

Internal distribution code:

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

**Datasheet for the decision
of 8 August 2019**

Case Number: T 0378/17 - 3.3.09

Application Number: 10075150.2

Publication Number: 2210499

IPC: A23G1/18, A23G1/00

Language of the proceedings: EN

Title of invention:

Apparatus for continuous tempering of chocolate mass

Patent Proprietor:

Aasted ApS

Opponents:

Sollich KG

Bühler AG

Headword:

Relevant legal provisions:

EPC Art. 123(2)

EPC R. 43(7)

RPBA Art. 12(4), 13(1)

Keyword:

Main request and auxiliary request 7 - admission into the
appeal proceedings (no)

Auxiliary requests 1 to 6 - added matter (yes)

Decisions cited:

T 0052/15, T 0390/07, T 0361/08, T 0922/08, T 1525/10,
T 0140/12, T 1697/12, T 0143/14, T 2748/17

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 0378/17 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 8 August 2019

Appellant: Aasted ApS
(Patent Proprietor) Bygmarken 7-17
3520 Farum (DK)

Representative: Heiden, Finn
Heiden ApS
Sønderengen 12
2870 Dyssegård (DK)

Respondent: Sollich KG
(Opponent 1) Siemensstrasse 17 - 23
32105 Bad Salzuflen (DE)

Representative: REHBERG HÜPPE + PARTNER
Patentanwälte PartG mbB
Robert-Gernhardt-Platz 1
37073 Göttingen (DE)

Respondent: Bühler AG
(Opponent 2) Gupfenstrasse 5
9240 Uzwil (CH)

Representative: Hepp Wenger Ryffel AG
Friedtalweg 5
9500 Wil (CH)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 13 December
2016 revoking European patent No. 2210499
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman W. Sieber
Members: A. Veronese
 F. Blumer

Summary of Facts and Submissions

- I. The appeal was filed by the patent proprietor against the decision of the opposition division to revoke European patent No. 2 210 449.
- II. In their notices of opposition the two opponents had requested the revocation of the patent in its entirety on the grounds of Article 100(a) (lack of novelty and lack of inventive step), 100(b) and 100(c) EPC.
- III. In its decision the opposition division found that the main request and auxiliary requests 1 to 3 contained subject-matter extending beyond the content of the application as filed.
- IV. The decision was appealed by the proprietor (appellant). In the statement setting out the grounds of appeal, filed by letter dated 5 April 2017, the appellant requested that the decision be set aside and that the oppositions be rejected (main request), or alternatively that the patent be maintained on the basis of one of auxiliary requests 1 to 6 enclosed with that letter. Further requests were filed by a letter dated 5 February 2019 (main request-bis and auxiliary requests 1-bis to 6-bis), and by a letter dated 20 June 2019 (new main request, replacing the previous main request).
- V. In their replies to the statement setting out the grounds of appeal the opponents (respondent 1 and respondent 2) requested that the appeal be dismissed and that the main request and auxiliary requests 1 and 2 and 4 to 6 not be admitted into the appeal proceedings.

- VI. In a communication issued in preparation for the oral proceedings the board drew the parties' attention to the points to be discussed.
- VII. On 8 August 2019 oral proceedings took place before the board. During the oral proceedings the appellant withdrew the main request-bis and auxiliary requests 1-bis to 6-bis and filed auxiliary request 7. It requested that the decision under appeal be set aside and that the patent be maintained on the basis of:
- the main request, filed by letter of 20 June 2019, or alternatively
 - one of auxiliary requests 1 to 6, filed by letter dated 5 April 2017, or alternatively
 - auxiliary request 7, filed during the oral proceedings before the board.

The respondents requested that the appeal be dismissed and that the main request and auxiliary requests 1 and 7 not be admitted into the appeal proceedings. However, they withdrew their request that auxiliary requests 2 and 4 to 6 not be admitted.

At the end of the oral proceedings the chairman announced the decision.

- VIII. Claim 1 of the **main request** reads (amendments over claim 1 as granted indicated by strike-through or underlined text):

"1. Apparatus (1, 36, 46, 51, 56, ~~60, 66, 72, 74~~) for continuous tempering of chocolate mass comprising a cooling stage (A), a crystallisation stage (B) and a mixing stage (C) arranged as a tempering column (2) as well as pump means (5) for the chocolate mass, characterised in, that a primary conduit (8, 9, 43, 49, 53, 58, ~~62, 70, 76~~) for chocolate mass flowing from the cooling stage (A) to the mixing stage (C) is arranged by-passing the stage (B) for creating crystals so that an amount of mass is by-passed outside the exchanger without being crystallised."

