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D E C I S I O N
of 20 November 2002

Case Number: T 0135/98 - 3.3.2

Application Number: 91201092.3

Publication Number: 0458380

IPC: A23K 1/16

Language of the proceedings: EN

Title of invention:
Fish feed

Patentee:
NORSK HYDRO A/S

Opponent:
Nutreco International B.V.
Ewos Limited

Headword:
Fish feed/NORSK HYDRO

Relevant legal provisions:
EPC Art. 52(1), 52(4), 54(5), 83, 84, 104

Keyword:
"Late-filed evidence not admissible: appellant's silence for four month, knowing it would not be able to comply with a direction of the Board given in response to its own adjournment request - abuse of the procedure"
"Novelty (no): no first medical (veterinary) use - in the absence of any specific proplylactic or therapeutic effect to be achieved, use of a known fish feed in the optimal satisfaction of the nutritional requirements of farmed fish is no use for a method referred to in Article 52(4) EPC"

Decisions cited:
T 0780/89

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0135/98 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 20 November 2002

Appellant: (Proprietor of the patent)
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 22 December 1997 revoking European patent No. 0 458 380 pursuant to Article 102(1) EPC.**

Composition of the Board:

Chairman: J. Riolo
Members: G. F. E. Rampold
C. Rennie-Smith

Summary of Facts and Submissions

I. This appeal is against the decision of the opposition division of 22 December 1997 to revoke European patent No. 45 83 80 ("the Patent") entitled "Fish feed" and based on European patent application No. 91 201 092.3. Oppositions to the Patent were filed by two parties - opponent 1 (respondent 1) which sought revocation on the grounds of lack of novelty and inventive step (Articles 54, 56 and 100(a) EPC) and also on the ground of insufficient disclosure (Articles 83 and 100(b) EPC), and opponent 2 (respondent 2) which sought revocation on the grounds of lack of novelty and inventive step (Articles 54, 56 and 100(a) EPC).

II. The claims of the patent as granted read as follows:

"*1. Fish feed which contains proteins, lipids and carbohydrates in combination with one or more additional components; such as fillers, adhesives, preservatives, vitamins* [sic] *and minerals mixed together to make a dry, soft or wet feed, characterised in that the feed contains n-3 polyunsaturated, fatty acids or digestible derivatives of fatty acids in amounts from 8,5 - 2,0% by weight, and amounts of biologically available iron varying from 5 -150 mg, and whereby the high amounts of iron will require lower amounts of n-3 fatty acids or fatty acids derivatives in the feed and vice versa.*

2. Fish feed according to claim 1, characterised in that it contains less than 100 mg iron and more than 3,5% by weight of n-3 polyunsaturated fatty acids or fatty acid derivatives."

III. Of the numerous documents cited during the opposition and subsequent appeal proceedings, the following are referred to in the present decision.

(1) EP-A-0 322 114;

(2) L. M. Desjardins et al, *"Iron catalyzed oxidation of trout diets and its effect on the growth and physiological response of rainbow trout"*; Fish Physiology and Biochemistry 3 (4), pages 173-182 (1987);

(4) T. C. Yu et al, *"Effect of dietary lipids on fatty acid composition of body lipid in rainbow trout (Salmo gairdneri)"*; Lipids 12 (6), pages 495-499,(June 1977);

(9) K. A. Rorvik, Report entitled "Testing of Four Types of Test Feed for Salmon", filed on behalf of opponent 1 together with the opposition statement on 9 May 1994;

(16) F. W. Bernhart and R. M. Tomarelli, *"A Salt Mixture Supplying the National Research Council Estimates of the Mineral Requirements of the Rat",* J. Nutrition, 89: '66, 495-500.

IV. At the end of oral proceedings held on 28 October 1997, the opposition division decided that the main request and auxiliary request before it, although complying with Articles 84 and 123(2) EPC and being novel, lacked an inventive step. As regards the objection of insufficient disclosure, the opposition division considered this was in effect related to the issue of inventive step on which it found the patent deficient.

