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**Datasheet for the decision
of 31 January 2020**

Case Number: T 0388/16 - 3.3.09

Application Number: 04758686.2

Publication Number: 1608231

IPC: A23K1/00, A23K1/16, A23K1/18

Language of the proceedings: EN

Title of invention:
PET FOOD COMPOSITION AND METHOD

Patent Proprietor:
Hill's Pet Nutrition, Inc.

Opponent:
The IAMS Company

Headword:
Pet food composition/HILL'S

Relevant legal provisions:
RPBA Art. 13(3)
EPC Art. 84, 123(2), 100(a), 56

Keyword:

Late-filed request - admitted (yes)
Claims - clarity (yes)
Amendments - allowable (yes)
Inventive step - (yes)

Decisions cited:

Catchword:



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Case Number: T 0388/16 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 31 January 2020

Appellant: The IAMS Company
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 12 October 2015
rejecting the opposition filed against European
patent No. 1608231 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman A. Haderlein
Members: M. Ansorge
E. Kossonakou

Summary of Facts and Submissions

I. This decision concerns the appeal filed by the opponent against the opposition division's decision to reject the opposition against European patent No. 1 608 231.

II. With its notice of opposition, the opponent had requested revocation of the patent in its entirety *inter alia* on the grounds for opposition under Article 100(a) EPC (lack of novelty and lack of inventive step) and Article 100(c) EPC.

III. The documents submitted during the opposition proceedings included:

D3: US 6,103,290

D12: S. Schonauer and R. Moreira, "A variable restrictive valve as an extra independent control variable for food extrusion processes", Food Science and Technology International (1996) 2, pages 241 to 248.

IV. Claim 1 as granted reads as follows:

"A method for preparing pet food discrete particles comprising:

extruding the pet food in an extruder which comprises a Venturi plate and a die,

wherein the pet food has zero to less than 15 wt% carbohydrate,

wherein the Venturi plate has at least one hole through which pet food flows prior to entering the die, and

wherein the Venturi plate restricts extrudate flow in the extruder."

Claims 2 to 4 as granted relate to product-by-process claims each containing the term "obtainable by the method of claim 1".

- V. The opposition division rejected the opposition and decided, *inter alia*, that:
- the ground for opposition pursuant to Article 100(c) EPC did not prejudice the maintenance of the patent; and
 - the claimed subject-matter involved an inventive step in view of D3 as the closest prior art.
- VI. In its statement setting out the grounds of appeal, the opponent (hereinafter referred to as "the appellant") requested that the decision be set aside and the patent be revoked in its entirety.
- VII. With its reply to the statement setting out the grounds of appeal, the proprietor (hereinafter referred to as "the respondent") requested that the appeal be dismissed (main request) or that the patent be maintained on the basis of the first or second auxiliary request, both filed with the reply.
- VIII. With its letter dated 3 December 2019 the appellant announced that it would not be attending the oral proceedings.
- IX. During oral proceedings held before the board, the respondent withdrew the main request and first auxiliary request and filed - as the sole remaining

request - an amended second auxiliary request to replace the second auxiliary request on file (i.e. the second auxiliary request filed with the statement setting out the grounds of appeal; hereinafter referred to as "previous second auxiliary request"). In addition, new description pages 2 to 8 were filed during the oral proceedings to replace the description pages of the patent as a whole.

X. The second auxiliary request (i.e. the respondent's sole remaining request) contains three claims and is as follows:

Claim 1 of the **second auxiliary request** differs from claim 1 as granted (see point IV above) in that:

- the feature "wherein the pet food has zero to less than 15 wt% carbohydrate" was replaced by "wherein the carbohydrate content of the pet food is a minimum of 7 wt.%, with a maximum of 12 or 10 wt.%, based on nitrogen free extract, on a dry matter basis"; and
- the feature "and wherein the pet food discrete particles are dimensionally stable such that they retain the same shape as when immediately prepared and then packaged" was inserted at the end of claim 1.

Claim 2 of the **second auxiliary request** differs from claim 2 as granted in that the feature "zero to less than 15 wt% carbohydrate, and" was deleted.

In a similar manner, claim 3 of the **second auxiliary request** differs from claim 3 as granted in that the

feature "zero to less than 15 wt% carbohydrate, and" was deleted from this claim as well.

