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**Datasheet for the decision  
of 18 October 2019**

**Case Number:** T 0432/15 - 3.3.08

**Application Number:** 06014353.4

**Publication Number:** 1762622

**IPC:** C12N15/54, C12N15/55, C12N9/10,  
C12N9/18, A23L1/03, A23L1/035,  
A21D8/04

**Language of the proceedings:** EN

**Title of invention:**  
Method for the in situ production of an emulsifier in a  
foodstuff

**Patent Proprietor:**  
DuPont Nutrition Biosciences ApS

**Opponent:**  
Novozymes A/S

**Headword:**  
Lipid acyltransferase dough baked product/DUPONT NUTRITION  
BIOSCIENCES

**Relevant legal provisions:**  
EPC Art. 100(c), 113(1), 114(2), 123(2)  
RPBA Art. 12(4), 13(1), 15(1)

**Keyword:**

Main request, auxiliary requests 2 to 5 - admission (no);  
Auxiliary request 1 - added subject-matter (yes);

**Decisions cited:**

G 0002/10, T 2168/11, T 0105/14, T 0217/15

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 0432/15 - 3.3.08

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.08**  
**of 18 October 2019**

**Appellant I:** DuPont Nutrition Biosciences ApS  
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**Appellant II:** Novozymes A/S  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
23 December 2014 concerning maintenance of the  
European Patent No. 1762622 in amended form.**

**Composition of the Board:**

**Chairman** B. Stolz  
**Members:** P. Julià  
R. Winkelhofer

## **Summary of Facts and Submissions**

- I. European patent no. 1 762 622 is based on European patent application no. 06 014 353.4 (hereinafter "the patent application"), a divisional application of the earlier European patent application no. 04 702 393.2, published under the PCT as International patent application WO 2004/064537. The patent was granted with 44 claims.
- II. An opposition was filed on the grounds as set forth in Articles 100(a), (b) and (c) EPC. The opposition division considered that the main request (claims as granted) extended beyond the content of the application as filed (Article 100(c) EPC), auxiliary request 1 lacked novelty (Article 54 EPC), and auxiliary request 2 fulfilled the requirements of the EPC. Accordingly, the patent was maintained on the basis of auxiliary request 2.
- III. Appeals were lodged by the patent proprietor and the opponent (appellants I and II, respectively). With the statement setting out the grounds of appeal, appellant I filed a main request and auxiliary requests 1 to 5. As an auxiliary measure, oral proceedings were requested by both appellants.
- IV. The parties replied to the respective statements of grounds of appeal. Appellant I filed additional experimental evidence (document (20)) and a new auxiliary request 4 to replace its former auxiliary request 4. Appellant II requested the board not to admit auxiliary requests 2 and 4 into the appeal proceedings.

- V. The board summoned the parties to oral proceedings. In a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA), they were informed of the board's provisional opinion on some of the issues of the case. The board stated *inter alia* that: i) the main request, auxiliary request 2 and the replacement auxiliary request 4 were likely not to be admitted into the proceedings (Articles 12(4) and 13(1) RPBA); auxiliary request 1 already formed part of these proceedings; and, if needed, the admission of auxiliary requests 3 and 5 would have to be discussed at the oral proceedings; ii) the auxiliary request 1 contravened Articles 123(2) and (3) EPC, and iii) all other auxiliary requests contravened Article 123(2) EPC.
- VI. In reply thereto and without making any substantive submissions, both appellants withdrew their requests for oral proceedings.
- VII. The oral proceedings were cancelled.
- VIII. Claims 1 and 23 of the main request read as follows:
- "1. Use of a lipid acyltransferase to prepare from a water containing food material comprising 10-98% water a dough product or a baked product comprising an emulsifier, wherein the emulsifier is generated from constituents of the food material by the lipid acyltransferase, wherein the lipid acyltransferase is one which when tested using the Transferase Assay in Buffered Substrate has at least 10% acyltransferase activity; said transferase assay comprising the steps of:

i) dissolving 450mg phosphatidylcholine and 50mg cholesterol in chloroform, evaporating to dryness under vacuum;

ii) transferring 300mg cholesterol/phosphatidylcholine mixture to a Wheaton glass, adding 15ml 50mM HEPES buffer pH 7 and dispersing the lipid in the buffer during agitation;

iii) heating the substrate to 35°C during mixing with a magnetic stirrer and adding 0.25ml enzyme solution;

iv) taking samples of 2 ml at 0, 5, 10, 15, 25, 40 and 60 minutes reaction time and immediately stopping the enzyme reaction by the addition of 25µl 4M HCl to acidify the free fatty acid;

v) adding 3ml chloroform and shaking vigorously for 30 seconds, centrifuging and isolating 2ml of the chloroform phase, filtering through a 0.45µm filter into a 10ml tared Dram glass;

vii) evaporating the chloroform under a stream of nitrogen at 60°C, and scaling the samples;

viii) analysing the extracted lipid by GLC.

