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**Datasheet for the decision
of 19 March 2018**

Case Number: T 1010/13 - 3.2.07

Application Number: 08793832.0

Publication Number: 2134611

IPC: B65D85/804, A47J31/24

Language of the proceedings: EN

Title of invention:

SYSTEM AND METHOD FOR PREPARING A BEVERAGE

Patent Proprietor:

Koninklijke Douwe Egberts B.V.

Opponents:

Migros-Genossenschafts-Bund
Alice Allison SA
Pajaro Limited
Patentwerk B.V.
Zardi, M. Marco

Headword:

Relevant legal provisions:

EPC Art. 54, 56, 83, 123(2)

Keyword:

Procedural deficiencies (no)

Novelty - main request (no) - auxiliary request (yes)

Amendments - auxiliary request - added subject-matter (no)

Sufficiency of disclosure - auxiliary request (yes)

Inventive step - auxiliary request (yes)

Decisions cited:

T 1704/06, T 0068/85

Catchword:



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Case Number: T 1010/13 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 19 March 2018

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
28 February 2013 concerning maintenance of
European patent No. 2134611 in amended form**

Composition of the Board:

Chairman I. Beckedorf
Members: G. Patton
V. Bevilacqua

Summary of Facts and Submissions

I. Appellant I (patent proprietor) lodged an appeal against the interlocutory decision of the opposition division maintaining European patent No. 2 134 611 in amended form.

Appellant II (opponent 2), appellant III (opponent 4) and appellant IV (opponent 5) likewise lodged an appeal against this interlocutory decision.

Opponent 1 is a party to the proceedings as of right pursuant to Article 107 EPC.

Opponent 3 withdrew its opposition by letter of 15 February 2016 and, hence, is no longer a party to the proceedings.

II. In the opposition proceedings, the subject-matter of independent claims 1, 2, 44, 45 and 48 of the patent as granted (appellant I's then main request) was regarded as lacking inventive step, while the grounds for opposition based on Articles 100(b) and (c) EPC were found not to prejudice the maintenance of a patent. The patent was maintained on the basis of the then first auxiliary request.

III. The Board provided a preliminary non-binding opinion annexed to the summons to oral proceedings with respect to appellant I's main request (patent as granted) and auxiliary requests filed with a letter dated 26 November 2013, the latter subsequently being replaced by a new auxiliary request 1 during oral proceedings.

- IV. Oral proceedings took place on 19 March 2018 in the presence of appellant I only. For the course of the oral proceedings and in particular the requests, procedural declarations and the matters discussed as well as the decision announced at the end of the oral proceedings, reference is made to the minutes.
- V. Appellant I requested that the decision under appeal be set aside and that the patent be maintained as granted or, in the alternative, that the patent be maintained in amended form on the basis of the set of claims filed as auxiliary request 1 during the oral proceedings.
- VI. Appellants II, III and IV requested that the decision under appeal be set aside and that the patent be revoked.
- Appellant II also requested that the case be remitted to the opposition division.
- VII. The following documents from the opposition proceedings are of relevance for the decision:

D1: FR 2 617 389 A;
D2: WO 2004/083071 A;
D3: DE 1 989 147 U;
D4: EP 1 854 741 A;
D5: US 5 242 702 A;
D10: EP 1 580 144 A;
D11: EP 1 295 554 A;
D12: US 5 897 899 A;
D18: DE 692 10 084 T2;
D21: FR 2 905 683 A;
D22A: WO 2006/053635 A;
D24: EP 1 344 722 A;

D25: EP 1 555 219 A;
D30: EP 0 512 468 A;
D31: US 2003/172813 A;
D33: EP 0 521 510 A;
D37: US 2005/0150390 A;
D38: US 2006/0107841 A;
D39: EP 0 512 470 A;
D46: US 3 878 772 A; and
D48: DE 41 92 762 C2.

Document D21 was published between the claimed priority date and the filing date of the contested patent.

The following documents, which are of relevance for the present decision, were first filed during the appeal proceedings:

E1: US 6 026 732 A;
E5: US 2005/0150391 A; and
E6: CH 605 293 A.

Their admittance into the appeal proceedings has not been contested by appellant I.

VIII. Claim 1 of the **main request** reads as follows:

"System (1) for preparing a predetermined quantity of beverage suitable for consumption using an extractable product comprising:

an exchangeable capsule (2), and
an apparatus (104) comprising a receptacle (106) for holding the exchangeable capsule, and a fluid dispensing device (108) for supplying an amount of a fluid, such as water, under pressure to the exchangeable capsule (2);

wherein the exchangeable capsule comprises a circumferential wall (10); a bottom (12) closing the circumferential wall at a first end (14); and a lid (16) closing the circumferential wall at a second end (18) opposite the bottom, wherein the wall, bottom and lid enclose an inner space (20) comprising the extractable product,

wherein the bottom (12) comprises an entrance area and the system is arranged for bringing the fluid dispensing device in fluid connection with the entrance area for supplying the fluid to the extractable product for preparing the beverage,

wherein the lid (16) comprises an exit area and the system comprises an outlet which, in use, is in fluid communication with the exit area for draining the prepared beverage from the capsule and supplying the beverage to a container such as a cup,

wherein the receptacle comprises bottom piercing means (122) intended for piercing the entrance area of a prior art capsule (102) for creating at least one entrance opening (124) for supplying the fluid to the extractable product through said at least one entrance opening (124),

characterised in that the entrance area of the capsule (2) of the system (1) comprises an entrance filter (34) for supplying the fluid to the extractable product there through which entrance filter (34), in use, is positioned at a distance from the bottom piercing means (122), such that the capsule of the system is not pierced by the bottom piercing means and the bottom stays intact."

Claim 1 of **auxiliary request 1** (= independent claim 2 of the patent as granted/main request) reads as follows:

"System (1) for preparing a predetermined quantity of beverage suitable for consumption using an extractable product, comprising:

an exchangeable capsule (2); and
an apparatus (104) comprising a receptacle (106) for holding the exchangeable capsule, and a fluid dispensing device (108) for supplying an amount of a fluid, such as water, under pressure to the exchangeable capsule (2),

wherein the exchangeable capsule comprises a circumferential wall (10); a bottom (12) closing the circumferential wall at a first end (14); and a lid (16) closing the circumferential wall at a second end (18) opposite the bottom, wherein the wall, bottom and lid enclose an inner space (20) comprising the extractable product,

wherein the bottom (12) comprises an entrance area and the system is arranged for bringing the fluid dispensing device in fluid connection with the entrance area for supplying the fluid to the extractable product for preparing the beverage,

wherein the lid (16) comprises an exit area and the system comprises an outlet which, in use, is in fluid communication with the exit area for draining the prepared beverage from the capsule and supplying the beverage to a container such as a cup,

wherein the receptacle comprises lid piercing means (128) intended for piercing the exit area of a prior art capsule (102) when the exit area sufficiently presses against the lid piercing means (128) under the influence of the pressure of the fluid and/or beverage in the capsule for creating at least one exit opening (130) through which the beverage can drain from the prior art capsule,

characterised in that the exit area of the capsule (2) of the system (1) comprises an exit filter (36), through which the beverage can drain from the capsule of the system, wherein the lid piercing means (128) and the exit filter (36) are adapted to each other such that the capsule of the system, in use, is not pierced by the lid piercing means and the lid stays intact."

Claim 43 of **auxiliary request 1** (= claim 45 of the patent as granted/main request) reads as follows:

"Method for preparing a predetermined quantity of beverage suitable for consumption using an extractive product, comprising:

providing an exchangeable capsule (2), comprising a circumferential wall (10), a bottom (12) closing the circumferential wall (10) at a first end (14), and a lid (16) closing the circumferential wall at a second end (18) opposite the bottom (12); wherein the wall (10), bottom (12) and lid (16) enclose an inner space (20) comprising the extractable product,

providing an apparatus (104) comprising a receptacle (106) for holding the exchangeable capsule (2), a fluid dispensing device (108) for supplying an amount of a fluid, such as water, under pressure to the

exchangeable capsule (2), and an outlet which, in use, is in fluid communication with the capsule (2) for draining the prepared beverage from the capsule and supplying the beverage to a container such as a cup, wherein the receptacle comprises lid piercing means (128) intended for piercing the lid (116) of a prior art capsule (102) when the lid (116) sufficiently presses against the lid piercing means (128) under the influence of the pressure of the fluid and/or beverage in the capsule for creating at least one exit opening through which the beverage can drain from the prior art capsule, and

supplying the fluid to the extractable product for preparing the beverage,

characterised in that the lid (16) of the capsule (2) comprises an exit filter (36), through which the beverage can drain from the capsule (2) wherein the lid piercing means (128) and the exit filter (36) are adapted to each other such that the capsule, in use, is not pierced by the lid piercing means and the lid stays intact."

Claim 46 of **auxiliary request 1** reads as follows (bold and strike-through show the amendments with respect to claim 48 of the patent as granted/main request; emphasis added by the Board):

"Use of a capsule (2) of the system (1) according to any one of claims 1-4~~23~~ for preparing a beverage using the apparatus (104) according to any one of claims 1-4~~23~~."

IX. Appellant I argues in substance essentially as follows:

Main request

The filter 5b of D10, figure 2, is not comprised in the entrance area as claimed, since it is a loose part not bound to said entrance area. Hence, D10 does not disclose the feature of the characterising portion of claim 1 that the entrance area of the capsule of the system **comprises** an entrance filter; so novelty of the claimed subject-matter should be acknowledged.

Auxiliary request 1

The subject-matter of claim 1 of auxiliary request 1 is described in figure 2 and paragraphs 54 to 61 of the patent in suit. Hence, the disclosure is sufficient for the skilled person to perform the invention.

The subject-matter of claim 1 of auxiliary request 1 should be seen as novel vis-à-vis each of documents D24, D25, D46 and D48.

The first embodiment of D25 shown in figure 2 should be taken as the closest prior art for claim 1 of auxiliary request 1 since, like claim 1, it concerns a capsule which, in use, is not pierced and the lid stays intact. In view of the technical effects associated with the following distinguishing features (b):

(b) the receptacle comprises lid piercing means intended for piercing the exit area of a prior art capsule when the exit area sufficiently presses against the lid piercing means under the influence of the pressure of the fluid and/or beverage in the capsule for creating at least one exit opening

through which the beverage can drain from the prior art capsule

the problem to be solved should be seen as how to modify the capsule of the first embodiment of D25 to make it fit and usable in a beverage apparatus comprising lid piercing means, without being pierced by the latter in use.

Either the cited prior art does not disclose lid piercing means, more particularly features (b), such that its combination with the first embodiment of D25 would not lead to the claimed subject-matter in an obvious manner, or the skilled person would not think of combining the cited prior art, since it discloses piercing of the capsule in use, which is contrary to the first embodiment of D25. Were he nonetheless to think of the combination, he would then arrive at a capsule pierced in use, i.e. not at the claimed subject-matter.

Hence, inventive step should be acknowledged for the subject-matter of claim 1 of auxiliary request 1.

For the same reasons inventive step should also be acknowledged for independent claims 43 and 46.

X. Appellants II, III and IV argue in substance essentially as follows

Procedural deficiencies

For appellant II the opposition division interpreted features of the claims too narrowly, thereby excluding relevant prior-art documents. The opposition division should have applied the partial problems approach for

assessing inventive step in respect of the claimed subject-matter. The description should also have been adapted in respect of the teaching of documents D24 and D25. The decision under appeal is also insufficiently reasoned, and the opposition division misunderstood appellant II's objection(s). The case should therefore be remitted to the opposition division in order to reconsider these issues.

Main request

According to appellant IV, D10 discloses all the features of claim 1, including that the entrance area of the capsule of the system comprises an entrance filter. The term "comprises" also encompasses the technical meaning that the entrance filter is not attached to the bottom but is merely present in the entrance area, as is the case for the entrance filter 5b of D10, see figure 2. Hence, the subject-matter of claim 1 should be regarded as lacking novelty over D10.

Auxiliary request 1

For appellant II, claim 9 of auxiliary request 1 should be deleted because of double patenting and should be examined for consistency with the other claims, in particular with claim 10 of auxiliary request 1.

Appellant II also considers that the patent does not disclose how to adapt the lid piercing means and the exit filter to each other in order to not pierce the capsule and to keep the lid intact. The position of the filter cannot inevitably lead to such claimed results to be achieved. Hence, the skilled person would not know how to perform the invention.

Appellant IV refers to its arguments presented with its notice of opposition for the objections pursuant to Articles 100(c) and 123(2) EPC.

Appellant IV, still referring to its arguments presented in opposition proceedings, considers that in the absence of a definition in the contested patent of the expression "prior art capsule" used in claim 1 of auxiliary request 1, the skilled person would not be able to realise piercing means suitable for piercing said "prior art capsule".

Regarding patentability, it is objected that the subject-matter of claim 1 of auxiliary request 1 should be seen as lacking novelty vis-à-vis each of documents D24, D25, D46 and D48.

The subject-matter of claim 1 should be seen as lacking inventive step starting from any one of documents D5, D11, D21, D24, D25, D46, E1 or E5 taken as plausible closest prior art.

Starting from the first embodiment of D25 shown in figure 2 as closest prior art, its combination with the teaching of either D11, D24 or D39 leads to the claimed subject-matter in an obvious manner.

In particular, the apparatuses of D11 or D24 would not pierce the capsule of the first embodiment of D25 in use, since the disclosed piercing means would merely abut against the filter element 2 of D25.

