BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS | BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE | CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN DES BREVETS

Internal distribution code:
(A) [ ] Publication in OJ
(B) [ ] To Chairmen and Members
(C) [X] To Chairmen

D E C I S I O N
of 23 July 1998

Case Number: T 0583/96 - 3.3.4

Application Number: 88201681.9

Publication Number: 0304115

IPC: A23D 7/00

Language of the proceedings: EN

Title of invention:
Marine/vegetable oil blend and products made therefrom

Patentee:
Unilever N.V. et al

Opponents:
(01) N.V. Vandemoortele International
(02) Golden Vale PLC
(03) Ifoma Ltd

Headword:
Oil blend/UNILEVER

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

Keyword:
-

Decisions cited:
G 0001/93, T 0004/80, T 0124/90, T 0313/86

Catchword:
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0583/96 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 23 July 1998

Appellant: (Proprietor of the patent)
Unilever N.V.
Weena 455
3013 AL Rotterdam (NL)

Representative:
Mulder, Cornelis Willem Reinier, Dr.
Unilever N.V.
Patent Division
P.O. Box 137
3130 AC Vlaardingen (NL)

Respondent I: (Opponent 01)
N.V. Vandemoortele International
Kennedypark 8
8500 Kortrijk (BE)

Respondent II: (Opponent 02)
Golden Vale PLC
Charleville
County Cork (IE)

Representative:
Gorman, Francis Fergus
F. F. Gorman & Co.
54, Merrion Square
Dublin 2 (IE)

Respondent III: (Opponent 03)
Ifoma Ltd
2 College Yard
Lower Dagnall Street
St. Albans
Hertfordshire AL3 4PE (GB)

Representative:
Perry, Rogert Edward
Gill Jennings & Every
Boardgate House
7 Eldon Street
London EC2M 7LH (GB)

Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 21 May 1996 revoking European patent No. 0 304 115 pursuant to Article 102(1) EPC.**

Composition of the Board:

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

Summary of Facts and Submissions

I. European patent No. 0 304 115 was granted in response to European patent application No. 88 201 681.9.

Claim 1 as granted reads as follows:

"1. A process for the preparation of a bland marine/vegetable oil blend which comprises blending unhydrogenated refined marine oil with vegetable oil characterized in that the oil are blended during refining or thereafter before substantial deterioration of the refined marine oil occurs, the ratio of marine oil to vegetable oil being less than one to three, the temperature of the oil during refining is held below 200°C, **and that the refined marine oil blended does not contain a synthetic antioxidant**." (with emphasis on the disclaimer under discussion).

II. Notices of opposition were filed by respondents I, II and III (opponents 01, 02 and 03) *inter alia* on the ground that the subject-matter of the patent in suit extended beyond the content of the application as filed (Article 100(c) EPC) because, in the view of the respondents, the disclaimer introduced during the examination procedure gave rise to added subject-matter.

The patent in suit was revoked by the Opposition Division because of the noncompliance of claims 1 of all requests before it with Article 123(2) EPC. The reasons for the decision by the Opposition Division were that:

Claims 1 of the requests as filed, i.e. main request, first, second and third auxiliary requests were directed to a process for the preparation of a bland vegetable/marine oil blend characterized by a specific blending step which could not be derived from document (1) neither from the general disclosure nor from the examples (document (1), cf. page 1, paragraph 3, page 16, last paragraph and pages 18 and 23). Thus the inserted disclaimer in claim 1 of the patent in suit reading "in that the marine oil blended does not contain a synthetic antioxidant" did not properly correspond to that disclosure of document (1) and, hence, was not allowable. Moreover the said disclaimer was in contradiction to the teaching of the application as filed (cf. page 2, lines 30 to 35 and Examples 1 and 2).

