

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

**Datasheet for the decision
of 30 November 2010**

Case Number: T 0105/09 - 3.2.07

Application Number: 04250381.3

Publication Number: 1440910

IPC: B65B 81/00

Language of the proceedings: EN

Title of invention:

System and method for the preparation of beverages

Patentee:

Kraft Foods R&D, Inc.

Opponents:

Mars, Incorporated
NESTEC S.A.

Headword:

-

Relevant legal provisions:

EPC Art. 54, 106(1), 111(1), 123(2)

Relevant legal provisions (EPC 1973):

-

Keyword:

"Admissibility of the 1st auxiliary request (yes)"
"Remittal of the 1st auxiliary request (no)"
"Novelty: claim 1 of the 1st auxiliary request (no)"
"Allowability of the amendments: 5th auxiliary request (yes)"
"Remittal of the 5th auxiliary request (yes)"

Decisions cited:

T 0123/85, T 0915/98, T 0755/00, T 0133/87, G 0009/91,
G 0010/91

Catchword:

-



Case Number: T 0105/09 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 30 November 2010

Appellant:
(Patent Proprietor)

Kraft Foods R&D, Inc.
(a Delaware corporation)
Bayerwaldstrasse 8
D-81737 Munich (DE)

Representative:

Thomson, Neil David
Boulton Wade Tennant
Verulam Gardens
70 Gray's Inn Road
London WC1X 8BT (GB)

Respondent I:
(Opponent I)

Mars, Incorporated
6885 Elm Street
McLean, Virginia 22101 (US)

Representative:

James, Anthony Christopher W.P.
Carpmaels & Ransford
On Southhampton Row
London WC1B 5HA (GB)

Respondent II:
(Opponent II)

NESTEC S.A.
Avenue Nestlé 55
CH-1800 Vevey (CH)

Representative:

Beder, Jens
Mitscherlich & Partner
Patent- und Rechtsanwälte
Sonnenstraße 33
D-80331 München (DE)

Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted 30 December 2008
revoking European patent No. 1440910 pursuant
to Articles 101(2) and 101(3)(b) EPC.**

Composition of the Board:

Chairman: H. Meinders
Members: K. Poalas
E. Dufrasne

Summary of Facts and Submissions

- I. The appellant (patent proprietor) lodged an appeal against the decision of the Opposition Division revoking the European patent No. 1 440 910.
- II. Two oppositions (opponents I and II) had been filed against the patent as a whole based on Article 100(a) EPC on the grounds of lack of novelty (Article 54 EPC) and lack of inventive step (Article 56 EPC).
- III. The Opposition Division found that the subject-matter of claim 1 according to the main, first and second auxiliary requests does not meet the requirements of Article 100(c) EPC (unallowable amendments; Article 123(2) EPC).
- IV. The following document is mentioned in the present decision:
- D2: WO-A-02 19 875.
- V. Oral proceedings before the Board took place on 30 November 2010.
- (a) The appellant requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the set of claims filed as 1st auxiliary request, or alternatively, on the basis of the set of claims filed as new 5th auxiliary request.

(b) The respondents I and II (opponents I and II) requested that the appeal be dismissed.

VI. Independent claim 1 according to the 1st auxiliary request being identical with claim 1 of the patent as granted, besides some minor punctuation amendments, reads as follows:

"A beverage preparation system comprising a beverage preparation machine (201) having means for receiving a range of beverage cartridges (1) and means for passing an aqueous medium through said beverage cartridges; a first beverage cartridge (1) containing one or more beverage ingredients (200) for preparing a first portion of a beverage; and a second beverage cartridge (1) containing one or more beverage ingredients (200) for preparing a second portion of that beverage, characterised in that one of the first or second beverage cartridges contains a liquid dairy-based ingredient".

Independent claims 1 and 2 according to the new 5th auxiliary request read as follows (amendments over claims 1 and 2 as granted are depicted in bold):

"1. A beverage preparation system comprising a beverage preparation machine (201) having means for receiving a range of beverage cartridges (1) and means for passing an aqueous medium through said beverage cartridges, a first beverage cartridge (1) containing one or more beverage ingredients (200) for preparing a first portion of a beverage, and a second beverage cartridge (1) containing one or more beverage ingredients (200) for preparing a second portion of that beverage,

characterised in that one of the first or second beverage cartridges contains a liquid dairy-based ingredient, **and wherein said cartridge (1) containing said liquid dairy-based ingredient comprises means for foaming the beverage portion formed from said liquid dairy-based ingredient, said means for foaming comprising an aperture (128) of said cartridge (1) through which said beverage portion is forcible as a jet into an expansion chamber so as to pass directly over an air inlet (71) of said cartridge (1) so as to entrain air from said air inlet (71) into said jet".**

"2. A method of preparing a beverage comprising the steps of:

- a) inserting a first beverage cartridge (1) containing one or more beverage ingredients (200) into a beverage preparation machine (201);
- b) operating said beverage preparation machine to pass an aqueous medium through the first beverage cartridge to dispense a first portion of said beverage into a receptacle;
- c) inserting a second beverage cartridge (1) containing one or more beverage ingredients (200) into the beverage preparation machine; and
- d) operating the beverage preparation machine to pass an aqueous medium through the second beverage cartridge to dispense a second portion of said beverage into the receptacle;

characterised in that one of the first or second beverage cartridges contains a liquid dairy-based ingredient **and further comprising the step of foaming the liquid dairy-based ingredient during dispensation, wherein said step of foaming is achieved by said cartridge (1) containing said liquid dairy-based**

ingredient comprising means for foaming the beverage portion formed from said liquid dairy-based ingredient, said means for foaming comprising an aperture (128) of said cartridge (1) through which said beverage portion is forced as a jet into an expansion chamber so as to pass directly over an air inlet (71) of said cartridge (1) so as to entrain air from said air inlet (71) into said jet".

VII. *Procedural matters*

During the oral proceedings the Board, concurring with the impugned decision, established after discussion with the parties that the amendments carried out in the opposition proceedings to claim 1 according to the main request did not meet the requirements of Article 123(2) EPC. Thereupon respondent I requested not to admit the appellant's 1st auxiliary request into the appeal proceedings. After discussion the 1st auxiliary request was admitted into the appeal proceedings. The appellant then requested the remittal of the case with the claims of that request to the opposition division for considering novelty and inventive step. After the discussion of this request, the Board decided to not remit the case to the opposition division. After the discussion of novelty it found that the subject-matter of claim 1 of this request did not meet the requirements of Article 54 EPC. The appellant then withdrew its main request as well as the 2nd to 4th auxiliary requests filed in the written appeal proceedings. After discussion the Board found further that claims 1 and 2 of the new 5th auxiliary request met the requirements of Article 123(2) EPC. Subsequently the Board, in accordance with the requests

of all parties, remitted the case to the opposition division for further prosecution.

VIII. The appellant argued essentially as follows:

Admissibility of the 1st auxiliary request

The 1st auxiliary request was filed in the appeal proceedings at the earliest possible moment, namely together with the grounds of appeal. The filing of said request was the appellant's reaction to the impugned decision revoking its patent.

Remittal of the 1st auxiliary request to the opposition division

The appellant was not able to file an appeal based on the ground of novelty, as it was not part of the impugned decision. As the framework of the appeal is determined by the decision under appeal and the appeal itself, novelty cannot be examined nor decided on by the Board.

The Board was not correct in assuming in its preliminary opinion that the provisional opinion of the opposition division would be identical with the division's final decision concerning the novelty issue.

According to Article 106(1) EPC an "appeal shall lie from decisions of the Receiving Section, Examining Division, Opposition Division and the Legal Division". According to Rule 99(2) EPC in "the statement of grounds of appeal the appellant shall indicate the reasons for setting aside the decision impugned, or the

extent to which it is to be amended, and the facts and evidence on which the appeal is based". According to Article 111(1), second sentence, EPC the "Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution". There is clearly a conflict between Articles 111(1) and 106(1) EPC, if the former would allow examination of issues which are excluded from the appeal proceedings by the latter.

The appellant has the legitimate and fundamental right to challenge the grounds on which a decision of a department of first instance is based through two instances.

The opposition division did not decide upon the ground of novelty for the claims of this request. Under these circumstances, established case law suggests that the case should be remitted. In T 915/98 (not published in OJ EPO, see point 6 of the Reasons) for example, since the opposition division had not decided nor given a reasoned opinion, on the questions of novelty and inventive step, the deciding Board felt it had no choice but to remit the case.

Since there is no first instance decision concerning lack of novelty there has been no fair hearing on this issue. The appellant cannot be deprived of this right to be heard just for the sake of not lengthening the proceedings.

The 1st auxiliary request should therefore be remitted to the opposition division.

*Claim 1 of the 1st auxiliary request - Novelty,
Article 54 EPC*

There is no specific disclosure in D2 of first and second beverage cartridges of which one contains a liquid dairy-based ingredient.

The examples provided in D2 on pages 14, 17 and 18 all relate to powdered ingredients and the use of just one sachet.

The only part of D2 mentioning "liquid milk" together with the problems resulting from the use of steam in connection with liquid milk, whereby the steam is not supplied under pressure, is on page 3, lines 25 to 29.

On page 14, lines 11 to 17 dairy and non-dairy whiteners together with a partially or completely dehydrated dairy or non-dairy milk product, such as a milk powder or granulate, are mentioned.

According to page 18, lines 11 and 12 the sachet contains a solid beverage brewing ingredient and/or foam forming ingredient.

On page 19, lines 4 to 6 "concentrated milk" is mentioned. Since the term "powder" is positioned after the expression "concentrated milk", such milk has to be in powder form. In any case, the above mentioned sentence cannot be read as unambiguously disclosing liquid milk.

According to page 20, lines 1 to 5 at least one beverage brewing sachet comprises a first sachet containing a foamable dehydrated milk and a second sachet containing a coffee or tea brewing ingredient. Liquid milk is also not mentioned here.

The author of D2 uses the expression "milk" when he means "whitener", i.e. a dairy product in powder form.

The skilled person has to combine different parts of D2 in order to arrive at the subject-matter of claim 1, which one cannot do when attacking novelty.

Independent claims 1 and 2 of the new 5th auxiliary request - Amendments, Article 123(2) EPC

Support for the foaming means mentioned in claims 1 and 2 is to be found in paragraphs [0052] and [0073] of the published patent application. It is not necessary to introduce all the features of the corresponding second and fourth versions of the cartridge into claims 1 and 2. It is sufficient to introduce only the essential features needed for foaming.

Remittal of the new 5th auxiliary request

Since independent claims 1 and 2 of the 5th auxiliary request involve new features extracted from the description and novelty and inventive step for said claims have not been decided upon by the opposition division the case should be remitted for further prosecution.

IX. The respondents I and II argued essentially as follows:

Admissibility of the 1st auxiliary request

The 1st auxiliary request should not be admitted into the proceedings because it has not been presented timely as it could easily have been submitted or maintained in the opposition proceedings, with the additional benefit that the impugned decision would then have dealt with it. The consideration of this request would significantly delay the procedure. The filing of said request during the appeal proceedings constitutes an abuse of the procedure which aims at delaying intentionally the procedure by necessarily remitting the case back to the opposition division whatever the decision on appeal will be.

Furthermore, this practice deeply affects the legal security for third parties because in principle the patent is revoked and the only point in consideration for the appeal should be whether the opposition division's decision is confirmed or reversed, both only on the elements discussed before the opposition division.

Remittal of the 1st auxiliary request to the opposition division

After the opposition division found during the oral proceedings that the subject-matter of claim 1 according to the present main request does not meet the requirements of Article 123(2) EPC the appellant had the opportunity to file additional auxiliary requests. The appellant, by refraining to do so, demonstrated

that it was clearly not interested in having its complete case examined by the opposition division, abandoning thereby the possibility of having its requests subjected to two instances. The case based on the 1st auxiliary request therefore should not be remitted to the opposition division.

*Claim 1 of the 1st auxiliary request - Novelty,
Article 54 EPC*

D2 discloses a beverage preparation system comprising a beverage preparation machine having means for receiving a range of beverage cartridges and means for passing an aqueous medium through the beverage cartridges, a first beverage cartridge containing one or more beverage ingredients for preparing a first portion of a beverage, and a second beverage cartridge containing one or more beverage ingredients for preparing a second portion of that beverage, see page 20, lines 1 to 5 and claim 60. Moreover, D2 discloses that one beverage brewing ingredient can be a concentrated milk or cream, see page 19, lines 4 to 6. The term "concentrated milk" is used therein in its usual sense of a liquid milk concentrate. This is evident also because "milk powder" is listed separately as an alternative ingredient. Furthermore, cream is certainly a liquid dairy-based ingredient.

