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Aktenzeichen / Case Number / N° du recours : T 73/88 - 3.3.1

Anmeldenummer / Filing No / N° de la demande : 81 301 707.6

Veröffentlichungs-Nr. / Publication No / N° de la publication : 0 039 185

Bezeichnung der Erfindung: An expanded snackfood, together with a half product
Title of invention: and an expanded food product for use in, and a
Titre de l'invention : process for preparing said expanded snackfood.

Klassifikation / Classification / Classement : A23L 1/10

ENTSCHEIDUNG / DECISION

vom / of / du 7 November 1989

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

The Howard Foundation

Einsprechender / Opponent / Opposant :

01 Flessner GmbH & Co.
02 Convent Knabber-Gebäck GmbH & Co. KG

Stichwort / Headword / Référence :

Snackfood/Howard

EPÜ / EPC / CBE

Arts. 87, 88, 89, 107

Schlagwort / Keyword / Mot clé :

"Appeal - opponent party to appeal proceedings
without having to file appeal - equal rights
of all parties"
"Adversely affected - patentee in opposition
proceedings"
"Priority - disclaimer - additional feature in
claim - not related to character and nature of
invention"

Leitsatz / Headnote / Sommaire

I. On the date when an appeal from a decision of an opposition division is duly filed by one of a number of opponents, an appeal proceedings is brought into being, and all other parties to the opposition proceedings (in particular the other opponents) are on and after that date parties to the appeal proceedings by operation of law under Article 107 EPC, without having to file further individual appeals.

II. Each party to the appeal proceedings has equal procedural rights in the appeal, whether he became a party to the appeal by filing the appeal or by operation of law under Article 107 EPC (Decision G 1/86, OJ EPO 1987, 447 followed).

III. If a patentee in opposition proceedings has had his request that the patent be maintained upheld by the Decision of the Opposition Division, he may not file an appeal against reasoning in the Decision which was adverse to him (here: his claim to priority), because he is not adversely affected by the Decision within the meaning of Article 107 EPC (following Decision J 12/85, OJ EPO 1986, 155). In the event of an appeal being filed by an opponent, however, if the patentee wishes to contend that such adverse reasoning was wrong, he should set out his grounds for so contending in his observations under Rule 57(1) EPC in reply to the statement of grounds of appeal, by way of cross-appeal.

IV. A technical feature in a claim of a European patent, which is an essential feature for the purpose of determining the scope of protection conferred, is not necessarily an essential feature or element for the purpose of determining priority.

Whether a particular feature is essential for the purpose of priority, and therefore needs to be specifically disclosed in the priority document, depends upon its relationship to the character and nature of the invention. In a case where a feature in a claim is not related to the function and effect of the invention, such feature is not related to the character and nature of the invention, and the absence of such feature from the disclosure of the priority document does not cause loss of priority, provided the claim is otherwise in substance in respect of the same invention as that disclosed in the priority document (Decisions T 81/87 and T 301/87 followed and distinguished).

V. If a technical feature in a claim of a European patent is a more specific embodiment of a feature which is more generally disclosed in the priority document, there is no loss of priority provided that the inclusion of such more specific technical feature does not change the character and nature of the claimed invention which therefore remains in substance the same invention as that disclosed in the priority document.

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Beschwerdekammern
Case Number : T 73

Boards of Appeal
/88 - 3.3.1

Chambres de recours



DECISION
of the Technical Board of Appeal 3.3.1
of 7 November 1989

Appellant:
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Decision under appeal : Decision of Opposition Division of the European Patent Office dated 22 January 1988 rejecting the opposition filed against European patent No. 0 039 185 pursuant to Article 102(2) EPC.

Composition of the Board :

Chairman : K. Jahn

Members : F. Antony

G. Paterson

Summary of Facts and Submissions

- I. European patent application No. 81 301 707.6, which had been filed on 16 April 1981, claiming priority from a British application filed on 26 April 1980, was granted as European patent No. 39 185 on 1 August 1984, with thirteen claims, the independent Claims 1 and 10 to 12 reading as follows:

"1. An expanded snackfood in the form of discrete cooked portions of a dough composition comprising gelatinised starch, the snackfood containing at least 5% by weight of oil or fat and characterised in that the snackfood includes from 15 to 70% by weight of added cereal bran selected from wheat bran, barley bran, oats bran, rye bran, maize bran and mixtures thereof.