Claim 1 of **auxiliary request 1** reads:

"1. Apparatus (1, 36, 46, 51, 56) for continuous tempering of chocolate mass comprising a cooling stage (A), a crystallisation stage (B) and a mixing stage (C) arranged as a tempering column (2) having disc-shaped chocolate chambers interconnected via chocolate channels and intermediary disc-shaped water chambers as well as a central shaft connected with stirring tools arranged in the chocolate chambers, as well as pump means (5) for the chocolate mass as an external pump provides a pressure for the flow of chocolate through the chambers of the apparatus, characterised in, that a primary conduit (8, 9, 43, 49, 53, 58) for chocolate mass flowing from stage (A) to stage (C) is arranged by-passing the stage (B) for creating crystals so that an amount of mass is by-passed outside the exchanger without being crystallised.

The underlined text contains an expression disclosed on page 5 of the description of the application as filed. This same feature is also found in claim 1 of each of **auxiliary requests 2 to 6**.

Claim 1 of **auxiliary request 7** differs from claim 1 of auxiliary request 1 in that the expression:

"...while the remaining mass is flowing through the crystallisation stage and thereafter the two streams are mixed in the mixing stage."

was added at the end of the claim.

IX. The appellant's arguments, where relevant to the decision, may be summarised as follows.

The main request was to be admitted into the appeal proceedings. Although this request corresponded essentially to the granted claims, which were not maintained during the opposition proceedings, the then patent proprietor had not surrendered the granted subject-matter. Thus, the appellant had to be allowed to reinstate that subject-matter during the appeal proceedings.

Auxiliary request 1 was to be admitted because it was filed at the earliest possible stage in the appeal proceedings, namely together with the statement of grounds of appeal, and addressed the objections which had led to the revocation of the opposed patent.

Auxiliary request 1 did not contain added subject-matter extending beyond the content of the application as filed. The amendment requiring that an amount of the chocolate mass was bypassed outside the exchanger without being crystallised was directly and unambiguously disclosed in the passage on page 5 lines 15-18 of the application as filed. Omitting the following statement of this passage, which required the remaining stream to flow through the crystallisation

stage and that thereafter the two masses were brought together and mixed, did not create new subject-matter, because these requirements were implicit for the skilled person reading the claim and taking into account how the invention was carried out.

Auxiliary request 7 was filed during the oral proceedings before the board to address the negative finding of the board that auxiliary requests 1 to 6 contained added subject-matter. This finding was rather unexpected and could not have been foreseen by the appellant. Therefore, there were good reasons for the appellant to file this request during the oral proceedings and for the board to admit it.

- X. The respondents' arguments, where relevant to the decision, may be summarised as follows.

During the opposition proceedings the then patent proprietor had deliberately replaced its original request based on the granted claims with claims of more limited scope. By doing so it had prevented the opposition division from deciding on critical points raised by the opponents. For this reason the main request, which corresponded essentially to the granted claims, was not to be admitted into the appeal proceedings.

Auxiliary request 1 was also not to be admitted, because it could have been filed during the opposition proceedings. Furthermore, this request contained added subject-matter extending beyond the content of the application as filed. The requirement that an amount of the chocolate mass was bypassed outside the exchanger was mentioned on page 5 lines 15-18 of the application. However, this passage also required the remaining

stream of chocolate to flow through the crystallisation stage and the two masses to be then brought together and mixed. Omitting these requirements created a new teaching extending beyond the content of the application as filed. The same arguments applied to auxiliary requests 2 to 6.

Auxiliary request 7 was filed at an extremely late stage of the appeal proceedings to address an objection which had already been set out in writing by respondent 1. The appellant had waited for the board's finding on the issue before actually reacting to the objection. This was not appropriate conduct. Thus, this request was not to be admitted into the appeal proceedings.

Reasons for the Decision

Main request

1. *Admission*
- 1.1 Claim 1 of the main request differs from the granted claim 1 in that the words "cooling" and "mixing" were added to the characterising part of the claim when referring to the stages (A) and (C) of the apparatus, and in that some reference signs were deleted.
- 1.2 These amendments are not associated with any change in the scope of the claims. The preamble of the granted claim 1 identifies stage (A) as the cooling stage and stage (C) as the mixing stage. It is immediately clear to the skilled person that the stages (A) and (C) mentioned in the characterising part of the granted claim are those same cooling and mixing stages. The

board admits that the symbols (A) and (C) could be viewed as reference signs within the meaning of Rule 43(7) EPC, as argued by the respondents. Corresponding letters are indeed present in figures 1 and 2 and 5 to 13. However, within claim 1 these symbols do also unambiguously identify the stages of the apparatus. This cannot be ignored when reading and interpreting this claim. Any other interpretation of claim 1 would not make technical sense. Thus, the addition of the wording "cooling" and "mixing" to the characterising part of claim 1 of the main request does not change the scope of claim 1.

- 1.3 The deletion of some reference signs from the granted claim 1 also does not change the scope of the claimed subject-matter. Furthermore, the deleted signs concern embodiments of the invention represented in figures 10 to 13, which are not covered by this claim (the primary conduit not passing outside the exchanger).
- 1.4 For these reasons it can be concluded that the subject-matter of claim 1 of the main request corresponds essentially to that of granted claim 1.
- 1.5 The granted claims coincide with those of the initial main request of the then patent proprietor in the opposition proceedings. In the communication issued in preparation for the oral proceedings before the opposition division, the preliminary opinion was expressed that those granted claims lacked novelty over D16, D20 and possibly D17, and that these issues needed to be discussed during the hearing. In reply to this opinion the patent proprietor filed claims of more limited scope.

1.6 The appellant stated that with this replacement the then patent proprietor intended to address the objections raised by the opposition division in its preliminary opinion and to streamline the opposition proceedings. The then patent proprietor had however not surrendered the subject-matter defined in the granted claims. Thus, this subject-matter could be reinstated during the appeal proceedings. In this context, referring to the Case Law of the Boards of Appeal, 8th edition, IV.E.3.2f, the appellant argued that in appeal proceedings proprietors always have the right to reinstate their patent as granted.

1.7 The board does not agree. Under Article 12(4) RPBA a board of appeal has the discretionary power to refuse to admit requests filed with the grounds of appeal which could have been presented or were not admitted in proceedings before the department of first instance. In the board's view, this applies particularly to a request that was filed during proceedings before the department of first instance and subsequently withdrawn. Withdrawing the request in opposition proceedings the patent proprietor prevented the opposition division from providing an appealable decision on the subject-matter defined in the granted claims. The reintroduction of the previously withdrawn request on appeal runs counter to the main purpose of inter partes appeal proceedings, namely to give the losing party the possibility of challenging the decision of the opposition division on its merits. Although Article 12(4) RPBA applies to requests filed with the grounds of appeal, under Article 13(1) RPBA the board's discretion extends to requests which, like the present one, were filed at a later stage of the appeal proceedings.

- 1.8 Even if, in principle, a proprietor could not be prevented from reverting to the patent as granted, it would be illogical if this right could be exploited without restrictions. For example, a proprietor may not steer the appeal proceedings in a manner which undermines the main purpose for which the proceedings were intended, i.e. to give a judicial review on what was decided at first instance. This would also result in the board being precluded from exercising its discretionary power under Articles 12(4) and 13(1) RPBA in these cases.
- 1.9 Although there have been decisions where the boards have allowed patent proprietors to reinstate broader requests which had been withdrawn or were not maintained during the opposition proceedings, numerous decision have also been issued in which the board's discretion has been applied in a strict manner and such requests have not been admitted into the appeal proceedings (see the Case Law of the Boards of Appeal, 8th edition, IV.E.4.3.2d and IV.E.4.5.1; T 52/15, T 390/07, T 361/08, T 922/08, T 1525/10, T 140/12, T 1697/12, T 143/14). This appears to be the current predominant approach applied by the boards.
- 1.10 The present board endorses the principle that the admission of any such request is under the board's discretion, taking into account *inter alia* whether the undecided issues are critical for the board's decision, their complexity and possibly also the reasons for not maintaining that request before the first instance.
- 1.11 In the present case considering that:

- the undecided technical issues are complex and also critical for a decision to be taken by the board (e.g. with regard to Article 54(2) EPC),
- these issues could not be decided upon by the opposition division as a consequence of procedural steps chosen by the proprietor during the opposition proceedings,
- there are no special reasons for admission into the appeal proceedings,

the main request is not admitted into the appeal proceedings (Article 13(1) RPBA).

