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**Datasheet for the decision
of 28 October 2015**

Case Number: T 2080/12 - 3.3.06
Application Number: 01202906.2
Publication Number: 1281749
IPC: C11B3/00, C11B3/16, B01D9/00,
C11B7/00
Language of the proceedings: EN

Title of invention:

Process and installation for dry fractionation

Patent Proprietor:

De Smet Engineering N.V.

Opponent:

JVK Filtration Systems GmbH

Headword:

Dry fractionation / DE SMET

Relevant legal provisions:

EPC Art. 123(2)
RPBA Art. 12(1), 12(2), 12(4), 13(3)

Keyword:

New Main claim Request filed with the statement of grounds of appeal - admissible (yes)

Amendments - extension beyond the content of the application as filed (yes - Main Request)

1st Auxiliary Request filed at the oral proceedings - admissible (no) - not clearly allowable

Decisions cited:

Catchword:



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Case Number: T 2080/12 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 28 October 2015

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 13 July 2012
revoking European patent No. 1281749 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman B. Czech
Members: P. Ammendola
C. Heath

Summary of Facts and Submissions

- I. This appeal lies from the decision of the Opposition Division to revoke European patent no. 1 281 749.
- II. Claim 1 of the corresponding application as filed reads (emphasis added by the Board):
- "1. Process for the dry fractionation of edible oils and fats and related products, comprising the steps of:*
- a) solidifying the product in a crystalliser comprising at least one cooling chamber that is provided with **at least one wall** permitting heat transfer, to form a solid block of crystallised material;*
 - b) discharging the chambers and collecting the block;*
 - c) crushing the block so that a pumpable paste is obtained;*
 - d) pumping this paste into a filter press;*
 - e) separating this paste into an olein fraction and a stearin fraction by filtration and collecting both fractions."*
- III. Claim 1 as granted differs from claim 1 of the application as filed, *inter alia* in that said "at least one wall" of the a crystalliser is additionally required to be "**positioned vertically**".
- IV. The Opponent had sought revocation of the patent on the grounds of, *inter alia*, Article 100(c) / 123(2) EPC, also because of the introduction in claim 1 of this additional feature (item 3.2. of the opposition brief of 14 July 2010).

On 20 June 2012, i.e. few days before the oral proceedings scheduled to be held before the Opposition Division on 26 June 2012, the Proprietor had filed, *inter alia*, sets of amended claims as Sixth to Eighth Auxiliary Requests. At said oral proceedings, it filed a new Ninth Auxiliary Request. In the respective claim 1 of each of these Auxiliary Requests the Proprietor had for the first time used, in the definition of the crystalliser, the expression "*positioned vertically above the/a hopper*" referring to "*wall (11)*" of a "*cooling chamber*" (Sixth to Eighth Auxiliary Requests) or to "*chamber walls with plates*" (Ninth Auxiliary Request).

- V. At the hearing the Opposition Division admitted into the proceedings said Sixth to Ninth Auxiliary Requests and the Opponent presented, for the first time, its complete objections as to the allowability of the respective claims 1 thereof under Article 123(2) EPC.

The Opposition Division found that all pending versions of claim 1, including those according to the Sixth to Ninth Auxiliary Request, to contravene the requirements of Article 123(2) EPC. Thus, the patent was revoked.

- VI. With its statement of grounds of appeal, the **Appellant** (Patent Proprietor) filed with the statements of *inter alia* a set of amended claims labelled Eighth Auxiliary Request.

- VII. Claim 1 of this Eighth Auxiliary request reads as follows (differences vis-à-vis claim 1 of the application as filed, quoted under II, *supra*, made apparent by the Board):

"1. **A** ~~Process for the dry fractionation of edible oils~~

~~and fats and related products lauric oils, fatty acids and fatty acid esters, comprising the steps of:~~

a) ~~solidifying the product in a crystalliser (3) to form a solid block of crystallised material, comprising at least one cooling chamber that is provided with at least one wall permitting heat transfer, to form a solid block of crystallised material;~~

b) ~~discharging the chambers and collecting the said solid block;~~

c) ~~crushing the said solid block so that into a pumpable paste is obtained;~~

d) ~~pumping this the said paste into a filter press;~~ (7),

e) ~~separating this the said paste into an olein a liquid fraction (8) and a stearin solids fraction (9) by filtration, and~~

f) ~~collecting both fractions (8) and (9),~~

characterized in that said crystalliser (3) comprises a series of cooling chambers (10) each consisting of the space enclosed by two plates (11) allowing said plates (11) to be hydraulically compressed or withdrawn, during operation said chambers (10) are compressed and therefore closed, to discharge said solidified blocks of crystallised fat the crystalliser is opened so that the blocks can drop down by gravity, said plates (11) of said crystalliser (3) being positioned vertically above a hopper (4) into which said solidified block will drop during the discharge of said crystallizer (3) and permitting heat transfer to form at least one solid block of crystallised material."