23. A method of production of a dough product or a baked product comprising an emulsifier, wherein the method comprises the step of adding a lipid acyltransferase to a dough product containing 10-98% water, wherein the lipid acyltransferase is one which when tested using the Transferase Assay in Buffered Substrate has at least 10% acyltransferase activity; said transferase assay comprising the steps of:

[i) to viii) as in claim 1]."

- IX. Claims 1 and 23 of auxiliary request 1 are identical to claims 1 and 23 of the main request, except for steps i) and v) which read as follows:

"... i) dissolving 450mg L-alpha-phosphatidylcholine 95% (Plant)Avanti no. 441601 and 50mg cholesterol in chloroform, evaporating to dryness under vacuum;

... v) adding 3ml chloroform and shaking vigorously on a Whirley for 30 seconds, centrifuging and isolating 2ml of the chloroform phase, filtering through a 0.45µm filter into a 10ml tared Dram glass; ..."

- X. The following document is cited in this decision:

(20): Technical Note; "Test of lipid acyl transferase variants according to EP 1 762 622".

- XI. Appellant I's (patent proprietor's) submissions, insofar as relevant to this decision, may be summarised as follows:

*Admission of the main request*

No submissions were made in this respect.

*Auxiliary request 1 - Article 123(2) EPC*

The three features referred to in the preamble of claims 1 and 23, namely i) the class of lipid acyltransferases, ii) a food material comprising 10-98% water, and iii) a foodstuff selected from a dough product or a baked product, simply defined more preferred aspects of the same embodiment. A skilled

person would have seriously contemplated that the patent application was directed to such subject-matter which was directly and unambiguously derivable from its content.

*Admission of auxiliary requests 2 to 5*

No submissions were made in this respect.

XII. Appellant II's (opponent's) submissions, insofar as relevant to this decision, may be summarised as follows:

*Admission of the main request*

No submissions were made in this respect.

*Auxiliary request 1 - Article 123(2) EPC*

The subject-matter of claims 1 and 23 was characterized by three specific features selected from three different lists, namely i) a selection of lipid acyltransferases having at least 10% acyltransferase activity when tested using the Transferase Assay in Buffered Substrate (TABS), ii) a selection of food material comprising 10-98% water, and iii) a selection of that food material being one which may be prepared into a dough product or a baked product. The combination of these three features was not directly and unambiguously derivable from the patent application.

*Admission of auxiliary requests 2 to 5*

Auxiliary requests 2 and 4 should not be admitted into the appeal proceedings because they were new requests.



No submissions were made on the admission of auxiliary requests 3 and 5 into the appeal proceedings.

XIII. Appellant I (patent proprietor) requests that the decision under appeal be set aside and that the patent be maintained on the basis of its main request or, in the alternative, on the basis of any of auxiliary requests 1 to 5.

XIV. Appellant II (opponent) requests that the decision under appeal be set aside and that the patent be revoked.

## **Reasons for the Decision**

### Article 113(1) EPC

1. By their decision to withdraw their requests for oral proceedings and not to file substantive arguments in reply to the issues raised in the board's communication pursuant to Article 15(1) RPBA, all parties have chosen not to make use of the opportunity to comment on the board's provisional, non-binding opinion, either in writing or at the oral proceedings, in particular not appellant I to whom this opinion was unfavourable.
2. In the light thereof, the present decision is based on the same grounds, arguments and evidence on which the provisional, non-binding opinion of the board was based.

