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For Creativity and Innovation

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PATENTS ACT 1977

APPLICANT Mars UK Limited

ISSUE Whether patent application number GB 0329453.5 complies with sections 1(1)(a) and 14(5)(b)

HEARING OFFICER C L Davies

DECISION

Introduction

1 Patent application number GB 0329453.5 entitled "Foodstuff Profile" was filed on 19th December 2003, claiming priority from four GB applications. A search report was issued on 25th May 2004 and the application published on 28th July 2004.

2 In the first section 18(3) examination report issued on 27th September 2005, the examiner objected that the original claims lacked novelty and clarity. The agent responded with arguments to support novelty of the claims and filed no amendments to the claims. In view of the agent's arguments, the examiner maintained her novelty and clarity objections in several further S18(3) reports, to which the agent responded with further arguments to support the applicant's original claims. In a letter of 30th May 2007, the agent requested a hearing.

3 In a letter of 26th June 2007, the examiner summarised the outstanding issues to be addressed at the hearing, to which the agent responded in a letter of 5th July 2007, with two amended claim sets entitled "Main Request Claims" and "Auxiliary Request Claims", requesting that a patent be granted in respect of the "Main Request Claims". In a letter dated 12th July 2007, the examiner re-asserted novelty objections pointing, out the most relevant citations and stating that they were relevant to both sets of claims filed with the agent's letter of 5th July 2007. The examiner also re-asserted her clarity objections. The agent responded in a further letter of 13thJuly 2007, filing a further set of amended claims which were referred to as the "2nd Auxiliary Request Claims", and requested that should the claims filed with the agent's letter of 5th July 2007 be rejected that they be given an opportunity to discuss the claims of either of the auxiliary requests. In an e-mail to the agent, the examiner acknowledged the applicant's response and

confirmed that the outstanding clarity and novelty objections would be discussed at the hearing.

4 A hearing was held before me on 25th July 2007, attended by Dr Alison Care of Kilburn & Strode, Mr. Andrew Miller of Mars UK Limited and Mrs. Kathryn Orme, case examiner.

The application

5 The application purports to relate to a method of ensuring long term acceptance of a foodstuff to a cat, by feeding the cat with a foodstuff which has specific macronutrient content parameters, the macronutrients in question being protein, fat and carbohydrate. The applicant has found that when given the opportunity to do so e.g. by providing foods of different macronutrient contents, feline animals will select between these foods so as to regulate their consumption of each macronutrient in order to reach an optimum ratio. This invention purportedly demonstrates the assumption that acceptability of a food and preference for one food over another being primarily driven by the taste and texture of the food is not the case.

The hearing

6 At the outset, the agent clarified that the applicant intended to proceed with the 2nd Auxiliary Request Claims set and that it was the applicant's intention to set aside the Main Request Claims and the 1st Auxiliary Request Claims.

7 The hearing proceeded therefore on the basis of the 2nd Auxiliary Request Claims and my decision is based on this set of claims.

The claims

8 The "2nd Auxiliary Request Claims" set contained 10 claims, having two independent claims, namely 1 & 6 plus an omnibus claim. Claim 1 reads as follows:

"1. A foodstuff having a protein energy ratio of from 40 to 60%, a carbohydrate energy ratio of 25% or less and a fat energy ratio of from 15 to 60%, wherein the energy ratios are based on the total energy content of the foodstuff, when used in a method of increasing the acceptance and enjoyment of a foodstuff to a cat."

Claim 6 reads as follows:

"6. Use of a source of fat, protein and carbohydrate, in the manufacture of a foodstuff having a protein energy ratio of from 40 to 60%, a carbohydrate energy ratio of 25% or less and a fat energy ratio of from 15 to 60%, wherein the energy ratios are based on the total energy content of the foodstuff, to ensure the increased acceptance and enjoyment of a foodstuff to a cat."

Issues to be decided

9 On the basis of the 2nd Auxiliary Request Claim set, the issues discussed at the hearing were clarity (section 14(5)(b)) and novelty (section 1(1)(a)).