VIII. With the reply to the statement of grounds of appeal the Opponent (below **Respondent**) disputed, *inter alia*, the allowability of the Eighth Auxiliary Request under Article 123(2) EPC.

IX. In a communication (point 6.1) dated 22 October 2015 issued in preparation for oral proceedings the Board expressed, *inter alia*, the preliminary opinion that the "cooling plates" (below **plates**) of the crystalliser described in paragraph [0043] of the patent as granted (identical to page 8, lines 20 to 29, of the application as filed) and schematically shown in Figure 2 were "positioned vertically" also in the sense of being generally oriented perpendicularly to the ground, and not just "positioned vertically above the hopper" (relative arrangement) as stated in paragraph [0044] of the patent as granted.

X. At the beginning of the oral proceedings held before the Board on 28 October 2015, the Appellant requested the Board to consider the Eighth Auxiliary Request filed with the statement of grounds of appeal as its **Main Request**.

The Board, having heard the Parties on the admissibility of this Request, decided to admit it into the proceedings.

Subsequently, the Parties were heard as regards objections against the Main Request, *inter alia*, under Article 123(2) EPC.

After deliberation, the Chairman announced the Board's conclusion that amended claim 1 of the Main Request did not comply with, *inter alia*, with Article 123(2) EPC, since the following features were missing:

- that the plates were "assembled like in a filter press", and
- that it was "the press forming the

crystalliser" (not "the crystalliser") that was "opened so that the blocks can drop down by gravity".

The Appellant then filed an amended set of claims as new 1st Auxiliary Request and withdrew all the previously pending Auxiliary Requests.

Claim 1 of this new 1st Auxiliary Request reads as follows (amendments to claim 1 of the Main Request quoted under VII, *supra*, made apparent by the Board):

"1. A process for the dry fractionation of lauric oils, fatty acids and fatty acid esters, comprising the steps of:

- a) solidifying the product in a crystalliser (3) to form **a solid blocks** of crystallised material,*
 - b) discharging and collecting the said solid blocks;*
 - c) crushing the said solid blocks into a pumpable paste;*
 - d) pumping the said paste into a filter press (7),*
 - e) separating the said paste into a liquid fraction (8) and a solids fraction (9) by filtration, and*
 - f) collecting both fractions (8) and (9),*
- characterized in that said crystalliser (3) comprises a series of cooling chambers (10) each consisting of the space enclosed by two plates (11), **wherein the plates (11) permit heat transfer to form solid blocks of crystallised material, wherein the crystalliser (3) comprises a series of such cooling plates (11) assembled like in a filter press,** allowing said the plates (11) to be hydraulically compressed or withdrawn, **wherein** during operation said chambers (10) are compressed and therefore closed, **and** to discharge said solidified blocks of crystallised fat the crystalliszer is opened so that the blocks can drop*

down by gravity, said **wherein the** plates (11) of said crystallizer (3) being **are** positioned vertically above a hopper (4) into which said **the** solidified blocks will drop **by gravity** during the discharge of said crystallizer (3) ~~and permitting heat transfer to form at least one solid block of crystallised material.~~"

XI. The final requests of the Parties were thus as follows:

The Appellant requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution on the basis of the "Eighth Auxiliary Request" (that became the Main Request during the oral proceedings), or on the basis of the "1st Auxiliary Request" filed during oral proceedings.

The Respondent requested the appeal to be dismissed.

XII. The Appellant's arguments of relevance here may be summarized as follows.

Main Request- Admissibility

The claims according to the Main Request were filed with the statement of grounds of appeal in reaction to objections presented by the Respondent during the opposition proceedings in relation to requests that had been filed just a few days before (Sixth to Eighth Auxiliary Requests) or during the oral proceedings (Ninth Auxiliary Request). Since these objections had also been found convincing by the Opposition Division, the filing of the claims according to the Main Request at issue with the statement of grounds of appeal was procedurally justified and this request should be admitted.

