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## The role of the Judge in reviewing court expert's reports, inventive step and product by process claims in a recent decision of the Court of Turin

Daniela Ampollini (Trevisan & Cuonzo) · Tuesday, August 28th, 2012

By ruling of 10 July 2012, the Court of Turin decided in the first instance an infringement action filed by Italian company Novamont against German and French companies Biotec and Biosphère, for the alleged infringement of three Novamont patents concerning starch based plastic materials used in the production of biodegradable shoppers. The Court denied the infringement and, in fact, found for the nullity of the enforced patents (with the sole exception of a process claim of one of said patents, which was however not found to have been infringed).

The decision is a case in which the Court partially dissented with the conclusions of the Court Expert who had instead found that one of the three enforced patents was valid and infringed. In this regard, the decision clearly sets out the rules upon which the Judge may overcome and diverge from the findings of his own Court Expert. It is in particular stated that, provided that the Judge is never bound by the findings of the Court Expert as he is the so called “peritus peritorum”, the Judge can nevertheless only dissent from the Court Expert's findings when the criticism brought by the parties towards the Court Expert's conclusions is of a type and nature that can be independently understood and assessed by the Judge based on his non-scientific background. In other words, this is only possible when the criticism concerns the logic, methodology, rationality and inexistence of contradictions or inconsistencies in the reasoning followed by the Court Expert, by subjecting the latter's report to a scrutiny that is within the reach of the Judge who, although competent in the legal rules governing patents and their interpretation, is incompetent in the specific scientific field and cannot therefore substitute himself for the Court Expert in the assessment of criticism of a merely technical nature.

In addition, this is one of the very few Italian decisions that theorise on the approach to be taken in the assessment of inventive step. In particular, it is clearly stated that the approach to be generally used is the problem and solution approach, which the Court defines as follows: “According to Article 48 Italian IP Code, an invention is considered having inventive step if, for a person skilled in the art, the invention is not obvious from the state of the art. As such an assessment is carried out ex post (i.e. after the invention) it is necessary to conduct the same assessment based on logical criteria that avoid to consider obvious what was not obvious before the invention. To this end, the EPO has established the guidelines to be followed in so called problem – solution approach. There are three stages in this approach, namely: a) the determination of the reference prior art; b) the identification of the objective technical problem which the invention proposes to resolve; c) the verification of whether the solution adopted to resolve the objective technical problem, starting from the prior art, was “obvious” for the skilled in the art. The latter stage is generally defined as

the “would – could” approach and it is aimed at verifying, by means of an ex ante assessment, if the skilled person would have been pushed to resolve the technical problem starting from the prior art in the hope to in fact resolve the objective technical problem, or at least to obtain some improvement or advantage”.

The decision finally touches a point concerning product by process claims, by clearly acknowledging that the claim of a product that is defined by means of the process remains nothing more than a product claim, so that it is the product which needs to be novel and inventive and therefore differ from the prior art for some objectively verifiable feature. The process mentioned in the claim cannot cure the inexistence of novelty and inventive step in the claimed product – says the Court – but just contribute to overcoming difficulties in defining the product from a structural point of view.

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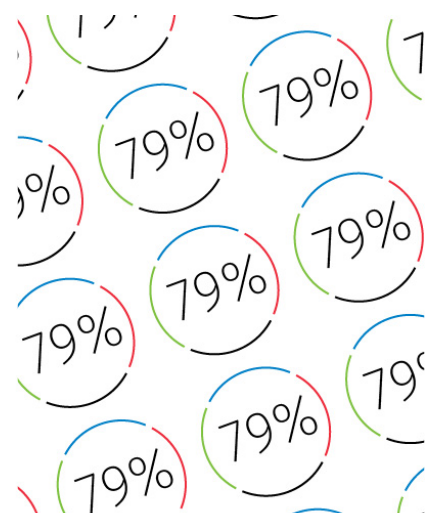
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