The main request before the opposition division read as follows:

"*1. Fish feed which contains proteins, lipids and carbohydrates in combination with one or more additional components; such as fillers, adhesives, preservatives, vitamins and minerals mixed together to make a dry, soft or wet feed, characterised in that the feed contains above 3.5% by weight of EPA and/or DHA based on the weight of the feed and up to 8.5% by weight of n-3 polyunsaturated fatty acids, or digestible derivatives of said fatty acids based on the weight of the feed and in that the feed contains amounts of biologically available iron varying from at least 5 mg/kg and below 120 mg/kg, and whereby the high amounts of iron will require lower amounts of n-3 polyunsaturated fatty acids or fatty acids derivatives in the feed and vice versa, but excluding a fish feed having the following composition in percent by weight:*

protein	*33.33%*
herring oil	*22.00%*
dextrin	*26.00%*
cellulose	*11.17%*
and premix	*7.5&,*

wherein said protein contains 75% casein and 25% gelatin and wherein said premix provides in said feed 4.00% Bernhart-Tomarelli salt mix, 2.00% of a vitamin mix, 0.20% methionine, 0.10% tryptophan, 0.2% vitamin E concentrate and 1.00% choline chloride.

2. Fish feed according to claim 1, characterised in

that it contains less than 100 mg iron."

The auxiliary request differed from the main request only in that the upper limit of the amounts of biologically available iron in claim 1 was *"below 100 mg/kg"* instead of *"below 120 mg/kg"* and claim 2 was deleted.

V. The opposition division considered that the disclaimer at the end of claim 1 (see paragraph IV above) conferred novelty on the claimed subject-matter over the state of the art according to (4). It saw the problem to be solved by the patent as the production of a fish feed which provided increased strength and improved health. It considered citation (1) to be the closest prior art since this document related to a fish feed for solving the similar problem of providing a feed capable of preventing and treating certain diseases in farmed fish. In the opposition division's view, the solution of the problem by limiting the content of biologically available iron to below 120 mg/kg in the known fish feed of (1) was obvious to a person skilled in the art who knew, from citation (2), that lower iron concentrations in fish feed up to 86 mg/kg were beneficial to the health and weight of fish. The opposition division also observed in its decision that neither the experimental data in the patent specification nor that provided during the opposition proceedings demonstrated that the claimed invention produced an unexpected benefit.

The opposition division also found the only auxiliary request before it unacceptable for the same reasons.

VI. The patent proprietor (appellant) filed a notice of

appeal and paid the appeal fee on 3 February 1998 and filed a statement of grounds of appeal on 21 April 1998. The respondents filed arguments supporting their requests for the appeal to be dismissed with letters of 21 August 1998 (respondent 2) and 15 October 1998 (respondent 1). The parties filed further submissions in or with letters of 31 May 2002 (appellant), 9 October 2002 (respondent 2) and 18 October 2002 (respondent 1).

VII. In a letter dated 22 January 1999, enclosing a supporting declaration, respondent 2 (Ewos AB) explained that its assets in the interest of which its opposition had been brought had been transferred to a related company (Ewos Limited) which thereafter became respondent 2 in place of the original opponent/respondent.

VIII. Oral proceedings were appointed for 8 February 2002 by a summons sent to the parties on 16 November 2001. By a letter dated 13 December 2001, the appellant sought a postponement of the oral proceedings until the end of June 2002 or later in order to allow the preparation and filing of further evidence in the form of independently-conducted experiments to be carried out in the period January to May 2002. The appellant acknowledged the request to be unusual but said the evidence was "vital to a fair assessment of patentability".

IX. The Board, in a communication dated 14 January 2002, acceded to the appellant's request in part by allowing a postponement, but also, in order to give the other parties time to consider the further evidence, made directions for the appellant's further evidence to be

filed by 31 May 2002, for the respondents to file any comments thereon and/or any further evidence of their own in reply by 31 October 2002 and for the oral proceedings to be re-scheduled for a date after 31 October 2002. Further, the Board observed that the admissibility of any late-filed evidence or other material remained to be decided and would have to be considered at the oral proceedings; and that the appellant's justification for its conduct, objections thereto by the respondents and any applications under Article 104 EPC should be outlined in writing in advance.

X. In a letter dated 31 May 2002, the appellant explained that, not having been able to obtain the necessary materials in time, it had not conducted the experiments referred to in its request for postponement of the oral proceedings but other experiments which allowed previously submitted data to be reinterpreted. In submissions filed with their letters of 9 October 2002 and 18 October 2002, respondents 2 and 1 respectively objected to the admissibility of the appellant's new experimental evidence.

XI. The appellant also filed with its letter of 31 May 2002 a new main and seven auxiliary requests, the main and first auxiliary requests being the same as the corresponding requests considered by the opposition division at the oral proceedings before it (see paragraph IV above). Under cover of its subsequent letter of 6 November 2002, the appellant filed amended versions of all these requests.

XII. Oral proceedings were held on 20 November 2002 at the end of which the Board announced its decision that the

appeal is dismissed. During the oral proceedings, the appellant presented a new main and auxiliary requests which replaced all its previous requests filed with its letter of 31 May 2002. The auxiliary request was subsequently withdrawn. The new main request is accordingly the sole remaining request and consists of two claims reading as follows:

"1. Fish feed which contains proteins, lipids and carbohydrates in combination with one or more additional components, such as fillers, adhesives, preservatives, vitamins and minerals mixed together to make a dry, soft or wet feed, characterised in that the feed contains from 8.5-2.0% by weight of n-3 polyunsaturated fatty acids and above 3.5% by weight of EPA and/or DHA, or digestible derivatives of said fatty acids, and in that the feed contains amounts of biologically available iron varying from at least 5 mg/kg and below 120 mg/kg, and whereby the high amounts of iron will require lower amounts of said n-3 polyunsaturated fatty acids or fatty acid derivatives in the feed or vice versa, for use in obtaining a prophylactic effect on diseases or improved health and growth for fish fed with said feed.

2. Fish feed according to Claim 1, characterised in that it contains less than 100 mg/kg iron."

XIII. The arguments of the appellant as regards this main request and related issues can be summarised as follows:

(A) As to the late-filed evidence filed with the letter of 31 May 2002, the appellant gave no specific reasons for its lateness but argued, in that letter, that the additional experimental evidence and reinterpretation of earlier experimental results showed that the health of farmed salmon is positively and significantly affected by a synergistic effect between EPA/DHA and iron in fish diets.

(B) As to why the evidence actually filed in May 2002 was not the evidence indicated in its letter of 13 December 2001, the appellant explained that the experiments it intended to perform would have been very expensive; that both the appellant company and another company partly owned by the appellant which actually works the invention had to share the costs and this entailed extensive discussions; matters were further hindered by a major reorganisation within the appellant company; and that, despite placing orders for the necessary feed and fish pens in good time, these could not be obtained by the end of January 2002 which meant the experiments could not be conducted in time for the evidence to be filed by 31 May 2002 (the date set by the Board's directions - see paragraph IX above).

(C) As to its new request, the appellant submitted that the current claims corresponded to the claims in the proceedings before the opposition division, except that the disclaimer had been deleted from claim 1 and the claims had been redirected towards the use of the defined fish feed in obtaining a prophylactic effect on diseases and improved

health and growth for fish fed with said feed. The claims had the correct format of a so-called first medical (veterinary) indication as provided for in Article 54(5) EPC. The language of these revised claims was fully supported by the application as originally filed.

(D) Concerning novelty and inventive step the appellant essentially argued that citation (4) was of no significance because it was only concerned with the effects observed by a partial replacement of herring oil by lard in fish feed. From this state of the art, the only conclusion that could be drawn was that such partial replacement did not adversely affect fish growth and did not increase the saturation of the fish body lipid. However, citation (4) was wholly silent as to the effects and benefits of reducing the iron contents of feeds containing large quantities of marine lipids and hence high concentration of n-3 polyunsaturated fatty acids (n-3 PUFA). The three isocaloric diets disclosed in (4), including Diet No. 1, were prepared for the sole purpose of comparing the effect of dietary lipids on fatty acid composition of body lipid in rainbow trout. There was absolutely no disclosure or hint in citation (4) that any of these diets was either effective in the prophylaxis of diseases or in improving health and growth of fish fed with said diets. Even if the skilled reader would be led by citation (4) to make up a feed with a high content of n-3 PUFA fish oils, more specifically EPA (5,8,11,14,17-eicosapentaenoic acid) and/or DHA (4,7,10, 13, 16, 19-docosahexaenoicacid), and an iron content of the feed below 120 mg/kg, there