### Admission of the main request

3. According to the established case law, the function of an appeal is to give a judicial decision upon the

correctness of a separate earlier decision taken by an examining or opposition division. Appeal proceedings are not an opportunity to re-run or re-open proceedings before any of these divisions. The purpose of appeal proceedings is not to give the patent proprietor the opportunity to improve the drafting of the claims or to recast them as it sees fit and to have all its requests admitted into the proceedings (cf. T 2168/11 of 24 June 2015, point 15.5 of the Reasons with further references). The admission of new claim requests into the appeal proceedings is at the board's discretion (Article 114(2) EPC and Articles 12(4) and 13(1) RPBA; see "Case Law of the Boards of Appeal of the EPO", 9th edition 2019, V.A.1, 1133 and V.A.4, 1206).

4. The main request filed in appeal proceedings is identical to the auxiliary request 4 originally filed at first instance on 23 July 2014. Although the main request is identical to an auxiliary request that was already filed at first instance, this auxiliary request had a lower ranking (auxiliary request 4) than the auxiliary request upheld by the opposition division (auxiliary request 2). Thus, there was no need for the opposition division to take any decision on this auxiliary request 4 and, accordingly, there is no reference thereto in the reasons for the decision under appeal. As a consequence of the change of order of these auxiliary requests in appeal proceedings, the board is, in essence, asked to consider a claim request not examined by the opposition division which moreover defines its subject matter in broader terms than auxiliary request 2 underlying the decision under appeal, before reviewing the decision of the opposition division on another claim request.

5. In the communication pursuant to Article 15(1) RPBA, the board drew appellant I's attention to the fact that no reasons had been provided to explain why the order of the claim requests has been changed in appeal proceedings and why this change could not have been made at first instance proceedings. The board further stated that, in the absence of convincing reasons, the admission of the main request would go against the criteria developed in the case law referred to above. Thus, the main request was likely not to be admitted into the appeal proceedings.
  
6. Since no reply in substance to the board's communication has been provided and thus, no reasons given to explain the change of order at the stage of the appeal proceedings, the board sees no reason to change its provisional opinion. Therefore, the board, in the exercise of its discretion, does not admit the main request into the appeal proceedings.

Auxiliary request 1

7. Auxiliary request 1 is identical to the auxiliary request 2 upheld by the opposition division and underlying the decision under appeal; therefore, it already forms part of the present appeal proceedings.

*Article 123(2) EPC*

8. In the decision under appeal, the opposition division considered the subject-matter of this request to fulfil the requirements of Article 123(2) EPC.
  
9. In appeal proceedings, the parties' arguments under Article 123(2) EPC on claims 1 and 23 of auxiliary request 1 relate to the combination of three specific

features or selections, namely i) a class of lipid acyltransferases having at least 10% acyltransferase activity "when tested using the TABS", ii) a food material comprising 10-98% water, and iii) a foodstuff selected from a dough product or a baked product.

10. It is common ground between the parties that there is a basis in the patent application for each of the three specific features or selections in isolation. Example 12 and the general disclosure on page 18, paragraphs [0222] and [0223] of the published patent application provide a basis for the subject-matter of the first selection; page 17, paragraph [0204] for the second selection; and pages 16 and 23, paragraphs [0193] and [0276], respectively, for the third selection. It is however disputed whether or not there is a basis in the patent application for the specific combination of these three features.
11. In the communication pursuant to Article 15(1) RPBA, the board considered the case law cited by the parties in support of their arguments relevant, in particular the case law precluding the use of the patent application as a "reservoir" (cf. "Case Law", *supra*, II.E.1.6.1, 459), defining the criteria for allowing selections from several lists (cf. "Case Law", *supra*, II.E.1.6.2, 460) and, more particularly, the definition of the gold standard for assessing compliance with Article 123(2) EPC (cf. "Case Law", *supra*, II.E.1.3.1, 436; G 2/10, OJ EPO 2012, 376).
12. In the board's view, it is directly and unambiguously derivable from the patent application that lipase acyltransferases identified by the (TABS) method as described in Example 12 may be used to prepare - from a food material - a foodstuff comprising an emulsifier;

this being one of the broadest disclosures of the patent application. Preferred acyltransferases identified by the (TABS) method of Example 12 for use in the compositions and methods disclosed are defined on page 18, paragraph [0223] of the published patent application. Described are, *inter alia*, acyltransferases having at least 10% relative acyltransferase activity. This specific value is disclosed within a long group/list of (from 2% to 75%) possible values of relative acyltransferase activities.

