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D E C I S I O N
of 15 September 1995

Case Number: T 0751/93 - 3.3.4

Application Number: 85309010.8

Publication Number: 0185511

IPC: A23L 1/05

Language of the proceedings: EN

Title of invention:
Gel system

Patentee:
Mars G.B. Limited

Opponent:
Merck & Co., Inc.

Headword:
Amendment

Relevant legal provisions:
EPC Art. 111(1), 114(2), 123(2)(3)

Keyword:
"Amendment"
"Main request generalisation - not allowed"
"Auxiliary request - allowed"
"Auxiliary request submitted during appeal proceedings"

Decisions cited:
-

Catchword:
-



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Boards of Appeal

Chambres de recours

Case Number: T 0751/93 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 15 September 1995

Appellant:
(Proprietor of the patent) Mars G.B. Limited
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Respondent:
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 1 June 1993 revoking
European patent No. 0 185 511 pursuant to
Article 102(1) EPC.

Composition of the Board:

Chairman: U. M. Kinkeldey
Members: D. D. Harkness
S. C. Perryman

Summary of Facts and Submissions

- I. European patent No. 0 185 511 relating to a gel system was granted on the basis of a main claim reading:

"A gellable composition comprising a mixture of (1) gellan, (2) xanthan gum, and (3) a galactomannan and/or glucomannan gum capable of forming a gel with xanthan gum, the gellan being present in the composition in an amount less than 50% of the total weight of the composition."

and dependent claims 2 to 12. The main claim had been amended during examining proceedings by the addition of the proviso at its end, "the gellan being present in the composition in an amount less than 50% of the total weight of the composition.", in order to distinguish over document

(1) JP-5988051,

cited in the Search Report which disclosed in Example 7 a combination of gums with 50% by weight gellan.

- II. An opposition was filed raising objections under Article 100(a) EPC that the subject matter of the patent was not novel and inventive, (Articles 54 and 56 EPC) and under Article 100(c) EPC that the application had been amended in such a way that the subject matter extended beyond the content of the application as filed.
- III. The patent was revoked under Article 102(1) EPC by the Opposition division after oral proceedings which took place on 5 May 1993.

The reason given for the decision was that the subject matter extended beyond the content of the application as filed (Article 100(c) EPC). Novelty and inventive step were not considered.

In its decision the Opposition Division found that the addition of the phrase "the gellan being present in the composition in an amount less than 50% of the total weight of the composition." to originally filed claim 1 did not comply with Article 123(2) EPC. It was stated that the figure of "less than 50%" for the gellan gum content was not implicit in, and did not unambiguously appear in the application as filed.

In the opinion of the Opposition Division the amendment was made in order to substantiate inventive step for otherwise non-inventive subject matter. Appeal Board Decisions (a) T 4/80 (OJ EPO 82, 149) and (b) T 170/87 (OJ EPO 89, 441) were referred to as these decisions, (a) require that the original inventive teaching as a whole be not changed by the amendment and that a disclaimer may only excise that part of the inventive teaching which is not novel, (b) a disclaimer may make an inventive teaching which overlaps with the prior art novel, but it cannot make an obvious teaching inventive.

The Opposition Division was also of the opinion that deletion of the amendment would contravene Article 123(3) EPC and that there was no other allowable amendment possible.

IV. The Appellant filed an appeal against the decision of the Opposition Division, paid the appeal fee and submitted a Statement of Grounds with a main request and three auxiliary requests.

V. Oral proceedings took place on 15 September 1995.

VI. The only issue discussed at oral proceedings was that concerning Article 123(2) and (3) EPC.

VII. During the course of the oral proceedings the Appellant withdrew the main request (claims as granted) and first two auxiliary requests. A new main request was submitted based upon the previous third auxiliary request with a claim 1 reading as follows:

"1. A gellable composition comprising a mixture of (1) low acetyl gellan, (2) xanthan gum and (3) a galactomannan and/or glucomannan gum capable of forming a gel with xanthan gum, characterised in that the ratios of gellan : xanthan gum : galactomannan or glucomannan gum lie in the ranges 1:1 to 2:1 to 2."

Also a new auxiliary request was submitted with a claim 1 reading as follows:

"1. A gellable composition comprising a mixture of (1) low acetyl gellan, (2) xanthan gum and (3) a galactomannan and/or glucomannan gum capable of forming a gel with xanthan gum, the galactomannan and/or glucomannan gum being in the form of carob or cassia or konjac gum, and the ratios of gellan : xanthan gum : carob or cassia or konjac gum lying in the ranges 1:1 to 2:1 to 2."

VIII. The Appellant relied in particular on the passage on page 2, lines 55 and 56 of the patent as granted (and also identical in the application as filed) reading:

"Particularly good gels have been found to be formed at a ratio of gellan:xanthan gum: carob or cassia or konjac gum of within the range 1:1 to 2:1 to 2."

and argued that the main request was allowable as the skilled person would be taught by the disclosure that any galactomannan or glucomannan gum currently in common commercial use could be employed in the compositions claimed and not only the identified carob, cassia or konjac gums. The auxiliary request had a clear basis in claim 7 as filed and granted.

