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**Datasheet for the decision
of 12 July 2016**

Case Number: T 0248/13 - 3.3.09

Application Number: 02747438.6

Publication Number: 1441597

IPC: A23G1/00, A23G1/04

Language of the proceedings: EN

Title of invention:
MANIPULATION OF CHOCOLATE FLAVOUR

Patent Proprietor:
SOCIETE DES PRODUITS NESTLE S.A.

Opponent:
Mars Incorporated

Headword:

Relevant legal provisions:
EPC Art. 100(c), 84
RPBA Art. 12(2), 13(1), 13(3)

Keyword:

Grounds for opposition - subject-matter extends beyond content of earlier application - benefit of the doubt goes to the opponent

Clarity of amendment - feature of granted claim taken out of context - applicability of G 3/14

Late-filed request - change of subject-matter

Decisions cited:

G 0003/14, T 0400/94

Catchword:



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Case Number: T 0248/13 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 12 July 2016

Appellant: SOCIETE DES PRODUITS NESTLE S.A.
(Patent Proprietor) Case postale 353
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Representative: Cockerton, Bruce Roger
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 19 November
2012 revoking European patent No. 1441597
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman W. Sieber
Members: M. O. Müller
D. Prietzel-Funk

Summary of Facts and Submissions

- I. This decision concerns the appeal filed by the proprietor of European patent No. 1 441 597 against the decision of the opposition division to revoke it.
- II. With its notice of opposition, the opponent had requested revocation of the patent in its entirety on the grounds under Article 100(a) (lack of novelty and lack of inventive step), 100(b) and 100(c) EPC.

The documents submitted during the opposition proceedings included:

D2: DE 38 03 180 A1;

D4: "Chocolate, Cocoa, and Confectionery: Science and Technology", B.W. Minifie, 3rd edition, 1989, 74 pages;

D5: "Industrial Chocolate Manufacture and Use", S.T. Beckett (ed.), 2nd edition, 1994, 58 pages;

D11: US 2,835,592 A;

D17: EP 1 084 622 A2; and

D20: Declaration of Mr J.M. Kaiser, August 2012.

- III. The decision of the opposition division was based on a main request and auxiliary requests 1 and 2.

Claim 1 of the main request read as follows:

"1. A process for manipulating the flavour of a single mass of chocolate which comprises first

reducing or removing the natural flavour from the chocolate ingredients or the chocolate mass by stripping and then adding to the chocolate mass from 0.001% to 10% by weight based on the weight of the chocolate mass of a flavour attribute associated with chocolate and obtained by adding cocoa and/or milk/dairy flavours or by adding non-cocoa/dairy flavours to a single mass."

The main request was rejected *inter alia* on the ground that the feature in claim 1 "a flavour attribute associated with chocolate" was not based on the application as filed.

Claim 1 of auxiliary request 1 was amended to refer to "a consumer recognisable flavour attribute associated with chocolate".

The term "consumer recognisable" was considered to be clear since flavour attributes in general were subjective and the added term "did not make this more subjective". T 94/82 did not apply since the consumer-recognisable flavour attribute was not a parameter as referred to in this decision, i.e. it was not a measurable parameter. However, the first auxiliary request was rejected on the ground that it lacked novelty.

The second auxiliary request was rejected on the ground that it lacked inventive step in view of *inter alia* D2 as the closest prior art.

IV. This decision was appealed by the proprietor (hereinafter: the appellant). The notice of appeal contained a clerical error in that it referred in the first line to the opponent rather than the proprietor

as the appealing party. The appellant requested that this be corrected. The appellant's statement setting out the grounds of appeal contained

D21: M. Stauffer, "The Flavor of Milk Chocolate - Changes Caused by Processing, 54th PMCA Production Conference, 2000, pages 145 to 150;

D22: J. Urbanski, "Dark Chocolate: What Affects the Flavor?", 55th PMCA Production Conference, 2001, pages 152 to 157; and

D23: S. Lambert, "Cocoa fermentation - general aspects", 8 pages.

and auxiliary requests 1 to 26, the main request being the claims as granted.

