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

Case Number: T 0958/16 - 3.3.05

Application Number: 05744354.1

Publication Number: 1753529

IPC: B01J13/02, A01N25/28,
A01N35/06, A01N35/02,
A01N31/16, A01N31/08,
A01N31/02, A61K9/50

Language of the proceedings: EN

Title of invention:

HOLLOW GLUCAN PARTICLES ENCAPSULATING A TERPENE COMPONENT,
METHODS OF MAKING AND USING THEM

Patent Proprietor:

EDEN RESEARCH PLC

Opponent:

Lesaffre International

Headword:

Hollow glucan capsules/EDEN RESEARCH

Relevant legal provisions:

EPC R. 99(1)(c), 99(2)
EPC Art. 54(1), 54(2)
RPBA Art. 13(3)

Keyword:

Admissibility of appeal - (yes)

Novelty - (no)

Late-filed request - amendments after arrangement of oral proceedings - adjournment of oral proceedings would have been required (yes)

Decisions cited:

T 0358/08, T 1435/11

Catchword:



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Case Number: T 0958/16 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 7 June 2018

Appellant: EDEN RESEARCH PLC
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 15 February
2016 revoking European patent No. 1753529
pursuant to Article 101(3) (b) EPC**

Composition of the Board:

Chairman A. Haderlein
Members: J.-M. Schwaller
P. Guntz

Summary of Facts and Submissions

- I. The present appeal lies from the decision of the opposition division to revoke European patent No. 1 753 529 on the ground that claim 1 of the sole request then on file (now main request) lacked novelty over document D11: US 4 696 863.
- II. With its grounds of appeal, the appellant contested the decision and filed two auxiliary requests.
- III. With its reply to the grounds of appeal, the respondent argued that the appeal was not admissible. Further, it contested *inter alia* the novelty of the claimed subject-matter in the light of several documents, among them D11 and D10: EP 0 085 805 B1, which had already been referred to in the proceedings before the opposition division.
- IV. With a letter dated 5 May 2017, the appellant submitted a new first auxiliary request and renumbered the then first and second auxiliary requests as the second and third auxiliary requests, respectively. Claim 1 of the main request, also filed with this letter, reads as follows:

"1. A composition comprising a hollow glucan particle encapsulating a terpene component wherein the lipid content of the hollow glucan particle is 5% w/w or greater."

Claims 1 of the auxiliary requests read as follows (differences compared to claim 1 of the main request emphasised by the board).

First auxiliary request:

"1. A composition comprising a hollow glucan particle encapsulating a terpene component wherein the lipid content of the hollow glucan particle is 10% w/w or greater."

Second auxiliary request:

"1. A composition comprising a hollow glucan particle stably encapsulating a terpene component wherein the lipid content of the hollow glucan particle is 10% w/w or greater."

Third auxiliary request:

"1. A composition comprising a hollow glucan particle stably encapsulating a terpene component wherein the lipid content of the hollow glucan particle is 10% w/w or greater; provided that the terpene component is not menthol oil."

V. In a communication pursuant to Article 15(1) RPBA, the board expressed its preliminary opinion that the appeal appeared to be admissible, that claim 1 of the main and second auxiliary requests appeared to lack novelty over the disclosure of document D11 and that claim 1 of the first auxiliary request appeared to lack inventive step over D11. The third auxiliary request did not appear to comply with Article 123(2) EPC.

VI. At the oral proceedings, novelty was discussed in particular in view of D10. The appellant also submitted a new second auxiliary request, claim 1 of which reads:

"1. A method of preparing a composition comprising a hollow glucan particle encapsulating a terpene component wherein the lipid content of the hollow glucan particle is 10% w/w or greater said method comprising the steps of:

a) providing a terpene component;

b) providing a hollow glucan particle;

c) incubating the terpene component with the hollow glucan particle under suitable conditions for terpene encapsulation; and

d) recovering the hollow glucan particle encapsulating the terpene component."

This request, after discussion of its admissibility, was rejected as inadmissible.

VII. The final requests of the parties were as follows:

The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of one of the sets of claims according to the main or one of the first to fourth auxiliary requests, the main, first, third and fourth auxiliary requests as filed with the letter dated 5 May 2017 as the main and first to third auxiliary requests, and the second auxiliary request as filed at the oral proceedings.

The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. Admissibility of the appeal

In points (i) and (ii) of the notice of appeal, the appellant requested that the decision to revoke the

current European patent be set aside in its entirety and that the patent be restored in its entirety.

The notice of appeal thus satisfies the requirements for an admissible appeal, as set out e.g. in T 358/08, i.e. that Rule 99(1)(c) EPC is met if the notice of appeal contains a request, which may be implicit, to set aside the decision in whole or (where appropriate) only as to part. Whether there is an alleged contradiction in the grounds of appeal, as contended by the respondent, has no bearing on this finding. T 1435/11 cited by the respondent is of relevance here, because in that case neither the notice of appeal nor the grounds of appeal contained at least one clear request (reasons 2, last sentence), whereas in the present case the grounds of appeal contain several such clear requests. By the same token, the requirement of Rule 99(2) EPC is complied with.

The appeal is therefore admissible.

2. Main request - novelty

- 2.1 D10 (claim 1) discloses a method for producing an encapsulated material comprising treating a grown microbe with the material to be encapsulated.

In example I, the microbe is a yeast of the strain *Lipomyces lipofer* 5841 which was grown so as to have a lipid content of about 30% by weight.

In example XV, a 20% aqueous slurry containing 3g (dry weight) of the above grown microbe is mixed with 3g of clove oil and 0.5 ml of 2-ethylhexyl acetate for 3 hrs at 50°C. The microbial product is then centrifuged and oven-dried at 70°C.