A skilled person reading D25 would be referred to D24, in which the water flows in both directions. He would then be taught that the water flow could be reversed in the first embodiment of D25, such that lid 4 of said

embodiment can be seen as the exit area of the capsule. Lid 4 does not form part of the capsule since it merely serves to conserve the coffee inside the capsule. Therefore, the capsule is not pierced in the first embodiment of D25, and the lid ("Verteilorgan" 3) stays intact. Hence, starting from the first embodiment of D25, the skilled person considering D24 would arrive at the claimed subject-matter in an obvious manner.

Reasons for the Decision

1. *Right to be heard*

Although appellants II, III and IV did not attend the oral proceedings, the principle of the right to be heard pursuant to Article 113(1) EPC is observed since that article affords only the opportunity to be heard, and by absenting itself from the oral proceedings a party gives up that opportunity (see the explanatory note to Article 15(3) RPBA cited in T 1704/06, not published in OJ EPO; see also the Case Law of the Boards of Appeal, 8th edition 2016, sections III.B.2.7.3 and IV.E.4.2.6.d).

2. *Procedural deficiencies*

2.1 Appellant II considers that procedural deficiencies occurred during the opposition proceedings.

Its view is that the opposition division interpreted the terms "bottom" and "lid" used in the claims too narrowly. As a consequence, many documents were wrongly not taken into consideration. In particular, D25, figure 2, should have been regarded as novelty-destroying for claim 2 of the main request and relevant

for inventive step in respect of claim 1 of the main request, bearing in mind the broadest technically feasible interpretation of these terms.

Further, still according to appellant II, the opposition division refused to apply the partial problems approach for assessing inventive step in respect of the claimed subject-matter, although the technical features did not have any synergy in their effects. The description should also have been adapted in respect of the objective technical problem, taking the teaching of documents D24 and D25 into account.

The opposition division did not provide sufficient reasoning in the decision under appeal with regard to the objections raised during the opposition proceedings, in particular the objection pursuant to Articles 100(b) and 83 EPC. As apparent from the minutes, appellant II's objection in this respect was misunderstood by the opposition division.

Appellant II therefore requests that the case be remitted to the opposition division in order to reconsider these issues (see letter dated 16 February 2018, "Zu a): Prozessmängel", page 4; and "Anträge", page 13).

2.2 The Board cannot follow appellant II's view for the following reasons.

Firstly, it notes that appellant II did not request a correction of the minutes, which in its view incorrectly reflected its arguments as to insufficiency of disclosure. There is therefore no reason to doubt the veracity of the minutes and the fair conduct of the oral proceedings vis-à-vis all parties present.

Secondly, the Board considers that the issues raised by appellant II - interpretation of features, assessment of inventive step and adaption of the description - relate to the opposition division's evaluation of the substantive merit of each respective issue. This as such cannot amount to a procedural deficiency.

Finally, the Board finds no lack of reasoning in the impugned decision, whatever the objection raised. In particular, the objection pursuant to Articles 100(b) and 83 EPC is dealt with in point 2.3.3 in a sufficiently reasoned manner.

2.3 Hence, the Board cannot identify any procedural deficiency in the opposition proceedings that could necessitate or justify remitting the case to the opposition division.

3. *Main request*

Since the Board considers that the subject-matter of independent claim 1 of the main request lacks novelty over D10 (see below), there is no need to discuss in this decision the other objections raised by appellants II, III and/or IV against this request.

3.1 Document D10, paragraph 57, discloses a reversible capsule ("cartridge" 1) in figures 1 to 4, i.e. it can also be inserted and used upside down in the apparatus. Hence, the bottom and the lid of the cartridge of figures 1 to 4 can have both roles (entrance area and exit area), depending on how the capsule is inserted in the apparatus. For the following analysis of D10, the disclosure of figure 18 is used, i.e. lip port 3 representing *de facto* the bottom of the capsule

specified in claim 1 (entrance area). It is however taken into account that, in accordance with the above disclosure of D10, uncontested by appellant I, the capsule 1 depicted in figures 1 to 4 can also be inserted and used upside down in the apparatus shown in figure 18.

D10 (paragraphs 28-49, 57, 58, 144-165; figures 1-4, 17, 18) discloses a system for preparing a predetermined quantity of beverage suitable for consumption using an extractable product (paragraph 1), comprising:

an exchangeable capsule 1, and
an apparatus ("extraction assembly" 60) comprising a receptacle ("cartridge holder" 64) for holding the exchangeable capsule 1, and a fluid dispensing device ("water inlet" 65; "nozzle body" 265a) for supplying an amount of a fluid, such as water, under pressure to the exchangeable capsule 1;

wherein the exchangeable capsule 1 comprises a circumferential wall ("cylindrical sidewall" 8); a bottom ("lid portion" 3; "lid base" 7b) closing the circumferential wall at a first end; and a lid ("cup base" 7) closing the circumferential wall 8 at a second end opposite the bottom 3, 7b, wherein the wall 8, bottom 3, 7b and lid 7 enclose an inner space ("internal volume") comprising the extractable product ("ground coffee"),

wherein the bottom 3, 7b comprises an entrance area ("lid port" 6b; "opening" 103b; "barriers" 104b) and the system is arranged for bringing the fluid dispensing device 65, 265a in fluid connection with the

entrance area 6b, 103b, 104b for supplying the fluid to the extractable product for preparing the beverage,

wherein the lid 7 comprises an exit area ("cup port" 6a) and the system comprises an outlet ("opening" 267) which, in use, is in fluid communication with the exit area 6a for draining the prepared beverage from the capsule 1 and supplying the beverage to a container,

wherein the receptacle comprises bottom piercing means ("needle" 265b) intended for piercing the entrance area of a prior art capsule 1 ("lid port plugged by a film...pierced or torn by the machine during the extraction...", see paragraph 49) for creating at least one entrance opening for supplying the fluid to the extractable product through said at least one entrance opening,

wherein the entrance area of the capsule 1 of the system comprises an entrance filter ("paper filter" 5b) for supplying the fluid to the extractable product there through which entrance filter 5b, in use, is positioned at a distance from the bottom piercing means 265b, such that the capsule of the system is not pierced by the bottom piercing means and the bottom stays intact ("lid port plugged by a film...manually removed...", see paragraph 49).

In view of the above, D10 discloses all the features of claim 1 of the main request, and hence its subject-matter is not novel over D10 (Article 54(1) EPC).

3.2 The Board does not concur with the finding of the impugned decision, point 2.3.6.1, relative to the definition of a lid. As discussed in the oral proceedings, the Board considers for the present

decision that, as stated in claim 1, the bottom is the part of the capsule from which, in use, the fluid enters said capsule; the lid is the part of the capsule from which, in use, the fluid exits said capsule.

