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Datasheet for the decision of 8 February 2018

Case Number: T 1959/14 - 3.3.09

Application Number: 01991459.7

Publication Number: 1339292

IPC: A23K1/16, A23K1/18

Language of the proceedings: EN

Title of invention:
COMPOSITION AND METHOD

Patent Proprietor:
Hill's Pet Nutrition, Inc.

Opponent:
THE IAMS COMPANY

Headword:

Relevant legal provisions:
EPC Art. 56
RPBA Art. 13(1)

Keyword:
Late-filed documents - admitted (no)
Inventive step - (yes)

Decisions cited:

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

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Case Number: T 1959/14 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 8 February 2018

Appellant: (Patent Proprietor)	Hill's Pet Nutrition, Inc. 400 Southwest 8th Avenue Topeka, KS 66603 (US)
Representative:	Daniels, Jeffrey Nicholas Page White & Farrer Bedford House John Street London WC1N 2BF (GB)
Respondent: (Opponent)	THE IAMS COMPANY 8060 South Mason-Montgomery Road Mason, OH 45040 (US)
Representative:	Schiweck, Weinzierl & Koch Patentanwälte Partnerschaft mbB Landsberger Straße 98 80339 München (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 15 July 2014 revoking European patent No. 1339292 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	J. Jardón Álvarez
Members:	M. O. Müller
	E. Kossonakou

Summary of Facts and Submissions

I. This decision concerns the appeal filed by the proprietor of European patent No. 1 339 292 against the decision of the opposition division to revoke it.

II. In the notice of opposition the opponent had requested revocation of the patent in its entirety on the grounds under Article 100(a) (lack of novelty and inventive step) and 100(b) EPC.

The documents submitted during the opposition proceedings included:

D3: I. Cantuti-Castelvetri et al., Int. J. Devl. Neuroscience 18, 2000, pages 367 to 381;

D4: WO 00/11968 A1;

D7: WO 00/44375 A1;

D9: US 5,030,458 A;

D10: N. W. Milgram et al., Learning & Memory, volume 6, 1999, pages 54 to 61;

D11: S. Stoll et al., Pharmacology Biochemistry and Behavior, volume 46, 1993, pages 799 to 805;

D12: T. Kalaiselvi et al., J. Nutr. Biochem., volume 9, 1998, pages 575 to 581;

D13: T. M. Hagen et al., The FASEB Journal, volume 13, February 1999, pages 411 to 418;

D14: L. Packer et al., Free Radical Biology &

Medicine, volume 22, numbers 1/2, 1997, pages 359 to 378; and

D15: WO 01/58271 A1.

III. In its decision, the opposition division admitted D9 to D15 and found that the subject-matter of claim 10 of the third auxiliary request (the only claim relevant to the present decision) lacked inventive step. This claim read as follows:

"10. A companion pet diet meeting ordinary nutritional requirements of an adult companion pet and comprising at least about 100 ppm of vitamin E, at least about 50 ppm of vitamin C, at least about 25 ppm of alpha-lipoic acid, and at least about 50 ppm of l-carnitine, wherein the pet is a canine of 1 to 6 years or a feline of 1 to 6 years."

The opposition division held that the subject-matter of this claim differed from the closest prior art, D7, in terms of the specific antioxidants and their amounts. The opposed patent did not contain any information on why these antioxidants and amounts had been selected. These selections were thus arbitrary and could not contribute to an inventive step.

IV. This decision was appealed by the proprietor (the appellant). The statement setting out the grounds of appeal filed on 25 November 2014 contained a main request and first to third auxiliary requests as well as:

H1: Butterworths Medical Dictionary, second edition, London, Boston, Sydney, Wellington, Durban, Toronto, page 1150.

V. In a communication dated 12 July 2017 the board indicated the points to be discussed during the oral proceedings.

VI. With its letter dated 31 August 2017, the respondent filed:

D22: WO 02/45525 A2;

D23: first priority document of D22;

D24: second priority document of D22;

D25: third priority document of D22; and

D26: fourth priority document of D22.

VII. In response thereto, the appellant requested that D22 to D26 not be admitted into the proceedings and on 5 February 2018 filed the following evidence:

D27: Assignment dated 6 August 2001 concerning provisional application no. 60/253,448;

D28: Assignment dated 6 August 2001 concerning provisional application no. 60/253,447; and

D29: Extract from the patent assignment section of the USPTO public PAIR system, dated 2 February 2018.

