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DECISION
of 27 November 2003

Case Number: T 0947/99 - 3.3.2
Application Number: 93921860.8
Publication Number: 0662787
IPC: A23G 1/20
Language of the proceedings: EN

Title of invention:
Production of confectionery

Patentee:
UNILEVER PLC, et al

Opponent:
NESTEC S.A.

Headword:
Confectionary/UNILEVER

Relevant legal provisions:
EPC Art. 54, 56, 69, 83, 100(a),(b), 114(2), 117(1),
123(2),(3), 71(2)

Keyword:
"Late filed facts, evidence and arguments relating to
adequately substantiated allegations of prior use (admitted)"
"Prior use (yes) - direct and unlimited access to any
information regarding methods known per se for the production
of confectionary in three different factories was possible"

Decisions cited:
G 0002/88, G 0006/88, G 0001/92, T 0093/89, T 0534/89,
T 0538/99, T 0211/90, T 0628/90, T 0830/90, T 0017/91,
T 0150/93

Catchword:
-



Case Number: T 0947/99 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 27 November 2003

Appellant: NESTEC S.A.
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
3 August 1999 concerning maintenance of
European patent No. 0662787 in amended form.

Composition of the Board:

Chairman: U. Oswald
Members: G. F. E. Rampold
J. H. P. Willems

Summary of Facts and Submissions

I. This appeal is against the interlocutory decision in opposition proceedings posted on 3 August 1999 maintaining European patent No. 66 27 87 ("the Patent") in amended form. The Patent was granted to the proprietor/respondent in response to European patent application No. 93 921 860.8 and is entitled "Production of Confectionery". Claim 1 of the Patent as granted read as follows:

"1. A method of preparing chocolate products by moulding in which

- (i) a fat-containing mass at a temperature in the range 15°C, preferably from 28°C to 55°C and having a fat content of at least 25% by weight is introduced into a mould having a temperature of from 0°C to -40°C;
- (ii) the fat-containing mass is retained in contact with the mould for a period sufficient to allow the fat-containing mass to solidify in an unstable form at least in the layer in contact with the mould, and
- (iii) the fat containing product is removed from the mould."

Dependent claims 2 to 10 related to elaborations of the method according to claim 1.

II. The opponent/appellant gave notice of opposition on **19 March 1997**, the date on which publication of the mention of the grant of the Patent appeared in the European Patent Bulletin 1997/12. In its statement of opposition filed on the same date, the opponent sought

revocation in full of the Patent on the grounds of lack of novelty and inventive step (Articles 54, 56 and 100 (a) EPC), and also on the ground of insufficient disclosure (Articles 83 and 100(b) EPC).

III. In the statement of opposition, the following documents were cited individually against novelty and inventive step of the subject-matter claimed in the Patent:

(1) = DE-B-1 180 613,

(2) = CH-B-379 249 and

(3) = US-A-4 426 402.

In addition, the following documents were cited individually against inventive step of the subject-matter claimed in the Patent:

(4) = US-A-2 670 696 and

(5) = US-A-3 529 553.

IV. By its letter of **17 June 1999**, received by the Office on **18 June 1999**, ie about 18 months after expiry of the time limit for opposition set in Article 99(1) EPC (see II above), the opponent/appellant introduced into the proceedings a new objection of lack of novelty and inventive step on account of alleged public prior use based on the manufacture and sale of (a) the **FEST IS** range by Frisco Sol Is (hereinafter referred to as "**FRISKO**"). To substantiate this prior use allegation, the opponent/appellant filed under the same cover, *inter alia*, a first declaration by Dr Johan Bisgaard

(hereinafter referred to as "BISGAARD I"). "BISGAARD I" was accompanied by three exhibits designated JB-1, JB-2 and JB-3.

V. In its interlocutory decision, the opposition division found that the amended set of claims 1 to 8 and the consequentially amended description, both filed during oral proceedings held on **20 July 1999** before it, met the requirements of the EPC. Claim 1 as maintained by the opposition division reads as follows, with the amendments highlighted in bold italics below:

"1. A method of preparing **frozen filled** chocolate products by moulding **comprising**:

(i) a **chocolate** mass at a temperature in the range of 15°C, preferably from 28°C, to 55°C and having a fat content of at least 25% by weight is introduced into a mould having a temperature of from 0°C to -40°C;

(ii) **the chocolate mass** is retained in contact with the mould for a period sufficient to allow the **chocolate mass** to solidify in an unstable form at least in the layer in contact with the mould **to provide a chocolate shell**;

(iii) the chocolate shell is filled with a filling; and

(iv) the **filled chocolate** product is removed from the mould."

Dependent claims 2 to 8 relate to elaborations of the method according to claim 1.

VI. The essence of the reasoning in the opposition division's interlocutory decision was as follows:

(A) As regards the opponent's objection on the **ground of insufficiency**, the opposition division considered that the patent specification contained at column 2, lines 19 to 21, a satisfactory explanation of what is meant by the reference in current claim 1 to a "*chocolate mass in an unstable form*" and also adequate instructions which would allow the skilled person to obtain the chocolate mass in the postulated unstable form. Since, moreover, the general term "fat-containing mass" used in the claims as granted (see I above) has been replaced in the claims as amended by the more restrictive wording "chocolate mass" (see IV above), the opposition division found that the Patent fulfilled the requirement of enabling disclosure and that insufficiency as a ground for opposition was no longer of relevance to the Patent in amended form.

(B) As regards the opponent's/appellant's **objection of lack of novelty** based on the prior art of citations (1) to (3), the opposition division found that none of the cited documents anticipated the subject-matter of the claims as amended.

As to the opponent's **objection of lack of novelty** on account of alleged **public prior use** by (a) "**FRISKO**", the opposition division decided to disregard this prior use allegation for having been filed too late and also for being only insufficiently substantiated by the evidence presented by the opponent/appellant. In this context, the opposition division observed in the decision under appeal that the declaration by Dr

Bisgaard ("BISGAARD I") did not reveal the identity of any member of the public who had the opportunity to visit the manufacturing facility at the company "**FRISKO**", a subsidiary of the respondent company, where the public prior use, ie the production of the "**FEST IS**" range of desserts, had allegedly taken place. Moreover, it observed in the impugned decision that in Dr Bisgaard's declaration no detailed information had been given as regards those technical features of the manufacturing process which could have been recognised by a skilled visitor of "**FRISKO'S**" manufacturing facility. It was thus impossible, in the opinion of the opposition division, to determine the nature and extent of knowledge members of the public could have gained from their visit of "**FRISKO'S**" manufacturing plant.

The opposition division further mentioned in its decision that Dr Bisgaard's declaration was accompanied by three supporting exhibits, designated JB-1, JB-2 and JB-3. JB-1 and JB-2 were extracts from advertising and promotion materials in respect of a broad range of "**FRISKO'S**" ice cream products made available to the public prior to the priority date of the Patent. The opposition division found, however, that these materials did not describe the particular manufacturing process of the ice cream products disclosed therein and that the evidence produced by the opponent was thus inappropriate to support the allegation of public prior use. Exhibit JB-3 was a flow chart showing the consecutive steps used for the production of the "**FEST IS**" range. This flow chart

was designed by Dr Bisgaard after the filing date of the Patent and was therefore, in the opposition divisions' judgment, likewise an inappropriate piece of evidence, and as such insufficient to destroy the novelty of the claimed method in the Patent.