The law

10 The relevant provisions are sections 1(1), 2(6), 14(5) and 18(3):

> *1.-(1) A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say -*
>
> *(a) the invention is new;*
> *(b) ...*
> *(c) …*
> *(d) …*
>
> *2(6) In the case of an invention consisting of a substance or composition for use in a method of treatment of the human or animal body by surgery or therapy or of diagnosis practiced on the human or animal body, the fact that the substance or composition forms part of the state of the art shall not prevent the invention from being taken to be new if the use of the substance or composition in any such method does not form part of the state of the art.*
>
> *14(5) The claim or claims shall -*
>
> *(a) define the matter for which the applicant seeks protection;*
> *(b) be clear and concise;*
> *(c) …*
> *(d) …*
>
> *18(3) If the examiner reports that any of those requirements are not complied with, the comptroller shall give the applicant an opportunity within a specified period to make observations on the report and to amend the application so as to comply with those requirements…, and is the applicant fails to satisfy the comptroller that those requirements are complied with, or to amend the application so as to comply with them, the comptroller may refuse the application.*

Arguments and analysis

Claim construction

11 In respect of original claim 1, which reads "A method of ensuring the long term acceptance of a foodstuff to a cat, the method comprising feeding to said cat a foodstuff …..", the examiner, in her pre-hearing report, had considered that the person skilled in the art would understand the term "acceptance" to mean that *"the cat is willing to eat the foodstuff when the cat is hungry to a usual degree. That is, if their usual food is replaced by the foodstuff of claim 1, then the cat will eat some of it"*.

12 Prior to the hearing, the applicant filed amendments to the claims, as indicated in paragraph 3 and claim 1 now under consideration reads "A foodstuff ….. when used in a method of increasing the acceptance and enjoyment of a foodstuff to a cat." The examiner, because of the pending hearing, did not construe the meaning of this claim, in particular, the meaning of enjoyment.

13 At the hearing, the agent disagreed with the examiner's interpretation of "acceptance", stating that *"acceptance is not just eating some of the food because the cat will always eat some of the food to try it, just to determine whether it likes it or not. So it is whether it actually eats it both to meet its nutritional requirements and whether it enjoys it, and whether it eats it the next day. And the enjoyment is included as part of acceptance, but it is also in the*

claim."

14 The agent referred me to page 5 line 25, to page 6 line 5 of the description, where the applicant has defined what acceptance and enjoyment means, and how the cat will react. This passage from the description reads:

The enjoyment of the animal and/or increase in acceptance/palatability can be determined, for example, by one or more of the following:-

- *an increase in the quantity of foods consumes;[sic]*
- *a decrease in the frequency of refusals to eat over an extended period of time;*
- *an increase in enthusiasm during the meal as indicated by a reduction in the time taken to start a meal and/or increase in the speed at which food is consumed;*
- *the animal chooses the food over another food;*
- *the animal refuses other foods;*

or by any other behaviour by a pet animal which is taken by the owner/carer to be an indication of enjoyment of the food, for example:-

- *the animal rubs around the owner/carer when serving the food;*
- *the animal is inactive/rests or sleeps after eating;*
- *the animal licks itself or washes after eating.*

15 The agent further stated that *"when the specification as a whole is read and the claims are read, then this is how the term acceptance and enjoyment is interpreted … it isn't just the fact that the cat will eat some of the food."*

16 The agent asserted that the terminology "when used in", is "limiting that foodstuff to only when it is used in that method", further adding that the applicant is not trying to claim the foodstuff on its own, it is only when it is used for the purpose of increasing the acceptance and enjoyment of the foodstuff.

17 I asked Mr. Miller whether the term "acceptance" was a common term in the field, to which he replied positively, pointing out the way it has been described in the specification. He indicated that refusal and increased intake are absolute in that the industry uses these as palatability bench marks.

18 I also asked Mr. Miller about the term "enjoyment", to which he said that *"… it was probably broader in terms of its definition, so people will have their own definitions of "enjoyment". But maybe we have quite clearly defined what we believe to be "enjoyment" for a cat."*

19 Mr. Miller added further that "acceptance" and "enjoyment" are measurable. He indicated that even naïve owners, can be asked the question "does your cat enjoy this food more than that food?" and they would be able to give us a measurable difference between foods.

20 Having listened to the agent's/applicant's observations/arguments and in addition, the comments made by the examiner both during the hearing and through correspondence on this case, it remains for me to construe claims 1 and 6.

21 The foodstuff *per se* defined in claims 1 and 6 is clearly defined and not in dispute.

Claim 1:

22 Regarding the terminology "when used in", I am satisfied that this is limiting the foodstuff to when used in a particular method. It remains therefore, for me to construe what is meant by "a method of increasing the acceptance and enjoyment of a foodstuff to a cat".

