ITALIAN REPUBLIC

IN THE NAME OF THE ITALIAN

PEOPLE THE COURT OF APPEAL OF

TURIN CIVIL SECTION V

Specialised Section for Commercial Matters

Meeting in chambers, composed of the judges Germano

Cortese and Dr Emanuela	President
Dr Cecilia Marino	Judge (rapporteur)
Rizzi, Dr Francesco	Judge, has

issued the following

JUDGMENT

In the civil proceedings, registered under case no. R.G. 955/2024, brought on appeal by:

Opposing Party_1 (VAT No. *VAT_1*) in the person of its pro-tempore legal representative, Dr. *CP_2* represented and defended by Solicitors Fabrizio Jacobacci and Nicoletta

Galizia of the Turin Bar, and with address for service at the latter's offices at 8 Corso Emilia, Turin – as per the power of attorney on file.

- appellant

against

CP_3 with registered office at 16-18 Rue Chalgrin, 75016, Paris, France, in the person of its pro tempore legal representative Mr *CP_4* represented and defended by Alberto Tornato and Daniel Hazan, of the Milan Bar, and by Maddalena Bumma, of the Turin Bar

at whose office she is domiciled in Turin, at 32 Corso Cairoli – as per the power of attorney on file.

- respondent

SUBMISSIONS OF THE PARTIES

On behalf *of* **the appellant:** *"May the Court of Appeal, in setting aside the judgment of the Court of Turin No. 3684/2024 of 26 June 2024 - Having first ordered the renewal of the court-appointed expert report in light of the manifest error in the conclusions reached by the same in the first instance; - To ascertain and declare the nullity (of the Italian portion) of EP patent '483; - With award of costs, fees and expenses, to be assessed in accordance with Ministerial Decree No. 55/2014, plus a flat-rate reimbursement of general expenses at 15% (Article 2, Ministerial Decree No. 55/2014), C.P.A., VAT as required by law and any subsequent costs incurred in the two instances of the proceedings".*

On behalf of the respondent: *"May this Most Honourable Court of Appeal, having rejected the opposing arguments, and reject, in particular, the request for the renewal of the court-appointed expert report by Eng.* *Per_1* *to rule as follows: IN THE MAIN, to dismiss in its entirety the appeal brought by* *Opposing Party_1* *since it is unfounded in both fact and law, confirming, subject to the acceptance of all the objections, including those relating to the taking of evidence, raised by the respondent at first instance, judgment no. 3684/2024 issued by the Court of Turin on 26 June 2024 in proceedings RG no. 6310/2022; IN ALL EVENT: order the appellant, pursuant to Article 96 of the Code of Civil Procedure, to pay to* *CP_3* *a sum determined on an equitable basis, including as compensation for damages. With costs (including those of the court-appointed expert and the party-appointed expert), fees and expenses of both instances."*

SUBJECT MATTER OF THE DISPUTE AND GROUNDS FOR THE DECISION

1. By writ of summons served on 30 March 2022, the present appellant *Controparte_1* — a company operating in the textile automation sector — brought proceedings before the Court of Turin against the company *CP_3* (a company incorporated in France), seeking a declaration of the invalidity of the Italian portion of European patent No. EP 1 951 483 (hereinafter 'EP '483'), owned by the defendant, on the

grounds of lack of inventive step. Specifically, patent EP ‘483’ relates to an ‘automatic cutting machine for sheet materials’ and, consequently, for fabrics, characterised by a curved structure designed to withstand deformations caused by pressure, comprising

a housing that is concave and bulges outwards at least in its lower part, opposite the cutting zone; according to the patent description (doc. 3, plaintiff's part), this configuration makes it possible to significantly limit the structural deformations that the cutting machine undergoes during operation due to pressure and to achieve a weight saving of around 30% compared to a conventional cutting machine (and, consequently, a saving on the costs of the
machine, transport and installation).

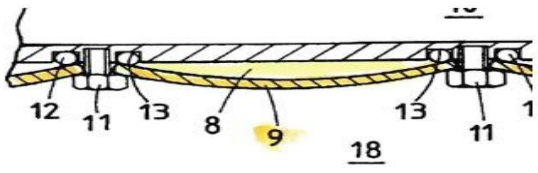
Co argued that the claimed solution (essentially, the outward curvature of the housing) was lacked inventive step in the light of general knowledge in the field and, specifically, the combination of two prior art references: 1) Japanese patent application JP H08-257985 A, relating to a cutting machine with a suction chamber (without outward curvature); 2) Japanese patent application JP 2000-029469 A (and corresponding European patent EP 0 970 896 A2), relating to a double-walled, curved, heat- and sound-insulating chamber. *Co* stated that the Japanese Patent Office had rejected the corresponding patent application for *CP_3* precisely on the basis of these prior art, and therefore urged that the patent in question be declared invalid.

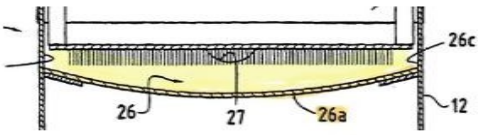
1.2. , in its statement of defence dated 16 June 2022, formally entered the proceedings *CP_3* , preliminarily raising a plea of lack of jurisdiction regarding the non-Italian portions of the patent and defending the validity of the patent on the merits. The defendant argued that the technical problem solved by the patent, not limited merely to resolving the issue of deformation, was twofold: to increase structural strength and to reduce weight (by up to 30%), objectives neither achieved nor suggested by the prior art cited, which related to technical fields different from and distant from that of cutting machines (namely relating to thermal insulation, as the cited prior art concerned a thermally and acoustically insulated container), and which were therefore not relevant for assessing inventive step. The defendant therefore moved for the dismissal of all the claimant's claims.

1.3. <u>The Court ordered a court-appointed expert report</u>, appointing Eng. *Person_2* *[...]* to verify the validity of European patent No. EP 1951483, with particular reference to its novelty under Article 46 of the Italian Industrial Property Code and to the inventive step under Article 48 of the Italian Industrial Property Code.

Following the expert's investigations, in the report filed on 21 June 2023, the court-appointed expert concluded that the Italian portion of patent EP '483' was valid and that the requirements for novelty were met, finding that the solution identified was not obvious in relation to the prior art. In particular, the court-appointed expert noted that: ***i)*** the objective technical problem of the Lectra machine is to increase the strength of the structure without increasing its weight; ***ii)*** the claimant's conclusions regarding the lack of inventive step based on the teachings of document EP'896 (the European patent corresponding to the original Japanese patent JP'985, in which a vacuum is used to achieve insulation and thus performs a specific function entirely different from the suction flow present in the cutting machine) cannot be accepted and, in particular, the conclusions that "EP'896 contains an explicit teaching, even for a person skilled in the art of fabric cutting machines, to give the housing 26 an outwardly curved shape in its lower part" [1] ; ***iii)*** the conclusions of the Japanese Office cannot be accepted in light of the technical analysis carried out, as the combination of the documents does not prejudice the validity of the patent *CP_3* under examination.

1.4. <u>The Court of Turin, Commercial Division, in its judgment no. 3684/2024 published on 26 June 2024</u>, dismissed the applications for *CP_1* *and* ordered it to pay the costs of the proceedings and the court-appointed expert. The Court justified its decision by fully endorsing the conclusions of the court-appointed expert, noting in particular that:





[1] D2 - Japanese patent JP 885, i.e. EP 896 ↑ Lectra patent EP 483 ↑

• The technical problem solved by the patent is not limited to the prevention of deformation, but consists in increasing the strength of the machine's overall structure without increasing its weight; therefore, the argument that the solution is obvious, put forward by *Co* , based on 'common general knowledge'

and prior art not considered by *Cont* , is not convincing and appears to contradict the criticism levelled

to *Opposing_Party_6* ;

• The prior art (document D2/EP '896) describes a double-walled, vacuum-insulated container, a structurally different solution far removed from the field of cutting machines, such that a person skilled in the art would have found no incentive therein to implement the solution claimed by *Co_2* ;

• The expert's conclusions are based on reasonable analytical findings, thereby validating the reasoning *by reference.*

2. An appeal was lodged against the judgment of the Court of Turin *Opposing Party_1* citing three grounds of appeal, one of which concerns costs, reiterating on the merits all the defences already put forward at first instance and rejected by the first judge, and requesting a new expert report due to the manifestly erroneous conclusions of the one carried out at first instance.

