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**D E C I S I O N**  
**of 24 October 2001**

**Case Number:** T 0724/99 - 3.3.2

**Application Number:** 95908256.1

**Publication Number:** 0710074

**IPC:** A23G 9/02

**Language of the proceedings:** EN

**Title of invention:**  
ICE CONFECTIONS

**Patentee:**  
UNILEVER PLC, et al

**Opponent:**  
NESTEC S.A.  
Schöller Lebensmittel GmbH & Co KG  
MIDOR AG  
Nestlé Nederland B.V.  
Yorkshire Dales Ice Cream Ltd  
Frisa NV

**Headword:**  
Ice confections/UNILEVER

**Relevant legal provisions:**  
EPC Art. 99(1), 107, 101(2), 123(2)(3), 112(1)(b), 112(2)(3)  
EPC R. 58(2), 66(1)  
RPBA Art. 16, 17

**Keyword:**  
"Applicability of decision G 0001/99 - yes"  
"Alternative amendment not leading to *reformatio in peius* - possible - no such amendment requested by the Respondent (Patentee)"

**Decisions cited:**  
T 0543/99, G 0001/99, G 0004/93, G 0009/92, G 0009/93,

G 0001/84, G 0004/92

**Headnote:**  
(follows)



Case Number: T 0724/99 - 3.3.2

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.2**  
**of 24 October 2001**

**Appellant:**  
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**Decision under appeal:** Interlocutory decision of the Opposition Division  
of the European Patent Office posted 11 May 1999  
concerning maintenance of European patent  
No. 0 710 074 in amended form.

**Composition of the Board:**

**Chairman:** P. A. M. Lançon  
**Members:** U. Oswald  
C. Rennie-Smith

## Summary of Facts and Submissions

I. European patent No. 710 074 was granted on the basis of 8 claims of which the sole independent claim reads as follows:

"1. A method of preparing a two-component ice confection in which:

i) a surface of a mass of milk containing ice confection is brought to a temperature of below about -15°C

ii) the surface is immersed in a water ice solution having a solids content between 15% and 50% by weight for a time sufficient to allow a layer of water ice to form on the surface, and

iii) the whole is subjected to a hardening step to form the water ice layer, whereby the whole is cooled to a temperature of step (i) or below."

II. Oppositions were filed against the granted patent by Opponents I to VI on the grounds of lack of novelty and inventive step under Article 100(a) EPC and insufficiency of disclosure under Article 100(b) EPC. The notice of opposition filed by Opponent II referred to a "co-opponent" (Miteinsprechender) and named a second company as such but only one opposition fee was paid.

III. By its interlocutory decision posted on 11 May 1999 the Opposition Division maintained the patent on the basis of an amended set of 6 claims, filed during the oral proceedings before it on 25 March 1999, of which the sole independent claim reads as follows:

"1. A method of preparing a two-component ice confection in which:

- i) a surface of a mass of milk containing ice confection is brought to a temperature of below  $-25^{\circ}\text{C}$
- ii) the surface is immersed in a water ice solution having a solids content between 15% and 50% by weight for a time sufficient to allow a layer of water ice to form on the surface, and
- iii) the formation of the water ice layer of step (ii) is completed by a hardening step, whereby the whole water ice layer is cooled to a temperature below  $-15^{\circ}\text{C}$  in a refrigerated volume at  $-40^{\circ}\text{C}$  or below or by immersion in a cryogenic liquid."

- IV. Each of the Appellants (Opponents) lodged an appeal against this decision.
  
- V. Appellants V and VI, by letters of 10 December 1999 and 28 January 2000 respectively, and the Respondents (the Patent Proprietors), by a letter also of 28 January 2000, requested acceleration of the appeal proceedings.

The Respondents' request referred to the Notice from the Vice-President of Directorate-General 3 of the EPO of 19 May 1998 (OJ 1998, 362) and enclosed copies of documents evidencing the commencement of national (English) infringement proceedings against Appellants V and VI and a related company of Appellants I and IV. By a Communication of 15 March 2000 the Board directed that the appeal proceedings be accelerated, there being a consensus between at least three parties on both sides of the proceedings that they should be accelerated, and national infringement proceedings being an example in the said Notice of a case where acceleration may be appropriate.

