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**Datasheet for the decision
of 24 October 2017**

Case Number: T 2334/14 - 3.3.09

Application Number: 03720422.9

Publication Number: 1492415

IPC: A23K1/165, A23K1/16, A23K1/18

Language of the proceedings: EN

Title of invention:
Method of improving absorption of vitamin E by a pet animal

Patent Proprietor:
Nestec S.A.

Opponent:
The IAMS Company

Headword:

Relevant legal provisions:
EPC Art. 100(c), 111(1)

Keyword:

Main request: Amendments - extension beyond the content of the application as filed (yes)

Auxiliary request 1: Amendments - extension beyond the content of the application as filed (no)

Remittal: yes

Decisions cited:

T 0686/99, G 0003/14

Catchword:



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Case Number: T 2334/14 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 24 October 2017

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 14 October 2014
revoking European patent No. 1492415 pursuant to
Article 101(3) (b) EPC**

Composition of the Board:

Chairman W. Sieber
Members: J. Jardón Álvarez
D. Prietzel-Funk

Summary of Facts and Submissions

- I. This decision concerns the appeal filed by the proprietor of European patent No. 1 492 415 against the opposition division's decision to revoke it.
- II. The granted patent contained 14 claims, independent claims 1 and 14 reading as follows:

"1. A lipid-absorption promoting composition comprising at least one liver function-promoter and at least one an [sic] intestinal mucosa function-promoter for use in promoting or maintaining or improving lipid absorption capacity in a cat or dog over the age of 9 years old for the manufacture of an edible composition for improving or maintaining absorption of vitamin E in the cat or dog over the age of 9 years old, wherein

the liver function-promoter is selected from taurine, edible emulsifiers, vitamins, minerals, glutathione and glutathione promoters, wherein the intestinal mucosa function-promoter includes a fat transportation aid agent or carrier selected from whey protein and proteases; and wherein the intestinal mucosa function-promoter alternatively or in addition includes an anti-inflammatory agent selected from omega-3 fatty acids, lactoferrin, prebiotics or probiotic micro-organisms."

"14. A non-therapeutic method of improving or maintaining absorption of vitamin E in a cat or dog over the age of 9 years old to achieve benefits related to outward appearance, aging and owner-interaction benefits, the method including the step of feeding the cat or dog over the age of 9 years old a lipid-absorption promoting composition comprising at least

one liver function-promoter and at least one an [sic] intestinal mucosa function-promoter, wherein

- the liver function-promoter is selected from taurine, edible emulsifiers, vitamins, minerals, glutathione and glutathione promoters, wherein
- the intestinal mucosa function-promoter includes a fat transportation aid agent or carrier selected from whey protein and proteases; and wherein
- the intestinal mucosa function-promoter alternatively or in addition includes an anti-inflammatory agent selected from omega-3 fatty acids, lactoferrin, prebiotics or probiotic micro-organisms."

The remaining claims were dependent claims.

- III. The opponent 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), an auxiliary request filed during the oral proceedings and five auxiliary requests filed with letter of 4 August 2014. It may be summarised as follows:
- The subject-matter of claim 1 of the main request extended beyond the content of the application as filed (Article 100(c) EPC). The claimed subject-matter resulted from multiple selections within the teaching of the application as filed, the combination of which was not directly and unambiguously disclosed in the application as filed. The selections concerned: (a) the ingredients of the composition, (b) the target

animal and (c) the effects and use of the composition.

- The same objection applied to the request filed during the oral proceedings, which was therefore not admitted into the proceedings, and to the other five auxiliary requests on file.
- The opposition division did not deal with any 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 16 February 2015, including eight auxiliary requests. It requested that the decision under appeal be set aside and that the patent be maintained on the basis of the granted claims (main request) or on the basis of the claims of one of the auxiliary requests.

VI. With its reply dated 6 July 2015 the opponent (in the following: the respondent) requested that the appeal be dismissed (main request). It also requested that, if the board were to conclude that any of the requests met the requirements of Article 123(2) EPC, the case be remitted to the opposition division for consideration of the further grounds for opposition.

VII. By letter dated 6 November 2015 the appellant filed a further submission and also requested that the case be remitted to the department of first instance if any of the requests were found to comply with Article 123(2) EPC.

VIII. In a communication dated 4 May 2017 the board indicated the issues to be discussed during the oral proceedings.

It also expressed its preliminary view that the main request would be not allowable.