The first ground of appeal (which is divided into two sub-grounds) **concerns the incorrect interpretation of the facts and**

the case documents in relation to the validity of the patent, *Co* complains that the Court was erred in identifying the technical problem addressed by the patent where it observed that it *"does **not** consist of the need to prevent deformation of the part of the machine that is arched"*, ruling in clear contradiction to the patent description itself, which instead expressly states that the lower part of the outwardly curved vacuum chamber *"allows for a significant reduction in the structural deformations that the cutting machine undergoes during operation*". Furthermore, the appellant contends that the solution (of the aforementioned "curvature") is obvious in the light of "common general knowledge" (i.e., elementary laws of physics – considering, for example, submarines, dams, and pressure vessels – which demonstrate that it is well known that a curved wall, namely the curvature of the bottom of a casing, withstands pressure better than

(a flat surface), thus constituting the application to that specific field of a physical principle known for centuries. It should be added that prior art D2 (JP '469/EP '896 – Patent relating to insulated containers), which contains a clear teaching to curve or arch a wall outwards to resist deformation caused by pressure differences, predates patent *CP_3*, which is therefore devoid of novelty. These elements were apparently erroneously overlooked

by *Opposing_Party_7* (when it registered the Lectra patent), but were instead cited and taken

into account by the Japanese Patent Office in rejecting the corresponding patent application. The Appellant points out that D2 (*see image in note 1*) contains a clear teaching to curve or arch a wall outwards to resist deformation caused by the pressure difference, which is exactly the solution claimed by *CP_3* for its cutting machine, with the consequence that D2 anticipates the *CP_3* patent and, as such, is sufficient to invalidate it.

On the point of inventive step, *CP_3's* defences regarding the inapplicability of D2 because it pertains to a 'different technical field', were not proven at first instance and the court-appointed expert deemed it relevant only 'in hindsight'.

In a 'sub-ground' also concerning the erroneous decision on the validity of the patent, the appellant complains of inconsistency in the position regarding *(Cont),* criticising the passage of the judgment in which

it is stated that the argument of obviousness "is difficult to reconcile" *Cont* for failing to have seen the documents with the criticism of

cited; on the contrary, there is no contradiction: it is precisely this general knowledge that should have prompted the skilled person in the art to seek solutions in related fields (vacuum technology), leading him to

find documents D1 and D2, which t*Cont* he had not found and which would have made the solution obvious.

With the Second Ground concerning the failure to state reasons due to uncritical acceptance of the expert report *Co* omplains that the Court merely adopted the expert's conclusions, describing them as 'based on analytical findings', without, however, responding to the specific and detailed criticisms raised by the claimant's experts. In particular, the appellant considers that the judge failed to state reasons for deeming the court-appointed expert's error in interpreting the D2 figure (regarded as a complex double-walled structure rather than as

a lesson on the curvature of the individual panel) to be irrelevant. FK

argues that the reference *by reference* does not exempt the judge from having to explain the reasons why he is disregarding the party's critical observations.

With the additional ground concerning litigation costs, as a consequence of the request for reversal on the merits, Co seeks the reversal of the ruling regarding litigation costs and the court-appointed expert's fees, which should be borne by CP_3 in accordance with the principle that the losing party bears the costs.

3. By a statement of 15 November 2024,

CP_3 , requesting, subject to a declaration of inadmissibility of the appeal pursuant to Article 348 bis of the Code of Civil Procedure, the dismissal of the appeal and the full confirmation of the contested judgment, with an order for the costs of the proceedings. The respondent considers the grounds set out in the judgment, to which reference is made, to be correct, reaffirming the validity of its patent and considering the expert investigation carried out at first instance to be complete, logical and free from defects.

With regard to the first ground of appeal (incorrect interpretation of the facts concerning the validity of the patent),

CP_3 argued that the opposing party's reconstruction was unfounded, being based on an incorrect identification of the technical problem, highlighting that EP '483 patent does not merely aim to prevent structural deformation of the machine (as simplistically argued by Co), but pursues a dual, inseparable objective: to increase the strength of the overall structure **and**, at the same time, to reduce its weight (by up to 30%). The appellant's omission of the second requirement (lightness) would vitiate the entire reasoning on obviousness, as it renders references to 'worlds apart' technical fields (such as submarines, dams or bathyscaphes) apparently relevant, which address strength issues through heavy structures that are not comparable to the cutting machines at issue in the case.

As regards prior art, CP_3 reiterated the irrelevance of the combination of document D1 (JP H08-257985 A) and document D2 (EP 0 970 896 A2 / JP 2000-029469 A), the latter relating to double-walled thermal insulation containers, since extrapolating (as the appellant did) from document D2 solely the characteristic of the 'convex shape' of the panel, whilst ignoring the complex double-walled structure with a vacuum cavity serving the purpose of thermal insulation, constitutes

an inadmissible ex post facto analysis (‘hindsight bias’). Consequently, a person skilled in the art,

starting from a flat-bottomed cutting machine (D1) and seeking to solve the problem of strength and lightness, would find no incentive in D2 to adopt a simple curved base, given that D2 teaches a structurally different solution that is heavier and complexity. According to the respondent, the decision *Cont* not uphold the rejection decision issued by the Japanese Patent Office, based on a superficial and technically flawed examination of the same prior art.

Regarding the second ground of appeal (failure to state reasons due to uncritical acceptance of the expert report), *CP_*3 observed that the Court did not merely refer to the findings of the expert report but specifically set out the reasons for its agreement, adopting the logical arguments of the report concerning the definition of the technical problem and the analysis of prior art, with reference to the case law of the Court of Cassation (Cass. 11007/2024) according to which a judge who accepts the conclusions of the court-appointed expert is not required to explicitly refute every single observation made by a party if the overall reasoning implicitly rejects the opposing arguments.

Finally, *CP_3* sought confirmation of the first-instance judgment regarding costs, urging the appellant to be ordered to pay further costs pursuant to Article 96 of the Code of Civil Procedure, considering the appeal to be frivolous and vexatious, given the re-submission of technical arguments clearly refuted by the evidence in the proceedings.

4. Following the hearing at which the parties appeared, held by way of written proceedings pursuant to Article 127-ter on 5 December 2024, the Court, having decided to reject the application for a fresh expert report, set reverse deadlines for the clarification of submissions and the filing of closing pleadings, and adjourned the case to the hearing for referral to the Court for decision on 28 January 2026, at which the case was then referred to the Court for its decision.

GROUNDS FOR THE DECISION

First of all, at this stage, any assessment of the respondent's application regarding manifest lack of merit under Article 348-bis of the Code of Civil Procedure is superfluous.

The appeal must be dismissed.

-FIRST GROUND OF APPEAL

The ground of appeal is not well founded.

The appellant's assertion that the judgment is incorrect in stating on page 3 that *'the technical problem addressed by the patent is* not *the need to prevent deformation of the part of the machine that is* bent' is incorrect.

The appellant justifies this assertion by stating that the technical problem to be overcome is the deformation of the machine and that the objective of the patent is to increase the strength of the machine's overall structure without making it heavier; the court of first instance is alleged to have confused the problem with the objective.

CP_3 responds to *CP_8* as follows

"The patent of CP_3 therefore sets itself not only the task of resolving the problem of structural deformation that the machine's frame undergoes during operation, but also a dual objective, as can be seen from page 4 of the Italian translation of EP'483 (see doc. 5, first-instance file):

1) the first objective is to increase the strength of the machine's overall structure, thereby reducing the aforementioned disadvantages, which include the deformation of the machine resulting from the strong vacuum generated at the cutting conveyor, which is necessary for precision during the cutting phase;

2) the second objective is to achieve the result referred to in point 1) above without, however, having to make the overall structure of the machine heavier, and therefore without increasing the weight and, consequently, without increasing transport and installation costs. Indeed, paragraph [0008] of patent EP'483 (see page 4 of the technical description referred to in document 5 of the first-instance file) states that "The main purpose of the present invention is to reduce these disadvantages by increasing the strength of the overall structure of the cutting machine without, however,

increasing its weight and thus its cost, transport and installation prices".

On this point, the court-appointed expert concludes on page 10 of the Expert Report (see Annex B), stating that *"patent CP_3 clearly presents the technical effect achievable through the presence of a casing with an outwardly curved depression in the lower part, namely an increase in the strength of the structure without adversely affecting the weight, as is the case with machines known in the*

, where the desired structural strength is achieved by increasing the thickness of the structure or adding reinforcing elements".

The Court notes that the appellant quotes only part of the sentence contained in the judgment, which is worded as follows and thus takes account of the complexity of the issue: " *Taking into account the expert opinion as a whole, the claimant's argument regarding the obviousness of the solution is not convincing, because the technical problem addressed by the patent does not consist of the need to prevent deformation of the part of the machine that is arched, but rather of 'increasing the strength of the machine's overall structure', 'without increasing its weight*'.

The appellant's argument that the court of first instance confused the problem with the objective cannot be accepted, as it seeks to artificially separate two aspects of the inventive concept which are, in fact, encompassed within the very concept of an invention.

An invention is, in fact, a new, original and industrially applicable solution to a previously unsolved technical problem, achieved through the technical application of a scientific principle or other theoretical knowledge, which makes it possible to obtain a product or a process.

The inventive step, contrary to the appellant's contention, is precisely defined by having created a new solution to the problem identified, consisting of increased strength without an increase in weight, by acting on structural deformation—a solution obtained by applying the physical principle of wall curvature.

The second aspect of the first ground of appeal, relating to the fact that, once the premise has been 'corrected', the patent would be invalid in light *of 'the obvious nature of the solution adopted by the patent in the light of common general knowledge'*, must also be rejected.

The appellant bases its argument on the observation that the physical principle whereby, to prevent the deformation of a wall subjected to pressure, the shape of the wall can be modified has been known for hundreds of years, as demonstrated by its practical application to objects such as submarines, etc., and is a principle known to any craftsman.

This is all the more so in view of the findings of a very simple query submitted to both the Google search engine and the ChatGPT application, which, by definition, do not ‘invent’ anything but simply ‘scan’ the knowledge and experience available online and, based on the principle of statistical probability, provide their response, as set out in the closing statement.

The appellant, in its written submissions of 27 January 2026, submitted a further query to the artificial intelligence, asking it to refer to knowledge from 2004 as well as a degree thesis on dams.

The respondent has requested that the new exhibits be declared inadmissible.

The submissions consisting of the queries to the AI and the thesis must be declared inadmissible as they were filed late, even if included in the text of a party’s pleading, as they constitute a new document even in that form.

Furthermore, the appellant has not provided evidence of the reliability of the artificial intelligence applications used, as data such as the scope of the knowledge available to the software—both in quantitative terms and in terms of qualitative depth—is unknown, nor is it known whether they are capable of avoiding so-called ‘hallucinations’, i.e. incorrect answers, etc.; therefore, no probative value can be attributed to the answers produced by *CP_1*

The ground of appeal based on the alleged obviousness, and therefore the lack of any inventive step, of the application of the physical principle of curvature cannot be accepted.

It is undisputed, in fact, that every invention is underpinned by one or more known physical principles, which are applied to provide new solutions to needs or problems.

The patentability of an invention lies in the implementation of a new and original technical solution to a technical problem, the novelty and originality of which are assessed in relation to the state of the art.

In the present case, the technical solution involved an inventive step that led to significant technical progress in relation to the specific requirements for the use of the cutting machine.

The statement made by *CP_3* appears correct, namely that if the appellant's argument were accepted, all patents on inventions relating to accelerometers fitted to *smartphones* – which allow the screen to remain horizontal relative to the ground despite the device's rotation – would have to be deemed invalid, as they are based on the well-known acceleration due to gravity.

The ground of appeal relating to the lack of inventive step of the patent at issue in relation to the patent referred to in document D2 must be rejected.

The appellant states that the Japanese Patent Office, a full 12 years after the *Opposing Party_6*, correctly rejected the patent application *CP_3* on the grounds of lack of inventive step, precisely in light of the combination of the document designated 'D1' – that is, a 'closest prior art' document relating to a cutting machine without a crown (JP H 8257985 A), cited by *CP_3* itself in its patent application filed in Japan – with doc. "D2", namely Japanese patent JP2000 029469 A (i.e. documents 4 and 5 produced at first instance).

In fact, the Japanese document "D2" – which has a European counterpart, EP 0 970 896 A2 – describes a container characterised by the presence of external panels (indicated by 9, FIG. 3 and paragraph 0041 of the description), which are convex outwards.

The same document D2, in paragraphs 0015 and 0017, *CP_1*, specifies that the according to

externally convex shape of the panels, in a cylindrical or arched configuration, makes the entire container – and not just a part (or side or box) of it – more resistant to deformation.

Well, if document D2, that is, the Japanese patent (like its European counterpart), teaches that the convex shape of each panel contributes to making the container as a whole more rigid (and not just the panel itself), one can only conclude that D2 anticipates both the aim and the means of solving the technical problem set out by *CP_3* itself in the introductory part of the patent of which

is the subject of the proceedings, with the obvious consequence that D2 anticipates the *CP_3* patent and, as such, is sufficient to invalidate it.

It is further noted that *CP_1* that, regarding inventive step, *CP_3* argued, during the proceedings at first instance, that D2 was inapplicable because it allegedly pertained to a

"different" technical field. This assertion, however, was not proven and, in fact, was correctly rejected by the court-appointed expert who, nevertheless, due to a trivial error of interpretation—highlighted by the appellant in its defence, most recently in its reply to the opposing party's closing submissions—considered that it did not constitute "explicit" teaching but deemed it relevant only "a posteriori"; despite this, the said error was not taken into account in any way by the judge.

According to *(Co),* if *Cont*, in the course of his research, had traced D2, he would have reached a different decision.

The main claim of document D2 (as correctly explained during the expert examination by *Co*) would confirm the teaching to mount each individual panel externally and not a double-walled structure. Therefore, directly and unequivocally, even a floor delimiting a depressurised compartment (hull) to prevent its deformation.

Yet, despite the expert witness's glaring error having been thoroughly identified by *Co* in its defence submissions, the Judge made no mention of this, merely confirming the (erroneous) conclusions of the court-appointed expert and, in particular, the fact that EP 896 describes a container *"which has a double-walled structure ...*".

Well, certainly a double-walled structure would not be deemed useful by an expert in the cutting machine sector, as it would clearly not contribute to optimising structural strength.

And this principle is not, as *CP_3* would have us believe, the "creation of a double-walled structure", but rather the simple creation of convex panels to withstand pressure.

The very same EP '896 patent refutes *CP_3's* argument, stating unequivocally in paragraph [0015]:

"*According to another aspect of the present invention, a thermally and acoustically insulating container is described in which the surface panels each have an outwardly convex profile..."*

The word 'each' indicates that the teaching applies to the individual panel, not necessarily to the entire complex double-chamber structure. Therefore, the illustration of a single

convex panel (such as the bottom 26a of patent CP_3) that withstands pressure (such as that in the chamber 26) is a faithful and correct representation of the teaching of Co '896.

The Court considers that the expert witness has responded exhaustively and in a logical and convincing manner to the arguments raised by CP_1

After explaining the content of EP 896, noting that it relates to a thermally insulated container and addresses the problem that containers known as cold-room freezers are constructed with insufficient thermal insulation, the expert examines the solution set out in EP 896 and compares it with that of EP 483, which is the subject of the proceedings.

On the basis of this analysis, he states that it is a stretch to compare the space in which a vacuum is created between the two walls of the thermally insulated container of EP 896 with the suction chamber of a cutting machine, since, although both structures utilise a space in which a vacuum is created or a condition of negative pressure due to the suction flow, these two differ not only structurally but also in terms of operation.

In fact, according to him, in EP'896 a vacuum is created in the space between the two walls, and the document describes how a pump, based on a signal from a sensor, maintains this vacuum condition. For this reason, the panels 9 are secured to the frames 6 and 7 of the structure's walls by means of fluid seals.

In the suction chamber of a cutting machine, however, it is necessary for the flow to act through the transport medium on the elements to be cut at the cutting head. There must therefore be a suction action aimed at achieving this positioning effect, and one of the problems associated with this operation, as described, for example, in document JPH08257985 (JP'985), is the management of the suction flow so that it is uniform.

Engineer Per_1 further states that the vacuum condition and the negative pressure condition in the suction chamber of the cutting machine are created for different purposes and operate in different ways, and that, for the reasons set out, the technical field of document EP'896 relating to thermal/sound-insulating containers is distinct from the field of cutting machines. Moreover, according to the court-appointed expert, completely excluding document EP'896 from the state of the art appears to be a

. Indeed, the person skilled in the art, intent on solving the identified technical problem of increasing the strength of the structure without increasing its weight—and thus a technical problem concerning the field of structures—might turn to different fields where problems relating to structural strength are addressed.

However, for a correct application of *the problem-solution approach,* in the expert's opinion, it is necessary to assess what the sector specialist would have done, and not what they might have done.

For a correct analysis, Eng. *Per_1* considers that the sector specialist must necessarily take into account the content of the document in its entirety without making inadmissible isolations or extrapolations of characteristics outside their context.

If one departs from this comprehensive consideration, as proposed by the appellant, the document will be assessed in a partial manner and will therefore already be flawed by a selective choice of the information and teachings presented.

Furthermore, the technical expert must also assess the compatibility and the modifications required to the original document in order to apply the teachings of the second document to the original document.

In the opinion of the court-appointed expert, none of the operations proposed by *CP_8* is indicated in document

EP'896, nor does the document provide any indications or suggestions that would have prompted the person skilled in the art to take steps which, as mentioned, involve selecting a panel that completely eliminates not only the double-wall structure described in EP'896 but also the support frame to which the panels are fluid-tightly secured.

With particular reference to paragraph [0017] of document EP'896, the expert witness confirms that EP'896, with particular reference to that paragraph, refers to resistance to deformation and describes how it is the shape of the container or chamber (which is made with a double-walled structure) – spherical, cylindrical or arched – that allows the thermal/acoustic insulation container to maintain its strength and reduce its surface area, which is precisely the problem that EP'896 aims to solve.

To disregard these teachings entirely, without there being any guidance, suggestion or

incentive for the technical expert in the field to take the steps identified by the Plaintiff, means, in the opinion

of Eng. *Per_1* to arrive at a *retrospective* assessment, having already the solution in mind claimed.

In light of the teachings of EP 896, in the opinion of the court-appointed expert, the person skilled in the art would have found no incentive to construct at least the lower part of the casing opposite the cutting zone with a shape that is convex outwards.

This document describes a multi-layered double-walled container in which a vacuum is created in the intermediate cavity, yet the person skilled in the art would not have used a double wall with panels mounted on opposing frames to form a cavity in a cutting machine where a suction box is present.

The act of isolating part of the document, as the appellant seeks to do, is the result of an inadmissible ex post analysis, having already the solution of patent *CP_3* in mind, rather than representing the steps taken by a person skilled in the art on the basis of incentives present in the prior document.

A person skilled in the art, taking into account the content of document EP 896 in its entirety, would not have found any incentives to isolate features thereof and, starting from the features described therein as necessary—namely the double-walled structure with a void between the two walls—would not have used that structure to form a chamber within it.

Finally, the Court-appointed expert notes that the Plaintiff has not explained how the panel taken from document EP'896 can be combined with the structure of the machine in the starting document JP'985, used as *the closest prior art* by the Plaintiff, leaving this point unsubstantiated.

It is therefore clear that the expert witness does not agree with the conclusions reached by the Japanese examiner, as in his opinion the combination of the documents, for the reasons set out in paragraph 3.4 of the draft report and subsequently confirmed, does not affect the validity of the Lectra patent in question.

The contents of the court-appointed expert's report are hereby reproduced in full.

The Court agrees with and endorses the arguments and conclusions of the court-appointed expert, who has provided a comprehensive response to the appellant's submissions, in particular by explaining why, as regards

EP 896, the ‘double wall’ must be taken into account, as the technical solution adopted, whilst using individual arched walls, is nevertheless achieved through the configuration of said ‘double wall’.

Following the reasoning of *CP_1,* moreover, not even *CP_10* would have been patentable, as it is an expression of a principle of common general knowledge.

Nor can one agree with the observation in *CP_1* that the expert witness considered the teaching of *Co* 486 to be non-explicit but relevant only in hindsight.

In fact, the expert witness placed himself in the ex ante position of the skilled person who had EP486 at his disposal at the time he was preparing EP483, concluding that said skilled person could not have used the stated purpose.

In view of the above, it must also be concluded that *Cont*, even if he had been made aware of the existence of EP 896, would have concluded that EP 483 was valid.

-II GROUNDS OF APPEAL

The appellant asserts that the judge at first instance based his judgment on the uncritical repetition of phrases taken out of context from the expert witness’s report, without, despite the criticisms raised by *Co* in his defence submissions, no position was taken on the matter.

Furthermore, the references to case law contained in the judgment are said to be entirely irrelevant.

They merely set out the general principle that the trial judge, where he or she accepts the conclusions of the court-appointed expert, is not required to provide specific and detailed reasoning.

This assertion, however, according to *CP_1* , would appear to be partial and misleading, in that it fails to take into account the fundamental distinction governing the matter, consistently reaffirmed by the Supreme Court (and which also emerges from a careful reading of the very decisions cited by the opposing party).

The case law of the Court of Cassation is in fact consistent in distinguishing between the scenario where the expert’s conclusions are not the subject of specific challenges and the entirely different scenario—which is the one

, where the party has raised specific, substantiated and detailed criticisms. Only in the first case may the judge provide reasons *by reference*, whilst in the second case he has a precise and inescapable obligation to provide detailed reasons for his decision to disregard such criticisms and to accept the expert's opinion.

