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**Datasheet for the decision  
of 30 August 2024**

**Case Number:** T 1925/22 - 3.3.03

**Application Number:** 14809954.2

**Publication Number:** 3068804

**IPC:** C08B37/00

**Language of the proceedings:** EN

**Title of invention:**

METHOD OF PROCESSING SEAWEED AND RELATED PRODUCTS

**Patent Proprietor:**

Marine Biopolymers Ltd.

**Opponent:**

Alginor ASA

**Relevant legal provisions:**

EPC Art. 123(2)

**Keyword:**

Amendments - selections from two or more lists - added  
subject-matter (yes)

**Decisions cited:**

T 1621/16



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Case Number: T 1925/22 - 3.3.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.03**  
**of 30 August 2024**

**Appellant:** Alginor ASA  
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**Representative:** Lawrie IP Limited  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
30 May 2022 concerning maintenance of the  
European Patent No. 3068804 in amended form.**

**Composition of the Board:**

**Chairman** D. Semino  
**Members:** M. Barrère  
L. Basterreix

## **Summary of Facts and Submissions**

- I. The appeal of the opponent lies from the interlocutory decision of the opposition division concerning maintenance of European Patent No. 3 068 804 in amended form on the basis of the claims of auxiliary request 2 filed initially as auxiliary request 4 with letter of 5 March 2021 and an adapted description.
- II. In that decision the opposition division held, *inter alia*, that claim 1 of auxiliary request 2 satisfied the requirements of Article 123(2) EPC.
- III. The opponent (appellant) filed an appeal against said decision.
- IV. With the rejoinder to the statement of grounds of appeal, the patent proprietor (respondent) filed nine sets of claims as auxiliary requests 1 to 9.
- V. The parties were summoned to oral proceedings and a communication under Article 15(1) RPBA was subsequently issued, setting out the preliminary views of the Board on the issues relevant to the present case. In particular, the Board indicated that claim 1 of the main request and of the auxiliary requests did not appear to comply with the requirements of Article 123(2) EPC.
- VI. With letter dated 23 August 2024, the respondent indicated that they would not attend the oral proceedings and would not be represented thereat. With letter dated 26 August 2024, they submitted further

arguments concerning the fulfilment of the requirements of Article 123(2) EPC for auxiliary request 2.

VII. Oral proceedings were held before the Board on 30 August 2024 in the absence of the respondent.

VIII. The requests of the parties were as follows:

(a) The appellant requested that the decision under appeal be set aside and the patent be revoked.

(b) The respondent requested that the appeal be dismissed and the patent be maintained on the basis of the auxiliary request considered allowable by the opposition division (new main request of the respondent) or, alternatively, that the patent be maintained in amended form on the basis of one of auxiliary requests 1 to 9 and the related amended descriptions filed with the rejoinder to the statement of grounds of appeal.

IX. Claim 1 of the auxiliary request considered allowable by the opposition division (main request of the respondent) read as follows:

"1. A process for obtaining a target chemical species from seaweed, said process comprising the steps of:

(i) providing a seaweed portion comprising a stipe;

(ii) removing all of an outwardly facing surface layer of the stipe comprising an epidermis layer and a meristoderm layer, wherein the outwardly facing surface layer of the stipe that is removed

has a thickness of between approximately 0.5 mm and approximately 2.5 mm;

(iii) dividing the stipe into a plurality of portions by: (i) cutting, followed by (ii) milling;

(iv) washing the plurality stipe portions with water at a temperature of between approximately 40°C and approximately 90°C, between approximately 15 minutes and approximately 45 minutes; and

(iv) extracting the target chemical species from the plurality of stipe portions."

Claim 1 of auxiliary request 1 differed from claim 1 of the main request in that:

the washing step was carried out at a temperature of between approximately **70°C** and approximately **85°C** (modifications in **bold** here and below).

Claim 1 of auxiliary request 2 differed from claim 1 of auxiliary request 1 in that:

the washing step was carried out during between approximately **20** minutes and approximately **30** minutes.

Auxiliary requests 3 to 5 differed from the main request and auxiliary requests 1 and 2 respectively in that the following limitation was introduced at the end of claim 1:

**"wherein:**

**the target chemical species is alginate; and  
the seaweed is laminaria hyperborea."**

Claim 1 of auxiliary request 6 differed from claim 1 of the main request in that:

in step (iii), **"the milled portions have a particle size having a largest diameter of between approximately 4.5 mm and approximately 250  $\mu$ m".**

Auxiliary requests 7 to 9 differed from auxiliary requests 3 to 5 respectively in that the following limitation was introduced in claim 1:

in step (iii), **"the milled portions have a particle size having a largest diameter of between approximately 2.36 mm and approximately 250  $\mu$ m".**

The remaining claims of these requests are not relevant to this decision.

