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**Datasheet for the decision
of 7 February 2012**

Case Number: T 0605/09 - 3.3.09

Application Number: 00979476.9

Publication Number: 1143806

IPC: A23K 1/16, A23K 1/18

Language of the proceedings: EN

Title of invention:
Method for increasing pet activity

Patentee:
SOCIETE DES PRODUITS NESTLE S.A.

Opponent:
THE IAMS COMPANY

Headword:
-

Relevant legal provisions:
EPC Art. 54

Relevant legal provisions (EPC 1973):
-

Keyword:
"Novelty - no (main and auxiliary request)"

Decisions cited:
G 0002/88, T 0254/93

Catchword:
-



Case Number: T 0605/09 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 7 February 2012

Appellant: THE IAMS COMPANY
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Representative: Fisher, Adrian John
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Respondent: SOCIETE DES PRODUITS NESTLE S.A.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 16 January 2009
rejecting the opposition filed against European
patent No. 1143806 pursuant to Article 101(2)
EPC.

Composition of the Board:

Chairman: W. Sieber
Members: J. Jardón Álvarez
K. Garnett

Summary of Facts and Submissions

I. The mention of the grant of European patent No. 1 143 806, in respect of European patent application No. 00979476.9, in the name of SOCIETE DES PRODUITS NESTLE S.A., filed on 21 September 2000 as international application PCT/EP2000/009444, was published on 19 April 2006 (Bulletin 2006/16).

The patent was granted with 24 claims including nine independent claims. Eight of the independent claims were directed to a method for improving (physical) activity in a pet or in an elderly pet (claims 1, 7, 14 and 20-22), a method of increasing activity level in a dog of at least 5 years of age or a cat of at least 7 years of age (claim 23) and a method of returning a senior pet to being as lively as it was a few years previously (claim 24). Independent claim 15 was drafted as a second medical use claim directed to the use of a nutritional agent for ameliorating joint stiffness in a pet. The claims relevant for this decision, namely claims 1 and 15, read as follows:

"1. A method for improving activity in a pet, the method comprising administering to the pet a nutritional agent which promotes the growth of bifido- and lactic-bacteria in the gastro-intestinal tract of the pet."

"15. Use of a nutritional agent which promotes the growth of bifido- and lactic-bacteria in the gastro-intestinal tract of the pet in the manufacture of a composition for ameliorating joint stiffness in a pet."

II. A notice of opposition was filed by THE IAMS COMPANY on 19 January 2007 requesting revocation of the patent in its entirety on the grounds of Articles 100(a) (lack of novelty and lack of inventive step) and 100(b) EPC.

During the opposition proceedings, *inter alia*, the following documents were cited:

D4: EP 0 382 355 A2;

D6: WO 98/44932 A1; and

D7: WO 94/27617 A1.

III. By its decision announced orally on 2 December 2008 and issued in writing on 16 January 2009, the opposition division rejected the opposition.

The opposition division acknowledged novelty of the claimed subject-matter because none of the documents in the proceedings disclosed how to improve or increase the activity of animals by administering them a nutritional agent which promotes the growth of bifido- and lactic-bacteria in the gastro-intestinal tract. The beneficial effects of such nutritional agents described in the prior art included, *inter alia*, health improvement, the increase of growth rate and the improvement of glucose and fat metabolism. However, none of these effects directly and unambiguously anticipated the now claimed uses, namely the improvement of activity and/or the amelioration of joint stiffness.

The opposition division also concluded that the claimed subject-matter fulfilled the requirements of inventive step and sufficiency of disclosure.

IV. On 6 March 2009 the opponent (appellant) lodged an appeal against the decision of the opposition division. The appeal fee was paid on the same day.

The statement of grounds of appeal was filed on 13 May 2009 together with the following further documents:

D16: WO 98/26787 A1;

D17: D. Kato *et al.*, Life Sciences 63(8), pages 635-644 (1998);

D18: M. T. Nenonen *et al.*, British Journal of Rheumatology, 37, pages 274-281 (1998);

D19: US 5 932 258; and

D20: K. Hartmann *et al.*, European Journal of Medical Research, 3, pages 95-98 (1998).

The appellant requested that the decision under appeal be set aside and the patent be revoked in its entirety because the claimed subject-matter lacked novelty and inventive step, and was insufficiently disclosed.

V. With its reply dated 12 January 2010 the patent proprietor (respondent) disputed all the arguments submitted by the appellant and requested that the appeal be dismissed.

VI. By letter dated 7 June 2010 the appellant submitted further arguments and the following further documents:

D21: J. Wood, *The Pharmaceutical Journal*, Vol. 262, No 7050, pages 881-884 (June 1999);

D22: WO 97/29763 A1;

D23: US 2008/0305090 A1; and

D24: J. K. Spears *et al.*, *Archives of Animal Nutrition*, 59(4), pages 257-270 (2005).

VII. In a communication dated 6 June 2011, the board drew the attention of the parties to the points to be discussed during the oral proceedings. In particular, the board indicated that, in its preliminary view, the requirements of Article 83 EPC were fulfilled and the subject-matter of the claims appeared to be implicitly disclosed in the cited prior art.

VIII. Oral proceedings were held before the board on 7 February 2012. During the oral proceedings the respondent filed a set of five claims for an auxiliary request.

Claim 1 of the auxiliary request is identical to claim 15 of the granted patent (see point I above).

IX. The arguments presented by the appellant in its written submissions and at the oral proceedings, insofar as they are relevant for the present decision, may be summarized as follows:

- The subject-matter of claim 1 as granted lacked novelty in view of, *inter alia*, D4, D6 and D7, which disclosed that administration of a prebiotic agent to an animal improved its health. The claimed improvement of activity was not a new technical feature in the sense of G 2/88 and could not provide novelty over the prior art disclosures.

 - The auxiliary request filed during the oral proceedings should not be admitted into the proceedings because it was filed at a very late stage of the proceedings. Furthermore, the respondent was aware of the negative opinion of the board concerning novelty and should have filed the auxiliary request in due time before the oral proceedings.

 - The subject-matter of claim 1 of the auxiliary request lacked novelty having regard to the disclosures of D16 and D17, which disclosed the administration of prebiotic compositions for the treatment of rheumatoid arthritis. The treatment of rheumatoid arthritis necessarily implied ameliorating joint stiffness.
- X. The arguments of the respondent may be summarized as follows:
- The subject-matter of claim 1 of the main request was novel. The administration to a pet of a nutritional agent which promotes the growth of bifido- and lactic-bacteria in the gastro-intestinal tract of the pet for improving activity of the pet was a previously unknown property of the compounds,

such property providing a new technical effect. Indeed none of the documents cited referred to "increasing activity in a pet" which was clearly not the same as "increased nutrient absorption", "increased energy absorption" and "increased health". The improvement in activity in a pet was an effect which was not necessarily correlated with the known uses and could be clearly distinguished therefrom.

- Regarding claim 1 of the auxiliary request, neither D16 nor D17 provided an unambiguous disclosure of the use of a nutritional agent for amelioration of joint stiffness, the uses mentioned in these documents being rheumatoid arthritis and chronic fatigue syndrome.

XI. The appellant requested that the decision under appeal be set aside and that the European patent No. 1 143 806 be revoked.

The respondent requested that the appeal be dismissed, alternatively that the decision under appeal be set aside and the patent be maintained on the basis of the auxiliary request filed during the oral proceedings.

Reasons for the Decision

1. The appeal is admissible.

MAIN REQUEST

2. *Novelty (Article 54 EPC)*

2.1 Claim 1 of the main request is directed to:

- a method for improving activity in a pet,
- comprising administering to the pet a nutritional agent,
- which promotes the growth of bifido-and lactic-bacteria in the gastro-intestinal tract.

The nutritional agents used are known prebiotics, including oligosaccharides, probiotic micro-organisms, or a fermentation product thereof (see paragraphs [0015]-[0019] of the granted specification).

2.2 Claim 1, although drafted as "method of improving activity in a pet", is undoubtedly framed so as to protect the "use" of the known nutritional "for improving activity in a pet", that is to say, the claim is to be understood as a second non-medical use claim. This is in fact how the parties and the opposition division interpreted the claim throughout the opposition proceedings.

According to decision G 2/88 (OJ EPO 1990, 93) novelty within the meaning of Article 54(1) EPC can be acknowledged in cases where the discovery of a new technical effect of a known substance leads to an invention which is defined in the claims in terms of the use of that substance for a hitherto unknown, new non-medical purpose reflecting such effect, even if the only novel feature defined in the claims is the purpose for which the substance is used.

It is then to be decided whether the claimed improvement of activity in a pet is a new technical effect in terms of G 2/88.

2.3 The novelty of claim 1 was contested by the appellant during the appeal proceedings having regard *inter alia* to the disclosures of D4, D6 and D7.

2.4 D4 discloses the use of pullulan and/or dextran as growth-promoting agent for bifid bacteria (see page 2, lines 1-2; see also claim 1). Although D4 does not disclose that pullulan and dextran promote the growth of lactic-bacteria, they are in fact growth-promoting for lactic bacteria, as evidenced by D22, D23 and D24. The agent can exert its activity in domestic animals such as dogs and cats (page 3, line 54) and is said to be very useful, *inter alia*, in the maintenance and improvement of health (page 5, lines 37-39).

D6 discloses a pet diet which alters the function and morphology of the gastrointestinal tract in ways which are beneficial to the animal's health and well being (page 2, lines 16-20). The diet comprises fermentable fibres such as fructooligosaccharides or inulin (page 3, lines 10-14), both being nutritional agents which promote the growth of bifido- and lactic-bacteria in the gastro-intestinal tract (see paragraph [0016] of the patent specification).

D7 discloses the use of sucrose thermal oligo-saccharides to increase the number of bifidobacteria and lactobacilli within the gastrointestinal tract (page 9, lines 12-16 and 27-30). The nutritional agents

of D7 are used to enhance the growth rate and health of animals, including dogs and cats (page 5, lines 17-23 and page 7, lines 28-30).

2.5 Thus, neither D4, D6 nor D7, nor any other cited prior art, contains an explicit disclosure that these nutritional agents have the claimed capability of improving the activity in a pet.

2.6 The assessment of novelty depends on the answer to the question whether or not this effect, i.e. the capability of the nutritional agents to improve the activity in a pet, which is not verbatim disclosed in the state of the art, can confer novelty to the subject-matter of claim 1 in view of the conclusions laid down in G2/88 (point 2.2 above).

2.7 In the board's judgement this is not the case here because the improvement of the activity of the pet does not represent a newly discovered technical effect of the nutritional agents for the following reasons:

2.7.1 There is undeniably a correlation between improving health of a pet and its (physical) activity. As pointed out by the appellant, every dog or cat owner knows that a primary indicator of the health of a dog or a cat is its level of activity. In particular, it is well known that lethargy or inactivity are an indicator of illness. This self-evident truth is reflected, for example, in D20, in which the state of health of a cat is assessed by means of a modified "Karnofsky" score. The levels of playing and social activity in the cat contribute to the overall score, such that increased activity is taken as an indicator of improved health. The health

improvement disclosed in D4, D6 and D7 results inherently in an increase of the activity of the pet.

- 2.7.2 In fact the alleged newly discovered effect of improving pet activity is necessarily correlated to the known one. In other words, the claimed effect was already manifest and could not have been overlooked by a pet owner when feeding the compositions of D4, D6 or D7 to its pet.

Hence, the effect relating to improving pet activity is not a new technical effect in the sense of G 2/88 and cannot confer novelty on the subject-matter of granted claim 1 over the disclosure of D4, D6 and D7.

- 2.8 The respondent maintained that an improvement in the health of a pet did not mean that the activity of the pet was increased. The claimed improvement in activity in a pet was not necessarily correlated with the known improvement of health and could be clearly distinguished therefrom.

- 2.9 The board cannot accept this argument for the following reasons:

- 2.9.1 It is correct that the prior art does not mention the wording "improving activity". It is however self-evident that an improvement of health results in increased activity as explained above. Calling the "improvement of health" which is disclosed in D4, D6 and D7 "improving activity" is only paraphrasing a known effect. Specifically pointing to this effect can not be considered as an additional piece of knowledge about the known use of the nutritional agents because

it is only the rewording of a known effect. The above considerations are in line with the conclusions in decision T 254/93 (OJ EPO 1998, 285, point 4.8 of the reasons) where it is stated that "the mere explanation of an effect obtained when using a compound in a known composition, even if the effect was not known to be due to this compound in the known composition, cannot confer novelty on a known process if the skilled person was aware of the occurrence of the desired effect".