XI. The appellant's arguments, in so far as still relevant for the present decision, are as follows:

- The subject-matter of claim 1 as granted does not meet the requirements stipulated in Article 123(2) EPC.
- The subject-matter of claim 1 does not involve an inventive step since the problem of the contested patent is not solved. In addition, the claimed method is an arbitrary modification in view of the prior art.

XII. The respondent's arguments, in so far as relevant for the present decision, are as follows:

- Claims 1 to 3 of the second auxiliary request comply with the requirements of Article 123(2) and (3) EPC. Support for the features introduced into claim 1 can be found on page 1, lines 11 to 13, and page 2, lines 19 to 22 of the application as filed. In claims 2 and 3 the only amendment was that the reference to the carbohydrate content was removed, so claims 2 and 3 of the second auxiliary request also comply with Article 123(2) EPC.
- The claimed subject-matter of the second auxiliary request involves an inventive step in view of D3 as the closest prior art, even if combined with D12.

XIII. The parties' requests were as follows:

- The appellant requested that the decision be set aside and the patent be revoked in its entirety.
- The respondent requested that the patent be maintained on the basis of claims 1 to 3 of the second auxiliary request and description pages 2 to 8, all filed at the oral proceedings before the board.

Reasons for the Decision

1. Admission of the second auxiliary request into the proceedings (Article 13(3) RPBA 2007)

During the oral proceedings the board raised an objection under Article 123(3) EPC with respect to the maximum carbohydrate content of "15 wt.%" in claim 1 of the previous second auxiliary request.

As an immediate reaction, the respondent filed the second auxiliary request, which differs from the previous second auxiliary request only in that the term "15," was deleted from claim 1, thus restricting the maximum carbohydrate content to 12 wt.% or 10 wt.% (see point X above). It was immediately evident that this amendment overcame the board's objection.

In the board's view, submitting the second auxiliary request did not raise any issues which the board or the appellant, had it been present at the oral proceedings, could not reasonably have been expected to deal with

without adjournment of the oral proceedings
(Article 13(3) RPBA 2007).

Thus, the board admitted the second auxiliary request
into the proceedings.

2. Claim 1 of the second auxiliary request differs from
claim 1 as granted in that:

- the carbohydrate content of the pet food is limited
to a minimum of 7 wt.%, with a maximum of 12 or 10
wt.%, based on nitrogen free extract, on a dry
matter basis; and
- the pet food discrete particles are further
specified as being dimensionally stable such that
they retain the same shape as when immediately
prepared and then packaged (i.e. the term
"dimensionally stable", which is considered to be
equivalent to the term "dimensional stability" used
in original claim 1, is introduced, together with a
further explanation of the term taken from page 1
of the application as filed).

3. Article 84 EPC

Since the feature "dimensionally stable" was not
present in claim 1 as granted and was introduced from
original claim 1 in combination with a feature from the
description (see page 1, lines 11 to 13 of the
application as filed), compliance with Article 84 EPC
may be examined.

In the procedure leading up to the grant of the patent
in suit, the examining division was of the opinion that
the term "dimensional stability" in original claim 1

was unclear.

The board thus considers it appropriate to assess whether amended claim 1 complies with the requirement of clarity despite the appellant not having raised an objection to this effect. The term "dimensionally stable" now present in claim 1 of the second auxiliary request is further specified in that the expression "such that they retain the same shape as when immediately prepared and then packaged" is added to further explain its meaning. In the board's view, this amendment renders the meaning of "dimensionally stable" in claim 1 sufficiently clear.

Thus, the subject-matter of claim 1 of the second auxiliary request meets the requirements stipulated in Article 84 EPC.

4. The appellant did not raise any objections at all against the claims of the previous second auxiliary request. Thus, in addition to Article 84 EPC (see point 3 above), which was examined of the board's own motion, only those objections raised by the appellant against the claims as granted which are still applicable to the second auxiliary request (i.e. Article 123(2) EPC and lack of inventive step) will be assessed hereinafter.
5. Article 123(2) EPC
 - 5.1 The appellant raised objections against the subject-matter in claim 1 as granted in relation to:
 - the removal of the feature "having dimensional stability" (**objection 1**);

- the Venturi plate, which in the appellant's view is only disclosed in combination with particular extruders, i.e. Wenger X-135 and Wenger X-235 (**objection 2**);
- the carbohydrate content in claim 1 as granted, which in the appellant's view relates to the pet food in the extruder whereas original claim 1 requires the carbohydrate content to relate to the extruded pet food discrete particles (**objection 3**); and
- the (total) carbohydrate content in claim 1 as granted being less than 15 wt%, whereas in the application as filed the carbohydrate content is based on nitrogen free extract (**objection 4**).

5.2 In the following, it will be assessed whether the above **objections 1 to 4** raised by the appellant against claim 1 as granted are still equally applicable to the now amended method claim 1 and are well founded.

5.2.1 The appellant's objection in relation to the deletion of the feature "having dimensional stability" (**objection 1**) is no longer applicable in view of the introduction of the equivalent feature "dimensionally stable" into claim 1.

5.2.2 In view of the replacement of the feature "wherein the pet food has zero to less than 15 wt% carbohydrate" with "wherein the carbohydrate content of the pet food is a minimum of 7 wt.%, with a maximum of 12 or 10 wt. %, based on nitrogen free extract, on a dry matter basis", there is no doubt that the carbohydrate content of the pet food in claim 1 is now based on the nitrogen free extract, on a dry matter basis. There is a

sufficient basis for this amendment to claim 1 on page 2, lines 19 to 22 of the application as filed. Thus, the appellant's **objection 4** in relation to the carbohydrate content in claim 1 is no longer applicable either.

- 5.2.3 For the following reasons, the appellant's **objection 3** is considered to be no longer applicable either:

The carbohydrate content in claim 1 is now based on nitrogen free extract on a dry matter basis. Thus, the amount of moisture in the intermediate product in the extruder has no influence on the carbohydrate content, which is now based on the dry matter. Thus, **objection 3** is considered to be no longer applicable for this very reason. In addition, the carbohydrate content in claim 1 is considered to relate to the final product and not to the intermediate product in the extruder. There does not seem to be any indication at all in the application as filed that the carbohydrate content might relate to the pet food inside the extruder. Accordingly, the board cannot accept the appellant's arguments in this respect.

- 5.2.4 Concerning **objection 2**, the paragraph spanning pages 3 and 4 of the application as filed discloses means for increasing the shear in the extruder, and the preferred method of increasing the shear is through the use of a Venturi plate, which is then further specified.

The relevant paragraph spanning pages 3 and 4 of the application as filed begins with the sentence:

"Utilizing a standard Wenger X-135 single screw extruder preferred, or an X-235, with a preconditioner under standard operating conditions and a high protein,

high fat, low carbohydrate diet, dimensionally stable discrete particles of the pet food were not prepared." (emphasis added by the board).

Obviously, this sentence relates to unsuccessful experiments using a Wenger X-135 or X-235 extruder under standard conditions, which did not result in dimensionally stable discrete particles of pet food.

The following sentence of the aforementioned paragraph reads as follows:

"After much work, it was found that increasing the shear in the extruder created an extruded pet food which was processed into discrete particles which were dimensionally stable even with low levels of carbohydrate therein." (emphasis added)

In the appellant's view, the underlined term "the extruder" in the latter sentence relates only to one of the two extruders mentioned in the previous sentence (i.e. Wenger X-135 or X-235), not just to any extruder.

In the board's view, the passage on page 3, lines 27 to 30 of the application as filed referring to "... the extruder" does not support the appellant's assertion that "the extruder" must only relate to the two extruders named before, i.e. Wenger X-135 and X-235. Rather, the whole context of the application as filed needs to be evaluated.

Page 4, lines 12 and 13 of the application as filed, reads as follows:

"An example of an extruder with the insertion of a Venturi plate used in the process is now provided." (emphasis added)

In addition, page 4, lines 16 to 19 of the application as filed mentions "for example a Wenger X-135" (emphasis added), which is fully in line with the above interpretation.

In view of the above, it cannot be taken from the application as filed that a Venturi plate is only disclosed in combination with extruders of the type Wenger X-135 and X-235, which are only mentioned by way of example in the framework of the invention. Thus, the board cannot accept the appellant's **objection 2** either.

5.3 Thus, all the **objections 1 to 4** raised by the appellant fail. Moreover, the further amendments relate to subject-matter directly and unambiguously derivable from the application documents as filed. In particular, there is a sufficient basis in original claim 1 in combination with page 1, lines 11 to 13 of the application as filed for adding the feature "wherein the pet food discrete particles are dimensionally stable such that they retain the same shape as when immediately prepared and then packaged".

Therefore, the subject-matter of claim 1 of the second auxiliary request is considered to meet the requirements stipulated in Article 123(2) EPC.

6. Inventive step

6.1 With respect to claim 1, the appellant provided two inventive-step attacks. In the first, it argued that the method of claim 1 did not solve the problem and

thus, for this reason alone, was not inventive. In the second line of attack, the appellant submitted that the problem was not solved over the entire claimed scope and the difference from the prior art was that a Venturi plate was introduced into the extruder. In the appellant's view, the claimed method was merely an arbitrary modification in view of the prior art.

6.2 In said first attack, the appellant did not identify any closest prior-art document at all. However, in the assessment of inventive step (by applying the problem-solution approach) the claimed subject-matter is to be assessed in view of the prior art, i.e. a closest prior-art document, and it is up to the appellant to provide reasons why the claimed subject-matter is obvious in view of said prior art. Since the appellant did not identify any closest prior-art document and did not provide any reasoning why arriving at the claimed subject-matter might have been obvious for a skilled person, the first inventive-step attack fails.

6.3 The second inventive-step attack mainly relies on a detailed explanation why the problem is not solved over the entire scope, without explicitly mentioning which document is considered the starting point in the assessment of inventive step. However, in view of the fact that the appellant refers to the opposition division's decision considering D3 as the closest prior art (see page 5, second line from the bottom, to page 6, line 4 of the statement setting out the grounds of appeal) and does not refer to any other possible closest prior art, the board concludes that the appellant also considered D3 to be the closest prior art in its second attack. Thus, the question of inventive step is assessed hereinafter in view of D3 as the closest prior art.

6.4 The appellant submitted that no technical effect resulting from the presence of a Venturi plate in the extruder - as the only distinguishing feature - has been shown. Thus, in the appellant's view the problem to be solved was merely the provision of an alternative method for preparing pet food discrete particles.

6.5 Assuming that the objective technical problem is indeed as submitted by the appellant, the subject-matter of claim 1 involves an inventive step in view of D3 as the closest prior art for the following reasons.

6.5.1 D3 does not mention the presence of a Venturi plate in an extruder. Thus, D3 alone cannot give a skilled person any motivation to contemplate a Venturi plate in an extruder.

6.5.2 The appellant pointed out that D12 did not teach the contrary to the contested patent, which would imply that the appellant considers D12 to be a document to be combined with D3 to possibly teach the provision of a Venturi plate. However, D12 does not disclose a Venturi plate either; it merely discloses a variable restrictive valve or throttle valve being an integral part of the die assembly itself (see page 243, left-hand column, section "Die configuration"; and Figure 1 of D12). Thus, for this reason alone, D12 does not provide any teaching towards contemplating a Venturi plate inside an extruder before the (exit) die.

In view of the above, the skilled person would not have arrived at the claimed method even if they had combined the teachings of D3 and D12. The claimed method thus at least represents a non-obvious alternative in view of the cited prior art.

Thus, the subject-matter of claim 1 of the second auxiliary request involves an inventive step in view of D3 as the closest prior art, taken alone or in combination with D12.

7. Regarding product claims 2 to 4 as granted, the appellant merely mentioned that the same consideration (as for claim 1) applied *mutatis mutandis*. In the board's view, this cannot be considered to substantiate an inventive-step attack against the product claims. The board thus concludes that claims 2 and 3 of the second auxiliary request were not attacked in the appeal proceedings.

Furthermore, as the case stands, the board does not consider it necessary to comment on the patentability of the subject-matter of claims 2 and 3. It is nonetheless noted that due to the product limitations introduced into claim 1 of the second auxiliary request, claims 2 and 3 (having a back-reference to claim 1) have been limited even further.

8. The board considers the amended description to represent an appropriate adaptation to the current claim 1. The requirement of Article 84 EPC is thus fulfilled.

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 following documents:

Claims:

Claims 1 to 3 of the second auxiliary request, filed at the oral proceedings before the board

Description:

Description pages 2 to 8, filed at the oral proceedings before the board.

The Registrar:

The Chair:



D. Magliano

A. Haderlein

Decision electronically authenticated