

**Internal distribution code:**

- (A) [ ] Publication in OJ  
(B) [X] To Chairmen and Members  
(C) [ ] To Chairmen

**D E C I S I O N**  
**of 9 September 1998**

**Case Number:** T 0900/94 - 3.3.2

**Application Number:** 87309468.4

**Publication Number:** 0269257

**IPC:** A23B 7/00

**Language of the proceedings:** EN

**Title of invention:**

Apparatus & process for sterilization of spices and leafy herbs

**Patentee:**

McCormick & Company, Inc.

**Opponent:**

Compagnie Gervais Danone  
CPC Maizena GmbH

**Headword:**

Sterilization/McCORMICK

**Relevant legal provisions:**

EPC Art. 84, 107, 110, 111, 123  
EPC R. 57, 57a, 64

**Keyword:**

"Admissibility of the appeal: yes, appellants adversely affected"  
"Admissibility of amendments into appeal proceedings: yes, amendments and alternative requests filed with the statement of grounds"  
"Allowability of the amendments under Articles 123 and 84: yes, compliance with the requirements of the EPC"  
"Remittal to the department of first instance"

**Decisions cited:**

G 0009/92, G 0004/93, G 0010/93, T 0123/85, T 0153/85,  
T 0133/87

**Catchword:**

-



Europäisches  
Patentamt

European  
Patent Office

Office européen  
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number: T 0900/94 - 3.3.2

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.2  
of 9 September 1998

**Appellant:**  
(Proprietor of the patent) McCormick & Company, Inc.  
11350 McCormick Road  
Hunt Valley  
Maryland 21031 (US)

**Representative:**  
Jump, Timothy John Simon  
Venner Shipley & Co.  
20 Little Britain  
London EC1A 7DH (GB)

**Respondent:**  
(Opponent 01) Compagnie Gervais Danone  
126-130, rue Jules Guesde  
92302 Levallois Perret (FR)

**Representative:**  
Jacquard, Philippe Jean-Luc  
Cabinet Ores  
6, Avenue de Messine  
75008 Paris (FR)

**Respondent:**  
(Opponent 02) CPC Maizena GmbH  
Knorrstrasse 1  
74074 Heilbronn (DE)

**Representative:**  
Lederer, Franz, Dr.  
Lederer, Keller & Riederer  
Patentanwälte  
Prinzregentenstrasse 16  
80538 München (DE)

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 20 September 1994  
revoking European patent No. 0 269 257 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** P. A. M. Lançon  
**Members:** G. F. E. Rampold  
R. E. Teschemacher

## Summary of Facts and Submissions

- I. European patent application No. 87 309 468.4 comprising 19 claims was filed by the appellants (proprietors). Claims 1, 7, 16 and 17 as filed read as follows:

"1. A method of sterilizing raw vegetable product such as leafy herbs, spices and the like so as to reduce loss of volatile material from the vegetable product comprising the steps of

preheating the interior of a closed container system to a selected temperature, loading a selected quantity of the vegetable product into the container system, injecting sterilizing steam into the container system for a time period sufficient to reduce the bacteria present in or on the product to an acceptable level, then lowering the pressure in the container system to below atmospheric while cooling the product in the container system, then raising the pressure in the container system by introducing a substantially bacteria free gas and then evacuating the contents of the container system.

7. The method as claimed in claim 1 wherein the step of introducing the gas includes introducing inert gas to raise the pressure in the container system to approximately one psig.

16. Apparatus for use in sterilizing raw vegetable product such as leafy herbs, spices and the like without substantial loss of volatile oils or substantial change of color or lowering of moisture content comprising a container system having a first vessel including jacket means and mixing means rotatably mounted in the interior of said first vessel, a second vessel including jacket means and mixing means rotatably mounted in the interior of said second

vessel, conduit means connecting the interiors of said vessel with one another through valve means and means for conditioning the atmosphere in each of said vessels including means for introducing a fluid at a selected temperature into each of said jacket means, means for controlling the pressure of the atmosphere in each said vessel, said means for conditioning the atmosphere including a steam generation means for said first vessel.

17. The apparatus as claimed in claim 16 wherein said means for conditioning the atmosphere includes a liquid chiller for the jacket means of said second vessel."

II. European patent No. 0 269 257 with 19 claims was granted to the appellants in response to the above-mentioned European patent application.

Claim 1 as granted was worded as follows:

"1. A method of sterilizing raw vegetable product so as to reduce loss of volatile material from the vegetable product comprising the steps of  
preheating the interior of a closed container system to a selected temperature, loading a selected quantity of the vegetable product into the container system, injecting sterilizing steam into the container system for a time period sufficient to reduce the bacteria present in or on the product to an acceptable level, then lowering the pressure in the container system to below atmospheric while cooling the product in the container system, then raising the pressure in the container system by introducing a substantially bacteria free gas and then evacuating the contents of the container system."

III. Notice of opposition was filed by respondents (opponents) 01 and by respondents (opponents) 02, both requesting that the patent be revoked in its entirety under Article 100(a) EPC because of lack of novelty (Articles 52(1) and 54 EPC) and lack of inventive step (Articles 52(1) and 56 EPC), and under Article 100(b) EPC because of insufficiency of disclosure (Article 83 EPC).

IV. During oral proceedings before the opposition division the appellants requested that the patent be maintained in amended form on the basis of claims 1 to 17 filed on 26 July 1994. Claim 1 of the said request was worded as follows:

"1. A method of sterilizing a raw vegetable product **selected from the group consisting of leafy herbs and spices** so as to reduce loss of volatile material **therefrom** comprising the steps of -  
preheating the interior of a closed container system to a selected temperature, loading a selected quantity of **uncoated** product into the container system, injecting sterilizing steam into the container system for a time period of **from 10 seconds to 5 minutes** to reduce the bacteria present in or on the product to an acceptable level **while continuously mixing the product in said container system, the pressure in said container system being controlled to be within the range of 1.36 to 4.46 bar (5 to 50 psig)**, then lowering the pressure in the container system to below atmospheric while cooling the product in the container system, then raising the pressure in the container system by introducing a substantially bacteria free gas and then evacuating the contents of the container system." (Emphasis added.)

V. The opposition division found in the application documents as filed no sound basis for the following features introduced into claim 1 as amended during the opposition proceedings:

- (i) leafy herbs and spices
- (ii) "uncoated product" and
- (iii) "while continuously mixing the product in said container system, the pressure in said container system being controlled to be within the range of 1.36 to 4.46 bar (5 to 50 psig)";

it therefore decided to revoke the patent on the ground that claim 1 was inadmissibly amended and did not comply with the provisions of Article 123(2) EPC.

In the absence of an independent claim 1 satisfying the requirements of Article 123(2) EPC, the opposition division considered it inappropriate to examine the grounds of opposition invoked by the respondents in their notice of opposition (see paragraph III above) or to give a decision on these grounds.

VI. The appellants filed an appeal against the decision of the opposition division and submitted a statement of grounds of appeal within the time limit set by Article 108 EPC, requesting that the patent be maintained on the basis of the main request or one of the five auxiliary requests filed together with the appeal statement. In the main request, the features considered inadmissible by the opposition division had been either amended or deleted.

Claims 1, 5 and 14 of the main request are worded as follows:

"1. A method of sterilizing a raw vegetable product **selected from the group consisting of spices and leafy herbs** so as to reduce loss of volatile material from the vegetable product comprising the steps of

preheating the interior of a closed container system to a selected temperature, loading a selected quantity of the vegetable product into the container system, injecting sterilizing steam into the container system for a time period **sufficient for the vegetable product to be exposed to the steam for between 10 seconds and 5 minutes** and to reduce the bacteria present in or on the product to an acceptable level, then lowering the pressure in the container system to below atmospheric while cooling the product in the container system, then raising the pressure in the container system by introducing a **substantially bacteria free gas** and then evacuating the contents of the container system.

5. The method as claimed in claim 1 wherein the step of introducing the gas includes introducing inert gas to raise the pressure in the container system to **6.9 kPa over ambient atmospheric pressure** (one psig).

14. Apparatus for use in sterilizing a raw vegetable product **selected from the group consisting of spices and leafy herbs** without substantial loss of volatile oils or substantial change of colour or lowering of moisture content, comprising a container system having a first vessel including jacket means and mixing means rotatably mounted in the interior of said first vessel, a second vessel including jacket means and mixing means rotatably mounted in the interior of said second vessel, conduit means connecting the interiors of said vessel with one another through valve means and means

for conditioning the atmosphere in each of said vessels including means for introducing a fluid at a selected temperature into each of said jacket means, means for controlling the pressure of the atmosphere in each said vessel, said means for conditioning the atmosphere including a steam generation means for said first vessel and a liquid chiller for the jacket means of said second vessel." (Emphasis added.)