In letters to the Board of 28 March 2000 Appellants I and IV said they did not agree to such acceleration. Appellant IV gave as its only reason that infringement proceedings against it and other parties in the Netherlands in 1997 were unsuccessful. Appellant I referred also to earlier proceedings in Italy, to the fact some parties had not requested acceleration, to the judgment of 3 February 2000 of the English Patents Court staying the infringement action pending against Appellant VI, and suggested that acceleration might prevent sufficient consideration of the issues in this appeal.

The parties were informed by the Board's Communication of 31 March 2000 that the acceleration direction could not be changed. If the earlier proceedings in the Netherlands or Italy constituted a reason for refusing acceleration, this was outweighed by the fact that the criteria for acceleration in the aforesaid Notice were satisfied and by the consensus for acceleration between several of the parties. Acceleration of these appeals and the stay of the English proceedings should together ensure, as both the national judge and the Board agreed, that substantial costs were saved and undesirable parallel litigation avoided over a patent which might either be revoked or amended by the Board (see pages 14G-15B and 15G-16B of the national court judgement). The Board also observed that acceleration affects only the speed at which an appeal is conducted and not the quality of the consideration given to the issues.

VI. By a Communication of 24 March 2000 the Board expressed its provisional opinion that amendments made to the claims during the opposition proceedings appeared not



to meet the requirements of Article 123(2) and (3) EPC.

In reply the Respondents filed, with a letter dated 22 May 2000, a new main and five auxiliary requests. In a further Communication of 19 December 2000, the Board indicated Article 123(2) and (3) remained in issue as regards a number of those new requests.

The Appellants all filed written arguments in their Grounds of Appeal and several also filed one or more further written submissions responding to the Board's Communications and the Respondents' various requests. In its submissions dated and filed on 15 May 2001, Appellant 1 raised arguments of *reformatio in peius* based *inter alia* on decision G 1/99 of the Enlarged Board of Appeal.

By their letter dated 24 September 2001, the Respondents withdrew all their previous requests and made their sole request the maintenance of the patent as granted by the Examining Division.

VII. On 19 December 2000 the parties were summoned to oral proceedings. On 22 October 2001 the Respondents informed the Board in writing, and confirmed by telephone, that they would not be attending the oral proceedings held on the 24 October 2001.

VIII. To the extent relevant to the issues ultimately decided at the oral proceedings, the Appellants argued *inter alia*:

That, since the claims as granted were broader than the amended claims as maintained, the Respondents' only request (to maintain the patent as granted) would put

the Appellants in a worse situation than if they had not appealed; and the request was therefore inadmissible as *reformatio in peius*.

That decision G 1/99, since it only clarified earlier decisions, applies to the present case in which possible requests complying with the order in G 1/99 could have been filed which would not have put the Appellants in a worse situation than if they had not appealed.

That, even if G 1/99 did not apply, the Respondents' request was inadmissible in view of the earlier Enlarged Board decisions G 9/92 and G 4/93 (OJ EPO 1994, 875) which held that a non-appealing patentee is primarily limited to defending the version of the claims as maintained by the Opposition Division and that only appropriate and necessary amendments are admissible.

IX. The Respondents' arguments, submitted in writing, relevant to the issues ultimately decided at the oral proceedings, were *inter alia* as follows:

That the request to maintain the patent as granted overcame the various objections under Article 123(2) EPC made during the appeal proceedings and complied with the principles of the Enlarged Board decisions as to *reformatio in peius* at least until the publication of G 1/99.

That G 1/99 could not apply to the present case because it was published after the date of filing of the amendments allowed by the Opposition Division. Those amendments had thus been made in the knowledge of the

earlier Enlarged Board decisions and in the belief that, if an objection was made under Article 123(2) EPC, an amendment replacing the temperature of "below - 25°C" in step (i) by "below about -15°C" (thus in effect reverting to the text of claim 1 as granted) would be allowable.

That G 1/99 prevented *reformatio in peius* if it was possible to introduce limiting features into a claim, whereas in the present case no amendment could be made which would meet the various objections under Article 123(2) EPC raised by the Appellants while at the same time offering any actual protection.

- X. The Appellants requested that the decision under appeal be set aside and the patent be revoked

The Respondents requested that the patent be maintained as granted by the Examining Division.

