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

Case Number: T 0409/13 - 3.3.03

Application Number: 01935205.3

Publication Number: 1292639

IPC: C08L3/00

Language of the proceedings: EN

Title of invention:

HIGHLY FLEXIBLE STARCH-BASED FILMS

Patent Proprietor:

Tate & Lyle Ingredients Americas LLC

Opponent:

Cargill, Incorporated

Relevant legal provisions:

EPC Art. 123(2), 123(3)

Keyword:

Amendments - extension beyond the content of the application as filed (yes) Main request and auxiliary requests 1-5, 7-11, 13-16, 18-21 - Extension of protection conferred by the European patent (yes) Auxiliary requests 6, 12, 17, 22



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Case Number: T 0409/13 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 12 January 2016

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 23 November
2012 revoking European patent No. 1292639
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman F. Rousseau
Members: D. Marquis
R. Cramer

Summary of Facts and Submissions

I. The appeal by the patent proprietor lies from the decision of the opposition division posted on 23 November 2012 revoking European patent N° 1 292 639 (based on application number 01 935 205.3).

II. The application was originally filed with a set of 47 claims of which claims 1, 5, 6 and 8 read as follows:

"1. A gelatin-free film-forming composition, comprising:
starch material having a dextrose equivalent less than about 1 and selected from the group consisting of modified starch and waxy starch; and
a primary external plasticizer;
wherein the weight ratio of plasticizer to starch material is at least about 0.5:1."

"5. The composition of claim 1, further comprising water."

"6. The composition of claim 5, wherein the composition comprises 30-70% by weight dry solids."

"8. The composition of claim 6, wherein the dry solids in the composition comprise 25-75% starch material, 25-75% plasticizer, and 0-15% gum or synthetic polymer."

III. The patent as granted contained a set of 26 claims of which independent claim 1 read as follows:

"1. A gelatin-free film-forming composition, comprising:
starch material having a dextrose equivalent less than

1 and selected from the group consisting of waxy starch and modified starch, wherein said modified starch is selected from hydroxypropyl, hydroxyethyl, succinate and octenyl succinate starch and has an average molecular weight of 100,000-2,000,000 and a degree of substitution of at least 0.015; and a primary external plasticizer comprising at least one compound having the formula $C_nO_nH_x$, wherein n has a value between 3 and 6, and x has a value between 2n and (2n+2), or a dimer or oligomer of such a compound; wherein the weight ratio of plasticizer to starch material is from 1:1 to 3:1; and said composition is iota-carrageenan free and is not a composition consisting of 20.0% wt. PURE-COTE[®], 6.0% wt. kappa-carrageenan, 2.0% wt. xanthan gum, 20.0% wt. glycerin USP, 1.0% wt. sodium phosphate di basic, 0.20% wt. preservative and 50.8% wt. water USP."

Claims 2-26 were directed to preferred embodiments of claim 1. Claims 5, 6 and 8 read as follows:

"5. The composition of claim 1, further comprising water."

"6. The composition of claim 5, wherein the composition comprises 30-70% by weight dry solids."

"8. The composition of claim 6, wherein the dry solids in the composition comprise 25-75% starch material, 25-75% plasticizer, and 0-15% gum or 0-50% synthetic polymer."

IV. A notice of opposition against the patent was filed in which the revocation of the patent was requested on the grounds according to Article 100(a) EPC (lack of

novelty and lack of inventive step), Article 100(b) EPC and Article 100(c) EPC.

V. By decision of 23 November 2011, the opposition division revoked the patent. The decision was based on the main request (claims as granted) as well as five auxiliary requests filed on 9 August 2012. The opposition division found that the disclaimer in claim 1 of the main request and auxiliary request 1 that was introduced in view of D7 (WO-A1-01/03 677) was not allowable. The amendments to claim 1 of auxiliary requests 2, 3, 4 and 5 were not disclosed in the application as filed. Also, it was found that claim 8 of the main request and auxiliary requests 2 to 5 did not fulfil the requirements of Article 123(2) EPC because there was no basis in the description as originally filed for a composition comprising 0-50% of synthetic polymer that was not water soluble. None of the requests complied with the requirements of Article 123(2) EPC.