VII. In the communications of 30 December 1997 and 23 March 1998 the board informed the parties about its preliminary opinion, that the amendments to the claims of the appellants' main request were considered potentially acceptable under the terms of Article 123, paragraphs 2 and 3 and Article 84 EPC.

As far as the procedural aspects were concerned, the board informed the parties about its intention to remit the case to the first instance department for consideration of all the undecided issues, viz. the grounds for opposition invoked by the respondents, if, following the appeal proceedings, the appeal on the particular issue, which was decisive for the revocation of the patent in the first instance (i.e. Article 123(2) EPC), could be allowed. In the said communications and in the annex to the summons to attend oral proceedings the attention of the parties was also drawn to the fact that in the circumstances of the present case such procedure was in accordance with the consistent practice of the boards and, consequently, the subject of the oral proceedings and the board's decision would, at this stage, strictly be confined to the admissibility of the appeal and to the question whether or not the appeal on the particular issue of added subject-matter, which led to the revocation of the patent in the first instance opposition proceedings, could be allowed.



Oral proceedings were held on 9 September 1998.

VIII. Respondents 01 challenged both in the written procedure and at the oral proceedings the admissibility of the appeal and objected to the board's intention of possibly remitting the case to the department of first instance by providing essentially the following arguments:

The main request and five auxiliary requests, as submitted by the appellants during the appeal proceedings, all contained claims from which certain features had been removed which were present in the claims forming the basis of the impugned decision of the opposition division to revoke the patent. The removal of such features had the effect that the appellants tried to proceed with this case at the appeal stage with claims which were broader than the claims of the patent in the form revoked by the opposition division.

Article 107 EPC provided that a party could appeal against a decision of a first instance department only to the extent that it was adversely affected by that decision. Although the expression "to the extent" was not used in the English version, the above interpretation of Article 107 EPC was in full agreement with the French and the German version of the text of said article. Thus, in the present case the appellants were, in the opinion of the respondents, restricted during appeal proceedings to defending their patent on the basis of the claims and in the form in which it was revoked by the opposition division, since they were only adversely affected within the meaning of Article 107 EPC to the extent that these claims were

not accepted. It was thus clear that Article 107 also governed the question whether or not the appeal was admissible in view of the appellants' new requests submitted in the appeal proceedings.

Respondents had to accept that under the terms of Article 111(1) EPC a board of appeal might exercise any power within the competence of the department which was responsible for the decision appealed. However, if this power concerned the board's competence to permit broadening amendments in the appeal proceedings, there was, in the opinion of the respondents, a clear conflict with Article 107 EPC. The exercise of the board's discretion under Article 111(1) EPC was then controlled by the strict provision of Article 107 EPC stipulating that a party must be adversely affected to have the right to appeal.

Moreover, decisions G 9/92 and G 4/93 concerning prohibition of *reformatio in peius* indicated that a party to appeal proceedings was essentially restricted during appeal proceedings to defending its patent on the basis of the claims and in the form underlying the decision of the department of first instance.

Although Article 111(1) EPC provided the board with the power to remit the case to the opposition division, this discretionary power had to be exercised within the general principles governing the opposition procedure in the EPO, as published in OJ EPO, 1989, 417.

Following these principles the EPO's aim remained to establish as rapidly as possible, in the interest of both the public and the parties, whether or not the patent might be maintained. By remitting the case to the department of first instance, the board acted, in the respondents' view, directly against these principles particularly, since the appellants already

during the proceedings before the opposition division had the opportunity of filing auxiliary requests to overcome the ground for the revocation and to enable the opposition division to give a complete decision on all the issues raised.

- IX. Respondents 02 concurred, in principle, with the criticism of respondents 01 regarding the board's approach of possibly remitting the case to the department of first instance and objected to such course of action in particular on the basis of the argument that the EPC did not confer on the parties the right to have all the issues considered by two instances.