## **Reasons for the Decision**

### *Admissibility of the Appeals*

1. All the appeals are admissible. In the case of Appellant II however, the original opposition must, as regards the second-named company in the notice of opposition, be deemed not to have been filed since it did not pay the opposition fee as required by Article 99(1) EPC. It follows that, not having filed an admissible opposition, that company could not be adversely affected by the decision under appeal (see Article 107 EPC) and that the appeal of Appellant II is, as regards that company, also inadmissible. The

reasons given in decision T 543/99 (of 24 October 2000, not published in OJ EPO) apply equally in this case. The Board observes that EPO Form 2300 (the standard form produced by the EPO for optional use as a notice of opposition), which uses the words "Multiple opponents" (in the German version used by Opponent II "Gemeinsamer Einspruch") unaccompanied by a reminder that each opponent must pay an opposition fee, could be better worded.

*Admissibility of the Respondents' request*

2. The state of the case reached by the oral proceedings, when the Respondents had only one request - maintenance of the patent as granted - and the Appellants objected to the admissibility of this request as *reformatio in peius*, requires the Board to consider the following questions:
  - (a) On a comparison of the claims (in effect claim 1, the only independent claim), is the granted form wider than the amended form maintained by the Opposition Division? If the answer is no, there can be no *reformatio in peius* and the admissibility objection fails.
  - (b) If the answer to question (a) is yes, there is a *prima facie* case of *reformatio in peius*. The next question which then arises, on the arguments in this case and before deciding whether such *reformatio* is permissible, is whether decision G 1/99 of the Enlarged Board of Appeal, delivered while these appeals were pending, applies to the present case (as the Appellants argued) or does not apply (as the Respondents argued).

- (c) Having by the answer to question (b) established the extent of the relevant case-law, the final question to be answered is whether the apparent *reformatio in peius* is permissible or not. This question calls for consideration, if G 1/99 is applicable, of the Enlarged Board's guidance in that opinion as to what amendments non-appealing respondent patentees may make, and of the arguments in this case as to whether the Respondents could have made alternative acceptable amendments.

*Comparison of Claim 1 as Granted and as Amended*

3.1 Claim 1, in the amended form which the Opposition Division found to meet the requirements of the EPC, contained, in comparison with the claims as granted, the following amendments (see paragraphs I and III above):

- (A) in step (i) the temperature of "below about -15°C" became "below about -25°C";
- (B) in step (iii) "the whole" was replaced by "the whole water ice layer";
- (C) the temperature in step (iii), to which in the claim as granted "the whole" was cooled, was "the temperature of step (i) or below" whereas the temperature, to which in the claim as amended "the whole water ice layer" is cooled, is "below -15°C"; and
- (D) in step (iii) the amended claim includes the additional feature of specified cooling means,

namely "in a refrigerated volume at -40°C or below or by immersion in a cryogenic liquid".

3.2 The Board considers that amendments (B) and (C) produce some extension of the scope of protection within the meaning of Article 123(3) EPC (with the result that reversion to the wording of claim 1 as granted would amount to a **reduction** in scope compared with the amended claim as maintained). However, there is no doubt that amendments (A) and (D) result in a narrowing of the claims. According to step (i) in its amended form, the claimed method is restricted to a temperature below about -25°C for the surface of a mass of milk whereas in the method as granted the possible temperature of the surface of the mass of milk is extended upwards by ten degrees from about -25°C to about -15°C. Moreover, according to step (iii) in its amended form, the claimed method requires specific cooling means such as a cryogenic liquid whereas the method as granted contained no such limiting feature and thus embraced any technically feasible means of cooling to reach the desired temperature. Accordingly, claim 1 of the patent as granted, and as now requested by the Respondents, covers ways of performing the method which were excluded by the amended claims as maintained by the Opposition Division (with the result that reversion to the wording of claim 1 as granted would amount to an **extension** of scope compared with the amended claim as maintained).

3.3 The Board therefore concludes that, by reverting in their only outstanding request in the appeal proceedings to the method as granted, the Respondents (who have not themselves appealed) would, if their request were to succeed, put the Appellants in a worse

position than if they had not appealed. This amounts *prima facie* to *reformatio in peius* - a worse outcome for an appellant - as considered and defined in the case-law. (See the Enlarged Board decisions G 9/92 and G 4/93 (OJ EPO 1994, 875) and G 1/99 (OJ EPO 2001, 381). As in G 1/99, the Board will refer below only to G 4/93.)

