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**FRENCH REPUBLIC**  
IN THE NAME OF THE FRENCH PEOPLE

**PARIS COURT OF APPEAL**

**Pole 5 – Chamber 1**

**RULING DATED MARCH 23, 2011**

(no. 70, 06 pages)

Registration number on the docket: **09/12645**

Decision referred to the *Cour*: Judgment dated May 20, 2009 – High Court of PARIS –  
Docket no. 07/17231

**APPELLANT**

**BOEGLI-GRAVURES, SA**

company under Swiss law

represented by its legal representatives

having its registered office at 24/26, rue de la Gare, P.O. BOX 9

CH-2074 MARIN (Switzerland)

electing domicile in the offices of the SCP MONIN D AURIAC DE BRONS, attorneys to the  
*Cour*

assisted by Me. Jacques ARMENGAUD, attorney at the Paris Bar, i.d.: W07

pleading for the SEP ARMENGAUD ET GUERLAIN

**APPELLEE**

**DARSAIL LTD**

company under Russian law

represented by its legal representatives

having its registered office at 4 Kulneva St.

121170 MOSCOW (Russia)

electing domicile in the offices of SCP FANET SERRA, attorneys to the *Cour*

assisted by Me. Serge BINN, attorney at the Paris Bar, i.d.: P515

pleading for the SELARL LAVOIX AVOCATS

**COMPOSITION OF THE COURT:**

The case was heard on February 8, 2011, in a public hearing, before the court made up of:

Mr. Didier PIMOULLE, president  
Ms. Brigitte CHOKRON, adviser  
Ms. Anne-Marie GABER, adviser

who discussed it

**Clerk** during the discussions: Ms. Christiane BOUDET

**RULING:** - adversarial  
- handed down by filing at the court registry office, the parties having been previously notified under the conditions set out in the second subsection of Article 450 of the Code of Civil Procedure.

- signed by Mr. Didier PIMOULLE, president, and by Ms. Aurélie GESLIN, clerk, with whom the minutes of this ruling were filed by the signing magistrate.

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**THE COURT,**

In light of the appeal lodged by the business corporation [*société anonyme*] organized under Swiss law Boegli-Gravures of the judgment by the High Court of Paris (3<sup>rd</sup> chamber, 3<sup>rd</sup> section, Docket no.: 07/17231), handed down on May 20, 2009;

In light of the most recent pleadings by the appellant (January 25, 2011);

In light of the most recent pleadings (December 30, 2010) by the Russian company Darsail, appellee;

In light of the closing order pronounced on February 1, 2011;

\* \*

**WHEREFORE,**

Whereas Boegli-Gravures (hereafter: Boegli), holder of European patent no. 1 324 877 filed on October 3, 2001 and granted on June 21, 2006 relating to a “device for embossing and satinizing flat materials,” having observed, during the Tabexpo exhibition at the Parc des Expositions de Villepinte from November 26 to 29, 2007, the exhibition and sale, by Darsail, of equipment it considered to be infringing, carried out a seizure, then summoned that company based on the infringement of claims 1, 2, 5 and 8 of the patent;

Whereas the *Tribunal*, by the judgment under appeal, having found, for the essential issue, that claims 1, 2, 5 and 8 of the invoked patent were invalid for lack of inventive step, rejected all of the claims by Boegli;

Whereas Boegli is pleading for invalidation of the judgment, defending the

validity of its patent, and reiterating its requests as claimed in first instance based on the infringement; Darsail is asking the *Cour* to uphold the judgment and, additionally, to cancel claims 1 to 7 for extension of their object beyond the application as filed and claims 1 to 8 for lack of inventive step and to state, in any case, that the alleged infringement is not proven;

**Admissibility of the contest regarding the validity of claims 3, 4, 6 and 7:**

Whereas the *Tribunal* rejected, as inadmissible, Darsail's requests to invalidate claims 3, 4, 6 and 7 of the patent in dispute, which were not enforced against it; the appellee is, however, maintaining these requests, which it presents as counterclaims since they are seeking to procure it an advantage other than the mere rejection of its opponent's claims;

But whereas, pursuant to Article 70 of the Code of Civil procedure, counterclaims are only admissible if they have a sufficient connection to the original claims;

Whereas, in the case at hand, the circumstance that claim 3 depends on claims 1 and 2, that claim 4 depends on claims 1 to 3, that claim 6 depends on claims 1 to 5 and that claim 7 depends on claims 1 to 6, and the fact that the parties are competitors in the activity sector where the patent is exploited, do not establish a sufficient connection to justify, in the context of this dispute, the critical examination of the validity of the claims of the patent that are foreign to the original claims; whereas the judgment will therefore be upheld on this point;

**Validity of claims 1, 2, 5 and 8 of the patent:**

Whereas, pursuant to Article L.614-12 of the Intellectual Property Code, "a European patent may be revoked with effect for France on any one of the grounds set out in Article 138(1) of the Munich Convention";

Whereas Article 138, paragraph 1 of the Munich Convention dated October 5, 1973 on European patents provides that a European patent may only be revoked under the law of a Contracting State, with effect for its territory, on the following grounds:  
a) if the subject-matter of the European patent is not patentable within the terms of Articles 52 to 57;  
[...]"

Whereas, according to Article 52, paragraph 1 of the Munich Convention, "European patents shall be granted for any inventions which are susceptible of industrial application, which are new and which involve an inventive step"; whereas Article 56 specifies that "an invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art";

Whereas the person skilled in the art, within the meaning of the provisions recalled above, is one who has normal knowledge of the art in question and is capable, using only his professional knowledge, of conceiving of the solution to the problem the invention proposes to resolve;

Whereas the art in question in this case consists of creating reliefs on a flat surface by exerting pressure thereon using a suitable device; whereas this technique involves, depending on the proportion of the reliefs and the nature of the surface,

drawing, stamping, embossing or satinizing; whereas the appellant rightly criticizes the definition of the person skilled in the art as held by the *Tribunal*, i.e. the machine-tool designer, which errs due to excessive extension, while that proposed by Boegli, i.e. a micromechanical engineer with knowledge of optics, adds a specificity that is not required as this simply involves a shadow effect, which is a universally known phenomenon that consists of knowing that the size of a shadow, therefore its visibility, depends on the height of the relief that creates it, but also the incidence angle of the light hitting it;

Whereas assessing the existence of an inventive step assumes determining whether the means that make up the invention were previously disclosed in one or more documents of a definite nature in terms of their date, content, and accessibility to the public, if there were grounds motivating the person skilled in the art to pose the technical problem at the base of the invention in question and to combine, alter, or complete the characteristics disclosed by this or these document(s) in order to resolve the posed technical problem and whether these operations led him obviously to the invention in question;

Whereas, in the case at hand, the person skilled in the art knew about the existence of patent FR 2,058,248 published on May 28, 1971, called the Nielsen patent for the name of the inventor, which relates to “a method for manufacturing a material in foil embossed on both sides which consists of inserting the material of a foil between two cylinders, the surfaces of which are provided with protrusions such that one protrusion of each of the cylinders is surrounded on all sides, at the interstice of the cylinders, by protrusions of the other cylinder, each of the protrusions of a cylinder being axially offset in relation to the peripherally adjacent protrusions of the same cylinder, protrusions of one of the cylinders forming, with corresponding and alternating protrusions of the other cylinder, straight lines practically parallel to the axes of the cylinders”;

Whereas the circumstance that the method thus described aims primarily to impart, to the foil material thus treated, by drawing and distortion, increased performance in terms of strength and shock absorption is not sufficient to exclude it from the field of the normal knowledge of those skilled in the art, especially given that, aside from the main function thus described, the patent explicitly considers that “the height and the shape of the teeth could also vary, for example so as to yield a particular pattern. For example, it is possible to give certain protrusions a relatively large surface, which can be important when the embossed product must be adhered to a flat foil. The material can be made up of paper, fibrous material, metal, or thermoplastic material. In the illustrated embodiment, the two sets of grooves are positioned with the same incline angle, but they can also have different incline angles. It is also possible for one series of grooves to be oriented axially and the other obliquely”;

Whereas the Nielsen patent also describes “a pair of cylinders intended to perform the method and the characteristics of the pair of cylinders according to the invention lies in the fact that the protrusions have a practically flat upper surface and a well-defined transitional region, while rounded, from this upper surface to the side surface of the protrusion. It is thus possible to obtain good retention of the material during the embossing operation, i.e. complete or partial locking of the material in its position on the cooperating protrusions of the two cylinders so that it is possible to obtain the desired stretching between the apices of one of the cylinders and the apices of the protrusions of the other cylinder given that movement of the material during the beginning of the cooperation between the two cylinders is avoided”;

Whereas claim 1 of the patent in dispute relates to “a device for satinizing and simultaneously embossing packaging foils having a metalized surface or consisting of metal, comprising at least two embossing rolls that are connected to a driving system and capable of being driven individually or in common, the rollers adapted to be resiliently pressed against each other and the interpenetrating pyramidal or conical teeth of the rolls having flattened tips, characterized in that pyramidal or conical teeth (T2) of at least one roll have a different geometrical shape and/or surface than the teeth (T1) that are intended for satinizing in order to produce embossed signs (L) that modify the metalized surface of the packaging foil and whose appearance changes according to the viewing angle of the observer (D) and/or the kind and/or the position of the lighting source (LS) in these locations during the passage of the packaging foil”;

Whereas a comparison of the texts of the two patents, clarified by the accompanying drawings, leads the court to approve the *Tribunal*, which held, after having performed the same operation (page 7, 2<sup>nd</sup> subsection of the judgment), that the subject-matter of claim 1 was completely disclosed by the Nielsen patent with the exception of the characteristic related to the elastic pressing of the rollers, having observed that the *Tribunal* also rightly noted that the feature of a low relief pattern that changes appearance depending on the viewing angle of the observer and/or the kind and/or the position of the lighting source is well known and cannot be considered a discovery demonstrating an inventive step,

Whereas moreover the Nielsen patent, although it does not explicitly disclose the shadow effect, nevertheless teaches that varying the height and shape of the teeth makes it possible to obtain specific patterns, from which it results that a person skilled in the art knows that by reducing the height of the teeth or protrusions, he will obtain a pattern with a less pronounced relief, which will reveal itself with a different intensity to the observer depending on the incidence angle of the light;

Whereas Boegli does not contest that its patent EP 0925911, filed on December 11, 1998 also belongs to the state of the art and is in within the scope of the knowledge of those skilled in the art and that that patent, which relates to satinizing metal foils in which certain zones may not be satinized and may remain smooth in order to show signs such as trademarks or written information, also teaches that the two rollers can be pressed against each other elastically;

Whereas it emerges from the preceding that it was on relevant grounds which the *Cour* is adopting that, having invalidated claim 1 of the patent for lack of inventive step, the *Tribunal* thus invalidated, on the same grounds, the subsequent claims 2, 5 and 8 of the patent; whereas, then, the claims by Boegli for infringement of the claims thus invalidated cannot be received;

Whereas the judgment must be definitively upheld in all provisions thereof;

\* \*

**ON THESE GROUNDS:**

UPHOLDS the judgment in all provisions thereof,

ORDERS the business corporation [*société anonyme*] organized under Swiss law Boegli-Gravures to pay all costs of the appeal, which can be recovered pursuant to

Article 699 of the Code of Civil Procedure, and to pay the company organized under Russian law Darsail €40,000 pursuant to Article 700 of the Code of Civil Procedure.

**THE CLERK,**

**THE PRESIDENT,**