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**Datasheet for the decision
of 5 November 2018**

Case Number: T 0888/17 - 3.3.07

Application Number: 04770702.1

Publication Number: 1713448

IPC: A23L33/10, A61K9/16, A61K9/50

Language of the proceedings: EN

Title of invention:
PROCESS FOR PREPARING BEADLETS OF LIPOPHILIC NUTRIENTS

Patent Proprietor:
OmniActive Health Technologies Pvt. Ltd

Opponent:
DSM Nutritional Products Ltd

Headword:
PROCESS FOR PREPARING BEADLETS OF LIPOPHILIC NUTRIENTS/
OmniActive Health Technologies Pvt. Ltd

Relevant legal provisions:
EPC R. 106
EPC Art. 84

Keyword:

Request for correction of the minutes (No)
Objection under Rule 106 EPC
Adaptation of the description (Yes)

Decisions cited:

T 2614/11

Catchword:



Beschwerdekammern
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Case Number: T 0888/17 - 3.3.07

D E C I S I O N
of Technical Board of Appeal 3.3.07
of 5 November 2018

Appellant: DSM Nutritional Products Ltd
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
2 February 2017 concerning maintenance of the
European Patent No. 1713448 in amended form.**

Composition of the Board:

Chairman J. Riolo
Members: D. Boulois
 Y. Podbielski

Summary of Facts and Submissions

- I. European patent No. 1 713 448 was granted on the basis of a set of 47 claims.
- II. The patent was opposed under Article 100 (a), (b), (c) EPC on the grounds that its subject-matter lacked novelty and inventive step, was not sufficiently disclosed and extended beyond the content of the application as filed.
- III. By the decision T 2614/11, the case was remitted to the department of first instance with the order to maintain the patent on the basis of the third auxiliary request as submitted with the letter of 9 October 2014 and a description to be adapted thereto.

Independent claim 1 of auxiliary request 3 read as follows:

"1. A process for the preparation of beadlets of lipophilic nutrients comprising:
(i) forming a colloidal suspension of lipophilic nutrient by dissolving the lipophilic nutrient in a non-polar solvent and diluting the resulting solution with a polar solvent;
(ii) spraying the resulting colloidal suspension onto an inert core in a fluid-bed system provided with a bottom-spray mechanism at a temperature in the range of ambient temperature to 45 degree C, at an atomisation pressure in the range of about 0.1 kg/cm² to about 3 kg/cm² and a spray rate in the range of about 10 g/hour to about 600g/hour; and
(iii) drying the resulting beadlets in the fluid-bed system at an atomisation pressure of about 0.8 kg/cm² to about 1.2 kg/cm²."

- IV. The appeal by the opponent lies from the decision of the opposition division that the adapted description met the requirements of Article 84 EPC and that the amended patent on the basis of auxiliary request 3 met the requirements of the EPC. The decision was based on the claims of auxiliary request 3 filed with letter dated 9 October 2014, and the description pages 2, 3, 6-12 filed with letter dated 15 June 2016 and pages 4, 5 filed with letter dated 21 November 2016.
- V. According to the decision under appeal, references to features of the beadlets in the description were justified and could in no way mislead the reader into thinking that the beadlets per se were an aspect of the invention. Indeed, paragraph [0029] stated that "the novel beadlets obtained by the invention process are not part of the invention". According to the opposition division, the reference to "novel beadlets" in the description was also justified and did not contravene Article 84 EPC. The adapted description met therefore the requirements of Article 84 EPC.
- VI. The opponent (hereinafter the appellant) filed an appeal against said decision.
- VII. With letter dated 4 October 2017, the proprietor (hereinafter the respondent) contested the admissibility of the appeal.
- VIII. The Board sent a communication dated 23 April 2018. In its communication the Board stated in particular that the term "novel" which is present in the description in relationship with the claimed process and the beadlet obtainable by said process infringed Article 84 EPC. An objection under Article 84 EPC as regards all other

points mentioned by the appellant appeared unjustified to the Board.

