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**Datasheet for the decision  
of 22 March 2012**

**Case Number:** T 0759/10 - 3.3.09

**Application Number:** 97911262.0

**Publication Number:** 1011343

**IPC:** A23D 9/013, A23D 7/00,  
A23L 1/30

**Language of the proceedings:** EN

**Title of invention:**  
Texturizing compositions for use in fat blends in food

**Applicant:**  
Raisio Nutrition Ltd.

**Opponents:**  
BASF Personal Care and Nutrition GmbH  
Vandemoortele Izegem NV  
Walter Rau Lebensmittelwerke GmbH & Co. KG

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 84, 100(c), 123(2)  
EPC R. 80  
RPBA Art. 13(3)

**Keyword:**  
"Enlarged Board - referral (no)"  
"Extension of subject-matter - yes (main request and auxiliary requests 1 and 2), no (auxiliary request 3)"  
"Clarity of claims - yes (auxiliary request 3)"  
"Allowability of amendments under Rule 80 EPC - yes (auxiliary request 3)"

**Decisions cited:**

G 0002/98, G 0001/03, G 0003/08, G 0002/10, T 0472/88,  
T 0975/94, T 0868/04, T 0725/08, T 0903/09

**Catchword:**

"Amendment from "comprising" to "consisting essentially of" -  
ground of opposition under Article 100(c) EPC (see points  
3.2 - 3.4 and 5.1 - 5.6)"



Case Number: T 0759/10 - 3.3.09

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.09  
of 22 March 2012

**Appellant:**  
(Patent Proprietor)

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**Decision under appeal:**            **Decision of the Opposition Division of the European Patent Office posted 2 February 2010 revoking European patent No. 1011343 pursuant to Article 101(2) and 101(3)(b) EPC.**

**Composition of the Board:**

**Chairman:**            W. Sieber  
**Members:**            M. O. Müller  
                             K. Garnett

## Summary of Facts and Submissions

- I. This decision concerns the appeal of the proprietor of European patent No. 1 011 343 against the opposition division's decision to revoke it.
- II. Opponents I (Unilever NV and Unilever PLC), II (BASF Personal Care and Nutrition GmbH, previously Cognis GmbH), III (Vandemoortele Izegem N.V.) and IV (Walter Rau Lebensmittelwerke GmbH & Co. KG) had requested revocation of the patent in its entirety on the grounds that the claimed subject-matter was neither novel nor inventive (Article 100(a) EPC, opponents I-IV), that the patent did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC, opponents I, III and IV) and that the patent contained subject-matter which extended beyond the content of the application as filed (Article 100(c) EPC, opponents I-IV).
- III. By letter of 23 January 2008, opponent I withdrew its opposition.
- IV. The opposition division's decision, which was announced orally on 3 December 2009 and issued in writing on 2 February 2010, was based on a main request filed during the oral proceedings before the opposition division as well as auxiliary requests 1A, 1B and 2, filed with letter of 3 November 2009.

Claim 1 of the main request and auxiliary request 1A read as follows:

"1. A texturizing composition comprising a texturizing agent and a hardstock, the texturizing composition having substantially the same physical properties as hardstocks, characterized in that the texturizing agent consists essentially of one or more phytosterol fatty acid esters, one or more phytostanol fatty acid esters or their mixtures, and in that the texturizing composition comprises at least 70% of the texturizing agent."

In the same way as claim 1 of the main request and auxiliary request 1A, claim 1 of auxiliary requests 1B and 2 both required the texturizing agent to consist essentially of one or more phytosterol fatty acid esters, one or more phytostanol fatty acid esters or their mixtures.

The opposition division reasoned *inter alia* as follows:

The feature that the texturizing agent consists essentially of one or more phytostanol fatty acid esters, one or more phytosterol fatty acid esters or mixtures thereof (in the following denoted "stanol/sterol esters") extended beyond the content of the application as filed. While the originally filed application provided support for a texturizing agent comprising and consisting of stanol/sterol esters, a texturizing agent consisting essentially of stanol/sterol esters was not clearly and unambiguously disclosed. Such a feature could also not be considered to be inherently supported by the combination of the terms "comprising" and "consisting of", because the technical meaning of the term "consisting essentially of" was different from that of these two terms.

Finally, the disclosure on page 9, lines 28-30 of the original description that the texturizing agent was composed primarily of at least one stanol fatty acid ester could not be considered to provide support for a generalised use of the term "consisting essentially of". Rather, it would be understood by the skilled reader from the context that this disclosure referred to a texturizing agent which consisted of a mixture of stanol and sterol fatty acid esters with a major portion of stanol fatty acid esters.