V. In response, the opponent requested that D21 and D22 not be admitted into the proceedings.

VI. Subsequently, the board issued its preliminary opinion, in which it observed that the amendment of the flavour attribute in claim 1 of the then main request as being associated with chocolate was not based on the application as filed and that the definition of the flavour attribute in the then auxiliary request 5 as being "a consumer recognisable flavour attribute associated with chocolate" and not the mere enhancement of the chocolate flavour appeared to render this claim unclear. The board also addressed the question of inventive step of the subject-matter of claim 1 of this request in view of D2 as the closest prior art.

VII. In the subsequent proceedings, the parties filed the following further documents:

D24: A. Purwantara et al., Crop Protection, volume 77, 2015, page 18 (appellant).

D25: EU Directive 2000/36/EC (respondent).

VIII. With letter dated 26 May 2016, the appellant filed a new main request and new auxiliary requests 1 to 4 to replace all requests previously on file.

IX. In response, the respondent requested that these requests as well as several arguments not be admitted into the proceedings.

X. On 12 July 2016, oral proceedings were held before the board. The appellant withdrew its request that the notice of appeal be corrected. The respondent withdrew its request that the main request and auxiliary request 1 not be admitted. During the oral proceedings, the parties did not rely on D21 and D22, so that there was no need to decide on the admission of these documents.

XI. Claim 1 of the main request reads as follows:

"1. A process for manipulating the flavour of a single mass of chocolate which comprises first reducing or removing the natural flavour from the chocolate ingredients or the chocolate mass by stripping and then adding to the chocolate mass from 0.001 % to 10% by weight based on the weight of the chocolate mass of a flavour attribute associated with chocolate and obtained by adding cocoa and/or milk/dairy flavours or by adding non-cocoa/dairy flavours to a single mass, wherein the natural chocolate flavour is reduced or removed

from the chocolate mass by pretreating cocoa during or following roasting with water which is later evaporated and takes with it the flavour, or by adding water to liquid chocolate as it is processed by a high shearing/drying machine, or by avoiding the use of commercially available high heat-treated milk powders which possess strong cooked "Maillard" flavours, or by using spinning discs, PDAT reactors (Carle & Montanari) with inert gas, or scraped surface heat exchangers with forced air or vacuum applied."

Claim 1 of the auxiliary requests reads as follows (amendments to the main request indicated):

Auxiliary request 1:

"1. A process for manipulating the flavour of a single mass of chocolate which comprises first reducing or removing the natural flavour from the chocolate ingredients or the chocolate mass by stripping and then adding to the chocolate mass from 0.001 % to 10% by weight based on the weight of the chocolate mass of a flavour attribute associated with chocolate and obtained by adding cocoa and/or milk/dairy flavours or by adding non-cocoa/dairy flavours to a single mass, wherein the natural chocolate flavour is reduced or removed from the chocolate mass by pretreating cocoa during or following roasting with water which is later evaporated and takes with it the flavour, or by adding water to liquid chocolate as it is processed by a high shearing/drying machine, or by avoiding the use of commercially available high heat-treated milk powders which possess strong cooked "Maillard" flavours, or by using spinning discs, PDAT reactors

(Carle & Montanari) with inert gas, or scraped surface heat exchangers with forced air or vacuum applied, **wherein the flavour attribute is a consumer-recognisable flavour associated with chocolate, other than chocolate flavour enhancement or an overriding, dominant flavour different to chocolate.**"

Auxiliary request 2:

"1. A process for manipulating the flavour of a single mass of chocolate which comprises first reducing or removing the natural flavour from the chocolate ingredients or the chocolate mass by stripping and then adding to the chocolate mass from 0.001 % to 10% by weight based on the weight of the chocolate mass of a flavour attribute associated with chocolate and obtained ~~by adding cocoa and/or milk/dairy flavours or~~ by adding non-cocoa/dairy flavours to a single mass, wherein the natural chocolate flavour is reduced or removed from the chocolate mass by pretreating cocoa during or following roasting with water which is later evaporated and takes with it the flavour, or by adding water to liquid chocolate as it is processed by a high shearing/drying machine, or by avoiding the use of commercially available high heat-treated milk powders which possess strong cooked "Maillard" flavours, or by using spinning discs, PDAT reactors (Carle & Montanari) with inert gas, or scraped surface heat exchangers with forced air or vacuum applied, **wherein the flavour attribute is a consumer-recognisable flavour associated with chocolate, other than chocolate flavour enhancement or an overriding, dominant flavour different to chocolate.**"

Auxiliary request 3:

"1. A process for manipulating the flavour of a single mass of chocolate which comprises first reducing or removing the natural flavour from the chocolate ingredients or the chocolate mass by stripping and then adding to the chocolate mass from 0.001 % to 10% by weight based on the weight of the chocolate mass of a flavour attribute associated with chocolate and obtained ~~by adding cocoa and/or milk/dairy flavours or~~ by adding non-cocoa/dairy flavours to a single mass, wherein the natural chocolate flavour is reduced or removed from the chocolate mass by pretreating cocoa during or following roasting with water which is later evaporated and takes with it the flavour, or by adding water to liquid chocolate as it is processed by a high shearing/drying machine, or by avoiding the use of commercially available high heat-treated milk powders which possess strong cooked "Maillard" flavours, or by using spinning discs, PDAT reactors (Carle & Montanari) with inert gas, or scraped surface heat exchangers with forced air or vacuum applied, **wherein the non-cocoa/dairy flavour attribute added to the chocolate mass is a concentrate formed by adding a mixture of flavour precursors comprising (A) proline, ornithine or protein hydrolysate, and (B) rhamnose, fructose or fucose, to a fat-based medium and heating the mixture to about 100-400 C for about 10-120 minutes.**"

Auxiliary request 4 is a combination of auxiliary requests 1 and 3.

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

Main request

The definition of the flavour attribute in claim 1 as being associated with chocolate was based on the last line of page 2 to the third line of page 3 of the application as filed, bearing in mind that a patent document was its own dictionary. A further basis was page 2, lines 23 to 30, page 3, lines 5 to 10 and page 3, line 20 of the application as filed.

Auxiliary request 1

The definition of the flavour attribute in claim 1 as being a consumer-recognisable flavour associated with chocolate, other than chocolate flavour enhancement or an overriding, dominant flavour different to chocolate, was clear. The description of the patent and numerous prior-art documents gave examples of flavour attributes falling within and outside this definition and these flavour attributes were well known in the art. The definition of the flavour attribute in claim 1 of auxiliary request 1 simply implied that the flavour attribute was one that was or at least could be generated during chocolate making. Even if unclear, the definition of the flavour attribute in claim 1 could not be attacked under Article 84 EPC, since it had already been present in dependent claim 15 as granted.

Auxiliary request 3

Auxiliary request 3 was admissible, since the amendments in this request were a reaction to the board's preliminary opinion on inventive step in view of D2. Furthermore, the amendment addressed the clarity objection against the definition of the flavour attribute that had been the focus of the proceedings so far. Lastly, the subject-matter of claim 7, from which the new definition of the flavour attribute was derived, dominated the description and the examples of the patent and had already been attacked by the opponent in its notice of opposition. The opponent had thus had the opportunity to comment on the new definition of the flavour attribute.

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

Main request

The definition of the flavour attribute in claim 1 as being associated with chocolate was not based on the application as filed. The last line of page 2 to the third line of page 3 of the application as filed disclosed this definition only in connection with further requirements to be fulfilled by the flavour attribute that were not present in the claim. The other passages cited by the appellant as a basis referred to the flavour of the final chocolate rather than to that of the flavour ingredient to be added thereto.

Auxiliary request 1

The definition of the flavour attribute in claim 1 as being a consumer-recognisable flavour associated with chocolate, other than chocolate flavour enhancement or an overriding, dominant flavour different to chocolate, lacked clarity. The terms used were entirely subjective and in fact even depended on the geographical location at which the flavour was determined. This definition was objectionable under Article 84 EPC, since it had been taken out of the context of claim 15 and had been put into a different context in claim 1. This had created a lack of clarity compared with the claims as granted.