Main Request - Allowability (Article 123(2) EPC)

At the oral proceedings the Appellant argued essentially that the amended definition of the crystalliser according to claim of this request referred to (using an only partially different wording) the crystalliser described on page 8, lines 20 to 29, of the application as filed and also shown in Figure 2 thereof (below **the crystalliser of Figure 2**). This crystalliser was "resembling a conventional filter press" whose plates (as also preliminarily acknowledged in the Board's communication) were "*positioned vertically*" also in the sense of being oriented perpendicularly to the ground.

More particularly, the crystalliser's definition in claim 1 at issue explicitly specified that the crystalliser:

- had to comprise a series of cooling chambers, each consisting of the space enclosed by two cooling plates to be hydraulically compressed or withdrawn, and
- was to be operated by first compressing and therefore closing the cooling chambers and then by opening the crystalliser so that the solid blocks dropped down by gravity.

These features of claim 1 in combination also implied for the skilled reader that the plates of the crystalliser had to be assembled "like in a filter press" and that the opening of the **crystalliser** resulted from the hydraulic withdrawal of the plates, i.e. from the opening of the **press**.

Hence, it was not necessary to incorporate the following features, set out in the description of the application as filed (i.e. at page 8, lines 20 to 29) with regard to the crystalliser of Figure 2, into the definition of the crystalliser according to claim 1 at issue:

- (A) that the plates had to be "**assembled like in a filter press**", and
- (B) that it was "**the press forming the crystalliser**" (and not "*the crystalliser*" as recited in claim 1) that was "**opened so that the blocks can drop down by gravity**".

The allegations of the Respondent that the definition of the crystalliser in claim 1 would encompass, *inter alia*, filter press-like crystallisers similar to that of Figure 2 but with plates positioned vertically that could, in addition to being hydraulically compressed/withdrawn, comprise further independently movable parts allowing to discharge the chambers without withdrawing the plates one from the other (i.e. without opening the **press**) were technically unrealistic.

Moreover, the disclosure on page 13, lines 19 to 22, of the application as filed provided a basis for the amended definition of the crystalliser in claim 1 reading "*the crystalliser is opened so that the blocks can drop down by gravity*".

1st Auxiliary Request - Admissibility

Amended claim 1 according to this request expressly required the above-identified feature **A** taken from the description, in the application as filed, of the

crystalliser of Figure 2 (i.e. that the cooling plates were "*assembled like in a filter press*"). Hence, this claim overcame the objections raised by the Respondent against claim 1 of the Main Request.

XIII. The Respondent's arguments of relevance here may be summarized as follows.

Appellant's Main Request - Admissibility

The request was filed unjustifiably late. Its filing was just another attempt to address the same issue under Article 100(c) / 123(2) EPC (vertical positioning of the cooling walls of the crystalliser) that had been under discussion since the filing of the opposition. Hence, the Appellant could and should have filed this request already during the opposition proceedings, e.g. together with the then filed Sixth to Eight Auxiliary Requests or at the latest at the hearing before the Opposition Division.

Main Request - Allowability (Article 123(2) EPC)

The Respondent argued that the definition of the crystalliser required according to amended claim 1 did not necessarily imply the two features **A** and **B**. Hence, this definition could not be considered to find basis in the original description of the crystalliser of Figure 2.

It would be apparent to the skilled person that the series of chamber-forming pairs of cooling plates could be assembled differently as in a filter press, e.g. contiguously on one plane and/or could be discharged differently than by just hydraulically withdrawing the plates from each other, e.g. foreseeing further movable

parts in the plates. Therefore, claim 1 of the Main Request even encompassed processes making use of other crystallisers that, although "resembling a filter press" with vertically positioned plates, were still not encompassed by the disclosure of the crystalliser of Figure 2. For instance, it encompassed the use of crystallisers with plates that comprised additional movable parts whose displacement allowed the solidified blocks to drop out by gravity without "opening the press".

1st Auxiliary Request - Admissibility

Claim 1 of this request did still not mention the above-identified feature **B** of the crystalliser of Figure 2, i.e. a feature that the Board had already explicitly indicated to be missing in claim 1 of the Main Request and, thus, rendering the latter non-compliant with the Article 123(2) EPC. Since this Auxiliary Request was not only filed very late but was thus also *prima facie* not allowable under Article 123(2) EPC, it should not be admitted into the proceedings.

Reasons for the Decision

Appellant's Main Request

1. Admissibility

1.1 The set of claims forming the present Appellant's Main Request was filed with the statement of grounds of appeal (as Eighth Auxiliary Request, see VI *supra*).

1.2 The Board notes the following:

- The Sixth to Ninth Auxiliary Requests admitted by the Opposition Division and considered in the decision under appeal were the first requests of the Patent Proprietor comprising features/wording ("*plates*"; "*positioned vertically above the hopper*"; see IV *supra*) clearly taken from the description, in the application as filed, of a crystalliser comprising a "*series of chambers*" formed by "*plates*" which are "*positioned vertically above the hopper*".
- Only at the oral proceedings had the Patent Proprietor been confronted with the detailed reasons for the Opponent's objections raised under Article 123(2) EPC against claim 1 of these Auxiliary Requests (reasons that also the Opposition Division had found convincing and relied upon in the written decision).
- The filing of the Main Request was another attempt to introduce in claim 1 more features taken from the disclosure in the application as filed relating to the crystalliser comprising a "*series of chambers*" formed by "*plates*" which are "*positioned vertically above the hopper*".

1.3 Thus, the Board accepts that the claims according to the Main Request at issue were filed in reaction to objections only raised at the first instance oral proceedings and to the detailed reasons given in the decisions under appeal. Their filing is thus considered as a legitimate attempt to overcome said objections having led to the rejection of the previously pending claim requests.

1.4 Hence, the Board decided to admit the Appellant's Main Request despite its late filing under cover of the statement of grounds (Article 12(1), (2) and (4) RPBA).

2. Allowability of the amendments - Claim 1

2.1 Claim 1 at issue (VII, *supra*) differs from claim 1 of the application as filed (II, *supra*) in terms of, *inter alia*, the amended definition of the "crystalliser" reading as follows (emphasis added):

*"said crystalliser (3) comprises a **series** of cooling chambers (10) each consisting of the space enclosed by two plates (11) allowing said plates (11) to be hydraulically compressed or withdrawn, during operation said chambers are compressed and therefore closed, to discharge said solidified blocks of crystallised fat the crystalliser is opened so that the blocks can drop down by gravity".*

2.2 The Appellant ultimately argued that this passage was based on the description of the crystalliser of Figure 2 on page 8, lines 20 to 29, of the application as filed which reads (emphasis added):

"As shown in Figure 2, each cooling chamber 10 consists of the space enclosed by two plates 11. The crystalliser 3 comprises a series of such cooling plates 11, assembled like in a filter press, allowing the plates 11 enclosing the cooling chambers 10, to be hydraulically compressed or withdrawn. During operation, the chambers 10 are compressed and therefore closed, and to discharge the solidified blocks of crystallised fat, the press forming the crystalliser 3 is opened so that the blocks can drop down by gravity. This opening and closing can be fully automated."

The Appellant, however, also referred to page 13, lines 19 to 22, of the description of the application as filed reading as follows:

"In the **discharge step** of the process according to the invention, the **chambers 10** are **emptied**. This is achieved by **opening the crystalliser 3** as a result of which the solidified blocks will drop out by gravity. "

- 2.3 The Board notes that none of these two passages of the application as filed quoted under 2.2, *supra*, provides *per se* a complete *verbatim* counterpart of the definition of the crystalliser given in claim 1 at issue (quoted under 2.1, *supra*).
- 2.4 The Board notes further that the passage at page 13 is very general and, in particular, does not exclusively refer to the crystalliser of Figure 2, which comprises chamber-forming plates to be hydraulically compressed/withdrawn. Hence, for the Board, the general indications in the passage on page 13 regarding the opening of the crystalliser as the operation resulting in the discharge of the block(s) by gravity do not amount to an implicit disclosure that also in the crystalliser of Figure 2 the discharge of the block(s) by gravity may (generically) result from any possibly conceivable way of opening "*the crystalliser*", rather than just by opening "*the press forming the crystalliser*" (as specifically described in Figure 2 and on page 8, lines 27 to 28, of the application as filed).
- 2.4.1 Hence, the two passages quoted under 2.2, *supra*, cannot simply be read in combination and considered to thereby form a sufficient basis for the definition of the crystalliser in claim 1 at issue.

2.4.2 No further details need to be given in this respect since the Appellant's line of argument was rather that the definition of the crystalliser as comprised in claim 1 at issue was in substance equivalent to the description of the crystalliser of Figure 2 in the application as filed.

2.5 The crystalliser of Figure 2 is characterised in the above-cited original description by, *inter alia*, features **A** and **B** identified under XII, *supra*.

It is undisputed that these features are, however, not explicitly part of the definition of crystalliser according to claim 1.

