

**OPINION UNDER SECTION 74A**

Patent	GB 2614513 B
Proprietor(s)	Corn Products Development, Inc.
Exclusive Licensee	
Requester	Bryers Intellectual Property Ltd
Observer(s)	
Date Opinion issued	26 February 2025

**The request**

1. The comptroller has been requested to issue an opinion regarding the validity of GB 2614513 (“the patent”), specifically that it lacks novelty and an inventive step in view of each of several prior art documents and common general knowledge and also that it lacks sufficiency of disclosure.
2. Observations have been filed on behalf of the proprietor and observations in reply received from the requester.

**Preliminary matters****Timeline**

3. The request for an opinion was initially filed on 23 October 2024 and the Office responded with a letter of 31 October 2024 expressing a preliminary view that the request should be refused as being inappropriate in all the circumstances and offering the requester an opportunity to submit arguments and observations. The basis for this preliminary view was that the prior art referred to in the request had been adequately considered during pre-grant processing of the application by virtue of being substantially similar to third-party observations filed on 6 June 2024.
4. The requester responded with a letter dated 5 November 2024 arguing that two of the documents accompanying the request had not been adequately considered prior to grant by virtue of arguments filed as third-party observations filed on 4 July 2024. They also pointed out that their request also concerned sufficiency of disclosure and argued that this raised new questions.
5. The Office responded in a letter of 18 November 2024 accepting that the opinion request should proceed on the basis that the question of sufficiency of disclosure

had not been considered previously and should consider only that question. A further opportunity to submit arguments and observations was offered.

6. The requester responded on 22 November 2024 with further arguments that the request raised new questions of novelty and inventive step. The Office responded on 5 December 2024 to the effect that the opinion could proceed on the basis of the question of sufficiency of disclosure and to further consider some of the issues raised in the request, offering an opportunity to re-submit the opinion request statement.
7. The requester re-submitted their Statement of Grounds and enclosures D1 to D26 on 6 December 2024 at which point the Office communicated the request to the proprietor in a letter dated 12 December 2024 and the request was passed to me as the examiner.
8. Observations from the proprietor were filed on 23 January 2025 arguing that the request should be refused in its entirety and commenting on the objections raised in the Statement of Grounds accompanying the request.
9. The observations also included a request to be allowed to submit experimental data prior to the issuance of an opinion and to be provided with sufficient time to perform such experiments in the event that the examiner intended to allow the request and would not acknowledge the novelty of claim 1 based upon written arguments alone.
10. Observations in reply were filed by the requester on 4 February 2025 disputing the arguments from the requester regarding refusal of the opinion, arguing that the requests to make further submissions should be refused and seeking a finding that the patent is clearly invalid and further that the Office should initiate revocation proceedings.
11. The Office responded to the proprietor by E-mail on 7 February 2025 explaining that it would not be possible to file further experimental data to be considered as part of the opinion.

## **Refusal of the request**

### ***The law and case law***

12. The law relating to opinions is set out in sections 74A and 74B of the Patents Act and in associated rules 92 to 100 of the Patents Rules 2007. The relevant provisions so far as this opinion is concerned are:

#### Section 74A(1)

*The proprietor of a patent or any other person may request the comptroller to issue an opinion on a prescribed matter in relation to the patent.*

#### Section 74A(3)

*The comptroller shall issue an opinion if requested to do so under subsection (1) above, but shall not do so-*

*(a) in such circumstances as may be prescribed, or*

(b) if for any reason he considers it inappropriate in all the circumstances to do so.

Rule 94(1)

The comptroller shall not issue an opinion if—

- (a) the request appears to him to be frivolous or vexatious; or
- (b) the question upon which the opinion is sought appears to him to have been sufficiently considered in any relevant proceedings.

Rule 95(1)

The comptroller must notify each of the following persons of the request (except where the person concerned is the requester)—

- (a) the patent holder;

...

Rule 95(4)

The comptroller must advertise a request in such manner as he thinks fit.

