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**Datasheet for the decision
of 20 November 2024**

Case Number: T 0690/23 - 3.3.09

Application Number: 12710375.2

Publication Number: 2825058

IPC: A23C9/142, A23C9/15, A23J1/20,
A23L33/00, A23L33/19

Language of the proceedings: EN

Title of invention:
PROCESS FOR THE HUMANIZATION OF ANIMAL SKIM MILK AND PRODUCTS
OBTAINED THEREBY

Patent Proprietor:
N.V. Nutricia

Opponent:
Arla Foods Amba

Headword:
Humanisation of animal skim milk/NUTRICIA

Relevant legal provisions:
EPC Art. 100(a), 56

Keyword:

Objections against request withdrawn by opponent - review of
decision under appeal
Inventive step - (yes)

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 0690/23 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 20 November 2024

Appellant: N.V. Nutricia
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Appellant: Arla Foods Amba
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
28 February 2023 concerning maintenance of the
European Patent No. 2825058 in amended form.**

Composition of the Board:

Chairman A. Haderlein
Members: M. Ansorge
A. Jimenez

Summary of Facts and Submissions

- I. The proprietor and the opponent both lodged appeals against the opposition division's interlocutory decision holding the then auxiliary request 11 allowable.
- II. With its notice of opposition, the opponent had requested that the patent be revoked on the grounds for opposition of lack of novelty and lack of inventive step under Article 100(a) EPC.
- III. The opposition division decided, *inter alia*, that the subject-matter of process claim 1 of the then auxiliary request 10, covering the two alternatives 1A and 1B, was novel over D1. Alternative 1A in claim 1 of the then auxiliary request 10 was considered to involve an inventive step in view of D1 as the closest prior art, but alternative 1B in said claim was considered not to involve an inventive step in view of D1 as the closest prior art.
- IV. With its statement setting out the grounds of appeal, the proprietor pursued the patent as granted as the main request, followed by auxiliary requests 1 to 20, filed with the statement setting out the grounds of appeal.
- V. The opponent requested in its statement setting out the grounds of appeal that the decision be set aside and that the patent be revoked.
- VI. In its communication pursuant to Article 15(1) RPBA, the board concluded that the main request and auxiliary requests 1 to 5 did not appear to be allowable (since

product-by-process claim 10 of the main request and auxiliary requests 1 to 5 was not novel and not inventive over D1), but auxiliary request 6 (which corresponds to the then auxiliary request 10 before the opposition division, which was renumbered during the oral proceedings before the opposition division, and auxiliary request 9 filed on 12 December 2022) seemed to be allowable, since the subject-matter of process claim 1 of said request involved an inventive step in view of D1 as the closest prior art.

VII. By letter of 11 September 2024, the proprietor withdrew its main request and auxiliary requests 1 to 5 on the condition that the opponent would withdraw all objections against auxiliary request 6. It also withdrew its request for oral proceedings on the condition that auxiliary request 6 would be considered allowable.

VIII. By letter of 11 November 2024 the opponent withdrew its objections against auxiliary request 6 on the condition that the proprietor would make auxiliary request 6 the main request.

IX. The oral proceedings were cancelled.

X. Claim 1 of auxiliary request 6 (which is identical to claim 1 of the then auxiliary request 10 before the opposition division and auxiliary request 9 filed on 12 December 2022) reads as follows:

"Process for the preparation of an infant formula base product, comprising:

(a) a micro filtration step (MF2) of animal skim milk over a ceramic membrane having a porosity of 0.10 -

0.30 micrometer or over a spiral wound organic membrane having a porosity of 0.10 - 0.35 micrometer, resulting in a retentate (MFR2) and a permeate (MFP2);

(b) an ultrafiltration step (UF) of a liquid composition originating from the MFP2 over a membrane having a molecular weight cut-off of at most 25 kDa, resulting in a retentate (UFR) and a permeate (UFP);

(c) mixing a composition originating from the MFR2 and a composition originating from the UFR, whereby a composition having a casein/whey protein weight ratio of 30/70 - 50/50 is obtained,

wherein the micro filtration operates with a volume concentration factor of 4 - 8 and the ultrafiltration operates with a volume concentration factor of 3 - 7;

and/or

wherein the MFR2 obtained in step (a) comprises at most 15 wt% whey protein based on total protein and at least 55 wt% casein based on dry weight, the MFP2 obtained in step (a) comprises at most 1.0 wt% casein based on total dry weight, and the UFR obtained in step (b) comprises 22 - 33 wt% whey proteins based on total dry weight and a phosphorus/protein weight ratio between 1/40 and 1/100."

Claims 2 to 9 are dependent process claims.

XI. The following document was cited in the case in hand:

D1: NZ 511562 A

XII. The parties' relevant arguments submitted during the written proceedings are reflected in the reasons for the decision below.

XIII. Requests

The proprietor requested that the decision be set aside and that the patent be maintained on the basis of auxiliary requests 6 as its main request and, alternatively, on the basis of auxiliary requests 7 to 20, all filed with the statement setting out the grounds of appeal.

The opponent requested that the decision be set aside and did not object to the patent being maintained on the basis of auxiliary request 6.

