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**Datasheet for the decision
of 21 October 2022**

Case Number: T 0554/20 - 3.3.09

Application Number: 06790790.7

Publication Number: 1937078

IPC: A23G1/00, A23G1/30, A23G1/46

Language of the proceedings: EN

Title of invention:
HIGH MILK SOLID CHOCOLATE COMPOSITION

Patent Proprietor:
Mondelez Canada, Inc.

Opponent:
Société des Produits Nestlé S.A.

Headword:
High milk solid chocolate composition/MONDELEZ

Relevant legal provisions:
EPC Art. 54(1)
RPBA 2020 Art. 12(4), 12(6), 13(2)

Keyword:

Novelty - main request (no)

Amendment after summons - exceptional circumstances (no) -
taken into account (no) - evidence and auxiliary request -
taken into account (no)

Decisions cited:



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0554/20 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 21 October 2022

Appellant: Société des Produits Nestlé S.A.
(Opponent) Entre-deux-Villes
1800 Vevey (CH)

Representative: Elkington and Fife LLP
Prospect House
8 Pembroke Road
Sevenoaks, Kent TN13 1XR (GB)

Respondent: Mondelez Canada, Inc.
(Patent Proprietor) 3300 Bloor St W
Suite 1801
Toronto ON M8X 2X2 (CA)

Representative: Wilson Gunn
Charles House
148/9 Great Charles Street
Birmingham B3 3HT (GB)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
2 January 2020 concerning maintenance of the
European Patent No. 1937078 in amended form.**

Composition of the Board:

Chairman A. Haderlein
Members: C. Meiners
N. Obrovski

Summary of Facts and Submissions

- I. This decision concerns the appeal filed by the opponent (appellant) against the interlocutory decision of the opposition division finding that, on the basis of auxiliary request 1 filed during oral proceedings before the opposition division, the patent in suit ("the patent") met the requirements of the EPC.
- II. In its notice of opposition, the opponent had requested that the patent be revoked in its entirety on, *inter alia*, the ground for opposition under Article 100(a) EPC in combination with Article 54 EPC (lack of novelty).
- III. In its decision, the opposition division found, *inter alia*, that the auxiliary request was novel and involved an inventive step. Claim 1 of this request reads:
- "1. A milk chocolate composition comprising greater than 40% natural milk solids by weight and other milk chocolate ingredients, wherein the milk chocolate composition contains a milk fat component of said milk solids that is not greater than 8% by weight of the composition, wherein the composition is prepared from ingredients comprising chocolate crumb in an amount of not greater than 70% by weight."
- IV. The following documents submitted during the opposition proceedings are relevant to the decision:
- 01 "Industrial Chocolate Manufacture and Use", S. T. Beckett (ed.), third edition, 1999, 342

O2 GB 2 369 985 A

- V. Together with its reply to the statement setting out the grounds of appeal, the patent proprietor (respondent) submitted document O9:

O9 EP 3 383 192 B1

- VI. The board summoned the parties to oral proceedings and issued a communication under Article 15(1) RPBA 2020 in which it set out its preliminary opinion.

- VII. Together with a letter dated 1 September 2022, the respondent filed an auxiliary request.

Claim 1 of the auxiliary request reads (amendments with respect to claim 1 of the request allowed by the opposition division are underlined):

"1. A milk chocolate composition comprising greater than 40% natural milk solids by weight and other milk chocolate ingredients, wherein the milk chocolate composition further comprises a) cocoa liquor; b) cocoa butter; and c) added sweetener in an amount of not greater than 38 wt% of the milk chocolate composition; wherein the milk chocolate composition contains a milk fat component of said milk solids that is not greater than 8% by weight of the composition, wherein the composition is prepared from ingredients comprising chocolate crumb in an amount of not greater than 70% by weight."

- VIII. Furthermore, the respondent submitted the following document O10 on 28 September 2022:

O10 "Industrial Chocolate Manufacture and Use", S. T. Beckett (ed.), fourth edition, 2009, pp. 2, 5, 101-120, 160, 161

IX. The appellant's arguments relevant to the decision may be summarised as follows:

Documents O9 and O10 should not be admitted into the proceedings. Likewise, the auxiliary request should not be admitted.

The subject-matter of claim 1 of the main request (auxiliary request 1 as held allowable by the opposition division) lacked novelty vis-à-vis document O2. As followed from paragraphs [0021] and [0031] of the patent, the scope of claim 1 was not limited to final, consumable milk chocolate compositions, but included chocolate crumb. Also the crumb compositions described on page 9 and in example 2 of O2 had been prepared from ingredients comprising no chocolate crumb. They thus fell within the scope of claim 1. The crumb of O2 was even consumable, as it had been tested by persons (second paragraph on page 11 of O2). The expression "prepared from ingredients" had to be interpreted with the broadest sensible meaning, and included any downstream processing steps (of the ingredients).

X. The respondent's arguments relevant to the decision may be summarised as follows:

The auxiliary request and document O10 should be admitted into the proceedings, as they had been filed in response to the preliminary opinion of the board, which unexpectedly contradicted the opinion of the opposition division on novelty and inventive step.