VIII. With its letter dated 6 February 2018, the respondent filed:

D30: Extract from the patent assignment section of

the USPTO public PAIR system, printed on 6 February 2018.

IX. On 8 February 2018, oral proceedings were held before the board. During them, the appellant withdrew its main request and first and second auxiliary requests. The only claim of the remaining, third auxiliary request was identical to claim 10 of the third auxiliary request before the opposition division (see point III above).

X. So far as relevant to the present decision, the appellant's arguments can be summarised as follows:

D22 to D26 should not be admitted, since they had been filed extremely late and the novelty attack based on these documents raised complex new issues.

The subject-matter of claim 1 was inventive in view of D7 in combination with D4. It differed from the closest prior art, D7, in terms of the amounts of vitamins C and E and in that specific amounts of alpha-lipoic acid and L-carnitine were present. The problem to be solved in view of D7 was the provision of a diet that enhanced learning ability in cats and dogs. It was credible in view of example 1 of the opposed patent that this problem had been solved. The claimed solution was not obvious even if D7 was combined with D4. D4 did not address learning ability at all but focused on a completely different issue, namely neuropathy caused by diabetes. Furthermore it did not disclose the amounts of alpha-lipoic acid and L-carnitine as required by claim 1.

XI. So far as relevant to the present decision, the respondent's arguments can be summarised as follows:

D22 to D26 should be admitted since the appellant had been acquainted with D22 before it had been filed, and furthermore the documents had been filed as soon as the respondent had become aware of them.

The subject-matter of claim 1 lacked inventive step in view of D7 in combination with D4. Example 1 of the opposed patent was not a fair comparison between the claimed subject-matter and the closest prior art, D7. It could thus not prove that an enhanced learning ability was achieved compared with D7. The objective technical problem was thus the provision of a further diet. The solution to this problem, the claimed pet diet, was obvious in view of D4. D4 disclosed a composition containing vitamin C, vitamin E, alpha-lipoic acid and L-carnitine. The amounts of alpha-lipoic acid and L-carnitine given for this composition in D4 were amounts per kilogram diet and thus within the claimed ranges.

XII. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the third auxiliary request, filed with its letter dated 25 November 2014.

Further, the appellant requested that D9 to D15 not be admitted into the proceedings, and thus implicitly that the opposition division's decision to admit these documents be set aside.

Lastly, the appellant requested that D3 and D22 to D26 not be admitted into the appeal proceedings.

XIII. The respondent requested that the appeal be dismissed. Furthermore, the respondent requested that D3 and D22 to D26 be admitted into the proceedings.

Reasons for the Decision

Third auxiliary request (sole request)

1. Novelty

1.1 With its letter dated 31 August 2017, the respondent submitted a new document, D22, together with priority documents for it - D23 to D26 - and for the first time attacked the novelty of the subject-matter of claim 1 of the third auxiliary request on the basis of D22 (point 5 in conjunction with points 2 to 4 of the respondent's letter of 31 August 2017). The respondent argued that certain passages of D22 validly claimed priority while the priority of claim 1 of the opposed patent was invalid. The passages of D22 were thus prior art for the subject-matter of claim 1 and destroyed its novelty.

1.2 According to Article 13(1) RPBA, any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted at the board's discretion. This discretion has to be exercised in view of *inter alia* the current state of the proceedings and the complexity of the new subject-matter.

1.3 As set out above, the respondent's novelty attack was raised for the first time with its letter dated 31 August 2017. This was after the summons to the oral proceedings had been issued, so the new attack was filed extremely late.

1.4 This attack raises several complex new issues including whether the priority of certain passages of D22 and that of claim 1 of the opposed patent are valid.

The first issue, the priority of D22, was not at all addressed during the appeal proceedings before the letter dated 31 August 2017 was filed, and thus is a completely new issue.

As regards the second one, i.e. the validity of the priority of claim 1 of the opposed patent, the board acknowledges that it was raised in the response to the statement of grounds of appeal in the context of the question whether D15 is prior art under Article 54(2) EPC. However, this letter simply alleged that the priority of claim 1 of the opposed patent was not valid and did not provide any argument at all. Hence, this issue too was raised, in a substantiated way, for the first time with the letter dated 31 August 2017. It is thus equally a completely new issue.

1.5 The respondent argued that D22 to D26 should nevertheless be admitted since the appellant had known of D22. However, whether the appellant knew of D22 is irrelevant. What matters is that the appellant was confronted after the summons with a completely new attack and completely new issues related thereto.

