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D E C I S I O N
of 29 May 1998

Case Number: T 0939/94 - 3.3.4

Application Number: 88201374.1

Publication Number: 0298552

IPC: A23L 1/226

Language of the proceedings: EN

Title of invention:

Process for the preparation of a flavoured foodstuff as well as a foodstuff obtainable by such a process

Patentee:

Unilever N.V., et al

Opponent:

Krayer, Warner Dirk

Headword:

Flavoured Foodstuff/UNILEVER

Relevant legal provisions:

EPC Art. 123
EPC R. 67

Keyword:

"Amendment - allowable"
"Procedural violation - no"

Decisions cited:

G 0001/93, T 0201/83, T 0343/90

Catchword:

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Case Number: T 0939/94 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 29 May 1998

Appellant:
(Proprietor of the patent) Unilever N.V.
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Respondent:
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Representative:
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 7 October 1994
revoking European patent No. 0 298 552 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairwoman: U. M. Kinkeldey
Members: D. D. Harkness
W. Moser

Summary of Facts and Submissions

- I. European patent application No. 88 201 374.1, having the title "Process for the preparation of a flavoured foodstuff as well as a foodstuff obtainable by such a process" was filed with 16 claims. Claim 1 read as follows:
- "1. Process for preparing flavoured foodstuff, characterized in that at least 0.05% (w/w) oxidized butterfat having an n-pentanal content of more than 0.5 ppm and/or a 2-trans-nonenal content of more than 0.05 ppm is added to edible material."
- II. During the examination procedure claim 1 was amended to include a reference to the oxidised butterfat "having a peroxide value of at least 0.7", and in dependent claim 13 the amendment "has a peroxide value of at least 1,5." was made. The so amended application was granted as European patent No. 0 298 522.
- III. The patent was opposed by the respondent (opponent) on the grounds of lack of novelty, lack of inventive step and that the subject-matter extended beyond that of the application as filed (Article 100(a) and (c) EPC).
- IV. In its decision the Opposition Division revoked the patent on the ground that the subject-matter extended beyond the content of the application as filed, (Articles 123(2), 100(c) and 102(1) EPC). The decision made no comment upon novelty or inventive step.
- V. In its decision the Opposition Division stated that, although it was agreed that the peroxide value and aldehyde content of the oxidised butterfat were parameters independent from each other, the peroxide values were closely associated with other features of

the specific examples. As was demonstrated by the examples, each example used different specific techniques and parameters in order to reach specific peroxide and aldehyde values. Since example 2 had provided a sample of oxidised butterfat of peroxide value 0.7 in combination with the stated quantities of aldehydes, the patent disclosure had not described how a peroxide value of 0.7 would be achieved in combination with low amounts of aldehydes referred to in the claim. Accordingly, the granted amended claim 1 and also claim 13 to which analogous reasons applied did not comply with Article 123(2) EPC.

- VI. The appellant (patentee) filed an appeal and paid the appeal fee. A statement of grounds was filed and, as an auxiliary request, oral proceedings were requested.
- VII. The respondent (opponent) replied to the appeal.
- VIII. The appellant's arguments may be summarised as follows:

The questions to be answered in respect of the allowability of the amendments to claims 1 and 13 having regard to the Board of Appeal decision T 201/83 (OJ EPO 1984, 481) were:

- (i) Did the amendment generate any novel subject-matter with respect to the application as filed and did it represent a reduction of a range to a value already envisaged within the document?
- (ii) Could the skilled man have readily recognized this value as not so closely associated with the other features of the example as to determine the effect in a unique manner and to a significant degree?

With regard to question (i) there was no generation of new subject-matter because the inclusion of a lower limit represented a limitation of the claimed subject-matter which was already envisaged in the specification of the patent in suit. Peroxide values of 0.1 to 0.5 meq O₂/kg were those exhibited by butter which was fit for human consumption, thus the 0.7 limit was a minimum applicable to oxidised butterfat. The 0.7 and 1.5 peroxide values were disclosed in the examples, which also showed that these values were not directly linked with particular aldehyde levels. It was seen from examples 1 and 2 that the higher 3.0 peroxide level of example 1 was associated with lower aldehyde levels than were disclosed in example 2 which referred to a peroxide value of 0.7.

Question (ii) had to be answered in the affirmative because aldehydes were at least partly responsible for the butter-like flavour whilst peroxides did not have any influence on taste and the skilled worker would know that. Also it was pointed out that the invention related to a process "in which oxidised butterfat was used to flavour a foodstuff, and this process in itself was quite independent of the process details by which the butterfat was oxidised.

A procedural violation was made by the Opposition Division because it refused to discuss a Board of Appeal Decision T 343/90 (of 26 May 1992) and gave no reason for not doing so. The Opposition Division therefore seriously biased the discussion on an issue highlighted by itself and then took the decision on grounds upon which the appellant had no opportunity to present comments thus violating Article 113(1) EPC.

IX. The respondent's arguments may be summarised as follows:

It was undisputed that the peroxide value and the aldehyde levels were independent parameters and therefore the peroxide value of 0.7 had to depend on the process parameters used in the production of the oxidised butterfat. This specific peroxide value was only mentioned in respect of the butterfat oxidation process of example 2 and therefore the combination of this peroxide value with the low amounts of n-pentanal and 2-transnonenal aldehydes in claim 1 constituted a new contribution to the subject-matter claimed and therefore in the light of Enlarged Board of Appeal Decision G 1/93 (OJ EPO 1985, 60) and Board of Appeal Decision T 201/83 (see above) was not allowable under Article 123(2) EPC.

X. In a provisional opinion given in a communication, the Board indicated that the decision of the opposition division would be set aside and that the matter would be remitted to the first instance for further prosecution.

A refund of the appeal fee was not envisaged because the factual situation in Board of Appeal Decision T 343/90 (see above) was different from that of the patent in suit and the refusal by the opposition division to consider it could not give rise to a procedural violation within the meaning of Rule 67 EPC. The appellant was requested to indicate whether or not in the light of these circumstances the request for oral proceedings would be maintained.

XI. The appellant withdrew his request for oral proceedings in a letter dated 30 September 1997.

XII. The appellant requested;

- (i) that the decision under appeal be set aside and that the patent be maintained as granted, or
- (ii) that the decision under appeal be set aside and that the case be remitted to the Opposition Division for examination according to Article 100(a) EPC, and
- (iii) that the appeal fee be reimbursed pursuant to Rule 67 EPC.

The respondent requested;

- (i) that the appeal be dismissed.

Reasons for the Decision

Article 123(2)(3) EPC.

1. The process claimed in claim 1 of the European patent application as filed made no reference to a peroxide value for the oxidised butterfat used for food flavouring. However, such a value does appear to be a well known parameter in this art and was referred to in the **description** of the application as filed relevant to oxidised butterfat preparations. Example 2 gave a specific value of 0.7, the figure now quoted in claim 1. This figure now specified as a minimum does represent a limitation in respect of which oxidised butterfats may be employed in the process claimed, because those oxidised butterfats of lower peroxide value^{*} are now excluded from the scope of protection conferred by the amended claims. Thus, there is no violation of Article 123(2)(3) EPC.

2. It was agreed by the Opposition Division (page 4 of the decision), the appellant and the respondent that the peroxide value and the aldehyde value were **independent** parameters and if this is the case there can be no objection to the inclusion in claim 1 of the 0.7 peroxide value taken from the preparation of the oxidised butterfat employed in example 2 because it may be associated with any aldehyde value without imparting any new technical teaching. Since this peroxide value was disclosed in the description of the application as filed it cannot be regarded as an added technical feature which contributes something over and above what was already there. Accordingly the amendment made does not make a technical contribution to the claimed subject-matter and is allowable under Article 123(2) EPC.

3. The Opposition Division considered that the peroxide and aldehyde values of the oxidised butterfats which are to be used for flavouring were linked with the specific methods (see examples) by which they were made. However, the description of the application as filed at page 3 lines 26 to 34 indicates general methods for preparation of the oxidised butterfats which enable the skilled person to make them, thus the specific values for peroxide and aldehyde are obtainable using conventional methods known to the skilled person. In these circumstances the oxidised butterfat preparative details are not inextricably linked with the said values and do not constitute essential features for claims of the invention which are directed to the **subsequent** flavouring process comprising the step of adding the oxidised butterfat to edible material.

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4. The amendment does not therefore give rise to added subject-matter as indicated in Enlarged Board of Appeal Decision G 1/93 (OJ 1994, 541), which (see paragraph 16 of the reasons) did not allow amendments giving rise to a "technical contribution" to the subject-matter of the claimed invention.

5. The circumstances of this amendment are not comparable with those specified in Board of Appeal Decision T 201/83 (see above paragraph 12) because in that case an amendment was made to a claim by taking a feature from an example of the invention.

6. The above reasoning applies *mutatis mutandis* to the amendment made to claim 13 by which the peroxide value, being an independent feature, of at least 1.5 was introduced. This peroxide value was given as a feature of the oxidised butterfat used in example 5 disclosed in the description of the application as filed.

Procedural violation and refund of appeal fee, Rule 67 EPC

7. With regard to the allegation of procedural violation two points were raised by the appellant:
 - (a) the first was that the Opposition Division seriously biased the discussion on a key issue of the opposition and took a decision on grounds on which the appellant did not have an opportunity to present comments Article 113(1) EPC. It appears that the Opposition Division up to and including the oral proceedings were of the opinion that the peroxide level and aldehyde content were closely linked, but in the written decision changed its mind on this. It seems therefore that the appellant has not been given the opportunity to

comment on this aspect of the decision. However this change of mind did not disadvantage the appellant. Rather, it supported his case by disassociating these two features. On this basis a substantial procedural violation has not taken place.

- (b) the second point was that the Opposition Division refused to allow discussion of T 343/90 (see above) which was intended to support the appellant's case. However, the circumstances of the amendment made in the patent in suit differ from the factual situation in Board of Appeal Decision T 343/90 (see above) in which the amendment was of a different nature because the features in question belonged only to examples of the invention claimed. Therefore this decision need not be taken into account and failure to do so by the Opposition Division did not constitute a substantial procedural violation.

Since there is no substantial procedural violation, the appeal fee cannot be refunded pursuant to Rule 67 EPC.

Remittal to the first instance, Article 111(1) EPC.

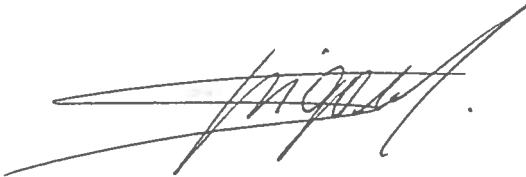
9. The opposition also included objections on the grounds of lack of novelty and inventive step upon which the Opposition Division did not express any opinion. In order to safeguard that these matters may be decided by two instances the Board makes use of its power under Article 111(1) EPC and thus the case is remitted to the Opposition Division for these matters to be considered, on the basis of the claims of the patent in suit as granted.

Order

For these reasons it is decided that:

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

The Registrar:



D. Spigarelli

The Chairwoman:



U. Kinkeldey

