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**Datasheet for the decision
of 14 February 2020**

Case Number: T 0314/18 - 3.2.03

Application Number: 12198084.1

Publication Number: 2745744

IPC: A47C27/06, A47C27/07

Language of the proceedings: EN

Title of invention:
Backfolded pocket mattress

Patent Proprietor:
Starsprings AB

Opponent:
Spühl GmbH

Headword:

Relevant legal provisions:

EPC Art. 100(a), 54(1), 54(2), 56, 113(1), 117(1), 111(1)
RPBA 2020 Art. 11, 25
EPC R. 103(1)(a)
RPBA Art. 12(4)

Keyword:

Alleged public prior use - witness offered but not heard -
substantial procedural violation (yes)
Remittal to the department of first instance - (yes)
Reimbursement of appeal fee - (yes)

Decisions cited:

T 0716/06, T 1363/14, T 2238/15

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 0314/18 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 14 February 2020

Appellant: Spühl GmbH
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 23 November
2017 rejecting the opposition filed against
European patent No. 2745744 pursuant to Article
101(2) EPC.**

Composition of the Board:

Chairman G. Ashley
Members: V. Bouyssy
E. Kossonakou

Summary of Facts and Submissions

- I. European patent No 2 745 744 (in the following: "the patent") concerns a pocket mattress comprising coil springs enclosed in pockets, as well as a method and a device for manufacturing such a mattress.
- II. The patent as a whole was opposed on the grounds of lack of novelty and lack of inventive step (Article 100(a) EPC) in view of patent publications and a public prior use by sales of a pocket spring coiling machine by REMEX AG.
- III. The opposition division decided to reject the opposition against the patent.
- IV. This decision was appealed by the opponent (in the following: the appellant).
- V. With summons to oral proceedings, the Board sent a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) indicating its preliminary opinion of the case.
- VI. Oral proceedings before the Board were held on 14 February 2020.
- VII. Final requests

The appellant requested

- that the appealed decision be set aside and the patent be revoked, alternatively that the case be remitted to the opposition division for further investigation of the alleged public prior use;

- that auxiliary requests 1 to 3 not be admitted into the proceedings, and
- that the appeal fee be reimbursed.

The patent proprietor (here respondent) requested that the appeal be dismissed, alternatively that the patent be maintained as amended on the basis of one of the set of claims filed as auxiliary requests 1 to 3 with letter dated 15 August 2018. The respondent also requested that the case be remitted to the opposition division for further investigation of the prior use, in the event that the Board decided that the opposition division had committed a substantial procedural violation.

VIII. Claims of the respondent's main request

Independent product claim 1 as granted reads as follows:

A pocket mattress (10) comprising coil springs (2) arranged as spring units enclosed in a covering material (4) forming pockets (3), the spring units being arranged successively in elongate strings, the mattress comprising a plurality of such interconnected strings arranged side by side, wherein the elongate strings have a plurality of transverse seams (5) arranged parallel to the longitudinal direction of the coil springs (2) to separate the pockets (3), wherein a middle portion (8) of the transverse seams (5) attaches at least a layer of covering material (4) from either side of the spring unit to each other, characterized in that at least some of the transverse seams (5) are back folded transverse seams (7), in which the covering material (4) in proximity to an end portion of said back folded transverse seams (7) is back folded towards

the middle portion (8) of the transverse seams (5), whereby said back folded transverse seams (7) each have at least one end portion attaching at least twice as many layers of covering material (4) as in a corresponding transverse seam (5) which is not back folded.

Independent device claim 7 as granted reads as follows:

A device for manufacturing a spring mattress comprising: means for providing a covering material (4) forming an elongate string, means for arranging coil springs (2) in succession in such a manner that they are enclosed by the covering material (4), means for providing transverse seams separating each coil spring in enclosed pockets (3), and means for interconnecting a plurality of parallel strings side by side by surface attachment between abutting surfaces, wherein it further comprises means for providing at least some of the transverse seams (5) as back folded transverse seams (7) by back folding covering material in at least one end portion of each said back folded transverse seams (7) towards a middle portion (8) of the transverse seams (5).

Independent method claim 11 as granted reads as follows:

A method for manufacturing a pocket string comprising the steps of: providing a covering material (4) forming an elongate string configured to enclose a plurality of coil springs (2) arranged in succession; arranging coil springs (2) in such a manner that they are enclosed by the covering material (4); providing a plurality of transverse seams (5) across the elongate string, so that successive pockets (3) are formed, and directed so

that a longitudinal axis of the coil springs (2) is parallel to the transverse seams (5) providing back folded transverse seams (7), prior to, concurrently or after the step of providing a plurality of transverse seams (5), by back folding covering material in proximity to at least an end portion of said back folded transverse seams (7) towards a middle portion (8) of the transverse seams (5).

IX. Cited evidence

(a) In the statement setting out the grounds of appeal, and in the reply to it, the parties relied among others on the following patent publications, which were filed in the opposition proceedings and are cited in the decision under appeal:

O9: WO 2005/055771 A1;
O10: WO 01/02747 A1;
O11: US 6,499,275 B1.

(b) In the statement setting out the grounds of appeal, and in the reply to it, the parties also referred to the afore mentioned alleged public prior use and the following documents which were filed in the opposition proceedings in support of the prior use and are cited in the decision under appeal:

O1: Operating instructions of pocket spring coiling machine PWS-100, REMEX AG, German version 1.1, 22 December 2005;
O2: Operating instructions of pocket spring coiling machine PWS-100, REMEX AG, English version 1.1, 3 January 2006;
O3: Circuit diagrams of automatic spring coiler PWS-100, REMEX AG, PWS100_300605, 30 June 2005;

- O4: Photograph of produced pocket mattress with "folded ears";
- O5: Brochure on fully automatic pocket-spring transfer-line PST-200, REMEX AG;
- O6: Documents regarding the sale and delivery of a pocket spring coiling machine PWS-100 to AGRO International, Bad Essen, Germany, 2007;
- O7: Documents regarding the sale and delivery of a pocket spring coiling machine PWS-100 to Charles Blyth & Co. Ltd., Castle Donington, England, 2007;
- O8: Documents regarding the sale and delivery of a pocket spring coiling machine PWS-100 to Kovas, Panevezys, Lithuania, 2010;
- O16: Operating instructions of pocket spring coiling machine PWS-100, REMEX AG, German version, 1 February 2011;
- O17: Operating instructions of automatic pocketed spring gluing machine PST-200, REMEX AG, German version, 23 January 2008;
- O18: Operating instructions of automatic pocketed spring gluing machine PST-200, REMEX AG, English version, 23 January 2008.

Of these, O16 to O18 were filed by the appellant after expiry of the opposition period, and the opposition division admitted them into the proceedings, using its discretionary power under Article 114(2) EPC.

(c) With the statement setting out the grounds of appeal, the appellant filed the following pieces of evidence:

- O19: List of machines delivered by REMEX AG since 2003;
- O20: Copies of invoices for sales of machine PST-200

to various customers;

- O21: Operating instructions of pocket spring coiling machine PWS-100/s-HP, REMEX AG;
- O22: Screenshot of a video of REMEX AG on YouTube, <https://www.youtube.com/watch?v=ikVWaTX2Y0M>, published on 25 July 2011;
- O23: Shortened version of the YouTube-video of O22;
- O24: Written declaration of Mr D. Nussbaum, dated 28 March 2018, with receipts regarding the sale and delivery of a pocket spring coiling machine PWS-100 to MIMO, S.A. DE C.V., Mexico, 2006;
- O25: Written declaration of Mr B. Schweizer, dated 29 March 2018;
- O26: Written declaration of Mr F. Moser, dated 29 March 2018.

In addition, the appellant reiterated its offer to have Mr Nussbaum heard as a witness, and offered with the grounds of appeal Messrs Schweizer and Moser as witnesses.

X. The arguments of the parties, insofar as relevant for the present decision, can be summarised as follows:

(a) Inventive step in light of O9, O10 and O11

The appellant submitted that, contrary to the decision of the opposition division, the claimed invention lacked an inventive step when starting from O9 as closest prior art. The subject-matter of claim 1 differed from O9 by the so-called "back folded transverse seams" feature in the characterising portion of the claim. This modification was rendered obvious by the teaching of O10 or O11. For the same reasons, the subject-matter of claims 7 and 11 was not inventive.

The respondent argued that the claimed invention involved an inventive step in light of O9 to O11, because none of these documents disclosed the feature of the back folded transverse seams as required in claims 1, 7 and 11.

(b) Alleged public prior use

The appellant submitted that the subject-matter of the alleged public prior use anticipated the claimed invention and that, contrary to the appealed decision, the prior use had been sufficiently substantiated in the notice of opposition, whereby the hearing of a witness (Mr Nussbaum) had been proposed only in case there was any doubt concerning evidence that had already been filed, but not to close any gap in the substantiation.

The respondent argued that the opposition division had come to a correct decision regarding the alleged public prior use. The appellant had failed to provide evidence to establish the prior use. There remained questions regarding what was actually used, and the circumstances of the use, in particular whether the machines' sales had not been subject to any obligation of confidentiality. In particular, operating manuals O1, O2 and O16 to O18 were to be kept confidential, as required by a confidentiality clause in them. At any rate, even if the public availability of the prior use were to be proven, its subject-matter would not anticipate the claimed invention, in particular the feature of the back folded transverse seams as required in claims 1, 7 and 11. Hence, the prior use was *prima facie* not relevant for the evaluation of the novelty and inventive step of the claimed subject-matter.

(c) Admission of O19 to O26 in the appeal proceedings

Documents O19 to O22 and O24 to O26 and video O23 were filed for the first time with the statement of grounds of appeal.

The respondent requested the Board not to admit these new pieces of evidence into the proceedings because

- their filing was belated,
- the appellant had given no explanation for their late filing, even though the pieces of evidence could and should have been filed in the opposition proceedings, and
- their accuracy, authenticity, credibility and relevance were questionable.

The appellant argued that the new pieces of evidence were filed in reaction to the decision of the opposition division that the prior use was not sufficiently substantiated and the offered witness was not to be heard. The submission of these new pieces of evidence, together with the statement of grounds of appeal, took place as early as possible in the appeal proceedings, and there was neither reason nor necessity to submit them in the opposition proceedings, since the appellant could reasonably assume that the written evidence submitted and the witness evidence offered would be sufficient to substantiate sufficiently the prior use. The content of the new evidence was highly relevant for the evaluation of the questions of novelty and inventive step.

(d) Substantial procedural violation

The appellant submitted that the opposition division infringed its right to be heard, and so committed a

substantial procedural violation (Article 113(1) EPC), by refusing to hear the offered witness on the prior use (Article 117(1) EPC).

The respondent argued that the opposition division correctly decided not to hear the offered witness, because the appellant had failed to specify what facts would be corroborated by hearing the witness. This decision could not be considered to constitute any substantial procedural violation.

Reasons for the Decision

1. Applicable Rules of Procedure of the Boards of Appeal (RPBA)
 - 1.1 The appeal was filed before the entry into force of the revised version of the Rules of Procedure of the Boards of Appeal (RPBA 2020) on 1 January 2020 (Article 24(1) RPBA 2020). In accordance with the transitional provisions laid down in Article 25(1) RPBA 2020, the revised version shall apply to any appeal pending on that date.
 - 1.2 However, as the statement of grounds of appeal was filed before 1 January 2020 and the reply to it was filed in due time, Article 12(4) to (6) RPBA 2020 does not apply to these submissions, and instead Article 12(4) RPBA 2007 continues to apply (Article 25(2) RPBA 2020).
2. Inventive step in light of 09, 010 and 011
 - 2.1 The Board shares the parties' view that the pocket spring mattress disclosed in 09 forms a realistic starting point for the assessment of inventive step and

that the subject-matter of claim 1 differs from the mattress disclosed in 09 by the feature in the characterising portion of the claim, namely

"that at least some of the transverse seams are back folded transverse seams, in which the covering material in proximity to an end portion of said back folded transverse seams is back folded towards the middle portion of the transverse seams, whereby said back folded transverse seams each have at least one end portion attaching at least twice as many layers of covering material as in a corresponding transverse seam which is not back folded".

- 2.2 Whilst 09 already discloses the provision of a slit between two adjacent pockets to prevent excess cover material from accumulating at the top and bottom of the strings and thus avoid undesirable "false lofts" in the mattress, i.e. upstanding portions of covering material protruding from the surface of the mattress, the distinguishing feature has the effect that the top and/or bottom end portion of transverse seams has a smoother, more even surface without protruding false lofts (paragraphs 10 to 12 of the patent specification).
- 2.3 Hence, starting from the mattress disclosed in 09, the objective technical problem to be solved can be formulated as how to improve further the avoidance of false lofts.
- 2.4 The Board is not persuaded by the appellant's contention that the skilled person, in the expectation of solving this problem, could and indeed would consider the teaching of 010 or 011 and then modify the floor of 09 in the claimed manner.

2.5 The Board shares the appellant's opinion insofar as O10 and O11 address the problem of undesirable differential face feel and undesirable false lofts and thus the skilled person could consider the teachings of these documents.

2.6 However, the Board can see no reason why the skilled person would get any motivation from O10 or O11 to form back folded transverse seams in the mattress of O9 in the manner required by claim 1:

2.6.1 O10 teaches that the undesirable differential face feel of a mattress can be eliminated by positioning the longitudinal seam (20) of a pocket of springs approximately midway between the ends of the springs (13), and providing two longitudinal edge flaps (16) folded into contact with the outer surface of the pocket and incorporated into each transverse seam (14) (see figures 1 to 3). This results in that the transverse seams attach four layers of covering material halfway between the spring ends, i.e. twice as many layers as in the other portions of the transverse seams. Should the skilled person consider combining this teaching with that of O9, they would inevitably consider positioning the longitudinal seam midway between the end portions of the transverse seams and forming back folded transverse seams in this region. By so doing they would not arrive at the claimed solution, wherein the covering material is back folded in proximity to the end portion of some transverse seams and the end portion attaches twice as many layers as the other portions.

2.6.2 O11 concerns a method for producing strings of pocketed coil springs which are effective in performance, yet

cost effective. It teaches that the problem of false lofts can be avoided by positioning the longitudinal seam of the string of springs on a side thereof (column 3, lines 44 to 46). It is shown in figures 5 and 6 that the longitudinal seam 54 of the string is located approximately midway between the top and bottom ends 90, 92 of the springs 14, so that in this region the transverse seams 80 attach four layers of fabric 16 (column 6, lines 33 to 38), i.e. twice as many layers as in the other portions of the transverse seams. Should the skilled person consider combining this teaching with that of 09, they would arrange the back folding in the middle portion of the transverse seams, but not at an end portion. Thus, the teaching of 011 would lead the skilled person away from the claimed solution.

- 2.6.3 The appellant refers to the statement in column 6, lines 44 to 47 of 011 that, at variance with the embodiment shown in figures 5 and 6, the longitudinal seam 54 may be located anywhere between the top and bottom of the string. However, this statement must be read in context of the overall teaching of 011 and it is clear to the skilled person that the longitudinal seam cannot be located at an end portion of the transverse seams and at the same time achieve the advantage of the invention. Indeed, in the production method disclosed in 011, it is inevitable that the longitudinal seam is formed some distance away from the top and bottom of the springs and thus away from the end portions of the transverse seams (in figures 1, 3 and 9 see longitudinal seam forming station 52 located downstream from the spring insertion station 34 proximate the free edges 28 of the fabric plies 24 and 26 keeping the coil springs 14 compressed).

2.6.4 The appellant submits that it is irrelevant that O10 and O11 disclose longitudinal seams positioned between the top and bottom ends of the springs, because the broad wording of claim 1 is not limited to any specific location of the longitudinal seam. However, when answering the "could/would" question, it is simply if starting from O9 it is obvious to adopt the teaching of O10 or O11 to solve the objective problem. At this stage of the analysis of inventive step, the wording of the claim has to be left aside in order to avoid any hindsight bias.

2.7 In conclusion, the Board is not convinced that the subject-matter of claim 1 lacks an inventive step when starting from O9 and considering O10 or O11 (Article 56 EPC).

2.8 For the same reasons the objection of lack of inventive step against claims 7 and 11 based on O9, O10 and O11 is not persuasive.

2.9 It thus follows that the Board shares the view of the respondent and the opposition division that the specific "back folded transverse seams" feature is neither disclosed nor rendered obvious by the teachings of documents O9 to O11.

2.10 In light of this conclusion, the Board considers that the alleged public prior use must be further investigated.

3. Alleged public prior use

3.1 With respect to the public prior use alleged by the appellant, the opposition proceedings can be summarised as follows:

- 3.1.1 In the notice of opposition, the appellant alleged that the claimed invention was anticipated by a public prior use in the form of several sales of the pocket spring coiling machine PWS-100 by REMEX AG before the patent's filing date (19 December 2012). The appellant explained in detail why the claimed subject-matter was anticipated by the machine PWS-100 as described in operating manuals O1 and O2 and document O3, when used in the system PST-200 as disclosed in document O5. The appellant submitted that O1 to O3 were printed before 19 December 2012, whereby O1 and O2 were delivered with the machine. To confirm the alleged sales the appellant provided copies of shipment orders, delivery notes and invoices relating to the sale and delivery of a machine PWS-100 and the corresponding system PST-200 by REMEX AG to AGRO International (Germany) in 2007 (O6), Charles Blyth & Co. Ltd. (England) in 2007 (O7) and Kovas (Lithuania) in 2010 (O8). These different public disclosures were subsumed under the term "prior use". The appellant asserted that the sales were not subject to any confidentiality agreement. Finally, the appellant offered the hearing of a witness (Mr Nussbaum) to corroborate the date, the subject-matter and the circumstances of the alleged prior use (page 7) as well as the correctness of the appellant's submissions with respect to the technical features and the mode of operation of the machine PWS-100 and the system PST-200 (page 9).
- 3.1.2 In its response dated 30 May 2016, the respondent contested the alleged prior use.
- 3.1.3 In the annex to the summons to oral proceedings, the opposition division expressed its preliminary non-

binding opinion on the alleged public prior use as follows (point 4.1):

- the alleged public prior use was insufficiently substantiated in the notice of opposition, in particular it was not supported with facts which made it possible to determine the date on which the alleged use had occurred, what had been used and all the circumstances relating to the use in order to determine to what extent it was made available to the public;
- the lack of adequate substantiation could not be removed by hearing of the proposed witness, as he should serve for corroboration of facts brought forward, not for supplying these facts in place of the opponent;
- documents O1 and O2 themselves were intended to be kept confidential; and
- even if the alleged prior use were proven, its subject-matter would not be relevant for the evaluation of the novelty of the claimed subject-matter, in particular because the teaching in paragraph 15.7.4.2 of O1 or O2 did not anticipate the feature of the back folded transverse seams as required in claims 1, 7 and 11.

3.1.4 In its response to the summons dated 4 August 2017, the appellant submitted that, contrary to the opposition division's view, all the facts necessary to determine the date, the subject-matter and the circumstances of the alleged public prior use had been duly provided in the notice of opposition, and that the hearing of the witness had been proposed only in case there was any doubt, but not to close any gap in the substantiation. The appellant also filed further evidence, namely operating manuals O16 to O18, to confirm that the machine PWS-100, when used in the system PST-200,

anticipated the feature of the back folded transverse seams as required in claims 1, 7 and 11.

3.1.5 In its written decision, the opposition held essentially:

- (a) that the alleged prior use was insufficiently substantiated in the notice of opposition with respect to its date, subject-matter and circumstances and that the lack of adequate substantiation could not be removed by hearing of the proposed witness (points 3.1 and 4.3 of the reasons, where reference is made to EPO Guidelines G-IV, 7.2);
- (b) that, in the notice of opposition, the appellant had made a generic statement that the witness could confirm the when, what, and how of the prior use but had failed to indicate what specific facts would be confirmed by the witness (point 3.1 of the reasons, where reference is made to EPO Guidelines E-IV, 1.2);
- (c) that operating manuals O1, O2 and O16 to O18 did not form part of the prior art in the sense of Article 54(2) EPC, in particular because they expressly referred to a confidentiality clause and it had not been proven beyond reasonable doubt that they were delivered together with the machine PWS-100 and the system PST-200 to the customers mentioned in O6 to O8 (point 4.3 of the reasons);
and
- (d) that it had not been proven beyond reasonable doubt that the machine PWS-100 and the system PST-200 described in O1, O2 and O16 to O18 were actually delivered to the customers mentioned in O6 to O8 (point 4.3 of the reasons).

Thus, the alleged prior use was not taken into account when assessing the novelty and inventive step of the claimed invention.

4. Relevance of the alleged prior use

4.1 When dealing with an allegation of public prior use or disclosure, the first issue to be decided is its relevance for the case at hand. Hence first of all, it is essential to assess the basic information regarding the object of the use (what). Information regarding the circumstances and date thereof then becomes important, in order to assess whether the allegation could be part of the state of the art (prior and public character of the alleged use/disclosure). This information needs to be on file at least on a *prima facie* basis, although it does not need to be exhaustive or indeed conclusive.

4.2 In the present case, the opponent submitted in the notice of opposition all the necessary facts and information for enabling an assessment of the relevance, and thus had substantiated its case in this respect. It would appear that the opposition division, when discussing substantiation, was rather considering issues of proof. This is however a subsequent step.

4.3 Regarding the facts relating to the prior use, the Board is of the opinion that the alleged prior use is *prima facie* highly relevant for assessing the novelty, and possibly the inventive step, of the claimed invention. In particular, it appears to follow from O1 (paragraphs 15.6.3, 15.7.3 and 15.7.4.2) that the machine PWS-100 comprises two lateral blowpipes in the immediate vicinity of a transverse welding apparatus, the blowpipes being designed to blow the fabric material in excess between two spring pockets towards

the centre of the spring string prior to transverse welding, thereby folding the fabric inwardly and avoiding any unevenness at the welding points. This seems to result inevitably in back folded transverse seams, as required in claims 1, 7 and 11.

5. Admission of O19 to O26 in the appeal proceedings
- 5.1 The Board considers that the filing of O19 to O26 in appeal is a legitimate reaction of the appellant to the opposition division's decision that the alleged prior use was insufficiently substantiated and that the witness did not need to be heard; further, that the appellant exercised appropriate care by filing these new pieces of evidence as early as possible in the appeal proceedings.
- 5.2 The Board cannot find any indication in the file to suggest that the appellant deliberately chose not to submit the new evidence in the opposition proceedings.
- 5.3 Even though the appellant already filed documents O16 to O18 to substantiate further the alleged prior use in reaction to the preliminary opinion of the opposition division accompanying the summons to oral proceedings, it came as a surprise to the appellant that the opposition division finally decided not to hear the proposed witness.
- 5.4 Therefore, the Board sees no reason to disregard O19 to O26, irrespective of their relevance (Article 12(4) RPBA 2007).

6. Substantial procedural violation
 - 6.1 The Board agrees with the appellant that, in particular having regard to the existing evidence on file as well as to the doubts that the opposition division had with respect to its probative value, the opposition division should have heard the witness.
 - 6.2 From the language used to offer the witness it is clear upon reading the notice of opposition that - contrary to the view of the opposition division and the respondent - the appellant offered the witness solely to corroborate the facts already brought forward in support of the alleged prior use (see points 3.1.1 and 3.1.4 above; see page 9, paragraph 4 of the notice of opposition, "Als Zeuge, welcher die Richtigkeit der obigen Ausführungen und die beschriebene Funktionsweise der Federwindemaschine PWS-100 sowie der Gesamtanlage PST-200 belegen kann, wird wiederum angeboten ... Hr. Daniel Nussbaum").
 - 6.3 No provision of the EPC requires that an alleged prior use be conclusively proven within the opposition period. When referring to the EPO Guidelines G-IV, 7.2 and E-IV, 1.2, and arguing that the lack of adequate substantiation of the prior use in the notice of opposition could not be removed by hearing the witness, the opposition division mixed up the submission of facts and the proof required to establish them (see point 4.2 above).
 - 6.4 By refusing to hear the proposed witness, the opposition division proceeded in fact to assess evidence that had not been established, although it appeared to be *prima facie* relevant for the decision to be taken. This is procedurally incorrect.

- 6.5 The opposition division thus has infringed the appellant's right to be heard under Articles 117(1) and 113(1) EPC (see comparable cases e.g. T 716/06 of 17 June 2008, point 4 of the reasons; T 1363/14 of 30 May 2016, point 2 of the reasons; T 2238/15 of 11 April 2018, point 2 of the reasons).
7. The above mentioned substantial procedural violation is sufficient reason for setting aside the decision under appeal, and justifies the remittal of the case to the opposition division (Article 111(1) EPC and Article 11, second sentence, RPBA 2020), as well as the reimbursement of the appeal fee (Rule 103(1)(a) EPC).
8. It follows from the preceding considerations that it is still in dispute between the parties whether the alleged public prior use has been sufficiently proven. In particular, it is in dispute among the parties whether the alleged prior sales took place, which machines were actually sold and whether the sales were subject to confidentiality conditions.

In the oral proceedings before the Board, the respondent submitted that it followed from the written declaration O24 of the proposed witness that, at the time of the alleged sales, he was working in Mexico. Therefore it was unlikely that the hearing of the witness could provide conclusive evidence of the alleged sales in Germany, England and Lithuania. As indicated above in respect of the opposition division's related reasoning, this amounts to an inadmissible assessment of evidence before it has been established.

9. However, since the case is to be remitted, the Board refrains from further comments or indeed from taking a final decision on these issues.

10. Nevertheless, given the nature of the points at issue, it seems that it would be appropriate to enlarge the opposition division by the addition of a legally qualified examiner (Article 19(2), fifth sentence, EPC).

11. Under these circumstances there is no need to address the admissibility into the proceedings of auxiliary requests 1 to 3, let alone their allowability. However, the Board notes that auxiliary requests filed in due time with the reply of a patent proprietor to the statement of grounds of appeal of an opponent are normally to be taken into consideration (Article 12(4) RPBA 2007).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:



C. Spira

G. Ashley

Decision electronically authenticated