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**Datasheet for the decision
of 28 April 2022**

Case Number: T 0625/21 - 3.3.09

Application Number: 12848116.5

Publication Number: 2775863

IPC: A23L29/281, A23L27/00,
A23L29/256, A23L2/56, A23L2/52,
A23L2/38

Language of the proceedings: EN

Title of invention:
MULTI-FLAVORED BEVERAGE

Applicant:
Herschauer, Richard

Headword:
Multi-flavored beverage/HERSCHAUER

Relevant legal provisions:
EPC Art. 18(2), 111, 113(1)
EPC R. 103(1)(a)
RPBA 2020 Art. 11
Guidelines for examination C-VII 2.8.5, E-X 1.3.3 and 2.6
(November 2019)

Keyword:

Right to be heard - examination procedure - substantial
procedural violation (yes)

Remittal

Reimbursement of appeal fee - (yes)

Decisions cited:

J 0007/82, T 0094/84, T 0763/04, R 0003/10



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Case Number: T 0625/21 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 28 April 2022

Appellant: Herschauer, Richard
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 4 December 2020
refusing European patent application No.
12848116.5 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman M. Ansorge
Members: F. Rinaldi
F. Blumer

Summary of Facts and Submissions

- I. This decision concerns the applicant's appeal against the examining division's decision to refuse the European patent application No. 12 848 116.5.
- II. The decision under appeal is based on the main request and the first to third auxiliary requests, all filed by letter dated 29 September 2020, and the fourth to seventh auxiliary requests, filed by letter dated 23 November 2020. The examining division decided, among other things, that none of the requests complied with the requirement of Article 54 EPC.
- III. With the statement setting out the grounds of appeal, the applicant (appellant) resubmitted all the requests dealt with in the impugned decision.
- IV. Claim 1 of the main request reads:

"A flavor additive comprising:

a flavor base selected from the group consisting of proteins, gelatin, pectin, alginate, gums, starches, modified starches, oils, food grade petrochemicals, and mixtures thereof; and

a flavor component that is stably distributed in the flavor base,

wherein the flavor additive is a liquid, semi-liquid, or a suspension; and

wherein, when added to a beverage selected from the group consisting of water, sodas, coffees, teas, dairy products, sports drinks, meal replacements, and mixtures thereof, the flavor additive is stable as a physically separate phase within the beverage."

V. The appellant requested:

- that the decision under appeal be set aside and that "the application be sent back to the Examining Division for properly reasoned examination"
- or alternatively that the application be accepted for grant on the basis of the main request or any one of auxiliary requests 1 to 7

Furthermore, it requested, among other things, that the appeal fee be reimbursed.

VI. The appellant argued as follows:

- The examination proceedings involved several written communications, an exchange of emails and telephone calls, and three summons to oral proceedings.
- Among other things, after the first summons to oral proceedings, the applicant filed amended claim requests, discussed the case with the examiner and made additional written submissions. The examiner then explained in an email dated 10 October 2019 that the examining division would proceed with the grant of a patent. The oral proceedings were cancelled. However, the examining division reconsidered its intention to grant a patent and continued the examination proceedings. Among other things, this involved another communication under Article 94(3) EPC, a second summons to oral proceedings, postponement of those proceedings and a third summons. Even shortly before the last oral proceedings scheduled, the examiner explained in an email dated 26 October 2020 that clarity and novelty issues would not be discussed on the phone

due to the complexity of the objections and arguments.

- In sum, throughout the entire proceedings, the examiner made no attempt to comment on or address the applicant's substantive points, leading to several substantial procedural violations.
- In particular, the examining division did not consider the argument that the feature "wherein, when added to a beverage ... the flavor additive is stable as a physically separate phase within the beverage" was a distinguishing feature of claim 1.
- The applicant chose not to attend the oral proceedings because it saw no way to properly prepare for it. In its view, an applicant should not have to attend oral proceedings just to know what the examining division's case is.

Reasons for the Decision

1. *The application's disclosure*

The patent application relates to a flavour additive and beverages comprising it. The flavour additive comprises a flavour base (e.g. proteins, gelatin, pectins, alginate, gums) and a flavour component which is stably distributed in the flavour base. The flavour additive may itself be homogeneous, but when added (i.e. "shaken, stirred, or otherwise agitated a little") to a beverage it provides a beverage having a heterogeneous flavour profile. The flavour profile varies as the beverage is consumed (page 2, first paragraph to page 4, second paragraph).

