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**Datasheet for the decision  
of 11 October 2011**

**Case Number:** T 0991/10 - 3.2.04

**Application Number:** 06013230.5

**Publication Number:** 1700548

**IPC:** A47J 31/40, B65D 81/00

**Language of the proceedings:** EN

**Title of invention:**  
Capsule with sealing means

**Patentee:**  
Nestec S.A.

**Opponent:**  
STRAWMAN LIMITED

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 123

**Relevant legal provisions (EPC 1973):**  
EPC Art. 84, 100c, 111

**Keyword:**  
"Allowable amendments"  
"Remittal"

**Decisions cited:**  
G 0009/91

**Catchword:**  
-



Case Number: T 0991/10 - 3.2.04

**DECISION**  
of the Technical Board of Appeal 3.2.04  
of 11 October 2011

**Appellant:** Nestec S.A.  
(Applicant) Avenue Nestlé 55  
CH-1800 Vevey (CH)

**Representative:** Christian Rupp  
Mitscherlich & Partner  
Patent- und Rechtsanwälte  
Sonnenstraße 33  
D-80331 München (DE)

**Respondent:** STRAWMAN LIMITED  
(Opponent) 34 Lovedon Lane  
Winchester  
Hampshire SO23 7NU (GB)

**Representative:** Marlon Blood  
Vereenigde  
Johan de Wittlaan 7  
NL-2517 JR The Hague (NL)

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 1 April 2010  
revoking European patent No. 1700548 pursuant  
to Article 101(3)(b) EPC.

**Composition of the Board:**

**Chairman:** M. Ceyte  
**Members:** M. Poock  
C. Heath

## Summary of Facts and Submissions

I. This appeal is against the decision of the opposition division posted 1 April 2010 revoking European patent No. 1 700 548.

II. Granted claims 1 and 9 read as follows:

"1. A capsule for containing beverage ingredients, the capsule (1) being designed for insertion in a beverage production device (2) in which a liquid under pressure enters the capsule (1) in order to interact with the ingredients (3) in the capsule (1) and to drain a beverage from the capsule (1), the capsule (1) comprising a cup-like base body (4) and a closing foil member (5), or the capsule having a lenticular form with two essentially matching and opposing walls, comprising a hollow sealing member (26) on the outer surface of the capsule (1) for achieving a sealing effect between an enclosing member (9) of the beverage production device (2) and a capsule holder (13)."

"9. A beverage production system comprising a capsule (1) according to any one of the preceding claims and a beverage production device (2) having an enclosing member (9) adapted to be selectively in sealing engagement with the sealing member (26) of the capsule (1)."

III. The opposition division held, *inter alia*, that granted claim 1 of the main request did not meet the requirements of Article 123(2) EPC, because the sealing effect between the enclosing member 9 of the beverage production device 2 and the capsule holder 13 was not

directly and unambiguously disclosed in the application. Although claim 1 of auxiliary request I complied with this requirement, it would not meet the requirements of Article 123(3) EPC, because its amendments extended the scope of granted claim 9. It defined not any more an absolute sealing effect between the enclosing member and the capsule holder but only a sealing effect for water entering the interstice between the exterior of the capsule and the enclosing member.

IV. The patent proprietor lodged the appeal on 3 May 2010 and paid the prescribed fee simultaneously. The statement of grounds of appeal was received on 10 August 2010.

V. With the summons to the requested oral proceedings, the board informed the parties that claim 1 of auxiliary request I, in contrast to the one of the main request, appeared to meet the requirements of Article 123(2) EPC, but not those of Article 123(3) EPC. Some inconsistencies in claim 1 were spotted.

In response, the appellant submitted an amended auxiliary request I in which these inconsistencies were addressed.

The requested oral proceedings took place on 11 October 2011 in which the appellant withdrew its main request.

