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**Datasheet for the decision  
of 15 January 2021**

**Case Number:** T 0734/18 - 3.2.04

**Application Number:** 10701110.8

**Publication Number:** 2410894

**IPC:** A47J31/46, A47J31/44

**Language of the proceedings:** EN

**Title of invention:**

PUMP MOUNT IN A BEVERAGE PREPARATION MACHINE

**Patent Proprietor:**

Société des Produits Nestlé S.A.

**Opponents:**

Krüger GmbH & Co. KG  
BSH Hausgeräte GmbH

**Headword:**

**Relevant legal provisions:**

EPC R. 76(2) (c)  
EPC Art. 54(2), 56  
RPBA Art. 12(4)

**Keyword:**

Novelty - main request (no) - public prior use - burden of proof

Evaluation of evidence - credibility of witness

Inventive step - auxiliary request (yes)

**Decisions cited:**

T 0472/92, T 2338/13, T 0202/13, T 2451/13, T 0887/04,

T 0898/07

**Catchword:**

Reasons 4 - witness testimony - applicable standard of proof



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Case Number: T 0734/18 - 3.2.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.04**  
**of 15 January 2021**

**Appellant:** Société des Produits Nestlé S.A.  
(Patent Proprietor) Entre-deux-Villes  
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**Representative:** Vossius & Partner  
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**Appellant:** Krüger GmbH & Co. KG  
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**Representative:** Kutzenberger Wolff & Partner  
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**Appellant:** BSH Hausgeräte GmbH  
(Opponent 2) Carl-Wery-Strasse 34  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
16 January 2018 concerning maintenance of the  
European Patent No. 2410894 in amended form.

**Composition of the Board:**

**Chairman**           A. de Vries  
**Members:**           G. Martin Gonzalez  
                          T. Bokor  
                          S. Hillebrand  
                          C. Heath

## Summary of Facts and Submissions

I. The appellant-proprietor lodged an appeal, received on 20 March 2018, against the interlocutory decision of the Opposition Division posted on 16 January 2018 concerning maintenance of the European Patent No. 2410894 in amended form, and simultaneously paid the appeal fee. The statement setting out the grounds of appeal was received on 25 May 2018.

The appellant-opponent 1 also appealed the interlocutory decision by notice of appeal received on 26 March 2018 and paid the appeal fee on the same day. The statement setting out the grounds of appeal was received on 25 May 2018.

The appellant-opponent 2 also filed a notice of appeal received on 14 March 2018 and paid the appeal fee. They withdrew their appeal with letter of 9 May 2018.

II. Two oppositions were filed under Article 100(a) EPC for lack of novelty and lack of inventive step.

III. The Opposition Division held that the patent as amended complied with the provisions of the EPC having regard *inter alia* to the following evidence:

(D2) WO 2006/032599 A2

Evidence related to prior use Jura Z5

(E1.1) "Noch ein Nachschlag", Article in E&W Haushalt, edition 03/2005, pp.98-99

(E2.1) Cover of a Brochure on the Jura Impresa Z5

(E3.1) Technical drawing of the company Eugster/Frismag AG (hereinafter as "Eugster") amended on 16 September 2005.

(E4.1) Invoice dated 29 June 2004

(E5.1) Screenshot of the website "Geizhals" dated 9 December 2014.

Additionally, the Opposition Division heard Mr. D. Fischer as witness, and also relied on the witness statement as recorded and available in the file.

The following evidence was not admitted by the Opposition Division

(D3) AU 16549/76

(D4) FR 2.214.069

IV. The appellant-opponent 1 filed the following further evidence in appeal

(E6.1) Bedienungsanleitung zur Jura Impressa Z5, 9/05

V. The appellant-proprietor requests that the decision under appeal be set aside and the patent be maintained as granted (main request). Auxiliarily they request the dismissal of the appeal of the opponent 1, i.e. to maintain the patent in an amended form as upheld by the Opposition Division (auxiliary request 1), or further auxiliarily to maintain the patent in an amended form on the basis of one of the auxiliary requests 2A, 2A', 2B, 2B', 3A, 3A', 3B, 3B', 3C, 3D, 3E, 4A, 4A', 4B, 4B', 5A, 5A', 5B, 5B', 6A, 6A', 6B, 7, in that order, where requests 2A, 3A, 4A, 5A, 2A', 3A', 4A', 5A', 2B', 3B', B', 5B', 6A were filed with letter dated 15 December 2020,

and requests 1, 2B, 3B, 3C, 3D, 3E, 4B, 5B, 6B, 7 were filed with the response to the opponent's grounds of appeal dated 16 October 2018.

The appellant-proprietor further request to postpone the oral proceedings in order that their Swiss representative, Mr Hess, be able to participate.

The appellant-proprietor also requests referral to the Enlarged Board of Appeal for the question of the admissibility of multiple independent claims, as presented in their letter of 15 December 2020, should this question be relevant.

The appellant-opponent 1 request that the decision under appeal be set aside and the patent be revoked.

The opponent 2, party as of right and respondent to the appeal of the proprietor, has not formulated any request.

VI. In preparation for oral proceedings the Board issued a communication, dated 5 June 2020, setting out its provisional opinion on the relevant issues.

Oral proceedings before the Board were duly held on 15 January 2021. In the course of the oral proceedings the appellant-proprietor stated that Mr Hess ultimately did not come to Haar for the oral proceedings given the uncertainty of his admission to the premises of the Office.

VII. The wording of claim 1 of the requests relevant to this decision is as follows:

(a) Main request

"A beverage preparation machine comprising: a housing (1000); a pump (800) which vibrates during use and which is mounted in the housing; and a dampener for preventing or reducing the transmission of vibrations from the pump to other machine parts, the dampener comprising a spring (850) on which the pump is mounted in the housing, characterised in that the dampening spring (850) is a helicoidal dampening spring."

(b) Auxiliary request 1

Claim 1 as in the main request with the following features added at the end of the claim:

"...and in that the beverage preparation machine comprises a brewing unit for receiving a preportioned ingredient of a beverage supplied within a capsule or pod and for guiding an incoming flow of liquid through said ingredient to a beverage outlet."

VIII. The appellant-proprietor argued as follows:

(1) The opposition of the appellant-opponent was insufficiently substantiated and thus inadmissible.

(2) The Opposition Division had found that the patent as granted lacked novelty over the prior use Jura Z5, a finding that was based on the above documentary evidence and the hearing of the witness Mr Fischer. In reaching its conclusion, the Opposition Division was wrong to apply the evidentiary standard of a balance of probability. The correct standard to apply for the prior use to be proven in the present case would have been the so-called "up to the hilt", essentially a proof beyond any reasonable doubt. When judged against this standard, the prior use was insufficiently proven.



Mr Fischer had a significant interest in the outcome of these proceedings, namely in the revocation of the patent, and as such should be perceived as partial. His testimony should be assessed accordingly. The reason why the Board should use a different standard of proof, and should regard Mr Fischer's testimony in a different light was the following.

Although the company Eugster was a supplier to both the appellant-proprietor and the appellant-opponent 1, Eugster and its employee Mr Fischer assisted the appellant opponent 1 in preparing the case for the opposition, while no such assistance had been received by the appellant proprietor. Eugster in this regard had "concealed" its co-operation with the appellant-opponent.

Further, there was a fundamental difference between the business relationship appellant-proprietor/Eugster and appellant-opponent/Eugster in that Eugster and its employee Mr Fischer had assisted the appellant opponent 1 in designing, devising and marketing coffee-maker K-fee 11 that infringed the patent at issue. This was of relevance because thereby, Eugster and the appellant opponent 1 should be regarded as co-actors in an infringing activity for which also Mr Fischer as a leading employee of Eugster could be held liable under Swiss law. For the purposes of applying the correct standard for the burden of proof, Eugster due to its supply of infringing parts should be regarded as belonging to the sphere of the appellant-opponent 1 and consequently the standard of "up to the hilt" should apply. As the liability of Mr Fischer for such infringement arose regardless of whether or not he had knowledge of having committed or merely being accused

of such infringement, it was immaterial whether he was actually aware of any possible infringement, whether established or only alleged. It was sufficient that he could objectively be held liable, and therefore his testimony could no longer be treated as that of an impartial witness.

