 21). The product specifications for the "Viennetta" biscuit product (D11, D14 and D15) disclose a biscuit-like paste made of 49% crumbed biscuit, 26% fat (vegetable oil) and 25% other components (mainly sugar). The subject-matter of claim 1 differs from these disclosures by the use of a higher amount of fat, namely an amount within the range of 40 to 60% by weight.

- 2.2.3 The board agrees with the appellants that the public prior use represents the closest prior-art because the amount of fat used therein is closer to the range required by claim 1.

2.3 Problem to be solved and its solution

- 2.3.1 According to the respondent, the claimed biscuit-like mass represents an improvement over the biscuit-like mass used for "Viennetta". Although no direct comparison had been made, the respondent argued that the biscuit-like mass for "Viennetta" had a thicker consistency and could not be easily pumped. The respondent based its argument on the experimental results submitted by the appellants with the statement of grounds of appeal. According to the table on page 7 of the statement of grounds of appeal the biscuit-like mass of the products according to D3 could only be pumped with a syringe "if enough force was applied" (table on page 7 entry D3), while the biscuit-

like mass of examples 1 and 2 of the patent "was pumpable using the syringe" (table on page 7, entry Patent (Ex 1 & 2)). Since the products of D3 were similar to the "Viennetta" biscuit product, similar considerations should apply for the "Viennetta" biscuit product.

2.3.2 The appellants contested this conclusion of the respondent and pointed out that the biscuit-like mass of D3 and the public prior use were not the same. In fact, they were quite different because of the different kind of fat used. Thus, in D3 a solid fat (margarine) was used while for the "Viennetta" biscuit product a liquid vegetable oil was used. Moreover, the appellants pointed out that the biscuit mass of the prior use had the same paste-like rheological characteristics as the 54.5 : 45.5 (biscuit:fat) fat mass used in the examples of the patent in suit (see page 9 of the statement of grounds of appeal, lines 7 to 10). This finding was not contested by the respondent, who did not file any experimental evidence in support of any improvement of the claimed biscuit-like mass.

2.3.3 In view of this evidence, the board agrees with the appellants that the experiments on page 7 of the statement of grounds of appeal do not establish any improvement for the claimed subject-matter over the disclosure of the prior use.

2.3.4 Consequently, the objective technical problem to be solved by the patent in suit in view of the closest prior-art can only be seen in the provision of an alternative biscuit-like mass, being both easily processable at room temperature and still having a biscuit-like crispy consistency when cooled.

2.3.5 This problem is credibly solved by the biscuit-like mass of claim 1, as shown by the examples in the patent in suit wherein the claimed biscuit-like mass is co-extruded to obtain composite frozen compositions still having a biscuit-like texture.

2.3.6 This conclusion was not contested by the appellants. In fact, it was confirmed by their reworking of examples 1 and 2 of the patent (see table on page 7 of the statement of grounds of appeal).

2.4 Obviousness

2.4.1 It remains to be decided whether, in view of the available prior-art documents, it would have been obvious for the skilled person to solve the above defined technical problem by the means claimed, namely by increasing the amount of fat used in the prior use.

2.4.2 In the board's judgement it would have been obvious for the skilled person to solve the posed problem by modifying the amounts of fat and biscuit particles, the main components of the biscuit-like mass of the public prior use product. In particular, it would have been obvious to solve the problem by increasing the amount of fat. As pointed out by the appellants, the skilled person trying to provide a further biscuit-like mass that was liquid at 15°C would increase the amount of fat in the composition, because the fat is the only liquid component of the biscuit mass of the public prior use product. An increase in the amount of biscuit particles would result in a more solid mass so that the skilled person would automatically exclude this possibility.

2.4.3 The respondent argued essentially that there was no hint in the prior art towards the amount of fat now claimed and that the skilled person would have had plenty of other possibilities to modify the biscuit-like mass. For instance, he could have used a liquid sugar as in D3 (cf. golden syrup).

The board finds these arguments unconvincing for the following reasons:

- It is correct that the public prior use and document D3 disclose two single recipes of biscuit-like masses with a lower amount of fat, and that none of these documents by itself suggests increasing the amount of fat. However, as explained above, the board has found a lack of an inventive step because it would have been obvious for the skilled person, looking for alternative compositions, to modify the known compositions by increasing the amount of fat and not because there was a suggestion in D3 or the public prior use itself to increase the amount of fat (see 2.4.2 above).
- Concerning the further argument of the respondent that further alternatives were possible, it is again noted that the main components of the biscuit-like mass are the biscuit particles and the fat, so that the skilled person looking for an alternative mass would first modify these main components and thus at once arrive at the claimed mass. The fact that other modifications of the compositions are possible cannot make an obvious modification inventive.

2.4.4 For these reasons, the subject-matter of claim 1 of the main request lacks inventive step.

AUXILIARY REQUEST 1

3. *Admissibility*

3.1 Auxiliary request 1 was filed by the respondent towards the end of the oral proceedings after the board had deliberated upon the allowability of the main request, *i.e.* at the very last moment. Requests filed at such a late stage of the proceedings are usually only admitted into the appeal proceedings under exceptional circumstances, in particular, if it can be quickly ascertained that they overcome all the outstanding issues without raising new ones.

3.2 The respondent justified the late filing of auxiliary request 1 as being a result of the negative finding of the board that the main request lacked inventive step. Furthermore the request limited the subject-matter to the preferred fats used in the working examples, was simple to understand as it resulted from the combination of claims 1 and 2, and went in the same direction as the main request.

3.3 The board cannot agree with this. The amendment made to the claim, namely the limitation of the fat to high oleic partially hydrogenated vegetable oil, shifts the subject-matter of the claim in a new direction that could not have been foreseen from the written proceedings. In fact, the respondent relied in the written proceedings and during the oral proceedings on the amount of fat used and not on a particular type of fat. Moreover, there is no indication in the patent specification that the use of "high oleic partially

hydrogenated vegetable oil" is associated with any technical effect for the claimed biscuit-like mass. As pointed out by the appellants, it is not even clear whether such an oil was used in the working examples in the patent. The fat used in the examples is said to have been "partially hydrogenated vegetable fat (DURKEX 500)" and there is no evidence that such a fat indeed is a high oleic partially hydrogenated vegetable oil.

- 3.4 Consequently, the board exercised its discretion not to admit auxiliary request 1 into the proceedings because it was filed at an extremely late stage and because the amendments raised new issues taking the case in a direction not foreseen in the written proceedings (Article 13 RPBA).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



M. Cañueto Carbajo

W. Sieber

Decision electronically authenticated