- V. On 6 April 2010, the appellant (proprietor) filed a notice of appeal against the above decision and paid the prescribed fee on the same day. A statement setting out the grounds of appeal was filed on 11 June 2010 together with a main and nine auxiliary requests.
- VI. With letters of 22 October 2010 and 2 November 2010, respondents II and IV (opponents II and IV) filed responses to the appeal. A further response was filed by respondent III (opponent III) with letters of 29 July and 6 October 2010.
- VII. With its letter of 3 March 2011 the appellant filed a new main request and new auxiliary requests 1-4 in reply thereto.
- VIII. By letters of 19 January and 22 February 2012, observations were filed by respondents III and IV, respectively. Respondent III *inter alia* requested that the case be remitted to the opposition division in order for the grounds of opposition under Articles 100(a) and (b) EPC to be examined in the event that the board should find any claim set submitted by the

appellant to be allowable under Articles 84 and 123(2) EPC.

- IX. With its letter of 22 February 2012, the appellant filed a new main request and new auxiliary requests 1 to 4 and requested that several questions be referred to the Enlarged Board of Appeal.
- X. On 22 March 2012 oral proceedings were held before the board. During the oral proceedings, respondent III requested that the appellant's main request be not admitted into the proceedings. The appellant withdrew its previous auxiliary requests 3 and 4 and filed a new auxiliary request 3.

Claim 1 of each of the main request and auxiliary requests 1 and 2 (as submitted with letter of 22 February 2012) is identical to claim 1 of the main request that formed the basis of the opposition division's decision (see point IV above).

Auxiliary request 3 (as submitted during the oral proceedings before the board) contains three independent claims, namely claims 1, 13 and 19, which read as follows:

"1. A texturizing composition comprising a texturizing agent and a hardstock, the texturizing composition having substantially the same physical properties as hardstocks, characterized in that the texturizing agent consists of one or more phytosterol fatty acid esters, one or more phytostanol fatty acid esters or their mixtures, and in that the texturizing composition comprises at least 70% of the texturizing agent."



"13. A fat blend comprising a liquid oil component and a texturizing composition as defined in claim 1."

"19. A food product containing a fat blend wherein the fat blend is as defined in any one of claims 13-18."

XI. The appellant's arguments can be summarized as follows:

Main request

In the main request, claims had merely been deleted and claim dependencies had been modified. This simplified the case rather than leading to any surprise or difficulty. The main request should therefore be admitted into the proceedings.

The amendment of the wording in claim 1 "the texturizing agent comprises" to "the texturizing agent consists essentially of" did not infringe Article 100(c) EPC. Firstly, the term "comprises" in claim 1 as originally filed itself provided sufficient basis for the term "consists essentially of" as the latter term simply represented one of the three alternatives covered by the term "comprises". Secondly, the feature that the texturizing agent consists essentially of the stanol/sterol esters could be clearly and unambiguously derived from the original disclosure as a whole. In particular, the application as filed explicitly disclosed texturizing agents comprising and consisting of the stanol/sterol esters and gave a clear indication on pages 13 and 15 that further components could be present in

the texturizing agent, in addition to the stanol/sterol esters.

#### Referral to the Enlarged Board of Appeal

With regard to the allowability of the amendment of the term "comprising" to "consisting essentially of" under Article 123(2) EPC, a divergence existed between, on one hand, decisions T 472/88 and T 975/94 and on the other hand decisions T 868/04 and T 725/08. In particular, in T 472/88 and T 975/94 the respective boards considered the amendment of the term "comprises" to "consists essentially of" to be generally allowable as the term "consists essentially of" was narrower than "comprises", while in T 868/04 and T 725/08 the respective boards concluded that in the absence of either an explicit or an implicit disclosure of the term "consists essentially of", such an amendment extended beyond the content of the application as filed. Therefore, a referral to the Enlarged Board of Appeal was necessary with regard to this issue.

#### Auxiliary request 3

Claims 8, 9, 11, 14, 17 and 19 were derived from original claims 11, 12, 14, 18, 22 and 24 respectively.

The feature that the texturizing agent consisted of the stanol/sterol esters was based on the application as filed, page 4, lines 6-7 and lines 17-18, page 7, lines 14-15, page 8, lines 2-4 and

lines 20-23, page 9, lines 2-3, page 10, lines 35-36 and all the examples. The passage at page 8, lines 2-4 was a suitable basis as, though being directed to a process, it repeated what the term "texturizing agent" meant. The combination of the feature that the texturizing agent consisted of the stanol/sterol esters with further features was equally supported by the application as filed as this feature was disclosed throughout the application as filed.

The amendment of "stanol" and "sterol" to "phytostanol" and "phytosterol" respectively was based on the paragraph spanning pages 4 and 5 of the application as filed. This passage also provided appropriate support in the sense of Article 84 EPC for the definitions of the terms "phytostanol" and "phytosterol". The amendment was made in response to an objection of the opposition division under Article 123(2) EPC and thus met the requirements of Rule 80 EPC.

The deletion of the term "optionally" in claim 1 did not add subject-matter. The term "optionally" in claim 1 as originally filed clearly disclosed either the presence of hardstock or the absence thereof and thus provided a basis for claim 1 of auxiliary request 3, which required the presence of hardstock. Moreover, numerous passages in the application as filed disclosed a texturizing composition comprising both a texturizing agent and hardstock and thus provided a basis for the deletion of the term "optionally" in claim 1.