Auxiliary request 3

This auxiliary request should not be admitted into the proceedings. The specific definition of the flavour attribute in the claims of this auxiliary request had never been present in any of the claim requests submitted so far. Furthermore, the appellant had kept entirely silent as to why this feature could contribute to inventive step. The respondent thus was not prepared to address this issue during the oral proceedings. It had in fact expected that, in view of the large number of requests filed with the statement of grounds of appeal, all the amendments contemplated by the appellant had been incorporated into those claims. It was thus very surprising that an entirely new claim request had been filed at a much later stage. This request should have been filed much earlier since the issues it was intended to address had

already been dealt with in the opposition division's decision.

XIV. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claims of the main request or any of auxiliary requests 1 to 4, all requests submitted with letter dated 26 May 2016.

The respondent requested that the appeal be dismissed.

Reasons for the Decision

Main request

1. Amendments - Article 100(c) EPC

1.1 Claim 1 of the main request relates to a process for manipulating the flavour of a single mass of chocolate which comprises first reducing or removing the natural flavour from the chocolate ingredients or the chocolate mass and then adding to the chocolate mass a flavour attribute associated with chocolate.

1.2 Claim 1 as filed discloses the same general process except that it refers to a flavour attribute rather than a flavour attribute associated with chocolate.

Hence, apart from the definition of the flavour attribute, this general process is based on claim 1 as filed.

1.3 It was a matter of discussion between the parties whether also the definition of the flavour attribute as

being associated with chocolate was based on the application as filed.

- 1.4 According to the appellant, this definition was based on the last line of page 2 to the third line of page 3 of the application as filed, where the following is disclosed:

"By flavour attribute in this invention, we mean a consumer-recognisable flavour attribute associated with chocolate, and not the mere enhancement of the chocolate flavour, e.g. by adding vanilla, or a different overriding, dominant flavour such as peppermint" (emphasis added by the board).

- 1.4.1 The board acknowledges that this passage discloses the definition "flavour attribute associated with chocolate" as present in claim 1 of the main request. However, unlike claim 1 of the main request, this definition requires the flavour attribute to meet further criteria, namely that it is consumer-recognisable but not a mere enhancement of the chocolate flavour or a different overriding, dominant flavour. Therefore, this passage cannot provide a basis.
- 1.4.2 The appellant argued in this respect that a patent document was its own dictionary. Therefore, the skilled person reading claim 1 of the main request would understand "flavour attribute associated with chocolate" in the light of the above-discussed passage of the description - the same passage is present in paragraph [0006] of the patent as granted - and if interpreted in this way, there was no difference between the definition of the flavour attribute in claim 1 of the main request and the above-discussed

passage in the application as filed. The skilled person would in particular realise that in the light of this passage of the description, the further criteria were inherently present in claim 1.

However, if accepted, this argument would lead to the untenable conclusion that a claim amendment relating to an isolated feature disclosed in the description as filed only in combination with further features can never be objected to under Article 123(2) EPC, since the claim would have to be interpreted in the light of the description and thus inherently includes all these further features.

Furthermore, the alleged dictionary-like definition in the above-discussed passage of the application as filed in fact defines the term "flavour attribute" rather than "flavour attribute associated with chocolate" as present in claim 1 of the main request. It is not at all clear whether a definition given for a flavour attribute as such also applies to a flavour attribute associated with chocolate. In the present case however, the benefit of the doubt goes to the opponent (respondent) rather than to the proprietor (appellant) who is responsible for the amendment (T 400/94, point 2.1.6).

1.4.3 Hence, it still holds true that the above-discussed passage of the application as filed cannot be considered to provide a basis for the feature "flavour attribute associated with chocolate" in claim 1 of the main request.