The main request was considered by respondents 02 as acceptable under the terms of Article 123(2) EPC, in spite of certain reservations remaining as to the clarity of claims 1 and 13 which, in their opinion, were inconsistent or lacked essential features. However, since this lack of clarity did not result from the amendments of the present claims, they had to accept that this question was in fact not relevant at this stage, because Article 84 EPC was not one of the grounds for opposition mentioned in Article 100 EPC.

However, Set B (first auxiliary request), Set C (second auxiliary request) and Set D (third auxiliary request) contained in the opinion of respondents 02 certain claims which apparently did not comply with the provisions of Article 123(2) EPC.

- X. The appellants disagreed and submitted in support of their appeal both in the written procedure and at the oral proceedings essentially the following arguments as to the admissibility of the appeal and the compliance of the amendments with the requirements of the EPC:

The opposition division's decision to revoke the present patent was clearly a decision subject to appeal under the provisions of Article 106 EPC. A notice of appeal and supporting statement were filed within the time limit set by Article 108 EPC. The appellants were undoubtedly adversely affected by the aforementioned decision of the opposition division, because it resulted in the revocation of their patent. Accordingly the appeal complied with Articles 106 to 108 and Rule 64 EPC and was therefore admissible.

The purpose of Article 107 EPC was stated in its title, namely to determine whether or not a party is entitled to appeal. That article did not, as respondents 01 contended, govern the extent to which a patent proprietor might introduce amendments or the admissibility of new requests into an admissible appeal. The admissibility of amended claims into appeal proceedings was a matter for the discretion of the responsible board of appeal.

The accuracy of this interpretation was born out in numerous decisions of the boards of appeal, in which a discussion of the admissibility of each appeal, under Articles 106 to 108 EPC, was usually set out before the admissibility of new requests was considered.

In circumstances where an opposition division declared that a limitation introduced during opposition proceedings offended against the provisions of Article 123(2) EPC, it would be unreasonable for that division to deny the patentees an opportunity to remove the offending amendment. This held equally true for the board of appeal since it might under Article 111(1) EPC exercise any power within the competence of the department which was responsible for the decision appealed.

Moreover, removal of such a limitation in the claims was sanctioned in decision T 123/85 in circumstances where its presence had resulted in revocation of the patent by the opposition division for non-compliance with Article 123(2) EPC.

The appellants concurred with the board's finding in the official communications to the effect that the claims of the main request complied with the requirements of Article 123(2) and (3) and Article 84 EPC, and agreed that this case should now be remitted to the opposition division for further consideration as provided in Article 111(1) EPC.

- XI. The appellants requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request as submitted with the statement of grounds of appeal (Set A).

Alternatively, they requested that the patent be maintained on the basis of one of the five subsidiary requests as submitted with the statement of grounds of appeal.

As a further alternative, they requested that the patent be maintained as granted (6th auxiliary request).

- XII. The respondents requested that the appeal be dismissed.

## Reasons for the Decision

### 1. *Admissibility of the appeal (Articles 106 to 108, Rule 64 EPC)*

1.1 It was not contested by the respondents that the appeal was lodged in respect of a decision of the opposition division within the meaning of Article 106(1) EPC, and it was also not contested that both the notice of appeal and the statement setting out the grounds of appeal were filed in due form and within the time limit provided in Article 108 EPC.

It was similarly not disputed that the content of the notice of appeal complies with the requirements set out in Rule 64 EPC.

1.2 Since the appellants are the proprietors of the patent under opposition, there can also be no doubt that the appeal was filed by a party to the proceedings before the opposition division which issued the impugned decision (see Article 107, first sentence, EPC).

The opposition division has disallowed the appellants' sole request that the patent be maintained in amended form and has decided to revoke the patent in its entirety. The appellants are therefore adversely affected by the decision of the opposition division. Hence, both requirements of Article 107 EPC are fulfilled in the present case.

1.3 Notwithstanding this, respondents 01 challenged for the first time in their written submissions dated 20 May 1998 and later during oral proceedings before the board the admissibility of the appeal under Article 107 EPC on the basis of their interpretation of the first sentence of Article 107 EPC in the French version of

the text ["Toute partie à la procédure  
..... peut recourir contre cette décision  
**pour autant** qu'elle n'ait pas fait droit à ses  
prétentions."] and in the German version of the text  
["Die Beschwerde steht denjenigen zu, die am Verfahren  
beteiligt waren....., **soweit** sie durch  
die Entscheidung beschwert sind."]. From this the  
respondents concluded that the equivalent English text  
of Article 107 EPC would have to be interpreted  
correctly as reading: "Any party to proceedings may  
appeal against a decision **to the extent that** it is  
adversely affected by that decision."