VI. Claim 1 of revised auxiliary request I reads as follows:

"1. A beverage production system comprising a beverage production device (2) and a capsule (1), the beverage production device (2) having an enclosing member (9)

adapted to be selectively in sealing engagement with a sealing member (26) of the capsule (1), and the capsule (1) containing beverage ingredients and being inserted in the beverage production device (2) in which water under pressure enters the capsule (1) in order to interact with the ingredients (3) in the capsule (1) and to drain a beverage from the capsule (1), the capsule (1) comprising a cup-like base body (4) and a closing foil member (5), the sealing member (26) of the capsule (1) being a hollow sealing member (26) on the outer surface of the capsule (1), said sealing engagement of the enclosing member (9) with the sealing member (26) achieving a sealing effect between the enclosing member (9) of the beverage production device (2) and a capsule holder (13) for water entering the interstice between the exterior of the capsule (1) and the enclosing member (9) from a water injector of the beverage production device (2), the hollow sealing member (26) having the shape of a step, i.e. a sudden increase of the diameter of the side wall of the capsule (1)."

VII. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained on the basis of the auxiliary request I filed with the letter of 31 August 2011, in the alternative on the basis of any of the auxiliary requests II to VI filed with the grounds of appeal.

The respondent (opponent) requested that the appeal be dismissed.

VIII. The appellant argued essentially that claim 1 of auxiliary request I meets the requirements of

Article 123(2) and (3) EPC, because the amendments in claim 1 have a clear basis in the disclosure of the third embodiment of the application as filed originally and clearly limit the extent of protection in comparison with granted claim 9.

This claim defines that the sealing engagement of the enclosing member 9 with the sealing member 26 of the capsule achieves a sealing effect between the enclosing member 9 and the capsule holder 13 for water entering the interstice between the capsule exterior and the enclosing member from the water injector of the beverage production device. Such sealing engagement only applies to the water in the interstice and was never mentioned with regard to the drained beverage. Therefore the interpretation for an "absolute" sealing effect does not make technical sense for the skilled person and, consequently, was not described in the patent or application.

IX. In contrast, the respondent argued that claim 1 of auxiliary request I does not meet the requirements of Article 123(2) and (3) EPC.

Since claim 1 is limited to a hollow sealing member having the shape of a step it is supported solely by the description and Figures 10-12 of the third embodiment for which a sealing engagement is disclosed between the enclosing member and the hollow sealing member.

However, from "the perspective of water coming from the water injector, this sealing engagement may be considered as giving rise to a sealing effect, but

there is no basis in the application as originally filed for defining that sealing effect as being between the enclosing member and specifically the capsule holder as opposed to any part of the beverage production system which is beyond the sealing engagement. Whether that specific sealing effect is disclosed depends on what structure exists beyond the sealing engagement. As noted by the Opposition Division in item 4 of the decision under appeal, since the third embodiment is only shown in cross-section, it is not possible to ascertain what sealing exists beyond the sealing engagement since it is not directly and unambiguously derivable whether there is a contact between the flange-like rim of the capsule and the capsule holder along the whole circumference of the capsule holder."

"Claim 9 of the granted patent claims the sealing effect between the enclosing member and the capsule holder per se, i.e. without any limitation to any particular perspective, or an "absolute sealing effect" in the Opposition Divisions phrase. By specifying in claim 1 of the auxiliary request I that the sealing effect exists from the perspective of water coming from the injector, the patentee lessens the requirements of the sealing effect. The requirements of claim 1 of auxiliary request I are met as long as the water from the injector is prevented from passing the sealing engagement between the capsule and the enclosing member, irrespective of what exists beyond that sealing engagement. Thus, by making it irrelevant what structure exists beyond the sealing engagement between the capsule and the enclosing member, claim 1 of auxiliary request I would necessarily cover possible

solutions that are not covered by claim 9 of the granted patent."

Moreover it was argued that the term "sealing effect" in claim 1 was unclear.

With respect to the request that the case be remitted to the opposition division, preference was indicated that the board of appeal decided on patentability.

### **Reasons for the Decision**

1. The appeal is admissible.
2. Articles 100c - 123(2) EPC
  - 2.1 Claim 1 of auxiliary request I is based on the beverage production system of claim 9 in combination with the capsule of claim 5 including the features of original claim 1, all as filed originally. Such a system is disclosed as third embodiment and shown in figures 10 to 12 in the original application. That the liquid under pressure mentioned in original claim 1 could be water results from page 1, line 24.
  - 2.2 It was at stake whether the amended feature that "said sealing engagement of the enclosing member (9) with the sealing member (26) achieving a sealing effect between the enclosing member (9) of the beverage production device (2) and a capsule holder (13)" has a basis in the application as originally filed.



2.2.1 This amendment links the unspecified sealing effect of granted claim 1 to the sealing engagement of the enclosing member with the sealing member of the capsule. The claimed sealing effect is thus achieved not just anywhere between the enclosing member and the capsule holder, but at a specific location in-between, i.e. where the enclosing member has physical contact with the sealing member of the capsule. Thus, in combination with the following feature in claim 1, it defines that the water in the interstice is prevented from escaping past the seal provided by the enclosing member and the sealing member of the capsule.

In this respect, the board adds that it is irrelevant what sealing exists beyond this sealing engagement and whether there is a contact between the flange-like rim of the capsule and the capsule holder along the whole circumference of the capsule holder, because claim 1 is not directed to this aspect. What matters is the sealing engagement between the enclosing member and the sealing member of the capsule.

2.2.2 Such a sealing engagement is clearly disclosed on page 5, lines 18 to 22 in combination with page 7, paragraph 3 and in the description (page 15, line 15 to page 16, line 6) and the drawings (figures 10 to 12) for the third embodiment. Figure 12 shows the sealed state of the beverage production device in which the enclosing member 9 and the sealing member 26 of the capsule 1 are engaged at a sealing surface 15 so that water in the interstice between the enclosing member 9 and the capsule 1 is prevented from escaping.

2.3 Consequently, the subject-matter of claim 1 does not extend beyond the content of the application as filed (Article 100c EPC) and complies with the requirements of Article 123(2) EPC.

3. Article 123(3) EPC

3.1 Granted claim 9 covers a beverage production system comprising:

- (a) a capsule (1) according to any one of the preceding claims. Thus, according to granted claim 1, the capsule is for containing beverage ingredients and is designed for insertion in a beverage production device (2) in which a liquid under pressure enters the capsule (1) in order to interact with the ingredients (3) in the capsule (1) and to drain a beverage from the capsule (1), the capsule (1) comprising:
  - (i) a cup-like base body (4) and a closing foil member (5), or the capsule having a lenticular form with two essentially matching and opposing walls,
  - (ii) a hollow sealing member (26) on the outer surface of the capsule (1) for achieving a sealing effect between an enclosing member (9) of the beverage production device (2) and a capsule holder (13),
- (b) and a beverage production device (2) having an enclosing member (9) adapted to be selectively in sealing engagement with the sealing member (26) of the capsule (1).

3.2 These features are identically present in claim 1 of auxiliary request I, except for

- feature (a) which specifies now "water" as "liquid" under pressure,
- feature (b) (ii) which now reads: "the sealing member (26) of the capsule (1) being a hollow sealing member (26) on the outer surface of the capsule (1), said sealing engagement of the enclosing member (9) with the sealing member (26) achieving a sealing effect between the enclosing member (9) of the beverage production device (2) and a capsule holder (13) for water entering the interstice between the exterior of the capsule (1) and the enclosing member (9) from a water injector of the beverage production device (2)", and
- the further feature that the hollow sealing member (26) having the shape of a step, i.e. a sudden increase of the diameter of the side wall of the capsule (1).

3.2.1 These amendments clearly restrict the extent of protection conferred by granted claim 9 because they add further limitations. The sealing effect is now limited to the sealing engagement of the enclosing member 9 and the sealing member 26 of the capsule 1 at sealing surface 15 so that water in the interstice between the enclosing member 9 and the capsule 1 is prevented from escaping.

4. In summary, the amendments in claim 1 comply with Article 123(3) EPC.

5. Article 84 EPC

The respondent objected in the oral proceedings that the term "sealing effect" was unclear. However, this term is present in granted claim 1. Therefore, it is not an amendment to granted claim 1 which could be examined for compliance with the requirements of Article 84 EPC according to G 9/91, item 19; OJ EPO 93, 408).

6. Since the decision of the opposition division did not contain any findings regarding the patentability of the claimed subject-matter, and in view of the requests made by the parties in the appeal procedure, the board in exercising its discretion under Article 111(1) EPC 1973 decided to remit the case to the first instance for further prosecution on the basis of auxiliary request I filed with the letter of 31 August 2011.

**Order**

**For these reasons it is decided that:**

1. The decision of the opposition division is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

G. Magouliotis

M. Ceyte