**COMMERCIAL COURT No. 1 OF BARCELONA**

**PATENTS SECTION**

 **Judges:**

 Mr. Alfonso Merino Rebollo

Mr. Florencio Molina López

Ms. Yolanda Ríos López

**Matter: Ordinary Proceedings No. 353/2016 Section E**

**Plaintiff:**

Court Attorney: Ángel Joaniquet Tamburini

Lawyer: Luis Fernández-Novoa Valladares

**Defendant:**

Court Attorney: Ignacio López Chocarro

Lawyer: Alejandra Matas Brancós

**Subject matter of the proceedings:** patent rights infringement and validity.

**DECISION No. 84/2018**

 Barcelona, 26 March 2018

**FIRST.-** On May 17, 2016, Mr. ÁNGEL JOANIQUET TAMBURINI, Court Attorney, filed a complaint on behalf of the company SCA TISSUE FRANCE SAS (hereinafter SCA), domiciled at 151-161 Boulevard Victor Hugo, 93400 Saint Ouen, France, against the company INDUSTRIE CARTARIE TRONCHETTI IBÉRICA S.L. (hereinafter ICT) based on the infringement of claims 1, 2, 3, 4, 6 and 9 of patent ES 2.299.237 (Spanish part of the European patent EP 1.081.284), in relation with the manufacturing and marketing of the products commercially known as *FOXY SEDA and FOXY BOUQUET, LANTA 3 CAPAS, DIA PREMIUM, AUCHAN SUPREME and AUCHAN FLORAL.*

In the pleading section of the complaint it is requested the Court to issue a Decision:

**a) which declares:**

1.1.- That SCA TISSUE FRANCE SAS is the legal owner of the patent ES 2.299.237.

1.2.-That the defendant, INDUSTRIE CARTARIE TRONCHETTI IBÉRICA S.L., is manufacturing and/or importing, offering and marketing in Spain toilet paper products named FOXY SEDA and BOUQUET, LANTA 3 CAPAS, DIA PREMIUM, and AUCHAN SUPREME and FLORAL which make use of the technology protected by the patent ES 2.299.237 (EP 1.081.284) owned by SCA TISSUE FRANCE SAS, without permission of authorization from SCA, thus violating its rights and in infringement of the provisions of the Law 11/1986 of March 20 on Patents previously mentioned in this writ.

1.3.- And as a result of the foregoing:

**b) which orders** INDUSTRIE CARTARIE TRONCHETTI IBÉRICA S.L.:

1.4.- To obey and abide by the previous declaratory decisions.

1.5.- To cease in any actions that infringe the intellectual property rights of SCA TISSUE FRANCE SAS as legal owner of the patent ES 2.299.237 (EP 1.081.284).

1.6.-To cease in the importation, distribution, offering and marketing in Spain of the toilet paper products below:

* FOXY SEDA
* FOXY BOUQUET
* DIA PREMIUM
* AUCHAN SUPREME
* AUCHAN FLORAL
* LANTA 3 CAPAS

1.7.- or any other which falls within the scope of protection of the patent claims.

1.8.- To pay, as compensation for damages suffered in accordance with the criteria of “*hypothetical royalty*” as provided in Article 66(2)(b) Patent Act (PA), 4% of the net sales of the toilet paper products below (to be determined during the enforcement phase):

* FOXY SEDA
* FOXY BOUQUET
* DIA PREMIUM
* AUCHAN SUPREME
* AUCHAN FLORAL
* LANTA 3 CAPAS

or any other which falls within the scope of protection of the patent claims.

19.9.- To bear seizure and destruction of the toilet paper products:

* FOXY SEDA
* FOXY BOUQUET
* DIA PREMIUM
* AUCHAN SUPREME
* AUCHAN FLORAL
* LANTA 3 CAPAS

that it may have in stock, as well as of any other which falls within the scope of protection of the patent claims.

1.10.- To bear destruction of all equipment and materials intended for the production of the toilet paper products:

* FOXY SEDA
* FOXY BOUQUET
* DIA PREMIUM
* AUCHAN SUPREME
* AUCHAN FLORAL
* LANTA 3 CAPAS

or any other which falls within the scope of protection of the patent claims.

1.11.- To publish the Decision against the defendant at its expense in the journals “El País” and “Expansión”, in accordance with as provided in Article 63(1)(f) PA.

1.12.- To pay the legal costs of these proceedings.

**SECOND.-** The complaint was accepted by Order dated May 18, 2016, summoning the defendant to reply to the complaint in 20 days.

**THIRD.-** On June 21, 2016, INDUSTRIE CARTAIRE TRONCHETTI IBÉRICA S.L. replied to the complaint, opposing to it and requesting its dismissal based on the following:

3.1.- **Prescription of the action and subsidiary belated institution of the action or unfair delay.** The action has prescribed due to the lapse of the five years period “*from the date on which it could have been brought*”, as foreseen in art. 71.1 Patents Act. The product FOXY SEDA was launched to the market on 2007, and the first cease and desist letters date 2014.

3.2.- **Non-infringement** as the products marketed are different from those manufactured under the patented technology; as well as the production process applied to obtain them (note, page 26 in fine of the reply to the complaint [page 18 on HRM ENG translation]).

