

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 2020**

Case Number: T 1825/16 - 3.3.08

Application Number: 00943685.8

Publication Number: 1198562

IPC: C12N9/98, C11D3/386, A23K1/165

Language of the proceedings: EN

Title of invention:
A PROCESS FOR PREPARING AN ENZYME CONTAINING GRANULE

Patent Proprietor:
Novozymes A/S

Opponent:
DuPont Nutrition Biosciences ApS

Headword:
Process for preparing granules/NOVOZYMES A/S

Relevant legal provisions:
EPC Art. 123(2)
EPC R. 80, 116
RPBA Art. 12(4)

Keyword:

Main and auxiliary request 1 - Article 123(2) - (no)
Auxiliary requests 2 to 6 - admitted (yes)
Auxiliary requests 2 to 6 - Article 123(2) (no)
Auxiliary requests 7 and 8 - admitted (no)

Decisions cited:

Catchword:



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 1825/16 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 7 May 2020

Appellant: Novozymes A/S
(Patent Proprietor) Krogshøjvej 36
2880 Bagsvaerd (DK)

Representative: Stevens, Ian, E.
Potter Clarkson
The Belgrave Centre
Talbot Street
Nottingham NG1 5GG (GB)

Respondent: Garberg, Morten
(Opponent) Mulhern, Declan
DuPont Nutrition Biosciences ApS
Langebrogade 1
1411 Copenhagen K (DK)

Representative: Hoffmann Eitle
Patent- und Rechtsanwälte PartmbB
Arabellastraße 30
81925 München (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 21 June 2016
revoking European patent No. 1198562 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman B. Stolz
Members: D. Pilat
D. Rogers

Summary of Facts and Submissions

- I. European patent No 1 198 562 was granted with 19 claims. It is based on European patent application No 00943685.8 (published as International patent application WO2001/004279; hereinafter "the patent application"). An opposition was filed on the grounds of Article 100(a) EPC in conjunction with Articles 54 and 56 EPC, and Article 100(b) and (c) EPC. The opposition division considered the main and auxiliary requests 1 to infringe Article 123(2) EPC, while auxiliary requests 2 to 8 were not admitted into the proceedings.
- II. With its statement of grounds of appeal, the patent proprietor (appellant) submitted a main request and auxiliary requests 1 to 8, identical to those filed during opposition proceedings.
- III. As a subsidiary measure, oral proceedings were requested by the parties.
- IV. The appellant informed the board with its letter dated 24 January 2020 that it withdrew its request for oral proceedings and that it would not attend them. Under cover of a letter dated 28 January 2020, the respondent asked the board to cancel the oral proceedings appointed for 4 March 2020, if the appeal could be dismissed based on its written submissions.
- V. Independent claim 1 of the main request read as follows:
- "1. A process for manufacture of a dry enzyme-containing granule comprising the step of adding a

cereal grain flour to a mixer granulation process, wherein the cereal grain flour constitutes less than 75 of 100 parts of the finished granule and the cereal grain flour consists of particles having a mean size in their longest dimension which is at least 40 μm and is less than half the diameter of the final granule.

Independent claims 15 and 17 to 20 refer to compositions and a method of preparing dough comprising the granules obtainable by the process of claim 1.

Dependent claims 2 to 14 and 16 define specific embodiments of the process of claim 1 and of the detergent composition of claim 15.

Auxiliary request 1 (claims 1-19)

Auxiliary request 1 is identical to auxiliary request 1 of the decision under appeal. It differs from the main request in that claim 1 was amended to include "... is less than half the mean diameter of the final granule in its longest diameter" (emphasis added).

Auxiliary requests 2 to 6 (claims 1-19; 1-18; 1-13 and 1-12 respectively)

Auxiliary requests 2 to 6 are identical to auxiliary requests 2 to 6 of the decision under appeal and were filed within the term set under Rule 116 EPC.

Auxiliary request 2 differs from the main request in that claim 1 was amended to include and "... is less than half the mean diameter of the final granule in its longest diameter and the finished granule has a mean size below 480 μm ."

Auxiliary request 3 differs from the main request in that claim 1 was amended to include granule "for an animal feed composition" and "... is less than half the mean diameter of the final granule in its longest diameter and the finished granule has a mean size below 480 µm."

Auxiliary request 4 differs from the main request in that claim 1 was amended to include "... is less than half the mean diameter of the final granule in its longest diameter and the finished granule has a mean size below 480 µm and wherein the flour has been treated with dry superheated steam."

