

Court of Appeal
Brussels
Judgment
8th room I
civil affairs

In the case of:

The company under Israeli law SARIN TECHNOLOGIES LTD, with registered office at 4 Haharash St. Hod Hasharon 4524075, Israel (formerly 7 Atir Veda Street, Kfar Saba 4464307, Israel), named SARINE TECHNOLOGIES LTD following the name change of January 20, 2014,

appellant,

lawyers: mrs. Benoit Strowel and Steven Cattoor, with office at Nervierslaan 9-31, 1040 Brussels,

present at the hearing: mr. Steven Cattoor,

in return for

1. the bv OGI SYSTEMS EUROPE, with registered office in 2018 Antwerp, Schupstraat 1-7/60, registered with the CBE under no. 0473.352.377,

2. the company under Israeli law OGI SYSTEMS LTD., with registered office at 52522 Ramat Gan (Israel), 34 Tuval Street,

respondents,

lawyers: mrs. Fernand de Visscher and Eric De Gryse, with offices at Avenue Louise 250/10, 1050 Brussels,

present at the hearing: mr. Fernand de Visscher and Eric De Gryse.

The appeal is directed against a judgment handed down by the Court of First Instance in Antwerp on 18 December 2007.

The appellant appealed against this judgment by application lodged at the registry of the Court of Appeal of Antwerp on 30 June 2011.

The Court of Appeal of Antwerp ruled on this appeal by judgment of 20 February 2012.

Respondents lodged an appeal in cassation against the judgment of the Antwerp Court of Appeal of 20 February 2012.

By judgment of 6 March 2014, the Court of Cassation quashed the contested judgment insofar as it ruled that the data of the expert report should also not be taken into account with regard to factual findings and technical advice and ruled on the counterclaim of current defendants . The Court of Cassation referred the limited case to the Brussels Court of Appeal.

On May 30, 2014, the appellant summoned the respondents to appear before this court, following an appeal in cassation.

I. PROCEDURE PREPARATIONS

1. On March 17, 2005, the company under Israeli law Sarin Technologies Ltd, now Sarine Technologies Ltd, hereinafter referred to as 'Sarine', filed a unilateral application for an attachment concerning counterfeiting with the attachment judge at the Court of First Instance in Antwerp. It argued that the OGI Multiscope system, as well as one or more separate modules commercialized by OGI Systems Europe bvba, such as the OGI marker and the OGI writer, infringed its patent rights to the Belgian patent BE 1.014.912 (hereinafter also: 'BE '912') relating to a system and method for marking diamonds with a laser. By decision of 23 March 2005, the attachment judge granted both descriptive and attachment measures, and appointed ir. Walter Huys as an expert to proceed to a description of the alleged counterfeiting at the BVBA OGI Systems Europe with regard to the devices OGI-marker , OGI writer and Multiscope. Each holder of the allegedly infringing products was ordered not to hand over, sell or dispose of them, forfeiting a penalty of 2,000 euros per product placed on the market after notification of the decision.

The decision of March 23, 2005 was served on OGI Systems Europe BVBA on April 11, 2005. On the same day, the appointed expert proceeded to implement the descriptive measures. OGI Systems Europe bvba did not lodge any third-party opposition to this decision.

The descriptive report of the expert was communicated to the parties and to the attachment judge on 29 August 2005.

2. On 27 September 2005, Sarine proceeded to summon OGI Systems Europe bvba and OGI Systems Ltd., a company under Israeli law, hereinafter referred to as 'OGI', before the Court of First Instance in Antwerp for patent infringement.

Sarine's claim before the first court sought:

- declare in law that the defendants infringe the Belgian patent BE 1.014.912 of the appellant by importing, supplying, storing, commercializing and promoting the contested products in Belgium:

- to rule that the aforementioned infringement must be regarded as an infringement with bad faith;

- to prohibit the defendants, either directly or indirectly through branches, subsidiaries, distributors or in any other way, from importing, offering, commercializing, storing the contested products in Belgium and ordering them to carry out such acts on the Belgian to suspend the market under forfeiture of a penalty of 125,000 euros per copy of the products that

they would import, offer, commercialize or keep stock in contravention of this order from the tenth day after service of the judgment to be intervened;

- prohibit respondents from advertising the products in question and order them to cease such advertising subject to forfeiture of a penalty of 15,000 euros per day that such advertising would be conducted after service of the judgment to be intervened contrary to this order;

- order the defendants to pay the appellant provisional compensation in the amount of EUR 250,000 and to appoint an expert to estimate the damage suffered by the appellant, as well as the quantity and price of the infringing products sold;

- order the defendants to pay the costs of the proceedings, including the costs of the counterfeit seizure procedure;

- to reject the counterclaims of defendants;

- declare the judgment provisionally enforceable.

Respondents decided that the claim of the appellant is admissible, but unfounded.

A counterclaim was brought by respondents in order to:

- * declare the invalidity of the appellant's Belgian patent BE 1.014.912, at least the claims 1 to 15 of the said patent and order that a copy of the interlocutory judgment be communicated by the Registrar to the Belgian Office for Intellectual Property;
- * in the alternative, rule that the defendants did not infringe the appellant's Belgian patent no. BE 1,014,912;
- * the prohibition on handing over, selling, otherwise disposing of the objects suspected of counterfeit suspected objects, as imposed in the decision of 23 March 2005, lifted;
- * order that the judgment to intervene be published at the appellant's expense be published in two national daily newspapers, as well as in magazines 'Rapaport', 'Diamond World', 'CMP Asia' and 'Antwerp Diamond List', and order the appellant to pay pay the invoices, even not yet discharged, of the publishers and translators;
- * prohibit the appellant from making any communication to third parties in any countries and in any form whatsoever with regard to the order of the judge of attachment of Antwerp attachment judge of 23 March 2005 on pain of a penalty payment of of 10,000 euro per communication in violation of the judgment to be intervened, it being understood that each copy of a circular, a magazine or any other shall be deemed to be a communication for the purposes of the penalty, and subject to a penalty of 50,000 euros per day on which such a communication is present on an internet site which is under the control of the appellant or which is encouraged to do so by the appellant;
- * order the appellant to pay damages to the respondents of provisionally 100,000 euros for disseminating misleading advertising concerning the dispute between the parties;
- * order the appellant to pay the lawyers' fees and those of the patent attorney ex aequo et bono assessed at €40,000.

3. By interlocutory judgment of 18 December 2007, the Court of First Instance of Antwerp declared the main and counterclaims admissible, but before ruling on their merits the grand of them it ordered an expert examination by a panel of experts composed of Mr Koen Callewaert, Mr Eric Blondeel and Dr N.V.T.G. D'Halleweyn,

with mandate:

"to examine and give reasoned advice:

- A. Whether patent no. BE 1,014,912, filed on 14 June 2001 and granted on 1 June 2004 for "Marking Diamonds with the Laser" meets the requirements of 1. novelty and 2. Inventive activity as provided for in the Act on invention patents;
- B. Whether [OGI], by committing the acts complained of by [Sarine] of which it claims the cessation of, infringes the claims of the aforementioned patent,
- C. On the technical-scientific challenges raised by the parties."

The expert report was filed on 12 March 2011.

4. On 30 June 2011, after filing the expert report, Sarine lodged an appeal against the interlocutory judgment of 18 December 2007. The appellant limited her appeal to a grievance, which was to argue that the assignment granted to the experts contained legal questions and was therefore affected by an unlawful transfer of jurisdiction. By judgment of 20 February 2012, the Antwerp Court of Appeal decided the admissibility of the appeal. The plea of acquiescence raised by respondents was rejected as unfounded. The Antwerp Court of Appeal declared the appeal already well-founded as follows:

"Annuls the judgment in question;

Reserves consideration of the merits of the case;

Receives the counterclaim for vexatious or reckless appeal but declares it unfounded;

Remands the case for further proceedings (including costs in both submission and the costs of the expert examination) to the special role."

