

**Internal distribution code:**

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

**Datasheet for the decision  
of 5 March 2020**

**Case Number:** T 0280/17 - 3.3.07

**Application Number:** 04721495.2

**Publication Number:** 1605917

**IPC:** A61K9/16

**Language of the proceedings:** EN

**Title of invention:**

PROCESS FOR THE PRODUCTION OF CROSS-LINKED GELATIN  
MICROBEADLETS

**Patent Proprietor:**

DSM IP Assets B.V.

**Opponent:**

BASF SE

**Headword:**

PROCESS FOR THE PRODUCTION OF CROSS-LINKED GELATIN  
MICROBEADLETS/BASF SE

**Relevant legal provisions:**

EPC Art. 108  
EPC R. 99(2)  
RPBA Art. 12(4)

**Keyword:**

Appeal admissible - Yes

Amended main request admissible - No

**Decisions cited:**

T 1193/15, T 0162/97, T 2001/14, G 0009/91

**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 0280/17 - 3.3.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.07**  
**of 5 March 2020**

**Appellant:** DSM IP Assets B.V.  
(Patent Proprietor) Het Overloon 1  
6411 TE Heerlen (NL)

**Representative:** Schwander, Kuno  
DSM Nutritional Products Ltd.,  
Wurmisweg 576  
4303 Kaiseraugst (CH)

**Respondent:** BASF SE  
(Opponent) 67056 Ludwigshafen (DE)

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted on 1 December 2016  
revoking European patent No. 1605917 pursuant to  
Article 101(3) (b) EPC.

**Composition of the Board:**

**Chairman** A. Uselli  
**Members:** D. Boulois  
Y. Podbielski

## Summary of Facts and Submissions

- I. European Patent 1 605 917 had been opposed under Article 100 (a) EPC on the grounds that its subject-matter lacked novelty and inventive step.
- II. The appeal lies from the decision of the opposition division to revoke the patent. The decision was based on the claims as granted.

Independent claim 1 as granted read as follows:

"1. A process for the production of cross-linked beadlets having a core and a surface region, wherein the core region contains, in a high concentration, one or more active ingredients selected from the group of a fat-soluble vitamin active material, a carotenoid and a polyunsaturated fatty acid, and the surface region contains less than 10 % of the total active ingredient content, which process comprises the steps of:

- a. forming an aqueous emulsion containing the active ingredients, an emulsifier selected from the group consisting of gelatine and ascorbyl palmitate, a texturing agent and a reducing sugar selected from the group consisting of fructose, glucose, lactose, maltose, xylose, arabinose, ribose, sucrose or a mixture of two or more sugars,
- b. converting the emulsion to a dry particulate form by coating the emulsion droplets with a finely dispersed powder selected from the group consisting of polysaccharides such as starch and modified starch, calcium silicate or of a mixture of calcium silicate with one of the following mixture components: microcrystalline cellulose, magnesium silicate, magnesium oxide, stearic acid, calcium stearate, magnesium stearate, hydrophilic silicic

acid and kaolin, and optionally drying the coating,  
and

c. heat treating said dry particulate form at a  
temperature in the range of from 90°C to 140°C for  
a time period of from 30 seconds to 30 minutes or  
from 1 minute to 10 minutes or from 3 minutes to  
7."

III. The documents cited during the opposition proceedings  
included the following:

D1: EP 0 285 682

IV. According to the decision under appeal, D1 was novelty  
destroying for claims 1-4 and 6 as granted. The  
opposition division also mentioned in its decision that  
the patent proprietor had not responded to the notice  
of opposition, that therefore no summons to oral  
proceedings had been issued and that a decision to  
revoke the patent was taken directly.

V. The patent proprietor (herein after the appellant)  
filed an appeal against said decision. With the  
statement setting out the grounds of appeal dated 3  
April 2017, the appellant submitted a new main request  
which was its only claim request.

In comparison to claim 1 as granted, claim 1 of the  
amended main request has been further restricted by  
steps d) and e) as follows:

"d) the beadlet is added in a hot air or nitrogen  
stream having a temperature between 100 and 200°C and  
wherein

e) the concentration of the active ingredient is  
selected from a total concentration in the range of  
from 800,000 IU vitamin A/g beadlet to 1,500,000 IU  
vitamin A/g beadlet, in the range of from 100,000 IU

vitamin D/g beadlet to 500,000 IU vitamin D/g beadlet, in the range of from 50% to 75% vitamin E, in the range of from 5% to 20% of carotenoid and in the range of from 5% to 50% polyunsaturated fatty acid, wherein the surface region contains less than 10% or less than 5% of the total active ingredient content."

