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**Datasheet for the decision
of 3 July 2012**

Case Number: T 0495/10 - 3.3.09
Application Number: 02766984.5
Publication Number: 1418819
IPC: A23K 1/16, A23K 1/18
Language of the proceedings: EN

Title of invention:
NON-STARCH-POLYSACCHARIDES

Patentee:
K.U. LEUVEN RESEARCH & DEVELOPMENT

Opponents:
Sedamyl S.p.A.
DF3 SAS
Cargill, Inc.

Headword:
-

Relevant legal provisions:
EPC Art. 108, 123, 84, 53(c), 111

Keyword:
"Admissibility of appeal - yes"
"Admissibility of main request and auxiliary requests 1 to 5 -
no (withdrawn in opposition proceedings)"
"Auxiliary request 6 - admissibility - yes"
"Claim drafted analogous to Swiss-type"
"Claims: fulfils Article 123, 84 and 53(c) EPC"
"Remittal - yes"

Decisions cited:
G 0010/91, G 0005/83, T 1067/08, T 1286/05, T 0611/09

Catchword:

Swiss-type claim relating to non-therapeutic use allowable having regard to inevitable and inextricable link between therapeutic and non-therapeutic effect.



Case Number: T 0495/10 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 3 July 2012

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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 23 December 2009 revoking European patent No. 1418819 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman: W. Sieber
Members: J. Jardón Álvarez
 K. Garnett

Summary of Facts and Submissions

I. This decision concerns the appeal by the proprietor of European patent No. 1 418 819 against the decision of the opposition division to revoke the patent.

II. The patent was granted with 28 claims, including eight independent claims. Independent claims 1, 12 and 21, which are relevant for this decision, read as follows:

"1. A feed additive comprising at least 20% w/w of low molecular weight arabinoxylans having a molecular mass between 414 and about 52,800 Da."

"12. The use of arabinoxylans or preparations or materials containing arabinoxylans for the manufacture of a feed additive according to any one of claims 1 to 11."

"21. A method for improving the weight gain and/or feed utilisation of monogastric animals, which comprises incorporating into the feed of said animals 1 to 50 g of low molecular weight arabinoxylans per kg of feed, said low molecular weight arabinoxylans having a molecular mass between 414 and about 52,800 Da."

III. Notices of opposition against the patent were filed by Sedamyl S.p.A. (opponent 01), DF3 SAS (opponent 02) and Cargill, Incorporated (opponent 03).

All opponents requested revocation of the patent in its entirety on the grounds pursuant to Article 100(a) EPC (lack of novelty and lack of inventive step),

opponent 02 additionally on the grounds pursuant to Articles 100(b) and (c) EPC.

Out of the citations relied on by the parties in support of their requests in the course of the first instance proceedings, only the following document needs to be referred to in the present decision:

D58: C.M. Courtin *et al.*, "Dietary Inclusion of Wheat Bran Arabinoxyloligosaccharides Induces Beneficial Nutritional Effects in Chickens" CEREAL CHEMISTRY, vol. 85(5), 2008, pages 607-613.

IV. Oral proceedings before the opposition division were held on 13 January 2009. The proprietor's main request (claims as granted) and first auxiliary request (maintenance of patent in amended form) were not allowed. After finding that the subject matter of the second auxiliary request was novel over the cited prior art, the opposition division decided, due to the late hour (18:15) and the resulting lack of time for further discussion, to adjourn the oral proceedings. The chairman indicated that the starting point at the resumption of the oral proceedings would be the discussion of inventive step of auxiliary request 2. This request consisted of a set of five claims, whereby claim 1, the only independent claim, corresponded to claim 21 of the granted patent (see point II above).