 Specifically, the defendant states that its products do not reproduce the following feature: “*the central ply (4) and the embossed upper outer ply (3) are associated by means of a so-called “nested” mode, with said embossed lower outer ply (2) being at the level of at least part of the peaks of the first pattern (5) of said embossed lower outer ply (2)”* due to the fact that its products comprises three plies, a lower ply, an upper ply, and a middle ply, associated by means of an embossed pattern having protrusions turned towards the interior of the structure, said protrusions opposing a third, intermediate ply, that is, using the “**tip-to-tip”** method of association which is not within the scope of the patent (page 48, second paragraph reply to the complaint [page 37 on HRM ENG translation]).

 Therefore, ICT’s products comprise three plies, two joined by embossing and a third bonded to the other two with adhesive by “tip-to-tip” association, with the same motif reproduced in an overlapping position on all three plies (page 50, second paragraph of the reply to the complaint [page 39 on HRM ENG translation]).

3.3.- By means of a Counterclaim the defendant **brought a nullity action against the claims 1 to 6 of patent ES ‘237,** requesting the cancelation of the patent before the Spanish Trademark and Patent Office, **alleging lack of inventive step,** based on two different constructions:

 Starting from *US 5840404* **as the closest prior art document**, which would only miss one technical feature (related with the protrusions density). The combination with document *US 5846636* would anticipate a nesting of the patterns having those patterns a density higher than 30 protrusions/cm2 (Col. 2, line 37).

 Starting from *FR 9802792* **as the closest prior art document,** being acknowledge by the applicant that said document comprehends all the technical features of the patent’s Preamble, departing from said document and testing a nested pattern having a protrusion density greater than the limit set in the Preamble, the expert would reach the missing feature (page 67 in fine and 70 of the counterclaim [page 56 on HRM ENG translation]).

**FOURTH.-** On November 14, 2016, the plaintiff replied to the counterclaim, opposing to it and requesting its dismissal, based on the following reasons:

 4.1.- The patent FR 9802792 is not part of the prior art for inventive step purposes, since it was published on September 1999, after the filing date of the patent application ES 237 on August 31, 1999 (Exhibit 2, filed with the reply to the counterclaim).

In this regard, it can be argued that the determination of the relevant state of the art to prosecute the nullity of the patent for lack of inventive step excludes, ex Article 54.3 EPC the documents published after the date of the patent application whose validity is subject to examination.

In no way does the previous conclusion erode that the very description of the patent ES'237 can make any reference to the document FR 9802792, insofar as it comes from the same applicant, given that the patent whose nullity is prosecuted can not be part of the "state of the art" for the purposes of validity analysis for an alleged lack of inventive step.

 4.2.- Regarding the lack of inventive step attack based on US 5840404 (as the closest prior art) combined with the teachings disclosed by document US 5846636, the plaintiff argues that it does not lead to the obviousness of the inventive solution protected by the patent.

**FIFTH.-** The pre-trial hearing was held on February 23, 2017. The parties did not reach any agreement. After establishing the controversial facts, they proposed documental, witness and expert evidence, those means of evidence considered pertinent and useful by Court were admitter. Then, the trial date was established.

**SIXTH.-** On July 5 and 6, 2017, the trial was held, the proposed and accepted means of evidence were put into practice, and, after the parties presented their conclusions, the case was remitted for decision.

**SEVENTH.-** The present case was submitted for the consideration and deliberation of the Patent Section of the Commercial Court of 1st Instance of Barcelona, integrated by Mr. Alfonso Merino Rebollo, Mr. Florencio Molina López and Mrs. Yolanda Ríos López, within the framework of the Protocol of the Statute of the Commercial Court of First Instance of Barcelona, approved by agreement of July 15, 2014, by the Permanent Commission of the CGPJ and revised by the Agreement of the Permanent Commission of the CGPJ dated February 18, 2016.

**LEGAL GROUNDS**

**FIRST.-** **Proven Facts.**

The following are the relevant facts to take into account to solve the present case:

1.1.- The company SCA TISSUE FRANCE SAS is the holder of the European Patent EP 1.081.284, validated in Spain as ES 2.299.237, applied for before the European Patent Office (EPO) on August 31, 1999, published on March 7, 2001 and granted on January 2, 2008 (expiring on August 31, 2019).

1.2.- Patent ES’237 comprehends 18 claims, being the first and the twelfth independent claims; the rest depend on the aforementioned ones.

1.3.- **Claim 1** protects the following invention:

*“1. Product made of absorbent paper with a gram weight of about 36 to about 105 g/m2, comprising at least three plies (2,3 and 4): two embossed external plies, lower (2) and upper (3) and a central ply (4), wherein the external plies (2,3) each comprise patterns in relief (5,7 and 9), consisting at least partly of discrete protuberances (6, 8 and 10), wherein the distal surfaces of at least a part of the protuberances of each of said external plies (2,3) are turned towards the central ply (4), and wherein at least one of the external folds has a pattern density higher than 30 protuberances/cm2, wherein the lower embossed external ply (2) has a first (5) and a second (7) pattern, the second pattern having a height lower than the first pattern, so that the central ply (4) and the upper embossed external ply (3) are associated with said lower embossed external ply (2) in a so called “nested” manner at the level of at least a part of the tips of the first pattern (5) of the lower embossed external ply (2).”*

1.4.- It comprehends the following technical features:

C1.- Product made of absorbent paper with a gram weight of about 36 to about 105 g/m2

C2.- comprising at least three plies,

C3.- two embossed external plies, lower (2) and upper (3) and a central ply (4),

C4.- wherein the external plies (2,3) each comprise patterns in relief (5,7 and 9), consisting at least partly of discrete protuberances,

C5.- wherein the distal surfaces of at least a part of the protuberances of each of said external plies (2,3) are turned towards the central ply,

C6.- wherein at least one of the external folds has a pattern density higher than 30 protuberances/cm2,

C7.- wherein the lower embossed external ply (2) has a first (5) and a second (7) pattern, the second pattern having a height lower than the first pattern,

C8.- characterized in that the central ply (4) and the upper embossed external ply (3) are associated with said lower embossed external ply (2) in a so called “nested” manner at the level of at least a part of the tips of the first pattern (5) of the lower embossed external ply (2).

1.5.- **Claim 2** protects the following invention:

*“2. The product according to claim 1, characterized in that the three plies are connected by adhesive (11) at the level of the first pattern (5)”*

1.6.- **Claim 3** protects the following invention:

*“3. The product according to claims 1 and 2, characterized in that each of the external embossed plies (2, 3) has a total density of patterns (5, 7, 9) of less than 150, preferably less than 90 protuberances/cm2.”*

1.7.- **Claim 4** protects the following invention:

*“4.The product according to Claim 1, characterised in that the external embossed upper ply (3) comprises a second pattern with a height different from that of the pattern (9).”*

1.8.- **Claim 5** protects the following invention:

*“5. Product according to any one of claims 1 to 3, characterised in that the pattern (5,7,9) densities of the embossed outer plies are different.”*

1.9.- **Claim 6** protects the following invention:

*“6. The product according to one of Claims 1 to 5, characterised in that the gram weight of the central ply (4) is different from the gram weight of at least one of the external embossed plies (2, 3).”*

1.10.- **Claim 7** protects the following invention:

*“7. The product according to any of Claims 1 to 6, characterised in that the fibrous and/or chemical composition of the central ply (4) is different from that of at least one of the external embossed plies (2, 3).”*

1.11.- **Claim 8** protects the following invention:

“*8. The product according to any of Claims 1 to 7, characterised in that at least one of the external embossed plies (2, 3) has a fibrous composition based essentially on short fibres, and in that the central ply (4) has a fibrous composition based essentially on long fibres*.”

1.12.- **Claim 9** protects the following invention:

*“9. The product according to any of Claims 1 to 8, characterised in that at least one of the external embossed plies (2, 3) comprises a softener.”*

1.13.- **Claim 10** protects the following invention:

*“10. The product according to any of Claims 1 to 9,****characterised in that****at least one of the plies comprises a hydrophobic agent.”*

1.14.- **Claim 11** protects the following invention:

*“11. The product according to any of Claims 1 to 10, characterised in that the central ply (4) comprises a temporary or permanent wet moisture resistant agent.”*

1.15.- **Claim 12** protects the following invention:

*“12. A method for manufacturing an absorbent paper according to any of Claims 1 to 11 and comprising at least three associated plies (2, 3, 4), wherein each of said plies has a gram weight of approximately 12 to approximately 35 g/m2, and preferably 12 to 25 g/m2, characterised in that it consists in:*

*- embossing a first external ply (2) on an embossing cylinder (13) having at least one relief pattern comprising, at least in part, of spikes with a height H1 to obtain, on the ply, a first pattern (5) consisting of protuberances (6);*

*- superimposing a central ply (4) on said protuberances (6) of the first external embossed ply (2);*

*- embossing a second external ply (3) on an embossing cylinder (20) having a relief pattern (9) comprising, at least in part, of spikes with a height h'1;*

*- associating the first external embossed ply (2), provided with the central ply (4), with the second external embossed ply (3), by means of a marrying cylinder (22), in a so-called "nested" manner; and*

*- exerting sufficient pressure to ensure the connection or binding of said aforementioned plies (2, 3, 4).”*

1.16.- **Claim 13** protects the following invention:

*“13. The method according to Claim 12, characterised in that an adhesive (11) is applied to the external surface of the central ply (4) opposite the distal surfaces of the first pattern (5) of the external embossed ply (2).”*

1.17.- **Claim 14** protects the following invention:

*“14. The method according to Claim 13, characterised in that the adhesive (11) is applied by means of a gluing device (15) comprising an applicator cylinder (16).”*

1.18.- **Claim 15** protects the following invention:

*“15. The method according to any of Claims 12 to 14, characterised in that the cylinder (13) presents a second pattern comprising spikes at a level h1 lower than the first of the height H1.”*

1.19.- **Claim 16** protects the following invention:

*“16. The method according to Claim 15, characterised in that the spikes of the first pattern on the cylinder (13) have an engraving height H1 of between 0.2 mm and 2 mm, and the spikes of the second pattern have an engraving height h1 that is such that the difference in height H1-h1 is between 0.1 mm and 0.7 mm.”*

1.20.- **Claim 17** protects the following invention:

*“17. The method according to Claim 12, characterised in that an aqueous or hot-melt adhesive is applied by spraying to provide the connection or binding between the plies.”*

1.21.- **Claim 18** protects the following invention:

*“18. Use of the product according to one of Claims 1 to 11, or obtained by the method according to one of Claims 12 to 17, as toilet paper, a table serviette, handkerchief, wiping down cloth or similar.”*

1.22.- The defendant is carrying out in Spain acts of manufacture and / or importation, offering and marketing of certain toilet paper products, marketed under the following names: FOXY SEDA and FOXY BOUQUET, LANTA 3 CAPAS, DIA PREMIUM, AUCHAN SUPREME and AUCHAN FLORAL.

**SECOND.- On the (lack of) validity of patent ES’ 237.**

**2.1.- *Nullity action approach.***

ICT brought a nullity action by means of counterclaim against claims 1 to 6 of the patent ES’237 on the grounds of lack of inventive step, based on two different constructions:

2.1.1.- Starting from *US 5840404* as the closest prior art document, which would only miss one technical feature to reach the inventive solution (related with the protrusions density). The expert on the field would combine it with document *US 5846636,* which would anticipate a nesting of the patterns having those patterns a density higher than 30 protrusions/cm2 (Col. 2, line 37).

 2.1.2.- Starting from *FR 9802792* as the closest prior art document**,** being acknowledge by the applicant that said document comprehends all the technical features of the patent’s Preamble, departing from said document and testing a nested pattern having a protrusion density greater than the limit set in the Preamble, the expert would reach the missing feature (page 67 in fine and 70 of the counterclaim [page 56 on HRM ENG translation]).

**2.2.- Legal configuration and case-law on inventive step.**

2.2.1.- Ascertain the inventive step means to judge the merit of the invention to be considered as such. To that end, it is necessary to consider if the person skilled in the art, starting from the prior art, and based on his own knowledge, would be able to obtain the same result without exercising inventive imagination.

2.2.2.- In this sense, art. 8 of the Spanish Patent Act establishes that “a*n invention shall be considered to involve an inventive step where it does not derive from the state of the art in a manner obvious to a person skilled in the art”.* In relation with utility models, art. 146.1 of the same Law establishes: *“in order to be protected as a utility model, an invention shall be deemed to involve an inventive step if it does not obviously result from the state of the art for a person skilled in the art.”*

2.2.3.- A useful method to analyze the inventive step requirement is the “problem-solution” approach, which is frequently used by the EPO examiner, although it is not the only suitable procedure to assess the inventive step.

2.2.4.- The aforementioned method, used by the EPO when analyzing the inventive step of a patent application and know by the name “problem and solution approach”, intends to avoid an ex post facto assessment of the inventive step, thus it tries to objectivized the obviousness assessment in the date in which the priority of the patented invention is claimed, that is, before the description of the invention was made public, as required by art. 8.1 PA and art. 56 EPC.

2.2.5.- In order to seek for a legal foundation, the EPO Boards of Appeal usually relay on Rule 40(1)(c) (Implementing Regulations to the Convention on the Grant of European Patents, as adopted by decision of the Administrative Council of the European Patent Organization of 7 December 2006), according to which the application description shall: “*disclose the invention, as claimed, in such terms that the technical problem, even if not expressly stated as such, and its solution can be understood”.* Therefore, the technical problem and its solution are always elements of any invention.

2.2.6.- The implementation of the method involves three steps: a) determining the "closest prior art", b) establishing the objective technical problem to be solved by the invention, and c) considering whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person, which means on the one hand that the expert had raised the problem that the invention tries to solve, and, on the other hand, which proposed solution would have seemed obvious to him.

A.1) Determination of the closest prior art.

2.2.7.- In order to determine the closest prior art the EPO Boards of Appeal follow several criteria, generally starting from the fact that said prior art is represented by a prior document which combines a series of characteristics. The first consideration is that it should be directed to a similar purpose or effect as the invention (T606/89, T 686/91, T 650/01). Secondly, the document shall belong to the same or a closely related technical field as the claimed invention (T 909/93, T 1203/97, T 263/99). Thirdly, it shall be, for the person skilled in the art, the most promising starting point for a development leading to the invention (T254/86, T 282/90,70/95, T 644/97, T656/90).

2.2.8.- The EPO Guidelines for examination (Version 16/09/2013, Part G, Chapter VII, 5.1.) established that: *“The closest prior art is that which in one single reference discloses the combination of features which constitutes the most promising starting point for a development leading to the invention”.*

2.2.9.- When analyzing novelty, the relevant date is that of disclosure of the prior document, not the priority date of the challenged patent, while when assessing inventive step, the relevant date is that of the priority of the patent in question. As the EPO’s Board of Appeal case law states, "the closest prior art must be assessed from the skilled person's point of view on the day before the filing or priority date valid for the claimed invention” (T 24/81, DO 1983, 133, T 772/94, T 971/95, Guidelines G-VII, 5.1 – June 2012 version).

A.2) Technical problem that is intended to be solved with the new invention.

2.2.10.- The second step of the applied test consists on identifying the objective technical problem to solve with the new invention.

2.2.11.- The Guidelines says on section C-VII, 5.2: “*In the context of the problem-and-solution approach, the technical problem means the aim and task of modifying or adapting the closest prior art to provide the technical effects that the invention provides over the closest prior art. The technical problem thus defined is often referred to as the "objective technical problem".*

A.3) Obviousness assessment.

2.2.12.- Once the closest prior art and the objective problem to be solve with the invention are determined the last step of the problem-solution approach is the assessment of whether the solution proposed by the patent at stake is obvious or not to the hypothetical skilled person.

2.2.13.- In this regard, we must remember that said skilled person in the art always has some common features that we should define:

1. The person skilled in the art is a person (or a team) is a practitioner in the relevant art concerned, who has general knowledge in the technical or scientific field at the application time. He is an average skilled person who has common general knowledge in the field.
2. He should also be presumed to have had access to everything in the state of the art, who has carefully read them, and in particular the documents cited in the search report.
3. Our technician has at his disposal the normal means and capacity for routine work and experimentation.
4. The skilled person will be an expert in a technical field (EPO Boards of Appeal T641/00, OJ 2003, 352) he is not possessed of any inventive capability (T 39/93 OJ 1997, 134). It was the presence of such capability in the inventor which set him apart from the notional skilled person.
5. The starting point for defining the appropriate skilled person is the technical problem addressed by the invention and intended to be solved, since the person skilled in the art is an expert in the field of the technical problem, not in the field of the solution (T422/93).

2.2.14.- At this point, following the “could-would” approach, it is important to remember that it is not that the expert in the field “could” have been able to reach the questioned invention. Undoubtedly, an expert could have reached it carrying out the same routine experiments that the patent holder did. But this analysis would be an *ex post facto* examination of the inventive step, that is, knowing the starting point (the closest prior art) and the point of destination (the invention questioned), without keeping in mind that, on the priority date of the patent, the expert did not know the invention that solves the problem.

2.2.15.- The decisive factor to evaluate if the invention is obvious or not, is if the skilled person would have done so, that is, we must ask if, departing from the closest prior art, the expert would have reached the proposed solution. That “would” is what makes something obvious, which otherwise is inventive.

**2.3.- The lack of inventive step of Claim 1 of patent ES’ 237.**

2.3.1.- In the present case, the nullity plaintiff ICT present two different approached to allege the lack of inventive step of the patent at stake.

2.3.2.- It is convenient to clarify that the nullity action is brought in the counterclaim only against claims one to sixth of patent ES’237, despite the fact that in the expert report provided by Dr. Juncosa the analysis is extended to other claims, which will not be taken into consideration in this Decision as a result of the preclusion rules.

2.3.3.- According to the first thesis of ICT, starting from the document "Patent FR 9802792", entitled "*New product of absorbent paper comprising three plies and its manufacturing process*" as closest prior art, the person skilled in the art would try to combine said teachings with a nested pattern with a density of protuberances above the limit as set in the Preamble, which would achieve the missing characteristic.

2.3.4.- However, SCA opposes that the relevant document FR9802792 is not a relevant prior art document to evaluate the inventive step based on art. 54.3 EPC, since it was published in September 10, 1999, therefore, after the filing of the application for patent ES’237, which took place in August 31, 1999 (Exhibit 2 filed with the reply to the counterclaim).

2.3.5.- This fact has not been contested by ICT that limits itself to defend that the patent referred in the description to the French document, reason why it concludes that it must be considered "*public and known*" in order to examine the nullity of the patent due to its obviousness.

2.3.6.- We understand that the fact that patent ES’237 description itself cites the document FR 9802792, insofar as both documents come from the same applicant, lacks relevance, considering that the implementation of the provisions of art. 54.3 EPC is imperative. Therefore, the content of the patent which nullity is judge cannot be considered as comprised in the relevant *“state of the art”* to analyze its inventive step.

2.3.7.- Therefore, the conclusion is that the patent cannot be declared invalid based on said reason.

2.3.8.- ICT’s second argument is that, starting from the document US 5840404 *“Absorbent multilayer sheet and method for making same”* as the closest prior art, which would only lack one technical feature to reach the inventive solution (the one related with the density of the protrusions), it would be obvious for the skilled person to combine it with the document US 5846636, titled “M*ultilayer sheet of absorbent paper and its manufacturing method*”, since the latter advanced the nesting of the patterns including those patterns a density higher than 30 protrusions/cm2 (Col. 2, line 37).

2.3.9.- It must be objected that, in the first place, this construction does not respond to the parameters of the Problem Solution Approach Method that has been repeatedly set by the EPO Boards of Appeal. The counterclaimant does not fully explain in the counterclaim, what was the technical problem that the skilled person had solved in an obvious way by combining the closest prior art document, that is, US 5840404, with the teachings of US 5846636, let alone does it explicitly explain what indicator or pointer would have motivated the expert to make that specific combination to reach the inventive step.

2.3.10.- To this argumentative deficit, a subsidiary technical one should be added. Assuming, as the defendant of nullity does, that the technical problem to be solved in the patent ES'237 is "*to provide a new dense and smooth product, with good performance and resistant to crushing after conditioning in roll form, (page 3, lines 60 to 62)*", it seems clear that the inventive solution consists of the activity of the central ply not previously stamped, which prevents any overlap of the two external plies together, a phenomenon that would occur if this ply did not exist, due to the small support surface offered by such thin protuberances (page 4, lines 7 to 11 of EP'237).

2.3.11.- Thus, US ‘636 does not seem to disclose a central ply not pre-embossed which prevents the overlapping of the outer plies. Quite the opposite, it seems that US ‘636 advances a ply placed “*in the middle”* of two plies but not necessarily equal to the upper and lower embossed plies, so when the simultaneous "nested" association of three layers does not concur, the technical effect protected in ES'237 would necessarily be missing.

2.3.12.- For all these reasons, the claim for nullity for lack of inventive step must be dismissed, proclaiming the validity of the patent.

**THIRD.- On the infringement of Claim 1 of patent ES’237.**

3.1.- Once the validity of the patent has been declared, it must be examined if the defendant infringes the patent. For that purpose it is convenient to analyze if the products FOXY SEDA and FOXY BOUQUET, LANTA 3 CAPAS, DIA PREMIUM, AUCHAN SUPREME and AUCHAN FLORAL fall within the patent’s scope of protection, starting from claim 1, which reads as follows:

*“1. Product made of absorbent paper with a gram weight of about 36 to about 105 g/m2, comprising at least three plies (2,3 and 4): two embossed external plies, lower (2) and upper (3) and a central ply (4), wherein the external plies (2,3) each comprise patterns in relief (5,7 and 9), consisting at least partly of discrete protuberances (6, 8 and 10), wherein the distal surfaces of at least a part of the protuberances of each of said external plies (2,3) are turned towards the central ply (4), and wherein at least one of the external folds has a pattern density higher than 30 protuberances/cm2, wherein the lower embossed external ply (2) has a first (5) and a second (7) pattern, the second pattern having a height lower than the first pattern, so that the central ply (4) and the upper embossed external ply (3) are associated with said lower embossed external ply (2) in a so called “nested” manner at the level of at least a part of the tips of the first pattern (5) of the lower embossed external ply (2).”*

3.2.- The expert report provided by Mr. Francisco Javier Moledo Froján, Phd in Industrial Engineering (Exhibit 19 filed with the complaint) concludes, based on the laboratory tests carried out by TECNALIA, attached as Annex no. 4 to 9, that all the products manufactured by the defendant infringe the claim 1 of the patent at stake, inasmuch as they reproduce every technical feature of it, which can be disaggregated as follows:

*C1.- Product made of absorbent paper with a gram weight of about 36 to about 105 g/m2*

*C2.- comprising at least three plies,*

*C3.- two embossed external plies, lower (2) and upper (3) and a central ply (4),*

*C4.- wherein the external plies (2,3) each comprise patterns in relief (5,7 and 9), consisting at least partly of discrete protuberances,*

*C5.- wherein the distal surfaces of at least a part of the protuberances of each of said external plies (2,3) are turned towards the central ply,*

*C6.- wherein at least one of the external folds has a pattern density higher than 30 protuberances/cm2,*

*C7.- wherein the lower embossed external ply (2) has a first (5) and a second (7) pattern, the second pattern having a height lower than the first pattern,*

*C8.- characterized in that the central ply (4) and the upper embossed external ply (3) are associated with said lower embossed external ply (2) in a so called “nested” manner at the level of at least a part of the tips of the first pattern (5) of the lower embossed external ply (2).*

3.3.- Considering that the defendant ICT only challenges that the products FOXY SEDA and FOXY BOUQUET, LANTA 3 CAPAS, DIA PREMIUM, AUCHAN SUPREME and AUCHAN FLORAL reproduce the feature C8 (“*characterized in that the central ply (4) and the upper embossed external ply (3) are associated with said lower embossed external ply (2) in a so called “nested” manner at the level of at least a part of the tips of the first pattern (5) of the lower embossed external ply (2)”),* admitting that the other features are present in those products, we will evaluate the scope of said technical feature as well as the presence of it in the products marketed by the defendant (pages 17 and 36 to 39 of the report, pages 167 and 186 to 189 of the Court files).

3.4.- Regarding the scope of protection, it is worth highlighting, in line with the expert Mr. Moledo, that the description in patent ES’237 of the outer plies as upper and lower is not determined by the position of the plies in relation with the paper roll, but the lower outer ply is that which presents a first and a second pattern in different heights.

3.5.- Thus, the Description indicates (respectively, page 4, lines 50-51, page 9, lines 8-10 and page 2, lines 59 to 63):

* *“The embossed lower outer ply having a first and a second pattern, the second pattern having a height smaller than the first pattern”*
* “…*the lower embossed external ply (2) has a first (5) and a second (7) pattern, the second pattern having a height lower than the first pattern,”*
* *“…the definition of the term “nested” is extender to the case when the connecting plane between the distal surface of the protuberances of a first embossed ply and a second ply, is located in the same plane as the plane of said second ply regardless of the relative position of the distal surface in relation with the protuberances of the second ply. Thus it can be found between two protuberances of the second ply but also partly or wholly covering one of these protuberances which is thereby crushed.”*

3.6.- Based on the tests carried out by TECNALIA, the results of which are summarized in pages 186 to 189 of the Court file (Annexes 4 to 9), it follows that the micrographs of the allegedly infringing products show that the central ply and the upper embossed external ply are associated in a nested manner with the first pattern of said lower embossed external ply (in a geometrical position which matches the Fig. 1 of patent ES’237). Therefore, there is infringement since the products FOXY SEDA and FOXY BOUQUET, LANTA 3 CAPAS, DIA PREMIUM, AUCHAN SUPREME and AUCHAN FLORAL reproduce every technical feature of claim 1 of the patent at stake.

3.7.- Having said that, it is important to note that the defendant ICT defends the **non infringement** based on two different arguments (page 26 in fine of the reply to the complaint [page 19, first paragraph on HRM ENG translation]): a) the products marketed are different from those manufactured under the patented technology; b) The production process apply to obtain the products is different.

3.8.- In particular, the defendant alleged that the products FOXY SEDA and FOXY BOUQUET, LANTA 3 CAPAS, DIA PREMIUM, AUCHAN SUPREME and AUCHAN FLORAL do not reproduce the feature consisting in that *“the central ply (4) and the upper embossed external ply (3) are associated with said lower embossed external ply (2) in a so called “nested” manner at the level of at least a part of the tips of the first pattern (5) of the lower embossed external ply (2)”,* and that because they incorporate three plies, a lower ply, an upper ply and a middle ply, associated by means of an embossed pattern, having protrusions turned towards the interior of the structure, said protrusions opposing a third, intermediate ply, using the “**tip-to-tip**”(“stitch-stitch”) method of association which is excluded from the patent scope of protection (page 48, second paragraph of the reply to the complaint [page 37 of HRM ENG translation]).

3.9.- In this regard, it is important to mentioned two different expert reports, which performed a very similar analysis. The first one, attached to the reply to the complaint, was drafted by Mr. Juncosa. The second one, provided by the judicial expert Mr. Jesús Baró Panizo, after a visual inspection of the FOXY SEDA and FOXY BOUQUET, LANTA 3 CAPAS, DIA PREMIUM, AUCHAN SUPREME and AUCHAN FLORAL paper production plant located in El Burgo de Ebro (Zaragoza) which confirms the previous one when concluding (page 8) that from the study of the 475-C machine and the elements that are produced in it, it follows that it is a **tip-to-tip** pliesconnection system, a point that the patent expressly excludes, so that for the production of products object of complaint, the **production process "necessarily leads to a product whose technical features do not infringe the invention patent ES'237".**

3.10.- Even considering these conclusions valid, it would only apply to the production process, or, more precisely, to the inspected machine. But not to the toilet paper marketed under the name FOXY SEDA and FOXY BOUQUET, LANTA 3 CAPAS, DIA PREMIUM, AUCHAN SUPREME and AUCHAN FLORAL, because there is no examination of the them at the request of the defendant.

3.11.- This doubt is greater if it is put in relation with the report further submitted by Mr. Moledo, who also attended the inspection at the ICT production facilities, who, after stating that the machine was never put into operation (which raise even more doubts as to whether the commercialized paper is manufactured with said machinery and with the hardware as configured during the visit), insists that the FOXY SEDA and FOXY BOUQUET, LANTA 3 CAPAS, DIA PREMIUM, AUCHAN SUPREME and AUCHAN FLORAL papers do not present the symmetrical character that characterizes a tip-to-tip paper, but the distal surfaces of a part of the protuberances of the external plies are turned towards the central ply and the central ply and the upper embossed external ply are associated in a nested mode with the lower embossed external ply, at the level of the peaks of the first pattern of said lower embossed external ply. The conclusion is clear: these papers can not be manufactured in a machine like the one inspected, because it appears incompatible.

3.12.- The need to examine the product – and not the production process, being the plaintiff the only one who has proven that the paper marketed by the defendant reproduces all the technical characteristics of the first claim of patent Es'237, leads to appreciate that the infringement exists, thus admitting the complaint entirely on this point, with the consequences that will be exposed in the following section.

3.13.- Nor can we admit, for the purpose of enervating the effects of the proven infringement, the application of the doctrine of the statute of limitations or undue delay in the exercise of a legal action, essentially inasmuch as it does not appear that the plaintiff, in relation to the products marketed by the defendant FOXY SEDA and FOXY BOUQUET, LANTA 3 CAPAS, DIA PREMIUM, AUCHAN SUPREME and AUCHAN FLORAL has delayed *ad hoc* the date of the filing of the complaint (two years after the first cease and desist letter), or has waived its right to file a lawsuit, since the computation of the limitation period begins with the cessation of the infringing activity. Therefore, they are not grounds that allow

**FOURTH.-** **Regarding the consequences deriving from the patent infringement.**

As requested in the complaint, its admission produces the following consequences:

4.1.- Once the infringement of claim 1 of patent ES’ 237 has been declared, the defendant company INDUSTRIE CARTARIE TRONCHETTI IBÉRICA S.L. shall be ordered to refrain from offering, manufacturing, importing, exporting, marketing or, in general, any act of exploitation of products FOXY SEDA, FOXY BOUQUET, LANTA 3 CAPAS, DIA PREMIUM, AUCHAN SUPREME and AUCHAN FLORAL or others that similarly infringe patent ES 237.

4.2.- Similarly, the defendant company INDUSTRIE CARTARIE TRONCHETTI IBÉRICA S.L. shall be ordered to withdraw from the market any of the products that may exist which are referred to in the previous paragraph.

4.3.- In the same vein, infringement entails that the defendant company INDUSTRIE CARTARIE TRONCHETTI IBÉRICA S.L. shall compensate the plaintiff for damages caused, **in an amount which will be determined during the judgment’s enforcement phase, on the basis of the criteria of the “*hypothetical royalty rate”* as established in article 66.2b) PA, fixed on 4% of the net sales made with the products.**

* FOXY SEDA
* FOXY BOUQUET
* DIA PREMIUM
* AUCHAN SUPREME
* AUCHAN FLORAL
* LANTA 3 CAPAS

4.4.- Similarly, INDUSTRIE CARTARIE TRONCHETTI IBÉRICA S.L. is ordered to bear seizure and destruction of the toilet paper products that it may have in stock, as well as to bear destruction of all equipment and materials intended for the manufacture of the toilet paper products (as well as of any other which falls within the scope of protection of the patent).

4.5.- Finally, INDUSTRIE CARTARIE TRONCHETTI IBÉRICA S.L. shall be ordered to publish the decision at its expense in the journals “El País” and “Expansión”, in accordance with as provided in Article 63(1)(f) PA, due to the need of minimizing the damages caused, given the relevance of the infringing product in the market.

**FIFTH.- Regarding the procedural costs.**

5.1.- Regarding the patent infringement complaint, the main claim having been fully upheld, the defendant must be ordered to pay the procedural costs incurred, by application of the objective criterion of maturity (Article 394.1 SPA).

5.2.- Regarding the patent nullity action, it has been dismissed, thus it is appropriate to condemn the counterclaimant to the payment of the procedural costs (Article 394.1 SPA).

By virtue of the foregoing,

**RULING**

**1.- We fully UPHOLD the infringement complaint** for infringement of patent rights filed by the procedural representation of SCA TISSUE FRANCE SAS against the company INDUSTRIE CARTARIE TRONCHETTI IBÉRICA S.L., and by virtue thereof:

1.1.- The infringement of claim 1 of patent ES’ 237 being declared, the defendant company INDUSTRIE CARTARIE TRONCHETTI IBÉRICA S.L. is ordered to refrain from offering, manufacturing, importing, exporting, marketing or, in general, any act of exploitation of products FOXY SEDA, FOXY BOUQUET, LANTA 3 CAPAS, DIA PREMIUM, AUCHAN SUPREME and AUCHAN FLORAL or others that similarly infringe patent ES’ 237.

1.2.- The defendant company INDUSTRIE CARTARIE TRONCHETTI IBÉRICA S.L. is ordered to withdraw from the market any of the products that may exist which are referred to in the previous paragraph.

1.3.- The defendant company INDUSTRIE CARTARIE TRONCHETTI IBÉRICA S.L. shall compensate the plaintiff for damages caused,in an amount which will be determined during the judgment’s enforcement phase, on the basis of the criteria of the “*hypothetical royalty rate”* as established in article 66.2b) PA, fixed on 4% of the net sales made with the products:

* FOXY SEDA
* FOXY BOUQUET
* DIA PREMIUM
* AUCHAN SUPREME
* AUCHAN FLORAL
* LANTA 3 CAPAS

1.4.- The company INDUSTRIE CARTARIE TRONCHETTI IBÉRICA S.L. is ordered to bear seizure and destruction of the toilet paper products that it may have in stock (as well as of any other which falls within the scope of protection of the patent):

* FOXY SEDA
* FOXY BOUQUET
* DIA PREMIUM
* AUCHAN SUPREME
* AUCHAN FLORAL
* LANTA 3 CAPAS

1.5.- The company INDUSTRIE CARTARIE TRONCHETTI IBÉRICA S.L. is ordered to destroy all equipment and materials intended for the manufacture of the toilet paper products (as well as of any other which falls within the scope of protection of the patent):

* FOXY SEDA
* FOXY BOUQUET
* DIA PREMIUM
* AUCHAN SUPREME
* AUCHAN FLORAL
* LANTA 3 CAPAS

1.6.- INDUSTRIE CARTARIE TRONCHETTI IBÉRICA S.L. is ordered to publish at its expense the decision in the journals “El País” and “Expansión”, in accordance with Article 63(1)(f) PA.

1.7.- The defendant company INDUSTRIE CARTARIE TRONCHETTI IBÉRICA S.L. is ordered to bear the costs that derive from the infringement lawsuit.

**2.- We DISMISS the invalidity counterclaim** of patent rights filed by the procedural representation of INDUSTRIE CARTARIE TRONCHETTI IBÉRICA S.L. against SCA TISSUE FRANCE SAS, acquitting the defendant for the plaintiff’s claims, condemning it to the payment of the procedural costs incurred.

It shall be notified to the parties that this judgment is not final, an appeal may be lodged against it, which should be filed by means of a written document filed before this court within a 20-day deadline as from service, in accordance with the provisions of arts. 455 and following SPA, proving that the appellant has entered the amount of 50 euros in this Court’s account, otherwise the appeal will not be admitted (XV Additional Provision of the Organic Law of the Judicial Branch, according to the regulation given by Organic Law 1/09, of November 3).

Ordered and signed by Mrs. Yolanda Ríos López, Judge of Barcelona Commercial Court No.1, having submitted it to the deliberation of the Patent Section of the Commercial Court of First Instance of Barcelona, integrated by Mr. Alfonso Merino Rebollo and Mr. Florencio Molina Lopez, within the framework of the Protocol of the Statute of the Commercial Court of First Instance of Barcelona, approved by agreement dated on July 15, 2014 of the Permanent Commission of the General Council of the Judiciary and reviewed by the Agreement of the Permanent Commission of the General Council of the Judiciary of February 18, 2016.