

Internal distribution code:

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

**Datasheet for the decision
of 5 April 2017**

Case Number: T 2094/12 - 3.2.04

Application Number: 04762873.0

Publication Number: 1670316

IPC: A21B3/13, A47J37/01, B65D81/34,
B65D85/36, B65D25/56, B65D25/08

Language of the proceedings: EN

Title of invention:

PREFILLED PACKING USEABLE AS BAKING TIN AND A RECIPE FOR
INGREDIENTS BEING PREFILLED IN THE PACKING

Patent Proprietor:

Millstone A/S

Opponent:

Dr. August Oetker Nahrungsmittel KG

Headword:

Relevant legal provisions:

EPC Art. 107, 54
RPBA Art. 12(4), 13(1)

Keyword:

Admissibility of appeal - (yes)

Examination of the opposition - extent of power to examine an
opposition

Novelty - main request (prima facie - yes)

Late-filed argument - admitted (no)

Decisions cited:

G 0009/91, T 0293/88, T 0156/90, T 0548/91

Catchword:

reasons 2



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 2094/12 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 5 April 2017

Appellant: Dr. August Oetker Nahrungsmittel KG
(Opponent) Lutterstrasse 14
33617 Bielefeld (DE)

Representative: Graf von Stosch, Andreas
Graf von Stosch
Patentanwalts-gesellschaft mbH
Prinzregentenstraße 22
80538 München (DE)

Respondent: Millstone A/S
(Patent Proprietor) Ornevej 69, 1.tv
2400 Copenhagen NV (DK)

Representative: Holme Patent A/S
Valbygårdsvej 33
2500 Valby (DK)

Decision under appeal: **Interlocutory decision of the Opposition**
Division of the European Patent Office posted on
12 July 2012 concerning maintenance of the
European Patent No. 1670316 in amended form.

Composition of the Board:

Chairman A. de Vries
Members: J. Wright
C. Schmidt

Summary of Facts and Submissions

I. The appellant-opponent lodged an appeal, received 20 September 2012, against the interlocutory decision of the opposition division, posted on 12 July 2012, concerning maintenance of the European Patent No. 1670316 in amended form, and paid the appeal fee at the same time. Their statement setting out the grounds of appeal was filed on 30 October 2012.

II. Opposition was based on, inter alia, lack of novelty and lack of inventive step, Article 100(a) EPC together with Articles 52(1), 54 and 56 EPC.

The opposition division held that the patent as amended according to an auxiliary request met all the requirements of the EPC, having regard to the following documents amongst others:

E1 : DE29918836 U

E4 : DE8804308 U

E5 : GB1598947

III. Oral proceedings before the Board were duly held on 5 April 2017.

IV. The appellant-opponent requests that the decision under appeal be set aside and that the patent be revoked.

The respondent-proprietor requests, as a main request, that the appeal be rejected as inadmissible or that the appeal be dismissed and the patent be maintained in the version held allowable by the opposition division , alternatively, that the patent be maintained in amended form according to one of auxiliary requests 1 to 3 filed with letter of 3 March 2017.

The independent claims of the patent as upheld in the decision under appeal read as follows:

Claim 1: "A packing (1) for food ingredients comprising a container having first part (2) and a second part (3),

- the second part being removable from the first part to provide an opening (6) into said container,
- the first part (2) being made from one or more materials being resistant to temperatures up to 300°C, to allow the first part (2) to be used as a baking tin, said packing (1) being adapted to keep ingredients contained in the packing (1) inside the packing prior to removal of the second part (3); and the packing preferably containing ingredients for producing a bread and/or cake dough, characterised in that
- the second part (3) comprises a lid (5) which upon removal/opening provides an opening (6) which is closable by the lid (5)".

Claim 26: "A method of producing a bread and/or cake dough, such method utilising a packing according to any of the claims 1 - 25 having a first part (2) made from materials resistant to temperatures up to 300°C, making it suitable to be used as a baking tin, a second part (3), being removable from the first part (2) to provide an opening (6) into the container, said packing being prefilled with baking ingredients, the method comprising

- adding liquid, preferably in the right relation, such as a predefined relation, between ingredients and liquid, to the packing,
- and then shaking and/or stirring the ingredients and fluid in the packing,

- and finally baking the produced dough in the first part of the packing".

V. The appellant-opponent argued as follows:

Admissibility of the appeal

The decision adversely affects the appellant-opponent. No consent was given to maintaining the patent in the form held allowable by the division. On the contrary, reasons were given at the oral proceedings before the first instance as to why the patent should not be so maintained.

Admissibility of arguments filed with grounds of appeal.

