

Wear and damage do not constitute a patent infringement

Kluwer Patent Blog
October 17, 2011

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Please refer to this post as: Kristof Roox, 'Wear and damage do not constitute a patent infringement', Kluwer Patent Blog, October 17, 2011, <http://patentblog.kluweriplaw.com/2011/10/17/wear-and-damage-do-not-constitute-a-patent-infringement/>

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The Ghent Court of Appeal dismissed the claims of the German patent holder Grumbach and its Dutch licensee, Bollegraaf Recycling Machinery, relating to the Carbo Separator, a paper sorting device sold by their Dutch competitor Wagensveld to the Stora Enso group's Belgian subsidiary. The Court affirmed the earlier decision of the President of the Ghent Commercial Court.

Grumbach and Bollegraaf initiated accelerated proceedings on the merits against Wagensveld and Stora Enso, invoking the European patent EP 1291 092 (EP 092). In its 26 September 2011 decision, the Ghent Court of Appeal dismissed most of the claims.

EP 092, granted on 15 November 2006, relates to a "method and device for removing cardboard from a wastepaper mixture".

The device separates cardboard components from used paper materials via a conveyor (or sorting belt) that carries the material to a sorting station. The paper and cardboard components of the mixture are carried flat, with partial supports and recessed free zones between the supports. A holder synchronized with the conveyor projects spikes that penetrate into the free zones, piercing the (hard) cardboard components to be retained at the holder. The (more flexible) paper components are not pierced and move onwards. The paper components are thus separated from the cardboard components.

According to the Court, there are two essential elements of EP 092: (1) the wastepaper mixture is only partially supported so that there are free zones, and (2) the spikes can project through these free zones. The spikes press the more flexible paper components into the free zones and pierce the cardboard parts.

Bollegraaf offers for sale a paper sorting device that implements EP 092 under the name "Paper Spike".

Wagensveld on the other hand sells a paper sorting device under the name "Carbo Separator". The Carbo Separator consists of a sorting belt that carries the mixture of cardboard and paper, and a sorting roll with spikes. The spikes pierce the cardboard components while the more flexible paper components remain on the belt. In the first generation Carbo Separator, the sorting belt had grooves and the spikes on the sorting roll and the grooves were aligned. In the second generation Carbo Separator, the sorting belt has a flexible surface: the spikes in the sorting roll press in the flexible surface, piercing the cardboard components, while the more flexible paper components are not pierced.

Stora Enso, a manufacturer of paper that uses recycled material as raw material, purchased a second generation Carbo Separator for its facilities in Belgium, giving rise to the infringement action.

According to Bollegraaf and Grumbach, the Carbo Separator (both generations) infringe EP 092. Wagensveld and Stora Enso filed a counterclaim for revocation of EP 092.

The Court first decided that EP 092 is valid but should be construed narrowly.

With regard to the Carbo Separator of the first generation, the Court ruled that it infringed EP 092. The Court found that the grooves of the sorting belt are indeed "free zones" as meant in EP 092 through which spikes can project. Although Wagensveld stated it no longer commercialized this product, the Court imposed an injunction.

With regard to the Carbo Separator of the second generation, Bollegraaf and Grumbach argued that the sorting belt would deteriorate as a consequence of the pressing of the spikes into the surface of the sorting belt; grooves would eventually appear, creating "free zones". Although grooves can indeed appear in the surface of the sorting belts after some time, the Court considered this to be the consequence of wear and damage, holding that such local and random grooves cannot be considered "free zones" with carefully chosen dimensions as meant in EP 092.

The Court ruled that this was not literal or infringement by equivalent.

In this noteworthy decision, the Ghent Court of Appeal confirmed its earlier case law that, as a rule, patents should be construed narrowly given their anti-competitive effects. Moreover, it clarified its position on possible infringement as a consequence of wear and damage.

An embodiment of EP 092:



A schematic view of the Carbo Separator second generation:

