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**Datasheet for the decision
of 8 December 2020**

Case Number: T 0720/17 - 3.2.07

Application Number: 10776705.5

Publication Number: 2385922

IPC: B65D85/804, A47J31/00

Language of the proceedings: EN

Title of invention:

CAPSULE AND METHOD FOR PREPARING A BEVERAGE SUCH AS COFFEE FROM SAID CAPSULE

Patent Proprietor:

Société des Produits Nestlé S.A.

Opponents:

Patentwerk B.V.
Plasseraud IP
Grey, Ian Michael

Headword:

Relevant legal provisions:

EPC Art. 83, 111(1), 113(1)
EPC R. 115(2)
RPBA 2020 Art. 11, 15(1), 15(3), 25(1)

Keyword:

Oral proceedings - held in absence of party
Sufficiency of disclosure - (yes)
Remittal - special reasons for remittal

Decisions cited:

T 1888/12, T 0019/90, T 0182/89, G 0003/14

Catchword:



Beschwerdekammern
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Case Number: T 0720/17 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 8 December 2020

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 17 January 2017
revoking European patent No. 2385922 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman I. Beckedorf
Members: A. Pieracci
 A. Cano Palmero

Summary of Facts and Submissions

- I. The patent proprietor (appellant) lodged an appeal in the prescribed form and within the prescribed time limit against the decision of the opposition division to revoke the European patent No. 2 385 922.
- II. The opposition had been filed against the patent as a whole based on all grounds for opposition pursuant to Article 100 EPC (lack of novelty and inventive step, insufficiency of disclosure and added subject-matter). The opposition division found that the patent as amended according to the main request and to auxiliary request I to XI did not meet the requirements of Article 83 EPC.
- III. In preparation for the oral proceedings scheduled at the requests of the appellant and of opponents 01 and 03 (respondents 01 and 03), the Board communicated its preliminary assessment of the case to the parties by means of a communication pursuant to Article 15(1) RPBA 2020. The Board indicated that the patent in suit appeared to disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.
- IV. Oral proceedings before the Board took place on 8 December 2020 in the absence of opponent 02 (respondent 02), at the end of which the decision was announced. For further details of the oral proceedings reference is made to the minutes thereof.
- V. The final requests of the appellant are

that the appealed decision be set aside and

that the patent be maintained in amended form according to the main request filed with letter dated 24 February 2014,
or, in the alternative,
that the patent be maintained in amended form on the basis of auxiliary requests I to XI, whereby auxiliary request I corresponds to the auxiliary request filed with letter dated 24 February 2014 and auxiliary requests II to XI correspond to auxiliary requests II to XI filed with letter dated 8 November 2016, all auxiliary requests having been re-filed with the statement setting out the grounds of appeal.

- VI. The final requests of respondents 01 and 03 are

that the appeal be dismissed.
- VII. Respondent 02 (opponent 02) did not file any requests or submissions during the appeal proceedings.
- VIII. The lines of argument of the parties are dealt with in detail in the reasons for the decision.
- IX. Claim 1 according to the main request reads (the amendments with respect to claim 1 of the patent as granted being highlighted by the Board):

Capsule for the preparation of a beverage in a beverage preparation device comprising:
a cup-shaped body (12) comprising a cavity containing a beverage ingredient and a flange-like rim (14) extending outwardly from the base of said body,
a beverage delivery wall (13) connected to the flange-like rim,

characterized in that the flange-like rim is formed of a polymer material chosen in a grade having a Vicat softening point according to ISO 10350 being ~~between about 30 and 100°C, preferably~~ between 40 and 90°C or a polymer chosen in a grade comprising a glass transition temperature (Tg) ~~between 30 and 80°C, preferably~~ between 40 and 60°C.

- X. In view of the decision taken by the Board there is no need to reproduce claim 1 of the auxiliary requests.

Reasons for the Decision

1. Absence of respondent 02 - Right to be heard
(Article 113(1) EPC)

Although respondent 02 did not attend the oral proceedings, the proceedings could be continued without that party in accordance with Rule 115(2) EPC and Article 15(3) RPBA 2020. The principle of the right to be heard pursuant to Article 113(1) EPC is observed since that provision only affords the opportunity to be heard and, by absenting itself from oral proceedings, a party gives up that opportunity (see the Case Law of the Boards of Appeal, 9th edition 2019, III.B.2.7.3 and V.A.4.5.3).

2. Sufficiency of disclosure of the invention according to claim 1 of the main request (Article 83 EPC)
- 2.1 Claim 1 of the main request is directed to a capsule for preparing a beverage being characterized by a

flange-like rim "... formed of a polymer material chosen in a grade having a Vicat softening point according to ISO 10350 between 40 and 90°C or a polymer chosen in a grade comprising a glass transition temperature (T_g) between 40 and 60°C ...".

The Board substantially concurs with the appellant that the characterizing features of the claim, contrary to the decision of the opposition division, do not lead to the claimed invention being insufficiently disclosed.

It is established jurisprudence of the Boards of Appeal that an objection of lack of sufficient disclosure presupposes that there are serious doubts substantiated by verifiable facts. The burden of proof is upon the opponent(s) to establish on the balance of probabilities that a skilled reader of the patent, using his common general knowledge, would be unable to carry out the invention (see the Case Law of the Boards of Appeal, *supra*, II.C.9., referring to T 19/90, OJ EPO 1990, 476, and T 182/89, OJ EPO 1991, 391).

In the present case the Board is of the opinion that the objection of insufficiency of disclosure raised by the respondents and followed by the opposition division is not substantiated by verifiable facts and that therefore the respondents have failed to discharge their burden of proving that the person skilled in the art is not able manufacture a capsule according to the subject-matter of claim 1.

The argument of respondent 03 that the burden of proof is shifted to the patent proprietor because there is allegedly a weak presumption that the invention is sufficiently disclosed (see point 2.1 to 2.5 of the letter dated 21 October 2020) is not convincing because

it is based on the assumption that the claimed Vicat softening point and the claimed glass transition temperature (Tg) do not refer to the properties of the bulk material used for forming the flange like-rim (see in particular point 2.5 of the letter dated 21 October 2020) which in the Board's view is not correct as further discussed in point 2.2.5 below.

2.2 With respect to the correctness of the reasoning of the impugned decision the Board also notes the following.

2.2.1 The Board cannot follow the finding of the opposition division (see the reasons for the decision, point II. 2.3) that the Vicat softening point and the glass transition temperature (Tg) are not inherent/intrinsic material properties and that, whilst generally suitable and/or preferred types of plastic materials are given in the patent specification, no specific example of a material with properties falling within the claimed ranges is provided. The specification further fails to provide a clear teaching showing the processing steps required to ensure that a selected materials does meet one of the claimed parameters, therefore the skilled person is required to use trial and error to identify such a material.

2.2.2 The Board considers the argument of the appellant convincing (see point VI.1.1 of the statement setting out the grounds of appeal), that, although the Vicat softening point and the glass transition temperature (Tg) might not be an inherent/intrinsic property for a particular group or type of material, they are indeed inherent for a specific material. In the understanding of the Board the specific value of the Vicat softening point and of the glass transition temperature (Tg) distinguishes the specific material relevant to the

claimed invention with respect to other materials of the same type.

This argument, which had been submitted already during the opposition proceedings, has not been addressed by the opposition division nor by the respondents, who bear the burden of proof in this respect.

- 2.2.3 The Board accepts the argument of the appellant that the absence of a specific material in the patent specification does not cause an undue burden for the person skilled in the art willing to put the invention into practice.

As indicated by the appellant, materials characterized via the Vicat softening point and via the glass transition temperature are known in the field and available to a person skilled in the art as also shown by the documents cited in opposition proceedings (see point VI.1.2 of the statement setting out the grounds of appeal, page 9).

That this is not the case for the materials having a Vicat softening point and a glass transition temperature within the specifically claimed ranges is not apparent and has not been demonstrated by the opposition division nor by the respondents, who again bear the burden of proof in this respect.

- 2.2.4 Furthermore, the fact that in the patent in suit no information is provided as to how the (semi) crystallized and/or amorphous state, degree of crystallinity, chain length, cooling rate, molecular weight distribution and the amount and type of fillers/additives should be controlled to reliably obtain the

claimed parameter also does not affect the sufficiency of disclosure of the claimed invention.

The Board concurs with the appellant (see page 5, last paragraph of the letter dated 12 July 2018) that since the patent in suit is directed to a capsule comprising a specific material and not to a process for producing such a material or to the material as such, the information above is not necessary to the person skilled in the art to put the invention into practice, contrary to what indicated by the opposition division (see the reasons for the decision, point II.2.3) and by respondent 03 (see point 26 of their reply to the statement setting out the grounds of appeal).

- 2.2.5 The Board also follows the argument of the appellant contesting the reasoned finding of the opposition division, that it is not possible to obtain the material used in the claimed invention from a supplier "...in particular since the test conditions specified in patent par. [0048] require a material thickness of more than 1 mm being - in doubt - not present at most of the capsule flanges fabricated in accordance with the preferred embodiments defined in patent claim 13...", (see page 8, first paragraph of the reasons for the decision).

As indicated by the appellant (see point VI.1.3 of the statement setting out the grounds of appeal) the required material properties can be ascertained from the bulk material from which a flange with a certain thickness is to be obtained. This is in fact what is required by the claim, *i.e.* that the flange-like rim is formed of a polymeric material having the Vicat softening point or the glass transition temperature (T_g) within the claimed ranges.

The Board cannot follow the argument submitted by respondent 03 at the oral proceedings that since the characterizing portion of claim 1 indicates that "...the flange-like rim is **formed of** a polymer material chosen..." and not that the flange-like rim is **formed from** such a polymer material, the claimed value of the Vicat softening point and of the glass transition temperature (Tg) refer to the flange-like rim as such and not to the bulk material from which it has been made. This interpretation of the claim is contrary to the plain reading by the person skilled in the art, according to which the properties indicated in claim 1 are rather those of the bulk material used for forming the flange-like rim.

The argument of the respondents that the appellant itself in opposition proceedings followed this interpretation of the claim is not relevant even if correct, since the EPC requires that the claims are interpreted according to the understanding of the person skilled in the art only.

2.2.6 That the material for the flange-like rim cannot in fact be obtained by a material supplier contrary to the above argument of the appellant (see in particular the statement setting out the grounds of appeal, page 10, third paragraph), has not been shown by the respondents, who bear the burden of proof in this respect.

2.2.7 The argument of the opposition division that a lengthy process of trial and error is necessary in order to carry out the invention is thus not convincing.

2.3 The Board therefore is not convinced by the reasons given by the opposition division in its decision and the corresponding arguments submitted by the respondents in the appeal proceedings.

2.4 With respect to the further arguments submitted by respondent 01 in its reply to the statement setting out the grounds of appeal and at the oral proceedings in relation to the ISO standard 10350 reference in claim 1, the following is noted.

The Board cannot follow the argument of respondent 01, referring to various decisions of the Boards of Appeal and in particular to T 1888/12, that the reference to ISO 10350 in the claim without any further indications, such as the publication year or the version of the norm, causes an essential lack of clarity with the result that the person skilled in the art is not able to carry out the invention.

As far as this objection of respondent 01 is directed to the clarity of claim 1, the Board notes that the contested reference to the ISO standard was already present in claim 1 of the patent as granted and, thus, is not open to examination in the present proceedings in accordance with the decision of the Enlarged Board of Appeal G 3/14 (OJ EPO 2015, A102).

As far as respondent 01 considers the alleged lack of clarity to cause an insufficiency of disclosure, this line of argument has not been supported by any evidence and therefore constitutes an unsubstantiated allegation which cannot be found convincing.

3. In summary, in reviewing the decision under appeal, the Board finds that the appellant has convincingly demonstrated the incorrectness of the decision of the opposition division that the invention is not

sufficiently disclosed for it to be carried out by a person skilled in the art using his common general knowledge.

In view of this finding, the present case is in a position to be decided on with regard to the question of sufficiency of disclosure according to Article 83 EPC, which was the sole ground for revocation mentioned in the contested decision.

4. Remittal of the case to the opposition division (Article 111(1) EPC and Article 11 RPBA 2020)

The Board is aware that according to Article 11 RPBA 2020, which is applicable in the present case (Article 25(1) RPBA 2020), a remittal for further prosecution should only be ordered exceptionally, when special reasons apply.

The Board notes that the opposition division has not decided on the other grounds for opposition raised by the respondents in their notices of opposition, and that according to Article 12(2) RPBA 2020 the primary object of the appeal proceedings is to review the decision under appeal in a judicial manner.

The Board also notes that none of the parties to the appeal proceedings has submitted any arguments in respect of the further patentability requirements under the EPC but merely stated that the opposition division had not dealt with the conformity of the claimed subject-matter with the requirements of Articles 54, 56 and 123(2) EPC in particular. Rather, the appellant and respondent 03 explicitly requested remittal of the case to the opposition division for further prosecution, and respondents 01 and 02 did not object to this request.

Against this background, after considering all the relevant circumstances of the case at hand, the Board comes to the conclusion that in the present case it is not in a position to decide on all relevant patentability issues without an undue burden. Hence, there are special reasons within the meaning of Article 11, first sentence, RPBA 2020, so that it is appropriate to remit the present case to the opposition division for further prosecution in accordance with Article 111(1) EPC.

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

I. Beckedorf

Decision electronically authenticated