10. A half product comprising at least some gelatinised starch and added cereal bran selected from wheat bran, barley bran, oats bran, rye bran, maize bran and mixtures thereof, from which a snackfood according to any one of the preceding claims can be prepared by cooking by a process which includes a step whereby half product dough portions are expanded to at least 1.25 times their original volume and a step which may be the same step of imparting an oil or fat content of at least 5% by weight.

11. An expanded food product comprising discrete cooked portions of a dough composition comprising gelatinised starch and added cereal bran selected from wheat bran, barley bran, oats bran, rye bran, maize bran and mixtures thereof for use in preparing a snackfood according to any one of claims 1 to 9 by imparting thereto an oil or fat content of at least 5% by weight.

12. A process for preparing a snackfood according to any one of claims 1 to 9, which process comprises cooking discrete portions of a dough composition comprising gelatinised starch and added cereal bran selected from wheat bran, barley bran, oats bran, rye bran, maize bran, and mixtures thereof to expand the dough portions to at least 1.25 times their original volume, the process including a step whereby an oil or fat content of at least 5% by weight is imparted to the dough portions, the cooking preferably being achieved (a) by frying in oil or fat, or (b) by immersion in a bed of hot particulate material, the cooked snackfood being subsequently treated after step (b) to provide the required level of fat or oil, preferably by spraying."

II. Notices of opposition were filed by

- (1) Flessner GmbH & Co on 18 April 1985 and by
- (2) Convent Knabber-Gebäck GmbH & Co KG on 30 April 1985,

each requesting complete revocation of the patent, on the ground of lack of inventive step over a large number of documents, of which only the following ones were introduced into the appeal proceedings:

- (I) Gordian 78/10 (1987), 284-291;
- (VIII) GB-A-1 484 455;
- (IX) US-A-2 710 200;
- (XV) Hastings, Snack Food, October 1980, 20-21;
- (XVII) Staley Refined Corn Bran, April 1980; and
- (XIX) GB-A-1 544 843.

With particular reference to documents (XV) and (XVII), Opponent (2) contested that the claims of the patent were

entitled to claim priority from the British application filed on 26 April 1980.

- III. In a Decision announced orally on 11 November 1987 and posted on 22 January 1988 the Opposition Division rejected the opposition.

Its Decision held that all the claims of the patent were entitled only to the European filing date, not to the claimed priority date, because the figure 5 in the feature "at least 5% by weight of oil or fat" contained in each independent claim (and therefore also in the dependent claims) could not be derived from the priority document, and constituted subject-matter added to the specification after the priority date. A further reason why, it had been argued, the claims were not entitled to the claimed priority, viz. lack of disclosure in the priority document of the specific brans (other than wheat bran) enumerated in each independent claim, was not accepted by the Opposition Division.

Nevertheless, it was held that the claims of the patent in suit were novel over all citations, including documents (XV) and (XVII). In determining inventive step the Opposition Division started from a "closest prior art" not identified by reference to a document, but represented by conventional expanded snack food consisting of discrete cooked dough portions comprising gelatinised starch, as well as of fat or oil derived from a final frying step or applied by spraying. The problem would then be to obtain an acceptable product high in fibre and low in energy value, and the solution would appear to consist in addition of the amounts specified in Claim 1 of one of the cereal brans enumerated therein. This solution was inventive on the basis of an alleged prejudice, to the effect that bran would alter the texture of the product

and might act as a fat and water absorbent, while in fact an increase in bran content would bring about a substantial reduction in fat content.

