

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 25 November 1998

Case Number: T 1075/96 - 3.3.2

Application Number: 91200898.4

Publication Number: 0455288

IPC: A23L 1/19

Language of the proceedings: EN

Title of invention:
Whippable non-dairy creams

Patentee:
Unilever N.V., et al

Opponent:
Macphie of Glenbervie Ltd.
Remia B.V.

Headword:
Non-dairy creams/UNILEVER

Relevant legal provisions:
EPC Art. 52(1), 54, 83, 84, 111(1)

Keyword:
"Sufficiency yes: Product defined in terms of its composition, additional functional technical feature in claim 1 reproducible on the basis of the disclosure of the invention"
"Novelty yes: subject-matter of claim 1 not directly and unambiguously derivable from the cited prior art"
"Remittal to the department of first instance: inventive step of claim 1 and patentability of claims 2 to 14 not examined in the decision of the opposition division"

Decisions cited:
T 0012/81, T 0124/87, T 0133/87, G 0009/91, G 0010/91

Catchword:
-



Case Number: T 1075/96 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 25 November 1998

Appellant: Unilever N.V.
(Proprietor of the patent) 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: Macphie of Glenbervie Ltd.
(Opponent 01) Glenbervie
Stonehaven Kincardineshire AB3 2Y (GB)

Representative: Ede, Eric
Fitzpatrick's,
4 West Regent Street
Glasgow G2 1RS
Scotland (GB)

Other party: Remia B.V.
(Opponent 02) Willem Arntszlaan 71-77
3734 ED Den Dolder (NL)

Representative: van Gennip, Johannes Simeon Wilhelmus
Vereenigde Octrooibureaux
Nieuwe Parklaan 97
2587 BN 's-Gravenhage (NL)

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. 0 455 288 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. 0 455 288 comprising 15 claims was granted to the appellants (proprietors) in response to European patent application No. 91 200 898.4.

Claim 1 had the following wording:

"Whippable, non-dairy cream (NDC), comprising a water-continuous emulsion of an aqueous phase, containing optionally butter milk component and thickeners, and a fat phase in an amount of 15-25 wt% fat, comprising
1) fat selected from the group consisting of palm kernel, hardened palm kernel, palm mid fraction, palm stearin, palm kernel stearin, coconut, hardened coconut, cacao butter substitutes or mixtures thereof, which fat or mixtures can contain less than 10% butter fat (on NDC) and

2) not more than 0.7 wt% of an emulsifier system, comprising at least a stabilising and a destabilising emulsifier, which NDC is whippable within 6 min, when using a domestic, electrical whipper, either per se or after a tempering treatment."

- II. Notice of opposition to the grant of the patent was filed by both respondents (opponents) 01 and respondents (opponents) 02 under Article 100(a) and (b) EPC. Both respondents requested that the patent be revoked in its entirety on the grounds of lack of novelty (Articles 52(1), 54 EPC), lack of inventive step (Articles 52(1), 56 EPC), and insufficiency of disclosure (Article 83 EPC).

Out of the 20 citations relied on by the respondents in the course of the first-instance opposition proceedings the following were considered in the decision of the opposition division and are also referred to in this decision:

(10) EP-A-0 294 119

(13) R. A. Buchanan, D. R. Smith, "Recombined Whipping Cream" , XVII Int. Dairy Congress, 1966, Section F:2, pages 363 to 367

III. In the proceedings before the opposition division, the appellants requested maintenance of the patent in amended form on the basis of claims 1 to 14 filed on 14 December 1994.

Claim 1 as amended reads as follows:

"Whippable, non-dairy cream (NDC), comprising a water-continuous emulsion of an aqueous phase, containing optionally butter milk component and thickeners, and a fat phase in an amount of 15-25 wt% fat, comprising
1) fat selected from the group consisting of palm kernel, hardened palm kernel, palm mid fraction, palm stearin, palm kernel stearin, coconut, hardened coconut, cacao butter substitutes or mixtures thereof, which fat or mixtures can contain less than 10% butter fat (on NDC) and
2) not more than 0.7 wt% of an emulsifier system, comprising at least a stabilising and a destabilising emulsifier, which NDC **contains 1-5 wt% of milk protein, in particular casein, and is whippable within 6 min, when using a domestic, electrical whipper, either per se or after a tempering treatment.**"

Claim 1 is followed by dependent claims 2 to 8 relating to specific embodiments of the NDC according to claim 1.

