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**Datasheet for the decision
of 12 May 2016**

Case Number: T 1784/14 - 3.3.09

Application Number: 01932104.1

Publication Number: 1284102

IPC: A23L1/236, C07H3/04, C07H15/04

Language of the proceedings: EN

Title of invention:
SYRUP-CONTAINING COMPOSITIONS AND PROCESS FOR PRODUCING THE
SAME

Patent Proprietor:
Ueno Fine Chemicals Industry, Ltd.

Opponents:
Cargill, Incorporated
Südzucker Aktiengesellschaft
Mannheim/Ochsenfurt

Headword:

Relevant legal provisions:
EPC Art. 56

Keyword:

Inventive step - (main request, no)
First to third auxiliary requests - not deemed to have been
validly filed

Decisions cited:

T 2033/09, T 0217/10, T 1732/10

Catchword:

If no substantiation is provided, at any stage during the
appeal proceedings, for claim amendments which are not self-
explanatory, the requests containing those amendments may be
considered not validly filed (point 3 of the Reasons,
T 1732/10 followed)



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Case Number: T 1784/14 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 12 May 2016

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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
9 July 2014 concerning maintenance of the
European Patent No. 1284102 in amended form.

Composition of the Board:

Chairman W. Sieber
Members: M. O. Müller
F. Blumer

Summary of Facts and Submissions

- I. This decision concerns the appeals filed by both opponents against the interlocutory decision of the opposition division that European patent No. 1 284 102 as amended met the requirements of the EPC.
- II. With their notices of opposition, the opponents had requested revocation of the patent in its entirety on the grounds under Article 100(a) (lack of novelty and inventive step) and 100(b) EPC.
- III. The documents submitted during the opposition proceedings included:
- A5: EP 0 625 578 B1.
- IV. In a first decision dated 17 July 2009, the opposition division decided to revoke the patent.
- V. The proprietor appealed this decision, requesting that the decision under appeal be set aside and that the case be remitted to the opposition division on the basis of the claims as granted (main request), or alternatively on the basis of one of the first to sixth auxiliary requests as filed with letter of 18 November 2009.
- VI. In its decision T 2033/09, the board rejected the main, first and second auxiliary requests and remitted the case to the opposition division for further prosecution on the basis of the third auxiliary request, claim 1 of which read as follows:

"1. A crystalline mixture solid composition comprising α -D-glucopyranosyl-1,1-mannitol,

α -D-glucopyranosyl-1,6-sorbitol and 1.0 to 1.99 wt% of α -D-glucopyranosyl-1,1-sorbitol (the above wt% is based on the total weight of the α -D-glucopyranosyl-1,1-mannitol, α -D-glucopyranosyl-1,6-sorbitol and α -D-glucopyranosyl-1,1-sorbitol)."

Hereinafter, the following acronyms will be used:

α -D-glucopyranosyl-1,1-mannitol: GPM

α -D-glucopyranosyl-1,6-sorbitol: GPS-6

α -D-glucopyranosyl-1,1-sorbitol: GPS-1

- VII. In the resumed opposition proceedings, the opponents raised objections under Articles 123(2), 84, 83, 54 and 56 EPC against the third auxiliary request.
- VIII. In its second decision dated 9 July 2014, the opposition division considered the third auxiliary request to meet the requirements of the EPC. In particular, the claimed subject-matter was held to be novel over A5, which disclosed crystalline compositions with at least 2 wt% GPS-1, whereas the independent claims required a GPS-1 level of 1.00 to 1.99 wt%. The claimed subject-matter was also inventive. The problem solved over the closest prior art A5 was the provision of a composition with improved hygroscopy and solubility. Neither A5 nor any of the other cited documents suggested that a lower GPS-1 amount would solve this problem.
- IX. Opponents 1 and 2 (hereinafter: appellants 1 and 2) appealed the above decision and raised objections under

Articles 123(2), 83, 54 and 56 EPC. The statement of grounds of appeal of appellant 1 included

A47: WO 97/08958 A1.

- X. In its response to the statements of grounds of appeal the proprietor (hereinafter: the respondent) requested that the appeals be dismissed or, alternatively, that the case be remitted to the opposition division for consideration of the fourth to sixth auxiliary requests as filed on 19 November 2009 (referred to hereinafter as first to third auxiliary requests) or alternatively, if this request was not allowed, that these auxiliary requests be considered by the board. The proprietor did not submit any facts, evidence or arguments in support of the allowability of any of its claim requests.

The main request corresponds to the third auxiliary request before the opposition division (for claim 1, see point VI above).

Claim 1 of the first auxiliary request corresponds to claim 1 of the main request except that the upper limit of the GPS-1 amount has been lowered from 1.99 wt% to 1.5 wt%.

