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**Datasheet for the decision
of 10 May 2019**

Case Number: T 1753/15 - 3.3.09

Application Number: 08766884.4

Publication Number: 2178385

IPC: A23C21/08, A23L2/60, A23L2/66

Language of the proceedings: EN

Title of invention:
HEAT STABLE NUTRITIONAL BEVERAGE AND METHOD OF PREPARING IT

Patent Proprietor:
Campina Nederland Holding B.V.

Opponent:
N.V. Nutricia

Headword:

Relevant legal provisions:
EPC Art. 83, 111(1), 123(2)

Keyword:
Main request: added matter (no), sufficiency of disclosure (yes), remittal for further prosecution

Decisions cited:

Catchword:



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Case Number: T 1753/15 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 10 May 2019

Appellant: Campina Nederland Holding B.V.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 3 July 2015
revoking European patent No. 2178385 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman W. Sieber
Members: N. Perakis
D. Prietzel-Funk

Summary of Facts and Submissions

- I. This decision concerns the appeal filed by the patent proprietor against the opposition division's decision revoking European patent No. 2 178 385.
- II. In the notice of opposition, the opponent requested revocation of the patent in its entirety on the grounds of Article 100(a) (lack of novelty and lack of inventive step) and 100 (b) EPC.

Claim 1 as granted reads as follows:

"1. Heat-stable nutritional beverage having a pH of 6.6-8.2 and having an ionic strength of between 0.5 and 80 mM, comprising 5-12% w/w whey protein and 4-16% w/w of at least one sugar selected from di-, oligo- and polysaccharides wherein at least one monosaccharide residue is other than glucose."

The opposition division decided that the invention as defined in the main request (claims as granted), auxiliary requests 1, 2 and 5 was insufficiently disclosed (reasons, points 4, 5 and 10). The subject-matter of claim 1 of auxiliary requests 3 and 4 did not comply with the requirements of Article 123(3) EPC.

- III. The patent proprietor (the appellant) requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request (identical to auxiliary request 1 of the appealed decision), alternatively on one of auxiliary requests 1 to 5, all requests submitted with the statement setting out the grounds of appeal dated 3 November 2015.

Claim 1 of the main request (the only request that is relevant for this decision) reads as follows (amendments over claim as granted appear in bold):

"1. Heat-stable nutritional beverage having a pH of 6.6-8.2 and having an ionic strength of between 0.5 and 80 mM, comprising 5-12% w/w whey protein and **6.0-15.0%** w/w of at least one sugar selected from di-, oligo- and polysaccharides wherein at least one monosaccharide residue is other than glucose."

- IV. By letter of 4 March 2016, the opponent (the respondent) requested that the appeal be dismissed and that auxiliary requests 1 to 4 not be admitted into the proceedings. The respondent also requested that the case not be remitted to the opposition division but that the board should also decide on the questions of novelty and inventive step.
- V. In a communication dated 23 October 2018, the board *inter alia* gave a preliminary opinion on issues regarding Articles 123(2) and 83 EPC of the main request.
- VI. By letter of 7 November 2018, the appellant filed a new auxiliary request 4 and requested that, should the board decide that the main request or one of the auxiliary requests meets the requirements of Articles 123(2), 84 and 83 EPC, it remit the case to the opposition division so as to allow the appellant to be heard on the issues of novelty and inventive step in the proceedings at first instance.
- VII. By letter of 27 February 2019, the respondent requested that none of the appellant's auxiliary requests be admitted into the proceedings.

VIII. By letter of 21 March 2019, the appellant submitted further arguments on the issues of novelty and inventive step and a further document:

D14: *Diary Science and Technology*, 2nd edition, Walstra *et al*, 2006, p 538.

IX. On 10 May 2019, oral proceedings were held before the board. During these proceedings the appellant withdrew its request for remittal of the case to the opposition division and left this issue to the board's discretion.

X. The relevant arguments put forward by the appellant in its written submissions and during the oral proceedings may be summarised as follows:

Added subject-matter

- The subject-matter of claim 1 of the main request did not extend beyond the content of the application as filed but was directly and unambiguously derived from the combination of claims 1, 5 and 9 as filed.

Sufficiency

- The invention underlying the subject-matter of claim 1 was sufficiently disclosed. It had to be borne in mind that claim 1 contained not only compositional features but also the functional feature "heat stable". The skilled person would find the necessary guidance in the patent in suit to enable them to prepare a heat-stable nutritional beverage covering the entire scope of claim 1. The fact that table 4 showed two beverages with a sugar

content falling within the scope of claim 1 but not providing the required heat stability did not mean that the invention could not be carried out across the claimed scope. The skilled person was able to adapt the other parameters of the beverage, such as pH, ionic strength, protein content, within the claimed ranges, and obtain a heat-stable beverage without undue burden.

XI. The relevant arguments put forward by the respondent in its written submissions and during the oral proceedings may be summarised as follows:

Added subject-matter

- The subject-matter of claim 1 of the main request extended beyond the content of the application as filed since a sugar concentration between 6.0-15.0% w/w was disclosed in the application as filed only for a ready-for-use beverage (page 6, lines 23-24).

Sufficiency

- The invention underlying claim 1 was not sufficiently disclosed across the entire scope of this claim. Table 4 of the application as filed showed that a beverage with an inulin content of 8 and 9% w/w was not heat-stable and. Furthermore, it did not contain results on heat stability for an inulin content of 6 and 7% w/w.

Remittal

- The case should not be remitted to the opposition division for procedural economy.

