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Bezeichnung der Erfindung: Frozen fish
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement : A23B 4/06, A22C 25/22

ENTSCHEIDUNG / DECISION

vom / of / du 27 August 1990

Anmelder / Applicant / Demandeur : Frisco-Findus AG

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPÜ / EPC / CBE Article 56

Schlagwort / Keyword / Mot clé : "Inventive step - Yes
Simplified process, long felt need"

Leitsatz / Headnote / Sommaire

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Case Number : T 90/89 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 27 August 1990

Appellant : FRISCO-FINDUS AG
CH-9400 Rorschach

Decision under appeal : Decision of Examining Division 020 of the European Patent Office dated 5 September 1988 refusing European patent application No. 85 111 663.2 pursuant to Article 97(1) EPC

Composition of the Board :

Chairman : P.A.M. Lançon
Members : I.A. Holliday
M. Lewenton

Summary of Facts and Submissions

I. European patent application No. 85 111 663.2 was filed on 14 September 1985 and published under No. 0 215 143.

II. On 5 September 1988, the Examining Division issued a decision refusing the application under Article 97(1) EPC for failure to comply with Articles 56 and 52(1) EPC. The decision was based on Claims 1-7 received on 4 November 1987.

Claim 1 reads as follows:

1. A process of preparing a frozen rolled cod tail comprising rolling an unfrozen cod tail around a solid or hollow spindle wherein when the spindle is solid, freezing the rolled cod tail on the surface, removing said partially frozen cod tail from the spindle and then freezing completely and when the spindle is hollow, freezing the rolled cod tail completely, conveying liquid above the freezing point through the inside of the hollow spindle until the temperature of the spindle has increased sufficiently to enable the said frozen rolled cod tail to be removed from the spindle.

III. The ground for the refusal was that, in the opinion of the Examining Division, Claim 1 (and dependent Claims 2-7) although novel lacked inventive step having regard to the disclosures of US-A-3 152 915 (1) and DE-A-1 454 172 (2). It was known from (1) that when two freezing steps were needed to prepare frozen products, the quality of the frozen end product is decreased. Accordingly, when preparing frozen fish products, there was a strong incentive to use fresh or unfrozen fish and to limit the freezing to one complete step. A process for the preparation of fish-rolls on spindles is known from (2).

Although there is no disclosure of the freezing of the rolled products known from (2), the Examining Division took the view that a one-step freezing process was an obvious development of the process of (2) and, furthermore, that the claimed method for removing the rolled fish tails from the spindles was self-evident. In other words, it was the Examining Division's view that the claimed process was merely a combination of known or obvious measures.

IV. On 13 October 1988, a Notice of Appeal was filed together with a debit order for the appeal fee. On 27 December 1988 a statement setting out the grounds was received.

The Appellant agreed that a single freezing process was known to be desirable but denied that the method used for preparing rolled fish in (2) was a suitable starting point for the claimed process. The products of (2), in contrast to those of the application, have to be pinned together in order to retain their rolled configuration. Although the products of (2) were prepared by winding on spindles, the spindles were part of the machine and could not be removed for the freezing step. When the products of (2) were removed from the machine, they would, although pinned, have irregular shapes, the hollow interior tending to collapse. The products would then be unsuitable for preparing the uniform filled products obtainable from the process of the application. There was also no way, without hindsight, in which the methods used to remove the products from the spindle, especially the embodiment employing the hollow spindle, could be derived from the cited prior art.

V. The Applicant requests that the decision under Appeal be set aside and that a patent be granted on the basis of Claims 1-7 received on 4 November 1987.

Reasons for the Decision

1. The appeal is admissible.

2. Claim 1 as received on 4 November 1987 is in effect a combination of the originally filed Claims 1, 5 and 7 and is based on the originally filed description on page 1, lines 25 to 29; page 2, lines 11 to 13 and page 2, line 34 to page 3, line 4. The requirements of Article 123(2) are accordingly satisfied.

3. The application concerns a process for preparing frozen rolled cod tails capable of being filled, e.g. with spinach and a sauce topping at a later stage.

3.1 The closest state of the art is document (2) which is also concerned with preparing rolled fish tails by winding round a spindle. The products prepared according to (2) are not, however, frozen but are pinned in order to retain their rolled configuration before being mechanically removed from the spindle. After removal, the rolls prepared by the process of (2) have no rigidity so that the hollow interior tends to collapse. The unfrozen products are thus incapable of being filled. It would also be difficult to freeze them in a particular shape so that they could be filled.

3.2 In relation to the above prior art (2), the problem to be solved by the application is to develop a process for the preparation of frozen rolled cod tail which overcomes the disadvantage outlined above. The solution according to the application is the freezing process set out in Claim 1 above. The description and the accompanying drawings provided evidence that the problem has been plausibly solved.

4. None of the prior art documents cited in the European Search Report discloses all the features of Claim 1 of the application. Novelty of the subject-matter can accordingly be acknowledged. Since the Examining Division did not dispute novelty, it is not necessary to consider the matter any further.

5. It remains to consider whether or not Claim 1 satisfies the requirements of Article 56 EPC in respect of inventive step.

5.1 The process of Claim 1 differs from that of (2) in several respects. Although in both processes the fish tails are wound on to spindles, according to (2) the spindle is part of the machine, the wound fish tail being pinned before mechanical removal from the spindle. In the process according to the application, however, the fish tail is wound round the spindle, which may be solid or hollow, and frozen whilst the spindle is still in position. If the spindle is solid, the product is frozen for a time sufficient to achieve rigidity and the spindle removed before freezing causes adhesion to the fish; after removing the spindle freezing is completed. When a hollow spindle is employed, the freezing is carried to completion after which the inner surface of the spindle is briefly warmed. Thus, in both embodiments products are obtained with a regular hollow centre which can be filled either on removal from the spindle or at a later stage. Especially when using the freezing frame according to Figure 3 of the drawings in conjunction with a plate freezer, products of even configuration can be obtained.

5.2 Using the process of (2), it is also possible to prepare a filled rolled fish tail but only as part of the rolling process (see drawings and description, Phase II on page 3). However, if no filling were to be added at Phase II, the hollow centre would tend to collapse on removal from the spindle owing to the lack of rigidity of the unfrozen fish. Thus, the facility of filling the fish later would not be available. As indicated in (2), the dwell time on the machine is very short (e.g. two seconds, page 2, lines 1-3). It would be impossible to incorporate a freezing step in such a machine having regard to the limited time available. According to the application, a minimum of two minutes (and desirably longer) is required to freeze the outer surface of the fish. It is also apparent from (2) that the spindles (Wickeldorn) are part of the machine and there would be no possibility of removing them with the rolled fish. It would, of course, be possible to freeze the products of the process of (2) but such frozen products would not have the consistent shape with a regular hollow centre obtainable by the process of the application.

5.3 It is indeed self-evident that a completely frozen rolled fish would adhere to a spindle around which it had been frozen. However, the actual methods prescribed in Claim 1 of the application to remove the fish are not derivable from the prior art. There is no suggestion in (2), nor in any other of the prior art cited in the European Search Report, of partial freezing of rolled fish on a spindle. Although the spindles used in (2) may be hollow (page 2, line 29), there is no indication that such hollow spindles might be used as a conduit for a heating fluid.

5.4 Other relevant prior art is that acknowledged in the application on page 1, lines 6-11, without reference to a prior published document. Here it is stated that it was

prior art practice to convey already frozen cod tails to a factory, defrosting them, placing a filling on top of the tail, then winding and finally refreezing. An analogous process for shrimps is known from document (1).

5.5 In summary, although the individual features of Claim 1 of the application may seem trivial and obvious, the prior art as represented by (1) or (2) gives the man skilled in the art no incentive to combine the said features to arrive at a solution to the problem defined above. It is also relevant to consider the fact that some twenty years elapsed between the publication of documents (1) and (2) and the filing date of the present application. The Applicant has developed a simplified process for preparing rolled cod tails which employs a single freezing step, thus avoiding the disadvantages recorded in document (1) (see Point III above). The process is also capable of producing a uniform product desirable in the market place. Having regard to the decision T 106/84, O.J. EPO 1985, page 132, the combination of features set out in Claim 1 leads to a process which fulfils a long felt need in the art; this is further evidence in favour of an inventive step.

6. It is accordingly the Board's view that the subject-matter of Claim 1 would not be obvious from either citation taken singly or in combination. Thus the required inventive step is not lacking and the requirements of Article 56 are satisfied. Claim 1 and dependent Claims 2-7 are therefore allowable having regard to Article 52(1).

7. As noted by the Examining Division in Point 4.2 of the contested decision, the description requires adaptation to the current Claim 1.

Order

For these reasons, it is decided that:

1. The decision of the Examining Division dated 5 September 1988 is set aside.

2. The application is remitted to the Examining Division with order to grant a European patent on the basis of Claims 1-7 received on 4 November 1987, the description being adapted thereto.

The Registrar: The Chairman:

M. Beer P.A.M. Lançon