V. With the summons dated 2 February 2009 to the resumed oral proceedings (to be held on 24 November 2009), the opposition division summarised the current state of proceedings and stated that any comments and additional information, as well as potential new requests, should

be filed within the prescribed time limits and that only very relevant information documents would be admitted into the proceedings at that stage of the proceedings. Various submissions filed thereafter by the parties included the following:

- With a letter dated 13 August 2009, opponent 02 raised a new objection to claim 1 of the proprietor's second auxiliary request under Article 53(c) EPC (as well as substantial inventive step arguments) and filed new documents, *inter alia* D58.
- With its letter dated 24 September 2009, opponent 01 filed submissions on inventive step and supported opponent 02's new Article 53(c) EPC objection.
- With its letter dated 24 September 2009, the proprietor made its previous second auxiliary request its main request and filed new first and second auxiliary requests. It filed extensive submissions on the inventive step arguments and the new documents filed by opponent 02. As to the new objection under Article 53(c) EPC, the proprietor made only the general comment that certain grounds of opposition were absent from the original notice of opposition and in the circumstances appeared *prima facie* inadmissible.

VI. At the resumption of the adjourned oral proceedings on 24 November 2009, the following took place:

- The proprietor filed new auxiliary requests 1 to 5.

- Having heard argument (see point 4 of the minutes) the opposition division admitted D58 and the new ground of opposition under Article 53(c) EPC into the proceedings. It further came to the conclusion that claim 1 of the then main request was not patentable having regard to Article 53(c) EPC, and that the same deficiencies applied to auxiliary requests 1 to 5 (see point 5 of the minutes).

- After being given a break in the proceedings to file a new request, the patentee withdrew its existing main request, abandoned previous auxiliary requests 1 to 5 and filed an amended main, now sole request, being the request on which the opposition division's decision was subsequently based.

Claim 1 of this request reads as follows:

"1. Use of arabinoxylans or preparations or materials containing arabinoxylans for the manufacture of a feed additive for monogastric animals, said feed additive comprising at least 20% w/w of low molecular weight arabinoxylans having a molecular mass between 414 and about 52,800 Da, and said feed additive used at 1 to 50 g of said low molecular weight arabinoxylans per kg of feed, for improving the weight gain and/or feed utilisation of monogastric animals."

- The admissibility of this request was then discussed, the opponents objecting to its late filing and the proprietor arguing that the decision to admit the

new ground of opposition had come as a surprise (see point 7 of the minutes).

- Before interrupting the proceedings the chairman noted that there was now only one request from the proprietor for maintenance of the patent on file and that if this were found to be inadmissible it would lead to revocation of the patent. No further requests were filed by the proprietor (see point 8 of the minutes).
- After deliberation the chairman announced that the new request was not admitted into the proceedings. The patent was then revoked.

VII. By its decision issued in writing on 23 December 2009, the opposition division decided that "the claims of the main and sole request filed during the second oral proceedings on 24.11.2009 were found to be not admissible" and that, based on this request, the patent and the invention to which it related did not "meet the requirements of the EPC" (see the last paragraph of the decision). As to this:

- The opposition division held that this request did not meet the requirements of either Article 84 or Article 123(2) EPC. In its opinion, the feature "said feed additive used at 1 to 50 g of said low arabinoxylans per kg of feed" was not clear because it might mean that 1 to 50 g of low molecular weight arabinoxylans were simply present in the feed additive without their being incorporated into a feed, or that the 1 to 50 g of low molecular weight arabinoxylans were present in the feed because they

were contained in a feed additive that was incorporated into a feed. This lack of clarity had also consequences for whether the request fulfilled the requirements of Article 123(2) EPC.

- The opposition division also held that the claim was not allowable under Article 53(c) EPC. The feature "for improving the weight and/or feed utilisation of monogastric animals" could be understood to apply directly to the use itself. Since furthermore it was known that arabinoxylans, when fed to animals, had therapeutic effects, the subject-matter of claim 1 could be considered as encompassing a method of treatment of the human or animal body by therapy.

VIII. On 23 February 2010 the patent proprietor (in the following: the appellant) lodged an appeal against the decision of the opposition division and paid the appeal fee on the same day.

IX. In the statement of grounds of appeal filed on 22 April 2010, the appellant argued that, arising out of the interruption of the oral proceedings, the opposition division had committed several substantial procedural violations and the appellant maintained that all the actions taken at the continuation of the oral proceedings on 24 November 2009 should be regarded as not having taken place, thereby restoring the proceedings to the status at the suspension of the oral proceedings on 13 January 2009.