23 The approach to be adopted in construing claims is as set out by the House of Lords in its decision in *Kirin-Amgen Inc v Hoeschst Marion Roussel Ltd* [2005] RPC 9 where it was stated at page 186:

"The question is always what the person skilled in the art would have understood the patentee to be using the language of the claim to mean".

24 The skilled person, in my opinion, would be a cat owner, a cat breeder, a cat nutritionist.

25 At first instance and in its most simplistic interpretation, a skilled person may recognise this claim as being to no more than "feeding a cat a specific foodstuff." For example, owners would offer foodstuff to their cats with the expectation that their cat would eat (and therefore show acceptance) of the foodstuff and because of this, the owner would conclude that the cat must have enjoyed the foodstuff because it has eaten it. The claim would therefore appear to be seeking to monopolise feeding a specific foodstuff to a cat. I will now look at this claim in more detail.

26 Regarding acceptance, I have re-considered the examiner's interpretation in light of the agent's comments and I am inclined to accept in part, the agent's interpretation insofar as "acceptance" is not just eating some of the food, but in my opinion, the skilled person would interpret this as meaning the cat will eat the majority of the food and will also eat the same food when offered at it's next meal time. I am inclined to recognise Mr. Miller's reference to "acceptance" as being a term having a specific meaning in the industry and that this term, when referring to a cat's increased intake and refusal, can be used to reliably determine the cat's acceptance of the foodstuff. I consider therefore that the behaviours detailed at page 2 line 27 to page 3 line 5 are acceptance "indicators". To this end, I consider "acceptance" to be clear i.e. determinable and measurable.

27 Regarding "enjoyment" however, this is where I believe the skilled person would start to struggle in assigning a precise and reliable meaning to this term and therefore the scope of the claim.

28 In my opinion, the skilled person would recognise the applicant's definitions for

"enjoyment", in particular those detailed on page 3 lines 7-12, as being typical "behaviours" or "traits" of a cat, which such a person would expect a cat to display when the cat is feeling contented/happy, and possibly but not necessarily, with its food.

29 These "behaviours" of the cat, in my opinion, are subjective, since they depend upon how the skilled person may interpret them in respect of their cat (or a particular cat) and also, how the cat may be feeling at a particular point in time. For example, a cat may be perfectly content with the foodstuff it has just eaten (including a foodstuff having the same macronutrient content as defined in the claim), but may not display any of the so-called enjoyment behaviours indicated in the specification. How will the skilled person gauge the cat's level of enjoyment in this instance and how reliable therefore will this be in determining a method of increasing the acceptance and enjoyment of a foodstuff to a cat? In another scenario, the cat may be very hungry e.g. following a stint of exercise or a prolonged period without food, at which point, it will be contented to eat whatever is offered (including a foodstuff having the same macronutrient content as defined in the claim). How will the skilled person interpret this, since the cat's behaviour here, need not necessarily be a reliable indication of whether the cat has enjoyed the food. Again, how reliable is this as a measure to be used in determining a method of increasing the acceptance and enjoyment of a foodstuff to a cat?

30 In my opinion therefore, I believe the definitions for measuring enjoyment (as given in the specification) are purely subjective and cannot possibly be reliable to the extent necessary to establish with preciseness, the scope of a patent claim. I refer to the comments made by Mr. Miller in respect of "enjoyment", in paragraph 17 above.

31 I will briefly consider the word "increasing". What does this mean? In my opinion, a skilled person would interpret this to mean that some sort of comparison would need to be made regarding a cat's acceptance and enjoyment of a foodstuff which is not in accordance with the invention such as a baseline diet (e.g. it's current foodstuff), with a diet that is in accordance with the invention. Presumably, the skilled person would need to gauge the cat's behaviour in respect of the two diets, ie, it's "acceptance and enjoyment" of the different foodstuffs, which again is subjective and not precise. In my opinion, this term is unclear in scope.

32 Drawing the above points together, it is my opinion that a skilled person would be unable to reliably construe the method, simply because it is reliant upon the cat owner's, breeder's, nutritionist's view of how they gauge the cat's behaviour towards the food and also, how the cat itself feels about the food it is eating. Whilst I might be prepared to consider the term "acceptance" as being determinable, I do not consider the term "enjoyment" capable of being reliably determinable: I consider it to have no precise meaning. Following on from this, I find that I am unable to reliably construe claim 1 and that the precise scope of this claim is indeterminable.