1.6 The respondent further argued that documents D22 to D26 had been filed as soon as the respondent had become aware of their existence. However, the respondent filed an opposition against the patent issued from D22 already in 2014 and thus should have been aware of that document much earlier than 31 August 2017. Furthermore, the question whether a party files a document as soon as it becomes aware of it is irrelevant for the

criteria of complexity and state of the proceedings as referred to in Article 13(1) RPBA.

1.7 Therefore, the board decided not to admit the new novelty attack and the related documents D22 to D26 into the proceedings (Article 13(1) RPBA).

1.8 The respondent did not make any further novelty attack and the board is convinced that the subject-matter of claim 1 (the only claim) of the third auxiliary request is novel.

2. Inventive step

2.1 The only inventive-step attack the respondent maintained during the oral proceedings was based on a combination of D7 as the closest prior art with D4. Also the appellant started from D7 as the closest prior art.

2.2 The invention is directed to a method for increasing the mental capacity of an adult companion pet which comprises feeding the pet a sufficient amount of an antioxidant mixture (see paragraph [0009] of the specification).

2.3 D7 is directed to the provision of a means for reducing oxidative stress in domestic cats and dogs (page 1, lines 15 to 16 and page 2, lines 24 to 25). Therefore D7 has a similar objective as the opposed patent and can indeed be considered to represent the closest prior art. This was agreed by both parties.

2.4 The diet of D7 comprises vitamins C and E in combination (see paragraph bridging pages 6 and 7) and is used for the prevention or treatment of a disorder

such as ageing and neurodegenerative disease (page 13, lines 7 to 14).

D7 does not disclose either the presence of the further antioxidants alpha-lipoic acid and L-carnitine or their amounts as defined in claim 1.

Furthermore, as set out by the appellant in the statement of grounds of appeal, D7 does not disclose the amounts of vitamins C and E as required by claim 1, namely at least about 50 ppm of vitamin C and at least about 100 ppm of vitamin E. What D7 discloses is a level of vitamin C from 10 to 50 mg per 400 kcal diet (page 7, lines 9 to 11) and a level of vitamin E of 25 IU per 400 kcal diet or above (claim 8). Since the composition of the diet is not disclosed, it is not possible to transform the energy amount of 400 kcal into an amount expressed as weight. The amounts of vitamins C and E in terms of mg per kg diet (i.e. ppm) in D7 are thus not necessarily as required by claim 1.

In summary, the diet of claim 1 differs from the diet of D7 in terms of the amount of vitamin C, the amount of vitamin E, the presence and amount of alpha-lipoic acid and the presence and amount of L-carnitine.

2.5 According to the appellant, the problem to be solved in view of D7 was the provision of a diet which led to enhanced learning ability in dogs and cats.

2.5.1 In example 1 of the opposed patent, seventeen adult beagle dogs 2 to 4 years of age where randomly placed into a control or an enriched diet group. The control diet contained 59 ppm vitamin E and less than 32 ppm vitamin C. This diet differs from the diet defined in claim 1 in that the amounts of vitamins C and E are

below the lower limit of the claimed range and in that it does not contain any alpha-lipoic acid and L-carnitine. The enriched diet contained 900 ppm vitamin E, 121 ppm vitamin C, 260 ppm L-carnitine and 135 ppm alpha-lipoic acid. It is thus as defined in claim 1. The dogs receiving the control or enriched diet were tested by a landmark discrimination learning task. It was found that the dogs on the enriched diet made fewer errors than those on the control diet.

It is thus credible that by selecting amounts of vitamins C and E as required by claim 1 and by adding the further antioxidants alpha-lipoic acid and L-carnitine in the claimed amounts, the above problem of enhancing the learning ability of dogs and cats is solved.

2.5.2 The respondent argued that the amounts of antioxidants in the enriched diet of example 1 were far above the lower limits defined in claim 1. There was no proof that the problem of enhancing the learning ability was solved also for lower amounts close to these lower limits.

However, while experimental evidence is available in the opposed patent in the form of example 1 that an enhanced learning ability can be obtained, no experimental evidence at all was provided by the respondent. Without any such evidence, the respondent's argument is a mere allegation that due to its unsubstantiated nature cannot succeed.

2.5.3 The respondent further argued that the comparison made in example 1 of the opposed patent between the control and enriched diet was not a fair comparison with the

teaching of D7 and could not prove that compared to D7, an enhanced learning ability was obtained.

The board disagrees. While it is correct that a direct comparison with an exemplified embodiment of D7 has not been made, the diet of the control group is according to the teaching of D7. More specifically, similarly to the control diet, the amounts of vitamins C and E in terms of ppm are not known in D7 and no alpha-lipoic acid and L-carnitine are present. Moreover, in any case the board would acknowledge an inventive step even if no improvement over D7 is achieved (see below point 2.9).

2.5.4 Therefore, the provision of a companion pet diet which leads to enhanced learning ability is credibly solved over D7 and thus constitutes the objective technical problem.

2.6 D7 does not suggest that this problem can be solved by adjusting the amounts of vitamins C and E as required by claim 1 and by adding L-carnitine and alpha-lipoic acid in the claimed amounts. The solution as defined in claim 1 is thus not obvious in view of D7.

2.7 The respondent argued that the claimed solution was obvious in view of D7 in combination with D4.

D4 discloses an antioxidant composition comprising the two components acetyl L-carnitine and alpha-lipoic acid (title on page 1). In the last two paragraphs on page 17, D4 discloses that there is a marked synergistic effect of these two components on mice with proprioceptive sensory perception abnormalities induced by cisplatin. In the third paragraph from the bottom of

page 18, D4 continues that on the basis of this synergistic interaction, the composition

> "is suitable for preventing toxic and metabolic damage which gives rise to neuronal lesions of an acute or chronic nature. In particular, it can be used in the treatment of toxic neuropathies, especially diabetic peripheral neuropathies." (emphasis added by the board)

In the next two paragraphs, D4 discloses that

> "In view of its antioxidant capability, this composition is also indicated in the prevention or treatment of abnormalities of toxic or anoxic origin related to the release of free radicals in the brain, liver, heart or other organs and tissues.
>
> Furthermore in view of the ability of the composition to promote the action of IGF-1, pathological abnormalities related to ageing, such as neuro-degenerative disorders, may also obtain satisfactory benefit from its use." (emphasis added by the board)

On page 19 of D4, six compositions are disclosed one of which (composition 6) contains *inter alia* acetyl L-carnitine, alpha-lipoic acid, vitamin C and vitamin E.

D4 thus discloses the two components of claim 1 missing in D7 and in fact discloses the combination of all four components required by claim 1. However, D4 does not at all address learning ability. On the contrary, D4 focuses on the treatment of diabetic neuropathy (see the above highlighted portions with IGF-1 being an

insulin-like growth factor playing a role in diabetes). Therefore the skilled person looking at D4 would not have had any reason to assume that adding alpha-lipoic acid and L-carnitine to the diet of D7 would enhance the learning ability of dogs and cats.

Even if the skilled person would have added the two components, he would not have arrived at the subject-matter of claim 1, since D4 does not disclose amounts of alpha-lipoic acid and L-carnitine as required by claim 1. In this respect, the respondent's argument that the amounts of alpha-lipoic acid and L-carnitine in composition 6 of D4 (page 19) were as required in claim 1 is not convincing. The respondent's argument rests on the assumption that these amounts (25 mg alpha-lipoic acid and 250 mg acetyl L-carnitine) refer to amounts per kilogram diet since the amounts of these two components were given in the toxicological tests on page 7 of D4 in milligram per kilogram. However, firstly, there is no link in D4 between composition 6 on page 19 and these tests on page 7. Secondly, these tests refer to the feeding of a group of rats and mice, so the kilograms in these tests may equally refer to kilogram body-weight rather than kilogram diet.

2.8 Consequently, the subject-matter of claim 1, i.e. the only claim of the third auxiliary request, is inventive over D7 in combination with D4.

2.9 Even if one accepts the respondent's argument that example 1 was not a fair comparison between the claimed subject-matter and the closest prior art D7 (see point 2.5.3 above), inventive step would still have to be acknowledged. In this case, the objective technical problem would have to be formulated less ambitiously as the provision of a further/alternative diet that leads

to a good learning ability in cats and dogs. Since, as set out above, D4 does not address at all learning ability, the claimed solution would still not be obvious in view of D7 in combination with D4.

2.10 During the oral proceedings, the board decided to admit D3 into the proceedings and to uphold the opposition division's decision to admit D11, D14 and D15. Since these documents were not used against the third auxiliary request, there is no need for the board to give detailed reasons therefor in the present decision.

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 in amended form on the basis of

   - the claim of the third auxiliary request filed with the statement setting out the grounds of appeal dated 25 November 2014 and

   - a description to be adapted thereto.

The Registrar: The Chairman:

M. Cañueto Carbajo J. Jardón Álvarez

Decision electronically authenticated