- IX. In response to the Board's communication, the respondent filed amended pages 2, 4, 5, 6 and 7 of the description with letter dated 17 May 2018.
- X. Oral proceedings took place on 28 June 2018 in the absence of the respondent. During said oral proceedings, the appellant pointed out that in paragraph [0001] of page 2 of the description, there was still a reference to the term "novel beadlets", which had been objected to under Article 84 EPC by the Board. During said oral proceedings, the appellant also raised for the first time the objection that example 4 of the description did not fall under the scope of the claims. After deliberation by the Board, the Chairman announced that the Board was not in a position to render a decision on the day of oral proceedings and that the Board had decided to continue the proceedings in writing.
- XI. A second communication dated 17 July 2018 was sent by the Board. In this communication, the Board requested the respondent to clarify whether it wanted to maintain the term "novel beadlets" in said paragraph [0001], line 4. The Board also stated that in its preliminary view the objection of the appellant as regards example 4 of the contested patent was unfounded, and that the presence of the word "coating" in the description of the patent did not infringe Article 84 EPC.
- XII. With letter dated 14 August 2018, the respondent filed an amended page 2 of the description, where the term "novel" was deleted from paragraph [0001], line 4. It also clarified that this deletion had been

inadvertently omitted in the previously filed amended version of the description.

- XIII. By letter dated 3 September 2018, the appellant requested correction of the minutes of the oral proceedings of 28 June 2018. By the same letter it raised an objection under Rule 106 EPC.
- XIV. In its communication dated 28 September 2018, the Board gave its preliminary opinion on the request for correction of the minutes. It also gave reasons as to why it considered the objection under Rule 106 EPC to be without merit.
- XV. A second oral proceedings took place on 5 November 2018 in the absence of the respondent.
- XVI. The arguments of the appellant may be summarised as follows:

Adaptation of the description

The adaptation of the description did not correspond to the subject-matter of the claims of auxiliary requests 3 as maintained by decision T 2614/11.

The claims as maintained related to a process, while the description of the specification still mentioned the beadlets. The aspects referring to the beadlets as such or to certain details of said beadlets should have been suppressed from the description, since the claims as maintained relate only to a process of preparation of said beadlets. The process as claimed could in particular not provide all aspects of the beadlets described in the specification.

Moreover, the term "novel beadlets" present in the description was not acceptable.

The term "coating", present in paragraphs [0020] to [0024] of the specification was also not a feature of claim 1 of the patent as maintained. The process as claimed did not result in a coating around the beadlets.

Example 4 mentioned a drying atomization pressure of 2 kg/cm² which was outside of the claimed subject-matter. Example 4 did therefore not fall under the scope of the claims. As discussed during oral proceedings, if said step involving an atomization pressure of 2 kg/cm² was not considered as being the drying step, it would imply that of none of the examples of the specification fell under the scope of the claims.

Request for correction of the minutes

The respondent had requested a decision on the basis of the pages of the description filed with letter dated 17 May 2018, and also informed the Board that it would not be present at the oral proceedings planned for the 28 June 2018. The minutes of the oral proceedings of 28 June 2018 failed to mention this. They did not comply with the requirements of Rule 124(1) EPC, as they did not contain all the legally relevant declarations of the participants, in this case of the respondent. The appellant's request for a correction of the minutes of the oral proceedings of 28 June 2018 was therefore to be allowed.

Objection under Rule 106 EPC

The appellant made an objection under Rule 106 EPC. The decision of the Board to continue the proceedings in

writing, taken during oral proceedings of 28 June 2018, not only constituted a violation of the respondent's request to take a decision on the state of the file, it also led to an unjustified procedural advantage for the respondent.

The Board was in a position to take a decision during the oral proceedings on 28 June 2018. In its communication pursuant to Article 15(1) RPBA of 23 April 2018, the Board had referred to the possibility of revocation of the patent, since it had mentioned that the patent could be revoked if the description contained the term "novel" in relation to the claimed process and the beadlets obtainable by the process. Furthermore, in this communication the Board had also explicitly drawn attention to the paragraphs of the description which, in its view, required adaptation.

The patentee then submitted an amended description with its submissions of 17 May 2018. In this amended description, the term "novel" was removed in 12 places. However, paragraph [0001] on page 2, line 4, still mentioned the term "novel beadlets". The oral proceedings took place thereafter in the absence of the respondent, and the Board decided to continue the proceedings in writing without explanation.

The subsequent communication of the Board contained some indications as to why the Board did not take a decision on the case at the oral proceedings, i.e. that the appellant first stated at the hearing that paragraph [0001] on page 2 of the description still contained a "novel". However, the fact that the respondent was in principle already informed about this problem, had the opportunity to comment on it and also used it, could not put the Board or any of the parties

in doubt.

In the present case, the Board of Appeal ought to have decided to revoke the patent at the end of the oral proceedings for that reason alone. The fact that the oral proceedings were closed without taking a decision was therefore objected to under Rule 106 EPC.

In the case that the Board considered the arguments put forward against example 4 and the "coating" as late-filed submissions, it could have disregarded them. According to Article 114(2) EPC, the EPO did not need to take into account facts and evidence submitted late by the parties.

