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**Datasheet for the decision
of 2 May 2012**

Case Number: T 1187/10 - 3.3.09

Application Number: 01995816.4

Publication Number: 1351587

IPC: A23L 3/46, A23L 3/18,
A23C 1/04, A23C 3/037,
A23L 3/24, A23L 2/46,
A23L 2/10, A23L 2/00

Language of the proceedings: EN

Title of invention:
Pasteurizing or sterilizing

Applicant:
N.V. NUTRICIA

Opponent:
Friesland Brands B.V.

Headword:
-

Relevant legal provisions:
EPC Art. 123(2)
RPBA Art. 12(4)

Keyword:
"Main request: added subject-matter - yes"
"Auxiliary request: admission into the proceedings - no"

Decisions cited:
-

Catchword:
-



Case Number: T 1187/10 - 3.3.09

DECISION
of the Technical Board of Appeal 3.3.09
of 2 May 2012

Appellant: N.V. NUTRICIA
(Patent Proprietor) Erste Stationsstraat 186
NL-2712 HM Zoetermeer (NL)

Representative: Prins, Adrianus Willem
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Respondent: Friesland Brands B.V.
(Opponent) Blankenstein 142
NL-7943 PE Meppel (NL)

Representative: Verdijck, Gerardus
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
16 February 2010 concerning maintenance of the
European patent No. 1351587 in amended form.

Composition of the Board:

Chairman: J. Jardón Álvarez
Members: W. Ehrenreich
R. Menapace

Summary of Facts and Submissions

I. European patent No. 1 351 587 was granted in respect of European patent application No. 01995816.4, which was filed in the name of Nutricia N.V. on 21 December 2001 as international application PCT/NL2001/000935 (WO 2002/051266). The mention of grant was published on 27 September 2006 in Bulletin 2006/39. The patent was granted with 17 claims, claim 1 reading as follows:

"1. A method for pasteurising or sterilising a product in liquid form comprising a heat-sensitive substance comprising atomising the product in liquid form while admixing steam in a mixing chamber heated by the steam, so that microorganisms are killed, wherein

- the product in liquid form has a solids content of more than 45 wt.%
- the steam is introduced into the mixing chamber at a steam pressure of 3-20 bar,
- the residence time of the product in the mixing chamber is in the range of 0.2-20 msec, and
- the weight ratio between the product in liquid form and steam is chosen in the range between 1.6 and 10."

Claims 2 to 17 were dependent claims.

II. A notice of opposition was filed by Friesland Brands N.V. on 27 June 2007. The opponent requested revocation of the patent in its entirety under Article 100(a) EPC for lack of novelty and lack of inventive step, Article 100(b) EPC for insufficiency of disclosure and

Article 100(c) EPC for added subject-matter. The opponent cited 28 documents in support of its arguments.

III. By its interlocutory decision announced orally on 21 January 2010 and issued in writing on 16 February 2010, the opposition division maintained the patent in amended form with the claims of the proprietor's auxiliary request. Claim 1 as maintained by the opposition division reads as follows:

"1. A method for pasteurising or sterilising a product in liquid form comprising a heat-sensitive substance comprising atomising the product in liquid form while admixing steam in a mixing chamber heated by the steam, so that microorganisms are killed, wherein

- the product in liquid form has a solids content of more than 45 wt.%
- the steam is introduced into the mixing chamber at a steam pressure of 3-20 bar,
- the residence time of the product and steam in the mixing chamber is in the range of 0.2-20 msec,
- the weight ratio between the product in liquid form and steam is chosen in the range between 1.6 and 10, and

wherein steam is introduced into the mixing chamber via a spray nozzle and the mixing chamber has a length of 1-20 cm."

The set of claims maintained by the opposition division was filed during the oral proceedings as first auxiliary request. The request replaced an earlier first auxiliary request filed with letter dated 21 December 2009. Claim 1 of this previous request was

identical to claim 1 as maintained by the opposition division, with the only difference that the word "and" in the last sentence read "or". Thus, compared to the claim maintained by the opposition division, this claim was broader as it required either that steam was introduced into the mixing chamber via a spray nozzle or that the mixing chamber had a length of 1-20 cm.

The opposition division rejected the main request of the patent proprietor (claims as granted) because the claimed subject-matter extended beyond the content of the application as originally filed. The opposition division held that there was no basis in the application as filed for the isolated feature "steam pressure of 3-20 bar", the reason for this finding being that the description as originally filed required, apart from the above pressure, that steam was introduced via a spray nozzle (claim 12) or by using a mixing chamber having 1-20 cm length (page 9, lines 22-23), while granted claim 1 did not include these limitations.

The opposition division held that the subject-matter of the claims of the first auxiliary request, wherein it was specified that the steam was introduced via a spray nozzle and that the mixing chamber had a length of 1-20 cm, was supported by the application as originally filed and therefore the amendment was allowable. Moreover, the claims also fulfilled the requirements of sufficiency of disclosure, novelty and inventive step.