The appellant requested that the decision of the opposition division be set aside and that the patent be maintained with the claims of the main request filed

with the statement of grounds of appeal or, alternatively, with amended claims as specified in auxiliary requests 1 to 6 also filed with the statement of grounds of appeal. The main request and auxiliary requests 1 to 5 were identical with the requests which had been withdrawn or abandoned during the resumed oral proceedings. Auxiliary request 6 was a slightly modified version of the sole request for maintenance of the patent which remained at the end of the opposition division proceedings.

- X. Opponents 02 and 03 (in the following: respondents 02 and 03) filed replies by letters dated 18 August 2010 and 8 November 2010, respectively, and requested that the appeal be dismissed. In addition respondent 03 requested that the appeal be rejected as inadmissible.
- XI. On 31 January 2012 the board dispatched a summons to oral proceedings. In the attached communication the board outlined the points to be discussed during the oral proceedings, namely procedural issues arising out of the alleged substantial procedural violations, admissibility of the appeal, admissibility of the requests of the appellant and substantive issues concerning the requirements of Articles 84, 123(2) and 53(c) EPC.

The board also indicated that if any of the appellant's requests were admitted and/or the subject-matter of auxiliary request 6 was found to comply with the requirements of Articles 84, 123(2) and 53(c) EPC, the board would hear argument and decide on how best to proceed with the remaining issues in the appeal, whether at a subsequent hearing of the oral proceedings

or by way of remittal of the case to the opposition division.

XII. Further submissions were filed by the appellant with letters dated 3 and 21 June 2012, by respondent 02 with letter dated 30 May 2012 and by respondent 03 with letters dated 31 May 2012 and 13 June 2012.

XIII. Oral proceedings were held before the board on 3 July 2012.

The requests remaining at the end of the oral proceedings are those listed below under point XVII.

Claim 1 of the main request is identical to claim 21 of the granted patent. Claim 1 of auxiliary requests 1 to 5 is directed to a "Method for improving the feed utilisation and/or the weight gain ...".

Claim 1 of auxiliary request 6, which is essentially based on claim 1 of the sole request maintained before the opposition division, reads as follows:

"1. Use of arabinoxylans or preparations or materials containing arabinoxylans for the manufacture of a feed additive for monogastric animals for improving the weight gain and/or feed utilisation of monogastric animals, said feed additive comprising at least 20% w/w of low molecular weight arabinoxylans having a molecular mass between 414 and about 52,800 Da and said feed additive being used at 1 to 50 g of said low molecular weight arabinoxylans per kg of feed."

- XIV. Opponent 01 took no active part in the appeal proceedings. It did not file any submissions or requests and was not represented at the oral proceedings before the board.
- XV. The arguments presented by the appellant in its written submissions and during the oral proceedings, insofar as they are relevant for the present decision, may be summarized as follows:
- The appeal was admissible and the requests filed with the statement of grounds should be admitted into the proceedings. The statement of grounds of appeal was drafted as a reaction to the irregularities and unclear situations arising out of the chaotic handling of the oral proceedings by the opposition division. The withdrawal or abandonment of what were now the main request and auxiliary requests 1 to 5 should in fact be regarded as being without legal effect in view of the procedural irregularities which had taken place during the opposition proceedings, in particular the fact that at the resumed hearing the opposition division had taken into account new submissions filed during the intervening period and had allowed in a new ground of opposition, contrary to what it had said at the end of the first day of oral proceedings (see points IV and V, above). This was contrary to established procedural deadlines and rules, and contrary to the appellant's legitimate expectations that only inventive step in relation to this request remained to be discussed. What should have happened is that the second hearing should have followed on seamlessly from the first. The adjournment of the

oral proceedings on 13 January 2009, which was only necessary because of the Office's poor planning, should not have lead to the appellant being disadvantaged; the new ground would never have been raised had the proceedings continued the next day. The appellant did not realise at that time that the withdrawal or abandonment of the main request and auxiliary requests 1 to 5 would avoid a reasoned decision on these requests, something which in fact the appellant earnestly desired.

