**Internal distribution code:**

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

**Datasheet for the decision of 7 May 2018**

**Case Number:** T 1977/15 - 3.3.09

**Application Number:** 09165039.0

**Publication Number:** 2272377

**IPC:** A23G1/32, A23G3/00, A23G3/26, A23G3/34, A23G3/54, A23G1/04, A23G1/40, A23G1/30, A23G3/20, A23G1/54, A23G1/00

**Language of the proceedings:** EN

**Title of invention:**
Process for producing a confectionery product

**Patent Proprietor:**
Kraft Foods R & D, Inc.

**Opponent:**
Nestec S.A.

**Headword:**

**Relevant legal provisions:**
EPC Art. 56

**Keyword:**
Inventive step - (no)

**Decisions cited:**

**Catchword:**

Europäisches Patentamt
European Patent Office
Office européen des brevets

**Beschwerdekammern**

**Boards of Appeal**

**Chambres de recours**

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

**Case Number: T 1977/15 - 3.3.09**

# D E C I S I O N
# of Technical Board of Appeal 3.3.09
# of 7 May 2018

| | |
|---|---|
| **Appellant:** (Opponent) | Nestec S.A.<br>Avenue Nestlé 55<br>1800 Vevey (CH) |
| **Representative:** | Plougmann Vingtoft a/s<br>Rued Langgaards Vej 8<br>2300 Copenhagen S (DK) |
| **Respondent:** (Patent Proprietor) | Kraft Foods R & D, Inc.<br>Three Parkway North<br>Deerfield, IL 60015 (US) |
| **Representative:** | Wilson Gunn<br>Charles House<br>148/9 Great Charles Street<br>Birmingham B3 3HT (GB) |
| **Decision under appeal:** | **Interlocutory decision of the Opposition Division of the European Patent Office posted on 29 June 2015 maintaining European patent No. 2272377 in amended form** |

**Composition of the Board:**

| | |
|---|---|
| **Chairman** | W. Sieber |
| **Members:** | J. Jardón Álvarez |
| | E. Kossonakou |

## Summary of Facts and Submissions

I. This decision concerns the appeal filed by the opponent against the interlocutory decision of the opposition division that European patent No. 2 272 377 as amended met the requirements of the EPC.

II. The opponent had requested revocation of the patent in its entirety on the grounds of Article 100(a) (lack of inventive step) and (c) EPC. The documents cited during the opposition proceedings included:

D1: US 4 980 192 A;

D5: JP H4 248950 A;

D5a: English translation of JP H4 248950 A; and

D9: S.O. Corriher, "BakeWise - The Hows and Whys of Successful Baking" 2008, pages 104 and 105.

III. The opposition division maintained the patent on the basis of the first auxiliary request, claim 1 of which read as follows:

"1. A process for producing a confectionery product comprising the step of spraying water and/or a polyol solution onto chocolate or a compound mass;

wherein the water and/or polyol solution and the chocolate/compound mass have the same temperature; and

wherein when the water and/or polyol solution is/are sprayed onto chocolate, the chocolate and the water and/or polyol solution have a temperature within the range of 29-35°C, and when the water and/or polyol solution is/are sprayed onto a compound mass, the compound mass and the water and/or polyol solution have

a temperature within the range of 30-45°C, these temperatures being maintained for a period such that the water and/or polyol solution mixes with the chocolate/compound mass."

The remaining claims were dependent claims.

IV. The opposition division's decision may be summarised as follows:

- The opposition division rejected the then pending main request of the patent proprietor because it did not meet the requirements of Article 123(2) EPC.

- On the other hand, the opposition division held that the claims of auxiliary request 1 fulfilled the requirements of Articles 123(2) and (3), 84 and 56 EPC and maintained the patent in amended form on the basis of the claims of that request.

- Concerning inventive step, the opposition division and the parties agreed that D5 represented the closest prior-art document. Since no improvement in the resulting product had been shown, the opposition division defined the problem to be solved by the invention in view of D5 as how to provide an alternative process for producing a confectionery product.

- This problem was solved by the process of claim 1, which was characterised in that the water/polyol solution and the chocolate/compound mass had the same temperature to allow mixing. This solution was not obvious in view of D5 alone or taken in

combination with D9 (common general knowledge of the skilled person) or D1.