Auxiliary request 1

2. Admission

2.1 Auxiliary request 1 was filed for the first time with the statement of grounds of appeal. It differs however significantly, and is substantially more limited in scope with respect to the granted claims. Furthermore, claim 1 specifies that the apparatus contains chambers which are "disc-shaped". This characterisation addresses the opposition division's objection in the appealed decision that the failure to indicate the shape of the chambers added subject-matter that extended beyond the application as filed.

2.2 Considering that auxiliary 1 was filed at the earliest stage in the appeal proceedings, is significantly more limited in scope compared to the granted claims and addresses the grounds of revocation, this request is admitted into the appeal proceedings.

3. *Added subject matter*

3.1 Claim 1 of auxiliary requests 1 requires that:

"...a primary conduit (8, 9, 43, 49, 53, 58) for chocolate mass flowing from stage (A) to stage (C), is arranged by-passing the stage (B) for creating crystals so that an amount of mass is by-passed outside the exchanger without being crystallised"

3.2 This feature was not present in claim 1 of the patent application as filed. As the basis for this amendment, the appellant referred to the passage on page 5, lines 15-18 of the application as filed. However, this passage also requires that:

"...the remaining stream of the mass is flowing through the crystallisation stage for creating crystals in the mass". The passage continues: *"Thereafter the two streams of mass are brought together and mixed in the mixing stage".*

3.3 These two requirements exclude the presence of any other conduit, beyond the primary one, transporting chocolate outside the exchanger defined on page 5. These requirements are however not present in claim 1 of auxiliary request 1. The board does not follow the appellant's argument that the skilled reader would necessarily rule out the presence of any other such conduit in the claimed apparatus.

3.4 As submitted by opponent 1, a further conduit transporting chocolate outside the crystallisation stage could indeed be present in the system to direct a part of the chocolate mass to another stage of the apparatus or to a different manufacturing step or

process. These alternative embodiments are technically feasible and are not excluded by claim 1. They are however excluded by the passage on page 5 lines 15-18 of the application as filed which was relied upon by the appellant for amending claim 1.

- 3.5 For these reasons, the amendment introduced in claim 1 of auxiliary request 1 introduces new subject-matter which is not disclosed in the application as filed (Article 123(2) EPC).

Auxiliary requests 2 to 6

4. Added subject-matter

- 4.1 Claim 1 of auxiliary requests 2 to 6 include the same amendment mentioned above (points 3.1 and 3.2), which characterises claim 1 of auxiliary request 1.
- 4.2 Accordingly, the reasons for the finding that auxiliary request 1 adds subject-matter extending beyond the content of the application as filed apply equally to auxiliary requests 2 to 6 (Article 123(2) EPC).

Auxiliary request 7

5. Admissibility

- 5.1 Claim 1 of auxiliary request 7 was amended adding the expression

"...while the remaining mass is flowing through the crystallisation stage and thereafter the two masses are mixed in the mixing stage."

at the end of claim 1 of auxiliary request 1.

- 5.2 This amendment was made during the oral proceedings before the board to overcome the negative finding of the board that auxiliary requests 1 to 6 contained added subject-matter. According to the appellant the reason for filing this request during the hearing was that the board's finding was unexpected and could not be foreseen.
- 5.3 The board does not consider this an acceptable justification for such late filing. The objection leading to this finding was not a new one. In its letter dated 15 June 2017, on page 7, opponent 1 had already argued that the failure to include the aforementioned expression into a claim requiring a part of the chocolate to bypass the crystallisation stage added new originally undisclosed subject-matter.
- 5.4 Furthermore, in its communication in preparation for the oral proceedings, the board had explicitly indicated that the basis for the feature requiring the presence of a conduit allowing chocolate to bypass the exchanger needed to be discussed. Despite this, the appellant did not file in due time any set of claims addressing this point and waited until the oral proceedings to do so.
- 5.5 The board considers it inappropriate conduct for a party to wait until the last minute of the oral proceedings to file a request addressing a point already raised during the written proceedings. Therefore, taking into account the stage of the appeal proceedings and the need for procedural economy, the board decided not to admit auxiliary request 7 into the appeal proceedings (Article 13(1) RPBA and decision T 2748/17).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



B. Atienza Vivancos

W. Sieber

Decision electronically authenticated