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**Datasheet for the decision
of 28 June 2023**

Case Number: T 0111/22 - 3.3.09

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Language of the proceedings: EN

Title of invention:

Carbohydrate composition and flat glucose response

Patent Proprietor:

N.V. Nutricia

Opponent:

Société des Produits Nestlé S.A.

Headword:

Carbohydrate composition/NESTLÉ

Relevant legal provisions:

EPC Art. 123(2), 123(3)

Keyword:

Claim interpretation in light of the description
Main request and auxiliary requests 1 to 7: Added matter -
(yes)
Auxiliary requests 8 to 11: Extension of the scope of
protection - (yes)
Amendments - inescapable trap (yes)

Decisions cited:

T 1172/08, T 1646/12, T 0073/19, T 1473/19, T 0169/20,
T 0450/20

Catchword:



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 0111/22 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 28 June 2023

Appellant: N.V. Nutricia
(Patent Proprietor) Eerste Stationsstraat 186
2712 HM Zoetermeer (NL)

Representative: Nederlandsch Octrooibureau
P.O. Box 29720
2502 LS The Hague (NL)

Respondent: 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)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 19 October 2021
revoking European patent No. 1832179 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman A. Haderlein
Members: A. Veronese
N. Obrovski

Summary of Facts and Submissions

- I. The decision concerns the appeal filed by the patent proprietor (appellant) against the decision of the opposition division revoking the European patent.
- II. With its notice of opposition, the opponent (respondent) had requested revocation of the patent in its entirety on, *inter alia*, the grounds under Article 100(c) EPC.
- III. The decision of the opposition division is based on a main request, the patent as granted, auxiliary requests 1 to 7 filed by letter dated 20 December 2019 and auxiliary requests 8 to 11, filed by letter dated 11 August 2021.
- IV. Claim 1 of the granted patent reads:
- "1. A low-glycemic available carbohydrate composition containing the following components:*
- (i) 5-60 wt.% of one or more monosaccharides selected from monosaccharides other than glucose and fructose, in particular galactose, ribose and mannose;*
- (ii) 15-75 wt.% of oligosaccharides having a length of 2 to 20 anhydromonose units, at least half of which are anhydroglucose units linked at their α 1-position to the 1-, 3-, 5- or 6-position of another anhydromonose unit, wherein component (ii) comprises 10-45 wt.% of palatinose; and*
- (iii) 0-45 wt.% of other available carbohydrates."*
- V. Claim 1 of auxiliary requests 1 to 7 differ from claim 1 of the main request, in particular in that

component (ii) "consists of" rather than "comprises" 10-45 wt.% of palatinose, in that it "consists of" or "comprises" 15-45 wt.% palatinose or in that the amount of component (ii) is 18-50 wt.% of the composition.

VI. Claim 1 of auxiliary request 8 reads:

"1. A low-glycemic available carbohydrate composition containing the following components:

(i) 5-60 wt.% of one or more monosaccharides selected from monosaccharides other than glucose and fructose, in particular galactose, ribose and mannose;

(ii) 15-75 wt.% of oligosaccharides having a length of 2 to 20 anhydromonose units, at least half of which are anhydroglucose units linked at their α 1-position to the 1-, 3-, 5- or 6-position of another anhydromonose unit, ~~wherein component (ii) comprises of~~ which 10-45 wt.% - based on the available carbohydrate composition - consists of palatinose; and

(iii) 0-45 wt.% of other available carbohydrates."

(With emphasis by the board to identify deletions and insertions compared to claim 1 as granted)

VII. Claim 1 of auxiliary requests 9 to 11 has the same wording as claim 1 of auxiliary request 8 and differs from it in that the range 10 to 45 wt.% was replaced by 15-45 wt.% and/or in that the range 15-75 wt.% was replaced by 18-50 wt.%.

