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D E C I S I O N
of 25 July 2000

Case Number: T 0275/99 - 3.3.2

Application Number: 95923108.5

Publication Number: 0766517

IPC: A23L 2/52

Language of the proceedings: EN

Title of invention:
Gellan gum beverage

Applicant:
Monsanto Company

Opponent:
-

Headword:
Beverage/MONSANTO

Relevant legal provisions:
EPC Art. 54, 56, 111(1), 113(1)
EPC R. 67

Keyword:
"Novelty - yes - component of a composition not implicitly disclosed - abstract here insufficient"
"Procedural violation - no - right to be heard fulfilled by reference to the International Preliminary Examination Report (IPER)"
"Remittal - yes - examination of Article 56 EPC requires systematic approach"

Decisions cited:
-

Catchword:

-



Case Number: T 0275/99 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 25 July 2000

Appellant:

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Representative:

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Decision under appeal:

**Decision of the Examining Division of the
European Patent Office posted 5 November 1998
refusing European patent application
No. 95 923 108.5 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: P. A. M. Lançon
Members: U. Oswald
M. B. Günzel

Summary of Facts and Submissions

I. European patent application No. 95 923 108.5, filed as an international application on 22 June 1995 and published under international publication number WO96/00018, was refused by a decision of the Examining Division dated 5 November 1998.

II. The decision was based on the 8 claims filed with the request for entry into the regional phase before the EPO dated 3 December 1996 and received on 7 December 1996. Claim 1 reads as follows:

"A beverage comprising between 0.03 and 0.12% gellan gum and a sequestrant, said beverage displaying rheological properties of a weak gel system when measured using dynamic viscoelastic measurements, while not having a significantly increased viscosity when consumed."

Claims 2 to 6 are dependent on claim 1.

Claims 7 to 8 relate to a process for preparing the beverage of claim 1.

III. The following documents were inter alia cited during the examining procedure:

- (1) Patent Abstracts of Japan, Vol. 018, Nr. 40 (C-1155), 21 January 1994, Abstract of JP5268918
- (2) Research Disclosure, No. 361, May 1994, HAVANT GB, page 237, "Judicious use of sequestrants to optimize KELKOGEL Gellan gum performance in sugar gels"

IV. The decision to refuse the application was issued following the response of the Applicant to the first communication of the Examining Division, said communication referring to the deficiencies mentioned in the international preliminary examination report drawn up for the present application.

V. The Examining Division took the view that in the absence of a request for oral proceedings and in view of the fact that all the necessary arguments for reaching a decision had already been submitted to the Applicant in the form of the international preliminary examination report and were repeated by way of an official communication, the applicant had sufficient opportunity to comment and that accordingly the decision could be issued.

The Examining Division held that the beverage according to claim 1 and the process for preparing it according to claim 7 lacked novelty with regard to document (1). This prior art did not mention the presence of a sequestering agent. However, according to document (1) gellan was used as gelling agent and consequently the composition must contain a sequestering agent because it was well known in the art that gellan belonged to the group of gelling agents which needed sequestering agents in order to gel. Document (2) was cited in support of this argument.

Furthermore, the Examining Division held that the requirements of Rule 27(1)(b) EPC were not fulfilled and that the description had not been adapted to the amended set of claims.

VI. The Appellant (Applicant) lodged an appeal against this

decision.

VII. The Appellant argued that document (1) was silent on the use of sequestrants. Document (2) was not relevant in the present case since it related to optimising gellan gum functionality in non-beverage compositions containing more than 35% sugar and accordingly taught away from the use of sequestrants in compositions containing sugar levels below 35%.

The Appellant argued that his right to be heard under Article 113 EPC had been violated by the Examining Division and thus reimbursement of the appeal fee was justified.

More particularly, it was pointed out that the Examining Division's position as to the disclosure of documents (1) and/or (2) was not clear. Therefore the Appellant had invited the Examining Division to issue at least one further official communication other than a rejection.

