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Aktenzeichen / Case Number / N^o du recours : W 43/90 - 3.3.2

Anmeldenummer / Filing No / N^o de la demande : PCT/GB 90/00 176

Veröffentlichungs-Nr. / Publication No / N^o de la publication :

Bezeichnung der Erfindung:

Title of invention: Food treatment

Titre de l'invention :

Klassifikation / Classification / Classement : A 23C 9/13

ENTSCHEIDUNG / DECISION

vom / of / du 8 November 1990

Anmelder / Applicant / Demandeur : Elopak Limited et al

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPÜ / EPC / CBE PCT Article 17(3)(a), Rule 13.1, Rule 40.1

Schlagwort / Keyword / Mot clé : "Lack of unity (no) - inadequate reasons"

Leitsatz / Headnote / Sommaire



Case Number : W 43/90 - 3.3.2

International Application No. PCT/GB 90/00 176

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 8 November 1990

Applicant : Elopak Limited
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Subject of the Decision : Protest according to Rule 40.2(c) of the Patent Cooperation Treaty made by the applicants against the invitation (payment of additional fee) of the European Patent Office (branch at The Hague) dated 21 June 1990.

Composition of the Board :

Chairman : P.A.M. Lançon
Members : I.A. Holliday
C. Holtz

Summary of facts and submissions

- I. The Applicant filed international patent application PCT/GB 90/00 176.
- II. The EPO, acting as International Search Authority (ISA) sent to the Applicant an invitation to pay an additional search fee in accordance with Article 17(3)(a) and Rule 40.1 PCT.

The ISA indicated that the subject-matter claimed related to two inventions set out as follows:

1. Claims 1-13, 26, 27 : Preparing a fermented milk by re-heating a heat-treated milk, followed by carbonization with CO₂ gas and addition of starter culture.
2. Claims 14-25, 28 : Process and apparatus for introducing CO₂ gas into heat treated milk during the passage of the milk through a line to a fermentation tank.

- III. The Applicant paid the additional search fee under protest arguing that the requirement of unity of invention is met as Claims 1-13, 26 and 27, on the one hand, and Claims 14-25 and 28 on the other hand constitute a group of two inventions so linked as to form a single general inventive concept; the carbonisation of milk with CO₂ gas was a relatively limited field with only a relatively small number of prior art documents.

Reasons for the Decision

1. The protest is admissible.
2. Adequate reasoning under Rule 40.1 PCT.
 - 2.1 Rule 40.1 PCT stipulates that the invitation provided for in Article 17(3)(a) PCT must specify the reasons why the International application is not deemed to comply with the requirements of unity of invention. The purpose of setting out reasons is to enable the Applicant and, in the case of a protest, also the appeal body to examine whether the request to pay additional fees owing to lack of unity of the invention is justified. At the least, the considerations that motivated the decision must be readily comprehended from the reasons indicated in the invitation of the ISA.
 - 2.2 In two earlier published decisions (W 04/85, OJ EPO 1987, 63 and W 07/86, OJ EPO 1987, 67) the Boards of Appeal have already expressed the view that the requirement to give reasons in an invitation pursuant to Article 17(3)(a) and Rule 40.1 PCT is so fundamental that an unsubstantiated invitation cannot be regarded as legally effective. The first mentioned decision states that in straight forward cases all that may be necessary to substantiate a lack of unity is a list of the different groups of subject-matter in the application. However, in the latter decision, it was deemed appropriate to add that such is rarely the case.
 - 2.3 In the present case, however, the invitation of the ISA cannot be considered as containing an acceptably reasoned statement setting out the considerations for the decision

in a way which could be readily understood. The invitation to the Applicant sets out, as "reasons for requiring the additional fee", merely a list of the two groups of subject-matter specified in Point II above. Since the ISA made no reference to the prior art in the sheet accompanying Form PCT/ISA 6, it is apparent that an objection "a priori" is intended. However, in the Board's opinion, the present application is not a straight forward case where it would immediately follow from a mere listing of the separate groups of subject-matter that there is lack of unity (cf. W 04/85, page 3).

3. Unity of invention.

- 3.1 In the case of a protest under Rule 40(2) PCT, where an objection a priori is raised, no examination of the merits of the claims in comparison with the state of the art has been carried out. The only way to determine the technical problem (in contradistinction to the normal approach) is to rely on the description of the application and the provisional acknowledgement of the prior art therein, if given. According to the description, the incubation time is critical for the development of the right texture and aroma of the fermented dairy products. Reduction of the incubation time would be of great importance and would provide a number of advantages (see page 4, lines 16-19). The problem is thus stated to lie in the shortening of the incubation time and in the improvement of the activity of the starter culture during production of a fermented milk (see page 4, lines 23-28). The solution claimed relates to a method of converting milk comprising heating a heat-treated milk, adding CO₂ gas and starter culture to instigate fermentation and to the product obtained therefrom (Claims 1-13, 26 and 27), a method of converting milk comprising supplying heat-treated milk to a

fermentation tank, introducing CO₂ gas into the heat-treated milk by infusion as illustrated diagrammatically (Fig. 7) prior to adding the starter culture and the product obtained (Claims 14-19 and 28) and an apparatus for use in converting milk, which apparatus corresponds to the diagram of Claim 14 (Claims 20-25).

3.2 Although the wording of Claims 1 and 14 differs essentially in that the heat-treated milk in claim 14 is not reheated before the carbonisation step, a common feature links both claims. This feature is the heating (once or twice) before the step of adding CO₂ gas to the milk. This feature appears to be the common solution to the problem stated above. It appears from the description that the presence of CO₂ in the milk stimulates the growth of yoghurt bacteria. The feature that the milk is carbonized before it is inoculated improves the evenness of the degree of carbonization throughout the milk and improves the speed of production of fully carbonized milk; the fermentation time can be shortened (see page 6, lines 3-12 and 26-36). The feature of introducing CO₂ into the heat-treated milk before the inoculation appears to provide the unity required by Rule 13.1 PCT.

3.3 The Board, therefore, considers that the ISA was wrong in claiming at this stage of the proceedings that there was lack of unity of invention. Consequently the fee paid by the Applicant cannot be retained.

Order

For these reasons, it is decided that:

Reimbursement of the additional fee to the Applicant is ordered.

The Registrar:

The Chairman:

M. Beer

P. Lançon