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

Case Number: R 0008/23

Appeal Number: T 1841/18 - 3.2.07

Application Number: 11158426.4

Publication Number: 2500151

IPC: B25J15/00, B65B35/56,
B65G47/244, B65D77/04,
B65G47/91

Language of the proceedings: EN

Title of the invention:
Machine and method for cartoning articles

Patent Proprietor:
CAMA 1 SpA

Opponent:
I.M.A. INDUSTRIA MACCHINE AUTOMATICHE SpA

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
RPEBA Art 12(1)

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

Decisions cited:
R 0002/14, R 0001/15, R 0008/15, R 0007/16, R 0007/23



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

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Case Number: R 0008/23

**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 1841/18 of the Technical
Board of Appeal 3.2.07 of the European
Patent Office of 14 December 2022.

Composition of the Board:

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

Summary of Facts and Submissions

I. The petition for review concerns appeal proceedings T 1841/18 of board of appeal 3.2.07 ("the Board"). The Board revoked the patent in its decision dated 14 December 2022 ("the Decision"). This petition concerns facts and submissions almost identical to those in petition R 7/23. The facts and submissions that are identical to R 7/23 will be dealt with in the "First Part" of this decision. Those facts and submissions that are specific to the present case, and not found in R 7/23, will be dealt with in the "Second Part".

First Part - Summary of Facts and Submissions

II. The appeal was against a decision of an opposition division to reject the opposition.

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 - the decisions

IV. The Court of Milan found in its decision n. 4352/2015 of 8 April 2015 (document D1q and D1qEN) that Mr Grassilli, was bound by the secrecy agreement between Caffitaly (not a party to this litigation, also referred to as "Caffita") and GIMA. The consequence of this finding was that the court in Italy found the invention to be novel.

V. In reaching this conclusion the Court of Milan looked at the following evidence: written statements by Grassilli (document D1d before the EPO) and Tosarelli, and the non-disclosure agreements between Cama (the Petitioner) and Caffita (document D1k and D1k_full before the EPO), and Caffita and GIMA (document D1m before the EPO).

VI. The opposition division, in addition to the evidence that was before the Court of Milan, also heard Grassilli as a witness. From this evidence, the opposition division concluded that the details of the cartoning machine were revealed to Grassilli, but that Grassilli could not be considered as a member of the public. This was because Grassilli gained access to the Caffitaly factory due to the relationship between GIMA (the opponent) and Caffitaly (see opposition division decision page 5, third and fourth paragraphs). The opposition division thus decided that the circumstances of the inspection of the machine implied the existence of an obligation to maintain secrecy (see opposition division decision, page 6, second paragraph). This led the opposition division to a finding that the patent in suit was novel.

Proceedings before the Board

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

VIII. The proprietor-respondent (Petitioner) responded to this and filed 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 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.

- IX. Opponent-appellant replied to the Board's communication and to the Petitioner 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 interrogatory of the witness (Grassilli).
- X. In a letter dated 9 December 2022, the proprietor-respondent (the Petitioner) argued that the Board ought to accept as res judicata the final decision reached in Italian litigation proceedings on the non-availability of the prior use in the Caffitaly factory. To this end, the proprietor-respondent (the Petitioner) submitted document Dlu, an analysis of court decisions in Italy by an expert in Italian law.
- XI. Before the Board, the proprietor-respondent (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 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.
- XII. 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 Petitioner argued that the opponent 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 prior use.

XIII. 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 was therefore prior art.

XIV. 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 Petitioner's 9 December 2022 letter. It discussed these arguments in para 2.5.9 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.

XV. The Board thus found (last paragraph of para 2.5.9, page 17 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

XVI. The Petitioner 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 D1u 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.

XVII. These arguments were that:

(i) the existence of an obligation of confidentiality on Grassilli 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).

XVIII. 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 2.5.9 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.

XIX. 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.

XX. 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.

XXI. 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.

XXII. 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.

Second Part - Facts and Submissions

XXIII. The Petitioner identified a further violation of its right to be heard. The opponent's novelty objection was based upon an implicit disclosure in D1d (the Grassilli declaration). The Petitioner's submissions made on this point in its letter of 27 June 2022 were not admitted into the proceedings by the Board.

XXIV. The Petitioner argues that the reasoning given in section 7.2 of the Decision, as to why document D1d rendered claim 1 of the main request not novel, is not sufficient. The Board's reasoning was:

"...taking into account the description given in points d-h of D1d, the Board concludes that the opponent has convincingly shown that the subject matter of claim 1 of the main request lacks novelty".

XXV. The Petitioner considers this not to be a reasoned decision and that a violation of its right to be heard occurred because:

"As the novelty objection raised by the opponent was from the very beginning, based on alleged implicit case, the board should have explained the reasons behind its conclusion that the conditions for an implicit disclosure were met. The board however failed to do so and the patent proprietor was deprived of the opportunity to counterargue on those reasons".

XXVI. Besides violation of its right to be heard, the Petitioner also considers that the Board did not decide on the implicit novelty case, and hence decided the case without deciding on a relevant issue. This raises a ground for petition under Rule 104(b) EPC - request not decided upon.

XXVII. In its letter of 28 March 2024, page 2, starting from line 12, the Petitioner made a new submission that "the

decision not to admit the submissions of June 2022 was *in itself* a violation of Art. 113 EPC...". In the oral proceedings before the Enlarged Board, the Chair pointed out that according to Article 12(1) RPEBA, this new submission might be considered by the Enlarged Board if this was justified for special reasons. The Petitioner argued that this was not a new argument but a clarification of its position. At the oral proceedings, the Petitioner confirmed that it relied upon its written submissions as regarded requests not decided upon.

Requests

XXVIII. The Petitioner requests that:

The Enlarged Board set aside the decision T 1841/18 and re-opens the proceedings before the Board of Appeal.

First Part - Reasons for the Decision

Has the Petitioner complied with Rule 106 EPC?

Right to be heard

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.
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 XXI (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 XXI(iv)).
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 XVII 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 2.4.4, and 2.5.1 to 2.5.9 of the Decision. It addresses and dismisses them in the last paragraph of para 2.5.9. 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 Dlu 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 2.5.9 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 2 of the Decision, that the Board, in para 2.5.9 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 2 of the Decision is concerned with the issue of prior public use, which the Board considered to be decisive. In para 2.1 to 2.4.4 the Board sets out the arguments of the parties concerning prior public use. The Board sets out its own position in para 2.5.1 to 2.5.9. 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 the 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 2.5.9 is brief, nevertheless, in the light of the discussion of the key issue of prior public use that took place in para 2 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 Dlu 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 as regards the above points.

Second Part - Reasons for the Decision

17. The Enlarged Board considers that the Petitioner was not able to make a Rule 106 EPC objection prior to reading the Decision as regards the issues dealt with below.

18. The Petitioner's argument is that the Article 113(1) EPC, right to be heard, includes the right to have a fully motivated decision. This right was violated as para 7.2 of the Decision is merely a statement that the Board agrees with the opponent, which does not constitute a reasoned decision on the disputed implicit disclosure.
19. The Petitioner set out its position on the issue of novelty over the Caffitaly machine in its 27 June 2022 letter. The Board did not admit these submissions into the proceedings. The Board also found the Caffitaly machine to be prior art. As a consequence of the non-admission of the 27 June 2022 submissions, there were no arguments on file from the Petitioner as to why the disclosure of the Caffitaly machine was not novelty destroying. The opponent-appellant had made novelty arguments on this issue at para III.3.1 of its statement of grounds of appeal, and in document D1d, the Grassilli declaration. Para 7.1 of the Second Decision refers to para III.3.1 of the statement of grounds and to document D1d.
20. Deficiencies in the reasoning of a board's written decision can be the basis for a petition in view of Article 112a(2)(c) EPC if they amount to a fundamental violation of Article 113 EPC (see also CLBA, V.B.3.4.2, in particular R 1/15, point 3.5 of the reasons, R 8/15, point 2.2.2 of the reasons and R 7/16, point 3.1.1 of the reasons).
21. Under Article 113(1) EPC, decisions may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. This implies not only that a party is given the opportunity to present its views but also that its relevant submissions are taken into account and considered.
22. Accordingly, the reasoning in a decision should be such that a party can establish that the deciding body did

indeed consider its relevant submissions and can understand why, in the event of an adverse decision, they were found not to be convincing. Assessing the completeness of the reasoning would usually be beyond the scope of scrutiny under Article 113(1) EPC. For compliance with the right to be heard, reasons may be incomplete, but as long as they show that the board, in the course of the appeal proceedings, substantively assessed a certain point as being part of the procedure and that it found to be relevant, there will be no violation of Article 113(1) EPC (see also R 7/16, point 3.1.2 of the reasons; R 8/15, point 2.2.2 of the reasons).

23. In the present case, the submissions made by the Petitioner on the issue of novelty over the prior art Caffitaly machine were not admitted into the proceedings by the Board. The Board's decision on lack of novelty, which found the submissions of the opponent-appellant convincing on this issue, is therefore reasoned, and perfectly understandable.

24. Turning now to the Petitioner's submissions on page 14/15 of Second Petition, para 3.6, as far as these concern a violation of the right to be heard, these have been dealt with above. As regards the part of these submissions that concerns Rule 104(b) EPC, deciding on an appeal without deciding on a request relevant to that decision, the Petitioner has failed to identify such a request. The Enlarged Board notes that the Board decided upon the main request, it found it not novel.

25. As regards the new submissions of the Petitioner, see para XXVII above, in the absence of any special reasons being advanced by the Petitioner, the Enlarged Board decides not to admit them into the proceedings, Article 12(1) RPEBA.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:



N. Michaleczek

C. Josefsson

Decision electronically authenticated