

# Kluwer Patent Blog

## Another chapter of the coffee capsule saga

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### ECC's patent strategy not Swiss courts' cup of tea

Ethical Coffee Company (ECC) and different entities of the Nestlé group of companies have been involved in many legal disputes in various jurisdictions. The parties' positions are normally as follows: ECC seeks access to the Nespresso coffee capsule machines for its biodegradable coffee capsules and Nestlé tries to prevent the distribution of the ECC capsules based on its exclusive rights.

However, in the latest Swiss chapter of this saga things had an interesting twist.

For several years, ECC has been accusing Nespresso of introducing a mechanism into its coffee machines that makes them incompatible with ECC's own biodegradable capsules.

However, ECC's president Jean-Paul Gaillard (who was Nespresso's CEO from 1988 to 1997) said in a press statement that ECC "in anticipation of such a move" had secured patent rights that would allow ECC to prevent Nespresso from using a mechanism that makes the ECC capsules incompatible with the Nespresso machines.

ECC inter alia owns the European patent [EP 2 312 978](#). This patent was upheld by the Opposition Division (see [decision of 15 March 2016](#)) and the appeal filed against this decision by Nestec SA and Nespresso France was rejected by the Board of Appeal in oral hearings on 30 May 2017 (see the minutes of the oral hearing of [T0696/16](#)).

The English version of claim 1 of EP 978 (the application was filed in French) reads as follows:

*Device for preparing a drink extracted from a capsule (1) comprising a capsule support (4) and a capsule cage (5) inside which there are at least a water inlet and capsule-piercing means, characterized in that said cage (5) is sized in such a way as to deform, at least partially, using deforming means included on the internal wall of the cage, any capsule (1), made of a material that can be deformed upon contact with hot water, which is placed in the cage (5), so that the capsule (1) is retained in the cage (5) following its contact with hot water, said means being a relief of the barbed hook (11) type.*

On 30 January 2015, ECC sued Nestlé Nespresso SA and two other companies (DKB Household Switzerland AG and Eugster/Frismag AG) before the Swiss Federal Patent Court. ECC's complaint was not based on the Swiss portion of EP 978 but on the Swiss patent [CH 701 971 B1](#).

CH 971 belongs to the same patent family as EP 978. Both patents claim the same priority date. Due to the pending appeal proceedings before the EPO there was no double patenting issue.

Claim 1 of CH 971 may be structured as follows (unofficial translation of the French version):

*M1: Device for preparing a drink extracted from a capsule (1)*

*M2: comprising a capsule support (4)*

*M3: and a capsule cage (5)*

*M4: inside which there are at least a water inlet and capsule-piercing means*

*M5: characterized in that said cage (5) is arranged to deform, at least partially, any capsule (1), made of a material that can be deformed upon contact with hot water, which is placed in the cage (5)*

*M6: so that the capsule (1) is retained in the cage (5) following its contact with hot water.*

In proceedings before the Swiss Federal Patent Court ECC asserted that the Nespresso coffee machines met the features of claim 1 of CH 971 and blocked the ECC capsules in the Nespresso coffee machines so that they were not compatible with the Nespresso system anymore.

It seems that ECC's biodegradable coffee capsules did not work perfectly with at least some of the Nespresso machines and could block occasionally. The original Nespresso capsules are made of aluminum. Those capsules do not deform upon contact with hot water. But for ECC's capsules made of biodegradable material, the contact with hot water seems to cause problems (at least in the past). ECC claimed that the use of CH 971 blocked ECC capsules in the Nespresso machines. At the same time, ECC announced that it had developed new biodegradable capsules to circumvent that problem.

In its decision of 12 July 2016 (O2015\_001) the Swiss Federal Patent Court dismissed ECC's complaint.

The court came to the conclusion that claim 1 of CH 971 requires that any capsule (meaning every capsule) made of a material that can be deformed upon contact with hot water must be retained in the cage of the concerned coffee machines following the contact with hot water.

Since ECC asserted in proceedings that it had developed biodegradable capsules that could be used with less problems in the Nespresso coffee machines and it did not dispute tests presented by the Defendants according to which not all capsules that are deformed following the contact with hot water are retained in the Nespresso coffee machines the court held that ECC's lawsuit must be rejected.

In addition, the court found that ECC's prayers for relief were unduly broad since they did not include all the features of claim 1 of CH 971 and, in particular, did not address the features M1, M2 and M4 so that the scope of the prayers for relief extended beyond the scope of claim 1 and the complaint had to be dismissed also for this reason.

The panel of the Federal Patent Court included among its five judges three graduates of the Federal Institutes of Technology, including an engineer with a degree in mechanics and a doctor in

technical sciences.

ECC filed an appeal with the Swiss Federal Supreme Court and asserted that it was not necessary that the Nespresso coffee machines retain every capsule that is deformable after the contact with hot water. According to ECC the generic term “any capsule” in claim 1 of CH 971 shall mean “a capsule of any type”, or more simply “a capsule”.

However, in its decision of 7 April 2017 ([docket no. 4A\\_520/2016](#)) the Federal Supreme Court confirmed the dismissal of ECC’s complaint and ruled that the interpretation of the Federal Patent Court of claim 1 of CH 971 was correct.

According to the Supreme Court ECC did not show that there was a special technical meaning which the Federal Patent Court would have disregarded when interpreting the expression “any claim”.

According to the Federal Supreme Court the expression “any capsule” in claim 1 of CH 971 refers to every capsule made of a material deformable in contact with hot water.

The Swiss Federal Patent Court therefore had not breached the rules of interpretation by considering that the patented device implies that every capsule with the specific characteristics must be deformed and hence retained in the capsule cage of the coffee machines after having been in contact with water hot.

In sum, ECC’s interesting patent strategy was not rewarded by the Swiss courts.

According to a press release of ECC of 10 February 2016 other similar proceedings were initiated in France, Germany (Munich and Dusseldorf), and Brussels. So far, it seems that ECC has not revealed the status or outcome of those procedures.

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