Finally, the deletion of the wording "at least one" before "phytostanol" and "phytosterol" in claims 9, 11 and 17 did not add any new matter to these claims.

XIII. The respondents' arguments can be summarized as follows:

Main request

The main request constituted the third set of requests submitted during the appeal proceedings and was filed late. Therefore this request should not be admitted into the proceedings.

The fact that the term "comprises" covered the alternative of the texturizing agent consisting essentially of stanol/sterol esters was irrelevant with regard to Article 100(c) EPC. What had to be examined in the context of this Article was the question whether the application as filed clearly and unambiguously disclosed this alternative, and this question had to be answered in the negative. More particularly, the wording "consists essentially of" was to be interpreted such that additional components could be present in such amounts that the essential characteristics of the invention were not materially affected and no disclosure of any such additional components or their amounts was present in the application as filed. This was not changed by the disclosures on pages 13 and 15, which merely allowed the conclusion that natural starting materials could be present in the texturizing agent, rather than

any additional components covered by the term "consisting essentially of".

#### Referral to the Enlarged Board of Appeal

The alleged divergence of case law did not justify a referral to the Enlarged Board of Appeal as the question whether an amendment of the term "comprises" to the term "consists essentially of" was allowable under Article 123(2) EPC depended on the facts of the case.

#### Auxiliary request 3

No objections against the admittance of this request into the proceedings were raised.

The amendment of "comprises" to "consists of" in claim 1 of auxiliary request 3 was not based on the application as filed. In particular, the passage on page 8 of the application as filed, which referred to a texturizing agent consisting of the stanol/sterol esters did not provide a basis for this amendment, as this passage was directed to a preparation process while claim 1 was a product claim. Furthermore, the feature that the texturizing agent consisted of the stanol/sterol esters was combined with further features in claims 8-11, 14 and 17 of auxiliary request 3 and this combination was lacking support in the application as filed. Finally, the amendment of "comprises" in claim 9 of auxiliary request 3 to "consists of" was not based on the application as filed since, as a result of this

amendment, the claim required the texturizing agent to consist of phytostanol fatty acid ester only, while, due to the word "comprises", the corresponding claim 12 as originally filed allowed for the presence of phytosterol fatty acid esters. An analogous objection applied to claim 11 of auxiliary request 3.

Furthermore, the amendment of "stanol" and "sterol" to "phytostanol" and "phytosterol" in claim 1 was not based on the application as filed as the passage bridging pages 4 and 5 of the application as filed referred to phytosterol rather than phytostanol. Moreover, the term "phytostanol" in the claims of auxiliary request 3 led to an objection under Article 84 EPC as it was not clear whether the possibility of synthetically producing phytosterol alcohols, as mentioned in the passage bridging pages 4 and 5, also applied to the phytostanol. Finally, the amendment to "phytosterol" in claim 1 did not meet the requirements of Rule 80 EPC as it was unclear which of the objections raised by the opponents caused or possibly justified this amendment.

Moreover, the deletion of the term "optionally" in claim 1 and of the wording "at least one" before "phytostanol" and "phytosterol" in claims 9, 11 and 17 was not based on the application as filed. In particular, by the deletion of the term "optionally", a hardstock became an essential component and this essentiality was not disclosed in the application as filed.

Finally, claim 1 lacked clarity since the terms "hardstock" and "or their mixtures" were ill-defined. Also claim 8 lacked clarity as it was unclear how the texturizing agent of this claim could consist of a mixture of at least one phytosterol fatty acid ester and at least one phytostanol fatty acid ester while, at the same time, comprise up to 30% by weight of phytosterol fatty acid esters and at least 70% by weight of phytostanol fatty acid esters.

No objections against the remittal of the case on the basis of auxiliary request 3 to the opposition division were raised.

XIII. During the oral proceedings, the board made the following additional remarks:

The case law had been developed in G 2/98, G 1/03 and G 2/10, on the basis of which the criterion now to be applied to examine the requirements of Articles 123(2) and 100(c) EPC was that of clear and unambiguous derivability from the application as filed.

If the term "consists essentially of" in claim 1 of the main request extended the subject-matter of the claim beyond the content of the application as filed, this objection applied equally to auxiliary requests 1 and 2.

The terms "hardstock" and "or their mixtures" were already present in claim 1 as granted and thus the alleged lack of clarity was not open to an objection under Article 84 EPC in opposition appeal proceedings.

XIV. The appellant requested that

- (1) The decision under appeal be set aside;
- (2) The case be remitted to the opposition division for consideration of the grounds of opposition under Articles 100(a) and (b) EPC on the basis of the main, alternatively the first or second auxiliary requests filed with the letter dated 22 February 2012;
- (3) In the event of any of the foregoing requests not being granted, the following questions be referred to the Enlarged Board of Appeal:

1. In order for amendment of the term "comprising" to "consisting essentially of" to be in accordance with Article 123(2) EPC, is it necessary for the term "consisting essentially of" to be found *expressis verbis* in the application as filed?

