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Datasheet for the decision of 20 October 2015

Case Number: T 0824/12 - 3.3.09

Application Number: 99920265.8

Publication Number: 1102549

IPC: A23L1/29

Language of the proceedings: EN

Title of invention:
NUTRITIONALLY COMPLETE LOW pH ENTERAL FORMULA

Patent Proprietor:
ABBOTT LABORATORIES

Opponent:
NESTEC S.A.

Headword:

Relevant legal provisions:
EPC Art. 54, 56, 83, 100(a), 100(b), 100(c), 123(2)

Keyword:
Amendments - added subject-matter (no)
Sufficiency of disclosure - (yes)
Novelty - (yes)
Inventive step - claim 1 as granted (no)
Inventive step - claim 1 of auxiliary request I (no)
Inventive step - auxiliary request II (yes)

Decisions cited:
T 1002/92

Catchword:

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Case Number: T 0824/12 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 20 October 2015

Appellant: (Opponent)	NESTEC S.A. Avenue Nestlé 55 1800 Vevey (CH)
Representative:	Rupp, Christian Mitscherlich PartmbB Patent- und Rechtsanwälte Sonnenstraße 33 80331 München (DE)
Respondent: (Patent Proprietor)	ABBOTT LABORATORIES 100 Abbott Park Road Abbott Park, IL 60064-3500 (US)
Representative:	Boult Wade Tennant Verulam Gardens 70 Gray's Inn Road London WC1X 8BT (GB)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 30 January 2012 rejecting the opposition filed against European patent No. 1102549 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman	W. Sieber
Members:	N. Perakis
	D. Prietzel-Funk

Summary of Facts and Submissions

I. This decision concerns the appeal filed by the opponent against the decision of the opposition division to reject the opposition against European patent No. 1 102 549.

II. The patent was granted with twenty claims. Claims 1, 16 and 20 read as follows:

"1. A liquid nutritional product having a pH of from 3.0-4.6 comprising:

a) from 45-95% by weight water;
b) from 1.0-15% by weight of a source of protein;
c) from 0.1-3.3% by weight of a stabilizer system comprising high methoxy pectin in the amount of at least 0.1% by weight of the nutritional product;
d) from 1-30% by weight of a carbohydrate;
e) from 0.5-10% by weight of an edible oil; and
f) at least 800 mg/liter of calcium;
g) at least 40 mg/liter of vitamin C;
h) at least 100 µg/liter of folic acid;
i) at least 2.5 µg/liter of vitamin D;
j) at least 6 mg/liter of vitamin E;
k) at least 30 µg/liter of vitamin K;

said liquid nutritional product prepared by a method including a homogenization step prior to and another one subsequent to an acidification step."

"16. A nutritional product according to claim 1 wherein said pH is 4.0 to 4.4 and said nutritional comprises:

a) from 60-90% by weight water;
b) from 6-8% by weight of a source of protein, wherein said source of protein is a mixture of milk protein isolate and calcium caseinate;
c) from 0.8-2.0% by weight of a stabilizer system comprising high methoxy pectin;
d) from 0.1-1.0% by of a calcium source, wherein said calcium source comprises a mixture of calcium glycerophosphate and calcium citrate;
e) from 0.3-2.0% by weight of a feed grade acid;
f) from 0.1-5.0% by weight soy lecithin;
g) from 0.1-3% by weight of an antioxidant system comprising ascorbyl palmitate, mixed tocopherols and citrate;
h) from 10-25% by weight of a carbohydrate;
i) from 0.5-5% by weight of an edible oil; and
j) vitamins and minerals."