Reasons for the Decision

AUXILIARY REQUEST 6

1. The opponent withdrew all of its objections against auxiliary request 6. While the board is not bound by such a withdrawal, the board does not see any reason to examine them *ex officio* in the present decision. In the following, the opposition division's conclusions on this claim request are dealt with.

2. The claimed subject-matter

Claim 1 of auxiliary request 6 (which is identical to claim 1 of the then auxiliary request 10 before the opposition division) covers the following two alternatives 1A and 1B:

- Alternative 1A, in which the ultrafiltration operates with a volume concentration factor (VCF) of 3-7; and
- Alternative 1B, in which the MFR2 obtained in step (a) comprises at most 15 wt% whey protein based on total protein and at least 55 wt% casein based on dry weight, the MFP2 obtained in step (a) comprises at most 1.0 wt% casein based on total dry weight, and the UFR obtained in step (b) comprises 22 - 33 wt% whey proteins based on total dry weight and a phosphorus/protein weight ratio between 1/40 and 1/100.

3. Amendments and novelty

The opposition division found that the requirements of Article 123(2) EPC and novelty are met for this claim request (see points 13.1 and 13.2 of the impugned decision). The board does not see any reason to deviate from these findings.

4. Inventive step

4.1 The opposition division decided that alternative 1A in claim 1 involved an inventive step in view of D1 as the closest prior art, but alternative 1B in said claim was considered not to involve an inventive step in view of D1 as the closest prior art.

4.2 The board agrees with the opposition division's conclusion that alternative 1A in claim 1 involves an inventive step in view of D1 as the closest prior art (see points 13.3.1 to 13.3.6 of the opposition division's ruling on alternative 1A in claim 1 of the then auxiliary request 10 of the decision).

- 4.3 With respect to the question of inventive step of alternative 1B in claim 1 in view of D1 as the closest prior art, the board makes the following comments.
- 4.3.1 The board shares the opposition division's conclusion that, as far as alternative 1B is concerned, the process in claim 1 differs from D1 in that "the ultrafiltration retentate (UFR) comprises 22-33 wt% whey proteins based on total dry weight and a phosphorus/protein weight ratio between 1/40 and 1/100, and the microfiltration retentate (MFR2) comprises at most 15 wt% whey protein based on total protein and at least 55 wt% casein based on dry weight of the MFR2, and the microfiltration permeate (MFP2) comprises at most 1.0 wt% casein" (see point 13.3.2, item (ii), of the decision).
- 4.3.2 Even when considering that the objective technical problem was to provide an alternative process, as outlined below, the board concludes that alternative 1B in claim 1 also involves an inventive step over D1 as the closest prior art.
- 4.3.3 The opposition division considered the distinguishing features of alternative 1B to be *desiderata*, i.e. to obtain a microfiltration retentate and permeate comprising a particular amount of casein and whey protein, as well as an ultrafiltration retentate comprising a particular amount of whey protein and having a particular phosphorus/protein weight ratio. It further considered that, in the absence of the feature "the ultrafiltration operates with a volume concentration factor of 3-7", which in its view represented an essential feature of the invention, the objective technical problem was not solved for

alternative 1B. For this reason alone, the opposition division concluded that alternative 1B was an obvious alternative to the processes disclosed in document D1. No further reasoning with respect to the issue of obviousness was provided in the decision.

- 4.3.4 The board does not agree with this reasoning. While it might be the case that, for achieving the features of alternative 1B, it is essential to operate the ultrafiltration with a volume concentration factor of 3-7, not mentioning this possibly essential feature in claim 1 cannot lead to the automatic conclusion that achieving the distinguishing features of alternative 1B is obvious. Instead, the question to be answered is whether and how a skilled person starting from D1 as the closest prior art would arrive at the claimed subject-matter without exercising inventive skill.
- 4.3.5 The opposition division's decision does not explain what measures are necessary to arrive at the claimed subject-matter in an obvious manner. The opponent's assertion, made prior to withdrawing its objections against the present claim request, that the process claim did not contain sufficient details of how to operate the process steps in order to unambiguously lead to the desired intermediate products as well as the desired final infant formula base product does not explain why the claimed subject-matter might be obvious in view of the prior art. At best, this is an argument directed to the question of clarity or the breadth of claim 1, but not a reason why it might be obvious for a skilled person to contemplate the distinguishing features, i.e. the features of alternative 1B.

4.3.6 In addition, no document was cited by the opponent or the opposition division which could have suggested the distinguishing features in question.

To the board, D1 gives no prompting or indication of how to obtain the features of alternative 1B when applying the respective process steps taught in D1. The common general knowledge is not suitable for providing such teaching, either.

In view of the above, not only alternative 1A in claim 1, as concluded by the opposition division, but also alternative 1B in claim 1 involves an inventive step in view of D1 as the closest prior art. The same applies to the dependent claims.

Therefore, auxiliary request 6 is allowable.

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 with the order to maintain the patent with the following claims and a description to be adapted to them:

Claims:

No. 1 to 9 according to auxiliary request 6 filed on 10 July 2023 with the patent proprietor's statement of grounds of appeal.

The Registrar:

The Chairman:



K. Götz-Wein

A. Haderlein

Decision electronically authenticated