On this point, he cites the statement of the Court of Cassation according to which: *'Where the trial judge accepts the opinion of the court-appointed expert, he is not required to set out the reasons specifically, since the acceptance of the opinion, by outlining the logical reasoning behind the decision, constitutes adequate reasoning, not open to challenge on grounds of legality, as the reference to the report, even 'by reference', may imply a complete and positive assessment of the line of argument and the scientific principles and methods followed by the expert; the situation is different where specific and detailed criticisms have been raised against the findings of the court-appointed expert report, both by the parties' experts and by the defence counsel: in such a case, the trial judge, in order to avoid falling foul of the defect under Article 360(5) of the Code of Civil Procedure, is required to explain in a precise and detailed manner the reasons for his or her acceptance of one conclusion or the other"* (Civil Cassation, Section I, 11 June 2018, No. 15147).

The ground of appeal must be dismissed.

It should in fact be noted that, as a general principle, the reasoning by reference contained in a judgment is entirely valid.

As indeed established by the Supreme Court, Civil Section, No. 642/2015 (Source: Italgiureweb), "in civil proceedings …, a judgment whose reasoning merely reproduces the content of a party's pleading (or other procedural documents or judicial orders), without adding anything to it, is not void provided that the grounds for the decision are, in any event, attributable to the court and are set out in a clear, unambiguous and exhaustive manner, given that, in accordance with constitutional and procedural provisions, this drafting technique cannot, in itself, be regarded as indicative of a lack of impartiality on the part of the judge, who is not required to be original in either the content or the manner of presentation…"

In the case in question, the judge used the content of the expert report as the grounds for the judgment, applying the principle in question.

More specifically, he stated that he had *"taken into account the expert report in its entirety*".

This means that the decision-making process took into account both all the criticisms—certainly specific and detailed—raised by the appellant against the expert report, as set out in the report itself, and the comprehensive and exhaustive responses to those criticisms provided by Eng. *Per_1* in his final report.

-III GROUND

The appellant's request to set aside the first-instance judgment in respect of the section concerning litigation costs and expert report costs must be rejected, given that the appellant has been unsuccessful.

-LEGAL COSTS

The appellant, having been unsuccessful, must be ordered to reimburse the respondent for the costs of the proceedings, which are assessed at an indeterminate value, in the high complexity bracket, given that the case involved dealing with complex technical and legal issues. The preparatory phase is excluded from the calculation of costs, as it was not carried out.

The remuneration is determined as follows:

preparatory phase €2,977.00

preparatory phase

€1,991.00

decision-making phase €5,103.00

total €9,991.00 plus ancillary costs.

The application by *CP_3* for the opposing party to be ordered to pay costs pursuant to Article 96 of the Code of Civil Procedure must be dismissed, as the technical complexity of the matter and the existence of a contrary decision by the

(albeit non-binding and based on different criteria) preclude any reckless conduct in the litigation or abuse of process on the part of *Co* .

Pursuant to the provisions of Article 13(1-quater) of Presidential Decree No. 115/2002, the appellant is required to pay an additional amount by way of a standard court fee equal to that due for the main appeal itself.

P.Q.M.

The Court of Appeal of Turin, Fifth Civil Section, specialising in corporate matters, ruling definitively in the civil appeal case registered under No. 955/2024 R.G., all other claims, objections and arguments being dismissed, hereby decides:

Dismisses the appeal brought by *Counterparty_1* , with the following effect:

Confirms judgment no. 3684/2024 of the Court of Turin, Section Specialising in Corporate Matters, published on 26 June 2024 and served on 28 June 2024.

Orders the appellant to reimburse the costs of the proceedings at this instance in favour of the respondent *CP_3* , which are set at a total of €9,991.00 plus a 15% flat-rate reimbursement, VAT and stamp duty to the extent that they are due.

Declares that the conditions set out in Article 13(1-quater) of Presidential Decree 115/02 are met, as the party *Controparte_1* is hereby ordered to pay an additional sum, by way of a unified contribution, equal to the amount due for the same matter and the same appeal.

So decided in Turin, in the Council Chamber of the Fifth Civil Section, Specialised in Corporate Matters, on 17 March 2026.

The President

Dr Emanuela Germano Cortese

The Reporting Judge

Dr Cecilia Marino