- (C) As to **inventive step**, the opposition division considered citation (2) to represent the closest state of the art because (2) was the only citation in the opposition proceedings relating to a manufacturing process for filled frozen chocolate products. It determined the problem to be solved by the claimed invention in relation to the prior art of (2) as that of improving, on the one hand, the taste and eating quality of filled frozen chocolate products and, on the other, the contact between the chocolate couverture and the frozen filling, such as, for example, ice cream.

The opposition division found that none of the cited prior art documents, alone or in combination, suggested to a person skilled in the art solving the problem posed by the modification of the process parameters used in the manufacturing process of (2) in the direction of those used in the claimed process in the Patent.

- VII. The opponent/appellant gave notice of appeal against this decision on **29 September 1999** and paid the appropriate fee on the same date. In its statement setting out the grounds of appeal, received by the Office on **10 December 1999**, the appellant referred to two further instances of public prior use based on the

manufacture and sale of (b) the **ISSTJERNE** product by "**PREMIER IS**" and (c) the **ROLADE** product by "**FREDERIKSBORG IS**".

As a further piece of evidence in support of its allegation of public prior use by (a) "**FRISKO**", the appellant filed at the appeal stage on **13 December 1999** a second declaration by the same Dr Johan Bisgaard (hereinafter referred to as "**BISGAARD II**").

A new declaration by Mr Frank Jørgen Pedersen (hereinafter referred to as "**PEDERSEN**") was filed by the appellant on **24 December 1999**, with its letter of 21 December 1999, in support of its allegation of public prior use by (b) "**PREMIER IS**". "**PEDERSEN**" was accompanied by exhibits FP1, FP2 and FP3.

On **9 February 2000**, with its letter dated 8 February 2000, the appellant filed a declaration by Mr Hans-Jørgen Eibye (hereinafter referred to as "**EIBYE**") to substantiate the alleged public prior use by (c) "**FREDERIKSBORG IS**".

VIII. The respondent filed arguments supporting its request for the appeal to be dismissed with letters of 25 April 2000 and 27 October 2003, enclosing three separate declarations by Huw Nigel Evans (hereinafter referred to as "**EVANS**"), Borge Sorensen (hereinafter referred to as "**SORENSEN**") and Martin John Izzard (hereinafter referred to as "**IZZARD**"). It requested accelerated processing of the appeal proceedings in accordance with the Notice of the Vice-President Directorate-General 3 dated 19 May 1998 (OJ EPO 1998, 362) In this connection, the respondent submitted all relevant documents showing

that infringement proceedings had been brought up by the respondent in the UK against Nestlé UK LTD, a company related to the appellant company, and that such infringement proceedings were in progress, and in fact stayed the proceedings pending the outcome of this appeal.

IX. By official letter issued on 11 July 2003, the parties were summoned to oral proceedings fixed for 27 November 2003.

X. On 17 October 2003 the appellant's authorised representative withdrew the request for oral proceedings and informed the board that the appellant would be neither present nor represented at the hearing.

XI. In a board's communication of 6 November 2003, the rapporteur notified the parties that they should be prepared to discuss at the oral proceedings the question of whether or not the amendment of the wording of the claim as granted "A method <.....> **in which** <.....>" (see I above) so as to read in the claim as amended "A method <.....> **comprising** <.....>" (see IV above) had an impact on the scope of protection conferred (Article 123(3) EPC). In that communication, the parties were also informed that the issue of alleged public prior use would be discussed at the hearing on the basis of the evidence submitted by them in the written proceedings.

XII. Oral proceedings thus took place in the appellant's absence as provided for in Rule 71(2) EPC. During the hearing, the respondent filed a new main request consisting of the set of claims 1 to 8 maintained by

the opposition division wherein the introductory portion of claim 1 reading "A method of preparing frozen filled chocolate products by moulding **comprising**" (see IV above) had been replaced by "A method of preparing frozen filled chocolate products by moulding **in which**" in accordance with the patent as granted. It also submitted further amendments by way of first and second auxiliary requests.

XIII. Claim 1 of the first auxiliary request corresponds to claim 1 of the above main request with the following addition to step (i) indicated in bold italics below:

- "1. A method of preparing frozen filled chocolate products by moulding in which:
- (i) a chocolate mass at a temperature in the range of 15°C, preferably from 28°C to 55°C having a fat content of at least 25% by weight **and which has not been subject to tempering** is introduced into a mould having a temperature of from 0°C to -40°C;

Dependent claims 2 to 7 correspond to claims 3 to 8 as maintained by the opposition division.

XIV. The claims of the second auxiliary request are those of the above main request. In this request, only the description has been amended by deleting the following passage from page 1, column 1, lines 20 to 26, of the patent specification as maintained by the opposition division:

"The term "chocolate" is used herein generally to include fat based compositions having a chocolate

component and extends to couvertures. Such compositions are well characterised in the literature, examples are Kirk-Othmer (2nd Edition 1964) at pages 363 et seq and Elements of Food Technology page 579 et seq, and include white chocolate."

- XV. The arguments of the appellant presented in its written submissions concerning the issues which are relevant to the present decision can be summarised as follows:

As regards the late-filed allegations of public prior use, the appellant submitted that the evidence of the manufacture and sale of the **FEST IS** range by "**FRISCO**" was presented to the opposition division at the earliest moment possible, ie approximately one month before the oral proceedings, and that the opposition division was wrong in not admitting this evidence into the proceedings.

The decision under appeal was short and gave little by way of reasoning in support of the opposition division's refusal to admit Dr Bisgaard's evidence of public prior use. Accordingly, in deducing the approach adopted by the opposition division, reference also needed to be made to the minutes of the oral proceedings. According to the minutes, referring to the evidence produced by Dr Bisgaard, the opposition division criticized the fact that no specific visitor or specialist, who had the opportunity to see the production of the **FEST IS** range, had been named in the evidence provided, and that an argument for public prior use could not be based on the non-proven allegations of one single expert.

The clear implication of this statement was, in the appellant's opinion, that the opposition division was generally not prepared to accept anything that Dr Bisgaard said without corroboration. The appellant would not suggest that this was necessarily any personal reflection on Dr Bisgaard, but the opposition division seemed to feel that Dr Bisgaard giving evidence for one of the parties, ie the appellant, should necessarily be assumed to be somehow in league with that party and what he said could not be accepted without being confirmed by someone else. This was quite unjustified and was the wrong way to approach evidence. Dr Bisgaard was at all times quite independent of the appellant and he was giving evidence because he believed that it was his public duty to do so.

Although the appellant considered that the admission of the evidence by Dr Bisgaard had been incorrectly refused by the opposition division for a number of reasons and this refusal formed part of the decision currently under appeal, it seemed more constructive for the appellant to request the board to admit the public prior use into the proceedings at the appeal stage. The board clearly had the power to do this. Decision T 628/90 of 25 November 1991 (cited in "Case Law of the Boards of Appeal of the European Patent Office", 4th edition, 2001, page 331) was only one example of a number of cases where an allegation of public prior use was filed for the first time during the appeal procedure and was admitted into the proceedings.