- VI. With letter dated 10 August 2017, the opponent (hereinafter the respondent) requested that the appeal be considered as not admissible, or, as an auxiliary measure, that the main request be not admitted under Article 12(4) RPBA 2007 and the appeal be dismissed.
- VII. A communication of the Board dated 27 September 2019 was sent to the parties. The board stated in particular that the appeal appeared to be admissible. When considering the Board's discretion not to admit requests filed with the grounds of appeal, the Board expressed its preliminary view that the main request could have been filed during the opposition proceedings.
- VIII. The parties did not file any substantive submissions in reaction to the Board's communication.
- IX. Oral proceedings took place on 5 March 2020 in the absence of the parties which had informed the Board beforehand of their intention not to participate.
- X. The arguments of the appellant may be summarized as follows:

The process claim comprised now the features of claim 5 of the patent as granted and claim 10 of the original application. The new claim 1 was novel in view of the cited prior art, as it now clearly defined the heating

step and a beadlet form with a high concentration of vitamin A.

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

The appeal was not admissible, since the patentee had not reacted during the opposition proceedings and had not submitted any request. The patentee was thus not adversely affected by the decision and the appeal was inadmissible.

The new main request filed in appeal proceedings should not be admitted under Article 12(4) RPBA, since it could have been filed during the opposition proceedings, in response to the notice of opposition, but also thereafter.

XII. Requests

The appellant (patent proprietor) requests that the decision under appeal be set aside and the patent be maintained according to the set of claims filed with letter of 3 April 2017.

The respondent (opponent) requests that the appeal be held inadmissible, or alternatively that the request on file be not admitted into the proceedings and the appeal be dismissed.

## Reasons for the Decision

### 1. Admissibility of the appeal

—

1.1 The Board considers that the appeal is admissible for the reasons set out below.

1.2 In the present case, the admissibility of the appeal depends on the conformity of the statement of grounds of appeal with Article 108, third sentence, EPC, taken together with Rule 99(2) EPC. According to these provisions, in the statement of grounds of appeal, the appellant shall indicate "the reasons for setting aside the decision impugned, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based".

Hence, the question of whether the conditions of Article 108, third sentence, EPC and of Rule 99(2) EPC are met must be decided on the basis of the statement setting out the grounds of appeal and the grounds for the contested decision, taking account of the changes made to the claims (see Case Law of the Boards of Appeal of the European Patent Office, 8th edition, IV.E.2.6.3a) with reference, inter alia, to decisions T 162/97 and T 2001/14).

1.3 In its decision the opposition division concluded that the disclosure of D1 anticipated the subject-matter of claims 1-4 and 6 of the opposed patent. This document formed the basis and the essential element of the opposition division's decision.



In its statement of grounds appeal, the appellant discussed the content of document D1 and argued that D1 was not relevant to novelty. The changes to the claims of the main requests, i.e. the incorporation of the features of dependent claim 5 into independent claim 1, were also intended to establish novelty with respect to D1, thus rendering the grounds for the decision irrelevant.

There is therefore a direct link between the decision and the statement setting out the grounds of appeal.

The appellant thus explained how it had remedied the reasons for the refusal of the opposition division's decision. In these circumstances, the Board considers that the conditions of Article 108, third sentence, and of Rule 99(2) EPC have been met.

2. Admission of the main request into the proceedings

2.1 The new main request on file differs from the claims as granted, .i.e. the former main request and sole request in the opposition proceedings, in that the features of dependent claim 5 as granted and of claim 10 as originally filed have been incorporated into claim 1. Moreover, a new claim 2 has been incorporated originating from the description of the original application.

2.2 Pursuant to Article 12(4) RPBA 2007, which applies to the present case (Article 25(2) RPBA 2020, OJ 2019, A63), the Board has discretion to hold inadmissible requests which could have been presented in the proceedings before the department of first instance. The Boards have interpreted this provision to mean that request are to be held inadmissible if they could

and should have been presented during the first instance proceedings.

2.3 The decision of the opposition division follows the arguments that the opponent had set out in the notice of opposition; said notice of opposition was not followed by any reaction of the patent-proprietor. There was thus nothing surprising in the decision under appeal.

2.4 It is clear that the appellant-proprietor could have filed the amended claim request that was submitted with the grounds of appeal already after having received the notice of opposition.

Moreover, the appellant-proprietor also should have filed this request during the proceedings before the opposition division. The main purpose of the opposition appeal proceedings is to give the losing party a possibility to challenge the decision of the opposition division on its merits (G 9/91, OJ 1993, 408, Reasons 18). It is not compatible with the purpose of the appeal proceedings that parties choose to present their case before the Board of appeal only, thereby forcing the Board either to rule on the matter for the first time or to remit the case for further prosecution. In addition, such behaviour would be the disadvantage of the opposing parties (see also T 1193/15 point 2.3 of the reasons).

2.5 Consequently, the main request is not admitted into the proceedings (Article 12(4) RPBA 2007)

## **Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:



B. Atienza Vivancos

A. Usuelli

Decision electronically authenticated