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**Datasheet for the decision
of 8 November 2013**

Case Number: T 0657/11 - 3.3.09

Application Number: 05747848.9

Publication Number: 1765094

IPC: A23L 1/325, A23J 3/30,
A23J 3/32, A23J 3/34, A23J 1/04

Language of the proceedings: EN

Title of invention:
Hydrolysed marine protein product, process for the production thereof, and application

Patent Proprietor:
Norcape Biotechnology AS

Opponent:
BASF Personal Care and Nutrition GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 83, 111
EPC R. 80, 139, 140

Keyword:
"Correction of error - yes"
"Sufficiency - yes"
"Remittal for further prosecution"

Decisions cited:
G 0001/10, G 0011/91

Catchword:

In opposition proceedings mistakes or errors concerning the claims, the description or the drawings of the patent as granted may be removed either by an amendment occasioned by a ground of opposition under Article 100 EPC or, as far as the mistakes or errors concern texts or drawings which remain unamended, by way of a correction pursuant to Rule 139 EPC (see point 3 of the Reasons).



Case Number: T 0657/11 - 3.3.09

DECISION
of the Technical Board of Appeal 3.3.09
of 8 November 2013

Appellant: Norcape Biotechnology AS
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Representative: Sønstevoid, Anne
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Respondent: BASF Personal Care and Nutrition GmbH
(Opponent) Rheinpromenade 1
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Representative: Wolf, Christian
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 20 January 2011
revoking European patent No. 1765094 pursuant
to Article 101(3) (b) EPC.

Composition of the Board:

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

Summary of Facts and Submissions

I. This decision concerns the appeal filed by the proprietor of European patent No. 1 765 094, Norcape Biotechnology AS, against the decision of the opposition division to revoke the patent.

II. The patent was granted with 15 claims, independent claims 1, 6, 12 and 15 reading as follows:

"1. Hydrolysed marine protein product, comprising a reduced level of monovalent ions and biogenic amine groups (NPN) and other rest products of enzymatic, cooking, acids and microbial degradation or any combination thereof, wherein the level of monovalent ions and biogenic amines is reduced by combining the steps of UF and NF."

"6. Process for the production of a hydrolysed marine protein product according to claim 1, comprising the following steps:

- homogenizing by-product from fish and/or other marine industries/sources;
- controlled hydrolyses of said proteins and/or separation of stickwater from processing of marine raw material;
- ultrafiltration to provide a clarified marine protein hydrolysate;
- nanofiltration of the clarified UF permeate to remove monovalent ions, biogenic amines and water;

- drying of the NF permeate and UF concentrate separately or a combination thereof by spray, vacuum or any other drying method."

"12. Feed product, comprising the product of claim 1 and any carbohydrate source, vitamins, oils, fats and trace elements."

"15. Use of the product according to claim 1 as a supplement for culture media."

Claims 2 to 5, 7 to 11, 13 and 14 were dependent claims.

III. The opponent Cognis GmbH (now BASF Personal Care and Nutrition GmbH) had requested revocation of the patent in its entirety on the grounds that the claimed subject-matter lacked novelty and inventive step (Article 100(a) EPC), 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) and that the patent contained subject-matter which extended beyond the content of the application as originally filed (Article 100(c) EPC).

The documents cited during the opposition proceedings included:

D1: WO 01/28353 A2;

D2: Esp@cenet Abstract of CN 1392155(A); and

D2a: Machine translation of D2 into English.

IV. By its decision, announced orally on 1 December 2010 and issued in writing on 20 January 2011, the opposition division revoked the patent. The decision was based on a main, first and second auxiliary requests. Apart from the correction of the wording "NF permeate" to "NF concentrate" in the last step of claim 6, the claims of the main request were identical to the granted claims. The first auxiliary request included the same correction as the main request and the second auxiliary request corresponded to the granted claims.

The opposition division rejected the main and the first auxiliary requests because in its opinion the correction made did not fulfil the requirements of Rule 139 EPC, the reason being that it was not immediately evident that nothing else would have been intended than what was offered as the correction.