VI. On 1 February 2013, the patent proprietor lodged an appeal against the decision of the opposition division. The statement setting out the grounds of the appeal was received on 8 April 2013. The patent proprietor requested that the patent be maintained on the basis of the main request (claims as granted) or any of twenty two auxiliary requests filed with the statement of grounds of the appeal.

The claims of the auxiliary requests that are decisive to the present decision are indicated hereafter:

Claim 1 of auxiliary request 1 corresponds to claim 1 as granted.

Auxiliary requests 2 and 3

"8. The composition of claim 6, wherein the dry solids in the composition comprise 25-75% starch material, 25-75% plasticizer, and 0-15% gum or 0-50% synthetic polymer."

Auxiliary requests 4 and 5

"8. The composition of claim 6, wherein the dry solids in the composition comprise 25-75% starch material, 25-75% plasticizer, and 0-50% synthetic polymer."

Auxiliary request 6

"1. A gelatin-free film-forming composition, consisting essentially of:

starch material having a dextrose equivalent less than 1 and selected from the group consisting of waxy starch and modified starch, wherein said modified starch is selected from hydroxypropyl, hydroxyethyl, succinate and octenyl succinate starch and has an average molecular weight of 100,000-2,000,000 and a degree of substitution of at least 0.015; and

a primary external plasticizer comprising at least one compound having the formula $C_nO_nH_x$, wherein n has a value between 3 and 6, and x has a value between 2n and (2n+2), or a dimer or oligomer of such a compound; and optionally water,

wherein the weight ratio of plasticizer to starch material is from 1:1 to 3:1."

Auxiliary request 7

"1. A gelatin-free film-forming composition, comprising:

starch material having a dextrose equivalent less than 1 and selected from the group consisting of waxy starch and modified starch, wherein said modified starch is selected from hydroxypropyl, hydroxyethyl, succinate and octenyl succinate starch and has an average molecular weight of 100,000-2,000,000 and a degree of substitution of at least 0.015; and a primary external plasticizer having the formula $C_nO_nH_x$, wherein n has a value between 3 and 6, and x has a value between 2n and (2n+2), where at least 80% of the oxygen is in the form of hydroxyl groups, and the remaining are in the form of ether groups, or a dimer, disaccharide or low molecular weight oligosaccharide of such a compound; wherein the weight ratio of plasticizer to starch material is from 1:1 to 3:1; and said composition is iota-carrageenan free and is not a composition consisting of 20.0% wt. PURE-COTE[®], 6.0% wt. kappa-carrageenan, 2.0% wt. xanthan gum, 20.0% wt. glycerin USP, 1.0% wt. sodium phosphate di basic, 0.20% wt. preservative and 50.8% wt. water USP."

Auxiliary requests 8, 9, 13, 14, 18 and 19

"7. The composition of claim 1, wherein the solids in the composition comprise 25-50% starch material, 50-75% plasticizer, and 0-15% water-soluble gum or 0-50% water-soluble synthetic polymer."

Auxiliary requests 10, 11, 15, 16, 20 and 21

"7. The composition of claim 1, wherein the solids in the composition comprise 25-50% starch material, 50-75% plasticizer, and 0-50% water-soluble synthetic polymer."

Auxiliary request 12

"1. A gelatin-free film-forming composition, consisting essentially of:
starch material having a dextrose equivalent less than 1 and selected from the group consisting of waxy starch and modified starch, wherein said modified starch is selected from hydroxypropyl, hydroxyethyl, succinate and octenyl succinate starch and has an average molecular weight of 100,000-2,000,000 and a degree of substitution of at least 0.015; and
a primary external plasticizer comprising at least one compound having the formula $C_nO_nH_x$, wherein n has a value between 3 and 6, and x has a value between $2n$ and $(2n+2)$, where at least 80% of the oxygen is in the form of hydroxyl groups, and the remaining are in the form of ether groups, or a dimer, disaccharide or low molecular weight oligosaccharide of such a compound;
and
optionally water,
wherein the weight ratio of plasticizer to starch material is from 1:1 to 3:1."