V. This decision was appealed by the opponent (in the following: the appellant). With the statement setting out the grounds of appeal filed on 6 November 2015, the appellant requested that the opposition division's decision be set aside and that European patent No. 2 272 377 be revoked in its entirety.

VI. With its reply dated 21 March 2016, the patent proprietor (in the following: the respondent) requested that the appeal be dismissed.

VII. The appellant filed a further submission on 24 June 2016.

VIII. In a communication dated 15 November 2017, the board indicated the points to be discussed during the oral proceedings scheduled for 7 May 2018.

IX. The oral proceedings were held in the absence of the parties, which had informed the board that they would not be attending them.

X. The arguments of the appellant where relevant for the present decision may be summarised as follows:

- The appellant agreed with the findings of the opposition division that D5 represented the closest prior art and that the objective technical problem to be solved was how to provide an alternative process.

- The only feature which distinguished the claimed process from the teaching of D5 was the requirement

that the chocolate and the water/polyol should have the same temperature within the range of 29-35°C. This feature, however, could not justify an inventive step. The skilled person would never contemplate using water/polyol at a temperature higher or lower than the chocolate temperature to avoid any risks concerning the chocolate properties (tempering and sprayability). Thus, the claimed subject-matter lacked inventive step over D5 in combination with the skilled person's common general knowledge (e.g. as represented by D9).

- The subject-matter of claim 3 lacked clarity.

XI. The relevant arguments of the respondent may be summarised as follows:

- The respondent saw the problem to be solved by the invention in view of D5 as how to provide an alternative process which surprisingly resulted in products having superior heat resistance. The prior-art process showed that using water at ambient temperature whilst maintaining the chocolate/compound mass at a higher temperature constituted the normal process conditions. None of the prior-art documents disclosed spraying water/ polyol solution and chocolate/compound mass at the same high temperature. The skilled person would find no motivation at all in D9 to deviate from the teaching of D5, which already used the temperatures discussed as optimal in D9.

## Reasons for the Decision

*1. Inventive step*

1.1 The invention relates to a process for producing a confectionery product comprising heat-resistant chocolate or a heat-resistant compound mass. Such a product can withstand temperatures of 30°C or more without becoming sticky. The process involves spraying water and/or a polyol (such as a sugar alcohol or a sugar) solution onto chocolate or a compound mass, thereby inducing the formation of heat-resistant chocolate or a heat-resistant compound mass (see paragraphs [0001] and [0002] of the patent specification).

1.2 As acknowledged in the "Background of the invention" section of the patent specification, many (patent) documents are known which disclose methods of producing heat-resistant chocolate products by mixing polyols or water with chocolate (see paragraphs [0003] to [0007)]). However, the majority of these prior-art methods cannot produce compounded or enrobed chocolate confectioneries which themselves exhibit water-absorbing properties, such as biscuits or wafers, and whose quality is thus adversely affected by absorption of water (see paragraph [0012]).

1.3 Closest prior art

1.3.1 Document D5 (in the following, the references to D5 relate to its English translation, D5a) was agreed by the parties and the opposition division to represent the closest prior art. The board agrees that D5 is indeed an appropriate starting point for assessing inventive step.

1.3.2 Like the patent in suit, D5 aims at the provision of heat-resistant chocolate-coated food which does not melt readily even when the temperature of the surroundings becomes more or less high (see paragraph [0003]).

1.3.3 This is achieved in D5 basically by a panning process which is characterised in that centres are rotated while liquid chocolate is suitably distributed thereon, and water or an aqueous solution is distributed simultaneously with or after distributing chocolate, followed by solidification by cooling (claim 1). The operation is repeated to form a coating of the desired thickness. The centres include nuts, low-moisture or dried fruits, puffed cereals, sweets and baked products such as biscuits (see page 4, lines 12 to 17).

1.3.4 The chocolate is distributed manually or by spraying (see paragraph [0001]). According to the examples, chocolate material held at 35°C is distributed as evenly as possible on the centres (dried apple cut, almonds or orange flavoured gummy jelly in the form of spheres) inside a rotating pan, at a temperature which is within the claimed range. After cooling of the chocolate material, water is evenly sprayed onto the product inside the pan. Chocolate distribution, cooling and water spraying is repeated. The obtained product has a good flavour, and smoothness and mouthfeel are comparable to a product without added moisture. The product shows good heat resistance (see tables 1 to 4).

