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D E C I S I O N
of 15 February 2002

Case Number: W 0004/02 - 3.3.2

Application Number: PCT/GB 01/01928

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Language of the proceedings: EN

Title of invention:
Ambient stable beverage

Applicant:
HINDUSTAN LEVER LIMITED
UNILEVER PLC
UNILEVER NV

Opponent:
-

Headword:
Stable beverage/HINDUSTAN & UNILEVER

Relevant legal provisions:
EPC Art. 17(3)a
EPC R. 40

Keyword:
"Insufficient reasoning"

Decisions cited:
G 0001/89, W 0003/93

Catchword:
-



Case Number: W 0004/02 - 3.3.2
International Application No. PCT/GB 01/01928

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 15 February 2002

Applicant: HINDUSTAN LEVER LIMITED
UNILEVER PLC
UNILEVER NV

Representative: Baker, Colin, J.
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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 (International Searching Authority) dated 3 August 2001.

Composition of the Board:

Chairman: U. Oswald
Members: J. Riolo
B. Günzel

Summary of Facts and Submissions

I. The applicant filed an international patent application PCT/GB 01/01928 comprising a set of 19 claims, the independent claims of which read as follows:

"1. An ambient stable beverage that contains a preservative system that comprises cinnamic acid, one or more essential oils and one or more pasteurisation adjuncts that become fungicidal when activated by heat."

"19. A method for preparing an ambient-stable tea based beverage suitable for cold filing comprising adding cinnamic acid, one or more essential oils and one or more pasteurisation adjuncts that become fungicidal when activated by heat."

Claims 2 to 18 relate to preferred embodiments of the claimed beverage.

II. By the communication dated 3 August 2001, the European Patent Office, acting as an International Searching Authority (ISA), invited the applicant pursuant to Article 17(3)(a) and Rule 40.1 PCT to restrict the claims or to pay six additional preliminary examination fees.

Referring to document (1) (US-A-6042861), the ISA found the subject matter of claim 1 to be known from the prior art document (1), and inferred from this finding that there was lack of unity, the claims covering seven different inventions or groups of inventions:

Group 1: claims 1 to 19 in as far as they relate to non-aromatic C6 to C14 alcohols or esters of non-aromatic C6 to C14 carboxylic acids, as defined in claims 11 to 13, as pasteurisation adjuncts that become fungicidal when activated by heat.

Group 2: claims 1 to 19 in as far as they relate to benzoin, benzyl benzoate, isoamyl salicylate, benzyl salicylate, beta-caryophyllene or 2-phenoxyethyl isobutyrate as pasteurisation adjuncts that become fungicidal when activated by heat.

Group 3: claims 1 to 19 in as far as they relate to C6 to C14 aldehydes, as defined in claims 11 to 13, as pasteurisation adjuncts that become fungicidal when activated by heat.

Group 4: claims 1 to 19 in as far as they relate to C6 to C14 ketones, as defined in claims 11 to 13, as pasteurisation adjuncts that become fungicidal when activated by heat.

Group 5: claims 1 to 19 in as far as they relate to C6 to C14 lactones, as defined in claims 11 to 13, as pasteurisation adjuncts that become fungicidal when activated by heat.

Group 6: claims 1 to 19 in as far as they relate to C6 to C15 alcohols, as defined in claims 11 to 13, as pasteurisation adjuncts that become fungicidal when activated by heat.

Group 7: claims 1 to 19 in as far as they relate to C6 to C15 carboxylic acids, as defined in claims 11 to 13, as pasteurisation adjuncts that become fungicidal when

activated by heat.

- III. By its reply dated 31 August 2001, the applicant paid six additional search fees under protest pursuant to Rule 40.2(c) PCT.

In support of the protest, the applicant argued in its "Statement under Rule 40.2(c)" that document (1) did not disclose whether the membrane perturbors disclosed therein would become sufficiently fungicidal when activated by heat as required by the claimed invention, so that claims 1 to 19 complied with the requirement of unity of invention.

- IV. In a prior review pursuant to Rule 40.2(e) PCT dated 14 November 2001, the ISA found the invitation to pay additional fees to be justified and invited the applicant to pay the protest fee. In substance the Review Panel also considered that document (1) disclosed all the technical features of claim 1.