33 There would appear to be however, an alternative way to consider claim 1 and this involves considering how in practical terms a third party would know if they

were trespassing on the scope of the claim: the fact that the claim is proving difficult to construe means this would not be easy.

34 In respect of original claim 1, the examiner pointed out a comment from *Electrical and Musical Industries Ltd v Lissen Ltd 56 RPC 23*: that "the function of the claims is to define clearly and with precision the monopoly claimed so that others may know the exact boundaries of the area within which they will be trespassers".

35 I consider that it would still not be clear to a third party what the method of claim 1 constitutes and therefore a third party would not know what they could or could not do if the patent were granted.

36 In my opinion, there are only limited circumstances when a third party could be confident of performing the method of the invention, where for example they wanted to do the method with a range of other cat food compositions not according to the present invention.

37 One such circumstance would be when a foodstuff is given to a starving cat: such a cat would be expected to show its acceptance and enjoyment of the foodstuff in many of the ways defined in the specification as being indicative of acceptance and enjoyment.

38 Furthermore, I would expect a starving cat to always do the method of the invention insofar as it would react positively to any food within reason. In the case of a starving cat therefore, the method would cease to characterise the invention so that the only way a third party could be confident of determining if they were or were not infringing the present claims would be by having regard to the foodstuff itself.

39 Therefore, at least in one circumstance within the scope of claim 1, I find this claim to be characterised merely by the foodstuff itself, with the method placing no restriction on the scope of the claim.

40 For claim 1, I find that a skilled person when reading this claim in the light of the description, would either (i) be unable to reliably determine what constitutes "a method of increasing the acceptance and enjoyment of a foodstuff to a cat", due to the subjective nature of what constitutes enjoyment and therefore remain unable to construe a reliable meaning for the claim or (ii) decide that the provision "when used in a method of increasing the acceptance and enjoyment of a foodstuff to a cat" places no restriction on the scope of the claim, with the claim being merely to a foodstuff having the specified proportions of protein, fat and carbohydrate as specified in claim 1.

Claim 6:

41 Since a claim to "the use of" a material can be regarded as equivalent to a claim to "a method of using" the material, claim 6 can be considered as: "A method of using a source of fat, protein, carbohydrate ……. to ensure the increased acceptance and enjoyment of a foodstuff to a cat."

42 For the same reasons set out in respect of claim 1 above, I consider that a skilled

person would recognise that “A method …. to ensure the increased acceptance and enjoyment” is indeterminable in scope and would therefore not be able to reliably construe this claim.

43 Once again, a skilled person could only reliably attribute the scope of this claim to that of the foodstuff *per se*.

44 At the hearing, the applicant proposed that claim 6 be interpreted as a “Swiss type” claim. The relevant section of the law, Section 2(6), requires however that the substance or composition be for “…use in a method of treatment of the human or animal body by surgery or therapy…” The present foodstuff is used in a nutritional and not a therapeutic method, so I do not find the foodstuff of the present invention to be amenable to the exclusion from normal claim interpretation provided by section 2(6).

45 For claim 6 therefore, I am of the opinion that a skilled person would only be able to reliably construe this claim by not limiting it to “a method of ensuring the increased acceptance and enjoyment of a foodstuff to a cat” but simply treating this claim as directed to the foodstuff *per se*.

46 The requirement under patent law that the claims shall be clear applies to individual claims and also to the claims as a whole and is of utmost importance in view of the function of the claims in defining the monopoly sought.

47 Since I have been unable to reliably construe the scope of claims 1 and 6, I find that both of these claims and their respective appendant claims, fail to satisfy the requirements of section 14(5)(b).

Novelty

48 Since I have found independent claims 1 and 6 to be unclear in scope and because there is no dispute regarding the fact that the foodstuff *per se* as defined in all claims 1-10 is known, I need not necessarily consider novelty. However, I will do so for completeness.

49 Prior to the hearing, the examiner brought to the applicant’s attention, two citations (US 6203825 B1 (Hodgkins) and US 6071544 A (Sunvold)-stipulating that these were examples out of many which disclose the foodstuff *per se* but which she considered to be the most relevant because they were the most explicit in disclosing how long the cats ate the food for, with this in itself being indicative of the cats’ “acceptance” of the food.