On the basis of this interpretation, the effect of  
Article 107 EPC was, in the opinion of the respondents,  
that the appellants were limited to defending their  
patent in the opposition appeal proceedings on the  
basis of the claims underlying the opposition  
division's decision under appeal as being the broadest  
claims, since they were only adversely affected to the  
extent that these claims were revoked. In view of the  
above considerations respondents 01 concluded that the  
appellants could not seek to obtain protection for the  
invention at the appeal stage on the basis of a newly  
filed set of claims broader than those forming the  
basis for the decision of the opposition division, and  
further that the question of the admissibility of  
broader claims in the appeal proceedings concerned  
directly the requirements for admissibility of an  
appeal. Consequently, the appeal contravened, in the  
opinion of respondents 01, the provisions of  
Article 107 EPC and was therefore inadmissible.

- 1.4 The board is unable to share the opinion of respondents  
01 as to the consequences arising from Article 107 EPC.  
According to the consistent practice of the EPO, a  
party is considered adversely affected and entitled to  
appeal **if the decision of the department of first**

instance does not correspond to what the party had expressly requested (see Case Law of the Boards of Appeal of the European Patent Office, Munich 1966, VI. E. 6.3.2)

- 1.5 In the present case the appellants' sole request presented in the first instance opposition proceedings, namely that the patent be maintained in amended form, was disallowed and the patent was revoked by the first instance department in its entirety. The appellants were therefore adversely affected by the decision of the opposition division at the very least, since their sole request was not acceded to and the decision of the opposition division was thus in **its entirety** inconsistent with the appellants' request in the first instance opposition proceedings.

Consequently, Article 107 EPC provides them with a right to appeal against the said decision, but does not govern the extent of possible amendment or the admissibility of new requests in that appeal. Thus, in the circumstances of the present case, the question what is meant by the expression "to the extent" ("pour autant", "insoweit") does not arise as such under Article 107 EPC.

- 1.6 The objections of respondents 01 to the admissibility of the appeal concern in fact an aspect of the proceedings which is entirely different and not comparable at all with that discussed in foregoing points 1.4 and 1.5.

It is correct that the appellants requested in the first instance opposition proceedings maintenance of the patent on the basis of claims which had been restricted during opposition proceedings. This has, however, not the effect, that the appellants were bound to defend their patent in this restricted version in



further proceedings before the first or second instance. In general, the submission of an amended version of the application or the patent is to be seen as an attempt of the applicant or proprietor to remove any deficiency enabling him to proceed with a version which complies with the requirements of the Convention.

In the absence of any particular circumstances, the submission of a restricted version of the claims in the proceedings before the department of first or second instance is in accordance with the consistent practice of the EPO, as established in decision T 123/85 (see OJ EPO 1989, 336, and the confirming decisions cited in the Case Law of the Boards of Appeal mentioned above, VI. A. 9.3), **not** to be considered as a partial abandonment of originally filed subject-matter. In requesting before the opposition division that their patent be maintained in a limited form, the appellants were merely trying to delimit their patent to meet certain objections expressed by the opponents. However, the appellants did not, by virtue of such limitation, **irrevocably surrender** that part of their patent as granted.

Therefore, prosecution of the case at the appeal stage on the basis of claims which are broader than those underlying the decision of the first instance, is generally not excluded in opposition appeal proceedings. The appellants, having offered a restrictive amendment in order to overcome the grounds for opposition, are thus entitled to reintroduce into their claims subject-matter which they had previously offered to delete, provided that such amendments do not constitute an abuse of the proceedings. This is not the case here (see T 123/85, already cited; for more recent confirming decisions see the references in EPO Board of Appeal Case Law 1996, special edition of OJ EPO 1997, 119).

