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**Datasheet for the decision  
of 31 July 2018**

**Case Number:** T 1808/16 - 3.3.09

**Application Number:** 03717271.5

**Publication Number:** 1492413

**IPC:** A23K1/165, A23K1/16, A23K1/18

**Language of the proceedings:** EN

**Title of invention:**  
Method and dietary composition for improving lipid  
digestibility

**Patent Proprietor:**  
Nestec S.A.

**Opponent:**  
Hill's Pet Nutrition, Inc.

**Headword:**

**Relevant legal provisions:**  
EPC Art. 100 (c), 111 (1)

**Keyword:**

New main request: Amendments - extension beyond the content of  
the application as filed (no)

Remittal: yes

**Decisions cited:**

T 0615/95

**Catchword:**



**Beschwerdekammern**

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Case Number: T 1808/16 - 3.3.09

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.09**  
**of 31 July 2018**

**Appellant:** Nestec S.A.  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 2 June 2016  
revoking European patent No. 1492413 pursuant to  
Article 101(2) and 101(3) (b) EPC**

**Composition of the Board:**

**Chairman** W. Sieber  
**Members:** J. Jardón Álvarez  
D. Prietzel-Funk

## Summary of Facts and Submissions

- I. This decision concerns the appeal filed by the proprietor of European patent No. 1 492 413 against the opposition division's decision to revoke it.
- II. The granted patent contained 16 claims, independent claims 1 and 9 reading as follows:

"1. Dietary component comprising a pancreatic function promoter, a liver function-promoter and an intestinal mucosa function-promoter for use in a nutrition management regimen for maintaining, improving, promoting or otherwise enhancing lipid digestibility by feeding it regularly in an effective lipid assimilation-promoting amount, according to predetermined directions, to a pet animal,

wherein the pancreatic function-promoter is selected from a lipase, a gut pH modifier or a pancreatic extract, the gut pH modifier including one or more of an acidifier, an alkanizer, or a buffer,

wherein the liver function-promoter is selected from taurine, emulsifiers, vitamins, minerals, glutathione and glutathione promoters, and combinations thereof, the taurine being taurine derived from a purified source or a mixture of a purified and a natural source, and

wherein the intestinal mucosa function-promoter is selected from a fat transportation aid, agent or carrier, selected from whey protein or a protease, and/or an anti-inflammatory agent."

"9. Edible composition comprising a pancreatic function-promoter, a liver function-promoter and an intestinal mucosa function-promoter for use as part of, or in addition to a pet's regular diet, in providing said pet with a benefit relating to effective assimilation of a lipid or a lipid fraction,

wherein the pancreatic function-promoter is selected from a lipase, a gut pH modifier or a pancreatic extract, the gut pH modifier including one or more of an acidifier, an alkalinizer, or a buffer,

wherein the liver function-promoter is selected from taurine, emulsifiers, vitamins, minerals, glutathione and glutathione promoters, and combinations thereof, the taurine being taurine derived from a purified source or a mixture of a purified and a natural source, and

wherein the intestinal mucosa function-promoter is selected from a fat transportation aid, agent or carrier, selected from whey protein or a protease, and/or an anti-inflammatory agent."

The remaining claims were dependent claims.

- III. The opponent had requested revocation of the patent in its entirety on the grounds of Article 100(a) (lack of novelty and lack of inventive step), (b) and (c) EPC.
- IV. The opposition division's decision was based on a main request (claims as granted), auxiliary requests 1 to 5 as filed by letter of 3 March 2016 and auxiliary requests 6 and 7 as filed during the oral proceedings. The opposition division revoked the patent because in its view the subject-matter of claim 1 of all requests

extended beyond the content of the application as filed (cf. Article 100(c) EPC).

- According to the opposition division, the definition of the pancreatic, liver and mucosa function-promoters in claim 1 as granted was based on originally disclosed lists from which some elements had been deleted. Deletions made from more than one list were normally not allowable and resulted in a combination of features which was not supported by the application as filed.

Furthermore, the omission of the original limitation that the proteases (used as a mucosa function-promoter) had "the capacity to promote formation of lipoproteins" resulted in an unallowable broadening of the claim.

- The same or similar arguments applied to claims 1 of all auxiliary requests, i.e. they contained new combinations leading to added subject-matter.
- The opposition division did not deal with any other patentability issue.

V. This decision was appealed by the patent proprietor (in the following: the appellant). With the statement setting out its grounds of appeal it requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or on the basis of the claims according to auxiliary requests 1 to 7, re-submitted therein.

VI. In a communication dated 5 February 2018, the board indicated the issues to be discussed during the oral proceedings. It also indicated that if any of the

requests were to be seen as fulfilling the requirements of Article 123(2), and Article 84 EPC where applicable, remittal of the case to the opposition division for further prosecution appeared to be appropriate, as no other patentability issues had been dealt with in the appealed decision.

