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**Datasheet for the decision  
of 13 May 2019**

**Case Number:** T 2313/15 - 3.2.04

**Application Number:** 07847879.9

**Publication Number:** 2091393

**IPC:** A47J31/40

**Language of the proceedings:** EN

**Title of invention:**

DEVICE AND METHOD FOR PRODUCING A FROTHED LIQUID FROM SOLUBLE  
INGREDIENTS AND DILUENT

**Patent Proprietor:**

Société des Produits Nestlé S.A.

**Opponent:**

Jordá Petersen, Santiago

**Headword:**

**Relevant legal provisions:**

EPC Art. 54(2), 108, 104(1), 111(1)  
EPC R. 99(2)

**Keyword:**

Admissibility of appeal - appeal sufficiently substantiated  
(yes)

Novelty - (yes)

Remittal to the department of first instance - (yes)

Apportionment of costs - (no)

**Decisions cited:**

T 0396/98, T 0240/04, T 0764/07

**Catchword:**

Reasons 4



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Case Number: T 2313/15 - 3.2.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.04**  
**of 13 May 2019**

**Appellant:** Société des Produits Nestlé S.A.  
(Patent Proprietor) Entre-deux-Villes  
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**Representative:** Ducreux, Marie  
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**Respondent:** Jordá Petersen, Santiago  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 26 October 2015  
revoking European patent No. 2091393 pursuant to  
Article 101(2) EPC.**

**Composition of the Board:**

**Chairman** A. de Vries  
**Members:** G. Martin Gonzalez  
T. Bokor

## Summary of Facts and Submissions

- I. The Appellant-Proprietor lodged an appeal, received on 10 December 2015, against the decision of the Opposition Division of the European Patent Office posted on 26 October 2015 revoking European patent No. 2091393 pursuant to Article 101(2) EPC, and simultaneously paid the appeal fee. The statement setting out the grounds of appeal was received on 16 February 2016.
- II. Opposition was filed under Article 100(a) EPC based on lack of novelty and on lack of inventive step, under Article 100(b) EPC based on insufficiency of disclosure and under Article 100(c) EPC based on added subject-matter.

The Opposition Division found that the subject-matter of independent claim 15 as granted was not novel having regard *inter alia* to the following evidence:

- (D1) WO 02/100224 A2
- (D2) US 3,212,757
- (D3) NL 1029155
- (D3b) WO 2006/043808 A3

- III. The Appellant-Proprietor requests that the decision under appeal be set aside, and that the patent be maintained as granted (main request), or that the patent be maintained in an amended form on the basis of the first to third auxiliary requests, both filed with the grounds of appeal dated 16 February 2016. The Appellant further requests that the case be remitted to the Opposition Division for further prosecution, for the examination of the remaining opposition grounds

beyond novelty of claim 15, and all patentability requirements of all claims other than claim 15.

The Respondent-Opponent requests that the appeal be found inadmissible or that it be dismissed. They further request apportionment of costs, should the case be remitted to the Opposition Division.

IV. Oral proceedings were held on 13 May 2019.

V. The independent claim 15 according to the main request - patent as granted - reads as follows:

"Method for producing a frothed liquid in a beverage production apparatus comprising :

- providing a chamber(13) with a transverse bottom wall (14) and a longitudinal upward wall (15),
- dosing the chamber (13) with soluble ingredient,
- feeding a diluent through a diluent inlet (18) to create a jet of diluent in the chamber (13) and mix the diluent with said soluble ingredient to dissolve it into a liquid,
- controlling the liquid flow delivered out of the chamber in such a manner that the liquid can rise up a certain level along the side of the upward wall when diluent is fed in the chamber and for the liquid to form a sheared surface of liquid which is energetically impacted, as a result of the direction and dimension of the diluent inlet in the chamber, by the jet of diluent,
- stopping the diluent intake inside the chamber and draining the frothed liquid from the chamber at least one outlet."