Moreover, the Appellant took the view that it was hard to understand why the Examining Division referred to Rule 27(1) EPC and requested the adaptation of the description to claims which were considered not to be patentable as well as the acknowledgement of a prior art which was not clearly and fully examined.

VIII. The Appellant requested:

"I: the decision dated 05. 11. 98 shall be set aside and the patent shall be granted on his application; or alternatively

IA: the application shall be remanded to the Examining Division with a request for completing the granting procedure;

II: the appeal fee shall be reimbursed; and

III: oral proceeding are requested in the event the Board of Appeal would not be willing to grant requests I or IA."

Reasons for the Decision

1. The appeal is admissible.

Amendments

2. The claims of the application were amended during the preliminary examination of the application under the Patent Cooperation Treaty.

The beverage according to present claim 1 is based on claim 2 as originally filed, with the addition of the physical properties that the beverage displays rheological properties of a weak gel system when measured using dynamic viscoelastic measurements according to the description as originally filed on page 5, lines 5 to 7.

The further functional characterisation "*while not having a significantly increased viscosity when consumed*" appears to be based only partially on examples 4 and 6 to 9 as originally filed.

Having regard to the relevant passages of these

examples "*KELCOGEL F gellan gum was used to suspend fruit pulp in an orange beverage without significantly increasing beverage viscosity*" (Example 4); "*Gellan gum was used to prepare a [fruit] [coconut] [coffee] [honey/apple] gel beverage without significantly increasing beverage viscosity*" (Examples 6 to 9), and taking into account that there appears to be no further basis in the application as originally filed, it appears doubtful whether the said functional characterisation relates to the beverage **when consumed**. The same applies to present claim 7 relating to a process for preparing the beverage according to claim 1 which appears to be based on original claim 14 relating to a **gelled** beverage but now including the said functional features. Moreover, Examples 8 and 9 clearly indicate that "*the resulting product is a gelled product which can be consumed following shaking to break the gel matrix*", whereas Examples 6 and 7 indicate that "*the resulting product is a weakly gelled product which can be consumed through a straw due to the product becoming liquid on suction*".

Since the Examining Division did not base its decision on the said functional features and since the outcome of the present decision is not affected by the said functional features, the question whether the subject-matter of the amended claims fulfils the requirements of Article 123(2) EPC can be left open for the time being.

Novelty

3. Document (1) is an abstract and discloses a drink exhibiting a gelatinised form in cooled state and

fluidisable by shaking, said drink being prepared by adding gellan gum as a gelling and stabilising agent to a dessert-like drink, and thermally sterilising the mixture. The gellan gum is added in an amount of 0.05 to 0.20% based on the raw material.

- 3.1 The Board notes that the range of the amounts of gellan gum required in the presently claimed beverage does indeed overlap with the range of the amounts disclosed in document (1) and that the lower limit of 0.05% clearly falls within the claimed range of 0.03 to 0.12%. However, document (1) does not mention the addition of a sequestrant which is an essential feature of the presently claimed beverage.

In this respect the Board cannot share the Examining Division's point of view that document (2) teaches that a sequestering agent must necessarily be present in the drink according to (1) because it was well known in the art that gellan belongs to the group of gelling agents which need sequestering agents in order to gel.

- 3.2 Document (2) also as an abstract discloses that gellan gum requires ions, for example calcium ions, to provide optimal gel strength (see first paragraph). It is clearly explained that only in the presence of a high concentration of sugars must the ion concentration required to form the gel be controlled (see second paragraph) and that if the calcium level is too high a sequestering agent can be used to decrease the concentration of interfering calcium ions (see third paragraph). The worked example of document (2) shows a composition including 0.2% Kelcogel F, a gellan-gum containing product outside the range claimed in the application.

Accordingly, document (2) teaches the use of a sequestering agent only in a particular case, namely for products having a high concentration of sugar, such as confections, fillings, icings, frostings, toppings and fruit preparations (see last paragraph).

3.3 The other **abstracts** cited in the European search report, as well as document WO 94/24887 which is to be taken into account under Article 54(3) EPC, neither contain the teaching that the addition of a sequestering agent to gellan gum must in any case be considered as a feature implicitly disclosed, nor disclose the combination of a sequestrant and gellan gum within the claimed range. Accordingly, the reasoning of the Examining Division cannot be followed and its conclusion cannot be maintained in so far as at least novelty cannot be denied on the basis of document (1) as read by a skilled person.

3.4 Article 54 EPC clearly says "the state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in other way, before the date of filing of the European patent application...".

The abstract of a document as such falls under this definition but may be cited only under the condition that it addresses to those skilled in the art technically meaningful information. Nevertheless such a document remains to be a summary which cannot be regarded as representing each element of the original document. Taking into account such incompleteness of an abstract citation it rests to the person responsible for citing the abstract (examiner) to verify whether or not the disclosure of the abstract gives raise to

examine the full content of the original document. In the present case indeed some of the abstracts cited in the European search report appear to disclose matter which gives rise to a full examination of the original document. Particular attention is drawn, inter alia, to Derwent Abstract AN 89-049865, corresponding to JP 870161497 870629, describing an aqueous solution of 0.03-2 w/w% of gellan gum where, in the case of an aqueous solution of 0.5% gellan gum, citric acid (a potential sequestrant) can be used as an additive.

4. *Remittal*

4.1 The Examining Division examined and decided that the subject-matter of claims 1 and 7 was not novel under Article 54 EPC in relation to document (1) and left open in the appealed decision the issue of inventive step under Article 56 EPC. From a purely procedural point of view this cannot be objected to.

4.2 Nevertheless, the question of inventive step was raised by the Examining Division in the official communication pursuant to Article 96 (2) and Rule 51 (2) EPC when referring to the IPER (International Preliminary Examination Report under the Patent Cooperation Treaty). Since, however, it merely mentioned that document (1) was relevant to the assessment of inventive step and that the problem underlying the present invention could have been solved in an obvious way, the Board cannot consider that an extensive examination of this issue was performed by the first-instance department. The assessment of inventive step clearly must be carried out on the basis of a systematic approach, which is common practice in the EPO examination procedure and entails discussing

obviousness of the claimed solution in the light of the disclosure of the whole available prior art.

4.3 Accordingly, the Board finds it appropriate to remit the case to the Examining Division for further prosecution, all the more so since the outcome of the decision under point 3 above may even require further examination of the prior art under Article 54 EPC.

5. *Reimbursement of the appeal fee*

5.1 According to Rule 67 EPC, the reimbursement of the appeal fee is ordered in the event of interlocutory revision or where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

5.2 The Appellant sees a violation of his rights in the fact that despite his request filed in response to the Examining Division's communication dated 2 September 1998, i.e. the request to issue at least one further official communication the examining division had immediately refused the application.

5.3 According to Article 113(1) EPC, a decision of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. In the context of the examining procedure under Articles 96 and 97 EPC, Article 113(1) EPC is intended to ensure that, before a decision refusing an application is issued, the Applicant has been clearly informed of the legal and factual reasons on which the decision is based.

No party should be taken by surprise by reasons given

in a decision rejecting his request on which he had no opportunity to comment.

- 5.4 In the Board's opinion, the requirements set forth above were fulfilled in the decision of the Examining Division. The appealed decision was entirely based on the grounds, facts and evidence which were already known to the appellant from the extensive international preliminary examination report (IPER) which had been drawn up for the description and the claims of the international application corresponding exactly to the European application refused and which had been incorporated by way of reference in the official communication of the Examining Division dated 20 November 1997.

Consequently, in the present case the Board cannot see a violation of the Appellant's right to be heard and the request for a reimbursement of the appeal fee has to be refused.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The appeal fee is not refunded.

The Registrar:

The Chairman:

M. Dainese

P. A. M. Lançon