- VII. By letter of 19 March 2018 the appellant filed further arguments in support of its case and a further request, auxiliary request 8.
- VIII. The opponent (respondent) did not file any submissions or requests during the appeal proceedings.
- IX. On 31 July 2018, oral proceedings took place before the board in the absence of the duly summoned respondent. After a discussion on added subject-matter, the appellant filed a new main request headed "Claims (New MR)" to replace its previous main request. It requested that the decision under appeal be set aside and that the case be remitted to the opposition division for further prosecution on the basis of claims 1 to 11 of this new main request or on the basis of the set of claims of any of previously filed auxiliary requests 1 to 8.

Independent claims 1 and 4 of the new main request were based on granted claims 1 and 9 and read as follows (amendments to granted claims 1 and 9 in strikethrough):

"1. Dietary component comprising a pancreatic function promoter, a liver function-promoter and an intestinal mucosa function-promoter for use in a nutrition management regimen for maintaining, improving, promoting or otherwise enhancing lipid digestibility by

feeding it regularly in an effective lipid assimilation-promoting amount, according to predetermined directions, to a pet animal,

wherein the pancreatic function-promoter is selected from a lipase, a gut pH modifier or a pancreatic extract, the gut pH modifier including one or more of an acidifier, an alkanizer, or a buffer,

wherein the liver function-promoter is selected from taurine, emulsifiers, vitamins, minerals, glutathione and glutathione promoters, and combinations thereof, the taurine being taurine derived from a purified source or a mixture of a purified and a natural source, and

wherein the intestinal mucosa function-promoter is selected from ~~a fat transportation aid, agent or carrier, selected from whey protein or a protease, and/or an anti-inflammatory agent.~~"

"4. Edible composition comprising a pancreatic function-promoter, a liver function-promoter and an intestinal mucosa function-promoter for use as part of, or in addition to a pet's regular diet, in providing said pet with a benefit relating to effective assimilation of a lipid or a lipid fraction,

wherein the pancreatic function-promoter is selected from a lipase, a gut pH modifier or a pancreatic extract, the gut pH modifier including one or more of an acidifier, an alkanizer, or a buffer,

wherein the liver function-promoter is selected from taurine, emulsifiers, vitamins, minerals, glutathione and glutathione promoters, and combinations thereof,



the taurine being taurine derived from a purified source or a mixture of a purified and a natural source, and

wherein the intestinal mucosa function-promoter is selected from ~~a fat transportation aid, agent or carrier, selected from whey protein or a protease, and/or an anti-inflammatory agent.~~"

The remaining claims are dependent claims.

X. The appellant's arguments where relevant for the present decision may be summarised as follows:

- Claim 1 of the new main request was based on the application as filed. It resulted from the combination of claims 11 to 14 and 18 as filed, wherein some of the alternatives for the pancreatic, liver and intestinal mucosa function-promoters had been deleted.
- According to established Board of Appeal case law, the shrinking of a group was allowable when it did not result in singling out a particular combination. The subject-matter of claim 1 was based on the claims indicated above, with some qualitatively equal elements deleted from the lists defining the three function-promoters.
- The deletion of these elements did not lead to a particular combination or a specific composition not disclosed in the application as filed.

## Reasons for the Decision

### NEW MAIN REQUEST

#### 1. *Amendments (Article 100(c) EPC)*

1.1 Claim 1 of the new main request is based on claim 11 as filed, which was directed to "**a nutrition management regimen** for ... **comprises** [*comprising*] **a dietary component** for ..., the dietary component comprising a pancreatic function-promoter, a liver function-promoter and an intestinal mucose function-promoter." (emphasis added by the board)

1.2 The board sees no problem in the rewording of the claim to a "**dietary component** comprising a pancreatic function-promoter, a liver function-promoter and an intestinal mucose function-promoter **for use in a nutrition management regimen** for ..." (emphasis added by the board). This is implicit from claim 11 as filed and was also not objected to in the decision under appeal.

1.3 In addition, the pancreatic function-promoter, the liver function-promoter and the intestinal mucosa function-promoter are further defined, namely:

- the pancreatic function-promoter is selected from a lipase, a gut pH modifier or a pancreatic extract, the gut pH modifier including one or more of an acidifier, an alkaliniser or a buffer, based on the disclosure of claims 12 and 13 as filed;
- the liver function-promoter is selected from taurine, emulsifiers, vitamins, minerals, glutathione and glutathione promoters, and

combinations thereof, the taurine being taurine derived from a purified source or a mixture of a purified and a natural source, based on the disclosure of claim 14 as filed and page 10, line 35 (further specification of the taurine); and

- the intestinal mucosa function-promoter is defined as being selected from an anti-inflammatory agent as disclosed on page 12, lines 9 to 10, of the application as filed.