2. *The proceedings before the examining division*

2.1 The appellant argued that the examining division committed substantial procedural violations. In support of its argument, it provided an in-depth summary of the course of the examination proceedings, intended to show that the examining division:

- at all times failed to address the substantive points made by the applicant and backed up with evidence
- reiterated the same arguments without a well-reasoned basis
- repeatedly changed its stance on the basis of the same facts

2.2 The examining division's failure to address the applicant's substantive arguments and the impact this had on the applicant's right to be heard is dealt with in point 3 below. In view of the board's conclusion explained in point 3, it is not necessary to assess whether further substantial procedural violations occurred during the examination of the application.

2.3 Nevertheless, the following observations are made.

2.4 After reviewing the decision under appeal and the examination proceedings leading to it, the board notes that it is evident that the examiner entrusted with the examination of the application made some effort to engage in dialogue with the applicant. The examiner made use of different communication channels - written communications, emails and telephone conversations - and last but not least they offered the oral proceedings which the applicant had requested. All this can be seen from both the impugned decision and the

appellant's statement setting out the grounds of appeal. The latter mentions the examiner's emails dated 10 October 2019 and 26 October 2020 which cannot be found in the public part of the file.

- 2.5 It is also evident from the statement setting out the grounds of appeal that the applicant's representative made use of these communication channels.
- 2.6 However, anything not in the public part of the file cannot be reviewed by the board because this part of the correspondence, and what was allegedly discussed in that context, remains unknown. The board simply has no way of forming its opinion on these aspects.
- 2.7 In this context it is recalled that any exchange of emails should be properly documented in the file (Guidelines for Examination in the EPO (November 2019, the version applicable when the decision was made), C-VII, 2.8.5). This ensures that the content of the emails is accessible in the public part of the file. In doing so, the other members of the examining division, the interested public and, in the event of an appeal, the competent board have unfiltered, direct access to what was discussed in the proceedings.
- 2.8 The appellant asserted that the examining division reconsidered its intention to grant a patent.

The board sees no issue in an examining division reconsidering the case before it, even more so if amended claim requests are filed. In this context, it should be noted that the examination of a European patent application is, as a general rule, entrusted to one member of the examining division (Article 18(2), second sentence, EPC). It is inherent to the provisions

of the EPC that an examining division, which consists of three technically qualified members, may reconsider the case before it.

- 2.9 The applicant decided not to attend the oral proceedings, arguing that an applicant should not have to attend oral proceedings just to know what the examining division's case is.
- 2.9.1 The board has some sympathy for this argument.
- 2.9.2 Nevertheless, oral proceedings give applicants the opportunity to address not only the examiner entrusted with the examination of the application but all members of the examining division simultaneously (Article 18(2), third sentence, EPC). Therefore, the case would have been discussed with the entire examining division.
- 2.9.3 As explained in R 3/10 (reasons for the decision, point 2.11), the purpose of oral proceedings is to allow a party to make an oral presentation of its arguments, to allow the board (or the deciding instance) to ask questions, to allow the party to respond to those questions and to allow controversial and perhaps crucial issues to be discussed. The value of oral proceedings is that matters may as a result be clarified and the board (or the deciding instance) may ultimately be satisfied that a party's position is the right one, although it was not so satisfied by the written submissions alone.
- 2.9.4 Therefore, by choosing not to attend the oral proceedings, the applicant missed an opportunity to advance the case in a discussion with the entire examining division.

3. *Right to be heard / substantial procedural violation*

3.1 In the decision under appeal (point 24), the examining division concluded that the subject-matter of claim 1 of the main request lacked novelty over D1. The reasoning was as follows.

- *"The examining division [interpreted] the claims in the broadest possible sense which is still meaningful. Furthermore, the feature of the last paragraph of claim 1: 'wherein, when added to a beverage ... the flavor is stable as a physically distinct phase within the beverage' is a process related feature related to the beverage in which the flavor additive could be added. This feature does not relate to the flavor additive itself and is thus not limiting."*
- The flavour additive in claim 1 was not further defined in the application as filed.
- D1 disclosed liquid beverages comprising an encapsulating material (alginate, pectinate, gelatin, etc.) and an encapsulated material (oil-in-water emulsion having at least one flavouring agent).
- For want of a more precise definition of the term "flavor additive", the liquid beverage in D1 was considered to be the flavour additive of claim 1. The encapsulated material and the encapsulating material in D1 were considered to be the flavour component stably distributed in the flavour base of claim 1.
- *"Furthermore if the beverage of D1 would be [sic] further diluted in a liquid, it would be stable as a physically distinct phase within the beverage."*

