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D E C I S I O N
of 11 April 2005

Case Number: W 0031/04 - 3.3.2

Application Number: PCT/NL03/00711

Publication Number: WO 2004/037004A2

IPC: A21D 8/04

Language of the proceedings: EN

Title of invention:
Encapsulated functional bakery ingredients

Applicant:
CSM Nederland B.V.

Opponent:

-

Headword:
Encapsulated functional bakery ingredients/CSM NEDERLAND

Relevant legal provisions:

EPC Art. 154(3)
PCT Art. 17(3)a
PCT R. 13.1, 40.1, 40.2

Keyword:

"Unity a posteriori (no) - Embodiment of claimed subject-matter anticipated"

Decisions cited:

-

Catchword:

-



Case Number: W 0031/04 - 3.3.2

International Application No. PCT/NL 03/00711

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 11 April 2005

Applicant: CSM Nederland B.V.
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Subject of this decision: Protest according to Rule 40.2(c) of the Patent Cooperation Treaty made by the applicants against the invitation (payment of additional fees) of the European Patent Office (International Searching Authority) dated 11 March 2004.

Composition of the Board:

Chairman: U. Oswald
Members: H. Kellner
B. Günzel

Summary of Facts and Submissions

I. The applicant filed an international patent application, No. PCT/NL 03/00711 (EP 03754312.1), comprising a set of 16 claims relating to granules (claims 1 to 10), a composition comprising granules (claims 11 and 12), the use of the composition (claim 13), a dough comprising the composition (claim 14) and methods of manufacturing the composition (claims 15 and 16). Claim 1 reads as follows:

"1. A granule suitable for use in the preparation of a dough, comprising:

- a. a hydrophilic core with a diameter of at least 5 μm , said core containing one or more functional bakery ingredients selected from the group of enzymes, oxidoreductants, acidulants, hydrocolloids, starches, yeast, sugars, water and flavours; and
- b. a lipophilic substantially continuous layer encapsulating the core, which layer contains at least 50 wt.% triglyceride fat with a slip melting point of at least 30°C and at least 1 wt.% of a release agent selected from the group of monoglycerides, diglycerides, diacetyl tartaric acid ester of mono- and/or diglyceride (datem), stearyl-lactylates and combinations thereof."

II. In its communication dated 11 March 2004, 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 pay eight additional search fees.

The ISA found that the subject-matter of the present application was concerned with a granule comprising a core containing one or more ingredients suitable for baking and being selected from nine different groups of compounds. This core was encapsulated with a lipophilic coating having a specific composition. The only technical feature common to all the different groups was the lipid-coated core. This lipid-coated core was disclosed in US-A-3 716 381 (1). Said document disclosed in its examples 1 to 4 the coating of sorbic acid, an acidulant, with a mixture of a hardened oil and a monoglyceride.

Hence, the ISA considered that claim 1 constituted nine different inventions:

Group 1: claims: 1-16 (granules comprising enzymes)

Group 2: claims: 1-16 (granules comprising oxidoreductants)

Group 3: claims: 1-16 (granules comprising acidulants)

Group 4: claims: 1-16 (granules comprising hydrocolloids)

Group 5: claims: 1-16 (granules comprising starches)

Group 6: claims: 1-16 (granules comprising yeast)

Group 7: claims: 1-16 (granules comprising sugars)

Group 8: claims: 1-16 (granules comprising water)

Group 9: claims: 1-16 (granules comprising flavours)

III. With its reply, dated 7 April 2004, the applicant paid two additional search fees under protest pursuant to Rule 40.2(c) PCT and requested that alleged invention groups 3 and 4 as defined by the ISA be searched.

In support of the protest, the applicant argued that the reference to nine specifically mentioned functional bakery ingredients in claim 1 merely served to clarify the meaning of the term "functional bakery ingredient". If claim 1 had simply referred to "one or more bakery ingredients", without further specifying these ingredients, it seemed unlikely that the current non-unity objection would have occurred.

Moreover, the nine "different inventions" identified by the ISA were linked by special technical features so as to form a single general inventive concept, the special technical features being the hydrophilic core containing one or more functional bakery ingredients and the lipophilic substantially continuous layer encapsulating the core.

Additionally, the definition of the invention as provided in claims 1 to 16 of the present application was deemed to be sufficiently specific to allow a search to be carried out for these claims without this requiring an undue effort from the ISA.

IV. In a prior review pursuant to Rule 40.2(e) PCT, dated 20 August 2004, the review panel of the ISA found the invitation to pay additional fees to be justified and invited the applicant to pay the protest fee.

In summary, the review panel agreed with the applicant's definition of the special technical features common to the different embodiments of claim 1 and stated that this corresponded to the opinion expressed by the ISA.

However, like the ISA, it found these features to be disclosed by document (1) and thus the requirements for unity not to be met.