"20. A method for preparing a liquid nutritional composition, said method including the steps of:

a) preparing an oil blend wherein said oil blend comprises an edible oil, an emulsifier, vitamins A, D, E and K, ascorbyl palmitate and mixed tocopherols;
b) preparing a carbohydrate/mineral slurry by mixing high methoxy pectin with water at less than 10% by weight total solids under high shear at a temperature between 65°C and 71°C (150°F-170°F) for at least ten (10) minutes and thereafter adding a source of major minerals, trace/ultra trace minerals and carbohydrates;
c) preparing a protein slurry by combining protein with water, under agitation, to obtain an aqueous mixture of at least 8% by weight solids;

d) combining the protein slurry, carbohydrate/mineral slurry and the oil blend to form a protein/carbohydrate/mineral/oil mixture;
e) homogenizing the protein/carbohydrate/mineral/oil mixture through a homogenizer at a pressure of at least 17 MPa to form a homogenized blend;
f) acidifying the homogenized blend of step (e) with an edible acid to a pH ranging from 3.0-4.6;
g) adding to the homogenized mixture at least one component selected from the group consisting of flavors, colors, vitamins, fruit juice, water, folic acid, cysteine and ascorbic acid;
h) homogenizing the acidified mixture from step (g) by passing the mixture through a homogenizer at a pressure of at least 17 MPa to form an aqueous food solution; and
i) heating said aqueous food solution to a sterilization temperature for a time sufficient to kill or inactivate substantially all microorganisms in said food solution."

III. A notice of opposition was filed requesting revocation of the patent in its entirety under Article 100(a) (lack of novelty and inventive step), Article 100(b) and (c) EPC.

IV. The documents submitted before the opposition division included the following:
D10: US 5 409 725 A;
D11: US 5 614 241 A;
D13: US 5 690 975 A;
D16: EP 0 765 609 A2;
D19: WO 96/29880 A1;
D20: WO 96/25054 A1;
D23: A.C. Spork, *Dairy Foods*, July 1994, pp 34 and 36; and

D25: B.R. Thakur *et al*, *Critical Reviews in Food Science and Nutrition*, 1997,37(1), pp 47-73.

V. The decision of the opposition division rejecting the opposition may be summarised as follows:

The subject-matter of the claims as granted did not extend beyond the content of the application as filed, and the invention was disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. Furthermore, novelty of the claimed subject-matter over the cited prior-art documents was acknowledged.

Regarding inventive step, the opposition division considered D10 to represent the closest prior art. It held that the claimed product differed from that of D10 in that it comprised only high methoxy pectin as stabiliser and that a homogenisation step was required prior to acidification. The technical problem underlying the claimed invention was seen in the provision of a storage-stable, retortable mineral and vitamin supplemented liquid formula comprising high methoxy pectin as stabiliser. Example V of the patent showed that the sole use of high methoxy pectin provided superior results. As the solution was not obvious from the prior art, inventive step was acknowledged.

VI. On 26 March 2012 the opponent (in the following the appellant) filed an appeal against the decision of the opposition division. The statement setting out the grounds of appeal was filed on 1 June 2012 and included the following new documents:

D37':Brochure of USAID and DSM entitled "Fortification Basics, Milk" comprising four pages (disclosing on Table 2 "Micronutrient Content of Cow's Whole Milk (3.3% Fat)" from Genesis 6.01, ESHA Research, 1997); and

D38':"High-shear mixer", from Wikipedia, http://en.wikipedia.org/wiki/High-shear_mixer; 11 May 2012.

The appellant requested that the decision under appeal be set aside and that the patent be revoked. The appellant maintained all the objections raised before the opposition division.

VII. By letter dated 17 October 2012, the patent proprietor (in the following the respondent) filed observations on the appeal, including auxiliary request I. The respondent requested that the appeal be dismissed or that the patent be maintained on the basis of the claims of auxiliary request I.

It is noted that the claims of auxiliary request I differed from the claims as granted only in that claims 16-18 as granted had been deleted.

VIII. By letter dated 6 March 2013, the appellant submitted the following new documents and requested that they be admitted into the proceedings:

D37: EP 0 449 354 A1;
D38: WO 97/03574 A1;
D39: EP 0 664 300 A1;
D40: WO 94/14329 A1; and
D41: N. Amice-Quemeneur *et al*, *J Dairy Sci*, 1995 (78), pp 2683-2690.

The appellant repeated the previously raised objections. Regarding inventive step, it developed a new line of argumentation, starting from D37 as the closest prior-art document.

These arguments were repeated in the letter dated 21 August 2015.

IX. By letter dated 17 September 2015, the respondent objected to the admission of the late-filed documents into the proceedings.