2.6 The Appellant nevertheless maintained that the definition of the crystalliser in claim 1 at issue corresponded to the description of the crystalliser of Figure 2 in the application as filed. More particularly, it was of the opinion that features **A** and **B** of the crystalliser of Figure 2 were implicit to claim 1 at issue for a skilled reader, considering that it was specified in claim 1

- that the crystalliser must comprise a "*series of cooling chambers (10)*",
- said chambers "*each consisting of the space enclosed by two plates*",
- that the plates may be be "*hydraulically compressed or withdrawn*",
- that during the operation of the crystalliser "*the chambers are compressed and therefore closed*", and
- that then the "*the crystalliser is opened so that the blocks can drop down by gravity*".

2.7 Contrary to the Appellant's submissions, the Board is not convinced that a crystalliser as defined in claim 1

must implicitly also have the plates "*assembled like in filter press*" (as required by feature **A** and also shown in Figure 2). Other spatial arrangements in which e.g. the chambers were not ordered along parallel planes but along a same plane, as suggested by the Respondent, see XIII *supra*, appear also to be fully compatible with the further requirement that the plates are to be "*hydraulically compressed or withdrawn*".

Likewise, the combination of features defining the crystalliser in claim 1 only appears to require that the opening of the crystalliser must result in the blocks dropping down by gravity. For the Board, it cannot be inferred from the other features of said definition that this operation necessarily requires the hydraulic withdrawal of the plates away from each other, i.e. by opening the press as required by feature **B**.

The Appellant also did not provide any more detailed reasoning, let alone evidence, supporting its allegation, disputed by the Respondent, that a skilled person would consider technically unreasonable the additional presence of further movable parts allowing to discharge the chambers without "*hydraulically withdrawing*" the plates from each other, in a device with cooling plates that can be "*hydraulically compressed or withdrawn*" thereby allowing opening and closing of the cooling chambers formed by the plates.

Hence, the Board accepts the argument of the Respondent (see XIII, *supra*), that the definition of the crystalliser in claim 1 at issue allows for, *inter alia*, the use of crystallisers with vertically positioned chamber-forming plates that might be opened, so that the blocks drop down by gravity, by means/

movements which do not necessarily require opening the press (feature **B** of the crystalliser of Figure 2), i.e. without the hydraulic withdrawal of plates away from each other.

- 2.8 The Board concludes, therefore, that the definition of the crystalliser in claim 1 is broader than the description of the crystalliser of Figure 2 in the application as filed, due to the omission of the two features **A** and **B** from this amended claim.

Hence, claim 1 at issue is directed to subject-matter not disclosed in and extending beyond the content of the application as filed (intermediate generalisation).

- 2.9 If only for this reason, this amended claim does not meet the requirements of Article 123(2) EPC.
3. Therefore, the Appellant's Main Request is not allowable.

Appellant's 1st Auxiliary Request

4. Admissibility

- 4.1 This request was only filed at the oral proceedings before the Board. Its admittance into the proceedings is therefore subject to the Board's discretion under Article 13(3) RPBA.
- 4.2 The Boards of Appeal of the EPO have developed several criteria that may be considered in the exercise of said discretion. In particular, claims which are not *prima facie* clearly allowable are normally not admitted. Claims are clearly allowable if the Board can quickly

ascertain that they do not give rise to new objections and overcome at least the outstanding formal objections under the EPC.

4.3 In the present case, the filing of the request at issue was preceded by the Board's express indication that claim 1 of the Main Request did not meet the requirements of Article 123(2) EPC since it did not specify the above-identified features **A** and **B** of the crystalliser of Figure 2 (see X, *supra*).

4.4 However, although the definition of the crystalliser in claim 1 of the request at issue (wording under X, *supra*) differs from claim 1 of the Main Request in terms of the added feature **A**, it still does not comprise feature **B**.

4.4.1 Hence, *prima facie*, claim 1 of the 1st Auxiliary Request does not appear to overcome both deficiencies under Article 123(2) EPC identified with respect to claim 1 of the Main Request.

4.4.2 In particular, the fact that claim 1 at issue additionally contains feature **A**, i.e. that the series of plates is to be "*assembled like in a filter press*", does not appear to necessarily imply that the sole possible way of opening "*the **crystalliser***" is the hydraulic withdrawal of the plates away from each other and, thus, the "*opening of the **press***" (see 2.7, *supra*).

4.5 Hence, for the Board, claim 1 of the 1st Auxiliary Request does not, *prima facie*, overcome all the outstanding objections under Article 123(2) EPC and is thus not clearly allowable.

4.6 Accordingly, the Board, in the exercise of its discretion under Article 13(3) RPBA, decided not to admit this request into the proceedings if alone for this reason.

Conclusion

5. None of the Appellant's claim requests is both admissible and allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



D. Magliano

B. Czech

Decision electronically authenticated