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D E C I S I O N
of 3 February 2000

Case Number: T 0829/95 - 3.3.2

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:
Frozen dough/RHEON AUTOMATIC MACHINERY

Relevant legal provisions:
EPC Art. 111

Keyword:
"Remittal to the first instance - yes - two levels of
jurisdiction"

Decisions cited:
-

Catchword:
-



Case Number: T 0829/95 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 3 February 2000

Appellant:
(Opponent)

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Representative:

Götz, Georg, Dipl.-Ing.
Götz, Küchler & Dameron
Patent- und Rechtsanwälte
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Respondent:
(Proprietor of the patent)

Rheon Automatic Machinery Co.Ltd.
2-3, Nozawa-machi
Utsunomiya-shi
Tochigi-ken (JP)

Representative:

Piésold, Alexander J.
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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 31 July 1995
rejecting the opposition filed against European
patent No. 0 353 036 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: P. A. M. Lançon
Members: J. Riolo
M. B. Günzel
U. Oswald
C. Rennie-Smith

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 as granted reads as follows:

"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."

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.

The Opposition Division took the view that the subject-matter of the patent in suit met the requirements of Articles 52(1), 54 and 56 EPC over the written documents and that the alleged content of a video tape as well as an alleged prior use were not to be regarded as proven prior art.

The reasons for these conclusions were the same as the ones given in a related case, treated in parallel by the Opposition Division, concerning technically related European patent No. 0 311 240, also pending before the Board under case No. T 828/95. Claim 1 of the patent in suit differs from patent No. 0 311 240, which has earlier filing and priority dates, only by the addition of a resting step (b).

The Opposition Division also examined the novelty of the subject-matter of the contested patent over said intermediate document EP-A-0 311 240 and considered that this document was not relevant.

Concerning inventive step, the Opposition Division expressed the opinion that the resting step (b) of claim 1 of the patent in suit was not relevant for the evaluation of inventiveness, since inventive step was acknowledged on the basis of step (c) of this process. This step was also considered as being inventive in the opposition to the technically related European patent No. 311 240 (T 828/95).

IV. The appellant lodged an appeal against the said decision, as well as against the decision of the Opposition Division concerning patent No. 0 311 240.

The following document was cited *inter alia* during the present appeal proceedings:

(31) leaflet printed in December 1987 (filed with the appellant's letter of 18 June 1997).

- V. The proceedings in the present case and in T 828/95, concerning patent No. 0 311 240, were also treated in parallel by the Board.
- VI. With respect to the alleged prior use, the Board decided to hear the appellant's witnesses subject to the outcome of the discussion at the oral proceedings of the written state of the art.
- VII. With a letter dated 4 January 2000, the respondent (patentee) filed five auxiliary requests.
- VIII. Oral proceedings were held before the Board on 3 February 2000 after the announcement of the decision of the Board to revoke the technically related European patent No. 311 240 (T 828/95).
- IX. At the oral proceedings the respondent argued that the revocation of the technically related European patent No. 311 240 was unexpected and that it needed to consider the written reasons in that decision in order to be in a position to argue the present case adequately.

It also submitted that the decision of the Opposition Division did not deal separately with the merits of the present case and merely followed from the decision to maintain the technically related European patent No. 311 240

- X. The appellant submitted, at the oral proceedings, that for considerations of procedural economy and to avoid further delay the case should not be remitted to the first instance.

It also contented that the respondent should have come to the oral proceedings prepared to argue the present case either way, that is according to whether the related European patent No. 311 240 were maintained or revoked.

- XI. The appellant (opponent) requested that the decision under appeal be set aside and that the European patent No. 353 036 be revoked.

The respondent (patentee) requested that the decision under appeal be set aside and the case remitted to the Opposition Division.

Reasons for the Decision

1. The appeal is admissible.
2. The Opposition Division acknowledged the inventive step of claim 1 of the patent in suit on the basis of step (c) of the claimed process. The resting step (b) was therefore said not to be relevant for inventiveness. In parallel decision T 828/95, rendered between the parties to the present case, the Board has now found that a claim having all the features of claim 1 of the patent in suit except a resting step is not inventive. Thus the finding of the Opposition Division in the

present case, that claim 1 of the patent in suit was inventive on the basis of its feature (c), also contained in claim 1 of parallel patent No. 0 311 240, and that the importance of the resting step was irrelevant, no longer holds good.

3. *Remittal to the first instance*

3.1 Although Article 111(1) EPC does not guarantee the parties right to have all the issues in the case considered by two instances, that may well be appropriate as regards essential issues. Hence, cases are often referred back, if essential questions regarding the patentability of the claimed subject-matter have not been examined and decided by the department of first instance.

In the present case the patent in suit and the related patent EP-B-311 240 were not considered independently at first instance. The Opposition Division decided that claim 1 of the patent in suit was patentable on the same grounds as that of the related patent EP-B-311 240. It did not therefore assess the relevance of the additional resting step (b) of the process of claim 1 of the patent in suit and of the comparative tests contained in its description. In view of the Board's decision to revoke EP-B-311 240, the resting step now falls to be considered as an essential substantive issue in the present case.

Moreover, document (31), which was only filed by the appellant in the appeal proceedings, could represent the closest state of the art if its date of availability to the public is clearly established.

3.2 The Board agrees in principle with the appellant's submissions that the respondent should have been prepared to argue the present case either way depending on whether the related European patent No. 311 240 was maintained or revoked and that procedural economy and avoidance of delay must be taken into account.

It is however the Board's judgement that, in the present case, such considerations should not take precedence over the possible consideration by two instances of essential and hitherto unconsidered issues.

As regards delay, it should be added that the appellant, by only filing document (31) - a brochure of its own - during the appeal proceedings, has to some extent itself contributed to delay in this case.

3.4 In view of the above the Board has reached the conclusion that, in the circumstances of the present case, it is appropriate to remit the case to the Opposition Division.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The decision of the Board of 23 September 1999 ordering the taking of evidence by the hearing of witnesses is set aside.
3. The case is remitted to the Opposition Division for further prosecution.

The Registrar:

The Chairman:

M. Dainese

P. Lançon