In the present case a very clear explanation had been given of the fact that the appellant had first become aware on 17 May 1999 of the possibility that there

might have been public prior use by "**FRISCO**" and an attempt was made by the appellant/opponent to introduce it into the proceedings already exactly one month later on 17 June 1999. This could thus not be said to be an abuse of procedure. On the other hand, since the prior use was by the proprietor/respondent itself, it must be deemed to have known about it well before the filing of the application which led to the European patent. Accordingly the proprietor had filed and maintained, in the appellant's opinion, a patent application which it should have known was invalid and if there had been any abuse of the procedure it had been by the proprietor.

The manufacture and sale of the **ISSTJERNE** and **ROLADE** products had not been drawn to the attention of the opposition division since the opponent/appellant became aware of them only after the oral proceedings before the opposition division. With the assistance of Dr Bisgaard, the appellant had been investigating other products available in the Danish ice cream market before the priority date of the Patent and now requested the board to admit into the proceedings evidence of the manufacture and sale of two further novelty-destroying ice cream products placed on the market prior to the priority date of the Patent. The appellant only became aware of these further instances of public prior use in October 1999, so that there had been no abuse of the procedure. The declarations by Mr Pedersen ("**PEDERSEN**") and Mr Eibye ("**EIBYE**") clearly substantiated in every detail these further instances of public prior use.

As regards the substantiation of all three instances of alleged public prior use, the appellant argued that in

the case of a prior art document all that needed to be proved was that the document in question had been made publicly available in a library before the priority date. It was not necessary to prove that the document had been read by a named individual on a specific date. Similarly, although the occurrence of public prior use could be proved by showing that a specific named individual saw a process in question being operated on a particular day, it was also possible to establish public prior use by showing that the process was used over a stated period before the priority date and that it was made available to the public within the meaning of Article 54(1) EPC, without any need to show that a specific named individual saw the process in operation on a specific day. The fact that availability to the public as such was the key issue also in cases of public prior use was, in the appellant's opinion, consistently confirmed by the Enlarged Board of Appeal's case law, for example in decision G 1/92 (OJ EPO 1993, 277).

All claims of the European patent lacked novelty over each and every one of the three instances of prior public use brought to the board's attention. All these instances of public prior use were of methods which fell within the scope of each and every one of the claims of the Patent as maintained by the opposition division. One could hardly imagine any instance of public prior use more clearly prejudicial to the maintenance of the European patent than those presented to the board in the present case. If the board nevertheless reached the conclusion that each and every feature of any one of the claims according to the appellant's current requests might not have become part

of the state of the art as a result of any one of the instances of public prior use referred to in the statement of the grounds of appeal, then the claims would lack inventive step over that instance of public prior use.

XVI. As regards the issues which are relevant to the present decision, the respondent argued, in writing and at the oral proceedings, essentially as follows:

The appellant's allegations of public prior use should not be admitted into the proceedings in view of the lateness of their introduction and in view of the fact that the circumstances relating to the alleged public prior use were not indicated within the opposition period. Moreover, there was in the respondent's opinion no conclusive evidence available that any of the instances of alleged prior use presented to the board by the appellant had ever been made available to the public within the meaning of Article 54(1) EPC. Deficiencies in the evidence meant that it could not be argued that the alleged prior use was the closest prior art. On the contrary, the appellant failed to provide convincing evidence of public prior use.

It was well settled by the case law of the board's of appeal that all facts which make it possible (i) to determine the date of the prior use, (ii) what has been used and (iii) the circumstances relating to the use must be indicated within the opposition period - nine months from the date of grant. Notwithstanding the fact that in the present case the opposition period had already expired in December 1997, the first allegation of public prior use was not raised until 17 June 1999.

The last allegation of public prior use was not raised until 10 December 1999 and the copy of the declaration by Mr Eibye ("EIBYE") was not sent to the EPO until 8 February 2000.

Under EPO case law, in certain circumstances late filed facts or evidence might be admitted into the proceedings, for example if they revealed, without any further investigation, that the basis of the decision would be changed. This was, however, not the case here, since all the evidence was deficient in respect of public availability of the processes presented by the appellant as prior use. The declarations from Johan Bisgaard, Frank-Jørgen Pedersen and Hans-Jørgen Eibye all generally asserted that visitors saw the process in operation, that there was no obligation of secrecy and that all the process parameters could have been determined by the visitor. Without naming in any of these declarations a single individual, who had visited the factory, it was *a priori* impossible to determine what precisely visitors had seen or what they had learnt about any given process. In particular, there no evidence had been provided that the process in question had in fact been in operation during any visit, that any of the visitors had been shown the process and/or that each and every parameter of the process had been made apparent to one or more visitors.

It was not a question of whether or not the evidence filed was believed or not. The fact remained that the evidence presented did not demonstrate that the process in question had in fact been made available to the public. In order to be able to demonstrate public availability, a member of the public and not only an

employee of the company running the process should have stated what was made available to them as a result of their visit to the factory and whether or not they felt bound by any duty of confidentiality.

In the absence of any physical evidence or testimony from a visitor to the facility, the appellant's case was based on uncorroborated testimony from a single witness whose evidence ultimately consisted in providing an opinion as to the likelihood of other persons, ie unnamed members of the public, being in a position to view and technically comprehend a specific process which in all probability was not even taking place at the times visitors were most likely to be present. Accordingly, the opposition division was correct in not accepting the evidence of Dr Bisgaard without corroboration. The evidence of a single individual could not be relied on as being accurate in every detail and fell far short of the standard of proof required by the EPO when making out a case of public prior use.

As regards the first auxiliary request, the respondent submitted that a visitor to any of the facilities that were the subject of allegations of public prior use would not have been able to determine whether the chocolate mass had been tempered or was untempered. Where chocolate was being used in moulding, a person skilled in the art would almost certainly have assumed that the chocolate was tempered.

As regards the second auxiliary request, the respondent argued that the proposed amendment of the specification limited the scope of the invention to chocolate. In

contrast to this, all three allegations of public prior use concerned the manufacture of coated ice cream where the coating was a couverture and not "real" chocolate. Therefore even if evidence of public prior use was admitted into the proceedings and even if it was held that there was sufficient evidence of both prior and public prior use, then this supposed public prior use would concern couvertures and not chocolate.

XVII. The appellant requested in writing that the decision under appeal be set aside and that the Patent be revoked.

The respondent requested that the appeal be dismissed and that the Patent be maintained on the basis of the main request or alternatively on the basis of one of the auxiliary requests, all filed during the oral proceedings.

Reasons for the Decision

1. The appeal is admissible.

Main request; amendments

2. The wording of the preamble in claim 1 as amended *post grant* and maintained by the opposition division, reading: "*A method of preparing frozen filled chocolate products by moulding **comprising***" has been replaced in the current version of claim 1 in accordance with claim 1 as granted by the wording: "*A method of preparing frozen filled chocolate products by*

moulding in which....." (see V, XI and XII above).

The current wording of claim 1 removes any doubts as to a possible violation of Article 123(3) EPC originating from the substitution of the term "comprising" for "in which" in claim 1 as amended after grant and maintained by the opposition division.

Admissibility of the appellant's late submissions

3. The foregoing shows that the appellant's objections of lack of novelty and inventive step, which were based in the statement of opposition on the prior art of citations (1) to (5), boil down to objections of public prior use based on the manufacture and sale of (a) the **FEST IS** range of products by "**FRISKO**", (b) the **ISSTJERNE** product by "**PREMIER IS**" and (c) the **ROLADE** product by "**FREDERIKSBORG IS**".

3.1 As is apparent from the observations in IV and VII above, all three allegations of public prior uses (a), (b) and (c) and the evidence filed on behalf of the appellant in support its allegations ("**BISGAARD I and II**", "**PEDERSEN**", "**EIBYE**" and the respective exhibits annexed to the aforementioned declarations) were all filed well outside the nine-month period for opposition at different stages of the opposition or opposition appeal proceedings. It is thus beyond doubt that all prior use allegations must be regarded as late- filed within the meaning of Article 114(2) EPC, whether "late" is taken to mean after the end of the opposition period or after the end of the opposition proceedings.

3.2 It is well-established by the jurisprudence of the boards of appeal that, in considering the admissibility of late-filed submissions, facts or evidence, account is to be taken, *inter alia*, of whether they could have been filed earlier and if so the reason why they were not, and of their relevance and in particular whether they have a greater relevance to the issues than the material already on file. In addition to these general principles, the board must also ensure that late filing does not constitute an abuse of procedure. Strict standards for the examination as to abuse of procedure have been set by the boards of appeal particularly in the case of the admissibility of late-filed allegations and evidence of public prior use by the opponent. On the basis of Article 114(2) EPC, the boards did not, for example, include such late-filed allegations and evidence in the proceedings because in the circumstances there had been an abuse of procedure and a breach of the principle of good faith. In such cases the boards chose to refrain from examining the potential relevance of the submission (see especially T 534/89, OJ EPO 1994, 464, T 211/90 of 1 July 1993 (not published in OJ EPO) and T 17/91 of 26 August 1992 (not published in OJ EPO) and generally in respect of the admissibility of late submissions: "Case Law of the Boards of Appeal of the European Patent Office", 4th edition, 2001, pages 324 to 333).

3.3 As to the circumstances surrounding the late allegation of public prior use by (a) "**FRISKO**", the appellant submitted in the proceedings before the opposition division and later at the appeal stage that the respondent/proprietor had instituted proceedings against it for infringement of the European patent (UK)

in the Patents Court in London and that, in response, it had applied to revoke the European patent (UK) before the same court. The procedure before the Patents Court involved the submission of testimony from an expert witness. As part of the process of identifying a suitable expert witness, solicitors acting for the opponent/appellant contacted a number of people experienced in the manufacture of ice cream. One of the people so contacted was Dr John Bisgaard who had many years experience in the ice cream industry in Denmark.

3.4 The appellant then submitted that in the course of the above-mentioned legal proceedings it had first become aware, during a meeting with Dr Bisgaard on **17 May 1999**, of the possibility that there might have been prior public use by "**FRISKO**". According to the appellant, an attempt was made to introduce the objection based on prior use as soon as possible into the proceedings before the opposition division. This was done exactly one month later on **17 June 1999**, ie about one month in advance of the oral proceedings held before the opposition division on **20 July 1999**.

3.5 The appellant's above assertions appear *prima facie* correct. Thus, in the board's judgment, a very clear explanation and sound reasons have been given by the appellant as to why in the present case the allegation of public prior based on (a) the manufacture and sale of the **FEST IS** range by "**FRISKO**" was filed when it was and why this could not have been done earlier. It follows that, in the board's view, the late filing of the prior use allegation (a) cannot be considered to be deliberate and does not represent an abuse of the proceedings.

- 3.6 As to the relevance of the appellant's objection based on public prior use by "**FRISKO**", the board has *prima facie* no reason to doubt the correctness and accuracy of the facts and evidence Dr Bisgaard reports in his declarations ("BISGAARD I" and "BISGAARD II"). Both declarations have been considered by the board, and found to be sufficiently relevant to establish a clear *prima facie* case as to the nature of the public prior use and the fact that it led to the method used by "**FRISKO**" becoming part of the state of the art. The alleged public prior use is of a method which, if established, would fall within the scope of each and every one of the claims of the Patent as maintained by the opposition division.
- 3.7 In view of the foregoing, the board has decided, in the exercise of its discretion pursuant to Article 114(2) EPC, not to follow the opposition division on this point and to take the late allegation of public prior use by (a) "**FRISKO**" into account.
4. In cases T 628/90 and T 150/93 (both decisions cited in "Case Law of the Boards of Appeal of the European Patent Office", 4th edition, 2001, page 331), allegations of public prior use, which were filed for the first time in appeal proceedings and were adequately substantiated, were taken into account because of their possible relevance **for enabling thorough consideration to be given to the patentability of the subject-matter of the contested patent.**
- 4.1 As to the reasons why the allegations of public prior use based on the manufacture and sale of (b) the

ISSTJERNE product by "**PREMIER IS**" and (c) the **ROLADE** product by "**FREDERIKSBORG IS**" were raised for the first time in the statement setting out the grounds of appeal, the appellant essentially offered the following explanation:

In paragraph 12 of "BISGAARD I" dated **15 June 1999**, the declarant said about the way in which the **FEST IS** products were made: *"The process was regarded as a traditional manufacturing process which was already known in the trade in Denmark and was operated in essentially the same way by other manufacturers in Denmark"*. This expert opinion led the appellant to investigate, with the assistance of Dr Bisgaard, other products available in the Danish ice cream market before the priority date. The appellant then says that, only in the course of this investigation did it become aware in October 1999 of the possibility that there might have been the above-mentioned two further instances (b) and (c) of public prior use. Since at that stage the decision of the first instance had already been issued, the manufacture and sale of (b) the **ISSTJERNE** product by "**PREMIER IS**" and (c) the **ROLADE** product by "**FREDERIKSBORG IS**" before the priority date could not have been drawn to the attention of the opposition division but only to the board's attention in the statement of the grounds of appeal.

- 4.2 In the board's judgment, there is *prima facie* no reason to doubt that the appellant is correct when it asserts that, in the circumstances of this case, it could not have filed the allegations of public prior use by (b) "**PREMIER IS**" and (c) "**FREDERIKSBORG IS**" before the

- appeal was lodged and the statement of the grounds of appeal was filed so that there has been established that no abuse of the procedure had occurred.
- 4.3 As to the relevance of these two further instances of public prior use, the observations made in 3.6. above in respect of "BISGAARD I and II" apply *mutatis mutandis* to the declarations of "PEDERSEN" and "EIBYE". Both declarations have been considered by the board, and found to be sufficiently relevant to establish further *prima facie* cases of public prior use in addition to (a) the "**FRISKO**" case.
- 4.4 The board has also ensured that the late filing did not take the respondent by surprise and that, if the late-filed allegations (b) and (c) were admitted, the respondent would have had sufficient time to consider them and, as appropriate, reply with evidence of its own. This is the case here, because the respondent had about four years [between the filing of the prior use allegations (b) and (c) and the oral proceedings before the board] in which to consider and prepare arguments and counter-evidence in reply to the late-filed prior use allegations (b) and (c).
- 4.5 In view of the foregoing, the board considers it reasonable and justified to follow the principles of the decisions cited in 4 above and to take into account also the allegations of public prior use based on the manufacture and sale of (b) the **ISSTJERNE** product by "**PREMIER IS**" and (c) the **ROLADE** product by "**FREDERIKSBORG IS**" because of their possible relevance *"for enabling thorough consideration to be given to the*

patentability of the subject-matter of the contested patent".

Admissibility of the respondent's late submissions

5. As regards the declarations by "EVANS", "SORENSEN" and "IZZARD", the respondent's assertion that these formed a response to the submissions and declarations submitted on behalf of the appellant appears *prima facie* correct. That said, "EVANS", "SORENSEN" and "IZZARD" were filed for the first time on **27 October 2003**, ie only one month before the hearing before the board fixed for **27 November 2003**, although the grounds of appeal had already been filed on **10 December 1999** and the appellant's latest written submissions in the appeal proceedings dated from **10 April 2000**. "SORENSEN", for example, is dated 17 September 1999 but was filed only on 27 October 2003, and the board does not condone such lateness *per se*.

5.1 Despite its strong disapproval of the respondent's conduct in presenting new evidence for the first time roughly three and a half years after the appellant's latest submissions in the written appeal proceedings had been filed and only one month in advance of the oral proceedings before the board, and mindful of its discretionary power to disregard any evidence filed at such a very late stage of the proceedings, the board decided to admit "EVANS", "SORENSEN" and "IZZARD" largely because the appellant and the board were clearly able to deal with these declarations at the hearing without delaying the proceedings. Coupled with the fact that the appellant to a large extent prompted the respondent's declarations and evidence by its own

late submissions, it is in the circumstances of this case, in the board's judgment, clearly in the interest of the proper administration of justice within the EPO that the respondent's late-filed evidence should also be admitted.

Substantiation of the appellant's allegations of public prior use

6. Article 117(1) of the Convention provides, amongst other means of giving or obtaining evidence, for the production of sworn statements in writing. The above-mentioned declarations were submitted in the form of sworn statements ("BISGAARD I", "BISGAARD II", "PEDERSEN" and "EIBYE" by the opponent/appellant; "EVANS", "SORENSEN" and "IZZARD" by the proprietor/respondent). Accordingly, they are evidence within the meaning of Article 117(1) EPC and are as such subject to free evaluation of evidence.

7. According to the established case law of the boards of appeal (cf. eg T 93/89, OJ EPO 1992, 718, point 8.1, T 538/89 dated 2 January 1991, point 2.3.1, unpublished, T 830/90, OJ EPO 1994, 713, point 3.2.1, and generally "Case Law of the Boards of Appeal", 4th edition 2001, VII.C.8.6, pages 473-474), there has been prior public use of the subject-matter of a patent if
 - (A) the use occurred prior to the filing or priority date of the contested patent (When did the action take place? Was it a prior use?);
 - (B) the subject-matter of the use coincides with that of the contested patent (What was used? Extent of

use, subject-matter used identical in essence to the subject-matter of the contested patent), and

- (C) the circumstances of the use are such that the subject-matter used has been made available to the public and has therefore become public (where, how and by whom the subject-matter was made public through that use).

8. ad (A): When did the action take place? Was it a prior use?

- (a) According to "BISGAARD I" (see page 2, paragraph 5) and "BISGAARD II" (see paragraph 2), the **FEST IS** range was produced in the same way during the entire period of Dr Bisgaard's employment at "**FRISKO**" from **1978 to 1988**. Exhibits "JB-1" and "JB-2" enclosed with "BISGAARD I" are extracts from advertising and promotional materials produced in respect of "**FRISCO'S**" ice cream products offered for sale in the years **1990** and **1991**. Both brochures JB-1 and JB-2 show, amongst a series of other kinds of "**FRISCO'S**" ice cream products, also the range of "**FRISCO'S**" **FEST IS** products.

- (b) Pedersen in "PEDERSEN" (see page 2, paragraph 4) reports that from about **1982 to 1984** "**PREMIER IS**" manufactured and sold a product under the name **ISSTJERNE**, which means Ice Star in English. This declaration is strongly supported by
- exhibit FP1 which is a copy of a leaflet advertising "**PREMIER IS**" products for **1982** and showing the product **ISSTJERNE**;

- exhibit FP2 which is a copy of a leaflet advertising "**PREMIER IS**" products for **1983** and likewise showing the product **ISSTJERNE**;
- exhibit FP3, a copy of a leaflet entitled "Eiskrem aus Dänemark **1983**" likewise showing the product **ISSTJERNE**.

(c) "EIBYE" (see page 2, paragraph 6) contains the statement that from **1970** to about **1987** the **ROLADE** product was entirely handmade at the facility of "**FREDERIKSBORG IS**".

8.1 On the basis of the evidence provided by the appellant, the board is convinced that all three instances (a), (b) and (c) of alleged public prior use occurred before the priority date of the Patent (1 October 1992).

8.2 As regards the relevant date on which the alleged prior use with the manufacture and sale of (a) "**FRISCO'S**" **FEST IS** products occurred, the board's above view is strongly confirmed by Sorensen, who says in his declaration (see "SORENSEN" submitted on behalf of the respondent in support of its case, especially page 1, paragraph 5) that **from 1978** onwards one of the products made at "**FRISCO'S**" Aarhus factory was an ice cream cake known as FESTIVAL which is, according to JB-1 and JB-2, a product of the **FEST IS** range. Nothing has been presented by the respondent to cast doubt on the appellant's submissions that all three instances (a), (b) and (c) of alleged public prior use occurred prior to the priority date of the Patent.

9. ad (B): What was used? Extent of use, is the subject-matter used identical in essence to the subject-matter of the contested patent?

The text indicated in ***bold italic letters*** below recites the features of claim 1 as maintained by the opposition division (reference numerals added in square brackets [1], [2], etc. by the board);

(a) the text under (a) below refers to the corresponding technical information contained in "BISGAARD I" and "BISGAARD II", relating to the manufacture and sale of a), the **FEST IS** range by **"FRISKO"**;

(b) the text under (b) below refers to the corresponding technical information contained in "PEDERSEN", relating to the manufacture and sale of (b), the **ISSTJERNE** product by **"PREMIER"**;

(c) the text under (c) below refers to the corresponding technical information contained in "EIBYE" relating to the manufacture and sale of (c), the **ROLADE** product by **"FREDERIKSBORG"**:

- 9.1 Coincidence between the technical features of claim 1 and the features of each of the three instances (a), (b) and (c) of alleged public prior use

[1] ***"A method of preparing frozen filled chocolate products by moulding in which..... "***

(a) *"The **FEST IS** range was made up of a number of lines including FESTIVAL, CHARLOTTE and JOSEFINE.*

FESTIVAL is a **moulded** chocolate shell in the form of a ring. The shell is filled with ice cream and in the final product the shell is inverted and decorated with cream, nuts and cherries. The centre of the ring is filled with balls of sorbet of different flavours" (see "BISGAARD I", page 3, lines 1 to 4);

"*FESTIVAL* <.....> are chocolate covered products and were made from 1978-1988 in the manner which I have described by **cold moulding** of chocolate shells which were subsequently filled with ice cream" (see "BISGAARD II", paragraph 3, lines 4-6).

- (b) "From about 1982 to 1984 "**PREMIER IS**" manufactured and sold a product under the name **ISSTJERNE** which means Ice Star in English. The **ISSTJERNE** product <.....> was essentially a **moulded** chocolate shell filled with ice cream" (see "PEDERSEN", page 3, paragraph 5);
- (c) "Over the period 1970 to 1993 "**FREDERIKSBORG IS**" manufactured and sold a product under the name **ROLADE**. This product was a **moulded** chocolate shell in the shape of a rod or flattened cylinder filled with ice cream and the dimensions of the product were about 20cm long, 7cm wide and 5cm high (see "EIBYE", page 2, paragraph 5);
- [2] **step (i): a chocolate mass at a temperature in the range of 15°C, preferably from 28°C, to 55°C and having a fat content of at least 25% by weight is**

introduced into a mould having a temperature of from 0°C to -40°C;

- (a) "The products were made in a 1-12 litre metal mould which was first of all placed on a continuous belt and passed through a hardening tunnel of conventional type used in ice cream manufacture which had a temperature of about- 30°C. On emerging from the hardening tunnel the **mould which had been cooled to the temperature of the tunnel**, was then filled by pouring in **molten chocolate or a compound with a temperature of 40 to 50°C**. Depending on the particular product line, we used a standard dark or milk chocolate with a **fat content from 40-60%** which is typical for use with ice cream" (see "BISGAARD I", page 3, paragraph 8);

"A 3000 litre hardening tunnel with blast freezing capability was used. The tunnel was provided with a continuous belt capable of taking about 1000 moulds. The tunnel was run at -30°C and had a thermometer on the front panel which showed the temperature at which it was operating. The visitor would have seen that the moulds being taken out of the hardening tunnel were white frost on the outside and were being handled by workers with gloves and would thus have been in no doubt **that they had been cooled to a temperature below 0°C**" (see "BISGAARD II", paragraphs 6 and 8);

"A chocolate dosing unit was also used comprising a temperature controlled vessel with stirrer to which the chocolate coating material was supplied

directly from a blending room above. The vessel was heated by a heating unit controlled by a thermostat to maintain the **chocolate at a temperature of 40 to 50°C**" (see "BISGAARD II", paragraph 6).

"The coatings varied slightly from time to time but typical coatings were: 50% standard dark chocolate and **50% coconut oil**; and 50 to 60% standard milk chocolate and correspondingly **50 to 40% coconut oil**" (see "BISGAARD II", paragraph 5);

- (b) "In developing the process for the manufacture of the **ISSTJERNE** product it was always our intention to introduce the chocolate into the moulds **with the moulds significantly below 0°C**. We then dried a couple of runs with the moulds cooled to just above 0°C and we found the solidification of the chocolate in the mould was again too slow and we decided to try cooling the moulds in a hardening tunnel so that they were cooled to **well below 0°C** when the chocolate was introduced. The **moulds were used straight from the hardening tunnel at a temperature of -35°C to -45°C**" (see "PEDERSEN", page 4, paragraph 6);

"Molten chocolate at about 20°C was dosed into each part of the mould. The chocolate was composed of chocolate and vegetable oil in the **proportions 52% chocolate and 48% vegetable oil or 55% chocolate and 45% vegetable oil**" (see "PEDERSEN", page 5, paragraph 7);

(c) *"Metal moulds were placed by hand in a **freezer at about -25°C**, remained in the freezer until they had taken on **the temperature of the freezer**. Immediately on removal of the freezer, the moulds were filled with molten coating chocolate from a container and placing it in the mould. The coating chocolate was composed of chocolate and about **40% coconut oil**. The **temperature of the chocolate coating** when it was placed in the moulds was **about 30°C**" (see "EIBYE", page 2, paragraph 6);*

[3] step(ii): the chocolate mass is retained in contact with the mould for a period sufficient to allow the chocolate mass to solidify in an unstable form at least in the layer in contact with the mould to provide a chocolate shell;

(a) *"The chocolate or compound was left in the mould for a short time (a minimum of 1 to 2 minutes) **until it had hardened in the layer in contact with the mould** but was still liquid in the interior. Excess liquid chocolate or compound was then removed by manual mould inversion **to produce a shell** inside the mould" (see "BISGAARD I", page 4, paragraph 10),*

(b) *"Pairs of moulds were then introduced into a Schløjter machine where the chocolate was distributed evenly over the inner surface of the moulds still cooled **below 0°C**, and **solidified**" (see "PEDERSEN", page 3, paragraph 5, point 3);*

(c) *"Almost immediately, the mould was manually inverted to pour out unsolidified coating*

chocolate and leave a thin shell of solid coating chocolate on the inside of the mould. This operation was carried out so quickly that the mould was still cold, i.e. close to the temperature of the freezer" (see "EIBYE", page 3, paragraph 5, point 3).

The explanation in the Patent at column 2, lines 19 to 21 of how chocolate is solidified in unstable form states that "the process, by rapidly cooling a chocolate mass in a mould, provides chocolate having an unstable form, usually α , and this provides the improved release". This means that the unstable product is the inevitable result of solidifying the chocolate in contact with the mould at 0°C to -40°C, as used in all three prior uses (a), (b) and (c).

[4] step (iii): the chocolate shell is filled with a filling;

(a) *"It would have been apparent from the nature of the product that after formation of the shell it had been filled with ice cream and normal handling techniques for ice cream would dictate that this operation was carried out at below 0°C, generally around -4°C to -5°C" (see "BISGAARD I", paragraph 14, page 6);*

"The moulds containing the chocolate shells were then removed to another working table with conveyor positioned in front of the hardening tunnel and ice cream was dispensed into the moulds at -4°C to -5°C from two 600-litre continuous ice

cream freezers, also manufactured by the company O J Hoyer" (see "BISGAARD II", paragraph 6, end of third page);

- (b) *"The moulds were removed from the Schløjter machine, opened up, and **ice cream was dosed into the solidified chocolate shells**" (see "PEDERSEN", page 3, paragraph 5, point 4);*

*"In step 4, the moulds were manually removed from the Schløjter machine and the two halves opened up. **Ice cream was then dosed into the shells still inside the moulds** from an 800 litre O. G. Hoyer continuous ice cream freezer. The ice cream was dispensed using a hose which was passed from one mould to another and it was not necessary to use a dosing head. The temperature at which the ice cream was dosed into the moulds was about -4°C to -6°C and it would be obvious to anyone familiar with the manufacture of ice cream that the ice cream would have to be at this temperature range or at least very close to it. Outside the range the ice cream could not have been dispensed directly into moulds from the hose and had the ice cream reached 0°C or above it would have been liquid and impossible to dispense, indeed it would no longer have been ice cream" (see "PEDERSEN", pages 5-6, paragraph 9);*

- (c) ***"The chocolate shells inside the moulds were then filled with ice cream** containing strawberries from a Gram continuous ice cream freezer, the ice cream being dosed manually by means of a dosing head. The temperature of the ice cream as it was dosed*

into the moulds was about -5°C" (see "EIBYE", paragraph 6, page 3, point 4);

[5] step (iv): the filled chocolate product is removed from the mould.

(a) *"Given that the product was clearly a moulded product but as sold does not include the mould, it would have been apparent to the ice cream specialist that **the product had been removed from the mould** subsequent to formation" (see "BISGAARD I", paragraph 14, page 6);*

*"Finally the **products were released from the moulds** by inverting the moulds and either tapping with a rubber hammer or by injecting air between the shell and the mould, whichever was considered most convenient by the operator" ("BISGAARD II", end of paragraph 6);*

(b) *"Finally **the plastic moulds were removed** and the Isstjerne products were passed to a packing station" (see "PEDERSEN" paragraph 5, point 6, page 4);*

(c) *"The moulds were then removed from the hardening tunnel and **the products removed from the moulds** (the chocolate shell released easily from the mould)" (see "EIBYE" paragraph 6, point 6, page 3).*

9.2 From the above comparison of the technical features of present claim 1 and the methods (a), (b) and (c) which are reported independently of one another in the above-

mentioned separate declarations, it is readily apparent that each of the following methods of preparing frozen filled chocolate products by moulding, namely

- (a) **the method** as used by "**FRISKO**" for preparing the **FEST IS** products and described in "BISGAARD I and II",
- (b) **the method** as used by "**PREMIER**" for preparing the **ISSTJERNE** product and described in "PEDERSEN", and
- (c) **the method** as used by "**FREDERIKSBORG**" for preparing the **ROLADE** product and described in "EIBYE"

would fall within claim 1.

9.3 As regards (a) the method as used by "**FRISKO**" for preparing the **FEST IS** products and described in "BISGAARD I and II", Dr Bisgaard's evidence is expressly confirmed by Mr Sorensen in "SORENSEN". Mr. Sorensen, a skilled dairy man was a factory supervisor at "**FRISKO'S**" Aarhus factory from 1971 until 1998 when the factory closed down [and, accordingly, a co-employee with Dr Bisgaard from 1978-1988]. Mr Sorensen confirms that the method of preparing the **FEST IS** products shown by Dr Bisgaard in the flow sheet (JB-3) enclosed with "BISGAARD I" accords with his recollection of the method of making the FESTIVAL ICE CAKE which is one of the **FEST IS** products (see "SORENSEN", page 1, fifth paragraph).

9.4 The board cannot share the respondent's objections presented in writing and orally at the hearing that in

the present case the allegations of prior use are solely based on uncorroborated witness testimony by Dr Bisgaard, Mr Pedersen and Mr Eibye. On the contrary, the **evidence** in 9 to 9.3 above showing that all three instances of prior use (a), (b) and (c) are of methods which fall within the scope of present claim 1 finds, in the board's opinion, **strong corroboration** in the virtually identical statements made by all three declarants (Dr Bisgaard, Mr Pedersen and Mr Eibye) independently of one another, namely that the processes for the manufacture of (a) the FEST IS products, (b) the ISSTJERNE product and (c) the ROLADE product used equipment **that was standard in the ice cream field operating in a standard way - see:**

- see "BISGAARD I", page 4, paragraph 12: "However, people from outside the company visited the manufacturing facility and were shown the standard production lines including the dessert line used for the manufacture of the FEST IS range. The process was regarded as traditional manufacturing process which was already well known in the trade in Denmark and was operated in essentially the same way by other manufacturers in Denmark. For this reason, no obligation of confidence was placed on visitors who saw the FEST IS desserts being made and no steps were taken to conceal from visitors what was being done."

- see "PEDERSEN", page 6, paragraph 11: "During the time that the ISSTJERNE product was being manufactured by Premier Is at our factory in Esbjerg we had an open policy towards visitors and many people from outside visited the factory and

were shown the production lines. On the one hand, we did not consider that our manufacturing methods needed to be confidential since we were making conventional products in a conventional way. This certainly applied to the ISSTJERNE product which I regarded as a traditional type of product being made by a wholly conventional process."

- see "EIBYE", page 4, paragraph 8: "I did not consider the process for the manufacture of the ROLADE product to be confidential, and on the contrary I thought of it as a well known process which had been operated for many years in the Danish ice cream industry for making a traditional type of product. The other products of "FREDERIKSBORG" Is were also standard products in the ice cream industry, and so there was little or nothing that I considered confidential about the technology in our factory. Accordingly, I was happy to welcome visitors to the factory and when they came no attempt was made to hide or conceal any of the processes that were being operated and they were not placed under any obligation of confidentiality in respect of what they had seen or heard."

10. ad (C): The circumstances of the act of use; where, how and by whom the was THE subject-matter made available to the public through that use?

10.1 It appears to be well established in the case law of the boards of appeal that for a claimed invention to have been "made available to the public" within the meaning of Article 54(2) EPC before the relevant filing

date, information equivalent to the claimed invention must have been accessible to a skilled person. As stated by the Enlarged Board in decisions G 2/88 and G 6/88 (OJ EPO 1990, 93 and 114), "the word "available" carries with it the idea that, for lack of novelty to be found, all the technical features of the claimed invention in combination must have been communicated to the public, or laid open for inspection".

Furthermore, in opinion G 1/92 (OJ EPO 1993, 277, see especially Reasons, point 2), the Enlarged Board stressed that "according to Article 54(2) EPC the state of the art shall be held to comprise everything made available to the public. **It is the fact that direct and unambiguous access to some particular information is possible, which makes the latter available, whether or not there is any reason for looking for it**" (emphasis added).

10.2 On the basis of the available evidence, the board has no reason to doubt that all three instances (a), (b) and (c) of prior use have been publicly made available to those skilled in the art prior to the priority date of the Patent. This opinion is essentially based on the following considerations:

10.3 As set out in the statement of the grounds of appeal and supported by evidence filed in the course of the opposition and subsequent appeal proceedings, (a) the **FEST IS** products, (b) the **ISSTJERNE** product and (c) the **ROLADE** product were manufactured and sold in Denmark before the priority date of the Patent and all these products are accordingly comprised in the state of the art under Article 54(2) EPC.

10.4 Furthermore, as set out in the statement of the grounds of appeal and supported independently of one another by the declarations of Dr Bisgaard, Mr Pedersen and Mr Eibye, the processes for the manufacture of (a) the **FEST IS** products, (b) the **ISSTERNJE** product and (c) the **ROLADE** product used equipment **that was standard in the ice cream field operating in a standard way**. On the basis of the available evidence, the board sees no reason to doubt the declarants' submissions that all three products (a), (b) and (c) were standard products and were manufactured by wholly conventional processes which were generally known in every detail to skilled persons in the Danish ice cream industry long before the contested patent's priority date (see 9.4 above).

10.5 All three declarants categorically ruled out in their declarations that either an express or tacit agreement on secrecy or an express or tacit obligation on confidentiality concerning the manufacture of (a) the **FEST IS** products, (b) the **ISSTJERNE** product or (c) the **ROLADE** product had ever existed or that access to the production lines and facilities for making these products was restricted to a particular group of persons and not open to visitors in general (see 9.4 above).

10.6 In the absence of any evidence to the contrary, the board is thus satisfied that a skilled visitor, experienced in the production of ice cream, who was inspecting the manufacturing processes known *per se* (see 9.4 above) for (a) the **FEST IS** products, (b) the **ISSTJERNE** product or (c) the **ROLADE** product, would have recognised immediately what was happening, for example

he would have known the general temperature range at which the freezing tunnel would be operating, the general temperature range at which molten chocolate is processed and the general temperature range at which the ice cream would be dispensed. Even if the visitor had not been able as a result of his inspection to determine with accuracy each and every detail of the process in question, he would have been invited and encouraged by the person, explaining to visitors the overall process for making product (a), (b) or (c), to ask for specific information. According to all three declarants, if any visitor had asked about details of the manufacturing process, he would have been given the relevant information.