VIII. In its decision, the opposition division held, *inter alia*, that:

- claim 1 of the main request and auxiliary requests 1 to 9 contained added subject-matter, contrary to the requirements of Article 123(2) EPC

- claim 1 of auxiliary requests 10 and 11 extended the scope of protection beyond that conferred by the patent as granted, contrary to the requirements of Article 123(3) EPC

IX. As far as relevant to the present decision, the **appellant's** arguments may be summarised as follows.

- Claim 1 of the main request did not create new subject-matter. The feature "wherein component (ii) comprises 10-45 wt.% of palatinose" was disclosed on page 5 of the original application as filed.
- Claim 1 was unclear on how to calculate the range 10-45 wt.% of palatinose. Thus, the description had to be used for interpretation. In the description, this amount was calculated referring to the total amount of available carbohydrates. This was evident from page 5, lines 15 to 20 of the description as filed. This passage had to be relied on to interpret claim 1 and provided the basis for this claim. The same arguments applied to the auxiliary requests.
- Claim 1 of auxiliary requests 8 to 11, in which the amount 10-45 wt.% of palatinose was explicitly calculated on the basis of the available carbohydrates in the composition, did not extend the scope of protection. Article 69(1) EPC required paragraph [0021] of the patent, in which the amount of palatinose was calculated in this manner, to be taken into account to determine the scope of protection conferred by the granted claims.

X. As far as relevant to the present decision, the **respondent's** arguments may be summarised as follows.

- Claim 1 of the main request and auxiliary requests 1 to 7 was clear. It required the range 10-45 wt.% of palatinose to be calculated on the basis of the amount of component (ii), not the entire available carbohydrate. Since there was no basis for a range as defined in claim 1 in the application as filed, this claim contained originally undisclosed subject-matter.
- Claim 1 of auxiliary requests 8 to 10 extended the scope of protection beyond that conferred by the granted claims. Since claim 1 as granted was clear, the description could not be relied on to calculate the amount of palatinose on the basis of the available carbohydrate in the composition. There was broad consensus in the case law that the description could not be relied on to give a different interpretation to a clear claim.

The requests

XI. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request - the patent as granted - or, in the alternative, on the basis of auxiliary requests 1 to 7, as filed by letter dated 20 December 2019 or, in the alternative, on the basis of auxiliary requests 8 to 11, as filed by letter dated 11 August 2021.

XII. The respondent requested that the appeal be dismissed.

Reasons for the Decision

Main request

1. Amendments (Article 100(c) EPC)

1.1 The appellant disputed the opposition division's finding that claim 1 contains subject-matter extending beyond the content of the application as filed. The appellant submitted that contrary to the opposition division's finding, the addition to claim 1 of the feature "wherein component (ii) comprises 10-45 wt.% of palatinose" did not create originally undisclosed subject-matter.

1.2 The appellant did not dispute that the application as filed did not explicitly disclose this feature. It argued, however, that claim 1 had to be interpreted correctly for determining whether it contained new subject-matter. It submitted that claim 1 was unclear because the amount of 10-45 wt.% of palatinose could be calculated in two different manners, namely:

(a) referring to the amount of component (ii)

(b) referring to the amount of "available carbohydrates composition", *i.e.* to the total amount of available carbohydrates in the claimed composition

1.3 In its opinion, both interpretations were possible. None could be ruled out as not making technical sense. Therefore, in line with established EPO case law, the skilled person had to look to the description to arrive at a feasible interpretation of the claim.

- 1.4 In the description, the amount of components (i) to (iii) was calculated referring to the "available carbohydrate composition", *i.e.* the total amount of available carbohydrates in the composition. The amount of palatinose was also calculated on this basis in paragraph [0021] of the opposed patent and on page 5, lines 15 to 19 of the application as filed.
- 1.5 Therefore, according to the appellant, the skilled person would have interpreted claim 1 as granted calculating the 10-45 wt.% of palatinose on the basis of the "available carbohydrates composition" and not on the basis of the amount of component (ii).
- 1.6 Page 5, lines 15 to 19 of the application as filed provided the basis for claim 1 as granted interpreted in this manner. Hence, the requirements of Article 123(2) EPC were fulfilled.
- 1.7 These arguments are not convincing.
- 1.8 Under established case law, patent claims must be interpreted through the eyes of the person skilled in the art, who should try with synthetic propensity to arrive at an interpretation which is technically sensible and takes into account the whole disclosure of the patent. In other words, the claims must be interpreted in their context, also taking into account any teaching in the description or the drawings (see "Case Law of the Boards of Appeal", 10th edn. 2022, section II.A.6.1, first paragraph and T 1646/12, Reasons 2.1).
- 1.9 However, the extent to which the meaning of a claimed feature may be affected by the description and/or the drawings is limited. There is a consensus within the

boards about the primacy of the claims in claim interpretation (see T 1473/19 (Reasons 3.16.2), T 73/19, (Reasons 2.2) and T 169/20 (Reasons 1.3.4)). This means that in case of a clear conflict between the claims and the description, the claims take precedence. In other words, if a person skilled in the art understands a claim in a certain manner without doubt, taking into account the rules of grammar, the ordinary meaning of the terms used and common general knowledge, this understanding usually takes precedence over an incidental and conflicting statement in the description, in particular if that statement is only made in the context of an alleged embodiment.

1.10 In the current case, the requirement in claim 1 that the composition contain a component (ii) "wherein component (ii) comprises 10-45 wt.% of palatinose" can only be understood so that it is component (ii) - and not the entire amount of carbohydrate in the composition - which comprises 10-45 wt.% of palatinose. This means that the amount of palatinose is calculated on the basis of the amount of component (ii) in the composition and not on the basis of the total amount of carbohydrates in the composition.

1.11 This interpretation corresponds to the unambiguous wording of claim 1 and is "technically sensible". Furthermore, as noted by the respondent, paragraph [13] of the granted patent requires that "component (ii) comprises 10-45 wt.% of palatinose". This paragraph of the description is therefore fully in line with claim 1 of the granted patent as interpreted by the board. Overall, there are thus no reasons to adopt a different claim interpretation based on the preferred embodiment described in paragraph [0021] of the description.

- 1.12 For these reasons, it is concluded that there are no reasons to interpret claim 1 as granted according to interpretation (b) referred to in point 1.2 above.
- 1.13 It was common ground between the parties that in the application as filed the amount of the components making up the claimed carbohydrate composition, including palatinose, is calculated on the basis of the "available carbohydrate composition". This expression is used consistently in the different sections of the application as filed defining these amounts (see page 5, lines 16 to 22 and 35; page 6, line 22 to 24; page 7, lines 10 to 16; page 8, line 34). "Available carbohydrates" are the carbohydrates present in the composition and digested in the intestinal tract (page 3, lines 27 to 29).
- 1.14 Furthermore, it was common ground that in the application as filed the amount of 15-45 wt.% palatinose mentioned on page 5, lines 17 to 19 as filed is also calculated on the basis of the total amount of available carbohydrates in the composition and not on the basis of the amount of component (ii).
- 1.15 Therefore, the passage on page 5, lines 17 to 19 as filed does not disclose the subject-matter of amended claim 1, which, as established above, requires the amount of palatinose to be 10-45 wt.% of component (ii).
- 1.16 Since no basis for the amendment can be found in the application, claim 1 contains subject-matter extending beyond the content of the application as originally filed. Thus, the ground for opposition pursuant to Article 100(c) EPC prejudices the maintenance of the patent as granted.

Auxiliary request 1

2. *Amendments (Article 123(2) EPC)*

2.1 Claim 1 of auxiliary request 1 defines a composition comprising 15-75 wt.% of component (ii) "of which 10-45 wt.% consists of palatinose". Despite the difference in wording, claim 1 requires, like claim 1 of the main request, the amount of palatinose to be calculated on the basis of the amount of component (ii). Therefore, the conclusions drawn above when dealing with the main request apply *mutatis mutandis* to auxiliary request 1. This request therefore does not comply with Article 123(2) EPC.

Auxiliary requests 2 to 7

3. *Amendments (Article 123(2) EPC)*

3.1 Claim 1 of auxiliary requests 2, 4 and 6 is formulated using the same wording used in claim 1 of the main request. Claim 1 of auxiliary requests 3, 5 and 7 is formulated using the same wording used in claim 1 of auxiliary request 1. The only difference in these claims is that narrower ranges are used to define the amount of component (ii) and/or of palatinose.

3.2 Despite these difference, the wording used in the claims of these auxiliary requests results in originally undisclosed subject-matter being claimed for the same reasons discussed when dealing with the main request and auxiliary request 1.