3.3 The Board follows appellant I's view put forward during the oral proceedings that in D10 the openings 103b of the bottom 3, 7b (and similarly openings 103a in figures 3 and 4) do not represent an entrance filter as claimed, since said openings 103b aim exclusively at diverting the fluid flow or providing support against the filter paper 5b, see paragraphs 36 to 42. They do not act as a filter because they do not retain any residue not intended to flow through the ground coffee. This, however, cannot provide novelty for the claimed subject-matter over D10, since the system of D10 explicitly comprises an entrance filter 5b, as discussed in point 3.1 above and also hereafter.

3.4 According to appellant I's view also put forward during the oral proceedings (see letter dated 26 November 2013, point C.1, page 9), the filter 5b of D10 is not comprised in the entrance area as claimed, since it is a loose part not bound to said entrance area. Hence, for appellant I the system of D10 does not disclose the feature of the characterising portion of claim 1 that the entrance area of the capsule of the system **comprises** an entrance filter. The fact that claim 1 excludes the configuration with a loose filter as in D10 would be derived from claim 1 itself in view of the features that the "bottom comprises an entrance area" and "the entrance area comprises an entrance filter", implying that the bottom comprises an entrance filter, i.e. the filter is part of the bottom. This would be supported by the embodiments of the contested patent, see figures 3a to 3d.

3.5 The Board cannot follow this view, since the term "comprises" used in claim 1 is to be given its broadest technically feasible meaning, which also encompasses the possibility that the entrance filter is not attached to the bottom but is merely present in the entrance area. This is clearly the case for the entrance filter 5b of D10, see figure 2. The Board fails to see why the term "comprises" should be seen as being limited to appellant I's interpretation and the embodiments of the contested patent.

The Board also emphasises that the expression "entrance area" used in claim 1 does not define an area with specific limits. According to claim 1, the entrance area has merely to be comprised in the bottom, the latter closing the circumferential wall, and the fluid dispensing device is brought in fluid connection with said entrance area. The position of filter 5b in D10 unambiguously fulfils these claimed criteria with respect to the entrance area.

4. *Auxiliary request 1*

4.1 Amendments

Claim 1 of auxiliary request 1 corresponds to independent claim 2 of the main request (patent as granted).

4.1.1 In appeal proceedings, only appellant IV raised the ground for opposition pursuant to Article 100(c) EPC.

However, appellant IV merely referred in general terms to its arguments presented with its notice of opposition, and in appeal proceedings it failed to

provide specific arguments as to why the impugned decision should be considered incorrect in respect of the requirements of Article 100(c) EPC.

- 4.1.2 Appellant IV therefore failed to comply with the requirements of Article 12(2) RPBA, and so its objections based on Article 100(c) EPC are not admitted into the appeal proceedings pursuant to Article 12(4) RPBA.

This was the Board's preliminary opinion provided in the annex to the summons to oral proceedings, point 6. It has subsequently been neither commented on nor contested by the parties, either in writing or orally.

Hence, the finding of the impugned decision, point 2.3.2, that the ground for opposition according to Article 100(c) EPC does not hold against the claims of the patent as granted, i.e. also against the claims of auxiliary request 1, is valid.

- 4.1.3 Furthermore, the Board fails to see the need to delete dependent claim 9 of auxiliary request 1 as requested by appellant II because of alleged double patenting or to examine its consistency with other claims, in particular with dependent claim 10 of auxiliary request 1 (see appellant II's letter dated 16 February 2018, page 13). In fact, the claims of auxiliary request 1 correspond to claims of the patent as granted, and the compliance of granted claims with the requirements of Article 84 EPC may not be examined (G 3/14, published in OJ EPO 2015, A102). Furthermore, the subject-matter was already part of the claims of the contested patent, and double patenting is not as such a ground for opposition.

4.2 Sufficiency of disclosure

4.2.1 Appellant II argues that claim 1 of auxiliary request 1 comprises the following two features drafted as results to be achieved:

- "the **capsule** of the system, in use, **is not pierced** by the lid piercing means" (first result to be achieved) and

- "the **lid stays intact**" (second result to be achieved),

which are to be obtained by the following functional feature: "the lid piercing means and the exit filter are adapted to each other".

For appellant II, the patent does not disclose how to adapt the lid piercing means and the exit filter to each other in order to obtain said claimed results to be achieved. The position of the filter cannot inevitably lead to the capsule not being pierced and the lid being left intact. This appears clearly from the prior-art disclosure, see for instance the capsule of D21 used in the apparatus of E6, or the systems disclosed in D24, D25 or D48.

Appellant II, referring to T 68/85 (OJ EPO 1987, 228), argues that a functional feature can be allowed only:

- (i) if the feature cannot otherwise be defined more precisely without restricting the inventive teaching; and
- (ii) if the feature provides the skilled person with a sufficient and clear technical teaching enabling him to carry it out without undue experimentation.

The first condition (i) would not be fulfilled, since the two results to be achieved are not linked to

the inventive teaching of the patent, which is to provide a more uniform flow of the fluid through the capsule. A more precise definition in relation to the inventive teaching would be that:

- "the **exit filter** of the system, in use, is not pierced by the lid piercing means" (first result to be achieved) and
- "the **exit filter** stays intact" (second result to be achieved).

The second condition (ii) would also not be fulfilled, since the capsule can be provided with a second lid seal (see claims 32 and 33) and the skilled person does not know how to leave the lid intact and avoid its piercing by adapting the lid piercing means and the exit filter to each other.

4.2.2 The Board cannot follow this view for the following reasons (see appellant I's letter dated 26 November 2013, point B).

The skilled person understands that by adapting the exit filter and the lid piercing means to each other, with respect *inter alia* to the shape, e.g. ridges, of the lid piercing means and to the parameters, e.g. tear strength, flow resistance or thickness, of the entrance filter, it can be brought about that the capsule, in use, is not pierced by the lid piercing means and that the lid stays intact.

A disclosure of such a situation is depicted for example in figure 2 of the patent in suit, where the the lid piercing means 128 and the exit filter 36 are adapted to each other such that the capsule 2 is not pierced, in use, by the lid piercing means 128 and the lid 36 stays intact. The lid piercing means comprise

for instance ridges against which the lid, in use, abuts. Such ridges can be formed by the blunt piercing means 128 as shown with dashed lines in figure 2 (see paragraphs 54 to 61).

If there were an element of the capsule which extended downwardly away from the exit filter, it is clear to the Board that for the same reasons as discussed above the lid piercing means and the exit filter can be adapted to each other such that the capsule including this element is not pierced and the lid stays intact.

4.2.3 As to the expression "prior art capsule" used in claim 1 of auxiliary request 1, the Board follows the opposition division's finding in point 2.3.3.2, second paragraph, of the impugned decision. In this respect, this was the preliminary opinion of the Board provided in the annex to the summons to oral proceedings, point 5.3. It has subsequently been neither commented on nor contested by the parties, either in writing or orally. The Board further notes that in appeal proceedings only appellant IV raised the issue of this expression, without however any additional substantiation as to why the opposition division's finding should be considered incorrect (see appellant IV's letter dated 9 July 2013, point I).

4.2.4 In view of the above, the Board cannot find fault in the finding of the impugned decision, point 2.3.3.

4.3 Novelty - claim 1

The opponents-appellants contested the novelty of the subject-matter of claim 1 of auxiliary request 1 in view of each of documents D24, D31, D25, D37, D46 and D48.

4.3.1 Vis-à-vis D24

Document D24 (paragraphs 18-28 and figures 1-6) discloses a system for preparing a predetermined quantity of beverage suitable for consumption using an extractable product ("Substanz", KP), comprising:

an exchangeable capsule ("Portionenkapsel"); and an apparatus comprising a fluid dispensing device for supplying an amount of a fluid, such as water, under pressure to the exchangeable capsule (see paragraph 1, claim 1),

wherein the exchangeable capsule comprises a circumferential wall ("Becher" 1); a bottom ("Deckel" 4 or "Boden" 7, depending on the direction of flow of the fluid represented by the double arrow 22 in figure 2) closing the circumferential wall at a first end; and a lid ("Deckel" 4 or "Boden" 7, again depending on the direction of flow of the fluid represented by the double arrow 22 in figure 2) closing the circumferential wall at a second end opposite the bottom, wherein the wall, bottom and lid enclose an inner space comprising the extractable product KP,

wherein the bottom 4 or 7 comprises an entrance area and the system is arranged for bringing the fluid dispensing device in fluid connection with the entrance area for supplying the fluid to the extractable product for preparing the beverage,

wherein the lid 4 or 7 comprises an exit area and the system comprises an outlet which, in use, is in fluid communication with the exit area for draining the

prepared beverage from the capsule and supplying the beverage to a container,

wherein the disclosed system comprises lid piercing means ("Aufstechmittel" 21, 20) suitable for piercing the exit area of a prior art capsule,

wherein the exit area of the capsule of the system comprises an exit filter ("Verteilorgan" 3 or "Sammelorgan" 2, depending on whether the top "Deckel" 4 or bottom "Boden" 7, respectively, is considered as the lid), through which the beverage can drain from the capsule of the system.

In the system of D24 the capsule, in use, **is pierced** by the lid piercing means 21 or 20 and the lid 4 or 7 **does not stay intact**.

As appears from the above, the Board follows appellant I's argument put forward at the oral proceedings that D24 does not disclose a receptacle as such.

As already mentioned in point 3.2 above, the Board considers that the bottom is the part of the capsule from which, in use, the fluid enters said capsule; the lid is the part of the capsule from which, in use, the fluid exits said capsule. Hence, each of the top ("Deckel" 4) or the bottom ("Boden" 7) of the capsule of D24 can represent the lid of claim 1 of auxiliary request 1, since the fluid can flow in both directions, see double arrow 22 in figure 2 and column 6, lines 32-35.

Should either top 4 or bottom 7 of the capsule of D24 be regarded as representing the lid of claim 1, they are both clearly pierced in use, contrary to the

requirements of claim 1 (see appellant I's letter dated 26 November 2013, point C.3).

Therefore, D24 does not disclose at least the following features (a) of claim 1:

(a) the lid piercing means and the exit filter are adapted to each other such that the capsule, in use, is not pierced by the lid piercing means and the lid stays intact.

Furthermore, in view of the position of the piercing means 21 and 20 depicted in figures 2 to 6, the skilled person would conclude that they are displaceable. Hence, the Board follows appellant I's view that the following features (b) of claim 1 are also not directly and unambiguously derivable from D24 (see appellant I's letter dated 26 November 2013, pages 49 and 52, feature (c)):

(b) the receptacle comprises lid piercing means intended for piercing the exit area of a prior art capsule when the exit area sufficiently presses against the lid piercing means under the influence of the pressure of the fluid and/or beverage in the capsule for creating at least one exit opening through which the beverage can drain from the prior art capsule.

In this respect, the passage of D24 from column 1, line 55, to column 2, line 9, cited by appellants II and III relates to the prior art of D24, i.e. not to the disclosure of D24 as such.

Consequently, the subject-matter of claim 1 of auxiliary request 1 is novel over document D24.

Appellant II refers to claims 32 or 33 of the contested patent (claims 31 or 32 of auxiliary request 1), which specify an additional seal to be partially releasable/removable, see figure 4a to 4c and paragraphs 77 to 81 of the contested patent. For appellant II, since it is not specified how this additional seal is partially releasable/removable, its piercing in use also falls within the definition of "partially releasable/removable". Since the additional seal can also be removed before use, appellant II also considers that it does not belong to the capsule, but is rather to be seen as being part of a packaging of the capsule. For appellant II, the capsule is to be understood as the walls encapsulating the product. In D24 the capsule would then be represented by the filters ("Sammelorgan" 2 and "Verteilorgan" 3) and the circumferential wall of the cup ("Becher" 1), see figures 3 to 6. Hence, for appellant II, the top 4 and the bottom 7 of D24 do not belong to the capsule and can be partially removed by piercing in accordance with the additional seal of claims 32 or 33, and so novelty should not be acknowledged.

The Board cannot follow this view. The top 4 and the bottom 7 of the capsule of D24 cannot equate to an additional seal as stated in dependent claims 32 or 33 of the contested patent. In fact, firstly, the Board does not follow appellant II's interpretation that the capsule is restricted to the walls encapsulating the product. Secondly, even if it is true that a packaging of the capsule cannot be regarded as belonging to the capsule itself, neither the top 4 nor the bottom 7 of the capsule of D24 is intended to be removed before use, so they are not part of a packaging of the

capsule. The top 4 and the bottom 7 are clearly part of the capsule disclosed in D24.

4.3.2 Vis-à-vis D31

The Board notes that document D31, which is briefly referred to by the opponents-appellants, is a parallel US patent application to D24 with a similar disclosure to that of D24. The above reasons also apply vis-à-vis D31.

4.3.3 Vis-à-vis D25

Document D25 (paragraphs 11-27 and figures 1-3) discloses a system for preparing a predetermined quantity of beverage suitable for consumption using an extractable product ("Kaffee", KP), comprising:

an exchangeable capsule ("Portionenkapsel"); and an apparatus comprising a fluid dispensing device for supplying an amount of a fluid, such as water, under pressure to the exchangeable capsule (see paragraph 1, claim 1),

wherein the exchangeable capsule comprises a circumferential wall ("Unterteil", "Becher" 1); a bottom ("Deckel" 4, in view of the direction of flow of the fluid represented by the arrow on figure 2) closing the circumferential wall at a first end; and a lid ("Boden" 7, again in view of the direction of flow of the fluid represented by the arrow on figure 2) closing the circumferential wall at a second end opposite the bottom, wherein the wall, bottom and lid enclose an inner space comprising the extractable product KP,

wherein the bottom 4 comprises an entrance area and the system is arranged for bringing the fluid dispensing device into fluid connection with the entrance area for supplying the fluid to the extractable product for preparing the beverage,

wherein the lid 7 comprises an exit area and the system comprises an outlet which, in use, is in fluid communication with the exit area for draining the prepared beverage from the capsule and supplying the beverage to a container such as a cup.