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

Adaptation of the description

As regards the aspects referring to the beadlets, it was not possible to dissociate the process as claimed from the final beadlets obtainable by the process and the beadlets features appeared necessary to the skilled person to repeat the invention.

As regards the aspects referring in the description to the coating of the beadlets, the presence of a coating appeared necessary, so that an objection under Article 84 EPC was unjustified.

All the terms "novel" had been deleted from the specification, on pages 2 and 4-7, thus meeting the requirements of the EPC. The deletion of the term "novel" in paragraph [0001] on line 4 of page 2 of the

description had been inadvertently omitted, and the further amended page 2 had the term deleted.

XVIII. Requests

The appellant requested that the decision under appeal be set aside and the patent be revoked. It furthermore requested that the minutes of the oral proceedings of 28 June 2018 be corrected.

The respondent requested in writing that the decision under appeal be set aside and a patent be maintained on the basis of the main request comprising page 2 of the description filed with letter dated 14 August 2018, pages 4, 5, 6 and 7 of the description filed with letter dated 17 May 2018, pages 3, 8 to 12 of the description filed with letter dated 15 June 2016, and claims 1 to 29 corresponding to the claims of auxiliary request 3 filed with letter dated 9 October 2014.

Reasons for the Decision

1. Admissibility of the appeal

The name and address of the appellant in the notice of appeal did initially not correspond to the indications on file. However, the correct name and address were provided within the time period for providing a response. The appeal is thus admissible.

2. Correction of the minutes

According to the minutes of the oral proceedings of 28 June 2018 the respondent requested in writing that the decision under appeal be set aside and the patent be maintained on the basis of the main request comprising

pages 2, 4, 5, 6, and 7 of the description filed with letter dated 17 May 2018, pages 3 and 8-12 of the description filed with letter dated 15 June 2016, and claims 1 to 29 corresponding to the claims of auxiliary request 3 filed with letter dated 9 October 2014.

The appellant requested a correction of the minutes to reflect the following two passages from the respondent's written submissions dated 17 May 2018:

(a) "Further...., Patentee is requesting cancellation of the Oral Proceedings and a **decision from the BOA based on the Patent as now amended**" [emphasis added by the appellant].

(b) "In case of maintenance of the Oral Proceedings, Patentee is informing the BoA that Patentee will not be present at the maintained Oral Proceedings."

The appellant argued that by requesting a decision whilst at the same time absenting itself from the oral proceedings, the respondent requested a decision from the Board, regardless of whether that decision was to maintain the patent "as now amended" or to revoke it. In other words, the appellant suggested that the respondent requested a decision on the state of the file, which was in essence a decision on the day of the oral proceedings on 28 June 2018.

In the Board's view, this interpretation is not compatible with the respondent's written submissions. In these submissions the respondent expressed its view that the Board's objections had been overcome by its amendments to the specification. This and the high costs involved in attending oral proceedings were given as reasons for requesting that the oral proceedings be cancelled and a decision be issued based on the patent as amended. In the Board's reading the respondent

requested that the patent be maintained "as now amended" - which is identical to the request referred to in the minutes as the respondent's request. The respondent did not request that the Board reach simply any decision on the day of the oral proceedings, i.e. that the patent be maintained "as now amended" or be revoked.

The minutes reflect the fact that no one was present at the oral proceedings on behalf of the respondent. No reference was made in the minutes to the respondent's "request for cancellation of oral proceedings" (which could only amount to a withdrawal of the respondent's request for oral proceedings) as it was, in so far as the minutes are concerned, procedurally not relevant in view of the appellant's request for oral proceedings.

For the reasons set out above, the Board sees no valid reason for correction of the minutes and refuses the request for correction.

3. Objection under Rule 106 EPC

The appellant raised an objection under Rule 106 EPC based on the fact that the Board decided at the end of the oral proceedings on 28 June 2018 that the proceedings be continued in writing. The appellant argued that by doing so the Board firstly disregarded the respondent's request for a decision on the state of the file, and secondly gave an unfair advantage to the respondent in that the latter had a further opportunity to amend the description. Whilst the Board has doubts as to whether these objections concern procedural defects on which a petition for review may be based, it nevertheless considers them.

For the reasons set out above in connection with the correction of the minutes, the Board does not consider that it disregarded a request from the respondent for a decision. The Board also sees no procedural violation or defect in continuing the proceedings in writing. There is no provision in the EPC pursuant to which the Board is under an obligation to render a decision at the end of the oral proceedings and it lies within the discretion of the Board to continue the proceedings in writing if the Board considers that the matter is not ripe for a decision.

