

The Italian Supreme Court provided guidance on patent infringement by equivalents, with particular regard to the role of prosecution history in determining the patent's scope of protection.

By judgment no. 2977 on 7th February 2020, the Italian Supreme Court (Section I) issued a ruling on a highly debated issue on patent infringement: the role of prosecution history in determining the patent's scope of protection. Additionally, the Court also provided more general guidance on infringement by equivalents under the Italian law.

1. The legal background in Italy on infringement by equivalents

Under Italian law, the patent's scope of protection is determined by Art. 52 of the Intellectual Property Code (Legislative Decree N°30 of 10 February 2005 – "IIPC").

Paragraph 1 and 2 of Art. 52 IIPC substantially reproduce the content of Art. 69 EPC and provide that: "*1. In the claims is determined, specifically, what is intended to be the subject of the patent; 2. The limits of the protection are determined by the claims; however, the description and drawings have the purpose to interpret the claims.*"

Similarly, paragraph 3 and 3-bis of Art. 52 IIPC reproduce the content of the Protocol of Interpretation of Art. 69 EPC and provide that: "*3. The provision of paragraph 2 must be understood in such a manner as to guarantee both fair protection to the owner and a reasonable legal certainty for third parties.; 3-bis. To determine the scope of the protection granted by the patent, each element that is equivalent to an element indicated in the claims must be considered.*"

However, paragraph 3-bis was introduced only in 2010, with the Legislative Decree N°131 of 13 August 2010. Therefore, the majority of the Supreme Court case law still concerns Art. 52 IIPC in the version not including paragraph 3-bis.

The traditional approach of the Italian Supreme Court, which is constantly recalled by the same Court, deems that "*in order to assess whether the contested embodiment can be considered equivalent to the patented one and therefore infringing, it is necessary to ascertain whether, in order to achieve the same final result, it is original, by offering a solution that is neither trivial nor repetitive of the previous one, and goes beyond the skills of the average technician who has to face the same problem; in this case only the solution goes beyond the protected idea of solution*" (Supreme Court, Section I, n. 257/2004 and Supreme Court, Section I, n. 9548/2012).

In addition, the Supreme Court traditionally points out that a partial reproduction of the patent does not in itself exclude the infringement, if the core of the invention is nevertheless

reproduced (Supreme Court, Section I, n. 30234/2011; Supreme Court, Section I, n. 22351/2015).

2. The legal background in Italy on prosecution history

In Italy, the role of prosecution history in the assessment of infringement by equivalents is debated, since no indication is given by the law.

According to a first approach, prosecution history has no binding role for the Judge while interpreting the claims. The prosecution history could be of help in interpreting the claims, but it can not prevail over the text of the patent, which is the sole document on which third parties can rely on (Court of Milan, order 15 October 2018; Court of Milan, order 18 September 2017).

According to a second approach, the characteristics excluded by the patentee himself by conscious limitation during prosecution cannot be included in the scope of the patent through an interpretation by equivalents, because this interpretation would be contradictory and incompatible with the owner's own wishes (Court of Milan, order 12 September 2017; Court of Milan, judgement 24 January 2017 n. 885; Court of Milan, judgement 10 June 2015 n. 7156; Court of Turin order 1 April 2011).

In light of the above, the judgment of the Supreme Court no. 2977/2020 is important for providing a view both on the application of Art. 52 paragraph 3-bis IIPC and the role of prosecution history in determining the patent's scope of protection.

3. The facts of the case and the appeal judgment

Proras enforced against the competitor Nuova Rivart the Italian portion of a European patent application concerning a process and a plant to extract and concentrate tannins from wood and from other natural products.

While the first instance proceeding were pending, the European patent was finally granted. However, this occurred only after the patent owner, upon the EPO examiners' requests, agreed to amend the independent product and process claims.

The Court of first instance ascertained the infringement of Proras patent, but the Court of Appeal ruled out the infringement by equivalents. In particular, the Court considered crucial the limitation made by the patentee in order to obtain the grating of the patent, which was the addition of a filtration step in order to stop particles greater than 10 µm. This feature was essential at the EPO to differentiate the invention from the prior art and overcome the objections raised by the examiners. The Court pointed out that the patentee can not pretend to expand the scope of protection to what he voluntarily excluded during the patent prosecution. Otherwise, the patent would be interpreted contrary to good faith, to the

detriment of rights and legal certainties for third parties. Therefore, the conscious limitations acted as a complete bar to the assessment of the infringement by equivalents, in compliance with the so called prosecution history estoppel.

Given that the contested process applied a filtration step to stop particles greater than 25 µm, the Court of Appeal therefore excluded the infringement.

4. The Decision of the Supreme Court

Proras filed an appeal before the Supreme Court, claiming that the Court of Appeal had not properly detected the "inventive core" of the patent and instead gave relevance to the theory of conscious limitations, which would have no legal basis in the Italian patent law system.

Firstly, the Court recalled many of its judgments in which assessed the infringement by equivalents before paragraph 3-bis was added to Art. 52 IIPC.

Then, the Court considered that even taking into account the new paragraph 3-bis, "*the fundamental criterion that gives the main role to the objective meaning of the claims cannot be abandoned*".

The Court provided more guidance on infringement by equivalents by making a list of examples where the non-coincidence between the contested product and the claims, does not nevertheless excludes the infringement. In particular, this would occur when:

- the modest variant affects an element of the claim that does not have a central role in the economy of the inventive idea (by eliminating the same element, or placing it in a different solution expressing the same fundamental idea);
- the allegedly infringing product by equivalent fulfils the same function as the patented product, essentially in the same way and reaches to the same result;
- the alternative solution adopted by the alleged infringer with respect to the patented solution appears to be obvious and not original, taking into account the average knowledge of the technician in the field.

The Court pointed out that the Court of Appeal did not considered the criteria set forth above and therefore failed to correctly apply Art. 52 paragraph 3-bis IIPC.

In particular, the Court of Appeal erroneously considered the prosecution history an absolute bar to the applicability of the infringement by equivalents, while instead it should not have refused to assess whether there was actually equivalence between the process followed by Nuova Rivart and the scope of protection of Proras' patent as determined by the claims, interpreted in light of the description and drawings.

The Supreme Court stated that the "*prosecution-history estoppel is extraneous to our order and patent system in which the rules of interpretation are set forth by Art.69 EPC Protocol and Art.52 IIPC, with the exclusion of the relevance of the subjective intention of the inventor, and having regard to the objective meaning of the patent, which can be understood from third parties, as expressed in the claims, interpreted in light of the descriptions and drawings, regardless of the administrative prosecution process for the granting of the patent and with no relevance to the obvious and non-inventive, elusive modifications of its objective scope.*"

Finally, the Supreme Court, by setting aside the Appeal judgment and referring back the case to the Court of Appeal, set forth the following principle of law: "*the Judge, in determining the scope of protection conferred by the patent ... must consider each element substantially equivalent to an element indicated in the claims; for this purpose it may avail itself of different methodologies for the assessment of the equivalence of the inventive solution, such as verifying whether the contested embodiment allows the same final result to be achieved with the adoption of variants that lack originality because they are obvious in light of the knowledge of the average technician skilled in the art who faces the same problem; however, the Judge cannot give importance to the subjective intentions of the patent applicant, albeit historically inferred through the analysis of the activities carried out during the administrative proceedings which lead to the granting of the patent*".

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