

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [-] To Chairmen
- (D) [X] No distribution

**Datasheet for the decision
of 22 July 2024**

Case Number: T 1627/22 - 3.3.09

Application Number: 15839068.2

Publication Number: 3397067

IPC: A23L2/66, A23J3/08, A23L29/25,
A23L33/19

Language of the proceedings: EN

Title of invention:
COMPOSITIONS COMPRISING WHEY PROTEIN AND GUM ARABIC

Patent Proprietor:
Compagnie Gervais Danone

Opponent:
Société des Produits Nestlé S.A.

Headword:
Compositions/GERVAIS DANONE

Relevant legal provisions:
RPBA 2020 Art. 13(2)
EPC Art. 56, 83, 100(a), 100(b)

Keyword:

Amendment after summons - exceptional circumstances (no)

Inventive step - (yes)

Sufficiency of disclosure - (yes)

Decisions cited:

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 1627/22 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 22 July 2024

Appellant: Compagnie Gervais Danone
(Patent Proprietor) 17, Boulevard Haussmann
75009 Paris (FR)

Representative: Regimbeau
20, rue de Chazelles
75847 Paris Cedex 17 (FR)

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)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
11 April 2022 concerning maintenance of the
European Patent No. 3397067 in amended form.**

Composition of the Board:

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

Summary of Facts and Submissions

- I. The proprietor and the opponent both lodged appeals against the opposition division's interlocutory decision holding the then auxiliary request 2 allowable.
- II. With its notice of opposition, the opponent had requested that the patent be revoked on the grounds for opposition under Article 100(a) EPC (lack of novelty and lack of inventive step) and Article 100(b) EPC.
- III. The opposition division decided that documents D5a and D9 were admitted into the opposition proceedings, the invention could be carried out (Article 83 EPC), the subject-matter of claim 1 of the patent as granted (main request) lacked novelty over D5a and the subject-matter of claim 1 of the then auxiliary request 1 lacked an inventive step in view of D3 as the closest prior art. The opposition division further decided that the then auxiliary request 2 was allowable. In particular, it concluded that the subject-matter claimed in auxiliary request 2 involved an inventive step in view of D3 as the closest prior art.
- IV. With its statement setting out the grounds of appeal, the proprietor filed a main request and 24 auxiliary requests. At the oral proceedings before the board, it withdrew the main request and auxiliary requests 1 to 3.
- V. Independent product claims 1 and 2 of auxiliary request 4 read as follows (differences compared with claim 1 of the patent as granted are indicated by underlining):

"1. An aqueous composition comprising:

- water,
- native starch,
- at least 8.0% by weight of whey protein, and
- at least 2.0% by weight of Gum Arabic,

wherein:

- the pH is of from 5.0 to 9.0, and
- the weight ratio GA/WP between Gum Arabic and whey protein is higher than 0.25 and lower than 1.00, wherein the whey protein is at least partly solubilized in the water, optionally in the form of at least partially solubilized complex."

"2. An aqueous composition comprising:

- water,
- a calcium complexing agent, preferably trisodium phosphate,
- at least 8.0% by weight of whey protein, and
- at least 2.0% by weight of Gum Arabic,

wherein:

- the pH is of from 5.0 to 9.0, and
- the weight ratio GA/WP between Gum Arabic and whey protein is higher than 0.25 and lower than 1.00, wherein the whey protein is at least partly solubilized in the water, optionally in the form of at least partially solubilized complex."

Claims 3 to 11 are dependent product claims, and claims 12 to 15 are process claims directly or indirectly dependent on the product claims.

The wording of auxiliary requests 5 to 24 is not relevant to the present decision.

VI. The following documents were cited in the case in hand:

D1: WO 2013/095131 A1

D3: WO 2009/011573 A1

D5a: F. Weinbreck et al., "Complex Coacervation of Whey Proteins and Gum Arabic", *Biomacromolecules* 2003, 4, 293-303

D9: Experimental report submitted by the opponent

VII. The parties' relevant arguments submitted during the written proceedings and the oral proceedings are reflected in the reasons for the decision below.

VIII. Requests

The proprietor requested that the decision be set aside and that the patent be maintained on the basis of one of auxiliary requests 4 to 24, filed with its statement of grounds of appeal.

The opponent requested that the decision be set aside and the patent be revoked.

Reasons for the Decision

AUXILIARY REQUEST 4

1. Article 13(2) RPBA

1.1 The proprietor requested that the opponent's new lines of argument submitted in its letter of 22 January 2024 (directed to the addition of gum arabic (GA) as an additional sugar, additional ingredient or additional

stabiliser) should not be admitted into the proceedings under Article 13(2) RPBA since there were no exceptional circumstances justifying their admittance.

1.2 As outlined below, the board concurs with the proprietor in this respect.

1.2.1 In its letter dated 22 January 2024, the opponent provided the following lines of argument under the question of obviousness:

- Obviousness in view of D3 - as an obvious alternative "sugar" (objection 1)
- Obviousness in view of D3 - as an obvious additional "sugar" (objection 2)
- Obviousness in view of D3 - as an obvious additional ingredient that is not a "sugar" (objection 3)
- Obviousness in view of D3 - as an obvious additional stabiliser that is not a "sugar" (objection 4)

1.2.2 The opponent provided only the above objection 1 in its statement of grounds of appeal and its reply to the proprietor's statement of grounds of appeal, arguing in particular that it was obvious to replace the carbohydrates (such as the fructooligosaccharide (FOS)) with GA or swap them for GA. The above objections 2 to 4 were only filed after receipt of the board's communication under Article 15(1) RPBA. All the objections essentially rely on the argument that it was obvious to add GA to the composition of D3 as opposed to swapping the sugars disclosed in D3 for GA.

1.2.3 In this context, the board does not agree with the opponent that it can be derived from, for instance,

paragraph (44) of the opponent's statement of grounds of appeal that the above objections 2 to 4 had already been raised in the opponent's statement of grounds of appeal or its reply to the proprietor's statement of grounds of appeal.

Paragraph (44) contains the sentence: "An obvious step to take when starting from D3 and aiming to provide an alternative aqueous whey protein composition would be to use a different carbohydrate." The board notes that the adjective "different" is used to qualify the carbohydrate in this sentence, as opposed to e.g. "additional". For the board, the only possible interpretation of this sentence is therefore that it was allegedly obvious to replace the sugar according to D3 with a different carbohydrate such as GA, not that it was allegedly obvious to use GA in addition to the sugar according to D3.

1.2.4 It follows that the new lines of argument (objections 2 to 4 referred to in point 1.2.1 above) constitute an amendment to the opponent's case, the admittance of which is within the board's discretion (Article 13(2) RPBA).

1.2.5 As to whether there are exceptional circumstances justifying the admittance of these new lines of argument, the opponent referred to the following sentence in point 8.5 of the board's communication:

"When D3 speaks of di-, oligo- or polysaccharides it seems that only (real) saccharides are meant having monosaccharide repeating units (see also claim 3 of D3 mentioning saccharose, lactose, inulin, fructooligosaccharides)."

- 1.2.6 The opponent argued that this interpretation given by the board differed from the interpretations provided by the opposition division and both parties. In the opponent's view, until the board's communication all parties had accepted that replacing the "sugar" of D3 with GA involved replacing one "sugar" with another. According to the opponent, even the proprietor considered GA to represent a "sugar", whereas the board for the first time considered GA not to be a "sugar". The opponent submitted that this new interpretation by the board represented an unforeseen development in the appeal proceedings and constituted exceptional circumstances which justified the admittance of its new arguments.
- 1.2.7 In the proprietor's view, the issue allegedly raised for the first time by the board had already been mentioned in the proprietor's statement of grounds of appeal, in which the proprietor had stated that GA was a complex polysaccharide having a protein fraction and was not a galacto-polysaccharide; a skilled person would thus not have considered replacing FOS with GA.
- 1.2.8 The board agrees with the proprietor in this respect. While the board's statement under point 8.5 of its communication and the wording provided by the proprietor are not exactly identical, the proprietor had indeed already indicated in its statement of grounds of appeal that GA was a complex polysaccharide. The board's taking up of this issue in its communication therefore does not qualify as exceptional circumstances which could justify raising the new objections 2 to 4 as indicated above.

The opponent's new lines of argument provided in its letter of 22 January 2024, directed to the addition of

GA as an additional sugar, additional ingredient or additional stabiliser, are therefore not taken into account (Article 13(2) RPBA).

2. Sufficiency

2.1 The opponent argued that the feature "optionally in the form of at least partially solubilized complex" in claim 1 meant there was a lack of sufficiency of disclosure.

2.2 As outlined below, the board does not agree.

The board agrees with the opposition division's conclusion that a skilled person would construe the "complex" mentioned in claim 1 as a WP/GA complex, and that this issue related rather to the clarity and interpretation of the claim. In addition, substantially the same arguments as submitted in the first-instance proceedings have been repeated with the opponent's sufficiency arguments. The board also shares the opposition division's view that there are no doubts that the claimed process can be carried out and leads to the claimed product.

2.3 In view of the above, the invention can be carried out by a skilled person.

3. Inventive step

3.1 The opponent argued that the aqueous compositions according to claims 1 and 2 of auxiliary request 4 did not involve an inventive step in view of D3 as the closest prior art in combination with the common general knowledge or D1.

- 3.2 D3 discloses a "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" (see claim 1). According to the paragraph bridging pages 5 and 6 of D3, the sugar component "can be selected from any di-, oligo- and polysaccharides, especially from di-, oligo- and polysaccharides wherein at least one monosaccharide residue is other than glucose, such as fructose, galactose, mannose, xylose, arabinose, etc.". The sugars preferred in D3 are saccharose, lactose and fructans (see D3, page 6, lines 18 and 19).
- 3.3 There was agreement among the parties that the subject-matter of claim 1 differed from D3 on account of the presence of GA and native starch, and that the subject-matter of claim 2 differed from D3 on account of the presence of GA and a calcium complexing agent.
- 3.4 With respect to the effect resulting from the distinguishing features, the opponent argued that no technical effect had been demonstrated across the whole scope claimed. In this context, reference was made in particular to example C of D9.
- 3.5 While the board shares the opponent's view that example C of D9 demonstrates that there is no improved heat stability over the composition according to D3 since the composition according to example C of D9 reveals that there is no such improvement over the whole pH range defined in claim 1 or claim 2, the board does not agree that this example is suitable to demonstrate that the tested examples falling within the scope of claim 1 are unstable in heat. The board shares the proprietor's view that this example is simply heat-

stable for a shorter period of time, but it cannot be concluded that it completely fails in this respect.

- 3.6 It follows that the objective technical problem is to be considered that of providing an alternative aqueous whey protein composition.
- 3.7 With respect to the question of obviousness, the opponent argued that using carbohydrates other than those described in D3 was obvious when starting from D3 and aiming to provide an alternative aqueous composition. GA was a well-known and well-accepted carbohydrate in the food industry, particularly as an emulsifier and/or stabiliser. It was a galactose-containing polysaccharide and was an obvious choice on the basis of the teaching in D3 alone. The skilled person would contemplate using it, in the expectation of providing a heat-stable nutritional beverage. The presence of native starch as in claim 1 or a calcium complexing agent as in claim 2 did not render the claims inventive either.
- 3.7.1 In the board's view, neither D3 nor the common general knowledge prompt the skilled person to use GA in place of the essential sugar component selected from di-, oligo- or polysaccharides disclosed in D3.

The paragraph bridging pages 5 and 6 of D3 mentions that the sugar component "can be selected from any di-, oligo- and polysaccharides, especially from di-, oligo- and polysaccharides wherein at least one monosaccharide residue is other than glucose". However, when considering the teaching of D3 in its entirety, the board concludes that whenever di-, oligo- or polysaccharides are mentioned in D3, only normal saccharides having monosaccharide repeating units are

meant (see for instance claim 3 of D3, which mentions saccharose, lactose, inulin and FOS). In this respect, the board shares the proprietor's view that GA is a complex polysaccharide including a protein fraction and that it is an unusual kind of polysaccharide. Under these circumstances, the board concludes that a skilled person would not contemplate replacing the sugar component, which is taught as being essential in D3, with GA on the basis of D3 and their common general knowledge.

- 3.7.2 In addition, the opponent argued that D1 taught that GA stabilised high-protein compositions comprising whey protein after heat treatment, so a skilled person would consider replacing the sugar disclosed in D3 with GA, which amounted to an obvious modification.

However, for similar reasons as outlined above, even if a skilled person took the teaching of D1 into account, they would not contemplate replacing the sugar, which is taught as being an essential component in D3, with GA.

In view of the above, the subject-matter of product claims 1 and 2 of auxiliary request 4 involves an inventive step in view of D3 as the closest prior art. The same applies to the dependent product claim and to the process claims, which refer directly or indirectly back to the product claims.

4. Adaptation of the description

The proprietor provided paragraphs [0015], [0037] and [0066] of the description adapted to the set of claims according to auxiliary request 4 (see "AMENDED PARAGRAPHS OF THE DESCRIPTION FOR AUXILIARY REQUESTS 4

& 18" filed with the proprietor's submission dated 15 April 2024). There were no objections against this proposed adaptation of the description from the opponent's side, and the board did not have any either.

The adapted description is consistent with the set of claims according to auxiliary request 4.

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 with the order to maintain the patent as amended in the following version:
 - claims 1-15 according to auxiliary request 4 filed with the statement of grounds of appeal
 - description of the patent specification with the exception of paragraphs [0015], [0037] and [0066], which are replaced with the amended paragraphs of the description for auxiliary requests 4 & 18 filed with the submission dated 15 April 2024

The Registrar:

The Chairman:



K. Götz-Wein

A. Haderlein

Decision electronically authenticated