In regard of the alleged infringement due to the marketing of the K-fee 11 machine, it was submitted that "the K-fee 11 coffee maker is believed to infringe the contested patent. ...K 11 appears to fall within the scope of the contested patent ... Mr. Fischer presumably was responsible for the technical design of K 11" (letter dated 15 December 2020); "Eugster/Frismag is currently involved in the manufacturing of at least one machine sold under a brand belonging to opponent 1 which is believed to incorporate the technology falling under the granted patent, i.e. the espresso coffee-maker K-fee 11. This has not been contested by the opponent." Further, "that [Mr Fischer] should have known [espresso coffee-maker K-fee 11] will fall into the scope of the patent." (statement of the grounds of appeal of 25 May 2018).

Their submissions of 23 March 2017 (before the Opposition Division) contain two black and white photographs of the coffee maker K-fee 11 and the explanation: "As apparent from the photographs below, the coffee machine K-fee 11 incorporates the claimed dampening spring." From this it should be sufficiently clear to Eugster and Mr Fischer that the K-fee 11 machine infringed their patent.

(3) Mr Andri Hess, who in the brief dated 25 December 2020 was named as a further representative of the appellant proprietor, was offered to explain Swiss law

in regard of Mr Fischer's potential liability as an infringer due to his leading involvement in the development of the K-fee 11 coffee maker. Due to the current rules applied by the Office in regard of the Covid-19 pandemic, it became clear that Mr Hess, travelling from Switzerland, would not be allowed into the EPO's premises without having spent at least five days in quarantine; he therefore refrained from travelling to Munich. His presence was essential to convince the Board that the consequences of a real or potential patent infringement for Mr Fischer were such that significant doubt should be cast on his testimony. For this reason postponement of the oral proceedings was requested.

(4) The new evidence E6.1 submitted by the appellant-opponent 1 for auxiliary request 1 should not be admitted. There was no apparent justification for its late filing and it was furthermore not relevant for the first auxiliary request, for which it has been cited. D3 and D4, not admitted by the Opposition Division, should also not be admitted in appeal for lack of reasoning.

(5) Claim 1 of the first auxiliary request is new over Jura Z5, since the latter had no brewing unit for receiving a capsule or a pod.

(6) It is also inventive over the teachings of D2 and prior use Jura Z5 even having regard to common general knowledge. The central teaching of D2 teaches away from the patent in that D2 suggests to suspend a horizontally arranged pump from above in order to dampen pump vibrations. The claim of the patent requires the pump being mounted on a helicoidal spring, i.e. a support from below and thereby excludes a

hanging fastening. The Jura prior use could not be considered as general knowledge but rather as one piece of prior art. There was no evidence on file that helicoidal springs for pump support were widely known, contrary to the statement of the witness. The skilled person would not have had any incentive to disregard the central teaching of D2 and to exchange it for something else. The suggested vibration dampening solutions of D2 lead away from a helicoidal spring. The skilled person would look for guidance in the shown embodiment of D2, which teaches away from a vertical arrangement. The long vertical heating blocks of D2 would make vertical positioning of the pump practically impossible. Vertical positioning of the pump would furthermore be a more noisy arrangement, since vertical vibrations produce higher shock levels of housing parts. D2 provides further advantages of the hanging pump arrangement. The hanging suspension of the pump is taught throughout D2. The proposal of the opponent would disregard the central teaching of D2. Even when supported from below, the hanging suspension is still required.

IX. The appellant-opponent 1 argued as follows:

(1) The notice of opposition was sufficiently substantiated. The opposition was thus admissible as held by the Opposition Division.

(2) There was no close business relationship between the appellant-opponent 1 and Eugster, as the latter supplied parts or complete coffee-machines, inter alia Jura, to various different companies including both the appellant-opponent 1 and the appellant-proprietor, nor had any case of infringement ever been substantiated to

a level that would require or even allow the appellant-opponent 1 to respond.

Mr Fischer was a credible witness and as a person involved in the development of coffee-machines for a number of companies, he had no specific link to the opponent appellant 1, or any personal interest in the outcome of the case.

(3) Claim 1 of the main request lacks novelty over the prior use Jura Z5.

(4) Claim 1 of the first auxiliary request also lacks novelty over Jura Z5. The wording of the feature added to claim 1 does not require the ingredient to be supplied within a capsule or pod to the brewing unit. Any beverage preparation machine configured for receiving ground coffee meets the new limitation because ground coffee could be supplied from within a capsule or pod. The contents (i.e. ground coffee) of the capsule/pod could be removed by a user, and the content (i.e., ground coffee) could then be introduced into the beverage preparation machine.

