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**Datasheet for the decision
of 13 August 2019**

Case Number: T 0839/17 - 3.3.09

Application Number: 05737679.0

Publication Number: 1737304

IPC: A23L1/29

Language of the proceedings: EN

Title of invention:
LIQUID CONCENTRATED FORMULA

Patent Proprietor:
N.V. Nutricia

Opponent:
Société des Produits Nestlé S.A.

Headword:

Relevant legal provisions:
EPC Art. 100(c)

Keyword:
Amendments - added subject-matter (yes)



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0839/17 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 13 August 2019

Appellant: N.V. Nutricia
(Patent Proprietor) Eerste Stationsstraat 186
2712 HM Zoetermeer (NL)

Representative: Nederlandsch Octrooibureau
P.O. Box 29720
2502 LS The Hague (NL)

Appellant: Société des Produits Nestlé S.A.
(Opponent) Entre-deux-Villes
1800 Vevey (CH)

Representative: Elkington and Fife LLP
Prospect House
8 Pembroke Road
Sevenoaks, Kent TN13 1XR (GB)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
8 February 2017 concerning maintenance of the
European Patent No. 1737304 in amended form.**

Composition of the Board:

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

Summary of Facts and Submissions

- I. This decision concerns the appeals filed by the patent proprietor and the opponent against the interlocutory decision of the opposition division that European patent No. 1 737 304 as amended met the requirements of the EPC.
- II. In its notice of opposition, the opponent had requested the revocation of the patent on the basis of Article 100(a) (lack of inventive step), 100(b) and 100(c) EPC.
- III. With regard to the main request (claims as granted), the opposition division decided that the grounds of opposition under Article 100(b) and (c) EPC did not prejudice the maintenance of the patent as granted, but that the subject-matter of claim 5 lacked inventive step. Furthermore, the opposition division held that the subject-matter of auxiliary request 1 complied with the requirements of the EPC.

The only claims relevant to the present decision are claims 1 and 5 as granted. Claim 1 as granted reads as follows:

- "1. A liquid complete nutritional composition suitable for feeding cachectic patients, having an energy density of at least 1.45 kcal/ml (at least 6.06 kJ/ml), comprising:
- a carbohydrate fraction in an amount of 17-27 g per 100 ml;
 - a protein fraction in an amount of 8.5-12 g per 100 ml, which comprises intact protein in an amount of 8.2-11 g per 100 ml; and

- a lipid fraction;
characterised in that at least 70 wt.% of the protein fraction is obtained by demineralising milk, and the protein fraction comprises between 25 and 37 wt.% of whey proteins."

Claim 5 as granted differs from claim 1 as granted in that the characterising portion reads as follows:

"characterised in that at least 70 wt.% of the protein fraction is obtained by demineralising milk, and the protein fraction comprises less than 5 wt.% of free amino acids."

- IV. In its statement setting out the grounds of appeal, the patent proprietor requested, *inter alia*, that the decision of the opposition division be set aside and the patent be maintained as granted (main request).
- V. In its statement setting out the grounds of appeal, the opponent requested, *inter alia*, that the decision of the opposition division be set aside and that the patent be revoked in its entirety. It also filed the following document:
- D14: JP H08-196236 A (English translation).
- VI. As both the patent proprietor and the opponent are appellant and respondent in these proceedings, for simplicity the board will continue to refer to them as the patent proprietor and the opponent.
- VII. By letter dated 26 October 2017, the patent proprietor filed auxiliary requests 1 to 7 and the following document:

D15: Experimental data (patent proprietor).

VIII. The opponent made further substantive submissions and filed document D14a:

D14a: Table comparing composition according to claim 5 with selected compositions of D14.

IX. On 13 August 2019, oral proceedings were held before the board. At the beginning of the oral proceedings, the patent proprietor withdrew its main request and auxiliary requests 1 to 4.

The final requests were as follows:

The patent proprietor requested that the decision under appeal be set aside and that the patent be maintained on the basis of any one of auxiliary requests 5 to 7 filed by letter dated 26 October 2017.

The opponent requested that the decision under appeal be set aside and the patent be revoked.

