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D E C I S I O N
of 1 September 1999

Case Number: T 1073/96 - 3.3.2

Application Number: 88810875.0

Publication Number: 0328849

IPC: A23G 3/30

Language of the proceedings: EN

Title of invention:

Use of a racemic mixture of alpha-D-glucopyranosyl-1-6-mannitol and alpha-D-glucopyranosyl-1-6-sorbitol in a sugarless low-moisture absorbing chewing gum composition

Applicant:

Warner-Lambert Company

Opponent:

Dansk Tyggegummi Fabrik A/S
Wrigley JR Company

Headword:

-

Relevant legal provisions:

EPC Art. 54, 83

Keyword:

"Sufficiency of disclosure: (yes)"

"Novelty (no): claimed use of Palatinit^R not distinguishable from its known use disclosed in the state of the art."

"Solution of a technical problem vis-à-vis the closest state of the art not recognisable."

Decisions cited:

G 0002/88, G 0006/88, T 0231/85, T 0059/87, T 0254/93

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 1073/96 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 1 September 1999

Appellant: Dansk Tyggegummi Fabrik A/S
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 17 October 1996
rejecting the opposition filed against European

patent No. 0 328 849 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: P. A. M. Lançon
Members: G. F. E. Rampold
M. B. Günzel

Summary of Facts and Submissions

I. European patent No. 0 328 849 was granted on the basis of 13 claims in respect to European patent application No. 88 810 875.0. Claim 1 reads as follows:

"Use of a racemic mixture of alpha-D-glucopyranosyl-1, 6-mannitol and alpha-D-glucopyranosyl-1, 6-sorbitol in a sugarless low-moisture absorbing chewing gum composition in an amount of from 10 to 70% by weight, with respect to the weight of the chewing gum composition, to texturise and maintain said composition in a substantially anhydrous form and to provide an improved structural gum surface for a confectionery coating, the composition further comprising a high intensity sweetener and from 10 to 75% by weight of the composition of a gum base.

Claims 2 to 7 are dependent claims directed to elaborations of the use according to claim 1.

Independent claim 8 is worded as follows:

"Use of a racemic mixture of alpha-D-glucopyranosyl-1, 6-mannitol and alpha-D-glucopyranosyl-1, 6-sorbitol in a confectionary coated sugarless low-moisture absorbing chewing gum composition in an amount of from 10 to 70% by weight, with respect to the weight of the chewing gum composition, to texturise and maintain said composition in a substantially anhydrous form and to provide an improved structural gum surface for a confectionery coating, the composition further comprising a hard shell confectionary coating."

Claims 9 to 13 are dependent claims directed to elaborations of the use according to claim 8.

- II. The disaccharide alcohol used in the above-mentioned claims and designated in the patent in suit either in terms of chemical nomenclature "racemic mixture of alpha-D-glucopyranosyl-1, 6-mannitol and alpha-D-glucopyranosyl-1, 6-sorbitol", or by its generic name "Isomalt", or by its tradename "Palatinit^R" (see especially page 5, lines 12 to 31), is hereinafter referred to as Palatinit^R.
- III. Oppositions to the grant of the patent were filed by appellant 01 and appellant 02 on the grounds of lack of novelty (Articles 100(a); 52(1); 54 EPC), lack of inventive step (Articles 100(a); 52(1); 56 EPC) and insufficiency of disclosure (Articles 100(b); 83 EPC).

The oppositions were supported, *inter alia*, by the following documents:

- (2) H. Bollinger, Palatinit^R (Isomalt) - ein kalorienreduzierter Zuckeraustauschstoff - technologische und physiologische Eigenschaften, Teil 1; Gordian, May 1987, pages 92-95
- (3) H. Bollinger, Palatinit^R (Isomalt) - ein kalorienreduzierter Zuckeraustauschstoff - technologische und physiologische Eigenschaften und seine Verarbeitung in Süßwaren, Teil 2; Gordian, June 1987, pages 111-114
- (7) Extracts (32 selected technical sheets) from the

"Palatinit^R - Infopac", published by Süddeutsche
Zucker AG

IV. In a decision notified on 17 October 1996 the
opposition division rejected the oppositions. The
substance of its reasoning was as follows:

As to the ground for opposition under Article 100(b)
EPC, the alleged insufficiency of disclosure was, in
the absence of any experimental evidence, only
insufficiently supported by the statement in the
paragraph bridging pages 7 and 8 of the McGrew
declaration, filed by appellant 02 on 23 August 1996,
because this statement merely represented the author's
personal view on this issue.