- V. By a letter of 23 November 2001, the applicants paid the protest fee according to Rule 40.2(e) PCT and submitted a "Supplemental Statement under Rule 40.2(e)" containing detailed arguments as to why document (1) did not anticipate the subject matter of claim 1. Consequently, it was held that claims 1 to 19 must be considered unitary.

Reasons for the Decision

1. General requirements of protest proceedings pursuant to Rule 40.2 PCT

- 1.1 Pursuant to Rule 40.2 PCT, the Board must examine the protest and, to the extent that it finds the protest justified, shall order the total or partial reimbursement to the applicant of the additional fees.
- 1.2 According to the established practice of the Boards of Appeal, the examination in protest proceedings has to be carried out in the light of the reasons given by the ISA in its invitation to pay additional fees under Rule 40.2 PCT and the applicant's submissions in support of the protest. The Board cannot investigate of its own motion whether an objection relating to non-unity of invention might be justified for other reasons not considered in the ISA's invitation to pay additional fees (see W 3/93, OJ EPO 1994, 931).
- 1.3. A complete and comprehensive reasoning in the ISA's invitation to pay additional fees is therefore mandatory. The necessity of setting out "a logically presented, technical reasoning containing the basic considerations behind the finding of lack of unity in accordance with Annex B to the Administrative Instructions" is underlined in the PCT Search Guidelines (see Chapter VII, 2(a), WIPO, edition 1998) which are binding on the EPO when acting as an ISA and on the Boards of Appeal when deciding on protests against the charging of additional fees (see G 1/89, OJ EPO 1991, 155, point 6).

2. *Sufficiency of reasoning in the ISA invitation*

- 2.1 In the present case, the ISA's invitation to pay additional fees is based on the allegation that document (1) discloses all the features of the subject matter of claim 1 (see item 2 of said invitation). This

allegation has been contested by the applicant in its above-mentioned "Statement" under Rule 40.2(c) PCT. Therefore, the Board has to examine the relevance of the prior art identified.

- 2.2 Although document (1) discloses an ambient stable beverage that contains a preservative system that comprises cinnamic acid, and one or more essential oils (eg Example 10), and recites that membrane perturber adjuncts can be added in order to increase the stability of the beverage (column 5, line 54 to column 6, line 8), this document is silent about the ability of the membrane perturber adjuncts to **become fungicidal when activated by heat**.

In the absence of any element in the ISA's invitation showing that the membrane perturber adjuncts described in document (1) nevertheless intrinsically possess this particular property and that the skilled person reading document (1) would be aware of that, the Board can only conclude that this functional feature of **becoming fungicidal when activated by heat** is either not disclosed in document (1) or was overlooked by the ISA when analyzing the features of the claimed invention.

In that respect, the Board notes also that the compounds specifically listed in the application (Table 1) as fulfilling this functional technical requirement are different from the ones disclosed in document (1) (column 5, line 54 to column 6, line 8).

As a matter of fact, the reasoning in the invitation to pay further fees does not consider the above-mentioned aspect at all and the communication of the Review Panel also merely states that "the membrane perturber of (D1)

is a pasteurisation adjunct in the sense of the present application" without any comment or explanation as to the functional feature of **becoming fungicidal when activated by heat**.

As stressed by the applicant in its letter dated 23 November 2001 (page 1, second paragraph) and as apparent from the application, this aspect is however a key feature of the claimed invention and, consequently, of the common inventive concept (see, page 3, lines 24 to 29 and page 11, line 35 to page 12, line 14).

This aspect should therefore have been dealt with in the reasoning of lack of unity of the invention. In the absence of such a reference, the objection raised does not comply with the requirements of Rule 40.1 PCT which stipulates that the invitation to pay additional fees "shall specify the reasons for which the international application is not considered as complying with the requirement of unity of invention", in that it is not sufficiently reasoned (see W 17/99 dated 13 January 2000).

- 2.3 The Board therefore finds the applicant's protest entirely justified so that the additional fees and the protest fee must be refunded in accordance with Rule 40.3(e) PCT.

Order

For these reasons it is decided that:

The additional search fees and the protest fee are to be

reimbursed.

The Registrar:

The Chairman:

E. Görgmaier

U. Oswald