X. On 20 October 2015, oral proceedings were held before the board. During these proceedings the board decided to admit late-filed document D37. The respondent reacted by filing auxiliary request II, consisting of one claim, namely claim 20 as granted. The appellant stated that he did not object to the admissibility of auxiliary request II.

XI. The arguments put forward by the appellant in its written submissions and at the oral proceedings may be summarised as follows:

- Claim 1 as granted extended beyond the content of the application as filed (Article 100(c) EPC). Firstly, there was no clear and unambiguous teaching in the application as filed that ingredients (g)-(k) as disclosed in table 2 could be combined with ingredients (a)-(e) in claim 1. Secondly, the reference to "vitamins and minerals" in claim 1 as filed was no longer present in claim 1 as granted, which now recited only one mineral, calcium. Lastly there was no basis in the application as filed for the process feature in

granted claim 1 in these general terms ("said liquid product prepared by a method including a homogenization step prior to and another one subsequent to an acidification step").

The range of "6-8% by weight of a protein source" in claim 16 as granted was not disclosed in the application as filed in combination with the specific amounts of the vitamins and minerals. In this regard, claim 18 as filed was not a proper basis, because it required for the composition "at least 25% of the RDI for protein".

- The invention disclosed in the patent lacked sufficiency because three out of the four high methoxy pectins of example II were found to be physically unstable. Furthermore, the stable one was only defined by its trade name, and its chemical structure may have changed over time.

- The subject-matter of claim 1 as granted lacked novelty in view of D10, D10/D21, D13 and D16. The subject-matter of claim 20 as granted lacked novelty over at least D10.

- Late-filed documents D37 to D41 should be admitted into the proceedings in view of their *prima facie* relevance, their submission being early enough to allow them to be considered by the respondent and not to complicate the proceedings.

- The subject-matter of claim 1 as granted lacked inventive step in view of the obvious combination of D37 with D23 or D25, or with one of D38 to D41.

- The subject-matter of claim 1 of auxiliary request II (identical to claim 20 as granted) lacked an inventive step in view of the obvious combination of D37 with D23/25 and D19. The method of claim 20 compared with that of D37 provided an alternative method for the preparation of a liquid nutritional composition. The technical differences over the method of D37 did not provide any technical effect and were either disclosed in D23/D25 (replace pectin by high methoxy pectin) and D19 (use an edible acid in order to reduce pH) or within the capabilities of the skilled person.

- The appellant objected to the description as adapted to auxiliary request II, in particular to paragraph [0001] and any formulation ("example") raising doubts as to whether or not the product would still be understood to be part of the claimed invention, which now related to a method only.

XII. The arguments put forward by the respondent in its written submissions and at the oral proceedings may be summarised as follows:

- The opposition division was correct to conclude that the introduction of ingredients (f)-(k) based on the complete set of lower German RDI values from table 2 was permissible. The claim was merely limited to one of the individual embodiments disclosed in the application as filed. As to the alleged omission of "minerals", it was clear from page 23, lines 20-21, that "Vitamins, minerals and other trace elements could be used to supplement the food composition ...", i.e. they were optional. Regarding the two homogenisation

steps, one before and another after acidification, this was also disclosed on page 13, lines 3-5.

As to claim 16 as granted, the amount of protein derived from the disclosure on page 9, line 33. For a nutritional product delivering at least 25% of the RDI for protein (also required in this embodiment), the lower limit must be 6% by weight. The only "selection" that had to be made in arriving at the subject-matter of claim 16 as granted was the selection of the minimum RDI values for Germany, which was entirely permissible.

- The invention of the patent was sufficiently disclosed. The patent set out in detail:
  i) suitable components for use in a liquid nutritional composition according to the invention (sections A-J of the description);
  ii) suitable high methoxy pectins in section B, such as GENU, JMJ, GEN, JM manufactured by Hercules Food ingredients;
  iii) at least one process for producing a liquid nutritional composition according to the invention (paragraphs [0096]-[0104] and example IV); and
  iv) liquid nutritional compositions according to the invention (examples IV and IX-XII).

- The subject-matter of claim 1 as granted (identical to claim 1 of auxiliary request I) was novel over D10, D11/D21, D13 and D16.

  D10 did not disclose a nutritional composition with a pH of 3.0-4.6, with 0.5-10 wt% of an edible oil (the list of ingredients in the single example

of D10 did not contain fat, since skim milk was involved), or with vitamins and minerals at the quantities specified in features (f) to (k) of claim 1 as granted.

D11/D20 concerned powdered food compositions and did not disclose that after water addition the reconstituted liquid nutritional product had the claimed pH or contained a high methoxy pectin (the disclosed pectin-citric was not necessarily a high methoxy pectin), an edible oil, vitamins and calcium in the claimed amounts. Furthermore, D11/ D20 did not disclose the homogenisation of the composition.

D13 did not disclose compositions which included an edible oil or the vitamins of features (f)-(k) of claim 1 as granted. Only skim milk powder was involved in the composition, so the list of D37', relating to the whole cow's milk, could not be used to supplement the disclosure of D13. Regarding homogenisation, it occurred only after acid acidification.

D16 did not disclose the vitamins and minerals of features (f)-(k) of claim 1 as granted. If homogenisation had to be used, it should be carried out after acidification.

- The subject-matter of claim 20 as granted (identical to claim 1 of auxiliary request II) was also novel over the stated prior art. The appellant failed to point out a single prior-art document which clearly and unambiguously disclosed steps (a) to (i) of the claim.

- Late-filed documents D37-D41, used against the inventive step, should not be admitted into the proceedings. D37, allegedly being the closest prior art, was not more relevant than D10, considered as such by the opposition division. In fact, D37 did not belong to the technical field of the patent in suit. Regarding the secondary documents D38-D41, they were not more relevant than the secondary documents submitted before the opposition division.

- The subject-matter of claim 1 as granted (identical to claim 1 of auxiliary request I) also involved an inventive step if D37 was taken as the closest prior-art document. D37 did not disclose a high methoxy pectin or the claimed vitamins and mineral in the claimed amounts. Furthermore, D37, in its general disclosure, did not describe an homogenisation step before acidification of the composition. The role of pectin in D37 was to stabilise the composition during the pasteurisation heat-treatment. The technical problem in view of D37 was the provision of a liquid nutritional composition with an extended shelf life and excellent physical stability. This was shown by the examples of the patent. The skilled person starting from D37 would have no reason to replace the pectin of D37 by a high methoxy pectin. The high methoxy pectins disclosed in D23 improved the mouthfeel, viscosity and stability of dairy drinks which were not complete nutritional products. The high methoxy pectins disclosed in D25 were used as gelling agents in the presence of calcium ions. The stability in D23 and D25 concerned stability during pasteurisation in order to avoid micro-organisms' spoilage; it

had nothing to do with physical stability over a long shelf life. The arguments of the appellant were based on an *ex post facto* analysis.

- The subject-matter of claim 1 of auxiliary request II (identical to claim 20 as granted) also involved an inventive step. The combination of the specific method steps provided a physically stable product with a long shelf life which was not disclosed or derivable from the cited prior art.

- The description adapted to auxiliary request II fulfilled the requirements of the EPC. In particular, the contested term "example", which replaced the previous term "embodiment", was used to describe the products derived from the claimed method; it did serve to disclose embodiments of the invention.

XIII. The appellant requested that the decision under appeal be set aside and that the patent be revoked.

XIV. The respondent requested that the appeal be dismissed, or, alternatively, that the patent be maintained on the basis of auxiliary request I submitted with letter dated 17 October 2012, or on the basis of claim 1 of auxiliary request II, including the adapted description pages 2 to 33, as submitted during the oral proceedings of 20 October 2015.

Reasons for the Decision

Main request (claims as granted)

1. The appellant maintained the objections raised before the opposition division against the granted patent, namely added subject-matter, insufficient disclosure and lack of novelty. The board, in agreement with the opposition division and in line with the submissions of the respondent, decided during the oral proceedings that the claims as granted did not contain added subject-matter, the claimed invention was sufficiently disclosed and the subject-matter of the claims as granted was novel over the cited prior art. Since, however, the board decided that the subject-matter of claim 1 as granted lacked inventive step, it is not necessary to further elucidate these issues (as to the novelty of claim 20 as granted, which is the subject-matter of auxiliary request II, see point 5 below).

2. Admissibility of late-filed documents

2.1 Documents D37-D41 were filed in the appeal proceedings with letter of 6 March 2013. As pointed out in T 1002/92, point 3.4 of the reasons, late-filed evidence should only very exceptionally be admitted into the proceedings, and only if such new material is *prima facie* highly relevant in the sense that it is highly likely to prejudice the maintenance of the patent in suit.

2.1.1 D37 is directed to a liquid, low pH, nutritional composition which uses as sole stabiliser pectin and two homogenisation steps, one before and one after acidification of the composition (see example 1). Furthermore, it has a shelf life of up to six months

with no substantial separation or sedimentation in the liquid as a result of the high calcium content (see page 1, lines 52-56; column 2, lines 26-31; column 5, lines 27-29).

Thus D37 lies within the same technical field as the patent, namely the field of liquid, low pH, nutritional compositions with high levels of macronutrients, vitamins and minerals having an extended shelf life and excellent physical stability. The patent in suit discloses that physical stability refers either to the absence of sediment or to a significant reduction in the occurrence of the formation of sediment - some of the physical instability is due to the high concentration of soluble calcium ions (patent page 1, lines 5-7; page 4, lines 24-25; page 11, lines 39-40). Furthermore, the compositions of D37, compared with those of the other cited documents, have the most features in common with the invention as granted.

2.1.2 Thus D37 is considered to be not only *prima facie* relevant but also the more suitable closest prior-art document. It is closer to the invention than D10 as regards the function of pectin in the nutritional composition. D10 imparts the long-term stability to the use of galactomannan (column 1, lines 54-59), while high methoxy pectin is disclosed to act only as a heat stabilising agent, i.e. it stabilises the composition during the chemical reaction between protein and galactomannan (see column 3, lines 21-34; column 4, lines 20-23). D37 uses pectin as a stabiliser and discloses that the final beverage is stable for a long storage period (see column 1, lines 1-5; column 2, lines 26-31; column 4, line 2; column 5, lines 27-30).

2.1.3 The respondent argued that D37 should not be considered as relevant closest prior art because it related to calcium-enriched fermented milk beverages. However, milk beverages fall within the scope of the invention as granted. Claim 6 as granted, dependent on claim 1, relates to sources of protein which include milk protein isolate, milk protein concentrate, and claim 10 as granted, also dependent on claim 1, relates to a specific source of protein, namely milk protein isolate. Thus this argument of the respondent must fail.

2.1.4 As correctly pointed out by the appellant, the introduction of D37 did not increase the degree of procedural complication. It was filed more than two years before the oral proceedings, and in fact at a time when the parties had not yet been summoned to oral proceedings. Thus, the respondent had had sufficient time to respond to the objections raised.

2.1.5 In view of the above, the board decided to admit D37 into the proceedings.

2.1.6 Documents D38-D41, which relate to the use of high methoxy pectins for the stabilisation of proteins in an acidic environment, are not more relevant than the documents already in the proceedings such as D23. Thus these documents were not admitted into the proceedings.

2.2 During the oral proceedings the appellant no longer relied on D37' and D38', i.e. the documents which had been filed with the statement of grounds of appeal. Thus, the board saw no need to decide on the admittance of these documents.

3. Inventive step

3.1 Closest prior art

As already explained above (point 2.1.2), D37 is considered to be the closest prior-art document. Example 1 of D37 discloses a liquid nutritional product which has a composition very similar to the composition of claim 1. In particular, the exemplified product:

- has a pH of 4.0 (column 5, line 32);

- is prepared by a method including a homogenisation step prior to and another one subsequent to an acidification step (column 4, lines 53-55 and column 5, lines 1-2 and 21-23, respectively); and

- comprises the following ingredients in the following amounts (the calculations of the appellant in this respect have not been contested by the respondent):
  - 10 wt% of protein (column 5, lines 30-32);
  - 0.4 wt% of pectin (column 5, lines 9-10);
  - 7.55 wt% of carbohydrates saccharose and lactose (column 5, lines 9-10);
  - 0.99 wt% of edible oil, namely molten butter oil (column 4, lines 53-55);
  - 1.56 g/ calcium (column 5, line 10);
  - vitamin mixture (column 5, line 21).