The claimed use of Palatinit^R for the specific purpose
of providing an improved structural gum surface for a
confectionery coating of the particular chewing gum
composition specified in claim 1 was not directly and
unambiguously derivable from any document cited in the
opposition proceedings. The novelty of the claimed
subject-matter in the patent in suit had accordingly to
be acknowledged.

Concerning inventive step, the article by Hartmut
Bollinger, published in two parts in documents (2) and
(3), was considered to be the closest state of the art.
Document (3) disclosed in paragraph 1.5 the use of
Palatinit^R for the purpose of improving the structure of
a sugarless, low-moisture absorbing chewing gum
composition and moreover recommended in paragraph 1.2
that the surface of fillings (inserts) for chewing gum

dragées be preferably sprinkled with Palatinit^R powder before being coated with a confectionery coating to bind the moistness and form an uninterrupted covering. On the basis of this disclosure in (3), the skilled person could not reasonably and necessarily conclude that the use of Palatinit^R in large quantities in the body of the gum composition would similarly result in a gum surface which contained large quantities of Palatinit^R and which, accordingly, exhibited the same or at least similar properties as described for the gum surface in paragraph 1.2 of document (3). Hence, the known use of Palatinit^R powder for sprinkling the surface of gum fillings for dragées disclosed in (3) could not reasonably be said to suggest to a person skilled in the art to advantageously solve the problem of providing an improved structural gum surface for a confectionery coating by simply incorporating Palatinit^R in large quantities in the chewing gum composition *per se*.

Document (7), the so-called "Palatinit^R-Infopac", could not be taken into consideration since no convincing evidence was provided that it was made available to the public before the priority date of the patent in suit.

- V. Both appellant (opponent) 01 and appellant (opponent) 02 filed notice of appeal and requested the arrangement of oral proceedings.

In a fax received on 2 August 1999 in advance of the oral proceedings scheduled for 1 September 1999, appellant 01 informed the board that it would not be represented at the oral proceedings.

At the beginning of the oral proceedings, appellant 02 withdrew its earlier requests that Mrs Dubitzky be heard as a witness for the appellant's assertion that document (7) was made available to the public prior to the priority date of the patent in suit, and that (7) be admitted into the proceedings as state of the art.

Upon inquiry of the chairman appellant 02 confirmed that it did not wish to maintain insufficiency of disclosure as a ground for opposition.

VI. The arguments presented by the appellants can be summarised as follows:

In the context of the production and the physico-chemical properties of Palatinit^R, document (3) contained in the first column on page 111 an explicit reference to document (2). In accordance with the "Guidelines for examination in the EPO", Chapter IV, 7.1, the combined teaching of documents (2) and (3) was therefore to be regarded as a single reference for the assessment of novelty.

The opposition division determined in the impugned decision that all the features of claim 1, with the possible exception of the intended use of Palatinit^R for the purpose of improving the structural gum surface for a confectionary coating, were disclosed in citation (3). However, contrary to what was stated at page 9, penultimate paragraph, extending onto page 10 of the impugned decision, it was quite clear from the specification of the patent in suit that the "improved structural gum surface for a confectionary coating"

ascribed to the chewing gum composition in claim 1 was not some inexplicably improved surface structure, but described nothing more than a firmer surface of the composition. In any case, it was admitted by the opposition division and by the respondent itself that the non-hygroscopic nature of Palatinit^R was well known at the priority date of the patent in suit and that it provided firmness to gum pellets because of its non-hygroscopic nature.

The distinction made by the opposition division between a chewing gum composition which was firm enough to be coated and one having an improved structural gum surface for a confectionary coating was neither understood nor raised in the patent in suit. The patent specification and the respondent in its submissions made it quite clear that what was really relevant was the textural firmness of the gum provided by the non-moisture pick-up resulting from the use of Palatinit^R.

As had already been stated in paragraph 1.2 of citation (3), coating the gum fillings with Palatinit^R "binds the moisture and forms a closed surface". Given that the virtual elimination of moisture was an inherent and well-known quality of Palatinit^R when used in confectionery products, it was evident that there was no difference whether the Palatinit^R was included within the gum product or simply coated on the surface, because the use of Palatinit^R in large quantities in the gum pellet *per se* meant that the surface contained large quantities of Palatinit^R. The result from the use of Palatinit^R was in both cases the same, namely no stickiness.