Claim 1 of the second auxiliary request (the only independent claim) reads as follows:

"A process for producing a crystalline mixture solid composition comprising α -D-glucopyranosyl-1,1-mannitol, α -D-glucopyranosyl-1,6-sorbitol and 0.01 to 1.99 wt% of α -D-glucopyranosyl-1,1-sorbitol (the above wt% is based on the total weight of the α -D-glucopyranosyl-1,1-mannitol,

α -D-glucopyranosyl-1,6-sorbitol and α -D-glucopyranosyl-1,1-sorbitol) which process comprises the steps of supplying a composition comprising 50 to 80 wt% of α -D-glucopyranosyl-1,1-mannitol, 1 to 50 wt% of α -D-glucopyranosyl-1,6-sorbitol and 0.01 to 20 wt% of α -D-glucopyranosyl-1,1-sorbitol into a kneader to knead and cool it so as to produce a composition, mixing the composition with a hydrophilic solvent, and separating solid matter from the liquid (the above wt% is based on the total weight of the α -D-glucopyranosyl-1,1-mannitol, α -D-glucopyranosyl-1,6-sorbitol and α -D-glucopyranosyl-1,1-sorbitol)."

Claim 1 of the third auxiliary request differs from that of the second auxiliary request in that the hydrophilic solvent is specified as being an ethanol aqueous solution having a concentration of 60 to 90%.

- XI. With its communication dated 29 September 2015, the board summoned the parties to oral proceedings and issued its preliminary opinion. As regards the main request, the board observed *inter alia* that the subject-matter of claim 1 appeared to lack inventive step in view of A5. As regards the auxiliary requests, the board noted that the respondent had not explained which amendments had been made and, more importantly, how they related to the appellants' objections.
- XII. With letters dated 5 and 18 April 2016, the respondent and appellant 1 announced that they would not be attending the oral proceedings.
- XIII. With its letter dated 12 April 2016, appellant 2 submitted:

A48: Internet excerpt "Fehlerrechnung", <http://kr.perihel/ch/Material/Theorie/Grundlagen/fehlerrechnung.pdf>; and

A49: Internet excerpt "Significant figures" from Wikipedia.

XIV. On 12 May 2016 oral proceedings were held before the board, in the absence of appellant 1 and the respondent.

XV. So far as relevant to the present decision, the appellants' arguments can be summarised as follows:

- Main request

The subject-matter of claim 1 lacked inventive step over the closest prior art A5, from which it differed, if at all, only in terms of the amount of GPS-1. There was no technical effect linked to this difference, for which reason alone inventive step had to be denied. Furthermore, even if the problem was to provide a composition with improved crystallinity, to achieve that goal it would have been obvious in view of A5 to reduce the amount of GPS-1.

- First to third auxiliary requests

The auxiliary requests should not be admitted into the proceedings. The respondent had not provided any substantive reasons for admitting them, In particular, no information had been provided as to how the amendments in these requests could overcome the appellants' objections.

XVI. The appellants requested that the decision under appeal be set aside and that the patent be revoked.

Appellant 2 furthermore requested that the first to third auxiliary requests (fourth to sixth auxiliary requests before the opposition division) not be admitted into the proceedings.

XVII. The respondent requested in writing that

- the appeal be dismissed (implying maintenance on the basis of the third auxiliary request found allowable by the opposition division) or, alternatively, that
- the case be remitted for consideration of the first to third auxiliary requests (corresponding to the fourth to sixth auxiliary requests before the opposition division) or, if this request was not granted, that
- these auxiliary requests be considered by the board, implying that the patent be maintained on the basis of any of the first to third auxiliary requests.

Reasons for the Decision

Main request

1. Inventive step

1.1 The invention aims at providing a crystalline mixture solid composition of GPM, GPS-6 and GPS-1 "in an extremely short period of time with small-scale

equipment by a process which can save power and does not take much time and labor" (paragraph [0009]).

1.2 A5 relates to sweetener compositions and a process for their preparation. The process of A5 comprises steps of converting saccharose enzymatically into isomerised saccharose and catalytically hydrogenating the isomerised saccharose (claim 1, example 1). Like the patent, A5 aims at a process that can be carried out in an economical way (page 2, line 10). Therefore, as argued by both appellants, A5 can be considered to represent the closest prior art.

1.2.1 In example 4 of A5, the hydrogenated isomerised saccharose obtained as in example 1 was treated with a chromatographic separation column. The composition of the desired main product (fractions containing the disaccharides) was as follows:

GPS-6: 46.2%
GPS-1: 4.1%
GPM: 49.6%.

In example 5, an analogous chromatographic separation was carried out. Although there is a reference to an unspecified example ("Es wurde analog Beispiel eine chromatographische Trennung nach der Hydrierung durchgeführt..."), the unspecified example referred to can only be example 4 since this is the only example with a chromatographic separation after hydrogenation.

Example 6 discloses that in order to crystallise the fractions containing the disaccharide alcohols, i.e. those containing the GPS-6, GPS-1 and GPM, water is removed by evaporation. To do this, these fractions, e.g. the fraction obtained in example 5, were

concentrated by evaporation of water under reduced pressure, and the resulting product was solidified by cooling and milled. A fine-particle, non-adhesive and free-flowing (i.e. crystalline) product was obtained. Although example 5 does not indicate the amount of GPS-1 in the fraction of disaccharide alcohols, due to the similarity of the type of separation with that of example 4 its amount can reasonably be assumed to be in the same order of magnitude as in example 4, namely around 4%, and in any case above 1.99%.

- 1.2.2 The composition of example 6 of A5 is identical in terms of its constituents, i.e. GPM, GPS-6 and GPS-1, to that of claim 1. Furthermore, it is solid and crystalline as required by claim 1. However, it differs from that of claim 1 in terms of the amount of GPS-1, which is above the claimed upper limit of 1.99 wt%.
- 1.3 As argued by both appellants, there is no evidence on file that an amount of 1.99 wt% GPS-1 instead of a higher amount, e.g. 4% as assumed for example 6 of A5, provides any technical effect. Therefore the objective technical problem is the provision of an alternative crystalline, solid GPM/GPS-6/GPS-1 composition.
- 1.4 The solution to this problem consists in the arbitrary variation of the amount of GPS-1. In fact an amount of 2 wt% GPS-1 is already disclosed in A5 itself (page 3, lines 27 to 35 and claims 2, 6 and 7) and it is not apparent how the arbitrary variation of this amount to the slightly lower amount of 1.99 wt% could contribute to inventive step.
- 1.5 But even if, in the respondent's favour, one formulates the problem more ambitiously as the achievement of a higher crystallinity, the subject-matter of claim 1 is

obvious. More specifically, the skilled person confronted with this problem would learn from A5 (page 3, lines 47 to 48) that to achieve a higher crystallinity, the amount of GPS-1 has to be reduced. The skilled person confronted with this more ambitious problem would thus have reduced the amount of GPS-1 in example 6 of A5 and would thereby have arrived at the subject-matter of claim 1.

1.6 Consequently, the subject-matter of claim 1 lacks inventive step over A5.

2. The appellants raised additional objections under Articles 123(2), 83 and 54 EPC. In view of the fact that the subject-matter of the main request was found to lack inventive step, there was no need to decide on these objections.

First to third auxiliary requests

3. Admission

3.1 The first to third auxiliary requests were filed, or at least referred to, by the respondent in its response to the statement of grounds of appeal. These auxiliary requests correspond to the fourth to sixth auxiliary requests submitted during the opposition proceedings.

3.2 The only submissions the respondent made with regard to these auxiliary requests are those in its letter dated 10 March 2015:

"Furthermore, in the event that the Board of Appeal ultimately concludes that the Main Request cannot be granted, I request that the proceedings are remitted back to the Opposition Division for

consideration of the Fourth to Sixth Auxiliary Requests as filed on 19 November 2009 [the present first to third auxiliary requests]. It will be appreciated that these claim requests have not previously been considered by the Opposition Division.

Finally, in the event the Board of Appeal both concludes that the Main Request cannot be granted and decides against remittal, I request consideration in the present appeal proceedings of the Fourth to Sixth Auxiliary Requests as filed on 19 November 2009" (insertion in square brackets by the board).

Consequently, the respondent has not provided a single argument to substantiate why the amendments in the auxiliary requests have overcome the objections made by the appellants against the main request.

3.3 Even after the board had reiterated in its preliminary opinion the appellants' inventive-step objection on the basis of A5 (point 4.1.1), and had observed that there was no explanation as to how the amendments related to the appellants' objections (point 6), the respondent did not file any such explanation. Instead, it simply announced that it would not be attending the oral proceedings.

3.4 A substantiation as to why amendments are filed may exceptionally not be needed if they are self-explanatory in the sense that they are such as to put the board and the other party in a position to understand - without any further explanation - why they overcome any outstanding objections. This condition is however not met in the present case. More specifically,

in the present case it is not at all clear why the amendments in the auxiliary requests, i.e. the reduction of the upper limit of the GPS-1 amount to 1.5 wt% in the first auxiliary request, the restriction to process claims in the second auxiliary request (all product claims being deleted) and the further restriction of the type of solvent in the third auxiliary request overcome the inventive-step objection based on A5.

- 3.5 As set out in T 1732/10 (point 1.5), unsubstantiated claim requests which are not self-explanatory become effective only at the date on which substantiation is provided (see also 217/10; point 5). Their filing in and of itself plays no role, no matter when they are filed. While in the case underlying that decision, substantiation was provided shortly before the oral proceedings, and the claim requests were deemed to have been validly filed at that point in time, the situation in the present case is even worse in that no substantiation was provided at any time during the entire appeal proceedings. As a logical consequence, the claim requests must be considered not validly filed at all.
- 3.6 Any other conclusion would have as a consequence that by submitting claim requests without explanation and by simply requesting, as in the present case, a remittal to the first instance for consideration of these requests, a decision could be deliberately delayed. That would not be conducive to procedural efficiency and in fact would almost amount to an abuse of procedure.
- 3.7 Therefore the board decided that the auxiliary requests could not be considered validly filed. Since the

auxiliary requests were not part of the present appeal proceedings, no decision on their substance needed to be taken by the board.

Request for remittal

4. For the same reasons, the request for remittal based on these auxiliary requests could also not succeed.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



T. Buschek

W. Sieber

Decision electronically authenticated