In the present case the matter was not ripe for a decision for several reasons. The appellant presented for the first time during the oral proceedings before the Board the objection based on example 4 of the description. The Board considered the objection as one which might have led to the revocation of the patent. In the absence of any other clear reason for revocation (see paragraph 4.4.2 in this respect) the objection necessitated careful examination. The Board was not able to deal with it during the oral proceedings and considered it in its communication subsequent to the oral proceedings and in the course of the second oral proceedings.

In these circumstances the Board considered it appropriate to request further clarification from the respondent concerning the omitted deletion of the term "novel" in the description, because this omission, which had only been raised by the appellant during the oral proceedings, was in contradiction to the respondent's stated intention that the description had been amended "*wherein the term "novel" has been cancelled both for the method and the beadlets*" (respondent's letter dated 17 May 2018). The Board does

not consider that seeking such clarification amounted to an unfair advantage given to the respondent, especially as the most likely explanation for this contradiction was a clerical error on the part of the respondent.

With regard to the issue of the additional costs incurred through the second oral proceedings, the Board notes that if the second oral proceedings had been caused by the behaviour of one party only, then there might be a case for an apportionment of costs. In the present case, the facts suggest a more complicated situation and a request for apportionment of costs was in any event not made.

In view of these events, the Board does not see how any party was given an unfair advantage by the way it proceeded and dismisses the objection under Rule 106 EPC.

4. Adaptation of the description - Article 84 EPC

4.1 Several points as regards the adaptation of the description to the claims of auxiliary request 3 were objected to by the appellant:

- (a) the aspects referring to the beadlets as such or to certain details of said beadlets, while the claims as maintained relate to a process of preparation;
- (b) the aspects in the description referring to the coating of the beadlets which is absent from claim 1 as maintained;
- (c) the presence of the terms "novel beadlets" and "novel process" in the description;
- (d) the presence of a drying step in example 4 which fell outside the scope of claim 1 as maintained.

4.2 Aspects referring to the beadlets

4.2.1 The subject-matter of claim 1 of auxiliary request 3 relates to the preparation of beadlets of lipophilic nutrients. The persistence of beadlet-related features in the description was objected to by the appellant.

4.2.2 The description mentions explicitly in paragraph [0029] that the beadlets obtained by the invention process are not part of the invention. Said passage excludes clearly the beadlets as such from the coverage and scope of protection of the claims, and there is no passage in the description that contradicts this statement.

Moreover, it is not possible to dissociate the process as claimed from the final beadlets obtainable by said process. The presence in the description of features relating to the beadlets obtainable by the claimed process is necessary and must be considered to be useful for highlighting the specific aspects of the claimed process; said features are not seen as extending the scope of protection of the claims. Such features are in particular necessary for the skilled person to repeat the invention, thus to present a sufficient disclosure of the claimed invention, especially as regards the choice of the correct components and their amounts to put the claimed process in practice.

4.2.3 An objection under Article 84 EPC as regards this point is thus unjustified.

4.3 Aspects referring to the coating of the beadlets

- 4.3.1 The presence of the term "coating" in the description as to the beadlets was objected to by the appellant. The appellant's view is that the claimed process did not result in the formation of a coating, and that all references to a "coating" should be deleted from the description.
- 4.3.2 The application as filed and the patent specification related to coated beadlets and to the process for the preparation of said beadlets. The process claim of claim 19 of the application as filed is identical to claim 1 of auxiliary request 3 as maintained. It relates to the "*spraying the resulting colloidal suspension onto an inert core*", which undeniably forms a coating around said inert core. The fact that the word "*coating*" is absent from claim 1 of auxiliary request 3 does not mean that said coating cannot be performed. Hence, it is obvious from the application as filed and from the patent as maintained that the process claimed in claim 1 of auxiliary request 3 and the coated beadlets relate to the same and unique invention and that the process claimed cannot be dissociated from the coated beadlets obtained therefrom. Hence, it becomes immediately obvious that the claimed process involves the preparation of coated beadlets and that it is a coating process.

Moreover page 8 of the application as filed and paragraph [0030] of the specification reads verbatim that "*the beadlets of the present invention are obtained by coating one lipophilic nutrient, or a mixture of such nutrients on a central core to obtain uniform, generally spherical beadlets*", which clarifies also explicitly that the process involving the preparation of the beadlets is a coating process.

