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**Datasheet for the decision  
of 1 February 2021**

**Case Number:** T 2698/17 - 3.2.07

**Application Number:** 05795017.2

**Publication Number:** 1816934

**IPC:** B65D85/804, A47J31/40

**Language of the proceedings:** EN

**Title of invention:**

Capsule with biasing sealing member

**Patent Proprietor:**

Société des Produits Nestlé S.A.

**Opponent:**

Oak International B.V.

**Headword:**

**Relevant legal provisions:**

EPC Art. 116, 113, 123(2)

RPBA 2020 Art. 12(8), 15(1), 15(3), 24, 25(1)

**Keyword:**

Amendments - intermediate generalisation - allowable (no)  
Reimbursement of appeal fee - no explicit withdrawal of the  
request for oral proceedings - confirmation of T 73/17

**Decisions cited:**

T 0073/17, T 0191/17, T 0517/17, T 0777/15

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: T 2698/17 - 3.2.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.07**  
**of 1 February 2021**

**Appellant:** Société des Produits Nestlé S.A.  
(Patent Proprietor) Entre-deux-Villes  
1800 Vevey (CH)

**Representative:** Rupp, Christian  
Mitscherlich PartmbB  
Patent- und Rechtsanwälte  
Sonnenstraße 33  
80331 München (DE)

**Appellant:** Oak International B.V.  
(Opponent) Oosterdoksstraat 80  
1011 DK Amsterdam (NL)

**Representative:** V.O.  
P.O. Box 87930  
2508 DH Den Haag (NL)

**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
17 October 2017 concerning maintenance of the  
European Patent No. 1816934 in amended form.**

**Composition of the Board:**

**Chairman** I. Beckedorf  
**Members:** A. Cano Palmero  
K. Poalas

## **Summary of Facts and Submissions**

I. Both the opponent and the patent proprietor lodged an appeal in the prescribed form and within the prescribed time limit against the decision of the opposition division to maintain European patent No. 1 816 934 in amended form on the basis of the then auxiliary request III.

II. The patent proprietor initially requested

that the decision under appeal be set aside and that the patent be maintained according to the set of claims filed as main request, corresponding to auxiliary request II decided upon in the decision under appeal,

or, in the alternative,

that the patent be maintained in amended form according to one of the set of claims of auxiliary requests 1 to 9 filed with the statement setting out the grounds of appeal, whereby auxiliary request 1 corresponds to auxiliary request III, which the opposition division held to meet the requirements of the EPC.

III. The opponent initially requested

that the decision be set aside and that the patent be revoked in its entirety.

IV. With a communication pursuant to Article 15(1) RPBA 2020, the Board informed the parties of its preliminary assessment of the factual and legal situation, according to which the patent proprietor's appeal was

unfounded and therefore was likely to be dismissed, whereas the opponent's appeal was likely to be allowed.

V. With letter of 4 November 2020, the patent proprietor withdrew their appeal and announced that they would not attend the oral proceedings scheduled for 23 February 2021.

VI. Claims 1 and 2 of auxiliary request III, which was held by the opposition division to meet the requirements of the EPC, and on which the present decision and the decision under appeal are based, read as follows:

**Claim 1:** "A method for producing a beverage, the method comprising the following steps:  
-providing a capsule (1) containing ingredients,  
-positioning the capsule (1) in a beverage production device (2),  
-providing clamping on a clamping portion (29) of the flange-like rim so that the capsule is held in position in the device,  
-producing at least a first opening in a first wall member (4) of the capsule (1),  
-having a liquid enter the capsule (1) at said least first opening in the base body (4) and,  
- producing at least a second opening in a second wall member and draining a beverage from the second opening of the capsule (1),  
wherein it comprises:  
- separating the two openings by a sealing engagement of at least one sealing surface of the beverage production device (2) and a sealing member (8) at the exterior of the capsule (1), the sealing member (8) being biased against the sealing surface of the beverage producing device (2)

and wherein said clamping portion (29) forms an annular surface and the sealing member (8) prolongs the clamping portion (29), wherein the sealing member (8) is a flexible lip extending from the outer edge of the flange-like rim (6)."

**Claim 2:** "A method for producing a beverage, the method comprising the steps of:  
-providing a capsule (1) containing ingredients,  
-positioning the capsule in a beverage production device (2),  
-providing clamping on a clamping portion (29) of the flange-like rim so that the capsule is held in position in the device,  
-producing at least a first opening in a first wall member of the capsule,  
-having a liquid enter the capsule (1) at the first opening in the base body (4),  
-producing at least a second opening in a second wall member and draining a beverage from the second opening of the capsule (1), and  
-separating the at least first and second openings by a sealing engagement of at least one sealing surface of the beverage production device (2) and a sealing member (8) at the exterior of the capsule (1), the sealing engagement being self-reinforcing when pressurized and wherein said clamping portion (29) forms an annular surface and the sealing member (8) prolongs the clamping portion (29), wherein the sealing member (8) is a flexible lip extending from the outer edge of the flange-like rim (6)."

