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**Datasheet for the decision  
of 23 November 2020**

**Case Number:** T 0626/16 - 3.2.07

**Application Number:** 08735106.0

**Publication Number:** 2139791

**IPC:** B65D85/804

**Language of the proceedings:** EN

**Title of invention:**

SINGLE-USE CONTAINMENT CAPSULE OF AN AROMATIC ESSENCE FOR  
PRODUCING AN INFUSION

**Patent Proprietor:**

Novadelta-Comércio e Industria de Cafés, Lda.

**Opponent:**

Société des Produits Nestlé S.A.

**Headword:**

**Relevant legal provisions:**

EPC Art. 69, 123(2), 123(3)

RPBA Art. 12(4)

RPBA 2020 Art. 15(1)

**Keyword:**

Amendments - broadening of claim (yes) - main request, 1st and 2nd auxiliary requests

Auxiliary requests 3rd to 5th - submitted and not admitted in opposition proceedings - admitted (no)

Auxiliary requests 6th to 8th - not examined by the opposition division - admitted (no)

**Decisions cited:**

G 0007/93, T 1578/13, T 0052/15

**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 0626/16 - 3.2.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.07**  
**of 23 November 2020**

**Appellant:** Novadelta-Comércio e Industria de Cafés, Lda.  
(Patent Proprietor) Av. Infante Dom Henrique 151 A  
1950-041 Lisboa (PT)

**Representative:** Zimmermann, Tankred Klaus  
Schoppe, Zimmermann, Stöckeler  
Zinkler, Schenk & Partner mbB  
Patentanwälte  
Radlkoferstrasse 2  
81373 München (DE)

**Respondent:** Société des Produits Nestlé S.A.  
(Opponent) Entre-deux-Villes  
1800 Vevey (CH)

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

**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 15 January 2016  
revoking European patent No. 2139791 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** A. Pieracci  
**Members:** K. Poalas  
R. Cramer

## Summary of Facts and Submissions

- I. The patent proprietor (appellant) lodged an appeal against the decision of the opposition division revoking the European patent No. 2 139 791.
  
- II. The opposition was directed against the patent as a whole based on Article 100(a) EPC (lack of novelty and inventive step), on Article 100(b) EPC (insufficient disclosure) and on Article 100(c) EPC (unallowable amendments).
  
- III. The opposition division held in the decision under appeal  
  
that claims 1 of the main, 1<sup>st</sup> and 2<sup>nd</sup> auxiliary requests filed with letter dated 6 November 2015 violate the requirements of Article 123(3) EPC and  
  
that the 3<sup>rd</sup> to 5<sup>th</sup> auxiliary requests filed during the oral proceedings are not to be admitted into the proceedings.
  
- IV. The patent proprietor requested in the statement setting out the grounds of appeal  
  
that the decision under appeal be set aside and  
  
that the patent be maintained according to the main request underlying the decision under appeal, or, in the alternative,  
  
that the patent be maintained in amended form according to one of the 1<sup>st</sup> to 8<sup>th</sup> auxiliary requests filed together with the statement setting

out the grounds of appeal.

Thereby, claims 1 of the 1<sup>st</sup> to 5<sup>th</sup> auxiliary requests correspond to claims 1 of the 1<sup>st</sup> to 5<sup>th</sup> auxiliary requests underlying the decision under appeal, claim 1 of the 6<sup>th</sup> auxiliary request corresponds to claim 1 of the patent as granted and the independent claims of the 7<sup>th</sup> and 8<sup>th</sup> auxiliary requests have been filed for the first time in the present opposition-appeal-proceedings.

V. The opponent (respondent) requested in the reply to the statement setting out the grounds of appeal

that the appeal be dismissed.

VI. To prepare the oral proceedings scheduled upon both parties' request, the Board communicated its preliminary assessment of the case to the parties by means of a communication pursuant to Article 15(1) RPBA 2020 dated 13 January 2020. The Board indicated therein that claims 1 of the main request and of the 1<sup>st</sup> and 2<sup>nd</sup> auxiliary requests did not appear to meet the requirements of Article 123(3) EPC and that the admissibility of the 3<sup>rd</sup> to 8<sup>th</sup> auxiliary requests was questionable.

VII. Oral proceedings before the Board took place on 23 November 2020.

The parties confirmed their above-mentioned initial requests (see points IV und V above) as their final requests.

At the end of the oral proceedings the decision was announced. For further details of the oral proceedings

reference is made to the minutes thereof.

VIII. As far as relevant for decision at hand, the parties' submissions are discussed in the Reasons.

IX. Claim 1 of the **main request** reads as follows (amendments over claim 1 of the patent as granted are highlighted in bold or struck through):

"Single-use containment capsule (1) of powder of an aromatic essence for producing an infusion, characterised in that it comprises a container (2) having a perforated base (4) being part of the ~~capsule~~ **container** wall and being externally covered with a protective element (5) and a perforator element (6) present on the inner side of said protective element (5) and operable by the fluid pressure that is created inside said container (2) so to permit the exit of said infusion from said container (2)."

