

## ES – VORWERK v. LIDL SUPERMERCADOS

### Court of Appeals of Barcelona, Spain, 13 January 2022, Appeal Docket No. 880/2021 (ECLI:ES:APB:2022:1)

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One year after the first-instance ruling in one of the most mediatic patent cases in Spain, the Court of Appeals of Barcelona rendered a judgment changing course, namely in reversing the first instance judgment and declaring the invalidity of Vorwerk's patent on its famous "Thermomix" food processor. Defendant Lidl is now free to reinstate its competitor "Monsieur Cuisine Connect" robot in the market.

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Previously [in this blog](#) we commented on the judgment handed down on 19 January 2021 by Commercial Court no. 5 of Barcelona in the lawsuit brought by Vorwerk against Lidl Supermarkets for the commercial exploitation of its "Monsieur Cuisine Connect" food processor, for infringement of Vorwerk's patent EP 1269898 ("EP'898") relating to its well-known "Thermomix" robot. On that occasion, the Court dismissed Lidl's counterclaim for patent invalidity and admitted Vorwerk's infringement claim, ordering Lidl, among others, to cease any commercial exploitation of the "Monsieur Cuisine Connect" robot, and to pay damages and cover Vorwerk's legal costs.

One year later, and as a result of the appeal lodged by Lidl against that judgment, the Barcelona Court of Appeals ruled in favour of Lidl, finding not only the nullity of Vorwerk's patent, due to added subject-matter and lack of inventive step, but also due to lack of infringement of Lidl's robot, if the patent was to be considered valid.

Briefly recalling the relevant background, Vorwerk's EP'898 patent at issue protects in its independent claim 1 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.

Below is a brief summary of the Barcelona Court of Appeals' findings on each and every one of the grounds of the lower Court, finally leading to the reversal of the first instance judgment.

***Added subject-matter***

Starting first with the nullity argument of added-subject matter that Lidl had raised in its invalidity counterclaim, the dispute focused on the two features below of claim 1 of EP'898, which according to Lidl, would not be derived from the original patent 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,

Regarding **feature C1.4**, Lidl had opposed the fact that the description in the application as filed did not mention that the weighing device was controlled by a controlling circuit, nor that the latter was part of the control board. The first instance Court had found, however, that a skilled person would have derived from the original description, directly and unequivocally, that the existence of a control circuit linked to a control board was implicit to the functions of a weighing mechanism, as this was in fact expressly referred to in the description in relation to the stirring and heating functions. It had further added that, in the 21<sup>st</sup> century, if the inventor had wanted to include a weighing function not associated with a control circuit on the control board, he would have stated so.

The Barcelona Court of Appeals disagreed with this assessment. In the Court's view, a skilled person would have not directly and unequivocally inferred from the patent application that the fact that the control board had a circuit acting on the weighing function, separate from the circuit controlling the stirring and heating functions, was a feature of the invention. Vorwerk had only explicitly referred in the patent application to the stirring and heating functions when describing the control board, and during prosecution it amended the claim to make the weighing function explicit. The Court noted that this need to make the weighing function explicit in claim 1 was hardly compatible with the idea that it could be considered a feature that was clearly and unambiguously implicit in the original application.

Moreover, the Barcelona Court of Appeals observed that it was doubtful that a weighing device necessarily requiring a circuit on a control board was implicit in the application -i.e., one could not rule out that it worked by having the machine connected to a power supply-, and it found that it was certainly unlikely to consider as implicitly disclosed that a single control board should house all the circuits corresponding to the different functions of the machine, which should have been made explicit in the patent application.

For this reason alone, claim 1 of EP'898 was regarded as comprising added subject-matter, thus leading to the invalidity of the patent.

Without prejudice to the above, the Barcelona Court of Appeals, as the first instance Court did before, did not allow Lidl's argument with regard to the addition of subject-matter stemming from **feature C1.5**. Lidl had claimed that this feature represented an intermediate generalization of the original disclosure, because the claim just referred to the mixing function as being switch-activated whereas, according to the description in the patent application, Lidl alleged, the switch released the power supply to activate at least certain functions of the control board, which had been omitted in the claim. The first-instance Court had found that this omission in fact entailed a restriction of the scope of the claim against the disclosure in the patent application.

The Barcelona Court of Appeals ruled in this respect that Lidl's argument was not well-founded, because it relied on a passage of the description contained in the application that related to the control board, and not to the *"circuit relating to the mixing member"*, which is the essence of feature C1.5. The Barcelona Court of Appeals also observed that, just after the passage pointed out by Lidl, the original description went on to state that *"for example, the control board circuit on the stirring element is only powered when the switch is activated"*, precisely what was included in feature C1.5 of claim 1.

### ***Scope of protection***

Following the assessment of added subject-matter, for which the EP'898 should be deemed invalid, the Barcelona Court of Appeals made some considerations to delimit the patent's scope of protection due to its relevance for the examination of the remaining questions under appeal. In this respect, the Court of Appeals, focused on features C1.1 and C1.6 of claim 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,

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

First, in relation to **feature C1.1**, the lower Court had rejected this feature as requiring a sequential succession of steps, as Lidl had contended. Lidl had argued that in light of this claim feature, the intervention in the stirring vessel was determined by two successive steps: the stopping of the stirring mechanism, followed by the intervention inside the stirring vessel by removing or opening the previously-blocked lid. The Barcelona Court of Appeals upheld Lidl's claim construction, finding that it was supported by the patent description, which stated that the locking system provided *"allows intervention inside the stirring vessel only after the stirring mechanism has stopped"*, or that *"It is therefore ensured that the lid cannot be removed while the stirring mechanism is switched on"*.

Concerning **feature C1.6**, the appealed judgment found that it condensed the essence of Vorwerk's invention, in the sense that, unlike prior art kitchen appliances including stirring and weighing mechanisms, Vorwerk's cooking robot provided circuits that allowed the stirring and weighing devices to operate independently from each other, so that, when the switch is activated, the stirring vessel stops, but not the weighing function. Lidl challenged this interpretation, arguing that nowhere in the patent description is there any mention of said independence between the two mechanisms. However, the Barcelona Court of Appeals noted that an excessively literal interpretation should be avoided, and that feature C1.6 should be construed by contextualizing it with the rest of the features of claim 1, with the prior art stated in the patent and with the rest of the patent description. This integrative interpretation confirmed the lower Court's analysis, thereby rejecting Lidl's argument.

### ***Inventive step***

The Barcelona Court of Appeals next considered the inventive step challenge. Lidl had proposed two different approaches to substantiate the lack of inventive step of Vorwerk's EP'898 patent:

- On the one hand, departing from Braun's patent US 5329069 (D1) as the closest prior art, combined with Philips' patent EP 0638273 (D3) and/or Matsushita's patent US 4373677 (D6).
- On the other hand, departing from Philips' patent EP 0638273 (D3) as the closest prior art, combined with Braun's patent US 5329069 (D1) or Ronic's patent FR 2651982 (D9).

The first instance Court had rejected the first challenge, departing from Braun's patent, in the understanding that, as this document did not disclose feature C1.1 of Vorwerk's invention, it represented state of the art very distant from the invention. The second challenge, departing from Philips' patent, on the other hand, was dismissed by the lower Court, thus considering Vorwerk's patent inventive.

Lidl appealed both findings, stressing that the obviousness of the EP'898 patent should have been assessed starting from Braun's patent, which the first instance Court did not do.

With regard to this first challenge, which started from **Braun's patent**, the Barcelona Court of Appeals refused the lower Court's approach to plainly dismiss the same on grounds that Braun did not represent the closest prior art to the invention. The Court recalled in this respect its previous case law, pursuant to which Courts shall be consistent with the parties' claims as filed, so, if there are several possible starting points, each of the hypotheses put forward shall be analysed (unless there are justified grounds for a straightforward rejection). The Court of Appeals further remarked that, according to the EPO Guidelines for Examination, there can be several equally valid starting points for assessing inventive step, whereas applying the problem-solution approach starting from all of them is only required if it has

been convincingly shown that all those documents are equally valid springboards. Therefore, in the Court's view, in order to reject a starting point proposed by the party challenging validity, it is necessary to rule out that it is an equally valid starting point, for which it is not sufficient to simply assert that there is a better starting point.

With these considerations in mind, the Court of Appeals found that Braun's patent, contrary to the opinion of the lower Court, could not be discarded as the closest prior art in assessing the obviousness of Vorwerk's patent, since it related to cooking machines that still had many similarities with the one described in the EP'898 patent.

When applying the problem-solution approach starting from Braun's patent, the Court of Appeals found that the only difference between the latter and the claimed invention would be limited to the aforementioned 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"*), the technical effect being that the locking of the stirring vessel and of the lid prevents access to or intervention inside the stirring vessel when the processor is in operation. Considering the above, the objective technical problem would therefore be, in the Court of Appeals' opinion, how to prevent access or intervention inside the stirring vessel when it is in operation.

The Court of Appeals then noted that the skilled person would have referred to the technical background information of the EP'898 patent itself, mentioning that this feature was known in the prior art, namely in Philips' patent (D3) and in Matsushita's patent (D6), and that both patents actually describe a safety system consisting of locking the container's lid, thus preventing access to the inside during the device's operation. Therefore, the Court of Appeals determined that the solution to the objective technical problem provided for by patent EP'898 was obvious to the skilled person, and hence that Vorwerk's patent was also invalid for lack of inventive step.

The same conclusion was reached when considering the second of the inventive step challenges raised by Lidl, starting from **Philips' patent** (D3). In this case, the difference focused on the weighing mechanism, and therefore on features C1.4 and C1.6. The Court of Appeals thus understood that the objective technical problem would be the one described in the EP'898 patent itself, that is, how to achieve a cooking machine that combines a safe mechanism and a weighing system independent of the switch operation. And, the Court noted, the skilled person would then resort to Braun's patent (D1) to solve that problem given that, as previously found, it discloses all the features of the invention save for C1.1. The solution would be obvious to the skilled person in view of Ronic's patent (D9) as well.

## ***Infringement***

While considering Vorwerk's EP'898 patent invalid due to added subject-matter and lack of inventive step, the Barcelona Court of Appeals also addressed the appeal arguments challenging the findings of the first instance judgment regarding the patent infringement by Lidl's exploiting its "Monsieur Cuisine Connect" food processor.

The parties had disagreed only on the implementation in Lidl's robot of claim feature C1.1, and had maintained opposite positions as to whether in Lidl's robot the stirring vessel and the lid could be interlocked, thus preventing intervention inside the stirring vessel during operation.

Hence, at this point, the new interpretation given by the Court of Appeals concerning feature C1.1 became particularly relevant. The Court of Appeals maintained that Lidl's interpretation of the patent, according to which, in order to be able to intervene in the stirring vessel, it is necessary to stop the stirring mechanism beforehand, was the correct one and more aligned with the patent description, in addition to being a pre-existing solution in the state of the art, as inferred from the patent description itself.

Considering the evidence submitted by Lidl, the Court of Appeals concluded that its food processor did not reproduce that sequence of steps necessary for safe intervention in the stirring vessel according to the patent. It observed that in Lidl's robot, the lid can be opened without any prior action, that is, without first stopping the stirring mechanism, and it is the opening of the lid by means of a small twist on its axis that actually makes the stirring mechanism stop. Accordingly, no patent infringement could be found in Lidl's "Monsieur Cuisine Connect" robot.

In view of the above, by admitting Lidl's appeal, the Barcelona Court of Appeals reversed the previous judgment issued by Commercial Court no. 5 of Barcelona, fully dismissing Vorwerk's complaint for infringement and instead upholding Lidl's invalidity counterclaim against the EP'898 patent. Vorwerk was further ordered to pay the legal costs of the first instance proceedings related to both the infringement and the invalidity actions.

An extraordinary cassation appeal before the Spanish Supreme Court is still available to Vorwerk. We are not aware of any new filings at this stage.