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Datasheet for the decision of 5 February 2016

Case Number: T 1937/14 - 3.3.09

Application Number: 05075549.5

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IPC: A23L1/29

Language of the proceedings: EN

Title of invention:
Infant formula with improved fat composition

Patent Proprietor:
N.V. Nutricia

Opponents:
ABBOTT LABORATORIES
Friesland Brands B.V.

Headword:

Relevant legal provisions:
EPC Art. 76(1)

Keyword:
"All requests: Extension beyond the content of the earlier application as filed (yes)"

Decisions cited:
T 0686/99

Catchword:

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Case Number: T 1937/14 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 5 February 2016

Appellant: (Patent Proprietor)	N.V. Nutricia Eerste Stationsstraat 186 2712 HM Zoetermeer (NL)
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Respondent 02: (Opponent 02)	Friesland Brands B.V. Stationsplein 4 3818 LE Amersfoort (NL)
Representative:	van Deursen, Petrus Hubertus FrieslandCampina Innovation Centre Intellectual Property Department Bronland 20 6708 WH Wageningen (NL)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 23 July 2014 revoking European patent No. 1557096 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	W. Sieber
Members:	J. Jardón Álvarez
	F. Blumer

Summary of Facts and Submissions

I. This decision concerns the appeal filed by the proprietor of European patent No. 1 557 096 against the decision of the opposition division to revoke the patent.

II. The granted patent originated from a divisional application of the earlier European patent application No. 00991317.9 and contained 16 claims, independent claim 1 reading as follows:

"1. An infant formula comprising:

a. at least one protein component;
b. at least one lipid component;
c. at least one prebiotic component, wherein said prebiotic component comprises a mixture of one or more *trans*-galacto-oligosaccharides and one or more fructo-oligosaccharides; and
d. the polyunsaturated long chain fatty acids linoleic acid, α-linolenic acid, oleic acid, arachidonic acid and docosahexaenoic acid."

Claim 15 was directed to the use of components a) to d) for preparing a nutritional composition for feeding infants.

Claims 2 to 14 and 16 were dependent claims.

III. With the notice of opposition both opponents had requested revocation of the patent in its entirety on the grounds of Article 100(a) (lack of novelty and inventive step), (b) and (c) EPC.

IV. The opposition division's decision was based on a main request (claims as granted) and two auxiliary requests. It can be summarised as follows:

- The subject-matter of claim 1 of all requests extended beyond the content of the parent application as filed (D1: WO 01/41581 A1). The claimed embodiments resulted from several selections out of equally preferred components disclosed in the parent application as filed. There was no pointer to the specific claimed combinations. As a consequence, none of the requests met the requirements of Articles 100(c)/ 123(2) EPC.

- The opposition division did not deal with other patentability issues.

V. The patent proprietor (in the following: the appellant) lodged an appeal and filed the statement setting out the grounds of appeal on 21 November 2014, including a main request (former auxiliary request 1) and three auxiliary requests (former auxiliary request 2 and two new requests). The appellant requested that the decision under appeal be set aside, that the compliance of the main request or of any of auxiliary requests 1 to 3 with Articles 123(2) and (3) and 84 EPC be acknowledged by the board and that the case be remitted to the opposition division for the further consideration of sufficiency of disclosure, novelty and inventive step.

VI. With their replies dated 23 February 2015 and 10 March 2015 respectively, both opponents (in the following: respondent 01 and respondent 02) requested that the appeal be dismissed and that auxiliary requests 2 and 3 not be admitted into the proceedings. They supported the

appellant's request for remittal if any of the requests were seen by the board as fulfilling the requirements of Articles 76(1)/123(2) EPC. Additionally, respondent 02 requested that the appeal be rejected as inadmissible.

VII. In a communication dated 4 August 2015 the board indicated the points to be discussed during the oral proceedings.

VIII. Oral proceedings before the board were held on 5 February 2016. At the beginning of the proceedings respondent 02 withdrew its request that the appeal be rejected as inadmissible and during the proceedings both respondents withdrew their requests not to admit auxiliary requests 2 and 3 into the proceedings.

