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Aktenzeichen / Case Number / N<sup>o</sup> du recours : T 47/86 - 3.3.1

Anmeldenummer / Filing No / N<sup>o</sup> de la demande : 81 304 283.5

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Bezeichnung der Erfindung: Sunflower-oil-based edible fat product

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : A23D 3/00

### ENTSCHEIDUNG / DECISION

vom / of / du 26 April 1989

Anmelder / Applicant / Demandeur : Nabisco Brands Inc.

Patentinhaber / Proprietor of the patent /

Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Fat product/Nabisco

EPÜ / EPC / CBE Rule 86(3)

Schlagwort / Keyword / Mot clé : - consent for amendments (not given), amended claims not clearly allowable -

Leitsatz / Headnote / Sommaire

Europäisches  
Patentamt

Beschwerdekammern

European Patent  
Office

Boards of Appeal

Office européen  
des brevets

Chambres de recours



Case Number : T 47/86 - 3.3.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.1  
of 26 April 1989

**Appellant :** NABISCO BRANDS, Inc.  
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**Decision under appeal :** Decision of Examining Division 020  
of the European Patent Office  
dated 12 September 1985 refusing  
European patent application  
No. 81 304 283.5 pursuant to  
Article 97(1) EPC

**Composition of the Board :**

**Chairman :** F. Antony  
**Members :** R. Spangenberg  
G.D. Paterson

Summary of Facts and Submissions

- I. European patent application No. 81 304 283.5 was filed on 17 September 1981, and relates to a sunflower oil based edible fat product.
  
- II. During the proceedings before the Examining Division, in the first communication dated 7 March 1983 objection was raised to the allowability of the claims as originally filed on the ground of lack of inventive step under Article 56 EPC, in view of the disclosures of
  - (1) GB-A-2 007 702,
  - (2) GB-A-1 121 662.

Thereafter an amended main claim was proposed by the Appellant, which was not acceptable to the Examining Division because it appeared to lack novelty under Article 54 EPC and furthermore did not meet the objection already raised under Article 56 EPC. Oral proceedings took place before the Examining Division, following which the Applicant filed amended claims in the form of a main request and four auxiliary requests. Claim 1 of the main request and of the first auxiliary request (Claims A) were the same and read as follows:

"A sunflower-oil-based edible fat product which exhibits an SFI profile with the following ranges

50°F (10°C)	≥	8%
70°F (21°C)	≥	3%
92°F (33.3°C)	≤	4%

and which comprises a blend of an interesterified fraction and a non-interesterified fraction, wherein: (a) from 30 to

75% by weight of the fat product comprises a randomly interesterified first portion comprising from 30 to 100% hydrogenated sunflower oil and from 0 to 70% liquid sunflower oil, both based on the weight of the first portion; and (b) from 25 to 70% by weight of the fat product comprises a second portion comprising from 60 to 100% liquid sunflower oil containing at least 68% by weight linoleic acid, and up to 40% hydrogenated sunflower oil based on the weight of the portion; wherein the fat product contains, based on its combined weight, less than 21% total of palmitic and stearic acids, and from 32 to 55% linoleic acid and wherein the liquid sunflower oil of the second portion has a higher linoleic acid content than the sunflower oil used to prepare the hydrogenated sunflower oil."

According to the second and third auxiliary requests (Claims B and C), the minimum amount of linoleic acid "68%" in the above claim was to be replaced by "70%"; and according to the fourth auxiliary request (Claims D) the requirement "and wherein the liquid sunflower oil of the second portion has a higher linoleic acid content than the sunflower oil used to prepare the hydrogenated sunflower oil" was to be deleted from Claim A.

By its decision dated 12 September 1985, the Examining Division refused the application. The main ground of refusal in respect of all the requests was lack of inventive step under Article 56 EPC. The Examining Division considered that document (1) was concerned with the same problem as the application in suit, namely providing a fat product made from sunflower oil with an improved texture as regards sandiness or grittiness. It held that the ranges and amounts of the various constituents of the fat product disclosed in document (1) and claimed in each of the requests largely overlap, and that document (1) allowed a

wide variation in linoleic acid content of the sunflower oil. An improvement in respect of sandiness could be expected from all variations within the general disclosure of document (1). No evidence had been filed to show any unexpected properties provided by the particular compositions within the claims of the application in suit.

The main claims of the main request and the first auxiliary request (Claims A) were also considered to be inadmissible under Article 123(2) EPC, there being no specific disclosure of the particular combination of amounts of ingredients in the description and claims as originally filed.

The Examining Division also stated in this decision that Article 113(1) EPC does not require that an applicant be given a repeated opportunity to comment, so long as the decisive objections against grant remain the same; and that it saw no progress towards removing the main ground of objection.

III. The Appellant filed a notice of appeal on 19 October 1985 and duly paid the appeal fee. A Statement of Grounds of Appeal was filed on 16 January 1986, in which the previous third auxiliary request (C) became the main request. The finding of lack of inventive step was contested on the basis that no proof of unexpected properties was necessary. During the course of the appeal proceedings the Board issued a communication dated 14 April 1988 in which it was indicated that the proposed claims lacked an inventive step; in a reply by letter dated 21 October 1988 the Appellant first proposed that the previous fourth auxiliary request (Claims D) before the Examining Division should become the main request, and argued that such subject-matter was inventive.

Subsequently, in a letter dated 14 April 1989 filed shortly before the oral proceedings, the Appellant proposed six further requests to take the place of all previous requests. In one of these requests, the first auxiliary request, a new feature was introduced for the first time.

IV. During oral proceedings on 26 April 1989, in response to objections raised by the Board under Article 123(2) EPC the Appellant withdrew all earlier requests, and submitted four further proposed amended main claims marked as the main request, and the first, second and third auxiliary requests. Claim 1 according to the main request (Claims E) reads as follows:

"A sunflower-oil-based edible fat product which exhibits an SFI profile within the following ranges

- 50°F (10°C)            ≥ 8%
- 70°F (21°C)            ≥ 3%
- 92°F (33.3°C)         ≤ 4%

and which comprises a blend of an interesterified fraction and a non-interesterified fraction, wherein: (a) from 30 to 75% by weight of the fat product comprises a randomly interesterified first portion consisting of hydrogenated sunflower oil; and (b) from 25 to 70% by weight of the fat product comprises a second portion comprising from 60 to 100% liquid sunflower oil containing at least 65% by weight linoleic acid, and up to 40% hydrogenated sunflower oil based on the weight of the second portion; wherein the fat product contains, based on its combined weight, less than 21% total of palmitic and stearic acids, and from 32 to 55% linoleic acid."

This claim contains the same one feature which was present in the first auxiliary request filed on 17 April 1989, namely in requirement (a) the randomly interesterified first portion consists of hydrogenated sunflower oil and contains no liquid sunflower oil.

According to the first auxiliary request (F), the minimum linoleic acid content of the liquid non-interesterified portion is to be 70% instead of 65%, and according to the second auxiliary request (G) this second portion is to consist of 100% liquid sunflower oil, i.e. the optional content of up to 40% hydrogenated oil is to be deleted.

The third auxiliary request (H) corresponds to the main request rejected by the Examining Division (paragraph II above) with the same limitation as to the interesterified portion and of the minimum linoleic acid content as contained in auxiliary request (F) submitted at the oral proceedings.

The Appellant essentially argued that according to the current amended claims, the technical problem underlying the claimed invention should not only be seen in providing a sunflower-oil based edible fat product with a high content of linoleic acid which has desirable texture and melting properties but also in a considerable simplification of the manufacturing of such product. This problem was solved by omitting the step of blending hardened sunflower oil with liquid sunflower oil prior to the interesterification step. Document (1) did not provide an incentive for this simplification, because according to this document the blending of hardened and unhardened oil prior to interesterification was mandatory. Therefore, the subject-matter of the amended claims should be regarded as inventive.

V. At the end of the oral proceedings the decision was announced that the appeal was dismissed.

#### Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 EPC as well as Rule 64 and is, therefore, admissible.
2. As can be seen from the Summary of Facts and Submissions, during prosecution of this application before the Examining Division and the Board of Appeal since March 1983, the Appellant has filed a large number (more than 10) of alternative proposed main claims, in attempts to meet the objection of lack of inventive step while at the same time satisfying the requirements of Article 84 and 123(2) EPC.

Up until shortly before the oral hearing before the Board, the main feature relied upon in support of the inventiveness of the claimed invention was the selection for the non-interesterified non-hardened portion of a sunflower oil having an unusually high linoleic acid content, thus allowing a reduction in the proportion of interesterified fats while still avoiding a grainy texture. However, as set out in IV above, the claims filed during the oral hearing all contain an additional feature which was relied upon by the Appellant in support of inventiveness, namely that in accordance with requirement (a) of Claim 1 the "randomly interesterified first portion" consists of "hydrogenated sunflower oil", and does not contain any liquid sunflower oil. This is in contrast to all previously proposed claims filed before 17 April 1989, where the randomly interesterified first portion included from 0 to 70% liquid sunflower oil. The Appellant's further argument in support



of the inventiveness of such claims is also set out in paragraph IV above.

3. During the appeal stage of examination proceedings the admissibility of proposed amendments to the claims is of course a matter of discretion under Rule 86(3) read in conjunction with Rule 66(1) EPC. In Decision T 153/85 "Alternative claims/Amoco" (OJ EPO 1988, 1), it was emphasised that as a normal rule, if an Appellant wishes that the allowability of alternative sets of claims differing in subject-matter from those considered at first instance should be considered by the Board of Appeal during appeal proceedings, such alternative claims should be filed with the grounds of appeal or as soon as possible thereafter. Furthermore, it was held that a Board may justifiably refuse to consider alternative claims filed at a very late stage, such as during oral proceedings, if such claims are not clearly allowable.
  
4. In the present case, in the Board's view the claims which are the subject of the requests before it, which were all filed during the oral proceedings, are not clearly allowable, for the following reasons.
  - (a) On the assumption that the claims in the various requests before the Board are admissible having regard to Article 123(2) EPC, i.e. not taking into account the additional feature that the "randomly interesterified first portion" does not contain any liquid sunflower oil, the Board is not satisfied as to the presence of an inventive step having regard to the reasons set out in the decision of the Examining Division. In this connection the Appellant has at no stage filed any evidence of a surprising effect resulting from the claimed combination of ingredients, in comparison with document (1).

(b) In relation to the new feature of Claim 1 in each of the various requests before the Board (absence of liquid sunflower oil in feature (a) of Claim 1), the Appellant submitted that there was a proper basis for the proposed claims at page 10, line 20 onwards, of the description as originally filed, and in Example 1. Page 10, line 20 reads "The first portion of the oil phase, which contains hydrogenated sunflower oil and can optionally include up to 70% liquid sunflower oil, is interesterified ...", and a general discussion of the possible ranges and amounts of the other ingredients then follows. There is in the Board's view no disclosure in this passage of an embodiment according to which there is a necessity that such portion should not include any liquid sunflower oil (this now being an essential feature of the claimed invention), especially in combination with the particular ranges and amounts of the other ingredients as now claimed. Furthermore, while Example 1 is a particular detailed example and does not contain any liquid sunflower oil in its "first portion", it is clearly one of four detailed examples illustrating merely one version within what is "optional" at page 10, line 20. The Board is, therefore, not satisfied that Example 1 can properly be used as a basis for what is now proposed as a general requirement of the invention.

(c) For these reasons, in the Board's judgment, the claims in each of the requests before it are certainly not clearly allowable. Following the principles set out in Decision T 153/85 above, the Board has therefore decided, having regard to the late stage of the proceedings when they were filed, to reject each of the

requests before it in the exercise of its discretion under Rule 86(3) EPC.

5. A further factor of some relevance to the exercise of the Board's discretion in the present case is that the new feature put forward in support of inventive step by the Appellant for the first time during the oral proceedings before the Board has never been considered by the Examining Division. Therefore, if the requests before the Board were to have been admitted, the presence of the new feature in the claims of such requests would probably have necessitated the remittal of the case to the Examining Division for further examination. Having regard to the time which has elapsed since the filing of the application, such a remittal would have caused undesirable further delays contrary to the public interest.

Order

For the reasons set out above, it is decided that:

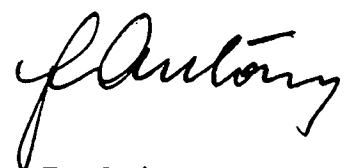
The appeal is dismissed.

The Registrar:



J. Rückerl

The Chairman:



F. Antony