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## Reformulation of technical problem not permitted during litigation

**A recent decision from the Court of Milan confirmed the case law trend that the reformulation of a technical problem solved by a patented invention is inappropriate during legal proceedings.**

### Relevant law

Article 51(2) of the Industrial Property Code states that an invention must be “described in a sufficiently clear and complete manner so that any person who is an expert in the field can implement it”.

According to Article 21(3) of the Regulations for Implementation of the Industrial Property Code, the description of a patent must, among other things, “explain the invention in such a way that the technical problem and the proposed solution can be understood”.

European patents are also expected to present the technical problem in the description in such a way that it can be clearly understood. According to Rule 42 (1)(c) of the European Patent Convention, the description should – at least implicitly – mention the technical problem that the invention intends to solve and its solution, together with any advantageous effects of the invention with reference to the prior art. According to the Guidelines for Examination in the European Patent Office (EPO), this allows the technical problem underlying the invention to be recognised despite the fact that it might not immediately be apparent from the claims.

Failure to satisfy these provisions results in refusal of the application.

### Background

The definition of a 'patentable invention' as a “new and original solution to a technical problem” is well established in the Industrial Property Code and the European Patent Convention.

During the prosecution of a European patent application before the EPO, it is also well established that the definition of the objective technical problem may change as a function of the available prior art, which in turn may change over time following further searches (or during opposition proceedings as a result of newly submitted prior art documents). In light of the above, the definition of the objective technical problem that an invention intends to solve is often more dynamic than static during EPO pre-grant or opposition proceedings.

For Italian patents, a reformulation of the technical problem during court proceedings has been addressed several times, in particular when the basis of a newly proffered technical problem is not already evident in the patent description.

In 2009, in agreement with a 2005 Court of Milan decision, the Court of Cassation confirmed (with two decisions) that the inability to understand the technical problem that the patent is intended to solve results in an inability to identify the inventive step required for the patent validity assessment, even if the solution to the problem is new compared to the known prior art. In addition, the court stated that inventive activity can be recognised only when a solution to a concrete technical problem is claimed, or otherwise described, in the patent.

The first-instance Court of Milan decisions and the Court of Cassation decisions highlighted that the absence of a technical problem in the description cannot be cured after the fact. Decisions in 2010 by the Court of Milan and the Court of Bologna strengthened the trend that failure to disclose a technical problem in a patent cannot be remedied later during court proceedings.

In particular, in 2010 the Court of Milan noted that the formal requirement for a clear and complete description of the technical problem cannot be remedied using inferences or investigations by a technical professional. In 2012 the Court of Bologna reached the same conclusion based on similar facts.

### Ongoing trend

In a 2015 decision, the grounds of which have been published recently, the Court of Milan again confirmed this trend.

In October 2012 Whirlpool Corporation and Whirlpool Europe srl sued Samsung Electronics Italia spa for infringement of the Italian portion of European Patent EP1925704, relating to washing machine drums. Samsung responded by asserting a counterclaim of invalidity. During the proceedings for evaluating invalidity, Whirlpool attempted to reformulate the technical problem solved by the invention. Whirlpool argued that the technical problem was not related to providing a better solution with respect to the state of the art, but was directed to providing an acceptable and effective alternative solution consistent with the EPO Guidelines for Examination (G-I, 3 and G-VII, 5.2 of the guidelines).

In 2015 the Court of Milan issued a decision invalidating a subset of the claims of the patent due to lack of inventive step. Despite the fact that the court based its invalidity arguments on an obvious combination of technical solutions disclosed in two prior art documents, the decision went further, addressing the “technical problem reformulation issue”.

The court found that:

*“Italian case-law... is consistent in considering illegitimate a reformulation of the technical problem identified in the patent during litigation... The board adheres to this trend, sharing the opinion of Samsung that [the inadmissibility of the reformulation] is perfectly compatible with the EPO guidelines. Also, in this case, the controversial burden of proving the presence of technical benefits or other technical effects fell entirely on Whirlpool. In fact, the presumption of validity of the patent after grant may not go beyond what is reported in the patent itself (as technical effects other than those described therein).”*

### **Comment**

The board's decision reaffirms the importance of disclosing, or at least being able to demonstrate, how the technical features of the invention described in a patent application contribute to a specific technical advantage or effect which solves one or more technical problems.

Given the clear emergence of the strong trend in this direction, it is best to consider this as a rule that must be taken into account in order to avoid the risk of patent invalidity during litigation based on a lack of sufficient disclosure of the technical problem solved by the invention.

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