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**Datasheet for the decision
of 13 February 2007**

Case Number: T 1585/06 - 3.3.02

Application Number: 99941566.4

Publication Number: 1202632

IPC: A21D 10/02

Language of the proceedings: EN

Title of invention:

Refrigerated bakery dough product

Applicant:

SOCIETE DER PRODUITS NESTLE S.A.

Opponent:

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Headword:

-

Relevant legal provisions:

EPC Art. 54, 84, 111, 123(2)

Keyword:

"Novelty (yes): water content of the dough is different in the prior art"

"Remittal (yes): undecided issues"

Decisions cited:

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Catchword:

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Case Number: T 1585/06 - 3.3.02

D E C I S I O N
of the Technical Board of Appeal 3.3.02
of 13 February 2007

Appellant: SOCIETE DES PRODUITS NESTLE S.A.
Case postale 353
CH-1800 Vevey (CH)

Representative: Rupp, Christian
Mitscherlich & Partner
Patent- und Rechtsanwälte
Postfach 33 06 09
D-80066 München (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 11 May 2006
refusing European application No. 99941566.4
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: J. Riolo
Members: A. Lindner
J. Seitz

Summary of Facts and Submissions

I. European patent application No. 99 941 566.4 was refused by a decision of the examining division posted on 11 May 2006 on the basis of Article 97(1) EPC on the grounds of lack of novelty and lack of clarity (Articles 54 and 84 EPC).

II. The following documents cited during the proceedings before the examining division and the board of appeal, remain relevant for the present decision:

- (1) WO 98/26666
- (2) WO 92/10101
- (3) WO 99/66802

III. The decision was based on claims 1-15 of the sole request filed with the letter of 18 February 2005.

Independent claim 1 of this request read as follows:

"1. A ready-for-use bakery dough product in the form of a block, which can be preserved in the refrigerator and which is prepared from flour, sugar, baking power and fat, wherein the baking powder is present in an amount of between about 0.1 and 3.0% and the dough product is provided in a form which is pre-cut or which includes grooves or score lines thereon defining pieces of the dough product to be baked into final bakery items, said dough having a water content in the order of about 6 to 20%, wherein said block presents the following features selected from the group consisting of:

- a) at least two different layers,

- b) at least two different strips for each piece taken from the block,
- c) the same or a different stamping on the top of each piece,
- d) the same or a different decoration on the top of each piece,
- e) a filling which is different from the basic dough and is the same or different in each piece, or
- f) pre-cut forms of different specific shapes or sizes."

IV. The arguments in the decision may be summarised as follows:

In connection with novelty, the examining division came to the conclusion that each of documents (1), (2) and (3) was novelty destroying. As regards document (2), it was emphasised that the corrugations of the doughs disclosed therein could be considered as grooves or scores.

As far as clarity is concerned, the examining division held that the requirements of Article 84 EPC were not met, because

- (a) claim 6 was redundant with regard to claim 1; and
- (b) the "abouts" in claims 1, 4, 5, 6, 7, 9, 11 and 12 rendered the claimed subject-matter unclear.

V. The appellant (applicant) lodged an appeal against said decision.

VI. The appellant filed a new main request as well as an auxiliary request together with the statement of the grounds of appeal dated 21 September 2006.

VII. In the telephone conversation on 23 January 2007, the novelty and clarity of the claims were discussed. The appellant's representative agreed to file a new main request.

VIII. With his fax of 31 January 2007, the appellant filed a new single request which replaced all the previous requests. The independent claim 1 reads as follows:

"1. A ready-for-use bakery dough product which can be preserved in the refrigerator and which is prepared from flour, sugar, baking powder and fat, wherein the baking powder is present in an amount of between 0.1 and 3.0% and the dough product is provided in a form which is pre-cut or which includes grooves or score lines thereon defining pieces of the dough product to be baked into final bakery items, and wherein the water content is 13.5% to 20%."