The proprietor's filing of a request based on granted claim 5 at the first instance oral proceedings came as a surprise, there was then no time to prepare a proper response, so such a response should be allowed in appeal.

Interpretation of the claim

According to claim 1, the second part comprises the lid, this formulation includes the possibility that the entire second part is a lid. Any lid that has been (partly) removed can be replaced. Therefore the amendments to claim 1 vis-à-vis granted claim 1 merely explicitly state what was already implicit in granted claim 1. Therefore claim 1 is, prima facie, not new for the reasons the impugned decision gives for finding the subject matter of granted claim 1 to lack novelty.

In any case, even if the subject matter of present claim 1 were considered to be different from that of granted claim 1, it would still, prima facie, lack novelty against E1, E4 and E5.

In particular, as well as all other claim features, E1 discloses a lid, that is a second part which is at least in places ("stellenweise") detachable from a first part. The corollary of this statement is that the lid may be completely detached, in other words it is removable. Furthermore E1 discloses lids that are closable.

E4 is likewise prima facie novelty destroying. It discloses a springform pan with reclosable lid that doubles as a packing for baking ingredients.

E5 also, prima facie, prejudices novelty of claim 1. Notably it discloses a first part (foil tray) and a second part (sealed cover lid). The cover is removable, therefore it can be put back again, so the second part comprises a lid which, upon removal provides an opening which is closable by the lid.

The arguments made with letter of 4 November 2016 are not new arguments but merely flesh out arguments already presented in the appeal grounds by reference to the opposition proceedings. Therefore they are not late filed so should be admitted into the proceedings.

VI. The respondent-proprietor argued as follows:

Admissibility of the appeal

No opposition was filed against granted claim 5, the subject matter of which is incorporated into claim 1 as

held allowable by the division. Furthermore the appellant agreed that the subject matter of present claim 1 was new in the first instance oral proceedings. This amounts to the proprietor giving consent to the amendments, at least as far as novelty is concerned. Following the jurisprudence of T0156/90 and T0548/91, in such cases the appellant is not adversely affected by the decision and therefore the appeal should be found inadmissible.

Admissibility of arguments filed with grounds of appeal

It cannot have come as a surprise to the appellant that the claim would be amended by combining granted claims 1 and 5 since no objection against this combination was raised in the written opposition proceedings. Therefore the appellant should have been fully prepared for this possibility prior to first instance oral proceedings. In the appeal grounds all the appellant-opponent's arguments pertain to lack of novelty. They had their chance to argue against novelty of claim 1 in opposition but chose not to, even arguing the subject matter of claim 1 to be new. Therefore all their arguments are late filed and should not be admitted.

Prima facie, none of E1, E4 and E5 prejudice novelty of claim 1.

E1 discloses closable lids, but these are hinged, like an egg-box, so their lids are not removable.

E4 does not disclose a packing for food ingredients, rather it discloses a lidded pan that can be used as a storage tin.

E5 discloses a container having a first part in the form of a foil tray that is sealed by a second part in the form of a covering film. This film must be broken to open the container. Afterwards the second part is not closable by the covering film, because the latter is broken.

The appellant-opponent's arguments made with letter of 4 November 2016 are late filed and raise new and complex issues, therefore they should not be admitted into the proceedings.

Reasons for the Decision

1. Admissibility of the appeal
 - 1.1 The impugned decision is appealable, Article 106 EPC, and the appellant-opponent filed a notice of appeal and reasoned grounds of appeal within the prescribed time limits, meeting the formal requirements of Article 108 and Rule 99 EPC.
 - 1.2 Admissibility of the appeal under Rule 101 (1) EPC turns on whether or not the appeal complies with Article 107 EPC, that is whether or not the opponent was adversely affected by the impugned decision.

In the present case the notice of opposition, and indeed the statement of the opponent's request at the start of oral proceedings before the opposition division (minutes, point 1), only mentioned claims 1-4, 18-23 and 27 to 31 of the patent. Thus granted claim 5, which was dependent on granted claim 1, was not specifically mentioned in the notice of opposition. Claim 1 as upheld combines granted claim 1 with the

(non-optional) subject matter of granted claim 5 and is now the respondent-proprietor's main request.

1.3 The subject matter of claim 1 of the main request is therefore based on "dependent subject matters" as referred to in G 9/91, reasons, point 11. According to this point:

"...even if the opposition is explicitly directed only to the subject-matter of an independent claim of a European patent, subject-matters covered by claims which are depending on such an independent claim may also be examined as to patentability, if the independent claim falls in opposition or appeal proceedings, provided their validity is prima facie in doubt on the basis of already available information (cf. T 293/88, OJ EPO 1992, 220). Such dependent subject-matters have to be considered as being implicitly covered by the statement under Rule 55(c) EPC [now rule 76(1)(c) EPC]....".

