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**Datasheet for the decision  
of 5 February 2019**

**Case Number:** T 1223/15 - 3.2.04

**Application Number:** 06716590.2

**Publication Number:** 1848310

**IPC:** A47J31/00, A47J31/06,  
A47J31/40, A47J31/44

**Language of the proceedings:** EN

**Title of invention:**

METHOD AND APPARATUS FOR PREPARING A BEVERAGE SUITABLE FOR  
CONSUMPTION

**Patent Proprietor:**

Koninklijke Douwe Egberts B.V.

**Opponent:**

Kraft Foods Group, Inc.

**Headword:**

**Relevant legal provisions:**

EPC Art. 100 (b), 111 (1)

**Keyword:**

Grounds for opposition - insufficiency of disclosure (no)  
Appeal decision - remittal to the department of first instance  
(yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**

**Boards of Appeal**

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Case Number: T 1223/15 - 3.2.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.04**  
**of 5 February 2019**

**Appellant:** Koninklijke Douwe Egberts B.V.  
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**Representative:** V.O.  
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**Respondent:** Kraft Foods Group, Inc.  
(Opponent) Three Lakes Drives  
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**Representative:** Boulton Wade Tennant LLP  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 7 April 2015  
revoking European patent No. 1848310 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** W. Van der Eijk  
**Members:** G. Martin Gonzales  
S. Oechsner de Coninck

## **Summary of Facts and Submissions**

I. The Appellant-Proprietor lodged an appeal, received on 15 June 2015, against the decision of the Opposition Division of the European Patent Office posted on 7 April 2015 revoking European patent No. 1848310 pursuant to Article 101(3)(b) EPC, and simultaneously paid the appeal fee. The statement setting out the grounds of appeal was received on 17 August 2015.

II. Opposition was filed under Article 100(a) EPC based on lack of novelty and inventive step, under Article 100(b) on insufficiency of disclosure and Article 100(c) on unallowable extension of subject-matter.

The Opposition Division found that the invention was not sufficiently disclosed in the sense of Article 100(b) EPC for claim 1 of the main request (patent as granted) and auxiliary requests 1 to 4.

III. The Opponent withdrew the opposition with letter of 28 April 2016 without replying to the appeal.

IV. Oral proceedings were scheduled for 1 February 2019.

The Board informed the Appellant-Proprietor with communication of 4 December 2018 of its intention to set aside the impugned decision and to remit the case for further prosecution.

With letter of 24 December 2018, the Appellant-Proprietor confirmed their intention not to attend the oral proceedings and maintained their request for remittal.

On 14 January 2019 the Board cancelled the oral proceedings, and the proceedings were continued in writing.

- V. The Appellant-Proprietor requests that the decision be set aside and the opposition rejected. Alternatively that the patent be maintained according to auxiliary requests I-IX filed with the statement of grounds of 17 August 2015. They also request to remit the case to the first instance, if the grounds of novelty or inventive step need to be discussed.
- VI. The wording of claim 1 of the patent as granted (main request) reads as follows:

"A method for preparing a beverage suitable for consumption from at least two ingredients (6,10) and an amount of liquid (18) such as water which is supplied to the ingredients, wherein a first ingredient (10) comprises a substance to be extracted or to be dissolved with a liquid and a second ingredient (6) comprises a substance to be extracted or to be dissolved with a liquid, characterized in that the method comprises the steps of:

supplying, during at least a first period, to the first and second ingredients (6,10) the liquid (18) having, at most, a first temperature for obtaining a first beverage part,

supplying, during at least a second period, to the first and second ingredient, the liquid (18) having, at least, a second temperature for obtaining a second beverage part; combining the first and the second beverage parts for obtaining the beverage; and selecting the first and second ingredients (6,10) and the first and second temperatures in a manner such that

during the first period, the first ingredient dissolves or is extracted to a greater or smaller extent than during the second period and/or that during the first period the second ingredient dissolves or is extracted to a greater or smaller extent than during the second period so that the first and second beverage part differ from each other."

VII. The Appellant-Proprietor argued as follows:

Although the independent method claim contains a number of possible permutations in respect of the sequence of claimed time periods, temperatures and degree of extraction or dissolution of the ingredients, the skilled person would have no technical difficulty, nor would it represent an undue burden for him, to carry out all possible claimed permutations of the invention by combining the relevant features of the three embodiments of the description and figures. The claimed method is thus sufficiently disclosed. Remittal of the case for the discussion of the grounds under Article 100(a) EPC, novelty and inventive step is appropriate, as they were not properly discussed at first instance.

### **Reasons for the Decision**

1. The appeal is admissible.
2. The invention relates to a method for preparing a beverage from two ingredients by supplying liquid such as water to the ingredients. Each ingredient comprises a substance to be extracted or dissolved (e.g. coffee and milk). Both ingredients can be held in the same machine holder through which water is circulated, see specification paragraphs [0001]-[0002]. The object of

the invention is to provide a method wherein it is possible to obtain a ready beverage, with, for instance, frothed milk floating on a coffee extract, so that a real cappuccino is obtained. More in general, the object of the invention is to provide a method wherein the first and the second ingredient dissolve or are extracted at least partly independently, see patent specification paragraph [0004]. To that end water having different temperatures is circulated during a first period and during a second period. The ingredients and temperatures are so selected that the ingredients are extracted or dissolved to a different extent in each period, see specification paragraph [0005]. First and second different beverage parts with different properties are obtained that are subsequently combined.

The invention also relates to an apparatus for preparing a beverage from two ingredients, see paragraph [0002] and independent claim 32.

3. Sufficiency of disclosure - main request (patent as granted)

The independent method claim 1 contains a number of possible permutations in respect of the sequence of time periods, different temperatures and different degrees of extraction or dissolution of the ingredients.

3.1 The opposition division held, see impugned decision sections 26-30, that the skilled person cannot carry out one of those permutations (combination of features) or, at least, that the skilled person would not be able to carry out that particular permutation over its entire claimed scope. The disputed combination of

features is one requiring an ingredient to dissolve to a greater extent during the period of lower temperature than during the period of higher temperature, as follows:

- the first period is earlier than the second period,
- the second ingredient comprises a substance to be dissolved,
- the first temperature is lower than the second temperature, and
- during the first period the second ingredient dissolves to a greater extent than during the second period.

Accordingly, the second ingredient would be required to dissolve to a greater extent in the first period of lower temperature. The Opposition Division noted that according to the general laws of physics this would not be possible, as solids dissolve better in hotter temperatures than they do in colder temperatures. The Division further argued that, even if a convenient selection of different time periods duration may possibly yield the desired result (first time period longer than the second), the duration of the time periods is not specified in the claim. Consequently, according to the Opposition Division, the skilled person would not be able to carry out the particular combination of features over its entire claimed scope, as it would include any periods durations e.g. first and second periods of equal duration, for which the above conclusion that an ingredient cannot dissolve to a greater extent in the period of lower temperature holds.



- 3.2 Following established case law, an invention is *in principle* sufficiently disclosed if at least one way is clearly indicated, enabling the person skilled in the art to carry out the invention, see Case Law of the Boards of Appeal, 8th. edition 2016 (CLBA), II.C.4.2. But this is sufficient only if it allows the invention to be performed in the whole range claimed, see CLBA II.C.4.4.
- 3.3 As put forward by the Appellant-Proprietor, the patent specification discloses in paragraphs [0027] and [0028] an embodiment that satisfies the above combination of features (or permutation of features), including dissolving a second ingredient (milk powder/creamer) to a greater extent during a first period of lower temperature, by varying the length of the first and second periods relative to each other. In the disclosed example, the first time period duration is long so that the second ingredient (milk powder/creamer) dissolves to a greater extent than during the second shorter time period despite the higher water temperature of the second period. In the Board's understanding, this embodiment clearly and sufficiently discloses the required at least one way to carry out the invention according to the disputed combination of features (or permutation) by appropriate selection of time lengths.
- 3.4 For assessing the second condition, that the above disclosure allows the invention to be performed in the whole range claimed, it must first be ascertained what the scope of the claimed range is. The latter involves in the present case an issue of claim interpretation. In particular, that pursuant to established case law, the skilled person, when considering a claim, should rule out interpretations which do not make technical sense, and should try to arrive at an interpretation of

the claim that takes into account the whole disclosure of the patent, see CLBA, II.A.6.1. Turning to the interpretation of the claim in front of the Board, the Division read the claimed feature "selecting the first and second ingredients (6,10) and the first and second temperatures *in a manner such that*" as requiring that the different degree of extraction or dissolution must be fulfilled for any first and second period durations - i.e over the entire scope of time duration. However, in the Board's view, the relevant skilled person, for the present case an engineer involved in the design and development of beverage makers or coffee machines, would immediately realize, that requiring the different degrees of dissolution to be achieved for any first and second periods durations is not technically feasible due to the general laws of physics. Thus the skilled person would immediately understand that the claim scope does not extend to those variants that, due to the general laws of physics, are not obtainable in practice. Such variants cannot therefore justify an objection of insufficiency of disclosure.

The Board also considers that the skilled person, without undue burden and using a reasonable amount of trial and error, is able to establish the different duration ranges that can achieve for each ingredient the required relative dissolution/extraction degree of the disputed permutation or combination of features and thus to obtain substantially all embodiments falling within the ambit of its claimed scope. The Board is therefore satisfied that the disclosure of the above embodiment is sufficient to allow the skilled person to perform the invention in the whole range claimed.

3.5 Otherwise, the Board is also satisfied that the skilled person would have no technical difficulty, nor does it represent an undue burden for him, to also carry out the other - not discussed - possible claimed features' combinations, permutations or variants by straightforwardly combining the relevant features of the above embodiment and of the other two further embodiments, each sufficiently disclosed in the description and figures.

3.6 The Board therefore concludes that the claimed method is disclosed in a manner sufficiently clear and complete in the sense of Article 100(b) EPC.

#### 4. Remittal

In view of the withdrawal of the opposition and of the above finding of the Board, a decision under Rule 84(2) EPC, whether the Office continues the opposition proceedings of its own motion, should be taken, see CLBA IV.C.4.3.3. The question arises whether this decision should be taken by the Board.

In the present case, objections under Article 100(a) based on lack of novelty and inventive step were raised with the notice of opposition but were not discussed in first instance and only considered in a non-reasoned manner in an obiter dictum of the written decision. Therefore the Board is of the view that the most appropriate course of action under the circumstances of the present case is to exercise its discretion under Article 111(1) EPC and remit the case for further prosecution, including first and foremost whether the Office wishes to continue the proceedings of its own motion according to Rule 84(2) EPC.

The Appellant-Proprietor has also requested to remit the case, as it wishes - in case the opposition proceedings are continued - to preserve for the other objections the possibility of a consideration by two instances. The Board has decided to follow this request of the Appellant-Proprietor.

## **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 for further prosecution.**

The Registrar:

The Chairman:



G. Magouliotis

W. Van der Eijk

Decision electronically authenticated