VI. The Appellant-Proprietor argued as follows:

The appeal is admissible. Granted claim 15 is new over documents D1, D2 and D3/D3b. Remittal for the examination of the remaining opposition grounds beyond novelty of claim 15 that were not considered in the impugned decision is appropriate in the present case. A different apportionment of costs is not justified.

VII. The Respondent-Opponent argued as follows:

The statement of grounds of appeal is not complete and the appeal is thus inadmissible. Granted claim 15 lacks novelty over documents D1, D2, D3/D3b. Remittal is not appropriate for reasons of procedural economy. The behaviour of the Appellant-Proprietor at first instance and upon appeal justifies a different apportionment of costs for reasons of equity.

### **Reasons for the Decision**

1. Admissibility of the appeal
  - 1.1 The Respondent-Opponent objects that the statement of grounds only addresses novelty of claim 15 and is therefore not a complete case in the sense of Article 12(2) RPBA. On this ground the appeal is, according to the Respondent, inadmissible.
  - 1.2 Concerning the disputed aspect of the admissibility, the extent of the required reasoning and sufficient substantiation, this is governed by Article 108 and Rule 99(2) EPC. The examination of the question whether the requirements of Article 108 EPC, third sentence in combination with Rule 99(2) EPC are met is made on the basis of the contents of both the statement of grounds of appeal and of the decision under appeal, T 162/97, see Case Law of the Boards of Appeal, 2016, 8th.

edition (CLBA), IV.E.2.6.3. In a case such as the present one, where the appeal lies against a decision based on a sole ground (lack of novelty) a statement of grounds is sufficiently substantiated in the sense of Rule 99(2) EPC if it addresses that sole ground in a manner for the Board and the other party to understand why the Appellant considers the decision to be incorrect. That the present statement of grounds addresses the sole ground for revocation, and in sufficient detail, is undoubtedly the case. Nor has it been argued that this would not be so.

1.3 The Respondent-Opponent has rather argued that the Appellant in their statement of grounds should have dealt with all grounds raised in opposition. This view however has neither a basis in the Convention nor is it supported by jurisprudence. Neither of the two decisions cited by the Respondent is indeed concerned with the question of admissibility of an appeal. T 396/98 deals with the issue of the extent to which an opposition division's decision is binding on the corresponding appeal board, see Reasons, point 2 - i.e. whether the board can also review findings of the opposition division that were in favour of the appellant party-, which is not related to the question of admissibility of the appeal. T 240/04, on the other hand concerns the question of admittance of an auxiliary request, see Reasons points 16.1-16.3.

1.4 As otherwise all formal requirements of Article 108 and Rule 99 EPC are met, the Board concludes that the appeal is admissible.

2. Background

The invention is concerned with the production of frothed liquid from the combination of a diluent and a soluble ingredient. The invention is generally aimed at providing a simple and low cost method and device, without involving the use of motor-driven whipping means or a pressurized chamber, see specification paragraph [0009]. With this aim, a soluble ingredient (powder or liquid concentrate) is dosed into a mixing chamber. The force of a continuous jet of diluent injected into the mixing chamber is used to form a swirling layer of liquid along an internal wall of the chamber, the jet being further so sized and oriented that the formed layer of liquid is also impacted on its surface by the incoming jet. As a result the powder or concentrate is dissolved and froth is produced. The liquid flow exiting the chamber through the bottom outlet is controlled to prevent the liquid from leaving the chamber too quickly, since insufficient liquid quantity inside the chamber would not allow the development of the appropriate swirling layer of liquid, see paragraphs [0010]-[0013] and [0051] of the specification.

3. Novelty of granted claim 15.

The Appellant-Proprietor contests the findings of the Opposition Division that the subject-matter of granted claim 15 is not new over D2. The Respondent-Opponent contends that not only was the division right to find lack of novelty over D2 but that the claimed subject-matter also lacks novelty over D1 and D3/D3b, as already argued in opposition.

3.1 Document D2



- 3.1.1 It is undisputed that document D2 discloses a mixing chamber 12 fed through an inlet 23 with powder or liquid concentrate; and that a jet 28a of diluent is injected through port 28 to create an upward swirl of mixed fluid along arcuate wall 11 toward the end 11a, see column 3, lines 19-25. When the layer of liquid leaves the end of surface 11a, it forms a freely falling sheet or curtain.
- 3.1.2 D2 states that the force of the jet 28a causes some of the liquid to make several circuits, see column 3, lines 61-64. In the Board's understanding this implies that the jet impacts the liquid swirling along the arcuate wall 11 with sufficient energy to maintain it in swirling motion. As the chamber is oriented vertically and the liquid is also made to swirl in a vertical plane, it necessarily rises up to form a "sheared" surface of liquid which is energetically impacted by the jet of diluent, as also held by the impugned decision, see reasons point 2.1. Here, "sheared" surface is understood as denoting a liquid surface or surface layer that is subjected to shear forces, cf. paragraphs [0010] and [0016] of the patent specification. Due to the impact of the injected liquid and its angle, which is such as to maintain the swirling action, high shear forces are necessarily at work also in D2 in the liquid as it rises.
- 3.1.3 The Opposition Division further held that the arcuate wall 11 embodies both the transverse bottom wall and the longitudinal upward wall in the sense of granted claim 15, see point 2.3 of the impugned decision. According to the Division, the lower section of wall 11 anticipates the claimed transverse bottom wall while the lateral upward section of arcuate wall 11 embodies the claimed longitudinal upward wall.

- 3.1.4 However claim 15 also requires the upward wall to be longitudinal. In the Board's understanding, "longitudinal" calls for a wall that is placed lengthwise or is otherwise related to the length of the object, the length of an object being its longest dimension. Thus the Board holds that granted claim 15 requires an upward wall that is placed along or related to the longest dimension of the chamber. However, document D2 discloses a disc shaped chamber 12, where a longest dimension cannot clearly and unambiguously be identified by the skilled person. Therefore, in the Board's understanding, the skilled person would not derive from D2 as a matter of direct and unambiguous disclosure that the chamber has a longitudinal upward wall.
- 3.1.5 The Respondent-Opponent contends that longitudinal is very broad and open to many other different interpretations such as a direction from the inlet to the outlet, or a vertical direction or any axis of symmetry of the body, which not necessarily implies that it is the longest dimension. However, the person skilled in the art who approaches a claim with a mind willing to understand, when reading a technical claim does so contextually and interprets terminology according to its usual technical meaning. In the present case, the disputed term "longitudinal" has a well defined meaning requiring a relationship to the length or longest dimension of an object. This is also supported by the context of the patent specification, cf. paragraph [0022] where it is explained that a longer upward dimension is needed in order to ensure that liquid does not overflow when swirling. The lateral upward section of wall 11 of of the flat

cylindrical chamber of D2 is not longitudinal in the normal sense of that term.

3.1.6 The Board thus concludes that the subject-matter of claim 15 is new over D2.

3.2 Documents D1 and D3/D3b

3.2.1 It is undisputed that document D1 discloses a chamber 28 with an upward longitudinal wall 30 in the sense of the contested patent, see figure 2a, 2b and page 9, lines 7-26. The known chamber 28 is, however, open at its bottom end 46 and therefore fails to disclose, in the Board's opinion, a **transverse** bottom wall as required by granted claim 15. The Board is not convinced by the contention of the Respondent-Opponent that the lower part of the inwardly inclined conical wall 30, underneath the nozzle 34 has a transverse component while above the nozzle the conical wall 30 has a longitudinal component. Again, for the skilled person who reads the claim constructively with the intent of making technical sense of it, rather than for the sake of engaging in philological argument, the qualification "transverse" for the bottom wall is understood as further differentiating it from a "longitudinal" upward wall. The two terms - longitudinal and transverse - act in opposition to define clearly distinct wall sections forming the chamber, with transverse read as "lying across" (OED) to the longitudinal direction. In the conical wall of D1, figure 2b, the skilled person sees only a single wall section oriented in the same direction. The Board concludes that D1 does not disclose a transverse bottom wall (as distinct from a longitudinal upward wall).