In the appellants' submissions all claims of the patent in suit lacked novelty and, independently of the lack of novelty, were obvious in the light of document (3).

VII. The respondent essentially argued that the subject-matter of claim 1 as granted was novel over the cited state of the art, since at least the use of Palatinit^R for improving the structural gum surface was not disclosed in the closest prior art according to (3). The specific purpose of using Palatinit^R stated in claim 1, namely "to provide an improved structural gum surface for a confectionary coating", was self-explanatory and meant that the use of Palatinit^R had the effect of improving the structure of the gum surface. A clear distinction had to be made between the use of Palatinit^R for this new purpose and its use for the purpose of texturising the gum composition described in claim 1. The latter related to the "firmer, but acceptably chewable texture" of the gum product to enhance processing and packaging, as referred to in the patent specification on page 3, lines 52 to 54, and page 5, lines 32 to 39.

Although it was not permissible to combine citations (2) and (3) for the assessment of novelty, the claimed use of Palatinit^R in the patent in suit would not be anticipated, even if the teachings of (2) and (3) were combined.

The closest state of the art was the reference in paragraph 1.5 of (3) to a chewing gum composition containing Palatinit^R as the bulking agent/sweetener. While it was possibly derivable from the cited

reference that the use of Palatinit^R had the effect of improving the structure of a sugarless, low moisture-absorbing chewing gum composition, nothing was said about the structure and properties of the gum surface itself as a result of using Palatinit^R. The distinction made by the opposition division between a chewing gum composition which was firm enough to be coated and one having an improved structural gum surface for a confectionery coating was correct, because firmness of the gum itself did not necessarily facilitate easy coating of the gum surface.

As could be derived from paragraph 1.2 of document (3), the real problem to be solved by the invention was to be seen in the provision of a chewing gum composition which did not have to be pretreated to allow for easy coating. The claimed use of Palatinit^R for improving the structural gum surface for a confectionery coating was not obvious to a person skilled in the art and was, moreover, advantageous, because the need for a pretreatment such as sprinkling the gum surface with Palatinit^R powder to bind the moistness and form an uninterrupted covering so as to facilitate the subsequent coating process could successfully be avoided.

VIII. Both appellant 01 (main request) and appellant 02 (sole request) requested that the impugned decision be set aside and the patent be revoked in its entirety.

As an auxiliary request, filed with the grounds for appeal, appellant 02 requested that the purpose of using Palatinit^R "to texturise and maintain said

composition in a substantially anhydrous form" be deleted from both independent claims 1 and 8.

The respondent requests that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.
2. *Opposition under Article 100(b) EPC; insufficiency of disclosure*

The board sees in the submissions of appellant 02 during the first instance opposition proceedings no basis for an objection under Article 83 EPC. Since insufficiency of disclosure as a ground of opposition was not resumed by the appellants at the appeal stage, there is no need for further detailed substantiation of this matter.

3. *The state of the art according to documents (2) and (3)*

In the heading on document (3), it is explicitly indicated that (3) is **part 2 of an article by H. Bollinger**, entitled "Palatinit^R (Isomalt) - ein kalorienreduzierter Zuckeraustauschstoff". Following the summary, the text of document (3) starts in the left-hand column on page 111 with the **specific reference** that the production of Palatinit^R (Isomalt), its physico-chemical properties and its nutritional physiological characteristics are reported in detail in

part 1 of the same article by H. Bollinger, published one month earlier in the preceding issue of the same journal, namely Gordian 87/5, pages 92 to 95 (ie document (2) in the proceedings).

When assessing novelty, the disclosure of a particular prior document must normally be considered in isolation; in other words it is only the actual content of a document, as understood by a skilled person, which destroys novelty. It is not permissible to combine **separate items of the prior art** together. However, in a case such as the present, where there is a specific reference in one prior document to a second prior document indicating that documents (2) and (3) relate to parts 1 and 2 respectively of the same article by the same author and, moreover, that both parts of that article were published in two consecutive issues of the same journal, when construing documents (2) and (3) (ie determining their meaning to the skilled person), these two documents must actually be considered to represent **a single item of prior art**.

