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D E C I S I O N
of 25 March 2002

Case Number: T 0122/00 - 3.2.4

Application Number: 95117508.2

Publication Number: 0713669

IPC: A47J 43/10

Language of the proceedings: EN

Title of invention:

Milk jug with froth-forming device for making "cappucino" and the like

Patentee:

FRABOSK CASALINGHI S.p.A.

Opponents:

- (I) PI-DESIGN AG
- (II) G&G DESIGN S.r.l.
- (III) Randwyck B.V.
- (IV) Maxs AG
- (V) Bialetti Industrie S.p.A.

Headword:

Cappuccino/FRABOSK

Relevant legal provisions:

EPC Art. 100(c), 123
EPC R. 71(2)

Keyword:

"Undisclosed feature (limiting the scope of the claim and providing a technical contribution)"

Decisions cited:

G 0001/93

Catchword:

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Case Number: T 0122/00 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 25 March 2002

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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 26 November 1999
revoking European patent No. 0 713 669 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: C. A. J. Andries
Members: P. Petti
C. Holtz

Summary of Facts and Submissions

- I. Five oppositions were filed against the European patent No. 713 669, based on European patent application No. 95 117 508.2, which was filed on 7 November 1995.
- II. By the decision of the opposition division dispatched on 26 November 1999 the patent was revoked. In this decision, the opposition division held that the patent contravened the provisions of Article 100(c) EPC.

The decision was based on the independent Claim 1 filed by the patent proprietor during the oral proceedings on 9 November 1999. This claim reads as follows:

"1. Method for making cappuccino with frothed milk comprising the steps of inserting the milk in a container body (2), heating the milk and emulsifying the milk so heated characterized in that the heated milk is emulsified by causing it to pass through a froth forming element (10) constituted by a plunger element (11), whereby the plunger element is subjected to a reciprocating motion (11) in the heated milk, said plunger element (11) being supported and guided by a lid (4) which can close the container body (2) and being associated with a rod (12) that protrudes from said lid (4)."

- III. On 25 January 2000 the appellant (proprietor) lodged an appeal against this decision and simultaneously paid the appeal fee. A statement setting out the grounds of appeal was received on 28 March 2000.
- IV. With the statement setting out the grounds of appeal

the appellant filed some publications relating to the beverage called "cappuccino" (enclosures A to G).

Some further publications relating to "cappuccino" (enclosures 1 to 6) were filed by respondent I with the letter dated 22 February 2002.

V. Oral proceedings were held on 25 March 2002. Opponents (respondents) II and III, who had been duly summoned to oral proceedings, were not present. In accordance with Rule 71(2) EPC, the proceedings were continued without them.

VI. The appellant requested that "the appealed decision be set aside for the part concerning Art.100(c)/Art.123(2) and the patent be remitted to the Opposition Division for prosecuting the opposition proceedings" (see statement of grounds of appeal) on the basis of Claim 1 filed on 9 November 1999.

Respondents (opponents) I, III, IV and V requested that the appeal be dismissed.

Respondent II did not present either arguments in reply to the statement of appeal grounds or requests.

Reasons for the Decision

1. The appeal is admissible.
2. *The claimed subject-matter*
 - 2.1 The present Claim 1 is directed to

A) a method for making cappuccino with frothed milk comprising the steps of

B) inserting the milk in a container body (2),

C) heating the milk, and

D) emulsifying the so heated milk,

wherein

E) the heated milk is emulsified by causing it to pass through a froth-forming element (10),

E11) the froth forming element (10) is constituted by a plunger element (11),

E111) the plunger element is subjected to a reciprocating motion in the heated milk,

E112) the plunger element is supported and guided by a lid (4),

E1121) the lid can close the container body (2), and

E113) the plunger element is associated with a rod that protrudes from the lid.

2.1.1 It can be understood from feature A in conjunction with features B, E and E112 that the method according to Claim 1 implies the use of a milk container (jug) comprising

- a1) a container body
- a2) a lid, and
- a3) a froth-forming element.

2.1.2 The expression "emulsifying the so heated milk" (step D) defines a step consisting in including air inside the heated milk and thus producing a froth. Due to the presence of the words "so heated", it is clear that step D is carried out after step C.

Having regard to the features specified in the characterising portion of Claim 1 (ie features E to E113), it is also clear that step D is carried out after step B.

However, neither Claim 1 nor the description refers to a time relationship between steps B and C. In other words, Claim 1 cannot be interpreted as defining a method in which the milk is heated only after having been inserted into the container.

2.2 Claim 1 of the patent as granted was directed to a method for making "cappuccino **or the like**" (emphasis added), whereas the present amended Claim 1 only refers to "cappuccino". The amendment consists only in the suppression of the expression "or the like".

This amendment, being self supported by Claim 1 as granted and limiting the scope of the claim, does not contravene either Article 123(2) or Article 123(3) EPC.

3. *Procedural matter*

The documents (enclosures A to G) submitted by the appellant with the statement stating the grounds of appeal as well as those (enclosures 1 to 6) submitted by respondent I with the letter dated 22 February 2002 either were published after the filing date of the patent in suit or are not provided with a publication date.

Therefore, these documents are not taken into consideration.

4. *Article 100(c) EPC*

4.1 Claim 1 of the application as filed can be construed as being directed to a milk jug with froth-forming device for making cappuccino and the like, comprising

- a1) a container body
- a2) a lid, and
- a3) a froth-forming element,

wherein

E1121) the lid can close the container body (2),

E11) the froth forming element (10) is constituted by a plunger element (11),

E112) the plunger element is supported and guided by the lid (4), and

E113) a rod is associated with the plunger element, and protrudes from the lid.

4.1.1 Claim 1 of the patent as granted differs from Claim 1 of the application as filed in that

(i) it is directed to a method, ie to the use of a milk jug (feature A), instead of being directed to a milk jug comprising a container body, a lid, and a froth-forming element (features a1, a2 and a3),

(ii) features B, C, D, E, and E111 have been added.

4.2 Having regard to the comments in section 2.1.2 above, feature C, read in conjunction with feature D, means that the milk has to be heated before being emulsified. Thus, feature C has a limiting effect with respect to the present Claim 1 (as well as with respect to Claim 1 of the patent as granted), in so far as the scope of the claim is limited to methods in which the emulsifying step is carried out only after the heating of the milk. In other words, due to features C and D, the scope of the present Claim 1 (as well as of Claim 1 as granted), does not extend to methods in which the milk is emulsified before or during heating or without any heating.

4.3 It has however to be noted that the application as filed does not **explicitly** disclose the step of heating of the milk (feature C) but only refers to the step of emulsifying the milk contained in a container by means of a froth-forming element.

The application as filed therefore did not explicitly disclose the milk heating as such, let alone the specific steps sequence between heating and emulsifying.

4.4 With respect to feature C, the appellant essentially argued that the step of heating the milk before emulsifying is **implicitly** disclosed in the application as filed. The arguments of the appellant can be summarized as follows:

- (i) The application as filed clearly refers to "a milk jug with a froth-forming device for making 'cappuccino'" (page 1, lines 1 and 2). The introductory part of the description of the application as filed also refers to the use of a steam jet as a technique used to make cappuccino (page 1, lines 3 to 5). Thus, the expression "cappuccino" has to be construed as defining a hot beverage, ie a warm mixture of coffee (espresso) and milk with froth. Thus, the skilled person will immediately realize that the milk used for making cappuccino has to be heated.

- (ii) The introductory part of the description of the application as filed refers to the milk jug used to emulsify the milk, firstly, as being provided with a handgrip (5) made of heat insulating material (page 3, lines 1 to 5), secondly, as being provided with a froth-forming element (10) having at its free end a grip knob (13), preferably made of a heat insulating material (page 3, lines 10 to 15), and thirdly, as having a lid (4) which is provided "in order to facilitate the actuation" with a finger-bearing element (6) made of heat insulating material (page 3, lines 16 and 17). The skilled person reading the description of the application as filed will derive from it the information that all the elements of the milk jug which have to be touched,

and particularly the elements to be touched when the froth-forming element is actuated (ie grip knob 13 and finger-bearing element 6), are made of heat insulating material. Therefore, the skilled person will immediately realize that the emulsifying step takes place after the heating of the milk.

4.4.1 With respect to the appellant's comments referred to in section 4.4 (i) above, the board has no doubts that the expression "cappuccino" defines a hot beverage, consisting of a warm mixture of coffee (espresso) and milk with froth. The introductory part (page 1, line 1 to page 2, line 12) of the description of the application as filed makes it clear that the aim of the invention is to emulsify milk without having to resort to the use of a jet of steam (see particularly page 1, lines 13 to 17). However, this part of the description of the application as filed does not even implicitly disclose that the milk to be used for making cappuccino is heated, nor does it implicitly disclose that the milk has to be heated before emulsifying it. In other words, the fact the aim of the invention is to produce a hot beverage called cappuccino does not imply that the milk used for making cappuccino is heated before being emulsified. It has to be noted that a (hot) "cappuccino" could be made for example by mixing coffee, heated milk and frothed milk obtained by emulsifying cold milk.

4.4.2 Likewise, the board cannot accept the arguments referred to in section 4.4 (ii) for the following reasons:

The fact that all the elements of the milk jug which

are touched when the milk-frothing element is actuated are made of heat insulating material implies that the milk **could be** hot before the beginning of the emulsifying step but does not imply in a clear and unequivocal manner that the milk contained in the milk jug **has to be** previously heated before the beginning of the emulsifying step. In other words, the presence of the elements made of heat insulating material represents only the possibility of using the milk jug for emulsifying heated milk but does not clearly and unambiguously disclose the step of heating the milk before emulsifying it.

It has also to be noted that the step of emulsifying the milk could be carried out for example simultaneously with the step of heating the milk.

4.5 The appellant also argued that the additional step of heating the milk before emulsifying it is only a limitation which does not provide any technical contribution to the claimed subject-matter and does not give any unwarranted advantage to the appellant and that, therefore, this step has to be considered not as contravening Article 100(c) EPC, having regard to the decision G 1/93 (OJ EPO 1994, 541).

4.5.1 The board cannot accept this argument for the following reasons:

The technical problem to be solved, as it can be understood from the application as filed, is to emulsify the milk for making cappuccino "without having to resort to the use of a jet of steam". It is clear that the steps of inserting the milk in the container and emulsifying the milk by causing it to pass through

the froth-forming element defined by features E1, E11, E111, E112, E1121 and E113 contribute to the solution of this problem. It is also clear that the additional step of heating the milk before emulsifying is not independent from the above mentioned steps but interacts with them and particularly with the way these steps solve the technical problem. Therefore, this additional step provides a technical contribution to the invention as defined by the present Claim 1 (as well as by Claim 1 of the patent as granted).

It has also to be noted that the appellant, on the one side, asserted that the additional step is not essential but, on the other side (especially in his written submissions, see letter dated 28 March 2000), presented this additional heating step as being very important in order to obtain milk froth for making a cappuccino.

- 4.6 The step of heating the milk before emulsifying it cannot be derived in a clear and unequivocal way from the application as filed (see comments in sections 4.3 to 4.4.2 above). Since this step limits the scope of protection conferred to the patent (see comments in section 4.2 above) and is considered as providing a technical contribution to the claimed subject-matter (see comments in sections 4.5 and 4.5.1 above), the present Claim 1 contravenes the requirements of Article 100(c) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Magouliotis

C. Andries