3.2.2 It is not under dispute that document D3/D3b discloses a mixing chamber 10 as depicted in figures 1a-1c, with a longitudinal upward wall and a transverse bottom wall, also having an inlet 16 for allowing an incoming jet of diluent for mixing with the supplied coffee concentrate, see D3b, page 12, lines 15-25. As depicted in figures 1a-1c, and also described on page 16 of D3b, lines 12-16 whirls are formed in the mixing chamber 10.

However, the contested claim additionally calls for controlling the liquid flow out of the chamber in such a manner that the liquid can rise up along the side of the upward wall. Accordingly, the rising of the liquid is a consequence of controlling the chamber liquid outflow. The claimed control may also be a passive control as described in the contested patent specification paragraph [0016] - i.e. only requiring a proper dimensioning of the outlet cross section. However, such dimensioning (control) must be so determined in respect of the filling flow that the evacuation flow rate is sufficiently low to allow for proper liquid accumulation and rising up along the upward wall.

In this respect, document D3/D3b does not disclose whether or how the outlet or liquid delivery out of the mixing chamber 10 is controlled. Nor does D3/D3b describe whether the liquid level inside the chamber rises or not during the mixing process, nor is this otherwise inferable from D3/D3b. As to the swirl depicted in figures 1a-1b, referred to by the Respondent-Opponent, the Board notes that it is drawn loosely to suggest mixing action within chamber 10, rather than that it is meant to be representative of the precise conditions in the chamber. Such a simple illustration cannot be seen by the Board as a clear and

unambiguous disclosure of the whirl dimensions or whirl height or whether it rises up a certain level along the upward wall or not.

In the Board's understanding, the disputed feature is also not anticipated by the fact that some liquid might also rise in the method of D3/D3b as a consequence of the incoming liquid jet impacting the chamber inner wall and splashing in all directions. Any upward splashing of liquid would be incidental and chaotic and in any case not a consequence of controlling the chamber liquid outflow, which is required by the contested claim.

The Board is also not convinced by the further contention of the Respondent-Opponent that the disputed outlet control feature should be disregarded for the novelty assessment. According to the Respondent-Opponent it implicitly defines the outlet aperture - and is thus an apparatus feature, which is not limiting for a method claim. The Board considers, on the contrary, that an apparatus feature that specifies the physical means by which method steps are carried out clearly does limit those steps and must therefore also be considered for novelty.

3.2.3 In view of the above, the Board holds that the subject-matter of granted claim 15 is new over the cited prior art, D1, D2 and D3/D3b.

3.3 Remittal

3.3.1 The Respondent-Opponent requests the Board to make a final decision rather than remit the case to the Opposition Division. Indeed, as correctly noted by the Respondent-Opponent, there is no absolute right to have

an issue decided at two instances and the general interest in conclusion of proceedings within a reasonable time frame or other criteria may sometimes weigh more heavily than the interest of one or more of the parties, cf. CLBA IV.E.7.2.1 or II.E.7.6. However, the decision remains at the discretion of the Board which must weigh up all relevant factors on a case by case basis.

3.3.2 In the present case all grounds of opposition under Article 100 EPC had been raised against all of the claims of the patent, based on various citations. The Opposition Division, however, issued its decision immediately, without oral proceedings, based only on the single ground of lack of novelty of claim 15 over a single document. For the Board to decide all the remaining issues it would effectively be carrying out the greater part of the task entrusted to the first instance and it would then do so in a rather different framework to that in which it had decided novelty. This would be alien to an appeal board's primary role to adjudicate on the correctness of decisions by departments of first instance. Nor does it seem particularly fair to the Board that the Appellant Proprietor should stand to lose all in what is then effectively a single instance procedure. Finally, having stated in its communication its intention to remit should claim 15 of one of the requests be found novel, the Board does not consider itself in a position to decide all of the remaining issues, nor is the Appellant Proprietor in a position to defend its position on all points.

3.3.3 In the light of the above, the Board considers that having a final decision without remittal would largely exceed the primary function of the appeal proceedings

as judicial review of a first instance decision to such an extent that outweighs, in the present case, the public interest for procedural economy and the legitimate wish of the Respondent-Opponent to have such decision made by the Board.

3.3.4 The Board thus decides in the exercise of its discretionary power under Article 111(1) EPC to remit the case to the department of first instance for further prosecution.

4. Request for a different apportionment of costs.

Under Article 104(1) EPC, in opposition proceedings each party must, as a rule, meet the costs it has incurred, unless reasons of equity justify to order otherwise.

4.1 The Respondent-Opponent requests an award of costs in respect of the additional expenses for a second first-instance opposition proceedings and for the present appeal proceedings, in the event that the case is remitted. The Respondent argues that the Proprietor neither requested oral proceedings nor filed auxiliary requests at first instance that could have avoided remittal and that they furthermore, in appeal, solely presented arguments and auxiliary requests in defense of novelty of claim 15, also missing a further opportunity to avoid remittal. The extra costs are thus caused by the Appellant-Proprietor's behaviour.

4.2 The Board notes that in the present case, the Proprietor in the proceedings before the opposition division dealt with all the objections raised by the Opponent in their reply to the notice of opposition. That it did so only by argument, without submitting

auxiliary requests and without requesting oral proceedings, is a legitimate defence against an opposition, though it runs the calculated risk of an immediate contrary decision.

Thus, the Appellant-Proprietor had no particular obligation to request oral proceedings before the Opposition Division. Their right to appeal or to file further requests on appeal is not affected by the mere fact that they did not request oral proceedings. The Board fails to see any legal basis for the implied assertion of the Respondent that the rights of the Appellant-Proprietor in the appeal proceedings are somehow more restricted because they did not request oral proceedings. It cannot be known how the events would have unfolded, had oral proceedings taken place, and it cannot be known if this would have materially changed the outcome of the first-instance opposition proceedings. It is also not apparent that the present situation is financially much worse for the Respondent. It could be argued that much of the cost of a full first instance proceedings with oral proceedings and multiple auxiliary requests was spared them.

Nor does the Board consider it equitable to impute to the Appellant-Proprietor the fact that the Opposition Division chose to decide the case on the basis of only one of the various issues raised and without summoning to oral proceedings (and was within its rights to do so). Likewise the decision to now remit the case upon appeal in accordance with common practice can also not be imputed to the successful Appellant. Finally, that upon appeal the Appellant argued only against novelty over D2 as sole ground for revocation is not in any way reprehensible as it is all they are required to do, as noted above.



4.3 The main argument of the Respondent was directed at the fact that generally, costs could have been avoided, if Appellant had conducted the proceedings properly and diligently. It was not argued that possibly different conclusions might also be justified for the two distinct cost items due to their different character (first second-instance proceedings and second first-instance proceedings), the two cost items were treated by Respondent as a single cost burden. Given that the Board does not accept Respondent's arguments for the reasons given above, i.e. that the Board does not see any reproachable conduct by Appellant at all, it is not necessary for the Board to address whether Respondent's arguments were indeed equally applicable to these two cost items, in spite of their different character.

4.4 In conclusion, it does not appear equitable to the Board that the Appellant-Proprietor should bear the costs for consequences that derive from discretionary procedural decisions on the part of the Opposition Division, of the Board of Appeal or from circumstances of the case that are not demonstrably the result of an abuse or lack of due care on the part of the Appellant-Proprietor. The Board thus decides not to order a different apportionment of costs pursuant to Article 104(1) EPC.

**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

A. de Vries

Decision electronically authenticated