3.2 The appellant contested the decision, arguing that the examining division had disregarded ("totally ignored"; statement setting out the grounds of appeal, page 11, line 1) its arguments regarding the feature

"wherein, when added to a beverage selected from the group consisting of water, sodas, coffees, teas, dairy products, sports drinks, meal replacements, and mixtures thereof, the flavor additive is stable as a physically separate phase within the beverage".

3.3 First of all, it is noted that claim 1 calls for a flavour additive in a physically separate phase within the beverage, yet the decision under appeal mentions a physically distinct phase within the beverage.

3.3.1 Therefore, on the face of it, the examining division did not base its decision on claim 1 before it.

3.3.2 Nevertheless, for the following reasons, this in itself is not considered to be a substantial procedural error.

3.3.3 In earlier versions of claim 1, the term "distinct" was used. In the course of the examination proceedings, the applicant replaced it with the term "separate". The examining division accepted that the term "distinct" could be replaced with the term "separate" (annex to the summons dated 17 November 2020, point 1.1.2). In other words, the examining division regarded the terms "distinct" and "separate" as synonymous in the context of claim 1.

3.3.4 This is in line with the view of the applicant, which also regarded the two terms as synonymous or interchangeable.

- 3.3.5 Furthermore, the appellant did not raise any objection in this regard.
- 3.4 The point the appellant is asserting is different.
- 3.5 Throughout the proceedings before the examining division, the applicant's argument was that claim 1 had been restricted further by the feature that the flavour additive was stable as a physically separate or distinct phase within the beverage. In particular, it presented the following arguments.
- Claim 1 specified the nature of the flavour base, of the flavour additive (liquid, semi-liquid or a suspension) and of the beverage. Thus, claim 1 imposed restrictions as regards the nature of the flavour additive (letter dated 25 April 2016, page 3).
 - Claim 1 not only related to a specified beverage comprising the flavour additive, but functionally defined the additive itself in terms of its solubility (letter dated 10 September 2018, pages 2 and 3).
 - It was well-known basic science that, where two liquids are not entirely miscible, each liquid remains in a physically distinct phase when combined. Thus, the two liquids (beverage and flavour additive) were immiscible (letter dated 10 October 2019, pages 1 to 5). Support for this interpretation was found in the description of the application as filed and in several documents reflecting common general knowledge cited and filed by the applicant.
 - Lastly, the examiner had not provided "*detailed reasoning or evidence (for example in the form of textbooks) to indicate ... why the person of skill*

in the art would be unable to simply and as a matter of standard procedure, verify whether a flavour additive in accordance with the present claims is able to form a stable and physically distinct phase within any one of the beverages listed in Claim 1" (letter dated 29 September 2020, page 9).

- 3.6 In summary, throughout the proceedings before the examining division, the applicant's position was consistently that the flavour additive of claim 1 had been further restricted and more precisely defined: the flavour additive was immiscible with the beverages specified in the claim.
- 3.7 The applicant relied on this argument to show that D1 did not disclose all the features of claim 1. Therefore, it has to be considered a significant or central argument in support of the applicant's assertion that claim 1 was novel over D1.
- 3.8 From the entire written file under scrutiny on appeal, there is no indication that the examining division carefully considered the applicant's (most) significant or central argument. In particular, there is no explanation as to why it is incorrect, not convincing or immaterial for other reasons. Instead, the examining division merely repeated its view that the feature of the last paragraph of claim 1 did not impose a restriction on the flavour additive.
- 3.9 At this juncture, it is necessary to address the examining division's concluding remark on the novelty of claim 1:

"Furthermore, if the beverage of D1 would be [sic] further diluted in a liquid, it would be stable as a physically distinct phase within the beverage."

