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D E C I S I O N
of 13 September 2001

Case Number: T 0331/98 - 3.3.2

Application Number: 93200313.0

Publication Number: 0555917

IPC: A23D 9/00

Language of the proceedings: EN

Title of invention:
Non-temper filling fats

Patentee:
UNILEVER N.V., et al

Opponent:
N.V. Vandemoortele International

Headword:
Filling fats/UNILEVER

Relevant legal provisions:
EPC Art. 54(3) and (4), 111(1)
EPC R. 57(a)

Keyword:
"Main request - novelty: no - error in anticipating prior art
example not shown."
"First auxiliary request - remittal to the first instance."

Decisions cited:

-

Catchword:

-



Case Number: T 0331/98 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 13 September 2001

Appellant:
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Decision under appeal: Interlocutory decision of the Opposition Division
of the European Patent Office posted 27 January
1998 concerning maintenance of European patent
No. 0 555 917 in amended form.

Composition of the Board:

Chairman: P. A. M. Lançon
Members: J. Riolo
S. U. Hoffmann

Summary of Facts and Submissions

- I. European patent No. 0 555 917 based on application No. 93 200 313.0 was granted on the basis of 8 claims.

Independent claim 1 as granted read as follows:

"1. Cool-melting, non-temper, non-trans filling fat comprising a fat blend having the composition:

% SUS = 51-80 wt%;

% S₃' = less than 5 wt%, preferably less than 3 wt%;

% (U₂S + U₃) = 7-60 wt%, preferably 10-50 wt%;

% SSU = less than 40 wt%;

weight ratio SUS/SSU < 6;

S = saturated fatty acid having 16-18 C atoms;

S' = saturated fatty acid having 10-24 C atoms;

U = unsaturated fatty acid having 16-22 C atoms, in particular C_{18:1}."

- II. Notice of opposition was filed against the granted patent by the opponent.

The patent was opposed under Article 100(a) EPC for lack of novelty and lack of inventive step.

The following documents were *inter alia* cited during the proceedings.

(6) EP-B-536 824

(7) EP-A-347 006

- III. The interlocutory decision of the Opposition Division established that the patent could be maintained in an amended form under Article 106(3) EPC on the basis of the set of claims filed on 5 September 1997.

Independent claim 1 of this set of claims read as follows:

"1. Cool-melting, non-temper, non-trans filling fat comprising a fat blend having the composition:

% SUS = 51-80 wt%;

% S₃' = less than 5 wt%, preferably less than 3 wt%;

% (U₂S + U₃) = 7-60 wt%, preferably 10-50 wt%;

% SSU = less than 40 wt%;

weight ratio SUS/SSU < 6;

whereas the non-trans filling fat has a C_{16:0} content of > 35 wt% and a C_{18:0} content of < 8 wt%;

S = saturated fatty acid having 16-18 C atoms;

S' = saturated fatty acid having 10-24 C atoms;

U = unsaturated fatty acid having 16-22 C atoms, in particular C_{18:1}."

The Opposition Division considered that document (6), submitted at the beginning of the oral proceedings, was filed too late to be introduced into the proceedings.

It added that this document was not suitable for raising objections under Article 54(3) and (4) EPC as it was the published document of the granted patent instead of the published document of the patent application and as the validity of the priority dates was not investigated. It was also questionable whether the disclosure in the EP-B document and the EP-A document was identical.

It submitted moreover that the content of document (6) was not prima facie relevant because two technical features of the claimed composition of the contested patent were missing, namely the SSU content and the (U₂S + s₃) content.

During the oral proceedings, all other requests previously raised in the written submissions were dropped.

IV. The appellant (opponent) lodged an appeal against the said decision and filed document (8) EP-A-536 823, the published patent application related to the published patent (6).

V. Two sets of claims as first and second auxiliary requests were filed on 16 August 2001 by the respondent (patentees).

The set of claims of the first auxiliary request corresponds to the set of claims maintained by the Opposition Division wherein the N_{20} value of more than 20% of claim 5 was incorporated into claim 1.

VI. Oral proceedings were held before the Board on 13 September 2001.

VII. The appellant maintained the grounds of opposition under Article 100(a) EPC as to the lack of novelty of the patent in suit under Article 54(3) and (4) EPC compared with document (8).