2. If the answer to question 1 is no, is it nevertheless necessary to consider whether the term "consisting essentially of" is directly and unambiguously derivable from the content of the application as originally filed?

3. If the answer to question 2 is yes, is the term "consisting essentially of" considered directly and unambiguously derivable from the term "comprising" itself, such that no new subject-matter is introduced by an amendment of the term



"comprising" to the term "consisting essentially of"?

- (4) Alternatively the case be remitted to the opposition division for consideration of the grounds of opposition under Articles 100 (a) and (b) EPC on the basis of the third auxiliary request filed during the oral proceedings.

XV. The respondents requested that the appeal be dismissed.

### **Reasons for the Decision**

1. The appeal is admissible.

Main request

2. *Admissibility*

The current main request was filed by the appellant with letter of 22 February 2012. This request differs from auxiliary request 1 filed with the statement of grounds of appeal only by the deletion of claims 25-31 and 33 and the amendment of the back-references in claims 20, 21 and 23. Thus, as no major amendments have been carried out, the respondents could be expected to be able to deal with this request without adjournment of the oral proceedings. The board therefore admitted this request into the proceedings (Article 13(3) RPBA).

3. *Amendments - Article 100(c) EPC*

3.1 Claim 1 of the main request contains the feature that the texturizing agent "consists essentially of one or more phytosterol fatty acid esters, one or more phytostanol fatty acid esters or their mixtures" (in the following denoted "stanol/sterol esters"). This feature differs from the corresponding feature in claim 1 as originally filed in that the term "consists essentially of" has been substituted for the term "comprises". It was a matter of dispute between the parties whether this amendment infringed Article 100(c) EPC.

3.2 The term "consists essentially of" in claim 1 of the main request implies that apart from the stanol/sterol esters, only certain types and amounts of other components may be present in the texturizing agent, namely those types and amounts that do not materially affect the essential characteristics of the texturizing agent (see the interpretation of the term "consisting essentially of" in eg T 472/88 of 10 October 1990, point 3).

3.3 The application as filed does not contain any explicit disclosure of the term "consisting essentially of" or the possibility that the texturizing agent, apart from the stanol/sterol esters, contains certain types and amounts of other components that do not materially affect its essential characteristics.

It has therefore to be examined whether there is a clear and unambiguous implicit disclosure in the

application as filed for the amendment from "comprises" to "consists essentially of".

- 3.4 As has been set out above, claim 1 as originally filed and page 10, lines 20-22 of the application as filed disclose texturizing agents comprising the stanol/sterol esters.

The appellant argued that the term "comprising" encompassed three alternatives, namely (i) "comprising", (ii) "consisting of" and (iii) "consisting essentially of", and each of these alternatives would immediately come to the skilled person's mind when reading the term "comprising". The term "comprises" is therefore by itself already a sufficient basis for the term "consists essentially of".

The board cannot accept this argument as each term has a different technical meaning, namely (i) that any further component can be present ("comprises"), (ii) no further component can be present ("consists of") and (iii) specific further components can be present, namely those not materially affecting the essential characteristics of the texturizing agent ("consists essentially of"). Therefore the skilled person is not at liberty to choose whichever of the three terms he wishes when reading the term "comprises". Consequently, the reference to texturizing agents comprising stanol/sterol esters in the application as filed does not provide a clear and unambiguous disclosure of the feature "consists essentially of".

- 3.5 Apart from the disclosure of texturizing agents comprising the stanol/sterol esters, the remaining part

of the application as filed refers to texturizing agents consisting of these esters. Reference is made in particular to the following passage on page 8, lines 2-4 as filed:

"The process comprises substituting, for at least a portion of the hardstock, a texturizing agent consisting of fatty acid esters of sterols, fatty acid esters of stanols or mixtures of these" (emphasis added).

As has been set out above, the term "consisting of" has a different technical meaning than the term "consisting essentially of" in that it excludes the presence of any components other than the stanol/sterol esters. The reference to texturizing agents consisting of stanol/sterol esters in the application as filed therefore does not provide a clear and unambiguous disclosure of the feature "consists essentially of" either.

- 3.6 Apart from the above disclosures, the passage on page 12, line 29 to page 13, line 7 of the application as filed appears to be relevant with regard to the composition of the texturizing agent. This passage describes the preparation of stanol fatty acid esters (as the texturizing agent) from (i) a fatty acid ester or a fatty acid ester mixture, (ii) a stanol and (iii) an interesterification catalyst. This reaction results in a mixture of stanol fatty acid esters and further fatty acid esters, which mixture can either be purified or can be applied as such. This preparation process is further illustrated by way of a specific example on page 15, lines 1-30, where the preparation of stanol

fatty acid esters is described starting from vegetable oil stanol and erucic acid rapeseed oil methyl ester (a fatty acid ester) and resulting in a blend of stanol fatty acid esters and erucic acid rapeseed oil methyl ester. The conversion rate of the esterification process is described to be higher than 99% (page 15, line 29). Apart from the stanol fatty acid esters and erucic acid rapeseed oil methyl ester, the resulting reaction mixture thus possibly contains additionally some unreacted stanol starting material (due to conversion below 100%). This reaction mixture can be used as such or after removal of the erucic acid rapeseed oil methyl ester by vacuum distillation (page 15, lines 24-27).