In their submissions during oral proceedings before the board respondents 01 considered it inconsequential that the appellants should be entitled to prosecute their case in the appeal proceedings on the basis of broader claims in spite of the fact that they themselves had offered to restrict their claims in the proceedings before the opposition division. The board is unable to share this opinion. In this respect it should be emphasised that it is not an exceptional case that a party's attempt to remove a certain deficiency by restricting the claims at a certain stage of the proceedings results in the creation of another failure or deficiency, as occurred in the present case during proceedings before the opposition division. There is from a procedural point of view no reason to deprive the appellants at the appeal stage of the opportunity to remove such a deficiency which occurred in first instance proceedings. In cases, where the removal of inappropriate restrictions was likely to represent an abuse of the proceedings, the board would take this into consideration in deciding within its discretionary power whether or not the requested amendment should be admitted into the proceedings.

- 1.7 From the foregoing it becomes clear that the entitlement to appeal under Article 107 EPC does not govern the substantive aspects of the amendments requested by the appellants. The submission of amendments to a patent is regulated by Article 123 in general terms and Rules 57 and 57a EPC for the opposition procedure, as extended by Rule 66(1) EPC to the boards of appeal.

Both these questions are relevant at different stages of the appeal proceedings. The question of entitlement to appeal has to be answered in the affirmative before the appeal can be considered admissible under Articles 106 to 108 EPC. The substance of an amendment

is to be dealt with in the course of the substantive examination of the appeal under Article 110 EPC which can only take place in the framework of an appeal which has already been considered admissible (Article 110(1) EPC).

Therefore, the board cannot, contrary to the submissions of respondents 01 during oral proceedings, recognise the alleged conflict between the provisions of Article 107 and Article 111(1) EPC, since each of these articles regulates entirely different legal aspects of the appeal at different stages. Only if the appeal is admissible under the terms of Articles 106 to 108 EPC, a decision on the merits of the appeal will be given under Article 111(1) EPC.

- 1.8 Respondents 01 cannot invoke the decisions G 9/92 and G 4/93 (OJ EPO 1994, 875) in support of their opinion that the appeal is not admissible under Article 107 EPC. Both these decisions are concerned with the **prohibition of reformatio in peius** and as such put certain restrictions on the right of the **non-appealing party, i.e the party to the proceedings as of right under Article 107, second sentence EPC**, to file amendments and requests in appeal proceedings against an interlocutory decision.

Apart from the fact that the prohibition of reformatio in peius is definitely not a legal matter which is regulated by Article 107 EPC, in the present case it is the **appealing proprietor** who requests certain amendments to the claims. The above decisions referred to by respondents 01 are therefore entirely irrelevant to the present case.

- 1.9 Having regard to the above, the Board has reached the conclusion that the **appeal** is admissible under the terms of Article 106 to 108 and Rule 64 EPC.

It has therefore to be examined whether the **requested amendments are admissible and allowable.**

2. *Admissibility of the requested amendments into the appeal proceedings*

2.1 Regarding the admissibility of requests for amendment in appeal proceedings, the board stated in decision T 153/85 (OJ EPO 1988, 1; see especially Reasons, point 2.1):

"In relation to appeal proceedings, the normal rule is as follows: if an appellant wishes that the allowability of the alternative set of claims, which differ in subject-matter from those considered at first instance, should be considered (both in relation to Article 123 EPC and otherwise) by the board of appeal when deciding on the appeal, such alternative sets of claims should be filed with the grounds of appeal, or as soon as possible thereafter."

2.2 The present main and auxiliary requests at issue were all filed with the statement of grounds of appeal. Moreover, the appellants have clearly explained in the statement of grounds in respect of all requests on file the basis of the proposed amendments in the originally filed documents and the reasons for requesting these amendments.

It is also immediately apparent that the amendments vis-à-vis the patent in the form revoked by the opposition division concern essentially features which had been objected to under Article 123(2) EPC during the proceedings before the opposition division. The claims objected to were essentially amended in such a way that the features, which the first instance department had considered unacceptable under

Article 123(2) EPC, and inconsistencies regarding the values of the pressure given in different units in certain claims were removed. The board considers such amendments appropriate to overcome the objections which led to the revocation of the patent in the first instance opposition proceedings. Consequently, the requested amendments are considered admissible under the terms of Rules 57 and 57a EPC.