IV. On 15 April 2010 the patent proprietor (appellant) lodged an appeal against the interlocutory decision of

the opposition division and paid the prescribed fee on the same day.

In the statement setting out the grounds of appeal filed on 14 June 2010, the appellant requested that the opposition division's decision be set aside and that the patent be maintained as granted. The appellant also filed a set of claims as auxiliary request.

V. With its reply dated 25 October 2010 the opponent (respondent) disputed the arguments submitted by the appellant and requested the rejection of the main request and the auxiliary request of the appellant. The opponent further raised objections concerning sufficiency of disclosure, novelty and inventive step against both the main and the auxiliary request. Finally, the respondent filed three fresh documents in support of its arguments of insufficiency of disclosure and lack of novelty.

VI. Further submissions were filed by the appellant on 10 March 2011 and 6 December 2011 and by the respondent on 21 July 2011.

The appellant also filed a copy of the Dutch text of the application as filed and its English translation as filed with 'Het Bureau Internationale Eigendom' on 21 March 2002.

VII. On 10 February 2012 the board dispatched a summons to attend oral proceedings scheduled for 2 May 2012. In the attached communication the board drew the attention of the parties to the points to be discussed during the oral proceedings. The board expressed the preliminary

opinion that claim 1 of the main request did not fulfil the requirements of Article 123(2) EPC and that it would be decided during the oral proceeding whether the auxiliary request overcame the objections to the main request.

VIII. With letter dated 2 April 2012 the respondent put forward further arguments.

IX. On 2 May 2012 oral proceedings were held before the board.

X. The arguments presented by the appellant in its written submissions and at the oral proceedings, insofar as they are relevant for the present decision, may be summarised as follows:

- Concerning the main request, there was support in the application as originally filed for the isolated feature "steam pressure of 3-20 bar". The application as originally filed in Dutch showed that the 1-20 cm length of the mixing chamber was mentioned in combination with a pressure of 5-15 bar and not imperatively in combination with the steam pressure of 3-20 bar. The appellant maintained that the second comma on page 9, lines 22-24 of the English text in the application as filed was a typographical error caused by the translation of the original Dutch text. There was no ambiguity in the application as filed: both features, the steam pressure of 3-20 bar and the length of the mixing chamber, could be read independently.

- The auxiliary request should be admitted into the proceedings. The replacement during the oral proceedings before the opposition division of the previous filed auxiliary request had been made for purely pragmatic reasons. The appellant had not intended to give up any subject-matter before the opposition division. Moreover, the auxiliary request was a combination of granted claims 1 and 12 and fulfilled the requirements of Article 123(2) EPC.

XI. The arguments of the respondent may be summarised as follows:

- The feature "steam pressure of 3-20 bar" in claim 1 of the main request had no basis in the originally filed application. This feature was disclosed with the limitation of the length of the mixing chamber. Both features were not isolated features; they were disclosed in combination in one sentence in one paragraph stressing that they belonged together. Moreover, there was also no support in the application as filed for the feature "the residence time of the product in the mixing chamber is in the range of 0.2-20 msec"; the application as filed disclosed this feature only for a mixture of product and steam.
- In view of the fact that the claims of the main request had a broader scope than the claims maintained by the opposition division, the respondent raised objections of insufficient disclosure and lack of novelty and inventive step against these claims in the event that they were

seen as fulfilling the requirements of Article 123(2) EPC.

- Concerning the claims according to the auxiliary request, the respondent maintained that the same problems arose as for the main request. The admittance of this request would delay the final decision on this case for several years. Another reason for not admitting the request into the proceedings was that it could have been presented earlier.

XII. The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted or, as an auxiliary request, with amended claims as filed 14 June 2010 with the statement setting out the grounds of appeal.

The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

MAIN REQUEST

2. *Amendments* (Articles 100(c) and 123 EPC)
 - 2.1 Claim 1 was amended during the examination proceedings to indicate *inter alia* that "the steam is introduced into the mixing chamber at a steam pressure of 3-20 bar".
 - 2.2 There are two references to the steam pressure in the application as originally filed. In both cases the steam pressure is disclosed in combination with another feature, namely:
 - on page 9, lines 22-26, wherein it is stated that "Good results are obtained when introducing the steam into the chamber at a steam pressure of 3-20 bar, and in particular at a steam pressure of 5-15 bar, in mixing chambers about 1-20 cm length. This pressure is preferably measured just before the steam is introduced into the mixing chamber via a spray nozzle."; and
 - claim 12, which refers back to the method of claims 1-11, wherein it is stated that "steam is introduced into the mixing chamber via a spray nozzle, and wherein the steam pressure for the spray nozzle is 3-20 bar, preferably 5-15 bar."

2.3 The appellant did not dispute that in claim 12 the steam pressure was disclosed in combination with the use of a spray nozzle and did not use claim 12 as a support for the amendment. It argued, however, that on page 9 the steam pressure of 3-20 bar could be read independently of the length of the chamber.

2.4 Extracting an isolated feature from an originally disclosed combination and using it to delimit claimed subject-matter is allowable under Article 123(2) EPC only if that feature is not inextricably linked with the other features of that combination (see Case Law of the Boards of Appeal of the EPO, 6th edition 2010, Chapter III.A.2).

It has therefore to be decided in the present case whether or not the isolation of the steam pressure from the other features results in extended subject-matter which is not directly and unambiguously derivable from the application as filed.

2.5 The description of the application as filed discloses on page 2, lines 7 to 11 the pasteurising or sterilising method in its broadest manner. In subsequent pages, preferred embodiments and process conditions are discussed. The mixing chambers used are discussed from page 7, line 15 onwards. On page 8, lines 18-21 it is indicated that by changing the dimensions of the mixing chamber the average residence time and particle size of the atomised droplets can be varied.

A preferred embodiment is described on page 9, lines 22-24, specifying that "good results are obtained

when introducing the steam into the mixing chamber at a steam pressure of 3-20 bar, and in particular at a steam pressure of 5-15 bar, in mixing chambers about 1-20 cm length"(emphasis by the board).

2.6 The board sees no technical reason, and the appellant has not put forward any, why the skilled person, taking account of common general knowledge and the information in the preceding paragraphs, would read the chamber length only in conjunction with the preferred pressure range of 5-15 bar, but not (also) with the broader range of 3-20 bar. Rather, it is technically not plausible that the effect of the combination of the two features would be strictly limited to the preferred pressure range of 5-15 bar, with the exclusion of the adjacent ranges 3-5 and 15-20 bar. Therefore, taking into account the given technical and textual context, in particular the information in the preceding paragraphs and the fact that both parameters are specified in combination, a skilled reader of the sentence in question would understand from it that both features are required to obtain these good results.

2.7 Contrary to the appellant's contentions, this interpretation is not disproved by the fact that, in contrast to the English translation of the application, its original text in Dutch does not contain any commas in the sentence in question. It has not been shown - or even contended - by the appellant that this would mean, according to Dutch grammar and/or for a Dutch native speaker, that clearly and unambiguously the chamber length relates exclusively to the preceding narrower steam pressure range. After all, a person skilled in the art does not take a purely grammatical approach

when interpreting a written technical teaching and a skilled translator aims at a translation which reproduces the content of the original text rather than its grammatical structure. So there is no basis for assuming that the commas in the English version are due to a translation mistake and give the critical passage in the text of the patent in suit a different meaning from that of the original Dutch.

- 2.8 For these reasons, the amendment made to Claim 1 is not derivable from the application as originally filed and, consequently, the main request is not allowable.

AUXILIARY REQUEST

3. *Admissibility (Article 12(4) RPBA)*

- 3.1 Appeals offer the parties the opportunity to challenge first-instance decisions adversely affecting them, and to try to have them set aside and changed (see Case Law of the Boards of Appeal of the EPO, 6th edition 2010 Chapter VII.E.6). A patentee who has lost before the opposition division thus has the right to have the rejected requests reconsidered by the board of appeal.

- 3.2 However, the admission of other requests into the proceedings is a matter of discretion of the board of appeal. Pursuant to Article 12(4) RPBA a board of appeal has the power to hold inadmissible facts, evidence or requests that could have been presented in the opposition proceedings.

- 3.3 In the present appeal the auxiliary request at issue is directed to subject-matter which had already been

presented before the opposition division. The subject-matter of the request is essentially directed to one of the two alternatives present in the set of claims filed by the patentee with letter dated 21 December 2009 (see point III above) which was later replaced by the auxiliary request maintained by the opposition division. No decision was taken on this subject-matter, the opposition division having been prevented from doing so by the withdrawal of the request in question, even if the appellant did not intend to give up any subject-matter as a result.

3.4 As a consequence, the admission of that request into the proceedings would result in a fresh case. The claims of the auxiliary request are broader than the claims allowed by the opposition division. So far, no first-instance examination of the further patentability issues raised by the opponent (sufficiency of disclosure, novelty and inventive step) has been carried out for the broader subject-matter covered by claim 1 of the auxiliary request. In this situation, admitting that request into the proceedings would have led to an inescapable dilemma:

- Either the case is remitted to the opposition division for further prosecution, with the inevitable consequence that the final decision on the validity of the patent opposed is delayed for months or even years, in particular in the event of a further appeal. That is clearly incompatible with the interests of the parties and the public at large in legal certainty.

- Or the case is decided by the board within the pending appeal proceedings, which however is contrary to the boards' function as a second instance entrusted with the judicial review of the decisions of *inter alia* opposition divisions and deprives the parties of an examination by two instances.
- 3.5 In these circumstances, the board decided to use its discretionary power under Article 12(4) RPBA and not to admit the auxiliary request into the appeal proceedings.
4. As the patentee was the sole appellant against the interlocutory decision maintaining the patent in amended form, neither the board of appeal nor the non-appealing opponent can challenge the maintenance of the patent as amended.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

G. Röhn

J. Jardón Álvarez