Auxiliary request 17

"1. A gelatin-free film-forming composition, consisting essentially of:
a) starch material having a dextrose equivalent less than 1 and selected from the group consisting of waxy starch and modified starch, wherein said modified starch is selected from:
i) hydroxyethylated derivatives of dent corn starch having a degree of substitution from 0.015 to 0.30 ds and a molecular weight of from 100,000 to 2,000,000;

ii) hydroxyethylated corn starch having a degree of

substitution of 0.015 to 0.3 and a molecular weight of 200,000 to 2,000,000;

iii) hydroxypropyl derivatives of potato starch having a degree of substitution from 0.015 to 0.30 ds and a molecular weight of from 100,000 to 2,000,000; and

iv) hydroxypropylated high-amylose corn starch with a degree of substitution of 0.015 to 0.3 and a molecular weight of 200,000 to 2,000,000; and

b) a primary external plasticizer comprising at least one compound having the formula $C_nO_nH_x$, wherein n has a value between 3 and 6, and x has a value between 2n and (2n+2), or a dimer or oligomer of such a compound;

and

c) optionally water,

wherein the weight ratio of plasticizer to starch material is from 1:1 to 3:1."

Auxiliary request 22

"1. A gelatin-free film-forming composition, consisting essentially of:

a) starch material having a dextrose equivalent less than 1 and selected from the group consisting of waxy starch and modified starch, wherein said modified starch is selected from:

i) hydroxyethylated derivatives of dent corn starch having a degree of substitution from 0.015 to 0.30 ds and a molecular weight of from 100,000 to 2,000,000;

ii) hydroxyethylated corn starch having a degree of substitution of 0.015 to 0.3 and a molecular weight of 200,000 to 2,000,000;

iii) hydroxypropyl derivatives of potato starch having a degree of substitution from 0.015 to 0.30 ds and a molecular weight of from 100,000 to 2,000,000; and

iv) hydroxypropylated high-amylose corn starch with a degree of substitution of 0.015 to 0.3 and a molecular

weight of 200,000 to 2,000,000; and

b) a primary external plasticizer comprising at least one compound having the formula $C_nO_nH_x$, wherein n has a value between $2n$ and $(2n+2)$, where at least 80% of the oxygen is in the form of hydroxyl groups, and the remaining are in the form of ether groups, or a dimer, disaccharide or low molecular weight oligosaccharide of such a compound; and

c) optionally water,

wherein the weight ratio of plasticizer to starch material is from 1:1 to 3:1."

- VII. The reply to the statement of grounds of the appeal was received on 19 August 2013 in which the opponent requested the dismissal of the appeal.
- VIII. On 31 August 2015, the parties were summoned to oral proceedings to be held on 12 January 2016.
- IX. By letter of 7 December 2015, the appellant announced that he will not attend the oral proceedings.
- X. On 16 December 2015, a communication pursuant to Article 15(1) RPBA was sent by the Board. The communication contained a preliminary opinion of the Board about the requests on file on the issues of Article 123(2) EPC including the allowability of the disclaimers.
- XI. On 4 January 2016, the respondent announced that he will not attend the oral proceedings.
- XII. Oral proceedings were held on 12 January 2016.
- XIII. The appellant's arguments may be summarised as follows:

Admissibility of auxiliary requests 6 to 22

The claim sets of auxiliary requests 6 to 22 represented permutations of various amendments which were designed to address the three main issues raised in the decision of the opposition division, namely the undisclosed disclaimers, the disclosed disclaimers and the combinations of positively-recited features.

Main request

Allowability of the disclaimer - Article 123(2) EPC

These requests were based on two undisclosed disclaimers introduced to establish novelty of claim 1 over D7, a prior art document under Article 54(3) EPC. D7 contained a broad teaching that anticipated the subject matter of claim 1 without the disclaimers. Both disclaimers were necessary, the second disclaimer being drafted specifically in view of formulation 9 of D7. The disclaimers in claim 1 of these requests were allowable.