These disclosures imply that apart from the stanol esters, the texturizing agent may contain some additional fatty acid esters and some unreacted stanol. According to the appellant, these disclosures provide a basis for the term "consists essentially of" in claim 1 of the main request. The term "consisting essentially of" is however not restricted to additional fatty acid esters or unreacted stanol but clearly covers in general any types and amounts of further components that do not materially affect the essential characteristics of the texturizing agent. The specific reference to additional fatty acid esters and unreacted stanol in the application as filed thus does not provide a clear and unambiguous disclosure of the feature "consists essentially of" in claim 1 of the main request.

- 3.7 The amendment of the term "comprises" in claim 1 as originally filed to the term "consists essentially of"

thus infringes Article 100(c) EPC. The main request has therefore to be refused.

#### Auxiliary requests 1 and 2

4. Claim 1 of each of auxiliary requests 1 and 2 is identical to claim 1 of the main request. Consequently, for the same reasons as given above with regard to the main request, auxiliary requests 1 and 2 infringe Article 100(c) EPC and hence must be refused.

#### Request for referral to the Enlarged Board of Appeal

5. The appellant requested that, in the event of any of the main request or auxiliary requests 1 and 2 not being granted, three questions be referred to the Enlarged Board of Appeal (in the following "referral questions" - for details see point XIV above) as a divergence existed between, on one hand, decisions T 472/88 and T 975/94 and on the other hand T 868/04 and T 725/08. The appellant in particular argued that in T 472/88 and T 975/94 the respective boards considered the amendment of the term "comprises" to "consists essentially of" to be generally allowable as the term "consists essentially of" was narrower than "comprises", while in T 868/04 and T 725/08 the respective boards concluded that in the absence of either an explicit or an implicit disclosure of the term "consists essentially of", such an amendment extended beyond the content of the application as filed.
  - 5.1 In T 472/88 of 10 October 1990 (point 4, not published in OJ EPO), the board considered the requirements of Article 123(2) EPC to be met for a claim containing a

number of amendments, one of which was the replacement of the terms "comprising" by the term "consisting essentially of". The board cited several passages of the application as filed as a basis for the amendments but from inspection of the application in the public file (the cited passages are not quoted in the decision), it appears that the passages are not concerned with the amendment of "comprises" to "consisting essentially of" but with the other amendments. Rather, it therefore appears to be the case that the board considered the term "comprises" by itself to be a sufficient basis for the amendment from "comprising" to "consisting essentially of": see point 4, penultimate paragraph. In T 975/94 of 6 November 1996 (point 1.1, not published in OJ EPO), it was decided that the amendment of "comprises" to "consists essentially of" met the requirements of Article 123(2) EPC as the term "consists essentially of" was narrower in meaning than the term "comprises", so that no new subject-matter was introduced by this amendment. No further explanation as regards this amendment is present in the decision.

The present board therefore agrees with the appellant that the two boards in decisions T 472/88 and T 975/94 appear to have considered the term "comprises" by itself to be a sufficient basis for the term "consists essentially of".

- 5.2 However, since these two decisions, the jurisprudence of the boards has further developed, in particular by way of the two later decisions of the Enlarged Board of Appeal in G 2/98 and G 1/03.

In G 2/98 (OJ EPO 2001, 413; point 9), the Enlarged Board held as follows:

"... priority of a previous application in respect of a claim in a European patent application in accordance with Article 88 EPC is to be acknowledged only if the person skilled in the art can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole."

Hence, this decision establishes the criterion of clear and unambiguous derivability with regard to the concept of "the same invention" referred to in Article 87(1) EPC. According to G 1/03 (OJ EPO 2004, 413; points 2.2.2 and 4), the same criterion has to be applied with regard to both Articles 87 and 123(2) EPC:

"It is true that the European patent system must be consistent and the concept of disclosure must be the same for the purposes of Articles 54, 87 and 123 EPC." (point 2.2.2)

"In order to avoid any inconsistencies, the disclosure as the basis for the right to priority under Article 87(1) EPC and as the basis for amendments in an application under Article 123(2) EPC has to be interpreted in the same way." (point 4).

Consequently, the criterion of clear and unambiguous derivability referred to in G 2/98 has to be applied also to the requirements of Article 123(2) EPC and thus



Article 100(c) EPC. This is further confirmed by G 2/10, where the Enlarged Board used this criterion in the context of "disclosed disclaimers":

"An amendment to a claim by the introduction of a disclaimer disclaiming from it subject-matter disclosed in the application as filed infringes Article 123(2) EPC if the subject-matter remaining in the claim after the introduction of the disclaimer is not, be it explicitly or implicitly, directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as filed." (order 1a).