Auxiliary request 5 differs from the main request in that claim 1 was amended to include "... is less than half the mean diameter of the final granule in its longest diameter and the finished granule has a mean size below 480 µm and wherein the enzyme is selected from phytases (EC 3.1.3.-)."

Auxiliary request 6 differs from the main request in that claim 1 was amended to include "... is less than half the mean diameter of the final granule in its longest diameter and the finished granule has a mean size below 480 µm and wherein the flour has been treated with dry superheated steam and the enzyme is selected from phytases (EC 3.1.3.-)."

VI. The appellant's written submissions, insofar as relevant to the present decision, may be summarized as follows:

Main request

Article 123(2) EPC

The process of claim 1 as granted comprised a combination of features disclosed in claims 1, 9 and 10 of the patent application.

The process of the invention disclosed adding a cereal grain flour to a mixer granulation process, thereby producing a population of enzyme-containing granules and not a single granule. Thus, the skilled person, following the "gold standard" according to decision G 2/10, would have derived directly and unambiguously from the patent application using common general knowledge that the term "mean", omitted in the "cereal grain flour" of the last line of claim 1, had to be implicitly and necessarily read into it. Thus, the main request fulfilled the requirements of Article 123(2) EPC.

Auxiliary request 1
Article 123(2) EPC

The process of claim 1 of the patent application disclosed "adding a particulate component to the mixer granulation process", while claims 9 and 10 defined that "the particulate component is a vegetable flour" and that the vegetable "is a cereal grain". The particulate component mentioned in dependent claims 9 and 10 defined in consequence an embodiment wherein the particulate component was a cereal grain flour. Since a particulate component by definition consisted of a particle, the cereal grain flour of claim 1 had to consist of particles.

The patent application disclosed that the term "particulate component" i.e., a substance that consists of particles (see patent application page 10, line 3) embraced "... all powdered grained plant products" and

"the term vegetable flour encompasses refined flours in which some components of the plant/vegetable has been removed such as leaves or grain shell components ..." (see patent application, page 12, lines 17 to 19 and lines 22 to 24). This passage did however not disclose that an unrefined flour had to comprise non-particulate material. In consequence amended claim 1 complied with Article 123(2) EPC.

There were clear indications in the patent application that the "75 parts" of claim 1 had to be "75 of 100 parts". A skilled person reading "75 parts" in claim 1 would not have interpreted it as an absolute number with no units but as a relative term as indicated by the word "parts" (of something). This interpretation was confirmed by the content of the patent application (see page 24, line 14; page 35, lines 12 to 13; page 35, lines 30 to 31; page 36, line 17; page 37, line 5; page 38, lines 8 to 9; page 38, lines 26 to 27). A process for the manufacture of an enzyme comprising the steps of: adding less than 75 of 100 parts of a particulate component having a mean size of more than 40 μm in its longest dimension to more than 25 of 100 parts of an enzyme and conventional granulating components and mixing these ingredients to form an enzyme containing granule was specified on page 24 line 14 of the patent application, while the other examples disclosed an amount of cereal grain flour in relation to its finished granule linking the "less than 75 parts per 100" directly and unambiguously to the finished granule. For these reasons, auxiliary request 1 fulfilled the requirements of Article 123(2) EPC.

The opposition division in its decision was incorrect not to admit auxiliary requests 2 to 6 under Rule 80 EPC into opposition proceedings as they were all filed

before oral proceedings within the time limit set under Rule 116 EPC. They all met the requirements of Article 123(2) EPC for the same reasons as given for auxiliary request 1.

The auxiliary requests 7 and 8 were filed in reaction to a new objection raised during oral proceedings in opposition which had led the opposition division to deviate from its preliminary non-binding opinion. Appellant's auxiliary requests 7 and 8 were filed in direct response to an unexpected change in position of the opposition division and had to be admitted into the proceedings despite their late filing. Auxiliary request 7 intended to address the issue that the cereal flour "consists of" particles, by limiting it to refined cereal flour, while auxiliary request 8 limited the subject-matter of claim 1 further to particulate pre-gelatinized wheat flour. These amendments excluded the use of non-particulate material as objected by the opponent. Basis for these amendments were found on page 13, line 20, and in the examples (see page 35, line 17 to page 36, line 4). The expression "% by weight" in claim 1 of auxiliary requests 7 and 8 replaced the term "of 100 parts". Should the replacement be unallowable, reversal to the original wording was requested. Auxiliary requests 7 and 8 fulfilled the requirements of Article 123(2) and (3) EPC.

The respondent's written submissions, insofar as relevant to the present decision, may be summarized as follows:

Claim 1 included amendments infringing Article 123(2) EPC. Among others, the features:

- "less than half the diameter of the final granule" wherein the diameter was not a "mean" diameter, and
- "75 of 100 parts of the finished granules" were not disclosed in the patent application.

The "mean" diameter wherein the diameter was measured in "its longest diameter" of the final granule.

No basis was found for the amendment "less than half the ~~mean~~ diameter of the final granule" in claim 1. The only basis for this amendment was the paragraph bridging pages 10 and 11 of the patent application, which reads: ... that mean diameter of the particulate component in "its longest dimension is less than half the mean diameter of the finished granule in its longest diameter." The mean diameter size of the particulate component was therefore measured with regard to the "mean" diameter of the finished granule "in its longest diameter". Since the particulate component's mean size in its longest dimension could be less than half the diameter of any one of the final granule in the process of claim 1, while the patent application required it to be less than the mean diameter of the finished granule in its longest diameter, the process of granted claim 1 encompassed the use of particles with a mean size in its longest dimension larger (i.e. not less) than the mean diameter of the finished granule in its longest diameter. There was however no basis for the use of such particles in the patent application.

The "75 of 100 part"

No basis was found in the patent application for a process using cereal grain flour that constituted less than 75 "of 100" parts of the finished granule.

Although "of 100" parts could be one of the skilled person's first thought, there was no support for appellant's assertion. The patent application disclosed a process wherein the particulate component constituted less than 75 parts of the finished granule (claim 1; page 6, lines 28-29; page 24, lines 14-15) but no process comprising adding a particulate component restricted to cereal grain flour which constituted less than 75 parts of 100 parts of the finished granule in claim 1.

Admission of new sets of claims into the proceedings

In the decision under appeal the opposition division indicated that auxiliary requests 2 to 6 contravened Rule 80 EPC in that they did not overcome the outstanding objection of added-matter ascribed to the term "75 of 100 parts" and for this reason correctly exercised its discretion not to admit them into the proceedings in accordance with Article 114(2) EPC. Auxiliary requests 2 to 6 were still deficient under Article 123(2) EPC and should not be admitted into appeal proceedings under Article 12(4) RPBA 2007.

Auxiliary requests 7 and 8 were filed during oral proceedings in opposition. Claim 1 incorporated features from the description. Contrary to appellant's view, the added matter objection which occasioned their introduction was raised in the notice of opposition and could not have caught the appellant by surprise. Thus, it was justified not to admit these claims requests into the opposition proceedings.

The replacement of the term "75 of 100 parts", by "75% by weight" in auxiliary requests 7 and 8, re-submitted in appeal proceedings, did not prima facie overcome the added matter objection raised under Article 123(2) EPC

against the main and auxiliary request 1. The further characterization of the cereal grain flour as refined flour or as a particulate pre-gelatinized wheat flour in auxiliary requests 7 and 8, respectively, had no bearing in this case. Since auxiliary requests 7 and 8 were not admitted into the first instance proceedings and no reasons were provided why this decision was incorrect and why the introduced amendments *prima facie* addressed the outstanding added matter objection, both auxiliary requests should not be admitted into the appeal proceedings under Article 12(4) RPBA 2007.

VII. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of its main request or alternatively on one of the auxiliary requests 1 to 8. Remittal to the opposition division for consideration of Articles 54, 56 and 83 EPC, once a request was found not to contravene Article 123(2) EPC was requested.

VIII. The respondent requested that the appeal be dismissed and that the auxiliary requests 2 to 8 not be admitted into the proceedings.

Reasons for the Decision

1. The duly summoned appellant withdrew its request for oral proceedings. The board upon request of the respondent and under the present circumstances cancelled the oral proceedings appointed for 4 March 2020 with a letter dated 30 January 2020.

Main request (claims 1-19 claims)

Article 123 (2) EPC

2. Claim 1 is identical to granted claim 1 and to claim 1 of the main request of the decision under appeal.
- 2.1 In the decision under appeal, the process for manufacture of a dry enzyme-containing granule of claim 1 was held to contravene Article 123(2) EPC because the term "mean" was missing from the definition of the cereal grain flour as consisting of particles "less than half the diameter of the final granule" (based on page 11, lines 3 to 5 and page 8, lines 24 to 26 of the patent application).
- 2.2 It is undisputed that there is no explicit basis in the patent application for the process of claim 1 wherein the particle's diameter is not limited to less than half the "mean" diameter of the final granule.
- 2.3 The appellant argued that a skilled person would have derived directly and unambiguously from the patent application, using its common general knowledge, that the term "mean" had to be implicitly read into claim 1, and could therefore be omitted without extending its scope beyond the content of the application as filed.
- 2.4 Since the wording of claim 1 is not unclear, the board sees no reason to interpret it otherwise than literally, giving the words their regular meaning. Under these circumstances, there is no reason to re-interpret claim 1 taking into account technical features only recited in the description (e.g. headnote of decision T1018/02 of 9 December 2003). Hence, the appellant's argument that the term "mean", in the light of the patent application, is an implicit feature of claim 1, fails to convince the board.

2.5 The board notes that there is also no basis in the patent application for a process of claim 1 using cereal grain flour particles having a mean size in their longest dimension which is at least 40 μm and is less than half the diameter of the final granule, where said diameter could be either the final granule's longest diameter as well as any other diameter of the final granule.

2.5.1 Thus, the main request contravenes Article 123(2) EPC.

Auxiliary request 1

Article 123(2) EPC

3. Claim 1 of the auxiliary request 1 is identical to claim 1 of the main request except that it includes "... is less than half the mean diameter of the final granule in its longest diameter" in the definition of the mean particle size (emphasis added).

"The cereal grain flour constitutes less than 75 of 100 parts of the finished granule"

4. In the decision under appeal, the opposition division concluded that the application as filed did not directly and unambiguously disclose that the cereal grain flour constituted "less than 75 of 100 parts" of the finished granule.

4.1 In appellant's view there were clear indications in the patent application that the 75 parts had to relate to 100 parts of the finished granule.

4.2 It is undisputed that there is no explicit disclosure of a granule comprising cereal grain flour wherein the

cereal grain flour constitutes less than 75 of 100 parts of the finished granule.

- 4.3 The board sees no reason why, giving the terms of the claim their ordinary meaning, the "75 parts" of the finished granule as defined in claim 1 of the patent application inevitably or implicitly relate to 75 of 100 parts. Nor why "75 parts" cannot represent an absolute number of parts, or if a basis for a ratio existed in the patent application, why it could not refer to another proportion than 75 of 100 parts. *Inter alia*, the appellant referred to page 24 as a basis. The board notes that the patent application on page 24, beginning at line 14, describes a process for the manufacture of an enzyme containing mixer granule comprising steps a), b) and c). Step a) describes amounts (parts) of starting ingredients (i.e. a range of particulate component parts and enzyme parts) to be mixed in the process to form an enzyme containing granule, whereas claim 1 determines the particulate component parts with respect to the finished granule. For this reason alone, the generic process described on page 24 of the patent application cannot form a suitable basis for a granule comprising a cereal grain flour making up less than 75 of 100 parts of the finished granule as in claim 1. The remaining examples of the patent application comprised 15% wt, 30% wt, 45% wt, and 72% wt of wheat flour, which cannot be regarded as a direct and unambiguous disclosure of the process of claim 1 either, as all these examples relate first to the preparation of granulate and not to the preparation of enzyme-containing granulate and second, define the particulate component part in specific percentages by weight. Moreover, all the recited examples describe the use of wheat flour and not the

use of the more generic cereal grain flour of claim 1.

- 4.3.1 Thus, there is no direct and unambiguous disclosure in the patent application of a granule comprising cereal grain flour wherein said cereal grain flour constitutes less than "75 of 100 parts" of "the finished granule". The board concludes that the subject-matter of claim 1 contravenes Article 123(2) EPC.

Exercise of discretion not to admit claim requests by the opposition division

- 4.4 According to the established case law, if the way in which the opposition division has exercised its discretion when deciding on a procedural matter is challenged in an appeal, it is not the function of the board to review all the facts and circumstances of the case as if it were in the place of the opposition division, and to decide whether or not it would have exercised such discretion in the same way as the opposition division. The board will overrule the way in which the opposition division has exercised its discretion, only if the board concludes that it has done so according to the wrong principles or in an unreasonable way (cf. "Case Law of the Boards of Appeal of the EPO", 9th edition 2019, V.A.3.5, page 1198 et seq., and case law referred to therein).