IX. The Respondent attacked the main request on the ground that it did not comply with Article 123(2) EPC in that claim 1 thereof related to a combination of features not previously disclosed, ie., that the specific ratios there referred to were originally mentioned only in combination with the gums carob, cassia and konjac. In his view only these gums were allowable and it was doubtful that other gums eg., Tara gum would function as required since in the examples of Tables 1 and 3 this gum was used in amounts well in excess of that permitted by the ratios stipulated. With regard to the auxiliary request the Respondent argued that as this was filed only during the oral proceedings, this was too late (Article 114(2) EPC) to be considered by the Board.

X. The Appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main or of the auxiliary request submitted during the oral proceedings on 15 September 1995. The Respondent requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

Main request

Article 123(3) EPC

2. The granted claim 1 required gellan to be present "in an amount less than 50% of the total weight of the composition". Claim 1 of the present main request requires a ratio of 1 part of gellan to 1 to 2 parts of xanthan to 1 to 2 parts of galactomannan or glucomannan gum, which means that gellan is present as between 20% and 33,3% by weight of the total of gellan and xanthan and galactomannan or glucomannan gums, which weight of gellan thus falls wholly within the range for gellan specified by claim 1 as granted. The requirements of Article 123(3) are thus complied with.

Article 123(2) EPC

3. The requirement that the ratio of gellan : xanthan gum : galactomannan or glucomannan gum lie in the ranges 1:1 to 2:1 to 2, is a selection from the originally claimed unlimited ranges for these three types of component. To be allowable under Article 123(2) EPC there must be a basis in the specification as originally filed from which the skilled person would deduce that he should make such a selection. By no means every selection which reduces the scope of the claims as granted would suggest itself to the skilled person, so the mere fact that a selection falls within the scope of claim 1 as granted does not make it allowable. As the respondent pointed out, Tara gum falls in the category of "galactomannan or glucomannan gum" but the originally

filed application suggests use of Tara gum only in ratios falling outside the limited ranges now required by claim 1. In the Board's opinion this indicates to the skilled person that not each and every galactomannan or glucomannan gum is suitable in the range now claimed and thus the skilled person would have no reason to select these ranges for Tara gum on the basis of the information in the specification as filed, nor to derive unambiguously from the specification as originally filed that these ranges are significant for any galactomannan or glucomannan gum other than the carob or cassia or konjac gum specifically mentioned in connection with these ranges. What, if any, generalization a skilled person might unambiguously derive from the original disclosure is always a difficult question depending very much on the particular facts. But where, as here, the claimed generalization is not consistent with an example given, the generalization cannot be allowed under Article 123(2) EPC. The main request is thus not allowable.

Auxiliary request

Article 123(3) EPC

4. The granted claim 1 required gellan to be present "in an amount less than 50% of the total weight of the composition". Claim 1 of the present auxiliary request requires a ratio of 1 part of gellan to 1 to 2 parts of xanthan to 1 to 2 parts of carob or cassia or konjac gum, which means that gellan is present as between 20% and 33,3% by weight of the total of gellan and xanthan and carob or cassia or konjac gums, which weight of gellan thus falls wholly within the range for gellan specified by claim 1 as granted. As furthermore, carob or cassia or konjac gums are specific examples of the

galactomannan or glucomannan gums referred to in claim 1 as granted, the requirements of Article 123(3) are thus complied with.

Article 123(2) EPC

5. Claim 1 of the auxiliary request with the requirement that the ratio of gellan : xanthan gum : carob or cassia or konjac gum lie in the ranges 1:1 to 2:1 to 2, amounts to a combination of claim 1 as originally filed with claim 7 as originally filed which was dependent on claim 1 originally filed and supported by the originally filed description on page 3, paragraph 2, lines 6 and 7. Thus claim 1 of the auxiliary request involves only amendments allowable under Article 123(2) EPC.

Article 114(2) EPC

6. Claim 1 of the auxiliary request was only put forward as an independent claim at the oral proceedings, but it corresponds in scope to the dependent claim 7 as originally filed and granted, and present also in the requests put forward during the appeal. In these circumstances the Board thinks it appropriate to exercise its discretion under Article 114(2) EPC in favour of allowing the auxiliary request into the proceedings, particularly as the only questions that the Board is proposing to decide are those under Article 123 EPC. Other questions, in particular that of inventive step in relation to this claim 1, have not yet been considered by the first instance, nor have the parties focussed their arguments on this issue. Accordingly the Board considers it appropriate to exercise its powers under Article 111(1) EPC to refer the case back for further consideration on the basis of the auxiliary request submitted at the oral proceedings.

Order

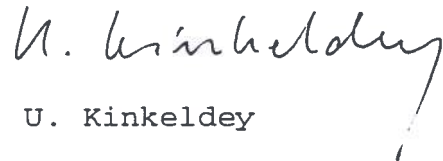
For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further consideration on the basis of the auxiliary request submitted at oral proceedings on 15 September 1995.

The Registrar:


L. McGarry

The Chairwoman:


U. Kinkeldey

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