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D E C I S I O N
of 11 June 1996

Case Number: T 0013/95 - 3.3.4

Application Number: 88105223.7

Publication Number: 0288773

IPC: A23L 1/28

Language of the proceedings: EN

Title of invention:
Mushroom flavour

Patentee:
SOCIETE DES PRODUITS NESTLE S.A.

Opponent:
CPC Maizena GmbH

Headword:
Mushroom flavour/NESTLE

Relevant legal provisions:
EPC Art. 123(2)(3), 111(1)

Keyword:
"Amendments - Article 123(2) and Article 123(3)"
"Remittal (yes)"

Decisions cited:
T 0063/86

Catchword:
-



Case Number: T 0013/95 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 11 June 1996

Appellant: SOCIETE DES PRODUITS NESTLE S.A.
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Respondent: CPC Maizena GmbH
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 30 November 1994
revoking European patent No. 0 228 773 pursuant to
Article 102(1) EPC.

Composition of the Board:

Chairman: L. Galligani
Members: D. D. Harkness
S. C. Perryman

Summary of Facts and Submissions

I. European patent No. 0 288 773 relating to a process for producing a mushroom flavourant was granted on the basis of 15 claims contained in European patent application 88 105 223.7. Claim 1 as granted read as follows:

"1. A process for producing a mushroom flavourant which comprises homogenising mushrooms and, during or after homogenisation, contacting the mushrooms with an aqueous medium contain a water-soluble salt of linoleic acid and oxygen."

II. The Opponent and Respondent to this appeal CPC MAIZENA GmbH filed an opposition against the grant of the patent raising objections under Article 100(a) and (b) EPC.

III. In reply to the opposition the Patentee and Appellant SOCIETE DES PRODUITS NESTLE S.A. filed an amended set of claims later replaced by a main request and four auxiliary requests filed on 4 November 1994 before oral proceedings took place on 8 November 1994.

IV. The patent was revoked by the Opposition Division under Article 102(1) EPC on the sole ground that none of the requests complied with Article 123(2) EPC.

This decision was reached because the main request and first three auxiliary requests referred to a feature not forming part of the application as originally filed, namely, "a 1-octen-3-ol content of the mushroom homogenate greater than 400ppm", and the fourth auxiliary request referred to a time of "within 80 seconds after homogenisation." also a feature not justified by the original disclosure.

- V. The Appellant filed an appeal against the decision, paid the appeal fees and submitted on 29 March 1995 a Statement of Grounds. This latter was accompanied by a new set of twelve claims, the main claim of which did not make reference to either of the features objected to under Article 123(2) EPC by the Opposition Division. Amended description pages 1 and 2 were also filed therewith.
- VI. The Respondent replied to the appeal but did not comment upon matters arising under Article 123(2) or (3) EPC.
- VII. In a communication pursuant to Article 11(2) of the Rules of procedure of the Boards of Appeal and Rule 71a EPC the parties were summoned to oral proceedings and informed that the Board intended only to discuss matters arising from Article 123(2) and (3) EPC at the oral proceedings.
- VIII. Both parties replied that in the event that only the Article 123 EPC issues would be discussed, then such proceedings were not necessary. They were accordingly cancelled.
- IX. The Appellant filed a corrected set of twelve claims on 16 April 1996 identical to the set of claims filed with the appeal except for an amendment made to bring claim 4 into agreement with the original disclosure of 28 rather than 25 degrees Centigrade. The new main claim reads as follows:

"A process for producing a mushroom flavourant for foodstuffs which comprises providing an aqueous medium containing a solution of a water-soluble salt of linoleic acid and homogenising mushrooms in the presence of said aqueous medium, introducing, during or after homogenisation, oxygen into the homogenised mushrooms,

and adding at least one of a flavouring plant extract additive, of an edible oil additive and of a carrier additive suitable for spray drying the homogenate."

Claims 2 to 12 are appendant to the main claim. Of them, claims 10 to 12 are in the form of "product-by-process".

- X. The Appellant requested that the decision of the Opposition Division be set aside and that the case be remitted to the first instance for further prosecution on the basis of the newly filed claims and amended description pages.

The Respondent stated that there existed no objection in respect of Article 123 EPC against the presently filed claims and that he agreed to a continuation of the prosecution in writing.

Reasons for the Decision

1. The appeal is admissible.

Fair basis (Article 123(2) EPC).

2. The claim 1 now put forward requires:

(a) the characteristics specified by originally filed claim 1, and

(b) the characteristics specified in one or other of originally filed dependent claims 2 or 3 (thus excluding the possibility of mushrooms being

homogenised first and only thereafter being contacted with an aqueous medium containing a water-soluble salt of linoleic acid), which claims were each dependent on original claim 1 and

- (c) the characteristics specified in originally filed claim 7 dependent on any of originally filed claims 1, 2 or 3.

2.1 There appears thus to be an explicit basis in the application as originally filed for the claim 1 now put forward, and the change in dependencies has not directed the claim to combinations not previously envisaged. Thus the requirements of Article 123(2) EPC are met for claim 1. The Board notes that the Respondent also shares this opinion.

2.2 The eleven dependent claims 2 to 12 now put forward correspond word for word (except for revised claim dependencies) to dependent claims 2 to 6, 8, 9, and to product-by-process claims 12 to 15, respectively as originally filed.

2.3 The changes in claim 1 and the changes in the dependencies, mean that some combinations are now specifically claimed, for example claim 9 when dependent on claims 4, 5, 6 or 7, which were not specifically claimed in the claims as originally filed. However the Board considers that the description, for example the passage at lines 40 to 41 of column 4 (referring to the B1 specification but appearing in identical form in the application as filed) would be read by the skilled person as meaning that all the combinations now specifically claimed are suitable, so that no Article 123(2) EPC objection arises on this.

- 2.4 The corresponding amendments to the description do not result in any added matter and are therefore admissible under Article 123(2) EPC.

No extension of scope of claims (Article 123(3) EPC).

3. The only independent process claim, claim 1, has been restricted compared to granted process claim 1.

- 3.1 The broadest product claim, claim 10, now claims the product of the process of new claim 1, which process has been restricted compared to that referred to in the broadest product claim, claim 13, as granted. Thus the present broadest product claim does not have a broader scope than the broadest product claim granted.

- 3.2 On this basis the Board sees no objections under Article 123(3) EPC to the claims now put forward.

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

4. The decision of the first instance was based solely on Article 123(2) EPC. The request now on file has not been considered by the first instance at all. To avoid a loss of instance, the Board, being satisfied that the Article 123(2) EPC objection has been removed remits the case to the first instance for further consideration.

- 4.1 Remittal to the first instance is necessary as the amendments made to the claims are significant and no decision was issued by the Opposition Division in respect of novelty and inventive step.

- 4.2 This decision is in line with previous decisions of the Boards of Appeal, in particular T 63/86 (OJ 1988, 224, at paragraph 2 of the reasons).

Order

For these reasons it is decided that:

1. The decision of the Opposition Division is set aside.
2. The case is remitted to the Opposition Division for further prosecution on the basis of claims 1 to 12 filed on 16 April 1996 and amended description pages 2 and 3 filed on 29 March 1995.

The Registrar:



L. McGarry

The Chairman:



L. Galligani

