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D E C I S I O N
of 20 January 1998

Case Number: T 0618/95 - 3.2.3

Application Number: 88312086.7

Publication Number: 0373274

IPC: B02B 3/00

Language of the proceedings: EN

Title of invention:
Process for use in flour milling

Patentee:
Tkac & Timm Enterprises Limited

Opponent:
Satake Corporation

Headword:
-

Relevant legal provisions:
EPC Art. 54(3), 100, 111(1)

Keyword:
"Novelty - prior European applications"
"Opposition grounds - amendments"
"Decision re appeals - remittal (yes)"

Decisions cited:
G 0010/91

Catchword:
-



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Boards of Appeal

Chambres de recours

Case Number: T 0618/95 - 3.2.3

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 20 January 1998

Appellant: Tkac & Timm Enterprises Limited
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 1 June 1995
revoking European patent No. 0 373 274 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: C. T. Wilson
Members: F. Brösamle
M. Aúz Castro

Summary of Facts and Submissions

- I. The appellant (proprietor) lodged an appeal on 24 July 1995 - paying the appeal fee on the same day and filing the statement of grounds of appeal on 4 October 1995 - against the decision of the opposition division of 1 June 1995 to revoke European patent No. 0 373 274.

The opposition division had expressed the view that the subject-matter of claim 1 underlying the decision lacked novelty with respect to

(D1) EP-A-0 295 774

which has to be considered under the terms of Article 54(3) EPC (date of publication 21 December 1988).

- II. Following the board's communication pursuant to Article 110(2) EPC dated 9 September 1996 the proprietor, with letter of 22 October 1996, received on 24 October 1996, filed a proposed main claim which reads as follows:

"1. A process for treating clean dry wheat kernels (2) having an endosperm (6) and a germ (8) encased in a layered bran coat (4), said process being intended to substantially remove the exposed bran coat (4) and being characterised by comprising, prior to the tempering and conditioning step of a conventional milling process, the following steps, while maintaining the endosperm (6) substantially integral: mixing in a dampening mixer, the clean dry wheat kernels (2) with water in an amount equalling about 1 to 3% by weight of the kernels (2), sufficient to condition the outer layers (14,16,18,20) of the bran coat (4) without fusing the layers (10,11,12,14,16,18,20) together;

after mixing, holding the kernels (2) in a holding bin (302,405) for a period of between one and about five minutes, feeding the kernels in a continuous stream through friction operations to substantially remove and separate the four outer bran layers (14,16,18,20); and feeding said kernels (2) in a continuous stream through abrasion operations to remove and separate the inner bran layers (10,11,12)."

III. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of claim 1 filed on 24 October 1996.

IV. The opponent - respondent in the following - requested that the appeal be dismissed.

V. In the oral proceedings of 20 January 1998 the parties essentially argued as follows:

(a) appellant:

- in claim 1 it is now made clear that holding the kernels takes place after mixing and in a holding bin;
- the holding time "of between one and about five minutes" according to the characterising clause of claim 1 is the time in which the kernels are in the holding bin and has nothing to do with any time period in which the kernels are in the dampening mixer; the above time is clearly disclosed in the patent specification, see for instance granted claim 10;
- the indication "about five minutes" as holding time in the holding bin is not seen to violate the requirements of Article 123 EPC and furthermore any objection against "about" could

have been made by the respondent in the opposition proceedings so that the board only should examine the amendments made to claim 1 and not claim 1 as a whole;

- based on the principles laid down in G 10/91 of the Enlarged Board of Appeal the appellant does not give his agreement to discussing a new ground of opposition, namely Article 100(c) EPC;
- claim 1 discloses subject-matter which is novel over the disclosure of (D1); (D1) is based on a "batch process" i.e. a process in which the kernels are held in the dampening mixer and which is therefore discontinuous since the dampening mixer has to be stopped during the holding period of the kernels;
- claim 16 of (D1) only indicates the process steps for treating the kernels, namely dampening-standing-passing to friction means without specifying where dampening takes place; a skilled reader would therefore turn to the description of (D1) and learn therefrom that the holding step of the kernels is carried out in the dampening mixer, see column 4, lines 41 to 43 of (D1); while the steps of dampening and passing the kernels to the friction machine are specifically defined in claim 16 of (D1) by structural features this is not the case for the step of holding the kernels so that a whole contents approach leads to the result that the subject-matter of claim 1 is novel over (D1);
- under these circumstances the decision under appeal cannot be upheld; the case should therefore be remitted to the opposition division for further prosecution.

(b) respondent:

- the term "about" five minutes for the holding period cannot be derived from the originally filed documents of (D1), see for instance claims 4, 7 and 8; this feature is moreover not clear within the meaning of Article 84 EPC;
- it is not allowable to not consider the residence time of the kernels when they are in the dampening mixer in claim 1 since this time period also has an effect on the kernels;
- (D1) does not literally mention a holding bin; this document read, however, by a skilled person pushes a skilled reader with feature "b" of its claim 16 to a "holding bin" in which the dampened kernels can be held for a specific time period (for instance 15 to 60 seconds);
- holding the kernels in a (separate) holding bin no longer blocks the dampening mixer for this purpose so that the process disclosed in (D1) is also to be seen as a continuous process which fully anticipates the subject-matter of claim 1;
- under these circumstances it has to be observed that claim 16 of (D1) already gives a complete technical information to a skilled reader without making it necessary to turn to the description of (D1); Figure 1 of (D1) is moreover only a flow chart of the process according to (D1) and cannot be seen as restricting a skilled person to not foresee a

holding bin; a structured feature for carrying out the method step "b" of claim 16 of (D1) is a must and a skilled person in the art is aware that the structural feature for holding dampened kernels is a holding bin;

- summarizing, (D1) - if seen by a person skilled in the art - is a novelty destroying document with respect to the subject-matter of claim 1 so that the appeal should be dismissed.