X. The appellant's submissions, in so far as they are pertinent to the present decision, may be derived from the reasons for the decision below. They were essentially as follows:

(a) Article 123(2) EPC

Claim 1 of the main request and of auxiliary requests 1 to 9 did not comply with the requirements of Article 123(2) EPC.

XI. The respondent's submissions, in so far as they are pertinent to the present decision, may be derived from the reasons for the decision below. They were essentially as follows:

(a) Article 123(2) EPC

Claim 1 of the main request and of auxiliary requests 1 to 9 met the requirements of Article 123(2) EPC.

## Reasons for the Decision

**Main request** (patent as maintained by the opposition division)

1. Article 123(2) EPC

1.1 Claim 1 of the main request corresponds to original claim 1 with the following amendments (deletion in ~~strikethrough~~ and additions in **bold**):

"1. A process for obtaining a target chemical species from seaweed, said process comprising the steps of:

(i) providing a seaweed portion comprising a stipe;

(ii) removing ~~at least a portion~~ **all** of an outwardly facing surface **layer** of the stipe **comprising an epidermis layer and a meristoderm layer, wherein the outwardly facing surface layer of the stipe that is removed has a thickness of between approximately 0.5 mm and approximately 2.5 mm;**

(iii) dividing the stipe into a plurality of portions **by: (i) cutting, followed by (ii) milling;**

**(iv) washing the plurality stipe portions with water at a temperature of between approximately 40°C and approximately 90°C, between approximately 15 minutes and approximately 45 minutes; and**

(iv) extracting the target chemical species from the plurality of stipe portions".

1.2 According to the appellant, claim 1 of the main request was the result of multiple selections from lists disclosed in claims 7, 24 and 25 as originally filed. Original claim 7 presented five different options for the outwardly facing surface of the stipe, from which the combination of the epidermis layer and the meristoderm layer was selected. In addition, specific selections of temperature and time ranges (taken from original claims 24 and 25) were introduced in present claim 1. The appellant further argued that the combination of six specific original claims (4, 7, 10, 19, 24 and 25) with claim 1, out of 41 possible dependent claims, and the additional selection from original claim 19 of a thickness of 0.5 mm to 2.5 mm rather than the most preferred range of 0.5 mm to 1.5 mm, contributed to the arbitrary nature of the subject-matter in claim 1 of the main request. For these reasons, the subject-matter of claim 1 of the main request would go beyond the content of the application as filed contrary to the requirements of Article 123(2) EPC (statement of grounds of appeal, point 4; letter dated 27 July 2023, pages 4 and 5 and letter dated 30 July 2024, page 2, fourth paragraph to page 3, fifth full paragraph).



1.3 The respondent agreed with the opposition division's assessment of the ranges disclosed in original claims 24 and 25 as "cascading ranges", with narrower ranges being clearly preferred. They contended that combining a selection from claim 7 with the preferred ranges of claims 24 and 25 did not constitute multiple selections from multiple lists but rather a combination of one single selection with preferred embodiments of the application as filed. Additionally, the respondent disagreed with the assertion that the features taken from claim 7 represented a selection from a list, arguing that claim 7 described the outwardly facing surface layer of the stipe, which may not always include epiphytes.

The respondent further referred to decision T 1621/16 concerning selections from lists of converging alternatives, highlighting that such selections did not necessarily lead to the singling out of an invention but rather to subject-matter based on a more or less restricted version of said feature. They argued that the application as filed provided support for the specific combination of features of claim 1 of the main request, primarily through the detailed description and the dependencies of claims 24 and 25 on preceding claims. Consequently, present claim 1 would comply with the requirements of Article 123(2) EPC (rejoinder, page 3, point 4.1 to page 5, point 4.10).

1.4 With regard to claim 1, the Board does not consider that it meets the requirements of Article 123(2) EPC for the following reasons:

1.4.1 It is first noted that the washing step as defined in present claim 1 is limited *inter alia* by the combination of a temperature range (40°C to 90°C) and a

time range (15 to 45 minutes). It is not disputed that these ranges are disclosed individually in claims 24 and 25 as originally filed. However, each of them constitutes a selection from a list of possible ranges. While it is acknowledged that the lists in original claims 24 and 25 are lists of converging alternatives, it does not necessarily mean that the multiple selections from said lists meet the requirements of Article 123(2) EPC. Instead, according to the so-called "gold standard" the combination should be directly and unambiguously derivable from the application as originally filed, which condition can be considered to be met, as noted in T 1621/16 (point 1.7.3 b) of the reasons), if the combination of features of present claim 1 (and specifically the selection of the two ranges) is supported by a pointer in the application as filed.

- 1.4.2 In the present case, the Board does not consider that there is any direct and unambiguous disclosure of, and in particular no pointer to, this particular combination of ranges in the application as filed. Firstly, contrary to the respondent's view, these ranges (40°C to 90°C and 15 to 45 minutes) are not identified as preferred embodiments of the claimed invention. The wording of original claims 24 and 25, which use the adverb "optionally" rather than "preferably", does not support this argument. Secondly, in the example of the application as filed (page 25, lines 9 to 11), the washing step is carried out at 70°C, which cannot be seen as a pointer for any of the temperature ranges disclosed in original claim 24 (indeed 70°C falls under the three ranges of said claim). The same applies to the time range which is 15 to 45 minutes at 70°C but can vary between 10 and 60 minutes in the example depending on the temperature and

number of washing stages (page 26, lines 12 to 15). For these reasons, the Board fails to recognise a pointer in the application as filed for the combination of ranges specified in present claim 1.

- 1.4.3 In addition, the Board agrees with the appellant that the step of removing a surface comprising an epidermis layer and a meristoderm layer is an additional selection for the following reasons:

According to original claim 7 (read in combination with original claim 1), the outwardly facing surface to be removed comprises "an epidermis layer, and/or a meristoderm layer, and/or epiphytes". However, it is not disputed that all stipes inherently possess a meristoderm and an epidermis (the epidermis being the upper layer) while epiphytes are organisms growing on a surface of the seaweed (rejoinder, page 3, paragraph 4.2).

Consequently, original claim 7 (in combination with claim 1) encompasses at least three distinct embodiments:

1. removal of the meristoderm, epidermis, and any present epiphytes;
2. removal of only the epidermis and any present epiphytes;
3. removal of epiphytes only.

While the appellant contended that there were five potential options (letter dated 30 July 2024, page 2, fourth paragraph to page 3, fifth full paragraph), the precise number of alternatives is not determinative in this context. The central point is that the selection of the first option – removal of meristoderm,

epidermis, and epiphytes, if present – constitutes a selection from a list of alternative embodiments disclosed in original claim 7.

- 1.4.4 Consequently, as the application as filed does not contain any direct and unambiguous disclosure, nor any pointer for the above multiple selections (selection of a temperature range, selection of a time range and selection of a surface to be removed), the subject-matter of present claim 1 goes beyond the content of the application as filed contrary to the requirements of Article 123(2) EPC.

#### **Auxiliary request 1**

- 1.5 Claim 1 of auxiliary request 1 differs from claim 1 of the main request in that:

the washing step is carried out at a temperature of between approximately **70°C** and approximately **85°C**.

- 1.6 The respondent argued that the limitation of the temperature to the most preferred temperature range of original 24 improved their position with regard to the appellant's objection under Article 123(2) EPC (rejoinder to the statement of grounds of appeal, page 22, penultimate full paragraph).

- 1.7 As explained above (see point 1.4), the Board considered that the subject-matter of claim 1 of the main request was the result of three selections from three different lists (selection of a temperature range, selection of a time range and selection of a surface to be removed) and that, in the absence of a pointer, there was no direct and unambiguous disclosure of these multiple selections in the application as

filed. Even if, as argued by the respondent, the temperature range of 70 to 85°C were the most preferred range disclosed in the application (which is not necessarily the Board's position), it remains that two selections would still be necessary to arrive at the subject-matter of claim 1 of auxiliary request 1. In the absence of any pointer to these selections (selection of a time range and selection of a surface to be removed), the Board has to come to the conclusion that the subject-matter of claim 1 of auxiliary request 1 extends beyond the content of the application as filed contrary to the requirements of Article 123(2) EPC.

#### **Auxiliary request 2**

1.8 Claim 1 of auxiliary request 2 differs from claim 1 of the main request in that the washing step is carried out:

at a temperature of between approximately **70°C** and approximately **85°C**,

between approximately **20** minutes and approximately **30** minutes.

1.9 The respondent contended that the limitations of the temperature and time ranges corresponded to the most preferred embodiments of original claims 24 and 25 (letter dated 26 August 2024, page 2, second main bullet point to page 3, fourth paragraph). Furthermore, it was clear from the example of the application as filed that the washing temperature was between 70°C and 85°C, constituting a pointer to that specific range.

1.10 The appellant stated that it could not be inferred from the application as filed that the temperature and time ranges as defined in present claim 1 were preferred. Moreover, the example of the patent could not be considered to point to these ranges, since it disclosed three successive washing steps carried out for periods of 15 to 45 minutes (for the first step) and 15 minutes (for the second and third steps). However, there was no mention of a period of 20 to 30 minutes.

1.11 A first question to be answered by the Board is whether it can be considered that the list of ranges disclosed in original claims 24 and 25 converge from the less preferred to the most preferred embodiments. For the sake of clarity these claims are copied below:

*"24. A process as claimed in any preceding claim, comprising the further step of washing the plurality of stipe portions with water, optionally at a temperature of between approximately 25 °C and approximately 90 °C, optionally between approximately 40 °C and approximately 90 °C, optionally between approximately 70 °C and approximately 85 °C.*

*25. A process as claimed in claim 24, wherein the plurality of stipe portions are washed between approximately 10 minutes and 60 minutes, optionally between approximately 15 minutes and approximately 45 minutes, optionally between approximately 20 minutes and approximately 30 minutes."*

1.12 In the Board's view, the use of the term "optionally" rather than "preferably" does not convey any information as to the preference of a specific embodiment compared to another. Instead the term

"optionally" suggests only that the temperature and time ranges listed are not mandatory; they are just possibilities. This means the process could be performed within any of the optional ranges, or it could be carried out outside these ranges. While it is correct that the ranges of original claims 24 and 25 are converging, the Board has no reason to consider that the narrowest ranges should necessarily be the most preferred (in particular as there is no other teaching in the application as filed supporting that interpretation). Consequently, the Board is of the opinion that the choice of a temperature of 70 to 85°C and a time range of 20 to 30 minutes are still selections from two lists of alternative converging embodiments.

- 1.13 A second question to be answered is whether the application as filed contains a pointer to the selections of a temperature range of 70 to 85°C in combination with a time range of 20 to 30 minutes.
- 1.14 In that respect, the Board agrees with the appellant that the sole example of the application as filed (see bridging paragraph between pages 25 and 26) discloses three successive washing steps carried out for periods of 15 to 45 minutes (for the first step) and 15 minutes (for the second and third steps). However, for none of these individual steps, nor for the whole washing a period of 20 to 30 minutes was chosen. In fact, the original description teaches that *"depending on the temperature and the number of washing stages, the time used for each stage can vary, and is typically from about 10 minutes to about 60 minutes"* (see page 26, lines 12 to 15). A similar teaching applies to the temperature which is not particularly limited (see page 26, lines 8 to 10). Hence it cannot be inferred from

the description that any one of the temperature and time ranges is particularly advantageous. Furthermore, the example does not point to the combination of a temperature and time range as defined in present claim 1.

- 1.15 Consequently, in the absence of any pointer to the present threefold selections (selection of a temperature range, selection of a time range and selection of a surface to be removed), the subject-matter of claim 1 of auxiliary request 2 goes beyond the content of the application as filed contrary to the requirements of Article 123(2) EPC.

#### **Auxiliary requests 3 to 9**

- 1.16 Regarding the higher-ranking requests, the Board determined that claim 1 did not meet the requirements of Article 123(2) EPC due to multiple selections lacking direct and unambiguous basis in the application as filed. These selections were:

- a temperature range chosen from a list of converging options (from original claim 24),
- a time range selected from a list of converging options (from original claim 25),
- an outwardly facing surface picked from a list of options (from original claim 7).

- 1.17 Claim 1 in auxiliary requests 3 to 9 contained the same selected features, and the respondent provided no additional arguments regarding these selections.

- 1.18 Consequently, for the same reasons as for the higher-ranking requests (above points 1.4, 1.7 and 1.15), the Board must conclude that claim 1 of auxiliary requests



3 to 9 also fails to meet the requirements of Article 123(2) EPC.

2. As none of the respondent's requests meets the requirements of Article 123(2) EPC, there is no need to deal with any other issue and the patent is to be revoked.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



D. Hampe

D. Semino

Decision electronically authenticated