Claim 8 - Article 123(2) EPC

The reference to "0-50% synthetic polymer" was based explicitly on page 4, lines 10-11 of the description. Both terms "synthetic polymer" and "water soluble synthetic polymer" described the same polymer component. Claim 8 was allowable in view of Article 123(2) EPC.

Auxiliary requests 1 and 7

The claims of auxiliary request 1 differ from those of the main request in that some dependent claims have

been deleted. Claim 1 of auxiliary request 7 corresponded to claim 1 of auxiliary request 1 for which the plasticizer was additionally limited.

Auxiliary requests 2 to 5

Claim 8 - Article 123(2) EPC

No further arguments than the ones provided for claim 8 of the main request were provided for claim 8 of auxiliary requests 2 to 5.

Auxiliary requests 6, 12, 17 and 22 - Article 123(3) EPC

No arguments were provided by the appellant in view of Article 123(3) EPC.

Auxiliary requests 8-11, 13-16, 18-21

Claim 7 - Article 123(2) EPC

The reference to "0-50% water-soluble synthetic polymer" added to granted claim 8 was based on page 4, lines 3 to 5 and 9 to 11 of the description as filed. The requests 8-11, 13-16, 18-21 were allowable under Article 123(2) EPC.

XIV. The respondent's arguments may be summarised as follows:

Admissibility of auxiliary requests 6 to 22

Auxiliary requests 6 to 22 were not admissible in appeal because they could have been filed during first instance proceedings. The Board had to confine itself

to the judicial review of the request considered by the opposition division. No further arguments were provided concerning auxiliary requests 6 to 22.

Main request

Allowability of the disclaimer - Article 123(2) EPC

D7 did not anticipate the claimed subject matter and therefore could not form the basis of an undisclosed disclaimer. Also, the disclaimers of claim 1 removed more than was disclosed in D7. The disclaimers of these requests were therefore not allowable.

Claim 8 - Article 123(2) EPC

Claim 8 of the application as originally filed only stated that the composition may comprise "0-15% gum or a synthetic polymer. The passage on page 4 of the description only referred to the presence of 0-50% of synthetic polymers that were water soluble. There was therefore no basis for claim 8 of these requests which did not require the synthetic polymer to be water soluble. Claim 8 of the main request contained added subject matter contrary to Article 123(2) EPC.

Auxiliary requests 1 and 7

Only dependent claims were deleted in these requests. The deficiencies noted for claim 1 of the main request were therefore not overcome in these requests. Auxiliary requests 1 and 7 did not fulfil the requirements of Article 123(2) EPC.

Auxiliary requests 2 to 5

Claim 8 - Article 123(2) EPC

No further arguments were provided against claim 8 of those requests in view of Article 123(2) EPC.

- XV. The appellant requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution on the basis of the main request (claims as granted) or on the basis of one of auxiliary requests 1 to 22 filed with the statement of grounds of appeal.
- XVI. The respondent requested that the appeal be dismissed. If the board found that any of the appellant's requests met the requirements of Article 123 EPC, it was requested that the case be remitted to the department of first instance for examination of sufficiency and patentability. It was further requested not to admit auxiliary requests 6 to 22 into the proceedings.

Reasons for the Decision

1. As announced in advance, the duly summoned appellant and respondent did not attend the oral proceedings. In accordance with Article 15(3) RPBA, the board relied for its decision only on the parties' written submissions. The board was in a position to decide at the conclusion of the oral proceedings, since the case was ready for decision (Article 15(5) and (6) RPBA), and the voluntary absence of both parties was not a reason for delaying a decision (Article 15(3) RPBA).
2. During oral proceedings, the main request and the auxiliary requests 1 to 22 submitted by the appellant were treated in the order of their submission. The requests are however grouped according to the reasoning

followed hereunder for a better readability.

3. The admissibility of auxiliary requests 6 to 22 into the appeal proceedings was contested by the respondent on the grounds that these requests were first submitted with the statement of grounds of appeal while they could have been filed before the opposition division.
 - 3.1 In its contested decision, the opposition division concluded that the disclaimers present in claim 1 of the main request was not allowable (point 7.1.2.1) and that the combination of features pertaining to the molecular weight of the starch material and the definition of the plasticizer present in claim 1 of the main request was not allowable (point 7.1.1.4).
 - 3.2 Claim 1 of auxiliary requests 6-22 provided with the statement of grounds of appeal has been modified: Claim 1 of auxiliary request 6 was modified such that its subject matter is not defined by disclaimers but by the closed formulation "consisting essentially of". Claim 1 of auxiliary requests 7-12 and 18-22 was modified to limit the definition of the plasticizer. Claim 1 of auxiliary requests 13-17 was modified to limit the starch material of the composition such that the starch is defined by its type, its degree of substitution and its molecular weight. The modification performed in claim 1 of the auxiliary requests 6-22 therefore relate to the reasoning provided by the opposition division in its contested decision.
 - 3.3 Although the auxiliary requests 6 to 22 could have been filed by the appellant in the first instance, they can nevertheless be considered to represent an appropriate response to the reasons underlying the contested decision. Auxiliary requests 6 to 22 have been filed by

the appellant as a response to the reasoning provided by the opposition division in its contested decision and at the earliest possible date in appeal proceedings, namely with the statement of grounds of appeal. The Board sees no reason not to take into account auxiliary requests 6 to 22 in the appeal proceedings.

Main request

4. Claim 1 - Allowability of the disclaimer - Article 123(2) EPC

4.1 The subject matter of claim 1 of the main request corresponds to that of claim 1 as originally filed modified by the addition of positive features as well as by the introduction of two disclaimers. It is undisputed that these two disclaimers were not disclosed as such in the application as originally filed. It must be decided if these disclaimers fulfil the requirements for their allowability as set out in the decision of the Enlarged Board of Appeal G 1/03.

4.2 In its decision G 1/03 the Enlarged Board decided that a disclaimer that had not been disclosed in the originally filed application may be allowable in order to:

- (i) - restore novelty by delimiting a claim against state of the art under Article 54(3) and (4) EPC;
- (ii) - restore novelty by delimiting a claim against an accidental anticipation under Article 54(2) EPC; an anticipation is accidental if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention; and
- (iii) - disclaim subject-matter which, under Articles

52 to 57 EPC, is excluded from patentability for non-technical reasons.

Also, a disclaimer should not remove more than is necessary either to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons. A disclaimer which is or becomes relevant for the assessment of inventive step or sufficiency of disclosure adds subject-matter contrary to Article 123(2) EPC. Finally, a claim containing a disclaimer must meet the requirements of clarity and conciseness of Article 84 EPC.

- 4.3 It has been agreed by both parties that the second disclaimer introduced in claim 1, requiring that the claimed composition "is not a composition consisting of 20.0% wt. PURE-COTE®, 6.0% wt. kappa-carrageenan, 2.0% wt. xanthan gum, 20.0% wt. glycerin USP, 1.0% wt. sodium phosphate di basic, 0.20% wt. preservative and 50.8% wt. water USP." serves the purpose of excising, from the scope of claim 1, the formulation 9 disclosed in D7, which is potentially a document according to Article 54(3) EPC. It must therefore be ensured that that disclosure of D7 was indeed novelty destroying for the claimed subject matter.
- 4.4 Among the features characterising the subject matter of claim 1 of the main request, one finds the dextrose equivalent of the starch material, which must be less than 1; its original average molecular weight, which must be comprised between 100,000 and 2,000,000; its degree of substitution, which must be at least 0.015 and the weight ratio of plasticizer to starch material which must be from 1:1 to 3:1. It must thus be determined whether D7 discloses these features or not.