In line with these decisions of the Enlarged Board of Appeal, more recent decisions of the boards of appeal, eg T 868/04 of 10 May 2006, T 725/08 of 16 July 2010 and T 903/09 of 7 September 2011 (none of which published in OJ EPO) have applied the criterion of clear and unambiguous disclosure to decide on the allowability of the amendment of the term "comprises" to "consists essentially of".

T 868/04 (point 2.2):

"In order to determine whether or not an amendment [concerning the amendment of "comprising" to "consisting essentially of"] offends against Article 123(2) EPC it has to be examined whether technical information has been introduced which a skilled person would not have objectively and unambiguously derived from the application as filed...". (Insertion in squared brackets by the present board).

T 725/08 (points 3.2 and 3.3.1):

"3.2 This expression ["consisting essentially of"] is not mentioned explicitly in the application as originally filed. Thus the board has to examine on the basis of the submissions of Appellant I whether it is directly and unambiguously derivable from the content of the application as originally filed...

3.3.1 It is, therefore, concluded that in the absence of either an explicit or an implicit disclosure of a process involving a milling mixture "consisting essentially of", the process defined in Claim 1 of the main request extends beyond the content of the application as originally filed." (Insertions in squared brackets by the present board).

T 903/09 (points 8.1 and 8.2):

"8.1 With respect to claim 1 of the main request ..., the feature "comprising" was replaced by "consisting essentially of". This feature is not explicitly disclosed in the application as originally filed, where the feature "comprising" is always mentioned ... The question is nevertheless whether the person skilled in the art would regard the subject-matter now claimed as implicitly but unambiguously disclosed in the application as filed.

8.2 Even it might be conceded as contended by the respondent, that the feature "consists essentially of" represents a limitation to identify more specifically the most essential elements of the invention, the question, which is different, is whether this new subject-matter meets the requirements of Article 123(2) EPC as defined above."

5.3 Consequently, a uniform approach has been developed by the jurisprudence of the boards of appeal, according to which an amended feature must, explicitly or implicitly, be directly and unambiguously disclosed to the skilled person using common general knowledge in the application as filed in order to be allowable under Articles 123(2)/100(c) EPC.

5.4 On the basis of this uniform approach, the first referral question can be answered in the negative by the present board without the need for any referral, ie it is not in doubt that in order for the amendment of the term "comprising" to "consisting essentially of" to be in accordance with Article 123(2) EPC, it is NOT necessary for the latter term to be found *expressis verbis* in the application as filed.

5.5 Equally on the basis of this uniform approach, the second referral question can be answered in the positive by the present board without the need for any referral, ie it is not in doubt that it is indeed necessary in the context of Article 123(2) EPC to consider whether the term "consisting essentially of" is directly and unambiguously derivable from the content of the application as filed.

5.6 As to the third referral question, namely whether the term "consisting essentially of" is to be considered directly and unambiguously derivable from the term "comprising" itself, in the more recent decisions which have applied the criterion of clear and unambiguous derivability (T 868/04, T 725/08 and T 903/09) the boards have considered this criterion not to be automatically fulfilled by the term "comprising" alone. This difference from the earlier decisions in T 472/88 and T 975/94 (above) is part of the ordinary development of the jurisprudence of the Boards of Appeal and does not mean that a reference to the Enlarged Board of Appeal is required for ensuring uniform application of the law: see G 3/08 (OJ 2011, 010; point 4 of the headnote).

More to the point, however, what the skilled person would clearly and unambiguously derive from an application as filed is a question that can only be answered by reference to the application in question. No general answer to the referred question is therefore possible and it is not a suitable subject-matter for a reference to the Enlarged Board of Appeal.

Auxiliary request 3

6. *Admissibility*

Auxiliary request 3 was filed by the appellant during the oral proceedings before the board. The claims of this request differ from the claims of auxiliary request 1A filed with the statement of grounds of appeal only by deletion of some claims, with

corresponding modification of the back-references, and the amendment of the term "consists essentially of" to "consists of". For the same reasons as given above with regard to the main request and in view of the fact that the respondents eventually did not have any objections against the admissibility of this request, the board decided to admit auxiliary request 3 into the proceedings.

7. *Amendments - Claim 1*

7.1 The amendment to "consists of"

Claim 1 of auxiliary request 3 differs from claim 1 as originally filed in that the wording "the texturizing agent comprises" has been amended to "the texturizing agent consists of". This amendment is based on page 8, lines 2-4 of the application as filed ("The process comprises substituting, for at least a portion of the hardstock, a texturizing agent consisting of fatty acid esters of sterols, fatty acid esters of stanols or mixtures of these"; see also point 3.5 above).

Respondent IV argued in this context that the passage on page 8 was not a basis for this amendment as it referred to a process whereas the claims of auxiliary request 3 were product claims.

However, the inevitable outcome of the process disclosed on page 8 is a product comprising a hardstock, of which at least a portion is substituted by a texturizing agent consisting of fatty acid esters of sterols, fatty acid esters of stanols or mixtures of these. The product characteristic "texturizing agent

consists of..." is thus clearly and unambiguously derivable from this passage of the application as filed (Article 123(2) EPC).