2.2 For the board, the oven-dried "microbial product" of example XV corresponds to the product defined in claim 1 at issue. In this respect, it is uncontested that the "microbial product" is a "glucan particle" in the sense of the patent, since it is commonly known that the walls of yeast cells contain glucan. Furthermore, the lipid content of said glucan particle is disclosed as being about 30% w/w, and the clove oil (a terpene oil) has been encapsulated in said glucan particle since, as indicated in example XV, the crushing of the microbial product revealed a distinct odour of clove oil.

2.3 The appellant contested this conclusion, arguing that according to the claimed subject-matter the particle had to be hollow before being contacted and filled with the terpene oil; this not being the case in example XV, claim 1 at issue was novel.

The board does not accept this argument, because claim 1 at issue relates to a product, namely a glucan particle encapsulating a terpene oil, not to a process for preparing such a particle. Therefore, whether the particle is prepared from a hollow yeast cell or from a yeast cell which has not been emptied of its content, the final product is in any case the same, namely a glucan particle which is no longer hollow since it has been filled by the terpene oil so as to encapsulate said oil within the yeast cell walls. In the context of example XV of D10, the clove oil migrates through the yeast cell membrane, which admittedly is not hollow before migration, but after this migration the clove oil is de facto encapsulated within the cell walls, and so a glucan particle according to the wording of claim 1 at issue is directly and unambiguously obtained in example XV of D10.

2.4 The board does not accept either of the appellant's other arguments, in particular that the amount of encapsulated terpene oil would allegedly be lower in the capsule of example XV, which is irrelevant in the present context, since the subject-matter of claim 1 at issue is not restricted to any amount of encapsulated terpene oil.

The further argument that there was no evidence that clove oil was indeed encapsulated is rejected because D10, claim 1, directly and unambiguously discloses that the material is "encapsulated" and "retained passively in the microbe", with the consequence that the amount of terpene oil in the particle in example XV cannot be zero, as alleged by the appellant. This incidentally is confirmed by the fact that an odour of clove oil was noticed when the capsule was crushed.

The appellant in this respect argued that the odour of clove oil after crushing might well come from the clove oil absorbed on the external side walls of the yeast cells. The board rejects this argument too, because no evidence supporting this statement has been filed. Moreover, the appellant itself (page 10 of the letter of 5 May 2017) recognised that "the compositions of D10 are based on the replacement of the intracellular content" of the yeast cells; so implicitly it recognised that the clove oil - after this replacement - was encapsulated in the yeast cell.

2.5 It follows from the above considerations that example XV of D10 destroys the novelty of the subject-matter of claim 1 at issue, which therefore is not allowable under Article 54(1), (2) EPC.

3. First auxiliary request - novelty

3.1 Claim 1 of this request differs from that of the main request in the lipid content of the glucan particle, which in this case is 10% w/w or greater.

3.2 The lipid content of the yeast of example XV of D10 being about 30% w/w, it directly and unambiguously falls under the wording of claim 1 of the request at issue, which therefore - for the same reasons as those indicated in points 2.1 to 2.4 above - is not allowable under Article 54(1), (2) EPC.

4. Second auxiliary request - admissibility

This auxiliary request was filed at the oral proceedings before the board after the discussion on the main request and after the appellant had indicated that it did not wish to comment on the first, third and fourth auxiliary requests, i.e. at an extremely late stage of the proceedings and well after the board had given its provisional conclusions in its communication under Article 15(1) RPBA - six weeks earlier - regarding the requests then on file.

The objections discussed at the oral proceedings, however, were similar to the board's preliminary opinion indicated in the communication under Article 15(1) RPBA and/or to the objections raised by the respondent in the reply to the grounds of appeal. Said communication even contained the further information that the appeal appeared to have limited chances of success.

Given that the appellant had sufficient time to file amended sets of claims before the scheduled oral

proceedings and that it was even prompted to do so for the above reasons, and that it deliberately decided not to amend its case, the board - further taking into account that the new claims filed during the oral proceedings are of a different category and thus take the respondent and the board by surprise, with the consequence that the oral proceedings should have been adjourned in order to give the respondent and the board sufficient time to prepare this new case - decided to exercise its discretionary power under Article 13(3) RPBA not to admit this request into the proceedings.

5. Third auxiliary request - novelty

5.1 Claim 1 of this request differs from claim 1 of the first auxiliary request in that the glucan particle stably encapsulates the terpene oil.

5.2 As indicated in Example XV of D10, the crushing of the microbial capsules reveals a "distinct odour of clove oil"; this means that the capsules were stable before being crushed since they liberate the clove oil after the crushing operation. As claim 1 at issue does not indicate the extent to which the claimed capsules are stable, the capsules obtained in example XV fall - for the same reasons as indicated in points 2.1 to 2.4 and 3.2 above - under the wording of claim 1 at issue, which therefore does not meet the requirements of Article 54(1), (2) EPC either.

6. Fourth auxiliary request - novelty

6.1 Claim 1 of this request differs from claim 1 of the third auxiliary request in that the terpene component is not menthol oil.

- 6.2 Irrespective of the allowability of this claim under Article 123(2) EPC, this additional requirement is fulfilled by the capsules according to Example XV too, since they contain clove oil which evidently is not menthol oil. Therefore for the same reasons as those indicated in point 5.2 above, the subject-matter of claim 1 of this request does not meet the requirements of Article 54(1), (2) EPC either.
7. As the sets of claims underlying the proposed requests either do not meet the requirements of the EPC or were not admitted into the proceedings, the appeal cannot succeed, and the decision to revoke the patent is to be upheld.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Vodz

A. Haderlein

Decision electronically authenticated