However, example 1 does not disclose the exact composition of the vitamins and their respective amounts, nor that pectin is a high methoxy pectin.

3.2 Technical problem and solution

3.2.1 The respondent argued that the technical problem underlying the claimed invention in view of D37 concerns the provision of a liquid, low pH, nutritional composition with an extended shelf life and excellent physical stability (see patent: page 2, lines 5-6; page 4, lines 24-25; page 33, lines 23-25). Physical stability, which refers to either an absence of sediment or a significant reduction in the occurrence of the formation of sediment, guarantees a shelf life of at least 12 months, (patent: page 9, lines 20-22).

3.2.2 The technical evidence of the patent does not support the assertion that the technical problem has been solved. Example II discloses four high methoxy pectins, namely Danisco RS400, Danisco RS450, Danisco AM491, and Hercules JMJ, which were tested for their stabilisation on a high protein content, low pH beverage of the claimed invention (paragraphs [0108] and [0109]). The results of light micrograph for the first three listed high methoxy pectins were unsatisfactory since they showed large aggregates that represented a physically unstable product. Only the fourth high methoxy pectin showed good stabilisation of the proteins, as indicated by small aggregates throughout the product (paragraph [0110]). In view of this technical evidence, the board concurs with the appellant that the alleged technical problem is not solved, at least not over the entire scope of the claim.

3.2.3 Consequently, the technical problem has to be reformulated in less ambitious terms and has to be seen in the provision of an alternative liquid, low pH, nutritional composition. There is no doubt that this problem has been solved.

3.3 Obviousness

3.3.1 The skilled person starting from the disclosure of D37 and looking for an alternative liquid, low pH, nutritional composition would find in D37 that appropriate vitamins to be used in the composition of example 1 are vitamins A, B, C, D, E and K or folic acid (column 4, lines 18-19). The skilled person would also be aware that these vitamins should be added in amounts which fulfill the RDI requirements of the country in which the nutritional composition is going to be commercialised, and would thus adapt their amounts accordingly. As these amounts are not related to any surprising effect, their selection is not based on an inventive merit but lies within the ordinary capabilities of the skilled person.

3.3.2 The skilled person looking for an alternative nutritional composition would also find in the state of the art the motivation to replace the pectin of D37 by high methoxy pectin and would arrive at the claimed composition without exercising any inventive skill. Reference is made to D23 and D25.

D23 belongs to the field of acidified milk drinks (liquid, low pH compositions) and addresses the problem of flocculation of proteins such as casein when pH is reduced in these drinks. Since D23 relates to the same technical field as D37, the skilled person would consult it, in particular when facing the problem of stabilising the proteins of a milk drink. D23 discloses that high methoxy pectins are particularly useful because they "provide a consistent level of stabilisation under a wide range of conditions" (see page 36, left column, third complete paragraph, last sentence). Furthermore, D23 contains a flow chart

in the middle column of page 36 where it is explained that a pectin solution comprising high methoxy pectin is first homogenised, then acidified by mixture with a non-fat yogurt comprising an acidified milk, and subsequently again homogenised. This is exactly the sequence that is required by the process steps of claim 1 and also disclosed in D37. Accordingly, D23 strongly suggests to use a high methoxy pectin in the method of D37.

D25 discloses the use of high methoxy pectins for the stabilisation of certain sour milk products (page 63, left column, lines 5-7 and page 64, right column, lines 27-29). Thus D25 also suggests to the skilled person the use of high methoxy pectins as an obvious alternative to the pectin of D37.

3.3.3 The respondent argued that it was not obvious to combine the specific vitamins in their respective amounts with high methoxy pectin. However, as the appellant correctly remarked, there was no synergistic effect shown to derive from the above combination. Thus this argument of the respondent must fail.

