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**Datasheet for the decision
of 4 April 2007**

Case Number: W 0021/06 - 3.2.04

Application Number: PCT/EP 2005/008989

Publication Number: WO 2006/024409

IPC: A47J 31/46

Language of the proceedings: EN

Title of invention:

Method and system for in-cup dispensing, mixing and foaming
hot and cold beverages

Applicant:

Nestec S.A.

Opponent:

-

Headword:

-

Relevant legal provisions:

PCT Art. 16, 17(3)(a)

PCT R. 13.1, 13.2, 40.1, 40.2(c), 40.2(e)

Keyword:

"Common problem underlying the inventions (yes)"

"Protest justified (yes)"

Decisions cited:

G 0001/89

Catchword:

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Case Number: W 0021/06 - 3.2.04

International Application No. PCT/EP 2005/008989

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 4 April 2007

Applicant: NESTEC S.A.
Avenue Nestlé 55
CH-1800 Vevey (CH)

Representative: P. Borne
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Decision under appeal: Protest according to Rule 40.2(c) of the Patent Cooperation Treaty made by the applicants against the invitation of the European Patent Office (International Preliminary Examining Authority) to restrict the claims or pay additional fees dated 5 December 2005.

Composition of the Board:

Chairman: M. Ceyte
Members: C. Scheibling
S. Hoffmann

Summary of Facts and Submissions

- I. International patent application No. PCT/EP2005/008989 was filed with 42 claims, including one independent product claim, and one independent method claim relating to a food product dispenser and to a method of preparing a food product from a food product dispenser.
- II. The European Patent Office (EPO), acting in its capacity as an International Searching Authority (ISA) under Article 16 PCT and 154 EPC, informed the applicant that the application did not comply with the requirement of unity of invention (Rule 13.1 PCT) and invited the applicant to pay fees for four additional inventions, in accordance with Article 17(3)(a) and Rule 40.1 PCT.

In the invitation the ISA listed the following groups of claims, each held to relate to a different invention:

1. claims: 1, 31
Food product dispenser with separate nozzles for mixing a diluent and a food product in a container; method therefore.
2. claim: 6
Food product dispenser with a dispensing bay for a container.
3. claims: 12-19, 35-37, 39, 40
Food product dispenser configured to obtain certain values of the diluent flow-rate and its linear velocity.

4. claims: 20-23
Food product dispenser with pumps for the diluent and the food component.
5. claims: 26, 27
Food product dispenser with a controller for a timed delivery.

The invitation then essentially stated that the subject-matter of claims 1 and 31 did not involve an inventive step, that claims 2-10, 6, 12, 17, 20, 24, 26, 28-30 were directly dependent on claim 1, and that "the features of claim 1 are in common between said aforementioned dependent claims. As said features are not inventive, they cannot be considered as common potential special technical features in the meaning of Article 13.2 PCT."

- III. The applicant paid three additional fees under protest (Rule 40.2(c) PCT) for the groups 3 to 5 and contested the findings of the ISA. No additional fee was paid for group 2 (claim 6).

He argued that the same inventive concept was disclosed in both claim 1 and the claims of group 3; this concept being to provide a good in-cup mixing, eventually in-cup foaming, by controlling certain key parameters, in particular (but not necessarily exclusively), the diluent velocity. Again the claims of group 4 were related to relevant technical conditions for delivering the diluent and liquid at the optimal conditions for obtaining an improved mixing and eventually foaming, whereas the claims of group 5 were related to a

controller for a timed delivery, i.e. conditions on the sequencing of the diluent and food delivery provided for obtaining the desired mixing (eventually foaming) results.

- IV. The review panel of the ISA considered that the protest for groups 3 and 4 was justified and ordered the refund of two of the additional fees.

The applicant duly paid the protest fee.

Reasons for the Decision

1. The Board is competent to decide on the present protest pursuant to Article 154(3) EPC in conjunction with Rule 40.2(c) PCT, second sentence. The protest complies with the requirements of Rule 40.2(c) and (e) PCT and is therefore admissible.

2. *Examination of the current protest*

- 2.1 The ISA held that the application comprises five groups of inventions.

No additional fees were paid for group two and the additional fees paid for groups three and four have already been refunded. Thus, the current protest only concerns the payment of the additional fee with respect to group five (claims 26 and 27).

- 2.2 As far as the present case is concerned, the Board first notes that the PCT International Search Guidelines state at point 10.03 that lack of unity of

invention may be directly evident "a priori," that is, before considering the claims in relation to any prior art, or may only become apparent "a posteriori," that is, after taking the prior art into consideration.

2.3 In its invitation to pay additional fees, the ISA argued in essence that the subject-matter of claims 1 and 31 did not involve an inventive step and that therefore, there were no potential special technical features in common between the dependent claims 2-10, 6, 12, 17, 20, 24, 26 and 28-30. It is thus apparent that the ISA's objection to unity was "a posteriori".

2.4 The Board agrees with the ISA that the objective technical problem of the first group can be seen in "how to obtain a beverage wherein the diluent and the food components are well mixed".

2.5 The fifth group, i.e. claims 26 and 27, defines a controller for controlling the ejection of diluent and of the food component, when diluent is ejected before and/or after the food component and during the overlap period. In the description, page 12, lines 21 and 22 it is stated "To achieve whiter foam, water may be delivered for a slightly longer period than concentrates".

The ISA derived from this passage that the objective problem of the fifth group had to be seen in "obtaining whiter foam".

However, as stated in claims 26 and 27 the controller is not restricted to control ejection when diluent is ejected simultaneously to and after the food component.

Thus, the objective problem cannot be limited to the problem defined by ISA but has to be defined in more general terms so as to also include controlling the ejection of diluent possibly before but not after the food component is ejected.

Since it is also indicated in claim 27 "... to complete dilution and/or mixing of the food product" the problem to be solved by the fifth group can rather be seen in improving the dilution and/or mixing of the food product.

2.6 The ISA's review panel already conceded that the distinguishing features of the claims of the third group were related to the technical problem of the first group of "improving the mixing of the defined components" and that the distinguishing features of the fourth group were directed to "relevant technical conditions for delivering the diluent and the liquid at optimal conditions... for improved mixing..." and therefore were also related to the technical problem of the first group.

2.7 In view of G 1/89 (OJ EPO 1991, 155) where the Enlarged Board held at point 8.2 that the charging of additional fees under Article 17(3)(a) PCT should be made only in "clear cases", and that "the ISA should exercise restraint in the assessment of novelty and inventive step and in border-line cases preferably refrain from considering an application as not complying with the requirement of unity of invention on the ground of lack of novelty or inventive step", i.e. where a posteriori objections are concerned, the Board does not see why the distinguishing features of the claims of the fifth

group should not contribute to improve the dilution and/or mixing and thus, should not be linked to the problem of the first group which relates to improving the mixing of the defined components.

- 2.8 The Board therefore judges that groups one and five have unity, so that the protest for group five is justified.

Order

For these reasons it is decided that:

1. The protest is justified.
2. The refund of the additional fee for group five and the protest fee is ordered.

The Registrar:

The Chairman:

R. Schumacher

M. Ceyte