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D E C I S I O N
of 24 January 2006

Case Number: T 0412/04 - 3.3.09

Application Number: 92922976.3

Publication Number: 0660670

IPC: A23B 4/12

Language of the proceedings: EN

Title of invention:

Method for preserving fresh meat products and products

Patentee:

MONFORT, INC.

Opponent:

DANISCO A/S
RHODIA CHIMIE
Chr. Hansens Bio Systems A/S

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)(3)

Keyword:

"Main request and Auxiliary requests 1-2: Added subject-matter (yes)"
"Auxiliary requests 3-11: Broadening of scope of protection (yes)"

Decisions cited:

T 0384/91, G 0001/93

Catchword:

-



Case Number: T 0412/04 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 24 January 2006

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted 16 January 2004
revoking European patent No. 0660670 pursuant
to Article 102(1) EPC.**

Composition of the Board:

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

Summary of Facts and Submissions

I. European patent No. 0 660 670, granted with a set of 36 claims, was based on the International application number PCT/US/09182, European patent application No. 92 922 976.3. In the present decision, reference will be made to the application documents published by WIPO under the International Publication Number WO 93/09676 as "application documents as originally filed".

II. Three oppositions were filed against this patent under Article 100(a) EPC, on the grounds of Articles 53(a), 54, and 56 EPC, and under Articles 100(b) and (c) EPC.

At the oral proceedings of 5 November 2003, the patentee submitted an amended set of 24 claims as a basis for its sole request. Claim 1 read as follows:

"A method for preserving a fresh meat product in order to retain the characteristics of fresh meat comprising inoculating a fresh meat product with an amount of non-spoilage, non-pathogenic bacteria effective to competitively inhibit the growth of spoilage and pathogenic bacteria prior to packaging the fresh meat product in a substantially oxygen impermeable package and wherein said non-spoilage, non-pathogenic bacteria comprises predominantly *Lactobacillus delbrueckii* and/or *Hafnia alveii*".

III. At the end of these oral proceedings, the opposition division announced its decision to revoke the patent on the ground that the subject-matter of Claim 1 did not comply with the requirements of Article 123(2) EPC. In

its opinion, the feature "to retain the characteristics of fresh meat" in Claim 1 did not have a basis in the original application documents. The decision was dispatched in writing on 16 January 2004.

IV. Notice of appeal against this decision was lodged on 19 March 2004 by the patentee. The Statement of the grounds of appeal was filed 11 May 2004. By letters dated 6 December 2005 and 20 December 2005, the appellant submitted sets of claims as bases for a new main request and eleven auxiliary requests.

V. Claim 1 of this new main request was the same as Claim 1 submitted during the oral proceedings before the opposition division except for the term "Hafnia alveii", which was amended to "Hafnia alvei".

Claim 1 of the first and second auxiliary requests only differed from Claim 1 of the main request in that the wording "comprises predominantly Lactobacillus delbrueckii and/or Hafnia alvei" was changed into "comprises predominantly Lactobacillus delbrueckii, or Hafnia alvei, or a combination of Lactobacillus delbrueckii and Hafnia alvei."

Claim 1 of the third auxiliary request differed from Claim 1 of the main request only in that the wording "in order to retain the characteristics of fresh meat" was replaced by "in order to extend the shelf life of the fresh meat".

Claim 1 of the fourth and fifth auxiliary requests differed from Claim 1 of the third auxiliary request only in that the wording "comprises predominantly

Lactobacillus delbrueckii and/or Hafnia alvei" was changed into "comprises predominantly Lactobacillus delbrueckii, or Hafnia alvei, or a combination of Lactobacillus delbrueckii and Hafnia alvei."

Claim 1 of the sixth auxiliary request was based on Claim 1 of the main request, with the only difference that the wording "in order to retain the characteristics of fresh meat" was replaced by "in order to retain the color and odor characteristics associated with fresh meat for an extended period of time".

Claim 1 of the seventh and eighth auxiliary requests differed from Claim 1 of the sixth auxiliary request only in that the wording "comprises predominantly Lactobacillus delbrueckii and/or Hafnia alvei" was changed into "comprises predominantly Lactobacillus delbrueckii, or Hafnia alvei, or a combination of Lactobacillus delbrueckii and Hafnia alvei."

Claim 1 of the ninth auxiliary request read as follows:

"A method for preserving fresh meat product in order to retain the color and odor characteristics associated with fresh meat for an extended period of time, comprising inoculating a fresh meat product with an amount of non-spoilage, non-pathogenic bacteria effective to competitively inhibit the growth of spoilage and pathogenic bacteria prior to vacuum packaging the fresh meat product in a substantially oxygen impermeable package, the said fresh meat product being then maintained at a temperature from -1°C to 7°C after said inoculation, and wherein said non-spoilage,

non-pathogenic bacteria is predominantly *Lactobacillus delbrueckii* or a combination of *Lactobacillus delbrueckii* and *Hafnia alvei*."

Claim 1 of the tenth auxiliary request was based on Claim 1 of the ninth auxiliary request, with the exception that the wording "is predominantly *Lactobacillus delbrueckii* or a combination of *Lactobacillus delbrueckii* and *Hafnia alvei*" was changed to "is predominantly *Lactobacillus delbrueckii*".

Claim 1 of the eleventh auxiliary request was also based on Claim 1 of the ninth auxiliary request, with the exception that the wording "is predominantly *Lactobacillus delbrueckii* or a combination of *Lactobacillus delbrueckii* and *Hafnia alvei*" was changed to "is a combination of *Lactobacillus delbrueckii* and *Hafnia alvei*".

- VI. In a communication dated 9 January 2006, the board informed the parties that the only issue to be discussed at the oral proceedings arranged for 24 January 2006 would be that of Articles 123(2) and (3) EPC.
- VII. At the oral proceedings which took place in the absence of two of the respondents, opponent 02 (Rhodia Chimie) and opponent 03 (Chr. Hansen A/S), the appellant withdrew its request for apportionment of costs, previously filed with the Statement of the grounds of appeal.
- VIII. The appellant's arguments with respect to the issues under consideration were essentially as follows:

- (a) The application documents implicitly disclosed a method "in order to retain the characteristics of fresh meat" because this feature was equivalent to the aim "in order to extend the shelf life of fresh meat".
- (b) Moreover, the expression "to retain the characteristics of fresh meat" did not provide a technical contribution. In view of the decision G 01/93 and T 384/91, this feature could be maintained in the claim without its infringing the requirements of Article 123(2) EPC.
- (c) Claim 1 of the third auxiliary request was directed to a method such as "to extend the shelf life of the fresh meat". Since the shelf life of fresh meat was longer than the time span within which the fresh meat still retained its characteristics, the requirement concerned was more stringent than the requirement to "retain the characteristics of fresh meat" as in granted Claim 1. This amendment therefore met the conditions of Article 123(3) EPC.
- (d) In addition, the scope of protection conferred by Claim 1 of the ninth to eleventh auxiliary requests was even more limited because the definition of the bacteria to be inoculated was further restricted.

IX. The respondents' arguments may be summarised as follows:

- (a) The concept of "to extend the shelf life of fresh meat" was not equivalent to that of "retention of characteristics of fresh meat".
- (b) The characteristics of fresh meat encompassed a number of other characteristics than its colour and odour.
- (c) The passage "to retain the characteristics of fresh meat" in Claim 1 of the main request and some of the auxiliary requests was a functional feature that clearly made a technical contribution to the claimed invention.
- (d) The amendment of the feature "to retain the characteristics of fresh meat" into "to extend the shelf life of fresh meat" resulted in an extension of the claimed scope because the shelf life extended beyond the time span within which the characteristics of fresh meat would be retained. In contravention of the requirements of Article 123(3) EPC the so-amended claim thus covered embodiments where some of the characteristics of fresh meat had changed during storage.
- (e) The same objection applied to the feature "to retain the color and odor characteristics associated with fresh meat for an extended period of time".

(f) The amendment in the definition of the bacteria as in Claim 1 of the ninth to eleventh auxiliary requests was not apt to change the above objection.

X. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claims of the main request or one of the auxiliary requests 1 to 8 filed with the letter dated 20 December 2005, or on the basis of the claims of the auxiliary requests 9 to 11 filed with the letter dated 6 December 2005.

The respondents requested that the appeal be dismissed.

Reasons for the Decision

1. Main request

Claim 1 of this request is directed to a method for preserving fresh meat product in order to retain the characteristics of fresh meat. It is undisputed that the feature "in order to retain the characteristics of fresh meat" has no literal support in the application documents as originally filed.

1.1 The board does not accept the appellant's argument that the expression "to retain the characteristics of fresh meat" is equivalent to the expression "to extend the shelf life of the meat product", originally disclosed in the application. The reasons for this finding are given below, with respect to the third auxiliary request (item 3.1).

1.2 Implicit disclosure

- 1.2.1 In order to assess whether the feature in question could be considered as implicitly disclosed in the original documents, it is first necessary to establish the meaning of the expression "characteristics of fresh meat".

It is common ground that odour and colour are two characteristics of a meat product (see for example original description, paragraph bridging pages 3 and 4). However, the original description itself, in its discussion of freezing food as a way of retarding the growth of bacteria, points at texture, consistency and taste as further relevant properties of fresh meat which are impaired by the thawing of frozen meat (page 2, lines 23 to 25). Further, it is mentioned that fresh meat is also characterised by a pH within the range of about 5.3 to about 7 (page 27, lines 21 to 22). To the board, the fact that these criteria are discussed in the context of fresh meat demonstrates that they are clearly considered to be part of its characteristics.

Moreover, the appellant itself has submitted that "the invention intends to provide a method of preserving fresh meat wherein generally the characteristics of fresh meat, particularly but not exclusively color and odor (emphasis added), are kept so that the shelf life of the product is extended" (Statement of the grounds of appeal, page 4, second paragraph). In a subsequent letter, it is further stated that "the invention provides for such changes where the extension of shelf life of the fresh meat allows enzymes in the meat to

degrade the meat fibre, thus making the meat more tender. Thus such a change may occur, when using the invention, while retaining the characteristics of fresh meat, such as colour and odour" (see letter dated 6 December 2005, page 3, last paragraph).

The board therefore concludes from the application documents as well as from the appellant's submissions that the "characteristics of fresh meat" involve other aspects than merely the odour and colour of the meat.

1.2.2 This conclusion is furthermore fully in agreement with the explanation in the original description concerning the gist of the claimed invention, namely to competitively inhibit and/or exclude the propagation of spoilage and pathogenic bacteria which are the source of malodours and discoloration and thereby extend the shelf life of the food. This effect is achieved by inoculating fresh meat with euhygienic (non-spoilage, non-pathogenic) bacteria (page 10, lines 18 to 27, and page 33, lines 7 to 25).

1.2.3 In summary, there is no indication in the application documents that the inoculation with non-spoilage, non-pathogenic bacteria as defined in Claim 1 is effective for retaining any characteristics of fresh meat other than its odour and colour. As indicated above, however, the term "characteristics of fresh meat" encompasses several other characteristics than odour and colour. The board therefore concludes that the subject-matter of Claim 1 extends beyond the original disclosure. In consequence, Claim 1 does not satisfy the requirements of Article 123(2) EPC.

1.3 Technical contribution / redundancy

1.3.1 The appellant argued that, pursuant to the decision G 1/93, the feature "to retain the characteristics of fresh meat" could be maintained in the claim without its infringing Article 123(2) EPC. This argument was based on the contention that this feature "is just a limitation that describes a "result" and neither give (sic) any technical contribution to the claim nor alone distinguished it from the prior art". According to the appellant, "the question of whether an added feature made a technical contribution or merely limits the scope of protection was discussed in T 384/91", ie the decision giving rise to the afore-mentioned decision G 1/93 (see letter dated 6 December 2005, page 5, second and last paragraphs).

1.3.2 The following point of law was referred to the Enlarged Board of Appeal by the cited decision T 384/91 of 11 November 1992 (OJ EPO 1994, 169):

"If a European patent as granted contains subject-matter which extends beyond the content of the application as filed and also limits the scope of protection conferred by the claims, is it possible during the opposition proceedings to maintain the patent in view of paragraphs 2 and 3 of Article 123 EPC?".

In the ensuing decision G 1/93 (OJ EPO 1994, 541), the Enlarged Board of Appeal answered as follows:

"A feature which has not been disclosed in the application as filed but which has been added to

the application during examination and which, without providing a technical contribution to the subject-matter of the claimed invention, merely limits the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, is not to be considered as subject-matter which extends beyond the content of the application as filed within the meaning of Article 123(2) EPC. The ground for opposition under Article 100(c) EPC therefore does not prejudice the maintenance of a European patent which includes such a feature." (Headnote 2 and item 2 of the Order).

In the further decision T 384/91 of 27 September 1994 (OJ EPO 1995,745), the responsible board took into account the instructions contained in G 1/93 and, addressing the substantive issues of the case, found that the feature "substantially free of stria" correlated with other features in the claim. It therefore concluded that the feature concerned provided a technical contribution to the subject-matter of that claim so that the condition stated in paragraph 2 of the Enlarged Board's order was not fulfilled (see Headnote 2 and items 5 and 6 of the decision).

1.3.3 According to the appellant, present Claim 1 is directed to a method defined by the essential features of:

- (i) preserving fresh meat product in order to retain the characteristics of fresh meat,

- (ii) inoculating a fresh meat product with an amount of non-spoilage, non-pathogenic bacteria effective to competitively inhibit the growth of spoilage and pathogenic bacteria prior to packaging the fresh meat product in a substantially oxygen impermeable package, and
- (iii) the non-spoilage, non-pathogenic bacteria comprising predominantly *Lactobacillus delbrueckii* and/or *Hafnia alvei*".

As pointed out by the board, the aim "to retain the characteristics of fresh meat" in feature (i) is only achieved under appropriately tailored conditions of the bacteria inoculation ((sub)species and number of euhygienic bacteria used, kind and concentration of undesired bacteria, type of meat, temperature and other environmental conditions). This view is consistent with the original description and not refuted by the appellant (page 11, lines 17 to 26 and page 32, lines 9 to 19). All these parameters, thus in particular the features (ii) and (iii), have to be chosen in view of the directive established by the feature "to retain the characteristics of fresh meat". Taking into consideration the criterion set out in the decision T 384/91 of 27 September 1994 , it thus follows that, irrespective of the concrete meaning of the term "characteristics of fresh meat", the feature "to retain the characteristics of fresh meat" provides a technical contribution to the method of Claim 1.

1.3.4 The appellant also asserted that the feature "in order to retain the characteristics of fresh meat" in Claim 1

was redundant with regard to the statement "for preserving a fresh meat product". For this reason alone, it could not infringe Article 123(2) EPC.

While the board accepts that "to preserve" may have the meaning "to keep something as it is" or "to protect from harm", to "preserve a fresh meat product" cannot in practice be equated with to "retain (all) the characteristics of fresh meat". In the board's judgment the former statement is rather vague and does not address specific characteristics of the meat. In fact, according to the description, the problem of preserving meat would rather address the shelf life of the meat, ie the time span in which meat maintains saleable (page 10, last lines 18 to 27 and page 15, lines 3 to 5). This is by no means identical to the time span in which (all) the characteristics of fresh meat are retained. This issue is discussed in detail in section 3 below.

- 1.3.5 The board therefore concludes that the subject-matter of Claim 1 of the main request does not meet the requirements of Article 123(2) EPC.

First and second auxiliary requests

2. Claim 1 of each of these requests is directed to a method comprising the functional feature "to retain the characteristics of fresh meat". The above finding with respect to Claim 1 of the main request therefore applies *mutatis mutandis* to the subject-matter of these claims. In consequence, these requests are also unallowable under Article 123(2) EPC.

Third auxiliary request

3. Claim 1 of the third request is directed to a method for preserving a fresh meat product in order to extend the shelf life of the fresh meat. Thus the functional feature "to retain the characteristics of fresh meat" in Claim 1 as granted is now replaced by a new objective to be achieved, namely "to extend the shelf life of the fresh meat".

