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Valencia Court of Appeal applies the “doctrine of equivalents” in jamonero dispute

Miquel Montañá (Clifford Chance) · Monday, February 17th, 2020

In *Odiorne v. Winkley* (1814), Harvard professor Joseph Story, then sitting as a Judge at a Circuit Court of the District of Massacusetts, upon being called to decide whether a machine infringed a patent wrote, in the context of that case, that “The material question, therefore, is not whether the same elements of motion, or the same component parts are used, but whether the given effect is produced substantially by the same mode of operation, and the same combinations of powers, in both machines. Mere colorable differences, or slight improvements, cannot shake the right of the original inventor.” The latter sentence laid down one of the seeds of what would become later known as the “doctrine of equivalents”, a doctrine with which courts around the world have been struggling since then.

On of the latest contributions to this debate from the Spanish Courts has come from the Valencia Court of Appeal, which in a judgment of 2 July 2019 applied the “doctrine of equivalents” to a case dealing with *jamoneros*. Readers who do not speak Spanish might be wondering what a *jamonero* is. It is a device used to hold a pig’s leg to safely cut the ham (“*jamón*“), that wonder of the Iberian Peninsula that has arrived to this day thanks to the formidable efforts of an agricultural engineer called Miguel Odriozola Pietas, who saved a bunch of Iberian pigs from a sure death in a country where people were starving during the Spanish Civil War.

Going back to the case discussed in this blog, the complainant asserted patent EP 1.623.661 B1 against a Spanish company that was marketing a *jamonero* (i.e. ham holder) allegedly falling within the scope of protection of claim 1, which reads as follows:

> *” Multi-positionable ham holder, of the sort that consists of a means for holding the leg, conveniently a pressure screw and a means for supporting the thicker part of the ham, characterised in that this includes:*
>
> *– A support structure (1) able to be installed on a horizontal or vertical surface.*
>
> *– A securing part (2) set in said support structure, characterized by :*
>
> *– Bars (6) which have a concave-curved shape and which have at their ends means for securing the leg of a ham and means for sticking in the opposite end of the hem; these bars are able to run along said securing part (2).*
>
> *– A mechanism for releasing/securing the bars (6) in respect of the securing part (2).*“

The case was assigned to Valencia Commercial Court Number 2, which on 11 June 2018 handed down a judgment finding that the *jamonero* fell within the scope of protection of the patent. This judgment has now been confirmed, as far as the finding of infringement is concerned, by the judgment of 2 July 2019 from the Valencia Court of Appeal. The Court, after noting that the device under discussion did not reproduce literally each and every characteristic of the claim, reached the conclusion that there was infringement under the doctrine of equivalents on the following grounds:

> *Thus, the substitution of a concave-curved bar that characterises the patent (without indicating whether it is circular or flat), for a flat bar in the defendant's ham holder falls within the same literality and continues to fulfil the same function (precisely the fact that it is concave-curved allows it to "run along the securing part").*
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> *The same can be said of the securing part. In this case, the infringement by literality can be questioned (as stated, this was already rejected), but not whatsoever infringement by equivalence. It could be said that the defendant has opted to apply the plaintiff's patent using a solution involving flat parts (bar and securing part) rather than round parts, which obliges the defendant to (partially) modify the securing system (obvious) in order for it to fulfil its adjustable function.*
>
> *In any event, the infringement occurs by equivalence because it fulfils exactly the same function. It does not alter the functioning, it is obvious, and it is clear that the subjection to the characterising elements is essential. Thus, it is not necessary to delve into issues regarding their finishing, stability, strength, ease of cleaning the ham holder and the product's supposed improvements.*

As readers may have noticed, the test applied resembles the U.S. "substantially same function-same way-same result" test (*Graver Tank & Mfg & Co v. Linde Air Products Inc* (1950)), which is the test traditionally applied by the Spanish Courts in cases dealing with mechanical patents and appears to be here to stay.

This entry was posted on Monday, February 17th, 2020 at 6:53 pm and is filed under 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, Patents
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