Claim 1 of the main request reads as follows:

"1. An infant formula comprising:
a. at least one protein component;
b. at least one lipid component, wherein the palmitic acid residues make up 16-24% of all fatty acid residues present in the triglycerides and of these palmitic acid residues at least 30% is in the Sn2 position of the triglycerides;
c. at least one prebiotic component; wherein said prebiotic component comprises a mixture of one or more *trans*-galacto-oligo-saccharides and one or more fructooligosaccharides wherein the ratio of *trans*-galacto-oligosaccharides to fructooligosaccharides in the mixture is between 5:1 and 15:1; and
d. the polyunsaturated long chain fatty acids linoleic acid, alpha-linolenic acid, oleic acid, arachidonic acid and docosahexaenoic acid."

Claim 1 of auxiliary request 1 differs from claim 1 of the main request in that the protein component a) is defined as follows:

"a. at least one protein component comprising between 1 and 3 gram protein hydrolysate per 100 ml;".

Claim 1 of auxiliary requests 2 and 3 is based on claim 1 of the main request and auxiliary request 1 respectively, with the further limitations that:

- the palmitic acid residues in the Sn2 position of the triglycerides is "at least 40%" (instead of "at least 30%"); and

- the ratio of *trans*-galacto-oligosaccharides to fructo-oligosaccharides in the prebiotic mixture is "about 9:1" (instead of "between 5:1 and 15:1").

IX. The arguments of the appellant may be summarised as follows:

- Contrary to the view of the opposition division, there was no need for the skilled person to select each of the features of the claim from lists of equally preferred alternatives. The claimed combination of preferred lipid component and preferred prebiotics was directly and unambiguously derivable from the application as filed.

- Moreover, the combination of protein component, lipid component, prebiotic component and a further component was emphasized in the application as filed as a preferred embodiment. The combination of this embodiment with polyunsaturated fatty acids

was certainly not an entirely different invention. The five polyunsaturated fatty acids were disclosed in the application as filed. They were ingredients of infant formulae known *per se* and they could not be considered to contribute to an entirely different invention. In its view, this feature did not improve the appellant's position and did not give it an unwarranted advantage.

- The auxiliary requests were restricted in terms of preferred components and would render the Article 123(2) EPC objections of the opposition division void.

X. The relevant arguments of the respondents may be summarised as follows:

- The respondents supported the line of argumentation of the opposition division.

- Additionally, they emphasised that there was no basis for omitting the phosphorous content from the protein component and that there was no disclosure of all five polyunsaturated fatty acids being present together in the infant formula.

- Respondent 01 also indicated that the argument of the appellant that the five polyunsaturated fatty acids did not provide a technical contribution was flawed. In fact, it was well known that these acids provided certain benefits to infant formulae.

XI. The appellant requested that the decision under appeal be set aside, that the compliance of the main request or any of auxiliary requests 1 to 3 with Articles 123(2) and (3) and 84 EPC be acknowledged and that the case be

remitted to the opposition division for the further consideration of sufficiency of disclosure, novelty and inventive step. Subsidiarily, the appellant requested that the patent be maintained according to the main request or any of auxiliary requests 1 to 3.

The respondents requested that the appeal be dismissed. In addition, they supported the appellant's request for remittal if any of the requests were to be seen by the board as fulfilling the requirements of Articles 76(1)/ 123(2) EPC.

Reasons for the Decision

MAIN REQUEST

1. *Amendments (Articles 76(1)/100(c) EPC)*

1.1 The patent in suit was granted on a divisional application of the earlier European patent application No. 00991317.9 (filed on 13 December 2000 as an international application and published as WO 01/41581 A1, D1 in these proceedings). In respect of Articles 76(1)/100(c) EPC, the subject-matter of the patent in suit may not therefore extend beyond the content of the earlier (parent) application as filed.

The relevant criterion in this context is whether the skilled person can derive the claimed subject-matter directly and unambiguously, using common general knowledge, from the parent application as filed as a whole, either explicitly or implicitly.

1.2 As set out at the very beginning of D1, the invention of D1 relates to an improved infant formula containing at

least an easily digestible lipid component and an improved protein component (page 1, lines 3 to 4; see also claim 1).

The passage at page 4, lines 14 to 24, then describes the infant formula in somewhat broader terms:

"Thus, the present invention provides an infant formula that comprises any combination of two or more, preferably of three or more, and most preferably all, of the following components:

a) at least one protein component (here below referred to as *"component A"*);

b) at least one lipid component that can be easily digested by an infant (*"component B"*);

c) at least one prebiotic component (*"component C"*);

at least one viscosity improving component (*"component D"*);

and that optionally further contains any component of infant formula known per se, including but not limited to those described below (here below referred to as *"further components"*);...".

Although the disclosure of D1 with regard to the composition of the infant formula remains rather vague, there is a clear preference as to the combination of components A, B and C (page 5, lines 25 to 26):

"More preferably, the infant formula of the invention contains a combination of components A + B + C; and optionally one or more further components".

1.3 It was undisputed that every feature of claim 1 is individually disclosed in D1. Reference is made to the following passages:

- The above-cited passage at page 4 refers to a protein component in general (feature a) of claim 1).

- Page 18, lines 17 to 21 defines the lipid component as follows: "In other - but somewhat less restrictive - words, when the palmitic acid residues make up more than 10%, preferably 16-24% of all fatty acid residues present in the triglycerides used in or as component B of the invention, of these palmitic acid residues, as much as possible, and preferably at least 30%,... should be in the 2- or ß-position of the triglyceride" (feature b) of claim 1).

- Page 20, lines 7/8 discloses the use of mixtures of one or more *trans*-galacto-oligosaccharides ("TOS") and one or more fructo-oligosaccharides ("FOS") in which the ratio of TOS-to-FOS is between 5:1 and 15:1 (feature c) of claim 1).

- Page 21, lines 21/22 discloses the use of one or more polyunsaturated long chain fatty acids ("PUFAs"), including but not limited to linoleic acid, α-linolenic acid, oleic acid, arachidonic acid and docosahexaenoic acid (feature d) of claim 1).

1.4 It was also undisputed that the combination of all the features required by claim 1 is not explicitly disclosed in the parent application as filed. The question to be

investigated in this appeal is therefore whether this combination is implicitly disclosed in the parent application as filed.

1.5 As to whether or not the generation of a fresh particular combination contravenes Article 123(2) EPC (and the same criteria apply for Article 76(1) EPC), it was set out in T 686/99 of 22 January 2003, not published in OJ EPO, that:

"The content of the application as filed must not be considered to be a reservoir from which individual features pertaining to separate sections can be combined in order artificially to create a particular combination. **In the absence of any pointer to that particular combination**, this combined selection of features does not, for the person skilled in the art, emerge clearly and unambiguously from the content of the application as filed" (point 4.3.3 of the reasons; emphasis added by this board).

1.6 The appellant argued in this respect that the present case was different. There was no need for the skilled person to select each feature of claim 1 from lists of equally preferred alternatives. In fact, there was a clear pointer in D1 to both the lipid and the prebiotic component: The advantages of the content and position of palmitic residues and the use of mixtures of TOS and FOS in an infant formula were already grouped together at page 2, line 25 to page 3, line 3 of D1 which define the problems existing in the conventional art, and the solutions provided by the inventors. The only selection to be made would be the choice of PUFAs from the list for further components. The combination of features a), b) and c) with the PUFAs was not a different invention.

1.7 However, in the board's view, these arguments are not convincing, for the following reasons:

1.7.1 The claimed infant formula does not merely require a single selection of PUFAs from the list for further components. In fact, in order to arrive at the subject-matter of claim 1, multiple selections within the disclosure of D1 are required.

1.7.2 Thus, as pointed out above, D1 does in fact disclose the combination of components A + B + C and optionally one or more further components as being preferred for an infant formula (page 5, lines 25 to 26). However, in the context of this passage, A, B and C are defined in rather general terms, namely as being a protein component (A), a lipid component (B) and a prebiotic component (C). The combination of A + B + C is not at all equivalent to the combination of a) + b) + c) as required in claim 1.

In fact, several selections have to be made within the disclosure of D1 in order to arrive at the combination a) + b) + c) as required in claim 1. It would be necessary to choose the broad definition for the protein component and combine it with specific selected embodiments for the lipid component and for the prebiotic component.

1.7.3 As to the lipid component b) of claim 1, it is based on the explicit disclosure on page 18 (see also point 1.3 above). But this passage gives two definitions with regard to the palmitic acid residue content and position in the triglycerides, one apparently being somewhat less restrictive than the other. Furthermore, it is stated at page 18, lines 22 to 25:

"Mixtures of fatty acid triglycerides that contain more than 10%, preferably 16-24% palmitate residues and that meet one or both of the requirements relating to the position of the palmitate residues set out in the above two paragraphs, will also be referred to below as the "*preferred lipid component B*"."

Thus, even for the preferred lipid component B, various, different definitions exist. There is no indication whatsoever in D1 that the somewhat less restrictive definition for the lipid has to be chosen in combination with the remaining features of claim 1.

1.7.4 Moreover two further selections are needed concerning the PUFAs, namely, first to select the PUFAs from the rather long list of further components, and second to select all five PUFAs as being present together. For such further selections there is also no hint at all in the parent application.

1.7.5 Also, the "key aspects" of the invention as set out at pages 3 to 4 referred to by the appellant do not establish an "intermediate teaching" having all the features of claim 1 apart from the PUFAs.

In particular, the definition of the lipid on page 3 is much more general than for component b) in claim 1. And even if that more general statement were to be interpreted as referring to "the preferred lipid component B" of D1, the argument given in point 1.7.3 equally applies here. The relevant question is still: why select the specific definition for component b) of claim 1?

1.7.6 Thus, the argument of the appellant that the subject-matter of claim 1 involves only the single selection of

polyunsaturated fatty acids, when taking into account the teaching provided in D1, must fail. Instead, the appellant has "cherry-picked" elements from the disclosure of D1 and created a new combination of features, without there being any pointer to this new combination in D1.

D1 describes the drawbacks of conventional infant formulae in a general way and presents preferred infant formulae and/or elements thereof as advantageous over prior art formulae. There are numerous alternatives for each component, but there is no hint to the combination of definitions (general and specific) now selected in claim 1. In fact, the components of the infant formulae are presented rather in a parallel manner than in connection to each other. There is no pointer at all to an embodiment with all the required features of claim 1.

1.7.7 This absence of a pointer to the claimed combination of features is corroborated by the fact that none of the examples, which is usually the place where the skilled person would look for the best infant formulae in a patent application, falls within the scope of claim 1. None of the examples contains all five PUFAs required by claim 1. General reference is made to poly-unsaturated fat, but the PUFAs required by claim 1 are not mentioned, let alone the presence of all five. Moreover, the infant formulae therein exemplified do not specify whether the lipids used are lipids meeting the requirements of component b) of claim 1.

1.7.8 Lastly, the board cannot accept the argument of the appellant that PUFAs are components of infant formula known *per se* and that therefore they cannot be considered to contribute to an entirely different invention. Apart from the fact that this is not the

relevant criterion for added subject-matter, the opposite appears to be the case. As pointed out by respondent 01, it is well known that PUFAs provide certain benefits to infant formulae as they promote growth and development of infants.

1.7.9 In summary, the board agrees with the respondents and the opposition division that the specific combination of features in claim 1 is not clearly and unambiguously derivable from the parent application as filed.

1.8 Therefore claim 1 of the main request contains subject-matter which extends beyond the content of the parent application as filed (Articles 76(1)/100(c) EPC). Consequently, the main request is not allowable.

AUXILIARY REQUESTS 1 TO 3

2. *Amendments (Articles 76(1)/100(c) EPC)*

2.1 In claim 1 of auxiliary requests 1 to 3 the components of the infant formula have been further limited based on preferred and/or more preferred embodiments disclosed in D1 (for more details see point VIII above):

- component a) (auxiliary request 1),
- components b) and c) (auxiliary request 2),
- components a), b) and c) (auxiliary request 3).

2.2 The subject-matter of claim 1 of all these requests still comprises the combination of the specific lipid component b) with the five polyunsaturated fatty acids. Thus, in order to arrive at the subject-matter of claim 1 of all the auxiliary requests, at least the definition of the lipid component b) from the various "preferred lipid component B" (see point 1.7.3) and all

five PUFAs from the list of further components (see point 1.7.4) have to be selected. Again, as set out for the main request, there is no pointer to this combination. Also, none of the examples supports the combination present in claim 1 of any of auxiliary requests 1 to 3.

2.3 For these reasons the subject-matter of claim 1 of auxiliary requests 1 to 3 extends beyond the content of the parent application as filed (Articles 76(1) and 100(c) EPC).

3. Consequently, none of the appellant's claim requests is allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

M. Cañueto Carbajo W. Sieber

Decision electronically authenticated