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The Italian Supreme Court on infringement by equivalents

Daniela Ampollini (Trevisan & Cuonzo) · Monday, April 23rd, 2012

The Italian case law on infringement by equivalent is rather scant and, until very recently, only one decision had been issued on this matter by the Supreme Court: 13 January 2004, no. 257, Lisec v. Forel, which stated that in order to assess infringement by equivalents it is necessary to consider whether the allegedly infringing product, in allowing the solution of the same technical problem, is original in that it does not result in a banal or repetitive solution as opposed to the patented one. until very recently The Supreme Court has recently issued its second decision: 30 December 2011, no. 30234, Barilla v. Pastificio Fazion. The case concerns a patent owned by Barilla claiming a system to dry up pasta according to which the pasta, rather than being laid down horizontally on the conveyer belt passing through the drying oven as in the prior art, is fixed between two perforated plates that are anchored vertically to the conveyer belt, which plates are hit transversally by the hot air passing through the oven, thereby increasing the capacity of drying ovens and reducing the risk of deformation for the pasta to be dried. Pastificio Fazion was using a system which differed from the patented one as the plates, rather than being perforated, were provided with grooves which still allowed the diffusion of the air to the pasta. Pastificio Fazion therefore claimed that such a grooved shape was an original and non banal solution with respect to using perforated plates, which in fact improved the overall system as it further reduced the risk of deformations for the pasta. The court of first instance and the court of appeal had rejected Barilla's claim, stating in substance that there was no infringement by equivalents as the solution adopted by Pastificio Fazion was, in fact, not banal. The Supreme Court, however, has now reversed the lower courts' decisions. In particular, the Supreme Court found that, regardless of the fact that the solution adopted by Pastificio Fazion as to the shape of its plates would not be a banal one, it must be considered that the perforation of the plates only represents one minor element in the overall patented invention, whose main characteristic is that of having changed the way of drying pasta by introducing the possibility to hold pasta vertically, rather than horizontally, on the conveyer belt. Therefore, the use of different plates, although provided with an original shape, does not exclude the (at least partial) infringement of the patent. The Supreme Court concluded by posing the following principle: "in order to exclude infringement by equivalents, the variation, although original, which concerns a single element of the patented invention is irrelevant, if the same variation is unable to exclude the use, even if only partial, of the patented invention".

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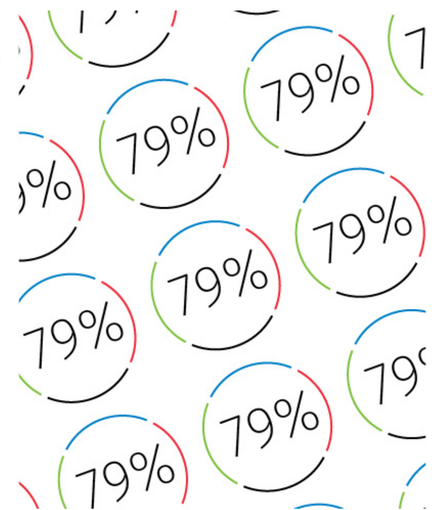

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This entry was posted on Monday, April 23rd, 2012 at 12:21 pm and is filed under (Indirect) infringement, literally fulfil all features of the claim. The purpose of the doctrine is to prevent an infringer from stealing the benefit of an invention by changing minor or insubstantial details while retaining the same functionality. Internationally, the criteria for determining equivalents vary. For example, German courts apply a three-step test known as Schneidmesser's questions. In the UK, the equivalence doctrine was most recently discussed in Eli Lilly v Actavis UK in July 2017. In the US, the function-way-result test is used.">Equivalents, Italy, Mechanical Engineering
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