V. With a letter of 16 September 2004, the applicant paid the protest fee according to Rule 40.2(e) PCT.

Reasons for the Decision

1. Under Article 154(3) EPC, the boards of appeal are responsible for deciding on the protest made by the applicant.
2. The protest complies with the requirements of Rule 40.2(c) PCT and is therefore admissible.
3. The relevant aspects of the general requirements for protest proceedings pursuant to Rule 40.2 PCT are as follows:

- 3.1 Pursuant to Rule 40.2 PCT, the board must examine the protest and, to the extent that it finds the protest justified, order the full or partial reimbursement to the applicant of additional fees, in so far as they were in fact paid and the payment was made under protest.
- 3.2 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.
4. The subject-matter of claim 1 of the application as originally filed represents a group of alleged inventions, since the claimed granule contains at least one of the "functional bakery ingredients" selected from a group of nine and thus each of these ingredients gives rise to one embodiment of claim 1.

The single general inventive concept linking a group of inventions is to be derived from the common features of the respective claims or embodiments. In the present case, these are all features of claim 1 except the specified examples for the "functional bakery ingredients".

Document (1) discloses

a granule (see column 1, lines 11 to 16), comprising:

a. a hydrophilic core (see example 1, lines 30 to 33)

with a diameter of at least 5 μm (see example 1, lines 20 to 22; this includes, for instance, a diameter of 20 μm),

said core containing one acidulant (see example 1, lines 20 and 32, sorbic acid); and

b. a lipophilic substantially continuous layer encapsulating the core (see example 1, lines 32 to 33),

which layer contains at least a triglyceride fat with a melting point of at least 30°C (see example 1, lines 22 to 24; hardened beef tallow representing more than 50 wt.% of the lipophilic layer; since the melting temperature of the hardened beef tallow is 60°C, it is beyond doubt for the person skilled in the art that the corresponding melting point, when measured according to the rules for establishing a slip melting point, will be situated above 30°C in any case)

and at least 1 wt.% of a release agent, for instance a monoglyceride (see example 1, lines 24 to 25; more than 1 wt.% glycerol monostearate).

The feature "suitable for use in the preparation of a dough" is not a distinguishing feature, since the granules disclosed in document (1) exhibit the same properties as the granules claimed in the present application and there is nothing to be seen that made them unsuitable for use in a dough.

5. All these findings in principle were already contained in the ISA's statement that the lipid-coated core, meaning the core, encapsulated with a lipophilic coating having a specific composition, with respect to the coated material sorbic acid, an acidulant, was disclosed by document (1), examples 1 to 4. Since, as was shown in detail under point 4 of this decision, all of the features of claim 1 of the present application are anticipated even by the single teaching of example 1 of document (1), it was not a problem for the person skilled in the art to recognise this information from the ISA's statement.

Additionally, from the circumstances of the present case, it was clear to the skilled person that the materials for the core, namely

- o enzymes,
- o acidulants and
- o hydrocolloids,

referred to by the applicant as the subject-matter of the searches to be made for the three search fees paid, are different from one another in a way that they would exhibit no special technical feature in common that could constitute a single general inventive concept.

Consequently, in accordance with the ISA's argumentation in the invitation to pay additional search fees, there remains no special technical feature that could define a contribution which any of the claimed inventions could make over the prior art.

6. The applicant's argument that the current non-unity objection would not have occurred, if claim 1 of the application had referred to "one or more bakery ingredients", instead of the nine functional bakery ingredients specifically mentioned, cannot succeed. Nor can the argument that it would have been no undue effort to the ISA to make a search for the subject-matter of the whole application without raising the non-unity objection.

As for the first argument, it is the mentioning of nine specific examples for the functional bakery ingredients in claim 1 (as if nine separate claims had been set out with respect to the nine ingredients) that defines a group of nine different teachings, each of them being explicitly specified, instead of a general teaching that could have been searched generally. Therefore it clearly does not matter that for the general teaching the objection of non-unity would not have occurred.

The second argument relates to Chapter VII-12 of the PCT International Search Guidelines (PCT Gazette No. S-06/1998) giving the possibility to the searching authority to search a group of inventions together and to include the result in the international search report, even if unity was not given. This regulation corresponds to a situation in which the search examiner is able to make a complete international search for more than one invention with negligible additional work. Nevertheless, it is fully within the examiner's discretion to decide on this matter and nothing has been submitted by the appellant to suggest that this discretion was misused in the present case. The board cannot find any such reasons either.

7. As regards the two additional search fees paid for the search of the inventions of groups 3 and 4, for the reasons given under points 4 and 5 of this decision, the board finds the applicant's protest not to be justified, so that the protest has to be dismissed.

Order

For these reasons it is decided that:

The protest is dismissed.

The Registrar:

The Chairman:

C. Eickhoff

U. Oswald