- IX. Further submissions were filed by the respondent on 23 August 2017 and by the appellant on 14 September 2017.
- X. During the oral proceedings held on 24 October 2017 the appellant filed an amended "Auxiliary Request 1" consisting of 12 claims. Independent claim 1 results from the combination of granted claims 1 and 2 and reads as follows:

"1. A lipid-absorption promoting composition comprising at least one liver function-promoter and at least one an [sic] intestinal mucosa function-promoter for use in promoting or maintaining or improving lipid absorption capacity in a cat or dog over the age of 9 years old for the manufacture of an edible composition for improving or maintaining absorption of vitamin E in the cat or dog over the age of 9 years old, wherein the liver function-promoter is selected from taurine, edible emulsifiers, vitamins, minerals, glutathione and glutathione promoters, wherein

the intestinal mucosa function-promoter includes a fat transportation aid agent or carrier selected from whey protein and proteases; and wherein the intestinal mucosa function-promoter alternatively or in addition includes an anti-inflammatory agent selected from omega-3 fatty acids, lactoferrin, prebiotics or probiotic micro-organisms, wherein the lipid-absorption promoting composition further comprises a pancreatic function-promoter."

Claims 2 to 12 are dependent claims.

XI. The arguments of the appellant, insofar as they are relevant for the present decision, may be summarised as follows:

- The combination of features of claim 1 as such with respect to the promoters was disclosed in the application as filed. The promoters were subsequently defined by lists of ingredients further defining those promoters. These lists might not be the literal lists disclosed in the application as filed, but they had generally only been shortened by a few elements.
- In particular, the claimed combination of two promoters resulted from the shortening of a list of three promoters by deletion of only one meaning. The original disclosure embraced a handful of possible combinations that was written in a short form without listing all possible combinations explicitly. However, that disclosure implicitly disclosed the combination as per claim 1 of the main request. Further support for the claimed combination was to be found in example 2, using two liver function promoters and one intestinal mucosa function promoter. The mention of taurine in the example as a pancreatic function promoter was an obvious error, and the skilled person would automatically correct it in view of the specification.
- The combination of the three promoters claimed in auxiliary request 1 was disclosed in claim 2 as filed and was hinted at in example 1 of the application as filed.

XII. The relevant arguments of the respondent may be summarised as follows:

- Concerning the main request, the respondent held in particular that there was no support for the two medical indications in the claim or for the specific combination of promoters claimed. The claimed alternative of two promoters represented a selection of a specific combination of promoters from seven possibilities originally disclosed, and it was not hinted at in any way in the application as filed.
- In addition, it agreed with the finding in the appealed decision that there was no support for the specific features defining the intestinal mucosa function promoter, the liver function promoter and/or the target animal. These features had been selected from several possible combinations within the scope of the application as filed.
- Concerning auxiliary request 1, it had no objection to its admission into the proceedings, and it did not dispute that example 1 hinted at the combination of the three promoters of claim 1.

XIII. The appellant requested that the decision under appeal be set aside and that compliance with the requirements of Article 123(2) EPC be acknowledged for the claims as granted (main request) or for "Auxiliary Request 1" filed during the oral proceedings or for one of the eight auxiliary requests already filed with the statement setting out the grounds of appeal, and that the case be remitted to the opposition division for further prosecution.

The respondent requested that the appeal be dismissed and furthermore that, if the board found any of the appellant's requests to meet the requirements of Article 123(2) EPC, the case be remitted to the opposition division for further consideration.

Reasons for the Decision

MAIN REQUEST (granted claims)

1. *Amendments - Article 100(c) EPC*

1.1 The **application as filed**, WO 03/084344 A2, discloses in claim 1 "A method of improving or maintaining absorption of vitamin E in a pet animal, the method including the step of feeding the pet an edible composition that promotes or maintains or improves its lipid absorption capacity".

Claim 2 further specifies that the edible composition used comprises "one or more of a pancreatic function-promoter, a liver function-promoter, and an intestinal mucosa function-promoter" (emphasis added by the board).

A similar definition of the lipid absorption-promoting ingredient is given on page 7, lines 25 to 27, where it is stated that the lipid absorption-promoting ingredient comprises "at least one nutrient selected from the groups comprising pancreatic function promoters, liver function promoters, intestinal mucosa function promoters and combinations thereof" (emphasis added by the board).

1.2 Thus, the general disclosure of **the application as filed** merely envisages a plurality of possible combinations of ingredients resulting in several alternatives. In this context, the respondent listed seven possible alternatives, namely:

- only one promoter: (A) pancreatic function promoter alone, (B) liver function promoter alone, (C) intestinal mucosa function promoter alone;
- combinations of two promoters: (AB), (AC), (BC);
- all three ingredients: (ABC).

The board notes that these seven alternatives are only the straightforward alternatives and that further alternatives are also possible, for example those containing two promoters of the same functionality, e.g. (AA'), (AA'B), etc., all of them embraced by the general disclosure of the definition of the lipid absorption ingredient given.