- XII. The appellant requested that the decision under appeal be set aside and the patent be maintained in amended form based on the claims of the main request or one of auxiliary requests 1 to 5, the main request and auxiliary requests 1 to 3 and 5 submitted by letter dated 3 November 2015 and auxiliary request 4 submitted by letter dated 7 November 2018.
- XIII. The respondent requested that the appeal be dismissed. It also requested that auxiliary requests 1 to 5 not be admitted into the proceedings, and that the case not be remitted to the opposition division for the assessment of novelty and inventive step.

Reasons for the Decision

1. Added subject-matter
- 1.1 In claim 1 of the main request the content of the specific sugars has been amended from 4-16% w/w (claim 1 as granted) to now 6.0-15% w/w. The respondent asserted that that this amendment was not properly supported by the sentence on page 6, lines 23 to 24 relied on by the opposition division and initially also by the appellant. In this sentence, which reads:

"A suitable concentration range of the sugar is 6.0-15.0 % w/w on the ready-for-use beverage"

the concentration range is only mentioned in the context of a ready-for-use beverage, a feature which has not been introduced into claim 1. Therefore, claim 1 of the main request does not meet the requirements of Article 123(2) EPC.

1.2 However, the subject-matter of this claim directly and unambiguously derives from the combination of claims 1, 5 and 9 of the application as filed, which read as follows:

"1. Heat-stable nutritional beverage having a pH of 6.6-8.2 comprising 5-12 % w/w whey protein and 4-16 % w/w of at least one sugar selected from di-, oligo- and polysaccharides, wherein at least one monosaccharide residue is other than glucose."

"5. Beverage according to any one of claims 1-4, which has a pH of 6.8-8.0 and/or comprises 6-10 % w/w whey protein and/or 6-15 % w/w of said sugar."

"9. Beverage according to any one of claims 1-8, which has an ionic strength of between 0.5 and 80 mM."

Since the features of claim 5 as filed are listed as "and/or", they are also presented as separate alternatives. Thus, the skilled person would combine the subject-matter of independent claim 1 with one of the alternatives of claim 5, namely the one relating to "6-15 % w/w of said sugar", and the additional feature of claim 9, dependent on any precedent claim.

1.3 In view of this the respondent's objection based on the sentence on page 6 cannot succeed.

1.4 To conclude, the subject-matter of claim 1 of the main request fulfils the requirements of Article 123(2) EPC.

2. Sufficiency

2.1 According to the appealed decision, the invention underlying claim 1 was not sufficiently disclosed because for the preferred polysaccharide, inulin, some concentrations that fell within the claimed range of 6.0-15.0% w/w did not result in a heat-stable beverage (reasons, point 4).

2.2 The opposition division based its finding on the data presented in table 4 of the patent in suit, which discloses the effect of the sugar concentration and the sugar type on heat stability. According to this table, the beverage compositions having a sugar content between 1 and 5% w/w (outside the claimed range) were not heat-stable and gelled, irrespective of the sugar type. In contrast, the compositions having sugar concentrations between 6 and 10% w/w remained in principle liquid, i.e. they were heat-stable. However, when inulin was used as the sugar, the beverage compositions gelled even at concentrations of 8 and 9% w/w. On the basis of the results on inulin, the opposition division denied sufficiency of disclosure across the entire scope of claim 1.

2.3 Claim 1 states that the nutritional beverage has the following four tangible parameters:

- a pH of 6.6-8.2,
- an anionic strength varies between 0.5 and 80 mM,
- 5-12% w/w whey protein, and
- 6.0-15.0% w/w of a selected sugar.

Claim 1 also contains a functional requirement, namely that the nutritional beverage is heat-stable. The term "heat-stable" is defined in paragraph [0015] of the

patent in suit "as a liquid state in which essentially no gelation, sedimentation or aggregation is observed in the beverage, either directly after heat treatment or after prolonged storage at temperatures of about 20°C, e.g. at least 6, preferably at least 12 months". The board agrees with the appellant that the functional feature "heat-stable" further limits the compositional requirements of the claim.

2.4 It is not unusual in a claim in which ranges for various parameters are given that not all possible combinations provide the desired result. In the case at hand, the limiting additional functional feature is a compromise between the fact that the purely compositionally defined claim would encompass non-working embodiments and the patent proprietor's expectation of a fair protection of its invention. Therefore, the fact that two inulin-containing aqueous compositions (pH 7.5, 8 wt.% whey protein) meet the compositional requirements of claim 1, but are gelled, does not necessarily warrant the conclusion that the invention underlying claim 1 is insufficiently disclosed.

2.5 The patent contains further information as regards the the concentrations in which suitable sugars should be applied. Paragraph [0032] teaches that sufficient sugar must be incorporated in order to ensure that the whey component does not gel. Furthermore, the inulin experiment of table 4 itself shows that this specific composition (pH 7.5, 8 wt.% whey protein) needs more inulin: with 10 wt.% inulin the beverage does not gel.

Furthermore, the skilled person could obviously vary the other parameters of the beverage composition, e.g.

reduce the amount of whey protein while keeping the amount of inulin.

2.6 In summary, claim 1 of the main request relates to a combination of ranges of parameters and includes a functional feature. As explained above, the patent enables the skilled person to obtain substantially all embodiments falling within the ambit of claim 1. Thus, the invention underlying claim 1 is sufficiently disclosed.

3. Remittal

The appealed decision did not deal with the issues of novelty and inventive step, which appear to be rather complex. For example, novelty objection requires the evaluation of contested technical evidence regarding the question of whether the feature of ionic strength was implicitly disclosed in the heat stable beverages of the prior art. Thus, the board exercises its discretion under Article 111(1) EPC and remits the case to the opposition division for further prosecution.

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 prosecution on the basis of claims 1 to 15 of the main request submitted by letter dated 3 November 2015.

The Registrar:

The Chairman:



M. Canueto Carbajo

W. Sieber

Decision electronically authenticated