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**Datasheet for the decision  
of 27 September 2024**

**Case Number:** T 1772/22 - 3.3.09

**Application Number:** 15726972.1

**Publication Number:** 3160247

**IPC:** A23F5/20, A23F5/22, A23F5/40,  
A23F5/12, A23F5/24, A23F5/28

**Language of the proceedings:** EN

**Title of invention:**  
COFFEE BEVERAGE COMPOSITION AND METHOD OF PRODUCING IT

**Patent Proprietor:**  
Société des Produits Nestlé S.A.

**Opponent:**  
Koninklijke Douwe Egberts B.V.

**Headword:**  
Coffee beverage composition/NESTLÉ

**Relevant legal provisions:**  
EPC Art. 84

**Keyword:**  
Claims - clarity (no)

**Decisions cited:**

G 0003/14

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 1772/22 - 3.3.09

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.09**  
**of 27 September 2024**

**Appellant:** Koninklijke Douwe Egberts B.V.  
(Opponent) Vleutensevaart 35  
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**Representative:** Boulton Wade Tennant LLP  
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**Respondent:** Société des Produits Nestlé S.A.  
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**Representative:** Plougmann Vingtoft a/s  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
6 May 2022 concerning maintenance of the  
European Patent No. 3160247 in amended form.**

**Composition of the Board:**

**Chairman** A. Veronese  
**Members:** M. Ansorge  
N. Obrovski

## **Summary of Facts and Submissions**

- I. The appellant (opponent) lodged an appeal against the opposition division's interlocutory decision holding the request that was then auxiliary request 1 allowable.
- II. With its notice of opposition, the opponent had requested that the patent be revoked on the grounds for opposition under Article 100(a) EPC (lack of novelty and lack of inventive step), Article 100(b) EPC and Article 100(c) EPC.
- III. The opposition division decided that the request that was then auxiliary request 1 was allowable and that the subject-matter of claim 1 thereof was clear (Article 84 EPC).
- IV. With its reply to the statement setting out the grounds of appeal, the respondent (proprietor) filed a main request, corresponding to auxiliary request 1 before the opposition division, and auxiliary requests 1 to 7. By letter dated 25 September 2024, the respondent then withdrew all of its previously filed claim requests except for auxiliary request 3 as filed with the reply to the statement setting out the grounds of appeal, which became its main request. By the same letter, it also filed auxiliary request 1.
- V. Claim 1 of the main request and of auxiliary request 1 reads as follows:

"A coffee beverage composition comprising

i) between 10% and 20% by weight of particles of roast *Coffea arabica* and/or roast *Coffea canephora* coffee beans; and

ii) at least 30% by weight of soluble coffee solids extracted from roast coffee beans;

wherein the composition comprises less than 1.2 mg of diterpenes per g of coffee solids, and

wherein the composition comprises an amount of coffee oil which is less than 4% by weight of the total amount of roast *Coffea arabica* and *Coffea canephora* coffee particles."

VI. The parties' relevant arguments submitted during both the written and oral proceedings are reflected in the reasons for the decision below.

VII. Requests

The appellant requested that the decision be set aside and that the patent be revoked.

The respondent requested that the patent be maintained on the basis of the main request (corresponding to auxiliary request 3 as filed with the reply to the statement setting out the grounds of appeal) or on the basis of auxiliary request 1 as filed by letter of 25 September 2024.

## Reasons for the Decision

Main request

1. Clarity (Article 84 EPC)
  - 1.1 Claim 1 relates to a coffee beverage composition comprising i) between 10% and 20% by weight of particles of roast Coffea arabica and/or roast Coffea canephora coffee beans; and ii) at least 30% by weight of soluble coffee solids extracted from roast coffee beans; wherein the composition comprises less than 1.2 mg of diterpenes per g of coffee solids, and wherein the composition comprises an amount of coffee oil which is less than 4% by weight of the total amount of roast Coffea arabica and Coffea canephora coffee particles (emphasis added by the board).
  - 1.2 Compared to claim 1 as granted, the following amendments have been introduced into claim 1 of the new main request (see also the underlined features in point 1.1 above).
    - The amount of particles of roast coffee beans in component i) has been limited from "at least 10% by weight" to "between 10 and 20% by weight" (feature 1).
    - The type of coffee beans in component i) has been specified as "Coffea arabica and/or Coffea canephora" (feature 2).
    - The feature "wherein the composition comprises an amount of coffee oil which is less than 4% by weight of the total amount of roast Coffea arabica and Coffea canephora coffee particles" (feature 3) has been introduced.

1.3 The respondent agreed that the clarity of the features introduced into claim 1 from the description could, in principle, be examined. However, as far as feature 3 could be considered unclear, a similar clarity issue was already present in claim 6 of the patent as granted. This issue related to the question of which particles were considered to be the reference point for calculating the oil content. These could be the roast coffee particles used as the starting material to prepare the composition or, alternatively, the fully or partly oil-depleted roast coffee particles obtained by removing oil from an aqueous slurry containing these particles. In the respondent's opinion, due to this similarity the clarity issue concerning feature 3 could not be examined by the board (reference was made to G 3/14).

1.4 As outlined below, the board does not agree.

1.4.1 It is uncontested that features 1 to 3 (defined in point 1.2 above) of claim 1 are taken from the description of the application as filed.

1.4.2 Concerning feature 3, the following is to be considered. Claim 6 of the patent as granted defines the amount of coffee oil in the composition; however, this definition significantly differs from that given in feature 3 of claim 1.

Claim 6 of the patent as granted reads as follows:

"6. The coffee beverage composition of any one of the preceding claims, wherein the composition comprises an amount of coffee oil which is less than the sum of: 15% by weight of the amount of particles of roast Coffea arabica coffee beans, and 7% by weight of the amount of

particles of roast *Coffea canephora* coffee beans." (emphasis added)

- 1.4.3 The wording used to define the oil content in feature 3 of claim 1 differs from that given in claim 6 of the patent as granted in the reference to a "total amount" rather than "the sum of", in the reference to a content of "less than 4% by weight" for both coffee varieties rather than different amounts for the two coffee varieties, and in the reference to "roast *Coffea arabica* and *Coffea canephora* coffee particles" instead of "particles of roast coffee beans".
- 1.4.4 Consequently, there is no doubt that the definition of the oil content according to feature 3 of claim 1 differs from that given in claim 6 of the patent as granted. The respondent has voluntarily chosen to define the coffee oil content using wording from the description instead of that used in claim 6 of the patent as granted, including in regard to referring to "roast ... coffee particles" instead of to "particles of roast ... coffee beans".
- 1.4.5 In view of the above-identified differences, the board does not concur with the opposition division's finding, on page 21, lines 1 to 15, of the decision, that the definition of the oil content according to feature 3 only differs from that according to claim 6 as granted in the different percentage amounts of *Coffea arabica* and *Coffea canephora*.
- 1.4.6 The board further notes that the other amendments to component i) of claim 1 do not result from a combination of granted claims either; they are also taken from the description of the application as filed.

These further amendments affect the interaction between the features defining component i) and feature 3.

- 1.4.7 In conclusion, since features 1 to 3 of claim 1 have been taken from the description of the application as filed and the definition of the oil content according to feature 3 is not identical to the one in claim 6 of the patent as granted, claim 1 may be examined under Article 84 EPC in these respects. In other words, as expressed in the order in G 3/14, claim 1 may be examined for compliance with the requirements of Article 84 EPC to the extent that the aforementioned amendments introduce non-compliance with Article 84 EPC. As long as this condition is fulfilled, it is irrelevant, contrary to the respondent's view, whether a possibly similar - but still different - issue of clarity also existed in the claims as granted.

Thus, the board does not agree with the opposition division's conclusion, and the respondent's opinion, that the clarity of claim 1, as far as feature 3 is concerned, cannot be examined.