Although it agreed that the conflicting European application (8) did not mention *expressis verbis* either the SSU content or the $(U_2S + S_3)$ content of the Palm Mid Fraction (PMF) described in examples I and II, it contended that these features were implicitly disclosed in (8) for the skilled person.

As evidence, the appellant filed *inter alia* document (7) to show that it was generally known that PMF products contained on average around 6 to 7 wt% of SSO (O: oleic acid) and that the $(U_2S + S_3)$ content was merely the remainder up to 100%.

It therefore concluded that composition 6 of example II of document (8) anticipated the claimed composition of the contested patent.

The appellant put forward no other objections.

VIII. The respondent contested that document (8) could be brought into the appeal as it was not *prima facie* relevant since it required a detailed discussion and complementary documents.

It moreover considered that the SOS value of 70% given for the PMF product in example I was in fact a typing error, since it was not compatible with the value of 85% given for the POP triglyceride (P: palmitic acid), which is a subclass of the SOS triglycerides.

In its opinion, this view was also supported by the fact that the calculations made by the appellant conflicted with the requirement expressed in document (8) that the SSO to SOO ratio of the fats should be more than 3.

IX. The appellant requested that the decision under appeal be set aside and that patent No. 0 555 917 be revoked or auxiliarily that the matter be referred to the Opposition Division.

The respondent requested that the appeal be dismissed and that the patent be maintained with the claims as granted by the Opposition Division (main request), or with the set of claims of the first or second auxiliary requests, both filed on 16 August 2001.

Reasons for the Decision

1. *The appeal is admissible.*

2. *Main request*

2.1 Articles 123 and 84 EPC

The set of claims of the main request corresponds to the set of claims maintained by the Opposition Division.

No objection under Articles 123 and 84 EPC was raised by the appellant with respect to this set of claims and the Board sees no reason to differ.

2.2 Novelty

2.2.1 As a preliminary remark, the Board notes that document (8), which has been cited under Article 54(3) EPC as prejudicial to the novelty of the subject-matter of the patent in suit, is an application which was cited in the description of the contested patent and which belongs to the respondent. Moreover, it was introduced into the appeal procedure in response to the objections raised in the decision of the Opposition Division.

Under these circumstances, the Board sees no reason to disregard this document in the appeal procedure.

Document (8) describes in blend number 6 of Example II a blend of 88 wt% PMF and 12 wt% of a PPO-rich fat.

The type of triglycerides for PPO and for PMF is given in Example 1 of document (8). While the complete triglyceride composition of PPO is given in this example, the disclosure of the triglyceride composition of PMF is limited to its SOS and S₃ content, namely 70% SOS and 2% S₃.

During the oral proceedings, the respondent assumed that the SSO content and the SOS content of PMF were representative of the SSU and SUS content of PMF, since the influence on the calculations of the amount of unsaturated fatty acids other than oleic acid, such as for instance linoleic acid, was negligible.

However, document (8) mentions neither the SSU content nor the (U₂S and U₃) content for PMF.

It must therefore be decided whether the skilled person would nevertheless consider these features to be implicitly contained in this document.

Having regard to document (7), which describes typical triglyceride compositions of PMF, the amount of SSO obtained by wet fractionation of palm oil ranges from 3 to 9% (page 3, lines 24 to 29).

In that respect, the appellant also acknowledged during the oral proceedings that this SSO range was in fact independent of the method of preparation and that the amount of SSO in PMF according to example I, which was also prepared by wet fractionation, did indeed lie between 3 and 9 wt%.

Accordingly, as the (U₂S and U₃) content in the triglyceride composition can only be the remainders up to 100 wt%, since there are no triglyceride types other than SUS, S₃, SSU, SUU, USU and S₃, the skilled person would know that the triglyceride composition of the PMF

disclosed in example I and used in blend 6 of example II of document (8) could only be the following: 70 wt% SUS, 2 wt% S₃, between 3 and 9 wt% SSU and between 19 to 25 wt% (U₂S and U₃).

With knowledge of the complete triglyceride composition of PPO and PMF of blend 6 of Example II as well as their FAME, which indicates their fatty acid composition, it can be calculated whether this blend consisting of 88 wt% of palm mid fraction and 12 wt% of a PPO rich fraction corresponds to all characterising features of the fat blend of the main claim of the contested patent.

These calculations, provided by the appellant in its letter dated 28 March 1998, show that all requirements of the composition of claim 1 are fulfilled when the SSU content of PMF is assumed to be 3 wt% and also when it is assumed to be 9 wt%.

The respondent did not contest these calculations *per se*, which it used itself in the tables that it handed over during the oral proceedings, but it submitted that they were done on the basis of wrong premises and alleged an error in the figures in example I of document (8).

- 2.2.2 The Board accepts that, literally speaking, the pronoun "it" in the second sentence of the paragraph of example I reading "PMF: contains...70% SOS... So it consists for about 85 wt% of POP." could refer to either PMF or SOS. However, as POP is one of the triglycerides that is covered by the more generic indication SOS, it can never be higher than the SOS content of PMF. Accordingly, technically speaking, the skilled person can only understand the second sentence as referring to the SOS content.

It therefore sees no reason to assume that, as alleged by the respondent, the 70% and 85% values were switched. This would mean that PMF has an SOS content of 85%, with the result that, as shown by the respondent's calculations in the tables handed over during the oral proceedings, the composition of blend 6 of Example II would no longer fall within the scope of claim 1 of the contested patent.

The Board disputes neither the fact that, as shown by the calculations of the respondent in the tables handed over during the oral proceedings, the SSO to SOO ratio of the fat of this blend is well below 3, nor that this is contrary to the statement in document (8) that the fat composition according to the invention of this document must fulfil the requirement that the SSO to SOO ratio of the fats be more than 3 (page 2, line 22, and claim 1).

The Board notes, moreover, that, as shown by the calculations of the respondent in the tables handed over during the oral proceedings, the SSO to SOO ratio is also not necessarily more than 3 when it is assumed that the SOS content of PMF is 85 wt% instead of 70 wt%.

These considerations do not however call into question the fact that the disclosure in a document must be taken at face value. In point of fact, when assessing novelty, the relevant question remains whether a prior-art disclosure falls within the scope of the claims of the contested patent and not whether a disclosure in a prior-art application is covered by its claims. In that respect, it is pointed out that such discrepancies between the claims and the examples in a non-examined application are not unusual.

This question appears moreover to be irrelevant. In

fact, as the POP content is not relevant for the above-mentioned calculations (see 2.2.1), the skilled person does not need to read that part of the disclosure to assess whether the example anticipates the patent in suit.

Under these circumstances, the Board concludes that it has not been shown that the anticipating example of document (8) is incorrect and based on an error.

The validity of the priority dates of document (8) was not contested by the appellant and the Board sees no reason to differ.

In conclusion, the subject-matter of claim 1 of the main request lacks novelty under Article 54(3) and (4) EPC.

3. *First auxiliary request*

3.1 Articles 123 and 84 EPC

No objection under Articles 123 and 84 EPC was raised by the appellant with respect to this set of claims, and the Board sees no reason to differ. In introducing in claim 1 the feature of claim 6 of the granted patent, the respondent sought to respond to the grounds of opposition.

3.2 Remittal to the department of first instance

The new feature introduced into claim 1 constitutes a restriction of the claims since compositions having less than 20% solid phase at 20°C are now outside the scope of the claims. As such, the amendment of the claims therefore could represent a "selection" which needs to be assessed with respect to novelty.

During the oral proceedings, the appellant sought to demonstrate that blend 6 of example II of document (8) also fulfilled this new requirement. However, the respondent refused to consider these oral submissions, arguing that as the feature introduced in claim 1 had never been contested *per se* before, neither in the opposition nor in the appeal proceedings, it was not in a position to answer these arguments. In that respect, it reminded the Board that the appellant also requested that the matter be referred back to the Opposition Division.

Although the EPC does not guarantee the parties an absolute right to have all the issues in the case considered by two instances, it is well-recognised that any party may be given an opportunity for two readings of the important elements of a case.

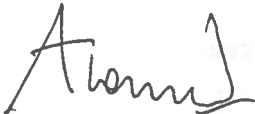
In the present case, the filing at a very late stage of the procedure (namely four weeks before the oral proceedings) of a new set of claims wherein a new feature, which had not been considered *per se* before and which might be decisive for the assessment of novelty, was introduced into claim 1, make it necessary to remit the case to the Opposition Division for further prosecution (Article 111(1) EPC).

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 prosecution.

The Registrar:



A. Townend

The Chairman:



P. Lançon

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