13. There is however no indication in the patent application that a lipid acyltransferase having a specific lipid acyltransferase activity of (as little as) at least 10% (identified by the TABS method of Example 12) may be suitable/appropriate to prepare a dough product or a baked product, let alone that any of the two can be prepared - using a lipid acyltransferase having at least 10% acyltransferase activity - from a water containing food material comprising (as little as) 10% to (as much as) 98% water (as known from the art, dough may usually contain 60 - 70% water).
  
14. In this context, it is worth noting that paragraph [0223] of the published patent application describes the "Transferase Assay in Buffered Substrate" as an assay "in which there is a very high water content - approximately 95%" (underlined by the board). The use of a lipid acyltransferase identified by an (TABS) assay with a very high water content (approximately 95%) in a food material with a low content of water (as little as 10%) is not directly and unambiguously derivable from the patent application, let alone when such a food material is the basis for preparing a dough product or a baked product.

15. Therefore, in the absence of a clear hint or indication to the skilled person, the combination of the specific acyltransferase activity of at least 10%, selected from a list of thirteen values, with a particular range of water content, selected from a list of eight ranges (cf. page 17, paragraph [0204] of the published patent application), and two specific products (a dough product or a baked product) selected from a long list of products (cf. page 16, paragraph [0193] *et seq.*) cannot be directly and unambiguously derived from the patent application. The specific combination of the selected parameters is thus not in line with the criteria developed in the case law referred to in point 11 above for allowing selections from several lists.
  
16. It follows from all these considerations, that the subject-matter of auxiliary request 1 extends beyond the content of the patent application and thus contravenes Article 123(2) EPC.

Admission of auxiliary requests 2 to 5

17. Auxiliary requests 2 and 4 are new requests in these proceedings resulting from combinations of auxiliary requests 2 and 4 and auxiliary requests 4 and 6, respectively, originally filed at first instance on 23 July 2014. Auxiliary requests 3 and 5 are identical to auxiliary requests 8 and 9 originally filed on the same day. There is no reference to any of these auxiliary requests in the reasons for the decision under appeal because either they are new in the proceedings (auxiliary requests 2 and 4) or they are of lower ranking than the auxiliary request upheld by the opposition division (auxiliary requests 3 and 5).

18. As regards new auxiliary requests 2 and 4, the board noted in its communication pursuant to Article 15(1) RPBA that no explanation had been provided by appellant I why these new requests had been filed at such a late stage of the proceedings and why they could not have been filed at first instance. This is particularly relevant for new auxiliary request 4, since this request was filed after the time limit for filing of the statement of grounds of appeal and of the replies thereto, in order to replace a former auxiliary request 4 (cf. point IV *supra*). This represents an amendment of appellant I's case in the sense of Article 13(1) RPBA. It is worth noting that appellant II has requested the board to exercise its discretion not to admit these auxiliary requests into the proceedings (cf. point IV *supra*).
19. As regards auxiliary requests 3 and 5, the board - in its communication pursuant to Article 15(1) RPBA - informed the parties that the mere fact of filing auxiliary requests at first instance cannot serve as a justification for automatically admitting all these auxiliary requests into the appeal proceedings, especially when their admission has not even been examined at first instance (cf. T 217/15 of 14 March 2019, point 39.2 of the Reasons). In line with the case law (see, for instance, T 105/14 of 12 April 2019, points 3 to 12 of the Reasons), the parties were informed that the admission of these requests may depend on their subject-matter and the conditions or circumstances of their filing.
20. In the communication pursuant to Article 15(1) RPBA, the parties were furthermore informed that, even if any of auxiliary requests 2 to 5 were admitted into the appeal proceedings, the board was of the provisional

opinion that none of them overcame the objection raised under Article 123(2) EPC against auxiliary request 1. The specific combination of the three features or selections referred to above is also found in auxiliary requests 2 to 5.

21. Appellant I, for whom the provisional opinion of the board was negative, did not reply to the board's communication in substance. Thus, the board has no reason to change its opinion and, and in the exercise of its discretion, does not admit auxiliary requests 2 to 5 into the appeal proceedings.

Admission of document (20)

22. Since all claim requests contravene Article 123(2) EPC, the admission of appellant I's late-filed experimental evidence (document(20)) into the appeal proceedings is not relevant anymore and thus, there is no need to decide thereupon.

Conclusion

23. Since there is no allowable claim request, the patent must be revoked.



**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



L. Malécot-Grob

B. Stolz

Decision electronically authenticated