3. Allowability of the amendment to the main request under Articles 123(2) and (3) and 84 EPC

3.1 Present claim 1 (cf. paragraph VI supra) differs from the wording of claim 1 as originally filed (cf. paragraph I supra) by the following features:

- (i) ..... vegetable product **"selected from the group of spices and leafy herbs"** so as to reduce loss of volatile material.....; and
- (ii) .....time period sufficient **"for the vegetable product to be exposed to the steam for between 10 seconds and 5 minutes and"** to reduce the bacteria present .....

Feature (i) is derivable from the wording in originally filed claim 1 "raw vegetable product such as **leafy herbs, spices** and the like" and even more clearly and unequivocally from the statement in the paragraph bridging pages 2 and 3 of the application as filed: "The present invention overcomes the foregoing difficulties by providing an environmentally safe yet highly economical and efficient process for handling raw vegetable product such as **spices and leafy herbs** without sacrificing their appearance, .....

The wording of feature (i) in present claim 1 is thus adequately supported by the originally filed documents and makes it, in the board's judgment, entirely clear that the kinds of raw vegetable product subjected to sterilization in the claimed process in the contested patent include **(a) spices** and **(b) leafy herbs**. The board is therefore unable to share the opinion of the respondents 02 expressed during the appeal proceedings (see letter of 2 August 1995, point 1) that feature (i) contravenes either Article 123(2) or Article 84 EPC.

Feature (ii) refers to the periods of time specified in originally filed claims 2 and 3 and is also clearly and unequivocally derivable from the statement in lines 24 to 26 on page 8 of the application as filed:

"Sterilizing steam will then be injected for a limited amount of time, preferably from about **10 seconds up to 5 minutes**, ....."

- 3.2 Dependent claims 2 to 4 correspond to originally filed claims 4 to 6.
- 3.3 Dependent claim 5 is based on originally filed claim 7. The conversion of the pressure values, originally given in claim 7 only in units of psig, into units of kPa and the indication of these values in present claim 5 in both units complies with the requirements of Rule 35(12) EPC. The acronym psig stands for "pounds per square inch gauge", whereby is meant what is commonly known as the "relative pressure", i.e. in the present case pounds per square inch over (or below, if the value was negative) the prevailing atmospheric pressure. Hence, in the board's judgment, the conversion made in claim 5 is correct and does not, contrary to the opinion of respondents 01 (see letter of 24 May 1995, especially the paragraph bridging pages 8 and 9), contravene Article 123(2) EPC.

3.4 Dependent claims 6 to 12 correspond to originally filed claims 8 to 14.

3.5 Independent claim 13 is based on originally filed claim 15. The raw vegetable product is now defined as **"selected from the group of spices and leafy herbs"** in the same manner as in claim 1 and on the basis of the same disclosures as mentioned in point 3.1 (*supra*).

The typing error, where the term "while" was duplicated in originally filed claim 15 (see page 15 as filed, lines 25 to 26) has been corrected in its replacement, i.e. present claim 13. The pressure values given in original claim 15 only in units of psig are in present claim 13 also indicated in units of kPa in the same manner as explained in point 3.3 (*supra*).

3.6 Independent claim 14 results from the combination of originally filed claims 16 and 17.-The raw vegetable product has been defined as **"selected from the group of spices and leafy herbs"** in the same manner as in claim 1 and on the basis of the same disclosures as mentioned in point 3.1 (*supra*).

3.7 Finally, dependent claims 15 and 16 correspond to originally filed claims 18 and 19.

In conclusion, all the amendments introduced into present claims 1 to 16 are adequately supported by the originally filed documents and comply in this respect with the provisions of Article 123(2) EPC.

3.8 Compared with the independent claims 1 (see paragraph II *supra*), 15 and 16 as granted, the corresponding independent claims 1, 13 and 14 as amended (see paragraph VI *supra*) are limited, with respect to the raw vegetable products used, to those

selected from the group of spices and leafy herbs and confer, in view of this additional technical feature, less protection. The amendments to present claims 1 to 16 are therefore also acceptable under the terms of Article 123(3) EPC.

- 3.9 Since Article 84 EPC is not one of the grounds for opposition mentioned in Article 100 EPC, the clarity of the claims has, at this stage, only to be examined with respect to the amendments introduced during the opposition proceedings. Both the features (i) and (ii) mentioned above are clear in themselves and contribute to the clarity of the claims as a whole by defining more precisely the kinds of vegetable products to be sterilized and the period of time for exposing them to the steam treatment.