Auxiliary request 8 to 11

4. *Extension of scope of protection (Article 123(3) EPC)*
- 4.1 Claim 1 of auxiliary request 8 requires that 15-45 wt.% of component (ii), based on the available carbohydrate composition, consists of palatinose.
- 4.2 The question is whether this definition of the claimed composition extends the scope of protection beyond that conferred by the claims of the patent as granted (Article 123(3) EPC).
- 4.3 As established above when dealing with the main request, claim 1 as granted defines a composition comprising an amount of palatinose which is 10-45 wt.% of the amount - namely 15-75 wt.% - of the component (ii) in the carbohydrate composition. This means that, according to claim 1 as granted, palatinose can be comprised in an amount of:
- from a minimum of 1.5 wt.% of the available carbohydrate composition (10 wt.% of 15 wt.%)
 - to a maximum of 33.75 wt.% of the available carbohydrate composition (45 wt.% of 75 wt.%)
- 4.4 Conversely, in claim 1 of auxiliary request 8, the amount of palatinose, calculated on the basis of the available carbohydrate composition, can vary from 10 to 45 wt.%.
- 4.5 The lower limit of 10 wt.% in claim 1 of auxiliary request 8 falls within the range specified in claim 1 as granted. However, the upper limit of up to 45 wt.% does not. As a consequence, with regard to the upper

limit, claim 1 of auxiliary request 8 encompasses compositions having an amount of palatinose higher than that, 33.75 wt.%, which is allowed by claim 1 as granted. These compositions do not fall within the scope of claim 1 as granted.

- 4.6 The appellant argued that, nevertheless, by virtue of Article 69 EPC, the scope of protection of claim 1 as granted extended to these compositions. It noted that paragraph [0021] of the granted patent defined the amount of palatinose on the basis of the available carbohydrate composition. This paragraph had to be taken into account to determine the scope of the granted claims and the scope of protection of the granted patent.
- 4.7 Furthermore, in its opinion, the wording of claim 1 of auxiliary request 8 merely removed an inconsistency in the granted claim and reinstated its correct meaning, which was that given in paragraph [0021]. Thus, in its opinion, claim 1 of auxiliary request 7 did not violate Article 123(3) EPC.
- 4.8 These arguments are not persuasive.
- 4.9 Article 69 EPC reads: "The extent of the protection conferred by a European patent shall be determined by the claims. Nevertheless, the description and drawings shall be used to interpret the claims."
- 4.10 However, Article 69(1), second sentence, EPC cannot be relied upon for replacing a claim feature with a different one which can only be found in the description (see T 450/20, Reasons 2.15). Reading the statement in paragraph [0021] into the clear wording of claim 1 as granted to establish compliance with

Article 123(3) EPC would have the consequence that the wording of this claim merely serves as an empty shell (see "Case Law of the Boards of Appeal", 10th edn., 2022, section II.E.2.3.1(c), in particular T 1172/08, Reasons 14 cited there).

- 4.11 This would undermine the principle stipulated in the first sentence of Article 69(1) EPC and reiterated in decision T 1473/19 (Reasons 3.16.2) that the claims have primacy for determining the extent of protection conferred by the European patent. In the board's view, it would also be at odds with providing a reasonable degree of legal certainty for third parties as required by Article 1 of the Protocol on the interpretation of Article 69 EPC.
- 4.12 Furthermore, as mentioned above when dealing with the main request, paragraph [13] of the granted patent requires, like claim 1 as granted, that "component (ii) comprises 10-45 wt.% of palatinose". This paragraph is therefore fully in line with the wording of claim 1 of the granted patent.
- 4.13 For these reasons, it is concluded that claim 1 of auxiliary request 8 extends the scope of the protection beyond that conferred by the patent as granted (Article 123(3) EPC).
- 4.14 Since claim 1 of auxiliary requests 9 to 11 requires, like claim 1 of auxiliary request 8, that 15-45 wt.% of component (ii), based on the available carbohydrate composition, consist of palatinose, the same conclusions apply to these auxiliary requests.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. Schalow

A. Haderlein

Decision electronically authenticated