IX. The appellant's submissions can essentially be summarised as follows: in connection with novelty it was held that the water content which had been introduced into claim 1 established novelty over documents (1) and (3). As for (2), the appellant was of the opinion that this document did not disclose a dough product which is pre-cut or which includes grooves or score lines which define pieces of the dough product to be baked into final bakery items. Moreover, the claims were now clear in the light of the amendments made, as the redundant claim 6 as well as the term "about" had been deleted.

- X. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the set of claims filed with the fax of 31 January 2007. Oral proceedings were requested in case the board intended to dismiss the appeal. Oral proceedings were not requested in case the board intended to remit the case back to the first instance for further prosecution.

Reasons for the Decision

1. The appeal is admissible.
2. Article 123(2) EPC:

Present claim 1 differs from claim 1 as filed by the inclusion of the water content from 13.5% to 20%. The basis for the said feature can be found in the sentence bridging pages 4 and 5 of the original application, wherein a water content of 6 to 20% is disclosed and in example 1, where a dough with a water content of 13.5% is prepared. As a consequence, the requirements of Article 123(2) EPC are met.

3. Article 84:

The grounds of refusal elaborated in the decision under appeal no longer apply to the present set of claims: the term "about" was deleted from the claims. Moreover, claim 6 of the set of claims which had formed the basis for the decision under appeal was cancelled. As a consequence, the requirements of Article 84 EPC are met.

4. Novelty:

The subject-matter of present claim 1 is novel over documents (1), (2) and (3), because none of the said documents relates to a dough product having a water content of 13.5% to 20%.

4.1 In documents (1) and (3), the water content of the dough products is in the range between 6 and 9% ((1): page 2, lines 35-37; (3): page 4, lines 24-25). The specific examples concern dough products with even lower water contents ((1): page 5, table; (3): page 8, table).

4.2 Document (2) relates to two different bakery products, namely biscuits and crackers or water biscuits. The latter products are of no interest in the present case, as the composition of the doughs used for the preparation of crackers is quite different from the doughs as presently claimed: these doughs contain neither sugar ((2): page 23, lines 2-7) nor, as can be seen from examples 1 and 2 of (2), any baking powder.

As far as the "normal biscuits" of document (2) are concerned, reference is made to examples 3 to 9 which disclose doughs comprising all the components of the doughs as presently claimed, i.e. flour, sugar, fat, baking powder in an amount of between 0.1 and 3% as well as water. However, the water content varies between 9.91% (example 6) and 10.752% (example 4). Doughs with a water content in the range of 13.5% to 20% are not disclosed in document (2).

4.3 As a consequence, the subject-matter of claim 1 is novel over documents (1), (2) and (3). The same applies to claims 2 to 20 which are all dependent on claim 1.

5. Remittal to the first instance:

5.1 Although Article 111(1) EPC does not guarantee an absolute right to have all the issues in the case considered by two instances, it is well recognised that any party should where possible be given the opportunity to have two readings of the important elements of the case. The essential function of an appeal is to consider whether the decision which has been issued by the first-instance department is correct. Hence, a case is normally referred back if essential questions regarding the patentability of the claimed subject-matter have not yet been examined and decided by the department of first instance.

In particular, remittal is taken into consideration by the boards in cases where a first-instance department issues a decision solely upon some particular issues which are decisive for the case and leaves other essential issues outstanding. If, following appeal proceedings, the appeal on the particular issues is allowed, the case is normally remitted to the first-instance department for consideration of the undecided issues.

5.2 The observations and comments made above apply fully to the present case. The examining division decided that the requests were not patentable on the grounds of lack of novelty (Article 54 EPC) and lack of clarity (Article 84 EPC), but left out other essential issues

such as inventive step (Articles 52(1), 56 EPC) and the assessment of the substance of the remaining X quoted documents cited in the search report. These issues, however, form, inter alia, the basis for the examination of the application and must therefore be considered as essential substantive issues in the present case.

5.3 Thus, in view of the above considerations, the Board has reached the conclusion that, in the circumstances of the present case, it is necessary to remit the case to the examining division for further prosecution on the basis of the set of 20 claims filed on 31 January 2007.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman

A. Townend

J. Riolo