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D E C I S I O N
of 22 April 1999

Case Number: T 0995/95 - 3.3.2

Application Number: 91200023.9

Publication Number: 0442544

IPC: A23G 1/06

Language of the proceedings: EN

Title of invention:

Method and device for processing chocolate mass

Patentee:

WIENER & CO. APPARATENBOUW B.V.

Opponent:

- (01) Bühler AG
(02) Bauermeister Verfahrenstechnik GmbH
(03) S.A. Martin Lloveras

Headword:

Chocolate/WIENER

Relevant legal provisions:

EPC Art. 52(1), 54(1),(2), 56, 84, 113(1), 123(2),(3)

Keyword:

"Admissibility of claims filed during oral proceedings (yes)"
"Claims allowable under the terms of Articles 84, 123(2), (3)
EPC"
"Rights of the respondents under Article 113(1) EPC satisfied"
"Final decision possible at the end of the oral proceedings"
"Novelty (no)"
"All the technical features of claim 1 clearly and
unambiguously derivable from the prior art"

Decisions cited:

T 0153/85

Catchword:



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Boards of Appeal

Chambres de recours

Case Number: T 0995/95 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 22 April 1999

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted 17 October 1995
revoking European patent No. 0 442 544 pursuant
to Article 102(1) EPC.**

Composition of the Board:

Chairman: U. Oswald
Members: G. F. E. Rampold
 M. B. Günzel

Summary of facts and submissions

I. The appellants are the proprietors of European patent No. 0 442 544 based on European patent application No. 91 200 023.9. According to the communication under Rule 51(4) EPC dated 2 February 1993, the examining division intended to grant the above-identified patent on the basis of 9 claims with independent claims 1 and 7 reading as follows:

"1. Method for mixing and grinding chocolate, fats or the like, wherein a process mass of cacao and/or cacao powder, cacao butter, edible fat, sugar and the like are pre-mixed and ground in a grinding device, **characterized in** that as grinding device is chosen a device for reducing the process mass to a certain particle size with a largely uniform particle size distribution and that the process mass is circulated in a cycle at least consisting of the grinding device and a separate ball mill and is ground to the desired particle size.

7. Installation for performing the method as claimed in claims 1 to 6, formed by a grinding device (1), a separate ball mill (3) connected to the grinding device, a taste-changer (4) connected to the grinding device and the ball mill positioned in a cycle and a pump (2) for circulating the process mass around the installation."

II. Claim 1 in the **printed** European patent specification (EP-B-0 442 544) additionally contains the feature "and a ball mill" at the end of the pre-characterising

portion inserted between the word "in a grinding device" and "characterized in".

By letter dated 8 September 1994 the appellants informed the EPO that the text of claim 1 in the printed European patent specification was inconsistent with the text of claim 1 in the "Druckexemplar" submitted to them with the communication under Rule 51(4) EPC. They requested correction of the printed European patent specification by deleting the feature "and a ball mill" preceding the wording "characterized in" and submitted that this feature had already been deleted from claim 1 in the "Druckexemplar". Its reappearance in the patent specification was thus apparently the result of a printer's error.

III. Notice of opposition against the patent as a whole was filed by:

- (i) respondents (opponents) 01 on the grounds
 - that the subject-matter of the patent opposed is not patentable under Article 100(a) EPC, because of lack of novelty (Articles 52(1); 54 EPC) and lack of inventive step (Articles 52(1); 56 EPC);
 - that the patent opposed does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC; see Article 83 EPC); and

- that the subject-matter of the patent opposed extends beyond the application as filed (Article 100(c) EPC; see Article 123(2) EPC);
- (ii) respondents (opponents) 02 on the ground
- that the subject-matter of the patent opposed is not patentable under Article 100(a) EPC, because of lack of novelty (Articles 52(1); 54 EPC) and lack of inventive step (Articles 52(1); 56 EPC).
- (iii) respondents (opponents) 03 on the grounds
- that the subject-matter of the patent opposed is not patentable under Article 100(a) EPC, because of lack of novelty (Articles 52(1); 54 EPC) and lack of inventive step (Articles 52(1); 56 EPC); and
 - that the patent opposed does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC; see Article 83 EPC).

