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Datasheet for the decision of 3 August 2018

Case Number: T 0254/17 - 3.3.09

Application Number: 08005444.8

Publication Number: 1952701

IPC: A23K1/18, A23K1/16, A61P13/12, A61P5/14

Language of the proceedings: EN

Title of invention:
Improving weight control of elderly pets

Patent Proprietor:
Nestec S.A.

Opponent:
Hill's Pet Nutrition, Inc.

Headword:

Relevant legal provisions:
EPC Art. 123(2), 54, 56, 76(1), 100(b)
RPBA Art. 15(3)

Keyword:
Oral proceedings - held in absence of appellant

Decisions cited:
T 1329/04

Catchword:

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Beschwerdekammern

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Case Number: T 0254/17 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 3 August 2018

Appellant: (Opponent)	Hill's Pet Nutrition, Inc. 400 Southwest 8th Street Topeka, Kansas 66603 (US)
Representative:	Daniels, Jeffrey Nicholas Page White & Farrer Bedford House John Street London WC1N 2BF (GB)
Respondent: (Patent Proprietor)	Nestec S.A. Avenue Nestlé 55 1800 Vevey (CH)
Representative:	Rupp, Christian Mitscherlich PartmbB Patent- und Rechtsanwälte Sonnenstraße 33 80331 München (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 24 October 2016 rejecting the opposition filed against European patent No. 1952701 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman	W. Sieber
Members:	F. Rinaldi
	F. Blumer

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. 1 952 701.

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

III. The documents cited during opposition proceedings included:

D1: US 2004/0091590 Al

D2: CANIDAE Corporation, "FELIDAE - All Life Stage Benefits" 6 August 2004

D3: WO 03/084344 A2

D4: WO 02/071874 A2

D5: WO 01/17366 A1

D6: EP 1 637 041 Al

D10: C.J. Cupp et al., Intern J Appl Res Vet Med 4(1), 2006, 34-50

D11: "Hill's Key to Clinical Nutrition", 2002 (extract)

D12: "Nutrient Requirements of Dogs", 1985 (extract)

D13: "Small Animal Clinical Nutrition", 2000, page 917, (extract)

D14: B.C. Tungland et al, Comprehensive Reviews in Food Science and Food Safety, 3, 2002, 101-104

D15: "AAFCO Association of American Feed Control Officials", 2014 Official Publication, 428-429.

IV. In opposition proceedings, the patent proprietor's main request was for maintenance of the patent on the basis of the granted claims, of which claim 1 read:

> "1. Use of a composition comprising an oil blend, a source of antioxidants and a source of prebiotic, in the manufacture of a medicament for improving the weight management of an elderly pet, wherein the oil blend comprises oils high in omega 3 and omega 6 fatty acids, including linoleic acid."

Claims 2 to 11 were dependent on claim 1.

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

- Documents D11 to D15 were not admitted into the proceedings.
- The ground of Article 100(c) EPC did not prejudice the maintenance of the patent.
- It was possible to reproduce the invention's essential aspect. The opposed patent contained sufficient guidance on how to prepare suitable nutritional compositions. The effects postulated in the application had been confirmed in post-published document D10.
- Furthermore, the subject-matter claimed was novel and inventive over the cited prior art.

VI. The opponent (in the following: **the appellant**) appealed the decision of the opposition division and filed the following documents with the statement setting out the grounds of appeal:

D16: "Small Animal Clinical Nutrition", 2000, page 316, (extract)

D17: Z. Zdunczyk et al., Soybean - Biochemistry, Chemistry and Physiology, 2011, 523-540

D18: "Hill's Key to Clinical Nutrition", 2003 (extract).

VII. In reply to the statement setting out the grounds of appeal, the patent proprietor (in the following: **the respondent**) filed auxiliary requests 1 to 5.

VIII. The parties were summoned to oral proceedings. The board issued a communication dated 11 May 2018 setting out its preliminary and non-binding opinion.

IX. By letter dated 16 May 2018, the appellant withdrew its request for oral proceedings.

X. By letter dated 21 June 2018, the respondent filed a new main request and new auxiliary requests 1 to 4. The main request contained nine claims. Claim 1 was identical to claim 1 of previous auxiliary request 1 filed in reply to the statement setting out the grounds of appeal, and read as follows:

> "1. Use of a composition comprising an oil blend, a source of antioxidants and a source of prebiotic, in the manufacture of a medicament for slowing the progression of weight loss beyond an elderly cats' [sic] ideal body weight, wherein the oil blend comprises oils high in omega 3 and omega 6 fatty acids, including linoleic acid."

