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**Datasheet for the decision
of 13 December 2017**

Case Number: T 1732/13 - 3.2.04

Application Number: 06013230.5

Publication Number: 1700548

IPC: A47J31/40, B65D81/00

Language of the proceedings: EN

Title of invention:
Capsule with sealing means

Patent Proprietor:
Nestec S.A.

Opponent:
STRAWMAN LIMITED

Headword:

Relevant legal provisions:
EPC Art. 54, 76(1), 123(2)
RPBA Art. 13(3)

Keyword:

Novelty of claim 1 - main and first auxiliary requests (no)
Added subject-matter - second to tenth auxiliary requests
(yes)
Admission of eleventh auxiliary request (yes)

Decisions cited:

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

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

Case Number: T 1732/13 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 13 December 2017

Appellant: Nestec S.A.
(Patent Proprietor) Avenue Nestlé 55
1800 Vevey (CH)

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

Appellant: STRAWMAN LIMITED
(Opponent) 34 Lovedon Lane
Winchester,
Hampshire, SO23 7NU (GB)

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

Decision under appeal: **Interlocutory decision of the Opposition**
Division of the European Patent Office posted on
11 June 2013 concerning maintenance of the
European Patent No. 1700548 in amended form.

Composition of the Board:

Chairman A. de Vries
Members: E. Frank
W. Van der Eijk

Summary of Facts and Submissions

I. The appeals lie from the interlocutory decision of the opposition division posted on 11 June 2013 to maintain the European patent No. 1 700 548 in amended form pursuant to Article 101(3) (a) EPC. The appellant proprietor filed a notice of appeal on 6 August 2013, paying the appeal fee on the same day. The statement of grounds of appeal was submitted on 18 October 2013. The appellant opponent filed a notice of appeal on 12 August 2013, also paying the appeal fee on the same day. The statement of grounds of appeal was submitted on 21 October 2013.

II. The opposition was filed against the patent as a whole and based on Article 100(a) in conjunction with Articles 52(1), 54, and 56, Article 100(b), and Article 100 (c) in conjunction with Article 123(2) EPC.

After remittal of the case from the Board of Appeal 3.2.04 (T 0991/10 of 11 October 2011), the opposition division held that the patent as amended based on claim 1 of auxiliary request III as filed during the oral proceedings met the requirements of the EPC. In its decision the division considered the following prior art, amongst others:

A9 = FR 2 617 389

III. A communication pursuant to Article 15(1) RPBA was issued after a summons to attend oral proceedings, which were duly held on 13 December 2017.

IV. The appellant proprietor requested to set aside the decision under appeal and to maintain the patent according to a main request, filed as auxiliary request

I with letter of 31 August 2011, or alternatively according to one of auxiliary requests I-X, filed with letter of 24 February 2014, with the addition of auxiliary request XI, filed during the oral proceedings.

The appellant opponent requested to set the decision under appeal aside and to revoke the patent in its entirety.

V. The claim wording of the main and auxiliary requests I to XI is appended to this decision.

VI. The appellant proprietor argued as follows:

Main and first auxiliary request

Under para 0054 of the patent it is distinguished between a compressed "filled" sealing member, and a "hollow" step-like member. The latter provides the sealing engagement solely because of its shape, i.e. without compression. Since the sealing in A9 ("incrustation des filets 29") was achieved by compression, i.e. by a "filled" sealing member within the meaning of the patent, claim 1 of the main and auxiliary requests is novel over A9.

Amendments second to tenth auxiliary requests

As is derivable from page 15 of the application as filed, line 15 onwards, the resilient nature may be provided by the geometrical shape of the sealing member, e.g. by a step. Consequently, a hollow step must be implicitly resilient and, based on the general teaching of lines 22 and 23 on page 15, at least deformable. Thus, claim 1 of the second to tenth

auxiliary requests is originally disclosed, and Art.76 (1) and 123(2) EPC are complied with.

Admission of eleventh auxiliary request

With respect to claim 1 of the tenth auxiliary request, merely the wording "or deformable" has been omitted and, therefore, the objection of extended subject-matter has been clearly overcome. Moreover, claims 2 to 5 are clearly based on page 15 and page 11 of the application as filed. Thus, the eleventh auxiliary request should be admitted into the proceedings.

VII. The appellant opponent argued as follows:

Main and first auxiliary request

The vague term "hollow" refers to the geometrical shape of the step-like sealing member, but does not imply any material properties. Since a step shaped sealing member is also derivable from A9 (see figures), and is moreover deformable ("incrustation des filets 29"), A9 deprives claim 1 of the main and auxiliary requests of novelty.

Amendments second to tenth auxiliary requests

On page 15 of the application as filed, lines 28 to 32, deflection does not imply resilient material property. Moreover, the very specific step shaped embodiment of figs. 10 to 12 is only directly and unambiguously disclosed in the context of an inwards and downwards deformation of the step. Therefore, claim 1 of the second to tenth auxiliary requests has been extended beyond the content of the application as filed, contrary to Art. 76(1) and 123(2) EPC.

Admission of eleventh auxiliary request

Although the deletion of the wording "or deformable" is a minor amendment, it was foreseeable and thus should have been presented much earlier. Moreover, it appears that claim 1 in combination with claims 2 to 5 is not clearly allowable as to the original disclosure of the parent application as filed. Thus, the eleventh auxiliary request should not be admitted at that late stage of the proceedings.

Reasons for the Decision

1. The appeals are admissible.
2. Novelty - main and first auxiliary requests
 - 2.1 "hollow" sealing member
 - 2.1.1 The beverage production system of claim 1 of the main and first auxiliary requests comprises a beverage production device having an enclosing member and a capsule. The enclosing member is adapted to be in sealing engagement with a sealing member of the capsule, thereby achieving a sealing effect between the enclosing member and the capsule holder for water entering the interstice between the exterior of the capsule and the enclosing member from a water injector of the beverage production device.

As to the sealing member of the capsule, claim 1 moreover stipulates:

"the sealing member of the capsule being a hollow sealing member on the outer surface of the capsule",

and

"the hollow sealing member having the shape of a step, i.e. a sudden increase of the diameter of the side wall of the capsule".

2.1.2 The appellant proprietor argues that based on paragraph 0054 of the patent specification, when a "filled" sealing member is used, a compression and/or displacement of the material occurs. By contrast, for the embodiment of figures 10 to 12 of the patent, when a "hollow" step-like sealing member is used, the sealing engagement is solely provided between a sealing member having such a shape and the enclosing member, that is, no compression of the sealing material is needed or takes place.

2.1.3 However, the Board concurs with the appellant opponent that the vague term "hollow" in claim 1 does not imply any further structural properties such as a hollow or filled part in the capsule's wall in its usual meaning, but rather refers to its geometrical shape, in the present case to a step-like shape. Neither the wording of claim 1 nor the specification of the patent, cf. paragraph 0054 and figures 10 to 12, can actually lead to an interpretation of "hollow" other than to a step shaped arrangement.

Therefore, the Board holds that whether or not the sealing member is "hollow" according to claim 1 has no further effect on the material properties of the sealing member, such as being in a compressed state

during use. Indeed, the Board sees itself confirmed in this understanding by the fact that it is only in dependent claim 2 of the main request (and as granted) that the deformability of the sealing member is first specified as a further refinement.

- 2.1.4 In summary, in the absence of any clear definition of the broad term "hollow" this cannot be interpreted as anything other than being a step shape.
- 2.2 Document A9 (see figures 1 and 3) describes a beverage production system, which comprises a beverage production device and a capsule. Contrary to the appellant proprietor's view, the step-like sealing member in the form of collar 6 (see fig.1: "collerette annulaire 6") of A9 by the mere fact of having a step shape forms a hollow sealing member having the shape of a step according to claim 1 of the main request, see interpretation of "hollow" above. The sealing action of this member follows from the fact that in A9 indentations on flange or abutment seat 28 (figure 3; page 7, lines 5 to 10) under axial pressure press into face 6a of collar 6 to form therein annular rings 29 (page 8, lines 1-7: "la pression axiale permettant l'incrustation des filets 29"). A9 thus not only discloses a hollow sealing member having a step shape of the capsule as in claim 1 of the main request, but also that it is deformable as in claim 1 of the first auxiliary request. As regards the argument that in A9 sealing is not at the locus of the hollow step-like member, but only at its flange, the Board finds that the claim itself does not identify which part of the hollow step like member seals.

Since it is common ground that all other features of the system of claim 1 of the main request and auxiliary

request 1 are known from A9, A9 deprives claim 1 of the main and auxiliary request 1 of novelty.

2.3 Hence, the main and auxiliary requests 1 do not comply with the requirements of Article 54 EPC.

3. Amendments - second to tenth auxiliary requests

3.1 The hollow step shaped sealing member has been further specified by features added to claim 1 of the second to tenth auxiliary requests. The appellant proprietor argues that these claim amendments are based on the disclosure on page 15, line 15 to page 16, line 2 of the original description of the divisional and parent application as filed (the respective description pages are identical)

3.2 According to established case law (see case law of the boards of appeal, 8th Edition, 2016, II.E.1.7) it will normally not be allowable to base an amended claim on the extraction of isolated features from a set of features originally disclosed only in combination, e.g. in a specific embodiment in the description.

Such a generalisation is justified only in the absence of any clearly recognisable functional or structural relationship among the features of the specific combination or if the extracted feature is not inextricably linked with those features.

3.3 Hence, in the present case the Board has to decide whether or not the skilled person would recognize any relationship between features of the hollow sealing member and its geometrical shape, in particular once a step-like shape according to the figure 10 to 12 embodiment on page 15 as filed is used.

3.3.1 In lines 28 to 31 on page 15 it is stated that, "when the resiliency of the sealing member is procured by the geometrical shape, usually a deflection of the sealing member occurs". Moreover, the Board concurs with the appellant opponent that the subsequent text in parentheses in lines 31 and 32 on page 15, viz. "here: inwards and downwards deformation of the step", cannot be understood other than referring to the step-like example of the sealing member as depicted in figures 10 to 12.

In other words, in order for the hollow sealing member to deflect, i.e. "to bend or turn to one side" (Oxford), it is clear that this is closely linked to its resiliency,. Secondly, when such a resilient step shaped sealing member is deflected, in this particular example the deflection occurs by inward and outward deformation of the step, i.e. the precise nature of the deflection (inward and outward) is closely linked to the step shape.

3.3.2 Although the patent elsewhere states that the geometrical form is not limited to the step shown (in figures 10 to 12) and other forms are viable as long as they procure a resilient or at least deformable nature of the sealing member, cf. lines 20 to 23 on page 15, the Board concludes that (contrary to the appellant proprietor's view) the skilled person would directly and unambiguously derive the following functional and structural relationship from the context of the application as filed:

in case the step-like form is deflected, it has to be resilient and the deflection is an inwards and outwards deformation of the step.

3.4 Moreover, turning to the respective amendments of claim 1 of the second to tenth auxiliary requests the Board notes the following:

Either claim 1 of these requests do not include both interlinked aspects (resiliency; inwards and outwards deflection) identified above as in auxiliary requests 2 to 4, 7 to 8 and thus constitute an unallowable intermediate generalization extending beyond the content of the divisional and parent application as filed.

Or, as in the case of auxiliary requests 5, 6, 9, 10, they also include a further option in which the step like sealing member may be only deformable rather than resilient. The two terms are not synonymous, resilient implying the ability to rebound or return to its original shape after deformation (Oxford) and thus being narrower than the former. However, there is no direct and unambiguous disclosure in the originally filed divisional or parent application of such a specific combination of a step shaped hollow sealing member with inward and outward deflection that is only deformable, so that its addition adds subject-matter extending beyond the content of the original parent or divisional disclosure.

For the sake of completeness, the Board adds that these amendments of claim 1 are neither based on claims as granted (cf. Article 100(c) EPC), nor on claim 1 of the then auxiliary request I in T 0991/10 of 11 October 2011.

3.5 Following from the above, the second to tenth auxiliary requests do not comply with the requirements of Articles 76(1) and 123(2) EPC.

4. Admissibility - eleventh auxiliary request

4.1 The eleventh auxiliary request was filed during the oral proceedings and its admission is thus subject to the discretion of the Board under Article 13(3) RPBA.

As to the subject-matter of the newly filed request, the Board notes that claim 1 corresponds to claim 1 of the tenth auxiliary request, wherein only the wording "or deformable" has been deleted. In so doing, the objection of extended subject-matter has been clearly overcome, as the non disclosed combination mentioned above is omitted and the deflected step-like sealing member is now only resilient and deflects inwardly and outwardly. Moreover, the dependent claims of the new request exactly correspond to those of the tenth auxiliary request. Contrary to the appellant opponent's view, claim 2 is evidently based on page 15, line 31, and claims 3 to 5 on page 11, lines 29 to 33, of the original application. Otherwise it is common ground that the eleventh auxiliary request is allowable.

Thus, the nature of the amendments and how they relate to the original disclosure is immediately apparent to the appellant opponent and to the Board, and the new set of claims can be considered clearly allowable with little or no investigative effort.

4.2 Consequently, since the Board or the other party can reasonably be expected to deal with these issues without adjournment of the oral proceedings, the Board

exercised its discretion to admit the eleventh auxiliary request into the proceedings.

5. Patentability - eleventh auxiliary request

Apart from the questions raised in respect of their admissibility, the allowability of claims 1 to 8 of the eleventh auxiliary request has not been objected to by the opponent appellant, and no arguments have been presented in this regard. Nor does the Board have any compelling reasons to take a different view on the allowability of claims 1 to 8. As to the adaptation of the description, the Board finally notes that the description pages filed during the oral proceedings of the opposition division comply with the newly filed subject-matter of claims 1 to 8 of the eleventh auxiliary request as well.

6. In conclusion the Board finds that the patent can be maintained in amended form according to the eleventh auxiliary request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance with the order to maintain the patent as follows:
 - claims : 1-8 of auxiliary request XI, filed on 13 December 2017 during the oral proceedings
 - description : pages 2-6 as filed on 24 April 2013 during oral proceedings of the opposition division
 - figures : 1-14 as published in the patent specification.

The Registrar:

The Chairman:



G. Magouliotis

A. de Vries

Decision electronically authenticated