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**Datasheet for the decision  
of 23 October 2019**

**Case Number:** T 0184/17 - 3.2.04

**Application Number:** 09795444.0

**Publication Number:** 2384133

**IPC:** A47J31/36, A47J31/06

**Language of the proceedings:** EN

**Title of invention:**

PROCESS OF BREWING TEA LEAVES CONTAINED IN A CAPSULE

**Patent Proprietor:**

Société des Produits Nestlé S.A.

**Opponent:**

Krüger GmbH & Co. KG

**Headword:**

**Relevant legal provisions:**

EPC Art. 54(2), 56, 114(1)

**Keyword:**

Novelty - (yes)

Inventive step - (no)

Grounds for opposition - fresh ground for opposition

**Decisions cited:**

G 0009/91, G 0010/91, G 0009/92, G 0004/93, G 0001/95,  
G 0007/95, T 0131/01, T 0448/03, T 0597/07, T 1738/11,  
T 0708/12, T 1029/14

**Catchword:**

Reasons 4



**Beschwerdekammern**  
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Case Number: T 0184/17 - 3.2.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.04**  
**of 23 October 2019**

**Appellant:** Société des Produits Nestlé S.A.  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
23 November 2016 concerning maintenance of the  
European Patent No. 2384133 in amended form.**

**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 20 January 2017, against the interlocutory decision of the opposition division posted on 23 November 2016 concerning maintenance of the European Patent No. 2384133 in amended form, and simultaneously paid the appeal fee. The statement setting out the grounds of appeal was received on 20 March 2017.

II. Opposition was filed under the ground of Article 100 (a) EPC for lack of novelty and under the ground of Article 100 (b) EPC for insufficiency of disclosure.

The opposition held that the patent as amended met the requirements of the Convention, having regard inter alia to the following evidence:

(E1) DE 33 25 280 A1

III. The respondent-opponent filed the following additional evidence in appeal:

(E10) EP 1 774 878 A1

IV. The appellant-proprietor requests that the decision under appeal be set aside and that the patent be maintained as granted (Main Request), or on the basis of one of the First or Second Auxiliary Requests as filed with the grounds of appeal.

The respondent-opponent requests that the appeal be dismissed, in the alternative that the case be remitted to the opposition division for further prosecution.

V. Oral proceedings were held on 23 October 2019.

VI. Independent claim 1 according to the requests relevant for the decision reads as follows:

(a) Main request (as granted)

"Process for the preparation of a beverage in a beverage machine with a capsule comprising an enclosure containing tea leaves comprising the steps of:

a) introducing water in the capsule to submerge the tea leaves in the capsule enclosure, then

b) introducing water at a soaking flow of at most 80 ml/min, then

c) introducing water in the capsule until the required volume of beverage is delivered, wherein during at least one period of step b), water is introduced in the capsule at a stirring flow superior to the soaking flow to stir tea leaves."

(b) First auxiliary request

Claim 1 as in the main request amended to specify at the end of the claim that (emphasis added by the board to indicate added text):

"...to stir tea leaves, and wherein the time length of step b) is at least 5 seconds, preferably at most 50 seconds."

VII. The appellant-proprietor argued as follows:

The subject-matter of claim 1 of the main request and of the first auxiliary request is new over the citation E1. The inventive step objection of the respondent-opponent constitutes a fresh ground for opposition. Its introduction into the appeal proceedings is only with the consent of the appellant-proprietor, see G10/91, which it does not give. Even so, the subject-matter of claim 1 according to both requests also involves an inventive step.

VIII. The respondent-opponent argued as follows:

The subject-matter of claim 1 of the main and first auxiliary requests lacks novelty over E1. Otherwise it lacks an inventive step in the light of E1 and common general knowledge. Inventive step, in the circumstances of the present case, can be examined by the board. Claim 1 of the second auxiliary request does not involve an inventive step in the light of E1 and the new document E10.

## **Reasons for the Decision**

1. The appeal is admissible.
  
2. The invention is concerned with a process for brewing tea leaves contained in a capsule in a beverage machine, see specification paragraph [0001]. The invention is aimed at a process for obtaining tea beverage in the shortest time possible while maintaining an optimal extraction from the tea leaves, see specification paragraphs [0009],[0010]. To this end, the process comprises the steps of introducing water in the capsule to submerge the leaves, then introducing water at a soaking flow of at most 80 ml/min, then introducing water in the capsule until the required volume of beverage is delivered. During at least one period during the soaking flow step, water is introduced in the capsule at a stirring flow, superior to the soaking flow, see paragraph [0011]. During the soaking flow, tea leaves are left to rest so that they can unfold, while short stirring temporarily moves and stirs the leaves, boosting extraction by avoiding lingering areas of high tea extract concentration, before they are again left to rest, see paragraph [0014].
  
