

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

D E C I S I O N
of 21 December 2005

Case Number: T 1086/02 - 3.3.09

Application Number: 96904385.0

Publication Number: 0871367

IPC: A23G 3/02

Language of the proceedings: EN

Title of invention:

Method and installation for preparing a light confectionery composition

Patentee:

Hosokawa Ter Braak B.V.

Opponent:

Klöckner Hänsel Prozesstechnik GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 54(2), 56

Keyword:

"Transfer of opponent status (yes)"

"Novelty - public prior use - confidentiality (yes) -
publication date - not proved"

"Inventive step (yes) - non-obvious solution"

Decisions cited:

-

Catchword:

G 0002/04, T 0482/89, T 0887/90



Case Number: T 1086/02 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 21 December 2005

Appellant: Klöckner Hänsel Prozesstechnik GmbH
(Opponent) Lister Damm 19
D-30163 Hannover (DE)

Representative: Rehberg Hüppe + Partner
Postfach 31 62
D-37021 Göttingen (DE)

Respondent: Hosokawa Ter Braak B.V.
(Proprietor of the patent) Thurledeweg 101-105
NL-3044 ER Rotterdam (NL)

Representative: van Westenbrugge, Andries
Nederlandsch Octrooibureau
P.O. Box 29720
NL-2502 LS The Hague (NL)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 16 July 2002
rejecting the opposition filed against European
patent No. 0871367 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: P. Kitzmantel
Members: A.-T. Liu
B. Günzel
W. Ehrenreich
W. Sekretaruk

Summary of Facts and Submissions

I. European patent No. 871 367 was granted on the basis of a set of three claims, with independent Claims 1 and 2 reading as follows:

- "1. Method for the preparation of a light confectionery composition, wherein a sugar-containing liquid dehydrated in a boiler, a beating agent and compressed air are beaten in a beating vat (7) under pressure, and the beaten composition is discharged discontinuously from the beating vat (7), characterised in that the beaten composition is fed discontinuously from the beating vat (7) to a pressurised buffer tank (14) in which the pressure is held essentially at a specific value, for example 2.8 bar, and in that the beaten composition is discharged continuously from pressurised buffer tank (14) and expanded.

2. Installation for carrying out the method according to Claim 1 comprising a beating vat (7), feed lines (8, 10 and 12), opening into said vat, for, respectively, confectionery liquid, which has been dehydrated by boiling, beating agent and compressed air, and a valve (9,1 (sic), 13) arranged in each of said lines, characterised in that the discharge line (15) from the beating vat (7) opens into a pressurised buffer tank (14) which is provided with means (18, 19, 20) for keeping the pressure in said tank essentially constant and with a discharge line (22) in which the beaten confectionery composition can be discharged in a continuous stream and can expand."

II. Opposition was filed against the patent on the ground of Article 100(a) EPC for lack of novelty and lack of inventive step. The opposition was supported by two prior art documents:

D1: DE-C-3 528 637

D2: EP-B-0 054 960

III. In a subsequent letter, the opponent raised the objection that the subject-matter of the patent in suit lacked novelty due to two public prior uses and requested that a witness be heard on that issue. The following documents were submitted as evidence for the alleged public prior uses:

D3: IEP, DRG No. TR0009/4002/A : "Proposed Flowsheet For Aerated Chew Base Business - Batch Process", (13.04.1994)

D4: Klöckner Hänsel, Offer No. 006 1.2691.2 VF1/0781, addressed to Trebor Ltd. and Trebor Basset Ltd., (July 26, 1994)

IV. The opposition was rejected by the decision of the opposition division, announced at the oral proceedings on 4 June 2002 and despatched on 16 July 2002. In essence, the opposition division held that the public character of the alleged prior use was not established in spite of the testimony of the witness and that the claimed subject-matter was novel and inventive in view of the cited prior art documents D1 and D2.

- V. The notice of appeal against the decision of the opposition division was filed on 14 September 2002, it being stated that the appeal was lodged on behalf of the opponent, Klöckner Hänsel GmbH, Hannover, now Klöckner Hänsel Processing GmbH, Hannover.
- VI. With the Statement of the grounds of appeal filed on 15 November 2002, the appellant asserted a further public prior use, this time in relation to Chocolat Frey AG, and requested that the witness who had given evidence to the opposition division be heard again.
- VII. The following documents were submitted as evidence in support of the said allegation of public prior use:
- D5: Letter addressed to Klöckner Hänsel GmbH, by Pronova AG (3 June 1992)
- D6: Pflichtenheft "Stengel-Linie" (14 May 1992), attached to D5
- D7: Annex 6 (Beilage 6) to D6: "Konzeptskizze einer möglichen neuen Massenaufbereitung"
- D8: Flowsheet Nr. F 2120 fs, "Projekt Stengel Linie" (8 October 1992)
- D9: Letter addressed to Chocolat Frey AG, by Löffler of Klöckner Hänsel GmbH (5 October 1992).
- D10: Offer Nr. 036 1 1557 3 VF1 addressed to Chocolat Frey AG (2 October 1992) attached to D9.

At the same time, the appellant also submitted the following document:

D11: "Maschinen für ... belüfteten Massen ...",
14 pages.

- VIII. By communication dated 26 September 2005, the parties were summoned to oral proceedings scheduled to take place on 21 December 2005. In a separate communication dated 27 September 2005, the parties were also informed of the board's preliminary view on the new assertion of prior use submitted on appeal. Essentially, the board expressed its doubt over the public character of this alleged prior use. Furthermore, the board also indicated that it was not minded to hear the witness again because it saw no reason to deviate from the opposition division's assessment of the testimony of the witness.
- IX. By letter of 5 October 2005, the appellant acknowledged reception of the preliminary opinion of the board as expressed in the communication of 27 September 2005. It withdrew its request for oral proceedings and announced that it would not attend the oral proceedings scheduled for 21 December 2005.
- X. By communication dated 14 October 2005, the parties were informed that the date fixed for the oral proceedings was maintained.
- XI. In a further communication despatched on 22 November 2005, the board indicated that, according to its preliminary view, the claimed subject-matter would appear to involve an inventive step with regard to the

prior art documents D1 and D2. The board also expressed its reservations as to the effective disclosure which might be inferred from D11, in addition to its doubts as to the date and the circumstances under which this document might have been made available to the public. The board observed in conclusion that the grounds of opposition raised by the appellant did not appear to prejudice the maintenance of the patent as granted and that it was inclined to dismiss the appeal.

- XII. In the same communication, the board also addressed the question of the transfer of the status of opponent. This communication, however, was sent out before the board was aware of the respondent's submissions in its letter dated 17 November 2005 (and received on Saturday 19 November 2005), relating to the transfer of assets from Klöckner Hänsel GmbH to Klöckner Hänsel Prozesstechnik GmbH.
- XIII. Oral proceedings took place before the board on 21 December 2005, in the absence of the appellant.
- XIV. The appellant's arguments submitted in writing were essentially the following:
- The drawing D3 made by IEP (Integrated Engineering Projects Ltd.) for Trebor-Basset Ltd. constituted evidence of the first public prior use.
 - This document was handed out to the appellant and to the respondent, without any secrecy agreement. The respondent was eventually chosen to set up the plant. Whether the delivery of this plant took place before or after the priority date of the

patent in suit had not been the subject of any comment by the respondent patentee.

- The second prior use was evidenced by the written offer D4, which did not contain any mention of a secrecy agreement.
- The witness called upon to clarify the relevant circumstances was lead astray because the opposition division did not put forward relevant questions concerning this particular issue.
- According to decision T 482/89, the sale of an apparatus constituted a public prior use. This finding should also be applied to an offer for sale of an apparatus.
- D8 clearly indicated that the flowsheet F 2120 fs was directed to Chocolat Frey AG as customer and concerned the "Projekt Stengel Linie". Although it contained remarks as to the confidential character of the document, these remarks were generated automatically and therefore not applicable. Moreover, they were barely legible.
- Although D11 was undated, the date of 28.05.1990 appearing on a picture of a screen display at "page 2" of this document was an indication that it was published and distributed to the public before the priority date of the patent in suit. The flowsheet disclosed in D11 therefore destroyed the novelty of the claimed subject-matter.

- In order to further substantiate the facts surrounding the alleged prior public uses, testimony of witnesses was offered.
- For the assessment of inventive step, D1 should be regarded as the closest prior art.
- The technical problem existing with respect to D1 was the development of a method allowing a continuous discharge of the beaten composition which had been prepared by the batch-wise beating of a sugar-containing liquid.
- The provision of a pressurised buffer tank would be a matter of course to the skilled person seeking to solve this technical problem.
- A similar solution to a similar problem was to be seen in household coffee machines comprising a thermos flask as "buffer container".
- In the process of D2, a confectionary mass was treated batch-wise in a degassing chamber and then transferred into a buffer chamber. By shutting the slide gate at its output, the buffer chamber could be kept at the same constant pressure as in the preceding degassing chamber.
- It was conceded that the present preparation of a light confectionary composition was more sensitive to pressure conditions than the process of D2. However, the skilled person knew that, in such case, he should take measures to prevent the

beaten composition from collapsing by keeping the buffer chamber under appropriate pressure conditions.

- XV. The respondent argued that, despite all the references cited by the appellant, it had not been established that the feature in Claim 1 stating that the pressure in the pressurised buffer tank (14) was held essentially at a specific value was positively disclosed before the priority date of the patent in suit.

The respondent did not comment on the issue of the appellant's transfer of opponent status.

- XVI. The appellant's request was that the decision under appeal be set aside and that the patent be revoked.

The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. Transfer of opponent status

In accordance with the jurisprudence of the boards of appeal, as confirmed by the decision G 2/04 of 25 May 2005 (ABl. 2005, 549), point 2.2.2 of the reasons, a transfer of the procedural status of opponent is accepted when it is related to the transfer of the business assets in the interest of which the opposition was filed.

1.1 In the present case, evidence of the transfer of assets was submitted with a letter dated 17 November 2005 (see point XII above). It is apparent from the first page of the submitted document that it is a notarised annex to the minutes of 15 May 2001 ("Anlage 1 zur Niederschrift vom 15 Mai 2001, Urk.Rolle Nr. 256/20. Der Notar: gez. Altenburg"). According to its "Preamble", the document concerns a transfer contract ("Einbringungsvertrag") between Klöckner Hänsel GmbH, Hannover and Klöckner Hänsel Prozesstechnik GmbH, Hannover, resulting from a corporate resolution taken on 15 May 2001 ("Gesellschafterbeschuß vom 15. Mai 2001"). The terms of this contract, in particular its §1(3), §3(1) and §4(1), make clear that all the assets of Klöckner Hänsel GmbH, Hannover are taken over by Klöckner Hänsel Prozesstechnik GmbH, Hannover.

1.2 The board notes that the said "Einbringungsvertrag" has not been submitted in a signed version but only in the form of a draft, as annexed to the minutes of the corporate resolution of 15 May 2001. However, it is apparent from the "Preamble" of this draft that by resolution of 15 May 2001, the corporate assembly of Klöckner Hänsel Prozesstechnik GmbH had agreed with Klöckner Hänsel GmbH to raise capital in the form of assets belonging to Klöckner Hänsel GmbH, whereby Klöckner Hänsel GmbH's was to transfer its plant in Hannover to Klöckner Hänsel Prozesstechnik GmbH, in accordance with the terms of the draft "Einbringungsvertrag".

In the board's view, it is highly unlikely that after such a corporate resolution had been taken in agreement with Klöckner Hänsel GmbH the resolution would not have

been executed as foreseen. No such doubts were raised by the respondent, whose attention was specifically directed to this issue. On the contrary, the fact of the transfer of the business assets constituting the Hannover plant from the original opponent to Klöckner Hänsel Prozesstechnik GmbH was not disputed by the respondent, who was present at the oral proceedings on 21 December 2005. In consequence, the board considers that the extent and validity of the transfer of assets from the former to the latter has been sufficiently established by the documents submitted. The board therefore finds that Klöckner Hänsel Prozesstechnik GmbH, Hannover, has effectively acquired the status of opponent and appellant.

2. *Allegations of public prior uses*

2.1 Trebor Basset Ltd.

2.1.1 The board notes that the appellant referred to D3 and D4 as evidence for two separate cases of public prior uses (Statement of the grounds of appeal, page 1, single paragraph and page 2, paragraph 3). However, although these documents came from different sources (IEP and Klöckner Hänsel, respectively), both are directed to the same client (Trebor Basset Ltd.) and relate to the same matter of setting up a manufacturing line for "aerated chew". Thus, they are in fact two separate pieces of evidence used in support for the allegation of the one public prior use, namely in relation to Trebor Basset Ltd. This is also consistent with the analysis of the opposition division, as indicated in the decision under appeal (page 2, point 6 and page 4, point 2.1).

2.1.2 Since the circumstances of the case of Trebor Basset Ltd. do not differ in their nature, as regards the issue of confidentiality of the information conveyed in the context of the business contacts with the original opponent, from the circumstances of the newly alleged public prior use submitted in the appeal, the reasons and conclusions for the finding in the former case are the same as indicated below for the latter case.

2.2 Chocolat Frey AG

2.2.1 In support of the new allegation of public prior use, the appellant has submitted documents D5 to D10, containing information exchanged between Chocolat Frey AG and the appellant (see also Statement of the grounds of appeal, page 3, item II).

As already established for the case concerning Trebor Basset Ltd., it follows from the appellant's arguments and the above-mentioned documents that the exchange of technical information between Chocolat Frey AG and the appellant was made at an early stage of business relations. Essentially, they concern technical specifications given by Chocolat Frey AG, in preparation for an offer for the delivery of an installation to be made by the appellant, which offer was then designed to meet the needs of this prospective ordering client. As already pointed out in the communication dated 27 September 2005 and not refuted by the appellant, the evidence on file does not justify the assumption that either of the parties would have been legally free to forward the information received

from or given to the business partner to any member of the public if it had so desired.

Even in the case where a prospective ordering client simultaneously conveys the same technical information to other firms with the aim to receive competing offers, this does not mean that this technical information is thereby made available to the public. On the contrary, such other firms would form a limited group and the interests involved in the relations between these other firms and the prospective ordering client as regards the treatment of information exchanged would be the same as between the appellant and a sole client.

- 2.2.2 This conclusion is fully in line with the jurisprudence cited in the "Case Law of the Boards of Appeal of the European Patent Office", 4th edition 2001, I.C.1.6.7 c) and, in particular, in e). In circumstances of this kind, the boards of appeal have constantly ruled that an implicit agreement to maintain secrecy is to be acknowledged; see in particular T 887/90 of 6 October 1993.

Decision T 482/89, OJ EPO 1992, 646, cited by the appellant, does not support its case because it also confirms the principle that the sale of an article renders the article sold available to the public subject only to the proviso that the buyer is not bound by an obligation to maintain secrecy (Headnote III; point 3. of the reasons).

- 2.3 Taking of evidence

2.3.1 As regards the appellant's request that the board should hear - again - the witness heard before the opposition division for the prior "Trebor Basset" use, the board declined to do so because in the view of the board the witness gave a clear answer to the question of confidentiality of business relations of the kind involved in both alleged prior uses. The board sees no reason to deviate from the opposition division's assessment of the testimony of the witness.

The appellant's criticism that the witness was led astray because the questions put forward by the opposition division only concerned generalities is not corroborated by the minutes of the hearing of the witness. It is stated in the minutes of the deposition that the witness was specifically asked by the opponent whether he could imagine that the appellant had been obliged, on handing over the drawing TR 0009 4002 (D3), to maintain secrecy (see page 5, paragraph 3 of the minutes). To the board, it is irrelevant by whom this question was put. According to the minutes, the reply of the witness was that he could imagine that they were reminded to keep the information secret because, as a rule, discussions with clients were not supposed to leak to the outside.

In the board's judgment, there is nothing in the answer of the witness suggesting that he might have misunderstood the question. On the contrary, the answer quite clearly indicates that the witness inferred secrecy from the fact that information obtained from prospective clients was always treated as confidential. Moreover, the witness also quite unmistakably declared that, except for standard offers concerning prior art

arrangements, information relating to processes developed in collaboration with clients was not forwarded to third parties (see page 5, last paragraph of the minutes).

It thus follows from the hearing of the witness that there was an implicit understanding of secrecy concerning the making of an offer for an installation designed according to a client's technical specifications. The existence of a - more or less tacit - secrecy agreement for this kind of business contacts is corroborated by the confidentiality clauses contained in the drawings. As to the legal nature of these clauses, it is entirely irrelevant by what technical means, eg rubber stamping or computer printing, such clauses were placed on the drawings.

2.4 Conclusion

To summarize, the appellant has not submitted any convincing arguments, let alone proof, which would allow the board to conclude that the information mutually conveyed in the context of its business relations with Trebor Basset and Chocolat Frey was thereby made available to the public. The board therefore finds that neither of the alleged prior uses is comprised in the state of the art within the meaning of Article 54(2) EPC.

3. *Novelty*

In Section III of the Statement of the grounds of appeal, the appellant made reference to D11 as a document anticipating the subject-matter of the patent

in suit. Allegedly, this document represents a prospectus issued by the respondent. The board first wishes to remark that the title which appears at the front page of this document is:

"Maschinen für belüfteten Massen"

On the basis of this wording, the board infers that the title is not complete, since if it were complete it would read "Maschinen für belüftete Massen".

In a communication to the parties, the board pointed out that D11 is a document consisting of 14 photocopied pages, containing neither printed page numbering nor a date of publication. For that reason, the board expressed its doubt that these 14 pages, tacked together and numbered by hand, necessarily belonged to a single document or that the document as such was made available to the public before the priority date of the patent in suit (see communication dated 17 November 2005, point 4.1). The appellant has not made any submission which has dispelled this uncertainty.