1.5 The appellant furthermore argued that a flavour attribute associated with chocolate was disclosed without any further restriction on page 2, lines 23

to 30, page 3, lines 5 to 10 and page 3, line 20 of the application as filed. These passages disclose the following:

"..., it is important to match the chocolate flavour attribute with the flavour intensity type of the other ingredient. For example, a cooked chocolate flavour attribute is desirable for a chocolate biscuit, a strong cocoa flavour attribute is required to offset a mint flavour intensity type whereas only a mild flavour attribute is required for praline which has a low intensity flavour. It would be very desirable to be able to manipulate the flavour associated with chocolate produced by a single process to obtain a flavour attribute of one's choice by adding the desired flavour attribute to a single chocolate mass irrespective of the process of preparation of the chocolate mass, the formulations and the ingredient origins" (page 2, lines 23 to 30; emphasis added).

"We have found, surprisingly, that by removing at least some of the natural flavour from the chocolate ingredients or the chocolate mass and then adding the desired flavour attribute to the chocolate mass, it is possible to manipulate the flavour associated with chocolate of the chocolate by adding the desired flavour attribute to a single chocolate mass irrespective of the process of preparation of the chocolate mass, the formulations and the ingredient origins" (page 3, lines 5 to 10; emphasis added).

"This [i.e. the process described in the preceding paragraph, namely a process for manipulating the flavour of a single mass of chocolate by removing

at least some of the natural flavour from the chocolate ingredients or the chocolate mass and then adding an effective amount of a flavour attribute to the chocolate mass] provides a flavour attribute associated with chocolate ..." (page 3, line 20; emphasis and insertion in square brackets added).

In all these passages the flavour or flavour attribute associated with chocolate refers to the flavour of the final chocolate obtained after adding the flavour attribute rather than to that of the flavour attribute to be added to the chocolate mass. Therefore, these passages cannot provide a basis for the definition of the flavour attribute in claim 1 of the main request either.

In this respect, the appellant's argument that the flavours of the final chocolate and that of the flavour attribute added thereto were the same is not persuasive. For instance, if no milk is added during the manufacture of chocolate, the resulting chocolate generally has a rather strong chocolate taste, so that the flavour of a flavour attribute additionally present may disappear completely. Hence, the taste of the final chocolate and that of the flavour attribute are not necessarily the same.

- 1.6 Consequently, the definition of the flavour attribute in claim 1 as granted as one associated with chocolate is not based on the application as filed.

- 1.7 As set out above, the appellant relied on the argument that the patent was its own dictionary, so that claim 1 of the main request inherently defined the flavour attribute as disclosed in the application as filed. The

respondent requested that this argument not be admitted into the proceedings since the appellant had presented it for the first time with its letter dated 26 May 2016.

The board admitted the appellant's argument into the proceedings since it was a legal argument that did not change the factual framework of the case. As set out above, however, this argument does not alter the fact that the feature "flavour attribute associated with chocolate" in claim 1 of the main request is not based on the application as filed.

Auxiliary request 1

2. Amendments - Article 84 EPC

2.1 The flavour attribute in claim 1 of auxiliary request 1 has been defined to be a consumer-recognisable flavour associated with chocolate, other than chocolate flavour enhancement or an overriding, dominant flavour different to chocolate.

2.2 It is unclear when a flavour attribute is on the one hand so different from chocolate flavour that it is recognised by the consumer as a flavour that is more than the mere enhancement of the chocolate flavour, and on the other hand is not so different from the chocolate flavour that it is considered to be an overriding, dominant flavour. All these definitions, of "consumer recognisable", "chocolate flavour enhancement" and "overriding, dominant flavour" are entirely subjective and cannot define a clear boundary between flavour attributes that fall within the definition of claim 1 of auxiliary request 1 and those that do not.

2.2.1 In fact, the patent itself (paragraph [0005] acknowledges that

"However, it is well known that there are a large number of different consumer-recognisable flavour attributes associated with chocolate, other than the mere enhancement of the chocolate flavour or a different overriding, dominant flavour, which vary considerably around the world according to local consumer preferences" (emphasis added by the board).

Hence, whether something is a flavour attribute as defined in claim 1 of auxiliary request 1 even depends on the part of the world where the flavour attribute is tested.

This is confirmed by D5 (page 258) which states that

"Defining tastes in different countries obviously has to be given in broad strokes, as to be too defined will only lead to controversy."

2.2.2 The appellant argued that the description of the patent (paragraph [0005]) gave numerous examples of flavour attributes meeting the definition in claim 1 of auxiliary request 1, and explicitly stated that these flavour attributes were well known in the cocoa trade where they formed part of the vocabulary.

However, the board fails to see how this can render the definition of the flavour attribute in claim 1 of auxiliary request 1 clear. Firstly, the claim as such must be clear in order to meet the requirements of Article 84 EPC. Secondly, the cited passage of the

description discloses the various flavour attributes only as examples (page 2, line 32: "for example") and leaves it open what other flavour attributes different from the exemplified ones fall under the definition of flavour attributes in claim 1 of auxiliary request 1.

- 2.2.3 The appellant also argued that flavour attributes that did or did not fall within the definition given in claim 1 of auxiliary request 1 were also disclosed in D4 (page 496, points 1 and 2), D5 (page 268, lines 3 to 10), D11 (column 5, line 16), D17 (example 1) and D20 (footnote on page 2).

However, none of the cited documents refers to the definition of flavour attributes as given in claim 1 of auxiliary request 1, let alone shows that it is clear to the skilled person what flavour attributes fall under this definition.

- 2.2.4 The appellant furthermore argued that the definition in claim 1 of auxiliary request 1 implied that the flavour attribute was one that was or at least could be generated during chocolate making.

There is however nothing in the definition of the flavour attribute in claim 1 of auxiliary request 1 that supports this assertion. In fact, this assertion actually contradicts the claim, which requires - as one alternative - that the flavour attribute associated with chocolate be obtained from **non-cocoa/dairy** flavours.

- 2.2.5 The appellant lastly argued that the definition of the flavour attribute in claim 1 of auxiliary request 1 could not be attacked under Article 84 EPC in

opposition appeal proceedings, since this feature was already present in dependent claim 15 as granted.

According to G 3/14 (catchword), the claims of a patent may be examined for compliance with the requirements of Article 84 EPC only when, and then only to the extent that, the amendment introduces non-compliance with Article 84 EPC.

Claim 15 as granted reads as follows:

"15. A process for manipulating the flavour of a single mass of chocolate according to claim 1 to provide a specific consumer-recognisable flavour associated with chocolate, other than chocolate flavour enhancement or an overriding, dominant flavour different to chocolate, in a chocolate however manufactured which comprises ...adding to the chocolate mass from 0.001% to 10% by weight based on the weight of the chocolate mass of an appropriate flavour attribute associated with chocolate and obtained by..." (emphasis added).

It is true that claim 15 as granted, like claim 1 of auxiliary request 1, contains the ambiguous terms "consumer-recognisable", "chocolate flavour enhancement" and "overriding, dominant flavour". However, unlike claim 1 of auxiliary request 1, where these terms refer to the ingredient (flavour attribute) to be added to the chocolate, in claim 15 as granted they define the flavour of the final chocolate ("chocolate however manufactured"). By taking these terms out of the context in claim 15 as granted (final chocolate), and by placing them in the context of claim 1 of auxiliary request 1 (ingredient to be added to the chocolate) a new ambiguity is introduced that was not

present before. Therefore this amendment of claim 1 of auxiliary request 1 is objectionable under Article 84 EPC.

- 2.3 The definition of the flavour attribute introduced by way of amendment into claim 1 of auxiliary request 1 thus does not meet the requirements of Article 84 EPC. Auxiliary request 1 is therefore not allowable.

Auxiliary request 2

3. Claim 1 of auxiliary request 2 contains the same unclear definition of the flavour attribute as claim 1 of auxiliary request 1. Therefore, for the same reasons as given for auxiliary request 1, this definition does not meet the requirements of Article 84 EPC. Consequently, auxiliary request 2 is not allowable either. In view of this, the board did not need to decide on the respondent's request that auxiliary request 2 not be admitted into the proceedings.