50 Hodgkins describes a dietary composition for treating abnormal carbohydrate metabolism in obligate carnivores, especially cats. Example 5 “DIET 2” provides fat, protein and carbohydrate in amounts that anticipate the foodstuff of present claims 1 to10. The tables in example 5 show that Diet 2 was fed to Cat 1 from 03/04/99 to 29/06/99 and Cat 2 from 07/04/99 to 07/04/99, thus demonstrating that the cats were fed for a long term period and therefore were in acceptance of the foodstuff.

51 Sunvold describes a dietary composition for promoting healthy weight loss in

cats. Table 2 gives values of protein, fat and carbohydrate that anticipate the foodstuff of claims 1, 4-6 and 9. The documents refer to cats being put on the weight reduction diets for 7-8 weeks. These cats therefore displayed acceptance of the foodstuff.

52 The agent's oral or written arguments do not dispute that the foodstuffs defined in these citations are foodstuffs as disclosed in the current claim set.

53 The applicant however asserted that their invention is novel over these citations, having regard to the method of increasing the acceptance and enjoyment of a foodstuff to a cat, as neither citation provides a measure of enjoyment and no choice of foods was given, and as such no increase in acceptance could be inferred.

54 The agent further stated that in Hodgkins, no indication of the amount of food given to the cats was made and as such it could not be assumed they were satisfied, and in Sunvold, the amount of food given was too low to provide accurate data on acceptance or enjoyment as the cats would have been motivated by intense hunger.

55 At the hearing the agent underlined that the prior art methods were performed for different purposes, i.e. Hodgkins – purpose of treating abnormal carbohydrate metabolism in obligate carnivores and Sunvold – purpose of promoting healthy weight loss in cats, whereas the purpose of the present invention is that the cat will "enjoy" the food and not refuse it.

56 Since it is accepted that the foodstuff *per se* is known, novelty of claim 1 over these citations must rest with what constitutes a "method of increasing the acceptance and enjoyment of a foodstuff to a cat".

57 I take from both citations that cats were fed a baseline diet followed by a foodstuff having protein, carbohydrate and fat energy ratios as defined in claims 1 and 6 and since the cats ate the foodstuff, it is implicit that they displayed acceptance of the foodstuff.

58 I have previously established that a skilled person would have difficulties in construing a precise scope for both claims 1 and 6. Therefore, depending upon which construction I follow, i.e., whether claims 1 and 6 are unclear in scope in respect of the method or whether the method bears no limitation on the scope of these claims, then I will come up with different answers as follows:

59 If I am unable to reliably determine the scope of claims 1 and 6 because the method is unclear, then it follows that I am also unable to determine novelty of these claims in respect of either Hodgkins or Sunvold. If however, I recognise that "acceptance" has a reliable meaning in the art but "enjoyment" does not, then it follows that claims 1 and 6 do not disclose novel methods on the basis of Hodgkins or Sunvold, since both disclose cats demonstrating "acceptance" of a known foodstuff by eating such foodstuff over a period of time.

60 Alternatively, if the method is non-limiting on the scope of claims 1 and 6, these claims are then simply to the foodstuff *per se* and it follows that Hodgkins

anticipates the foodstuff *per se* of claims 1-10 and Sunvold anticipates the foodstuff *per se* of claims 1, 4-6 and 9.

61 Mr. Miller indicated that in terms of novelty, the applicant has identified *"a nutritional composition which the cat is seeking"* and by providing this, they can *"bring an enjoyment benefit almost regardless of the taste and texture of the product."*

62 In respect of Mr. Miller's point, this "enjoyment benefit", in my opinion, must be inherent in the foodstuff *per se* and is something that would not appear to be definable in terms of a method.

Conclusions

63 I find that claims 1-10 of the 2nd Auxiliary Request Claims do not comply with section 14(5)(b) insofar as these claims are not clear in scope. I have been unable to come to a definitive opinion as regards compliance with section 1(1)(a) as I am unable to reliably construe the claims. I have carefully read the application but have been unable to find anything that, in my opinion, could form the basis of a patentable invention. I refuse the application under section 18(3).

Appeal

64 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

C L Davies
Deputy Director acting for the Comptroller