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**D E C I S I O N**  
**of 27 March 2006**

**Case Number:** W 0042/04 - 3.2.07

**Application Number:** PCT/NL03/00805

**Publication Number:** WO 05/047137

**IPC:** B65D 81/00

**Language of the proceedings:** EN

**Title of invention:**

Infusion container for tea or the like comprising a cover and  
infusion bag

**Applicant:**

MAGNA TERRA B.V.

**Opponent:**

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**Headword:**

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**Relevant legal provisions:**

EPC Art. 154

PCT Art. 16, 17(3)(a)

PCT R. 13.1, 13.2, 40.1, 40.2(c), 40.2(e)

**Keyword:**

"Lack of unity a posterior: (yes)"

**Decisions cited:**

-

**Catchword:**

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International Application No. PCT/NL03/00805

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.07  
of 27 March 2006

**Applicant:** MAGNA TERRA B.V.  
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**Decision under appeal:** 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  
19 July 2004.

**Composition of the Board:**

**Chairman:** H. P. Felgenhauer  
**Members:** K. Poalas  
C. Holtz

## Summary of Facts and Submissions

I. International patent application, No. PCT/NL03/0085 was filed with a set of 19 claims, claims 1 and 2 of which read as follows:

"1. Device for providing a drink from extracts, in particular tea extracts, comprising: at least one container for an extractable mixture which is at least partially permeable to drink, and a cover connected to the container, characterized in that the container is connected to the cover such that the mutual orientation of between the container and the cover can be changed between an active position, in which a substantial part of the container lies at a distance from the cover, and a non-active position, in which the container is at least substantially enclosed by the cover, and that the cover is provided with at least one incision for releasable fastening of the cover to a drink container, wherein the incision extends from a longitudinal edge of the cover at least partially in a direction away from the container oriented in active position."

"2. Device for extractable substances such as tea, particularly as claimed in claim 1, comprising at least one container for said extractable substances, in particular tea, which is wholly or partially permeable to water, and a cover connected to the container, which cover comprises at least two cover parts between which the container can be received, wherein at least one of the cover parts comprises a first and a second longitudinal edge which intersect at a corner point, wherein an incision extends in the or each associated cover part from the second longitudinal edge, which

incision comprises a first part which encloses an angle, or the tangent if which close to the second longitudinal edge encloses an angle with the second longitudinal edge, preferably such that said first part extends in the direction away from said corner point."

II. In its communication dated 19 July 2004 the European Patent Office, acting in its capacity as International Searching Authority (ISA) under Article 16 PCT and 154 EPC informed the applicant that the application did not comply with the requirement of unity of invention (Rule 13.1 PCT) and invited the applicant pursuant to Article 17(3)(a) and Rule 40.1 PCT to pay three additional search fees.

The ISA found that in view of the result of the partial international search the application consisted of four inventions.

First invention - claims 1 - 8, 9 (first part) and 10 - 14

The first invention was related to a device for providing a drink from an extract comprising a container part and a cover part, whereby an incision was provided on the cover part to fasten the cover to a cup or the like.

Second invention - claims 1, 2 and 9 (second part)

The second invention was related to a device for providing a drink from an extract comprising a container part and a cover part, whereby the container was connected to the cover via a thread.

Additionally two further inventions were identified relating to claims 1, 15, 16, 18, 19 and 1, 17, respectively.

With respect to the first and the second invention the ISA was of the opinion that the devices according to claims 1 and 2 lacked novelty with respect to documents D1, D2 or D3. Thus the features of these claims, being the features the first and the second invention have in common, could not be considered to be "special technical features".

III. With letter dated 18 August 2004 the applicant paid one additional search fee under protest pursuant to Rule 40.2(c) PCT and requested that an additional search be carried out with regard to the second invention.

IV. In support of the protest, the applicant argued that unity was given for the first and the second group of inventions.

The applicant requested reimbursement of the additional search fee.

V. The protest was reviewed in accordance with Rule 40.2(e) PCT by a review panel of the ISA. It held that the invitation to pay additional fees was justified and invited the applicant to pay a protest fee for further examination of the protest in accordance with Rule 40.2(c) PCT.

In summary, the review panel was of the opinion that claims 1 and 2 lacked novelty and that the remaining relevant features of the first and the second invention

not known from the prior art solved separate non-related problems.

VI. The applicant paid the protest fee.

VII. The applicant's arguments set out in the letter dated 18 August 2004 can be summarised as follows:

(i) Claim 1 is novel and based on inventive step since none of the cited documents discloses a device having a cover provided with an incision. The known devices have covers provided with a slot and not an incision.