2.9.2 Furthermore, the patent in suit associates health improvement with improved activity. In examples 1 and 4 the increased level of activity is associated with effects related to an enhancement of health (a healthy look, shinier coats, brighter eyes). Moreover in examples 2 and 3, where arthritic (i.e. ill) dogs were used, the improvement of activity can again not be separated from the known improvement of health.

2.9.3 Finally, it is noted that the patent attributes the improvement in activity to the increased production of nutrients and/or absorption of nutrients due to the increasing concentration of bifido- and lactic-bacteria, which provide the pet with better nutrition and more energy (paragraph [0008]). This is indeed the known effect of the used prebiotic and probiotic microorganisms. The ability to improve glucose metabolism and enhance nutrient absorption in animals is the reason for its beneficial use for improving health (see, for instance, D6, page 3, lines 10-31).

2.10 For these reasons the subject-matter of claim 1 of the main request is not novel.

AUXILIARY REQUEST

3. *Admissibility of the auxiliary request*

3.1 The respondent filed this request during the oral proceedings, after the board had given a negative indication as regards the novelty of the main request, that is to say, at a late stage of the proceedings.

3.2 The request was filed by the respondent as a reaction to the indication by the board that the subject-matter of claim 1 of the main request lacked novelty. The auxiliary request includes only claims already present in the granted claims. In fact the auxiliary request is restricted to claim 15 as granted (point I above) together with four dependent claims.

3.3 The limitation to this subject-matter is an attempt of the respondent to maintain the patent in an amended form. As indicated above the claims of the auxiliary request were already in the proceedings and had been discussed by the parties during the written procedure. Thus, the request did not raise any new issues with which the appellant or the board could not reasonably expect to deal during the oral proceedings.

3.4 Under these circumstances, the board exercised its discretion to admit the auxiliary request into the proceedings (Articles 13(1) and (3) RPBA).

4. *Novelty*

4.1 Claim 1 of the auxiliary request is drafted in the form of a second medical use claim and is directed to the

use of a nutritional agent which promotes the growth of bifido- and lactic-bacteria in the gastro-intestinal tract of the pet, that is to say the same known nutritional agents of claim 1 of the main request, in the manufacture of a composition for ameliorating joint stiffness in a pet.

- 4.2 The novelty of this claim was contested by the appellant in view of the disclosure of D16 and D17, which disclose the use of nutritional agents for the treatment of rheumatoid arthritis.

D17 investigates the effects of the oral administration of the viable bacterium *Lactobacillus casei* strain Shirota, on the development of type II collagen-induced arthritis in DBA/1 mice (summary). Type II collagen (CII)-induced arthritis in DBA/1 mice is a good experimental model of rheumatoid arthritis in humans (page 635, first two lines after the summary). *Lactobacillus casei* Shirota is cited in the patent in suit as example of suitable probiotic micro-organism which promotes the growth of bifido- and lactic-bacteria in the gastro-intestinal tract (column 3, line 48). Document D17 does not explicitly disclose the feature "for ameliorating joint stiffness in a pet" as now claimed. As a consequence, it has to be decided whether this feature is implicitly disclosed in D17.

- 4.3 Rheumatoid arthritis is a chronic, systemic inflammatory disorder that mainly affects flexible joints. Rheumatoid arthritis typically manifests itself by signs of inflammation, with the affected joints being swollen, warm, painful and stiff. The goals of management of rheumatoid arthritis are to relieve pain,

stiffness and swelling in order to improve mobility and function of joints (see, for instance D21, page 882 under "aims of treatment", filed by the appellant as proof of common general knowledge).

4.4 Consequently, the disclosure of D17 directed to the treatment of rheumatoid arthritis is a disclosure of the use of *Lactobacillus casei Shirota* for the amelioration of joint stiffness because this is achieved when treating rheumatoid arthritis. Having regard to D17, the feature "for ameliorating joint stiffness in a pet" does not provide any new technical information to the skilled reader.

4.5 The appellant argued that in D17 reference was made to arthritis treatment and reduction of swelling of the joints which is not necessary the same as ameliorating joint stiffness.

This argument is unconvincing. As indicated above in animals suffering arthritis the joints become swollen and stiffness limits their movement. A reduction in swelling automatically implicates an amelioration of the joint stiffness.

4.6 For these reasons, the subject-matter of claim 1 of the auxiliary request also lacks novelty.

5. In summary, none of the requests relate to patentable subject-matter.

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

G. Röhn

W. Sieber