VII. Auxiliary requests 2 to 9

(a) Claims 1 and 2 of auxiliary request 2 are based on claims 1 and 2 according to auxiliary request III

of point VI. above and further comprise the feature "the second wall member being a foil member that is closing-off the cup-like based body of the capsule".

- (b) Claims 1 and 2 of auxiliary request 3 are based on claims 1 and 2 according to auxiliary request 2 and further comprise the feature that "the foil member is adapted to be torn onto relief elements of a capsule holder of the beverage production device".
- (c) Claims 1 and 2 of auxiliary request 4 are based on claim 1 and 2 according to auxiliary request 2 and further comprise the feature that "the sealing member (8) is made from the same material as the capsule (1) and being an integral piece of the base body (4) of the capsule".
- (d) Claims 1 and 2 of auxiliary request 5 are based on claims 1 and 2 according to auxiliary request III of point VI. above and further comprise the feature that "wherein the flexible lip is bent, at rest, relative to the flat clamping portion (29) of the rim, comprised between 95 and 175 degrees".
- (e) Claims 1 and 2 of auxiliary request 6 are based on claim 1 and 2 according to auxiliary request 5 and further comprise the feature that "the flexible lip is the edge of a sidewall of the base body of the capsule".
- (f) Claims 1 and 2 of auxiliary request 7 are based on claims 1 and 2 according to auxiliary request III of point VI. above and further comprise the features according to which an enclosing member (9) and a capsule holder (13) are provided which clamp together the capsule (1) along the clamping portion (29) of the flange-like rim (6), wherein the enclosing member (9) includes one or more annular raising portions that firmly pinch or clamp the clamping portion (29) of the capsule onto a

receiving portion surface (31) of the capsule holder (13).

- (g) Claims 1 and 2 of auxiliary request 8 are based on claims 1 and 2 according to auxiliary request III of point VI. above and further comprise the feature according to which the sealing member is biased against the sealing surface of an enclosing member of the beverage producing device.
- (h) Claims 1 and 2 of auxiliary request 9 are based on claims 1 and 2 according to auxiliary request III of point VI. above and further specify that the foil member is torn on the relief elements in the step of producing the second opening in the second wall member of the capsule.

VIII. The parties' arguments relevant to the decision are those relating to the compliance of Article 123(2) EPC of the claims as maintained by the opposition division and are discussed in detail in the reasons for the decision.

### **Reasons for the Decision**

1. *Transitional provisions - Revised Rules of Procedure of the Boards of Appeal (RPBA 2020)*

The appeal proceedings are governed by the revised version of the Rules of Procedure which came into effect on 1 January 2020 (Articles 24 and 25(1) RPBA 2020).



2. *Procedural matters*

- 2.1 As a result of the withdrawal of the appeal of the patent proprietor, the opponent is the sole appellant and the patent proprietor has the status of respondent in the present appeal proceedings.
- 2.2 By withdrawing the appeal, the patent proprietor's main request submitted with the statement setting out the grounds of appeal has become obsolete. As respondent to the opponent's appeal the patent proprietor can only defend the contested patent in the form held by the opposition division to meet the requirements of the EPC or in a more restricted form, corresponding to auxiliary request 1 and to auxiliary requests 2 to 9, all submitted with the patent proprietor's statement setting out the grounds of appeal.
- 2.3 The case is ready for decision which is taken in written proceedings without holding oral proceedings in accordance with Article 12(8) RPBA 2020 and with Articles 113 and 116 EPC.

The opponent's request for oral proceedings pursuant to Article 116(1) EPC is auxiliary to their request that the decision under appeal be set aside and that the patent is revoked. Since this is followed by the Board, the opponent's auxiliary request for oral proceedings remains procedurally inactive.

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 the party's submissions are fully taken into account. By expressly declaring their intention not to participate in the oral proceedings, to which both parties were

duly summoned, the patent proprietor gives up this opportunity (see Case Law of the Boards of Appeal, 9th edition 2019, III.B.2.7.3 and V.A.4.5.3).

The appeal is thus ready for decision on the basis of the contested decision to be reviewed and the extensive written submissions of the parties (Article 15(3) RPBA 2020), while preserving their rights under Articles 113 and 116 EPC, so that the oral proceedings are cancelled.

3. *Patent as maintained by the opposition division - added subject-matter, Article 123(2) EPC*

3.1 Claims 1 and 2 according to patent as maintained by the opposition division correspond to the original method claims 13 and 14, whereby at least the feature "**wherein the sealing member is a flexible lip extending from the outer edge of the flange-like rim**" has been included.

3.2 The opponent argues in their statement setting out the grounds of appeal that by omitting *inter alia* the following features, the subject-matter of the claims has been generalised in an unallowable manner:

**(A)** the flexible lip is inclined; and

**(B)** the sealing surface is oppositely inclined to the flexible lip.

According to the opponent, the flexible lip constituting the sealing member now being part of the claims is inextricably linked to the fact that this lip is inclined and to the way this inclined sealing member cooperates with an oppositely inclined sealing surface

of the device, as explained at original description page 14, lines 1-6.

- 3.3 The patent proprietor, in points 1.1 and 1.2 of their reply to the opponent's statement of grounds of appeal, is of the view that there is no intermediate generalisation present, since page 12, lines 4-10 of the original application clarifies that the capsule design depicted in the figures 2-4 is merely a preferred embodiment and that *"other designs for the capsule are possible"*. Likewise, page 9, lines 33-38 reveals that *"In the following the invention will be explained referring to a certain design of a capsule (...). However it is to be understood that other designs of the capsule are viable"*.
- 3.4 The Board is not convinced by the arguments of the patent proprietor and follows the view of the opponent that the claims 1 and 2 as maintained by the opposition division do not meet the requirements of Article 123(2) EPC.
- 3.4.1 The only disclosure of the features directed to the sealing function of the flexible lip is to be found in the embodiment starting with Figure 2, in particular on page 13, lines 1-18. Figure 3 relates to this same embodiment of Figure 2 (see page 13, lines 33-34 *"according to this embodiment"*). As correctly pointed out by the opponent on page 8 of their statement of grounds of appeal from original description page 14, lines 1-6, is derivable that the flexible lip constituting the sealing member being inclined is inextricably linked to the way the sealing member cooperates with an oppositely inclined sealing surface of the device.

3.4.2 The passages indicated by the patent proprietor seem rather to relate to

- a) the general shape of the capsule (page 9, lines 33-38, cup-like or lenticular-shaped container), and to
- b) the hermetically closing of the ingredients in the capsule (page 12, lines 4-10).

Consequently, they do not appear to be directed to the embodiment of Figs. 2-4 in particular, let alone to the features regarding the clamping of the flange-like rim and to the sealing function of the flexible lip.

3.4.3 Accordingly, the above-mentioned passages referred to by the patent proprietor cannot justify an extraction of the features present in claims 1 and 2 of the patent as maintained by the opposition division, omitting thereby the above-mentioned features (A) and (B).

3.5 The Board thus concludes that the omission of at least features (A) and (B) in claims 1 and 2 results in an unallowable intermediate generalisation, which contravenes the requirements of Article 123(2) EPC. This conclusion corresponds to the preliminary view of the Board, which was communicated to the parties by the communication pursuant Article 15(1) RPBA 2020 of 20.05.2020, see point 7. This preliminary finding was neither commented nor disputed by the patent proprietor and is confirmed by the Board after reconsideration.

4. *Auxiliary requests 2 to 9 - Amendments,  
Article 123(2)EPC*

Auxiliary requests 2 to 9 do not meet the requirements of Article 123(2) EPC for the same reasons as for the

patent as maintained by the opposition division , see point 3. above.

5. It follows that the opponent has provided convincing arguments that would demonstrate the incorrectness of the contested decision as regards the maintenance of the patent in amended form according to the then auxiliary request III, which does not meet the requirements of Article 123(2) EPC. Hence, the decision under appeal shall be set aside and in the absence of any in its substance allowable request the patent shall be revoked.
6. *Rule 103(4) (c) EPC - Announcement not to attend oral proceedings*
  - 6.1 The patent proprietor withdrew their appeal with letter of 4 November 2020. Accordingly, the Board ordered on 11 November 2020 a corresponding reimbursement of 25% of the appeal fee to the patent proprietor pursuant to Rule 103(4) (a) EPC.
  - 6.2 With the same letter, the patent proprietor also declared that they would not attend the oral proceedings to which the parties had been summoned.
  - 6.3 Rule 103(4) (c) EPC foresees a reimbursement of the appeal fee of 25% "if **any** request for oral proceedings is withdrawn **within one month** of notification of the communication issued by the Board of Appeal in preparation for the oral proceedings, and **no oral proceedings take place**". As in cases T 73/17 (not published in the OJ EPO) and T 191/17 (not published in the OJ EPO) of the same Board in different composition, the question arises whether this announcement of non-attending the oral proceedings could also give rise to

a reimbursement of, for instance, the appeal fee of 25% to the opponent under Rule 103(4)(c) EPC.