- What was now essentially auxiliary request 6 had originally been filed as a reaction to the non-allowability of the main request by the opposition division and was drafted as a "Swiss-type claim" to overcome the reason for the rejection of the previous requests.

- Concerning Article 123(2) EPC, amended claim 1 resulted from the combination of claims 1, 16 and 31 of the application as originally filed (claims 1, 12 and 21 of the granted version). Claim 1 was further limited to the case where the feed additive was added to the feed, as disclosed on page 6, lines 23-24 of the application as filed. Moreover the amendment restricted the scope of the granted claims and therefore also fulfilled the requirements of Article 123(3) EPC.

- Amended claim 1 was based on granted claims and could not be objected to under Article 84 EPC. In any case the feature "said feed additive used at 1 to 50 g of said low molecular weight arabinoxylans

per kg of feed" was non-ambiguous and indicated that the feed additive was incorporated in the feed.

- Finally, the claim was drafted as a Swiss-type claim due to the finding of the opposition division that the previous "method" claims were seen as covering a method of treatment of the human or animal body by therapy. The patentee had then been forced to draft the claims as "second medical use" claims. In any case the wording of the claim was allowable under Article 53(c) EPC.

XVI. The arguments presented by respondents 02 and 03 in their written submissions and at the oral proceedings may be summarized as follows:

- Respondent 03 maintained that the appeal was inadmissible for lack of adequate substantiation. The appellant's statement of grounds of appeal gave no reason whatsoever why the decision under appeal should be set aside. The reasoning given in the grounds of appeal only dealt with the issues of subject-matter excluded from patentability and inventive step of a request on which no decision had been made because it had been withdrawn during the oral proceedings. Moreover, the reasoning addressed the issues of subject-matter excluded from patentability, clarity and added subject-matter of a request (the "New Request") which had not been submitted with the statement of grounds of appeal.
- The main request and auxiliary requests 1 to 5 were expressly withdrawn or abandoned before the opposition division and could not be allowed back

into the proceedings. Auxiliary request 6, while being similar to the final request considered unallowable by the opposition division, had never formed part of the proceedings before the opposition division and was therefore a new request. According to the EPO practice, such new requests should be admitted only if they were clearly allowable, which was not the case here.

- The subject-matter of claim 1 of auxiliary request 6 contravened Article 123(2) EPC for the reasons given in the appealed decision. Moreover, respondent 02 maintained that the amendments extended the protection conferred, due to the change of category of the claim. While the granted claims were directed to a non-therapeutic method, the amended claims aimed at covering a therapeutic treatment, as indicated by their formulation as second medical use claims.
- The subject-matter of auxiliary request 6 lacked clarity as it was not clear whether some characteristics were linked to the "feed" or to the "feed additive". Moreover the drafting as a second medical use claim was not correctly done as a "feed additive" was said to be manufactured and not a "medicament", as required by Swiss-type claims.
- Finally, the claims of auxiliary request 6 also violated Article 53(c) EPC, the therapeutic and non-therapeutic uses being inextricably linked.

XVII. The **appellant** requested that the decision under appeal be set aside and that the patent be maintained with the

claims of the main request filed with the statement of grounds of appeal dated 22 April 2010 or, auxiliary, with amended claims as specified in auxiliary requests 1 to 6 also filed with the statement of grounds of appeal. The appellant requested further that the case be remitted to the opposition division for further prosecution.

Respondent 02 requested that the appeal be dismissed.

Respondent 03 requested that the appeal be rejected as inadmissible, alternatively be dismissed. It requested further that the case be remitted to the opposition division for further prosecution in the event of any of the substantive requests of the appellant being allowed.

Reasons for the Decision

1. *Admissibility of the appeal (Article 108 and Rule 99 EPC)*
 - 1.1 According to respondent 03 the appeal is inadmissible in view of Article 108 EPC third sentence in combination with Rule 99(2) EPC, because the statement of grounds of appeal gave no reasons whatsoever why the decision under appeal should be set aside and the patent be maintained on the basis of one of the appellant's requests.
 - 1.2 Admittedly the statement of grounds of appeal is largely not directed to the decision under appeal in the sense that it deals with alleged substantial procedural violations by the opposition division

(point 2.1) and with substantive arguments (points 2.2.1 and 2.2.2) relating to a request which had been withdrawn and was therefore not the subject of the actual decision under appeal.

However, the statement of grounds of appeal also provides on page 9 explicit reasoning as to why the opposition division's findings should be set aside: the issue of patentability in relation to Article 53(c) EPC is discussed in point 2.2.3, the issue of clarity under Article 84 EPC is discussed in point 2.2.4 and the objection under Article 123(2) EPC is discussed in point 2.2.5.

- 1.2.1 Furthermore, the statement of grounds of appeal contains a main request and six auxiliary requests, the sixth request corresponding to the request not allowed by the opposition division, with, in particular, detailed argument as to why the main request should be allowed. Thus, contrary to respondent's 03 assertions the statement of grounds of appeal enables the board and the other parties to understand why it is said that the decision under appeal should be set aside and to what extent it is said that it should be amended.

- 1.3 Respondent 03 pointed out that points 2.2.3 to 2.2.5 of the reasoning address the issues of subject-matter excluded from patentability, clarity and added subject-matter relative to the "New Request" filed towards the end of the second oral proceedings before the opposition division (in the event the proprietor's sole request for maintenance of the patent), a request which it argues was not submitted with the statement of grounds of appeal.

However it is evident from the context that what is referred in the statement of grounds of appeal as the "New Request" is to be understood as a reference to auxiliary request 6 filed with the grounds of appeal. Apart from a rearrangement of the wording "for improving the weight gain and/or feed utilisation of monogastric animals" within claim 1, this auxiliary request 6 is identical to the sole, final request before the opposition division.

In the minutes of the oral proceedings before the opposition division this sole, final request is referred to as the "new request" (see points 6 and 7 of the minutes). The fact that capital letters ("New Request") are used in the statement of grounds of appeal cannot, in the board's view, raise any serious doubt as to what is meant by the "New Request".

1.4 The board is thus satisfied that the appellant's statement of grounds of appeal sets out in a sufficiently clear manner the basis for the appellant's request to set aside the decision under appeal and deals adequately with the reasoning of the opposition division. Therefore, the appeal complies in the board's view with the requirements of Article 108 EPC, third sentence in combination with Rule 99(2) EPC.

1.5 Since it has not been disputed that the notice of appeal and statement of grounds of appeal comply with the other requirements set out in Article 108 and Rule 99 EPC and the board sees no reason to raise an objection on its own in this context, the appeal is admissible.

2. *Admissibility of appellant's requests*

2.1 Main request and auxiliary requests 1 to 5

2.1.1 The main request and auxiliary requests 1 to 5 are identical to requests which were filed in the opposition division proceedings but then withdrawn or abandoned during the oral proceedings on 24 November 2009, after the opposition division had come to the conclusion that "the main request contained subject-matter not patentable under Article 53(c) EPC" and "the same deficiencies applied to the auxiliary requests 1-5" (point 5 of the minutes and point VI, above).

2.1.2 Although the main request and auxiliary requests 1 to 5 were presented with the statement of grounds of appeal, the board has the power to hold inadmissible requests which could have been presented in the first instance proceedings (Article 12(4) of the Rules of Procedure of the Boards of Appeal - "RPBA"). This includes requests which were filed but then withdrawn or abandoned.

Bearing in mind that the purpose of the appeal procedure *inter partes* is mainly to give the losing party a possibility to challenge the decision of the opposition division on its merits (G 10/91, point 18 of the reasons, OJ EPO 1993, 420), one criterion for exercising this discretion is to consider whether a party's conduct has prevented the department of first instance from giving a reasoned decision on the critical issues, thereby compelling the board of appeal either to give a first ruling on those issues or to remit the case to the department of first instance (see

Catchword of the decision T 1067/08 of 10 February 2011, not published in the OJ EPO).

- 2.1.3 In the present case, the appellant voluntarily withdrew or abandoned the main request and auxiliary requests 1 to 5, with the effect that no reasoned decision was given by the opposition division on the patentability of these requests.
- 2.1.4 The appellant argues essentially that the opposition division committed various errors arising out of the adjournment of the oral proceedings between January and November 2009. It is said that the proceedings in November should have followed seamlessly on from the proceedings in January and everything that happened in between should be ignored. The withdrawal or abandonment of the requests all arose out this procedural bungling.
- 2.1.5 The board cannot accept such a view of the situation, which is simply not realistic. There are no provisions in the EPC which support the appellant's arguments and from a procedural point of view the opposition division handled the adjournment of the proceedings perfectly properly. Further, there is no provision in the EPC which requires the opposition division to have excluded the submissions made by the parties, including new grounds of opposition, between 13 January 2009 and 24 November 2009. It was within the discretion of the opposition division to admit any such submissions at any time, whether between the two sets of oral proceedings or during the second oral proceedings.

2.1.6 Moreover, the new Article 53(c) EPC objection had been raised well in advance of the hearing on 24 November 2009 (see point V, above). The appellant should have been alive to the possibility the opposition might allow in the new ground of opposition and so prepared its strategy against that event.

2.1.7 While the requests may not have been withdrawn or abandoned with the express intention of avoiding a decision thereon - and in fact the appellant has submitted that it did not realise that the withdrawal would avoid a reasoned decision - that is the inevitable result of the withdrawal or abandonment of a request and the appellant must bear the consequences of its conduct of the proceedings.

2.1.8 For these reasons, the board, in exercise of its discretionary power, decided not to admit the main request and auxiliary requests 1 to 5 into the proceedings.

2.2 Auxiliary request 6

2.2.1 As indicated above in the context of the admissibility of the appeal, auxiliary request 6 is based on the sole, final request before the opposition division; the minor rewording of claim 1 has not in the board's view altered its meaning.

2.2.2 The basis on which the opposition division dealt with this request is not entirely clear. On the one hand, according to the minutes, the request was not admitted into the proceedings (see point VI, above). On the other, according to the written decision, the claims

were held to be not admissible or not allowable for substantive reasons because in its opinion they did not meet the requirements of Articles 84, 123(2) and 53(c) EPC.

- 2.2.3 It is not, however, necessary to go into the matter further. If the true position is that the request was not admitted into the proceedings (which seems the likely position), then this was clearly done on substantive rather than procedural grounds, i.e., because the opposition division concluded that the claims did not meet the above requirements of the EPC rather than because, e.g., the request was late filed. Since, for the reasons given below, the board considers that the conclusions of the opposition division on these substantive issues were incorrect it follows that the discretion not to admit the request was taken on an incorrect basis and there is therefore no good reason for the board to hold the request inadmissible using its power under Article 12(4) RPBA.

Consequently, auxiliary request 6 was admitted into the proceedings.

3. *Interpretation of claim 1*

- 3.1 Claim 1 is drafted in a manner analogous to a so called "Swiss-type" claim as "use of arabinoxylans ... for the manufacture of a feed additive for monogastric animals for improving the weight gain and/or feed utilisation of monogastric animals ...".

- 3.2 The appellant filed this claim during the opposition proceedings as a reaction to the finding of the

opposition division that its previous claims relating to "a method for improving the weight gain and/or feed utilisation of monogastric animals ... " contained subject-matter not patentable under Article 53(c) EPC (see point VI, above). According to the appellant, the opposition division's view that both a therapeutic and a non-therapeutic effect were inseparably associated with the use of arabinoxylans and consequently its statement that the method claims were not allowable necessitated amending the claim in the way prescribed by the Enlarged Board of Appeal for a second medical use. Indeed, it is apparent from points 4 and 5 of the minutes of the oral proceedings that the new ground of opposition concerning Article 53(c) EPC was indeed admitted into the proceedings having regard to the post-published document D58. D58 was filed by respondent 02 in order to show that the dietary inclusion of arabinoxylans had a therapeutic and/or prophylactic effect (see D58, under "Discussion" on pages 611-612).