- 10.7 In accordance with the principles set out in G 1/92 (*loc. cit.*), it is in the present case the fact that direct, unlimited and unambiguous access to any particular information regarding the manufacturing processes known *per se* for (a) the **FEST IS** products, (b) the **ISSTJERNE** product or (c) the **ROLADE** product was possible [as has been shown above], which made these processes available to the public within the meaning of Article 54(2) EPC, whether or not there was any reason to look or ask for such information.

Whatever the means of disclosure (written description, oral description, use by manufacture and sale, etc.), it is the availability to the public within the meaning of Article 54(2) EPC as such that counts. Contrary to the opinion of the opposition division in the decision under appeal, it is possible to establish prior public use by showing that a certain process was used over a stated period before the priority date for making a

certain product and that there existed a possibility for a stated class of individuals, eg visitors, who were under no obligation of secrecy or confidentiality, to have direct and unambiguous access to any particular information regarding this process. If, as here, this was the case, there is no need to show that a specific named individual saw the process in operation on a specific day.

11. To summarise, free evaluation of the combined evidence available in these proceedings leads the board to the conclusion that the probative value of the various statutory declarations and documents produced by the appellant is sufficient to establish that the manufacturing processes for (a) the **FEST IS** products, (b) the **ISSTJERNE** product and (c) the **ROLADE** product were made available to the public by use prior to the priority date of the Patent within the meaning of Article 54(2) EPC and that each of the processes (a), (b) or (c) falls within the scope of claim 1. The main request must therefore fail on the grounds of lack of novelty.

First auxiliary request

12. Claim 1 of the first auxiliary request differs from claim 1 of the main request by the specification that the chocolate mass used in the claimed method has not been subjected to tempering (see XIII above).
- 12.1 As discussed and agreed by the parties at the oral proceedings, cocoa butter is capable of crystallising in a number of different polymorphic forms some of which are more stable than others and, on storage at

room temperature or thereabouts, those crystal forms which are less stable tend to change into more stable forms. Bloom formation is prevented when the crystal types are converted to a mixture of the more stable forms by the process known as tempering. Tempering is a procedure whereby chocolate is subjected to successive melting and cooling treatments to stabilise the seed crystals of the more stable forms of cocoa butter. The board concurs with the appellant's submission that whilst bloom is a problem for the chocolate manufacturer, it is not a problem for the ice cream manufacturer who makes a chocolate/ice cream product. Bloom is a phenomenon associated with a predominance of unstable crystal types in cocoa butter during storage at room temperature. Since chocolate/ice cream products are stored at freezing temperatures prior to consumption, migration of fat to produce bloom cannot occur.

- 12.2 "BISGAARD I" (see page 3, paragraph 9), "BISGAARD II" (see page 2, paragraph 5) and "PEDERSEN" (see page 5, paragraph 7) confirm that no steps were taken in their processes to temper the chocolate coating material. "EIBYE" appears to be silent on the point whether or not the chocolate coating material has been subjected to tempering.

Even if the board were to accept novelty on the basis of the respondent's argument that a visitor to any of the facilities that are the subject of the current instances of public prior use would not have been able to determine whether the chocolate mass has been tempered or was untempered, the subject-matter of the first auxiliary request would not be patentable.

12.3 The respondent's allegations that the use of a chocolate mass which has not been subject to tempering was associated with certain advantages and possibly prevented problems with demoulding have not been supported by the submission of a strictly comparable experiment, as might have been expected, but merely by an argument that **ambient** moulded (not cold moulded) chocolate products normally require the use of tempered chocolate.

12.4 However, a person skilled in the art,

- (a) knowing that whilst bloom is a problem for the chocolate manufacturer, it is not a problem for the ice cream manufacturer who makes a chocolate/ice cream product, and
- (b) also knowing that chocolate which has been tempered will normally lose this temper, when it is in liquid form or is reheated and molten so as to be ready for use, for example, in a cold moulding process,

would in the first place use, for the claimed method, chocolate which has not been subjected to tempering. Only if he was not successful, would he possibly consider using a chocolate product which has been tempered. It follows that the claimed method according to the first auxiliary request, even if formally novel, could not be regarded as involving an inventive step.

12.5 Therefore, the appeal must also fail in respect of the first auxiliary request.

Second auxiliary request

13. The second auxiliary request differs from the above main request by an amendment of the patent specification such that the passage from page 1, column 1, lines 20 to 26, of the description as maintained by the opposition division has been deleted (see XIV above).
- 13.1 The board cannot, for several reasons, share the respondent's opinion that amendment of the specification as proposed in the second auxiliary request would limit the scope of the claimed invention to the use of "real" chocolate so as to exclude the use of "chocolate coatings, fat-based compositions having a chocolate component and couvertures from the scope of the claimed invention.
- 13.2 First, the specification itself as granted (see Examples 11, 12 and 13) and as maintained [see Example 11: "the shells in Examples 2, 3, and 4 were formed using a couverture containing 46% fat (cocoa butter, dairy fat and coconut oil)"] include a series of examples illustrating the claimed invention wherein the shells were formed using **a couverture instead of chocolate**. Since none of the above examples has been deleted, they are included in the amended specification of the respondent's second auxiliary request.
- 13.3 In accordance with Article 69 EPC and its Protocol, the claims of a European patent should be interpreted having regard to the description and drawings (if any).

In the present case, it thus follows clearly from the examples in the specification

- (a) that the claimed invention is not only concerned with the use of "real" chocolate but also with the use of couvertures and
- (b) that, in the context of the description, the expression "chocolate mass" in claim 1 of the second auxiliary request has consequently to be interpreted as embracing not only "real" chocolate, but also fat-based compositions having a chocolate component and couvertures.

13.4 Second, the expert opinions submitted by either party in the present case make it quite clear that the expression chocolate as used in claim 1 without further qualification such as "real" chocolate would be interpreted by those skilled in the art as including both "real" chocolate and couvertures:

- see, for example, "BISGAARD I", page 3, paragraph 9: "During the time that I was with FRISKO, regulations in Denmark as to what could be called chocolate for an ice cream coating were less strict than in some other European countries and in Denmark coating could be called chocolate which would have had to be called compound or couverture in some other countries";
- see, for example, "PEDERSEN", page 5, paragraph 7: "The chocolate was composed of chocolate and vegetable oil in the proportion 52% chocolate and 48% vegetable oil or 55% chocolate and 45%

vegetable oil. In accordance with the regulations in force in Denmark at the time, this could legally be described as a chocolate coating."

- see, for example, "EIBYE", page 2, paragraph 6, point 2: "The chocolate coating was composed of chocolate and about 40% coconut oil and was such that it could legally be called chocolate coating in Denmark."

- see, for example, "IZZARD", page 4, paragraph 8: "If anything, had I known that the chocolate coating being used in the Aarhus factory was 50% and 50% coconut oil, I would have assumed that it was tempered" ."

13.5 From the foregoing it follows that the proposed amendment of the specification in the second auxiliary request cannot dispel the conclusion of lack of novelty arising from the study of the main request in the light of any of the three instances of public prior use (a), (b) or (c).

14. In conclusion, neither the respondent's main request nor any of its auxiliary requests relates to a patentable invention. Thus the appeal is clearly allowable.

Order

For these reasons it is decided:

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

The Registrar:

The Chairman:

A. Townend

U. Oswald