*Application of G 1/99*

- 4.1 The Respondents argued that G 1/99 cannot apply in the present case because it was published after the date on which the amendments were presented to the Opposition Division and to apply it retrospectively would be in total contradiction to the approach taken in decision G 9/93 (OJ EPO 1994, 891). The Appellants argued that G 1/99 merely clarifies the earlier law and is not so limited in its effect. The Board agrees with the Appellants for the following reasons.
- 4.2 First, the Respondents' argument poses an immediate difficulty by the choice of the date after which, as they argue, G 1/99 should not have a retrospective effect. The relevant case-law is considered at any instance when a decision is being made, not when proceedings are commenced or any particular step in the proceedings is taken by a party such, as the Respondents suggest here, the filing of amendments. It would follow, if the Respondents were correct, that in each pending case the date of each earlier and possibly relevant case would have to be examined and, if it fell after the date of a certain step in the pending case, the earlier decision would have to be ignored.
- 4.3 Second, the Respondents' argument would suggest case-

law is binding unless otherwise stated which is contrary to the accepted practice. In the legal system established under the EPC there is no principle of absolute or binding case-law. Earlier decisions are authoritative and often followed, but the absence of any general obligation to treat earlier decisions as binding is highlighted not just by the specific saving the Enlarged Board considered necessary in G 9/93 (see paragraph 4.4 below) but also, and more importantly, by the presence in the EPC and its subsidiary legislation of provisions to deal with the inevitable differences of opinion non-binding case-law may produce (Article 112(1)(b) EPC; Articles 16 and 17 RPBA) and of provisions as to when, exceptionally, decisions do have a binding effect (Articles 111(2) and 112(3) EPC). Those exceptions, it should be noted, only relate to further proceedings in the particular cases in question and not to all subsequent decisions with the same issues.

- 4.4 Third, the case on which the Respondents rely does not assist them. In G 9/93 the Enlarged Board overruled its earlier decision G 1/84 (OJ EPO 1985, 299) on the question of oppositions filed against their own patents by proprietors. G 1/84 had held such oppositions were permissible - in complete contrast G 9/93 held they were not. In such a situation, where the law is completely changed by a case-law development, it was quite understandable that the Enlarged Board should have built into its decision a saving for innocent third parties who would otherwise have found themselves in a "trap", namely any patent proprietors who had in reliance on G 1/84 filed oppositions which were pending when the decision in G 9/93 was made. Although no such saving appears either explicitly or implicitly in the



text of the Enlarged Board's decision in G 1/99, for the Respondents' argument to succeed the Board would at the very least have to be satisfied that G 1/99 could otherwise spring such a trap on innocent third parties.

4.5 It appears to the Board that nothing could be further from the case. Far from effecting a complete change in the law, G 1/99 merely clarified the existing case-law, as already contained in the leading case G 4/93, on the question of *reformatio in peius* as it applies to non-appealing patentees. Far from changing the law so as to leave a number of parties to pending proceedings in a trap, it actually assisted non-appealing patentees by setting out a series of possible "escape routes" open to them when faced with objections of *reformatio in peius*. In fact, any "entrapment" of patentees by such an objection has if anything been reduced by G 1/99.

4.6 That the effect of G 1/99 is if anything in favour of non-appealing patentees is readily apparent from a comparison of that decision with G 4/93. The crucial passage of that earlier decision for such patentees reads:

"16 The patent proprietor, who has not filed an appeal and is therefore only a party to the proceedings under Article 107, second sentence, EPC, does not have the right to file a "cross- appeal" without limit of time. Unlike the rights he would have as appellant, his requests are therefore subject to restrictions. By not filing an appeal, he has indicated that he will not contest the maintenance of the patent in the version accepted by the Opposition Division in its decision. He is therefore primarily limited to defending this

version. Any amendments he proposes in the appeal proceedings may be rejected by the Board of Appeal if they are neither appropriate nor necessary, which is the case if the amendments do not arise from the appeal."

Turning to G 1/99, the limits of the subject-matter of the decision are clearly apparent:

"2.3 As regards putting the opponent/appellant in a worse situation, [the referring Board] only referred to the possible deletion of a limiting feature added during opposition proceedings.... Consequently, in the present decision, the Enlarged Board of Appeal only addresses the question whether and under what circumstances such a deletion is permissible."

It is thus abundantly clear that G 1/99 is confined to a consideration of one possible exception, namely deletion of a limiting feature added during opposition, to the general rule enunciated in G 4/93 that amendments not arising from the appeal are neither appropriate nor necessary. As is equally clear from the order in G 1/99 (and paragraph 15 of the Reasons on which the order is based), such an exception was accepted by the Enlarged Board as possible and three possible ways of achieving it were set out in descending order of desirability.