Independent claim 9 as amended is worded as follows:

"Process for the preparation of a whippable NDC by making an emulsion of a water phase, containing **1-5 wt% of milk protein and** optionally butter milk component and thickeners, and a fat phase in an amount of 15-25 wt% fat, comprising

1) fat selected from the group consisting of palm kernel, hardened palm kernel, palm mid fraction, palm stearin, palm kernel stearin, coconut, hardened coconut, cacao butter substitutes or mixtures thereof, which fat or mixtures can contain less than 10% butter fat (on NDC) and

2) not more than 0.7 wt% of an emulsifier system, comprising at least a stabilising and a destabilising emulsifier,

and processing the so obtained emulsion by heating, sterilisation, homogenisation and cooling to a temperature below 15°C, further characterised by a tempering step, which is carried out after the cooling by warming the cooled emulsion to ambient temperature and keeping it at this temperature for several hours after which the NDC is cooled again below 15°C."

Claim 9 is followed by dependent claims 10 to 14 relating to specific embodiments of the process according to claim 9.

IV. The opposition division considered in its decision the amended claims to comply with the provisions of Article 123(2) and (3) EPC and found in the respondents submissions no basis for an objection under Article 83 EPC but revoked the patent under Article 102(1) EPC on the ground of lack of novelty of claim 1 (Articles 52(1), 54 EPC) over the state of the art according to citation (10).

With regard to the feature in claim 1 requiring that up to 0.7 wt% of an emulsifier system comprising at least a stabilising and a destabilising emulsifier be present in the claimed NDC, the opposition division referred to the content of 0.35 wt% polyoxyethylene sorbitan mono-stearate (a stabilising emulsifier) in the example on page 4 of (10) and considered the presence of about 0.1 wt% lecithin (a destabilising emulsifier) as implicitly disclosed by the reference in the said example to the content of 7 wt% butter milk powder which according to the disclosure in Table I on page 364 of (13) had a total phospholipid content of 1.3%.

In these circumstances, the opposition division saw no need to examine whether claim 1 was based on an inventive step and to look into the patentability of the other claims either.

V. The appellants filed an appeal against the decision of the opposition division and submitted the statement setting out the grounds of appeal within the time limit set by Article 108 EPC. With reference to the oral proceedings scheduled to take place on 25 November 1998 the appellants filed by fax dated 23 October 1998 auxiliary requests 1 to 4 and submitted by fax dated 28 October 1998 comparative evidence pertaining to the whipping time of certain NDCs which contain different compositions of emulsifiers.

VI. Oral proceedings were held before the board on 25 November 1998. During the proceedings, the respondents relied in addition to citations (10) and (13) on the following citation already submitted in the proceedings before the opposition division:

(19) Emulgatoren für Lebensmittel, edited by Georg Schuster, Springer Verlag Berlin, Heidelberg 1985, pages 100 to 106, 107, 114 to 124, 137 to 141, 246 to 248.

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

The opinion of the opposition division in the impugned decision that the present patent lacked novelty over citation (10) was unfounded and incorrect. The features and parameters recited in present claim 1 were in citation (10) neither mentioned nor implicitly disclosed and therefore not unambiguously derivable from the cited document. The features and parameters concerned were essentially the range of the total fat content, the upper limit of the butter fat content, the combination and proportion of the emulsifier system used requiring the presence of a stabilising and destabilising emulsifier in that system, and the whipping time as a further product characteristic of the claimed NDC.

In particular, in the artificial cream disclosed in (10) the total amount of fat was 10-50 wt% in general and was 35 wt% in the only example of (10). The fat range of 15-25 wt% as claimed in the patent was therefore not disclosed in (10). Similarly, the amount of butter fat in the example of (10) was 10 wt%. On the contrary, in the claimed product the amount of butter fat was limited to less than 10%.

As far as the emulsifier system specified in claim 1 was concerned, for creams with a fat content of less than 25 wt% the only emulsifier suggested in (10) was a mixture of lecithin and fatty acid monoesters. However, neither a limit as to the total amount of emulsifier used nor the specific emulsifier system requiring the presence of a stabilising and a destabilising emulsifier could be derived from (10). From the reference to a mixture of lecithin and fatty acid monoesters in (10) it was not clear whether that fatty acid monoester was saturated or unsaturated. However, only saturated fatty acid monoesters fell into the category of stabilising emulsifiers.

The experimental evidence provided on the part of the appellants demonstrated clearly that the addition of buttermilk powder as the sole source of a destabilising emulsifier (lecithin), as was the case in the example of (10), was insufficient to render a low fat NDC, according to the contested patent, whippable within a period of 6 minutes.

The whipping time with the upper limit of 6 minutes was likewise an important and well-defined product characteristic and could thus also serve to establish novelty over (10).

It was generally known to the skilled person that the whipping time was the period required to whip a cream to a firm texture suitable for piping. Data on the firmness and overrun of the whipped product were given in all four examples. The temperature at which the whipping time was determined, was indicated in the examples as being about 5°C. Claim 1 referred to the use of a domestic electrical whipper and the description mentioned as a specific example a whipper of the type "Kenwood-Chef" which was a typical utensil used in the home for whipping cream. The skilled person was also

aware that only by using the maximum speed would the reproducibility of the whipping time measurement be guaranteed. Since the standard package size for NDCs was about 250 ml the skilled person would use this amount for determining the whipping time. The objection made by the respondents under Article 83 EPC on the grounds of insufficiency of disclosure was therefore entirely unfounded.

VIII. Both respondents disagreed with the appellants' submissions and produced in the written procedure and at the oral proceedings essentially the following arguments:

Citation (10) disclosed explicitly and unequivocally NDCs with fat contents lower than 25%. The presence of butter fat was a compulsory feature neither in the NDC according to claim 1 of the contested patent nor in that disclosed in (10). The upper limit of the amount of butter fat, if present at all in the NDC disclosed in (10), could be calculated at about 6.7%, and was thus well within the range tolerated in the claimed NDC. The butter fat content was therefore, contrary to the appellants' submissions not a distinguishing feature.

The reference in (10) to a mixture of lecithin and fatty acid monoglycerides being a suitable emulsifier system for low fat creams containing 25% fat or less would be interpreted by the skilled person in the context of the whole disclosure as a mixture of lecithin and saturated fatty acid monoglycerides, ie a mixture of a destabilising and a stabilising emulsifier. This view was clearly supported by citation (19) which was a relevant handbook relating to the use of emulsifiers in foodstuff and as such reflected the general knowledge of the person skilled in the art at the priority date of the contested patent.

The opposition division was correct in its observation that the example in (10) already disclosed a whippable NDC which contains an emulsifier system comprising a stabilising and a destabilising emulsifier in a total amount of 0.45 wt%. This amount was well below the upper limit specified in claim 1 of the contested patent.

The opposition division's conclusion that the disclosure of (10) was prejudicial to the novelty of claim 1 was therefore correct. The objection to lack of novelty of present claim 1 was accordingly maintained by the respondents.

On the other hand, the respondents could not agree with the finding of the opposition division that the disclosure was sufficient to enable implementation of the functional technical feature at the end of claim 1 requiring that the claimed NDC be whippable within 6 minutes. In the impugned decision, the fact that the whipping time of a cream was determined by several factors, such as the effective work per time unit on the emulsion, the quantity and temperature of the emulsion to be whipped, was totally ignored. Moreover, it was self-evident that the whipping time was susceptible to considerable variations depending on the specific domestic whipper used and its operating speed. The respondents had already filed on 10 July 1995 experimental evidence that the above-mentioned factors had indeed a considerable impact on the actual whipping time.

Thus the subject-matter of present claim 1 was neither novel nor reproducible on the basis of the disclosure of the patent.

- IX. The appellants requested that the decision be set aside and that the patent be maintained on the basis of the claims filed on 14 December 1994 as the main request. As auxiliary requests 1 to 4 they requested that the patent be maintained on the basis of one of the sets of claims 1 to 4 filed on 23 October 1998.
- X. Both respondents requested that the appeal be dismissed. As auxiliary request they requested that the decision under appeal be set aside and the case be remitted to the department of first instance for further prosecution.

Reasons for the Decision

1. The appeal is admissible.
2. In the following reference is made to the **main request**.
3. *Sufficiency of disclosure (Article 100(b) in conjunction with Article 83 EPC)*
 - 3.1 In view of the respondents' objection in this respect, the board considers it appropriate to emphasise as a preliminary point that claim 1 relates to a product, more specifically a non-dairy cream (NDC), which is clearly and conclusively defined in terms of its composition (see paragraph III above). The components of the claimed NDC are all well-known, commercially available products and are explicitly referred to in the claims and in the corresponding parts of the description, as are the proportions of the individual components present in the claimed NDC. Moreover, the skilled person is given precise instructions in the patent specification (see especially page 2, line 52, to page 3, line 28), as to how he can prepare an NDC

according to the present claims. Therefore, the skilled person should not, in the board's judgment, encounter any difficulties in reducing the invention to practice on the basis of the disclosure of the contested patent.

3.2 Notwithstanding this, the respondents essentially argued that the invention had been insufficiently disclosed and the appellants had failed to comply with the requirements of Article 83 EPC because they had not furnished actual details of the conditions required to implement the functional technical feature in present claim 1 stipulating that the claimed NDC be "whippable within 6 minutes, when using a domestic, electrical whipper, either per se or after a tempering treatment". This objection appears to be basically a matter for the support and clarity of the claim under Article 84 EPC which is not available as a ground for opposition under Article 100 EPC. If this objection is nevertheless considered to concern the question of sufficiency of disclosure and reproducibility, the board concurs with the opinion of the opposition division that the requirements of Article 83 EPC have been met.

3.3 In this respect, as a preliminary point it should be noted that in accordance with the yet undisputed submissions of the appellants during oral proceedings no definite common standard or norm regulating the factors or conditions to be applied for whipping a cream on a domestic level appear to exist in the art. In any case there was no evidence provided in the course of the entire proceedings that such a standard or norm has up to now been made available to the public.

3.4 The board observes, that the respondents themselves did not provide any evidence that a NDC having a composition within the limits defined in present claim 1 and being prepared by the method disclosed in

the contested patent was indeed not whippable within 6 minutes. Rather they referred during oral proceedings before the board to the test report filed by the appellants on 28 October 1998, more specifically to experiment 3**, which was carried out as a comparative example in support of inventive step. They argued that this experiment was illustrative of the fact that the disclosure was not enabling, since the product of experiment 3** was not whippable. This argument is, in the board's judgment, not convincing.

To the product of experiment 3** no extra destabilising emulsifier was added with the exception of the amount of destabilising emulsifier possibly present in the 8.75 wt% butter milk powder added. However, in the contested patent the addition of butter milk powder is an entirely optional measure which means that some butter milk powder may be present in the claimed NDC or may not. Therefore, the disclosure of the invention in the application as filed (see especially page 2, line 38, to page 3, line 23; examples 1 to 4; claim 1) and the patent specification (see especially page 2, lines 41 to 50; examples 1 to 4; claim 1) provide the skilled reader with the clear instruction to use an emulsifier system which itself consists of 1) stabilising emulsifiers and 2) destabilising emulsifiers **irrespective of the fact that some butter milk powder is optionally added or not**. Thus, contrary to the respondents' allegation, experiment 3** cannot call into question the sufficiency of disclosure and reproducibility of the invention. Rather it shows that acting against the clear teaching and instructions given in the contested patent does not lead to the desired result.

- 3.5 On the other hand, the patent specification contains four examples which provide the skilled reader with all the necessary information and instructions as to **the**

composition and the process for the preparation of NDCs according to the patent which are whippable within the period specified in Claim 1. The data on firmness (Boucher) and overrun given in each of these examples provide moreover clear guidance for the skilled person to determine when the cream according to the invention is to be considered whipped.

Moreover, in interpreting the instructions to store the liquid NDC at 5°C before whipping (see examples 1 to 4), and to use an ordinary domestic, electrical whipper (see, Claim 1; page 2, lines 13 to 14) the skilled reader would already rule out the use of impracticably low or high temperatures, impracticably large amounts of liquid cream and unsuitable whipping utensils in order to comply with the whipping time of 6 minutes. Thus, on the basis of the information available in the patent specification, the skilled person could, in the board's judgment, by means of simple tests should he really need them - readily determine the conditions required for whipping the claimed liquid NDC within the period specified in claim 1. The effort called for to carry out such tests must be considered reasonable, since determination of suitable whipping conditions is in practice merely a matter of simple tests which are carried out routinely by a person skilled in the art e.g. a person familiar with the common daily practice of domestic cooking.

- 3.6 In view of the above considerations, the board sees in the respondents' submissions no basis for an objection under Article 83 EPC and accordingly no substantiation of the ground for opposition under Article 100(b) EPC.

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

4.1 The question to be decided is whether the whippable, non-dairy cream (NDC) forming the subject-matter of claim 1 of the contested patent (see paragraph III above) is novel having regard to the disclosure of citation (10).

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 NDC is derivable directly and unambiguously from the disclosure of citation (10) as a whole including any features implicit to a person skilled in the art in what is expressly mentioned in that citation.

4.2 Therefore, consideration has to be given to the actual information imparted to the skilled person by the disclosure of citation (10). This citation discloses an artificial whippable (see page 3, line 34) cream comprising as the essential ingredients:

- (i) 10-50 wt% of edible fat selected from lauric fat and vegetable butter, eg hydrogenated palm kernel oil, coconut oil and butter fat, in aqueous phase (see especially claim 1; description page 3, lines 1 to 3 and 43 to 47; example on page 4).

According to claim 11 and the disclosure on page 4, line 14, low fat creams may contain **approximately 25% or less fat.**

- (ii) **Protein** in an amount of 0.5 to 50% by weight, in general up to **4% protein** equivalent to 12% milk powder, provided by **milk proteins**, for example, sodium caseinate or buttermilk or buttermilk

powder (see claims 1 and 4; page 3, line 58, to page 4, line 2; page 4, line 19).

- (iii) **One or more emulsifiers** including phosphatides, for example, **lecithin, partial glycerides**, preferably of saturated C₁₈/C₁₈ fatty acids, propylene glycol monofatty acid esters of saturated C₁₈/C₁₈ fatty acids, esters of lactylated polyhydroxy short-chain fatty acid esters, monostearates and di-stearates of polyhydric alcohols such as sorbitan and polyoxyalkylene ethers of such esters. Combinations of such emulsifiers may be used, eg a mixture of polyglycerolesters of fatty acids, particularly of saturated acids with 16 to 22 carbon atoms, with diacetyltartaric esters of monoglycerides of such acids. According to (10), the choice of emulsifiers to give the best results may depend on the fat contents (see especially claims 1 and 8 to 10; page 4, lines 7 to 13).

In claim 11 and in lines 14 to 15 on page 4 it is stated that **"with low fat creams containing approximately 25% or less fat, as emulsifiers a mixture of lecithin and fatty acid monoglycerides is suitable"**.

The only **example** available in the cited document which specifically describes an artificial cream according to (10) contains the following components mentioned under (i) to (iii) above:

- (i) 7.5% hydrogenated palm kernel oil
17.5% coconut oil
10.0% butterfat
- (ii) 7.0% buttermilk powder
- (iii) 0.35% "TWEEN" 60 (polyoxyethylene sorbitan mono-stearate).

4.3 As a preliminary point it should be noted, that the above example on page 4 of (10) is the only disclosure in the cited document which specifically describes the artificial whippable cream disclosed in (10) in individualised form. However, that example refers to an artificial cream having a **total fat content of 35%** and is therefore already on the basis of feature (i) outside the scope of present claim 1.

4.4 Turning now to the content of citation (10) as a whole, the following points appear relevant for the correct evaluation of the technical teaching of the cited document:

As far as the disclosure of the emulsifier or combination of emulsifiers is concerned, citation (10) provides the skilled reader with no explicit teaching that, as the emulsifier system, a mixture comprising at least a stabilising and a destabilising emulsifier should be used, as required in claim 1 of the contested patent. Contrary to the respondents' submissions in this respect, the information given in line 14 on page 4 of (10) that "with low fat creams containing approximately 25% or less fat, a **mixture of lecithin and fatty acid monoglycerides** is suitable" does not, in the board's judgment, unequivocally disclose the use of an emulsifier system according to present claim 1 comprising a stabilising and a destabilising emulsifier, since the generically defined class of

"fatty acid monoglycerides" in the above mixture in (10) embraces, apart from **saturated** fatty acid monoglycerides, ie stabilising emulsifiers, **unsaturated** fatty acid monoglycerides as well. However, both lecithin and unsaturated fatty acid monoglycerides are classified in the contested patent in the group of suitable destabilising emulsifiers (see especially page 2, lines 42 to 43). The skilled person is therefore already at this stage in a position requiring a choice between the two options covered by the definition "fatty acid monoglycerides" used in (10).

With reference to the disclosure on page 4, lines 7 to 11, the respondents argued that, in the context of the class of fatty acid monoglycerides disclosed in (10), the skilled reader would be predominantly and preferably referred to monoglycerides of saturated fatty acids, ie to stabilising emulsifiers. Even if this disclosure indeed led the skilled person to use an emulsifier from the group of saturated fatty acid monoglycerides in combination with lecithin, he would immediately be confronted with the difficulty that citation (10) does not disclose the actual proportion of this particular emulsifier system used in a whippable NDC having a **fat content in the range of 15-25 wt%**. In present claim 1 this proportion is limited to an amount of **0.7 wt% maximum**. This limitation cannot be derived from the cited prior art.

- 4.5 In connection with the question of novelty, the respondents referred further to the general common knowledge of the art and cited in this respect specifically handbook (19) - see especially page 246, line 15 from the bottom, to page 247, line 9. Even if one accepted in favour of the respondents that the content of (19) does indeed reflect the general knowledge of the notionally skilled person in the field, that is to say that the combination of a

stabilising and a destabilising emulsifier was commonly used at the priority date of the contested patent in order to obtain readily whippable creams, this would not call into question the novelty of present claim 1 either. Citation (19) is similarly entirely silent about the amount or proportion of the emulsifier used in a whippable NDC having a **fat content in the range of 15-25 wt%**.

4.6 In the impugned decision the opposition division found that in Table I on page 364 of citation (13) buttermilk powder from an unknown source is reported to have a total phospholipid content of 1.3% and concluded therefrom that the 7 wt% buttermilk powder present in the example of citation (10) (see point 3.1 above) would add about 0.1 wt% (exactly 0.091 wt%) of lecithin to the artificial cream disclosed in the said example. On this basis, it calculated the total amount of emulsifier present in the example of citation (10) to about 0.45 wt% resulting from the presence of 0.35 wt% "TWEEN" 60 (polyoxyethylene sorbitan mono-stearate), ie a stabilising emulsifier, and about 0.1 wt% lecithin, ie a destabilising emulsifier. Based on this calculation the opposition division considered both the amount and composition of the emulsifier system used in present claim 1 to be anticipated by the above-mentioned disclosure of the example in (10).

Even if the above calculation was adopted on the basis that the lecithin content of buttermilk powder was at the priority date of the contested patent indeed part of the general specialist knowledge, the skilled person would again immediately be faced with the difficulty that the proportion of 0.45 wt% of the emulsifier system is disclosed in (10) exclusively in the context of an artificial cream having a **total fat content of 35 wt%, including 10% of butter fat**. However, the total fat content of 35 wt% and likewise the butter fat

content of 10% are both outside the scope of present claim 1. Thus, in order to combine the fat content and the amount of emulsifier specified in present claim 1, a further choice from the different options presented in the cited prior art is necessary to arrive at the subject-matter of the invention. Having regard to the teaching of citation (10) in its entirety, there is no reason for a person skilled in the art to associate the proportion of the emulsifier system of 0.45 wt% disclosed in the example with a low fat cream having a fat content of 25% or less referred to in line 14 on page 4 of the description.

4.7 From the foregoing it follows necessarily that citation (10) cannot, contrary to the opinion given in the impugned decision, be considered as containing a "prior implicit disclosure" either, in the sense that, in carrying out the teaching of (10), the skilled person would **inevitably** arrive at a result falling within the terms of present claim 1. On the contrary, as shown above, the exercise of a multiple conscious choice of parameters from the different options disclosed in the state of the art and their purposive combination would be necessary to arrive at such a result (see in this respect, for example, decisions T 12/81, OJ EPO 1982, 296, Reasons, points 7 to 10, T 124/87, OF EPO 1989, 491).

4.8 The board accordingly concludes that the subject-matter of present claim 1 is neither explicitly nor implicitly unambiguously and directly derivable from the cited prior art. It is therefore deemed to be novel within the meaning of Article 54(1) EPC.

5. *Remittal to the department of first instance
(Article 111(1) EPC)*

5.1 Although Article 111(1) EPC does not guarantee the parties an absolute right to have all the issues in the case considered by two instances (see in this respect eg decision T 0133/87, especially reasons, point 2), it is well recognised that any party should possibly be given the opportunity to two readings of the important elements of the case. In accordance with decisions G 9/91 and G 10/91 (OJ EPO 1993, 408 and 420, see especially reasons, point 18); the essential function of an appeal in inter partes proceedings is to consider whether the decision which has been issued by the first instance department is correct. Hence, a case is normally referred back, if essential questions regarding the patentability of the claimed subject-matter have not yet been examined and decided by the department of first instance.

In particular, remittal is taken into consideration by the boards in cases where a first instance department issues a decision solely upon **one particular issue** which is decisive for the case against a party and leaves other essential issues outstanding. If, following appeal proceedings, the appeal on **the particular issue** is allowed, the case is normally remitted to the first instance department for consideration of the undecided issues (cf. Paterson, *The European Patent System*, London 1992, page 90, no. 2 to 83; Moser, *Europäisches Patentübereinkommen*, *Münchener Gemeinschaftskommentar*, 1997, Article 111, 6.1).

5.2 The observations and comments made above apply fully to the present case. The opposition division decided that claim 1 was not patentable on the ground of **lack of novelty** (Article 52(1) in conjunction with Article 54(1) EPC), but left the essential issues of inventive step (Articles 52(1), 56 EPC) and patentability of the other claims, including independent claim 9, undecided. These issues, however, form, *inter alia*, the basis for the requests of both respondents that the patent be revoked in **its entirety** and must therefore be considered as essential **substantive issues** in the present case.

It must also be noted that the opposition division considered in its decision, out of the 20 citations cited during the opposition proceedings, only citations (10) and (13). However, in the board's judgment, at least some of the other citations, which have not yet been considered, could turn out to be of a certain relevance when it comes to the decision on the question of inventive step in the present case.

5.3 Thus, in view of the above considerations and having carefully weighed up both the possible disadvantages of a further delay in the procedure and also the possible consequences of depriving any party of the opportunity of two readings of the yet undecided issues, the board has reached the conclusion that, **in the circumstances of the present case**, it is justified and even necessary to remit the case to the opposition division for further prosecution.

6. Since the main request is considered acceptable with respect to novelty and sufficiency, there is, at this stage, no need to deal with the auxiliary requests.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:

M. Martorana

P. A. M. Lançon