- 6.4 As to whether a party's announcement of their intention not to attend oral proceedings is to be considered as an implicit withdrawal of their request for oral proceedings, the Board confirms the approach followed in decision T 73/17 of 15 June 2020. In that case, the Board, in a different composition, held (point 9.3. of the Reasons - inofficial translation the language of proceedings (German)):

*"According to established case law, a party's request for oral proceedings can only be withdrawn by an unambiguous, written declaration expressing the party's will to withdraw. In the case law, this requirement is usually not considered to be fulfilled merely by an announcement that the party will not attend the oral proceedings (see Case Law of the Boards of Appeal, 9th edition 2019, III.C.4.3.1, with further references). Insofar as in some cases such an announcement appears to have been interpreted as an implicit withdrawal (see Case Law of the Boards of Appeal, supra, III.C.4.3.2, with further references), in the Board's view, this case law is not transferable to Rule 103(4)(c) EPC."*

- 6.5 The Board in its current composition takes note of decision of Technical Board of Appeal 3.5.03 in case T 517/17 of 27 October 2020 which held in point 6.3 of the Reasons, second paragraph:

*"However, this board holds that, if it is true that the express announcement of not attending arranged oral proceedings before the board is equivalent to a withdrawal of the request for them, this must be true and valid for all effects that the EPC and the case law*

*attach to a withdrawal. It does not appear to be justified to qualify the express announcement as equivalent to a withdrawal for the purposes of the question of whether appointed oral proceedings shall take place, but as not equivalent for the purposes of the question of whether fees shall be refunded."*

- 6.6 In view of the Board, this finding appears not to have fully appreciated that the requirements for arranging an oral proceedings upon a party's request pursuant to Article 116(1) EPC on the one hand and those for reimbursing a portion of the appeal fee pursuant to Rule 103(4) (c) EPC on the other hand, are distinct:

Article 116(1) EPC provides only for the requirements for holding oral proceedings: *i.e.* at a party's request or if considered expedient by the European Patent Office. This Article does not regulate under what conditions oral proceedings can be cancelled. The case law of the Boards of Appeal has dealt with the latter and either requires an explicit or an implicit withdrawal (see Case Law of the Boards of Appeal, *supra*, III.C.4.3.1 and 2). A party's expression of its intention not to attend oral proceedings which were arranged at that party's request may remove the necessity to hold oral proceedings, irrespectively of whether that expression is understood as an implicit withdrawal or as a mere non-maintenance of the request for oral proceedings.

However, Rule 103(4) (c) EPC is not silent on this point but requires that the "request for oral proceedings is withdrawn". Although the term "withdrawal" is not further qualified, the fact that this Rule explicitly calls for a "withdrawal" already indicates that nothing less than a procedural statement of withdrawal is

required to trigger the legal consequence of a partial reimbursement of the appeal fee.

This interpretation of the wording of Rule 103(4)(c) EPC is confirmed by the preparatory work and the circumstances surrounding the new version of Rule 103 EPC according to which

*"...the appeal fee is reimbursed at a rate of 25% if, in spite of a prior request for oral proceedings, the decision is eventually issued without the oral proceedings taking place. This will happen **if the Board does not consider oral proceedings expedient and, in ex parte cases, the applicant/appellant has withdrawn its request for oral proceedings or, in inter partes cases, if all parties have withdrawn their requests for oral proceedings.**" (see CA/80/19, of 4 October 2019, no. 85, emphasis added by the Board).*

Hence, both the wording of the provision and its legislative history lead the Board to understand Rule 103(4)(c) EPC, for the purpose of reimbursing 25% of the appeal fee, as requiring an express withdrawal of the request for oral proceedings, not merely an announcement of non-participation in oral proceedings. The procedural declaration of withdrawal is therefore of crucial importance, so that for reasons of legal certainty, especially for those involved in the proceedings, an explicit and unambiguous written declaration of withdrawal is a necessary condition for the partial repayment of the appeal fee.

Decision T 777/15 (not published in the OJ EPO) appears to have followed a similar approach by requiring a particular statement of withdrawal of a request for oral proceedings by any appellant (see point 4.1 of the Reasons).



The aforementioned understanding of Rule 103(4)(c) EPC was also confirmed by the Board in a different composition in case T 191/17 of 28 January 2021.

The second and third requirements, *i.e.* that the withdrawal is declared within one month of notification of the communication issued by the Board of Appeal in preparation for the oral proceedings (here the Board's communication pursuant to Article 15(1) RPBA 2020 of 20 May 2020) and that no oral proceedings take place, need also to be met.

6.7 In the case at hand, the third requirement is fulfilled, but not the first and second requirements.

Thus, the patent proprietor's announcement of their intention not to attend the oral proceedings enables the Board to take the decision without holding oral proceedings but does not allow for a reimbursement of the appeal fee pursuant to Rule 103(4)(c) EPC to the opponent.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated