

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

**Datasheet for the decision
of 23 January 2007**

Case Number: T 1198/03 - 3.3.02

Application Number: 89307573.9

Publication Number: 0353036

IPC: A21D 6/00

Language of the proceedings: EN

Title of invention:

A method of producing dough

Patentee:

RHEON AUTOMATIC MACHINERY CO. LTD.

Opponent:

A. Fritsch GmbH & Co. KG

Headword:

Method of producing dough / RHEON AUTOMATIC MACHINERY CO. LTD.

Relevant legal provisions:

EPC Art. 122, 123(2), 56
Art. 10a RPBA

Keyword:

"Added matter - yes: original disclosure does not provide a basis for the wording "comprising".

"Inventive step - yes: no hints about the specific conditions of a particular step and about its technical effects"

"Restitutio in integrum - not applicable"

"Reimbursement of restitutio fee - no"

Decisions cited:

G 0001/86, J 0001/80, J 0011/85, J 0008/87, J 0027/97,
T 0152/82, T 0192/84

Catchword:

-



Case Number: T 1198/03 - 3.3.02

D E C I S I O N
of the Technical Board of Appeal 3.3.02
of 23 January 2007

Appellant: RHEON AUTOMATIC MACHINERY CO. LTD.
(Patent Proprietor) 2-3, Nozawa-machi
Utsunomiya-shi
JP-Tochigi-ken (JP)

Representative: Piésold, Alexander James
Frank B. Dehn & Co.
St Bride's House
10 Salisbury Square
GB-London EC4Y 8JD (GB)

Respondent: A. Fritsch GmbH & Co. KG
(Opponent) Bahnhofstr. 27-31
D-8711 Markt Einersheim (DE)

Representative: Götz, Georg Alois
Intellectual Property IP-GÖTZ
Patent- und Rechtsanwälte
Postfach 35 45
D-90017 Nürnberg (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 18 September 2003
revoking European patent No. 0353036 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: U. Oswald
Members: J. Riolo
C. Rennie-Smith
G. Rampold
B. Müller

Summary of Facts and Submissions

I. European patent No. 0 353 036 based on application No. 89 307 573.9 was granted on the basis of 5 claims.

Independent claim 1 and dependent claim 2 as granted read as follows:

"1. A method of producing dough for bread or pastry or the like comprising the steps of:

a) mixing and kneading various materials such as yeast, water, sugar, flour to make a dough mass having a gluten network,

b) resting said dough for at least five minutes, while said dough is maintained within a temperature range of 0°C to 16°C, so as to soften and reduce the elasticity of the dough mass,

c) stretching said dough into a dough strip while subjecting it to mechanically imparted vibrations such that a thixotropy effect appears in the dough and the gluten network in the dough is not damaged during this step,

d) cutting and shaping said dough strip into dough pieces of a desired form,

e) fermenting said dough pieces,

f) freezing said dough pieces."

"2. The method of claim 1, further comprising between steps b) and c) a step of applying fat to the surface of the stretched dough to form a fat layer on a dough layer and folding said dough to sandwich the fat layers between the folded dough layers, thereby producing pastry dough."

II. A notice of opposition was filed against the granted patent by the appellant (opponent).

The patent was opposed under Article 100(a) EPC for lack of novelty and lack of inventive step.

III. The decision of the Opposition Division of 16 May 1995 posted on 31 July 1995 rejected the opposition under Article 102(2) EPC.

IV. The appellant (opponent) lodged an appeal against the said decision, i.e. appeal T 829/95.

V. At the oral proceedings held before the Board on 3 February 2000, the decision under appeal was set aside and the case was remitted to the Opposition Division for further prosecution.

VI. The following documents were cited, *inter alia*, during the proceedings:

(1) EP-A-145 367

(7) US-A-4 276 317

(31) product brochure describing the "Fritsch Satellitenkopf"

VII. In its decision dated 22 July 2003, the Opposition Division revoked the patent under Article 102(1) EPC.

The Opposition Division rejected the objection under Article 100(c) EPC as late filed, because it was not *prima facie* well-founded.