was still nothing in (4) to motivate the skilled person to use this feed for any of the prophylactic or therapeutic purposes specified in claim 1. Since citation (1) was entirely silent about the benefits of low iron levels in the feed, the skilled person had no incentive to combine the teachings of citations (1) and (4).

(E) There was considerable disagreement at first instance as to whether or not the appellant's experimental evidence demonstrated that the high n-3-PUFA, low iron feeds defined in claim 1 improved the health and well-being of farmed fish. Although the appellant accepted that its experiments were not ideal for the purpose of comparing the claimed invention with the cited state of the art, the opposition division failed, in the appellant's opinion, to give proper weight to the clear trends established by these experiments as a whole. If, however, the available experimental data were assessed scientifically, then it was undoubtedly proved on the strong balance of probabilities that a low iron content interacted with a high n-3-PUFA content to help prevent and control diseases and improve health and growth in fish fed with the diets specified in current claim 1.

XIV. The arguments of the respondents as regards the appellant's sole remaining request and related issues can be summarised as follows:

(A) The appellant's new evidence was filed very late, whether considered in the context of the opposition and appeal proceedings together or even

just in the context of the appeal. The appellant had clearly been working its claimed invention and thus evidence of the benefits of the invention could and should have been obtained much earlier.

(B) The experimental evidence actually filed with the appellant's letter of 31 May 2002 was not the evidence it had stated, in its letter of 13 December 2001, it intended to file and for which it sought an adjournment of the oral proceedings. The appellant was under a duty, when it became apparent that those experiments could not be conducted, to notify the Board accordingly. To use the postponement granted by the Board to conduct a different set of experiments was an abuse of the proceedings. That both the appellant and its related company would both need to be involved in experiments does not excuse the failure to make preparations earlier, and if the necessary feed and pens were not available to meet the time-scale indicated in the 13 December 2001 letter, they had in fact not been ordered in good time.

(C) The claims in the appellant's current request were directed to a method of medical treatment practised on the animal body and as such, were contrary to Article 52(4) EPC. This must be so because the appellant asserted in claim 1 that the feed in question was "for obtaining a prophylactic effect on diseases and improved health for fish fed with said feed". Since feeding the fish was the only practical step involved in obtaining the stated health benefits, it followed that feeding the fish must constitute a medical treatment.

Decision T 780/89 (OJ EPO 1993, 440) confirmed that a method of administration (i.e. feeding) of a defined chemical having an immuno-stimulating effect to a meat producing animal was a medical treatment within the meaning of Article 52(4) EPC even where the method was claimed only for non-therapeutic purposes (i.e. an improvement in the quantity or quality of the resultant meat), if the improvement resulted from the improved health of the animal as a result of the method. A method of feeding fish using a feed which was expected to provide a prophylactic effect on diseases and to improve health and growth for fish fed with such feed fell within this category.

(D) The format adopted in the appellant's request could do nothing to confer novelty on the amended claims. They were dressed up as first medical indication claims asserting that the claimed feed was for use in obtaining a prophylactic effect on diseases and improved health and growth. However, such aims were already specifically described in detail in the context of the fish feed disclosed in (4) and were, moreover, implicit in any fish feed. It followed that any prior art fish feed having the necessary composition would also have been intended for improving health and growth and would have been prophylactic against disease. Obviously poorly nourished fish would inevitably be prone to disease and the object of any fish feed was to provide proper nourishment. It was thus clear that the rewording of the claims provided no basis for the acknowledgment of novelty or inventive step over the prior art teaching already discussed during the proceedings

before the opposition division.

