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**Datasheet for the decision
of 29 March 2019**

Case Number: T 1420/15 - 3.3.09

Application Number: 05800284.1

Publication Number: 1793685

IPC: A23K1/18, B65D21/02, B65D85/72

Language of the proceedings: EN

Title of invention:
MORE APPEALING PET FOOD PRODUCTS AND THEIR METHODS OF
PREPARATION

Patent Proprietor:
Nestec S.A.

Opponents:
Mars UK Limited
The IAMS Company

Headword:

Relevant legal provisions:
EPC Art. 100(c), 84

Keyword:

Grounds for opposition - added subject-matter (yes)
Claims - clarity after amendment (no)

Decisions cited:

T 0331/87

Catchword:



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Case Number: T 1420/15 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 29 March 2019

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 22 May 2015
rejecting the opposition filed against European
patent No. 1793685 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman W. Sieber
Members: F. Rinaldi
 E. Kossonakou

Summary of Facts and Submissions

- I. This decision concerns the appeals filed by opponent 1 and opponent 2 against the decision of the opposition division to reject the oppositions against European patent No. 1 793 685.
- II. In their respective notice of opposition, opponent 1 and opponent 2 had requested revocation of the patent in its entirety under Article 100(a) EPC (lack of novelty and lack of inventive step), opponent 1 also under Article 100(b) and 100(c) EPC.
- III. The documents cited during opposition proceedings included:
- D16: US 3,898,345.
- IV. The opposition division decided, *inter alia*, that granted claim 1 was based on claims 16 and 24 of the application as filed and that the omission of two features from claim 16 as filed ("having increased consumer appeal" and "in the form of human delicatessen food") did not add subject-matter.
- V. Opponent 1 (appellant 1) and opponent 2 (appellant 2) appealed the decision and requested that the decision be set aside and that the patent be revoked. The following documents were filed with the statement setting out the grounds of appeal:
- E1: Repetition of example 1 of D16 (appellant 1)
D33: C. O. Chichester, "Advances in food research", vol. 30, Orlando, Academic press INC., 1986 (3 pages) (appellant 2).

VI. In its reply, the patent proprietor (respondent) requested that the appeals be dismissed and that the patent be maintained as granted (main request) or on the basis of one of the first to fifth auxiliary requests filed with it.

VII. By letter dated 28 February 2019, the respondent replaced the first to fifth auxiliary requests with corrected versions of these requests.

VIII. On 29 March 2019, oral proceedings were held before the board. The initial requests of the parties were:

Appellant 1 and appellant 2 requested that the decision under appeal be set aside and that the patent be revoked. Appellant 2 also requested that the fifth auxiliary request not be admitted into the proceedings. However, this request was withdrawn during the oral proceedings.

The respondent requested that the appeals be dismissed (main request) or, alternatively, that the patent be maintained in amended form on the basis of one of the first to fifth auxiliary requests filed by letter dated 28 February 2019. Furthermore, it requested that E1 and D33 not be admitted into the proceedings.

IX. The claim requests relevant for the present decision were the following:

Main request: claim 1 as granted read as follows:

"1. A pet food composition comprising a gravy and at least two ingredients selected from the group of ingredients consisting of meat, soy, vegetable, grains

and pasta, characterised in that the gravy comprises water, starch, dextrose, glycine and a flavouring."

First to fourth auxiliary requests: claim 1 of each of these requests was based on granted claim 1. However, their subject-matter was further specified, *inter alia*, by defining the amount of glycine (first to third auxiliary requests) and/or dextrose (second to fourth auxiliary requests) that was added to the gravy.

Fifth auxiliary request: claim 1 of this request read as follows (amendments over claim 1 as granted underlined):

"1. A pet food composition having increased consumer appeal comprising a gravy and at least two ingredients selected from the group of ingredients consisting of meat, soy, vegetable, grains and pasta in the form of human delicatessen food, characterized in that the gravy comprises water, starch, dextrose, glycine and a flavouring."

X. The appellants' arguments relevant to the present decision may be summarised as follows:

Granted claim 1 included added subject-matter. The features "having increased consumer appeal" and "in the form of human delicatessen food" were present in claim 16 as filed, but were omitted in claim 1 as granted. However, these were essential features, which provided a technical contribution to the claimed invention. The pet food compositions of claim 16 as filed designated a subset of pet foods and not all pet foods. The expression "in the form of delicatessen food" had been intended to exclude, *inter alia*,

processed food. The omission of the two features constituted an unallowable intermediate generalisation.

The fifth auxiliary request included unclear subject-matter.

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

The omitted terms did not limit the scope of the claims, and the removal of a non-limiting feature could not extend the scope of the claims. Reference was made to T 331/87. From paragraphs [0001], [0005] and [0063] of the application as filed, it was derivable that "in the form of a human delicatessen food" was not an essential feature of the food compositions, but that it rather related to an effect of the invention. It did not make any further technical contribution. The feature "in the form of human delicatessen food" was fulfilled by the features of claim 1.

Reasons for the Decision

1. *Main request - added subject-matter*

1.1 According to the reasoning in the opposition division's decision, granted claim 1 was based on claims 16 and 24 of the application as filed. On appeal, the appellants challenged this finding. According to the appellants, the omission of the two features "having increased consumer appeal" and "in the form of human delicatessen food" in granted claim 1 added subject-matter.

1.2 Claim 16 and claim 24 of the application as filed read as follows:

"16. A pet food composition having increased consumer appeal comprising: a gravy and at least two ingredients selected from the group of ingredients consisting of meat, soy, vegetables, grains and pasta in the form of human delicatessen food." (the features omitted in granted claim 1 are underlined by the board)

"24. The pet food composition of claim 16 wherein the gravy is comprised of water, starch, dextrose, glycine, and a flavoring."

1.3 The appeal or attractiveness (e.g. taste, smell, texture) certainly is in most cases an important and technical aspect of a food composition. Generally, such considerations also apply to pet food compositions, which have to be appealing to the pet owner as set out in paragraph [0005] of the application as filed. Therefore, it has to be examined whether, in the present case, the two features may be omitted without modifying the subject-matter of granted claim 1.

1.4 In the context of the opposed patent, the skilled person would have recognised that the feature "in the form of human delicatessen food" not only related to the appearance of the pet food composition, but also, *inter alia*, to the type of ingredients used. This understanding is supported by the application as filed. According to the definition given in paragraph [0061], "[t]he term 'delicatessen foods' can be understood to mean, for example, fresh and ready to eat, prepared foods containing natural products. Natural products are those that do not contain processed foods."

The board concedes that the feature "in the form of human delicatessen food" does not have a clearly defined meaning. Nevertheless, it does not simply relate to the technical effect or the technical problem of the application as filed, as argued by the respondent. On the contrary, it provides a technical contribution by excluding certain types of pet food compositions, i.e. it defines a subset of pet food compositions, in particular, those without processed foods. As discussed during the oral proceedings, if granted claim 1 included the feature "in the form of human delicatessen food", the prior-art disclosure under consideration for assessing novelty would arguably exclude example 1 of D16, which relates to a pet food composition prepared, *inter alia*, by impregnating bundles of spun vegetable protein fibres with an emulsion with gluten, creamed liver and homogenised whole blood.

1.5 The respondent further argued that the feature "in the form of human delicatessen food" was implicitly fulfilled by the features of present claim 1. However, the board fails to see how the features of granted claim 1 would automatically lead to the omitted feature "in the form of human delicatessen food". Nor did the respondent elaborate on this issue in the oral proceedings.

1.6 Also, the respondent's argument that paragraphs [0001] and [0005] of the application as filed supported the omission of the objected feature is not convincing. These two passages read as follows:

"[0001] The present invention is directed to pet food products. More specifically, the present invention is directed to pet food products that are complete

nutritionally balanced meals for pets that have a taste and aroma comparable to food obtainable in restaurants."

"[0005] The present invention is directed to pet food products that contain a combination of real meat, real vegetables, real grain and pasta and container systems regarding same. In an embodiment, the present invention provides a pet food product that contains a dog food having the appearance of food for human consumption as found in delicatessens. Thus, the pet food product is more appealing to pet owners."

The opening sentence of paragraph [0001] only mentions pet food products as such. It can hardly be used to identify subject-matter to which the claims may be directed. Neither the gravy nor the ingredients meat, soy, vegetable, grains and pasta are mentioned in this paragraph. The gravy is also not mentioned in paragraph [0005]. Consequently, these two passages do not form the basis for the subject-matter of granted claim 1. Moreover, even in paragraphs [0001] and [0005] emphasis is put on the notion of providing a pet food that has characteristics relating to delicatessen food (e.g. "taste and aroma comparable to food obtainable in restaurants", "real meat", "real vegetables").

The respondent also referred to paragraph [0063] as a basis for the amendment in granted claim 1, but in this paragraph it is again explicitly stated that "[t]he composition is provided in the form of human delicatessen food".

In summary, the respondent has not indicated any passage in the application as filed in which the ingredients of granted claim 1 are *not* associated with

the feature "provided in the form of human delicatessen food".

1.7 Lastly, the respondent argued that the omission of the underlined features was allowable in view of the essentiality or three-point test developed in T 331/87. However, this argument does not assist the respondent's case. This test cannot replace the need to answer the question of what a skilled person would objectively have derived from the description, claims and drawings of the European patent application on the date of filing (Case Law of the Boards of Appeal of the EPO, 8th edition 2016, Chapter II.E.1.2.4). What matters is not whether the omitted feature was essential, but rather whether the subject-matter of the amended claim was directly and unambiguously derivable from the application as filed, which is in fact the "gold standard" with respect to added subject-matter.

1.8 Therefore, in the context of the opposed patent, the omission of the feature "in the form of human delicatessen food" from the wording of claim 1 adds subject-matter. In view of this, there is no need to discuss whether the omission of the feature "having increased consumer appeal" also adds subject-matter.

1.9 Thus, the ground of Article 100(c) EPC prejudices the maintenance of the patent as granted.

2. *First to fourth auxiliary requests*

2.1 Claim 1 of the first to fourth auxiliary requests is based, like granted claim 1, *inter alia*, on claims 16 and 24 of the application as filed. In claim 1 of each of these requests, the feature "in the form of human delicatessen food" has been omitted.

2.2 Thus, the ground of Article 100(c) EPC still prejudices the maintenance of the patent based on the first to fourth auxiliary request.

3. *Fifth auxiliary requests*

3.1 The subject-matter of claim 1 of the fifth auxiliary request introduces the omitted features "having increased consumer appeal" and "in the form of human delicatessen food" and is thus based on claims 16 and 24 of the application as filed.

3.2 These two features were not present in the claims as granted. Therefore, it may be examined whether the insertion of these features into claim 1 introduces non-compliance with Article 84 EPC.

3.3 As mentioned above in the context of the main request (point 1.4, second paragraph), the feature "in the form of human delicatessen food" does not have a clearly defined meaning. The board is not aware of a commonly accepted meaning of this feature and the opposed patent merely provides examples of what is encompassed. Even the respondent did not contest at the oral proceedings that only an ambiguous meaning could be attached to this feature now delimiting the scope of claim 1.

3.4 Thus, for this reason alone, amended claim 1 does not comply with the requirements of Article 84 EPC.

4. *Admissibility of E1 and D33*

In view of the fact that none of the claim requests of the respondent is allowable, there is not need for the board to decide on the admissibility of E1 and D33.

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:



M. Cañueto Carbajo

W. Sieber

Decision electronically authenticated