IV. In support of their allegation of lack of novelty of claims 1 and 7, the respondents relied in the first instance opposition proceedings, *inter alia*, on the following citations which are members of the same patent family and are also referred to in this decision:

(2) DE-A-3 202 929

(3) NL-A-8 300 228

V. In its decision dated 17 October 1995 the opposition division found that the text of claim 1 in the printed patent specification was indeed inconsistent with the corresponding text in the "Druckexemplar" and that the correction of claim 1 requested by the appellants was obvious within the meaning of Rule 88 EPC. Nevertheless, it considered the issue of a corrigendum of the printed patent specification inappropriate in view of the fact that the patent had to be revoked under Article 102(1) EPC on the ground of lack of novelty of claim 1.

In particular, the opposition division concluded that all the technical features of claim 1 of the patent in suit could be derived from citation (2). With reference to some particularly relevant portions of the disclosure of the cited document (see the following references in parentheses), the opposition division found in point 3.1a of the impugned decision that citation (2) was prejudicial to the novelty of claim 1, since (2) already described "a method for mixing and grinding chocolate, fats or the like (claim 1), wherein a process mass of cacao and/or cacao powder, cacao butter, edible fat, sugar and the like (page 1, lines 3 to 5) was pre-mixed (page 1, line 6) and ground in a grinding device (page 1, lines 7 to 8), whereby as the grinding device 6 was chosen a device for reducing the process mass to a certain particle size with a largely uniform particle size distribution (page 1, lines 11 to 12) and the process mass was circulated (page 13,

line 10) in a cycle at least consisting of the grinding device 6 and a separate ball mill 4 and was ground to the desired particle size (page 11, lines 20 ff)".

VI. The appellants lodged an appeal against the decision of the opposition division and requested in the statement of grounds that the decision of the opposition division be set aside and that the patent be maintained on the basis of the claims as granted. Alternatively, they requested maintenance of the patent in amended form, comprising the insertion of the expression "continuously" between the words "is" and "circulated" in claim 1, so that the feature in question read "and that the process mass is continuously circulated in a cycle at least consisting of..... ."

The respondents filed their observations in response to the grounds of appeal and requested that the appeal be dismissed.

VII. Oral proceedings were held on 22 April 1999. At the beginning of the proceedings the board informed the parties that the valid text of claim 1 as granted was that in the "Druckexemplar", submitted to the appellants with the communication under Rule 51(4) EPC, because the decision of the examining division to grant the patent was based on the text of claim 1 as contained in the "Druckexemplar".

Of the three requests submitted during the oral proceedings (including the auxiliary request filed with the statement of grounds) the appellants eventually cancelled all but the request entitled "Auxiliary Request II" and maintained the latter as the sole

request.

Claim 1 (reference signs (a) to (g) added) of said request is worded as follows:

- (a) "Method for mixing and grinding chocolate, fats and the like,
- (b) wherein a process mass of cacao and/or cacao powder, cacao butter, edible fat, sugar and the like
- (c) are pre-mixed and ground in a grinding device wherein as grinding device is chosen a device for reducing the process mass to a certain particle size with a largely uniform particle size distribution and wherein
- (e) the process mass is circulated in a cycle
- (f) consisting of at least a grinding device and a separate ball mill and
- (g) is ground to the desired particle size,
characterized in that
- (d) the process mass is first introduced into the grinding device."**

Independent claim 7 (reference signs (a) to (f) added) is worded as follows:

- (a) "Installation for performing the method as claimed in claims 1-6,

- (b) formed by a grinding device (1),
- (c) a separate ball mill (3) connected to the grinding device,
- (d) a taste changer (4) connected to the grinding device and the ball mill positioned in a cycle and
- (e) a pump (2) for circulating the process mass around the installation,
- (f) wherein an in-feed (5) is connected to the grinding device (1) for introducing the process mass."**

VIII. The appellants' submissions both in the written proceedings and at the oral proceedings can be summarised as follows:

From the reference in claim 1 to "the process mass being circulated in a cycle at least consisting of the grinding device and a separate ball mill", the skilled person would necessarily conclude that what in fact was claimed was a continuous process. This view was supported by the disclosure of the invention in the description of the contested patent, in particular by the statements in column 2, lines 23-24 - "using the pump (2) the process mass can be circulated in the cycle" - and lines 33-35 - "while circulating be then ground successively in the grinding device (1) and the ball mill (3)".

In contrast to this, citation (2) disclosed a batch

process comprising the step of first reducing the particle size in the grinding device 4 of the main circuit to a size small enough to allow their further processing in the roller device ("Walzeinrichtung") 6, as could be derived from the disclosure on page 17, first full paragraph, lines 5 to 7 of citation (2).

The opposition division misinterpreted the state of the art according to (2) by saying that the statement - due to the fixed roll nip a noticeable reduction of the particle size did no longer take place ("Wegen des definierten Walzenspalts findet dabei eine merkliche Zerkleinerung nicht mehr statt"; see end of the 2nd full paragraph on page 17) - referred to the sub-circuit only and not equally to the main circuit.

The grinding device specified in the claims of the contested patent could not be compared with the roller device 6 in citation (2). The essential difference between a grinding device, on the one hand, and a roller device, on the other, was to be seen in the fact that in the latter it was only possible to process particles of a limited size, since larger particles could not enter the roll nip or gap between the rollers of the roller device. This was derivable from the reference at lines 7 to 9 from the bottom on page 11 of (2) stating that only particle fractions in a size range of 50-250 microns could be reduced in size.

Claim 1 of the sole request maintained during the oral proceedings was, moreover, clearly distinguished from the prior art of citations (2) and (3) by the inclusion of the additional feature (d). Even if it were accepted that the process mass was in (2) initially introduced

into the device 8, the figure on page 23 showed clearly that the process mass was in device 8 only pre-mixed or mixed, while in the process of present claim 1 the process mass was pre-mixed or mixed and ground in the grinding device 1.

IX. The respondents' submissions both in the written proceedings and at the oral proceedings can be summarised as follows:

As could be derived from the preamble of claim 1 of the contested patent, the appellants themselves were aware that it was already known to subject a chocolate mass to the steps of both pre-mixing and grinding the mass in a grinding device, followed by further grinding the process mass in a ball mill.

The grinding device 6 used in citations (2) or (3) was in fact a roll mill with an adjustable roll gap or roll nip between the rollers capable of reducing the process mass to the desired particle size. From the disclosure in the cited documents it was entirely clear that the grinding device 6 was incorporated in the cycle for exactly the same reasons as the grinding device in the process according to claim 1 of the patent in suit. Hence, if claim 1 was correctly reformulated by introducing all the technical features known from (2) or (3) into the pre-characterising portion, the only remaining "characterising feature" which could possibly be seen was that of reducing the process mass to a particle size with a largely uniform particle size distribution.

Since the particle size distribution of the process

mass subsequent to its passage through the grinding device was not specified in the contested patent, the only "characterising feature" was in fact meaningless and could therefore not serve to distinguish the claimed process in the contested patent from the prior art of (2) or (3).

The appellants' allegation that the claimed process was a continuous process, while citation (2) disclosed a batch process, did not find any support or substantiation in the disclosure of the invention in the contested patent. Rather, by the submission of an amended claim 1 during the oral proceedings before the board, which contained all the technical features of claim 1 as granted in the pre-characterising portion and from which the reference to a continuous process had been omitted, the appellants themselves admitted that claim 1 as granted was anticipated in its entirety by the cited prior art.

However, the newly introduced feature (d) was also unable confer novelty on claim 1, since it could clearly be seen from the figure on page 23 of (2) that the process mass in (2) was likewise initially fed through feed line 10 directly into the agitator (mixing, stirring) vessel ("Rührwerksbehälter") 8. This device 8 in (2) was equipped with both a stirrer for mixing and a roll mill for grinding the process mass and corresponded according to the explanation given in the description of the contested patent exactly to what was designated in general terms a "grinding device" (1) in claim 1 and was shown as a "black box" in figures 1 and 2 of the patent in suit.

It followed that claim 1 of the appellants' sole request maintained in the course of the oral proceedings likewise lacked novelty.

- X. The appellants requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request (Annex I) named "Auxiliary Request II".

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

Reasons for the decision

- 1. The appeal is admissible.

- 2. *Admissibility of the appellants' request into the proceedings*
 - 2.1 As is apparent from paragraph VI (above), independent claims 1 and 7 of the appellants' sole request differ from the corresponding claims of their requests submitted with the grounds of appeal. Present claims 1 and 7 in amended form were presented for the first time at the oral proceedings before the board.

In decision T 153/85 (OJ EPO, 1988, 1, especially reasons, point 2) it was held that 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 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. According to the established case law of the boards of appeal, a board deciding on an appeal during oral proceedings **may justifiably refuse** to consider alternative claims which have been filed at a very late stage, for example during oral proceedings, if such alternative claims are not clearly allowable under Articles 123(2) and 84 EPC (for details of said jurisprudence see "Case Law of the Boards of Appeal of the European Patent Office", 3rd edition, 1998, VII-D, 14., page 504 et seq.).

2.2 When applying the criteria set forth in point 2.1 above to the facts of the present case, the board's conclusions are as follows:

- (i) It is **immediately apparent** to the skilled reader that the amendments vis-à-vis the application as filed and the patent as granted concern the addition of the technical features (d) to claim 1 and (f) to claim 7. The features in question are **immediately derivable** from the description, which consists of **less than three full pages**, and from the drawings 1 and 2 of the application as filed. In these circumstances, the board considered the amended independent claims 1 and 7 of the appellants' present request to be clearly allowable under the terms of Articles 123(2) and (3) and 84 EPC (see for more details point 3 below). All three respondents fully concurred with the board's opinion in this respect.

- (ii) The claims of the appellants' requests submitted with the grounds of appeal were found during the oral proceedings to be unacceptable under the terms of Article 123(2) or (3) EPC. Hence, the sole remaining request represented the appellants' attempt to overcome both this objection and the objection to lack of novelty, which was the ground for the revocation of the patent in the first-instance opposition proceedings, by introducing an additional technical feature in each of the independent claims for the purpose of delimiting the claimed subject-matter in the patent in suit from the cited state of the art. The proposed amendments were thus made in the reasonable attempt to reverse the impugned decision and the objections raised in the oral proceedings by the board by suitably restricting the claims and are therefore considered to be necessary and appropriate.
- (iii) During oral proceedings the respondents gave the board a positive indication, before the decision was announced, that they were fully able to understand the meaning and technical relevance of the amended claims 1 and 7 and that they had sufficient and adequate opportunity to present their comments on the newly filed claims. The respondents' rights under Article 113(1) EPC were accordingly satisfied.

Hence, in spite of the fact that claims 1 and 7 of the actual request were submitted at such a late stage, the board was able to give a final

decision at the end of the oral proceedings, and the legal conflict (i.e. the opposition appeal) could be brought to a close.

2.3 In these circumstances the board exercises its discretion in favour of admitting the request filed during oral proceedings into the appeal proceedings.

3. *Allowability of the amendments to claim 1 under the terms of Articles 123(2) and (3) and 84 EPC*

3.1 The features (a) to (c) and (e) to (g) in the pre-characterising portion of claim 1 are the identical repetition of the features contained in claim 1 as originally filed, with the sole exception that features (e) to (g), which formed the characterising portion of the originally filed claim 1, have now been introduced in the pre-characterising portion of present claim 1.

The characterising feature (d), ie "the process mass is first introduced into the grinding device", can be derived from the references in the description to figures 1 and 2 on page 3, lines 3 to 4 and 9 to 10, of the application as filed, where it is stated:

"designated in the drawings with the reference numeral (1) is a grinding device in which the components of the process mass for processing are pre-mixed and ground" (lines 3 to 4); and

"the components for mixing and grinding are introduced into the unit (1) through the in-feed (5)" (lines 9 to 10).

The features (a) to (g) in claim 7 can be derived from claim 1 as originally filed.

Feature (f) reading "wherein an in-feed (5) is connected to the grinding device (1) for introducing the process mass" finds adequate support in the application as filed essentially by the same portions of the original disclosure which are mentioned above as the support for feature (d) in claim 1.

Claims 1 and 7 as amended are therefore adequately supported by the originally filed application documents as required by Article 123(2) EPC.

- 3.2 Present claims 1 and 7 contain, compared with the corresponding claims as granted (see paragraph I *supra*), the additional technical features (d) and (f), respectively. Such claims confer less protection and are therefore acceptable under the terms of Article 123(3) EPC, too.
- 3.3 As to clarity of the amended claims, Article 102(3) EPC does not allow objections to be based upon Article 84 EPC if such objections do not arise out of the amendments made in the course of the opposition proceedings (see eg decision T 301/87, OJ EPO 1990, 335, especially reasons, points 3.7 and 3.8). This means that, at this stage, the board has only the power to examine whether the amendments to claims 1 and 7, respectively, introduce any contravention of Article 84 EPC with regard to clarity and support.

In the board's judgment, feature (d) introduced in claim 1 as amended makes it sufficiently clear that the

claimed method for mixing and grinding chocolate, fats or the like is started by feeding the components for mixing and grinding or, expressed differently, by feeding the process mass via the in-feed (5) into the grinding device (1) before it is transferred from the grinding device (1) into the cycle shown in figures 1 and 2 for further processing.

Similarly, feature (f) which has been added to claim 7 takes account of the fact that the grinding device (1) is suitably equipped with an inlet, termed in-feed (5), for introducing the components to be mixed and ground, ie the process mass, into the grinding device (1) before its further processing is started.

Hence, the amended claims 1 and 7 are, in the board's opinion, not open to an objection under Article 84 EPC resulting from the inclusion of the features (d) and (f), respectively, in said claims.

4. *Novelty (Article 100(a) in conjunction with Article 54 EPC)*

4.1 The first question to be decided in this respect is whether the method for mixing and grinding chocolate, forming the subject-matter of claim 1 of the appellants' request (see paragraph VI above) is indeed anticipated by the disclosure of citation (2), as maintained by the respondents during the oral proceedings before the board.

In accordance with the established jurisprudence of the boards of appeal, in order to decide this question, it is necessary to consider whether the claimed method is

derivable directly and unambiguously from the disclosure of citation (2) as a whole, including any features implicit to a person skilled in the art in what is expressly mentioned citation (2).

4.2 Therefore, consideration has to be given to the actual information imparted to the skilled person by the disclosure of citation (2).

(a) Feature (a) of claim 1 of the contested patent ("method for mixing and grinding chocolate, fats and the like") is derivable from (2) on the basis of the following disclosure in the cited document: citation (2) discloses a **process** and device for producing various types of **chocolate masses or fats** (see especially page 7, lines 1 and 2, or claim 1: "Schokolademasse, Kuvertüre, Fettglasuren und dergleichen"). The process as a whole disclosed in (2) comprises at least the steps of

- (i) **stirring, ie mixing, the chocolate mass or fats in an agitator (mixing, stirring) vessel** ("Rührwerksbehälter"), and
- (ii) **grinding the mass (reducing the particle size) in a comminution (disintegration) device or mill** ("Zerkleinerungseinrichtung")
- see especially page 8, lines 1 to 4, or page 13, lines 14-15: ("Der Kreislauf enthält ferner einen Rührwerksbehälter 8, der mit einer Zerkleinerungseinrichtung in Reihe geschaltet ist", see figure on page 23).

- (b) Feature (b) of claim 1 of the contested patent ("wherein a process mass of cacao and/or cacao powder, cacao butter, edible fat, sugar and the like") is derivable from (2) on the basis of the following disclosure in the cited document: the components for mixing and grinding or, expressed differently, the process mass in (2), may include the ingredients **sugar, cacao mass, cacao powder, cacao butter, vegetable fats, milk powder**, and the like (see page 7, lines 3 to 5 or claim 1, lines 3 to 5).
- (c) in feature (c) reference is made to a "*grinding device*" capable of reducing the process mass to "*a certain particle size*" with "*a largely uniform particle size distribution*", without providing in the entire patent specification any explanation, details, limits or ranges, etc. as to what is indeed meant by "*a certain particle size*" or "*a largely uniform particle size distribution*". Owing to the use of this rather indefinite and imprecise terminology in the functional definition of what is meant by a "*grinding device*" in the present claim 1, this term lacks, in the board's opinion, clear, explicit boundaries, and its exact meaning and scope needs interpretation.

Figures 1 and 2 of the contested patent cannot contribute to a more precise definition or interpretation either, since in both figures the grinding device 1 is designed as an entirely empty box.

Hence, the skilled reader seeking an interpretation has to rely on the reference in column 2, lines 20-23, of the patent specification, reading thus: "*designated in the drawings with the reference numeral (1) is a grinding device in which the components of the process mass for processing are pre-mixed and ground*". This leads directly to the conclusion that what is meant by the technical feature "*grinding device*" has to be understood in its broadest sense, and that a "*grinding device*" as such within the meaning of claim 1 of the contested patent is accordingly any device which has the capability of mixing and grinding the components of the process mass.

On the basis of the above considerations, feature (c) of claim 1 of the contested patent ("are pre-mixed and ground in a grinding device wherein as grinding device is chosen a device for reducing the process mass to a certain particle size which a largely uniform particle size distribution") is derivable from (2) on the basis of the following disclosure in the cited document:

the figure on page 23 of citation (2) shows clearly that, in the process disclosed in (2), the components of the process mass pass through a device 8, termed agitator (mixing, stirring) vessel ("*Rührwerksbehälter*") which is equipped with both an **agitator (stirrer) 24** and a **roller device 6**.

From the disclosure in citation (2) - see especially,

- page 10 , lines 1 to 2, reference is made to the fact that in the comminution (disintegration) process the process mass is successively **ground** and **rolled**;
- page 10, lines 10 to 12, reference is made to the fact that the comminution (disintegration) device contains a **mill** and a **roller device**;
- page 11, lines 8 to 11, reference is made to the fact that, according to the appellants' present knowledge, the unexpected advantages associated with the invention are the result from inserting the **rolling step** which already affords a uniform, fine particle size within a remarkably shortened period compared to known processes;
- page 11, line 18 to page 12, line 13, reference is made to the fact that the additional **step of rolling** has the effect that the organoleptic disagreeable fractions containing particles of medium size are **quickly reduced in size** (page 11, lines 19 to 23); and that "it appears relevant that the step of rolling is capable of **immediately reducing the size of particles** having a size above-average to the adjustable size of the roll gap" (page 12, lines 1 to 3)
- it is sufficiently clear to the skilled reader that the roller device 6 has the function of a

roll mill suitable for reducing the particle size and that the agitator (mixing, stirring) vessel ("Rührwerksbehälter") 8 in (2) has the capability and function of carrying out both steps of **pre-mixing** and **grinding** the process mass to a certain particle size with a largely uniform particle size distribution and thus corresponds to and is clearly covered by the term "grinding device" used in claim 1 of the contested patent.

Contrary to the appellants' assertions during oral proceedings, the present claim 1 contains **no limitation** to the effect that the steps of pre-mixing and grinding the process mass in the "grinding device" must necessarily be carried out in a definite order, ie either concurrently or immediately after one another. The **process** disclosed in (2), wherein the process mass, subsequently to the step of its pre-mixing in the device 8, passes the ball mill 4 and is then fed back to the roll mill 6 of the grinding device 8, is of course **fully covered** by the wording of the present claim 1 and is therefore prejudicial to its novelty. In this respect attention is drawn to the fact that feature (c) merely requires that the process mass be pre-mixed and ground at any stage in the *grinding device*. As explained above, **this is clearly the case in the process disclosed in (2).**

- (d) The **characterizing feature (d)** of claim 1 of the contested patent ("the process mass is first

introduced into the grinding device") is derivable from (2) on the basis of the following disclosure in the cited document:

from the figure on page 23 of (2) in conjunction with the corresponding reference on page 13, line 16, it is clear that the process is started **by feeding the components of the process mass from outside through feed line 10 directly into the agitator (mixing, stirring) vessel**

("Rührwerksbehälter") 8 corresponding to the "grinding device" in claim 1 of the contested patent (see point (c) above), before they are pre-mixed in 8 and then transferred into the cycle.

- (e) Feature (e) of claim 1 of the contested patent ("the process mass is circulated in a cycle") is derivable from (2), *inter alia*, on the basis of the following disclosure in the cited document: in lines 7 to 8 on page 7 and in claim 1 of citation (2) reference is made to the process mass being subjected **in the cycle** ("im Kreislauf") several times to a size reduction process; lines 18 to 20 on page 13 of (2) provide the skilled reader with the teaching that "the devices located **in the cycle (circuit)** are interconnected in series by the connecting circuits 14 and 16."
- (f) Feature (f) of claim 1 of the contested patent ("consisting of at least a grinding device and a separate ball mill") is derivable from (2), *inter alia*, on the basis of the following disclosure in the cited document:

according to the disclosure in lines 7 to 9 on page 17 of citation (2), "in the main cycle (circuit) the **ball mill 4**, the **roller device 6** and the **agitator (mixing, stirring) vessel 8, ie the grinding device** (see point (c) above) are arranged (connected) in series;
feature (f) is also clearly derivable from the figure on page 23 of (2).

- (g) Apart from the fact that feature (g) of the contested patent ("is ground to the desired particle size") is more or less meaningless in the absence of any definition of what is meant by the "desired particle size", this feature is derivable from (2), *inter alia*, on the basis of the following disclosure in the cited document:

see page 11, lines 8 to 11: "according to the appellants' present knowledge, the unexpected advantages associated with the invention are the result from inserting the rolling step which affords already **a uniform, fine particle size** (ie the desired particle size) within a remarkably shortened period compared to known processes";

see page 11, lines 18 to 26: "the additional step of rolling has the effect that the organoleptic **disagreeable fractions** containing particles of medium size are **quickly reduced in size**" without the **unwanted augmentation** of the fraction containing particles of a very small size.

From this disclosure in (2) it can readily be

deduced that the result of carrying out the known process is likewise the reduction of the process mass to the desired particle size.

4.3 On the basis of the observations and considerations in point 3.2 above the board concludes that all the technical features (a) to (g) individually and their combination, forming the subject-matter of present claim 1, are directly and unambiguously derivable from the disclosure of citation (2) and that claim 1 therefore lacks novelty, contrary to the requirements of Article 52(1) in conjunction with Article 54(1) and (2) EPC.

5. Since a decision can only be taken on the request as a whole, there is no need to consider the patentability of independent claim 7 or the dependent claims.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

P. Martorana

U. Oswald