- IV. Opponents (2) and (1) (Appellants (2) and (1)) filed appeals on 8 February and 18 March 1988 respectively, and paid the appeal fees on the same dates. Statements of Grounds of Appeal were filed on 26 and 20 May 1988, respectively. It was submitted that none of the claims was entitled to the claimed British priority date, and on this basis documents (XV) and (XVII) were alleged to be part of the state of the art. The closest prior art was said to be represented by (XV) and (XVII), but if these were to be disregarded, then (XIX) was also closer than the prior art which the Opposition Division took as its starting point. (XIX) described products containing both fat and bran, namely rice bran, and there was no prejudice recognisable against substituting other brans for rice bran to improve the taste.
- V. The Respondent reserved his position on the priority question, and submitted that even if (XV) and (XVII) were prior art, they did not affect novelty. While (XIX) discloses a product containing fat or oil and rice bran, such product was not palatable to the Western taste, and only by using hindsight would a skilled man have thought of substituting another bran, e.g. wheat bran, in order to arrive at an acceptable product.
- VI. At the oral proceedings held on 7 November 1989, the priority question was discussed first. Both Appellants submitted that there was no disclosure in the British priority document either of a figure of at least 5% fat, or of the specific brans (other than wheat bran), listed in the claims, or of the exclusion of rice bran. The Respondent emphasised that the 5% figure was to some

extent arbitrary, and served to exclude products containing insufficient fat quantities to provide the desired "fried" taste. Furthermore, when the fat was added by frying, the low fat content resulted from the presence of bran and was not itself an inventive feature; as to the enumeration of specific brans, exclusion of rice bran was a disclaimer and therefore required no support as a matter of principle, and the "other forms of bran" referred to "generally available bran", which term the skilled person would immediately recognise as equivalent to the brans which were listed in the claim.

After a short adjournment for deliberation the Chairman announced the intermediate decision of the Board that all the claims are entitled to the claimed priority date of 26 April 1980, the filing date of the British application.

- VII. The Chairman indicated the Board's provisional opinion that Claims 10 and 11 were not novel over Example 10 of (IX), and the Respondent consequently indicated that he would delete those claims.
- VIII. In connection with inventive step, the arguments of the Appellants were essentially as follows:
- (a) Document (I) related to an investigation on the possibility of including bran in expanded food products, and differed from the subject-matter of the patent in suit only in that no fat content was provided for.
 - (b) In connection with a known technology not applied in (I), expansion by frying was even referred to (page 286, first paragraph) as an alternative, implying a fat content in the resulting products.

(c) A "fried" taste being desired, it was obvious to add fat - by whatsoever method - especially as, by the Respondent's own admission, the 5% figure was not an essential feature of the patent in suit, i.e. not critical.

Consequently, the Appellants requested that the decision under appeal be set aside and the patent in suit revoked.

IX. According to the Respondent, the products of (I) had such unattractive properties that the said document was not a suitable starting point for further development, but rather a starting point from which to look for something entirely different. Frying was alluded to in (I) not in connection with the process thereof, but in a different connection. There was no incentive either to combine the teaching of (XIX) - frying of dough containing bran, i.e. rice bran - with that of (I).

The Respondent therefore requested the Board to dismiss the appeal and to maintain the patent with an amended text as filed during oral proceedings.

X. At the end of the oral proceedings the Chairman announced the decision of the Board that the decision under appeal is set aside and the patent is maintained with the amended text filed during oral proceedings.

Reasons for the Decision

1. Procedural Matters

1.1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.

- 1.2. As set out in paragraph IV above, Opponent (2) filed an appeal on 8 February 1988 in accordance with the requirements of Article 108 EPC, and on that date the appeal proceedings were thereby brought into being.

In this connection it is to be noted that under Article 99(4) EPC, "Opponents shall be parties to the opposition proceedings as well as the Proprietor". It therefore seems that there is only one "opposition proceedings" even when there are several Opponents; and similarly, there is therefore only one appeal proceedings, as envisaged in Article 107 EPC.

According to Article 107 EPC, second sentence, any other parties to the opposition proceedings "shall be parties to the appeal proceedings as of right." In the Board's view it was therefore unnecessary for Opponent (1) to pay an appeal fee subsequent to 8 February 1988, although he in fact did so on 18 March 1988, because the appeal proceedings were already in existence from 8 February 1988 and Opponent (1) was already a party to such proceedings. He paid a fee for a right which he already possessed by operation of law, namely, to be a party to the appeal proceedings.

