

Commercial Court no. 4 of Barcelona, **TEKNICS v. CIBERNETICA**, Judgment of 19 March 2023, [ECLI:ES:JMB:2023:1261](#)

The plaintiff, S. R. Teknics Project 2016, S. L. (hereinafter, TEKNICS) filed a complaint against CIBERNETICA PARA LA PANIFICACION, S.L. (hereinafter, CIBERNETICA) for the infringement of Spanish patent ES 2279737 protecting a “dough-kneading machine”.

Independent claim 1 of ES 737 reads as follows:

“Cereal dough kneading machine, comprising a cylinder that contains inside a rolling spiral and a reduction motor assembly located in the lower part of the machine to drive the cylinder, characterized in that it has a holding structure from which the spiral is hung from its upper part and a structure to prevent radial movement of the spiral from its lower part.”

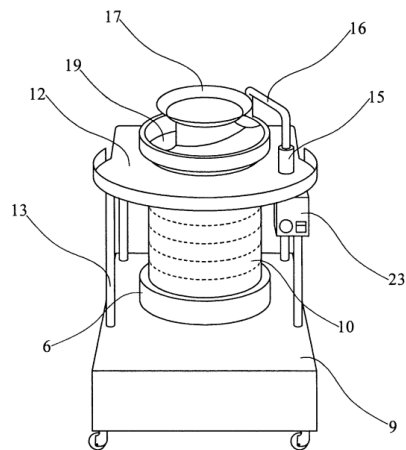


FIG. 1

According to the plaintiff TEKNICS, ES 737 was being infringed by CIBERNETICA’s dough-kneading machines, called “Heñidora Real”. As a defence, CIBERNETICA filed an invalidity counterclaim against ES 737 for lack of novelty and inventive step.

Novelty

For the novelty attack, CIBERNETICA filed as the prior art exhibit an extract from the Wayback Machine. This webpage described a competitor’s bread-rounding machine. The Court considered that

only page 1 of this Wayback Machine extract could qualify as prior art, given that only this page contained an explicit indication of the publication date.

However, the Court concluded that this exhibit was not novelty-destroying prior art because not all technical features of claim 1 of ES 737 were disclosed. As stated by the Court, page 1 of this document only showed the presentation of a bread-rounding machine (like a “cereal dough kneading machine” as protected by the preamble of claim 1). However, no further technical features were disclosed in this part of the document (page 1) that could qualify as prior art.

Inventive step

Regarding inventive step, CIBERNETICA did not choose the above-mentioned Wayback Machine extract used earlier in the novelty attack as the closest prior art document (the first step of the problem-solution approach chosen by the defendant for the assessment of inventive step). The plaintiff, TEKNICS, criticised this point; however, the Court, by referring to previous case-law, stated that it was obligated to follow the closest prior art as chosen by CIBERNETICA: *“if the defendant selects a document as the closest prior art, and the document is indeed relevant prior art, we must start our analysis from that selection (...) If the defendant has chosen a document further away than it should, it will bear its possible mistake in the analysis of the inventive step, but we cannot stop making that assessment just because there may be a document closer to the relevant prior art”*.

Having said that, the Court analyzed whether ES 737 lacked inventive step in view of US3899275, the document selected by CIBERNETICA as the closest prior art.

Document US3899275, published in 1975, protected a machine for rolling dough. According to CIBERNETICA, the only part not disclosed in US3899275 (the distinguishing feature) was the patent feature according to which the machine was characterized by having *“a structure to prevent radial movement of the spiral from its lower part”*. The Court agreed with this finding. However, it did not agree with CIBERNETICA’s formulation of the objective technical problem.

According to CIBERNETICA, the objective technical problem was *“to reduce the oscillations and vibrations suffered by the spiral of the machine”*. However, the Court considered that the effect regarding the weight produced by the spiral on the engine was also relevant, as expressed in the patent description. According to the Court, the objective technical problem was therefore twofold: on the one hand, as stated by CIBERNETICA, the objective technical problem was indeed *“to reduce the problems relating to the vibrations, oscillations and spiral wear during rolling of higher density doughs”* (as explained in the description, column 1, lines 30-47), but also, on the other hand, *“to prevent the reduction engine from supporting the weight from the bottom of the spiral”* (column 2, lines 3-11 of the description).

Consequently, because CIBERNETICA got the technical problem wrong, the Court decided not to continue with the following step of the problem-solution approach, that is, the obviousness test (i.e., whether or not the invention, expressed as the solution to the objective technical problem, was obvious to the skilled person on the priority or filing date). In this regard, the Court stated that: *“Since the identification of the technical problem to be solved is erroneous, we do not consider it necessary to analyze the rest of the aspects or steps of the problem-solution method”*.

Still, the Court stated with regard to this obviousness test that: *“The analysis of this presupposition requires us to study the following points: the team of experts, the general common knowledge of these experts, and the examination of the actual obviousness”*. In this respect, the Court criticised CIBERNETICA’s expert for not having properly followed the problem-solution approach because:

- The skilled person had been identified erroneously: *“The cited expert does not specify, in the first place, who the average expert in this field would be, even at the hearing he stated that there could be different types of people. If this expert in the field is not specified, it is difficult to determine the common general knowledge that this expert would apply to solve the problem-solution method.”*.
- Moreover, the expert gave no proper explanation for how to determine this common general knowledge, or how by starting from US3899275, the CGK would have led the skilled person to the claimed invention.
- Finally, no proper explanation was given, either, regarding what would have motivated the skilled person to combine US3899275 with other documents, such as the above-mentioned Way Back Machine extract. In other words, according to the Court, CIBERNETICA did not sufficiently develop the assessment as to whether the cited prior art would have prompted the skilled person to arrive at the claimed invention.

Therefore, the Court concluded that ES 737 was not invalid, either, for lack of inventive step.

Patent infringement

CIBERNETICA did not file non-infringement arguments in reply to TEKNICS’ complaint. Therefore, in the absence of allegations, the Court declared that TEKNICS’ patent ES 737 was being infringed by CIBERNETICA’s machines. Consequently, the Court upheld the following petitions:

- An injunction, along the following lines: *“The cessation of all manufacturing, importing, exporting, promotion, marketing and storage (refraining from such conduct in the future, including through the Cibernética website) in Spain”*;
- The destruction of CIBERNETICA’s machines, as well as any *“brochures, catalogs, price lists, advertising or promotional material and printed matter referring to such product”*;
- Payment of damages (to be determined at the enforcement phase of the judgment); and
- The notification of the judgment to those of CIBERNETICA’s clients who had been sold the infringing machine, as well as the publication of the judgment in a specialized magazine.

Conclusion

This judgment emphasises the need for a well-construed defence based on patent invalidity and, in particular, the need for a very detailed examination of each step comprising the problem-solution approach, if this is indeed the chosen method for the inventive step attack.

Additionally, it is worth noting that, even though Spanish Courts will generally feel bound to follow the closest prior art as selected by the party filing the invalidity action (and will therefore not examine the potential suitability of this document as the closest prior art), the subsequent steps must be explained in great detail and must be backed by sufficient documentary evidence. Any disagreement raised by the Court concerning any of the steps of the problem-solution approach, such as the formulation of the objective technical problem, could lead to the rejection of the entire inventive step attack.