(ii) Even if claim 1 is considered as lacking novelty the first and the second invention still would be based on the same single inventive concept resulting from the provision of a cover adapted to enclose the container at least substantially and the incision resulting in a minimised interruption of the cover.

### **Reasons for the Decision**

1. The protest complies with the requirements of Rule 40.2(c) PCT and is therefore admissible.
2. The applicant has paid one additional search fee for the ISA to carry out a search for the second invention according to claims 1, 2, 9 (second part) and requested that the unity of invention concerning the first and the second invention be acknowledged and that the additional search fee be refunded.

2.1 With respect to the request of the applicant and to the ISA's invitation to pay additional search fees, it has to be decided whether or not the first and the second invention do have a single general inventive concept in common.

2.2 Concerning the first and the second invention the ISA's invitation to pay additional fees was based on the finding that the devices according to claims 1 and 2 lack novelty with respect to documents

D1: WO-A-94/05549

D2: JP-A-1080362

D3: US-A-3 047 397.

The remaining relevant features of the first invention comprising claims 1 - 8, 9 (first part) and 10 - 14 not known from the prior art were considered as solving the problem of connecting the device to a cup in a simplified manner.

The remaining relevant features of the second invention comprising claims 1, 2 and 9 (second part) not known from the prior art were considered as solving the problem of facilitating the reinsertion of the container in the cover part after the immersion process.

Consequently the technical relationship required by Rule 13.2 PCT between the first and the second invention has been considered as lacking and the requirement for unity of invention according to

Rule 13.1 PCT has been considered as not being fulfilled.

2.3 The board sees no justification for a different opinion.

Document D1 discloses a device for providing a drink from extracts comprising at least one container 25 (page 5, lines 33, 34; figures 1 - 5), a cover 22, 22' connected to the container (cf. page 5, line 31 - page 6, line 3; figures 1 - 5) such that the mutual orientation between the container and the cover can be changed between an active position and a non active position (cf. page 7, lines 1 - 5; page 8, line 32 - page 9, line 2; figures 4, 5, 6 versus figures 9A, 9B), wherein the cover is provided with at least one incision, the incision extending from a longitudinal edge of the cover at least partially in a direction away from the container oriented in active position (cf. page 5, lines 12 - 14; page 6, lines 6 - 9; page 8, lines 21, 22; figures 1, 3, 4, 6). Consequently the device according to claim 1 lacks novelty with respect to D1.

In this connection it needs to be considered that, contrary to the opinion expressed by the appellant, no distinction can be made between the slots 11, 11', 21 and 21' according to D1 and the slits according to claim 1. The reason is that, according to D1, these slots may be narrow cuts, including slits, in leaves 12, 12', 22 and 22' respectively (cf. page 8, lines 21, 22) and that in this context a slit and an incision impose the same modification on a cover of the kind concerned.



The device according to claim 2 lacks novelty with respect to D1 for the reasons given above with respect to claim 1 considering in addition that the device according to D1 likewise comprises two cover parts 12, 12' (page 5, lines 14, 15; figures 1, 2) and an incision comprising a first part as defined in claim 2 (cf. figures 3, 6, 9A, 9B in connection with page 8, lines 21, 22).

Thus, the ISA's statement that claims 1 and 2 lack novelty and that a technical relationship, between the first invention relating to claims 1 - 8, 9 (first part) and 10 - 14 and the second invention relating to claims 1, 2 and 9 (second part) involving one or more of the same or corresponding special technical features, does not exist, is considered to be correct.

Consequently the feature relating to the cover being provided with an incision is, contrary to the view expressed by the appellant, not a special technical feature defining a contribution of the first and the second invention over the prior art. Thus irrespective of the provision of an incision serving the same purpose in the device according to the first and the second invention, such a feature cannot link these two inventions in the sense of a single general inventive concept.

3. Therefore, the alleged unity of the first and the second invention according to the applicant's letter dated 18 August 2004 cannot be acknowledged.

4. As regards the additional search fee paid for searching the second group of invention, for the reasons given in point 4 above, the board finds the applicant's protest not to be justified, so that the protest has to be dismissed.

Since the protest is not successful, there can be no refund of the fee for the examination of the protest.

### **Order**

**For these reasons it is decided that:**

The protest is dismissed.

The Registrar:

The Chairman:

G. Nachtigall

H.-P. Felgenhauer