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**Datasheet for the decision
of 20 November 2018**

Case Number: T 0719/14 - 3.2.07

Application Number: 06005233.9

Publication Number: 1676786

IPC: B65D81/00

Language of the proceedings: EN

Title of invention:

Method for the preparation of beverages

Patent Proprietor:

Koninklijke Douwe Egberts B.V.

Opponent:

Friesland Brands B.V.

Headword:

Relevant legal provisions:

EPC Art. 54(3), 54(2), 100(b), 100(c), 83, 123(2), 76(1),
111(1)

Keyword:

Grounds for opposition - subject-matter extends beyond content of earlier application (no) - insufficiency of disclosure (no) - added subject-matter (no)
Appeal decision - remittal to the department of first instance (yes)

Decisions cited:

G 0001/15

Catchword:



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Case Number: T 0719/14 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 20 November 2018

Appellant 1: Koninklijke Douwe Egberts B.V.
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
16 January 2014 concerning maintenance of the
European Patent No. 1676786 in amended form.**

Composition of the Board:

Chairman V. Bevilacqua
Members: K. Poalas
C. Brandt

Summary of Facts and Submissions

- I. The patent proprietor (appellant 1) and the opponent (appellant 2) each lodged an appeal in the prescribed form and within the prescribed time limit against the interlocutory decision of the opposition division maintaining European patent No. 1 676 786 in amended form.
- II. The application (EP 1 676 786 A, referred to as D9 in the following) from which the patent in suit was granted was filed as a divisional application originating from EP 1 440 908 A (referred to as D1 in the following).
- III. Opposition had been filed against the patent as a whole based on Articles 100(a) EPC (lack of novelty and inventive step), 100(b) EPC (insufficient disclosure) and 100(c) EPC (unallowable amendments).
- IV. The opposition division found that the subject-matter of claim 1 of the patent as granted lacked novelty over the content of the disclosure of D1. The patent was then maintained in amended form on the basis of the then second auxiliary request filed on 7 October 2013.
- V. In the present decision reference is also made to the following documents:

D2: EP 1 440 910 A,

D3: WO 02/087400,

D4: US 6 183 800,

D5: WO 01/58786.

VI. The patent proprietor requested

that the decision under appeal be set aside and the patent be maintained as granted (main request), or that, when setting aside the decision under appeal, the patent be maintained in amended form according to one of the three auxiliary requests filed together with its statement setting out the grounds of appeal.

The opponent requested

that the decision under appeal be set aside and that the patent be revoked.

VII. Oral proceedings were held on 20 November 2018, during which the factual and legal situations were discussed with the parties. In preparation, the Board had communicated its preliminary assessment of the case to the parties by means of a communication pursuant to Article 15(1) RPBA. For further details of the course of the oral proceedings, reference is made to the minutes thereof.

The decision was pronounced at the end of the oral proceedings.

VIII. Independent claim 1 according to the main request, i.e. according to the patent as granted, reads as follows:

"A method of dispensing a beverage from a cartridge (1) containing one or more concentrated liquid milk ingredients during an operating cycle, the method comprising the steps of passing an aqueous medium through the cartridge to form a beverage by dilution of said one or more concentrated liquid milk ingredients,

passing the beverage through means to produce foaming of the beverage, and dispensing the beverage into a receptacle, wherein the one or more concentrated liquid milk ingredients has between 25 and 40% total solids and between 0.1 and 12% fat, wherein the one or more concentrated liquid milk ingredients is diluted by a ratio of between 1 to 1 and 6 to 1, and wherein the level of foaming is greater than 40%".

IX. The opponent's arguments, insofar as they are relevant for the present decision, may be summarised as follows:

Given that the patent in suit does not contain clear and univocal definitions of the foaming level and the dilution ratio, and that both these parameters are mentioned in claim 1 of the main request, the claimed invention is not disclosed in a manner enabling a skilled person to reduce it to practice.

Claim 1 of the main request extends beyond the content of D9 and D1 because the combination of a dilution ratio between 1 to 1 and 6 to 1 with a level of foaming greater than 40% for concentrated milk having 25 to 40% total solids and 0.1 and 12% fat is neither directly nor unambiguously derivable from these documents.

According to the *ratio decidendi* of G 1/15, OJ EPO 2017, 82, documents D1 and D2 cannot be considered as representing a (novelty-destroying) state of the art according to Article 54(3) EPC. On the other hand, documents D3, D4 and D5, each representing a state of the art according to Article 54(2) EPC, render the subject-matter of claim 1 of the main request not novel and/or not inventive.

X. The patent proprietor's arguments, insofar as they are relevant for the present decision, may be summarised as follows:

The grounds of opposition according to Articles 100(b) and (c) EPC do not hold against claim 1 of the main request.

On the basis of the definitions given in the patent in suit, the skilled person has no difficulty in determining a level of foaming and a dilution ratio for a given beverage.