Thus in the present case, considering in particular the last sentence above, because the opposition notice was explicitly directed to granted claim 1, it was implicitly also directed to the subject matter of granted claim 5, now claim 1 of the main request. Following G9/91, reasons, point 11 the division was thus also competent to in considering prima facie validity of the patent.

1.4 Therefore the crux of the case lies in whether, at the end of the opposition proceedings, the appellant-opponent gave their approval to the claims being amended in accordance with the present main request (as maintained). In the Board's opinion, such approval was not given and the appellant-opponent was therefore

adversely affected by the impugned interlocutory decision.

- 1.5 The Board notes that neither the minutes nor the decision contain any explicit request from the appellant-opponent with respect to claim 1 in the form as held allowable by the opposition division, rather only to the claims as granted with their independent claims 1 and 27 (cf. decision, point 5, minutes point 1).
- 1.6 However, according to the minutes, when present main request was filed at the oral proceedings (then auxiliary request 2), the appellant-opponent said that the request should not be admitted as it was late filed (minutes point 7.3). Furthermore (minutes, point 9.6) the appellant-opponent is said to have stated that claim 1 of that request was "new but to his opinion not inventive over the prior art". Neither of these statements are consistent with a party giving their approval to the patent being maintained according to that request. Rather they show that the appellant-opponent objected to the admissibility and the patentability of the request, and thus implicitly requested that the patent, so amended, be revoked.
- 1.7 Put differently, had the opposition division concurred with the appellant-opponent in considering claim 1 of the request concerned to be inadmissible for being late filed or to lack inventive step, the result of the opposition proceedings would have been revocation of the patent, the main request of the opponent. Because this did not happen, and the division did not accede to this request (the division issued an interlocutory decision concerning maintenance of the patent in amended form), and what ever their view was with

respect to novelty at the time (minutes, point 9.6 again), the appellant-opponent was adversely affected by the decision.

Therefore the present case is quite different from T0156/90 (see reasons 6) and T0548/91 (reasons 1.1), where, in both cases, an opponent as appellant contested an amendment in appeal, to which they had previously expressly and unambiguously agreed in first instance proceedings.

- 1.8 The Board concludes that the appellant-opponent was adversely affected by the impugned decision within the meaning of Article 107 EPC. In view of the above, the Board can but conclude that the appeal is admissible.

2. Scope of the present appeal

The purpose of an appeal procedure inter partes is mainly to give the losing party a possibility to challenge the decision of the opposition division on its merits, G9/91, reasons 18. In this case the opposition division in application of reasons 11 of G9/91 held that validity of the claims as upheld was not prima facie called into doubt by the evidence (documents) then on file. Therefore, in order to challenge this decision on its merits the appellant-opponent must demonstrate why the division was wrong in this finding of prima facie validity and should have carried out a full examination. The review of the decision must take place under the same constraint, i.e. it must consider prima facie validity first, and only if that is not confirmed can a full examination take place. This way the appellant does not gain anything from the appeal vis-a-vis the situation at the end of the first instance proceedings.

The appellant can of course adduce new facts & evidence upon or during appeal, but these will then be subject to the discretion afforded under Article 12(4) and Article 13 RPBA.

3. Background of the invention

The invention relates to a packing for food ingredients having first and second parts, the second part being removable from the first part, the latter being usable as a baking tin (specification, paragraph [0006]).

4. Admissibility of arguments presented by the appellant-opponent for the first time with the grounds of appeal, Article 12(4) RPBA

4.1 In the grounds of appeal, the appellant-opponent's sole arguments were that documents E1, E4 and E5 prejudice novelty of claim 1 as held allowable by the opposition division in the impugned decision. These submissions were first made in appeal, therefore subject to the discretion afforded by Article 114(2) EPC with Article 12(4) RPBA. In exercising their discretion the Boards consider, among other factors, whether or not late filing is justified by developments in the procedure, cf. Case Law of the Boards of Appeal, 8th edition, 2016 (CLBA), IV.C.1.3.14, and the decisions cited therein.

4.2 In spite of there having been no objections to dependent claim 5 by the opponent in the opposition proceedings, this was not the only way the proprietor could have amended the claim. Indeed until the first instance oral proceedings, the proprietor had filed versions of claim 1 according to two auxiliary requests which went in quite different directions (see letter of

16 November 2011 with accompanying requests), neither version mentioned a lid, now a key aspect of claim 1.

Therefore the Board sees no reason why the appellant-opponent should have been prepared for this new request (cf. minutes, point 7.3).