1.4 When comparing the relevant disclosure of the application as filed with claim 1, it is apparent that not all the alternatives of the three function-promoters have been incorporated into claim 1, the following alternatives having been omitted:

- a prebiotic or probiotic micro-organism as a gut pH modifier being itself an alternative for the pancreatic function-promoter;
- natural taurine as an alternative for the liver function-promoter; and
- the fat transportation aid, agent or carrier as alternatives for the intestinal mucosa function-promoter.

1.5 The board disagrees with the opposition division that the deletion of some elements from lists is in principle not allowable.

1.5.1 As pointed out by the appellant, the guiding principle in the case law of the boards of appeal is that the deletion of specific meanings in several lists of possibilities is not objectionable under Article 123(2)

EPC as long as this does not result in singling out a particular combination of specific meanings, i.e. any hitherto not specifically mentioned individual compound or group of compounds (for instance, T 0615/95, Reasons 6).

- 1.5.2 Thus, in the present case two alternatives of the gut pH modifier out of the five disclosed in claim 13 as filed have been deleted. In this context, it should be noted that the gut pH modifier itself is one of three possibilities which can be used as pancreatic function-promoter. Thus, essentially the same level of generality is maintained as in the application as filed for the pancreatic function-promoter.

A similar situation occurs with the specification of the liver function-promoter, which still has to be selected from taurine, emulsifiers, vitamins, minerals, glutathione and glutathione promoters, and combinations thereof. Only the possibility that taurine may be natural has been deleted from the three alternative options disclosed on page 10, line 35, of the application as filed for taurine.

- 1.5.3 With regard to the restriction of the intestinal mucosa function-promoter to the use of an anti-inflammatory agent by deleting the use of a fat transportation aid, agent or carrier, the board considers that this restriction again does not single out any individual compound. The person skilled in the art is well aware that anti-inflammatory agents cover a broad range of compounds. This is confirmed by the passage on page 12 of the application as filed which mentions omega-3 fatty acids, lactoferrin, prebiotics and probiotics as examples of anti-inflammatory agents. But even if the selection of the anti-inflammatory agents were deemed

to constitute the singling out of a group of compounds, the application as filed at least hints towards this group. Thus, page 12 identifies this group explicitly as one alternative intestinal mucosa function-promoter, and both examples use as an intestinal mucosa function-promoter a compound identified in the passage on page 12 as being an anti-inflammatory agent, namely fish oil (example 1), which contains omega-3 fatty acid, and chicory (example 2), which is a prebiotic.

- 1.5.4 In summary, the definition of the three function-promoters in claim 1 does not lead to an unallowable singling out of a particular compound or group of compounds. Consequently, the combination of the three function-promoters likewise does not result in added subject-matter. The amendments merely result in the remaining subject-matter still being a generic group of alternatives differing from the original group only by its smaller size.
- 1.5.5 As to the opposition division's objection that the proteases were no longer limited to those having the capacity to promote the formation of lipoproteins, this objection does not apply to the claims now under consideration. The use of a protease as intestinal mucosa function-promoter is no longer claimed.
- 1.6 For these reasons, claim 1 of the new main request does not contain subject-matter which extends beyond the content of the application as filed.
- 1.7 The above reasoning applies in a similar manner to the subject-matter of independent claim 4 which, starting from claim 1 as filed, has been amended in the same way as granted claim 1.

1.8 The dependent claims also find support in the application as filed as follows:

- Claims 2 and 3 are respectively based on claims 15 and 19 as filed; and
- Claims 5 to 10 are based on claims 5 to 10 as filed, and claim 11 is based on the disclosure on page 6, lines 21 to 31.

1.9 The amendments made to the granted claims, namely the deletion of some meanings for the intestinal mucosa function-promoter and the deletion of some dependent claims, clearly restrict the scope of the granted claims. Hence, the amendments also fulfil the requirements of Article 123(3) EPC.

2. *Remittal - Article 111 EPC*

Added matter was the only reason for revoking the patent. The other grounds for opposition raised under Article 100(a) and (b) EPC were not dealt with in the appealed decision. Also taking into account that the appellant requested remittal, the board considers it appropriate to exercise its discretion under Article 111(1) EPC and remit the case to the opposition division for further prosecution on the basis of claims 1 to 11 of the new main request filed on 31 July 2018 during the oral proceedings before the board.

AUXILIARY REQUESTS 1 to 8

3. As the case is to be remitted to the opposition division for further prosecution, there is no need for the board to deal with these 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 for further prosecution on the basis of claims 1 to 11 filed as new main request on 31 July 2018 during the oral proceedings before the board.

The Registrar:

The Chairman:



M. Cañueto Carbajo

W. Sieber

Decision electronically authenticated