3. Main request - Novelty
  - 3.1 The appellant-proprietor contests the decision's finding that the subject-matter of claim 1 is not new over the process described on pages 29-33 of E1.
  
  - 3.2 In this regard, the scope of the subject-matter defined by claim 1 is in dispute. In particular, the scope of the claimed terms "capsule" and "soaking flow" and

whether step b) requires that the infusion material is continuously submerged during this step.

- 3.2.1 Claim 1 defines a process for the preparation of beverage with a capsule containing tea leaves. In this respect, the contested patent defines the term "**capsule**" in paragraph 22 to mean also "cartridge" or "package" in the sense of the patent. In the light of the description the term "capsule" should be interpreted likewise, as also encompassing "package". In the board's understanding the term "package" in its broad sense only requires an enclosure without further restriction as to form or shape. Thus, the claim is also directed at a package in this broad sense.
- 3.2.2 The claimed process also calls for three water introduction steps, namely
- a) introducing water to submerge the tea leaves,
  - b) introducing flow at a soaking flow and
  - c) introducing the water until the required beverage volume is delivered,
- wherein during at least one period of step b) water is introduced at a stirring flow.
- 3.2.3 As regards the claimed soaking flow in step b), the patent specification also defines in paragraph 14 that according to a specific mode the soaking flow "introduced" during step b) can be null.
- 3.2.4 As regards whether step b) requires continuous immersion of the tea leaves, the board notes that, contrary to the submissions of the appellant-proprietor, step a) and step b) are different steps as follows from the formulation "a) introducing .... then, b)". Moreover, step b) of the claim neither requires that the water introduced during step a) is fully or



partly retained inside the capsule nor that the tea leaves remain completely or partially submerged. Moreover, continuous soaking is also not required during the claimed step b). Step b) is very broadly defined as only requiring introduction of water at a soaking flow, which can be null. It is also not specified in claim 1 that the introduction of a stirring flow must occur while the infused material is submerged.

In summary, a process step comprising several soaking periods separated by intermediate periods of the container or package having emptied would also anticipate the claimed step b). The claim only further requires that during at least a period of that step b), no matter when, stirring flow is introduced.

3.3 Turning to E1, E1 describes a process for the preparation of a beverage on pages 29-33 with a sachet, that can be considered a package in the sense discussed above and thus a capsule in the sense of the contested patent, enclosing the infusion material. The process consists in a repetition of cycles, see bridging paragraph pages 32-33 points 1. to 5., each cycle including filling the sachet with water, pausing water introduction while infused beverage drips through a bottom exit and introducing air to expel the remainder of the water. The above cycle is repeated up to five times until the required beverage volume is delivered.

It is not under dispute that each water filling or re-filling suspends, i.e. submerges, and stirs the infusion material. Indeed, as for example described in the general description part of E1 in page 10, lines 16-19, according to the invention each new water introduction serves to again agitate and suspend the

particles susceptible of infusion/extraction ("...zum erneuten Suspendieren und erneuten Bewegen des aufgußfähigen Materials").

Thus, as held by the opposition division, the process described on pages 29-33 comprises the three claimed steps as follows. The first filling step of submerging (and also stirring) the infusion material anticipates step a). This is followed by a step b) comprising several subsequent pauses in water introduction (soaking flow thus being null) each followed by refilling of water to stir the sachet contents which correspond to the intermediate stirring periods. The final filling step introduces water into the sachet until the required volume of beverage is delivered and anticipates the claimed step c).

- 3.4 It is further in dispute whether the described process of pages 29-33 is a direct and unambiguous description of a process for preparing a beverage from tea leaves.

In this respect, E1 teaches that the machine of figures 2-7 can be used for extracting tea or coffee (see page 24, paragraph 2): "Die nunmehr mit Bezug auf die Fig. 2 bis 7 zu beschreibende Vorrichtung,... Sie ist insbesondere,..., zur Erzeugung von frisch aufgebrühtem Tee oder Kaffee...". E1 also explicitly states that for describing the functioning of the machine (i.e. the process for brewing), a delivery process of brewed coffee is used (see also page 24, paragraph 2): "Für die Zwecke dieser Beschreibung wird die Lieferung von frisch aufgebrühtem Kaffee benutzt, obwohl ebenso gut andere Getränke geliefert werden könnten." This includes the process described on pages 29-33. Thus, it is true that the detailed description of device and process appears merely to illustrate general operation,

which is intended also for other drinks, most particularly for coffee and tea. However, where values for timing cycles and portion sizes are mentioned these appear specific to the example discussed, namely coffee. This seems all the more so in the light of page 36 in relation to the possibility of selecting different timing cycles and portion sizes for different strength coffee. Based on common knowledge and experience at least the particular preparation times can be expected to be different for tea and coffee. In relation to such specific values, the Board thus considers that the cited process is not an unambiguous description of a process for preparing a beverage from tea leaves.

Whether the skilled person would, drawing on the teachings of the general description of the invention on pages 9-15 of E1 for brewing tea, adapt or modify the process of the particular embodiment described in pages 29-33 as a matter of obviousness, as the respondent-opponent argues, in the board's opinion is a matter of inventive step.

3.5 The board thus concludes that the subject-matter of claim 1 is new over E1.

4. New ground of opposition

The respondent-opponent submits that, if claim 1 is considered new for the lack of an unambiguous disclosure of a process for preparing a beverage from tea leaves, it anyhow lacks an inventive step. According to the respondent-opponent, the skilled person, drawing on the teachings of the invention in E1 already cited in the above novelty objection, would adapt as a matter of obviousness the cited process

described on pages 29-33 for preparing a beverage from tea leaves in the sense of the contested claim.

The appellant-proprietor contests that the ground of inventive step was neither raised nor substantiated in the notice of appeal and thus constitutes a fresh ground for opposition. Since the appellant-proprietor does not consent to its introduction into the appeal proceedings, the board has no authority to examine it, see **G10/91** (OJ 1993, 408 and 420).

- 4.1 In **G9/91** and **G10/91** (OJ 1993, 408 and 420) the Enlarged Board of Appeal held that Rule 76(2)(c) EPC has inter alia the function of establishing the legal and factual framework of the opposition including the grounds for opposition. In respect of fresh grounds of opposition, in decision **G7/95** (OJ EPO 1996, 626) the Enlarged Board of Appeal held that lack of novelty and lack of inventive step, albeit both falling under Article 100(a) EPC, are different legal grounds for opposition. Moreover, according to decision **G10/91** (OJ 1993, 408) a fresh ground for opposition (a ground neither raised and substantiated in the notice of opposition nor discussed during opposition proceedings) may in principle not be introduced at the appeal stage. This more restrictive application of Article 114(1) EPC, as explained by the Enlarged Board, also reduces the procedural uncertainty for patentees having otherwise to face unforeseeable complications at a very late stage of the proceedings and risking the revocation of the patent. An exception to this principle is justified in case the patentee agrees to its introduction: *volenti non fit injuria*, see point 18 of the reasons.

4.2 In the present case, the ground of inventive step was neither raised and substantiated in the notice of opposition nor discussed during opposition proceedings.

In appeal, the respondent-opponent for the first time advances the above inventive step objection. The new objection relies on the same passages and teaching of the document as the unsuccessful novelty objection, duly raised and substantiated with the notice of opposition. In other words, the lack of inventive step attack as raised in appeal stays within the factual and evidentiary framework relied upon by the opponent in the notice of opposition under the ground of Article 100(a) EPC for novelty.

This raises the question whether under such special circumstances, the new objection still falls under the principle as expressed in **G10/91**, or can be admitted into the appeal proceedings without the agreement of the patentee.

4.3 In this context, the board is mindful of the conclusions drawn in cases **T 597/07**, see reasons 5, and **T 131/01** (OJ EPO, 2003, 115), see reasons 3.1, that in a case where a patent has been opposed on the ground of lack of novelty having regard to a prior art document, a specific substantiation of the ground of lack of inventive step is neither necessary nor generally possible without contradicting the reasoning presented in support of lack of inventive step. The reasoning in decision **T 131/01** under point 3.1. reads as follows:

*"Although in decision **G 7/95** (supra) it was decided that the grounds of lack of novelty and lack of inventive step are two different grounds for opposition, this does not mean that there is no*

*substantive connection between these two grounds, at least in a case in which the claimed invention is to be compared with the same relevant prior art document in both respects. If the claimed invention is not considered novel having regard to a prior document, it is not logically possible to assess whether this claimed invention is inventive having regard to this prior art. Substantiating a lack of inventive step objection in such a case necessarily involves looking at possible differences between the claimed subject-matter and the prior art document and would thus lead to the risk of two conflicting reasonings within the same notice of opposition, i.e. a first reasoning in support of lack of novelty where it is concluded that there is no difference and the further reasoning presented in support of lack of inventive step submitting that there are indeed some differences between the same claimed subject-matter and the same prior art document."*

This reasoning was followed in the subsequent decision **T 597/07** of 12 August 2009 in point 5 of the reasons:

*"G 10/91 is silent on the issue of whether Article 100(a) EPC is to be considered as one single ground for opposition or whether the provisions of Articles 52 to 57 EPC mentioned therein are all different grounds for opposition (see also G 9/91; OJ EPO 1993, 408). This question has been answered only in G 1/95 (OJ EPO, 1996, 615), the content of which corresponds essentially to G 7/95. Accordingly, an objection of lack of novelty which has not been substantiated in the notice of opposition cannot be introduced into the appeal proceedings without the agreement of the patentee since it is a different legal objection than the objection of lack of inventive step and, therefore,*

*a fresh ground for opposition (point 7.1). However, it is also mentioned that in a case where the closest prior art document destroys the novelty of the claimed subject-matter, such subject-matter obviously cannot involve an inventive step. Therefore, a finding of lack of novelty in such circumstances inevitably results in such subject-matter being unallowable on the ground of inventive step (point 7.2 of **G 1/95**).*

*The consequence of this latter statement is in the Board's opinion that if a patent has been opposed on the grounds of lack of novelty and lack of inventive step and if only the ground of novelty has been substantiated, a specific substantiation of the ground of lack of inventive step is not necessary.*

*The Board further concurs with the conclusion drawn in **T 131/01** (OJ EPO, 2003, 115) that under such circumstances a specific substantiation of the ground of lack of inventive step is not even generally possible since - given that novelty, i.e. the presence of a difference between the claimed subject-matter and a prior art, is a prerequisite for determining whether an invention involves an inventive step in view of that prior art - this would contradict the reasons in support of lack of novelty.*

*Therefore, the Board holds that the objection of lack of inventive step is not a fresh ground for opposition in the present case."*

- 4.4 The board is aware that in the current case, the opponent in the notice of opposition had neither ticked the box concerning inventive step, nor in any other way specified this ground. The case in its factual aspects is thus not identical to the two cases cited previously where at least the box "inventive step" was ticked. In the board's opinion, this difference is not decisive. In the board's view what is decisive is that both lack

of novelty and lack of inventive step are argued within the same factual and evidentiary framework, which means that the passages and teachings relied upon by the opponent for substantiating both objections as well as the main body of the argument are the same, but only the legal conclusions drawn therefrom differ. While in the present case in the cited passages the general applicability to beverages such as tea and coffee is mentioned, the specific example relied upon only refers to coffee. In these circumstances, the board takes the view that raising such an inventive step attack does not amount to a fresh ground of opposition against which the patent proprietor could object in the sense of **G10/91** (supra).

- 4.5 Such an interpretation does not give rise to procedural uncertainty either, as most of the relevant arguments advanced against novelty are equally valid for the objection of lack of inventive step.
- 4.6 The board thus considers introducing an objection of lack of inventive step at this stage of the procedure as covered by the underlying principle in **G10/91** (OJ 1993, 408) that the notice of opposition should provide legal certainty to the patentee by determining the factual and evidentiary framework on which the patent is opposed.
- 4.7 The Board notes that decisions **T 1029/14** and **T 448/03**, cited by the appellant-proprietor, did not assess whether the new inventive step objections, though relying as starting point on the same document as the novelty objection, modified the original evidentiary and factual framework, e.g. by requiring further teachings or evidence. Thus, the reasoning in those decisions has no bearing in the present case.



Otherwise, the board agrees with the conclusions in the cited decisions that a fresh ground of inventive step cannot, as a general principle, be introduced into the appeal proceedings without the consent of the patentee.

The appellant-proprietor also cites decisions **T 708/12** and **T 1738/11** that also have no bearing on the present case, as these did not involve the ground of inventive step, but of novelty.

- 4.8 In conclusion, the board holds that even when the ground of inventive step was neither raised and substantiated in the notice of opposition nor discussed during opposition proceedings, an objection of lack of inventive step can exceptionally be examined in the appeal proceedings without the agreement of the patentee, if it stays within the same factual and evidentiary framework of a novelty objection properly raised and substantiated in the notice of opposition. This does not mean that the ground of lack of inventive step starting from the same prior art is always implicit in a properly substantiated allegation of lack of novelty. It rather applies exclusively to a case such as the present one, where, after having validly raised lack of novelty in opposition on the basis of a given document and passages cited therein, the ground of lack of inventive step is subsequently invoked in appeal based *only* on that document and the same passages, and where therefore the factual and evidentiary framework is substantially the same.

4.9 In the case under consideration, the respondent-opponent for the objection of lack of inventive step relies on the same particular embodiment of E1, namely the embodiment described on pages 29-33, as in the novelty objection and also on the same general teachings of the invention on pages 9-15 of E1, that were cited in support of the allegation that such an embodiment constitutes also a disclosure of a process for brewing tea in the sense of the contested claim 1. The board thus concludes that the new objection is within the original factual and evidentiary framework established by the notice of opposition. Therefore, according to the above conclusions, it can be examined by the board without the agreement of the appellant-proprietor.

4.10 The board therefore decides to admit the raised inventive step objection into the appeal proceedings, Article 114(1) EPC.

5. Main request - Inventive step

Starting from E1 as closest prior art, this document describes a process for the preparation of a beverage in the sense of the contested patent on pages 29-33. E1 further suggests that the cited illustrative process is also intended for other drinks, expressly mentioning tea, see page 24, paragraph 2. However, where values for timing cycles and portion sizes of the process are mentioned these appear specific to the example discussed, namely coffee. As explained above under novelty, the board considers this to be the only feature of the contested claim not anticipated by the cited example, namely that the claimed process is

specifically for preparing the beverage from tea leaves.

Thus the skilled person, when carrying out the teachings of E1 is faced with the problem that the specifically described process is not adapted for tea leaves. The associated technical problem can thus be formulated as how to adapt the known brewing process for using tea leaves as infusion material.

In this context, document E1 describes on page 10, focusing on the control of the infusion time as a central parameter, the most important features of tea preparation. Document E1 also teaches that means for controlling the time duration may be provided in the processes of the invention, which also helps to produce a drink of more consistent quality, cf. bridging paragraph pages 18-19. E1 further describes therein practical ways to carry out the time control: upstream or downstream valves or by manipulating the container itself. Moreover, from their basic understanding of tea brewing process, the skilled person knows the infusion times and beverage strengths that are appropriate for brewing tea leaves. Therefore the skilled person, when tasked with adapting the process described in pages 29-33 for brewing tea, would readily modify the timing of the cycles, drawing on the teachings of E1 and on their own common technical knowledge, to adapt them to the appropriate infusion times for tea leaves as a matter of obviousness.

- 5.1 The appellant-proprietor submits that the hot water in the process of pages 29-33 of E1 is retained within the container due to the coffee cake provided by the described ground coffee of the particular embodiment. According to the appellant-proprietor, such water

retention is not possible with tea leaves, that do not form such a cake and would not retain water. Thus, when using the process of pages 29-33 for tea leaves, the appropriate tea leaves soaking time needed for tea extraction would not take place. The board is not convinced by this argument. As explained above, the skilled person, when adapting the process of pages 29-33, knows from their basic understanding of tea brewing and from the teachings in the general part of the description of E1, which also teach various means for water retention inside the container, how to modify the infusion times to adapt it to tea leaves, including also the soaking time appropriate to them.

5.2 The board therefore concludes that the subject-matter of granted claim 1 does not involve an inventive step.

6. First auxiliary request - Inventive step

6.1 Claim 1 of the first auxiliary request is modified to add that the time length of step b) is at least 5 seconds. As indicated above step b) is considered to encompass several cycles of introducing water and then waiting. The total length of a cycle can be inferred from E1, bottom of page 32 and top of page 33, as having a duration of 4 seconds. Repeating each cycle three to five times, see top of page33, gives a value well over 5 seconds. Even if these values apply to the coffee making example, they give an idea of the order of magnitude of the values for making tea. Drawing on general tea making practice, where soaking should normally be in the order of seconds or tens of seconds if not more, the claimed values are not considered to be out of the ordinary. Consequently, this further feature to not seen to render the claimed subject-matter inventive.

7. Auxiliary request 2

As already noted by the board in its written communication, in **G 9/92** and **G 4/93** (both OJ 1994, 875) the Enlarged Board concluded that where the patentee was the sole appellant against an interlocutory decision maintaining the patent in amended form, neither the board of appeal nor the non-appealing opponent (as party to the proceedings as of right under Art. 107, second sentence, EPC 1973) could challenge maintenance of the patent as thus amended, see also Case Law of the Boards of Appeal, 8th edition 2016, IV.E.3.1.

The board is thus barred from considering the respondent-opponent's objections in respect of the second auxiliary request (maintained version). The question of admissibility of late filed E10, that has only been cited against claim 1 of the second auxiliary request, and its possible relevance for novelty and/or inventive step need therefore not be considered.

8. Neither the patent as granted (main request) nor as amended according to the first auxiliary request meet the requirements of the EPC, so that these requests fail. Consequently, the appeal also fails.

**Order**

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

**The appeal is dismissed.**

The Registrar:

The Chairman:



G. Magouliotis

A. de Vries

Decision electronically authenticated