3.4 On the basis of the above, claim 1 as granted lacks inventive step, with the consequence that the main request is not allowable.

Auxiliary request I

4. Claim 1 of auxiliary request I is identical to claim 1 as granted and in view of the conclusion regarding that claim, auxiliary request I is also not allowable.

Auxiliary request II

5. Novelty

5.1 Claim 1 of auxiliary request II is identical to claim 20 as granted. The appellant argued in the statement setting out the grounds of appeal that the subject-matter of this claim lacked novelty over at least D10. There was also a rather vague statement on D11/D20, D13 and D16.

Firstly, the board notes that the appellant had acknowledged before the opposition division that none of the cited documents disclosed the method according to claim 20 as granted (appealed decision, page 11, last paragraph). Secondly, the appellant did not identify a single document disclosing all the rather specific features (a) to (i) of the presently claimed method. Regarding D10 in particular, which relates to stable, protein-fortified juice beverages, it does not require an edible oil in the method for preparing the composition. Thus, the subject-matter of claim 1 of auxiliary request II is novel for at least this difference.

5.2 Contrary to the assertions of the appellant, the protein premix used in the example of D10 derives from skim milk and thus does not contain any milk fat.

6. Inventive step

6.1 The board concurs with the appellant that D37 could still be considered to represent the closest prior art. As set out above, D37 discloses a method for preparing a liquid nutritional composition which combines the steps of homogenising a low fat milk enriched with

butter oil (first homogenisation), fermenting the milk to a pH from 3.8-4.2 (acidification is caused by the acid produced by the lactic acid bacteria), homogenising the fermented yogurt (second homogenisation), mixing it with an aqueous solution of sugars, a stabiliser (such as pectin) sources of minerals (such as a calcium compounds and a magnesium compound) vitamins and trace elements under agitation, and finally homogenising the mixture (third homogenisation) before packaging it (see column 2, lines 2-23; column 4, line 50 to column 5, line 24; claim 1).

The method of claim 1 of auxiliary request II differs from the method of D37 essentially in that the homogenisation before acidification is carried out on a mixture comprising the proteins, carbohydrates, oil, vitamins and pectin, which is a high methoxy pectin, and that the acidification is carried out using an edible acid.

6.2 The technical problem underlying the claimed invention in view of D37 concerns the provision of an alternative method for preparing a liquid, low pH, nutritional composition.

6.3 The skilled person starting from the method of D37 and aiming to provide an alternative method for the production of a low pH, liquid, nutritional composition would not find in the state of the art any motivation to modify the known method in such a manner that he would arrive at the method as claimed. Although D23 and D25 disclose the use of high methoxy pectin as a stabiliser and although D19 discloses the use of edible oils in reducing the pH of liquid nutritional compositions (see D19: page 1, lines 2-3; page 3,

lines 25-29), there is no hint in the art to the combination of all the specific steps, in particular to homogenise all the essential ingredients of the composition including high methoxy pectin before acidification.

In the absence of any hint in the art, the argument of the appellant that the changes to the method of D37 which lead to the claimed method were within the capabilities of the skilled person can only be based on an *ex post facto* analysis.

6.4 On this basis, claim 1 is considered to involve an inventive step.

7. Adapted description

The appellant objected to the amended description. Basically it argued that the reference to beverages in paragraph [0001] and the substitution of the term "embodiment" by "example" conveyed to the reader that the invention was still directed to beverages. The board cannot accept this argument. Any reference to "inventive" or "of the invention" in the context of formulas/beverages has been deleted, so that it is clear that a formula/beverage is not part of the invention any more. Nevertheless, a formula/beverage is the inevitable product of the inventive process. It would therefore be inappropriate to completely delete any reference to formulas/beverages. The same reasoning applies to the term "example", which merely describes a particular formula/beverage which can be produced by the claimed process. Thus the adapted description is acceptable.

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 with the order to maintain the patent on the basis of:

   - claim 1 of auxiliary request II as submitted during the oral proceedings before the board together with
   - the adapted description pages 2 to 33 as submitted during the oral proceedings before the board.

The Registrar: The Chairman:

M. Cañueto Carbajo W. Sieber

Decision electronically authenticated