An ambiguity of the value of these parameters, due to the presence in the patent in suit of different definitions of these parameters, does not itself generate an insufficiency of disclosure, but may raise doubt on clarity, the latter not being a ground for opposition.

The basis for the feature's combination of claim 1 of the main request is to be found in claims 22 and 24, taken together with the passage extending between line 54 on page 10 and line 1 on page 11 of paragraph 98 of D1, and in claims 8, 10 and the passage extending between lines 48 to 53 of paragraph 98 of D9.

Following the *ratio decidendi* of G 1/15 (*supra*) D1 and D2 cannot be considered as representing a state of the art according to Article 54(3) EPC.

Documents D3, D4 and D5 are not suitable for casting doubts on novelty and/or inventive step of the subject-matter of claim 1 of the main request.

Reasons for the Decision

1. *Claim 1 according to the main request - sufficient disclosure, Article 100(b) EPC in combination with Article 83 EPC*

"Level of foaming"

- 1.1 Claim 1 requires the level of foaming to be greater than 40%. It is common ground that the terms "foamability level" and "foamability" used in paragraph 83 are equivalent to the term "level of foaming" present in paragraph 16 and in claim 1.

- 1.2 The Board agrees with the opponent in so far as it considers that the level of foaming definition in paragraph 16 of the patent in suit is not immediately recognisable by the person skilled in the art as being deficient and that therefore the patent in suit provides three different definitions of this parameter:

- In paragraph 16 the level of foaming is defined as the ratio of foam volume to the volume of the original liquid beverage ingredient;

- In lines 17 to 19 of paragraph 83 the level of foaming ("foamability level") is defined as the volume ratio of foam produced to the volume of liquid beverage ingredient dispensed;

- In lines 19 to 20 of paragraph 83 the level of foaming ("foamability") is calculated as the ratio of the volume of the foam to the total volume of the dispensed beverage minus the foam volume.

- 1.3 The three above-mentioned ways of defining/calculating the level of foaming provide the skilled person with different values for one and the same beverage dispensing method.
- 1.4 To this respect, the opponent argues that in the light of these three definitions given in the patent in suit it is unclear for the skilled person how to reproduce the invention. It is not possible to achieve a level of foaming of more than 40%, as required in claim 1, since it cannot be univocally determined how this level of foaming is to be defined and whether the skilled person is working within or outside the scope of claim 1.
- 1.5 The Board disagrees with the opponent's argument for the following reasons.
- 1.6 Under point 2.3.6 of its last written submissions dated 13 November 2018, the opponent, for a randomly chosen example, calculated three values of level of foaming according to the three definitions of the patent in suit.
- 1.7 These calculations demonstrate on the one hand that the calculated levels of foaming values differ from each other. On the other hand, they also demonstrate, that the skilled person, in all three cases was able to define/calculate a concrete value for the level of foaming for the example presented.
- 1.8 Accordingly, the claimed level of foaming is readily measurable and easily reproducible.
- 1.9 According to the established case law of the Boards of Appeal, whether or not the use of three distinct definitions of a parameter leads to different results

is a matter of clarity, and not a matter of sufficiency of disclosure (see hereto Case Law of the Boards of Appeal, 8th edition 2016, II.C.7.2). However, in such a case, the Board has no authority to determine the clarity of the feature in question, as this feature was already present in claim 1 of the patent as granted.

Dilution ratio

- 1.10 Claim 1 states that one or more concentrated liquid milk ingredients must be diluted by a ratio of between 1 to 1 and 6 to 1.
- 1.11 It is undisputed that the term "dilution ratio" is explicitly defined in paragraph 79, lines 41 to 42 of the patent in suit as the ratio of aqueous medium to beverage ingredient in the dispensed beverage.
- 1.12 The opponent argues that there exist various examples in the same paragraph 79, where the dilution ratio is calculated as the ratio of the solids concentrations before and after dilution (see lines 38 to 40, 40 to 42 and 43 to 44). Different values for the dilution rate are thereby calculated. With such a plurality of examples being inconsistent with the above-mentioned definition, the patent in suit fails to provide a clear, univocal and unambiguous teaching enabling a skilled person to carry out the claimed invention.
- 1.13 The Board disagrees with the opponent's argument for the following reasons.
- 1.14 The Board accepts the patent proprietor's corresponding argument that lines 38 to 40, 40 to 42 and 43 to 44 of paragraph 79 do not contain the total information needed to determine the starting solids level in the

liquid milk concentrate, nor the level of solids in the final beverage, so it is not possible to determine the ratio of aqueous medium to beverage ingredient in the dispensed beverage from the information provided there. Rather, the dilution ratio is explicitly given therein, as 3:1 or 5:1 for example. Therefore, the Board does not agree with the opponent's conclusion that there is a plurality of examples being inconsistent with the single definition given in lines 41 to 42 of paragraph 79.

- 1.15 But even if this were the case, under point 2.2.3 of its last written submissions dated 13 November 2018, the opponent calculated for some examples specific dilution-ratio- values according to "definition 1", i.e. according to lines 41 to 42 of paragraph 79 and according to "definition 2", i.e. according to lines 38 to 40, 40 to 42 and 43 to 44 of paragraph 79.
- 1.16 These calculations demonstrate on the one hand that the values differ from each other. On the other hand, they also demonstrate that the skilled person was in a position each time to identify a concrete value for the dilution ratio.
- 1.17 Accordingly, this parameter is readily measurable and easily reproducible.
- 1.18 As already noted above, according to the established case law of the Boards of Appeal, the question whether or not different definitions of a parameter lead to different results is a matter of clarity, and not a matter of sufficiency of disclosure. Again, the Board has no authority to determine the clarity of the feature in question, as this feature was already

present in claim 1 of the patent as granted.

- 1.19 For the above-mentioned reasons, the ground of opposition according to Article 100(b) EPC does not hold against the patent as granted.
2. *Claim 1 according to the main request - amendments, Article 100(c) EPC in combination with Articles 123(2) and 76(1) EPC*
- 2.1 As acknowledged by the opponent, the only features of claim 1 which are not disclosed in the combination of claims 22 and 24 of D1 (claims 8 and 9 of D9) are the features that the one or more liquid milk ingredients are **concentrated** liquid milk ingredients, and that said one or more concentrated liquid milk ingredients have between **25 and 40% total solids** and between **0.1 and 12% fat**.
- 2.2 In the passage extending between line 54 on page 10 and line 1 on page 11 of paragraph 98 of D1 (identical with the passage extending between lines 48 to 53 of paragraph 98 of D9), which the patent proprietor indicates as the basis for these features, it is stated that:
- "Accordingly the **present invention** provides for **a** beverage **cartridge** having **a concentrated dairy-based liquid product** therein. It has been found that by **concentrating the milk product** a greater amount of foam can be produced for a particular volume of milk when compared to fresh or UHT milk. ... The **concentrated** liquid milk preparations of the **present invention** contain between **0,1 and 12% fat** and **25 to 40% total solids**" (emphasis added by the Board).

- 2.3 From paragraph 88 of D1 (identical to paragraph 88 of D9) onwards there is a continuous reference to the fourth version of the cartridge according to D1, i.e. D9. Although paragraph 98 of both documents also begins with a reference to the fourth embodiment of beverage cartridge, the Board accepts the patent proprietor's argument that the text passage quoted above refers to the invention in general without being limited to the structural configuration of the fourth embodiment thereof. The Board comes to the above conclusion because this text explicitly mentions "the present invention" in general and also refers to "a concentrated dairy-based liquid product" in general. When there is specific information concerning the beverage cartridge according to the fourth embodiment, then an explicit reference to "the cartridge of the fourth embodiment" is used (see for example paragraph 100 of D1 and D9).
- 2.4 The Board therefore considers that the combination of 4% fat and 30% total solids mentioned in lines 1 to 2 of page 11 of paragraph 98 of D1 (lines 53 to 54 of paragraph 98 of D9) is not to be read solely in combination with the "fourth embodiment".
- 2.5 Accordingly, the Board considers that the combination of claims 22 and 24 of D1 (claims 8 and 9 of D9) together with the information disclosed in the passage comprised between line 54 on page 10 and line 1 on page 11 of paragraph 98 of D1 (identical to the passage comprised between lines 48 and 53 of paragraph 98 of D9) does not result in subject-matter which extends beyond the content of D1 or D9.
- 2.6 For the above-mentioned reasons, the ground of opposition according to Article 100(c) EPC in

combination with Articles 123(2) and 76(1) EPC does not hold against the patent as granted.

3. *State of the art according to Article 54(3) EPC*

3.1 The only reason the opposition division did not allow the main request was lack of novelty based on the assumption, that D1 represents state of the art according to Article 54(3) EPC.

3.2 As noted in the communication pursuant to Article 15 (1) RPBA, and as acknowledged by both parties during the oral proceedings, in the light of G 1/15 (*supra*) D1 and D2 cannot be considered as representing state of the art according to Article 54(3) EPC.

3.3 Accordingly, the opposition division's finding that the subject-matter of claim 1 of the main request is not novel over D1 is not valid anymore.

4. *Remittal*

4.1 During the present opposition and appeal proceedings the opponent questioned the novelty and inventive step of the subject-matter of claim 1 of the main request on the basis of documents D3, D4 and D5, all being state of the art according to Article 54(2) EPC.

4.2 In view of the Board's finding that D1 (and D2) cannot be considered as representing state of the art according to Article 54(3) EPC and that the opposition division's finding that the subject-matter of claim 1 of the main request is not novel over D1 is not longer valid, the impugned decision is to be set aside. So as not to deprive the parties of the opportunity to argue their complete case before two instances, the Board, in

accordance with the corresponding requests of both parties for remittal filed during the oral proceedings, exercises its discretion according to Article 111(1) EPC for the purpose of remitting the case to the opposition division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



G. Nachtigall

V. Bevilacqua

Decision electronically authenticated