3.3 According to EPO practice, in cases where a therapeutic and a non-therapeutic effect of a method are inseparable, because they are inevitable and inextricably linked, claims drafted as method claims are usually not allowed, as such methods are excluded from patentability under Article 53(c) EPC (see Case Law of the Boards of Appeal of the EPO, 6th edition 2010, Chapter I.B.4.4.2a) and the decisions therein cited).

3.4 "Swiss-type claims" were allowed in decision G 5/83 (OJ EPO, 1985, 64) for second (or further) medical uses. There, claims directed to the use of a substance or a

composition for the manufacture of a medicament for a specified new and inventive therapeutic application were allowed. The claims were exceptionally allowed because the appropriate form of protection, namely a use claim or a first medical use claim, was not possible.

3.4.1 The board sees in the present case a certain analogy to this situation. In the present case a method claim is not allowable because the claimed subject-matter embraces (an inseparable) therapeutic treatment excluded from patentability. The drafting of the claim as a "Swiss-type claim" ensures therefore that, insofar as the inseparable therapeutic method is concerned, the claim does not infringe the requirements of Article 53(c) EPC.

3.4.2 Although it has been said in some decisions that a Swiss-type claim relating to a non-therapeutic activity has to be interpreted as defining a conventional process of preparation (see T 1286/05, points 2.3 and 2.4 of the reasons, and T 611/09, point 10.1 of the reasons), it is the board's view that the approach of G 5/83 applies in a situation such as the present one where the claim, although relating to a non-therapeutic activity, also embraces an inseparable therapeutic activity. Thus, in analogy to a second medical use claim in the Swiss-type format, the features supporting novelty (and inventive step) of claim 1 of auxiliary request 6 will be the intended use. In other words, novelty and inventive step have to be examined in the light of the intended use, namely the use of the specified feed additive for improving the weight gain and/or feed utilisation of monogastric animals.

4. *Amendments*

- 4.1 Amended claim 1 is based on claim 16 as filed, this claim being directed to "The use of arabinoxylans or preparations or materials containing arabinoxylans for the manufacture of a feed additive according to any of the claims 1 to 15".

In addition to the features of claim 1 to which claim 16 refers back, it has been specified that the feed additive is "used at 1 to 50 g of said low molecular weight arabinoxylans per kg of feed". This feature is disclosed on page 6, lines 28 to 32 of the application as filed where it is stated that: "In a preferred embodiment the enrichment of the feed with the feed additive results in a low molecular weight arabinoxylan-concentration in the feed between 0.1 and 10% (w/w). In a more preferred embodiment, the low molecular weight arabinoxylan-concentration in the feed varies between 0.1 and 5 % (w/w)". The latter range is equivalent to the now claimed amount per kg of feed.

- 4.2 The opposition division and the respondents objected to the amendment on the grounds that it could mean that the 1 to 50 g of arabinoxylans were simply present in the feed additive without it being incorporated into a feed or that it could mean that the 1 to 50 g of arabinoxylans were present in the feed because they were contained in a feed additive that was actually incorporated into a feed. These two possible meanings thus resulted in an objection under Article 123(2) EPC.

4.3 The board cannot accept these arguments. Claim 1 indicates that the feed additive is "being used at 1 to 50 g of **said** low molecular weight arabinoxylans per kg of feed" (emphasis by the board). That is to say, the low molecular weight arabinoxylans present in the feed additive are those which result in the required concentration per kg of feed. There is no room for an interpretation of the claim wherein the feed additive is not incorporated into a feed.

Thus claim 1 has been limited to the embodiment wherein the feed additive is added to the feed in the specified amount, an embodiment explicitly disclosed as preferred in the application as originally filed (cf. page 6, line 23).

4.4 Concerning the question whether the amended claim 1 extends the protection conferred, it is noted that claim 1 is based on claim 12 as granted, this claim being directed to "the use of arabinoxylans ... for the manufacture of a feed additive according to any one of claims 1 to 11". Compared to granted claim 12, the subject-matter of claim 1 has been limited by specifying that the feed additive is "for monogastric animals for improving the weight gain and/or feed utilisation of monogastric animals" and that the feed additive is used "at 1 to 50 g of said low molecular weight arabinoxylans per kg of feed".

Thus, the scope of claim 1 of auxiliary request is limited over the scope of claim 12 as granted.

4.5 Insofar as the respondents argued that the granted claims did not protect a therapeutic use of the feed

additive whereas the amended claims protect such use, the board notes that this line of argument contradicts the core of the respondents' submissions that the granted claims were not allowable because they embraced a therapeutic use.

In any case, either because the therapeutic use was already embraced by the granted claims or because the granted claims, by not specifying the intended use, embraced any use, the claims have not been amended in such a way as to extend the protection they confer.

4.6 The opposition division in its decision did not raise any objection under Article 123(2) EPC against the remaining claims, *i.e.* dependent claims 2 to 8. Nor did the respondents during the appeal proceedings. The board sees no reason to raise any objection of its own.

4.7 Consequently, the subject-matter of the claims of auxiliary request 6 meets the requirements of Article 123(2) and (3) EPC.

5. *Article 84 EPC*

5.1 The opposition division saw a lack of clarity in the feature "said feed additive used at 1 to 50 g of said low arabinoxylans per kg of feed" and concluded that said lack of clarity had consequences for whether the claim fulfils the requirements of Article 123(2).

However, as explained above in relation to the discussion of the amendments (see point 4.3), the board sees no lack of clarity in the above mentioned feature.

The objected feature therefore fulfils the requirements of Article 84 EPC.

- 5.2 The respondents further argued a lack of clarity in the wording of the claim due to its drafting in the Swiss-type format.

The board agrees with the appellant that so far as the EPO is concerned, a Swiss-type claim relating to a second medical use has not given rise to any problem under Article 84 EPC for almost 30 years. As set out in point 3.4.2 above, claim 1 of auxiliary request 6 has to be interpreted analogously, namely that the invention lies in the intended use. Consequently, the drafting of the claim in a manner analogous to Swiss-type claims does not infringe the requirements of Article 84 EPC either.

- 5.3 Finally, as regards the respondents' objection that the arabinoxylans referred to at the beginning of the claim ("Use of arabinoxylans ... ") are not limited to the specific low molecular weight arabinoxylans mentioned subsequently in the claim, the skilled person when considering a claim would rule out interpretations which are manifestly inconsistent with its clearly intended meaning. In the present case, it would be immediately evident to the skilled person that the claim embraces only the use of the specified arabinoxylans, *i.e.* the low molecular weight arabinoxylans.

- 5.4 For these reasons the claims do not infringe the requirements of Article 84 EPC.

6. *Article 53(c) EPC*

6.1 Article 53(c) EPC requires that European patents shall not be granted in respect of methods for treatment of the human or animal body by surgery or therapy.

6.2 The respondents objected to claim 1 as embracing a therapeutic method, the reason being that the low molecular weight arabinoxylans may have both a therapeutic and a non-therapeutic effect.

6.3 This argument, however, no longer applies to present claim 1 which, as set out above, is drafted in a manner analogous to a Swiss-type claim as "Use of arabinoxylans ... for the manufacture of a feed additive ... ". Such a claim formulation is allowable even if the manufactured feed additive were used in a therapeutic method.

6.4 Consequently, the requirements of Article 53(c) EPC are met.

7. *Remittal (Article 111 EPC).*

7.1 The board has decided that the subject-matter of the claims of auxiliary request 6 overcomes the objections under Articles 84, 123(2) and 53(c) EPC forming the basis of the decision under appeal.

7.2 The opposition division has not yet taken a decision on the other patentability issues raised by the respondents.

Furthermore both the appellant and respondent 03 requested remittal of the case to the opposition division for further prosecution and respondent 02 stated during the oral proceedings that it did not oppose such remittal.

- 7.3 Under these circumstances, the board considers it appropriate to exercise its discretion under Article 111(1) EPC to remit the case to the opposition division for further prosecution on the basis of auxiliary request 6.

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 the further prosecution of the case on the basis of the sixth auxiliary request (claims 1 to 8) filed with the statement of the grounds of appeal dated 22 April 2010.

The Registrar:

The Chairman:

G. Röhn

W. Sieber