X. The only claim requests relevant to the present decision are auxiliary requests 5, 6 and 7.

Claims 1 and 5 of auxiliary request 5 differ from claims 1 and 5 as granted (see point III) in that

- the amount of the carbohydrate fraction is limited to 18-25 g per 100 ml (was 17-27);
- the amount of 4.8-7.0 g per 100 ml for the lipid fraction is inserted (was not specified); and
- the feature "said composition comprising 31-39 g dry matter per 100 ml" is inserted.

As to claims 1 and 5 of auxiliary request 6 and 7, the exact wording of these claims is not relevant. However, like granted claims 1 and 5, these claims include the feature:

"a protein fraction in an amount of 8.5-12 g per 100 ml, which comprises intact protein in an amount of 8.2-11 g per 100 ml".

XI. The opponent's arguments which are relevant to the present decision may be summarised as follows:

The feature "a protein fraction in an amount of 8.5-12 g per 100 ml, which comprises intact protein in an amount of 8.2-11 g per 100 ml" in claims 1 and 5 of auxiliary request 5 was not directly and unambiguously disclosed in the application as filed. The table on page 3 of the application as filed disclosed liquid compositions indicating their components and the amounts with regard to dry matter, intact protein, lipids and carbohydrate. One of the complete compositions contained an amount of 8.2-11 g per 100 ml of intact protein. However, there was no indication that these complete compositions contained, apart from the intact protein, any further protein, i.e. non-intact protein. There was no suggestion in the application as filed that the value of 8.2-11 g per 100 ml of intact protein could be combined with an amount 8.5-12 g per 100 ml of (total) protein fraction, let alone with the amounts of free amino acids required in claim 5.

XII. The patent proprietor's arguments which are relevant to the present decision may be summarised as follows:

The objected combination with regard to the protein fraction in claims 1 and 5 was directly and unambiguously disclosed in the application as filed. In light of the entire application as filed, it would be evident to the skilled reader that the presence of intact protein was an essential feature of the invention. Therefore, it was allowable to introduce this requirement into the claims. The skilled person would recognise that the table on page 3 of the application as filed describes the boundaries of the invention and that the amount of intact protein could be derived from this table. The combination of features relating to the protein fraction may affect some of the other values claimed but a perfect match of the values was not required for the amendment to be allowable.

Reasons for the Decision

1. At the oral proceedings before the board, the patent proprietor withdrew its main request and auxiliary requests 1 to 4 so that auxiliary request 5 became the highest ranking request for this decision.
2. The parties disagreed on whether the feature

"a protein fraction in an amount of 8.5-12 g per 100 ml, which comprises intact protein in an amount of 8.2-11 g per 100 ml"

in claims 1 and 5 of auxiliary request 5 had a proper basis in the application as filed.
 - 2.1 The relevant feature results from a pre-grant amendment of the claims. In claims 1 and 5 as filed the wording:

"a protein fraction in an amount of 7.8-12 g per 100 ml (0.31-0.48 kcal/ml) "

was replaced by:

"a protein fraction in an amount of 8.5-12 g per 100 ml, which comprises intact protein in an amount of 8.2-11 g per 100 ml".

With this amendment, two different amounts for protein have been introduced: an amount of 8.5 to 12 g per 100 ml referring to the total protein (intact protein and non-intact protein) and an amount 8.2 to 11 g per 100 ml for the intact protein.

2.2 There was no objection to the amendment of the lower limit from 7.8 to 8.5 g per 100 ml, which is actually based on claim 8 as filed. The thrust of the opponent's added subject-matter objection relates to the combination of the amount of the total protein with the amount of intact protein.

3. The only disclosure of the amount of intact protein can be found in the following passage on page 3 of the application as filed:

The product of the invention is a liquid composition, which contains in g per 100 ml product:

<i>Component</i>	<i>General</i>	<i>Preferred</i>	<i>Most preferred</i>	<i>Example</i>
Dry matter	30-39	31-39	33-38	36.7
Intact protein	7.8-12	8.2-11	8.5-10	9.0
Lipids	4.5-8.0	4.8-7.0	5.0-6.0	5.3
Carbohydrate	17-27	18-25	19-23	21
RDA vitamins, minerals, trace elements				

In this passage, four liquid compositions are described ("general", "preferred", "most preferred" and "example") indicating their components and the amounts with regard to dry matter, intact protein, lipids and carbohydrate. The amount of intact protein as required in claims 1 and 5 is disclosed in conjunction with the preferred composition.