Rule 96

(1) If the request has not been refused or withdrawn, any person may, before the end of the relevant period, file observations on any issue raised by the request.

(2) Such observations may include reasons why the comptroller should refuse the request.

13. As far as I am aware the refusal of an opinion under Section 74A has not been considered by the UK courts, although such refusals have been considered several times in decisions of the Office. These include *Franks Opinion Request* (BL O/289/07) (“*Franks*”)<sup>1</sup>, *Naylor Opinion Request* (BL O298/07) (“*Naylor*”)<sup>2</sup>, *Automation Conveyors Limited Opinion Request* (BL O/370/07) (“*Automation Conveyors*”)<sup>3</sup> and *Kohn & Associates PLLC Opinion Request* (BL O/310/21) (“*Kohn*”)<sup>4</sup> and *E-link Technology Co. Ltd Opinion Request* (BL O/681/21) (“*E-Link*”)<sup>5</sup>.

14. These decisions are consistent, as the Hearing Officer in *E-Link* put it:

*“It was always the intention that the opinion service would not be used to repeat or in some way reappraise the examination of the patent performed either in this Office or at the European Office. Rather, the intention was that there should be something new and the request should not simply seek to go over old ground. The rationale is that a patentee should not be asked to deal again with a question that he has already dealt with to the satisfaction of the Office pre-grant.”*

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<sup>1</sup> see <https://www.ipo.gov.uk/p-challenge-decision-results/o28907.pdf>

<sup>2</sup> see <https://www.ipo.gov.uk/p-challenge-decision-results/o29807.pdf>

<sup>3</sup> see <https://www.ipo.gov.uk/p-challenge-decision-results/o37007.pdf>

<sup>4</sup> see <https://www.ipo.gov.uk/p-challenge-decision-results/o31021.pdf>

<sup>5</sup> see <https://www.ipo.gov.uk/p-challenge-decision-results/o68121.pdf>

15. It is clear from these decisions that the pre-grant examination process is not “*relevant proceedings*” for the purposes of Rule 94(1) and not issuing an opinion because a question had already been considered during that process should be because the Comptroller considers it inappropriate in all the circumstances to do so, as provided by section 74A(3)(b).

16. According to the Hearing Officer in *Naylor*:

*“I should perhaps add that I do not believe that every request for an opinion should be required to cite a new piece of prior art but rather that it should at least put forward a new question. In this case I can find no new question. The prior art relied on was clearly considered during the examination process - indeed it was cited against the novelty of the patent application in two separate examination reports. Consequently, I do not believe that the request gives rise to any new question”*

17. The point was expanded upon by the Hearing Officer in *Automation Conveyors* (the emphasis is mine, but largely the same as the emphasis added by the Hearing Officer in *Kohn*):

*32. But what is “a new question or argument”? Mr. Wallin suggested that a new question “just has to be something that you can see from the prosecution history has not been considered before”. I agree with this statement, although I think I probably differ with him over the detail of what it means in practice. **It is an intrinsic part of the substantive examination process to assess the novelty and obviousness of the claims, as properly construed, in the light of the prior art. In this context, “prior art” means documents cited in the search report (at least under category “X” or “Y”, which indicate possible relevance to novelty or inventive step) as well as material which has come to the examiner’s attention in some other way. I think it reasonable to suppose in general that the examiner will have done his or her job properly in the absence of indication to the contrary, and I see no reason why this assumption should not apply even if the examiner has decided not to raise objection on the basis of any of the citations at substantive examination.***

*33. Having said that, I have to acknowledge the possibility that a decision by an examiner to discount a citation might be shown to have been clearly perverse, in the sense that no reasonable person could have reached it. Only in such a case might it be appropriate to reconsider the citation in an opinion as there could be said to be a new argument.*

*34. I should mention that Mr Wallin also proposed an alternative test by analogy with the one set out by Laddie J in *Series 5 Software* [1996] FSR 273. This concerned an application for an interlocutory injunction, in which there are a number of factors to be taken into consideration, but the one focused on by Mr Wallin was the “likelihood of success”. Obviously a request for an opinion is a very different situation to a request for an injunction when fully litigated proceedings are in prospect, but what I*