4. *Opposition under Article 100(a) EPC: lack of patentability*

4.1 The use of Palatinit^R as the bulking agent/sweetener (bulk sweetener) in chewing gum compositions is already known in the state of the art. More specifically, the closest state of the art discloses in paragraph 1.5 on page 113 of document (3):

(i) the use of Palatinit^R

- (ii) as the bulking agent/sweetener (bulk sweetener) in an amount of 63% by weight, with respect to the weight of the composition, in a sugarless, low-moisture absorbing chewing gum composition, which is cut into strips or shaped as fillings (inserts) for dragées (gum pellets, Type Chiclet; see especially (3), line 3 and end of paragraph 1.5: "Dragee-Einlagen")
- (iii) the composition further comprising aspartame as a high intensity sweetener and 25% by weight of the composition of a gum base (Type 3442, Dreyfuß).

That Palatinit^R is used in document (3) for the purpose of giving the particular chewing gum composition body and texture (ie "to texturise" the composition) is likewise directly and unambiguously derivable for the skilled reader from the disclosure of (3), as is the use of Palatinit^R for the purpose of maintaining said composition in a substantially anhydrous form.

More specifically, it is clear from the reference in the first two lines in paragraph 1.5 of (3) to the use of Palatinit^R as the "crystalline phase" in chewing gum mixtures, as well as from the references in (2) and (3) to the use of Palatinit^R as the bulk sweetener for the manufacture of such mixtures that Palatinit^R "texturises" a chewing gum (see, for example, (3), Summary, lines 1 to 2: *Palatinitit^R ist ein massegebendes Süßungsmittel*"; lines 9 to 10: *"Bevorzugte Einsatzgebiete für Palatinit^R sind vor allem Kaugummi"*).

Further, it is also disclosed in lines 7 to 8 of paragraph 1.5 that Palatinit^R imparts an improved, more flexible structure over an extended time period to the gum as compared to conventional sugarless chewing gums.

Palatinit^R is described in the cited documents as low-hygroscopic or even non-hygroscopic (see, for example, left-hand column on page 94 of (2), lines 10 to 11). The technical term "hygroscopic" is defined in Chambers Technical Dictionary as meaning "absorbing water readily". Accordingly, by definition, non-hygroscopic means low-moisture absorption. In this context reference is also made to Figures 1 and 2 on page 111 of (3) which demonstrate that Palatinit^R when used as the bulking agent in confectionery products has the capability of maintaining such products in a substantially anhydrous form. It is thus clear that Palatinit^R is low-moisture absorbing and as such functions to maintain the gum composition disclosed in paragraph 1.5 of document (3) in a substantially anhydrous form.

In conclusion, the technical teaching actually made available to the public in document (3) is that the use of Palatinit^R as the bulk sweetener in an amount falling within the range specified in claim 1 in combination with a gum base likewise in an amount falling within the range specified in claim 1 and a high intensity sweetener provides a substantially anhydrous, sugarless chewing gum composition which can be cut into strips or shaped as fillings or inserts for dragées (gum pellets) and which has a firm, flexible texture and structure and low moisture pick-up.

What was indeed not made available to the public in document (3) is an **explicit** disclosure or teaching to the effect that Palatinit^R, when used as the bulking agent in a chewing gum composition *per se*, possibly exerts some beneficial impact on the structure of the gum surface or, differently expressed using the wording in claim 1, that Palatinit^R can possibly be used "to provide an improved structural gum surface for a confectionery coating". This was not contested by the appellants.

- 4.2 On the basis of the above-mentioned statement in claim 1 as to the particular intended use of Palatinit^R the respondent sought to identify in the patent in suit a possible technical problem underlying the claimed invention.

In the context of the application of Palatinit^R as a confectionery coating mass for the preparation of coated goods (*dragées*) in general, including hard caramels, toffees, chewing candies or chewing gum, the author of (3) recommends, *inter alia*, in paragraph 1.2 that, **if the surface is sticky** ("*Ist die Oberfläche klebrig*"), the fillings (inserts) for *dragées* be preferably sprinkled with Palatinit^R powder before being coated with a confectionary coating to bind the moistness and form an uninterrupted surface.

The respondent, relying on this disclosure, argued during the oral proceedings before the board that, prior to the priority date of the patent in suit, some pretreatment of the fillings (inserts) for chewing gum *dragées* (gum pellets) was considered by the notionally

skilled person to be compulsory to facilitate their subsequent coating with a confectionery coating. The technical problem seen by the respondent was therefore that of providing a chewing gum composition which allows for easier coating without the need for any pretreatment.

