

FRENCH REPUBLIC
IN THE NAME OF THE FRENCH PEOPLE
COUR D'APPEL OF PARIS



Division 5 – Chamber 1
DECISION OF 29 JUNE 2011

(No. 173, 13 pages)

Docket Number: **09/15755**

Decision referred to the *Cour d'Appel*: judgment of 27 May 2009 – *Tribunal de Grande Instance* of Paris – Docket No. 08/00479

APPELLANT

HEIDELBERG POSTPRESS DEUTSCHLAND GMBH

a company governed by the laws of Germany

represented by its legal representative

Kurfürsten-Anlage 52-60

69115 HEIDELBERG (GERMANY)

Electing address at SCP GRAPPOTTE-BENETREAU ET PELIT-JUMEL, *avoués* before the *Cour d'Appel*

assisted by Mr Jean-Martin CHEVALIER, attorney-at-law, member of the Paris Bar, courthouse box: R159

pleading on behalf of COUSIN & ASSOCIÉS

RESPONDENT

BOBST, S.A

represented by its legal representatives

having its registered office at Route des Flumeaux, 50

PRILLY (SWITZERLAND)

Electing address at SCP FISSELIER-CHILOUX-BOULAY, *avoués* before the *Cour d'Appel*

assisted by Mr Geoffroy GAULTIER, attorney-at-law, member of the Paris Bar, courthouse box: R17

COMPOSITION OF THE COURT:

Pursuant to the provisions of Articles 786 and 910 of the French Code of Civil Procedure, the case was discussed on 18 May 2011, in public hearing, the attorneys-at-law not being opposed to it, before Mr Didier PIMOULLE, Presiding Judge, and Ms Anne-Marie GABER, Judge, in charge of conducting the case.

These judges gave an account of the oral pleadings during the deliberation of the Court, composed of:

Mr Didier PIMOULLE, Presiding Judge

Ms Brigitte CHOKRON, Judge

Ms Anne-Marie GABER, Judge

Court Clerk, during the discussion: Ms Aurélie GESLIN

DECISION: - after hearing both parties

- the decision was made available at the Court Clerk's office, the parties having been previously notified in accordance with the conditions laid down in the second subparagraph of Article 450 of the French Code of Civil Procedure.

- signed by Mr Didier PIMOULLE, Presiding Judge and by Ms Aurélie GESLIN, Court Clerk to whom the minutes of this decision were handed by the signatory Judge.

THE COURT,

Having regard to the appeal lodged by the German company Heidelberg Postpress Deutschland against the judgment handed down by the *Tribunal de Grande Instance* of Paris (3rd chamber, 3rd section, docket No. 08/479), on 27 May 2009;

Having regard to the appellant's latest pleading (10 May 2011);

Having regard to the latest pleading (10 May 2011) of the Swiss company Bobst, the respondent;

Having regard to the closing order of 10 May 2011;

**

WHEREUPON,

Considering that Bobst, holder of European patent No. 1 170 228, filed on 30 April 2001 with a Swiss priority of 16 May 2000 and granted on 28 December 2005, relating to a "device for controlling the means for feeding sheets in a machine", after having had a *saisie-contrefaçon* carried out in Fellmann Cartonnages' premises in Soultz, in Haut Rhin (French administrative division) served a summons for infringement upon Heidelberg Postpress Deutschland for having marketed in France a machine reproducing the characteristics of claims 1 and 3 of its patent;

That the *Tribunal*, in the appealed judgment ordering the provisional enforcement, having held the plea of nullity of the summons initiating the case inadmissible, having dismissed the arguments in support of the invalidity of the *saisie-contrefaçon*, having dismissed the arguments on the invalidity of claim 1 (insufficiency of disclosure, lack of inventive step, lack of novelty) and of claim 3 (lack of inventive step), held the existence of the alleged infringement, enjoined, under penalty, the continued marketing of the machine in dispute, ordered expert investigations to assess the damage and ordered the defendant to pay to Bobst, in addition to compensation in the amount of €50,000, an interim payment of €200,000;

