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**Datasheet for the decision
of 14 July 2022**

Case Number: T 0498/21 - 3.3.09

Application Number: 12726541.1

Publication Number: 2713764

IPC: A23G3/00, A23G3/26

Language of the proceedings: EN

Title of invention:

SYSTEM AND METHOD FOR CONTINUOUSLY COATING CONFECTIONARY
PRODUCT

Patent Proprietor:

Intercontinental Great Brands LLC

Opponent:

Mars, Incorporated

Headword:

Continuously coating confectionary product/INTERCONTINENTAL
GREAT BRANDS

Relevant legal provisions:

EPC R. 99(1)(c), 99(2)

EPC Art. 123(2)

RPBA 2020 Art. 12(2), 12(3), 12(4), 12(5), 12(6)

Keyword:

Admissibility of appeal (yes)

Amendment within meaning of Art. 12(4) RPBA 2020 (yes)

Claim request should have been submitted in first-instance proceedings (no)

Amendments - extension beyond the content of the application as filed (no) - general technical teaching in the description (yes)

Decisions cited:

G 0002/10, T 1777/14

Catchword:



Beschwerdekammern

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Case Number: T 0498/21 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 14 July 2022

Appellant: Intercontinental Great Brands LLC
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 23 February
2021 revoking European patent No. 2713764
pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chair A. Haderlein
Members: N. Obrovski
M. Ansorge

Summary of Facts and Submissions

- I. The appeal was filed by the patent proprietor (appellant) against the decision of the Opposition Division to revoke the patent. In this decision, claim 1 of the then pending main request was deemed to contain added subject-matter under Article 123(2) EPC.
- II. The appellant requested that the decision under appeal be set aside and that the case be remitted to the Opposition Division for consideration of novelty and inventive step on the basis of the main request as specified in their statement of grounds of appeal and attached to their submission dated 7 September 2021.
- III. The respondent (opponent) requested that the appeal be rejected as inadmissible or dismissed.
- IV. Claim 1 of the main request corresponds to claim 1 of the main request underlying the impugned decision and reads (labelling of the features by the Board, reference signs deleted):
 - a) A system for continuously coating individual pieces of confectionary product, the system comprising:
 - b) a product feed device;
 - c) at least one drum coating arrangement configured to receive the individual pieces of confectionary product from said product feed device,
 - d) said drum coating arrangement including a first rotating drum rotatable about a first drum axis and a second rotating drum rotatable about a second drum axis;
 - e) a first drum volume defined by said first rotating drum; and a second drum volume defined by said second

rotating drum, said first drum volume being communicable with said second drum volume,
f) wherein said first rotating drum is configured to apply a liquid material to the individual pieces of confectionery product and said second rotating drum is configured to apply a dry powder material to the individual pieces of confectionery product;
g) wherein said drum coating arrangement is configured such that the confectionery product has a longer residence time in said second drum volume than said first drum volume;
h) and wherein said first drum and said second drum are independently inclinable.

V. Claim 3 of the main request corresponds to claim 3 of the main request underlying the impugned decision, with the exception of the deletion of the following feature:

"- or wherein said first rotating drum is affixed to said second rotating drum via a locking mechanism contacting an outer surface of each of said first rotating drum and said second rotating drum."

VI. The PCT application was filed with the USPTO as the Receiving Office. Claims 3 and 21 of the PCT application contain features f) and h) respectively, but, as both of these claims refer back to independent claim 1 only (i.e. without any multiple dependencies), not in combination. In the oral proceedings before the Board, the parties mainly argued on whether the combination of features f) and h) was directly and unambiguously disclosed in paragraph [0007] and claim 21 as originally filed. Their arguments relevant for the decision are set out in further detail below.

Reasons for the Decision

1. Admissibility of the appeal - Rule 99(1)(c) and (2) EPC

1.1 In their statement of grounds of appeal, the appellant stated the following:

"For the avoidance of doubt, the Main Request is the same as the Main Request filed during the Opposition oral proceedings, with the exception of the deletion of the last optional feature of claim 3, i.e. the feature of the 'first rotating drum is affixed to said second rotating drum via a locking mechanism contacting an outer surface of each of said first rotating drum and said second rotating drum', has been deleted."

1.2 The respondent was of the view that the appeal did not meet the requirements of Rule 99(1)(c) and (2) EPC. They argued that, in view of the above statement and in the absence of a copy of the amended main request attached to the statement of grounds of appeal, the wording of the notice of appeal was undermined such that it did not contain a clear request defining the subject of the appeal. The respondent further stated that the phrase "with the exception of the deletion of the last optional feature of claim 3 [...] has been deleted" contained a double negation and implied that a feature in claim 3 of the main request on file before the Opposition Division had been reinserted upon appeal. It was therefore not clear to what extent the appellant sought amendment of the decision impugned.

1.3 The Board does not share the respondent's view. Firstly, the requirement under Rule 99(1)(c) EPC is met where the notice of appeal states, as in this case, "we

hereby appeal" against the decision impugned (see T 1777/14, Reasons 1.2).

1.4 Secondly, the requirement under Rule 99(2) EPC is met where the appellant indicates, as in this case, the extent to which the decision impugned is to be amended in their statement of grounds of appeal.

1.4.1 The appellant's statement that the main request on appeal "is the same as the Main Request filed during the Opposition oral proceedings, with the exception of the deletion of the last optional feature of claim 3" means that the only difference to the main request underlying the impugned decision consists in the deletion of that feature.

1.4.2 This is confirmed in the subclause after the comma, which begins with "i.e." (= "meaning"). In the respondent's excerpt as reproduced above, both the first comma and the "i.e." have been omitted, which could give the erroneous impression that the phrase "the deletion" and the phrase "has been deleted" belong to the same clause. The latter phrase, however, belongs to an explanatory subclause, the start of which is indicated by the first comma and "i.e.". While the second comma in the appellant's statement is arguably superfluous, its presence does not prevent the reader from immediately understanding the statement in the correct manner. The deleted feature is also reproduced verbatim in the statement of grounds of appeal and can thus be identified without doubt.

1.5 It follows that the appeal is admissible.

2. Admittance of the main request - Articles 12(2) to (6) RPBA 2020

2.1 The admittance of claim requests under the RPBA 2020 is to be assessed separately from the admissibility of an appeal under Article 108 and Rule 99 EPC.

2.2 The respondent argued that the main request should not be admitted into the appeal proceedings under Articles 12(2) to (6) RPBA 2020 because:

- it had not been specified expressly as required by Article 12(3) RPBA 2020
- it constituted an amendment under Article 12(4) RPBA 2020 not justified by the appellant
- it should have been submitted during the opposition proceedings in accordance with Article 12(6) RPBA 2020

2.3 Under Article 12(3) RPBA 2020, the statement of grounds of appeal must contain a party's complete case and, *inter alia*, expressly specify all the requests relied on. As stated above in the context of the admissibility of the appeal, the main request was expressly specified in the statement of grounds of appeal. Although the main request is not "a document referred to" within the meaning of Article 12(3)(a) RPBA 2020, the appellant could have indeed additionally attached the main request as an annex to their statement of grounds of appeal. However, even in the absence of such an annex, the main request was expressly specified. Therefore, the requirements under Article 12(3) RPBA have been met.

2.4 Under Article 12(2) RPBA 2020, a party's appeal case must, *inter alia*, be directed to the requests on which the decision under appeal was based. As the main

request differs from the main request underlying the impugned decision and was not raised in the opposition proceedings, it constitutes an amendment under Article 12(4) RPBA 2020. Its admittance is thus subject to the Board's discretion.

- 2.4.1 Under Article 12(4) RPBA 2020, a party must, *inter alia*, provide reasons why an amendment within the meaning of this provision overcomes the objections raised. The appellant did not provide such reasons. However, in point 4.3.4 of the decision under appeal, the Opposition Division stated "that some embodiments are not compatible, such as the independent inclinability of the drums as now claimed in claim 1 of the main request with regard to claim 3, which claims that the first drum is affixed to the second rotating drum".
- 2.4.2 The amendment consists in the deletion of the optional feature in claim 3 objected to by the Opposition Division and thus directly addresses this objection. It is self-evident why the amendment overcomes the Opposition Division's objection and why it was not necessary to indicate the basis for this amendment in the application as filed. Under such circumstances, the lack of an express justification for the amendment does not weigh heavily against the appellant. Moreover, the amendment neither is complex, creates a fresh case nor shifts the discussion. It is thus not detrimental to procedural economy.
- 2.5 Under Article 12(6) RPBA 2020, requests which should have been submitted in the proceedings leading to the decision under appeal are not to be admitted unless the circumstances of the appeal case justify their admittance.

- 2.5.1 During the oral proceedings before the Opposition Division, the opponent raised an objection under Article 83 and/or 84 EPC that the independent inclinability of the two drums in claim 1 of the then pending main request was not compatible with the locking mechanism for these two drums in claim 3 (minutes, points 7 and 8), as well as an objection under Article 123(2) EPC (minutes, point 8). After having been informed of the Opposition Division's negative conclusion on the objection under Article 123(2) EPC on claim 1 in the late afternoon of the oral proceedings before the Opposition Division (minutes, point 8, penultimate paragraph), the appellant did not immediately file an amended claim request during the oral proceedings (minutes, point 8, last paragraph). The objection related to the alleged incompatibility between claims 1 and 3 was seemingly only taken up by the Opposition Division in the impugned decision (see point 4.3.4 of that decision).
- 2.5.2 Under these circumstances, the Board does not consider that the appellant should have submitted a claim request addressing the objection related to the alleged incompatibility between claims 1 and 3 already during the oral proceedings before the Opposition Division.
- 2.6 In view of the above, the Board exercised its discretion under Articles 12(4) to (6) RPBA 2020 to admit the main request into the appeal proceedings.

3. Amendments - Article 123(2) EPC

- 3.1 The impugned decision found that in claim 1 the combination of feature f) (the first drum being configured to apply a liquid material and the second drum being configured to apply a dry powder material) and feature h) (the two drums being independently inclinable) was not directly and unambiguously disclosed. The Opposition Division held that there was no direct pointer to this claimed combination of features.
- 3.2 Under Article 123(2) EPC, the European patent application or the European patent may not be amended to contain subject-matter which extends beyond the content of the application as filed. The "gold standard" (G 2/10, OJ 2012, 376) for assessing compliance with Article 123(2) EPC is the following: any amendment to the parts of a European patent application or European patent relating to the disclosure (the description, claims and drawings) is subject to the mandatory prohibition on extension laid down in Article 123(2) EPC and can therefore, irrespective of the context of the amendment made, only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed. After the amendment, the skilled person may not be presented with new technical information (Case Law of the Boards of Appeal, 9th edition 2019, II.E.1.1.)
- 3.3 Claim 1 of the main request (see point 2.3 above) differs from claim 21 of the original application in that:

- feature f) has been added
- in feature h), the word "rotating" has been deleted ("wherein said first ~~rotating~~ drum and said second ~~rotating~~ drum are independently inclinable")

- 3.4 Considering the application as filed as a whole under the gold standard, these amendments do not present the skilled person with new technical information.
- 3.5 Feature f) is disclosed in paragraph [0007] of the application as filed, which states that the application of a soft pre-coating "may involve applying a liquid material in one drum and a powder material in a second drum" and that "in such a process, it may be desirable to have a longer residence time in the second drum so that the powder material has sufficient time to bind to the liquid material".
- 3.6 There is nothing in the application as filed to suggest that the technical teaching disclosed in paragraph [0007] can be linked only to certain embodiments of the invention. To the contrary, the embodiments confirm the general nature of this teaching.
- 3.6.1 Paragraph [0029] states that "a liquid material 49 is desirably chosen for feed into the first drum volume 40", and paragraph [0033] states that "any conventional dry powder material 66 is desirably chosen for feed into the second drum volume 42" and further that "it is important that the pieces 12 include a relatively longer residence time so that the powder material 66 may have sufficient time to bind to the liquid material 49 that has been applied to the pieces 12". Paragraph [0034] states that "the powder material 66 binds to the liquid material 49 (from the first drum 18) that already coats the surface of the pieces 12". In

paragraph [0038], "exemplary compositions of the liquid material 49 and powder material 66" are given.

- 3.6.2 Figure 6 also shows the liquid material 49 as the first material to be applied and the powder material 66 as the second material to be applied.
- 3.6.3 Moreover, originally filed claim 3 also discloses that the first rotating drum is configured to apply a liquid material and that the second rotating drum is configured to apply a dry powder material.
- 3.6.4 Correspondingly, neither the claims, the description nor the drawings as originally filed contain any indication that anything other than a liquid material should in some instances be used as the first material to be applied or that anything other than a powder material should in some instances be used as the second material.
- 3.6.5 It follows from the above that the technical teaching in paragraph [0007] on feature f) is of a general nature which may be combined with the features of claim 21 as originally filed.
- 3.7 The mere fact that the technical teaching in paragraph [0007] on feature f) is part of the section in the application called "background" does not alter this assessment. The respondent alleged in this context that this teaching referred to prior art. However, the technical teaching in paragraph [0007] on feature f) does not relate to prior art but rather to the problem the invention seeks to solve. It is therefore part of the teaching on the invention.

3.8 In the oral proceedings before the Board, the respondent further argued that:

- the teaching in paragraph [0007] relating to feature f) was not generally applicable but instead was one of several equally possible optional features as expressed in the dependent claims
- the teaching in paragraph [0007] was only disclosed for chewy candy cores and that its combination with claim 21 as originally filed (concerning a system for coating pieces of any confectionary product) constituted an unallowable intermediate generalisation
- paragraph [0007] did not link the different residence times in the two drum volumes exclusively to the application of a liquid material and a powder material as other material options such as two liquids were also available

3.8.1 The Board does not consider these arguments convincing. Firstly, as pointed out above (see point 3.6), there is nothing to suggest that the technical teaching disclosed in paragraph [0007] can be linked only to certain embodiments of the invention. Moreover, the application as filed does not contain any indication that anything other than a liquid material should in some instances be used as the first material to be applied or that anything other than a powder material should in some instances be used as the second material. Contrary to the respondent's allegation, the application of liquid and powder does not therefore have an "equal status" with all the other possible options.

3.8.2 Secondly, as pointed out by the appellant, the statement in paragraph [0007] referring to chewy candy cores begins with "For instance, certain confectionery

cores, such as chewy candy cores, [...]". Chewy candy cores are thus only given as an example in this paragraph, this not limiting the general technical teaching. Moreover, leaving aside that claim 1 is not directed to a method but to a system, it is technically not persuasive that the application of liquid and powder in a coating system is inextricably linked to chewy candy cores being coated.

3.8.3 Thirdly, even if paragraph [0007] contained equally optional teachings on the application of a liquid as the first material and a powder as the second material as well as the application of two liquids, it would not follow that the combination of only one of these equally optional teachings (i.e. the application of a liquid and a powder) with claim 21 as originally filed would present the skilled person with new technical information.

3.9 As to feature h), the omission of the word "rotating" does not present the skilled person with any new technical information either. It is evident from features d), e) and f) of claim 1 that the first drum and the second drum referred to in feature h) ("said") are rotating drums.

3.10 In conclusion, claim 1 of the main request does not contain subject-matter which extends beyond the content of the application as filed.

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.

The Registrar:

The Chair:



A. Nielsen-Hannerup

A. Haderlein

Decision electronically authenticated