Thus, D2 discloses and anticipates a beverage preparation system according to claim 1.

Independent claims 1 and 2 of the new 5th auxiliary request - Amendments, Article 123(2) EPC

Given the fact that milk foaming means are only mentioned in the "second" and "fourth" cartridge embodiments, that according to the corresponding paragraphs [0050] to [0052] and [0067] to [0073] of the published application the air inlet 71 is provided in the annular flange 47 and the expansion chamber is formed by the upper end of the discharge spout 43 and that neither this required annular flange nor the fact that the expansion chamber is necessarily formed by the upper end of the discharge spout are mentioned in claims 1 and 2, said claims do not meet the requirements of Article 123(2) EPC.

No objections under Article 123(3) EPC are raised.

Remittal of the new 5th auxiliary request

Since independent claims 1 and 2 of the 5th auxiliary request involve new features extracted from the description and novelty and inventive step for said claims have not been decided upon by the opposition division the case should be remitted for further prosecution.

Reasons for the Decision

1. *Admissibility of the 1st auxiliary request*

- 1.1 Claim 1 of the 1st auxiliary request is identical with claim 1 of the patent as granted besides some minor

punctuation amendments. Said request was filed in the appeal proceedings together with the grounds of appeal. The filing of said request can be seen as the appellant's reaction to the opposition division's decision revoking its patent.

1.2 In numerous decisions, stemming from decision T 123/85 (OJ EPO 1989, 336), the Boards of Appeal have permitted an appellant-patent proprietor, whose patent has been revoked, to seek maintenance of the patent as granted even though its main request before the opposition division had only been the maintenance of the patent in more limited form. There is nothing in principle to prevent a patent proprietor from later seeking to amend its request so as to request for the patent to be maintained in the form as granted (or in other, less limited terms), either in the course of proceedings before the opposition division or on appeal. In this respect the Board concurs with decision T 755/00 (of 18 October 2002, not published in OJ EPO, see points 5 to 9 of the Reasons). The exception to this principle is where it would amount to an abuse of procedure to allow the patent proprietor to revert to the granted claims.

1.3 In the present case both oppositions sought revocation of the patent as a whole. Originally the proprietor had requested the rejection of the oppositions, i.e. the maintenance of the patent as granted. The opposition division summoned to oral proceedings with a preliminary opinion that the systems of claims 1 and 2 of the patent as granted did not present novelty. The patent proprietor then sought maintenance of the patent in amended form, which was then rejected for the amendments not complying with Article 123(2) EPC. In

the appeal proceedings, the 1st auxiliary request, reverting back to essentially the claims as granted, was filed together with the grounds of appeal. It is not difficult to understand that this request clearly overcomes at least the reasons for the impugned decision, which manner of proceeding can hardly be seen as an abuse of procedure.

1.4 The objection of respondent II that the admittance of this request into the appeal proceedings would lead to an unacceptable delay of the present proceedings, due to the unavoidable remittal of this request to the opposition division, becomes moot due to the Board's conclusion not to remit the case with said request, see point 2 below.

1.5 Respondent II argued that the only point in consideration for the appeal should be whether the impugned decision is confirmed or has to be reversed, but only on the elements discussed before the opposition division. Consideration of any other point would "create a serious uncertainty for the third party's legal security".

This means to the Board that the appellant - patent proprietor would not have the right to file in the appeal proceedings any claims other than the ones dealt with in the impugned decision, or more limited ones: the extent of the protection defended ultimately for the decision under appeal would constitute the upper limit of what could come out of the appeal proceedings.

The Board cannot concur with this, as it would amount to an abandonment of subject-matter for which there is

no basis, unless it has been clearly presented as such at the time. That is not the case here.

Secondly, until the final decision in the appeal proceedings (which are a continuation of the opposition proceedings) the legal security for the parties continues to find its limits in the form of the claims of the patent as granted, which would have been the result if the oppositions had been rejected. The requirements of Article 123(3) EPC make sure that third parties are never affected worse than that.

- 1.6 For the above mentioned reasons, the request of respondent II not to admit the appellant's 1st auxiliary request into the proceedings is refused.
2. *Remittal of the 1st auxiliary request to the opposition division*
 - 2.1 After having its 1st auxiliary request admitted into the appeal proceedings the appellant requested the remittal of the case on the basis of this request to the opposition division for considering novelty and inventive step.

The appellant took the position that the framework within which the Board could operate in this respect was determined by its appeal filed pursuant to Article 106(1) EPC. As the decision under appeal was limited to the question of inadmissible amendment it was negatively affected only in that respect and could only appeal to that extent. As a consequence the Board's examination of the appeal pursuant to Article 110 EPC and its decision on the appeal pursuant to

Article 111(1), first sentence, EPC were limited to this issue only.

- 2.2 The Board cannot concur with this. Article 106(1) EPC stipulates that appeals lie from decisions. This means that the framework of the appeal is determined by the final result of the decision, rather than by the grounds of such a decision.

When the impugned decision revokes the patent, as it is the case here, the whole case is before the Board and the jurisdiction of the present Board therefore extends from allowing the appeal according to the appellant's requests (setting aside the decision under appeal and remitting the case to the opposition division as the objections under Article 123(2) EPC of the impugned decision have been overcome) on the one hand, to dismissing it on the other hand, which is not less than what was denied to the appellant by the opposition division, nor different from what the respondents request. There thus cannot be here a case of "*reformatio in peius*".

- 2.3 The appellant argued that there was a contradiction between what is stipulated in Article 106 EPC on the one hand, and Article 111(1), second sentence, EPC on the other. The first mentioned determined clearly for the appellant, the Board and the other parties to stay within the boundaries set by the reasons of the decision appealed and the appeal filed against it. The second appeared to open up for the Board the possibility to move outside of these boundaries, whereas the parties had to stay within.

2.4 Point 2.2 above has dealt with the question as to what constitutes the framework of the appeal. In that respect the Board cannot see a contradiction with Article 106 EPC arising out of Article 111(1), second sentence, EPC as it clearly further defines the two possibilities the Board has within its - broader than wished for by the appellant - jurisdiction: it can deal with the outstanding issues of the opposition proceedings itself or remit the case for further prosecution to the opposition division.

Naturally, limits on the Board's jurisdiction are set by the original extent of opposition and the grounds of opposition raised by the opponent(s) and/or the opposition division itself (G 9/91 and G 10/91, OJ EPO 1993, 408 and 420).

The ground of opposition for lack of novelty has been raised in the oppositions against claim 1 of the patent as granted, therefore the Board is not stepping out of its bounds here either.

2.5 The appellant takes the position that it has the legitimate and fundamental right to have a reasoned written decision by two instances on its request. As the request was not decided upon in the decision under appeal, the case should be remitted to the opposition division to address that issue in a decision, so that the appellant could properly challenge this decision on appeal. A legal basis for this position, however, could not be produced.

2.6 The Board has no knowledge of any such requirement in the European Patent Convention, nor its Implementing

Regulations. The consistent case law of the Boards of Appeal, to the contrary, is that there is no absolute right to two instances (see e.g. T 133/87 of 23 June 1988, not published in OJ EPO, point 2 of the Reasons), i.e. for having each and every issue decided by two instances. This is all the more evident in view of the discretion established for the Boards of Appeal, by virtue of Article 111(1), second sentence, EPC to exercise **any** power within the competence of the department which was responsible for the decision appealed, or to remit the case for further prosecution.

2.7 The appellant contended that it was established case law to remit a case to the department of first instance for the issue of novelty, if that issue had not been dealt with in the decision appealed. In support it referred to T 915/98 (*supra*).

2.8 The present Board is not aware of any case law fit to be applied to the circumstances of this case. It is these circumstances which determine the Board's exercise of discretion. The case referred to in this respect is not an appropriate example, as the circumstances are already different. The deciding Board states in point 6 of the Reasons of said decision that "[h]ad the Opposition Division decided - or at least given **a reasoned opinion** - also on the questions of novelty and inventive step, the Board may well have been able to take a final decision on the case at this point instead of having to remit it" (emphasis added by the Board).

In the present case, however, the opposition division has given **a reasoned opinion** on the question of novelty

in its annex to the summons to oral proceedings. This is not affected by its presentation as a preliminary opinion. Thus, the conditions set by the Board in that decision to be fulfilled for not remitting the case are perfectly met.

2.9 The appellant argued further that the Board incorrectly assumed in its preliminary opinion that the opposition division would have confirmed its provisional opinion on the novelty issue in its final decision. However, that opinion was non-binding on the division and could have changed in the light of further submissions and the discussion at the oral proceedings.

2.10 The appellant's assumption appears to be based on the premise that the Board is limited in its present examination of the appeal to what has been (or to what could have been) decided by the opposition division. Article 111(1), second sentence, EPC and points 2.2, 2.4 and 2.6 above show that that premise does not apply in the opinion of the Board.

What could have happened in the opposition proceedings, had the request been maintained is insofar irrelevant, as the Board in its own examination of the appeal had come to the same preliminary result as the opposition division; no more, no less.

2.11 Finally the appellant argued that in the written proceedings also respondent I was initially in agreement with a remittal to the opposition division and that respondent II had not expressed an opinion on this matter. Therefore the Board should not of its own motion refuse to remit the case.

2.12 The Board notes that respondent II had taken an even stronger standpoint, namely that the auxiliary requests should not even be admitted. To construe this as a tacit consent in the written proceedings to a remittal would go too far. Further, it is the Board which considers what is appropriate as regards the exercise of its discretion in view of the circumstances of the case, to which the parties may provide their views. In the present case the Board finds it appropriate for efficient proceedings to deal with the question of novelty of the subject-matter of claim 1 of the 1st auxiliary request itself, and to examine the remaining request for compliance with the requirement the infringement of which led to the impugned decision: the admissibility of the amendments (Article 123(2) and (3) EPC).

2.13 The request to remit the case with the claims of the 1st auxiliary request to the opposition division is therefore refused.

3. *Claim 1 of the 1st auxiliary request - Novelty, Article 54 EPC*

3.1 The appellant argued that the subject-matter of claim 1 differs from the beverage preparation system known from D2 in that the latter does not disclose
a) a first and a second beverage cartridge, and that
b) one of these cartridges contains a liquid dairy-based ingredient.

3.2 Feature a):

Claim 60 of D2, which depends on claim 58, is directed to a system for brewing beverages having in addition to the system according to claim 58 the feature that the beverage brewer comprises a second clamp for holding a second sachet for simultaneous or sequential brewing of first and second beverage components from the first and second sachets. Given the fact that the term "sachet" used in D2 is a term under which a "cartridge" can also be subsumed, which fact hasn't been questioned by the appellant during the present proceedings, said first and second sachets can be seen as being the first and second beverage cartridges in the sense of claim 1, namely cartridges containing brewing ingredients.

Feature a) is therefore known also from D2.

3.3 Feature b):

On page 19, lines 4 to 6 of the general part of the description of D2 a list of the beverage brewing ingredients used in the claimed beverage preparation systems is given. Under the ingredients listed therein are "concentrated milk", "cream", "creamer" and "milk powder". The Board considers that the separate listing of the above mentioned terms one after the other and separated by commas makes it evident to the person skilled in the art that the term "milk powder" is mentioned in order to document the use of milk in non-liquid form, i.e. powder in such systems, in contrast to the term "concentrated milk" which is used to document the use of milk in liquid form in such systems.

- Thus, feature b) is also known from D2.
- 3.4 The appellant argued that the term "liquid dairy-based ingredient" is not expressly mentioned in the above cited passage of D2, nor can it be derived from this passage, since the word "powder" could qualify all four ingredients.
- 3.5 The Board cannot follow the appellant's argument for the following reasons: Firstly, a breaking down of the above cited passage according to the appellant's argumentation would result in the following four discrete products "concentrated milk powder", "cream powder", "creamer powder" and "milk powder". A separate mentioning of "concentrated milk powder" and "milk powder" and also mentioning at the same time "cream powder" does not seem coherent. Secondly, in order to consider these four products mentioned by the appellant as being in powder form the expression to be used should have been for example in the form that the "beverage brewing ingredient may comprise powder of concentrated milk, cream, creamer and milk ...", which is not the case.
- 3.6 The other references in D2 to powdered milk etc. are of no consequence for the above passage, as it clearly denominates the ingredients which can be used in the claimed system and method.
- 3.7 For its allegation that the reference on page 3, lines 27 to 29 of D2 to the cross-contamination and hygiene problems generated due to the use of a steam wand immersed in liquid milk implies that any other mentioning of milk in D2 implicitly means "powder milk"

or "whitener" the appellant was not able to present any textual support in D2. The above mentioned passage on page 3 is part of the discussion of the problems of the therein discussed prior art, said problems being targeted and solved by the invention of D2, see page 5, lines 5 to 7. Therefore, the Board finds that this argument cannot hold either.