In the Board's view, there is nothing in the EPC which suggests that each party to appeal proceedings does not have equal rights and status with the other parties, however he has become a party (i.e. whether by filing an appeal under Article 108 EPC, or by operation of law under Article 107 EPC). Furthermore, the equal rights and status of all parties to a proceedings is in accordance with the principles of procedural law generally recognised in the Contracting States (Article 125 EPC, and see Decision G 1/86 (OJ EPO 1987, 447), Reasons, paragraphs 12 to 14). Thus, in the Board's view, it is in accordance

with the principle of equal and fair treatment of all parties to an appeal proceedings that each party has, for example, the right to a fair hearing, the right to request oral proceedings, and the right to continue to be a party in the appeal proceedings, even if another party (for example the party who actually filed the appeal) withdraws his appeal.

It follows that in the Board's view, the appeal fee paid by Opponent (1)/Appellant (1) should be refunded.

- 1.3. In its Decision, as set out in paragraph III above, the Opposition Division held in relation to priority and novelty, that the claims were not entitled to priority but were novel over the two "intervening" documents which were considered to have been published during the priority year.

In their Grounds of Appeal, the Appellants, although successful in relation to priority on one argument, continued to put forward further reasons why the claim to priority should not be allowed, as well as continuing to contend that the claims were not novel in view of the two intervening documents if the claim to priority was refused.

In his observations in reply, the Respondent continued to contend that the two intervening documents had not been proved to have been prior published, and anyway did not deprive the claims of novelty; as to the priority question, however, he merely reserved his position, and appeared to be uncertain of his rights as regards putting in issue the priority question in the appeal proceedings ("... and if it is open to the patentees to do so the Patentees would wish to argue ... for the maintenance of the priority date ..."). At the oral hearing the Respondent did so argue.

While not criticising the Respondent in the present case for the course which he took, especially because the priority question had been fully argued before the Opposition Division and its re-argument in the oral proceedings of the appeal caused no surprise to the Appellants, the Board would clarify the procedural position as follows:

Since the Decision of the Opposition Division held that the patent should be maintained as granted, the Patentee was not adversely affected by the decision as such (Article 107 EPC, first sentence), because the decision to maintain the patent as granted was what the Patentee had requested (see Decision J 12/85, OJ EPO 1986, 155). Thus, even though some of the reasoning in the Decision (namely that concerning priority) was contrary to the contentions of and therefore adverse to the Patentee, he could not file an appeal against the Decision. (The Patentee would, of course, be able to re-argue such matters in any subsequent proceedings). The Patentee was a party to the appeal proceedings (Respondent) as of right, however (Article 107 EPC, second sentence).

Following the filing of the Statements of Grounds of Appeal, the Respondent was invited to file observations in reply under Rule 57(1) EPC, which is applied mutatis mutandis to the appeal proceedings by virtue of Rule 66(1) EPC. In the circumstances of a case such as the present, if a Respondent wishes to contend in the appeal proceedings that a particular issue in the decision under appeal was wrongly decided against him (even though the overall result of the decision was in his favour), it is certainly open for him to do so. Furthermore, not only should he so state in his observations in reply, but he should also set out his grounds for such contention. A particular purpose of the written procedure prescribed

under Rule 57 in conjunction with Rule 66(1) EPC is to ensure as far as possible that the reasoning in support of all parties' contentions is adequately set out in writing prior to examination of the appeal and any oral hearing. Thus in the present case, it was clearly open to the Respondent to contend in the appeal proceedings that the priority issue should have been decided in his favour, and furthermore the grounds for this contention (constituting in effect a cross-appeal) should have been stated in his observations in reply to the Statements of Grounds of Appeal.

2. **Priority**

Since the earliest possible dates of publication of Documents (XV) and (XVII) are between the claimed priority date and the date of filing of the European patent, the Board must examine and decide whether the Appellant is entitled to the claimed right of priority from the filing of British application No. 80/13858 on 26 April 1980, pursuant to Articles 87 to 89 EPC. This depends upon whether the European patent is "in respect of the same invention" as the British application (Article 87(1) EPC).

- 2.1. Claim 1 of the European patent application as filed, and of the European patent as granted, requires as a technical feature of the claimed invention that the claimed snack food contains "at least 5% by weight of oil or fat." While the British application refers at page 5, third paragraph, to the fact that "Another unexpected property of the snack food of the present invention is its relatively low fat content when frying is used for cooking ...", and also states at page 8, third paragraph, that "... preferred snack foods in accordance with the present invention contain 20% by weight or less fat e.g. 8% to 20% by weight

fat ...", the minimum figure of 5% fat is not expressly mentioned. In its Decision the Opposition Division took the view that because the British application does not in terms disclose a numerical requirement of "... at least 5% fat ...", the figure of 5% constituted added subject-matter and the claim to priority could not be upheld.

In the Board's view such an approach to the determination of the right to priority is too narrow and too literal, and does not conform to the requirement of Article 87(1) EPC. What has to be considered in relation to this requirement is whether, as a matter of substance, the earlier filed application is in respect of the same invention as the invention claimed in the European application or patent.

- 2.2. In the present case, the invention described in the British application is very simple in nature: it is the provision of an expanded snack food comprising discrete cooked portions of a dough composition comprising gelatinised starch and added bran. The invention involves the technical effect that the addition of bran does not lead to an undesirably low level of expansion in the end product. In its broadest form as described and claimed in the British application, the invention is not concerned with the inclusion of oil or fat in the product at all. In the passages at pages 5 and 8 of the British application mentioned above, it is made clear that the possibility of a relatively low fat content for a product in accordance with the invention in the case when such a product is cooked by frying, is a property of the invention. But neither cooking by frying, nor the inclusion of fat or oil in the product, are part of the invention as such which is described in the British application.

- 2.3. The invention which is described and claimed both in the European patent application as filed and in the granted European patent includes an additional technical feature in the pre-characterising portion of claim 1, namely that the expanded snack food product contains "... at least 5% by weight of oil or fat ...". The description makes it clear that such oil or fat content may be incorporated into the snack food product either during frying (when frying is used for cooking) - and it is then an advantage that the product need only have a relatively low fat content compared to known products; or by spraying or otherwise treating a product which has been cooked otherwise than by frying with the necessary amount of oil or fat, to obtain the desired flavour.

The precise reason why the above-mentioned feature was added to the claims of the European patent application as filed, in comparison with the earlier filed British application, is in principle irrelevant to the determination of priority. It would appear to have been designed to improve the Respondent's chances of defending the validity of the patent.

X This additional feature is clearly an essential technical feature of the claims in that it has the effect of limiting the extent of the protection conferred by the patent, so that products which do not have at least 5% fat or oil are not within the protection conferred. The inclusion of a technical feature in a claim which is an essential feature for the purpose of determining the scope of protection conferred is not necessarily an essential feature for the purpose of determining priority, however. X

In general, the mere addition of a technical feature to a claim will always limit the extent of protection conferred, and additionally it may or may not change the nature

of the claimed invention. This is entirely a question of fact and degree in each case, and depends upon the relationship of the additional technical feature to the previous technical features of the claim.

- 2.4. A number of cases have previously been considered and decided by the Boards of Appeal, in which the invention as claimed in a European application or patent required a combination of technical features including one or more additional technical features, which combination had not been specifically disclosed in the relevant priority documents, cf. Decisions T 61/85 dated 30 September 1987 (EPOR 1988, 20), T 85/87 dated 21 July 1988 (EPOR 1989, 24), T 81/87 dated 24 January 1989 (to be published in OJ), T 301/87 dated 16 February 1989 (to be published in OJ). In each of these cases it was held that a particular technical feature of the invention in combination with other technical features as claimed in the European application constituted an essential element of the invention which had not been disclosed in combination with the other technical features in the relevant priority document. In each of these cases the presence in the claim of the additional technical feature was such as to change the essential character of the invention as claimed, in comparison with the disclosure of the priority document. The claimed invention was therefore not in substance the same as the invention disclosed in the priority document, and the claim to priority could not be upheld.

In the present case, it is clear from the European patent that the additional technical feature is concerned with the provision of a "fried flavour" to the claimed snack food, and has nothing to do with the essential character and nature of the invention as such (which is discussed in paragraph 2.2 above), this of course being what has to be considered when deciding upon a claim to priority. The

effect of this additional technical feature is really to disclaim some snack products which are in accordance with the essence of the invention as such, but which do not have a fried flavour, and thus to limit the claimed invention to a particular class of products. The presence of this additional feature in the claims of the European patent does not therefore change the character and nature of the claimed invention as such, in comparison with what is disclosed in the priority document, i.e. the British application. In the Board's view, it was not the intention of Articles 87 to 89 EPC (or of the relevant provisions of the Paris Convention with which such Articles are intended to conform - see Decision T 301/87 "Biogen" dated 16 February 1989, to be published) that a Patentee should forfeit his claim to priority (and potentially the validity of his patent), as a result of such a reduction in the scope of protection of his patent as compared to the disclosure in the priority document.

The Board does not, however, accept the Respondent's submission that the inclusion of a "disclaimer" in comparison with the priority document does not ever require direct support in order to successfully claim priority. In some cases such a "disclaimer" will cause a change in the character of the invention - see for example Decision T 61/85 identified above, where a limitation of the invention as claimed in the European application was intimately connected with the functioning and technical effect of the invention.

- 2.5. It was also argued by the Appellants that the list of specific brans in Claim 1 caused loss of priority - see paragraph VI above. As to this point, in the Board's view it is very clear that the listing of specific brans and the exclusion of rice bran from that list in no way alters the character and nature of the invention in comparison

with what is disclosed in the British application. Such listing is essentially a disclaimer in respect of the broad disclosure of brans in the priority document, which is not related to the function or effect of the invention, or therefore to its character and nature.

For the above reasons, in the Board's judgment the claims of the European patent are in respect of the same invention as that disclosed in the British application, and are therefore entitled to the right of priority provided by Article 89 EPC.

- 2.6. It appears to the Board that the approach to determination of priority taken by the Opposition Division in this case follows the suggestions contained in the Guidelines for Examination, C-V, 2.2 to 2.5. In that chapter, paragraph 2.2 states that for entitlement to priority, "It is sufficient that the documents of the previous application taken as a whole specifically disclose (the elements of the claimed invention)". Paragraph 2.3 then goes on to say that "The requirement that the disclosure must be specific means that it is not sufficient if the elements in question are merely implied or referred to in broad and general terms. A claim to a detailed embodiment of a certain feature would not be entitled to priority on the basis of a mere general reference to that feature in a priority document ...".

Furthermore, paragraph 2.4 states that for priority to be allowable, "the subject-matter of the claim must be derivable directly and unambiguously from the disclosure of the invention in the priority document", and refers to the test for priority being the same as the test for amendment under Article 123(2) EPC.

In the Board's view such statements in the Guidelines are too general, and do not pay sufficient attention to the nature of the "elements" which are not specifically disclosed, in relation to the nature of the claimed invention as such.

Thus in cases such as those identified in paragraph 2.4 above, where a particular technical feature of the claimed invention is central to the function and effect of the invention and therefore to its character and nature, what is decisive for priority is whether such technical feature is disclosed in the priority document, either explicitly or implicitly, in combination with the other technical features of the invention. In the context of such cases the above statements in the Guidelines may be generally applicable.

However, in a case such as the present, where a particular technical feature has been included in the claims of the European application as filed, which technical feature is a more specific embodiment of a feature which is more generally referred to in the priority document, contrary to what is suggested in the Guidelines such claims are entitled to claim priority from the priority document provided that the inclusion of such technical feature does not change the essential character and nature of the invention as such, and the claimed invention therefore remains "the same invention" as that which is disclosed in the priority document.

The references in the above-quoted passages in the Guidelines to the "elements" of the claimed invention suggest that what is there stated may have been derived from a consideration of Article 88(2), (3) and (4) EPC. If so, in the Board's view this has resulted from a misinterpretation of Article 88 EPC, which is essentially

concerned with the procedural and formal aspects of claiming priority, rather than the substantive requirements. This is clearly indicated by the heading to Article 88 EPC "Claiming priority", as compared to the headings and contents of Article 87 EPC "Priority right" and Article 89 EPC "Effect of priority right". The provisions of Article 88(2), (3) and (4) EPC correspond to similar provisions in the Paris Convention (Article 4F and H) which are clearly procedural and formal in nature.

Thus in the Board's view the statements in paragraph C-V, 2.3 of the Guidelines do not apply to a case such as the present. Furthermore, the statements in paragraph 2.4 to the effect that the "basic test" for priority is the same as that under Article 123(2) EPC is therefore incorrect.

3. **Novelty**

The patent in suit being entitled to the priority claimed, (XV) and (XVII) are clearly not pre-published and need not, therefore, be considered any further.

None of the other documents in the proceedings discloses a combination of all features of Claim 1 or of Claim 12 as granted (now Claim 10). These claims and those which are dependent upon them are thus novel. Granted Claims 10 and 11 having been deleted, all the present claims are novel. Novelty was conceded by both Appellants during oral proceedings.

4. **Inventive Step**

4.1. Closest prior art:

Document (VIII) was mentioned for the first time in the submission of the Appellant (1) dated 15 August 1986, thus

not in due time (Article 114(2) EPC). While the Opposition Division has considered it to be sufficiently relevant to be formally admitted into the proceedings (page 3, numbered paragraph 2, of the Decision under appeal), it was no longer relied upon at the oral proceedings and is, in the Board's view, not sufficiently relevant to be admitted into the appeal proceedings. It is therefore disregarded hereinbelow.

In the Board's view, documents (I), (IX) and (XIX) each relate to a product which is fundamentally different from that claimed in the patent in suit. For this reason, the Board considers that the closest prior art is essentially the commercial state of the art as defined on page 6, second paragraph, of the Decision under appeal, viz. an expanded snackfood consisting of discrete cooked portions of dough comprising gelatinised starch and containing an effective (from the taste point of view) amount of fat or oil. Such a product is defined in the pre-characterising portion of Claim 1 and is therefore in effect recognised by the Respondent as part of the prior art (Rule 29(1)(a) EPC).

4.2. Problem/Solution:

Starting from such closest prior art, the problem is considered to be the provision of such an expanded snackfood which has more desirable dietary properties. This problem is plausibly solved by the snackfood of Claim 1 of the patent in suit, having in mind the unrebutted statement of column 5, lines 63 to 66, and column 6, lines 63 to 65, of the specification in suit, taken together with Examples 1 to 12.

- 4.3. While the desirable dietary properties of bran were - without dispute - well known at the priority date of the invention, it has to be asked whether the skilled person would expect that he could add to the dough from 15 to 70% by weight of cereal bran and still obtain an expanded snackfood, which - by definition; cf. column 2, lines 61 to 65 of the patent in suit - means having an expansion of generally at least 1.25 times the original volume of the dough.

The Respondent has submitted that such a result was surprising and contrary to expectation (specification in suit, column 3, lines 2 to 6). This is to some extent supported by the following passages of (XIX): page 2, lines 111 to 126; page 3, lines 3 to 18, and particularly page 3, lines 19 to 24.

- 4.4. In his observations dated 15 August 1986, Appellant (2) contested this (page 6, paragraphs 3 and 4), with reference to (I).

However, while a certain expansion is mentioned in (I) - see, for instance, page 284, right-hand column, line 8 from the bottom - the Board is unable to draw any conclusion from the references therein to bulk volumes ("Schüttvolumina"), or from the passages of (I) referred to, as to the exact degree of expansion realised in the experiments reported by (I). So far as any significant results can at all be derived from Table 3 on page 288 of (I) - humidity content 20% - it would rather appear that the more bran is used, the smaller is the bulk volume, which seems to mean the more reduced is the expansion. Certainly the Board cannot derive from this anything which disproves the Respondent's point.

This being so, the principle expressed in this Board's Decision T 219/83 (OJ EPO 1986, 211) has to be applied, as follows: "If the parties to opposition proceedings make contrary assertions which they cannot substantiate, and the European Patent Office is unable to establish the facts of its motion, the patent proprietor is given the benefit of the doubt." Accordingly, an expansion as defined when the specified amounts of bran are added is considered surprising.

- 4.5. On this basis, in the Board's view a skilled man seeking to solve the problem set out in paragraph 4.2 above would see nothing in document (I) which would suggest that the manufacture of an expanded snack food product could be achieved even when the proportion of added cereal bran in the dough was from 15 to 70% by weight.
- 4.6. The term "desirable dietary properties" in the sense of the problem to be solved includes a comparatively low fat content, once it is accepted that some fat is necessary to provide the organoleptic effect of a "fried" taste. As to this, when the product of the patent in suit is made using process (b) of granted Claim 12, now Claim 10, i.e. making first a substantially fat-free product which is then treated to provide the required level of fat or oil, e.g. by spraying, then it is up to the manufacturer to provide as much or as little fat as he wants: there is no inventive contribution in this. When, on the other hand, the product is made using process (a) of granted Claim 12, i.e. by frying of the dough portions in oil or fat, then the fat content of the end product cannot be chosen at will; rather, it depends on a number of given factors including the properties of the dough used. From general experience, the skilled man might expect that the more fibrous the material which is contained in the dough, the more the dough will be soaked with the liquid fat in which

it is fried. As bran contains a large portion of fibres, the skilled man could expect that the larger the bran content before frying, the larger will be the fat content after frying, which would run counter to the desired dietary properties of the product. As is shown however by the figures of Table 1 (page 4 of the specification in suit), the opposite is actually true. An inventive contribution can therefore be seen in this, to the extent that the product of Claim 1 is made by a process including a frying step.

- 4.7. The Appellants relied primarily upon document (I) for the purpose of their submissions that the claims lacked inventive step - see paragraph VIII above. In the Board's judgment there is little in this essentially experimental document to attract the attention of the skilled man wishing to manufacture snack food products of the type claimed.

Certainly the Board sees no incentive pointing towards the claimed solution in the fact that in (I), after a description of the author's method how to make the bran-containing, but fat-free products of the citation (page 284, last paragraph), there follows immediately (page 286, first paragraph) a reference as to how other snack products can be made, this reference including expansion by frying. Not only does the first-mentioned paragraph expressly state that the method described therein is exclusively used when bran is employed (page 284, right-hand column, lines 4 to 2 from the bottom), but furthermore the expectation of a high fat content when using the method of page 286, first paragraph, would deter the skilled person from using this latter method.

- 4.8. The Respondent relied upon an alleged commercial importance of the claimed snack food, which has not been

disputed by the Appellants. In the Board's view consideration of such evidence is certainly not insignificant in relation to deciding upon inventive step, especially in a case such as the present when a total of nineteen prior documents were cited by the Appellants, but the closest prior art still appears to the Board to be a known conventional commercial product.

- 4.9. In summary, the solution of the problem in accordance with Claim 1 involves an inventive step.
5. Independent Claim 10 (= granted Claim 12) relates to methods for making the novel and inventive product of Claim 1, and benefits from the same inventive idea.
6. The dependent Claims 2 to 9 and 11 relate to preferred embodiments of the product of Claim 1 and the process of Claim 10, respectively, and are therefore likewise patentable.

Order

For these reasons, it is decided that:

1. The decision of the Opposition Division is set aside.
2. The case is remitted to the first instance with the order to maintain the patent with an amended text as filed during the oral proceedings.
3. The appeal fee paid by Appellant (1) should be refunded.

The Registrar:

S. Fabiani

S. Fabiani
04636

27.12.89

The Chairman:

K. Jahn