



Davide Rondano

Partner, Dr. Ing., Italian and European Patent Attorney, Professional Representative in Community Design matters before the EUIPO. CEIPI Diploma on Patent Litigation in Europe. Davide graduated in Mechanical Engineering from the Polytechnic of Turin.

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8 June 2016 – IAM Weekly E-mail (*)

Court of Cassation rules on patent infringement by equivalence

A recent Court of Cassation decision has affirmed the principle that a variant of a patented invention that is not original over the patent (i.e., does not exceed the technical skills of the skilled person) falls within the scope of the patent.

Relevant legal provisions

Article 52(2) of the Industrial Property Code states that the extent of protection conferred by a patent is determined by the wording of the claims. The description and drawings serve to interpret the claims. This provision corresponds to Article 69 of the European Patent Convention.

Moreover, according to Article 52(3) of the Industrial Property Code, the provision must be applied so as to ensure both fair protection for the patent proprietor and a reasonable degree of legal certainty for third parties. Paragraph *3bis* of the article states that for the purpose of determining the extent of the protection of a patent, "due account should be taken of any element which is equivalent to an element specified in the claims". These provisions apply the principles set out in Articles 1 and 2 of the Protocol on the Interpretation of Article 69 of the European Patent Convention.

Background

When assessing the alleged infringement of a patent by a product or process, literal infringement of the patent (i.e., the exact reproduction of all the features of the main claim of the patent by the allegedly infringing product or process) is usually assessed first. If no literal infringement is found at this stage because one or more features of the main claim of the patent are not reproduced exactly by the allegedly infringing product or process, then it must be established whether the patent is infringed under the doctrine of equivalents.

Neither the European Patent Convention (including the Protocol of the Interpretation of Article 69) nor the Industrial Property Code provides a definition of 'equivalents'. However, consolidated Italian case law confirms that a patent must be considered as infringed under the doctrine of equivalents when the differences between the allegedly infringing product or process and the main claim of the patent do not make the product or process original over the claimed invention. In this regard, in a 2004 decision the Court of Cassation stated that:

"for the purpose of assessing whether the allegedly infringing solution is to be regarded as equivalent to the patented one, and therefore as infringing the patent, it must be ascertained whether, in order to reach the same final result, it is an original solution... which exceeds the technical skills of the skilled person in the art that is faced with the same problem."

Moreover, according to relevant case law a patent is also infringed under the doctrine of equivalents when the allegedly infringing product or process reproduces the core of the patented invention, even if it does not reproduce all the features of the main claim of the patent. For example, in 2011 the Court of Cassation ruled that "in order to exclude infringement by equivalence, it does not matter if a single element of the patented solution has been changed, even if it is changed in an original way, if this change does not lead to excluding the possibility that the patent is, at least partially, used". According to a 2013 Court of Cassation decision, infringement exists if the "inventive core of the protected idea" is reproduced.

Decision

This rather broad interpretation of the principle of patent infringement by equivalence was recently used by the Court of Cassation in *Omac srl v Galli SpA* (Decision 22351, November 2 2015). The Court of Cassation confirmed a decision issued by the Bologna Court of Appeal, according to which a patent relating to a machine for loading, unloading and coupling leather strips was found to be infringed under the doctrine of equivalents because the machine sold by the alleged infringer represented a variant of the patented solution not exceeding the technical skills of the skilled person faced with the same problem as that underlying the invention.

In particular, the Court of Cassation held that the approach followed by the Bologna Court of Appeal, in which it first identified the core of the invention before assessing whether the patent was infringed, was correct. Since the core of the invention was actually reproduced by the allegedly infringing machine, the fact that the latter reproduced only part of the features of the main claim of the patent was considered insufficient to exclude infringement under the doctrine of equivalents.

Comment

The Court of Cassation decision confirms the importance of considering equivalence carefully when assessing infringement of a patent. If the product or process in question does not exactly reproduce all the features of the main claim of the patent, it must be established which features of the main claim define the core of invention and whether these features are reproduced by the product or process in question, irrespective of whether other features of the claim are reproduced. In particular, the courts should assess whether the product or process, although not reproducing all the features, differs from the patented invention in its core elements.

For further information please contact:

Davide Rondano
Jacobacci & Partners
www.jacobacci.com
Email: drondano@jacobacci.com
Phone: (+39) 011.2440311

(*) *Jacobacci & Partners - IAM Country contributor for Italy*