4.7 The Board accordingly rejects the Respondents' argument that G 1/99 has no retrospective effect. G 1/99 must be considered as part of the relevant case-law.

*Admissibility of the Respondents' request notwithstanding*

*reformatio in peius*

- 5.1 As mentioned above, G 1/99 gives a non-appealing patentee three possibilities to amend even if this leads to *reformatio in peius*, provided the prohibition in Article 123(3) EPC against extension of the scope of the patent as granted is observed. As the first possibility, a patentee is allowed to amend by introducing one or more originally disclosed features which limit the scope of the patent as maintained. If, and only if, such a limitation is not possible, a patentee may then, as a second possibility, within the limits of Article 123(3) EPC, file a request (such as that now under consideration) which would extend the scope of the patent as maintained.
- 5.2 The Board must accordingly first consider whether any alternative amendment not leading to *reformatio in peius* was available to the Respondents. The Respondents argue there was no such possibility which would both answer the objections made and leave them with any protection. The Appellants argue there were in fact such possibilities.
- 5.3 Before considering whether such possibilities in fact existed, the Board makes two observations. First, the Respondent's request filed before the oral proceedings, to maintain the patent as granted, was made with full knowledge both of the objections of the Appellants to the amendments in the patent as maintained and of the Board's own provisional views in its communications. Moreover, the Respondents' attention had already been drawn to decision G 1/99 (see paragraph VI above) and thus to the possibility of filing other requests than maintenance of the patent as granted in order to

overcome such objections and views.

5.4 Second, Appellant V put forward contradictory arguments on this issue (see its letter dated 24 September 2001). On the one hand, it said the request of the Respondents reverting to the claims as granted should be refused in the light of decision G 1/99 - an argument suggesting the claims as granted were broader than the claims as maintained. On the other hand, it said the amendments made as a result of the opposition proceedings lead to an extension of protection - an argument suggesting that the claims as maintained were broader than the claims as granted. However, in the oral proceedings before the Board Appellant V argued that the granted claims were clearly broader than the maintained claims, at least as regards the temperature at which step (i) of claim 1 is performed.

5.5 As to whether it would have been possible to frame requests with alternative amendments containing disclosed limiting features which would have avoided *reformatio in peius*, the Board agrees with the Appellants who pointed to several such possible amendments which would have restricted the scope of the patent as maintained and thereby overcome the earlier objections under Article 123 EPC. One example given by Appellant V was that, in step (i) of claim 1 as granted, a temperature of below -40°C could have been introduced. The Board also notes that, in the set of claims as granted, the dependent claims contain several limiting features which, in combination with the features of claim 1 as granted, offered other possibilities for restricting the scope of the patent as maintained. Such possibilities would have included, in addition to Appellant V's example, the combination

of claim 1 as granted with a temperature of below  $-25^{\circ}\text{C}$  as in claim 2, and the introduction into claim 1 as granted of a cooling step by immersion in a cryogenic liquid as in claim 6 as granted. Such combinations would have been obvious ways to restrict the claims as maintained by the Opposition Division.

- 5.6 As for the Respondents' argument that no amendment could be made which would meet the objections under Article 123(2) EPC while offering any actual protection, the Board finds this incorrect not only for the reasons in the previous paragraph but also for the simple reason that if, which is not the case here, there really are no amendments which can be made to avoid objections to patentability, there can be no valid patent. Relying as they have on G 4/93, the Respondents must have been aware that *reformatio in peius* only affects a patentee which does not appeal against an interlocutory decision maintaining a patent in amended form and that, if they wished to pursue the protection offered by the patent as granted, they should have themselves appealed.
- 5.7 Last but not least, before reverting to the patent as granted as its only request, the Respondent had filed a number of requests, several of which had not been objected to under Article 123 EPC in the Board's communications.
- 5.8 It appears therefore that a request could have been filed which would have overcome the objections put forward by the Appellants and the Board but which would not have put the Appellants in a worse situation than if they had not appealed. As such a limitation was possible the Respondents' only request must be held

inadmissible.

*Absence of the Respondents at the Oral Proceedings*

6. The present decision has been taken against the Respondents at the oral proceedings at which, although duly summoned, they did not appear. However, as appears from the reasons above, the decision is based only on facts and arguments that the Respondents knew and as to which they put forward submissions in writing before the oral proceedings. The requirements of Article 113(1) EPC have consequently been met (see G 4/92, OJ EPO 1994, 194).

**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:

A. Townend

P. A. M. Lançon