

Italian Supreme Court, Section I, 4th January 2022, n. 120, Garbuio S.p.A. v. COMAS S.p.A. et al. - *The Italian Supreme Court provided guidance on patent infringement by equivalents, giving central relevance to the individual elements claimed by the patent*

By judgment no. 120 on 4th January 2022, the Italian Supreme Court addressed the topic of patent infringement by equivalents. In particular, the Court provided guidance on two highly debated issues under Italian law:

- a) what should be the subject of the equivalence assessment; and
- b) what test should be used to assess the equivalence.

1. The legal background in Italy and the traditional approach to determine patent infringement by equivalents

Under Italian law, the patent's scope of protection is determined by Art. 52 of the Italian 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 of the European Patent Convention ("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, most of the Supreme Court case law – except for a few recent judgments, including the one at issue – concerns Art. 52 IIPC in the version not including paragraph 3-bis.

The traditional approach of the Italian Supreme 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, such approach deems 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).

Therefore, infringement by equivalents would require only that the "*core of the invention*" (i.e. the essential features of the invention) is reproduced in the contested product or process. Consequently, the fact that the "*secondary*" or "*non-essential*" elements of the claims are missing in the contested device is irrelevant, because such elements do not limit the patent's scope of protection.

Regarding the test to be applied to assess the equivalence, the Italian case law usually applies two tests:

- a) the triple test or Function-Way-Result test ("*FWR*" test), according to which are infringing by equivalents the alternative solutions that achieve the same result, in substantially the same way and which perform substantially the same function of the invention;
- b) the obviousness test, according to which are infringing by equivalents the alternative solutions that, considering the prior art, are in the view of the expert in the field obvious variant or trivial and repetitive response to what is claimed.

2. The facts of the case and the appeal before the Supreme Court

Garbuio enforced against the competitor Comas the Italian portion of a European patent concerning a method and a device for transferring containers of shredded tobacco to individual feeders of cigarette-making machines.

The Court of first instance and the Court of Appeal ruled out the infringement because some of the components and functions claimed in the patent were missing in the contested device, replaced by more complex and inefficient mechanisms.

Garbuio filed an appeal before the Supreme Court, claiming that the Court of Appeal had not properly identified the "*inventive core*" of its patent. According to Garbuio, the Court of Appeal erred because it gave relevance to elements claimed in the patent that nonetheless should not have been considered to determine the patent's scope of protection, as they would not belong to the "*inventive core*" of the invention. In other words, according to Garbuio, those claimed elements would not have limited the patent's scope of protection because they were only "*secondary*" or "*non-essential*" elements.

3. The Decision of the Supreme Court: (i) the subject of the equivalence assessment

The Supreme Court stressed that Art. 52 IIPC as amended in 2010 provides that the claims determine, specifically, the subject of the patent protection and paragraph 3-bis points out that to determine the scope of the patent protection, it must be considered “*each element that is equivalent to an element indicated in the claims*”.

The Supreme Court, in line with one of its most recent judgments on infringement by equivalents¹, deemed that the provisions of the EPC and Art. 52 IIPC have overcome the “*central definition theory*”, focused on the evaluation of the invention as a whole and its “*inventive core*” intended as the selection of the essential characteristics of the invention only.

According to the Court, the provisions of the EPC and Art. 52 IIPC embrace the “*peripheral definition theory*”, based on the clear and precise identification of the limits of the patent protection, functional to determine the limits of the exclusive rights through the characteristics of the invention as expressly claimed in the patent text, pursuant to the “*element by element*” approach, already used in the US system. According to the Court, the “*element by element rule*” is a corollary of the “*all elements rule*”, according to which infringement occurs only if each claimed element is reproduced in the contested product or process either literally or by equivalents.

4. The Decision of the Supreme Court: (ii) the test to assess the equivalence

Regarding the test to be applied to assess the equivalence, the Supreme Court explained that both the FWR test and the obviousness test are available options.

The Supreme Court also recalled some of its previous judgments and, in particular, stressed that nowadays, in order to guarantee a balance between a fair protection for the patent proprietor and a reasonable degree of legal certainty for third parties, the patent scope of protection cannot always be determined on the basis of the mere literal content of the claims, since there are undoubtedly cases in which the non-coincidence between the product or process and the objective content of the patent claims nonetheless does not exclude the infringement. According to the Court, that quoted its judgment 2977/2020, 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 replacing it in a different solution expressing the same fundamental idea);

¹ Supreme Court, Section I, 7 February 2020, n. 2977, reported on EPLAW Patent Blog here: <http://eplaw.org/itguidance-on-patent-infringement-by-equivalents>.

- 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, considering the average knowledge of the technician in the field.

5. The principle of law set forth by the Supreme Court

By applying the principles set forth above to the case at issue, the Supreme Court deemed correct the finding of the Court of Appeal, according to which the enforced patent concerned a combination of several characteristics, having each of them a different function. All these characteristics, in their combination, contribute to determine the scope of protection since all of them are included in the patent claims.

As ascertained by the Court of Appeal, the contested device did not implement some of the features claimed by the enforced patent. Therefore, according to the Supreme Court, the solution adopted in the contested device did not consist of an obvious and trivial substitution of the elements claimed.

Additionally, the Supreme Court expressly stated that *“the distinction proposed by the plaintiff between essential and secondary elements, in light of new Art. 52 IIPC, cannot be shared”*.

Finally, the Supreme Court upheld the decision of the Court of Appeal, setting forth the principle of law according to which the Judge, in the assessment of the patent infringement by equivalents: *“must first determine the scope of the patent protection, then analytically identify the individual characteristics of the invention as expressly claimed in the patent text, interpreted in light of the description and the drawings, and then verify whether each element thus claimed is also found in the accused infringing product, even if only by equivalents. This means, according to one of the possible methods that can be used, that those variants of the invention can perform the same function as the elements of the patented product, essentially following the same way and achieving the same result”*.

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