5. On 14 December 2012, OGI lodged an appeal in cassation against the judgment of the Court of Appeal Court of Antwerp of 20 February 2012.

This cassation appeal was based on two pleas.

At first, OGI essentially argued that the Antwerp Court of Appeal, by declaring the entire expert report null and void and setting it aside merely because the expert report was ordered by the first court in disregard of Articles 11 and 962 of the Judicial Code, and without considering which parts of the report contained mere findings and technical advice

and which portions contained advice on the the merits of the claim, Articles 862 § 5, 2°, 978 § 1 and 981(1) of the Judicial Code violated.

In a second plea, OGI argued that the judgment was not adequately reasoned in that no response was given to OGI's plea accusing the appellant of having erroneously acted by waiting until after the conduct of the expert examination before appeal and thus by appealing at a time when all expert fees had been incurred.

By judgment of 6 March 2014, the Supreme Court ruled as follows:

First ground of appeal

4. Under Article 11(1) of the Judicial Code, judges cannot transfer their jurisdiction.

Under Article 962(1) of the Judicial Code, the judge may, in order to resolve a dispute brought before him or in the event of a dispute actually and immediately threatening to arise, order experts to make determinations or give technical advice.

5. It follows from those provisions that the court may only order an expert to make findings and give technical advice and not give an opinion as to the merits of the claim.

6. The expert report drawn up in breach of those provisions should be excluded from the debate to the extent that it provides advice on the merits of the claim.

This does not, however, enjoin the court from considering the findings and technical advice given by the expert. issued technical opinions a/s data and, where the evidence is admitted by presumptions, to infer, where appropriate, factual presumptions from these deduction.

7. The appellate judges held that:

- the breach by the first judge of Articles 11 and 962 of the Judicial Code results in the absolute nullity of the contested decision, so that the expert's report/ag in its entirety lapses;

Therefore, the request of the claimants to retain the expert report to be retained as far as the technical determinations are concerned;

- the expert report cannot be taken into account.

8. The appellate courts thus held that, as a result of the infringement of Articles 11 and 962 of the Judicial Code, the data of the expert's report may not be taken into account, even to the extent that it contains findings of fact and technical opinions do not justify their decision in law.

The plea is well-founded.

Second plea in law

9. The appeal judges did not answer the defence referred to in the plea. The plea is well-founded.

(...)

Dictum

The Court,

Sets aside the judgment under appeal in so far as it finds that the particulars of the expert's report should not be taken into account even as regards the findings of fact and technical opinions, and rules on the plaintiffs' counterclaim.

Orders that the costs be reserved and leaves the decision in that regard to the court hearing the case.

Refers the matter thus restricted to the Brussels Court of Appeal."

6. On 30 May 2014, the appellant summoned respondents to appear before the Court of Appeal in Brussels following cassation.

II. CURRENT SUBJECT MATTER OF THE CLAIMS ON APPEAL

7. The object of the appellant's claim in its 'last substitute summary judgment on appeal following cassation', filed on 20 May 2022, is to:

- Declare the main claim well-founded and, accordingly:

* rule that the defendants infringed the Belgian Sarine's BE '912 patent by importing, supplying, putting into circulation, stocking, marketing and promoting stock, marketing and promotion of the contested products in Belgium:

* rule that the said infringement is to be considered as an infringement in bad faith;

* order the defendants to pay Sarine provisional damages of damages in the amount of EUR 250,000, subject to increase in the course of the proceedings, and to appoint an expert to determine Sarine's damages as well as the quantity and price of the sold infringing products.

* Dismiss the counterclaims of the defendants and, in particular:

- Declare that it has no jurisdiction to rule on the cease-and-desist order brought by the defendants

* the cessation claims brought by the intimates;

* in any event, declare the counterclaims unfounded;

* Subordinate. if the Court should be of the opinion that claim 1 of the Belgian patent BE '912 is invalid because of one of the nullity arguments: confirm that, pursuant to art. XI.57 §2 WER, the patent could at least stand could be upheld in the amended form proposed by Sarine, and to confirm that respondents still infringed the patent in the form thus amended, and in particular:

in accordance with the first request for relief, claim 1 of BE '912 be declared valid in the following amended form, while maintaining the other claims as granted:

"Diamond marking attachment for a device for three-dimensional

mapping of diamonds, in order to create a map of a diamond the surface of which is to be marked according to a predetermined motif, and in order to create the 3D coordinates of a sequence of marker points representing the aforementioned motif represent, whereby the mapping device and the attachment, at least during their operation, form an integrated mapping and marking system, wherein said attachment comprises the following includes:

- a low power laser source with associated focalisation optics, to emit a concentrated laser beam emitted according to an optical path;
- a system for determining marker positions to move the optical path to move with respect to the diamond and thus bring both into a marker position; and
- computer means for employing the said system for determining the marking positions to handle the laser beam and the diamond sequentially into said position for each of the said marker points based on the 3D coordinates of those points determined by the 3D diamond cartography device."

More subordinated in accordance with the second auxiliary request, the claims of patent BE '912 be declared valid in the following modified form:

"1. Diamond marking attachment for a device for three-dimensional mapping of diamonds, capable of creating a map of a diamond which surface is to be marked according to a predetermined motif, and capable of determining the sequence of marking points representing the aforementioned motif, wherein said apparatus comprises the following:

- a laser source with associated focalisation optics, to emit a concentrated laser beam emitted according to an optical path; a system for determining marker positions to move the optical path to move with respect to the diamond and thus bring both into a marker position; and

- computer means to use the said system for determining the marking positions, to apply the laser beam and diamond sequentially into the said position for each of the said marking points.

Wherein said system for determining the marking positions includes a diamond orienting device and a street orienting device;

Wherein said mapping device has a rotary table having a central rotary axis and an upper surface for attaching thereon said diamond, and wherein said rotary table has the said diamond orientation means; wherein said beam orienting means is capable of adjusting the length of said optical path and to adjust said path moving along said central axis;

2. An attachment according to Conclusion 1, further comprising a pedestal on which said said laser source and said beam orienting system mounted wherein the pedestal has support surfaces on which said device for the mapping of diamonds may be mounted, and wherein said computer means can manipulate said device and said can manipulate said mount;

3. An attachment according to Conclusion 2, wherein said beam orienting system includes a device for moving the laser for a computer-controlled linear displacement of said laser source with its associated focalisation optics along an anterior portion of the optical path, so as to correct the length of the optical path.

4. An attachment according to Claim 3, wherein said pedestal has guides and said device for moving the laser is in the form of a cartouche capable of being moved along said guides and to carry said laser with its focalisation optics.

5. An attachment according to Claim 3, wherein said pedestal is in the form of a base with a concave area between said supporting surfaces, to positioning said laser source in such a way as to ensure that said front part of the optical path extending into said concave zone on a first plane perpendicular to said central axis and located below the said upper surface of the turntable.

6. A confirmation according to Conclusion 5, wherein said beam orienting system additionally comprises optical components mounted to said pedestal to guide the optical path from said front portion to a rear portion located on a second plane parallel to said top surface of the turntable, and above it located.

7. An attachment according to Conclusion 6, wherein at least one of said optical components can be moved along an axis parallel to said said central axis.

8. An attachment according to Conclusion 1, wherein said computing means are in capable of creating the appropriate position corrections whenever the diamond surface to be marked diamond surface is not in the predetermined position."