The subject-matter of claim 1 of the main request and of the auxiliary request was novel over O2. Claim 1 required that there be no more than 70 wt% of chocolate crumb being used to make the milk chocolate composition. Therefore it was distinguishable from a composition which consisted of pure crumb such as the intermediate crumb products of O2. The compositions of claim 1 could be distinguished from the chocolate crumb compositions of O2 by their different microstructures and flavours. The different flavours could be detected in taste testing of the respective compositions, as was supported by document O9. Even if 70 wt% of chocolate crumb was used (to prepare the milk chocolate composition), the flavours created by compounds formed in the Maillard reaction would not be present in the same quantities and thus not be as strong. A composition which was 100 wt% crumb in O2 would be distinguishable for a person skilled in the art from a composition containing 0-70 wt% of crumb. Such milk chocolate compositions as specified in claim 1 and containing 0-70 wt% of crumb were not directly and unambiguously disclosed in O2. By contrast, the intermediate products as described on page 9 and in example 2 of O2, i.e. pure crumb, would not be regarded as milk chocolate compositions by a skilled person. Such intermediate products could not be sold to consumers and were not consumable. As claim 1 explicitly required that no more than 70 wt% of chocolate crumb be used to make the milk chocolate composition, a composition which is 100 wt% chocolate crumb, such as disclosed in O2, did not fall within the scope of claim 1.

XI. Requests

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

The respondent requested that the appeal be dismissed or, alternatively, that the patent be maintained on the basis of the auxiliary request filed with the submission dated 1 September 2022.

Reasons for the Decision

1. Admittance of documents 09 and 010

1.1 The appellant requested that documents 09 and 010 not be admitted into the appeal proceedings.

1.2 The respondent submitted document 09 for the first time with its reply to the grounds of appeal to corroborate that (milk chocolate) compositions containing 70 wt% or less of chocolate crumb had less of the compounds which are associated with the flavour of crumb. Its filing therefore constitutes an amendment within the meaning of Article 12(4) RPBA 2020.

In the statement setting out the grounds of appeal, the appellant submitted that there was no evidence on file that the process feature in claim 1 established novelty over the prior art. This process feature requires that the composition be prepared from ingredients comprising chocolate crumb in an amount not greater than 70% by weight.

The board thus considers the filing of O9 a legitimate reaction to this issue raised in the statement of grounds of appeal. Admitting O9 is not detrimental to procedural economy and does not give rise to new issues either. The respondent's line of argument based on O9 is not complex, and the document addresses issues which led to the decision under appeal. Consequently, the board decided to admit this document into the appeal proceedings (Articles 12(4) and (6) RPBA 2020).

1.3 The respondent submitted document O10 with its reply to the communication of the board pursuant to Article 15(1) RPBA 2020, i.e. after notification of the summons to oral proceedings. The filing of O10 thus constitutes an amendment to the respondent's appeal case within the meaning of Article 13(2) RPBA 2020.

1.4 The respondent filed document O10 as a reaction to the board's preliminary written opinion that claim 1 was not novel over document O2, arguing that the board had thereby unexpectedly deviated from the opposition division's decision, which had considered claim 1 allowable.

However, in its statement of grounds of appeal the appellant had already submitted detailed arguments against novelty of claim 1 based on document O2, stating that it was not possible to determine whether or not a given milk chocolate composition had been prepared from chocolate crumb and that the specific conditions needed to obtain the claimed product had to be mentioned in the claim to confer novelty. Therefore the respondent could and should have filed O10 already together with the reply to the statement of grounds of appeal, in the context of its reference to the microstructure of pure crumb and of milk chocolate

compositions of claim 1 whereby it addressed the appellant's argument that the above-mentioned process feature in claim 1 did not confer novelty over O2.

- 1.5 Moreover, the mere fact that the board, in its communication pursuant to Article 15(1) RPBA 2020, came to a conclusion different from that of the opposition division cannot be considered *per se* an exceptional circumstance within the meaning of Article 13(2) RPBA 2020 (see Case Law of the Boards of Appeal, 10th edition 2022, Chapter V.A.4.5.8.b). The board did not introduce any new objection either, but rather considered the objection of lack of novelty over document O2, which was already in the proceedings, persuasive in its communication.

As to the respondent's argument that O10 was an excerpt taken from the same book as O1, the board notes that these two excerpts concern entirely different passages of this book.

In the absence of exceptional circumstances and cogent reasons provided by the respondent, the board decided not to take O10 into account (Article 13(2) RPBA 2020).

2. *Novelty (Article 54 EPC) - main request*

- 2.1 The arguments of the respondent in favour of novelty of the subject-matter of claim 1 centred around the question of whether pure (milk) chocolate crumb could be regarded as a milk chocolate composition within the meaning of claim 1. The respondent relied in this context on the teaching of document O9 and the argument that chocolate crumb was no complete chocolate but an intermediate product which consisted of sugar, cocoa mass (cocoa liquor) and milk mixed together and dried.

By contrast, additional ingredients and further processing were required to achieve a chocolate. A consumer would not like eating chocolate crumb itself, and it would not rapidly melt in the mouth at 37°C. A skilled person would know that chocolate crumb is actually not a milk chocolate and not a milk chocolate composition within the meaning of claim 1.

2.2 As to this point, the board observes that it is already apparent from the structure and content of the claims as held allowable by the opposition division that typical ingredients of a (finished) milk chocolate are merely optional features in claim 1. This is immediately clear in view of the wording of claim 6 (claim 7 as granted), stipulating that the other milk chocolate ingredients comprise *one or more* ingredients selected from cocoa butter, a sweetener and cocoa liquor.

2.3 Likewise, paragraph [0021] of the patent as granted (and as held allowable by the opposition division) mentions that other milk chocolate ingredients (other than natural milk solids) *can* include cocoa liquor, cocoa butter and sweetener. In the same way, paragraph [0031] of the patent sets out that, for commercial retail sale for purchase by a consumer, a *finished* milk chocolate composition product can weigh about 100 g. The board holds that it also follows from this passage of the description that not only finished milk chocolate compositions are encompassed by the scope of claim 1. The opposition division came to the analogous conclusion in points 3.2.1 and 3.2.2 that claim 1 of the then-main claim request (claims as granted) included pure chocolate crumb, as described in example 2 of O2.

2.4 Claim 1 includes embodiments wherein the composition is prepared from ingredients comprising chocolate crumb in an amount of 0 wt%.

2.5 Page 9 of O2 describes in the first full paragraph a chocolate crumb comprising approximately 65 wt% of skimmed milk powder as natural milk solids and less than 1 wt% of milk fat in the total composition (see corresponding remarks in point 3.2.1 and 3.2.2 of the appealed decision, which the board endorses). Similar relative amounts of skimmed milk powder and of milk fat are present in the crumb prepared in example 2 of O2, as also set out in the pertinent remarks in point 3.2.1 and 3.2.2 of the decision appealed. These chocolate crumbs are prepared from ingredients not containing any chocolate crumb, i.e. comprising chocolate crumb in an amount of 0 wt%.

2.6 The chocolate crumb compositions disclosed on page 9 and in example 2 of O2 are thus milk chocolate compositions within the meaning of claim 1, having all the features of claim 1. Therefore the subject-matter of claim 1 lacks novelty vis-à-vis document O2 and does not meet the requirement of Article 54(1) EPC.

3. *Admittance of the auxiliary request filed on 1 September 2022 (Article 13(2) RPBA 2020)*

3.1 The auxiliary claim request was submitted by the respondent, together with its reply to the communication pursuant to Article 15(1) RPBA 2020, after notification of the summons to oral proceedings before the board. Its submission thus constitutes an amendment within the meaning of Article 13(2) RPBA 2020 read in conjunction with Article 12(4) RPBA 2020.

- 3.2 The respondent argued that the filing of the auxiliary request had been occasioned by the surprising finding of the board that document O2 was novelty-damaging for the subject-matter of claim 1 held allowable by the opposition division. This line of events qualified as exceptional circumstances within the meaning of Article 13(2) RPBA 2020, justifying the filing of the auxiliary request and its admission into the proceedings.
- 3.3 As to this argument, the board observes that the fact that, in its communication pursuant to Article 15(1) RPBA 2020, the board came to a different conclusion from the opposition division cannot be considered an exceptional circumstance within the meaning of Article 13(2) RPBA 2020 for the reasons already set out for the non-admittance of document O10 above.
- 3.4 Moreover, the board agrees with the appellant's assessment that admittance of this request would also be detrimental to procedural economy. The amendment made in the auxiliary request is based on the description as originally filed (see page 3, lines 19 to 23 of the PCT publication) and did not form part of the granted claims. The amendment is thus under scrutiny regarding the meeting of the requirements of Article 84 EPC. Whereas claim 5 as granted called for "[a] sweetener in an amount of not greater than 38% by weight of the resulting milk chocolate composition", claim 1 of the auxiliary request recites "[...] and c) *added* sweetener in an amount of not greater than 38 wt% of the milk chocolate composition" (emphasis added by the board). The board concurs with the appellant that it is impossible to establish for a given milk chocolate composition whether the sweetener(s) present in the composition have been added or already formed part of the crumb used, let alone how it could be

determined whether the total amount of a sweetener present (such as lactose) includes greater than 38 wt% of the milk chocolate of the added sweetener, i.e. sweetener that has been added as an "ingredient" and not as part of another component. The board thus shares the view of the appellant that the subject-matter of claim 1 of the auxiliary request, *prima facie*, gives rise to new issues, namely to an objection under Article 84 EPC. Admitting the request would thus also be detrimental to procedural economy.

- 3.5 The board thus did not take the auxiliary request into account (Article 13(2) RPBA 2020).

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:



M. Schalow

A. Haderlein

Decision electronically authenticated