Claims 2 to 9 were dependent claims. Further, arguments on added subject-matter, sufficiency of disclosure, novelty and inventive step were provided.

XI. On 3 August 2018, oral proceedings took place in the absence of the appellant.

The **appellant** had requested in writing that the decision under appeal be set aside and that the patent be revoked in its entirety. Further, it requested that documents D11 to D18 be admitted into the proceedings.

As its initial request, the **respondent** had requested that the patent be maintained on the basis of the main request or of any of auxiliary requests 1 to 4, all requests filed with its letter dated 21 June 2018. Further, it requested that documents D11 to D15, D17 and D18 not be admitted into the proceedings.

In the course of the oral proceedings, the respondent filed an amended main request (labelled "New MR") and requested that the patent be maintained on the basis of this request or on the basis of auxiliary requests 1 to 4 on file. The only difference from the previous main request filed with its letter dated 21 June 2018 (see point X.) was that the spelling mistake "an elderly cats'" in claim 1 had been corrected to now read "an elderly cat's".

XII. The **appellant's written arguments**, in so far as they can be considered to apply to the subject-matter of the main request as filed at the oral proceedings ("New MR"), may be summarised as follows:

- The opposition division should have admitted documents D11 to D15 into the proceedings, since their disclosure prejudiced *prima facie* the maintenance of the patent.

- The subject-matter of claim 1 was not disclosed in combination with "oils high in omega 3 and omega 6 fatty acids" and the same applied to the term "source" in the context of antioxidants and prebiotic. Moreover, the subject-matter of the dependent claims was not disclosed in combination with the subject-matter of claim 1.

- The invention was not sufficiently disclosed, because the opposed patent did not describe the suitability of the composition claimed for improving weight management in an elderly cat. The example of the opposed patent clearly indicated that the use of a composition according to claim 1 failed to improve the weight management of an elderly pet. This was supported by the conclusions section of the opposed patent.

- The subject-matter of claim 1 was not confined to a true therapeutic application and encompassed non-therapeutic effects. The claim had to be interpreted as for use of the composition in the manufacture of a medicament *suitable for* improving the weight management of an elderly pet. Based on this interpretation, the subject-matter of claim 1 lacked novelty. In view of the fact that no technical problem concerning weight management was solved, the technical problem was to find alternative compositions suitable for senior pets. The solution was obvious in view of D1 to D5, all of which were equally suitable for selection as the closest prior art.

XIII. The **respondent's arguments** which are relevant for the present decision may be summarised as follows:

- Documents D11 to D15 should not be admitted into the proceedings. The same applied to D17 and D18, filed only on appeal.

- The application as filed was directed generally to improving the condition of elderly pets, in particular cats. The subject-matter disclosed in claim 1 of the main request was clearly defined on page 3, lines 11 to 14, of the parent application as filed. The oil blend comprising oil high in omega 3 and omega 6 fatty acids was described on page 2, lines 17 and 18, of the application as filed. Furthermore, the example pointed to the combination of features described in the claims.

- It was clear from the application as filed that the composition claimed was suitable for slowing down the progression of weight loss of an elderly cat. The skilled person would understand from the results discussed in the example of the opposed patent that the claimed effect could be expected.

- Claim 1 was drafted as a second medical use claim. Prior-art documents D1 and D2 did not disclose the medical indication. Therefore, the subject-matter of claim 1 was novel. As for inventive step, none of documents D1 to D5 qualified as the closest prior art, because none of these documents suggested the medical indication recited in claim 1. Thus, the subject-matter of claim 1 involved an inventive step.

Reasons for the Decision

1. In the present case, the appellant did not comment on the auxiliary requests filed in response to the statement setting out the grounds of appeal, even though auxiliary request 1 ultimately formed the basis for the main request filed at the oral proceedings ("New MR"). The appellant also withdrew its request for oral proceedings and was not represented at the oral proceedings before the board. Accordingly, in the present decision the board will primarily deal with the appellant's original requests and arguments, in so far as they are applicable to the current main request (Article 15(3) RPBA).

2. Admission of documents

2.1 Documents D11 to D15 were filed only a few days prior to the oral proceedings before the opposition division. The admission of documents filed after the nine-month time limit for opposition is at the discretion of the opposition division. It is evident from the appealed decision that the opposition division examined whether the documents were *prima facie* relevant, both for assessing novelty and inventive step. The board cannot identify any error in the discretionary decision of the opposition division and sees no reason to reverse it. Therefore, these documents are not part of the present proceedings.

2.2 D17 and D18 were filed on appeal to further support the admissibility of documents D11 to D15. Since the latter documents were not admitted into the proceedings, the board sees no reason to admit D17 and D18.

3. Added subject-matter

3.1 The opposed patent is based on the application as filed, which is a European divisional patent application filed in respect of the earlier European patent application No. 04 255 726 (parent application). The two applications have an identical description. In the following discussion of added subject-matter, reference will be made only to the application as filed, it being understood that the same disclosure is present also in the parent application as filed.

3.2 The basis for the subject-matter of claim 1 can be found on page 3, lines 11 to 14, of the application as filed, which reads: "The present invention also provides a method for slowing the progression of weight loss beyond an elderly pets' [sic] ideal body weight by administering to the pet a composition comprising one or more antioxidants, an oil blend including linoleic acid, and a prebiotic." The elderly pet described throughout the application is an elderly cat (e.g. page 1, lines 4 and 5; page 4, lines 10 to 13; and the example, page 9, line 11 onwards, which relates to a long-term study on senior cats). Further, the oils high in omega 3 and omega 6 are described as preferred for all compositions of the invention. Support for these oils can be found on page 2, lines 17 and 18 of the application as filed. These oils are also used in the composition of diet 3 of the example, which corresponds to the composition recited in claim 1. In other words, for the skilled person the combination of the features of claim 1 is directly and unambiguously derivable from the application as filed.

3.3 The appellant objected to the introduction of the term "source" into claim 1 ("source of antioxidants" and "source of prebiotic"). However, it has not explained why, in its view, this amendment adds subject-matter. Moreover, "source of antioxidants" is explicitly disclosed on page 4, line 22, and "source of prebiotic" on page 2, line 10.

3.4 Furthermore, it raised a general objection that the subject-matter of the dependent claims was not disclosed in combination with the subject-matter of claim 1. The board does not agree. The subject-matter of claims 2 to 9 relates to the preferred ingredients and form of the composition disclosed in the application as filed. The combination of these features is in particular pointed to by the (inventive) diet 3 of the example.

3.5 In view of these considerations, claims 1 to 9 do not include added subject-matter and so comply with the requirements of Article 123(2) EPC and of Article 76(1), second sentence, EPC.

4. Sufficiency of disclosure

4.1 The appellant argued that the composition disclosed in claim 1 of the patent as granted did not provide any effect relating to weight management. Although this objection was not raised in the context of the present main request, the board considers that the objection carried over to claim 1 of the main request, which is directed to a more specific weight-management effect, namely the slowing of the progression of weight loss beyond an elderly cat's ideal body weight.

4.2 In the example of the opposed patent (paragraph [0046] onwards) elderly cats were assigned to three different test groups. Each test group received a different diet:

- diet 1 (standard fish-based cat food);
- diet 2 (standard fish-based cat food including antioxidants); and
- diet 3 (standard fish-based cat food including antioxidants, namely β-carotene and vitamin E, an oil blend including omega 3 and omega 6 fatty acids and chicory root, a source of prebiotics).

The composition of diet 3 corresponds to the composition of claim 1. The effects of these diets are discussed in paragraph [0049] onwards. Weight maintenance is discussed in paragraph [0056] of the opposed patent. The first two sentences of this paragraph read: "All three groups lost weight over time, on average, which is expected with aging cats. Average weight losses and food consumption were not significantly different between the three dietary treatment groups." At first glance this statement appears to confirm the appellant's argument that the patent itself demonstrates that the claimed effect is not achieved. However, the board agrees with the respondent that this statement has to be read in the context of the example as a whole. In the same paragraph, the diet compositions are compared with regard to the microflora and the blood values, in particular plasma linoleic acid. Positive effects are identified for the composition of diet 3, as compared with the effects achieved with diet 1 or diet 2.