More subordinately, should the court invalidate Belgian patent BE '912 because of any of the nullity arguments invoked by respondents and the first and second relief requests proposed by the appellant were not accepted: to reopen the debates reopen and set a new procedural calendar to allow the parties to exchange arguments on how the Belgian patent BE '912 should be limited in accordance with Art. XI.57§2 WER, taking into account the specific nullity argument retained by the court;

- Finally, and in any event, order the defendants to pay the costs of of the proceedings, including the counterfeiting attachment proceedings and the costs of the expert opinion, including the litigation fee, estimated at the maximum amount of EUR 15,400 at each instance.

8. In the final post cassation substitute summary judgment, OGI claimed that the court should would please:

In highest order:

- ruling on OGI's counterclaim, annul claims 1 to 15 of Belgian Patent

Belgian patent no. BE 1.014.912 and order that a copy of the intervening judgment be communicated by the Registrar to the Belgian Intellectual Property Office;

- consequently, dismiss all of Sarine's main claims based on claims 1 to 15 of this Belgian patent BE '912. this Belgian patent BE '912 be declared unfounded and dismissed;

- subordinately, the auxiliary applications with substitute patent claims filed by Sarine

filed with its substitute synthesis claim on appeal following cassation of 30 June 2020 as void and invalid as well as reject any claim by Sarine based on these patent claims allegedly founded;

In secondary order:

- Sarine's main claim against OGI, in the absence of proven infringement of the Belgian patent No BE 1,014,912, be declared unfounded and dismissed;

In any event:

- prohibit OGI Systems Europe from handing over, selling or otherwise dispose of the objects suspected of being counterfeit, as imposed by the decision of 23 March 2005 as a result of the application for bes lag on counterfeiting, in its entirety;

- order that the forthcoming judgment be published, at the expense of Sarine, in

two national newspapers, namely, in Dutch in De Tijd and in French (translation) in L'Echo, as well as in the magazines "RAPAPORT", "DIAMOND WORLD" "CMP ASIA" and "ANTWERP DIAMOND LIST", and order Sarine to pay of the invoices, even not yet discharged, of the publishers and translators;

- prohibit Sarine from making any misleading communication to third parties in all countries and in any like form concerning the order of the judge of attachments in Antwerp of 23 March 2005 or any other decision rendered in the context of this dispute between the parties, and forfeiting a a penalty of EUR 10,000 per communication in breach of the intervening judgment, provided that each copy of a circular, magazine or any other means, including a communication on the internet or via social media, will be considered a communication for the purposes of the penalty and under forfeiture of a penalty of 50,000 euros per day on which such communication is present on an internet website that is under direct or indirect control of Sarine or which is encouraged to do so by Sarine is encouraged to do so by Sarine;

- Order Sarine to pay to OGI a provisional indemnity of €100,000, for spreading misleading advertising concerning the dispute between the parties, and decide on the final quantum of damages reserve;

- Order Sarine to pay OGI additional provisional damages of €10,000, for wrongful seizure of the counterfeit goods suspected of counterfeiting, and reserve the decision on the final quantification of damages reserve;

- reserve judgment on the costs of the proceedings until a decision has been made

made on the final assessment of the damages suffered by OGI or, in subordinate order, order Sarine to pay the costs of the proceedings, including of court costs, estimated at EUR 19,600 at first instance and EUR 19,600 Euros on appeal (maximum amount indexed) and the full costs of the sum of EUR 28,974.51 which it has advanced, together with court costs and the judicial interest.

III. FACTS

Parties

9. The company incorporated under Israeli law Sarine Technologies Ltd (formerly Sarin Technologies Ltd), was founded in 1988. It is a world leader in the development, manufacture and commercialisation of innovative and high-quality planning, evaluation and measurement systems to assess and value diamonds enter manufacture of gemstones. Its products include instruments for assessing the quality of cut, colour and light performance of diamonds systems for determining the optimum yield of a rough stone, systems for mapping inclusions, laser mapping of inclusions, laser cutting and shaping systems and devices for the marking diamonds and for applying indicia to diamonds with a laser.

Its main expertise lies in the development of marking support devices and related products.

10. OGI Systems Ltd. is a company incorporated under Israeli law, established in 1990. It has specialised, inter alia, in the development and manufacture of systems for determining the optimum yield from a rough diamond, systems for mapping mapping of inclusions, laser systems for marking and cutting rough diamonds, systems for measuring and evaluating the cut, colour and light performance of polished diamonds and laser systems for engraving inscriptions on the diamond belts.

OGI is one of the world leaders in the development of such systems and equipment. It has six subsidiaries, including the Belgian subsidiary BV OGI Systems Europe. It supplies clients throughout the world, including in Belgium, Israel, India, South Africa, Thailand and in the United States of America.

The patent BE '912

11. There is no dispute between the parties that since the 1980s systems were known that, in the decision-making process prior to the processing of the rough diamond, used 30-cartography of rough diamonds, as well as systems for the three-dimensional measurement of finished stones, mainly for the assessment of their quality.

These 30-cartography systems allowed a full three-dimensional representation or virtual model of a stone in a computerised system.

Among other things, they were able to calculate the optimum yield of a rough diamond, and to indicate where the rough stone needed to be cut to obtain the most valuable diamonds to be obtained from the rough stone, including by showing the sawing surfaces on the three-dimensional virtual model.

Nore is there any dispute that since the 1980s, devices were available for laser inscription ('indicia') on a predetermined defined area of the surface of a finished, cut diamond, the location of which was was chosen by the user.

In the diamond industry, laser equipment was further used for the cutting/cutting rough diamonds along cutting lines, which were manually or semi-automatically marked on them were marked with an ink pen.

Sarine argues that in late 2000, early 2001, it introduced a system, called 'DiaMark®' introduced, which combined the capabilities of existing state-of-the-art devices combined and used them in a new way. This system used a 3D cartography device (Sarine's 'DiaExpert' or 'DiaExpert 2000' system) not only to decide how the diamond should be cut, but also to determine 3D coordinates of marking points corresponding to this decision, and a laser marking device that was capable of performing automated, accurate and indelible laser marking perform, sending a focused laser beam to be successively be brought to each of the points on the surface of the diamond whose 3D coordinates were obtained from 3D cartography. A laser marking device could be supplied as an additional module to an existing 'DiaExpert' 3D cartography system, or as a part of a new integrated system.

About two years later, it introduced a 'DiaScribe' system configured for the marking indicia on polished diamonds.

12. Sarine sought patent protection in Belgium, Israel, the United States and India.

It is the holder of Belgian patent No. BE 1,014 912 (hereinafter BE '912), relating to marking diamonds with a laser, with priority date 8 September 2000. The patent application was filed on 14 June 2001. The patent was granted on 1 June 2004, and expired 20 years after the patent application was filed on 14 June 2021. The patent was granted in French. Sarine submits as its exhibit 1.1.b its own translation of this patent into Dutch, prepared by a sworn translator. This translation is disputed on several points by OGI, and Sarine also moves in claims to amend parts of this translation. In this account of the facts, the Court of Appeal, for the sake of the readability of the judgment to a reproduction of the translation of the patent emanating from Sarine, without inferring that the court agrees with this translation. The ambiguities or disputes concerning the translation were dealt with when the assessment of the dispute when necessary.

The invention claimed in the asserted patent comprises three independent claims, each with a set of dependent claims.

Sarine invokes only independent claim 1 and its dependent claims 2 to 7 and 11 to 15.

The nature of the invention claimed in these claims is described as follows in the "Summary of the Invention" ("Resume de l'invention"):

"One aspect of the present invention discloses a device that is attached to a device for mapping diamonds, for the purpose of marking the diamond with a laser. The device for three-dimensional mapping of the diamond, the surface of which is to be marked, map and record a sequence of points forming that motif. The device comprises a laser source with associated focalisation optics, intended to produce emitting a concentrated laser beam, along an optical path extending between said source and a marker position on said surface of the diamond, as well as a beam orienting system for moving said path relative to the diamond to move it thus to the proper marker position.