- 1.5 As to the merits of the clarity objection against claim 1, the board comments as follows.

- 1.5.1 Component i) of claim 1 and feature 3 of claim 1 use different terminology. While in component i) "particles of roast Coffea arabica and/or roast Coffea canephora coffee beans" are specified, feature 3 mentions "roast Coffea arabica and Coffea canephora coffee particles" as the reference point for defining the amount of coffee oil.

In the board's view, since feature 3 is merely intended to define the oil content, this discrepancy in wording

creates doubts as to whether the same particles are meant in the part of claim 1 defining component i) and in the last paragraph of this claim, feature 3, bearing in mind that a definition of "roast Coffea arabica and Coffea canephora coffee particles" is not given in the description.

In any case, even if one were to assume that it is clear to the person skilled in the art that the particles mentioned in feature 3 are the same particles as those referred to in component i) of claim 1, claim 1 would be unclear for the reasons given below.

1.5.2 As argued by the appellant, feature 3 is not clear on its own and allows the following three reasonable interpretations for a skilled person.

- The roast particles are meant to be the fresh particles of roast coffee beans, i.e. the starting material used to prepare the composition (interpretation 1).
- They are meant to be partly oil-depleted particles of roast coffee beans obtained after extracting oil from the composition (interpretation 2).
- They are meant to be fully oil-depleted particles of roast coffee beans (interpretation 3).

1.5.3 The respondent argued that there could be no doubt - when reading claim 1 with a mind willing to understand - that interpretation 2 was the only one a skilled person would adopt when reading claim 1, bearing in mind that the gist of the invention was to reduce the coffee oil content.

1.5.4 The board does not agree, since the other interpretations (i.e. interpretations 1 and 3) would

also be reasonably adopted by the skilled person reading claim 1.

- 1.5.5 The description of the patent specification does not support the respondent's interpretation of claim 1 either. On the contrary, when referring to the amount of coffee oil, paragraphs [0013] to [0017] of the patent compare the amount of coffee oil to the starting material, i.e. the fresh roast coffee particles, and not to partly or fully oil-depleted coffee particles. In addition, when the description mentions "particles of roast coffee beans" it refers to a starting material before the removal of coffee oil. Nowhere in the patent is there an indication that the "particles of roast coffee beans" are partly oil-depleted coffee particles.
- 1.5.6 As outlined below, the examples of the patent do not support the respondent's opinion either. The respondent provided calculations concerning the coffee oil content of Sample 2 of Example 1 of the patent (which it considered to be in line with the claimed product). However, as noted by the appellant, in these calculations the respondent provided the wt.% of coffee oil in the composition relative to the wt.% of roast and ground coffee originally used to form the composition, i.e. fresh beans without the coffee oil removed (see point 3.1.1 of the reply to the statement setting out the grounds of appeal). This is in conflict with the respondent's interpretation of claim 1, according to which the roast particles can only mean partly oil-depleted particles of roast coffee beans obtained after extracting oil from the composition (interpretation 2).

1.5.7 The respondent further argued that even if feature 3 referred to fresh roast coffee particles and not to the partly oil-depleted particles present in the composition, the result would only be a minor deviation.

The board does not agree, since taking a different reference point in the determination of the coffee oil amount shifts the boundaries of claim 1 and therefore leads to a different extent of protection.

1.6 In view of the above, claim 1 of the main request does not meet the clarity requirement of Article 84 EPC.

#### Auxiliary request 1

2. Since claim 1 of the main request is identical to claim 1 of auxiliary request 1, the same reasoning applies as that given above with respect to the main request. Hence, the claimed subject-matter of auxiliary request 1 also lacks clarity (Article 84 EPC). Under these circumstances, it is neither necessary nor expedient to decide on the admittance of this claim request into the appeal proceedings.

**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:



K. Götz-Wein

A. Veronese

Decision electronically authenticated