Claim 1 of the **1<sup>st</sup> auxiliary request** is a combination of claim 1 of the main request and claim 9 of the patent as granted.

Claim 1 of the **2<sup>nd</sup> second auxiliary request** is a combination of claim 1 of the main request and claims 3 and 9 of the patent as granted.

Claim 1 of the **3<sup>rd</sup> auxiliary request** differs from claim 1 of the main request in that feature concerning the perforated base reads as follows:

"a perforated base (4) being ~~part of the container~~ wall **integral with the container (2)**".

Claim 1 of the **4<sup>th</sup> auxiliary request** corresponds to the

combination of claim 1 of the 3<sup>rd</sup> auxiliary request and claim 9 of the patent as granted.

Claim 1 of the 5<sup>th</sup> auxiliary request corresponds to the combination of claim 1 of the 3<sup>th</sup> auxiliary request and claims 3 and 9 of the patent as granted.

Claim 1 of the 6<sup>th</sup> auxiliary request is identical with claim 1 of the **patent as granted**.

Claim 1 of the 7<sup>th</sup> auxiliary request corresponds to the combination of claims 1 and 9 of the patent as granted.

Claim 1 of the 8<sup>th</sup> auxiliary request corresponds to the combination of claims 1, 3 and 9 of the patent as granted.

## **Reasons for the Decision**

1. *Claim 1 of the main request - Extension of the protection conferred (Article 123(3) EPC)*
  - 1.1 Claim 1 of the patent as granted defines that the perforated base is part of the **capsule wall**, whereas claim 1 of the main request requires without any reference to the capsule wall the perforated base to be part of the **container wall**.
  - 1.2 The patent proprietor argues that when the person skilled in the art reads claim 1 of the patent as granted using thereby its general technical knowledge and based on the whole disclosure of the patent in suit, considering thereby in particular the specific embodiments represented in the drawings, immediately understands that the terms used in claim 1 of the

patent as granted "capsule" and "container" are identical. In such a case, the wall of the capsule ("capsule wall") is identical with the wall of the container ("container wall"). According to the patent proprietor this interpretation of the claim would also be appropriate in view of Article 69 EPC. Therefore, a replacement of the term "capsule wall" through the term "container wall" does not violate the requirements of Article 123(3) EPC.

1.3 The Board does not agree with above-mentioned arguments of the patent proprietor for the following reasons.

1.4 The Board notes that claim 1 of the patent as granted and claim 1 according to the main request define *inter alia* two distinctive objects, a capsule (or according to the patent proprietor's interpretation a first container) and a (second) container, whereby the capsule (first container) comprises the (second) container. Said (second) container has further structural elements, like for example a perforated base and a perforator element. Furthermore, claim 1 of the patent as granted mentions a specific structural element of the first object, namely the wall of the capsule (first container), and requires, i.e. it discloses the restriction, that the perforated basis of the second object, namely of the (second) container, is part of said capsule wall (namely of the first container wall). On the other hand, claim 1 of the main request does not disclose said limitation any more. It requires only that the perforated basis of the (second) container is part of the (second) container wall.

1.5 Given that it cannot be directly and unambiguously derived from the wording of claim 1, that the capsule wall (first container wall) and the (second) container



wall are identical, the removal of the above-mentioned restriction in claim 1 of the main request, although replaced by a different restriction, generates an aliud which extends the scope of protection conferred contrary to the provision of Article 123(3) EPC.

1.6 The Board considers that claim 1 of the patent as granted does not refer to any specific embodiment disclosed in the patent in suit and that the expressions "capsule wall" and "container wall" used in the claims are clear for the skilled person. Although Article 69 EPC is to be applied whenever it is necessary to determine the extension of the protection conferred, it cannot be invoked in this case to give a different meaning to the above claimed expressions which in themselves impart a clear, credible technical teaching to the skilled reader (see the Case Law of the Boards of Appeal, 9th Edition 2019, II.E.2.3.1) so that the Board cannot accept any arguments of the patent proprietor based on the different specific embodiments of the patent in suit.

1.7 For the above-mentioned reasons, claim 1 of the main request does not meet the requirements of Article 123(3) EPC.

2. *Claims 1 of the 1<sup>st</sup> and 2<sup>nd</sup> auxiliary requests - Extension of the protection conferred (Article 123(3) EPC)*

2.1 Also the independent claims 1 of the 1<sup>st</sup> and the 2<sup>nd</sup> auxiliary requests do not mention a "capsule wall".

2.2 The additional features which distinguish the independent claims 1 of the 1<sup>st</sup> and the 2<sup>nd</sup> auxiliary requests over claim 1 of the main request make no

difference in this respect. Accordingly, the same arguments as for the main request apply.

2.3 For the above-mentioned reasons, claims 1 of the 1<sup>st</sup> and the 2<sup>nd</sup> auxiliary requests do not meet the requirements of Article 123(3) EPC.

3. *Admissibility of the 3<sup>rd</sup> to 5<sup>th</sup> auxiliary requests*

3.1 Claims 1 of the 3<sup>rd</sup> to 5<sup>th</sup> auxiliary requests correspond to claims 1 of the 3<sup>rd</sup> to 5<sup>th</sup> auxiliary requests underlying the decision under appeal. These requests were not admitted into the opposition proceedings, since the requests were late filed and contained amendments, which were not disclosed in the originally filed or granted claims.

3.2 Under points 4.1 and 5 of its submission dated 9 March 2017 the patent proprietor merely referred to the support of the amendments in the originally filed description and stated that the amended wording is an alternative formulation for the feature(s) in dispute ("capsule wall", "container wall"). No arguments were presented by the patent proprietor why their non-admission by the opposition division was caused by an error of assessment / appreciation.

3.3 With its communication pursuant to Article 15(1) RPBA 2020 dated 13 January 2020, see point 9, the Board informed the parties about its preliminary opinion concerning the admissibility of the 3<sup>rd</sup> to 5<sup>th</sup> auxiliary requests stating the following:

*"9.2 As set out in G 7/93 (OJ EPO 1994, 775), point 2.6 of the reasons, if a discretionary decision is appealed, it is not the function of a Board of Appeal*

*to review all the facts and circumstances of the case as if it were in the place of the first instance department, in order to decide whether or not it would have exercised such discretion in the same way as the first instance department. A Board of Appeal should only overrule the way in which a first instance department has exercised its discretion if it comes to the conclusion either that the first instance department in its decision has not exercised its discretion in accordance with the right principles or that it has exercised its discretion in an unreasonable way, and has thus exceeded the proper limits of its discretion.*

*9.3 In the present case, the opposition division based its decision on the finding that "the feature that the perforated base (4) is integral with the container wall was not disclosed in the originally filed or granted claims" and that "auxiliary requests 3 to 5 may thus be considered as "surprising" for the opponent".*

*9.4 Although in principle it may be expected that a patent proprietor files amendments in order to overcome an added matter objection, the Board agrees with the opposition division that it is indeed at least surprising if not abusive to base newly filed requests - submitted at the last possible moment of the opposition procedure - on features allegedly extracted from the description and not prima facie overcoming the objection based on Article 123(3) EPC.*

*9.5 In particular, no arguments are presented by the patent proprietor why the non-admission by the opposition division was caused by an error of assessment / appreciation. In its submissions dated 9 March 2017 the patent proprietor merely refers to the*

*support of the amendments in the originally filed description and states that the amended wording is an alternative formulation for the feature in dispute.*

*9.6 The Board thus comes to the conclusion that the opposition division applied reasonable criteria, weighing the respective interests of the opponent and the patent proprietor, thus exercising its discretion in a reasonable way within the limits of that discretion. There is thus no reason to overrule the way the first instance exercised its discretion".*

- 3.4 The above-mentioned preliminary finding of the Board has not been commented on in writing nor has it been contested by the patent proprietor during the oral proceedings, see fourth and fifth paragraphs on page 2 of the minutes of the oral proceedings.
- 3.5 Under these circumstances, the Board - having once again taken into consideration all the relevant aspects concerning said issue - sees no reason deviate from its above-mentioned findings.
- 3.6 As a consequence, the 3<sup>rd</sup> to 5<sup>th</sup> auxiliary requests are not admitted into the proceedings.
4. *Admissibility of the 6<sup>th</sup> auxiliary request*
- 4.1 Claim 1 of the 6<sup>th</sup> auxiliary request corresponds to claim 1 of the patent as granted.
- 4.2 Under point 6 of its submission dated 9 March 2017 the patent proprietor merely stated that the claims of the patent as granted were not actively withdrawn in the opposition proceedings and should therefore be

considered in the appeal proceedings.

- 4.3 With its communication pursuant to Article 15(1) RPBA 2020 dated 13 January 2020, see point 10, the Board informed the parties about its preliminary opinion concerning the admissibility of the 6<sup>th</sup> auxiliary requests stating the following:

*"10.2 Given that in the present case after the opposition division had expressed a negative preliminary opinion concerning the unallowable amendment of claim 1 of the patent as granted, see point 1 of the opposition division's communication dated 12 March 2015, the patent proprietor had decided not to argue against said finding of the opposition division, and had instead intentionally changed the subject-matter of claim 1 and filed a new main and five auxiliary requests based on different subject-matter, see points 2 and 6 of the minutes of the oral proceedings. By doing so the patent proprietor had deliberately chosen not to obtain a decision from the opposition division on claim 1 as granted. Allowing it to revert on appeal to claim 1 as granted would go against the need for procedural economy, see Case Law of the Boards of Appeal, 9th edition 2019, V.A. 4.11.3.e), fourth paragraph.*

*10.3 Furthermore, the Board cannot follow the argument of the appellant that the claims as granted were not actively withdrawn in opposition proceedings and should therefore be considered. By requesting to maintain the patent according to the main request filed on 6 November 2015 at the outset of the oral proceedings (see point 2 of the minutes), the previous request of maintenance of the patent as granted has been superseded (see decision T 0052/15, point 1.4 of the*

*reasons for the decision; see also decision T 1578/13).*

*10.4 In view of the above, the Board exercising its discretion according to Article 12(4) RPBA is inclined not to admit the 6<sup>th</sup> auxiliary request into the appeal proceedings."*

- 4.4 The above-mentioned preliminary finding of the Board has not been commented on in writing nor has it been contested by the patent proprietor during the oral proceedings, see fourth and fifth paragraphs on page 2 of the minutes of the oral proceedings.
- 4.5 Under these circumstances, the Board - having once again taken into consideration all the relevant aspects concerning said issue - sees no reason deviate from its above-mentioned findings.
- 4.6 As a consequence, the 6<sup>th</sup> auxiliary request is not admitted into the proceedings.
5. *Admissibility of 7<sup>th</sup> to 8<sup>th</sup> auxiliary requests*
- 5.1 The 7<sup>th</sup> and 8<sup>th</sup> auxiliary requests have been filed for the first time in the present opposition-appeal-proceedings together with the patent proprietor's statement setting out the grounds of appeal.
- 5.2 Under point 7 of its submission dated 9 March 2017 the patent proprietor merely referred to the support of the amendments made to the claims of the 7<sup>th</sup> and 8<sup>th</sup> auxiliary requests.
- 5.3 With its communication pursuant to Article 15(1) RPBA 2020 dated 13 January 2020, see point 11, the Board informed the parties about its preliminary opinion

concerning the admissibility of the 7<sup>th</sup> and 8<sup>th</sup> auxiliary requests stating the following:

*"11.2 The Board notes that claim 1 of the 7<sup>th</sup> auxiliary request corresponds to the combination of claims 1 and 9 of the patent as granted and claim 1 of the 8<sup>th</sup> auxiliary request corresponds to the combination of claims 1, 3 and 9 of the patent as granted. This means that claims 1 of the 7<sup>th</sup> and 8<sup>th</sup> auxiliary requests are based on claim 1 of the patent as granted, so that the same considerations apply to the question of the admittance of these auxiliary requests as for the 6<sup>th</sup> auxiliary request. Although claims 1 of the 7<sup>th</sup> and 8<sup>th</sup> auxiliary requests contain additional characteristics of dependent claims, their admittance would, in effect, amount to allowing a return to the granted version. For the procedural reasons set out in detail above and in view of the fact that the patent proprietor did not provide in its statement setting out the grounds of appeal any reasoning as to why said auxiliary requests were not filed during the opposition proceedings, the Board is intended to exercise its discretion under Article 12(4) RPBA by not admitting the 7<sup>th</sup> and 8<sup>th</sup> auxiliary requests into the proceedings.*

*11.3 The Board notes further that claims 1 of said auxiliary requests being based on claim 1 of the patent as granted seem, in a prima facie assessment by the Board, not to meet the requirements of Article 123(2) EPC as argued under points 8.1, 9.1 and 10.1 of the reply to the appeal and that claim 13 of the 7<sup>th</sup> auxiliary request and claim 12 of the 8<sup>th</sup> auxiliary request being based on claim 1 of the main request seem, in a prima facie assessment by the Board, not to meet the requirements of Article 123(3) EPC. Accordingly, claims 1 of the 7<sup>th</sup> and 8<sup>th</sup> auxiliary*

*requests being considered as not being prima facie allowable, said requests would not be admitted into the proceedings also for this reason."*

5.4 The above-mentioned preliminary finding of the Board has not been commented on in writing nor has it been contested by the patent proprietor during the oral proceedings, see fourth and fifth paragraphs on page 2 of the minutes of the oral proceedings.

5.5 Under these circumstances, the Board - having once again taken into consideration all the relevant aspects concerning said issue - sees no reason deviate from its above-mentioned findings.

5.6 As a consequence, the 7<sup>th</sup> and 8<sup>th</sup> auxiliary requests are not admitted into the proceedings.

6. Conclusions

Since none of the appellant's requests is either allowable or admissible the appeal cannot be allowed.



**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:



G. Nachtigall

A. Pieracci

Decision electronically authenticated