(E) Even if an attempt was made to interpret the obscure wording of the claim "whereby the high amounts of iron will require lower amounts of n-3 PUFA" in the light of the description, the skilled reader was given no instructions as to how to select the adequate respective amounts of iron and n-3 PUFA.

Moreover, the patent promised a fish feed that was effective in the prophylaxis of diseases and in obtaining improved health and increased growth. However, apart from the fact that the nature of the diseases to be prevented by feeding fish with the feed was not specified in present claim 1, the experimental evidence relied upon by the appellant and the respondents - especially the results presented in (9) - demonstrated clearly that this promise was not fulfilled by the feed defined in the current claims. It was therefore not possible for a person skilled in the art to work the invention in the manner promised by the appellant in the patent specification, contrary to the requirements of sufficiency of disclosure laid down in Article 83 EPC.

XV. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of its main request filed during the oral proceedings.

The respondents both requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

Late-filed evidence

2. It is well-established by the jurisprudence of the Boards of Appeal that, in considering the admissibility of late-filed evidence, account is to be taken of *inter alia* whether it could have been filed earlier and if so the reason why not, and of its relevance and in particular whether it has a greater relevance to the issues than the material already on file (see generally, "Case Law of the Boards of Appeal of the European Patent Office", 4th edition, 2001, pages 324 to 333). Thus in principle any new evidence filed on appeal is exceptional *per se* and its admissibility is a matter for the exercise of the Board's discretion. In addition to these general principles, the Board must also ensure that late filing does not take another party by surprise and that, if late evidence is to be admitted, the other party or parties have sufficient time to consider it and, as appropriate, reply with evidence of their own.

2.1 It is beyond doubt that the evidence filed by the appellant with its letter of 31 May 2002 was late whether "late" is taken as meaning after the end of the opposition period, after the end of the opposition proceedings, or after the grounds of appeal were filed in the appeal proceedings. Although the Board in its communication of 14 January 2002 specifically drew the parties' attention to the question of the admissibility of late-filed evidence and directed *inter alia* that the appellant's justification for the lateness of its

evidence be submitted in writing in advance of the oral proceedings, the appellant gave no reason for the late submission of the evidence it eventually produced other than an explanation for the non-production of the evidence it intended to but did not produce. As the respondents argued, the evidence actually filed as late as May 2002 is evidence the appellant could have produced earlier, not just because ample time had elapsed since the commencement of the proceedings on the patent, but also because on its own admission the appellant (albeit in conjunction with its related company) is engaged in the active exploitation of the claimed invention and thus had the opportunity to gather and examine data as to its effectiveness for a very considerable time. In fairness to the appellant, it did when filing its late evidence submit arguments as to its possible relevance but relevance and justification for lateness are separate criteria and satisfying the former does not satisfy the latter. In the Board's judgment, the lateness of evidence cannot be excused if no attempt is made to show why the actual evidence in question was not produced at an earlier date.

2.2 The real reason for the late filing of the evidence was, as is clear beyond doubt, that the appellant intended to file different evidence but then found it could not obtain the necessary feed and pens in time, and thus apparently had to satisfy itself with alternative evidence which could be produced in time. However, this does not alter the fact that the evidence actually filed could have been prepared and filed much earlier and is therefore insufficient to justify the lateness. The Board would add that the various reasons given by the appellant for the non-production of the

intended evidence (cost, the involvement of two companies, a corporate reorganisation, non-delivery of equipment in time) are not reasons the Board could have accepted for lateness of the intended evidence itself had that been filed. They were quite simply matters of the appellant's own making or which only the appellant could deal with and they cannot be allowed to excuse causing surprise or inconvenience to other parties.

