

ES – VORWERK v. LIDL SUPERMERCADOS

Commercial Court No. 5 of Barcelona, Spain, 19 January 2021, case number 1231/2019

In one of the most mediatic patent lawsuits of recent times in Spain, the Commercial Court no. 5 of Barcelona, in its Judgment of 19 January 2021, ordered the supermarket chain Lidl to cease all commercial exploitation in Spain of its "Monsieur Cuisine Connect" cooking robot for infringing Vorwerk's patent rights in relation to its famous "Thermomix" kitchen appliance.

It is unusual for a patent litigation to attract the attention of the media or the general public in Spain. However, the dispute between the German companies Vorwerk and Lidl regarding the patent rights of the former on the invention implemented in its well-known "Thermomix" robot, against the popularly known as its low-cost version, Lidl's "Monsieur Cuisine Connect" robot, has exceptionally monopolized a good part of the legal information pages and discussions recently.

Indeed, in June 2019, Vorwerk, manufacturer and marketer of the famous "Thermomix" robot, initiated legal proceedings in Spain against Lidl Supermarkets on grounds of infringement by the latter of Vorwerk's patent EP 1269898 (in Spain, ES 2301598; hereinafter "EP'898"). Independent claim 1 of EP'898 protects a food processor featured as follows:

1. A food processor (1) having a mixing vessel (2), a lid (3) and a housing (4), the mixing vessel (2) and the lid (3) being lockable in such a manner that access to the mixing vessel (2) is not possible during operation, the mixing vessel (2) and/or the lid (3) further being lockable and releasable by twisting about the vertical axis of the mixing vessel, an electrical switch (46) being actuated on account of the twisting of the mixing vessel (2) and/or the lid (3), the switch enabling supply of power to a control board (42), **characterized in that** the control board has at least one circuit controlling the mixing member and a circuit relating to a weighing device, and the circuit relating to the mixing member further being enabled on account of actuation of the switch, but the circuit relating to the weighing device being independent of actuation of the switch.

Against Vorwerk's lawsuit, Lidl defended itself not only denying the existence of any infringement by the commercial exploitation of its "Monsieur Cuisine Connect" robot, but also asserting the invalidity of Vorwerk's patent by filing a counterclaim on grounds of added subject-matter, lack of novelty and lack of inventive step.

In its Judgment of 19 January 2021, Commercial Court no. 5 of Barcelona put an end to the dispute in the first instance dismissing Lidl's invalidity counterclaim and admitting, however, Vorwerk's infringement claim.

In its Judgment, before entering into the assessment of the parties' respective claims, the Court focused on determining the patent scope of protection -namely of claim 1, which was at the heart of the dispute- as a necessary pre-condition for evaluating both the infringement and the invalidity arguments. In this context, the Court considered that it is in the following feature of the protected food processor, read together with the preceding claim features, that the essence of Vorwerk's invention lies:

[C1.6] (...) but the circuit relating to the weighing device being independent of actuation of the switch.

In other words: starting from the recognition that kitchen appliances were already known in the prior art, the Court found that the key in invention lied in the fact that Vorwerk's cooking robot provides circuits that allow the stirring and weighing devices to operate independently from each other. The weighing system is independent of the switch that is activated when the stirring vessel is fixed and the lid is secured on the vessel. In this way, the user can continue to weigh food on the stirring vessel lid regardless of whether or not the stirring mechanism is in operation, just provided the machine is plugged to a power supply.

Established the above, the Court moved on to first analyse the alleged nullity of the patent for including added subject-matter which, according to Lidl, would reside in the two following features of the invention as not deriving from the original application as filed:

[C1.4] characterized in that the control board has at least one circuit controlling the mixing member and a circuit relating to a weighing device,

[C1.5] and the circuit relating to the mixing member further being enabled on account of actuation of the switch,

With respect to feature C1.4, Lidl had alleged that the original description did not state that the weighing device was controlled by a controlling circuit nor that the latter was part of the control board. However, the Court noted that the description of the filed application mentioned that *"an electrical switch is actuated which enables the power supply to a control board, at least with regard to certain functions of the control board"* and that *"the functions of a possible weighing device are preferably independent of the switch position"*. Agreeing with the patentee, the Court found that a skilled person who read the entire description would derive directly and unequivocally that those functions of the weighing mechanism referred to in the description presuppose the existence of a control circuit linked to a control board just as they do appear explicitly in the description in relation to the stirring and heating functions, something logical in a 21st century machine of these characteristics.

As regards feature C1.5, Lidl had alleged that it represented an inadmissible intermediate generalization of the original disclosure, to the extent that, according to the description in the application, activating the switch releases power supply to activate “*at least (...) certain functions of the control board*”, exemplifying the description thereafter, as being or possibly being switch-actuated, the mixing mechanism or an optional heater circuit, the latter having been omitted in the claim as granted. However, the Court found, agreeing again with Vorwerk, that no intermediate generalization existed as the heating function -and so the actuation of the switch to release power supply to a heater circuit- was featured as optional in the original description, so the claim actually narrowed what had been disclosed in the original application.

Turning then to the assessment of the alleged lack of novelty in EP’898, this challenge had actually been abandoned by Lidl at the trial hearing, as its expert had admitted that claim feature C1.1:

[C1.1] A food processor (1) having a mixing vessel (2), a lid (3) and a housing (4), the mixing vessel (2) and the lid (3) being lockable in such a manner that access to the mixing vessel (2) is not possible during operation

was missing in the allegedly novelty-destroying document, Braun’s patent US 5329069. Nonetheless, the Court also went through the novelty attack to finally state that feature C1.6 -seen above as comprising the essence of the invention, according to the Court- was also not present in Braun’s patent, despite the fact that, as mentioned, Lidl was not pursuing this challenge any longer.

The Court then went on to analyse the inventive step challenge raised by Lidl, applying to that end the “problem-solution approach”.

The first obviousness challenge started from Braun’s patent mentioned above as the closest prior art document. Given that feature C1.1 had been admitted to be absent from Braun’s patent, this was reason enough for the Court to reject this challenge. The Court noted indeed that kitchen appliances having this feature (“A food processor (1) having a mixing vessel (2), a lid (3) and a housing (4), the mixing vessel (2) and the lid (3) being lockable in such a manner that access to the mixing vessel (2) is not possible during operation”), were already known in the prior art. The analysis therefore departed from a state of the art very distant from the invention, even beyond the prior art described in the EP’898 patent itself. The Court thus wondered why one should start from a prior art document lacking feature C1.1 when there were already kitchen machines in the prior art with that feature.

The first attack rejected, the Court focused on the second combination of documents defended by Lidl, wherein Philips’s patent EP 0638273 was regarded as the closest prior art document combined with either the Braun’s patent or Ronic’s French patent FR 2651982.

The parties agreed that the difference between the invention and the Philips' patent lied in the fact that the latter lacked a circuit relating to a weighing device (as featured in C1.4), for which this could not be independent of actuation of the switch either (as featured in C1.6). Similarly, it was undisputed that the technical effect produced by this difference was that the appliance of Vorwerk's patent claim 1 allowed to weigh food in the stirring vessel regardless of the state of the switch, the processing and weighing functions being independent from each other .

The Court thus identified the objective technical problem as *how to perform the weighing of food in the mixing vessel regardless of the status of the switch*, as stated in the patent description itself, further recalling that the objective technical problem to be solved shall always be the same even where different starting points are taken to arrive at the invention.

Finally, in the last step of the problem-solution approach, in determining whether the invention would have been obvious to the eyes of a skilled person starting from the premises above, the Court possibly made the most interesting findings in the Judgment, in application of the so-called "could-would" approach.

The Court observed that the Braun's patent described cooking robots provided with weighing devices with an electrical circuit connected to an electrical power source. On the other hand, it noted that the Ronic's patent described cooking robots that, in addition to processing food, allowed weighing with an electrical circuit with two buttons. However, what the Court found most important was that both documents "*take for granted and assume as a matter of course*" that weighing is done before or after food processing (Braun) or that the weighing function cannot be activated if in while processing food (Ronic).

Thus, agreeing with Vorwerk's expert, the Court found that neither of these two documents even suggested that getting a machine that was capable of processing and weighing food as two independent functions was a technical problem to be solved. Endorsing the words of Vorwerk's expert, the Court emphasized what was perhaps the key to this case: "*What now seems so easy - that I can cook while I'm weighing - once seemed impossible, so impossible that it was not even desired*".

In this respect, the Court noted that the solution offered by Vorwerk's patent was actually very simple, so that any technical expert *could* have arrived to it. However, that was not the question, but instead whether the expert *would* have actually made it. And this was not the case here: in the Court's view, Lidl had not justified how starting from the Philips' patent a skilled person would have combined its teachings with those in Braun or Ronic or how he would have thus arrived at Vorwerk's invention, much less when none of these two had even insinuated that it would be a technical challenge to create a

cooking machine that, in addition to processing, would allow to weigh food by independently activating both functions. Simply, there was not even the motivation to come up with the invention, so it could not be obvious.

All the grounds for invalidity raised by Lidl in its counterclaim having been dismissed, the Court entered into the assessment of Vorwerk's infringement arguments against Lidl's "Monsieur Cuisine Connect" robot. The dispute in this respect just focused on one claim feature:

[C1.1] A food processor (1) having a mixing vessel (2), a lid (3) and a housing (4), the mixing vessel (2) and the lid (3) being lockable in such a manner that access to the mixing vessel (2) is not possible during operation

Lidl defended a certain construction of this feature to deny infringement with which, however, the Court did not agree: Lidl and its expert had contended that, according to the claim, in order to be able to intervene inside the stirring vessel, the stirring mechanism must first be stopped and once it is stopped, the lid of the stirring vessel can be unlocked or released by a user. However, the Court rejected this interpretation based on several arguments:

- "Unlock" and "remove" the lid were used as equal terms where they are different and claim 1 even also referred to the first of them.
- Neither the claims or the description disclosed a sequence of steps as that maintained by Lidl.
- This was a partial and biased interpretation that ignored the rest of the features of claim 1.

Hence, making an integrative interpretation considering the remaining claim features, this element should be read, in the Court's opinion, in the sense that, when the lid is unlocked/released by rotation around the vertical axis of the stirring vessel, the stirring mechanism is interrupted for safety reasons; hence, when the lid is locked by rotation, this rotation position defines the stirring vessel operating position so that no intervention inside the stirring vessel is possible during operation.

Bearing the above interpretation in mind, the Court found that the technical evidence provided by Vorwerk proved indeed that Lidl's robot implemented the same and thus infringed Vorwerk's rights of the EP'898 patent. And the above conclusion was not altered by other arguments also put forward by Lidl to reject the infringement, including certain statements made in the instructions manual of its robot, or the presence of a filing orifice in it purportedly avoiding compliance with feature C1.1.

Consequently, the Court declared Vorwerk's EP'898 patent valid and infringed and, while dismissing Lidl's invalidity counterclaim, it admitted Vorwerk's infringement claim ordering Lidl to cease any commercial exploitation of the "Monsieur Cuisine Connect" robot subject of the dispute, to withdraw from trade any units thereof in its possession or in possession of its distributors, to withdraw any related commercial and advertising materials reproducing the same, to refrain thereafter from exploiting any

cooking machines implementing the invention, to pay compensation for damages (in an amount yet to be established, in enforcement stage) and the legal costs of the proceedings.

Lidl has lodged an appeal against this Judgment.