Claim 1 of the main request filed on 17 October 1995, which was refused by the Opposition Division, reads as follows

"1. A process for the preparation of a bland vegetable/marine oil blend which comprises blending unhydrogenated refined marine oil with vegetable oil, the ratio of marine oil to vegetable oil being less than one to three, the temperature of the oil during refining is held below 200°C, characterized in that the oils are blended during refining or shortly thereafter before substantial deterioration of the refined marine oil occurs **and in that the refined marine oil blended does not contain a synthetic antioxidant**."

III. As regards the prior art documents,

(1) Leatherhead Food R.A., "Development of Foods containing Unhydrogenated Fish Oil", Report P1823, pages 1 to 34, April 1986

was *inter alia* mentioned.

IV. The appellant (patentee) lodged an appeal against this decision, paid the appeal fee and filed a statement setting out the grounds of appeal.

All three respondents replied to the appeal. Oral proceedings took place on 23 July 1998. Respondent II did not attend the oral proceedings.

V. The appellant's arguments can be summarised as follows:

It was confirmed that the requests relied upon are those which were before the opposition division and which were refused leading to the revocation of the patent.

The disclaimer referring to synthetic antioxidants was justified for the following reasons:

(a) That the situation in this case was parallel with that pertaining to Enlarged Board of Appeal decision G 1/93, (OJ 1994 541).

(b) The disclosure in the European patent application at page 2, lines 28 to 35 showed that an antioxidant was not necessary to the process and also such compounds were not used in Examples 2 and 3 of the patent in suit.

(c) The nearest prior art document (1) at page 2, paragraph 3 indicated that synthetic antioxidants had been used in this prior disclosure and this justified the use of the disclaimer.

(d) In reply to points made by the respondents with respect to technical effects resulting from the disclaimer, the appellant stated that the synthetic antioxidant TBHQ was only to be used in quantities which did not lead to an unacceptable bitter taste in the final product, this being indicated in the description of the patent in suit on page 3, lines 32 to 34. Also it was not apparent from the disclosure of document (1) that an antioxidant was added to the oil before the deodorisation step.

VI. The respondents' arguments can be summarised as follows:

(a) Respondent I stated that the disclaimer relating to synthetic antioxidants was not allowable under Article 123(2) EPC and its removal would contravene Article 123(3) EPC in view of Enlarged Board of Appeal decision G 1/93 (supra), because it resulted in a technical contribution, ie, when TBHQ was left out of the process then the bitter taste associated with this compound was removed.

It was well known that deodorisation at high temperatures resulted in the destruction of any antioxidants present in the oil and therefore the compositions obtained would lack antioxidants. Example 3 related only to a modification of the bleaching step of the process and therefore was

not relevant to the deodorisation process as already described in Example 2. Accordingly, these examples did not provide any support for the disclaimer in claim 1.

The last paragraph on page 4 of document (1) did not make specific reference to synthetic antioxidants and insofar as this disclosure was relevant it related to the well known practice of adding antioxidants prior to transportation of the oil.

(b) Respondent II relied upon the submissions which were made during the opposition. With regard to the disclaimer it was argued that it was not based on the cited prior art and that the disclosure of the patent in suit did not indicate that an antioxidant should not be present.

(c) Respondent III argued that a disclaimer was only allowable to distinguish the patent subject-matter in cases of novelty destroying prior art, and there was no basis either in the prior art document (1) or in the patent application which justified the form of the disclaimer employed by the appellant.

Document (1) did not disclose a mixture of marine oil with vegetable oil and an antioxidant. Therefore, a disclaimer of the type now specified in claim 1 could not be justified. Process steps were described in document (1) including heating to 200°C during deodorisation, which process step destroyed the antioxidant, and there was no need to disclaim the use of antioxidants as there was none present in the product. At pages 16 and 17 of document (1), there was no reference to the addition of antioxidants to the oil during the

deodorisation step and accordingly no basis for the disclaimer did exist in view of this disclosure either. Document (1) referred only to specific synthetic antioxidants, accordingly, only these should be specified in the disclaimer.

Page 2, paragraph 4 of the European patent application as filed could not be considered to form a basis for the disclaimer as it appeared to deny any usefulness of antioxidants in the process claimed.

The disclaimer should not be allowed as it gave rise to a technical effect which consisted in the avoidance of an unpleasant bitterness in taste of the product oil blend.

VII. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the following documents:

(a) claim 1, filed on 17 October 1995 as main request; or

(b) claim 1, filed on 28 March 1996 as first auxiliary request; or

(c) claim 1, filed on 26 April 1996 as second auxiliary request; or

(d) claim 1, filed on 26 April 1996 as third auxiliary request.

The respondents requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

Main request - Article 123(2) EPC

2. In the first place it has to be decided whether or not the disclaimer used in claim 1 is allowable or not having regard to the requirements of Article 123(2) EPC. This disclaimer reads as follows: "...in that the refined marine oil blended does not contain a synthetic antioxidant.". The respondents' arguments were directed to the allowability of the form of the disclaimer having regard to the disclosure of the prior art and that of the patent in suit itself. The term "synthetic antioxidant" was not acceptable to them. Contrary to their view that this term is not to be found in the prior art, it is actually referred to in document (1) at page 13, lines 1 to 4 where it is stated that synthetic antioxidants have been tried individually and that synergism may occur when combinations of them are used. This disclosure confirms that the term is well known in the art and that the skilled person is able to understand its significance. In these circumstances its inclusion in the disclaimer is allowable in this respect (see decision T 4/80 (OJ EPO 1982, 149)).

3. Claim 1 is based on page 3, lines 4 to 10 of the patent application as filed, this claim being directed to blending the marine oil with vegetable oil in the given proportions during or shortly after refining.

4. The patent application as filed describes a process in which the oils were blended and the presence of additives was optional (see page 3, lines 4 to 10 and Example 1). However, no specific additives were referred to in this broadest statement of the

invention. Accordingly, the general process as originally claimed included the two possibilities that unspecified additives could be present and, on the other hand, that no additives were present. Example 1 of the patent in suit indicates that antioxidant is added at the end as well as at the beginning of the deodorisation step, therefore it follows that antioxidant is present in the final oil blend even if some of it is destroyed during deodorisation. Hence, the originally claimed subject-matter included the optional presence of TBHQ, and it is allowable to disclaim its presence in the blend.

5. After considering the wording of the disclaimer the Board cannot identify any technical feature which has been added and may have contributed new subject-matter. The technical term "synthetic antioxidant", of which an example was specified in the original disclosure (see Example 1), relates only to that subject-matter which has been disclaimed and which does not now belong to the patent disclosure.

6. The argument that, by disclaiming the use of said antioxidants, a technical advantage results because a bitter taste caused by some antioxidants may be avoided is, in the Board's judgement, not conclusive, because the application as filed at page 2, paragraph 4 made it clear that in cases in which such a problem arose only limited amounts of antioxidants would be incorporated, ie, less than that which would give rise to a bitter taste. Thus, in the present case, the factual situation underlying the decision of the Enlarged Board of Appeal G 1/93 (supra) does not exist.

7. The general term "synthetic antioxidant" does not appear in the disclosure of the patent in suit, but specific synthetic antioxidants are described. According to the established case law of the Boards of

Appeal of the EPO a disclaimer does not contravene Article 123(2) EPC because its wording is not contained in the patent specification as long as it can be found in a prior art document. This is the case here (see point 2 above).

8. The feature "shortly", newly introduced in claim 1 has been disclosed in the application as filed on page 3, line 8.

9. From the above it follows that the subject-matter of claim 1 meets the requirement of Article 123(2) EPC.

Article 123(3) EPC

10. Claim 1 differs from claim 1 as granted by the insertion of the feature "shortly" which limits the scope of protection conferred by the patent in suit. Thus, claim 1 does not contravene Article 123(3) EPC either.

11. Since claim 1 of the main request meets the requirements of Article 123(2) and (3) EPC, the auxiliary requests need not be considered. The case is therefore remitted to the Opposition Division for further prosecution.

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

18.2.98

UMoser 22.12.98