1.3 Furthermore, the application as filed contains two examples illustrating the implementation of fat absorption-improving nutritional intervention into commercial pet food products, namely a canned food cat diet (example 1) and a dry food cat diet (example 2). Diet B of example 1 is based on a commercial product which contains the following additional ingredients (see page 18, lines 25 to 28):

- a pancreatic function promoter: 0.1% acidifier (citric acid),
- a liver function promoter: at about 4 x AAFCO minimum taurine level for wet cat food (0.8% by weight on a dry matter basis),

- an intestinal mucosa function promoter: fish oils (3%).

The modified diet D of example 2 contains the following additional ingredients (see page 19, lines 10 to 12):

- a pancreatic function promoter: taurine (0.27%),
- a liver function promoter: lecithin from soya (1%),
- an intestinal mucosa function promoter: chicory (1%).

Although example 2 contains an error (see point 1.7.2 below), both examples disclose, at least *prima facie*, the combination of three promoters.

1.4 Claim 1 **as granted** is directed to a lipid-absorption promoting composition comprising

- at least one liver function promoter selected from a list of ingredients and
- at least one intestinal mucosa function promoter selected from another list of ingredients

for use in promoting or maintaining or improving lipid absorption capacity ...

Claim 1 is thus directed to the particular combination of at least one liver function promoter ingredient and at least one intestinal function promoter ingredient, (BC), this combination being neither explicitly mentioned nor exemplified in the application as filed.

1.5 As to whether or not the generation of a fresh particular combination contravenes Article 123(2) 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" (Reasons 4.3.3; emphasis added by this board).

1.6 The board cannot see any pointer in the application as filed to the specific combination of at least one liver function promoter ingredient and at least one intestinal function promoter ingredient. Nevertheless, the appellant argued that this combination was allowable, because:

(a) no undisclosed selection had been performed; the list of ingredients had merely been shortened by one meaning, the situation being comparable to the deletion of residues in multiple lists of residues defining a chemical formula; and

(b) example 2 hinted at the now claimed combination as it included two liver function promoters (taurine and lecithin from soya) and one intestinal mucosa function promoter (chicory).

1.7 The board disagrees for the following reasons:

1.7.1 As explained in point 1.2 above, the definition of the lipid absorption-promoting ingredient in the application as filed is not merely a list of three alternative components from which one has been deleted,

but is a general disclosure embracing a plurality of alternatives. This situation is completely different from the deletion of a possible residue in a chemical formula, where a meaning is merely deleted from a list of equally possible alternatives. In fact, the present situation leads to the singling-out of a combination not hinted at in the application as filed.

1.7.2 Also, example 2 cannot be seen as a pointer to the selected combination because this example is manifestly wrong. As pointed out above, it discloses a diet B based on a conventional dry cat food containing the following additional ingredients:

- taurine as a pancreatic function promoter,
- lecithin from soya as a liver function promoter,
- chicory as an intestinal mucosa function promoter.

The appellant argued that example 2 wrongly referred to taurine as a pancreatic function promoter, because it was evident from the description (for instance page 9, line 28) that taurine was in fact a liver function promoter. Therefore, example 2 would support the claimed combination of at least one liver function promoter and at least one intestinal mucosa function promoter.

The board accepts that the skilled person would realise that the reference to taurine as a pancreatic function promoter in example 2 is wrong. However, it cannot accept that the skilled person would immediately assume that taurine was indeed used and was wrongly named as a pancreatic function promoter. It is equally likely that a pancreatic function promoter had indeed been used, but not taurine. In this case the error lies in the reference to taurine. Thus, example 2 is not clear and

cannot be seen as a pointer to the claimed combination of promoters.

- 1.8 In summary, the board agrees with the opposition division and the respondent that the particular combination of promoters in claim 1 is not clearly and unambiguously derivable from the application as filed.
- 1.9 It therefore concludes that claim 1 of the main request contains subject-matter which extends beyond the content of the application as filed (Article 100(c) EPC) and that consequently the main request is not allowable.

AUXILIARY REQUEST 1

2. *Amendments - Article 100(c) EPC*

- 2.1 Claim 1 of auxiliary request 1 results from the combination of granted claims 1 and 2. Compared to granted claim 1 it now specifies that the lipid absorption-promoting composition "further comprises a pancreatic function-promoter".

The subject-matter now claimed is thus limited to the embodiment including the mandatory presence of three promoters, namely a liver function promoter, an intestinal mucosa function promoter and a pancreatic function promoter. This combination of promoters is the embodiment of example 1 of the application as filed, which ultimately is the only accurate example in the application.

This example provides the skilled person with the required hint that an embodiment including the three groups of promoters is a preferred embodiment within

the disclosure of the application as filed. In other words, the example is the required pointer to the disclosure of the now claimed combination.

2.2 The amendment made to claim 1 thus overcomes the reasons for rejection of the main request discussed above. This has not been disputed by the respondent.

2.3 The further features of the claim are supported by the application as filed as follows:

2.3.1 The two uses of improving lipid absorption capacity in a pet and of improving absorption of vitamin E are disclosed for instance on page 3, lines 22 to 26, where it is stated that:

"It is thus an object of the invention to provide a nutritional product that, when administered to a pet having sub-optimal serum levels of vitamin E, improves the digestibility of lipid and lipid-linked compounds, enabling more effective absorption or assimilation of vitamin E. Another object is to provide the pet and pet owner with advantages associated with effective assimilation of vitamin E." (emphasis added by the board)

and on page 4, lines 6 to 8, where is stated that:

"Thus, according to a first aspect of the invention, a method of improving or maintaining absorption of vitamin E in a pet animal includes the step of feeding the pet an edible composition that promotes or maintains or improves its lipid absorption capacity." (emphasis added by the board)

The respondent argued during the oral proceedings that the application as filed supported neither the use in promoting or maintaining lipid absorption capacity nor the combination of those two uses. In its view the application as filed referred to the lipid absorption capacity of the edible composition merely as a property of the composition, but not to the now claimed use.

While it is true that some passages of the description support the respondent's view, the two passages cited above give clear and unmistakable support for the combination of both uses as now claimed.

- 2.3.2 The target group of cats or dogs over the age of 9 years is disclosed on page 7, lines 31 to 32, where it is stated that:

"The invention has particular advantage for elderly or senior pets. Generally, these are pets of age 9 years and above."

Contrary to the respondent's view, this passage undoubtedly discloses the group of older pets - "9 years and above" - as the target group of the invention. The limitation to only those "over the age of 9 years" is also at least implicitly supported by the passage setting out the background of the invention and referring to older cats, "such as those above the age of 9 years" (page 1, lines 20 to 22).

- 2.3.3 The list of liver function promoters is explicitly disclosed on page 9, lines 27 to 28, of the application as filed. In this context the board agrees with the appellant that the change from "or" to "and" in the passage "glutathione or glutathione promoters" does not add any new meaning or matter to the recited list. In

any case the wording "glutathione and glutathione promoters" was also used in claims 5 and 21 of the application as filed, which also support this amendment.

- 2.3.4 The first definition of the intestinal mucosa function promoter as being "a fat transportation aid agent or carrier selected from whey protein and proteases" is supported by page 11, lines 5 to 7, reading:

"The intestinal mucosa function promoter of the invention may, in an embodiment, include a fat transportation aid agent or carrier, such as whey protein or a protease to help the formation of lipoproteins."

The board agrees with the appellant that the feature "to help the formation of lipoproteins" in this sentence relates to the definition of a purpose of the proteases, and does not represent a limitation to specific proteins. Omitting this feature does not result in any intermediate generalisation as maintained by the respondent.

- 2.3.5 Lastly, the alternative definition of the intestinal mucosa function promoter as including "an anti-inflammatory agent selected from omega-3 fatty acids, lactoferrin, prebiotics or probiotic micro-organisms" is supported by page 11, lines 13 to 16, where these compounds are mentioned as suitable examples of anti-inflammatory agents. It is noted that the passage on page 11 lists "fatty acids that have a profile specially selected to improve absorption" as a further example of anti-inflammatory agents, which is not incorporated into claim 1. However, the deletion of this compound from this list is allowable, as it does

not lead to the singling-out of a specific, undisclosed combination, unlike in the case of the main request. In fact, the level of generality of the claimed subject-matter is not affected by the deletion of this alternative.

2.4 For these reasons, claim 1 of auxiliary request 1 does not contain subject-matter which extends beyond the content of the application as filed.

3. *Further issues*

For the sake of completeness it is noted that:

- the amendment made, namely the introduction of the subject-matter of claim 2 into claim 1, limits the scope of the granted claims, and therefore the claims also fulfil the requirements of Article 123(3) EPC; and
- in view of the ruling in G 3/14, claim 1, which results from the combination of granted claims, cannot be objected to under Article 84 EPC in opposition/opposition appeal proceedings.

Also, no objections were raised by the respondent in this context.

4. *Remittal - Article 111 EPC*

Added matter was the only reason for the revocation of the patent. The other grounds for opposition raised under Article 100(a) and (b) EPC were not dealt with in the appealed decision. Taking furthermore into account that both parties requested remittal, 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 claims 1 to 12 of "Auxiliary Request 1".

FURTHER AUXILIARY REQUESTS

5. As the case is to be remitted to the opposition division, there is no need for the board to deal with the further auxiliary requests.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution on the basis of claims 1 to 12 filed as "Auxiliary Request 1" during the oral proceedings before the board on 24 October 2017.

The Registrar:

The Chairman:



M. Cañueto Carbajo

W. Sieber

Decision electronically authenticated