Auxiliary request 3

4. Admission

- 4.1 This request, which the appellant submitted with its letter dated 26 May 2016, is an entirely new request. It differs from the main request *inter alia* in that in claim 1 the flavour attribute has been restricted to a specific flavour attribute by adding the following wording at the end:

"wherein the non-cocoa/dairy flavour attribute added to the chocolate mass is a concentrate formed by adding a mixture of flavour precursors comprising (A) proline, ornithine or protein

hydrolysate, and (B) rhamnose, fructose or fucose, to a fat-based medium and heating the mixture to about 100-400 C for about 10-120 minutes."

- 4.2 The respondent requested that this request not be admitted into the proceedings.
- 4.3 The appellant argued that auxiliary request 3 should be admitted, since the amendments in this request were a reaction to the board's preliminary opinion on inventive step in view of D2.

However, the opposition division had already decided that the then second auxiliary request lacked inventive step in view of this document (point 5.5.2). Furthermore, the respondent raised numerous inventive-step objections in its response to the statement of grounds of appeal, including an attack starting from D2 as the closest prior art. Consequently, the appellant could and should have filed auxiliary request 3 already with its statement of grounds of appeal or, at the latest, in reply to the respondent's response. Instead, it waited almost three years, until 26 May 2016 before doing so. This is aggravated by the fact that the appellant had filed 27 claim requests already with its statement of grounds of appeal, which led the respondent and the board to believe that those requests contained all the amendments the appellant considered to be necessary.

The filing of auxiliary request 3 makes it necessary for the first time to examine whether the specific flavour attribute now claimed contributes to inventive step. However, until the oral proceedings, the appellant had not put forward any arguments as regards the inventive step of subject-matter characterised by

this specific flavour attribute. Hence any arguments that the appellant could have presented at the oral proceedings would have been entirely new to the respondent and the board.

4.4 During the oral proceedings, the appellant argued that the amendment addressed the clarity objection against the definition of the flavour attribute that had been the focus of the proceedings so far. However, if the objection that allegedly led to the filing of auxiliary request 3 had been the focus throughout the proceedings, this would have been even more reason to file this auxiliary request earlier.

4.5 The appellant lastly argued that the subject-matter of granted claim 7, from which the new definition of the flavour attribute was derived, dominated the description and the examples of the patent and had already been attacked by the opponent in its notice of opposition. The opponent had thus not only had the opportunity to comment on the new definition of the flavour attribute, but had actually used it.

The appellant's argument is not persuasive. It was the proprietor that appealed the opposition division's decision and it would thus have been on the proprietor/appellant to show that this decision was wrong and to present its complete case - including present auxiliary request 3 - with its statement of grounds of appeal (Article 12(2) RPBA). It is not the task of the opponent/respondent to speculate about what amendments might be made by the proprietor at some later stage of the proceedings and to prepare pre-emptively for them.

4.6 In conclusion, the filing of auxiliary request 3 represents a change of case at a very late stage that

neither the board nor the respondent could have been expected to deal with during the oral proceedings. The board therefore decided not to admit auxiliary request 3 into the proceedings (Article 13(1) and (3) RPBA).

Auxiliary request 4

5. Admission

Like claim 1 of auxiliary request 3, claim 1 of auxiliary request 4 contains the new definition of the flavour attribute:

"wherein the non-cocoa/dairy flavour attribute added to the chocolate mass is a concentrate formed by adding a mixture of flavour precursors comprising (A) proline, ornithine or protein hydrolysate, and (B) rhamnose, fructose or fucose, to a fat-based medium and heating the mixture to about 100-400 C for about 10-120 minutes."

Hence, in the same way as for auxiliary request 3, neither the board nor the respondent could be expected to deal at the oral proceedings with the question as to whether this amendment contributed to inventive step during the oral proceedings. Therefore, the board decided not to admit auxiliary request 4 into the proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. Cañueto Carbajo

W. Sieber

Decision electronically authenticated