The board notes that this problem is not mentioned in the application as filed or in the text of the granted patent, nor was it introduced into the proceedings by any party prior to the oral hearings before the board. It is further noted that the use as claimed in claim 1 of the contested patent does not include the step of converting the chewing gum composition into dragées and, accordingly, claim 1 contains no limiting technical feature so as to exclude a possible pretreatment of the chewing gum composition specified in the claim to facilitate a subsequent coating process.

Apart from the fact that the problem, relied on by the respondent, cannot be derived from the disclosure of the invention in the application as filed or in the granted version of the patent in suit, the person skilled in the art starting from the closest state of the art, namely the chewing gum composition disclosed in paragraph 1.5 of (3), **was not confronted with such a problem at all.**

Even upon careful study of the complete documents (2) and (3), the skilled reader is given no hint or suggestion leading him to the conclusion that the surface of the particular gum composition disclosed in

(3) was in any way sticky or tacky requiring a pretreatment of any kind to allow for coating with a confectionery coating. By contrast, the skilled person, being aware of the known use of Palatinit^R for the purpose of giving a chewing gum composition body and texture and maintaining said composition in a substantially anhydrous form (see point 4.1 above), had no reason to doubt that the gum composition disclosed in (3) had a firm flexible texture and structure and its surface was neither sticky nor tacky as the direct result of using Palatinit^R as the bulk sweetener. As is known to the skilled practitioner, surface stickiness is caused by moisture absorption. It was shown in the cited state of the art that the virtual elimination of moisture absorption is a known quality of Palatinit^R when used as the bulking agent in confectionery products (see especially (3), Figures 1 and 2). As is thus apparent from the disclosure of the state of the art, the avoidance of moisture absorption overcomes the problem of stickiness and tackiness as well.

Further, if the teaching in the state of the art is repeated by preparing a chewing gum composition according to the recipe given in paragraph 1.5 of document (3), the skilled person will immediately be aware that the gum surface is neither sticky nor tacky.

In view of the foregoing, the conclusion must be drawn that the particular technical problem identified by the respondent vis-à-vis the state of the art according to (2) and (3) is neither disclosed in or contemplated by the patent in suit nor does it actually exist as such.

The board does not recognise in the patent in suit another technical problem which had to be solved by the skilled person in order to arrive at the claimed invention, not yet having been solved by the state of the art according to (3).

4.3 Having regard to the observations in points 4.1 and 4.2 (above), reference is usefully made to decisions G 2/88 (OJ EPO 1990, 93) and G 6/88 (OJ EPO 1990, 114). In these decisions the Enlarged Board of Appeal took the view that the **new use** of a known compound may reflect a **newly discovered technical effect** described in the patent. The attaining of such technical effect should then be considered as a functional technical feature of the claim. If that technical feature has not been made available to the public, then the claimed invention is novel, even though such technical effect may have inherently taken place in the course of carrying out what has previously been made available to the public. In other words, novelty can only be acknowledged if both requirements are met, ie if

- (i) the claimed use as such is new, **and**
- (ii) if it reflects a newly discovered technical effect described in the patent.

4.4 Concerning the question of whether the particular intended use stated in claim 1 ("to provide an improved structural gum surface for a confectionery coating") indeed reflects in the present case a technical effect which has not previously been made available to the public, the board's finding is as follows.

No explanation was given by the respondent in the entire course of the proceedings of what in fact is meant by "an improved structural gum surface for a confectionery coating". The nature or characteristics of such an improved surface structure are nowhere explained in the patent specification or in the respondent's submissions during the proceedings.

If one scrutinises the specification of the patent in suit to find an answer to this question, the following disclosures appear particularly relevant:

On page 3, lines 19 to 20, it is said that "the use of the present invention provides both low moisture pick-up and a firmer texture which result in facilitating coating process for hard confectionery coated pelletized gum".

On page 5, lines 6 to 11, the description goes on to say: "The key to the present invention is the use of a low-moisture pick-up sweetener bulking agent in the form of a racemic mixture of alpha-D-glucopyranosyl-1, 6-mannitol and alpha-D-glucopyranosyl-1, 6-sorbitol which can be combined with glycerin or low amounts of sugar alcohol in a sugarless gum composition to: (1) significantly reduce the moisture pick up over a period of time and (2) to provide structural firmness in textural and structural integrity of the gum surface and matrix to allow for easy coating with confectionery coating compositions."

Further, on page 7, lines 4 to 11, it is stated: "The purpose of these hardness tests was to demonstrate that

the use according to the present invention provides chewing gum compositions which retain their firmness over an extended time period such that the coated process can be facilitated. Since the compositions in which Palatinit^R was used were initially firmer, and due to the presence of the non-hygroscopic bulking agent in the required flavorants, the moisture level remained relatively low. Moisture pick-up would result in a reduction of the gum's firmness, making coating with a confectionery coating more difficult and less effective."