4.3 Thus, the skilled person would understand from the entire paragraph that the slowing of the progression of weight loss had not yet been fully confirmed, but that

this effect was nevertheless expected, in view of the other positive results identified in the patent, such as the pathology results (paragraph [0054]), the microflora (paragraph [0056], lines 6 to 10), the plasma linoleic acid (paragraph [0056], lines 11 and 12 and on table 7), the antioxidant status and intestinal health (paragraph [0061]). All these effects would ultimately contribute to slowing the progression of weight loss. The respondent's argument is technically sound and the board is not aware of any argument which might speak against it. Therefore, the board concludes that the (prophylactic) therapeutic effect of slowing the progression of weight loss beyond an elderly cat's ideal body weight is sufficiently disclosed.

4.4 This effect was confirmed in D10, a post-published study. It describes, *inter alia,* that senior cats fed with a diet which corresponds to the composition described in claim 1 are subject to less decrease in body weight than cats fed with reference diets (D10, page 40, right column, last paragraph; and figure 5). In this context, it is worth noting that the post-published evidence D10 is only supplementary and does not serve as the sole basis for establishing that the claimed effect of slowing the progression of weight loss is indeed achieved. As mentioned above, not only was the claimed effect asserted in the application as filed, it was also shown to be at least plausible by the disclosure of the application as filed, and D10 is not the first disclosure going beyond speculation (by analogy with T 1329/04, point 12).

4.5 In view of these considerations, the ground of Article 100(b) EPC does not prejudices the maintenance of the patent on the basis of the main request.

5. Novelty and inventive step

5.1 The appellant's arguments regarding lack of novelty and lack of inventive step were based on the assumption that a therapeutic treatment is neither plausible nor achieved. As discussed above in the context of the assessment of sufficiency of disclosure, the board does not agree with this interpretation. Consequently, the appellant's novelty and inventive step attacks must be regarded as flawed from the outset.

5.2 Claim 1 is a second medical use claim in the Swiss-type form. The novelty of the subject-matter of such a claim can be derived from the new therapeutic application (Case Law of the Boards of Appeal of the EPO, 8th edition 2016, Chapter I.C.7.2.1). The board is not aware of any prior-art document disclosing a composition such as that recited in claim 1 and discussing the required specific therapeutic application.

5.3 Thus, D1 discloses a functional cocktail for a senior pet diet including flaxseed oil (an oil high in omega 3) and sunflower oil (which is rich in linoleic acid, an omega 6 fatty acid), vitamin E (an antioxidant) and chicory (a source of prebiotic), but it does not disclose the therapeutic application recited in claim 1. Similar considerations apply to D2, which discloses a cat food composition called "Felidae": the composition contains the ingredients of the claimed composition, but the specific therapeutic use is not disclosed. Thus, the board concludes that the subject-matter of claim 1 is novel over the cited prior art (Article 54 EPC).

5.4 The appellant also raised novelty objections based on D6 (the publication of the parent application) and D10 (post-published evidence) "in the event that the opposed patent is denied divisional status". However, in view of the conclusions drawn above (see point 3.5), the board does not consider D6 and D10 to be prior art, and the appellant's objections of lack of novelty based on these two documents must fail.

5.5 With regard to inventive step, the appellant considered that there were a number of equally suitable candidates for selection as the closest prior art. In this context, it discussed documents D1, D2, D3, D4 and D5. The board considers that it is not crucial which document is selected as the closest prior art, because none of the cited documents describes the therapeutic application recited in claim 1. Thus, the functional cocktail suitable for senior pets described in paragraph [0015] of D1 may well be considered the closest prior art, while the therapeutic application is the distinguishing feature.

5.6 The objective technical problem in view of D1 has to be seen in the provision of a further (medical) use of the composition of D1. As apparent from the discussion relating to sufficiency of disclosure, this problem is plausibly solved, namely by the use of the composition in slowing the progression of weight loss beyond an elderly cat's ideal body weight.

5.7 There was nothing indicating this solution to the skilled person in D1 itself or in any other cited prior art. In view of this, the board concludes that the subject-matter of claim 1 involves an inventive step (Article 56 EPC).

6. Since the main request is allowable, there is no need to deal with the 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 with the order to maintain the patent on the basis of claims 1 to 9 of the new main request (filed as "New MR" during oral proceedings before the Board on 3 August 2018) and a description to be adapted thereto.

The Registrar: The Chairman:

M. Cañueto Carbajo W. Sieber

Decision electronically authenticated