1.3.5 It is evident from the description in D5 that the addition of water during the panning process leads to mixing of the water with the chocolate material. Thus, page 4, lines 32-34, states that "[d]istributing water

to chocolate means a state in which chocolate and water are intensively mixed and water is mixed into the chocolate." This is confirmed by the statement on page 5, lines 23-24, that "water is mixed into the chocolate material during panning".

1.3.6 As to the water temperature used during spraying, page 4, line 31, merely states that "[o]rdinarily city water at ambient temperature is used".

1.3.7 Hence, D5 discloses a process which has all the features of claim 1 of the main request except that "the water and/or polyol solution and the chocolate/ compound mass have the same (high) temperature".

1.4 Problem to be solved and its solution

1.4.1 According to the respondent, the invention "solves the problem of providing an alternative process which surprisingly results in products having superior heat resistance" (reply to grounds of appeal, page 4, third paragraph from bottom).

In this context the respondent referred to the statement in paragraph [0123] of the patent specification that "[h]eat resistance of all tested products was proven at temperatures equal to 35°C and up to 50°C", while the process of D5 would result in heat stability of only up to 37°C as demonstrated in the examples of D5.

1.4.2 The board disagrees. There is simply no experimental evidence on file which would support the respondent's line of argument. The fact that heat stability of the products obtained in the examples of D5 was only measured at 37°C does not necessarily mean that their

heat stability at higher temperatures would be inferior to the heat stability of products obtained according to the claimed process.

The decision under appeal pointed out on page 11, third paragraph, that alleged advantages without sufficient evidence to support the comparison with the closest prior art cannot be taken into consideration when determining the problem underlying the invention.

In its written submission the respondent merely maintained its position, but did not explain why the opposition division had erred in its conclusion on this point. Nor did it provide evidence to support its position. There is no experimental evidence on file showing that this problem has been credibly solved by the claimed process. It has not been shown that the products prepared by the process of claim 1 have improved heat resistance as compared to the products prepared by the process of D5.

1.4.3 As a consequence, the objective technical problem has to be reformulated in a less ambitious manner, not involving any improvement over D5. Hence, the objective technical problem has to be seen as how to provide an alternative process for producing a confectionery product comprising heat-resistant chocolate or a heat-resistant compound mass.

1.4.4 The examples in the patent show that this less ambitious problem is credibly solved by the process of claim 1. This conclusion was not contested by the appellant, and the board too is satisfied that this problem is indeed credibly solved.

1.5 Obviousness

1.5.1 It remains to be decided whether it would have been obvious for the skilled person, in view of his common general knowledge or the available prior art, to solve this technical problem by the means claimed, namely by modifying the process disclosed in D5 such that the water/polyol solution and the chocolate material have the same temperature when the water/polyol solution is sprayed onto the chocolate material in the panning process of D5.

1.5.2 As pointed out by the appellant, a skilled person would know from his common general knowledge as shown for instance in D9 (see page 105, Chapter "Easy Tempering") that heating chocolate to temperatures above 34.4°C is associated with serious drawbacks, since tempering will be lost. Thus, heating melted chocolate to temperatures in the range of about 30°C to below 35°C is recommended, since tempering is not lost. Selecting a temperature for spraying water in the range of 29-35°C would then be an obvious choice for the skilled person, because such a temperature would minimise the risk of affecting the chocolate properties. Within this temperature range he would also contemplate the use of the same temperature for chocolate and water, as this alternative would have less impact on the chocolate properties.

1.5.3 Thus, starting from D5 and confronted with the problem of providing an alternative process, the skilled person would be motivated by his common general knowledge to use the same temperature in the specified range for the water and/or polyol solution and the chocolate/compound mass, because use of the same temperature would not affect the tempering of the chocolate. Thus, the

skilled person would arrive at the claimed process in an obvious manner.

1.5.4 The respondent argued that the skilled person reading D5, using water at ambient temperature whilst maintaining the chocolate/compound mass at a higher temperature, would have no motivation to deviate from this teaching.

However, the above reasoning shows that the skilled person was indeed motivated by his common general knowledge to use the same temperature for both steps.

1.6 For these reasons, the board concludes that the subject-matter of claim 1 lacks an inventive step. The sole request of the respondent is therefore not allowable.

2. In the light of this conclusion, there is no need for the board to decide upon the appellant's objection against claim 3 for lack of clarity.

**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:

M. Cañueto Carbajo W. Sieber

Decision electronically authenticated