The Board follows appellant I's argument put forward at the oral proceedings that in D25 a receptacle is not disclosed as such and that D25 discloses two distinct embodiments.

The first embodiment of D25 is represented in figure 2 and described in paragraphs 19 to 21.

The second embodiment of D25 is represented in figure 3 and described in paragraphs 22 to 27.

First embodiment

In the first embodiment of D25 shown in figure 2, the exit area comprises an exit filter ("Filterelement" 2) through which the beverage can drain from the capsule of the system. However, the system **does not comprise lid piercing means**, so this embodiment does not disclose the features (b) of claim 1:

(b) the receptacle comprises lid piercing means intended for piercing the exit area of a prior art capsule when the exit area sufficiently presses against the lid piercing means under the influence

of the pressure of the fluid and/or beverage in the capsule for creating at least one exit opening through which the beverage can drain from the prior art capsule.

In this respect, the Board follows appellant IV's view that the member ("Verteilelement", "Filterelement" 2) can be seen as representing the lid in accordance with claim 1 (see appellant IV's letter dated 9 July 2013, point 1.4.1, page 4). In fact, in D25 the flow of fluid is disclosed in one direction only, see arrow in figure 2.

The Board also notes that, contrary to appellant II's view, features (b) and more particularly the lid piercing means are essential features of claim 1 of auxiliary request 1 to be taken into consideration for assessing novelty and inventive step for its subject-matter. In fact, the claimed system is clearly provided with lid piercing means, since said lid piercing means have to be suitable for piercing a prior-art capsule under the influence of the pressure of the fluid and/or beverage in the capsule. By the same token, said same lid piercing means are to be adapted to the exit filter and vice versa, such that said lid piercing means do not, in use, pierce the capsule, i.e. including the exit filter 2 in D24, and the lid stays intact.

In the first embodiment of D25, the results stated in claim 1 are obtained, i.e. in use the capsule is not pierced and the lid stays intact.

Second embodiment

In the second embodiment of D25 shown in figure 3, the system comprises lid piercing means ("Aufstechorgan" 35) suitable for piercing the exit area of a prior-art capsule when the exit area sufficiently presses against the lid piercing means 35 under the influence of the pressure of the fluid and/or beverage in the capsule for creating at least one exit opening through which the beverage can drain from the prior-art capsule (see also arrow showing the direction of flow of the fluid defining the position of the exit area).

Furthermore, the exit area comprises an exit filter ("Filterelement" 2a) through which the beverage can drain from the capsule of the system, wherein the lid piercing means 35 and the exit filter 2a, respectively, are adapted to each other such that the capsule of the system, in use, **is pierced** by the lid piercing means 35 as the film ("Folie" 21a) is pierced, and the lid comprising said film 21a **does not stay intact**

In fact, the capsule comprises the foil 21a, which is part of the lid and is pierced in use by the lid piercing means ("Aufstechorgan" 35), contrary to claim 1. Hence this embodiment does not disclose features (a) of claim 1 that

(a) the lid piercing means and the exit filter are adapted to each other such that the capsule, in use, is not pierced by the lid piercing means and the lid stays intact.

Contrary to appellant IV's view, there is no support in D25 for the capsule of figure 2 being suitable for use

in the system of figure 3. Hence, the two embodiments cannot be combined for assessing the novelty of the claimed subject-matter. In addition, the disclosure at the end of paragraph 19 of D25 that the foil 21 is removed before use concerns only the embodiment of figure 2, i.e. not that of figure 3.

Furthermore, contrary to appellant III's view, there is also no support in D25 for the capsule of figure 2 being intended for use at several bars in a conventional coffee machine.

Consequently, the subject-matter of claim 1 of auxiliary request 1 is novel over document D25.

4.3.4 Vis-à-vis D37

The Board notes that document D37, which is briefly referred to by the opponents-appellants, is a parallel US patent application to D25 with a similar disclosure to that of D25. The above reasons also apply vis-à-vis D37.

4.3.5 Vis-à-vis D46

Document D46 (column 2, line 66, to column 3, line 67, figures) discloses a system for preparing a predetermined quantity of beverage suitable for consumption using an extractable product ("coffee granules" 26), comprising:

an exchangeable capsule ("reusable container" 10); and an apparatus ("coffee maker" 46) comprising a receptacle ("cover" 48 and "base" 50) for holding the exchangeable capsule 10, and a fluid dispensing device ("discharge opening" 56) for supplying an amount of a

fluid, such as water, under pressure to the exchangeable capsule 10,

wherein the exchangeable capsule 10 comprises a circumferential wall ("undercup" 14); a bottom ("strainer" 12) closing the circumferential wall at a first end; and a lid ("lower edge" 20) closing the circumferential wall at a second end opposite the bottom, wherein the wall, bottom and lid enclose an inner space ("chamber" 24) comprising the extractable product 26,

wherein the bottom 12 comprises an entrance area and the system is arranged for bringing the fluid dispensing device into fluid connection with the entrance area for supplying the fluid to the extractable product 26 for preparing the beverage,

wherein the lid 20 comprises an exit area and the system comprises an outlet which, in use, is in fluid communication with the exit area for draining the prepared beverage from the capsule 10 and supplying the beverage to a container 58,

wherein the receptacle 48, 50 comprises lid piercing means ("knives" 49) intended for piercing the exit area of a prior-art capsule (see column 2, lines 7-12, and column 4, lines 30-31), for creating at least one exit opening through which the beverage can drain from the prior-art capsule,

wherein the exit area of the capsule 10 of the disclosed system comprises an exit filter ("holes" 28 formed in lower edge 20 in the confines of "recess" 22), through which the beverage can drain from the capsule 10, wherein the lid piercing means 49 and the

exit filter 20, 22, 28 are adapted to each other such that the capsule 10 of the system, in use, is not pierced by the lid piercing means and the lid stays intact.

In view of the above, D46 does not, contrary to appellant III's view, disclose features (b) of claim 1 that:

(b) the receptacle comprises lid piercing means intended for piercing the exit area of a prior art capsule when the exit area sufficiently presses against the lid piercing means under the influence of the pressure of the fluid and/or beverage in the capsule for creating at least one exit opening through which the beverage can drain from the prior art capsule.

In fact, the knives 49 which are the lid piercing means of the system of D46 pierce a coffee can of the prior art by the closing movement of the apparatus, see column 2, lines 7 to 10.

As a result, the subject-matter of claim 1 of auxiliary request 1 is novel over document D46.

4.3.6 Vis-à-vis D48

Document D48 (paragraphs 30 to 53 and figures) discloses a system for preparing a predetermined quantity of beverage suitable for consumption using an extractable product ("Substanz"), comprising:

an exchangeable capsule ("Kapsel" 50); and
an apparatus comprising a receptacle ("Aufnahmeraum" 8; "Becher", "Entnahmeteil 9, 149; "Kammer" 148) for

holding the exchangeable capsule 50, and a fluid dispensing device ("Flüssigkeitsstrahlrösen" 18) for supplying an amount of a fluid, such as water, under pressure to the exchangeable capsule 50 (paragraph 1 and claim 1),

wherein the exchangeable capsule 50 comprises a circumferential wall ("Seitenwand" 1); a bottom ("obere Wand" 4) closing the circumferential wall at a first end; and a lid ("untere Wand" 2) closing the circumferential wall at a second end opposite the bottom, wherein the wall, bottom and lid enclose an inner space ("das Innere der Kapsel" 7) comprising the extractable product,

wherein the bottom 4 comprises an entrance area and the system is arranged for bringing the fluid dispensing device into fluid connection with the entrance area for supplying the fluid to the extractable product for preparing the beverage,

wherein the lid 2 comprises an exit area and the system comprises an outlet which, in use, is in fluid communication with the exit area for draining the prepared beverage from the capsule and supplying the beverage to a container,

wherein the receptacle comprises lid piercing means ("Vorsprung", "Spitzen" 13, 22) intended for piercing the exit area of a prior-art capsule when the exit area sufficiently presses against the lid piercing means 13, 22 under the influence of the pressure of the fluid and/or beverage in the capsule for creating at least one exit opening ("durchbohren" or "zerreißen") through which the beverage can drain from the prior-art capsule,

wherein the exit area of the capsule 50 of the system comprises an exit filter ("Filtermenbran" 43), through which the beverage can drain from the capsule of the system.

The Board concurs with the finding of the impugned decision, point 2.3.5.5, that the lid in the capsule of D48 can be represented by the wall ("Wand" 2) as it comprises the exit area, i.e. where the fluid flows out of the capsule, see figure 3.

In D48, figures 12a and 12b and paragraphs 49 to 54, it is disclosed with respect to the filter membrane 43 that it is not pierced by the lid piercing means 13, 22. However, the underlying wall ("Wand" 2) is explicitly pierced by said lid piercing means 13, 22, see paragraphs 36 to 42. This means that said wall 2 representing the lid in the sense of claim 1 of auxiliary request 1 is pierced in use. Hence, D48 does not disclose at least features (a) of claim 1 that:

(a) the lid piercing means and the exit filter are adapted to each other such that the capsule, in use, is not pierced by the lid piercing means and the lid stays intact.

As a result, the subject-matter of claim 1 of auxiliary request 1 is novel over document D48.

4.3.7 As a consequence of the above, none of the documents cited in the appeal proceedings discloses all the features of claim 1 of auxiliary request 1 in combination, and hence its subject-matter is novel (Article 54(1) EPC).

4.4 Inventive step - claim 1

4.4.1 Closest prior art

Many documents were regarded by the opponents-appellants as plausible closest prior art, e.g. D5, D11, D21, D24, D25, D46, E1 or E5.

In view of the numerous lack of inventive step objections based on many starting documents, the Board considers it appropriate in the present case to first determine which of said documents represents the closest prior art.

The purpose of the system of claim 1 of auxiliary request 1 is explicitly that **the capsule is not pierced and the lid stays intact**. Hence, only such systems of the prior art with the same purpose are regarded as plausible closest prior-art documents.

In E1, column 4, lines 43-44 and figures 1-3, the cover 10 which represents the lid in accordance with claim 1 is torn open, see also column 5, lines 30-34.

In E5, paragraph 24 and figure 2, both the bottom ("cover" 21) and the lid ("bottom" 22) are punched by punching members 13 and 15, respectively, so that the bottom 22 representing the lid in accordance with claim 1 is pierced.

In D5, column 6, lines 11-44, and figures 2 and 3, the lower face 16 which represents the lid in accordance with claim 1 is torn open, see also column 5, lines 30-34.

In D11, paragraphs 15 and 19 and figures 1 and 2, piercing devices 26, 46 pierce a capsule on both sides, in particular end wall 12 representing the lid in accordance with claim 1.

As already mentioned in points 4.3.1 and 4.3.3 above with respect to novelty, the system according to D24 and that according to the second embodiment of D25 disclose a lid which is pierced, i.e. does not stay intact.

Therefore, none of the systems of E1, E5, D5, D11, D24 and the second embodiment of D25 are considered to represent the closest prior art for claim 1 of auxiliary request 1.

As a result, either the system according to the first embodiment of D25 or the one according to D46 remains as plausible closest prior art.

As discussed in points 4.3.3 and 4.3.5 above, claim 1 of auxiliary request 1 differs from the first embodiment of D25, figure 2, and from the disclosure of D46 by the same distinguishing features (b). Taking that into account, the Board follows appellant I's view that **the first embodiment of D25, figure 2, is to be regarded as the closest prior art**, since the skilled person would realise that D46 does not relate to a system with an extractable product comprised in a capsule but rather to a system working with a coffee can (see appellant I's letter dated 26 November 2013, page 27, last paragraph, to page 28, last paragraph, and page 49, first paragraph). Furthermore, as also put forward by appellant I, both the contested patent and D25 aim at providing a uniform flow of the liquid on the inlet side of the capsule (see contested patent,

paragraph 6; D25, column 4, line 54, to column 5, line 15; column 6, lines 2-7; and claim 16).

- 4.4.2 Document D21 has also been argued to represent plausible closest prior art (see appellant III's letter dated 28 June 2013, point 4.4.5).

Document D21 is a French patent application published on 14 March 2008, i.e. between the priority date and the filing date of the contested patent. Hence, it belongs to prior art according to Article 54(2) EPC only if the claimed priority of the contested patent is not valid.

In D21, page 1, lines 11-17, reference is made to the device disclosed in E6 which does not comprise lid piercing means, see column 2, lines 1-26, and figure 2. In the capsule of D21, holes 51, 52 are provided in the lid ("couvercle" 2; "face aval"), see page 3, lines 1-3, and figure 4. Hence, D21, like the first embodiment of D25, does not disclose at least features (b) mentioned above and so **is no more relevant than the first embodiment of D25** as closest prior art (see point 4.3.2 above). As a result, the conclusion on inventive step drawn below starting from the first embodiment of D25 would equally apply starting from D21. For this reason, the Board considers that further discussion of D21 is not useful for the present decision, and hence there is no need to decide whether or not D21 belongs to the prior art according to Article 54(2) EPC, i.e. to decide whether the claimed priority of the contested patent is valid.

4.4.3 Distinguishing feature

As discussed in point 4.3.3 above, features (b) of claim 1 of auxiliary request 1 are not disclosed by the first embodiment of D25:

(b) the receptacle comprises lid piercing means intended for piercing the exit area of a prior art capsule when the exit area sufficiently presses against the lid piercing means under the influence of the pressure of the fluid and/or beverage in the capsule for creating at least one exit opening through which the beverage can drain from the prior art capsule.

4.4.4 Technical effect(s) and problem to be solved

The technical effect associated with the distinguishing features (b) is that the apparatus of the claimed system comprises lid piercing means, such that the system is suitable for also using capsules of the type to be opened by pressure.

The objective problem to be solved can then be seen as how to modify the capsule of the first embodiment of D25 to make it fit and usable in a beverage apparatus comprising lid piercing means, without being pierced by the latter in use.

4.4.5 Inventiveness

Starting from the first embodiment of D25, the opponents-appellants have raised objections of lack of inventive step in view of the combination of its teaching with that of **D11**, **D24** or **D39**.

As discussed in point 4.4.1 above, in **D11**, paragraphs 15 and 19 and figures 1 and 2, piercing devices 26, 46 pierce a capsule on both sides, including end wall 12 representing the lid in accordance with claim 1. As a consequence, there is no disclosure in D11 that the capsule is not pierced and the lid stays intact. Contrary to appellant III's view, there is no indication that the ridges of needles 30 of the perforation plate 26 of the apparatus of D11, see figures 1, 3 and 4, are adapted or intended to avoid perforation of filter element 2 of the capsule of D25. Such a disclosure is absent from D11, which explicitly intends the lid of the capsule to be pierced. Thus either the skilled person would not think of combining the teachings of D11 and the first embodiment of D25, as they are contradictory to each other in respect of the intention to pierce the lid, or when combining their teachings he would come up with piercing filter element 2 of D25 and thus would not arrive at the claimed subject-matter.

As discussed in point 4.3.1 above, **D24**, like the first embodiment of D25, does not disclose distinguishing features (b); so for that reason alone the combination of their teachings cannot lead to the claimed subject-matter. Furthermore, in the system of D24 the lid is pierced in use.

In **D39**, column 13, line 53, to column 14, line 30, and column 15, lines 36-57, and figures 3, 11 and 12, claim 1, the water is introduced into the capsule by bottom piercing means ("organe d'injection d'eau" 7). The lid ("opercule", "face inférieure" 4, 73) of the capsule, which represents the lid in accordance with claim 1 of auxiliary request 1, is pierced by lid piercing means ("éléments radiaux d'ouverture", "éléments en relief"

13, 74). There is no disclosure in D39 of any means that would prevent the lid from being pierced. Figure 11 referred to by appellant III is schematic and aims merely at showing how the perforation plate 67 is to be mounted. This embodiment also falls within the general teaching of D39 that the lid is pierced, see claim 1. As a consequence, the skilled person would not think of using the capsule of the first embodiment of D25 in the apparatus of D39 since they are contradictory to each other in respect of the intention to pierce the lid. Were he nonetheless to do so, he would arrive at the filter element 2 of the capsule of the first embodiment of D25 being inevitably pierced, contrary to claim 1 of auxiliary request 1.

- 4.4.6 Further documents, e.g. **D1**, **D10**, **D12**, **D18**, **D22A**, **D30**, **D33**, **D38** or **D48**, were also mentioned by the opponents-appellants when discussing inventive step in respect of the subject-matter of claim 1 of auxiliary request 1.

In **D1**, no lid piercing means are disclosed since the lid 4 is porous, see claim 1 and figures. Hence, D1 does not disclose features (b).

Regarding **D10**, figures 18-20, 24, 25 and 28, either the form of the capsule of the first embodiment of D25 is not compatible with the apparatuses of D10, such that the skilled person would not think of the combination of their teachings, or the apparatuses of D10 do not comprise any piercing means, such that features (b) would still be missing from the combination of the first embodiment of D25 with these apparatuses.

Documents **D12** and **D18** have a disclosure similar to that of D39 (see figures of D12 and D18; appellant I's letter dated 26 November 2013, page 54).

In **D22A**, page 10, line 21, to page 17, line 18, and figures 3 and 4, the system comprises relatively displaceable piercing means ("Aufstechmittel", "Hohldorn" 44, 54) to pierce both the lid (Kapselboden" 24) and the bottom ("Kapseldeckel" 22) of the capsule ("Kapsel" 20, 20'). The lid piercing means of D22A are hence not of the type specified in features (b), so combination with the first embodiment of D25 would not lead to the claimed subject-matter. Furthermore, D22A does not disclose how to adapt the lid piercing means 54 to the exit filter ("Sammeleinrichtung" 32) in order not to pierce the capsule 20, 20' and to keep the lid 24 intact; so combination with the first embodiment of D25 would lead to a pierced capsule.

D30, claims and figures, does not disclose any apparatus; so the combination of the capsule of the first embodiment of D25 with the disclosure of D30 cannot lead to the claimed subject-matter.

The same applies to **D33**, see claims and figures.

In **D38** the piercing member 15, 15a is designed such as to pierce the lid ("bottom" 4b), see figures.

Similarly, the capsule of the first embodiment of D25 would inevitably be pierced by the apparatus of **D48**, see figures 3 and 13 (see also point 4.3.6 above for discussion of its disclosure).

Hence, with respect to documents D1, D10, D12, D18, D22A, D30, D33, D38 and D48, either the disclosed apparatuses do not comprise piercing means and so do not disclose features (b), or when combining their teaching with the first embodiment of D25 the lid of

the capsule would be pierced and the lid would not stay intact, such that the skilled person would not arrive at the claimed subject-matter in an obvious manner.

4.4.7 Documents D2, D3 and D4 were also briefly mentioned in appeal proceedings without, however, any substantiation with respect to the combination of their respective disclosure with the first embodiment of D25.

4.4.8 In view of the above, none of the lack of inventive step objections raised by the opponents-appellants is convincing, and hence the subject-matter of claim 1 of auxiliary request 1 involves an inventive step (Article 56 EPC).

4.5 Independent claims 43 and 46

Since claims 43 and 46 of auxiliary request 1 comprise the features of claim 1 (see point VIII above), the reasoning and conclusions given above with respect to claim 1 apply *mutatis mutandis* to claims 43 and 46 of auxiliary request 1.

4.6 Adaption of the description

During the oral proceedings, appellant I filed a description adapted to the sets of claims according to auxiliary request 1, against which the Board had no objections.

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 with the order to maintain the patent in amended form on the basis of the following documents:

claims

1 to 46 as filed during the oral proceedings as auxiliary request 1

description

pages 2 to 9 as filed during the oral proceedings

figures

1 to 5b of the patent specification.

The Registrar:

The Chairman:



T. Buschek

I. Beckedorf

Decision electronically authenticated