

COURT OF FIRST
INSTANCE, PARIS

3rd Chamber, 3rd Section

No RG:
07/17231

ORIGINAL COPY NO: 3

Summons of:
12th December 2007

JUDGEMENT
Issued on 20th May 2009

APPLICANT

Company BOEGLI-GRAVURES
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CH-2074 MARIN SWITZERLAND

Represented by Jacques ARMENGAUD, from SEP J.ARMENGAUD & S
GUERLAIN, lawyer from the Paris bar, room W.07

RESPONDENT

Company DARSAIL Ltd
4 Kulneva St 121170 MOSCOW (RUSSIA)

Represented by Serge BINN, lawyer from the Paris bar, from SERLARL LAVOIX,
room P515.

COMPOSITION OF THE COURT

Elisabeth BELFORT, Vice-President, *signatory to the decision*
Agne THAUNAT, Vice-President,
Florence GOUACHE, JUDGE

Assisted by Marie-Aline PIGNOLET, Clerk, *signatory to the decision*

PROCEEDINGS

At the hearing of 2nd February 2009
In open court

JUDGEMENT

Declared by submission of the decision to the clerk
given after due hearing of the parties
in the first instance

FACTS AND CLAIMS OF THE PARTIES

BOEGLI-GRAVURES SA (hereinafter BOEGLI) is the holder of a European patent published under number 1 324 877, registered on 3rd October 2001 and issued on 21st June 2006.

The aim of this patent is “*a device to emboss and satin-finish a flat material*”.

The device in the invention is used in particular for sheets of metalized packaging for packs of cigarettes.

At the TABEXPO exhibition, which was held at the Parc des Expositions de Villepinte on 26th-29th November 2007, DARSAIL exhibited and offered devices for sale, which BOEGLI considered to be infringing copyright.

Following authorisation of the court, the goods infringing copyright were confiscated at the show.

According to the act of 12th December 2007, BOEGLI GRAVURES summoned DARSAIL for infringing patent rights.

According to its latest records of 13th January 2009, BOEGLI-GRAVURES requests that the court:

- declares that by importing, keeping, manufacturing, offering for sale and selling the devices and sheets produced by the devices offered for sale, which reproduce the characteristics in claims 1, 2, 5 and 8 of patent EP 1 324 877 held by BOEGLI GRAVURES, DARSAIL is culpable of infringing copyright in the meaning of article L 615-1 of the Intellectual Property Code;
- prohibits the continuation of these illicit acts under obligation,
- rules, in application of article L 615-7-1 of the Intellectual Property Code, the withdrawal of the counterfeit devices and/or the essential means of the device, such as rollers, from distribution channels and this being, for the purposes of destruction, at the cost of the respondent, and under obligation,
- rules, in application of article L 615-7-1 of the Intellectual Property Code, that DARSAIL pays it a provisional sum of 500,000 euros as compensation for its prejudice according to an expert who must be appointed, and indemnity of 50,000 euros in application of article 700 of the Civil Proceedings Code.

all being subject to the provisional implementation of the decision to be given and the authorisation to publish the decision in newspapers or reviews as well as on the homepage of DARSAIL's website.

DARSAIL Ltd, a company in Russian law, concluded, in its latest records of 22nd January 2009:

- the nullity of the French European patent 1 324 877 for lack of novelty, absence of inventive activity in extending the subject of the patent, beyond the contents of the application as registered;
- absence of infringement of copyright, as no supposedly counterfeit device was found on its stand and the analysis of the seized rollers proved insufficient in this respect, with regard to imitation aluminium rollers.

Therefore, this company requests that the nullity of all the claims in the opposed patent be declared and that the requests be dismissed as well as the applicant's ruling that it be paid compensation of 50,000 euros in application of article 700 of the Civil Proceedings Code.

In that:

Concerning the scope of patent EP 1 324 877:

The invention concerns a device for satin-finishing (which allows for the appearance of repeat motifs) and embossing (which allows for the appearance of simultaneous designs) on packaging sheets and on packaging sheets produced by this device.

The patent states that given the state of the art, there is, in existence:

- a device to satin-finish a sheet comprising two embossing rollers arranged to be reciprocally displaceable, and whose teeth engage. The sheet, which passes between the two rollers, can be embossed by removing teeth, the surface remaining flat in the space where there are no teeth.
- an object embossed on the substrate on which elements are stamped defining motifs whose aspects change depending on the angle of observation.

The problem the patent seeks to resolve is the creation of a device to create embossing, which stamps signs producing variable optical effects depending on the position and/or the source of the light, in order to create security elements which are very difficult to copy.

In order to do this, claim 1 of European patent 1 324 877 makes provision for "*a device for the simultaneous satin-finishing and embossing of packaging sheets with a metalized surface or made from metal, comprising at least two embossing rollers connected to a drive and which could be driven individually or together, it being possible to press the rollers one against the another elastically and the pyramidal or conical teeth having a flattened point, **characterised** in that the pyramidal teeth (T2)*

or conical teeth of a roller have at least a geometric form and/or different surface from that of the teeth (T1) designed for the satin-finishing in order to produce, as the packaging sheet is passed through this space, embossed signs (L) which alter the metalized surface of the packaging sheet and whose aspect changes depending on the angle of view of the observer (O) and/or the type and/or the position of the light source (LS).

The height of the different teeth T2 is less than that of the other teeth (R2); the shape of the sides or edges of teeth T2 are different from teeth T1 (R3). The surface of the flattened face of teeth T2 is structured (R4).

Claim 5 makes provision for a variant where the device is provided with a third supplementary embossing roller which cooperates with the first embossing roller or the preceding roller in order to obtain signs with a variable aspect, in the subsequent embossing, the said rollers being provided with teeth T2.

According to claim 6, the embossing rollers are reciprocally synchronised by synchronisation means.

Claim 7 makes provision for the possibility of least one of the non-driven embossing rollers to be supported in order to be capable “*of a deviation in the longitudinal direction of the axis and/or in the direction of the contact pressure and/or in the direction of movement of the material to be embossed*”.

Claim 8 protects the packaging sheets produced by the device according to the previous claims, these sheets being satin-finished with, on this satin-finished background, at least one sign (L) whose intensity varies depending on the angle of observation (O) and/or the types and/or position of the light source (LS) and comprising at least one group of signs (L) having the same aspect individually, in pairs or in groups.

On the validity of the BOEGLI patent:

On the validity of claim 1:

On extending the subject of the patent beyond the application as registered:

DARSAIL maintains that in the patent application description as registered, the sheets in the invention were aluminium sheets with no mention of other metals, or paper or “metalized synthetic” medium. By pointing out that the device in the application can be used for the satin-finishing and embossing of the packaging sheet with a metalized surface whatsoever the medium for this metalized surface or of packaging sheets comprising whatsoever metal, the patent extended the subject of the patent beyond the contents of the application as registered, which must incur the nullity of claim 1 and the dependent claims in application of articles 138.(1)c of the European Patent Convention (EPC).

The court notes that the patent application as registered details on page 7, lines 14 to 18 of the translation: “*these signs can be applied to the packaging of tobacco, cigarettes, foodstuffs, chocolate, medicine or other products of this type. Such*

packaging strips or sheets principally comprise aluminium or principally foldable paper”.

As the patent application was registered in German, the contention regarding the extension of the patent subject must be assessed in relation to the term “vorwiegend”. If, according to one of the first meanings of this word, “principally” means that the sheets are in a material comprising aluminium, another meaning is “more frequently” or “more generally”. It is this latter meaning which must be used given the content of the following phrases, which refer to the terms “metalized paper” “metalized layer” “metallic layer” without using the word aluminium, these materials being listed after the introduction “*recently for environmental reasons, materials to be embossed have been developed...*”.

In these conditions, the contention regarding extending the patent subject beyond the application is rejected, as the description has expressly targeted all metallic materials or metalized surfaces, with aluminium only being the material most frequently used.

On the novelty of claim 1:

DARSAIL claims that claim 1 is not new in relation to the information in claim 7 of patent US 6 176 819 by BOEGLI (BOELGLI patent 1) published on 23rd January 2001 which covers the same invention, this claim making provision for rollers comprising firstly an assembly of fine teeth, “*each a second set of larger teeth, the second set of teeth on a first roller being shaped to engage in the second set of teeth on the other roller*”. DARSAIL states that to be able to engage with one another when the rollers are rotating, the “larger teeth necessarily have a pyramidal or conical shape as well as, by nature, a different surface from those of the fine teeth in the first set. Finally, these larger teeth will produce embossed signs which are different from the satin-finished relief and the aspect of these signs will necessarily change “*depending on the angle of view of the observer and/or the type and/or the position of the light source*”.

The court states: -

- that contrary to the abovementioned translation produced by DARSAIL, the term “engage” is not translated by “mesh” but by “engage”;
- that it follows that the only purpose of the larger teeth on the edges of the rollers is to facilitate the engagement of the roller, one of which is mobile in translation in relation to the other, when the device is started up;
- that the purpose of the marginal part of the sheets is not to receive the embossed signs.

Since the function of the modified teeth in this patent is different from that of the teeth on the opposing patent, this publication does not act as a bar to the novelty in claim 1 of the former.

On the inventiveness of claim 1:

DARSAIL asserts that this claim is null and void with regard to the combined information in the BOEGLI 1 AND NIELSEN patents.

The NIELSEN patent, whose application was registered on 12th August 1970, concerns a manufacturing procedure for a material in sheets embossed on both sides, which consists of inserting the sheet material between two cylinders whose surfaces are equipped with projections, these being off-set axially from the adjacent projections on the other cylinder such that these projections form straight lines practically parallel to the axes of the cylinders, the embossing being obtained by stretching the sheet material from the peak of each projection on each cylinder to the surrounding peaks of the projections on the other cylinder. The patent states that *“because the two series of grooves cut each other, projections are formed which are approximately pyramidal whose sides are preferably in the shape of teeth with a 20% angle of engagement... in the method of completion shown, all the teeth are identical but the height and the shape of the teeth could thus vary, for example, to provide a particular motif. For example, it is possible that certain projections have a relatively large surface area which could be significant when the embossed product has to be adhered on a flat surface... the material can be formed from paper, fibrous material, metal or thermoplastic material”*. This manufacturing procedure allows sheets to be obtained with hardwearing qualities and the capacity to absorb significant shocks.

The BOEGLI patent concerns a device to manufacture satin-finished sheets whose designs are obtained using projections with particular shapes, these being placed on the outer surface of two cylinders which engage mutually, and the designs obtained are identical.

In the terms of article 56 of the EPC, *an invention is considered as involving an inventive activity if, for those of ordinary skill in the art, it does not result clearly from the state of the art.*

As DARSAIL rightly pointed out, those of ordinary skill in the art, in this case the engineer designing machine tools, seeks to have a device available, which allows for satin-finishing (repeat motif) and embossing at the same time in order to create security motifs, with it being noted that the effect of the light in the appearance of bas-relief designs is well known and it is not disputed that this is currently used in the area concerned.

Therefore, those of ordinary skill in the art will start from the Nielsen publication, which describes a device to emboss a sheet allowing a repeat motif (satin-finishing) to be obtained at the same time as a specific motif (embossing) without the properties bestowed on the sheet embossed in this way (hardwearing, capacity to absorb shocks perpendicular to the plane of the sheet) deviating from this invention, as these qualities do not contradict the sought after result.

Those of ordinary skill in the art, using the NIELSEN publication, know a device comprising at least two embossing rollers called cylinders connected by a drive and which can be driven individually or together (cf page 4 lines 28 to 36). The two rollers have pyramidal teeth with a flattened point (figure 3 and 5). The distance between the rollers is governed so that, when the rollers are rotated and when the sheet is inserted, these teeth cooperate creating a relief on this sheet (figure 5 and lines

32 to 24). Given the position of the teeth on each roller (figure 4), their interlocking creates repeat motifs (satin-finishing). The sheet can be formed from paper, fibrous material, metal or thermoplastic material and the obtained product can be used for the packaging. As has already been seen, the height and shape of the teeth can vary in order to obtain a specific motif (page 5 lines 35 to 38); on one of the rollers, pyramidal or conical teeth can have a geometric shape and/or a different shape from that of the other teeth in order to produce “embossed signs” as the sheet passes through.

The subject of claim 1 is totally publicized with the exception of the characteristic stressing the “elastic” pressing of the rollers, with it being noted that the effect of the light is well known in making bas-relief designs appear.

Concerning elastic pressing, this technique is described in the BOEGLI 1 publication (column 1 lines 1 to 12).

Therefore, in order to adapt to variations in sheet thickness, those of ordinary skill in the art using the NIELSEN information, which provides the solution in terms of the shape of teeth required to obtain specific motifs, will adopt the BOEGLI 1 technique for elastic pressing and will thus possess all the characteristics in claim 1.

Even in the hypothesis that those of ordinary skill in the art would seek to perfect the BOEGLI 1 device to create specific security motifs, he would find information in the NIELSEN publication whereby specific designs can be made to appear by varying the shape and the height of the teeth, with it being noted again that the effect of the light to show bas-relief designs is a known principle and currently used in surface treatment of materials.

In these conditions, the court considers that claim 1 of the opposed patent is null and void because of the absence of inventive activity.

On the validity of claim 2:

This claim is null and void with regard to the abovementioned NIELSEN information with it also being noted that, as rightly concluded by DARSAIL, in order to remove material from a teeth, there is no other solution than to plane one or several of its faces or its edges. Moreover, the NIELSEN information undisputedly states that specific designs result from the difference in height of a set of teeth in relation to another set.

This claim 2 is also null and void because of the absence of inventive activity.

On the validity of claims 3 and 4:

As these claims are not opposed, the request for nullity in their regard is rejected.

On the validity of claim 5:

This claim states that the device can comprise a third roller, the signs being produced by means of cooperation between this third roller and the first or second roller.

As DARSAIL has rightly stated, the description does not mention any particular advantage to adding a third roller, the latter allowing “*the same motif to be obtained in subsequent embossing*” (page 8 lines 12 and 13).

Therefore, this claim could not be inventive, as the NIELSEN and BOEGLI 1 publications do not limit their device to the use of only two rollers.

On the validity of claim 6 and 7:

As these claims are not opposed, the request for nullity in their regard is rejected.

On the validity of claim 8:

As has already been seen, the operation of the NIELSEN device fitted with the “elastic pressure” technique from the BOEGLI 1 publication produces sheets with both satin-finishing and specific designs, which appear under the effect of the light, the characteristic consisting of systematising these designs in pairs or groups does not present any inventiveness since they are a result of the shape or height of groups of teeth precisely fitted for this purpose.

This claim 8 is also null and void because of the absence of inventive activity.

On the counterfeiting:

As the opposed claims have been declared void, requests regarding counterfeiting are not applicable.

On other requests:

With regard to costs incurred by DARSAIL for its defence and evidence provided, it will be awarded compensation of 30,000 euros in application of article 700 of the Civil Proceedings Code.

With regard to the nature of the facts and the age of the dispute, this judgement is subject to provisional enforcement.

ON THESE GROUNDS,

The Court

Ruling following full discussion with the parties, in the first instance and by a decision understood to be agreed

Subject to provisional enforcement,

Cancels claims 1, 2, 5 and 8 of European patent 1 324 877 held by BOEGLI.

State that this judgement, which is definitive, will be sent to the INPI to be registered on the Patent registry, by the current clerk, requested in advance by the more diligent party.

Declare as inadmissible the applications for nullity for the other claims, which are not currently opposed by DARSAIL,

Dismiss the applications of BOEGLI,

Rule that BOEGLI pays DARSAIL compensation of 30,000 euros in application of article 700 of the Civil Proceedings Code and costs,

Apply the provisions in article 699 of the New Civil Proceedings Code to the benefit of Selarl BINN & Associes, lawyers, for the share of costs it has incurred in advance without receiving prior provision.

Drawn up and ruled in Paris 20th May 2009,

CLERK

PRESIDENT