- 3.8 The appellant argued further that the disclosure destroying novelty was pieced together in an unallowable manner from different parts of D2 in order to arrive at the subject-matter of claim 1.

The Board cannot follow this since only what is needed to arrive to the subject-matter of claim 1 is to use the beverage brewing ingredient "concentrated milk" suggested for use with such brewing systems on page 19, lines 4 to 6 of D2 in the system known from claim 60 of D2.

- 3.9 For the above mentioned reasons, the subject-matter of claim 1 is not new and the requirements of Article 54 EPC are not met.

4. *Independent claims 1 and 2 of the new 5th auxiliary request - Amendments, Article 123(2) and (3) EPC*

- 4.1 Claim 1 according to the new 5th auxiliary request differs from claim 1 of the 1st auxiliary request by the additional feature that the cartridge containing the liquid dairy-based ingredient comprises "means for foaming comprising an aperture of said cartridge through which said beverage portion is forcible as a jet into an expansion chamber so as to pass directly

over an air inlet of said cartridge so as to entrain air from said air inlet into said jet".

Claim 2 according to the new 5th auxiliary request differs from claim 2 as granted by the additional step that the liquid dairy-based ingredient is foamed during dispensation which is achieved with the cartridge comprising "means for foaming comprising an aperture of said cartridge through which said beverage portion is forced as a jet into an expansion chamber so as to pass directly over an air inlet of said cartridge so as to entrain air from said air inlet into said jet".

Support for the foaming means mentioned in claims 1 and 2 is to be found on page 22, line 8 to page 23, line 8 and page 30, lines 16 to 30 of the application as originally filed.

4.2 The respondents argued that given the fact that milk foaming means are only mentioned in the "second" and "fourth" cartridge embodiments and that according to the corresponding paragraphs in the description of the application as originally filed the air inlet 71 is provided in the annular flange 47 and the expansion chamber is formed by the upper end of the discharge spout 43. However, neither the annular flange nor the fact that the expansion chamber is formed by the upper end of the discharge spout are mentioned in claims 1 and 2, so that said claims do not meet the requirements of Article 123(2) EPC, as the amendments have been singled out from these mentioned other features.

4.3 The Board cannot follow these arguments for the following reasons: The skilled person derives from the

relevant paragraphs on page 20, lines 29 to page 23, line 8 and page 27, line 30 to page 30, line 30 of the application as filed, in application of his technical knowledge in this field, that in order to produce foaming of a liquid said liquid has to come into contact with pressurised air in a confined space and to have also the possibility of expanding into an expansion chamber. Accordingly, the features mentioned in claims 1 and 2 of the present request, namely the presence of an aperture in order to force the liquid ingredient into an expansion chamber so as to pass directly over an air inlet of said cartridge so as to entrain air from said air inlet into said jet, are the only essential technical features needed for achieving foaming of said liquid. The Board considers that the positioning of the air inlet in the annular flange and the formation of the expansion chamber by the upper end of the discharge spout are design solutions for adapting the air inlet and the expansion chamber to the configuration of the cartridges, but are not described as having any necessary functional or structural relationship with the features related to the action of foaming. Consequently, said features do not need to be present in claims 1 and 2 of the 5th auxiliary request.

4.4 Thus, claims 1 and 2 of the 5th auxiliary request meet the requirements of Article 123(2) EPC. The respondents have not raised objections under Article 123(3) EPC and the Board has no reason to see it differently.

5. *Remittal of the case with the claims of the new 5th auxiliary request*

Given the fact that the independent claims 1 and 2 of

the new 5th auxiliary request meet the requirements of Article 123(2) and (3) EPC, that these claims now involve added features extracted from the description, that a beverage preparation system and a method for preparing a beverage having means for foaming as claimed in claim 1 and 2 of the present request have not been examined by the opposition division and that all parties have requested remittal of the case to the department of first instance, the Board in applying its discretion according to Article 111(1) EPC decides to remit the case to the opposition division for further prosecution on the basis of the new 5th auxiliary request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution on the basis of the new 5th auxiliary request.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders