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**Datasheet for the decision
of 5 July 2011**

Case Number: T 2118/08 - 3.3.09

Application Number: 99202586.6

Publication Number: 0960567

IPC: A23D 9/00

Language of the proceedings: EN

Title of invention:

Fat based food products

Applicants:

Unilever N.V., et al

Opponents:

- (01) McNeil Nutritionals, LLC
(02) Forbes Medi-Tech Inc
(03) Dairy Crest Limited
(04) Walter Rau Lebensmittelwerke GmbH & Co. KG
(05) RAISIO BENECOL LTD

Headword:

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Relevant legal provisions:

EPC Art. 76(1)

Relevant legal provisions (EPC 1973):

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Keyword:

"The claimed subject-matter of the divisional patent extends beyond the scope of the earlier application as filed (parent application)"

Decisions cited:

T 0305/87, T 0296/96, T 0686/99, T 0763/07, T 1402/07

Catchword:

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Case Number: T 2118/08 - 3.3.09

DECISION
of the Technical Board of Appeal 3.3.09
of 5 July 2011

Appellants:
(Patent Proprietors) Unilever N.V., et al
Weena 455
NL-3013 AL Rotterdam (NL)

Representative:
Corsten, Michael Allan
Unilever Patent Group
Olivier van Noortlaan 120
NL-3133 AT Vlaardingen (NL)

Respondent 02:
(Opponent 02) Forbes Medi-Tech Inc
200-750 West Pender Street
Vancouver British Columbia V6C 2TB (CA)

Representative:
Jones, Helen M.M.
Gill Jennings & Every LLP
The Broadgate Tower
20 Primrose Street
London EC2A 2ES (GB)

Respondent 03:
(Opponent 03) Dairy Crest Limited
Claygate House
Littleworth Road
Esher
Surrey KT10 9PN (GB)

Representative:
Daniels, Jeffrey Nicholas
Page White & Farrer
Bedford House
John Street
London WC1N 2BF (GB)

Respondent 04: Walter Rau Lebensmittelwerke GmbH & Co. KG
(Opponent 04) Münsterstrasse 9-11
D-49176 Hilter (DE)

Representative: Leisser-Gerstl, Gabriele
Hoefer & Partner
Patentanwälte
Pilgersheimer Strasse 20
D-81543 München (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 2 September 2008
revoking European patent No. 0960567 pursuant
to Article 101(2) and (3)(b) EPC.

Composition of the Board:

Chairman: W. Sieber
Members: N. Perakis
R. Menapace

Summary of Facts and Submissions

I. Mention of the grant of European patent No. 0 960 567 in respect of European patent application No. 99202586.6 in the name of Unilever N.V. and Unilever PLC, which had been filed as a divisional application of the earlier European patent application No. 96917474.7, was announced on 5 October 2005 (Bulletin 2005/40). The patent was granted with three claims, Claim 1 reading as follows:

"1. Fat based food product wherein the food product is a yellow fat spreads [*sic*] containing vegetable fat and/or animal fat such as butterfat, a dressing, a coffeecreamer, a shortening, a filling or a topping, comprising natural fat components which have a blood cholesterol lowering effect in amounts sufficient to obtain a blood cholesterol lowering effect, wherein the product comprises at least 4 wt% phytosterol weight percentages being based on the total weight of the fat based food product, wherein the fat used in the product is a fat comprising at least 30 wt%, and preferably at least 45 wt% of pufa rich triglycerides, calculated on the total weight of the fat present in the product."

II. Notices of opposition to the patent were filed by McNeil Nutritionals LLC (opponent 01), Forbes Medi-Tech Inc (opponent 02), Dairy Crest Ltd (opponent 03), Walter Rau Lebensmittelwerke GmbH & Co. KG (opponent 04) and Raisio Benecol Ltd (opponent 05). All opponents requested revocation of the patent in its entirety citing Article 100(a) EPC, namely that the claimed subject-matter lacked novelty and inventive step, Article 100(b) and Article 100(c) EPC, namely that the

subject-matter of the patent opposed extended beyond the content of the application as filed/of the earlier patent application as filed.

Opponents 01 and 05 withdrew their oppositions in the course of the opposition proceedings.

III. By a decision announced orally on 2 July 2008 and issued in writing on 2 September 2008 the opposition division revoked the patent. It held that the subject-matter of Claim 1 as granted (main request) and of each Claim 1 of the first to seventh auxiliary requests did not fulfil the requirements of Article 123(2) EPC. It also held that the claimed combination of the following features, contained in Claim 1 of all requests, could not unambiguously be derived from the parent application as filed (WO 96/38047 A1):

- (A) yellow fat spreads;
- (B) the product comprises at least 4 wt.% phytosterol weight percentages being based on the total weight of the fat based product; and
- (C) the fat used in the product is a fat/fat blend (for the auxiliary requests) comprising at least 30 wt.% of pufa rich triglycerides, calculated on the total weight of the fat present in the product.

Furthermore, none of the auxiliary requests fulfilled the requirements of Article 123(3) EPC.

IV. The joint proprietors (appellants) appealed against the decision of the opposition division on 30 October 2008 and paid the appeal fee on the same day. The statement setting out the grounds of appeal was submitted on

12 January 2009 together with six sets of claims corresponding to a main and five auxiliary requests.

Claim 1 of the main request corresponds to Claim 1 of the first auxiliary request before the opposition division and reads as follows:

"1. Fat based food product wherein the food product is a yellow fat spread containing vegetable fat and/or animal fat such as butterfat, comprising natural fat components which have a blood cholesterol lowering effect in amounts sufficient to obtain a blood cholesterol lowering effect, wherein the product comprises at least 4 wt% phytosterol weight percentages being based on the total weight of the fat based food product, wherein the fat used in the product is a fat blend comprising at least 30 wt% of pufa rich triglycerides, calculated on the total weight of the fat present in the product."

Claim 1 of each auxiliary request is based on Claim 1 of the main request with the following further limitations:

- insertion of "comprising 5 to 80% fat" after "such as butterfat" (first auxiliary request),
- 5 to 60% fat (second auxiliary request),
- 5 to 40% fat (third auxiliary request),
- 5 to 25% fat (fourth auxiliary request),
- insertion of "a mixture of at least 1.2% oryzanol and" [at least 4 wt% phytosterol] (fifth auxiliary request).

- V. In letters of 10 May 2011 and 6 June 2011 opponent 03 (respondent 03) and opponent 02 (respondent 02), respectively, informed the board that they did not intend to be represented at the oral proceedings scheduled to be held on 5 July 2011.
- VI. In a letter of 12 May 2011, opponent 04 (respondent 04) raised objections under Article 76(1) EPC against all requests of the appellants.
- VII. In a letter of 10 June 2011 the appellants informed the board that they would not be represented at the oral proceedings and withdrew their request for oral proceedings. They requested that a decision be taken on the basis of the content of the file.
- VIII. Oral proceedings were held before the board on 5 July 2011 in the presence of respondent 04 only.
- IX. The arguments put forward by the appellants in their written submissions can be summarized as follows:
- The subject-matter of the main request did not extend beyond the content of the earlier filed patent application WO 96/38047. The features, namely (A) a yellow fat spread, (B) a product comprising at least 4 wt% phytosterol based on the weight of the fat based product and (C) a fat comprising at least 30 wt% of pufa rich triglycerides based on the weight of the fat, were combinable.
 - A patent specification was addressed to the person skilled in the art, who surely would understand that the best products would be obtained if the preferred

features were combined, even if there was no explicit statement that they were combinable. This would not be the case if the text said explicitly that these preferred features were not combinable.

- In the mechanical and electromechanical arts it was routine to combine features which were not disclosed in a single embodiment but taken from the more general passages in the original text, even though combinability was not explicit. Such combinations by way of amendment were not usually deemed to contravene Article 123(2) EPC.

- However, it appeared that a more stringent standard was often applied in the chemical and related arts. Thus there was a problem about where the board would draw the line, in any particular case, with regard to what was, or was not, directly and unambiguously derivable from the application as filed, and whether there was a technical contribution to the subject-matter of the invention.

- In this context there were liberal decisions where the board did not seem to have required literal or explicit disclosure in the application as filed. There were also strict decisions where absolute prior disclosure in the application as filed was seen to be essential if an amendment was to be allowed.

- The appellants considered that a patent specification was to be read by the person skilled in the art, who would read it as a technical teaching and not in a formulaic or pedantic manner

which may be the case if it was read by a patent practitioner. Accordingly, the spirit of the liberal decisions was the one which should be applied in the present case. Therefore the combination of features in Claim 1 of the main request should be deemed not to contravene Article 123(2) EPC.

- Additionally the specific embodiments in the general part of the description were quite separate from the examples. They were in fact only expressions of different constituents of the claimed compositions and there was nothing to suggest to the skilled person that they were not to be combined.
- X. The arguments put forward by respondent 04 in its written submissions and at the oral proceedings can be summarized as follows:
- The subject-matter of Claim 1 of the main request did not fulfil the requirements of Article 76(1) EPC.
 - The combination of features, namely (A) the yellow fat spread, (B) the amount of at least 4 wt% phytosterol with cholesterol lowering effect and (C) the fat used in the product which is a fat comprising at least 30 wt% of pufa rich triglycerides, was not disclosed in the earlier application WO 96/38047 as filed.
 - Undisputedly these features were individually disclosed, though in different preferred embodiments. However, their combination was not directly and unambiguously derivable from the earlier application

as filed. Therefore the claimed combination created new subject-matter which was not disclosed therein.

- The appellant cited a series of decisions in order to prove that the new combination of features was allowable. However these decisions concerned other facts, such as selection from lists, which could not be applied to the present case.
- The same reasoning applied to all auxiliary requests, as Claim 1 in each case comprised the combination of features (A), (B) and (C) of Claim 1 of the main request.
- The request for a referral to the Enlarged Board of Appeal was also not admissible, because there is no diverging case law. Furthermore, the cited decisions concern individual cases, which in principle are not comparable, and to the extent that they are comparable they lead to the same conclusions.

XI. The appellants (patent proprietors) requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for maintenance of the patent on the basis of, in order of preference, the sets of claims representing the main request and the first to fifth auxiliary requests filed on 12 January 2009, subject to the department of first instance dealing with any outstanding grounds of opposition which were not addressed in the decision under appeal. If the board was minded to find against the appellants, the case was to be referred to the Enlarged Board for clarification of the case law relating to the combinability of passages from an

application as filed (having regard to Article 123(2) EPC).

Respondent 04 (opponent 04) requested that the appeal be dismissed.

Respondent 02 (opponent 02) and respondent 03 (opponent 03) took no active part in these proceedings and did not file any requests.

Reasons for the Decision

1. The appeal is admissible.
2. The Main Request
 - 2.1 The opposition division in its appealed decision and respondent 04 in its written and oral submissions held that the subject-matter of Claim 1 extends beyond the content of the earlier application as filed, namely WO 96/38047, because it comprises a combination of features which was not disclosed in the parent application as filed.
 - 2.1.1 The subject-matter of Claim 1 relates to a fat based food product which comprises the combination of the following features:
 - (A) the food product is a yellow fat spread;
 - (B) the product comprises at least 4 wt% phytosterol weight percentages being based on the total weight of the fat based product; and

(C) the fat used in the product is a fat blend comprising at least 30 wt% of pufa rich triglycerides, calculated on the total weight of the fat present in the product.

2.2 It is undisputed that each feature (A), (B) and (C) is individually disclosed in the earlier application as filed. Particular reference is made to WO 96/38047, page 11, lines 7-10 for feature (A)

"The invention is in particular very suitable for yellow fat spreads, dressings, cheese, shortenings and cooking and frying oils, and more in particular for yellow fat spreads which can comprise 0 (zero) to 90% fat (usually 5-80%).";

page 5, lines 23-28 for feature (B)

"In a more preferred embodiment the fat based food product comprises at least 1.2 wt%, preferably at least 4 wt% phytosterol or at least 1.2 wt% preferably at least 4 wt% oryzanol or a mixture thereof in their relative weights.";

and page 13, lines 8-11 for feature (C)

"If a fat blend is used, it is preferred that it comprises at least 30%, and more preferred at least 45% of polyunsaturated fatty acids, based on the total weight amount of the fat in the fat based food product."

2.3 Nevertheless, it remains to be examined whether the combination of these features also has a basis in the earlier application as filed.

2.3.1 First of all the board notes that the combination of features (A), (B) and (C) is not explicitly disclosed in the earlier application as filed, so that the relevant question to be answered is whether or not this combination is, at least implicitly, directly and unambiguously derivable from the earlier application as filed.

2.3.2 As to whether or not the generation of a fresh particular combination contravenes Article 123(2) EPC (and the same criteria apply for Article 76(1) EPC), T 686/99 states:

"The content of the application as filed must not be considered to be a reservoir from which individual features pertaining to separate sections can be combined in order artificially to create a particular combination. In the absence of any pointer to that particular combination, this combined selection of features does not, for the person skilled in the art, emerge clearly and unambiguously from the content of the application as filed." (point 4.3.3 of the reasons)

This approach is established jurisprudence of the boards of appeal and has been applied in, for example, T 296/96 (point 3.1 of the reasons) and T 1402/07 (point 2.1.2 of the reasons). It might be worth mentioning at this juncture that the boards of appeal apply the same criteria when assessing novelty over a

piece of prior art (eg. T 305/87, OJ EPO 1991, 429, headnote, and T 763/07, point 3.1 of the reasons).

- 2.3.3 The appellants argued in their statement of grounds of appeal (page 5, first full paragraph) that "... the patent specification is addressed to the person skilled in the art. If the person skilled in the art reads of a number of preferred features, surely that person will understand that the best products will be obtained if those preferred features are combined, even if there is no explicit statement that they are combinable. Obviously, that would not be the case if the text said explicitly that, these preferred features were not combinable."

However, apart from this argument, the appellants have not cited any passage of the earlier application as filed which contains a pointer motivating the skilled person to combine features (A), (B) and (C) of present Claim 1. In fact, these features are presented in the earlier application as filed rather in a parallel manner than with a connection to each other. This is corroborated by the fact that none of the examples, which is usually the place where the skilled person would look for the best products in a patent application, falls within the scope of Claim 1. In the only two examples describing the preparation of a spread, namely Examples V and VI of the earlier application, no phytosterol at all was used. Also none of the claims of the earlier application as filed provides a hint to the combination required in Claim 1. Although Claim 6 of the earlier application as filed relates to a yellow fat spread, a fat content of 0 to 60% is a requirement of the said claim. Such a

requirement is completely absent in Claim 1 of the main request.

2.3.4 In summary, the board agrees with respondent 04 and the opposition division that the combination of features (A), (B) and (C) in Claim 1 is not clearly and unambiguously derivable from the application as filed. In fact, the subject-matter of Claim 1 appears to be, as pointed out by respondent 04, firstly a rather arbitrary combination of features in order to draft a claim which is novel over the cited prior art, and secondly a combination which is not hinted at by the earlier application as filed.

2.4 Therefore, Claim 1 of the main request contains subject-matter which extends beyond the content of the earlier application as filed, contrary to the requirements of Article 76(1) EPC. That is also what was clearly intended by the opposition division and what was understood by the parties, even if the opposition division referred to Article 123(2) EPC in this context.

Consequently, the main request must be refused.

3. First to fifth auxiliary requests

The subject-matter of Claim 1 of the auxiliary requests also comprises the combination of features (A), (B) and (C), which as set out above does not meet the requirements of Article 76(1) EPC. Therefore the auxiliary requests *mutatis mutandis* must be refused.

4. Referral to the Enlarged Board of Appeal

4.1 The appellants alleged that there was a dichotomy in the case law concerning the standards applied when assessing whether a European application or patent fulfils the requirements of Article 123(2) EPC. They argued that it appeared that a more stringent standard was often applied in the chemical and related arts than in the mechanical and electromechanical arts, where it was routine to combine features which were not disclosed in a single embodiment but taken from the more general passages in the original text, even though combinability was not explicit. This dichotomy has led to two different strands of case law, one comprising "liberal" decisions and the other comprising "strict" decisions. The appellants considered that in order to clarify the relevant law the case should be referred to the Enlarged Board. Although they held that the formulation of the questions would ultimately be at the discretion of the board, they considered that the following appeared to be relevant:

(i) Does an amendment which combines preferred or particular features which are not disclosed in a single embodiment always contravene Article 123(2) EPC?

(ii) When considering combinations of features from different embodiments, what actually constitutes an "embodiment"?

(iii) In order to contravene Article 123(2) EPC, to what extent do the members of a combination created by way of amendment need to be already combined, or be

indicated as potentially combinable, in the original disclosure?

- 4.2 The board, concurring with respondent 04, considers that the combinability of features taken from different embodiments disclosed in a European application or patent is not a legal issue but a factual one. Thus, depending on the circumstances of each particular case, a board must decide whether a claimed combination of features is or is not directly and unambiguously derivable from the content of the originally filed application.
- 4.3 Furthermore, the board has not identified any dichotomy in the case law. Whether a board has decided in favour of or against a claimed combination of features is the result of the evaluation of each individual case on its own merits following the requirement developed in the jurisprudence of the boards of appeal of the EPO, namely as to whether or not a claimed combination is directly and unambiguously derivable from the application as filed.
- 4.4 The appellants have even admitted in their statement of grounds of appeal (page 6, penultimate paragraph) that "(t)he problem is where the Board will draw the lines, in any particular case, with regard to what is, or is not, directly and unambiguously derivable, from the application as filed, and whether there is a technical contribution to the subject-matter of the invention". This is exactly what this board has done in the present case: by considering the particular technical constellation of the present case, it has decided that the claimed combination of features is not directly and

unambiguously derivable from the earlier application as filed.

- 4.5 Under these circumstances there is no reason to refer the case to the Enlarged Board.

Order

For these reasons it is decided that:

1. The request for referral to the Enlarged Board of Appeal is refused.
2. The appeal is dismissed.

The Registrar:

The Chairman:

G. Röhn

W. Sieber