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**Datasheet for the decision
of 16 July 2015**

Case Number: T 0919/13 - 3.3.09

Application Number: 03711759.5

Publication Number: 1492417

IPC: A23L1/00, A23P1/04

Language of the proceedings: EN

Title of invention:

ENCAPSULATED AGGLOMERATION OF MICROCAPSULES AND METHOD FOR THE
PREPARATION THEREOF

Patent Proprietor:

DSM Nutritional Products AG

Opponent:

Friesland Brands B.V.

Former Opponent:

GAT Microencapsulation AG

Headword:

Relevant legal provisions:

EPC Art. 100(c), 123(2), 123(3), 84, 111(1)

Keyword:

Amendments - allowable (yes)

Claims - clarity (yes)

Remittal - (yes)

Decisions cited:

Catchword:



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Chambres de recours**

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Case Number: T 0919/13 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 16 July 2015

Appellant:
(Patent Proprietor)

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Respondent:
(Opponent)

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Representative:

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 1 February 2013
revoking European patent No. 1492417 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman

W. Sieber

Members:

J. Jardón Álvarez

D. Prietzel-Funk

Summary of Facts and Submissions

- I. This decision concerns the appeal filed by the proprietor, DSM Nutritional Products AG (former Ocean Nutrition Canada Ltd.), against the decision of the opposition division to revoke European patent No. 1 492 417.
- II. The opponent, Friesland Brands B.V., had requested revocation of the patent in its entirety on the grounds that the claimed subject-matter was neither novel nor inventive (Article 100(a) EPC), that the patent did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC), and that the patent contained subject-matter which extended beyond the content of the application as originally filed (Article 100(c) EPC).

The documents cited during the opposition proceedings included:

D2: US 6 325 951 B1; and

D13: US 4 222 891 A.

- III. The opposition division's decision was based on a main request and six auxiliary requests. Claim 1 of the main request and of auxiliary requests 1 to 5 was directed to microcapsules and claim 1 of auxiliary request 6 to a process for preparing microcapsules.

Claim 1 of the main request, the only request relevant for the present decision, reads as follows:

"1. A microcapsule comprising an agglomeration of primary microcapsules, each individual primary microcapsule having a primary shell *around a loading substance which is a hydrophobic liquid*, and the agglomeration being encapsulated by an outer shell, *wherein the primary shell and the outer shell are each formed from a complex coacervate between two polymer components wherein one polymer component is gelatine type A and the other is selected from the group consisting of gelatine type B, polyphosphate, gum arabic, alginate, chitosan, carrageenan, pectin, and carboxymethylcellulose.*"

(amendments over claim 1 as granted in italics)

IV. The opposition division's position can be summarised as follows:

- The amendments made to claim 1 of the main request fulfilled the requirements of Articles 123(2) and 84 EPC. However, the deletion of granted claim 2 was contrary to Article 123(3) EPC;
- the same objection under Article 123(3) EPC applied to auxiliary requests 1 to 5;
- the subject-matter of the claims of auxiliary request 6 was novel over the cited prior art. However, at least the subject-matter of claim 1 did not involve an inventive step in view of the closest prior-art document, D13, when combined with the disclosure of D2.

The opposition division did not take any decision with respect to the ground for opposition under Article 100(b) EPC.

- V. On 26 March 2013, the patent proprietor (in the following: the appellant) lodged an appeal against this decision. The statement setting out the grounds of appeal was filed on 10 June 2013 including a main request and ten auxiliary requests. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of claims 1 to 25 of the main request. In the same letter the appellant also requested that the case be remitted to the opposition division for further prosecution.
- VI. In its reply dated 25 October 2013, the opponent (in the following: the respondent) requested that the appeal be dismissed.
- VII. On 23 January 2015, the board issued a summons to oral proceedings and indicated in the attached communication the points to be discussed during the oral proceedings. The board *inter alia* expressed its preliminary view that claim 1 of the main request fulfilled the requirements of Articles 123(2), 123(3) and 84 EPC and that it would be decided during the oral proceedings whether the case would be remitted to the opposition division for further prosecution.
- VIII. On 16 July 2015, oral proceedings were held in the absence of the respondent, which had informed the board by letter dated 2 July 2015 that it would not be attending the oral proceedings and that it would rely on its written submissions.

During the oral proceedings the appellant clarified its requests from the letter setting out the grounds of appeal to the effect that the decision under appeal be set aside and the case be remitted to the opposition division for further prosecution on the basis of

claims 1 to 25 according to the main request submitted with the letter setting out the grounds of appeal or, alternatively, on the basis of the claims according to one of auxiliary requests 1 to 10 filed with the letter setting out the grounds of appeal. In the course of the oral proceedings the appellant withdrew its main and first auxiliary requests and filed a new main request, which consisted of claims 1 to 16 of its previous main request. Claim 1 of this request is identical to claim 1 before the opposition division (see point III above). Claims 2 to 16 are dependent claims.

The final request of the appellant was that the decision under appeal be set aside and the case be remitted to the opposition division for further prosecution on the basis of claims 1 to 16 filed as the main request during the oral proceedings of 16 July 2015 or, alternatively, on the basis of one of auxiliary requests 2 to 10 filed with the letter setting out the grounds of appeal.