4.5 D7 discloses film forming compositions comprising modified starches and iota-carrageenan. More specifically, D7 discloses compositions suitable for forming a soft capsule, the composition comprising iota-carrageenan and at least one modified starch selected from the group consisting of hydroxypropylated tapioca starch, hydroxypropylated maize starch, acid thinned hydroxypropylated corn starch, potato starch, pregelatinized modified corn starches, and wherein said starch has a hydration temperature below about 90°C and wherein the weight ratio of modified starch to iota-carrageenan ranges from 1.5:1 to 4.0:1 (Claim 2). A somewhat more restrictive definition of the starch material is given in the description of D7 as it requires the starch material to display a hydration temperature below about 90°C (page 11, line 2). A general guidance on the choice of the starch material is disclosed on page 16 of D7, but it mainly concerns the selection of an appropriate starch in view of its functionality with the claimed iota-carrageenan plasticizer. D7 does however not disclose any of the dextrose equivalent of the starch material, its original average molecular weight and its degree of substitution, which are parameters that were used to characterize the starch material in claim 1 of the main request. Formulation 9 of D7 does not disclose these parameters either. The component that corresponds to the starch material in formulation 9 on page 34 is PURE-COTE®, which is not a single component but actually a whole class of commercially available starch materials as defined on page 5, lines 14 and 15 and in the first paragraph of page 26. The starch material of formulation 9 is therefore not sufficiently identified to conclude that its dextrose equivalent, average molecular weight and degree of substitution indeed fall under the claimed subject matter. On the basis of the

disclosure found in D7, it cannot be concluded that the subject matter of claim 1 was anticipated by D7.

4.6 Also, the amount of starch relative to the amount of plasticiser in claim 1 of the main request is defined as the weight ratio of plasticizer to starch material. In D7 however the relative amounts of these components are defined as the weight ratio of starch to iota-carrageenan (the plasticiser used in D7). In order to compare the numerical range associated to that ratio disclosed in D7 to that of claim 1, it is thus necessary to invert the ratio of D7 to arrive at a range directly comparable to the range disclosed in claim 1. In D7, the ratio of starch to iota-carrageenan is disclosed to be of at least 1.5 (page 12, line 7) or also between 1.5 and 4.0 (claim 2); this corresponds to a range of iota-carrageenan to starch of less than 0.67 (or between 0.25 and 0.67). The range of plasticizer to starch derived from D7 does therefore not overlap with the numerical range of from 1 to 3 (1:1 to 3:1) claimed in the patent in suit. That is also true in the specific case of formulation 9 of D7. It can be derived from the table on page 34 that formulation 9 contained 6.0 percent by weight of Kappa-carrageenan (a plasticizer) and 20.0 percent by weight of PURE-COTE®, an unidentified starch material. The ratio of plasticizer to starch that can be derived from these amounts is 0.3, below the lower limit of the claimed range of 1 to 3. For this reason as well it cannot be concluded that D7 anticipated the subject matter defined by the positive features of claim 1 of the main request.

4.7 It is concluded that there was no necessity to disclaim formulation 9 of D7 from the scope of claim 1 in order to establish novelty. Therefore, the second disclaimer

of claim 1 of the main request does not fulfil the first condition set out in the decision of the Enlarged Board of Appeal G 1/03. As there was evidently no basis for the second disclaimer in the description as originally filed, its introduction in claim 1 infringes Article 123(2) EPC.

5. Claim 8 - Article 123(2) EPC

5.1 By way of the dependency of claim 8 of the application as originally filed, the subject matter of claim 8 is defined by a combination of the features claims 6, 5 and 1 and the feature that "the dry solids in the composition comprise 25-75% starch material, 25-75% plasticizer, and 0-15% gum or synthetic polymer."

5.2 Compared to claim 8 as originally filed, claim 8 of the main request defines the amount in synthetic polymer to be 0-50% of the total solids. The passage cited as a basis for that amendment on page 4, lines 9 to 11 discloses an embodiment in which water soluble polymers may be added to the starch and plasticizer mixture. It is further added that the synthetic polymer is preferably 0-50% of the total solids in the mixture. It is clear from that passage that the amount mentioned refers to the water soluble polymer that may be added to the composition. The Board concludes that the amount of 0-50% of the total solids disclosed on page 4 of the application as originally filed only applies to those synthetic polymers that are water soluble. The synthetic polymer defined in claim 8 of the main request is however not necessarily water soluble as that requirement is not mentioned in claim 8 and is also not part of the claims 6, 5 and 1 which define the subject matter of claim 8. Several passages of the application mention the presence of a synthetic polymer

in the composition (page 3, line 14; page 5, line 26 and page 8, line 20) but none of these instances discloses its amount in the dry solids. There is therefore no basis in the application as filed for a composition comprising 0-50% of synthetic polymer of the total solids in the mixture when that polymer is not water soluble. As a result, the subject matter of claim 8 of the main request contravenes Article 123(2) EPC.