The appellant had previously observed that the date of 28 May 1990 could be seen on a picture on a screen display at "page 2" of D11. Arguing that pictures reproduced in leaflets were normally of recent date ("in der Regel ... neueren Datums"), it was concluded that the publication date of D11 must have been before the priority date of the patent in suit. In the board's judgment, however, the appellant's reasoning is highly speculative. In the absence of any corroborative evidence, the appellant's conclusion has to be rejected

since the facts on which it is based are not up to the stringent standard of proof required in such cases.

Under these circumstances, the board holds that the available evidence does not justify the conclusion that document D11 should be taken into consideration as a prior art document within the meaning of Article 54(2) EPC. In consequence, it is irrelevant what information may be inferred from D11.

- 3.1 The appellant has not cited any other prior art documents as novelty-destroying to the subject-matter of independent Claims 1 and 2. The board therefore accepts that the subject-matter as claimed is new. The reasons for this finding can be seen below, in the discussion of inventive step.
- 3.2 Inventive step
 - 3.2.1 Claim 1 of the patent in suit is directed to a method for the preparation of a light confectionery composition.
 - 3.2.2 It is common ground that the closest prior art is represented by D1, directed to a method for the batchwise production of an aerated confectionery product comprising the steps of feeding a boiled sugar mass into a pressure vessel, and beating the mass in the vessel (abstract and Claim 1). D1 does not describe further treatments of the beaten mass but merely mentions that the emptying of the pressure vessel after the beating takes place by way of an outlet valve (column 3, lines 40 to 42). Thus, it is undisputed that

- the beaten composition is discharged discontinuously from the beating vessel.
- 3.2.3 As described in the patent in suit, the technical problem to be solved with regard to D1 is the provision of a method wherein the discharge of the beaten confectionery composition takes place continuously for further treatment or processing (see column 1, lines 10 to 15).
- 3.2.4 Claim 1 proposes to solve the above technical problem by feeding the beaten composition discontinuously from the beating vat to a pressurised buffer tank in which the pressure is held at essentially a specific value, and discharging the beaten composition continuously from that pressurised buffer tank.
- 3.2.5 It is uncontested that the present technical problem is indeed solved by the method as claimed. Moreover, the board does not accept the appellant's argument that the proposed solution is obvious in view of the teaching according to D2, for the reasons explained below.
- 3.2.6 D2 relates to the preparation of a hard sugar product. According to this process, a sugar solution is dehydrated in two successive chambers ("Ausdampfkammer 4" and "Nachverdampfungskammer 9") and fed into a reservoir chamber ("Vorratskammer 14") from which it is continuously discharged (Claim 1; column 3, lines 13 to 52). By opening the valve 11 at the outlet of the second dehydration chamber 9, the sugar mass is transferred into the reservoir chamber either under gravity, or optionally with the help of compressed air (see in particular column 3, lines 33 to 40 and Figure).

The skilled person thus could not infer the teaching of maintaining the pressure in the reservoir chamber constant at a constant value from this description.

On the other hand, in contrast to the case concerning the preparation of a light confectionary composition, the process of D2 is not sensitive to pressure conditions. As conceded by the appellant, the latter process therefore does not necessitate maintaining the pressure in the reservoir chamber corresponding to the buffer tank of the claimed invention at a given value (see Statement of the grounds of appeal, page 9, last paragraph). The appellant's submission that it would nevertheless be obvious to the skilled person to feed the sugar composition to a buffer tank held at a specific pressure thus goes beyond the disclosure of D2.

In addition, the appellant's assumption that pressurising the buffer tank would be a matter of course so as to prevent the sensitive light confectionary composition from collapsing, is based on hindsight. The appellant's reference to household coffee machines comprising a thermos flask as "buffer tank" ("Warmhaltekanne, die als Puffertank dient") is to no avail in this context. As admitted by the appellant, these types of machines do not foresee a pressurising means for the "buffer tank", let alone address the problem encountered when handling pressure sensitive material such as an aerated confectionary composition.

3.2.7 Since the appellant has not cited any other prior art document in support of its objection of lack of inventive step, the board concludes that the subject-

matter of Claim 1 satisfies the requirements of Article 56 EPC.

- 3.3 The same reasoning also applies to the installation Claim 2, according to which a buffer tank is provided with means for keeping the pressure in said tank essentially constant. The conclusion that the subject-matter of Claim 1 involves an inventive step in view of the available prior art therefore applies *mutatis mutandis* to the subject-matter of Claim 2.
- 3.4 The dependent Claim 3 relates to a preferred embodiment of the installation according to Claim 2; its subject-matter is therefore also new and involves an inventive step.
4. As a corollary of the above, the board concludes that the grounds of opposition raised by the appellant/opponent do not prejudice the maintenance of the patent as granted.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Röhn

P. Kitzmantel