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

- In the main request, granted claim 2 was reinstated so that the reason for rejecting the then main request had been overcome.
- As the opposition division had not decided on the novelty of the microcapsules of claim 1 of the main request, the case should be remitted for further prosecution.

X. The written arguments of the respondent, insofar as they are relevant for the present decision, may be summarised as follows:

- The wording "the primary shell and the outer shell are each formed from (...)" in claim 1 introduced a lack of clarity, and therefore contravened Article 84 EPC.

Reasons for the Decision

1. Amendments (Article 123(2) EPC)

1.1 Claim 1 of the main request is identical to claim 1 of the then main request before the opposition division (see point III above), which had decided that the claim met the requirements of Article 123(2) EPC. The board agrees with this finding.

1.2 Claim 1 differs from claim 1 as granted (identical to claim 1 as filed) in that it has been further specified that:

- The primary shell of each individual primary microcapsule is around a loading substance which is a hydrophobic liquid (support page 4, lines 17/18 and page 5, lines 14/15 of the application as filed); and
- The primary shell and the outer shell are each formed from a complex coacervate between two polymer components as defined in the last paragraph of page 5 of the application as filed.

Although the wording "wherein the primary shell and the outer shell are each formed" is not explicitly disclosed in the paragraph on page 5, there is no doubt that this feature is implicitly disclosed in said paragraph (e.g. "The shell material is preferably a two-component system"; no distinction made between the material for the primary and outer shell).

- 1.3 Dependent claims 2 to 16 correspond to granted claims 2, 7 to 10, 13 to 18 and 21 to 24 which are identical to the respective claims as filed.
- 1.4 The board is therefore satisfied that the claims of the main request fulfill the requirements of Article 123(2) EPC, a point which was also not contested by the respondent in its submissions.
2. *Amendments (Article 123(3) EPC)*
 - 2.1 The amendments limit the scope of granted claim 1 by stating that the material to be encapsulated is a hydrophobic liquid and the nature of the shell material is a complex coacervate between two polymers.
 - 2.2 The opposition division rejected the then pending main request of the appellant, with the same claim 1 as present claim 1, apparently because the deletion of granted claim 2 infringed Article 123(3) EPC.
 - 2.3 Apart from the fact that granted claim 2 has been re-introduced into the main request so that the opposition division's objection under Article 123(3) EPC has been overcome, the board is at a loss with this argument, which is made even worse by the fact the reasoning on

that point is rather confusing, not to say incomprehensible.

2.4 Claim 2 as granted was dependent on claim 1 and read:

"2. The microcapsule according to claim 1, wherein the outer shell is a matrix of shell material that surrounds the agglomeration to form a foam-like structure."

Regardless of whether the subject-matter of dependent claim 2 is not a "real" technical feature but merely an explanation of the structures involved (as argued by the appellant before the opposition division) or indeed a preferred embodiment of the microcapsules of claim 1 (i.e. a further limitation of claim 1), the board cannot see how the deletion of dependent claim 2 could extend the protection conferred by the patent. The microcapsules of granted claim 2 were already protected by the scope of granted claim 1 not including the explanation/limitation of claim 2.

2.5 The board is satisfied that the claims of the main request also fulfil the requirements of Article 123(3) EPC. This was not contested by the respondent during the appeal proceedings.

3. *Amendments (Article 84 EPC)*

3.1 The board agrees with the finding in the appealed decision that the amended claims fulfil the requirements of Article 84 EPC.

3.2 The respondent argued that the expression "are each formed" in amended claim 1 was intended to make it clear that the material for both the "primary shell"

and "the outer shell" were identical. However, the inevitable lack of distinction between identical primary and outer shells would seem to render it impossible to assess whether or not a primary shell was actually present.

3.3 The board disagrees. The wording objected to merely defines the shell material(s) of the microcapsule. Insofar as the respondent interprets the above expression to mean that the material of both shells can be identical, the board agrees that this is an embodiment embraced by the claims and exemplified in the patent (see example 1, for instance). However, this possibility neither makes the claim unclear, nor does it make impossible to assess whether or not a primary shell is present. The structure of the claimed microcapsules can be seen in Figures 1 and 2 of the patent, where smaller (primary) microcapsules are agglomerated and the agglomeration is surrounded by an outer shell material to form a large microcapsule.

3.4 For these reasons the amendments made to the claims also fulfil the requirements of Article 84 EPC.

4. *Remittal*

4.1 The board has decided that the subject-matter of the claims of the main request fulfils the requirements of Articles 123 and 84 EPC.

4.2 The opposition division has not yet taken a decision concerning the present claims on the other patentability issues raised by the respondent, namely sufficiency of disclosure, and novelty and inventive step of the claimed microcapsules.

- 4.3 The appellant requested remittal of the case to the opposition division for further consideration of these issues and the respondent did not object to such a remittal.
- 4.4 In these circumstances, the board considers it appropriate to exercise its discretion under Article 111(1) EPC to refer the case back to the opposition division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution on the basis of the set of claims 1 to 16 filed as the main request during the oral proceedings of 16 July 2015.

The Registrar:

The Chairman:



M. Cañueto Carbajo

W. Sieber

Decision electronically authenticated