6. The main request is therefore not allowable under Article 123(2) EPC.

Auxiliary requests 1 and 7

7. Claim 1 - Article 123(2) EPC

- 7.1 Claim 1 of auxiliary request 1 corresponds to claim 1 of the main request. Therefore, that claim falls for the same reasons as discussed above in point 4 for the main request. Compared to claim 1 of the main request, claim 1 of auxiliary request 7 further limits the primary external plasticizer but retains the second disclaimer contained in the main request. D7, which does not anticipate claim 1 of the main request, does therefore not anticipate claim 1 of auxiliary request 7. The conclusion reached for the main request thus also applies to both auxiliary requests 1 and 7 which therefore are not allowable under Article 123(2) EPC.

Auxiliary requests 2 to 5

8. Claim 8 - Article 123(2) EPC

- 8.1 The wording of claim 8 of auxiliary requests 2 and 3 is identical to that of claim 8 of the main request. The

subject matter of claim 8 of auxiliary requests 2 and 3 is defined by that of claims 6, 5 and 1 from which it is dependent. It is nowhere mentioned in claims 6, 5 and 1 of these two requests that the synthetic polymer should be water soluble. Therefore, claim 8 of these requests fall for the same reasons as discussed above in point 5 for the main request. The subject matter of claim 8 of auxiliary requests 2 and 3 does not satisfy the requirements of Article 123(2) EPC.

8.2 Claim 8 of auxiliary requests 4 and 5 defines the gelatin-free film-forming composition in that "the dry solids in the composition comprise 25-75% starch material, 25-75% plasticizer, and 0-50% synthetic polymer." The subject matter of claim 8 of auxiliary requests 4 and 5 differs from that of claim 8 of the main request only in that it does not disclose the alternative presence of gum in an amount of 0-15% in the composition. Claim 8 of auxiliary requests 4 and 5 therefore pertains to a gelatin-free film-forming composition that may comprise 0-50% of synthetic polymer in the total solids. The subject matter of claim 8 of auxiliary requests 4 and 5 as defined by claims 8, 6, 5 and 1, does not require the synthetic polymer to be water soluble. The reasoning and the conclusion given against claim 8 of the main request in point 5 above therefore applies against claim 8 of auxiliary requests 4 and 5.

8.3 The Board concludes from points 8.1 and 8.2 that claim 8 of auxiliary requests 2 to 5 does not fulfil the requirements of Article 123(2) EPC.

Auxiliary requests 6, 12, 17 and 22

9. Article 123(3) EPC

9.1 Amendments of the claims filed in the course of appeal proceedings are to be fully examined as to their compatibility with the requirements of the EPC, e.g. with regard to the provisions of Article 123(2) and (3) EPC (see G 10/91, OJ EPO 1993, 420, point 19 of the reasons). Hence the appellant could reasonably have expected the board to consider these issues in respect of the claims of the auxiliary requests submitted with the statement of grounds of appeal. Specifically, the appellant had to expect that the Board would at least consider the question of whether the new auxiliary requests 6, 12, 17 and 22 could be admitted into the proceedings and, if so, whether the amendments satisfy the requirements of Article 123(3) EPC. In deciding not to attend the oral proceedings the appellant chose not to make use of the opportunity to comment at the oral proceedings on the issues of Article 123(3) EPC.

9.2 According to established jurisprudence, the expression "consisting essentially of" has a particular meaning, as explained in the Decision T 0472/88, No. 3 of the reasons: "In the Board's view the term 'consisting essentially of' means that in addition to those components which are mandatory ... other components may also be present in the composition, provided that the essential characteristics of the composition are not materially affected by their presence." In the present case, it means that besides the starch material and the plasticizer, the claimed compositions may include additives like gums, hydrocolloids, synthetic polymers, and/or other additives as contemplated on page 3, lines 13 to 15 and page 8, lines 18 to 27 since these

additives have no adverse effect upon the properties exhibited by the claimed starch-based compositions (page 8, lines 21-23). Carrageenan is among the hydrocolloid gums that may be used as additive in the composition (page 8, line 24). Claim 1 of auxiliary request 6 thus encompasses gelatin-free, film-forming compositions consisting essentially of starch material and plasticizer and containing a carrageenan as long as the composition is not affected by its presence. The formulation of amended claim 1 of auxiliary request 6 encompasses therefore compositions containing iota-carrageenan, which is known to be a carrageenan.