It also considered that document (31) was not relevant as it did not disclose a resting step, so that it was not introduced into the proceedings.

The Opposition Division was of the opinion that the main request (claims as granted) and auxiliary requests 1 to 5 lacked an inventive step vis-à-vis the combination of documents (1) and (7), since all steps of the process of the patent in suit resulted from a mere addition of the two disclosures.

The novelty objection based on an alleged prior use, which was rejected by the Opposition Division in its decision dated 16 May 1995, was not maintained by the opponent.

VIII. The appellant (patent proprietor) lodged an appeal against this decision.

IX. Oral proceedings were held before the Board on 23 January 2007.

During the oral proceedings the appellant filed auxiliary requests 1 and 2.

Claim 1 of auxiliary request 1 is identical to claim 1 as granted, except for the following amended wording:
"A method of producing dough for bread or pastry consisting of the steps of:"

Claim 2 of this request reads:

"2. A method of producing dough for pastry consisting of the steps of:

- a) mixing and kneading various materials such as yeast, water, sugar, flour to make a dough mass having a gluten network,
- b) resting said dough for at least five minutes, while said dough is maintained within a temperature range of 0°C to 16°C, so as to soften and reduce the elasticity of the dough mass,
- c) stretching said dough into a dough strip while subjecting it to mechanically imparted vibrations such that a thixotropy effect appears in the dough and the gluten network in the dough is not damaged during this step,
- d) applying fat to the surface of the stretched dough to form a fat layer on a dough layer and folding said dough to sandwich the fat layers between the folded dough layers, thereby producing pastry dough,
- e) cutting and shaping said dough strip into dough pieces of a desired form,
- f) fermenting said dough pieces,
- g) freezing said dough pieces."

The respondent also filed evidence (copy extracts from the relevant Register of Companies - "Handelsregister") during the oral proceedings showing that, on 16 September 2003, a change in the type of corporate entity conducting the opponent's business ("formwechselnde Umwandlung") from A. Fritsch GmbH & Co. KG to Fritsch GmbH was entered in the Register of Companies. As a result, from that date on, A. Fritsch GmbH & Co. KG has continued to do business as Fritsch GmbH. The appellant made no submissions challenging the change in the type of corporate identity and the concomitant fact that the opposition has since stood in

the name of Fritsch GmbH. The Board accepted sufficient evidence had been provided to this effect.

- X. The appellant submitted in substance that the main request fulfilled the requirement of Article 100(c) EPC, as the reference to claim 1 of dependent claim 2 mentioning further process steps clearly showed that other steps were envisaged in the process according to claim 1, which could therefore be drafted with the broader word "comprising" instead of the narrower word "consisting".

As to inventive step, it was of the opinion that none of the available prior art either disclosed or suggested a resting step, wherein the dough is maintained for at least five minutes within a temperature range of 0°C to 16°C, immediately before stretching, or that this particular step led to an improved quality dough.

- XI. The respondent argued that the application as originally filed only disclosed a process consisting of several precisely defined steps and that it contained no indication of further possible steps between the recited ones.

Concerning inventive step, it held that document (1), which related also to a method of producing dough for pastry, disclosed a resting step, wherein the dough is maintained for at least five minutes within a temperature range of 0°C to 16°C, so that this measure could not be regarded as inventive.

XII. The appellant 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 first or second auxiliary requests filed during the oral proceedings.

The respondent requested that the appeal be dismissed. It also requested *restitutio in integrum* and reimbursement of the *restitutio* fee.

Reasons for the Decision

1. *The appeal is admissible.*
2. *Main request*

Article 100(c) EPC

In its decision the Opposition Division rejected the objection under Article 100(c) EPC relating to the replacement of the wording "consisting of" in claim 1 as originally filed by "comprising" as late filed, because it was not *prima facie* well-founded.

Indeed it held that, as claim 2 as originally filed recited that the method of claim 1 further comprised a step of applying fat and folding the dough between steps b and c, it was clear that further steps could be added to the claimed process.