4.3 The appellant-opponent's initial assessment of novelty of claim 1 of the current main request at the oral proceedings in opposition was, at most, made just over an hour after having first seen the claim (cf. minutes, points 5.3, 6.1, 9.6, 9.7). Having admitted the respondent-proprietor's newly formulated request at the very end of the opposition proceedings, it would not be equitable to then limit the appellant-opponent's case in appeal by only admitting counter-arguments falling within the confines of this initial assessment.

4.4 For these reasons, the Board decided to exercise their discretion under Article 114 (2) EPC with Article 12(4) RPBA by admitting the appellant-opponent's submissions filed with their grounds of appeal (novelty vis-à-vis E1, E4 and E5).

5. Main request, prima facie novelty vis-à-vis E1, E4 and E5

5.1 The above findings with respect to admissibility do not change the fact that the notice of opposition did not explicitly mention granted claim 5 (see page 1, point 1). As already explained, how patentability of such dependent subject matter (now in claim 1) is to be examined by the opposition division or the Board, is dealt with in G9/91, point 11 (see above, point 1.3), and the Board only has the power to examine the subject matter of claim 1 (combining granted claims 1 and 5),

and related method claim 26 if its prima facie validity is in doubt on the basis of already available information. As will now be explained, the Board's prima facie assessment casts no doubt on the validity of claims 1 and 26.

5.1.1 Interpretation of certain claim features

Before considering prima facie validity, the Board finds it expedient to focus on the interpretation and significance of certain claim features.

a) "Packing"

Claim 1 is directed at a packing for food ingredients. The Board notes that, in the sense of an object rather than an action, the word "packing" is usually understood to mean the materials used to wrap or protect an object, especially a commercial product (cf. Oxford English dictionary). Thus packing and its cognate "packaging" relate to wrapping for enveloping an object. The patent tallies with this interpretation. According to the summary of the invention (specification, paragraph [0006]), the invention relates to a packing for food ingredients, which may be vacuum or air-tight packed (paragraph [0008]) for long-term storage (paragraph [0012]). The invention (paragraph [0026]) also relates to a method using a packing pre-filled with baking ingredients. Thus the description points to a wrapping for baking ingredients, not simply a container.

b) "removable"

Claim 1 defines the second part of the container as being removable from the first part. According to the

Oxford English dictionary, the usual meaning of "removed" is distant, remote or separate in space, time, or relationship. In the present case of two parts of a container, the one removable from the other, their separation can but be spatial. Thus the Board interprets "removable" in the claim to mean that the second part is spatially separable from the first part.

Nor is a different understanding derivable from the description. In the second part is said to be removed from the first part by tearing off along a score line 4 (specification, paragraphs [0017], [0035] and [0074] figures 1, 34a). The line 4 forms a continuous loop around the second part, so such tearing off results in separation of the two parts, not merely exposing an opening.

c) opening closable by the lid

In accordance with established jurisprudence, the word "comprises" in a claim covers both "made only of" and "includes". In the present case, the second part (that comprises a lid) may therefore be entirely made up of the lid. In this case, the second part (entirely lid) is removable (separable from the first part) to provide an opening, which, according to the last clause of the claim, can subsequently be closed again by the lid.

With respect to this last feature the Board notes that it is not so that all removable lids, once removed to reveal an opening can be used again to close an opening, some lids are destroyed by the process of being removed. Therefore the subject matter of claim 1 of the present main request is not the same as claim 1 as granted. Consequently, the argument that the finding of the impugned decision that the subject matter of

granted claim lacked novelty (reasons. page 2, point 4) must apply also to that of the amended claim 1 as they are identical must, on the face of it, fail.

5.1.2 Prima facie evaluation of novelty vis-à-vis E1

E1 discloses a packing for food ingredients (abstract) with a first part ("Unterteil 2") and second part ("Deckelteil 3"). The second part is, at least in places, detachably connected to the first part (page 1, line 4: "[das Unterteil und Deckteil sind] zumindest stellenweise lösbar miteinander verbunden"). This may mean that E1 includes the possibility of complete detachment, in other words removal, of a second part entirely made up of a lid, as the appellant-opponent has argued. However, in the Board's opinion, at first sight, there is no disclosure of such a lid being able to re-close the opening as the claim also requires. Although E1 does disclose lids which are reclosable, for example with a snap closure (see for example page 10, end of second paragraph), these lids appear not to be removable, rather they remain permanently hinged to a first part, as with an egg-box ("Eierkarton").

