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**Datasheet for the decision  
of 14 December 2022**

**Case 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 invention:**

Machine and method for cartoning articles

**Patent Proprietor:**

CAMA 1 SpA

**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. 11, 12(3), 12(5), 13(2)

**Keyword:**

Novelty - main request (no) - public prior use - implicit  
obligation to maintain secrecy (no)  
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:**



**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 1841/18 - 3.2.07

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

**Appellant:** I.M.A. INDUSTRIA MACCHINE AUTOMATICHE SpA  
(Opponent) Via Emilia, 428-442  
40064 Ozzano dell 'Emilia (BO) (IT)

**Representative:** Modiano, Micaela Nadia  
Modiano & Partners  
Via Meravigli, 16  
20123 Milano (IT)

**Respondent:** CAMA 1 SpA  
(Patent Proprietor) Via Vittor Pisani, 12/A  
20124 Milano (IT)

**Representative:** M. Zardi & Co S.A.  
Via G. B. Pioda, 6  
6900 Lugano (CH)

**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 1 June 2018  
rejecting the opposition filed against European  
patent No. 2500151 pursuant to Article 101(2)  
EPC.**

**Composition of the Board:**

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

## **Summary of Facts and Submissions**

I. The opponent lodged an appeal in the prescribed form and within the prescribed time limit against the decision of the opposition division rejecting the opposition filed against European patent EP 2 500 151.

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

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

*by the opponent*

Dld: Declaration by Mr. Grassilli (with translation)

Dlr: Share certificate dated August 2, 2010

*by the patent proprietor*

Dlg: Letter from Gima (with translation)

Dlh: Letter from Caffita System SpA (with translation)

Dlk: Extract from offer 2106-09 (with translation)

Dlm: 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:

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

Dlt: notice of appeal filed before the Italian Supreme Court against Dls, with translation;

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

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

III. The opponent initially requested

that the appealed decision be set aside and that the patent be revoked.

The patent proprietor initially requested

that the appeal of the opponent be dismissed, or, alternatively, when setting aside the decision under appeal, that the patent be maintained in amended form on the basis of one of auxiliary requests 1 to 5 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.

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. The patent proprietor first replied with letter dated 27 June 2022.

VI. With letter dated 7 September 2022 the patent proprietor submitted further arguments and further

documents related to national litigation proceedings involving the patent in suit (D1s, D1t) and to the allegation of prior use "Caffitaly" (D1k\_full).

- 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 additionally 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.

At the end of oral proceedings both parties confirmed their previously submitted requests as final.

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

"Machine for cartoning articles (A) in containers or boxes, having a loading section comprising:

- an article inlet area (1), positioned to feed articles arranged in one row or in two parallel rows, with positioning of the articles in said inlet area (1) substantially according to a 1xN line array or a 2xN two-line array during use, where N is the number of articles per row;
- an area (2) for loading articles into said containers;

- a configuring device (3);
  - at least a first robot or manipulator (4) positioned to load articles from said inlet area (1) and transfer the articles to said configuring device (3),
  - at least a second robot or manipulator (5) positioned to pick up articles from said configuring device (3) and transfer them to said loading area (2),
- characterized in that:
- the configuring device (3) comprising an array of seats (302) for temporary accommodation of articles, and said array of seats (302) of the configuring device (3) being formed by rows of article receiving seats where the transversal distance between at least two of said rows of seats of the configuring device is variable,
  - and in that said configuring device (3) comprises seats of a first type (302a) and seats of a second type (302b), differently shaped, the seats of the first type and of the second type being alternated in the rows of the array of the configuring device so that given a seat of the first type in a generic position (i, j) of said array, the seats in the adjoining positions of the array are of the second type, and vice-versa, the seats of a first type being for upright articles and the seats of a second type being for flipped articles."

XI. The text of auxiliary requests 1 to 5 is not repeated here because the present decision is based in this respect on procedural grounds only.

XII. 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).

2. *Visit to Caffitaly*

- 2.1 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 (D1d) of Mr. Grassilli.

- 2.2 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 D1d belonged to the state of the art (appealed decision, page 6, third sentence).

2.3 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.

2.4 The patent proprietor fully supported the conclusions of the opposition division arguing as follows (see the reference to the arguments submitted in the parallel case T1814/14 in the second paragraph at page 2 of its reply to the statement setting out the grounds of appeal of the opponent).

2.4.1 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 show 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 7 September 2022, page 5, lines 17 to 25).

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 14 to 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.

2.4.2 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) of the opposition and of the national court.

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).

- 2.4.3 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 7 September 2022, page 8, lines 14 to 19).

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).

- 2.4.4 The patent proprietor then also argued as follows (letters of 9 December 2022 and of 7 September 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).

2.5 The Board disagrees.

2.5.1 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 7 September 2022, starting from page 3, line 3, and point i at page 6 of their letter dated 9 December 2022).

2.5.2 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 (letter of proprietor dated 7 September 2022, page 5, lines 17 to 25).

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.

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.

2.5.3 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.

- 2.5.4 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.

- 2.5.5 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 though an act of a third person, Mr. Grassilli, upon which GIMA had no control.

- 2.5.6 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.

2.5.7 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 reply thereto, where the disclosure through "sale" was contested with a specific reference to D1k (see page 3, second paragraph of the letter dated 7 September 2022 for the "sale" and from page 6, line 1 for the "visit", where D1k is never mentioned).

2.5.8 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 7 September 201522 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 2.5.3 above for a discussion of this argument of the patent proprietor).

- 2.5.9 Document Dlu, 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 Dlu, 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.

Dlu is an analysis of documents D1s and D1t, drafted by an expert in Italian law, discussing which parts of judgement D1s had not been 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.

3. Novelty, claim 1 of the main request - late filed arguments
- 3.1 The patent proprietor identified in its letter dated 27 June 2022 (see page 2) the following distinguishing features with respect to the machine disclosed in D1m:

"said configuring device comprises seats of a first type and seats of a second type, differently shaped, the seats of the first type and of the second type being alternated in the rows of the array of the configuring device so that given a seat of the first type in a generic position of said array, the seats in the adjoining positions of the array are of the second type, and vice-versa, the seats of a first type being for upright articles and the seats of a second type

being for flipped articles".

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

- 3.1.1 The identification of a distinguishing feature cannot be considered as an amendment of the patent proprietor's appeal case, because lack of novelty over the machine described in D1d was in the proceedings from the beginning, and the patent proprietor never conceded that this prior use, if accepted as prior art, was novelty-destroying.
- 3.1.2 There are exceptional circumstances justifying the admission of this new line of defense.

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.

This is why the patent proprietor, although having never conceded lack of novelty of claim 1, never contested that the machine described in D1d was novelty destroying for the subject-matter of claim 1 of the main request.

The opponent, during written proceedings, failed to discuss the reasons why it considered that the now identified distinguishing feature were implicitly disclosed, by addressing the relevant criteria for implicit disclosure established in the Case Law.

It was therefore not possible for the patent proprietor to react in detail to the novelty objection, because this objection has not been submitted in a complete way.

3.2 The Board, following the opponent's arguments, disagrees.

3.2.1 In the letter dated 27 June 2022 (page 2) the patent proprietor identified, for the very first time in opposition and appeal proceedings, features distinguishing the claimed machine from the machine described in D1d.

This submission clearly relates to the objection of lack of novelty over the machine involved in the prior use "Caffitaly", which was raised in the notice of opposition and therefore is in the proceedings from the beginning.

This submission is, however, clearly a change in the patent proprietor's case because until that moment the patent proprietor consistently defended claim 1 of the main request only arguing that the alleged prior use "Caffitaly" was not prior art, and never contested the allegation of the opponent that the machine described in D1d was novelty destroying.

As a consequence of the above, the Board is convinced that the novelty arguments submitted with the letter dated 27 June 2022 (page 2) clearly represent an amendment of the patent proprietor's appeal case.

3.2.2 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, 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.

The argument that it was not possible to react in detail to the novelty objection before notification of the summons to oral proceedings, because this objection had not been submitted in a complete way is also not convincing because it confuses the substantiation requirement with the strength of the opponent's case, and does not explain why it was not possible to identify the same distinguishing features already in the reply to the statement setting out the grounds of appeal.

- 3.3 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 novelty arguments of the patent proprietor.

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 (page 2, line 2, of the reply to the appeal of the opponent).

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 argued 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.

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 Dlu (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 Dlu, and found that they are not convincing (see point 2.5.9 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 Dls 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 the 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 2.5.1 above), and without assessing the extent of the obligations stipulated therein (see points 2.5.7 and 2.5.8 above).

7. Novelty, claim 1 of the main request - discussion

7.1 The opponent argued that granted claim 1 of the patent in suit, deemed allowable by the opposition division, lacks novelty over the machine described in D1d, which was made available to the public by sale and delivery thereof, and through the visit of Mr. Grassilli and Mr. Tosarelli to the premises of Caffitaly (statement of grounds, section III.3.1).

7.2 The Board notes that the patent proprietor failed to contest the above objection in appeal in an admissible way (see point 3 above).

In fact, the only admissible defense of the patent proprietor was that the alleged prior use "Caffitaly" was not prior art (see page 2, lines 3 to 13 of the reply to the statement of grounds).

In view of the above, and 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.

7.3 Thus, the decision under appeal cannot be upheld.

8. Auxiliary requests 1 to 5

8.1 Auxiliary requests 1 to 5 have been first submitted before the opposition division with letter of 6 December 2017.

In this letter the patent proprietor indicated, referring to 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 sections III.3.4 to III.3.8).

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 27 June 2022 (starting from page 4), after notification of a summons to oral proceedings, that the patent proprietor submitted arguments explaining why auxiliary requests 1 to 5 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 1 to 5 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 1 to 5 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, 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 1 to 5 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 section III.3.4 of the statement setting out the grounds of appeal).

- 8.3.3 The circumstances put forward by the patent proprietor to justify the admission 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 1 to 5, 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 1 to 5 into appeal proceedings (Article 12(5) RPBA 2020).

9. Conclusions

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 1 to 5 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 request to refer a question to the Enlarged Board of Appeal is refused.
2. The request for taking evidence according to Article 117(1) (e) EPC is refused.
3. The decision under appeal is set aside.
4. The patent is revoked.

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated