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D E C I S I O N
of 31 January 2006

Case Number: T 0684/01 - 3.3.09

Application Number: 93200187.8

Publication Number: 0556883

IPC: A23K 1/16

Language of the proceedings: EN

Title of invention:

Method for the preparation of feed pellets

Patentee:

Koninklijke DSM N.V.

Opponent:

- 01) Ewos Limited
02) Ewos Innovation AS

Headword:

-

Relevant legal provisions:

EPC Art. 54, 123, 111

Keyword:

"Main request - novelty (no)"
"Auxiliary request I - novelty (yes)"
Remittal for further prosecution"

Decisions cited:

-

Catchword:

-



Case Number: T 0684/01 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 31 January 2006

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted 27 April 2001
revoking European patent No. 0556883 pursuant
to Article 102(1) EPC.**

Composition of the Board:

Chairman: P. Kitzmantel
Members: J. Jardón Alvarez
W. Sekretaruk

Summary of Facts and Submissions

I. The grant of European patent No. 0 556 883 in respect of European patent application No. 93 200 187.8 in the name of GIST-BROCADES N.V. (now Koninklijke DSM N.V.) which had been filed on 25 January 1993, was announced on 22 July 1998 (Bulletin 1998/30) on the basis of 6 claims. Claim 1 read as follows:

"1. A method for preparing an extruded feed pellet loaded with an active ingredient by adding to the feed pellet after extrusion, in a fluid phase, an active ingredient which would be damaged by an extrusion process, and loading the pellet under reduced pressure."

Claims 2 to 6 were dependent claims.

II. Two Notices of Opposition requesting the revocation of the patent in its entirety on the grounds of Article 100(a), (b) and (c) EPC were filed against this patent by:

Ewos Limited, (Opponent I) on 21 April 1999 and by

NorAqua Innovation AB (now Ewos Innovation AS,
Opponent II) on 22 April 1999.

Out of the 24 citations relied on by the Opponents in support of their requests in the course of the first instance proceedings, the following documents are referred to in the present decision:

D1: GB-A-2 232 573,

- D6: B. E. March et al.; *Aquaculture* 90 (1990) 313-322,
- D12: JP-B2-02589827 (English translation),
- D13: IAFMM, international association of fish meal manufacturers; *Fish Oil Bulletin* No 18, pages 5 - 7,
- D16: JP-A-1990-138944 (English translation),
- D20: G. Lambertsen et al.; *J. Sci. Fd Agric.*, 1971, vol. 22, pages 99 - 101, and
- D23: catalogue "Norsildmel" Information feed and feeding 1985 - 1986 (English translation).
- III. By its decision announced orally on 22 March 2001 and issued in writing on 27 April 2001, the Opposition Division revoked the patent.

The Opposition Division held that the application disclosed the invention in a manner sufficiently clear and complete for it to be carried out by the skilled person, essentially because it was well known in the art what could be regarded as an active agent and which agents could be damaged by an extrusion process. The Opposition Division also found that the ground for opposition filed under Article 100(c) EPC did not prejudice maintenance of the patent. Claim 1 as granted was a combination of Claims 1 and 3 as originally filed and consequently fulfilled the requirements of Article 123(2) EPC.

However, the Opposition Division found that Document D12 was novelty destroying for the subject-matter of Claim 1 of the patent in suit (since the patent D12 was published on 12 March 1997, namely after the filing date of the opposed patent and is therefore not state of the art, it is apparent and not contested by the parties that the document referred to should have been the corresponding application D16, published on 28 May 1990).

According to the Opposition Division this disclosure anticipated the claimed subject-matter because it specifically referred to cod liver oil to be loaded under reduced pressure onto extruded feed pellets (page 8 and examples 1 to 6) and because it specified on page 7, first full paragraph that the oil might contain optional ingredients such as vitamins and medicaments.

The Opposition Division further "decided to exercise its discretion of not allowing the late filing of new requests (at the oral proceedings) according to Articles 114(2) and Rule 71a EPC" and revoked the patent for lack of novelty of the claims of the patent as granted, without any discussion of inventive step.

IV. On 20 June 2001 the Patent Proprietor (Appellant) lodged an appeal against the decision of the Opposition Division and paid the appeal fee on the same day.

In the Statement of Grounds of Appeal filed on 27 August 2001, the Appellant requested that the decision be set aside and that the patent be maintained as granted (main request) or as amended as specified in

the auxiliary requests I to VII. The Appellant further requested reimbursement of the appeal fee under Rule 67 EPC because of an alleged substantial procedural violation committed by the Opposition Division.

V. The Respondents presented their counterstatements by letters dated 24 December 2001 (Respondent I/Opponent I) and 2 January 2002 (Respondent II/Opponent II) and requested that the appeal be dismissed; they also requested reimbursement of costs under Article 104 EPC.

VI. In a communication of the Board pursuant to Article 110(2) EPC dated 15 June 2005, the Board expressed its preliminary opinion on the case. It denied the novelty of the subject-matter of the main request and of auxiliary request I and acknowledged the novelty of the subject-matter of Claim 1 of auxiliary request II. The Board objected to some of the dependent claims of this auxiliary request and gave a preliminary opinion on the issues of reimbursement of the appeal fee and apportionment of costs.

The Board also expressed its intention to remit the case to the first instance to deal with the issue of inventive step and asked Respondent I whether it maintained its request for oral proceedings.

VII. By letter dated 6 July 2005, the Appellant filed an amended main request based on previous auxiliary request II which "should replace the currently pending claim requests".

- VIII. By letter dated 15 August 2005, the Respondent I informed the Board that it maintained its request for oral proceedings.
- IX. On 12 September 2005 the Board dispatched the summons to attend oral proceedings on 31 January 2006.
- X. By letter dated 21 December 2005, the Respondent I requested the revocation of the patent and submitted its arguments concerning novelty and inventive step. Moreover, it withdrew its request for reimbursement of costs.
- XI. By letter dated 28 December 2005, the Appellant submitted a copy of the main request as filed with the letter of 6 July 2005 and two auxiliary requests. The Appellant also abandoned its previous request for reimbursement of the appeal fee under Rule 67 EPC.

Claim 1 of the main request read as follows:

"1. A method for preparing an extruded feed pellet loaded with an active ingredient by adding to the feed pellet after extrusion, in a fluid phase, an active ingredient which would be damaged by an extrusion process, the active ingredient being an enzyme or protein, a pigment, an anti-oxidant, a colouring agent or a carotenoid, and loading the pellet under reduced pressure."

- XII. By letter dated 25 January 2006 both Respondents requested that the Board took a final decision on the validity of the patent.

XIII. Oral proceedings were held before the Board on 31 January 2006. During the proceedings Respondent II withdrew its request for reimbursement of costs and the Appellant filed an amended auxiliary request I.

Claim 1 of the amended auxiliary request I read as follows:

"1. A method for preparing an extruded feed pellet loaded with an active ingredient by adding to the feed pellet after extrusion, in a fluid phase, an active ingredient which would be damaged by an extrusion process, and loading the pellet under reduced pressure, wherein the active ingredient is astaxanthin."

XIV. The arguments presented by the Appellant during the oral proceedings may be summarized as follows:

- The subject-matter of Claim 1 of the main and the auxiliary request I was novel because neither D16 nor D1 used an active ingredient as recited in Claim 1. Although some oils could include vitamins and/or astaxanthin as components there was no unambiguous disclosure in D16 or D1 that the oils therein used actually included said active ingredients.
- Concerning inventive step of the auxiliary request 1, the Appellant stated that astaxanthin, which was the only compound exemplified in the patent in suit, was better retained within the feed pellets than other related active ingredients and that it was currently preparing further comparative examples in order to confirm this effect.

- The Appellant pointed out that inventive step had not been discussed by the Opposition Division and requested that the file be remitted to the first instance for this issue to be considered.
- XV. The arguments presented by the Respondents in their written submissions and at the oral proceedings may be summarized as follows:
- The subject-matter of Claim 1 of the main request lacked novelty having regard to the disclosure of D16 and D1 which described methods for the addition of a component to pellets after extrusion using reduced pressure. The presence of vitamins and carotenoids in the oils therein used resulted in a method as claimed due to the fact that these components were well known antioxidants as disclosed, for instance, in D13 (page 6), D20 (page 101, left column, last paragraph) or D23 (last page). The skilled person, using the method of D1 or D16, had the inherent knowledge that an antioxidant was present and consequently the disclosure of D16 (examples 1 to 5) and of D1 (example 6) anticipated the subject-matter of Claim 1 of the main request.
 - The subject-matter of Claim 1 of the auxiliary request 1 also lacked novelty having regard to the disclosure of D16 and D1 because it was well known to the skilled person that fish oils could also contain astaxanthin as it was disclosed, for instance, in documents D13 and D20.

- Concerning inventive step, the Respondents pointed out that the methodology of Claim 1 of the patent, namely the use of reduced pressure to adsorb an ingredient was already well known from D16 and D1 and that the use of this known technique for compounds like astaxanthin, a frequently used ingredient of fish food, which is susceptible to damage by extrusion, did not involve an inventive step. Moreover, the examples in the patent in suit did not show any surprising effect which could be attributed to the use of vacuum as compared to the use of atmospheric pressure.

- The Respondent also requested that the file not be remitted to the first instance essentially because the remittal would inevitably involve further delay. It pointed out that the facts of the present case were already known to the parties and the Board and that a remittal would not be in the interest of the public. Moreover there was no absolute right of a party to have every aspect of its case examined by two instances.

XVI. The **Appellant** requested:

- that the decision under appeal be set aside,

- that the Board acknowledges novelty of the main request (filed with letter dated 28 December 2005) or of one of the auxiliary requests I (filed on 31 January 2006, during the oral proceedings) or II (filed with letter dated 28 December 2005), and

- that the case be referred back to the Opposition Division for further prosecution.

The **Respondent** requested:

- that the appeal be dismissed, and
- that a final decision on this appeal be taken by the Board of Appeal.

Reasons for the Decision

1. The appeal is admissible.

MAIN REQUEST

2. *Novelty (Article 54 EPC)*
 - 2.1 Claim 1 of the main request is directed to a method for preparing an extruded feed pellet loaded with an active ingredient by adding to the feed pellet after extrusion under reduced pressure an active ingredient selected from an enzyme, a protein, an anti-oxidant, a colouring agent or a carotenoid.
 - 2.2 Document D16 discloses a method of improving the oil-absorbing properties of porous fish-farming feed characterized by an impregnation treatment involving depressurization (see page 2, lines 5 to 8). In said process, firstly an extruded feed pellet is prepared (see paragraph bridging pages 3 and 4) and then oil is absorbed by a depressurization and suction treatment

(see page 4, last four paragraphs). In the examples 1 to 5, cod liver oil is used as feed oil.

- 2.3 Although cod liver oil and vitamins are no longer embraced by the scope of Claim 1 of the main request, it is noted that this oil contains relatively high amounts of vitamins, in particular vitamins A, D and E, of which vitamin A and E are well known antioxidants which are also sensitive to the elevated temperatures of extrusion processes (not particularly specified in the patent in suit).

Thus, the method disclosed in examples 1 to 5 of D16 for the preparation of feed pellets using cod liver oil falls within the scope of Claim 1 because these antioxidant vitamins meet all the requirements of an active ingredient as defined in Claim 1 of the main request.

- 2.4 It has been argued by the Appellant that D16 was devoid of any information concerning the nature of the active ingredients the cod liver oil contained and that, for this reason, document D16 should not be considered as novelty destroying.

This argument is not convincing because cod liver oil in general is well known for its consistent content of at least vitamins A and D which are two of its essential components. It is thus clear for the skilled person reading D16 that, in the absence of any information therein that the oil used was free from these essential components, they must be present.

2.5 For these reasons the subject-matter of Claim 1 lacks novelty (Article 54 EPC).

AUXILIARY REQUEST I

3. *Amendments (Article 123 EPC)*

3.1 Amended Claim 1 is based on Claims 1, 3 and 8 of the application as originally filed; Claim 2 is supported by original Claim 4; Claim 3 is supported by the disclosure on page 6, lines 4 to 6 and Claim 4 is supported by page 8, lines 17 to 19. Therefore the amendments do not introduce subject-matter which goes beyond the contents of the application as originally filed (Article 123(2) EPC).

3.2 Amended Claim 1 is a combination of granted Claims 1 and 4 and its scope is clearly limited over the granted claims (Article 123(3) EPC).

3.3 Consequently, the subject-matter of the claims of auxiliary request 1 meets the requirements of Articles 123(2) and (3) EPC.

4. *Novelty (Article 54 EPC)*

4.1 The subject-matter of Claim 1 of this request has been limited to the use of astaxanthin as active ingredient for the loading of the pellets.

4.2 Astaxanthin is not mentioned in D16 and it is not a component found in cod liver oil. Consequently document D16 is not novelty destroying for the subject-matter of Claim 1 of the auxiliary request I.

- 4.3 The Respondents pointed out that document D16 was not limited to the use of cod liver oil but it included the broad use of animals oils, preferably fish oils (see page 6, last full paragraph) which can contain astaxanthin as disclosed, for instance, on the last paragraph of the left column of page 6 of D13 or on the last paragraph of the left column of page 101 of D20. Thus, the use of fish oils containing astaxanthin according to the method of D16 would result in a process falling within the scope of the method of Claim 1 of the patent in suit.

The Respondents also contested the novelty of Claim 1 having regard to the disclosure of D1 which discloses the addition by absorption under reduced pressure of a lipid to a pelleted product (see page 9, last paragraph - page 10, line 14). In its opinion, the lipids used therein could contain astaxanthin and the process of D1 was novelty destroying for the subject-matter of Claim 1.

- 4.4 The Board disagrees with this argumentation. Although astaxanthin can be a component of some fish oils, it is not always present in fish oils. Actually, the only oil exemplified in D16 is cod liver oil, and the Respondents did not file any document showing that astaxanthin is present in cod liver oil.

Thus, there is no clear and unmistakable disclosure in D16 of a method for preparing an extruded feed pellet loaded with astaxanthin as claimed in Claim 1. The fact that some fish oils can contain astaxanthin does not

result in an implicit disclosure of its presence in the method disclosed in D16.

4.5 The same reasoning applies *mutatis mutandis* to the disclosure of D1.

4.6 In view of the above findings, the subject-matter of Claim 1 and dependent Claims 2 to 4 of the auxiliary request I is novel over the available prior art.

5. *Remittal (Article 111 EPC)*

5.1 The Board considers that the subject-matter of auxiliary request I overcomes the objection of lack of novelty forming the basis of the decision under appeal. It still has to be assessed whether these claims satisfy the requirement of inventive step which has not yet been considered by the Opposition Division.

5.2 The Board informed the parties in a communication dated 15 June 2005 and in the annex to the summons to the oral proceedings dated 12 September 2005 of its intention to remit the file to the Opposition Division for further prosecution.

5.3 Only with the letter dated 25 January 2006, i.e. about one week before the date of the oral proceedings, did the Respondents request for the first time that a final decision be made by the Board instead of remitting the case to the Opposition Division for evaluation of inventive step. They argued that the remittal of the case to the first instance would unnecessarily delay the proceedings and - referring also to the interests

of the public - asked for a final decision by the Board of Appeal.

5.4 Under the established case law (see case law of the Boards of Appeal of the European Patent Office, 4th edition 2001, page 533 ff), the primary function of appeal proceedings is to decide on the correctness of a first instance decision.

5.5 In the present case the following points have to be considered:

- The Opposition Division only decided on novelty. Inventive step has not been discussed during the first instance opposition proceedings, nor did the Opposition Division express any provisional opinion in the decision under appeal.
- The Appellant has not commented on inventive step during the appeal proceedings and it expressed its intention to file experimental evidence in support of inventive step.
- The Respondents were aware of the intention of the Board of remitting the case back to the first instance and requested a final decision only shortly before the oral proceedings, preventing thereby an adequate preparation of this issue by the Appellant. The Respondent's interest for a final decision at such a late stage of the proceedings is also not justified by its conduct in the proceedings up until now. Nor is a remittal of the case at this stage undesirable in view of the duration of the proceedings and the patent's age.

5.6 Taking into account the circumstances of the present case, the Board therefore considers it appropriate to exercise its discretion under Article 111(1) EPC to refer the case back to the Opposition Division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division for further prosecution on the basis of the set of Claims 1 to 4 of auxiliary request I as filed during the oral proceedings.

The Registrar:

The Chairman:

G. Röhn

P. Kitzmantel