5.1.3 Prima facie evaluation of novelty vis-à-vis E4

E4 discloses a springform baking pan ("Blatt 4", second paragraph). It is true that this is provided with a suitable lid 2 which is removable ("Blatt 5, lines 6 to 18, figures 1 and 2). The springform thus doubles as a household container, with its lid 2 (page 6, lines 20 to 32, page 7, lines 18 to 22). In the Board's view, although such a lidded metal container can store baking ingredients, it is not a packing in the sense of the claim, see above.

5.1.4 Prima facie evaluation of novelty vis-à-vis E5

E5 relates to a packing for a baking product of the kind where a first part can be used as a baking tray. The packing also has a removable second part, referred to as a cover, which the consumer removes prior to baking the product (page 1, lines 11 to 30). In the Board's view, such a removable part can be considered to be a lid which upon removal provides an opening. However, on the face of it, E5 appears not to suggest that the opening is closable by the lid after its removal as claimed. The lid is a cover that seals the open face of the container (see claim 8) and is bonded to flanges of the first part (page 3, lines 40 to 46). In the Board's view, because such covers are bonded at their periphery, they must be removed by tearing or cutting in the central area. Therefore they are destroyed when being removed, so could not afterwards serve to re-close the opening.

5.1.5 In the light of the above prima facie evaluations, none of E1, E4 and E5 appear prejudicial to novelty of claim 1. The same applies to independent claim 26, which defines a method that, inter alia, utilises the packing of claim 1. As therefore their validity is not called into question by these documents, and applying the approach outlined above (from G9/91, reasons 11), the Board does not have the power to fully examine novelty of independent claims 1 and 26 vis-à-vis E1, E4 and E5.

6. Ammissibility of the appellant-opponent's arguments filed with letter of 4 November 2016, Article 13(1) RPBA

6.1 In their letter of 4 November 2016, the appellant-opponent submitted novelty attacks based on other

documents (E2, prior use "mixi", E8) as well as attacking inventive step. They argued that the submissions filed with the above letter were not late filed since they merely provided more detailed statements to flesh out arguments which, by reference to their written submissions in opposition, were already contained in the grounds of appeal. The Board sees it differently.

6.2 The references in the grounds of appeal, page 4, middle paragraph, are entirely unspecific and would encompass the entirety of the submissions made in first instance. According to well established jurisprudence, a generic reference in the grounds of appeal to the appellant's submissions in opposition, in the present case five letters, cannot be retroactively interpreted as expressly specifying particular aspects contained therein (see Case Law of the Boards of Appeal, 8th edition, 2016 (CLBA), IV.E.2.6.4, and the decisions cited therein).

6.3 Thus, in the Board's view, far from merely expanding on submissions already on file in appeal, the appellant-opponent filed new facts and arguments with letter of 4 November 2016. Consequently, they constitute amendments to the appellant-opponent's case in the sense of Article 13 of the Rules of Procedure of the Boards of Appeal (RPBA). Under paragraph (1) of that article the Board has discretion in admitting such amendments. The discretion shall be exercised in view of inter alia the complexity of the new subject matter submitted, the current state of the proceedings and the need for procedural economy.

6.4 These new submissions allege, inter alia, lack of novelty against certain documents not mentioned in the

grounds of appeal and lack of inventive step for the first time in appeal. Thus, the submissions raise complex issues for the first time.

- 6.5 The appellant-opponent has not provided any justification for the timing of these submissions, either in the letter itself or at the oral proceedings before the Board. Nor is the Board aware of any significant developments in the proceedings which might have justify their being filed after the grounds.
- 6.6 Accordingly, given the current state of the proceedings, the Board decided not to admit the appellant-opponent's submissions filed with letter of 4 November 2016 into the proceedings pursuant to Article 13(1) RPBA with Article 114 (2) EPC.
7. In conclusion, the arguments presented by the appellant-opponent have failed to cast doubt on the prima facie validity, in particular with respect to novelty, of the subject matter of claims 1 and 26 of the main request vis-à-vis E1, E4 or E5. No further objections of the appellant-opponent have been admitted. In the light of this, applying the approach outlined in G9/91, reasons 11, the Board does not have the power to fully examine patentability of these claims. For these reasons, the arguments presented by the appellant-opponent have not convinced the Board that the impugned decision (see conclusion, point 2 on page 5) was wrong in finding the claims of the present main request (then an auxiliary request) to meet the requirements of the EPC. It follows from this that the Board must dismiss the appeal.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Magouliotis

A. de Vries

Decision electronically authenticated