(5) The subject-matter of claim 1 of the first auxiliary request is not inventive in the light of the combinations of teachings of D2 and the prior use Jura Z5. Neither D2 nor the patent is limited to any special position of the pump. D2 also teaches that its solution was usable in many types of machines not restricted to the shown embodiment. It is also obvious to select a helical spring for dampening a vibration. Vertical positioning of the pump was well known at the relevant date. The question would always be the positioning of the totality of the main components of the machine, and not merely the pump. Vertical suspension was

technically preferable to suppress saucers moving due to vibrations, and corresponded to the direction of the water transport.

As the Jura Z5 machine was well known, it would offer a promising solution. It is true that D2 suggests hanging, but this is meant broadly in D2. D2 also teaches support from below, even if the pump is hanging. The Jura Z5 also had a support from below, direct on the base plate, just like in D2. The form of the heater tube of D2 does not exclude the positioning of the pump beside the heater tube, and vertically. This would also provide long tubes between the pump output and the heater input. Designers of coffee machines are permanently confronted with space constraints, and are used to positioning the main components in a number of ways, depending on the shape of the housing. Vertical positioning is an obvious solution, as shown in the Jura Z5 machine. The skilled person is always inclined to move the pump to any suitable suitable position within the housing, given that only the input and output tubes connected the pump to the rest of the machine.

- X. The opponent 2 (party as of right) has not made any submissions.

### **Reasons for the Decision**

1. The appeals are admissible.
2. Background

The patent is concerned with the fixation of a pump in a beverage preparation machine, see specification paragraph [0001]. In order to prevent or reduce the

transmission of vibrations from the pump to other machine parts, the machine comprises a dampener, see specification paragraph [0008]. The dampener of the claimed machine comprises a helicoidal dampening spring on which the pump is mounted in the housing, see specification paragraph [0012].

3. Admissibility of opposition 1 (Krüger GmbH & Co. KG)

3.1 The appellant-proprietor contests the admissibility of the opposition for insufficient indication of facts, evidence and argument, Rule 76(2)(c) EPC, for the only substantiated ground of novelty over the prior use *Jura Z5*.

3.2 As noted by the Board in its written communication,

"It is established case law that the above legal requirement is met when the notice of opposition contains sufficient information for the patentee and the Opposition Division to understand the case put forward by an opponent. In this regard, when an opposition ground is based on an allegation of public prior use, the requirements of Rule 76(2)(c) EPC are fulfilled if the notice of opposition indicates the facts that make it possible to determine the date of prior use, the object of the use, and the circumstances of the prior use, including an indication of the arguments and supporting evidence, see Case Law of the Boards of Appeal, 9th edition 2019 (CLBA), IV.C.2.2.8.d). Nomination of a witness for subsequent examination is deemed to constitute indication of evidence, also in CLBA, IV.C.2.2.8.d).

In the present case, the notice of opposition clearly indicated evidence E1.1 (E & W Österreichs Insiderblatt für die Elektrobranche), E4.1 (Verkaufsrechnung) and E5.1 (Screenshot des Portals "Geizhals") in support that the coffee machine *Jura Z5*, sold by Jura AG, was available on the market from 2004, and that it included an helicoidal pump spring support (evidence E3.1 - Detaildarstellung der Pumpenaufhängung), together with the nomination of Mr. Daniel Fischer as witness for corroborating those facts. An analysis why this machine construction deprived granted claim 1 of novelty was also indicated. The requirements of Rule 76(2) (c) EPC were therefore fulfilled within the opposition period. The strength of those arguments and the probative value of the evidence and witness testimony belongs to the substantive examination of the opposition.

It is not disputed that all other requirements of Articles 99(1) and 100 EPC and Rule 76 EPC are met. The opposition is therefore admissible."

- 3.3 The parties made no further comments on this issue after the communication of the Board. Absent any further submissions the Board sees no reason to change its point of view. The Board thus holds that the opposition of opponent 1 is admissible.
- 4. Main request - Novelty, prior use *Jura Z5*, standard of proof, credibility of the witness Mr Fischer and request for postponement of oral proceedings.
  - 4.1 With its appeal, the appellant proprietor has invited the Board to apply a standard of proof different from the one applied by the Opposition Division. The



appellant- proprietor has argued that if the prior use had to be proven "up to hilt", the appellant-opponent 1 had failed to do so and that therefore the prior use should not be taken into account. Basis for the different assessment of the burden of proof is the allegation that both the documents presented and the witness Mr Fischer should be considered to belong to the sphere of the opponent, a constellation where case law has consistently applied the evidentiary standard of "beyond any reasonable doubt", e.g. decision **T 472/92** of 22 November 1996, OJ 1998, 161, headnote and point 3.1 of the reasons, and, more recently, decision **T 2338/13** of 26 September 2016, point 2.2. of the reasons. While it was uncontested in this regard that Eugster was an independent supplier that had business relations with a number of companies selling coffee-makers, inter alia the appellant-opponent 1 and the appellant-proprietor, the latter has invited the Board to regard Eugster's, and consequently the witness's position differently, based on the following arguments:

(1) A different level for the burden of proof should be applied because Eugster had assisted the appellant-opponent 1 in its case of proving prior use. Eugster or the witness collaborated with the opponent to provide the necessary evidence for proving the prior use, including Mr Fischer who was willing to appear as a witness.

This line of argument fails to convince the Board. Whenever an opponent intends to prove a prior use, the evidence of which is in the possession of a third party, a certain co-operation with such a third party is normally required to succeed in proving the prior use. It also lies in the very nature of proving a prior

use that this is rather more beneficial to the opponent's case than to the patentee's.

(2) The next line of argument advanced by the appellant proprietor is the allegation that Eugster and the witness Mr Fischer should be regarded as belonging to the sphere of the appellant-opponent 1 due to these parties being jointly engaged in an infringement of the patent at issue and thus being joint tortfeasors.

In this regard, the Board first of all notes that none of the cases cited by the appellant-patentee (**T 2451/13**, **T 202/13** or **T 2338/13**) supports the view that the burden of proof should be shifted due to a common sphere of interest between the parties. These decisions rather turn on a legal relationship between parties such as that of a subsidiary, affiliated company etc. Case **T 2338/13** (as above) required proof "up to the hilt" because it could not be established whether the witness in whose possession the relevant document was, could indeed qualify as an independent witness, as neither the witness nor the opponent were very forthcoming as regards their exact relationship. While the appellant-proprietor alleges the same for Mr Fischer, the Board is unable to see any evidence to confirm this. The position of Mr Fischer with Eugster, the business relationships of Eugster and the alleged patent infringement brought up by the appellant-proprietor were all known prior to the oral proceedings before the Opposition Division. Had the appellant-proprietor indeed had any doubts or queries in this regard, they could have asked Mr Fischer to clarify the situation when he gave his testimony during the oral proceedings. The Board thus observes that none of the three cases as cited above appears to assist the appellant-proprietor in its line of argumentation.

Even if the Board were to accept the above line of argument, the Board is unconvinced that the appellant-proprietor has sufficiently substantiated the case of an alleged patent infringement committed jointly by Eugster, Mr Fischer and the appellant-opponent 1.

To the extent that the appellant-proprietor contests the factual and legal findings of the Opposition Division's decision, it is incumbent on the appellant-proprietor to substantiate its case. Though there was general agreement that this should be so, there was a significant discussion during the oral hearing before the Board as to what should be understood by sufficient substantiation of infringement in this case. The appellant-proprietor pointed to the fact that the appellant-opponent 1 had never contested the alleged patent infringement, that the Boards of Appeal were not the proper forum for conclusively establishing infringement and that Mr. Hess was meant to furnish information in regard of Swiss law on patent infringement.

4.2 These arguments need to be placed into their proper legal and factual context, however.

To the extent that the appellant-proprietor argues that the standard of proof should be altered because of a possible patent infringement, the plausibility of such a possible infringement has to be proven to the satisfaction of the Board. Although the Boards of Appeal are not a forum for determining infringement, it is not uncommon for national courts to make legal findings in relation to other jurisdictions where this is a necessary step in determining a domestic lawsuit. A court may have to establish the likelihood of a

foreign patent infringement where this is necessary in order to determine domestic liability for a threat, or for libel or slander. In the same vein, international private law may call upon a domestic (national) court to determine legal consequences under foreign law even if domestic law would not give corresponding jurisdiction. In a number of cases, German civil courts assessed the validity of a (foreign) patent although these courts lack jurisdiction to determine the validity of a German patent due to the separation of infringement and validity proceedings (e.g. LG Düsseldorf, decision of 31 May 2001, GRUR Int. 2001, 983 - "Schwungrad"; LG Düsseldorf, decision of 16 January 1996, Entscheidungen 1996, 1, 4 - "Reinigungsmittel für Kunststoffverarbeitungsgeräte"). In this regard, it would then be incumbent on the parties to furnish evidence of how infringement is to be determined under such foreign jurisdiction, a question on which the appellant-proprietor wished Mr. Hess to be heard. Also the fact that the appellant-opponent 1, Eugster or Mr Fischer did not deny infringement may have become important in this context.

Pursuing that avenue of enquiry first of all requires that the appellant-proprietor in appeal has substantiated to the Board's satisfaction that there was at least a plausible case for infringement under Swiss law. All that was submitted in this regard was a statement in their letter of 23 March 2017 (section 1.1.2) that the appellant-opponent 1 was engaged in the manufacture and sale of the K-fee 11 coffee maker, that this coffee maker was developed inter alia by Mr Fischer in the course of his employment with Eugster, and that two photos in black and white showed the inside arrangement of the K-fee 11 which "incorporates the claimed dampening spring". There is nothing that

would indicate when and where these machines were manufactured or sold (in Switzerland? Elsewhere? When? To whom?), there is no feature analysis that would compare the patent claim with the features of the K-fee 11, there is no allegation of potential infringement communicated to any of the three parties allegedly being joint tortfeasors, nor did they make an inquiry of rights, send a cease and desist letter or actually start infringement action. Neither was the case of alleged infringement put to Mr Fischer when he was questioned as a witness, as acknowledged by the appellant proprietor. Not even the case of manufacture on which the appellant-proprietor relies has been substantiated or detailed in any way apart from the allegation that such manufacture had presumably taken place. The Board is thus faced with such an incomplete set of allegations of infringement and supporting evidence that it does not allow it to draw any conclusions therefrom, in particular not that Eugster/Mr Fischer might be liable for infringement under Swiss law. For the same reasons appellant-opponent 1 saw no need in opposition and the following appeal to deny or rebut the allegation of infringement, let alone undertake legal action.

The Board's conclusions as to the level of substantiation of alleged infringement receive support in the case law of the Boards of Appeal in relation to Article 105 EPC, the intervention of an "alleged infringer". Under this provision, the "allegation" of infringement must be manifest either by the patentee raising an infringement suit, or by the alleged infringer instituting proceedings for determining non-infringement based on a threat (warning letter) by the patentee. In the latter case, the act of the patentee that would "allege infringement" needs to be an express

request to cease infringement (decision **T 887/04** of 14 November 2006, point 2.1 of the reasons), or the patentee's invitation to enter licensing negotiations in connection with alleging that the party's act would constitute infringement (decision **T 898/07** of 30 April 2009, point 2 of the reasons). In other words, the "allegation" of infringement must be concrete and manifest enough to allow the addressee to start proceedings for non-infringement, or to require some other form of action. No such allegations have been made here.

While the Board appreciates in this context that the appellant proprietor may have chosen such cautious and vague wording in order to avoid any possible civil liability for unjustified threats, it also leads to the result that no case of alleged infringement has been made in these proceedings: these are the eggs that need to be broken to make the proverbial omelet.

The Board therefore holds that the appellant-proprietor did not substantiate its case for the Board to qualify the position of Eugster different from the findings of the Opposition Division, namely as an independent supplier of coffee-machines outside the sphere of the appellant-opponent 1.

(3) Also the appellant-proprietor's case for casting doubt on the evidence of Mr Fischer is based on the alleged infringement by developing the K-fee 11 machine and has been argued as follows: By developing a machine that infringed the patent at issue, Mr Fischer had a manifest interest in the revocation of the patent. Whether Mr Fischer knew of the infringement or not was immaterial because liability for patent infringement did not require knowledge. Regardless, he in fact knew

about the patent since he had been called as witness regarding the patent, and must therefore have recognised that the K-fee 11 machine he had developed was infringing it.

The Board finds this argument fallacious for the simple reason that the Board cannot conclude that Mr Fischer's testimony was tainted by a liability if it is not proven that he was actually aware of such a liability. The appellant-proprietor in its written submissions and during the oral proceedings was unable to affirm that Mr Fischer had actual knowledge of potentially committing a patent infringement by developing the K-fee 11 machine. As acknowledged by the appellant proprietor, see also above, no inquiry or threat was ever made against him or his employer, no warning letter was ever sent to him or to his employer, no legal action was undertaken against him or his employer, and no case of any potential liability was ever put to him when he was heard as a witness in opposition proceedings.

The Board has thus no reason to doubt the credibility of Mr Fischer or the reliability of his testimony.

- 4.3 As all the information Mr Hess was intended to provide relates to the legal implications of Mr Fischer's acts under Swiss law rather than Mr Fischer's constructive knowledge of any implications (on which Mr Hess would not be able to shed any light), such information is immaterial for the outcome of the case. For this reason the Board considered the testimony of Mr Hess unnecessary, and consequently it saw no reason to postpone the proceedings in order to have him heard.

- 4.4 As a result, the Board sees no reason to deviate from the findings of the Opposition Division having regard to the evaluation of the evidence regarding the prior use of the coffee-machine Jura Z5.
- 4.5 No other arguments having been raised by the appellant-proprietor against the decision's finding of lack of novelty of the patent as granted (Main Request in these proceedings) vis-à-vis the prior use of the coffee-machine Jura Z5, the Board sees no cogent reason to deviate from that finding, and therefore confirms the finding of the decision under appeal in this regard and holds the Main Request unallowable for lack of novelty.
5. It follows from this that the Main Request must be refused, and that the appellant proprietor's appeal must be dismissed.
6. Admission of new evidence or evidence not admitted by the Opposition Division
  - 6.1 Upon appeal, the appellant-opponent 1 filed new evidence E6.1, and also requested to admit documents D3 and D4, not admitted by the Opposition Division.
  - 6.2 The Board decided not to admit any of the above evidence on the basis of Article 12(4) RPBA 2007 for the following reasons:
    - 6.3 There is no apparent justification for the late filing of E6.1, which is cited against auxiliary request 1. Moreover, it does not appear to be *prima facie* highly relevant that according to E6.1 the brewing unit of the prior use machine Jura Z5 has a loading opening for supplying loose ground coffee. Claim 1 of auxiliary request 1, for which it is cited, is restricted in



scope to machines with brewing units for receiving capsules or pods, see point 7., below.

6.4 The appellant-opponent 1 does not make any submissions in appeal as to why D3 or D4 are relevant or more relevant to the claimed subject-matter than the other evidence on file.

7. First auxiliary request - Novelty

The appellant-opponent 1 in their written submissions argued lack of novelty of claim 1 over the prior use Jura Z5. As noted by the Board in its written communication, see point 9.1,

“Claim 1 requires, for the skilled person reading the claim synthetically and with a mind willing to understand, that the brewing unit of the claimed machine receives the complete capsule or pod, not only unpacked loose ground coffee contents from a capsule or a pod. It is otherwise common ground that the prior use machine Jura Z5 does not disclose a brewing unit for receiving a capsule or a pod. Claim 1 is thus new.”

The parties refrained from commenting after the Board's communication on this issue. Absent any further submission the Board sees no reason to change its point of view and holds that claim 1 of the auxiliary request 1 is new.

8. First auxiliary request - Inventive step

8.1 The appellant-opponent 1 contests the positive findings of the Opposition Division in respect of inventive step, see written decision section 2.2.2. They object

lack of inventive step starting from Jura Z5 or from D2.

8.2 As regards Jura Z5 as starting point for the assessment of inventive step, the appellant-opponent 1 merely referred during the oral proceedings to their written submissions. As noted in the Board's communication in this regard,

"[I]f the skilled person would choose the machine for brewing loose ground coffee Jura Z5 as starting point, it does not appear that they would then consider, as a matter of obviousness, redesigning it for capsules or pods, which is a machine of fundamentally different design, so that it would no longer be suitable for loose ground coffee", see communication point 9.3.

Absent any further submissions from the appellant-opponent 1 the Board sees no reason to change its point of view. It thus holds that the claimed subject-matter involves an inventive step starting from the prior use Jura Z5.

8.3 D2 is also regarded as a suitable starting point by the parties. This document describes a beverage preparation machine for coffee pods with a water pump 32 mounted on a dampener (structure 56, 58 made of vibration-dampening material) with a suspension device 62 for the pump, see abstract. It is common ground that the claimed machine differs from the known device of D2 in that the dampener comprises a helicoidal dampening spring.

8.3.1 The appellant-opponent 1 regards the claimed helicoidal dampening spring instead of the known holding devices of D2 merely as an alternative solution to the problem

of preventing or reducing the transmission of vibrations from the pump. They submit that the skilled person would therefore as a matter of obviousness replace the suspension arrangement of D2 by a helicoidal dampening spring as known from the prior art Jura Z5.

The Board is not convinced by this argument. In the present case the teaching of D2 is predicated on building the pump mounting as a hanging mount. As explained in page 2, line 34 to page 3, line 11 of D2, using holding devices that suspend the pump from above ensures a particularly long transmission path for vibrations and so effective vibration damping ("... die Pumpenhalterung [ist] zur hängenden Lagerung der Pumpe ausgebildet ... und eine Aufhängeeinrichtung aufweist, in der die Pumpe von oben aufgehängt ist,.... Auf diese Weise müssen die durch die Pumpe erzeugten Schwingungen einen langen Übertragungsweg zwischen der eigentlichen Pumpenaufhängung und den Befestigungspunkten zurücklegen, was das Dämpfungsverhalten der Anordnung begünstigt.")

In the Board's view, given the centrality of this idea of D2, the skilled person would not as a matter of obviousness consider departing from this central teaching of D2 by replacing the known long, hanging transmission path for vibration by the mounting spring of Jura Z5 supporting the pump from below and resting it directly on the machine bottom plate. The mounting concept of D2 is moreover associated with the benefit of allowing a simple machine assembly by stably pre-mounting the pump in horizontal position on the bottom plate before the bottom plate is attached to the housing, see page 3, lines 13-21. The vertically arranged pump of Jura Z5 (see e.g. drawing E3.1, pump

at 357) cannot be stably pre-mounted to the bottom plate. It is only vertically supported by spring 356 on the bottom plate. It needs a further attachment (360 in E3.1) at the top of the pump to another element of the machine housing. Additionally, there is no room in the machine of D2 for a vertical arrangement of the pump at the same location. A vertical positioning, if at all possible, would need a thorough redesign of the internal components arrangement. It would therefore also not occur to the skilled person as a matter of obviousness to implement the Jura Z5 vertical mounting arrangement simply as an alternative without obtaining a readily evident technical benefit, at the price of abandoning the simple assembly process of D2 and having to completely overhaul the internal design of the machine.

8.3.2 The appellant-opponent 1 also submitted that the prior use Jura Z5 provides improved damping, which would motivate the skilled person to replace the hanging arrangement of D2 by the Jura spring. However, the technical information in respect of Jura Z5 is only the presence of the spring 356 as depicted on drawing E3.1. There is no explanation whatsoever in E3.1 as to its function or the overall advantages of the mounting arrangement, let alone that it provides improved damping performance with respect to the long transmission path for vibration as offered by the hanging arrangement of D2. The Board is also not convinced that this would be common technical knowledge. Mr Fischer's declaration or testimony is of no avail here as it does not include any discussion of the relative advantages or disadvantages of one over the other. The appellant-opponent 1 has not put forward any other evidence in respect of common general knowledge. As regards the advantages of the vertical

orientation of the pump per se, while horizontal positioning of the pump may produce higher horizontal vibrations, as submitted by the appellant-opponent 1, vertical arrangements may produce higher vertical vibrations. Both are undesirable when transmitted to the machine or the drinking cup. It is in this respect not apparent to the Board that one arrangement might be advantageous or technically preferable over the other. Thus, on the basis of the evidence provided, the Board is not convinced that the skilled person would have been motivated to replace the hanging arrangement of D2 by the Jura Z5 spring as a matter of obviousness on the basis of obtaining improved damping.

- 8.4 In sum, all objections of the appellant-opponent 1 against the validity of the decision's findings in respect of inventive step of the first auxiliary request fail. The Board thus sees no reason to deviate from the conclusions of the Opposition Division on this issue. It confirms the decision's finding that the subject-matter of claim 1 of the first auxiliary request involves an inventive step.
9. The appellant opponent's appeal must therefore also be dismissed.
10. In view of the above outcome of the appeals, the request for a referral to the Enlarged Board of Appeal for the issue of admissibility of multiple independent claims and filed in relation of lower auxiliary requests including multiple independent claims becomes moot. The upheld request, auxiliary request 1, contains only one independent claim.

**Order**

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

**The appeals are dismissed.**

The Registrar:

The Chairman:



G. Magouliotis

A. de Vries

Decision electronically authenticated