Admission of auxiliary requests 2 to 6

5. The opposition division, after having heard the parties, decided that both, the reference to "75 of 100 parts" and the reference to "cereal grain flour consists of particles" in claim 1 of the main request and auxiliary request 1 contravened Article 123(2) EPC

(see item 15 of the minutes of the oral proceedings). These features were also found unamended in auxiliary requests 2 to 6, so that the opposition division did not regard the proposed amendments as a serious attempt to overcome opponent's objection under Article 123(2) EPC and exercised its discretion not to admit them into the proceedings. The legal reason for not admitting auxiliary requests 2 to 6 given in the decision under appeal is that they contravened Rule 80 EPC as they did not comply with the requirements of Article 123(2) EPC (cf. point 5.3 of the decision under appeal).

6. Appellant contended that this decision was incorrect as the requests were all filed before the final date for making written submissions in preparation of the oral proceedings that was set under Rule 116 EPC by the opposition division.
7. Rule 80 EPC allows amendments of the claims provided such amendments are occasioned by a ground of opposition.
8. Auxiliary requests 2 to 6 were filed in response to the opposition division's notification and within the terms of Rule 116(2) EPC to further distinguish the subject-matter of claim 1 from that of prior art documents D1, D5 and D6, recited to deprive the subject-matter of claim 1 of novelty and inventive activity (see proprietor's letter 11 December 2014). Thus, the proposed amendments were undoubtedly occasioned by a ground of opposition, Article 100(a) EPC, although they may not be suitable to overcome the objections raised under Article 100(c) EPC. Under these circumstances, as auxiliary requests 2 to 6 were filed before the final date set under Rule 116(1) EPC, the opposition division had no discretion not to admit them under Rule 80 EPC.

- 8.1 Since auxiliary requests 2 to 6 were not admitted into the opposition proceedings based on an incorrect formal provision, the board sets the decision of the opposition division in this respect aside and admits them into the proceedings.

Auxiliary requests 2 to 6

Article 123(2) EPC

9. For the same reasons as developed in point 4 above, the added matter objection raised under Article 123(2) EPC against the feature "75 of 100 parts" of the finished granule, as defined in claim 1 of auxiliary request 1, still applies. Hence the board concludes that the subject-matter of claim 1 of auxiliary requests 2 to 6 does contravene Article 123(2) EPC.

Admission of auxiliary requests 7 to 8

10. In the decision under appeal, the opposition division decided not to admit auxiliary request 7 into the proceedings under Rule 116 EPC because one of the proposed amendments addressed an issue already mentioned in the statement of grounds of appeal (cf. last paragraph of point 6.3 of the decision).

Additionally, it decided that the replacement of the feature "75 of 100 parts" by "75% by weight" "is not admissible under Rule 80 EPC" because said replacement "does prima facie not overcome the objection under Article 123(2) EPC" (cf. point 6.4 of the decision).

11. For the same reasons, the opposition division decided not to admit auxiliary request 8 (cf. point 7 of the decision).

12. The appellant argued that auxiliary requests 7 and 8 did not contravene Article 123(2) and (3) EPC, and accordingly should have been admitted into the proceedings.

13. As stated above, the way in which a department of first instance has exercised its discretion when deciding on a particular case should only be overruled if the board concludes that it has done so according to the wrong principles, or in an unreasonable way, and has thus exceeded the proper limits of its discretion.
 - 13.1 For their non-admission of auxiliary requests 7 and 8, the opposition division stated first that the amendments proposed for the first time on the day of the oral proceedings, concerning the type of flour used ("the cereal grain flour is refined flour" (auxiliary request 7); "the cereal grain flour is particulate pre-gelatinized wheat flour" (auxiliary request 8)), addressed an issue already mentioned in the statement of grounds of opposition. Moreover, the proposed amendments were based on features only mentioned in the description, thus taking the opponent by surprise (cf. last two paragraphs of point 6.3 of the decision).

 - 13.2 It is evident from the minutes of the oral proceedings that the parties were heard on the issue of admission of auxiliary requests 7 and 8.
In the board's view, concerning the first reason, the opposition division based its decision on the right principles and acted in a reasonable way. The board has therefore no reason to overrule the opposition division's decision not to admit auxiliary requests 7 and 8 for this reason alone. The fact that the opposition division may not have based its decision concerning the second reason

on the right legal principles (cf. point 8 above) cannot alter this conclusion, as one legally correct reason for not admitting a request is enough.

14. Thus, auxiliary requests 7 and 8 are not admitted into the proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed

The Registrar:

The Chairman:



L. Malécot-Grob

B. Stolz

Decision electronically authenticated