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Discoveries versus inventions in an interesting decision of the Court of Appeal of Turin

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In a case involving the US multinational Mars and an Italian producer of rice (Riseria Monferrato), the Court of Appeal of Turin, by decision of 19 November 2008, tackled – one of the few cases in Italian case law – the interesting issue of the difference between discoveries and inventions and their patentability.

The case concerned, amongst other, the revocation of a process patent for the treatment of rice aimed at obtaining a product which would cook more quickly. According to the Court of Appeal, the patented process differed from the prior art in that it removed the last step (i.e. the compression of the rice grain) from a known process, claiming that said last step was irrelevant as the result pursued by the process (i.e. obtaining a rice which would cook more quickly) had already been obtained after the execution of the second to last step in the process (involving the milling of the bran from the rice grains).

The Court of Appeal acknowledged that the last step included in the prior art process represented a true technological prejudice, in that, in the field, it was thought that pressing rice grains was always a necessary step. This notwithstanding, the Court of Appeal indicated that an invention is present when the discovery (i.e. the cognitive act of identifying an existing situation, which is not patentable as such) is coupled by a "construction", i.e. a productive rule, and concluded that no productive rule can be found in a case in which the rule is to refrain from doing something.

In the case at issue, according to the Court of Appeal, the teaching only resulted in the discovery that a certain activity (the above mentioned last step) is useless, which would not elevate the discovery to the degree of invention. This was even more so considering that the two processes lead to the same product, and in fact the product claims contained in the patent application had already been removed during prosecution as considered not new by the EPO examiner. As a result of this reasoning, the patent was revoked for lack of inventive step as, according to the Court of Appeal, once the discovery had been made, the idea of eliminating the step as a consequence of the discovery of its uselessness, represents an automatic, obvious and banal consequence which may be understood not only by the person skilled in the art, but by anyone.

The reasoning of the Court of Appeal of Turin in this decision is very elaborated and based on thoughtful evaluation of the law and the relevant case-law. It is however not 100% convincing as it mix up with the two concepts of discovery versus invention, on the one hand, and inventive step, on the other hand. One could in fact say that the Mars process was certainly not a mere discovery

as a discovery is such when it involves the status of nature, while the prior art process was already containing a “productive rule” and the patented process simply modified such “productive rule”.

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