- 3.9.1 The board construes this statement to mean that the feature of the last paragraph of claim 1, which in the examining division's opinion did not restrict claim 1 (see point 3.7), is somewhat implicitly disclosed in D1. Put another way, the statement implies that even if the feature of the last paragraph of claim 1 were to impose some kind of restriction on the flavour additive or claim 1, then D1 discloses the feature.
- 3.9.2 The examining division did not explain the facts or considerations on which it based its conclusion in this statement. What is more, by making this statement, the examining division presented yet another conclusion that failed to consider the applicant's (most) significant or central argument. Therefore, the division failed to explain, in a logical chain, the reasons for arriving at this conclusion.
- 3.9.3 Thus, the decision is not sufficiently reasoned.
- 3.10 As concerns the right to be heard, decision T 763/04 states the following, in points 4.3 and 4.4 of the reasons for the decision:

"Article 113(1) EPC enshrines a party's right to be heard before a decision is issued against it. In accordance with established jurisprudence of the Boards of Appeal (see J 7/82, OJ 1982, 391 and T 94/84, OJ 1986, 337) this right also guarantees the right to have the relevant grounds fully taken into account in the written decision [...] In the present Board's view, the above principles apply equally to the consideration

of facts and arguments submitted by an applicant in support of his case in decisions in examination proceedings. Article 113(1) EPC will then be contravened where, as is the present case, facts and arguments, which from the appellant's submissions are clearly central to his case and which may speak against the decision taken, are completely disregarded in the decision in question.

[...]

Article 113(1) EPC is not a formal provision, but rather one of substance. Hence it is not sufficient to observe Article 113(1) merely formally by granting the Applicant the procedural possibility for presenting comments, as this was the case here. This procedural step falls short of its legislative purpose and remains a pure formality, if there is no trace in the file that such comments were indeed read and discussed on the merits, beyond a mere acknowledgement of their existence. In summary, Article 113(1) requires not merely that a party be given an opportunity to voice comments, but more importantly it requires that the deciding instance demonstrably hears and considers these comments."

- 3.11 The reasoning set out in T 763/04 fully applies to the case in hand.
- 3.12 Moreover, the reasoning in T 763/04 is reflected in the Guidelines for Examination in the EPO, in the passages that concern drafting decisions.
 - 3.12.1 The moment when the decision is taken is an important one. It is the last opportunity for the deciding instance to check and make sure that a party adversely affected by the decision has been granted the right to

be heard. If this is not the case, then a decision cannot be issued.

- 3.12.2 In the November 2019 version (applicable when the decision was issued), the Guidelines stated the following:

"All significant arguments advanced by a party to the proceedings are carefully examined and comprehensively discussed in the decision." (E-X, 1.3.3, paragraph 5)

- 3.12.3 This is explained in more detail in a section further down:

"The arguments put forward by the examiner during the proceedings should form the 'skeleton' for the decision and already define a complete and unbroken chain of reasoning leading to refusal. The decision may be based only on reasons already communicated to the applicant (Art. 113(1)). The applicant's arguments must be dealt with either point by point at the appropriate juncture in the chain of reasoning or en bloc at the end. The latter approach is often preferable as it makes clear that the final result is based solely on reasons already communicated to the applicant in compliance with Art. 113(1). In the part refuting the applicant's arguments, the decision should make clear why none of those arguments persuaded the examining division to depart from the final result.

It is particularly important that special attention should be paid to important facts and arguments which may speak against the decision made. If not, the impression might be given that such points have been overlooked. [...]

The need for complete and detailed reasoning is especially great when dealing with contentious points which are important for the decision ..." (E-X, 2.6, paragraphs 5 to 7)

3.13 To conclude, the examining division did not examine and discuss the applicant's (most) significant or central argument either during the examination proceedings or in the decision. Therefore, the examining division did not respect the applicant's right to be heard enshrined in Article 113(1) EPC.

3.14 This deficiency amounts to a substantial procedural violation.

4. *Remittal*

4.1 The appellant requested that the case be remitted to the examining division for a reasoned examination.

4.2 As explained above, the examining division did not respect the applicant's right to be heard. Therefore, the case is to be remitted to the examining division for further prosecution (Article 111 EPC and Article 11 RPBA 2020).

4.3 The board deems it useful to clarify that the examining division is at liberty to re-examine every aspect of the application and the claims under the EPC.

5. *Reimbursement of the appeal fee*

5.1 The appellant requested that the appeal fee be reimbursed.

5.2 In view of the substantial procedural violation of the applicant's right to be heard and the remittal to the examining division, reimbursement of the appeal fee is equitable (Rule 103(1) (a) EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:



A. Nielsen-Hannerup

M. Ansorge

Decision electronically authenticated