*understand Mr Wallin to have been suggesting was that the comptroller should proceed to issue the opinion if there was a significant likelihood that the outcome would be adverse to the patent. **This is a qualitatively different test to that of whether a new question is raised and is not fully consistent with the principle I set out above that the original examiner's decision should not be revisited unless it was clearly perverse. Moreover, it is self-contradictory in the sense that to come to a view on the likely outcome of the opinion process (which is a paper-based procedure) would in practice require investigating the merits of the request to an extent that could effectively mean doing the opinion.***

**35. My conclusion from the above is accordingly that a request for an opinion on validity which argues on the basis of prior art that was cited as category "X" or "Y" in the search report, or as part of a substantive objection at any other time in the examination procedure, is, other than in exceptional circumstances, unlikely to clear the hurdle of raising a new question or argument.**

18. The Hearing Officer in Kohn went on to say

*"It does strike me that the Hearing Officer in Automation did choose their words carefully when they wrote "clearly perverse" and also reinforced this by indicating that this relates to a decision that "no reasonable person" could make. I am satisfied that what the Hearing Officer had in mind was indeed an exceptional circumstance and that they were acknowledging that, although not likely, the possibility could not be eliminated completely. I also consider that "clearly perverse" is a level above "perverse" and that this is intended to allow for a very rare occurrence."*

and

*"From this I consider that the Hearing Officer was satisfied that, unless there is a very clear reason not to, one can assume that the examiner will have carried out their role properly in assessing the novelty and inventive step of an application including when they decide not to pursue an objection as the examination process proceeds."*

and further

*"I believe that this sets a high bar and that this was in line with the intention of the legislator as they saw it, when the provisions concerning opinions were put in place. Thus, while it cannot be discounted completely that a situation might arise concerning an X-document already cited (as in this case) where it would be appropriate to give an opinion, this would indeed be an exceptional circumstance. I further believe that the Hearing Officer in Automation was right to set a high bar – and I do consider that the use of the phrase 'clearly perverse' – does reinforce this. I can see no reason why I should not adopt the same approach in this case."*

### ***This request***

19. I should perhaps first address the question of whether I have any discretion to refuse this request in whole or in part. The requester quotes passages from the Office letter dated 12 December 2024 communicating the request to the proprietor and concludes "*the question on whether the Request for an opinion on validity of the patent should be refused has already been answered in that it will proceed on the basis of the Requester's updated Statement of Grounds.*".
20. I think *Automation Conveyors* assists me here:
  14. *Regarding his first argument Mr. Wallin suggested that there is an order of procedure implied by the Act and Rules according to which, following notification under rule 77E (rule 95 of the 2007 Rules), rule 77F (96) gives to the patentee (and other third parties) an opportunity to file observations, including on the question of refusal of the request. However, once the Office has indicated an intention to refuse a request, as in this case, then section 74A(6) is engaged. Since this specifies in terms that only the requester shall be a party to proceedings concerning whether to issue an opinion, it was Mr Wallin's contention that this overrides rule 77F and effectively closes off the possibility that submissions can be considered from anybody else.*
  15. *I agree that there is a logical progression of events implied in the way the rules are set out although I do not agree entirely with Mr Wallin's analysis. To my mind, the normal course of events is as follows: (1) the request is filed; (2) the Office conducts an initial inspection and forms a view, inter alia, on the question of whether it should be accepted or refused; (3) interested parties are notified and the period for submissions starts to run; (4) submissions, which may address the question of whether or not the comptroller should refuse to issue an opinion, may be received; (5) if submissions on the question of refusal are received, the examiner comes to a view on whether to refuse or proceed with the opinion; (6) if the decision is to proceed, the opinion is drawn up and issued. That I would suggest is the typical sequence of events. However it is crystal clear from the wording of rule 77D(3) (rule 94(3) of the 2007 Rules) that the Office can refuse a request at any time.*
21. Rule 96(2) explicitly allows for observations regarding refusal of a request and so the question of refusal cannot be treated as settled before a request is advertised and relevant persons notified as required by Rule 95.
22. In this instance "*submissions, which ... address the question of whether or not the comptroller should refuse to issue an opinion*" have been received in the observations from the proprietor as in step (5) above and hence it falls to me to come "*to a view on whether to refuse or proceed with the opinion*".
23. The proprietor has argued in their observations that the request should be refused in its entirety. Essentially they argue that the questions in the request cover old ground and were considered prior to grant and hence it would be inappropriate in all the circumstances to issue an opinion on those questions. They believe that questions