- VI. The oral proceedings were concluded by the Chairman giving the Board's decision and informing the parties that the new ground of opposition raised by the opponent was not decided on by the Board.

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments*
 - 2.1 In claim 1 it is now prescribed **when** and **where** holding of the dampened kernels takes place, namely **after** mixing and in a **holding bin**.
 - 2.2 From the wording of the characterizing clause of claim 1 it is moreover clear that the kernels are held in the holding bin "between one and about five minutes".
 - 2.3 Whether or not "about" five minutes is originally disclosed cannot be decided by the board, see opinion G 10/91, OJ EPC 1993, 420, point 18, of the Enlarged

Board of Appeal, since the ground of opposition of Article 100(c) EPC was not raised by the respondent in due time and since the appellant in the appeal proceedings, did not give his agreement to discuss this issue.

It is true that in case of amendments of the claims or other parts of the patent in the course of opposition or appeal proceedings these claims are to be fully examined as to their compatibility with the requirement of the EPC, but only in view of the amendments made and not with respect to the entire claim, see point 19 of the opinion. The word "about" was already contained in granted claim 1 and therefore does not form part of the amendment. Its compliance with Article 100(c) EPC should have been opposed in the notice of opposition.

2.4 It has to be added that **granted** claim 1 already contained the feature "about five minutes" so that claim 1 under discussion was not modified in this respect.

2.5 The amendments made are not open to an objection under Articles 123 and 100(c) EPC.

3. **Clarity**

3.1 Claim 1 is silent about the residence time of the kernels in the dampening mixer.

3.2 The respondent is right with his statement that this residence time has also an influence on the dampening effect of the kernels; it is, however, not justified to derive therefrom that claim 1 lacks clarity within the meaning of Article 84 EPC.

3.3 Whether or not the appellant restricts claim 1 to the residence time of the kernels in the dampening mixer has in the board's opinion nothing to do with the issue of clarity but with the scope of protection sought by the appellant.

3.4 Summarizing, claim 1 is not open to an objection under Article 84 EPC.

4. *Novelty*

4.1 While claim 1 (as granted) underlying the impugned decision did not contain a structural feature with respect to the holding of the dampened kernels claim 1 now on file is restricted to a holding bin in which the kernels are held for a specific time period after mixing.

4.2 The crucial question to be decided is therefore whether or not from the Article 54(3) - document (D1) seen **as a whole** (whole contents approach) a process for treating clean dry wheat kernels with the features of claim 1 is known.

4.3 Prima facie a holding bin as claimed in claim 1 cannot be seen from the claims, description and drawings of (D1) since claim 16 only mentions in its feature (b) "permitting the dampened wheat to stand 15 to 60 seconds" without defining **where** and **how** this process step is carried out. Claim 16 and also Figure 1 of (D1), see reference sign "206", do not therefore directly disclose a holding bin arranged after the dampening mixer.

- 4.4 It is true that a skilled reader had to decide in which way holding of dampened kernels can be achieved. Respondent's finding that the skilled reader of (D1) was in a one-way-street-situation cannot be shared by the board since these findings are not free from an ex-post facto analysis.
- 4.5 Claim 16 and Figure 1 of (D1) not being helpful to decide in which way holding of dampened kernels can be achieved the reader would turn to the description of (D1), for instance to its column 4 lines 41 to 43 and get the information that **holding takes place in the dampening mixer "202"** which means that this mixer cannot be used for mixing/dampening of kernels during the holding time period. (D1) is thus based on a **batch** process, i.e. a **discontinuous** process.
- 4.6 Claim 1 is based, however, on a **continuous** process since the dampening mixer is no longer the structural unit where holding of the kernels takes place since the dampened kernels continuously leave the dampening mixer and are held in a **separate** holding bin. Although claim 1 is not restricted to a "first in - first out" holding bin such a construction is not at all excluded by the wording of claim 1.
- 4.7 Without knowing the claimed process according to claim 1 a skilled person taking into account (D1) **as a whole** does not derive therefrom a holding bin for the dampened kernels arranged after the dampening mixer so that the board is convinced that (D1) is not a novelty destroying document to the process of claim 1, Article 54(3) EPC.
- 4.8 Under these circumstances the reason for revoking European patent No. 0 373 274 no longer exists.

4.9 In accordance with Article 111(1) EPC the board makes use of the possibility to remit the case to the opposition division for further prosecution on the basis of the new claim 1 as set out in the Communication of the board pursuant to Article 110(2) EPC.

Order

For these reasons it is decided that:

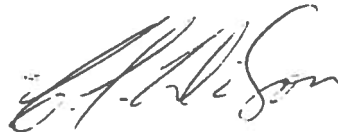
1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:



N. Maslin

The Chairman:



C. T. Wilson