The conversion of the units given for the pressure values complies with the requirements of Rule 35(12) EPC. Thus all the amendments are clear within the meaning of Article 84 EPC.

- 3.10 In conclusion, the main request is allowable because all the amendments comply with the requirements of the EPC. It is therefore not necessary to consider the allowability of the alternative requests.

4. *Remittal to the department of first instance  
(Article 111(1) EPC)*

- 4.1 In accordance with decision T 133/87, dated 23 June 1988, Article 111(1) EPC does not guarantee the parties an absolute right to have all the issues in the case considered by two instances. Rather, this is a matter of discretion which is left to the board depending upon the complexity of the matter and all the circumstances of the individual case. Since proceedings before the



boards of appeal are primarily concerned with the examination of the contested decision (see in this respect decision G 10/93, OJ EPO 1995, 172), a case is, in the absence of particular circumstances, normally remitted, if essential questions regarding patentability or sufficiency have not yet been examined and decided by the department of first instance.

In particular, remittal is regularly considered by the boards in cases where a first instance department issues a decision solely upon **one particular issue** which is decisive for the case against a party and leaves other essential issues outstanding. If, following appeal proceedings, the appeal on **the particular issue** is allowed, the case is normally remitted to the first instance department for consideration of the undecided issues (cf. Paterson, The European Patent System, London 1992, page 90, number 2-83; Moser, Europäisches Patentübereinkommen, Münchner Gemeinschaftskommentar, 1997, Article 111, 6.1).

- 4.2 The observations and comments made above apply fully to the present case. The opposition division gave its decision solely upon **the particular issue** of added subject-matter during opposition proceedings (Article 123(2) EPC), but left all the essential issues of novelty (Articles 52(1), 54 EPC), inventive step (Articles 52(1), 56 EPC) and sufficiency of disclosure and reproducibility of the invention (Article 83 EPC) undecided. These issues, however, form the basis for the oppositions of both respondents under Article 100(a) and (b) EPC, and must therefore be considered as the essential **substantive issues** in the

present case. Taking this into account, and also the **complexity of the present case**, the board is of the opinion that all the essential issues raised in the present case against the patentability and sufficiency should be examined by the opposition division.

- 4.3 The board is aware that in the present case the decision of the opposition division dates from September 1994. However, it also considers it necessary to emphasise, that this is one of the rather rare cases where neither an opinion of the first instance department on the relevant questions of novelty and inventive step of the subject-matter of the contested patent nor an opinion on the sufficiency of disclosure and reproducibility of the invention is available, although the validity of the patent has been challenged by the respondents on all the aforementioned grounds and has been strongly defended by the appellants.

The present board, responsible for this case since 1 October 1997, communicated on 30 December 1997 its preliminary opinion to the parties inviting them to reconsider their requests for oral proceedings at this stage. Notwithstanding this, respondents 01 decided to accept a further delay in the procedure by raising for the first time in their letter of 20 May 1998 their new objection as to the admissibility of the appeal under Article 107 EPC.

Thus, in view of the above considerations and having carefully weighed up both the possible disadvantages of a further delay in the procedure and also the possible consequences of depriving any party of the opportunity of two readings of all the undecided issues, the board maintains its position that, **in the particular circumstances of the present case**, it is justified and even necessary to remit the case to the opposition division for further and proper prosecution.

4.4 According to Article 111(1) EPC the department of first instance is required to take its own further decision on the merits of the case, without the board having given any ruling on the outcome to be expected. The purpose of referral back to the first instance department is to afford that instance the opportunity to consider and decide independently on the issues previously not dealt with. Thus, the board is unable to share the concern of respondents 01, expressed in writing and during oral proceedings, that the decision of the board concerning the allowability of the amendments under the terms of Article 123(2) EPC could have an impact on the decision of the opposition division on the grounds for opposition mentioned in Article 100(a) and (b) EPC, which have been invoked by the opponents in the present case but have not yet been decided on.

**Order**

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

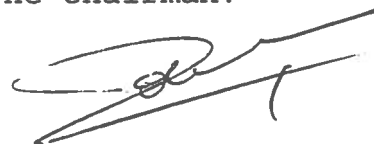
1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:



P. Martorana

The Chairman:



P. A. M. Lançon

GR  
12