2.3 In the present case, the issue of lateness was exacerbated by the fact that the evidence filed on 31 May 2002 was not the evidence the appellant sought an adjournment to prepare and file. In its letter of 13 December 2001, the appellant indicated it wanted to conduct independent experiments which required the purchase of special equipment and several months to conduct. As the Board observed in its communication of 14 January 2002, it was remarkable that the appellant should leave the preparation over several months of evidence it described as "vital" until the end of the appeal proceedings. That, having secured an adjournment of the oral proceedings to conduct such experiments and having discovered as soon thereafter as the end of January 2002 that these experiments could not be conducted within the extension of time it had obtained, it did not inform the Board (and thereby the respondents) until the very end of that extension of time that evidence of a quite different character would be produced, was understandably criticised by the respondents. The Board largely agrees with them. While there may have been no deliberate intention to mislead, the effect was beyond doubt to take the respondents by surprise when such surprise could have been prevented. The respondents could, in the light of the advance information given by the appellant, have been preparing

to counter the new evidence they expected to receive and might have incurred unnecessary cost in doing so.

2.4 The Board agrees with the respondents that the appellant, in the position in which it found itself by (on its own information) the end of January 2002, was under a duty to inform the Board of its change of plan. Put at its simplest, it was unfair for the appellant to remain silent for four months, knowing that it would be filing evidence the other parties and the Board did not expect and knowing it would not be able to comply with a direction of the Board given in response to its own adjournment request. It must be remembered that any postponement of oral proceedings granted in favour of an appellant acts as an extension of the suspensive effect of an appeal and thus, in the case of an appealing patentee, of the time during which respondent opponents risk an allegation of infringement if they work an invention which has already been found unpatentable by the opposition division. In the circumstances, the appellant's behaviour was an abuse of procedure.

2.5 Accordingly, the Board holds that the evidence filed with the appellant's letter of 31 May 2002 is not admissible.

Clarity

3. Clarity, a requirement of Article 84 EPC, is not *per se* a ground of opposition (see Article 100 EPC). However, the opposition division and the Board have the jurisdiction, and indeed the obligation, to consider clarity of a claim resulting from an amendment (cf. Case Law of the Boards of Appeal, 4th edition 2001,

VII.C.10.2, pages 488-489).

3.1 The clarity issue referred to in paragraph 3.2 below resulted directly from such an amendment. The previous main request contained the wording "the feed contains from 8.5% by weight of n-3-polyunsaturated fatty acids to above 3.5% by weight of EPA and/or DHA", to which the Board objected because the range thereby created had an upper limit expressed in generic terms of "n-3-polyunsaturated fatty acids" and a lower limit expressed in different specific terms of "EPA and/or DHA". The request was as a result amended, in the main and ultimately only request before the Board, to read "the feed contains from 8.5%-2.0% by weight of n-3-polyunsaturated fatty acids and above 3.5% by weight of EPA and/or DHA".

3.2 The main request finally before the Board, although as regards clarity an improvement on the previous main request it replaced, none the less still contains at least one lack of clarity, namely the feature "the feed contains from 8.5%-2.0% by weight of n-3-polyunsaturated fatty acids and above 3.5% by weight of EPA and/or DHA". Since "EPA" and "DHA" are two most prominent examples of "n-3-polyunsaturated fatty acids", claim 1 of the main request presents, if only as a matter of language, the logical impossibility of a fish feed containing at one and the same time as little as 2% by weight of "n-3-polyunsaturated fatty acids" (the generic term including "EPA" and "DHA") but at the same time a minimum of 3.5% by weight of "EPA and/or DHA" (the specific term). Since the appeal fails for other reasons (see point 6 below), the Board only observes here that, if the main request had otherwise complied with the requirements of the EPC, this

question of clarity could have been fatal to the request.

Sufficiency of disclosure

4. The respondents made a detailed attack at the hearing on the main request on the ground of insufficiency of description (see paragraph XIV/(E) above). While the Board has some sympathy with the respondents' arguments, it is unnecessary to make a final decision on this issue since the appeal must fail on other grounds (see point 6 below). In those circumstances, the Board confines itself to observing that when, as in this case, a significant lack of clarity appears in a claim (see point 3.2 above), there may, as here, often be at least an arguable insufficiency of disclosure as well.