Concerning the second auxiliary request, the opposition division held that this request fulfilled the requirements of Articles 100(c) and 100(b) EPC, but rejected it because the subject-matter of claim 1, the product claim, lacked novelty in view of the disclosure of documents D1 and D2.

The opposition division did not deal with the issues of novelty and/or inventive step of the process claims (granted claims 6 to 11).

V. On 18 March 2011 the patent proprietor (in the following: the appellant) filed an appeal and on the same day paid the prescribed fee.

The statement setting out the grounds of appeal was filed on 20 May 2011 and included a main request and auxiliary requests I to VI. The claims of the main request were identical to the claims of the main request before the opposition division.

VI. On 25 September 2012 the board dispatched the summons to attend oral proceedings. In the annexed communication, the board indicated that in its preliminary view it would be evident to the skilled person that the subject-matter of claim 6 as granted was incorrect. As the process was aimed at a protein product with a reduced level of monovalent ions and biogenic amine groups, it would be obvious to the skilled person that a mistake had occurred in the claim, because he would be aware of the fact that the nanofiltration permeate would contain most of the monovalent ions and biogenic amine groups which it was intended to remove. It would also be evident that the nanofiltration retentate was the fraction to be dried.

However, the removal of an error in the granted version of a patent was a matter of Rule 140 EPC in that it related to a decision of the Office, namely the decision to grant as taken by the examining division. As set out in the decision of the Enlarged Board of Appeal G 1/10 of 23 July 2012, a patent proprietor's request for such a correction was inadmissible whenever made, including after the initiation of opposition proceedings.

The board further indicated that it tended to agree with the reasoning of the opposition division concerning the allowability of the product claims.

Lastly, the board indicated that the opposition division had not dealt with the process claims and that, taking account of the appellant's request to discuss only those issues which were the basis of the decision under appeal, it would appear appropriate to remit the case to the opposition division for further prosecution.

VII. By letter dated 19 June 2013 the appellant filed a new main (sole) request with only 5 claims which corresponded to the granted process claims 6 to 11. The appellant requested that the case be remitted to the opposition division for further prosecution.

VIII. In a further communication dated 1 July 2013, the board noted that the amendments made overcame the reasons for the revocation of the patent and that the board considered it appropriate to remit the case to the opposition division for further prosecution on the basis of the sole request before the board. The board also indicated that it intended to cancel the oral proceedings and to issue a written decision.

IX. On 9 September 2013, the opponent (in the following: the respondent) filed for the first time a submission in the appeal proceedings and requested the revocation of the patent on the grounds of Articles 100(a) and 100(b) EPC.

X. In a further communication dated 24 September 2013, the board informed the parties that the date for oral

proceedings was maintained. The board further noted that, taking into account that the respondent had not raised any objection to the amendments made, the main issue to be discussed during the oral proceedings would be sufficiency of disclosure. The board further indicated that, if the requirements of sufficiency were met, it intended to remit the file to the opposition division for further prosecution.

XI. The respondent filed a further submission on 3 October 2013.

XII. Oral proceedings were held before the board on 8 November 2013. During the oral proceedings the appellant withdrew its previous request and filed an amended request as its sole request.

Claim 1 reads as follows:

"1. Process for the production of a hydrolysed marine protein product comprising a reduced level of monovalent ions and biogenic amine groups (NPN) and other rest products of enzymatic, cooking, acids and microbial degradation or any combination thereof, wherein the level of monovalent ions and biogenic amines is reduced by combining the steps of UF and NF, comprising the following steps:

- homogenizing by-product from fish and/or other marine industries/sources;
- controlled hydrolyses of said proteins and/or separation of stickwater from processing of marine raw material;
- ultrafiltration to provide a clarified marine protein hydrolysate;

- nanofiltration of the clarified UF permeate to remove monovalent ions, biogenic amines and water;
- drying of the NF concentrate and UF concentrate separately or a combination thereof by spray, vacuum or any other drying method."

Claims 2 to 5 are dependent claims.

XIII. The arguments presented by the appellant may be summarised as follows:

- The correction in granted claim 6 (present claim 1) should be allowed. The error was obvious to the skilled person because it was clear from the specification that the components of the permeate should be removed. Moreover, it was also evident that nothing else than the UF concentrate was intended as the correction.
- The patent, supplemented by common general knowledge, contained sufficient information for a skilled person to carry out the invention without undue burden. The starting material was defined in a broad way as the claimed process could be applied to a broad spectrum of starting materials. The process worked using different hydrolysis conditions, and ultrafiltration and nanofiltration were standard processes, well known to the person skilled in the art. Moreover, the specification included specific information on how to carry out the steps of the process. Any person with ordinary skill could carry out the claimed process with the information in the patent and knowledge in the field.

XIV. The arguments of the respondent, insofar as they are relevant for the present decision, may be summarised as follows:

- The request filed during the oral proceedings was very late filed and should not be admitted into the proceedings.
- The requested correction was not obvious, because the NF permeate too could be dried, as set out the by the opposition division. Moreover, even accepting that the description supported the drying of NF concentrate and UF concentrate in combination, the correction was still not obvious in so far as it related to carrying out the drying separately, which was an embodiment also explicitly claimed.
- The claimed process was not sufficiently disclosed as it included a huge number of alternatives due to the use of vague terms and the lack of information concerning the individual process steps. It would not be possible for the skilled person to reproduce the invention without performing a research program to find out the conditions of the process. During the oral proceedings the respondent focused its objections on the definition of the starting material and the lack of detailed process conditions in the hydrolysis, ultrafiltration and nanofiltration steps. In its written submissions it further objected to the features "reduced level",

"homogenizing" and "clarified" as being very broad and unclear.

XV. The appellant requested that the decision under appeal be set aside and that the case be remitted to the opposition division for further prosecution on the basis of claims 1 to 6 of the main request filed on 8 November 2013 during the oral proceedings.

The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

2. *Admissibility of the request*

2.1 The appellant's (sole) request for further prosecution on the basis of claims 1-6 as filed during the oral proceedings before the board is based on its previous request filed on 19 June 2013 (granted process claims), the only change made being the correction of the wording "NF permeate" to read "NF concentrate" in the last step of the process of claim 1 (point XII above).

2.2 The appellant argued that the correction was obvious and that the amended claims should not be upheld in a wrong form. The respondent requested that this request should not be admitted into the proceedings because it was late filed.

2.3 The board exercised its discretion according to Article 13(1) of the RPBA to admit the request for the following reason:

The new request did not bring up any new issue into the proceedings which could have taken the respondent or the board by surprise. The meaning of "drying the NF permeate" in the last step of granted claim 6 and claim 1 of the appellant's previous request, respectively, would have had to be discussed in any case, since it is crucial to the present invention.

3. *Correction under Rule 139 EPC*

3.1 The claims according to the main request before the opposition division (point IV above) and the appellant's initial request in the appeal proceedings (point V) differ from the granted claims only in that the wording "NF permeate" in the last process step of claim 6 was replaced by "NF concentrate".

3.2 As stated by the board in its communication of 25 September 2012 (see point VI above), what was sought by the appellant with this request was actually the correction of an error in the granted version of the patent. Such a correction would have been a matter of Rule 140 EPC in that it related to a purported mistake in a decision of the Office, namely the decision to grant the patent-in-suit as taken by the examining division. However, Rule 140 EPC is not available to correct the text of a granted patent and a request for such a correction is inadmissible whenever made, including after the initiation of opposition proceedings (see Headnote 1 of G 1/10, OJ EPO 2013, 194).

- 3.3 As compared to the claims as granted the claims according to the appellant's final (sole) request were amended beyond the mere removal of an error, namely by limiting them to those granted as (process) claims 6-11. Hence the basis for the decision on the appeal (and, thereby, on the opposition) is no longer that for the decision to grant the patent-in-suit, which decision will definitely lose its effect and be replaced by a new decision. In such a situation any (further) amendment of the claims, even if it aims at the removal of an obvious mistake in the claims as granted, does not constitute a correction of an error or a mistake in a decision of the EPO within the meaning of Rule 140 EPC.
- 3.4 As pointed out in the decision G 1/10, point 13 of the Reasons, it is always open to a patent proprietor to seek to amend his patent during opposition or limitation proceedings and such amendment could remove a perceived error. However, an amendment with the (sole) aim to remove a mistake or an error in the claims, but also in the description and the drawings of the patent as granted, cannot be said to be "occasioned by a ground for opposition under Article 100" (see Rule 80 EPC). It follows that such mistakes or errors - here the expression "[nanofiltration] permeate", see below - in the unamended part of the text in question may only be removed by way of a correction pursuant to Rule 139 EPC, which provision and the specific requirements defined therein apply independently from Rule 80 EPC.
- 3.5 Under Rule 139 EPC errors or mistakes in documents filed with the EPO may be corrected upon request and, if they concern the description, the claims (as in the

present case) or the drawings, on condition that the correction is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.

3.5.1 In the present case the request for correction is implied in the appellant's request for further prosecution on the basis of claims 1-6 which are, apart from the correction of a purported mistake (and the renumbering), identical to the claims 6-11 of the patent as granted.

3.5.2 With respect to the correction itself the board agrees with the appellant that it is immediately evident to the skilled person that there was an error in the wording of the process claim as filed. There is an internal inconsistency in the process claim as filed (claim 7, which is the basis for present claim 1). While the penultimate step requires the nanofiltration in order to remove monovalent ions and biogenic amines, the last step uses the nanofiltration permeate containing these undesired by-products to produce the desired marine protein product. There is a further inconsistency between the wording of the claim and several passages in the description as filed which refer to said monovalent ions and biogenic amines as undesired products (see page 6, lines 1 to 3; page 7, lines 26 to 27; the paragraph bridging pages 7 and 8 and the experimental part of the patent).

The board thus accepts that in view of these inconsistencies, the skilled person would have recognised that an error was present in the last step of claim 7 as filed.

- 3.5.3 It remains to be decided whether the requested correction is obvious in the sense that nothing else would have been intended than what is offered as the correction.

In the board's judgement this is indeed the case. The skilled person is aware that there are only two fractions in a filtration step and that if one fraction (the permeate) is incorrect, the only possible correction is the other fraction (the retentate or concentrate). This conclusion is in line with the concept of the present application that the undesirable biogenic amines pass through the NF membrane whereas the larger desirable amines are retained in the NF retentate (see page 13, lines 25 to 30; see also figure 10, point 7, last sentence). Finally, page 19, lines 23 to 25 discloses that the concentrate of the nanofiltration is to be used to produce the marine protein product.

- 3.5.4 The board cannot accept the argument of the respondent that the correction was not obvious because the wrong wording of the claim is also to be found in one passage of the description as filed. In fact, apart from this one passage, the rest of the description, the working examples and the figures are in line with the perceived correction as explained above. Thus the skilled person would immediately recognize that the error in claim 7 is also present in this one passage in the description and would automatically understand the process as in corrected claim 1.

As regards the respondent's further objection concerning the separate drying of the concentrates, the board notes that the correction has nothing to do with separate or combined drying of the NF concentrate and the UF concentrate. As set out above, the relevant question is what is dried.

- 3.5.5 Furthermore, the board can not share the doubts of the opposition division concerning the correction based on the argument that the drying of the NF permeate was something conceivable, since the invention could be carried out on board of ships and the drying of the permeate was a convenient way of not carrying too much water.

Although theoretically and technically possible, the skilled person would immediately reject such a process. Firstly, the compounds contained in the NF permeate are undesired. Secondly, the content of the NF permeate is not considered as hazardous waste so that it can be disposed of directly into the sea. It would make no sense to use energy in order to remove water from an undesired non-hazardous product and to transport the dry undesired product back to the harbour.

- 3.6 For these reasons the proposed correction has been made in accordance with the requirements of Rule 139 EPC. Such correction is of a strictly declaratory nature and it does not infringe the prohibition of extension under Article 123(2) EPC (cf. G 11/91, point 4 of the Reasons).

4. *Amendments*

4.1 The opposition division stated in its decision that the amendments made fulfilled the requirements of Article 100(c) EPC.

4.2 The respondent has not raised any objection to the finding of the opposition division and the board sees no reason to raise an objection of its own.

4.3 The amendments made during the appeal proceedings are not to be objected to under Article 123 EPC either. The replacement in the process claim of the reference to the product claim by the wording of this claim does not alter the subject-matter of the claim. Nor does the correction under Rule 139 EPC modify the content of the information given in the application as filed, as explained above.

4.4 The board thus concludes that the amendments made satisfy the requirements of Article 123 EPC.

5. *Sufficiency of disclosure*

5.1 The patent aims to reduce the level of monovalent ions, biogenic amines and water of hydrolyzed protein products by a multi-step process that is essentially characterized by the combination of ultrafiltration and nanofiltration steps (see claim 1).

5.2 The patent in suit contains experimental data which show the combination of ultrafiltration (UF) and nanofiltration (NF), including the determination of operating conditions of the UF membrane, production

trials for the ultrafiltration, and nanofiltration of the UF permeate (see paragraphs [0056] to [0086]). Furthermore, figures 1 and 10 show flow charts of the process according to the invention, which produces a marine product with a reduced level of amines and monovalent ions.

In this context the board notes that ultrafiltration and nanofiltration are two well-known membrane filtration processes. The invention is not based on the selection of specific process parameters but merely on the combination of the two known membrane filtration processes. It is within the common knowledge of the skilled person to select adequate parameters for each process. In this regard the patent in suit provides at least some guidance on how to carry out the claimed invention.

- 5.3 The respondent argued that the requirement of sufficiency of disclosure was not met because the claimed process embraces a huge number of alternatives due to the lack of information in the claims and in the specification concerning the starting material and the precise conditions of every step of the claim (controlled hydrolysis, nanofiltration and ultrafiltration).

This objection is unfounded. It is correct that the starting material is defined in a broad manner, but this broad definition does not result in a lack of the information necessary to enable a skilled person to carry out the claimed process. As indicated by the appellant, the process can be applied to different fish by-products and there is no information on file showing

that the process would not work with other starting material embraced by the claim.

Concerning the hydrolysis, ultrafiltration and nanofiltration, the board notes that these processes are standard processes in the art and that it is within the general common knowledge of the skilled person to select the necessary parameters to carry them out. In any case, the patent specification gives at least some information as to the type of hydrolysis (see [0002]), and the operating conditions for the ultrafiltration (see [0058] to [0061]) and nanofiltration (see [0070] to [0072]) steps.

It is within the common knowledge of the skilled person to select the adequate parameters for the single steps. The patent in suit did not invent protein hydrolysis, ultrafiltration or nanofiltration.

- 5.4 The respondent disputed in its letter of 6 October 2013 that the results of figure 10 represented an example according to the claim because in its opinion the obtained product had a higher level of monovalent salts and water. It based its objection on a recalculation of the results of figure 10 of the patent.

However, this objection is flawed because the calculation was made using the nanofiltration permeate instead of the nanofiltration concentrate as required by the claim.

- 5.5 Lastly, concerning the objections of the respondent based on the use of vague expressions such as "reduced level", "homogenizing" and "clarified", these objections

concern the question whether the claim clearly defines the subject-matter for which protection is sought, that is to say in relation to Article 84 EPC, which is not itself a ground for opposition. This objection cannot, in the light of what is set out in point 5.3. above, put into question the sufficiency of the disclosure.

- 5.6 In summary, the patent specification discloses the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. Moreover, the objection of the respondent that the invention could not be performed over the whole area claimed is neither well founded nor supported by experimental evidence. The board is therefore satisfied that the requirements of sufficiency are met.

6. *Remittal*

Taking into account that (i) the opposition division has not yet taken a decision on novelty and inventive step of the present process claims, (ii) the appellant has requested remittal of the case to the opposition division for further consideration and (iii) the respondent did not object to such remittal, the board considers it appropriate to exercise its discretion under Article 111(1) EPC and remit the case for further prosecution on the basis of claims 1 to 6 of the main request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the opposition division for further consideration on the basis of claims 1 to 6 of the main request filed on 8 November 2013 during the oral proceedings.

The Registrar

The Chairman

M. Cañueto Carbajo

W. Sieber