Considering that Heidelberg Postpress, which abandons its plea of nullity of the summons initiating the case, invokes in support of its appeal its plea of nullity of the *saisie-contrefaçon*, its requests for the invalidity of claims 1 and 3 of the patent at issue and disputes the materiality and the liability for the alleged infringement;

That the defendant concludes, essentially, that the appealed judgment should be affirmed;

On the procedure:

Considering that Article 784 of the French Code of Civil Procedure provides that “the closing order may be revoked only if a matter of serious gravity has appeared subsequent to its pronouncement”;

Considering that, in its pleading dated 12 May 2011, Heidelberg Postpress requests the revocation of the closing order of 10 May 2011 so that its communicated exhibit No. 26 “minutes of the hearing of 5 May 2011 before the German federal patent court” may be submitted to the discussion;

Considering that, in its latest pleading on the merits, Heidelberg Postpress mentioned the existence of the decision handed down on that date by this *Tribunal* holding the patent in dispute invalid; that Bobst’s attorney-at-law, who did not deem it useful to reply to the appellant’s pleading seeking the revocation of the closing order, informed the *Cour d’Appel* during the oral pleadings that it did not dispute the existence of the decision of the German court, which, while its grounds are not yet known, is of no interest in this dispute;

Considering that it results from the above that the existence of a grave matter pursuant to the provisions recalled above has not been demonstrated and that, therefore, there is no reason to revoke the closing order of 10 May 2011, nor to authorise the appellant to submit the decision of 5 May 2011 by way of a written submission;

On the saisie-contrefaçon:

Considering that Heidelberg Postpress invokes, as developed before the *Tribunal*, its plea of nullity of the *saisie-contrefaçon* by explaining that the *saisie* was requested by Bobst on the basis of two patents, one of which, subsequently held invalid, must be considered as never having existed, which would, according to Heidelberg Postpress, retroactively deprive the *saisie-contrefaçon* of its entire valid basis, with the fact that the second patent remains being of no consequence since the *saisie-contrefaçon*, initially based on the two titles, should be considered indivisible;

But considering, as rightly held by the *Tribunal*, that the *saisie-contrefaçon* was duly carried out on the basis of two titles which were valid at the time and that the subsequent invalidity of one of the two invoked patents has no effect on the *saisie-contrefaçon* which remains valid, in any case, in that it is based on the second patent in respect of which it is not disputed that Bobst’s action for infringement is admissible;

That, consequently, the appealed judgment should be affirmed in that it dismissed the plea of nullity of the *saisie-contrefaçon*.

On claim 1:

Considering, pursuant to Article L.614.12 of the French Code of Intellectual Property, that “a European patent may be revoked with effect for France on any one of the grounds set out in Article 138, paragraph 1 of the Munich Convention”;

That, pursuant to Article 138, paragraph 1 of the Munich Convention of 5 October 1973, “a European patent may be revoked with effect for a Contracting State only on the grounds that:

[...]

b) the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art”;

That, according to Article 52, paragraph 1, of the Munich Convention, “European patents shall be granted for any inventions, in all fields of technology, provided that they are new, involve an inventive step [...]”;

Considering that Heidelberg Postpress requests that the *Cour d'Appel* hold invalid claim 1 of the French designation of European patent No. 1 170 228 for insufficiency of disclosure, lack of novelty and lack of inventive step;

Considering that it is being referred to the appealed judgment (pages 6 and 7), for the precise description of the invention; that it suffices to recall that it relates to a device for inserting the sheets from a pile of cardboard sheets into a machine which cuts or prints them in a continuous mode (processing machine) and aims at improving the regularity thereof in order to prevent the problems of a paper jam or an interruption of the power supply which might stop the process;

That claim 1 is drafted as follows:

“A device for controlling the means delivering sheets from a pile (4) to a machine processing them, comprising at least one mechanism (1) for lifting the pile, a sheet-inserting means comprising gripping means (29) for supplying sheets to the machine, means for detecting the upper level of the pile comprising a detector of the front level (32) of the pile (4) connected to an input of a computer (37) acting on at least one electric motor (11) of the pile-lifting mechanism (1), and a means for raising the pile (4) in dependence upon the upper level, characterized in that the detector of the front level (32) of the pile (4) comprises means for measuring the extent of the variations in the level of the pile and in that an input of the computer (37) is also connected to a source of information (17) relating to the supply rate of the machine in real time and to the nominal thickness of the sheets, and the output of the computer (37) is connected to at least one frequency varying means (42) for controlling the electric motor or motors (11), the computer (37) being designed so that the value of the signal appearing at its output characterises the difference between the measured level of the pile (4) and the level calculated on the basis of the said nominal thickness and the supply rate and generates a variation in the frequency of the one or more varying means (42) tending to modify the forward speed of the motor (11) in order to make the measured level coincide with a set level.”;

On the description:

Considering that, to be held sufficient within the meaning of Article 138, paragraph 1, b, of the Munich Convention, the description should allow the skilled person to implement the invention over its whole range without undue burden;

Considering that there is no dispute concerning the definition of the skilled person as suggested by Heidelberg Postpress, *i.e.* a “control engineer having completed the training relating to the two-year vocational diploma in industrial control and automatic regulation, the regulation courses in particular, concerning more precisely command and control loops”;

Considering that Heidelberg Postpress argues that the descriptive part of the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art and therefore does not meet the requirements of Article 138, § 1, b of the European Patent Convention insofar as, firstly, the notions of “measuring” and of “extent of the variations in the level of the pile” are vague and imprecise and that, secondly, the patent contains no indication relating to the structure of the means that would enable the operation of such a “measuring [of the] extent of the variations in the level of the pile”, finally, that the description does not mention the use of an “extent of the variations in the level of the pile”;

But considering, on the first point, as rightly explained by Bobst and as rightly held by the *Tribunal*, since it cannot be disputed that the level of the pile varies continuously since it decreases after the departure of each sheet from the pile and must rise again so that the next sheet is at the required height, that the purpose is to continuously measure the extent of this variation or, as the description (column 3, § 10, line 8 and § 13 lines 46-47) clarifies without the ambiguity deceptively put forward by the appellant, to continuously detect the upper level of the pile and to send the computer an

analogical signal for “evaluating in real time the gap between the upper level of the pile, measured by the detector 32, and the reference upper level of this pile”;

Considering, on the second point, that the description specifies (column 3, § 10, lines 5 to 9) “This second detecting means 32 is preferably composed of a fixed camera placed in the vertical direction of the pile 4, so as to send an analogical signal depending on the measured level”; that the charge relating to the absence of an indication concerning the structure of the measuring means is therefore unfounded since the description mentions not only the nature of the detector (a linear camera) but also the position thereof (in the vertical direction of the pile) in order to be able to continuously measure the level;

Considering finally, on the third point, that the description, as mentioned previously, explains the use of the extent of the variations thus measured since the detector 32 continuously sends to the computer 17 the measured variation in the real level of the upper side of the pile, thereby allowing it, through a comparison with the set level calculated depending on the nominal thickness of the sheets and the supply rate of the machine, to determine and transmit to the varying means 42 the data required to accelerate or to slow down and thereby adapt at any time the speed of the motor 11;

On the novelty:

Considering that Article 54 of the Munich Convention provides:

- “1. An invention shall be considered to be new if it does not form part of the state of the art.
2. The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.”

Considering that Heidelberg Postpress insists on asserting that claim 1 of the patent in dispute is invalid for lack of novelty over U.S. patent No. 5, 295,678, filed on 29 October 1992 on the basis of a German priority, referred to as the Lindner patent, which, it alleges, is novelty destroying;

But considering that the *Tribunal* specifically noted that Bobst’s patent in dispute comprises two detectors while the Lindner patent only has one;

Considering, more precisely, that the purpose of the Lindner patent is to control “the lifting of a stack of sheets to be printed in order to keep the currently uppermost sheet of the stack within a certain predetermined height range for reliable removal to a feed table”; that the only sensor mentioned here aims at indicating whether or not the top sheet of the stack, to be transported to the processing machine, is within a given height range so that the suction-based lifting devices, *i.e.* the suction cups which engage the sheet so that it can be transported by pulses to the processing machine, ensure a reliable grip on the sheets, this positive or negative indication being transmitted to a computer which adjusts the lifting speed of the pile so that the upper sheet is kept within the adequate height range;

That the purpose of this sensor does not correspond to that of the sensor 32 of the Bobst patent, but rather to that of the sensor 30 of the same patent, located near the rear top part of the pile and linked to the sucking group 12, described but not claimed because already known, whose operation and motion is controlled by the motor 18, thereby contributing to the proper operation of the device for gripping, lifting and transporting the sheets;

Considering, in reality, that the Lindner patent contains no element comparable to the sensor 32 of the Bobst patent in dispute, which does not measure the height of a sheet to ensure that it is reliably engaged by the lifting device, but rather the variation in the level of the pile in order to reduce the risk of a paper jam or an interruption in the power supply following an untimely modification of the pitch of the layer of sheets, a notion which will be examined later and which is not mentioned at all in the

Lindner patent;

Considering that, therefore, the two sensors 30 and 32 of the Bobst patent in dispute belong to distinct control circuits and fulfil different functions of which only one can be found in the Lindner patent, which patent therefore is not novelty destroying, as was rightly held by the *Tribunal*;

On the inventive step:

Considering that Article 5¹ of the Munich Convention provides that “An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art”;

Considering that Heidelberg Postpress asserts that claim 1 of patent EP 1 170 228 is invalid for lack of inventive step over, firstly, Swiss patent CH 651 807 filed by Bobst on 31 March 1983 and published on 15 October 1985 and, secondly, over the Lindner patent previously examined with regards to the lack of novelty;

Considering that patent EP 1 170 228 in dispute mentions the disadvantage resulting from the prior art as constituted by Bobst’s Swiss patent CH 651 807 as follows (column 1, paragraph 4, lines 43 to 50): “the disadvantage of raising the stack of sheets by pulses is that the least offset between successive pulses may result in a variation in the pitch of the resulting layer of sheets. If the step tolerance exceeds a certain amount, the machine processing the layer of sheets stops and has to be restarted, resulting in substantial loss of production”;

Considering that it results from the explanations of the parties which are not disputed that the cardboard sheets of the pile are not introduced successively in the processing machine in a totally separate manner, the following one entering into the machine only once the one preceding it has already been entirely absorbed, but that they follow one another at such a rapid rate that the gripping and the transfer of the one is executed while the other has not yet totally left the pile, so that each sheet is partly overlapped, during its transfer, by the one following it, and that several successive sheets are therefore assembled together like the tiles of a roof, thereby forming the layer of sheets, the pitch of which measures the portion of each sheet overlapped by the next;

Considering that the description of patent EP 1 170 228 makes it clear that the problem which the invention attempts to solve derives from the observation that, as the thickness of the sheets and their flatness are not totally constant due to various factors such as the hygrometry, the raising of the pile, performed in the prior patent by successive pulses controlled by the decrease in the level of the pile every time a sheet is removed from it – which is not always the same since the thickness of the sheets, as mentioned previously, varies – will no longer be regular in the case of an offset in the pulse rate, leading to modifications of the pitch of the layer of sheets and, consequently, to either an accumulation of sheets at the entrance of the machine (jam) or on the contrary, an interruption of the power supply, and in both cases an untimely stopping of the process; that, therefore, to reduce this disadvantage, one should seek a means to continuously adapt the lifting speed in order to compensate for the unevenness in the thickness and flatness of the sheets;

Considering that Heidelberg Postpress peremptorily contends that the problem thus posed is artificial and that the purpose of the invention at issue is not to obviate the disadvantage as described, but to reduce the risks of premature wear of the machine parts caused by the jolts and the vibrations of any discontinuous regulation system (here the successive pulses of the system from the prior art) by replacing it with a continuous regulation system, which is the natural inclination of any control engineer such as the skilled person concerned by the patent at issue;

¹ Translator’s note: error in the source text, should read Article 56

But considering, in addition to the fact that patent EP 1 170 228 at no time mentions the purely mechanical risk thus mentioned, that the appellant does not seriously dispute the relevance of the problem as defined previously;

Considering that it has already been explained that the invention consists in overcoming the mentioned disadvantage by placing a detector (32) in front of the pile which, measuring continuously – and not at every moment a sheet is taken off the pile – the variation in the level of the pile (4) as compared to a set level, continuously transmits this measure to a computer (37) connected to a varying means (42) which determines at each moment the speed of the motor (11);

Considering that the skilled person obviously finds no indication useful to the invention in patent CH 651 807 since the problem solved by the said invention derives precisely from the limitations of this patent;

Considering, concerning the Lindner patent, that this patent aims at “controlling the lifting of a stack of sheets to be printed in order to keep the currently uppermost sheet of the stack within a certain predetermined height range for reliable removal to a feed table”; that it at no point mentions the risk of a paper jam or an interruption of the power supply of the processing machine which could occur following a modification of the pitch of the layer of sheets due to some inaccuracy in the pile-lifting movement; that it only aims at optimizing the operation of the sheet-gripping system, *i.e.* of the sucking group; that, to achieve this result, it implements a sensor which, far from continuously detecting the extent of a variation as in patent EP 1 170 228, only indicates whether the height of the top sheet is comprised between two lower and upper limit values, leading to a slower speed for lifting the pile if the height is too great and to an increased speed if it is insufficient; that this system is compatible both with a lifting of the pile by successive pulses as described in patent CH 651 807 and with a system for the continuous regulation of the lifting;

Considering that the Lindner patent certainly mentions the advantages of continuous regulation in comparison with discontinuous regulation, above all concerning the processing of relatively heavy sheets such as cardboard and at a rapid rate, insofar as, as it mentions (page 3 lines 25 *et seq.*) “at high switching frequencies the pallet and stack tend to vibrate, particularly in the associated mechanical lifting gears. These vibrations cause the stack (...) to experience unpredictable movements. As a result of these vibrations, (...) problems often occur in attempting to reliably lift the top sheet”;

But considering that this problem is not the subject-matter of the invention covered by the Lindner patent; that the said invention, which only aims at ensuring a reliable gripping of the top sheet, also operates with a continuous or discontinuous regulation system for lifting the pile;

Considering that the skilled person, facing the previously mentioned limitations of patent CH 651 807, who does not encounter any difficulty in gripping the sheets since, as mentioned in this patent (page 2, lines 4 to 7) “To ensure a continuous sheet-supply, several known devices control the raising of the lifting device supporting the sheet pile by means of a sensor detecting the position of the sheet of the pile close to the means equipped with suction cups”, has no reason to search the Lindner patent for the solution to a problem which this patent does not consider, a patent which, on the contrary, addresses a problem which he considers as already solved;

Considering, therefore, that the invention in dispute does not consist, as asserted by the appellant, of adapting, through a simple implementation measure, the device for controlling the pile-lifting speed according to the Lindner prior art document to patent CH 651 807, the Lindner prior art document only controlling the position of the top sheet within a certain range in relation to the sucking group, but rather in designing a system for a continuous raising of the pile through a continuous adjustment of the lifting speed in order to make the measured level in the front part of the pile coincide with a set level at any given time;

Considering, to sum up, that the invention of patent EP 1 170 228 is characterised, in comparison with the prior art including the Lindner patent:

- by the use of a second sensor, which is no longer located near the sucking group but at the front of the pile,
- by a change in the nature of the detected information, no longer the presence, or lack thereof, of a sheet between two height limits defined for the proper operation of the sucking group, but the continuous variation in the real level in the front part of the pile as compared to a set level,
- by a change in the implementation of the speed varying means, no longer only when the proper operation of the sucking group requires it, but continuously;

That these different changes in points of view did not derive in an obvious manner from the evolution of the technique, but characterise a real inventive step, as was rightly held by the *Tribunal*;

On claim 3:

Considering that claim 3 of patent EP 1 170 228 is drafted as follows:

“A device according to claim 1, characterized in that the lifting mechanism (1) is associated with an auxiliary supply device (50) controlled by a motor (53) connected to the computer (37) such that its forward speed is determined by the same information as used for controlling the one or more electric motors (11) of the lifting mechanism (1)”;

Considering that it results from the explanations of Heidelberg Postpress, which is not contradicted on this point, that this claim relates to a device according to claim 1 to which is associated an auxiliary supply device, making it possible to reload the sheet pile without interrupting the supply process of the processing machine, and therefore called “non stop”;

That the appellant invokes before the *Cour d'Appel* its ground for invalidity of this claim 3 taken from the lack of inventive step, such an auxiliary supply device being, according to it, disclosed in particular by the Mersereau patent No. 4 052 051 of 4 October 1977;

But considering that the *Tribunal* has rightly noted that, since claim 1 has been held valid, the dispute concerning the validity of claim 3, which depends on claim 1, is without object;

On the infringement:

Considering that the report on the *saisie-contrefaçon* drafted on 17 December 2007 by the bailiff firm Schaming et Schneider made it possible to note the presence, in Fellmann Cartonages' premises, in Soultz, in Haut Rhin, of a machine of the brand “Dymatrix 106 CSB” bearing an identification plate mentioning the name of Heidelberg Postpress, the serial number of the machine being MN.DEBO.00022 and the production year, 2006;

Considering that Heidelberg Postpress disputes the materiality of the alleged infringement, and, in the alternative, contests its liability for the alleged infringement;

On the materiality of the infringement:

Considering that the appellant contends that, in the absence of a real analysis of the machine structure, the statements in the *saisie-contrefaçon* report and the seized exhibits cannot constitute admissible items of evidence and, in any case, establish neither the presence of means for measuring the extent of the variations in the level of the pile, nor that of a computer likely to send a signal characterising the difference between the measured level of the sheet pile and that which is calculated on the basis of the nominal thickness of the sheets and of the supply rate and to generate a variation in the frequency of

the varying means tending to modify the forward speed of the motor to make the measured level coincide with a set level;

Considering, on the first point, that the *saisie-contrefaçon* report (page 7, paragraph 2) expressly notes “the presence of a detector located at the top of the pile”; that Heidelberg Postpress asserts (page 43 of its latest pleading) that this detector absolutely does not measure variation but rather, at most, the height of the upper edge of the pile in relation to the sheet flap;

But considering that this assertion, which, in addition, is not supported by any technical documentation, does not contradict the existence of a continuous measurement of the variation in the upper level of the pile, which constitutes the principle of claim 1;

Considering indeed that it emerges from the seized documents, in particular from the “service manual” taken from a file containing the directions for use of the 106 CSB machine (page G-36) that “the height of the upper edge of the pile of sheets is subject to a continuous gripping”;

Considering, in addition, that the photographs 5 and 6 of the *saisie-contrefaçon* report, which show the make-up of this detector of the Dymatrix 106 CSB machine, corroborate the technical explanations on its operation given by Bobst (page 36 of its latest pleading) and not refuted by the appellant;

That it results therefrom that this detector is composed of two light-emitting cells whose beam is focused on the upper edge of the pile and between which is placed a sensor made of a group of receiving cells arranged in the vertical direction which makes it possible to continuously determine, depending on the illuminated or non-illuminated basic cells, the exact height of the upper edge of the pile;

Considering that the presence, in the Dymatrix 106 CSB machine, of a system of continuous measurement of the extent of the variation in the level of the pile characteristic of claim 1 is thus established;

That, in addition, on 21 May 2010, Bobst had a *saisie conservatoire*² carried out in the Netherlands, where the machine had been transported following the *saisie-contrefaçon*, which made it possible to show that it was equipped with a type KA958 sensor manufactured by Leuze Electronic, identical to that equipping its own machines, which definitively ruins Heidelberg Postpress’ argument on an alleged difference between the nature and the function of the sensor of its machine and those of the sensor described in claim 1 of patent EP 1 170 228;

Considering, in this respect, that Heidelberg Postpress, which does not expressly request that the *Cour d’Appel* set aside from the discussion the documents seized on 21 May 2010 submitted to the discussion pursuant to the order of the Judge in charge of the case preparation dated 1 March 2011 ruling on an issue relating to the communication of these exhibits, nevertheless requests that the *Cour d’Appel* hold this *saisie conservatoire* invalid as, according to Heidelberg Postpress, the Dutch Judge had no jurisdiction to authorise since this operation, which was merely the continuation of the *saisie-contrefaçon* of 17 December 2007, the *saisie conservatoire* could only be ordered by the Presiding Judge of this Court, to whom this dispute was referred, pursuant to Regulation EC No. 1206/2001 relating to the cooperation between the courts of the Member States in the taking of evidence in civil or commercial matters;

But considering, assuming that the *Cour d’Appel* has the jurisdiction to hold the decision rendered by a foreign court invalid, that the mentioned regulation, the object of which (Article 1 *Scope*) is to provide, with the sole purpose of facilitating the taking of evidence, that it should be possible for the Judge of a Member State to request “a) the competent court of another Member State to take evidence; or b) to take evidence directly in another Member State”, does not result in prohibiting the concerned

² Translator’s note: the provisional seizure of goods

party from itself performing all the taking of evidence which it considers useful to assert its rights in a foreign State pursuant to the applicable law in that State;

Considering, on the second point, that Heidelberg Postpress contends that the alleged infringing device does not calculate reference levels based firstly on the nominal thickness of the sheets and, secondly, the supply rate of the processing machine, which the real level of the upper edge of the pile should be continuously approaching; that it results, on the contrary, from the service manual of the Dymatrix 106 CSB machine (page G20) that “the upper edge of the main pile is therefore at an optimal height in relation to the sheet flap”, therefore with no reference to a set level as mentioned in claim 1 of patent EP 1 170 228;

But considering that the *saisie-contrefaçon* report mentions (page 6) that the slowing down of the processing machine leads to a proportional reduction in the lifting of the tray (*i.e.* the tray supporting the pile), which always moves smoothly, which demonstrates the existence of a link between the processing speed and the pile-lifting speed; that, in addition, the service manual mentions (page G19, paragraph 3) that “the automatic control of the pile [...] controls [...] the movement of the pile in dependence on the speed of the machine and the thickness of the paper”; that the fact that these data are taken in to account to calculate the pile-lifting speed is thus demonstrated;

That it is further explained (page G20) that “during the processing of the main pile, the raising of the pile is carried out by the automatic control of the pile. The upper edge of the main pile is therefore at an optimal height in relation to the sheet flap”;

Considering that all these indications show that the calculation of the raising movement of the pile takes into account the nominal thickness of the sheets and the rate of the processing machine, such that the upper level of the pile has an optimal position in relation to the sheet flap; that it results from Bobst’s explanations, which are not disputed, that this tilting flap for sheet guidance has holes precisely so that, regardless of its position, the light beams of the cell sensor can pass through and check the real level of the upper edge of the pile, and possibly lead to its modification in order to keep it at the optimal level defined above;

Considering, in addition, that the *saisie-contrefaçon* report demonstrates the presence of a varying means, so that the second point of the dispute relating to the materiality of the infringement is not founded;

Considering, finally, that the service manual sets out (page G36) that “the lifting-rate of the main and auxiliary piles is adapted to the thickness of the sheets and to the speed of the machine”, which shows not only that the Dymatrix 106 CBS machine includes an auxiliary device as the one mentioned in claim 3, which, besides, is not disputed, but further confirms that the thickness of the sheets and the processing speed are taken into account in the operation of the main and auxiliary sheet-feeding devices;

Considering that it results from all the above-mentioned that the appealed judgment should be affirmed in that it held the materiality of the infringement of claims 1 and 3 of patent EP 228;

On the liability for the infringement:

Considering that Heidelberg Postpress asserts that it has not “offered for sale, imported and/or delivered in France to Fellmann Cartonages the Dymatrix 106 CSB machine found in the premises of this company” and that, therefore, it has committed no act of infringement on the territory on which the French designation of patent EP 1 170 228 has effect pursuant to Articles L.615-1 and L.613-3 *et seq.* of the French Intellectual Property Code;

But considering that the appellant, which does not dispute that it has manufactured the Dymatrix 106 CSB machine No. DEBO.00022 at issue and which explains that it has sold it to Heidelberg

Druckmaschinen which itself has sold it again to Heidelberg France which signed the deposit/test contract with Fellmann Cartonnages, does not question the previous statements contained in its pleading before the *Tribunal*, as reported by Bobst, from which it results that the machine has been installed at Heidelberg Postpress' expense on the premises of Fellmann Cartonnages to be tested there;

That Bobst relevantly adds that, taking into account the size and weight of the machine of more than 35 tons, it is not reasonable to think that it would first have been transported from its manufacturing place, Mönchengladbach, to Heidelberger Druckmaschinen's registered office in Wiesloch, and then from there to Tremblay in France, Heidelberg France's registered office, to be transported later in Haut-Rhin;

Considering, in addition, that the invoice relating to the sale of the machine by Heidelberg Postpress to Heidelberger Druckmaschinen (exhibit No. 14 of the appellant) expressly mentions that the machine is intended for Fellmann Cartonnages 2 rue Henry Rouby, which is the address of this company in Soultz, Haut-Rhin; that it results therefrom that Heidelberg Postpress cannot seriously assert that it did not deliver the machine in France while, furthermore, it is established that it delivered two other Dymatrix 106 CSB machines No. 00021 and DEBO 00027 in France;

Considering that it results therefrom that the appellant's argument, through which the appellant seeks to contest its liability for the acts of infringement of which it stands accused, is not founded and should be dismissed;

Considering, finally, that the appealed judgment should be affirmed in all its provisions;

Considering that the nature and the circumstances of the dispute require acceding to Bobst's requests relating to the publication of the decision at Heidelberg Postpress' expense;

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ON THESE GROUNDS:

AFFIRMS the appealed judgment in all its provisions,

ORDERS the publication of the decision by extracts in three French or foreign journals, at Heidelberg Postpress' expense and at the choice of Bobst in an amount not exceeding €6,000, excluding taxes, per insertion,

ORDERS Heidelberg Postpress to pay the costs of the appeal which will be recovered pursuant to Article 699 of the French Civil Procedure Code and to pay €80,000 to Bobst pursuant to Article 700 of the French Code of Civil Procedure.

THE COURT CLERK, THE PRESIDING JUDGE,