7.2 The amendment to "phytosterol" and "phytostanol"

7.2.1 Claim 1 of auxiliary request 3 furthermore differs from claim 1 as originally filed in that the terms "stanol" and "sterol" have been amended to "phytostanol" and "phytosterol".

This amendment is based on page 4, line 38 through page 5, line 7:

"The term phytosterol is intended to mean saturated and unsaturated sterol alcohols and their blends derived from plants (plant sterols), as well as synthetically produced sterol alcohols and their blends having properties that replicate those of naturally occurring alcohols. These sterol alcohols are characterised by a common steroid nucleus comprising a 17 carbon atom ring system, a side chain and a hydroxyl group. The nucleus is either saturated, wherein the sterol alcohol is referred to as stanol, or unsaturated, wherein the alcohol is referred to as a sterol. (emphasis added)".

By means of the term "These sterol alcohols" in the middle of the above passage, the saturated and unsaturated sterol alcohols, which are synonymous with stanol and sterol, as disclosed in the last sentence of the passage, are linked to the disclosure in the first sentence that these alcohols can be derived from plants

or their synthetically produced counterparts and hence can be phytostanol and phytosterol, respectively. The amendment of "stanol" and "sterol" to "phytostanol" and "phytosterol" thus meets the requirements of Article 123(2) EPC.

7.2.2 Respondent III argued that the term "phytostanol" (which was not present in the granted claims) led to a deficiency under Article 84 EPC as it was not clear whether the possibility of synthetically producing phytosterol alcohols, as mentioned in the passage bridging pages 4 and 5 of the application as filed, also applied to the phytostanol. However, as has been set out in the preceding paragraph, by means of the term "These sterol alcohols" in the middle of this text passage, it is clear that the possibility of synthetically producing the phytosterol alcohols also refers to stanol. There is thus no lack of clarity present.

7.2.3 Respondent III also argued that the amendment of "stanol" and "sterol" to "phytostanol" and "phytosterol" did not meet the requirements of Rule 80 EPC. However, this amendment leads to a restriction of claim 1 and furthermore was made in response to an objection by the opposition division under Article 123(2) EPC in the annex to the summons to oral proceedings. Therefore, this amendment at least potentially meets a ground of opposition and thus is in line with the requirements of Rule 80 EPC.

7.3 The deletion of the term "optionally"

Claim 1 of auxiliary request 3 additionally differs from claim 1 as originally filed by way of the deletion of the term "optionally" before "a hardstock".

According to respondent III, this deletion infringed Article 100(c) EPC. However, the embodiment resulting from this deletion, ie one where the texturizing composition comprises a texturizing agent and a hardstock rather than a texturizing agent alone, is disclosed throughout the application as filed.

Reference is made to page 4, lines 9 to 10 ("... use these texturizing agents fully or partly as replacements for the conventional hardstock in fat blends to be used in fat-containing products...", emphasis added), page 4, lines 16-19 ("...wherein the hardstock of the invention, defined herein as a texturizing composition, is composed of ... a blend of said texturizing agent and conventional hardstock"), and page 7, lines 13-16 ("In this specification the texturizing composition is either composed wholly of a texturizing agent defined herein as a phytosterol ester or ester blends or of a blend of said texturizing agent and conventional hardstock."). Article 100(c) EPC thus is not infringed by the deletion of the term "optionally".

7.4 The terms "hardstock" and "or their mixtures"

Respondents III and IV argued that claim 1 lacked clarity as the terms "hardstock" and "or their mixtures" were ambiguous. These terms were however already present in claim 1 as granted and thus the



alleged lack of clarity is not open to an objection under Article 84 EPC in opposition appeal proceedings.

7.5 The respondents' objections against claim 1 of auxiliary request 3 therefore are rejected and the board is satisfied that the subject-matter of this claim meets the requirements of Articles 123(2) EPC, 100(c) EPC and 84 EPC as well as Rule 80 EPC.

8. *Amendments - the remaining claims*

8.1 Apart from the amendments that will be discussed below in points 8.2 - 8.4, and the adaptation of the claim numbering and dependencies, the remaining claims (claims 2-19) of auxiliary request 3 are based on claims 4, 6-16, 18, 19 and 21-24 as filed.

8.2 Claims 8-11, 14 and 17 of auxiliary request 3 differ from the corresponding original claims in that the wording "the texturizing agent comprises" has been amended to "the texturizing agent consists of". As has been set out above for claim 1 (point 7.1), this amendment is based on page 8, lines 2-4 of the application as filed ("The process comprises substituting, for at least a portion of the hardstock, a texturizing agent consisting of fatty acid esters of sterols, fatty acid esters of stanols or mixtures of these").

The respondents argued in this context that the combination of the requirement that the texturizing agent consists of the stanol/sterol esters with the other features of claims 8-11, 14 and 17 of auxiliary request 3 lacked support in the application as filed.

The passage on page 8 represents however a general statement on how to prepare the texturizing composition of the application as filed. The requirement contained in this passage that the texturizing agent consists of the stanol/sterol esters can therefore be considered to apply to any originally-disclosed embodiment containing the texturizing agent. This is confirmed by the fact that this requirement is repeated numerous times throughout the application as filed, for example on page 4, lines 16-19 ("wherein the hardstock of the invention, defined herein as a texturizing composition, is composed of either fully phytosterol ester or ester blends, defined herein as a texturizing agent, or of a blend of said texturizing agent and conventional hardstock."), page 5, lines 18-21 ("The texturizing agent is composed most preferably of one or more stanol fatty acid esters, but it also can include varying amounts of one or more sterol fatty acid esters, ..."), and page 9, lines 2-3 ("The texturizing agent is a sterol fatty acid ester or a stanol fatty acid ester or a mixture of the two."). The combination of this requirement with further originally-disclosed embodiments as defined by the further features of claims 8-11, 14 and 17 thus does not extend the subject-matter beyond the content of the application as filed.

The respondents finally argued that the amendment of "comprises" to "consists of" in claim 9 of auxiliary request 3 was not supported by the application as filed since, as a result of this amendment, the claim now requires the texturizing agent to consist of phytostanol fatty acid ester only, whereas, due to the

word "comprises", the corresponding claim 12 as filed allows for the presence of additional phytosterol fatty acid esters. An analogous objection was raised against claim 11 of auxiliary request 3 which, by way of the same amendment, requires the texturizing agent to consist of a mixture of phytosterol fatty acid esters and which, contrary to the corresponding original claim, excludes the presence of any phytostanol fatty acid esters.

However, the disclosure on page 8, lines 2-4 that the texturizing agent consists of fatty acid esters of sterol, fatty acid esters of stanols or mixtures of these substances clearly and unambiguously implies that the texturizing agent can consist of fatty acid esters of sterols only without any fatty acid esters of stanols being present or can consist of fatty acid esters of stanols only without any sterol fatty acid esters being present. Claims 9 and 11 thus are based on the application as filed.

8.3 In the same way as claim 1, claims 3, 4, 7-12, 14 and 17 of auxiliary request 3 differ from the corresponding original claims in that the terms "stanol" and "sterol" have been amended to "phytostanol" and "phytosterol". As has been set out above, this amendment is based on page 4, line 38 through page 5, line 7 (Article 123(2) EPC) and meets the requirements of Article 84 EPC and Rule 80 EPC.

8.4 The deletion of the wording "at least one"

Claims 9, 11 and 17 differ from the corresponding claims as filed by way of the deletion of the wording

"at least one" before "phytostanol" and "phytosterol". According to the respondents, this deletion infringed Article 100(c) EPC.

This deletion however simply represents a selection of one of the two alternatives explicitly disclosed in the corresponding original claims, namely "one" (first alternative) "or more" (second alternative) sterol/stanol fatty acid esters and thus does not add any new subject-matter to these claims.

8.5 Respondent IV raised a clarity objection against claim 8, which reads as follows:

"8. The texturizing composition according to any of claims 1 to 6, characterized in that the texturizing agent consists of a mixture of at least one phytosterol fatty acid ester and at least one phytostanol fatty acid ester, the texturizing agent comprising up to 30% by weight of phytosterol fatty acid esters and at least 70% by weight of phytostanol fatty acid esters, the fatty acid part of the phytostanol and phytosterol fatty acid esters being derivable from liquid vegetable oils such as rapeseed oil, sunflower oil, soybean oil, corn oil or mixtures of at least two vegetable oils."

According to the respondent, the claim lacked clarity as it was unclear how the texturizing agent could at the same time meet the two requirements, namely

- firstly, consisting of a mixture of at least one phytosterol fatty acid ester and at least one phytostanol fatty acid ester and,

- secondly, comprising up to 30% by weight of phytosterol fatty acid esters and at least 70% by weight of phytostanol fatty acid esters.

The board cannot see any problem with this as the second requirement that the texturizing agent must comprise up to 30% by weight of phytosterol fatty acid esters and at least 70% by weight of phytostanol fatty acid esters is simply further defined by way of the first requirement such that the sum of the weight percentages of the two esters must add up to 100% by weight (such that the texturizing agent consists of the two types of esters).

- 8.6 The respondents' objections with regard to the remaining claims thus are not convincing either and the board is satisfied that the subject-matter of these claims meets the requirements of Articles 123(2) EPC, 100(c) EPC and 84 EPC as well as Rule 80 EPC.

9. *Remaining grounds of opposition*

The remaining grounds of opposition under Article 100(a) and (b) EPC have not been dealt with yet by the opposition division. To allow a full examination of these grounds at two levels, the board exercised its discretion under Article 111(1) EPC to remit the case to the opposition division for further prosecution, in line with the requests of the appellant and respondent III.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The request for referral of questions to the Enlarged Board of Appeal is refused.
3. The case is remitted to the opposition division for further prosecution on the basis of the third auxiliary request filed during the oral proceedings.

The Registrar:

The Chairman:

G. Röhn

W. Sieber