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**Datasheet for the decision
of 16 December 2019**

Case Number: T 1238/16 - 3.2.04

Application Number: 05826001.9

Publication Number: 1838185

IPC: A47J31/44

Language of the proceedings: EN

Title of invention:

SYSTEM AND METHOD FOR PRODUCING FOAMED AND STEAMED MILK FROM
MILK CONCENTRATE

Patent Proprietor:

The Coca-Cola Company

Opponent:

Koninklijke Douwe Egberts BV

Headword:

Relevant legal provisions:

EPC Art. 123(2)

RPBA Art. 13(3)

Keyword:

Amendments - allowable (yes)

Late-filed request - amendments after arrangement of oral proceedings

Decisions cited:

Catchword:



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Case Number: T 1238/16 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 16 December 2019

Appellant:
(Patent Proprietor)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 7 March 2016
revoking European patent No. 1838185 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman A. de Vries
Members: G. Martin Gonzalez
C. Heath

Summary of Facts and Submissions

- I. The appellant-proprietor lodged an appeal, received on 17 May 2016, against the decision of the Opposition Division posted on 7 March 2016 revoking European patent No. 1838185 pursuant to Article 101(3) (b) EPC, and simultaneously paid the appeal fee. The statement setting out the grounds of appeal was received on 18 July 2016.

- II. Opposition was originally filed under Article 100(a) EPC for lack of novelty and lack of inventive step, under Article 100(b) EPC for insufficiency of disclosure and under Article 100(c) for added subject-matter.

Taking account of the amendments made by the patent proprietor, the Opposition Division held that they either extended the scope of protection conferred by the granted version or that they contained subject-matter extending beyond the contents of the originally filed application.

- III. The appellant-proprietor requests that the decision under appeal is set aside and that the patent be maintained based on the main request or auxiliary requests 1 - 3 (filed as fourth - seventh auxiliary requests with letter dated 3 October 2019), in the auxiliary on the basis of auxiliary requests 4 - 7 (filed as main request and first - third auxiliary request, all filed with the grounds of appeal), further, remittal of the case for consideration of the outstanding issues not decided in opposition.

The respondent-opponent requests that the appeal be dismissed.

- IV. In preparation for oral proceedings the Board issued a communication setting out its provisional opinion on the relevant issues.

Oral proceedings were held on 16 December 2019.

- V. Independent claim 1 according to the main request (filed as fourth auxiliary request on 3 October 2019) reads as follows:

"A condensed milk system (600) for creating foamed milk from a source of condensed milk, a source of water, and a source of pressurized air, comprising:

 a pressurized air inlet system (160) for providing the pressurized air;

 a mixing area (310) for mixing the condensed milk, the water, and the pressurized air;

 a pump (130) to pump the condensed milk to the mixing area;

 a flow meter (720) to measure a flow of the water to the mixing area; and

 a ratio control system (700) in communication with said pump (130) and said flow meter (720) to provide a predetermined ratio of condensed milk and water to said mixing area (310)."

- VI. The appellant-proprietor argued as follows:

New main request (filed as fourth auxiliary request on 3 October 2019) is clearly allowable and thus admissible. Claim 1 of this request does not contain subject-matter extending beyond the contents of the originally filed documents.

VII. The respondent-opponent argued as follows:

The main request is late filed and not admissible. The independent claim 1 of that main request contains added subject-matter.

Reasons for the Decision

1. The appeal is admissible.
2. The invention is concerned with a beverage system for producing foamed milk from a source of condensed milk, see paragraphs [0001] and [0008]. To that end the system flows condensed milk, water and pressurized air into a mixing area. The flow of the condensed milk and the water is measured and fed to a control system to provide a predetermined ratio of condensed milk and water to the mixing area. The mixing area provides turbulent mixing of the condensed milk, water and air for producing the foamed milk, see paragraph [0006].
3. Main request - Admissibility

The appellant-proprietor with letter of 3 October 2019, after arrangement of the oral proceedings, filed as fourth auxiliary Request the present main request. The admission of such a late request is at the discretion of the Board, Article 13(3) RPBA in the applicable version adopted 25 October 2007.

- 3.1 Article 13(3) RPBA specifies that amendments made after oral proceedings have been arranged shall not be admitted if they raise issues which the Board or the other party cannot reasonably be expected to deal with without adjournment of the oral proceedings.

In the present case, the respondent raised an objection under Rule 80 EPC against the previous main request as it added, vis-a-vis the granted claims, a further independent use claim 6 (and dependent claim 7). The new main request deletes this claim as well as claim 7 dependent thereon. It is evident that the new main request, by deleting independent method use claim 6, successfully removes the issue raised under Rule 80 EPC. The remaining apparatus claims 1 to 5 are identical to claims 1 to 5 of the main request filed with the statement of grounds and they are the same as those raised by the respondent against those claims and considered by the Board in its preparatory communication. Consequently no new issues are raised by this amendment; rather the number of issues is reduced and therefore the respondent and the Board could reasonably be expected to deal with the new main request within the framework of the oral proceedings without an adjournment.

3.2 For the above reasons, the Board decided to admit the new main request into the proceedings.

4. Main Request - Amendments

4.1 It is common ground that present claim 1 is based on claim 8 as originally filed, with features of the pressurized air inlet system and source added from claim 1 as originally filed.

Present claim 1 limits the subject-matter of original claim 8, directed to a system for producing milk of unspecified kind from condensed milk, to a system for specifically producing foamed milk. It adds further features that the source of air is a source of pressurized air and that the system comprises a

pressurized air inlet system for providing the pressurized air.

- 4.2 The Division held in its decision (section 42), as also maintained by the respondent, that this added feature was extracted in isolation from the set of features defined by original claim 1, omitting other features present in that original claim that were closely linked to the creation of foamed milk, namely a milk inlet system, a water inlet system and an air inlet system for pressurized air, giving rise to an unallowable intermediate generalization.

However, the Board considers that those features are already implicit in the features of claim 1 of the main request that originate in as filed claim 8. Thus, to supply the condensed milk to the mixing area necessarily requires a pump as well as implying some sort of milk inlet system. Similarly, a flow meter to measure a flow of water to the mixing area, as well as the fact that water is supplied from a source to the mixing area imply some form of water inlet. Furthermore, it goes without saying that the air inlet system for the pressurized air added from as filed claim 1 is a pressurized air inlet system for providing the pressurized air.

- 4.3 The respondent further argues that the subject-matter of claim 1 represents an intermediate generalization vis-a-vis the detailed embodiment of figure 5. That is the only embodiment showing a condensed milk system for creating foamed milk including all the features of present claim 1. These features would be disclosed in a close functional and structural relationship with other features, notably the nozzle with an expansion area to produce foam, that are not included in claim 1. This

inclusion of only some, but not all features in claim 1 would result in an unallowable intermediate generalization vis-a-vis this specific disclosure.

- 4.4 The Board agrees that the embodiment of figure 5 is the only embodiment falling within the terms of claim 1. It is in fact also the only embodiment to fall within the terms of any of the originally filed independent claims 1, 8 and 13. All original claims, as well as the embodiment of figure 5, were directed at producing milk (foamed or not) from a source of *condensed* milk. A further arrangement described in relation to figures 1 to 4, but not covered by the claims (present or as originally filed) was included only for explanatory purposes.

Original claim 1 is directed to the creation of foamed milk from a source of condensed milk and a source of pressurized air but not a nozzle. This claim thus discloses, in isolation, the minimum combination of features associated with the aspect of creating foamed milk from condensed milk in the context of the original application. As noted the embodiment of figure 5 also falls under the subject-matter of original claim 1, indeed is the only embodiment to do so. Thus, the skilled person learns directly and unambiguously from original claim 1 that a foamed milk system for creating foamed milk from a source of condensed milk and a source of pressurized air, such as shown in figure 5, which is also the basis for as filed claim 8 and thus present claim 1, need only include the features of claim 1 (milk inlet, air inlet and water inlet systems and a mixing area) but not a nozzle. Claim 1 as originally filed therefore provides a basis for adding to as filed claim 8 the feature of a pressurized air source and inlet system without a nozzle.

Thus, in the opinion of the Board there is also no intermediate generalization in this regard.

4.5 The Board thus concludes that the amendments to claim 1 of the main request (filed as Fourth Auxiliary request on 3 October 2019) do not add subject-matter, Article 100(c) EPC and Article 123(2) EPC.

5. Remittal

Since the main purpose of the appeal proceedings is to give the losing party a possibility to challenge the decision of the Opposition Division on its merits, remittal in accordance with Article 111(1) EPC is normally considered by the Boards in cases where the Opposition Division issues a decision solely upon a particular issue and leaves other substantive issues undecided. The Opposition Division has left the further substantive issues of sufficiency of disclosure and inventive step undecided. The Board therefore considers it appropriate to exercise its discretion under Article 111(1) EPC and remit the case for further prosecution.

The appellant-proprietor has declared his agreement with this course of action, while the respondent-opponent does not object to it.

In view of the above, the Board has decided to remit the case for further prosecution on the basis of the set of claims of the Main Request (filed as Fourth Auxiliary request on 3 October 2019).

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 for further prosecution.**

The Registrar:

The Chairman:



G. Magouliotis

A. de Vries

Decision electronically authenticated