of novelty and inventive step were considered not least by virtue of third-party observations filed before the patent was granted. Regarding sufficiency of disclosure they say “*a consideration of sufficiency will inherently have been made by the Examiner in pre-grant examination of the application*”.

24. Taking the sufficiency question first, I have some sympathy with the proprietor here. In the context of considering prior art documents for novelty and inventive step purposes the Hearing Officer in *Automation Conveyors* took the view that “*I think it reasonable to suppose in general that the examiner will have done his or her job properly in the absence of indication to the contrary, and I see no reason why this assumption should not apply even if the examiner has decided not to raise objection on the basis of any of the citations at substantive examination.*”. This followed an observation that “*in pre-grant examination there is no corresponding window on the mind of the examiner*”, contrasting that with proceedings which result in a reasoned decision.
25. Requirements of the Act such as section 14(3) concerning sufficiency will be considered routinely during pre-grant examination. Where no objection has been raised one might infer that the examiner considered the issue and believed that the requirements of the Act had been satisfied. Consequently one might argue that a request for an opinion on sufficiency would be seeking to cover old ground even in the absence of any explicit comment from an examiner such as a pre-grant objection. However, taking a similar approach regarding sufficiency to that which the Hearing Officer took in *Automation Conveyors* regarding prior art documents would make the circumstances in which an opinion could be sought on questions of sufficiency extremely narrow. It seems to me unlikely that this was the intention behind the legislation. The circumstances envisaged in *Automation Conveyors* involved prior art documents that had been raised during the pre-grant examination process, such as by virtue of their appearance in search or examination reports. I suggest that this may be different to an issue that has never made any explicit appearance in the pre-grant examination process.
26. To my mind the question of sufficiency of disclosure in this case is not really covering old ground and I can issue an opinion on this question. I should say that I do not go as far as the requester in their observations in reply when they assert “*that the question of lack of sufficiency of disclosure has not at all been considered during the pre-grant examination proceedings*” nor that “*if it were to be presumed that insufficiency had been implicitly considered by the UK IPO Examiner, then opinion requests dealing with insufficiency would typically be refused, which would seem to **defeat the purpose of the legislation.***”. My view is simply that in this case issuing an opinion regarding the sufficiency of the disclosure of the patent is not inappropriate in all the circumstances.
27. Turning to the novelty and inventive step questions in the request. There are a number of documents D1 to D26 accompanying the request. Of those D24 to D26 are copies of documents concerning the pre-grant processing of two other patent applications, the parent application from which the application for this patent was divided and an application before the European Patent Office equivalent to that parent application. The proprietor has provided a table accompanying their observations showing which references D1 to D23 in the opinion request appear in either of two sets of third-party observations filed respectively before and after an

intention to grant letter was issued by the Office regarding the patent and showing which were cited by the EPO.

28. Except D3, D14, D16 and D23, all of D1 to D23 appeared in the third-party observations concerning the patent. D3 is a chapter from a book published in 2022 that is said by the requester to exemplify common general knowledge. D14 reports on a conference that included a presentation submitted as D13 with the request, D14 being used to establish a publication date for D13. D16 is a magazine article concerning the launch of a commercial product said in the request to provide additional evidence for the public availability of a product referred to in various other documents accompanying the request such as D4 to D12. D23 is a published European patent specification that appeared on the international search report relating to the parent application of this application.
29. None of D14, D16 and D23 raise a new question to my mind. By virtue of the parent application D23 forms part of the pre-grant processing of the patent. D14 and D16 seek to establish a publication date of documents that were previously considered.
30. In third party observations D1 was used to argue that the invention claimed was not novel and lacked an inventive step, either D1 alone or combined with D2. In the request D3 is combined with both document D1 and document D2 in an effort to show that the invention claimed in the patent was not novel or alternatively lacked an inventive step. D3 is offered as explicit evidence of the common general knowledge of the skilled person. It does not seem to me that this raises a genuinely new question given that questions of novelty and inventive step involving D1 and D2 were raised before grant.
31. In themselves the documents accompanying the request do not in my view raise any new questions. That leaves the question of whether the apparent or inferred decision by the examiner in this case to discount the various prior art documents and arguments has been shown to have been clearly perverse, in the sense that no reasonable person could have reached it. As already discussed, in such a case it might be appropriate to reconsider a citation in an opinion as there could be said to be a new argument. However, it is clear from decisions on this subject that this is a high bar, a level above perverse and that this is likely to be a very rare occurrence.
32. The requester's statement of grounds seeks to establish that the examiner's conclusion was unreasonable rather than clearly perverse, although there is one reference to clearly perverse at the top of page 6 "... *the presented arguments demonstrate that the Examiner's view taken on the relevance of D1 in combination with the experimental evidence D2 was unreasonable (clearly perverse)*". This phrasing suggests that the requester views unreasonable as synonymous with clearly perverse. It struck the Hearing Officer in *Kohn* that their colleague in *Automation Conveyors* chose their words carefully with "*clearly perverse*" and I am loath to stretch this phrase to encompass unreasonable.
33. The substantive arguments in the request regarding novelty and inventive step seem to me to be simply that the requester believes that granted claim 1 lacks novelty and was obvious in light of the prior art provided with the request and previously provided in third party observations, whereas seemingly the examiner did not believe so. Similarly it might be argued that there may be an inconsistency with the hearing



officer's decision refusing the parent application. The requestor also states that in a communication of 8 November 2024 "*the Examining Division of the EPO expressed and maintained their opinion that the pending claims of EP 19839240.9 (EP 3 902 413) [equivalent to the parent application to the patent] lack novelty in view of D17 (which corresponds to D1).*". The communication in question ends "*The applicant should therefore provide experimental evidence that, for at least certain combinations of reasonable selections of experimental parameters in the ranges of D17 (i.e., excluding extreme values/sub-ranges), thermally-inhibited starches not falling under present claims are obtained.*".

34. In effect the requester has demonstrated that they disagree with the examiner regarding the patent, that there may be an inconsistency between the decision of the examiner to grant this patent and the decision of the hearing officer refusing the parent application and that the EPO Examining Division remained to be convinced that the invention claimed in an application equivalent to the parent application of the patent was novel.
35. None of this strikes me as showing that the examiner's conclusion regarding novelty and inventive step implied by their decision to grant the patent was that very rare occurrence that clears the high bar of "*clearly perverse, in the sense that no reasonable person could have reached it*". Consequently I decline to issue an opinion on the questions of novelty and inventive step raised in the request.
36. I note that the Hearing Officer in *Kohn*, having refused a request for an opinion, made the following observation:

*Given the conclusion I have come to above, I would observe that refusing a request for an opinion does not preclude the requester of an opinion from subsequently seeking revocation of the patent under section 72 of the Act. While such a decision is entirely a matter for Kohn (or indeed any other interested third party) and is not relevant to the present case, it does provide the opportunity for a fresh consideration of the novelty and inventive step of an invention as claimed in a granted patent. I appreciate that this option takes more time and resources and is more expensive than the opinion route, it does provide a legally binding decision as to whether or not the granted patent of interest is valid.*

## **The patent**

37. The application for the patent was lodged on 28 April 2023 with the title Thermally Inhibited Starch and Process for Making. The application requested antedating from parent application number 2110810.5 which was filed as a Patent Cooperation Treaty application on 27 December 2019.
38. As the patent explains inhibition in this context refers to processes for modifying starch to resist gelatinization. Such processes are acknowledged as known and the patent is directed to methods that are said to be improved. The modified starches may be used as an ingredient in a food composition.
39. There is one independent claim:

*1. An improved thermally inhibited starch, obtainable by a method comprising: providing a starch and i) adding buffer and acid to the starch to obtain a pH adjusted starch having an acidic pH; and ii) thermally inhibiting the pH adjusted starch, wherein the thermally inhibited starch has a Hunter L value of 92 to 96.*

40. The starch provided initially should be granular, non-gelatinized starch which may be milled plant material such as flour. A Hunter L value refers to a whiteness of the starch, the patent suggesting that previous processes produce browner starch, amongst other drawbacks.

## **Sufficiency of disclosure**

### **The law**

41. Section 14(3) of the Act requires that:

*The specification of an application shall disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art.*

42. According to the Manual of Patent Practice:

*14.85 The specification does not need to disclose all the details of the operation to be carried out in order to perform the invention since an enabling disclosure is to be interpreted by the skilled person, in light of common general knowledge, who is reasonably expected to carry out tests. In *Eli Lilly & Co. v Human Genome Sciences, Inc.* [2008] EWHC 1903 (Pat) [2008] RPC 29, Kitchin J held that the specification must be sufficient to allow the invention to be performed without undue burden, having regard to the fact that the specification should explain to the skilled person how the invention can be performed. The question whether a burden is undue must be sensitive to the nature of the invention, the abilities of the skilled person and the art in which the invention has been made (at the time of filing).*

### **This request**

43. According to the requester the patent provides no technical guidance to the skilled person in terms of specific processing conditions for thermal inhibition to obtain the claimed thermally inhibited starch having a Hunter L value of 92 to 96. It is alleged that the skilled person would have to perform their own research program in order to establish the required process conditions such as specific pH value, specific temperature, specific duration of the reaction, etc. They point to phrases such as “*an acidic pH*” and “*enough time*” and suggest that these are vague, not specific and fail to provide technical guidance.
44. In their observations the proprietor disagrees with this assertion that the patent lacks sufficiency of disclosure. They point to passages that disclose possible parameters for making a thermally inhibited starch.

45. The observations in reply essentially repeat the assertion that the disclosure is insufficient.
46. Neither the requester nor the proprietor provides any evidence regarding the abilities of the skilled person.
47. Both the requester and the proprietor refer particularly to paragraphs 32 to 37 in the patent which specify a variety of parameters. These are described as a series of ranges. Each series begins with a very broad range. For example paragraph 37 includes a range of times for dry heating starch, the range begins with for less than 0.5 hours or about 0.05 to about 4 hours. Each series of ranges then narrows down somewhat. For example the heating time ranges in paragraph 37 end with the more specific range of about 0.5 to about 0.6 hours, although it does go on to specify a series of specific times rather than ranges, from about 0.1 hours to about 1 hour.
48. Paragraphs 83 and 84 describe the conditions for preparing samples which are then tested for viscosity and Hunter L value, the results being plotted on graphs in figures 1b, 1c and 2 in the patent. Some of the conditions specified are accompanied by “*about*”, but are not expressed as ranges.
49. It seems to me that the patent does provide much of the information that would be required for a person skilled in the art to perform the invention. It may be that exact values are not specified for absolutely every parameter required. Nevertheless I am satisfied that the person skilled in the art could perform the invention without undue burden. This might involve some degree of experimentation or trial and error, but I have no evidence to suggest that this would represent an undue burden.

## Opinion

50. I decline to issue an opinion on the novelty and inventive step questions in the request for the reasons given above. My opinion is that the specification of the patent discloses the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art.

Karl Whitfield  
Examiner

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## NOTE

*This opinion is not based on the outcome of fully litigated proceedings. Rather, it is based on whatever material the persons requesting the opinion and filing observations have chosen to put before the Office.*