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**Datasheet for the decision
of 19 July 2024**

Case Number: R 0007/23

Appeal Number: T 1814/18 - 3.2.07

Application Number: 11157856.3

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IPC: B25J15/00, B65G47/91, B65B5/08,
B65B5/10

Language of the proceedings: EN

Title of the invention:
Gripping head for a robot or manipulator of a cartoning
machine

Patent Proprietor:
Camal S.p.A.

Opponent:
I.M.A. INDUSTRIA MACCHINE AUTOMATICHE S.p.A

Headword:
Petition for review

Relevant legal provisions:
EPC Art. 112a(2)(c), 112a(2)(d), 113, 125
EPC R. 104(b), 106, 110
Lugano Convention 2007
EU Reg Nr 44/2001

Keyword:
Petition for review - clearly inadmissible or unallowable
Fundamental violation of Article 113(1) EPC (no)

Decisions cited:
R 0002/14



**Große Beschwerdekammer
Enlarged Board of Appeal
Grande Chambre de recours**

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Case Number: R 0007/23

**D E C I S I O N
of the Enlarged Board of Appeal
of 19 July 2024**

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Decision under review: **Decision T 1814/18 of the Technical Board of Appeal 3.2.07 of the European Patent Office of 14 December 2022.**

Composition of the Board:

Chair: C. Josefsson
Members: D. Rogers
P. Gryczka

Summary of Facts and Submissions

I. The petition for review concerns appeal proceedings T 1814/18 of board of appeal 3.2.07 ("the Board"). The Board revoked the patent in its decision dated 14 December 2022 ("the Decision").

II. The appeal was against a decision of an opposition division that maintained the patent in amended form. Both the patent proprietor (the Petitioner) and the opponent appealed this decision.

III. The parties to this case are involved in patent litigation in Italy. The following documents from this Italian litigation, shall be referred to:

- a) The Court of Milan issued a decision on 8 April 2015 (see D1q and D1qEN).
- b) The Court of Appeal of Milan issued its decision on 14 May 2020 (document D1s and D1sEN).
- c) The opponent-appellant before the Board, appealed to the Italian Supreme Court of Cassation on 4 November 2020 (D1t and D1tEN).

Litigation in Italy and before the opposition division

IV. For the purposes of this decision, only the following information about the litigation in Italy and before the opposition division is salient:

A key issue in Italy was whether an inspection of a machine at a factory constituted a novelty destroying disclosure. A certain Mr Grassilli ("Grassilli") was present during this inspection and the finding in the Italian courts was that he was both bound by an obligation of confidentiality and that, in any case, the details of the machine were not revealed to him.

The opposition division had to consider the same issue as the Italian courts. However, in addition to the evidence that had been before the Italian courts on this issue, the opposition division also heard Grassilli as a witness. Contrary to the finding in Italy, the opposition division found that the details of the machine were revealed to Grassilli. The opposition division found, as did the Italian courts, that Grassilli was bound by an obligation of confidentiality.

Proceedings before the Board of Appeal

V. Before going into the details of the proceedings and arguments before the Board, it is useful to summarise the results of the appeal proceedings: the Board found, contrary to the opposition division, that Grassilli was not bound by any obligation of confidentiality. The Board agreed with the opposition division that the details of the machine were revealed to him. The consequence of this was that the inspection of the machine constituted a public disclosure that rendered the object claimed in the patent in suit not novel.

VI. The Board sent out a communication setting out its preliminary opinion on the case.

VII. The proprietor-appellant (Petitioner) responded to this in a letter dated 15 June 2022. Enclosed with this letter were documents D1s and D1t. The Petitioner argued that certain facts and circumstances had been established by the Italian courts and that these were "...res judicata as far as the Italian proceedings are concerned...". The proprietor-Petitioner also pointed out that opponent-appellant's appeal to the Italian Supreme Court only challenged certain points of the Court of Appeal of Milan's decision.

VIII. Opponent-appellant replied to the Board's communication and the proprietor-appellant's (the Petitioner) 15 June 2022 letter on 2 December 2022. It requested that D1s and D1t not be admitted into the proceedings. It argued that national decisions have no binding effect on boards of appeal, regardless of whether they contain *res judicata* in Italy. It also argued that the Italian decision in D1s was in any case not binding for the EPO and was not based on a full examination of the witness (Grassilli).

IX. In a letter dated 9 December 2022, the proprietor-appellant (the Petitioner) argued that the Board ought to accept as *res judicata* the final decision reached in Italian proceedings that the inspection of a machine in a factory did not constitute a novelty destroying disclosure. To this end, the proprietor-appellant (the Petitioner) submitted document D1u, an analysis of court decisions in Italy by an expert in Italian law.

X. Before the Board, the proprietor-appellant (the Petitioner) argued that the existence of a confidentiality undertaking, binding on Grassilli, had been established by the Court of Appeal of Milan. In addition, the proprietor-appellant (the Petitioner) argued that both the parts of the decision that were subject to appeal in Italy (the appeal being to the Italian Supreme Court) and those that were not, could be considered binding on the parties. The judgment of the Court of Appeal of Milan did not have to be final to be binding on the parties. This binding effect of the Court of Appeal of Milan's decision came from the operation of the Lugano Convention and Article 125 EPC.

XI. The findings of the Court of Appeal of Milan, due to the doctrine of *res judicata*, and/or the Lugano Convention, could not be challenged by the parties in the appeal proceedings and could not be reviewed by the Board. Alternatively, the proprietor-appellant (the Petitioner) argued that the opponent-appellant had implicitly waived

those parts of its appeal before the Board relating to the facts that were the subject of the findings of the Court of Appeal of Milan on public prior use.

XII. The Board found that the witness statement of Grassilli before the opposition division provided evidence that Grassilli was not subject to an obligation of confidentiality. The Board also found that there was no evidence on file from which an implied obligation of confidentiality could be deduced. As a consequence the Board found that the inspected machine was made available to the public and therefore the object claimed in the patent was not novel.

XIII. The Board was not convinced by the *res judicata* argument, the Lugano Convention with Article 125 EPC argument and the waiver arguments set out in documents D1u and the proprietor-appellant's (the Petitioner) 9 December 2022 letter. It discussed these arguments in para 3.4.4 and 3.5.1 to 3.5.10 of the Decision. The witness statement of Grassilli before the opposition division was evidence that the Appeal Court of Milan had not had before it. Thus different evidence was presented before the EPO compared to before the Italian courts. The Board noted that such evidence might have potentially changed the course of the Italian proceedings.

XIV. The Board thus found (last paragraphs of para 3.5.10, page 22 of the Decision):

"..., the Board is convinced that the conclusions taken in D1s, irrespective of the issues raised in D1u ("*res judicata*", EU Regulation 44-2001, Lugano Convention), cannot be binding for the present proceedings".

Petitioner's arguments in its Petition

XV. The Petitioner (the proprietor-appellant) argues that its right to be heard was violated. This is because three of its arguments, set out in its 9 December 2022 letter and Dlu regarding the effect of the Italian court decisions were not considered and fully taken into account by the Board and the Board did not substantiate its conclusions on this point in its written decision.

XVI. These arguments were that:

(i) that Grassilli was subject to an obligation of confidentiality had been definitively established by the Court of Appeal of Milan, and that this finding was *res judicata* (the "*res judicata*" argument); and

(ii) The non-final findings of the Court of Appeal of Milan were in any case binding between the parties and also for the Board, so that the Board was precluded from a review thereof (the "*Lugano-Art 125*" argument); and

(iii) The opponent's failure to appeal the judgment in respect of the finding of an obligation of confidentiality of the Court of Appeal of Milan constitutes a conduct that equates to an implicit waiver by the opponent of the part of its appeal relating to the facts that are the subject of those findings, and that the waiver limits the power of the Board, since boards must not base their decision on unsubmitted or waived grounds of appeal (the "*waiver*" argument).

XVII. At the oral proceedings before the Enlarged Board on 19 July 2024, the Petitioner pointed out that the "*waiver*" argument, which was legally distinct from the "*Lugano-Art 125*" and "*res judicata*" arguments, was not mentioned at

all in para 3.5.10 of the Decision. The Petitioner also argued that the evidence before the Board, the witness statement of Grassilli before the opposition division, was irrelevant to the three arguments set out above, and thus should not have led to a different result before the EPO as compared to before the Italian courts.

XVIII. In addition the Petitioner claimed that its right to be heard was violated in respect of its request that the Board appoints an expert in Italian law; and in respect of its question to the Enlarged Board of Appeal. At the oral proceedings before the Enlarged Board on 19 July 2024, the Petitioner relied upon its written submissions as regarded the appointment of an expert in Italian law and the referral of questions to the Enlarged Board.

XIX. The Petitioner argues that the Board merely found that different evidence was presented before the Italian courts compared to the opposition division, and upon this basis rejected the Petitioner's arguments. This only became apparent once the Petitioner had read the written decision of the Board, it was not in a position to make a Rule 106 EPC objection during the appeal proceedings concerning the right to be heard and its *res judicata*, Lugano-Art 125 and waiver arguments.

XX. The Petitioner also makes a case under Article 112a(2)(d) EPC, in conjunction with Rule 104(b) EPC, that the Board decided on the appeal without deciding on requests relevant to that decision. The Petitioner says the requests not decided upon were:

- (i) its argument on *res judicata*;
- (ii) its argument that the non-final findings of the Court of Appeal of Milan were in any case binding between the parties and for the Board ;
- (iii) its argument that there was an implied waiver of the right to appeal by the opponent;

(iv) its request that a question be referred to the Enlarged Board of Appeal.

XXI. At the oral proceedings before the Enlarged Board on 19 July 2024, the Petitioner relied upon its written submissions as regards its case under requests not decided upon.

XXII. The Petitioner requests that:

The Enlarged Board set aside the decision T 1814/18 and re-opens the proceedings before the Board of Appeal.

Reasons for the Decision

Preliminary point

1. The Enlarged Board considers this Petition to be a petition under Article 112a(2)(c) EPC (violation of the right to be heard) and Article 112a(2)(d) EPC and Rule 104(b) EPC (decided on the appeal without deciding on a request relevant to that decision). A petition under such grounds is only admissible if an objection in respect of the defect was raised during the appeal proceedings and dismissed by the board, except where such objection could not be raised during the appeal proceedings.

Has the Petitioner complied with Rule 106 EPC?

Right to be heard

2. As regards the right to be heard in respect of "res judicata", "Lugano-Art 125" and "waiver", the Enlarged Board considers that the Petitioner was not in a position to object until it had seen the written decision of the Board. These grounds of the Petition are therefore admissible.

3. As regards the right to be heard in respect of the refusal of the Board to appoint an Italian law expert and to refer questions to the Enlarged Board, the Petitioner has not provided any arguments as to why it did not make a Rule 106 EPC objection at the oral proceedings before the Board. The Enlarged Board can also see no reason why such objections could not have been made, as the Board announced its decisions on these issues prior to the discussion on auxiliary requests 2 to 6 and the Chairman had previously explained the Board's position on these issues. The Enlarged Board therefore considers the Petition to be inadmissible under these heads.

Has the Petitioner complied with Rule 106 EPC?

Request not decided upon

4. The Enlarged Board takes the view that the Petitioner's objections under Article 112a(2) (d) EPC - requests not decided upon - as set out in para XX (i) to (iii) are in fact all objections under Article 112a(2) (c) EPC (violation of the right to be heard), as they appear to be arguments rather than requests, and indeed, in the petition, the Petitioner makes right to be heard arguments on these points. The Petitioner did not challenge this view at the oral proceedings before the Enlarged Board. Thus the only Article 112a(2) (d) EPC objection that remains concerns the request to refer a question to the Enlarged Board (see para XX (iv) above).

5. As regards its request to refer a question to the Enlarged Board of Appeal, the Enlarged Board notes that the Board did decide on this request: it rejected this request.

6. The Article 112a(2) (d) EPC objections in respect of the request that the Board refer a question to the Enlarged Board of Appeal is thus inadmissible.

Is the Petition allowable?

7. For those grounds that the Enlarged Board has found admissible, as set out above, the Enlarged Board considers the Petition to be clearly unallowable.

Fundamental procedural defect

Right to be Heard

8. The Petitioner made three arguments, points (i) to (iii) in XVI above, that it considers were not fully taken into account in the written decision in a manner that enables it to understand, on an objective basis, the reasons for the decision (see R0002/14, Headnote II and reasons, point 6). These arguments are the "res judicata", "the Lugano-Art 125", and the "waiver" arguments referred to above.
9. The arguments that the Petitioner claims it was not heard on were made in a letter dated 9 December 2022 and in document D1u.
10. The Board set out the Petitioner's arguments from document D1u and the 9 December 2022 letter at para 3.4.4, and 3.5.1 to 3.5.10 of the Decision. It addresses and dismisses them in para 3.5.10. It does this upon the basis that different evidence, that is the witness evidence of Grassilli, was before the opposition division, but not before the Court, and Appeal Court of Milan.
11. It is indeed the case that these paras of the Decision do not refer, in terms, to the "waiver" argument. The "waiver" argument appears in para 63 of D1u and at pages 7-8/22 of the Petitioner's 9 December 2022 letter. This letter refers to D1u and makes some submissions concerning a party before the EPO waiving its rights before the EPO as part of the exercise of the principle of party disposition.

12. Para 3.5.10 uses the words "...irrespective of the issues raised in Dlu...". These words are then immediately followed by "...("res judicata", EU Regulation 44-2001, Lugano Convention)...". The Petitioner pointed out that this summary of the arguments in Dlu did not include the word "waiver". The Petitioner argues that this omission is evidence that its arguments on the "waiver" point were not taken into account by the Board, this constituting a violation of its right to be heard.
13. It is clear, when taken in the context of the entirety of para 3 of the Decision, that the Board, in para 3.5.10 of the Decision is rejecting all the arguments made by the Petitioner in its 9 December 2022 letter and in Dlu, and is not limiting itself to the "res judicata" and the Lugano Convention points. This is because para 3 of the Decision is concerned with the issue of prior public use, which the Board considered to be decisive. In para 3.1 to 3.4.4 the Board sets out the arguments of the parties concerning prior public use. The Board sets out its own position in para 3.5.1 to 3.5.10. The end result of this was that the Board did not consider itself bound either by the results of the Italian litigation or the positions taken by the parties in this litigation.
14. Although in an ideal world, it would have perhaps been good drafting for the Board to explicitly list the "waiver" argument as being amongst those arguments that did not convince it, the word "waiver" occurs a single time in a single paragraph of Dlu, para 63, out of a total of 72 paragraphs, and once again in a footnote 9 to this para. The references to this argument in the 9 December 2022 letter refer back to Dlu without adding anything. It is therefore understandable that Board did not seek to draw attention to this term in its final dismissal of the arguments set out in Dlu. The Enlarged Board thus does not consider that the precise language

which the Board used by way of a reference to, and a summary of, a document, can, in this case, be criticised. A board must have a considerable degree of freedom in the language it uses to refer to and summarise the documents before it.

15. The reasoning in para 3.5.10 is brief, nevertheless, in the light of the discussion of the key issue of prior public use that took place in para 3 of the Decision, it appears that the Board fully took into account the Petitioner's arguments and the written decision enables the Petitioner to understand, on an objective basis, the reason for the decision. The Enlarged Board thus finds that the omission of the word "waiver" in the Board's final reference to a document that was before it does not support a finding that the Petitioner's right to be heard was violated.

16. The Enlarged Board thus concludes that no fundamental violation of Article 113 EPC within the meaning of Article 112a(2)(c) EPC occurred in respect of the Petitioner's arguments set out in document D1u and the 9 December 2022 letter, so that the Petition (including the request for reimbursement of fee for petition for review (Rule 110 EPC)) is clearly not allowable.

Order

For these reasons it is decided that:

The petition for review is unanimously rejected as being clearly inadmissible or unallowable.

The Registrar

The Chair

M. Schalow

C. Josefsson



Decision electronically authenticated