3.1 According to the description, the term "shelf life" means the period of time that a food product remains saleable to retail customers (page 15, lines 3 to 5). The extent of shelf life of fresh meat is described to be dependent of the number of spoilage and pathogenic bacteria present on the meat which cause "malodors, discoloration or poisoning of the food" (page 14, lines 5 to 11 and page 15, line 5 to page 16, line 27). Since the non-spoilage, non-pathogenic bacteria create essentially no malodours or discoloration of food products, such as meat, and since they competitively inhibit and/or exclude the growth of pathogenic and spoilage bacteria, they act to extend the shelf life of these food products (page 10, lines 21 to 27). Thus, the application teaches that the extent of the shelf life of the meat essentially corresponds to the time span during which the meat retains its odour and colour. The reader cannot infer from any part of the description that all the other characteristics of the meat are also retained during that time span. As a consequence, the technical feature "to extend the shelf life of the fresh meat" cannot be considered as equivalent to the stipulation "to retain the characteristics of fresh meat" in Claim 1 as granted.

At the oral proceedings, the appellant in fact submitted that the shelf life of fresh meat is longer than the time span during which the fresh meat still essentially retains its characteristics (cf. section IX above). This statement is fully in agreement with the criterion set out in the patent itself, namely that of the time span of saleability of the meat being solely governed by the inhibition of malodours, discoloration, and possibly poisonous by-products (see also item 1.3.4). In the board's judgement, the present amendment therefore cannot be accepted as a limitation with respect to Claim 1 as granted. On the contrary, the wording of present Claim 1 would confer protection on embodiments which are not encompassed by Claim 1 as granted, namely to methods for preserving fresh meat **for the extent of shelf life even when the characteristics of fresh meat are no longer retained** (emphasis added). For this reason, the incorporation into present Claim 1 of the feature "to extend the shelf life of the fresh meat" to replace the feature of "to retain the characteristics in fresh meat" in Claim 1 as granted amounts to an extension of the scope of protection conferred, contrary to the requirements of Article 123(3) EPC.

Fourth and fifth auxiliary requests

4. Claim 1 of each of these requests is directed to a method comprising the functional feature "to extend the shelf life of the fresh meat". The above finding with respect to Claim 1 of the third auxiliary request therefore applies *mutatis mutandis* to the subject-

matter of these claims. In consequence, these requests are also unallowable under Article 123(3) EPC.

Sixth to eleventh auxiliary request

5. Claim 1 of each of the sixth to eleventh auxiliary requests is directed to a method for preserving a fresh meat product in order to "retain the color and odor characteristics associated with fresh meat for an extended period of time". Thus the functional feature "to retain the characteristics of fresh meat" in Claim 1 as granted is now replaced by this new objective.

5.1 As already observed above, according to the patent in suit "the shelf life" of fresh meat is the time span during which the meat has not developed malodours or undergone discoloration (item 3.1). In the board's judgement, the feature "to retain the color and odor characteristics associated with fresh meat for an extended period of time" is therefore equivalent to the functional feature "to extend the shelf life" in the sense of the patent in suit. As a consequence, the above finding in respect of Claim 1 of the third auxiliary request also applies to Claim 1 of the sixth to eleventh auxiliary requests, which are therefore not allowable under Article 123(3) EPC.

5.2 The board does not ignore the appellant's contention that the definition of the bacteria to be inoculated is more restricted in Claim 1 of the ninth to eleventh auxiliary requests than in Claim 1 as granted. However, this restriction has no bearing on the difference in scope of the two functional definitions "to retain the

characteristics of fresh meat" and "to retain the color and odor characteristics associated with fresh meat for an extended period of time". As a consequence, these functional features in Claim 1 of the ninth to eleventh auxiliary requests still confer a scope of protection which is extended to embodiments not covered by Claim 1 as granted. The appellant's argument therefore is not susceptible of changing the above finding by the board.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

G. Röhn

P. Kitzmantel