- 9.3 Claim 1 of the patent as granted concerned a gelatin-free, film-forming composition comprising starch material and a primary external plasticizer provided "said composition is iota-carrageenan free". Claim 1 of the patent as granted therefore excluded compositions containing iota-carrageenan, contrary to claim 1 of auxiliary request 6 which allows its presence. As a result of the replacement of "comprising" by "consisting essentially of" in claim 1 of auxiliary request 6, the protection conferred by the European patent was extended, contrary to the requirements of Article 123(3) EPC. Auxiliary request 6 is therefore not allowable as it contravenes the requirements of Article 123(3) EPC. The same conclusion applies to auxiliary request 12, 17 and 22 as claim 1 of these requests contains the same feature.

Auxiliary requests 8-11, 13-16 and 18-21

10. Article 123(2) EPC

- 10.1 Claim 7 of auxiliary request 8 is dependent on claim 1 and further defines the gelatin-free film-forming

composition in that it comprises "25-50% starch material, 50-75% plasticizer, and 0-15% water-soluble gum or 0-50% water-soluble synthetic polymer." The subject matter of claim 7 of auxiliary request 8 is based on claim 8 of the application as filed with the additional feature that the amounts in starch material, plasticizer and the definition of the synthetic polymer have been further limited according to page 3, lines 23 and 24 and page 4, line 9 of the description as originally filed.

- 10.2 The amendment in claim 7 of auxiliary request 8 has been indicated by the appellant to result from the combination of two passages disclosed in the application as originally filed, the first passage relating to the preferred amounts of 25-50% starch material and 50-75% of plasticizer on page 3 and the second passage relating to the preferred amount in synthetic polymer of 0-50% on page 4. Reading these two passages as relating to the same embodiment would mean that the combined minimum amounts of starch material and plasticizer would sum up to 75% by weight, leaving a maximum possible amount of 25% by weight of water-soluble synthetic polymer, half of the range now defined for that component in claim 7 (0-50% by weight). Thus, the passages of the application as filed indicated by the appellant cannot provide a basis for the subject-matter of amended claim 7. Claim 7 of auxiliary request 8 contravenes the requirements of Article 123(2) EPC. The same conclusion also applies to auxiliary requests 9, 13, 14, 18 and 19 in which the subject-matter of claim 7 has also been extended beyond the content of the application as filed for the same reasons provided for auxiliary request 8.

10.3 Claim 7 of auxiliary requests 10, 11, 15, 16, 20 and 21 is dependent on claim 1 and further defines that the composition comprises "25-50% starch material, 50-75% plasticizer, and 0-50% water-soluble synthetic polymer." The definition of those amounts has been also argued to be based on page 3, lines 23 and 24 and page 4, lines 3-5 and 9-11 of the description as originally filed, which as shown with respect to auxiliary request 8 in above point 10.2 fails to convince. Hence, for the same reasons as provided in above point 10.2, claim 7 of auxiliary request 10 contravenes the requirements of Article 123(2) EPC. The same conclusion also applies to auxiliary requests 11, 15, 16, 20 and 21 which define the same amounts of starch material, plasticizer and water-soluble synthetic polymer.

11. The main request and auxiliary requests 1-5, 7-11, 13-16, 18-21 do not satisfy the requirements of Article 123(2) EPC. Auxiliary requests 6, 12, 17 and 22 do not satisfy the requirements of Article 123(3) EPC.

Order

For these reasons it is decided that:

1. The appeal is dismissed.

The Registrar:

The Chairman:



B. ter Heijden

F. Rousseau

Decision electronically authenticated