The description of the original application or of the patent specification mentions furthermore that "*in another embodiment of the present invention there is provided a process for the preparation of the beadlets of lipophilic nutrients as defined above, which comprises...*" (see page 11, last paragraph and page 12 of the application document; see par. [0043] of the specification). Said passage makes an explicit reference to the beadlets described in the description of the original application or patent specification, said beadlets being coated by the lipophilic nutrient. In particular the Board cannot see in the term "in another embodiment" the presentation of another invention relating to the process and independent from the beadlets, as it was argued by the appellant.

Finally, the presence of a oxygen barrier coating and a moisture barrier coating is claimed in claims 14-18, and explanations and disclosure appears also necessary in the description as regards these specific supplementary coatings.

4.3.3 An objection under Article 84 EPC as to the presence of features relating to "coating" in the description is thus unjustified.

4.4 Presence of the terms "novel beadlets" and "novel process" in the description

4.4.1 All terms "novel beadlets" and "novel process" have been deleted from the description, and this objection under Article 84 EPC is therefore moot.

4.4.2 The Board wishes to point out that the presence of one remaining unique term "novel beadlets" on page 2, paragraph [0001] filed by the respondent with letter

dated 17 May 2018 dated in preparation of the oral proceedings planned for the 28 June 2018 would not have been a cause for revoking the patent in view of the general teaching of the description of the specification. The requirement for support of the claims must be viewed as a formal matter to ensure that the description and claims have the same extent; the Board does not see how the presence of an unique term "novel beadlet" in the description could have extended the scope of the claims.

4.5 The drying step in example 4

4.5.1 According to the appellant the drying step in example is performed at an atomisation pressure different from the claimed drying atomisation pressure of "about 0.8 kg/cm² to about 1.2 kg/cm²" in claim 1. The appellant based its objection on the basis of the disclosure in example 4 on the fact that "atomisation pressure of 2 kg/cm² was maintained" (see paragraph [0074]). According to the appellant, the disclosed pressure of 2 kg/cm² corresponded to the drying pressure and was higher than the claimed 1.2 kg/cm².

4.5.2 Example 4 discloses the preparation of a colloidal suspension of lipophilic nutrient in paragraph [0073]. Said suspension is sprayed on non-pareil seeds at the rate of 500g/hour and at the temperature of 35°C (cf. par. [0074]). Example 4 mentions in the context of said spraying step of the suspension that "atomisation pressure of 2 kg/cm² was maintained" (cf. par. [0074]). Example 4 discloses thereafter two further coating steps corresponding to the oxygen barrier coating and the moisture barrier coating (see par. [0075] and [0076]).

4.5.3 The Board does not see any mention of a drying step in the passage cited by the appellant from example 4 which reads and interprets something which is not disclosed in example 4. The disclosed atomisation pressure of 2 kg/cm² corresponds unambiguously to the atomisation pressure used in step ii) of claim 1 of auxiliary request 3, namely the atomisation pressure step of the spraying of the colloidal suspension onto the inert cores at the pressure in the range of about 0.1 kg/cm² to about 3 kg/cm².

The absence of any mention of a drying step in the cited passage was discussed during the second oral proceedings on 5 November 2018. The answer of the appellant to this point raised by the Board was that none of the examples fell under the scope of the claims, since an explicit mention of a drying step was absent from all examples, instead all examples disclosed that "*the atomization pressure of ... was maintained*" in the context of the spraying of the non-pareil seeds with the colloidal suspension of lipophilic nutrient.

The Board cannot follow this line of argumentation. It is indeed true that none of examples 2-9 relating to the preparation of beadlets mentions explicitly a drying step. However, said drying step iii) was present ab initio in claim 19 and pages 11-12 of the application as filed, corresponding to claim 19 as granted and paragraphs [0043] and [0044] of the specification, and it is thus derivable directly and unambiguously from this disclosure that the skilled person would have applied said drying step to all resulting beadlets obtained in the examples, even if not disclosed verbatim in the examples. The skilled person would have understood also that said drying step

is applied to the final "*resulting beadlets*" as claimed, namely after the application of the oxygen barrier coating and the moisture barrier coating, and not as an intermediary step.

4.5.4 Consequently, an objection under Article 84 EPC as to the disclosure of example 4 is unjustified.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside. The case is remitted to the opposition division with the order to maintain the patent in the following version:
Claims 1 to 29 corresponding to the claims of auxiliary request 3 filed with letter dated 9 October 2014;
Description: Page 2 filed with letter dated 14 August 2018, pages 4, 5, 6 and 7 filed with letter dated 17 May 2018, and pages 3, 8 to 12 filed with letter dated 15 June 2016.
2. The request for correction of the minutes is refused.

The Registrar:

The Chairman:



S. Fabiani

J. Riolo

Decision electronically authenticated