4. The question is whether the skilled reader would directly and unambiguously combine the amount of intact protein as disclosed for the preferred composition of the table on page 3 with the amount for the total protein according to the disclosure of claims 1 and 5 as filed.

4.1 It is conspicuous to the board that claims 1 and 5 as filed already have different requirements and different mandatory features respectively with regard to the composition of the protein fraction. While both claims 1 and 5 require that at least 70 wt.% of the protein fraction is obtained by demineralising milk, the protein fraction in claim 1 as filed comprises between 25 and 37 wt.% whey proteins whereas the protein fraction in claim 5 as filed comprises less than 5 wt.% free amino acids. Thus, claims 1 and 5 as filed define "the invention" in different terms where at best there is a partial overlap in scope.

4.2 As to the preferred composition in the table on page 3, it explicitly discloses 8.2 to 11 g per 100 ml intact protein. However, there is no reference to the other features relating to the protein fraction of claims 1 and 5 as filed, namely:

- the total protein fraction;

- the content of protein fraction obtained by demineralising milk;
- the content of whey protein (claim 1); and
- the content of free amino acids (claim 5).

4.3 It is evident that the disclosure in the table on page 3 is simply different from the disclosure of claims 1 and 5 as filed. Thus, the disclosure relating to the table on page 3 must be regarded as yet another embodiment of the invention, different from the embodiment of claim 1 and different from the embodiment of claim 5 as filed.

4.4 The patent proprietor argued that it would be clear to the skilled reader, in view of the disclosure of the application as filed (page 1, lines 31 to 35 and page 4, line 22 and 23), that the presence of intact protein was an essential element of the invention. This feature had been omitted from claim 1 and 5 as filed by mistake. Nevertheless, the skilled reader would recognise that the table on page 3 represents a basic disclosure which describes the boundaries of the invention and that the amount of intact protein could be derived from this table.

4.5 The board is not convinced.

There is no explicit disclosure in the context of the table on page 3 that would allow the person skilled in the art to conclude that the compositions described in the table relate to the boundaries of the invention.

Rather, the presentation of the compositions in the table points towards separate embodiments containing intact protein as the sole protein fraction. There is nothing to suggest that the compositions disclosed in

the table on page 3 were intended to be supplemented by additional non-intact proteins, let alone free amino acids. Instead, the compositions are self-contained and even RDA vitamins, minerals and trace elements which may be added to it are explicitly mentioned.

Hence, there is no basis for combining the amount of total protein fraction given in claims 1 and 5 as filed (and with the amended lower limit in claims 1 and 5 of auxiliary request 5) with the disclosure of the table on page 3.

- 4.6 To sum up, several distinct ways of defining the invention can be identified in the application as filed: one way is defined in claim 1 as filed, a second way is defined in claim 5 and yet a further way is defined in the table on page 3.

While these distinct definitions of the invention may partially overlap or match, there is no direct and unambiguous disclosure in the application as filed that the features relating to the protein fraction (amount of total protein fraction / amount of intact protein / amount of protein fraction obtained from demineralised milk / whey proteins content / free amino acids content) could be freely combined.

- 4.7 Thus, the subject-matter of claims 1 and 5 includes added subject-matter. The ground of opposition under Article 100(c) EPC prejudices the maintenance of the patent on the basis of auxiliary request 5.

5. Like claims 1 and 5 of auxiliary request 5, claims 1 and 5 of auxiliary requests 6 and 7 contain the pre-grant amendment "a protein fraction in an amount of

8.5-12 g per 100 ml, which comprises intact protein in an amount of 8.2-11 g per 100 ml".

Thus, for the same reasons given as for claims 1 and 5 of auxiliary request 5, the subject-matter of claims 1 and 5 includes added subject-matter so that these requests are not allowable.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



B. Atienza Vivancos

W. Sieber

Decision electronically authenticated