As is apparent from the above quotations and further similar disclosures in the contested patent, there is no reference in the specification of the patent in suit to anything other than **the known technical effects** resulting from **the known use** of Palatinit^R already disclosed in citation (3) and mentioned above, namely its effect or capability of imparting a firm texture and structure to the gum composition and maintaining the composition in a substantially anhydrous state and, accordingly, maintaining its firmness over an extended period of time.

No distinction is raised in the patent in suit between these known technical effects, on the one hand, and the one which is possibly responsible for providing an improved structural gum surface for a confectionery coating, on the other. It is, however, entirely clear to a person skilled in the art that no such distinction exists and the known effects of Palatinit^R will also have some impact on the structure of the surface of the gum composition, because a firmer structure and a low

moisture pick-up of the composition *per se* will inevitably result in a firmer structure and texture of the surface to allow for easy coating.

Consequently, the claimed use of Palatinit^R for the purpose of "providing an improved structural gum surface for a confectionary coating" cannot reasonably be considered to be based on or to reflect a technical effect which is described for the first time in the contested patent **and** as such can be distinguished from the known effects already described in (2) and (3) in association with the known use of Palatinit^R. The finding that the known use of Palatinit^R claimed in the patent in suit possibly results in an improved structural gum surface for a confectionary coating can merely be regarded as *the ex post facto* attempt to **explain the known effects** resulting from **the known use** of Palatinit^R already disclosed in paragraph 1.3 of document (3).

The above considerations are, in the board's judgment, in line with the conclusions in decision T 254/93 (OJ EPO 1998, 285, see especially Reasons, point 4.8) where it is stated that **"the mere explanation of an effect** obtained when using a compound in a known composition, even if the effect was not known to be due to this compound in the known composition, cannot confer novelty on a known process if the skilled person was aware of the occurrence of the desired effect".

- 4.5 The board wishes to draw attention to the fact that the present case is entirely different from the cases underlying decisions G 2/88 and G 6/88. In the

situations which the Enlarged Board had in mind in these decisions a **new use** reflecting a **newly discovered technical effect** was actually present:

In the case giving rise to the referral (T 59/87, OJ EPO 1988, 347), the use of a certain substance as a rust-inhibiting additive was already known in the state of the art. Based on the **newly discovered friction-reducing effect** of the same substance, claims directed to the hitherto unknown, **new** use of that substance as a friction-reducing agent in a lubricant composition were held in the final decision (T 59/87, OJ 1991, 561) to be novel within the meaning of Article 54(1) EPC. Whereas the known use of the substance served to inhibit rust, the problem underlying the claimed invention was to reduce the friction between sliding surfaces in engines. Lubricants may be applied for numerous purposes and either of the two effects may be important in quite different situations. Thus, there exist, based on two distinctly different effects, two distinctly different applications or uses for the same substance, which can clearly be distinguished from each other.

In the second case, decision T 231/85 (OJ EPO 1989, 74; mentioned in G 2/88, reasons, point 9.1 and G 6/88, reasons point 7.1), the use of certain substances for influencing plant growth was known in the state of the art. Based on the **newly discovered fungicidal effect** of the same substances, claims directed to the use of these substances for the hitherto unknown, **new purpose** of controlling fungi and preventive fungus control were held to be novel within the meaning of Article 54(1)

EPC.

Again, in T 231/85 there existed, based on **two distinctly different effects**, two distinctly **different applications or uses** for the same substances, which could clearly be distinguished from each other. The circumstances in which the substances are applied for the purpose of controlling fungi are in fact different from those in which they are applied for the purpose of regulating plant growth.

- 3.8 In conclusion, the claimed invention aims at the provision of a sugarless low-moisture absorbing chewing gum composition having an improved structural gum surface for a confectionary coating. However, as demonstrated above, this problem has already been solved in the cited state of the art in exactly the same way as proposed in the patent in suit, namely by using Palatinit^R as the bulk sweetener. A definite distinguishing technical feature, which confers novelty on the subject-matter of claim 1 within the meaning of Article 54(1) EPC is not recognisable in the patent in suit.

Since a decision can only be taken on a request as a whole, there is no need to look into the patentability of the other claims.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

P. Martorana

P. A. M. Lançon