Internal distribution code:

(A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [-] To Chairmen
(D) [X] No distribution

Datasheet for the decision of 14 December 2022

Case Number: T 1814/18 - 3.2.07

Application Number: 11157856.3

Publication Number: 2497612

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

Language of the proceedings: EN

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

Patent Proprietor:
Cama1 S.p.A.

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

Headword:

Relevant legal provisions:
EPC Art. 54(2), 111(1), 112(1)(a), 117(1)(e)
EPC R. 117
RPBA 2020 Art. 12(3), 12(5), 13(2), 11

Keyword:

Novelty - main request (no) - auxiliary request (no) - public prior use - implicit obligation to maintain secrecy (no)
Remittal to the department of first instance
Remittal - (no)
Taking of evidence - decision on taking of evidence - expert opinion
Referral to the Enlarged Board of Appeal - (no)
Reply to statement of grounds of appeal - party's complete appeal case
Late-filed argument - amendments after arrangement of oral proceedings

Decisions cited:

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1814/18 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 14 December 2022

Appellant: (Patent Proprietor)	Cama1 S.p.A. Via Vittor Pisani 12/A 20124 Milano (IT)
Representative:	M. Zardi & Co S.A. Via G. B. Pioda, 6 6900 Lugano (CH)
Appellant: (Opponent)	I.M.A. INDUSTRIA MACCHINE AUTOMATICHE SpA Via Emilia, 428-442 40064 Ozzano dell 'Emilia (BO) (IT)
Representative:	Modiano, Micaela Nadia Modiano & Partners Via Meravigli, 16 20123 Milano (IT)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 7 May 2018 concerning maintenance of the European Patent No. 2497612 in amended form.**

Composition of the Board:

Chairman	I. Beckedorf
Members:	V. Bevilacqua
	A. Beckman
	A. Pieracci
	C. Brandt

Summary of Facts and Submissions

I. The patent proprietor and the opponent each lodged an appeal in the prescribed form and within the prescribed time limit against the interlocutory decision of the opposition division maintaining European patent EP 2 497 612 in amended form.

II. The present decision refers to the following documents mentioned in the appealed decision:

Patent documents

D4: JP 11-254367 (with translation)

Evidence related to the "Caffitaly" prior uses submitted during opposition proceedings

by the opponent

D1e: Declaration by Mr. Grassilli (with translation)
D1r: Share certificate dated August 2, 2010

by the patent proprietor

D1g: Letter from Gima SpA to Caffita System SpA
D1h: Reply from Caffita System SpA to Gima SpA
D1k: Extract from offer 2106-09 (with translation)
D1m: Purchase order (with translation)

The present decision also refers to the following documents related to the Caffitaly prior uses submitted by the patent proprietor during appeal proceedings, after notification of a summons to oral proceedings:

D1s: decision in national litigation proceedings involving the patent in suit, with translation;

D1t: notice of appeal filed before the Italian Supreme Court against D1s, with translation;

D1k_full: document from which D1k was allegedly extracted, with translation.

D1u: Legal opinion drafted by L. B. Dittrich.

III. The patent proprietor initially requested

that the appealed decision be set aside and that the patent be maintained as granted (main request),

or alternatively, that the appeal of the opponent be dismissed, *i.e.* that the patent be maintained in the amended form held by the opposition division to meet the requirements of the EPC (auxiliary request 1 filed during the oral proceedings in opposition proceedings),

or, as a further alternative, that the patent be maintained in amended form on the basis of one of auxiliary requests 1 to 6 submitted during opposition proceedings with letter dated 6 December 2017.

Should the allegation of prior use "Caffitaly" be considered as prior art, the patent proprietor additionally requested that the case be remitted to the opposition division for further prosecution.

The opponent initially requested

that the appealed decision be set aside and
that the patent be revoked in its entirety.

IV. In preparation for oral proceedings the Board communicated its preliminary assessment of the case by a communication pursuant to Article 15(1) RPBA 2020.

V. With letter dated 15 June 2022 the patent proprietor submitted further arguments and further documents related to national litigation proceedings involving the patent in suit (D1s, D1t).

VI. With letter dated 1 September 2022 the patent proprietor submitted further evidence (D1k_full) related to the allegation of public prior use "Caffitaly".

VII. With letter of 2 December 2022 the opponent requested not to admit these late filed documents.

VIII. With letter dated 9 December 2022 the patent proprietor submitted arguments together with a further document (D1u) again related to national litigation proceedings and requested to refer a question submitted with this letter to the Enlarged Board of Appeal and to commission an independent expert on Italian law (Article 117(1)(e) EPC).

IX. Oral proceedings were held on 14 December 2022. The factual and legal situation was discussed with the parties. For further details of the course of the oral proceedings, reference is made to the minutes thereof.

During oral proceedings the patent proprietor withdrew auxiliary request 1 submitted during opposition proceedings with letter dated 6 December 2017.

The final requests of the parties were as follows:

for the patent proprietor

that the appealed decision be set aside and
that the patent be maintained as granted (main request),

or alternatively,
that the appeal of the opponent be dismissed, *i.e.* that the patent be maintained in amended form held by the opposition division to meet the requirements of the EPC (auxiliary request 1 filed during the oral proceedings in opposition proceedings),

or, as a further alternative,
that the patent be maintained in amended form on the basis of one of auxiliary requests 2 to 6 filed with letter dated 6 December 2017.

Should the allegation of prior use "Caffitaly" be considered as prior art, the patent proprietor additionally requested

that the case be remitted to the opposition division for further prosecution.

The patent proprietor additionally also requested

that the question submitted with its letter dated 9 December 2022 be referred to the Enlarged Board of Appeal and

that an independent expert on Italian law be commissioned (Article 117(1)e)EPC);

for the opponent

that the decision under appeal be set aside and that the patent be revoked.

X. Claim 1 of the main request (as granted) reads as follows:

"Gripping head (4) for a loading robot or manipulator of a cartoning machine, the gripping head comprising a plurality of gripping members (400) arranged in at least one longitudinal row of said gripping head, characterised in that each of said gripping members comprises a gripping section (420) adapted to receive two adjacent articles and on opposite sides with respect to a centreline plane of the gripping section, and in that at least one subset of said gripping members are rotatable by at least 180 degrees around an axis (Z) parallel to said plane, said subset comprising at least the gripping members in even index position or in odd index position in said longitudinal row of gripping members."

Claim 1 as maintained according to the appealed decision reads as follows:

"Gripping head (4) for a loading robot or manipulator of a cartoning machine, the gripping head comprising a plurality of gripping members (400) arranged in at least one longitudinal row of said gripping head, wherein each of said gripping members comprises a gripping section (420) adapted to receive two adjacent articles and on opposite sides with respect to a

centreline plane of the gripping section, and wherein at least one subset of said gripping members are rotatable by at least 180 degrees around an axis (Z) parallel to said plane, said subset comprising at least the gripping members in even index position or in odd index position in said longitudinal row of gripping members,
characterised in that said plurality of gripping members comprises tiltable gripping members (404) which can be inclined with respect to a main framework (403) of the head to increase a space of distance between centres in the longitudinal direction between adjoining gripping members."

The text of claim 1 of auxiliary requests 2 to 6 is not repeated here because the present decision is based in this respect on procedural grounds only.

XI. The lines of argument of the parties are dealt with in detail in the reasons for the decision.

Reasons for the Decision

1. *Revised Rules of Procedure of the Boards of Appeal (RPBA 2020) - transitional provisions*

The present proceedings are governed by the revised version of the Rules of Procedure which came into force on 1 January 2020 (Articles 24 and 25(1) RPBA 2020), except for Article 12(4) to (6) RPBA 2020 instead of which Article 12(4) RPBA 2007 remains applicable (Article 25(2) RPBA 2020).

Appeal of the patent proprietor

2. Main request - Lack of novelty

2.1 The grounds for not acknowledging novelty of the subject-matter of claim 1 of the main request over the content of the disclosure of document D4 are given under point 3.3.2 of the reasons for the appealed decision.

2.2 According to the patent proprietor, the analysis of the opposition division was not correct, as none of the features of the characterizing portion of claim 1 of the main request is disclosed in this document (see in particular page 3 of the statement of grounds of appeal). The opposition division did not take account of the fact that the gripping head disclosed in D4 is specifically designed for gripping bottles.

2.2.1 The feature that each of the gripping members comprises a gripping section adapted to receive two adjacent articles was not derivable from D4, so the patent proprietor, because D4 disclosed a retaining member including two suction cups, which was specifically designed to process one bottle for each working cycle (see figure 5 of D4).

A skilled reader would also not find in the text of D4 any indication that each suction cap would be adapted to receive and hold a separate article.

A skilled person had no reason to assume that the device of D4 was adapted to receive two generic articles, instead of one bottle (patent proprietor's letter of 15 June 2022, page 2).

Having this in mind a skilled person would not see in D4 the disclosure of a gripping member comprising a gripping section adapted to receive two adjacent articles.

2.2.2 The opposition division also wrongly concluded that the feature that at least one subset of said gripping members are rotatable by at least 180 degrees around an axis (Z) parallel to the centreline plane of the gripping section was implicit in D4.

A skilled reader would have construed D4 as disclosing that the rotation is only performed to reach the target orientation in the most efficient way, e.g. minimizing the required rotation angle, which would therefore always be below 180 degrees.

2.2.3 Also the feature that the rotatable gripping members (the subset) comprised at least the gripping members in even index position or in odd index position in the longitudinal row of gripping members was not derivable from D4, according to the patent proprietor.
This was because D4 did not mention a selective rotation of even or odd gripping members at all, but rather disclosed that each gripping member is rotatable, in order to reach the correct orientation.

A skilled reader would therefore not see in D4 an indication that only the gripping members in the even or odd positions were rotatable, and would understand from claim 1 that "at least one subset of said gripping members are rotatable" means that all gripping members of the subset can rotate while the other gripping members do not (patent proprietor's letter of 15 June 2022, page 2, lines 5-18).

2.3 The Board is not convinced by the above arguments that the lack of novelty assessment at point 3.3.2 of the appealed decision is not correct.

2.3.1 The patent proprietor has not convincingly demonstrated that the gripping members of D4 comprised a gripping section which was not adapted to receive two adjacent articles.

This is because this party argued that the gripping members of D4 were specifically designed to process a single bottle for each working cycle, e.g. to **firmly hold** only one container, but failed to provide any explanation as to why a skilled reader would derive from this configuration a lack of suitability to **receive** two (smaller and) adjacent articles, in spite of the fact that the gripping section disclosed in this document comprises two separate suction elements, as shown in figure 5 of this document.

The feature "adapted to receive two adjacent articles" is therefore derivable from D4.

2.3.2 The feature that at least one subset of said gripping members are rotatable by at least 180 degrees around an axis (Z) parallel to said plane, is also known from D4.

This is because, to perform an efficient rotation of less of 180° to reach the target orientation, as argued by the patent proprietor, the capability of performing a rotation in both directions is necessary, and such capability is clearly derivable from the arrows in figure 3 of D4.

2.3.3 Also the feature that the rotatable gripping members (the subset) comprise at least the gripping members in

even index position or in odd index position in the longitudinal row of gripping members is disclosed in D4.

This is because all gripping members of D4 are rotatable, and the Board sees no reason, on the basis of the claim formulation and of the arguments submitted by the patent proprietor, to interpret claim 1 as being restricted to a selective rotation of only even or only odd gripping members, and to exclude embodiments in which even and odd gripping members are all rotatable.

2.4 The patent proprietor therefore did not convincingly demonstrate that the opposition division wrongly assessed the content of the disclosure of document D4 and that the decision of the opposition division not to allow the main request because of lack of novelty over D4 was not correct.

As a consequence of the above, the appeal of the patent proprietor is dismissed.

Appeal of the opponent - maintained version

3. Visit to Caffitaly

3.1 Both parties agree that Mr. Grassilli inspected a machine supplied by the patent proprietor during a visit to Caffitaly before the filing date of the patent in suit.

The circumstances of this visit as well as a description of the inspected machine are given in the written declaration (D1e) of Mr. Grassilli.

3.2 The opposition division decided, after having heard Mr. Grassilli as a witness, that the above mentioned inspection did not amount to a disclosure of the inspected machine because the circumstances of the inspection implied the existence of an obligation to maintain secrecy.

This was because there was evidence on file showing that at the moment of the inspection the employer of Mr. Grassilli and present opponent (IMA) controlled GIMA (the former opponent), as it owned the majority (65%) of the shares thereof (see D1r).

Mr. Grassilli, being an IMA employee at that time, was therefore allowed to inspect the machine because he worked for the parent company of GIMA, and fully replaced GIMA for the purposes of the applicability of the confidentiality agreement (D1m) stipulated between GIMA and Caffitaly (appealed decision, page 5, second paragraph).

Mr. Grassilli, during the inspection, acted in the best interests of GIMA and IMA, which was to keep the observed technical information confidential (appealed decision, page 6, second paragraph).

As a consequence of the above, as Mr. Grassilli could not be considered as a member of the public, it was not sufficiently proven that the details of the inspected machine mentioned in D1e belonged to the state of the art (appealed decision, page 6, third sentence).

3.3 The opponent contests the appealed decision substantially arguing that the opposition division was wrong when it concluded Mr. Grassilli did not inspect the machine as a member of the public because of the

relationship between his employer (IMA) and GIMA (statement of grounds of appeal, point III.1.2).

This was because the oral testimony of Mr. Grassilli, which was considered convincing by the opposition division, confirmed that at the time of the inspection the former opponent (GIMA) was a competitor of his employer (IMA).

Thus, the non-disclosure agreement contained in D1m was not binding on Mr. Grassilli.

The opposition division therefore also wrongly concluded that it was not sufficiently proven that the details of the inspected machine were disclosed to the public during the inspection.

3.4 The patent proprietor fully supported the conclusions of the opposition division arguing as follows.

3.4.1 As there was a non-disclosure agreement binding GIMA (D1m), clearly the same confidentiality obligations applied to Mr. Grassilli, because IMA and GIMA belonged to the same corporate group, and therefore were pursuing the same interests.

D1s and D1t (see also D1u and the last letter of the patent proprietor, dated 9 December 2022) showed that a final decision in national litigation proceedings involving the patent in suit confirmed that the extent of the non-disclosure agreement contained in the contractual document D1m, by explicitly referring to any kind of technical information provided by Caffitaly to the opponent, clearly encompassed the whole production line into which the machine sold by GIMA was integrated, and therefore also to the inspected

machine, which was delivered by the patent proprietor (letter of 15 June 2022, page 6, lines 10-18).

Considering that GIMA signed a contract to supply Caffitaly with packaging machines (D1m) and that IMA was the majority shareholder of GIMA (D1r) the national court finally established that the inspection of Mr. Grassilli was aimed at enabling IMA to check the operation of the packaging line comprising the machines supplied by GIMA, and that this was the context in which Mr. Grassilli also saw the allegedly novelty destroying machine, which was included in the same packaging line (see page 8, lines 9-13, of the letter of 15 June 2022, referring to D1s, pages 19 and 20 of the translation).

On the basis of the above circumstances, the national court decided that compliance with the rules of the business relationship between Caffitaly and GIMA, including confidentiality obligations, was an implied condition of Mr. Grassilli's access to Caffitaly, also because it was in IMA's interest that these obligations not be breached, with possible consequences for it, as the party acquiring GIMA.

3.4.2 The testimony of Mr. Grassilli (see the minutes of the taking of evidence recorded during the oral proceedings before the opposition division) was not part of the evidence available before the national court, but also supports the above conclusions (letter of the patent proprietor dated 9 December 2022, point 2.3.3):

This is because Mr. Grassilli confirmed that GIMA had been a former competitor of IMA, but at the time of the visit competition was limited to the field of

confectionary products (minutes of the taking of evidence, page 4).

On the contrary, GIMA and IMA worked closely together in the technical field of the patent in suit, as evident from the declaration that it had already been decided, before the inspection ("at that time", page 14, fifth paragraph, of the minutes of the taking of evidence), how the business had to be distributed between these two companies now belonging to the same corporate group.

Mr. Grassilli also confirmed that at the time of the inspection he was aware that the merger of GIMA and IMA was ongoing (page 7), and also Caffitaly was (page 8), such that it was clear to everybody that he was visiting also in GIMA's best interest (pages 8, 14).

3.4.3 The circumstances of the present case also show that there was also a general implicit confidentiality obligation binding all the parties involved in the delivery and subsequent inspection of the allegedly novelty destroying machine, including IMA (patent proprietor's letter of 15 June 2022, page 9, lines 3 to 8).

This is because the machinery suppliers involved in the production line in which the inspected machine was integrated signed respective agreements with Caffitaly (see the clause VII.8 of D1k and D1k_full, stipulated between the patent proprietor and Caffitaly and clause 8 at page 9 of D1m, stipulated between the opponent and Caffitaly).

The presence of at least an implicit confidentiality obligation binding all the involved parties, and

therefore also Mr. Grassilli, is also apparent from the negative reply of Caffitaly (D1h) to the opponent's request to send technical documentation (D1g).

3.4.4 The patent proprietor then also argued as follows (letters of 9 December 2022 and of 15 June 2022).

The Board ought to accept as *res judicata the* final decision reached in national litigation proceedings on the non-public availability of the "Caffitaly" prior use (D1s, page 20), based on the assessed originality of document D1k as well as on the scope and nature of the confidentiality agreements contained therein and in D1m, with the result that the "Caffitaly" prior use is not comprised in the state of the art.

This is because there is nothing in the EPC to confer jurisdiction on the Boards to determine that the extent of the contractual obligations stipulated in a contract governed by the law of a contracting state are different from those already determined when the court system of that contracting state has issued a final decision on this contract, while most contracting states to the EPC follow the principle of mutual recognition of final court decisions (EPC Regulation 44/2001, Lugano Convention).

3.5 The Board disagrees.

3.5.1 The present decision, favorable to the opponent, has been taken assuming that documents D1k, D1k_full and D1m are existent, genuine and reliable, and therefore without discussing the doubts of the opponent in that respect, and the counter-arguments of the patent proprietor (see in particular the patent proprietor's letter dated 15 June 2022, starting from page 3, line

12, their letter of 1 September 2022 and point i at page 6 of their letter dated 9 December 2022).

3.5.2 However, even assuming that D1k, D1k_full and D1m are original, still there is no evidence on file of the existence of a non-disclosure agreement directly involving IMA at the time of the inspection because the non-disclosure agreement contained in D1m was signed by GIMA and Caffitaly, and the non-disclosure agreement contained in D1k (and D1k_full) was signed by the patent proprietor and Caffitaly.

Mr. Grassilli was therefore not directly bound by these contractual obligations, irrespective of the extent thereof ("general nature" see the patent proprietor's letter of 9 December 2022, point b at page 6), and of the question whether they extended to the inspected machine or not.

Document D1r, to which the patent proprietor also refers to argue the substantial unity of IMA and GIMA for the purpose of the application of these non-disclosure agreements, only shows that IMA owned 65% of the shares of GIMA.
D1r also cannot prove that a non-disclosure agreement similar to the one contained in D1m was acting upon Mr. Grassilli, simply because it does not contain any information in this regard.

This is because, as also acknowledged by the patent proprietor during oral proceedings, the transfer to IMA of the totality of the opponent's business assets was only finalized after the inspection, and there is nothing in D1r supporting the patent proprietor's allegation that when IMA acquired a controlling

majority of the shares of GIMA (65%, see D1r), also these specific secrecy obligations were taken over.

3.5.3 On the contrary, D1r shows that at the moment of the visit the two companies IMA and GIMA existed in parallel, as two distinct legal persons.

3.5.4 Also the testimony of Mr. Grassilli contradicts the conclusions of the opposition division, that he was bound to secrecy, having visited Caffitaly in "GIMA's best interest". On the contrary, the testimony confirms what was alleged in the notice of opposition, namely that Mr. Grassilli was a member of the public.

This is because the witness explicitly confirmed that he was not aware of any confidentiality obligation during the inspection (page 8, second paragraph of the minutes of the taking of evidence), and that at that time GIMA was a competitor of IMA (see page 4, the last paragraph at page 5).

Mr. Grassilli openly declared that he and Caffitaly were aware of IMA's interest in acquiring GIMA, but also that the process was not yet concluded (see page 11).

There is no passage, in the minutes of the hearing of Mr. Grassilli, from which it could be directly inferred that already at that stage, only because IMA started a process to incorporate GIMA, the best interests of the two companies already converged (see in particular the only question asked by the patent proprietor, and the reply thereto, at page 21).

As a consequence of the above, the assumption of the opposition division that Mr. Grassilli was visiting

Caffitaly in GIMA's best interest (pages 6, first to third paragraph) is not supported by what the witness declared.

3.5.5 Based on the above, the opponent convincingly demonstrated that the assumption, at the basis of the appealed decision, that Mr. Grassilli was not a member of the public, is unjustified.

As a consequence of the above, the opponent also convincingly demonstrated that the inspected machine (see D1e) was made available to the public, and is therefore prior art.

3.5.6 The counter-arguments of the patent proprietor in relation to the testimony of Mr. Grassilli are not convincing, for the following reasons.

That the competition between GIMA and IMA was not limited to confectionary products, but extended to the field of the patent in suit is evident from the declaration of the witness that IMA lost the Caffitaly tender to GIMA (see, the third paragraph at page 6, of the minutes of the taking of evidence).

Mr Grassilli explicitly declared (page 7, second paragraph) that, as GIMA's end of line machine was better than IMA's, after the acquisition the decision was taken that GIMA would have developed the end of line machines for IMA.

Therefore, the interpretation of the patent proprietor of the expression "at that time" used at page 14, fifth paragraph, as "before the visit", meaning that the business had been distributed between the former competitors IMA and GIMA already before the visit,

would contradict what Mr. Grassilli explicitly declared.

The patent proprietor then also failed to indicate any passage of the minutes of the witness declaration supporting its allegation that compliance with the rules of the business relationship between Caffitaly and GIMA, including confidentiality obligations, was a condition of Mr. Grassilli's access to Caffitaly.

The patent proprietor's allegation that it was in IMA's interest, being the party acquiring GIMA, that GIMA did not breach the confidentiality obligations signed with Caffitaly, to avoid legal consequences, even if confirmed, is not relevant for the present decision.

This is because it was not GIMA, but Caffitaly, who gave access to the patent proprietor's machine to Mr. Grassilli.

It is therefore not apparent, on the basis of the circumstances of the inspection, which did not involve GIMA, but IMA and Caffitaly, how GIMA could have been considered responsible of breaching the non-disclosure agreement signed with Caffitaly through an act of a third person, Mr. Grassilli, upon which GIMA had no control.

3.5.7 The patent proprietor's allegation that there was a general implicit confidentiality obligation binding all the parties involved with Caffitaly, and therefore also Mr. Grassilli, is also not convincing, not being supported by the evidence on file.

This is because, as discussed above, the patent proprietor did not provide any evidence of any

agreement specifically binding Mr. Grassilli or its employer.

The negative reply of Caffitaly (D1h) to GIMA's request to send technical documentation (D1g) only confirms what was already evident from D1k and D1k_full, namely that Caffitaly signed a non-disclosure agreement with the patent proprietor.

3.5.8 As already discussed, IMA was not a party to D1k and D1k_full, and therefore the arguments of the patent proprietor on the extent of the contractual obligations stipulated therein are not relevant for assessing the position of Mr. Grassilli.

This lack of relevance is also evident because D1k (and therefore also D1k_full) has been submitted by the patent proprietor to show that the sale of the allegedly disclosed machine was made under secrecy and does not therefore relate, together with the subsequent debate between the parties on the originality thereof, to the issue whether Mr. Grassilli was a member of the public or not.

This is also reflected in the statement of grounds of appeal of the opponent, clearly distinguishing between the "sale", point III.1.1, and the "visit", point III. 1.2, and in patent proprietor's replies thereto, where the disclosure through "sale" was contested with a specific reference to D1k (see page 4, last paragraph, page 7, lines 7 to 10, page 9, starting from line 15).

D1k is never mentioned in the context of the patent proprietor's "visit" discussion (see the reply to the statement setting out the grounds of appeal of the opponent, from page 10, line 11, to page 13, line 20).

3.5.9 The extent of the contractual obligations stipulated in D1m is also not relevant for the above discussion, simply because neither Mr. Grassilli nor IMA appear as parties in this contractual document.

This has also been acknowledged by the patent proprietor who did not argue that Mr. Grassilli was directly bound to secrecy through D1m, but rather (letter of 15 June 2022 point 5, page 7) that compliance with the rules of the business relationship between Caffitaly and GIMA, including confidentiality obligations, was an implied condition of Mr. Grassilli's access to Caffitaly, because the interests of IMA and GIMA already converged at that time (see point 3.5.3 above for a discussion of this argument of the patent proprietor).

3.5.10 Document D1u, together with the arguments submitted in the last letter of the patent proprietor (dated 9 December 2022) are not convincing in relation to the specific issue discussed above, which is whether Mr. Grassilli was a member of the public or not.

Based on D1u, the patent proprietor argued that considering the prior use as prior art would be in unlawful conflict with the findings in D1s, which being a final national decision on that matter, is binding on the Board.

D1u is an analysis of documents D1s and D1t, drafted by an expert in Italian law, discussing which parts of judgement D1s had not ben appealed (D1t) and should be considered as *res judicata*.

The Board disagrees, because the present decision is based on Mr. Grassilli's testimony before the opposition division (see points 3.5.3 and 3.5.5 above).

As acknowledged by the patent proprietor, the present proceedings and those which led to D1s involve the same matter and the same evidence,

"the sole difference in evidence being Mr. Grassilli's testimony before the Opposition Division" (letter of 9 December 2022, page 5, fourth paragraph).

That a testimony of Mr.Grassilli may have potentially changed the course of proceedings in D1s is shown by the request of the appealing party in D1t (see the conclusions, at page 44 of the translation), which is to set aside the complete appealed decision (D1s) because there was a failure to admit decisive witnesses' evidence (from Mr. Grassilli) on the question whether he was a member of the public or not (see also point I of the Reasons).

The above shows that the evidence at the basis of the present proceedings is substantially **different** from the evidence upon which D1s was taken.

Based on the above, 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.

4. Request for remittal

4.1 The patent proprietor requested, should the allegation of prior use "Caffitaly" be considered as prior art,

that the case be remitted to the opposition division. This procedural request takes precedence over a decision on novelty of the claimed subject-matter.

4.2 According to Article 11, first sentence, RPBA 2020, a remittal for further prosecution should only be undertaken, exceptionally, when special reasons apply.

The patent proprietor argues that in the present case remittal would be equitable as the situation was similar to that of new prior art admitted during the appeal proceedings (page 13 of the reply to the appeal of the opponent, last paragraph).

The Board, however, follows the arguments of the opponent according to which no special reasons are apparent, justifying a remittal, from the above justification of the patent proprietor.

This is because no similarity is apparent to the Board between the present situation and a situation in which new prior art is admitted during appeal proceedings, due to the fact that the "Caffitaly" prior use acknowledged as prior art was not introduced in appeal, but first mentioned in the notice of opposition (see point III.1.1), to question of the patentability of the granted claims.

Consequently, the Board decides that it is not appropriate to remit the present case to the opposition division for further prosecution, in accordance with Article 111(1) EPC.

5. Request for a decision on taking of evidence

5.1 The patent proprietor also requested that a decision on taking of evidence (Article 117(2) EPC, Rule 117 EPC) is issued to commission an expert on Italian law on the questions and issues already discussed in D1u (letter of 9 December 2022, page 8, fourth paragraph). Like the preceding procedural request for remittal, the request for the taking of evidence takes precedence over a decision on novelty of the claimed subject-matter.

5.2 The Board decides not to allow the above request. This is because the Board has already examined the arguments submitted with D1u, and found that they are not convincing (see point 3.5.9 above), and the patent proprietor has not explained how a second expert opinion on the same issues could change the fact that the evidence at the basis of the present proceedings is substantially different from the evidence upon which D1s was taken.

6. Request for referral to the Enlarged Board of Appeal

6.1 The patent proprietor also requested that the following question be referred to the Enlarged Board of Appeal (letter of 9 December 2022, last page):

"Does the EPC confer jurisdiction on the EPO to determine the existence of a contract governed by the law of a Contracting State, and the extent of the contractual obligations, if any, if the court system of that Contracting State has already issued a final decision on this existence and this extent?"

Like the two preceding procedural requests, the request for referral takes precedence over a decision on novelty of the claimed subject-matter.

6.2 The Board decides not to allow the above request.

Under Article 112(1)(a) EPC a Board of Appeal shall refer a question to the Enlarged Board of Appeal if it considers that a decision is required.

No answer to the proposed question is required to decide the case at hand because, as already discussed, the finding that Mr Grassilli was a member of the public, with the consequence that the prior use belongs to the prior art, has been taken on the basis of the testimony of Mr. Grassilli before opposition division, without discussing issues related to the non-existence of the contractual documents supplied by the patent proprietor (D1k, D1k_full, D1m, see point 3.5.1 above), and without assessing the extent of the obligations stipulated therein (see points 3.5.7 and 3.5.8 above).

7. Novelty, claim 1 as maintained

7.1 The opponent argued that claim 1 of the amended version of the patent, deemed allowable by the opposition division, lacks novelty over the machine described in D1e, which was made available to the public through the visit of Mr. Grassilli to the premises of Caffitaly.

7.2 The Board notes that the patent proprietor failed to contest the above objection in appeal and to identify any specific distinguishing feature of the claimed subject-matter (see in particular page 14, lines 1 to 8, of the reply to the appeal of the opponent).

In fact, the patent proprietor defended the patent in suit, as maintained according to the appealed decision, only arguing that the alleged prior use was not prior art, and never contested, during opposition proceedings and appeal proceedings, that the inspected machine had the structural features mentioned by Mr Grassilli in its written declaration (D1e) and during his hearing as a witness (minutes of the taking of evidence, pages 9 to 13).

The patent proprietor also never contested that the inspected machine was novelty-destroying for the subject-matter of claim 1 as maintained.

In view of the above, and taking into account that all the features of claim 1 are effectively mentioned in D1e, points d-h, the Board concludes that the opponent has convincingly shown that the subject-matter of claim 1 as maintained according to the appealed decision (auxiliary request 1) lacks novelty.

Thus, the decision under appeal cannot be upheld.

8. Auxiliary requests 2 to 6 - admittance

8.1 Auxiliary requests 2 to 6 have been first submitted before the opposition division with letter of 6 December 2017.

In this letter the patent proprietor indicated, referring to the granted dependent claims, the basis for the amendments contained in these requests, but gave no explanation on how and why these amendments result in patentable subject-matter.

The opponent, in its statement setting out the grounds of appeal, objected to the subject-matter of the dependent claims upon which these auxiliary requests are based (see pages 9 to 11).

The patent proprietor, in its reply thereto, requested the maintenance of the patent in amended form according to these auxiliary requests, but failed to substantiate them, or to comment on the opponent's objections.

It is only with the letter of 15 June 2022 (see from page 10, line 17), after notification of a summons to oral proceedings, that the patent proprietor submitted arguments explaining why auxiliary requests 2 to 6 are patentable.

In this letter the patent proprietor however failed to provide any explanation as to the admissibility of these arguments.

8.2 During oral proceedings, faced with admissibility objections raised by the opponent, the patent proprietor argued as follows.

8.2.1 There was no obligation to substantiate auxiliary requests 2 to 6 when these were filed with the reply to the statement setting out the grounds of appeal of the opponent, because these requests had already been submitted before the opposition division.

8.2.2 There was also no subsequent obligation to do that, because these requests are self-explanatory, as shown from the fact that the opponent failed to submit substantiated objections specifically formulated against them.

8.2.3 In case that these auxiliary requests were not be considered as self explanatory, there are exceptional circumstances justifying the admission of the substantiation filed after notification of a summons to oral proceedings.

This is because, in view of the national decision (D1s) confirming the findings of the opposition division, the Board's decision to set aside the appealed decision and to consider the "Caffitaly" prior use as prior art was surprising and unexpected.

8.3 The Board is not convinced by the above arguments.

8.3.1 The Board disagrees with the patent proprietor's position that there was no obligation to substantiate auxiliary requests 2 to 6 when these were filed with the reply to the statement setting out the grounds of appeal of the opponent, simply because these requests had already been submitted before the opposition division.

Under Article 12(3) RPBA 2020 the statement of grounds of appeal and the reply to the statement of grounds of the opponent should have contained the patent proprietor's complete case, setting out clearly **the reasons** why it is requested that the decision under appeal be reversed, amended or upheld, also specifying expressly all the facts, arguments and evidence relied on.

The purpose of such a provision is to ensure fair proceedings for all parties and to enable the Board to start working on the case on the basis of each party's complete submissions.

Submitting auxiliary requests without any substantiation clearly goes against these requirements.

8.3.2 Contrary to what has been argued by the patent proprietor, auxiliary requests 2 to 6 are not self-explanatory, as shown from the fact that the opponent raised patentability objections against the subject-matter of the dependent claims upon which these auxiliary requests are based (see pages 9 to 11 of the statement setting out the grounds of appeal).

8.3.3 The circumstances put forward by the patent proprietor to justify the admission of the patentability arguments filed with letter of 15 June 2022, after notification of a summons to oral proceedings, in support of auxiliary requests 2 to 6 are not exceptional.

The Board's decision to set aside the appealed decision and to consider the "Caffitaly" prior use as prior art was taken on the basis of arguments submitted in the statement setting out the grounds of appeal of the opponent (see in particular point III.1.2 thereof).

That a Board might ultimately be convinced by a party's case is not a new – and still less unexpected – development in the proceedings, but rather a foreseeable possibility.

According to Article 13(2) RPBA 2020, any amendment to a part's appeal case made after notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

Based on the above the Board decides not to admit the late filed substantiation of the auxiliary requests.

8.3.4 Under Article 12(5) RPBA 2020, the Board has discretion not to admit any part of a submission on appeal which is not complete within the meaning of Article 12(3) RPBA 2020.

As discussed above, the case of the patent proprietor linked to auxiliary requests 2 to 6, not having been substantiated in an admissible way, is to be considered as not complete.

As the above outlined procedural conduct of the patent proprietor, fleshing out an incomplete case at a later stage, is not in line with the requirements set out in Article 12(3) RPBA 2022, the Board decides not to admit auxiliary requests 2 to 6 into appeal proceedings (Article 12(5) RPBA).

9. Conclusions

The patent proprietor has failed to convince the Board of the incorrectness of the reasoned findings of the opposition division in the decision under appeal that the subject-matter of claim 1 of the patent as granted lacks novelty over the disclosure of D4.
While the patent proprietor's procedural requests for remittal of the case to the opposition division for further prosecution, for the taking of evidence and for a referral to the Enlarged Board of Appeal were not allowed, the opponent has convincingly demonstrated the incorrectness of the reasoned findings of the opposition division in the decision under appeal concerning the public prior use. Rather, the opponent has convincingly shown that the inspected machine (D1e)

was made available to the public, and is therefore prior art in respect of which the subject-matter of claim 1 of the patent as maintained by the opposition division lacks novelty.
Because auxiliary requests 2 to 6 were not admitted into the proceedings for lack of substantiation, there is no admissible and allowable request on the basis of which the patent could be maintained.

Order

For these reasons it is decided that:

1. The appeal of the patent proprietor is dismissed.

2. The request for a referral of a question to the Enlarged Board of Appeal is refused.

3. The request to commission an independent expert on Italian law (Article 117(1)(e) EPC) is refused.

4. The decision under appeal is set aside.

5. The patent is revoked.

The Registrar: The Chairman:

G. Nachtigall I. Beckedorf

Decision electronically authenticated