The Board does not agree with these findings.

In fact, the question whether the wording "consisting of" in claim 1 as originally filed can be replaced by "comprising" has to be decided in the light of the content of the whole disclosure as originally filed.

In that respect, the Board observes that the description as originally filed discloses a process "consisting of" steps a) to f) (page 5, third paragraph, drawing 1) and that it also discloses a second process "consisting of" steps a) to f) wherein a step of applying fat and folding the dough between the steps of stretching and cutting the dough is foreseen (see the single example of the description).

Under these circumstances, there is no basis for a process wherein any kind of steps could be added at any of the stages of the process of claim 1.

Therefore, the set of claims of the main request has to be rejected because it contravenes the requirement of Article 123(2) EPC.

In addition to the view expressed by the Opposition Division and developed above, the respondent added that it was usual in the field of recipes and bakery that the steps given were not exclusive of other steps.

The Board agrees with the respondent's argument.

This is however not the point when it comes to the assessment of the requirements of Article 100(c) EPC.

In fact, the only relevant question is whether the skilled person reading the content of the application

as originally filed would be in a position to infer directly and unambiguously that the further steps at any stage of the claimed process were also envisaged in the application itself.

As it is evident from the above, this was not the case here.

3. *First auxiliary request*

The only point at issue was the assessment of inventive step vis-à-vis document (1).

The patent provides for two methods of producing dough for bread or pastry consisting of several steps wherein in each method, after the step of mixing and kneading the materials and before the step of stretching the dough, a resting step b) is foreseen lasting at least five minutes during which the dough is maintained within a temperature range of 0°C to 16°C (page 3, lines 10 to 24; figure 1, example).

Moreover, according to the description, because of this particular step the quality of the bread baked from this dough is better than that of the prior art as regards the specific volume and the uniformity of the layers and air pockets in the baked dough (page 8, lines 19 to 31).

Document (1), which relates to a method of producing dough for bread or pastry comprising, among others, steps a), c), d), e) and f) of the process of claim 1 of the contested patent, was considered as representing the closest state of the art by the Opposition Division

and the parties, and the Board sees no reason to differ (see respectively corresponding steps a-b), d), e), f), and g) of claim 1 of document (1)).

The respondent did not contest the effect shown in the description of the patent in suit in relation to step b) of the method (page 8, lines 19 to 31).

Under these circumstances, the problem to be solved by the invention is then to provide a process for producing dough for bread or pastry of improved quality.

In the light of the description and its working and comparative example, the Board is satisfied that the problem has been plausibly solved.

Thus, the question to be answered is whether the proposed solution, i.e. to have, after the step of mixing and kneading the materials and before the step of stretching the dough, a resting step b) for at least five minutes, while the dough is maintained within a temperature range of 0°C to 16°C, was obvious to the skilled person in the light of the prior art.

In that respect, it is noted that neither document (1) nor any of the other available prior art documents either disclosed or suggested a resting step, wherein the dough is maintained for at least five minutes within a temperature range of 0°C to 16°C, immediately before stretching, or that this particular step led to an improved dough quality.

Therefore, the Board is satisfied that the skilled person faced with the problem of improving the quality of the dough, could not have considered the particular step b) of resting the dough at a temperature maintained between 0°C to 16°C as indicated in claim 1 as a solution to this problem.

The respondent argued that document (1) taught on page 7, first paragraph, a resting period of at least 15 minutes at a temperature of between 1.7 and 5.5 °C.

In that respect, the Board observes that this resting period concerns a different step to that foreseen in the patent in suit since it has to be carried out after the first stretching of the dough (sheeting) "so that the dough may be more readily handed" (page 7, first paragraph).

This disclosure is therefore not relevant.

The respondent has further argued that the examples of document (1) disclosed a resting step of 5 minutes after the step of mixing and kneading the materials and before the step of stretching the dough.

The Board agrees that such a resting step is disclosed in the examples.

The Board observes, however, that examples 1, 2, 4 and 6 provide no indication as to the temperature of the dough.

As to examples 3 and 5, the Board notes that the temperature given in example 3 is 18.3 °C and that

example 5 mentions two contradictory ranges i.e. a range of 50 to 65°F and a range of 15.5°C to 18.3°C.

Moreover, none of the examples mention any means of maintaining the dough at a temperature below or equal to 16°C.

Accordingly, contrary to the respondent's statement, it cannot be established that the temperature of the resting step in these examples fulfils the requirements of step b) of claim 1 of the patent in suit.

On the contrary, in the absence of any precise information, the skilled person can only assume that the temperature of the dough would be around room temperature.

Under these circumstances, the Board considers the subject-matter of claim 1 of the main request to involve an inventive step as required by Article 56 EPC.

The same applies to the subject-matter of independent claim 2 and the dependent claims since the inventive process step b) is also present in these claims.

4. *Restitutio in integrum* and reimbursement of the *restitutio fee*

The sequence of events giving rise to the respondent's request for re-establishment of rights can be summarised as follows.

The appellant's statement of grounds of appeal was both dated and received at the EPO by fax on 28 January 2004. A copy was forwarded to the respondent's representative by the Board's registrar on 4 March 2004, so the time for filing the respondent's reply would have expired on 14 July 2004 (see Rule 78(2) EPC and Article 10a(1)(b) RPBA). By a fax request of 7 July 2004 the respondent requested an extension of time of two months. That extension was granted, such that the time expired on 14 September 2004. On 15 September 2004, the respondent's representative faxed a request for a further extension of time of one day (that is, until 15 September 2004) and, only one hour later on the same day, also faxed the reply to the EPO. On 22 September 2004, the respondent sent a further fax saying its representative had been told by the Board's registrar on the telephone on 20 September 2004 that the reply had been filed in time, requesting that even if late-filed the Board should consider the reply and further requesting that, if the Board would not otherwise consider the reply, the respondent be re-established into the time for filing the reply. The fee for a *restitutio* request was paid at the same time together with a request for its refund if the Board considered *restitutio* proceedings the incorrect procedure. It is abundantly clear the respondent considered its *restitutio* request as purely precautionary. The arguments in support of these requests need not be set out in detail here for the reasons given below: it is sufficient to say that the delay of one day was due to an oversight by the representative's assistant.

The Board is in principle required to consider any relevant submissions of the parties filed in time in proper form (see Article 10a(4) RPBA). While one purpose of Article 10a RPBA is clearly to make parties file their written submissions on time, another equally clear purpose is to limit each party's written submissions to one complete presentation of its case (and, if there is a subsequent communication from the Board, any response to that communication). However, there is no provision excluding in terms the consideration of late-filed submissions and, as is well-known, there is a considerable volume of case-law on the admissibility of such submissions (see for example "Case Law of the Boards of Appeal of the European Patent Office", 4th Edition 2001, pages 324 to 337). In the present case the Board, in exercising its discretion to consider late submissions, not only considered the respondent's reply filed one day late as described above but also considered the appellant's further written submissions of 13 November 2006. In both cases, no objection to consideration of the late-filed submissions was made by the other party. The Board was clearly empowered to consider the appellant's late submissions under Article 10b(1) RPBA. Compared with those submissions, filed two and a half years late and amending the appellant's case, the delay of one day by the respondent in filing its primary written case was *de minimis*. Not to consider that case purely because of that minimal delay would, in the circumstances of the case, have been an incorrect exercise of discretion. The *restitutio* request is therefore redundant and need not be considered on its merits.

As regards the fee paid for that request, the Board sees no grounds for ordering its refund. As stated, the respondent considered its request to be re-established into the time limit for filing the reply as purely precautionary should the Board not otherwise consider the reply. The request for refund was made in case the Board regarded *restitutio* proceedings as the incorrect procedure.

It is true that the case law of the boards of appeal includes examples where an application for restoration of rights was equally redundant but where the boards did reimburse the corresponding fee.

In T 152/82 (OJ 1984, 301) the question was whether payment of the appeal fee had been validly effected. As an auxiliary (subsidiary) request, the appellant asked for *restitutio* and paid the corresponding fee. Subsequently it requested reimbursement of that fee as it had become aware of its failure to observe the time limit for filing the request for restoration. According to the board, *restitutio* was in principle available in that case. The request for reimbursement of the *restitutio* fee amounted to a withdrawal of the auxiliary *restitutio* request. Such withdrawal did not justify reimbursement, even where the request had been made on an auxiliary basis. Reimbursement was justified, however, because the request for restoration was made under the condition that it was necessary. It was not the withdrawal of this request but the finding that it would not have become operational, which justified reimbursement of the fee.

Further decisions allowed the reimbursement of the *restitutio* fee where, likewise, *restitutio* was in principle applicable as a remedy but the request, which was filed either as a main or as an auxiliary request, did not become operational. Cases J 1/80 (OJ 1980, 289), J 11/85 (OJ 1986, 1), J 8/87 (OJ 1989, 9) and J 27/94 (OJ 1995, 831) also have in common that, in the respective boards' view, the Office had committed a mistake, which caused the request for re-instatement. In a further case, T 192/84 (OJ 1985, 39), the (main) request for *restitutio* was deemed without purpose because the time limits expiring in the relevant period, i.e. in that case the time limit for filing an appeal, were extended pursuant to Rule 85(2) EPC following a general interruption in the delivery of mail.

The present case differs from the cases referred to above insofar as *restitutio*, as a matter of principle, is not applicable as a remedy. For had the Board not considered the respondent's reply, this would not have had the direct consequence of a loss of rights or a means of redress of the respondent, as required by Article 122(1) EPC. Interestingly, the respondent itself does not even allege that. It contends that to the extent that the board would not consider the reply and this would affect its decision, the respondent would suffer a direct loss of rights. Due to the belated filing of the reply, the legal situation would be less favourable than in case of its timely submission.

The Board notes that even in *inter partes* proceedings a board may arrive at a certain conclusion, no matter

whether or not it is entitled to consider the respondent's reply to the statement of grounds of appeal. Therefore, the respondent's allegation in the case at hand that non-consideration of its reply would entail the automatic imposition of sanctions is not correct. As a consequence, in the present case, *restitutio* is not available as a matter of principle. Therefore, it can remain an open question whether this would also be true because the opponent/respondent had no standing to bring a restoration request. Article 122(1) EPC only entitles applicants for and proprietors of European patents to apply for *restitutio*, and G 1/86 (OJ 1987, 447) extended the scope of application of this provision to the opponent only insofar as its statement of grounds of appeal is concerned.

The present case also differs from those referred to above insofar as no mistake on the part of the Office had induced the respondent to file its (auxiliary) request for re-instatement of rights. This is true in particular in relation to the alleged statement made by the Board's registrar according to which the reply had been filed in time. Had the respondent relied on such a statement, it would on the contrary have refrained from filing the *restitutio* request. Nor can the respondent benefit from an extension of the time limit for filing the reply pursuant to Rule 85(2) EPC.

Under these circumstances, the Board does not consider it to be appropriate to return the *restitutio* fee on the ground that the *restitutio* request is redundant. In the present case, *restitutio* is clearly not applicable and the very nature of the respondent's request

indicates that it considered this to be possible. Moreover, the request for *restitutio* was not caused by a mistake made by the Office. In such a situation a party should not be able to reap cost benefits from the redundancy of a *restitutio* request filed on an auxiliary basis. Otherwise parties might be encouraged to file such inapplicable requests. This would run counter to the goal of procedural efficiency.

ORDER

For these reasons it is decided that:

- (a) The decision under appeal is set aside.
- (b) The case is remitted to the first instance with the order to maintain the patent with the claims of the first auxiliary request filed during the oral proceedings and the description and drawings as granted.
- (c) The request for reimbursement of the re-establishment fee is refused.

The Registrar:

The Chairman:

A. Townend

U. Oswald