Novelty

5. Citation (4) discloses a fish feed (Diet No. 1) having the following percentage composition (see Tables I - page 495 - and Table II - page 496):

33.33% **protein**:
ingredients: 75% casein + 25% gelatin
37.17% **carbohydrates**:
ingredients: 26% dextrin, 11.17% cellulose
22.00% **lipids (herring oil):**
EPA/DHA percentage of lipids in Diet No. 1 (see Table II): 8.7% EPA + 9.4% DHA = 18.1%;
22% lipids per kg feed x 0.181 = **3.98% EPA/DHA**
total n-3 PUFA percentage of lipids in Diet No. 1 (see Table II): 24.4%
22% lipids per kg feed x 0.244 = **5.368% PUFA**

7.50% Premix
(2.0% vitamin mix, 0.20% methionine, 0.20% tryptophane, 0.10% vitamin E concentrate, 1.00% choline chloride;
4.0% Mineral mix = 40 g/kg feed Bernhart-Tomarelli salt contains according to (16)- seep age 496, left hand column, Table 1: 5.58 mg Ferric citrate (16.7% Fe)/g = 0.93 mg Fe/g; 40 x 0.93 = **37 mg/kg Fe (iron)**

6.1 As admitted by the appellant itself, the fish feed (Diet No. 1) disclosed in citation (4) has a composition in accordance with the feed of current claim 1. This means that a fish feed with the particular composition specified in present claim 1 is already disclosed in the state of the art. (The function of the disclaimer at the end of claim 1 in the appellant's main and auxiliary requests before the opposition division was to restore novelty of claim 1 over the state of the art according to (4)- see paragraph IV above).

6.2 Claim 1 as it now stands is directed to the known fish feed disclosed in (4) *"for use in obtaining a prophylactic effect on diseases and improved health and growth for fish fed with said feed"*. The Board does not share the respondents' view that the claims in the appellant's request are directed to a medical treatment practised on the animal body as such and accordingly to a method referred to in Article 52(4) EPC. The appellant submitted that claim 1 is drawn up in the format of a first medical/veterinary use as provided for in Article 54(5) EPC.

6.3 Article 54(5) EPC expressly provides for an exception

to the general rules for novelty (Articles 54(1) to (5) EPC) in respect of the first medical or veterinary use of a substance or composition, by allowing a claim to the substance or composition *for the use in a method referred to in Article 52 EPC, paragraph 4*, provided that its use for any method referred to in that paragraph is not comprised in the state of the art.

6.4 Therefore, in order to assess the novelty of current claim 1 over the prior art of citation (4) it has to be established

(i) whether or not the claim is directed to a fish feed for the exclusive use in one or more method(s) referred to in Article 52(4) EPC and, only if this first question is answered in the affirmative,

(ii) whether or not the use of the fish feed (Diet No. 1) for a method referred to in Article 52(4) EPC has already been disclosed in citation (4).

6.4.1 As to (i): It appears clear to the skilled reader from the patent specification that the main purpose of the claimed invention is to provide a feed mixture for optimally satisfying the nutritional requirements of farmed fish. As a preliminary point in deciding question (i) it should be noted therefore that neither any of the pathologic conditions (diseases) to be prevented (prophylactic effect on diseases) nor any details of the particular improvement in terms of health and growth to be achieved by feeding fish with Diet No. 1 are specified in claim 1. In the absence of any such stipulation it necessarily follows that the particular intended use (*"for use in obtaining a*

prophylactic effect on diseases and improved health and growth for fish fed with said feed") of the known fish feed (Diet No. 1) defined in claim 1 can, like that of any prior art fish feed having an appropriate composition, only be either properly to nourish the fish to prevent pathologic conditions (diseases) or to avoid any negative impact on health and growth, which in either case would be caused by insufficient or defective nutrition or starvation. It is thus clear that any prophylactic effect on an unspecified disease and any unspecified improvement in health and growth must be regarded as the natural function or direct consequence of properly feeding the fish with the known fish feed defined in claim 1. In summary, the Board, therefore, reaches the conclusion that the particular intended use of the known fish feed (Diet No. 1) specified in claim 1 is the optimal satisfaction of the nutritional requirements of farmed fish and that this use is thus not intended for any method referred to in Article 52(4) EPC. Since question (i) has to be answered in the negative, it is unnecessary to consider question (ii). It follows that claim 1 lacks novelty over the state of the art according to (4).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

A. Townend J. Riolo