The mapping device and the device constitute, at least in operation, an integrated system of mapping and marking in which the coordinates of each point of the mark were calculated by computer and where the beam orienting system was manipulated to send the beam sequentially to the different points."

The independent product conclusion 1 reads as follows:

"Diamond marking attachment for a device for three-dimensional mapping of diamonds, capable of creating a map of a diamond whose surface to be marked according to a predetermined motif, and capable of measuring the determining the sequence of marking points representing said motif wherein said apparatus comprises a laser source with associated focalisation optics, to emit a concentrated laser beam emitted according to an optical path;

- A system for determining marker positions to move the optical path move relative to the diamond and thus bring both into a marker position and
- computer means for using the said system for determining the marker positions to sequentially bring the laser beam and the diamond into the said position for each of the said marker points.

Product conclusions 2 to 15 are all dependent on conclusion 1 and relate to specific properties and/or additions to the attachment as described therein.

The conclusions 2 to 7 relied upon by Sarine read as follows (translation piece 1.1.b Sarine):

"2. Apparatus according to claim 1, wherein said system determining the marking positions, comprises means for orienting the diamond and To orient the beam.

3. Apparatus according to claim 2, wherein said mapping device comprises a rotary table provided with a central axis of rotation and an upper surface on which the diamond can be fixed, and said rotary table intended means of orientation of the diamond.

4. Apparatus according to claim 2, wherein said beam orienting device is capable of is to correct the length of said optical course and to move said course along the central axis.

5. Apparatus according to claim 4, further comprising a pedestal on which said laser source and said beam orienting system are mounted, the pedestal has supporting surfaces on which said device for the mapping of diamonds can be mounted and wherein said computing means can simultaneously manipulate said device and said fixture.

'Free translation by Sarine of : "Fixation de marquage de diamant pour un appareil de cartographie de diamant en trois dimensions, capable de creer une carte d'un diamant dont la surface doit stre marquee suivant un motif predetermine, et de determiner une succession de points de marquage tepresentorn /edit motif, /adite fixation comprenant:

une source laser avec son optique de foca/isation assoclee, pour emettre un faisceau loser [ocailse sulvont un parcours optique; un systeme de definition des positions de morquage pour deptocer le parcours optique par rapport au diomant et pour oinsi Jes

amener taus deux dons une position de marquoge; et un moyen a ordinateur pour monipuler /edit svsteme de definition de la position de marquoge, pour amener le faisceau loser et le diomont dans /odite position successive de chacun desdits points de marquage."

6. Apparatus according to claim 5, wherein said beam orienting system includes a device for moving the laser for a computer-controlled linear displacement of said laser source with associated focalisation optics along a front portion of the optical track, so as to thus correct the length of the optical track.

7. Apparatus according to claim 6, wherein said pedestal has guides and the said device for moving the laser has the form of a cartouche which is capable of being moved along said guides and of moving the said laser with its focalisation optics."

Claims 11 to 15 read as follows:

11. Apparatus according to claim 1, wherein said computing means are capable of to create the appropriate position corrections each time the diamond surface to be marked is not in the predetermined position.

12. Apparatus according to claim 1 wherein said motif is a saw line, created by said mapping system.

13. Apparatus according to claim 1 wherein said motif is of a nature to be created in said mapping system by the said mapping system by a user.

14. Apparatus according to claim 13 wherein said motif is an identifier.

15. Device according to claim 13 wherein said motive is a random Inscription.

- Foreign proceedings

13. A patent was applied for and granted in the United States, under number US 6.552.300. This patent was not challenged.

In India, two patents were granted, a parent patent and a divisional patent, both of which were challenged in opposition proceedings. The validity of the Indian parent patent was confirmed in the opposition decision of 12 August 2014 in a proceedings between Sarine and the Indian company Lexus. The opposition regarding the subsidiary patent is still pending. This patent differs from the Belgian patent BE '912.

Claims 1 to 3 and 12 to 15 of the Israeli patent were rejected after opposition refused by decision of 20 November 2019, for lack of novelty, and this on ground of a public prior use of an anteriority known as 'SOLID'. Claims 4 to to 11 were accepted as patentable. Sarine filed amended patent claims to have the patent granted in amended form.

14. OGI filed a patent application in Israel entitled "Automatic marking of diamond belts using a laser" (Exhibit 1.15). By decision of 18 July 2007 Sarine's opposition to this patent application was upheld.

IV. ASSESSMENT

15. Sarine argues that OGI infringes in bad faith the independent claim 1 of its BE '912 patent, as well as dependent claims 2 to 7 and 11 to 15 of this patent.

By way of counterclaim, OGI challenges the validity of claims 1 to 15 of this patent. It also disputes that its devices would infringe the BE '912 patent.

The court should rule on the counterclaim for invalidity of the patent before ruling on the main claim for patent infringement.

A. Preliminary: the expert report.

16. The expert report should be excluded from the debate to the extent that it provides advice as to the merits of the parties' claim. The court cannot take into account the opinions in the expert report to the extent that the experts interpreted the patent, they assessed the probative value of evidence submitted by OGI , and to the extent that they ruled on OGI's raised nullity grounds of novelty and lack of inventive step.

However, this does not prevent the court from taking the findings and issued technical opinions as data and, where the evidence is admitted by presumptions, it may derive factual presumptions from them.

Under Article 962(1) of the Judicial Code, the court may, in order to resolve a dispute brought before it or in the event a dispute actually and imminently threatens to arise, order experts to make determinations or give technical advice.

The court may therefore take into account the factual determinations and purely technical opinions of the board of experts. The legal challenges between the parties should be assessed by the court taking into account the pleas and arguments, and the documents submitted by them in support of those pleas and arguments.

Sarine's allegation that, after the preliminary report, Mr Blondeel, a member of the college, would have been manipulated by the other experts to change his analysis from the preliminary report, and that the experts were biased, is not proved. To the extent that

Sarine refers to the opinion expressed by the experts in the preliminary report and the final report expressed opinion on the extent to which certain claims of the patent were or were not novel, or show inventive step, it is moreover the case that the court cannot and should take these opinions into account.

B. Counterclaim for partial invalidity of the BE '912 patent.

8.1. Conclusion 1

17. OGI decides the invalidity of independent claim 1 of BE '912 due to a lack of novelty (Article XI.57 § 1, 1 ° WER, in conjunction with Article XI.6 WER) vis-à-vis the pre-filing D1 {US 5,932,119, in the name of Lazare Kaplan & Sons, published on 3

August 1999, hereinafter also US '119 or the 'Kaplan' patent), D2 (US 4,392,476 or US '476 in the name of Lazare Kaplan & Sons, published on 12 July 1983, also called 'Gresser patent'),

the 'SOL/D' system of the Scientific and Technical Research Centre for the Diamond (hereinafter 'WTOCD') and the 'Sarine-ORZIV' system.

OGI also decides the invalidity of independent claim 1 of BE '912 due to lack of inventive step (Article XI.57 § 1, 1° WER in conjunction with XI. 7 WER) starting from the OGI 'Pen Marker', also known as the 'Rough Analyzer', hereinafter the 'OGI Pen Marker', or the 'SOLID' system, and successively starting from D1 (US '119), D2 (US '476), the 'Sarine-ORZIV' system, D4 ('Winston'), D5 ('Winston//'), the 'Merlin' system of COMDIAM, the 'Diamark' system of WTOCD, the 'ORZIV 2001' system, the 'Gorillatech' system, the 'PACOR' system and the Sivolvolenko article.

At the very least, it concludes the nullity of claim 1 of BE '912 for lack of a sufficiently clear and complete description of the invention so that a person skilled in the art could apply that invention could apply it (Article XI.57 § 1, 2° WER).

Sarine argues that claim 1 BE '912 is valid, and challenges the pleas of nullity raised by OGI.

18. BE '912 is a granted title, which is presumed to be valid. The mere fact that this Belgian patent was granted without preliminary examination does not affect this. However, this presumption of validity is rebuttable.

OGI, which argues that the BE '912 patent is invalid, bears the burden of proof of this.

B.1.1. Interpretation of claim 1 of the BE '912 patent

19. The parties disagree on the interpretation of claim 1 of the BE '912 patent. Sarine argues that OGI's invalidity argument is largely based on a misreading of the patent, so that prior to assessing the pleas of invalidity of OGI, it is necessary to proceed to an interpretation of the patent to the extent that that interpretation is the subject of dispute, and that dispute is relevant to the assessment of the validity of the patent.

A correct understanding of the patent is a necessary step that precedes the assessment of the validity of the patent, and the assessment of the infringement of the patent if the validity of the patent is decided.

The scope of protection of the patent is determined by the claims. Nevertheless, the description and drawings to explain the claims (Article XI.28 WER).

20. Claim 1 of the patent, in Sarine's own translation, concerns a "Diamond marking attachment for a device for three-dimensional mapping of diamonds, which device is capable of creating a map of a diamond whose the surface is to be marked according to a predetermined pattern, and capable of determining the sequence of marking points representing the said pattern represent".

A 'diamond marking attachment' (in the affidavit translation 'device for diamond marking', in the original French-language version: 'Fixation de marquage de diamant') claimed for a device for 3D cartography. Both parties prefer the translation 'diamond marking fixation'.

There is dispute between the parties on the interpretation of the term 'for'.

The description of the patent states that "One of the aspects of the present invention [discloses a device] dot be attached to a device for the mapping of diamonds, for the purpose of marking a diamond with a laser" (p. 1, lines 5-7 BE '912).

The court joins OGI where it argues that it is sufficient that the revealed diamond marking attachment is 'suitable for use warden' with a device for 3D cartography , and it is sufficient that the mount is capable of being used with a device for 3D cartography, capable of creating a map or three-dimensional model of the diamond, cooperate.

Sarine expressly acknowledges that at the priority date (8 September 2000) already included 3D cartography systems that allowed a full three-dimensional representation or virtual model of a given object in a computerised system. With regard to rough diamonds, the existing systems were able to calculate the optimal yield (i.e. the most valuable diamond(s) that could be obtained from the rough stone could be obtained), and to indicate where the rough stone needed to be cut to be sawn to obtain these finished diamonds (i.e. showing sawing surfaces on the three-dimensional virtual model (not on the stone)) (margin number 22 final substitute synthesis conclusion Sarine).

From the text of the conclusion, taking into account the description and the drawings, it can not be inferred that this attachment must be specifically shaped, designed and arranged for use with a 3D cartography device, whereby this attachment cannot function without the 3D cartography device, as Sarine suggests. The contrary cannot be inferred from the Directives of the European Patent Office (hereinafter: the Guidelines), which, moreover, the court faced with a dispute over the interpretation of a Belgian patent cannot bind the court. It follows from these Directives that the word 'for' in a claim formulated as a device 'for' performing a process, is to be understood as an apparatus or product 'suitable' for this purpose. The same applies to a conclusion formulated as a product 'for' a particular do I (Guidelines Part F, Chapter IV-16, no. 4.13). From the passage from the Guidelines cited by Sarine (Guidelines Part F, Chapter IV-16, no.4.14) does not follow that this interpretation does not apply when a conclusion in respect of a particular physical entity (product or apparatus) is formulated by reference to (use with) another entity. Since the first entity can often be produced and sold independently of the other (e.g. 'cylinder head for an engine'), the patent holder is entitled to independent protection of the first entity in itself. Consequently, argue the Guidelines, such a claim is in first instance is always interpreted to mean that this first entity does not contain the other entity or its characteristics: these limit the object of the claims only in the sense that the features of the first entity are suitable for being used with the features of the other entity (e.g. the cylinder head must be suitable to be mounted in an engine), but the characteristics of the engine do not in themselves limit the object of the conclusions not. Where an inference relates without any doubt to a combination of two separate entities, the conclusion should be rewritten (in this example: 'engine with cylinder head' or 'engine comprising a cylinder head') (Guidelines Part F, chapter IV-16, no.4.14). In the present case, Sarine, as patent owner, chose the wording 'Diamond marking attachment for a device for 3D cartography' (and not '3D cartography device with diamond marking attachment').

Nor does the interpretation defended by Sarine follow from the mere use of the word 'attachment', or the other features within claim 1. Indeed, the term 'attachment' does not exclude not precluding an independent component that can be attached or attachable to the device for 3D cartography, without inferring that this attachment cannot function without the 3D cartography device. It also follows from the last sentence of claim 1, it only follows that the claimed computing devices are 'suitable are' to work together with a device for 3D cartography of diamonds.

The claimed diamond marking fixture does not perform 3D cartography itself, but can be used in conjunction with a device for 3D cartography, and is suitable to cooperate with the 3D cartography device.

The diamond marking attachment functions as a standalone unit, without this attachment causing a change in the hardware and functionality of the 3D cartography device.

21. The term "marking" is not defined or limited: it should therefore be broadly interpreted broadly, and includes both the application of saw lines, the application of marking, and this on any diamond. In conclusion 1 no distinction is made between the nature of the diamonds, rough or polished. In the absence of any such distinction, it must be assumed that claim 1 of the patent covers both rough relates to rough diamonds as well as to polished diamonds. This is also evident from the dependent claims 13 and 15, in which, inter alia, the marking of an identification code or an inscription is claimed, which is done only on polished diamonds.

22. The said device "comprises a laser source with associated focalisation optics, to emit a concentrated laser beam according to an optical path" (affidavit translation/translation OGI) or "according to an optical path" (own translation Sarine) (original text: "une source laser avec son optique de focalisation associee, pour emettre un faisceau laser focalise suivant un parcours optique").

The 'laser source' may be any laser suitable for permanent marking in each of the marking points. Claims 1 to 15, which are at issue in the present dispute, do not distinguish between particular types of lasers and no particular power or intensity is claimed. This is evident from the description:

"As a laser source, any laser may be used whose power is sufficient to make permanent marks at each of the marking points." (p. 5, lines 29-30 BE '912).

Conclusion 1 claims a laser source with 'associated focalisation optics'. 'Associated focalisation optics' are means that allow the laser beam of the laser source to be focused at a well-defined point. Focalisation optics normally include one or more lenses (p. 15 and p. 99 College of Experts report). Sarine's contention that from the use of the word 'associated' additionally follows that the focalisation optics are specifically assigned to the laser source and they cannot simultaneously serve any other purpose, cannot be joined, and adds a condition to this conclusion that is not expressed herein.

An 'optical course' or 'optical path', by definition, is a path travelled by a beam of light traveled. This is evident from, among other things, a quotation from the technical dictionary cited by Sarine (Merriam-Webster's Medical Dictionary, 2002, freely translated: 'optical path: the path dot followed by a light beam through an optical system'), and is confirmed by the College of Experts (p. 15 and 100 College of Experts report). Such a path may be rectilinear (linear), or complex (where the path consists of several parts located in different planes). There is no reason to believe that in interpreting the claims of the patent should deviate from the usual meaning of these words as known to those skilled in the art: OGI does not show that a particular meaning is given to the term 'optical course' or 'optical path' that differs from what should be commonly understood by this term. OGI wrongly limits this optical path to the complex optical path that uses mirrors (deviation optics), shown in Figure 3 of the patent. From the brief description of the drawings, it follows that Figure 1 describes a method for realising the invention "by way of example, without being exhaustive", It concerns a particular form of realisation of the invention, described in derivative claims 9 and 10 of the patent, which are not relied upon by Sarine are not relied upon in support of its main claim for patent infringement against OGI.

23. The said 'attachment' includes "a system for determining marker positions for moving the optical track relative to the diamond and thus placing both in a marker position."

The attachment shall thus include displacement means, which allow the optical course to be moved relative to the diamond: In the description of the patent, this is this is described as "a beam orienting system for moving said course relative to the diamond" (p. 2, lines 13-14, BE '912).

In the detailed description of the methods of realisation, the function of the beam orienting system is explained as follows: "The beam orienting system is designed to guarantee that the beam remains concentrated on a p/ek at a/position D of the central x-os and a distance H from the upper surface (6) of the turntable (BJ, where the dot Pin is brought to its marking position by the rotation of the rotary table" (p. 4, lines 1-5 BE '912).

Figure 2 illustrates a possible implementation of such a system, in which this implementation is expressly designated as non-limitative ("a method by way of example, without being limitative", p. 2 line 32 BE '912). In the description it is emphasized that it is apparent to one skilled in the art that many modifications and variants of this invention possible, in terms of

design of the device for marking diamonds (..) within its scope of its description in the claims" (p. 7, lines 5-10 BE '912).

The panel of experts points to the existence of other possible variants that may affect the those of ordinary skill in the art will understand, such as motors for moving an optical fiber, motors for moving mirrors or motors for moving the diamond (p. 15, 16 and 17 report panel of experts).

24. The "confirmation" referred to includes "computer resources for the said system handle the determination of the marking positions, including the laser beam and the diamond sequentially in said positions for each of said ones penalty points."

These computer resources allow the laser beam and the diamond to be positioned in the marking positions on the basis of the mentioned markers, in particular those determined by the device for 3D cartography.

Thus, the computer resources of the diamond marking confirmation must be capable of to be used and to cooperate with the 3D diamond cartography device.

Sarine contradicts this interpretation. She refers at this point to the interpretation of its first characteristic, and in particular her interpretation of the characteristic "Diamond marker attachment for a three-dimensional cartography device of diamonds". On this point, it suffices to refer to what has already been said considered. Also the concrete passage quoted by Sarine from article 4.14.2 of this EPO guidelines do not contradict this interpretation. In Article 4.14 of the Guidelines attention is drawn to the requirement of clarity of the conclusion. From the quoted passage it follows only that it does not conflict with Article 84 of the European Patent Convention, which requires it that the claims are clear, concise and based on the description, including dimensions or shape of a first entity by reference to its dimensions and/or corresponding form of a second entity that is not part of the first, but linked by use, especially when these dimensions are standardized, or when one skilled in the art has little difficulty understanding the resulting limitation of the scope of protection for the first entity.

The marking position determination system is not manually controlled, but by computer means. These provide control of the system, point by point , from one marker position to

another. This is confirmed by the wording of the description, which states that "The device for three-dimensional cartography allows the diamond, on the surface of which is a mark must be made, map and record a sequence of points that form this motif." (...) "where the coordinates of each point of the mark with the calculated on a computer and in which the spreading orientation system is manipulated to send the beam to the different points sequentially." (p. 2, lines 7-9 and 17-19, BE '912).

B.1.2. Inventive step

B.1.2.1. General

25. There is an inventive step if the invention is not for a person skilled in the art arises in an obvious way from the state of the art (article XI.7 WER).

The 'expert' of Article XI.7 WER, or the 'craftsman', is a fictitious person, or a team of fictitious persons, each with their own expertise. The craftsman can be described as an experienced practitioner of the trade, who has average knowledge and skills, and is aware of the general technical knowledge of the sector concerned. He is an expert in a particular technical domain. He's supposed to have access to everything that belongs to the state of the art, and about the normal means and skills for routine work and experimentation.

The craftsman has sufficient intelligence to cope with normal problems, even if they cannot be solved by a simple mechanical and stereotyped application of the usual techniques.

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owever, he is not creative and does not have any inventive ability. This distinguishes the inventor of the craftsman.

B.1.2.2. Means Sarine: Overcoming Technical Prejudice - Prior Art Leads away of the invention - commercial success

26. Sarine argues that BE '912 is inventive because it has a technical bias overcomes and led the prior art away from the invention. She also argues that the inventive step is confirmed by its considerable and rapid commercial success of its laser marking devices, the simultaneous disappearance of existing pen markers of the market such as the 'Merlin' and 'Diamark' systems of the WTOCD and the OGI Pen Marker (the existence and characteristics of which are, however, disputed), and OGI's infringement of the patent. She argues that the above analysis in itself is sufficient for the court to be able to conclude that BE '912 shows inventive activity.

OGI disputes the existence of a technical bias and denies that the state of the technology led away from invention. She disputes the alleged considerable and rapid commercial success of Sarine's laser marking device, and disputes that they themselves have any infringed the BE '912 patent.

27. There is no dispute between the parties that the use of 3D cartography devices has been known in the diamond industry since at least the 1980s. In In this period, systems were already known that used 3D cartography of raw diamonds. For example, machines were developed that can make 3D models of a diamond, and software was developed to assist a planner, which is going on of such a 3D model decides how to cut the diamond, as well measuring systems for three-dimensional measurement of finished/polished stones, mainly for quality assessment. The effective placement of the markings on the stone was then done with a pen. There is also no dispute that the first lasers were already used in the 1980s indicia to engrave on the girdle of cut diamonds appeared.

Sarine argues that for 20 years, up to the priority date of her patent, no one came up with the idea that the use of a 3D cartography device could be beneficial for the laser marking of diamonds, let alone that it would make it possible to cut saw lines marking with a laser on the surface of rough diamonds. She argues that this change went against all traditions, and against the deep-rooted conviction in the sector of diamond production that laser techniques could only be used for it laser cutting of rough diamonds, considering the risk of damage to the rough stone.

Sarine states that, against all traditions within the conservative diamond manufacturing industry, she realized that the risk of damaging a rough stone in laser marking could be eliminated by using 3D cartography to determine the exact 3D coordinates of points on the

surface that represent cutting lines, and monitor the operation of the system to deliver a focused laser beam sequentially at each of those points to bring. Sarine then claims to have discovered the benefits of using the same concepts in the field of laser inscription of indicia on cut diamonds.

OGI argues that the existence of a technical bias is not demonstrated. She argues that there was only non-technical prejudice on the part of the clientele, that is linked to stick to the traditional ways of marking, and economic and commercial considerations on the part of manufacturers of machines for use in the diamond sector.

28. The burden of proof for the lack of inventive step of claim 1 of BE '912 rests on OGI, which claims the invalidity of claim 1 of the BE '912 patent.

However, in the context of its defense against this claim for invalidity, the patent holder can rely on the existence of a widespread technical prejudice associated with the invention is overcome. For example, the Research Guidelines of the European Patent Office state as a general rule that there is inventive activity when the state of the art leads the expert in the field away from the invention (Part G, Chapter VII, Annex.4). Inventive step can sometimes be demonstrated by the patentee by proving that a known bias, i.e. a widely held but incorrect view of a technical fact must be overcome. It must concern a technical prejudice, in particular a technical objection to the technical solution offered by the patent. The burden of proof for the existence of such a technical prejudice rests on the party invoking such prejudice. Sarine must demonstrate that the invention would not be practical or workable according to the opinion prevailing in the art on the priority date, and that the invention overcomes these were overcome.

29. First of all, it must be determined who the professional is. According to Sarine, the craftsman refers to "the manufacturer of diamond planning aid tools, i.e. tools who assist the "planner" in his decision process on how to cut or otherwise process the rough diamond in order to obtain the highest yield" (conclusions Sarine, margin number 99).

OGI states that the craftsman is an expert, or a team of experts, who, among other things is familiar with the techniques of cutting and polishing rough diamonds, who is up to date

of the way a three-dimensional cartography device works, of the fact that it is possible to mark or cut a diamond by means of a laser, and that precisely know how such machines function. She describes the professional as, among other things 'machine manufacturer' in the diamond sector. The clientele of this machine manufacturer can according to OGI, are not regarded as a specialist in the patent law sense, inter alia since this clientele is not familiar with the (laser) technology behind the equipment that available on the market.

The definition of the skilled person as formulated by Sarine is too limited: the invention of Sarine concerns the field of laser marking of diamonds in general, and not just marking cutting lines on rough diamonds.

The craftsman can be described as a producer or manufacturer of machines/tools for marking diamonds, including planning aid tools.

30. Sarine argues that in a letter to the experts (document 1.36 by Sarine) OGI has acknowledged that there was a general prejudice against the use of lasers for diamond mark, and this letter should be considered an explicit admission.

OGI, however, rightly argues that the quoted passage from the letter of the counsel of OGI to the Experts neither implicitly nor explicitly, as an express admission of a technical prejudice on the part of the skilled person can be read, but only as acknowledgment of the existence of a prejudice on the part of the clientele of this professional.

In the current proceedings, OGI argues that machine manufacturers in the diamond sector are stepping up had not considered the priority date opportune for economic reasons to invest on a commercial scale in laser-enabled diamond marking equipment combination with 3D cartography, as lasers were expensive at the time and the market was not there yet ready for laundry. OGI confirms that cutting line markings on diamonds have traditionally been done with a pen was affixed and indicates that the clientele of machines used for marking of diamonds preferred to stick to this traditional way of marking. The prejudice was according to OGI, not technical in nature, in the sense that the bias invoked is a technical objected to the technical solution offered by the invention, but purely economic and commercial, because machine manufacturers did not want to invest money in expensive lasers and the clientele liked to stick to the traditional way of marking.

This point of view was already defended by OGI during the expert investigation, including in marginal numbers 28 and 29 of the letter from OGI's counsel cited by Sarine to the panel of experts. When asked why OGI chose to develop its marking device with a pen, and not a laser, OGI replied: "Suitable lasers were available, but at the time, the industry did not want them because of an (probably unjustified) prejudice. Of course, OGI developed a device that was likely to interest consumers. It just adapted its offers to the market's expectations at that time. There were no technical barriers to develop it in another way (with laser), only economical barriers (. . .) It is not the first time in history that a new technology needs time in order to be accepted by the consumers but this has nothing to do with patent law." to the expectations of the market that time. There were no technical barriers to develop it in a different way (with laser), only economic barriers. (. . .) It is not the first time in history that it takes time for a new technology to be accepted by the lumps, but this has nothing to do with patent law. '

Sarine also confirms that the diamond industry was very conservative at the time of the invention, and that this sector did not easily adapt to changes that could affect the value of a diamond (Conclusions Sarine, margin number 11).

However, the potential resistance of the diamond marking machine/tool manufacturers to the use of lasers for marking cutting lines on rough diamonds by the customers is not a technical bias. The existence of a prejudice against the use of a particular technology by customers who do not have the knowledge of those skilled in the art of the invention does not prove that a such prejudice is shared by those skilled in the art, a fortiori it does not follow that such prejudice is widespread in the field of the invention.

Sarine does not prove that there was a widespread prejudice on the part of those skilled in the art against the use of lasers for marking diamonds in the field of the invention. Nor does it provide any handbook or standard work from which such a prejudice appears.

31. Sarine now refers to the WTOCD's 'Merlin' system, developed in 1998-1999, and the WTOCD's 'Diamark' system, developed in the 1990s, and the OGI PenMarker (which she

claims to have existed on the priority date at least with the features cited by OGI further disputed), all of which used a pen to mark cut lines, in conjunction with a 30 device used to analyze the rough diamond. She argues that these systems expressly diverted from the invention of Sarine, because they launched a pen marker instead of switching to a laser.

However, OGI argues that economic and commercial considerations, not technical considerations, explain why these producers continued to use a pen to mark rough diamonds.

Sarine recognizes that production costs are an important aspect in the diamond industry: a diamond producer may also consider the cost of production. It also acknowledges that there was a long tradition in the industry of using simple, low-cost tools, such as an ink pen, for diamond planning and diamond marking (Conclusions Sarine, no. 11). She confirms that both the WTOCD and OGI were well acquainted with these traditions and the needs of the rough diamond market (Conclusions Sarine, no. 79).

The invoices submitted by OGI (its exhibits 4.4 through 4.7) show that the OGI Pen Marker was sold on the Priority Date for a price of approximately USD 10,000 (less than EUR 9,000), including computer. The simple ink pen used in this cost a few euros at most. OGI points to the high cost of lasers on the priority date. It also appears from the invoices submitted by Sarine that the cost price of the lasers it purchased with the accompanying power supply in the period 1999-2002 varied from 4,000 to 5,190 euros each (piece 1.34 sarine). The incorporation of lasers into the machines concerned would lead to a serious increase in the production price of the machines in question and, consequently, in the sales price.

Economic considerations have no place within the framework of the technical analysis of the state of the art (see also in this sense K. NEEFS, "Paper Tigers in Patent Law", TBH, 2011, p. 477 and the cited case law of the Technical room of Appeal from the European Patent Office (TKB EPO 31 January 2007, T-852/04, Procter & Gamble/SCA & Kimberly-Clark, www.epo.org/law-practice/case-law-appeals, 4.9.1.)).

Sarine does not prove that the anteriors cited by her indicate any technical drawback that would have a dissuasive effect on those skilled in the art, nor does she demonstrate that these specific anteriorities led the skilled artisan away from the invention.

32. Moreover, the existence of a universal or widespread technical prejudice on the part of the artisan against the use of lasers for marking diamonds is contradicted by the numerous prior art documents and devices that reveal diamond marking by means of a laser.

Also Sarine's claim that specific anteriorities such as Kaplan (D1 and D2), D6 and the 'SOLID' system of the WTOCD led away from the invention is not proven (see below under marginal numbers 54, 56 and 57).

33. There is insufficient evidence that the invention met a long-standing need or solved a problem that has long been sought to be solved. On the contrary, both parties indicate that the diamond sector was attached to the traditional methods used by her.

Sarine also provides no evidence of the considerable and rapid commercial success of its laser marking devices in accordance with the invention as it claims. This commercial success is disputed by OGI. In support of her assertion, Sarine refers to her document 1.26, a simple table of figures, from which it cannot be deduced who drew it up, stating the number of appliances sold and the turnover achieved per product in the period from 1999 to 2006. These figures, those by OGI disputed are not supported by any accounting or other record. Moreover, commercial success alone is not an indication of inventive activity. Only when commercial success is linked to a long-standing need can this be an indication of inventive activity if it is shown that this success results from the technical characteristics of the invention and not from other influences, such as, for example, sales techniques or advertising (see also EPO Guidelines, Chapter C-IV, 9.10.4). No such proof is provided.

B.1.2.3. The OGI PenMarker

34. OGI argues that it itself realized the technique of automatically marking a rough diamond in a similar device in its 'OGI penmarker' or 'OGIPenMarker', also known as 'Rough Analyzer + Marker', and this for the priority date of BE '912.

According to OGI, this system made it possible to measure a rough diamond and generate a three-dimensional map or image of it. The software then calculated exactly how the rough diamond should be cut for optimum yield, including with as little loss of the diamond stone as possible. The system then allowed cutting lines to be applied directly to the diamond using a marking pen, as suggested by the software. The only relevant difference between this system and the system patented by Sarine, according to OGI, lies in the use of a marking pen, instead of a laser. According to OGI, the replacement of the marking pen in the existing system by a laser was not an inventive step, given that the possibilities of using lasers for marking diamonds have been known in the diamond industry for several years.

35. Sarine first argues that OGI fails to demonstrate any public prior use of the OGI pen marker. In a secondary order, Sarine contends that even if the court were to accept that the OGI pen-marker was part of the prior art, OGI fails to prove a lack of inventive step in light of the OGI pen-marker.

- Public pre-use

36. There is only an inventive step if the invention for which patent protection is claimed does not follow in an obvious way from the state of the art for a person skilled in the art. In accordance with article XI.6 § 2 WER, the state of the art is formed by everything that has been made publicly available before the date of filing of the patent application by written or oral description, by application or in any other way.

There is no hierarchy between these forms of disclosure, which are all equivalent.

The party claiming public prior use must demonstrate when this use took place, what was made accessible to the public through this use, and what the circumstances are of this use.

In this case, OGI must prove that the OGI pen marker was effectively publicly disclosed on the priority date and that the OGI pen marker displayed the relevant characteristics in the context of the invalidity argument developed by OGI.

The question of whether something was publicly available before the priority date is a matter of fact, which can be proven by any means of evidence. It is by no means required that scientific publications are submitted showing this public prior use.

37. Sarine argues that the case law of the European Patent Office ('fOB') should be applied with regard to the applicable standard of proof. Whereas the EPO usually weighs probabilities in opposition proceedings, for elements within a party's own power and knowledge, a stricter criterion should be applied, requiring proof beyond reasonable doubt.

However, this case law does not apply here, in the context of a dispute relating to an alleged infringement in Belgium of a Belgian patent. Under Belgian law, the standard of proof laid down in Section 5 of Book 8 of the Civil Code applies.

In accordance with Article 8.5 of the Civil Code, except in cases where the law provides otherwise, evidence must be provided with a reasonable degree of certainty.

There is no such deviating statutory provision, so that the general standard of proof applies.

38. OGI relies on evidence of public pre-use of the OGI pen marker on invoices from customers who allegedly purchased an OGI pen marker prior to the Priority Date, supplemented by those customers' written and oral testimonials, technical drawings of the mechanical parts of the OGI pen marker, supplemented with the statement of the third-party technical engineer who created these drawings and the statement of the third-party manufacturer of these mechanical parts, an undated user's manual, the source code of the software, and statements and papers related to a seminar where the OGI pen marker would have been presented to the public.

Sarine disputes the probative value of these statements and documents, and more specifically argues that the technical characteristics of the OGI pen marker as they allegedly existed on the priority date are not proven by these documents and statements. She refers to the proceedings conducted in Israel with regard to the Israeli patent, in which it was held that evidence of a public prior use of the OGI pen marker was not provided.

39. The determination of the Israeli Registrar of Patents, Designs and Trademarks, based on the evidence admissibly presented in those proceedings, as to whether public prior use of the OGI pen marker in these Israeli proceedings has been proven, is binding court not. This is especially true as it is not shown that all the evidence presented in the current proceeding was also presented in the Israeli proceeding. For example, the submitted decision does not mention the manufacturing drawings, source code, statements from Indian customers, statements from persons present at the lecture of October 25, 1999.

The court must review the evidence as presented in the current proceedings and then determine whether OGI provides evidence of public pre-use with a reasonable degree of certainty.

40. OGI submits detailed technical drawings of the mechanical elements of the OGI pen marker as provided to the third party manufacturer of these parts (manufacturing drawings), with an explicit date, with dates ranging from January 1999 to June 1999 (documents 4.1 b and next OGI). These drawings do not contain further details about the optical, electronic or electromechanical components. OGI also submits various general overview drawings (Documents 4.1 a, 4.1. ouch, 4.1. av OGI) which, according to the designer of the system, would date from January 1999, prior to the preparation of the detailed drawings for manufacturing (document 4.17 OGI), but which are not dated.

Sarine argues that there are contradictions between these drawings, without however specifying these alleged contradictions. The Board of Experts determined that several separate parts can be recognized in the overview drawings, and the mechanical components as shown in the film made by OGI of the OGI pen marking system in operation are analogous to those shown in the drawings (p. 53 Board report of expert). Evidence of contradictions between the drawings is not provided.

Both the author of these drawings, Mr. Bar-Am, and Mr. Bechar, Chairman of A. Bachar Engraving & Milling Ltd, the third party manufacturer of the parts, confirmed in signed written statements to the Belgian Courts that the mechanical parts of the automatic pen-marker were manufactured in the year 1999 on the basis of these drawings submitted as an appendix to their statements (documents 4.17 and 4.18 OGI). On June 29, 1999, A. Bachar Engraving & Milling Ltd issued an invoice to OGI for the production of parts. This invoice was paid by check dated August 31, 1999 (see invoice and check appended to Statement 4.18 of OGI).

These manufacturing drawings refer only to the mechanical elements as they were to be manufactured by OGI's third party supplier. OGI declares that the optical components, camera and motor drivers were previously known to it. Mr. Bar-Am confirms that he received the pre-existing components to be integrated into the system from OGI. Appendices D1 to D4 to Mr Bar-Am's statement show how the whole had to be assembled, and they also allow to identify mechanical elements other than the non-movable ones (such as stepper motors, the 3D cartography system with turntable , a device to move the pen, ... (section 4.17 OGI with appendices)).

OGI also deposits the source code of the OGI pen-marker software, in two files called 'MarkSetup.cpp' and 'Pen-Marker source code'. According to the 'properties' of these computer files, they were last modified on June 23, 1999 and July 13, 1999 (document 4.34. OGI).

The Court deems it proven that these drawings and source code were created between January and July 1999, as OGI contends, in view of the date stamps on these drawings and source code, the supporting statements that are credible, the invoice and payment receipts submitted, and customer statements of OGI who stated that they had purchased the OGI pen marker at the end of 1999 (see marginal 42 below, with regard to the probative value of these statements).

Sarine refers to a statement by Mr. Benzano, CEO of OGI, who allegedly stated in the proceedings in Israel that this device was developed in 1998. However, the extract from Mr. Benzano's testimony submitted by Sarine does not contain any statement to this effect. Even if Mr. Benzano would have stated that this machine was developed in 1998, this does not contradict the fact that this development was completed in the year 1999, with the preparation of final manufacturing drawings and the final delivery of the source code.

The court cannot take into account the opinion of the panel of experts with regard to the probative value of the documents submitted by OGI with regard to the public prior use of the OGI pen marker. However, the court can take into account the factual findings of the panel of experts with regard to what can be deduced in the technical field from the documents submitted by OGI to the panel of experts, and now to the court.

The panel of experts concluded that these documents show that a system was developed with at least the following characteristics:

- a 3D cartography system with a turntable rotatable by a motor C;
- a device in which a pen can be accommodated, the pen being mounted in such a way that it is movable in an X direction (longitudinal direction of the pen) by a motor Bx, and a Y direction perpendicular to the surface of the turntable by a motor By;
- the motors C, Bx and By are controlled by software and hardware. (p. 59 report panel of experts).

However, it cannot be deduced from these documents in themselves that the pen marker as developed was also publicly available on the priority date.

41. It appears from OGI's documents 4.13 and 4.26 that the Professional Training Committee of the Israel Diamond Institute invited manufacturers and sellers to a study day which took place on October 25, 1999, on the subject of 'OGI Systems Ltd.'. Announce a New

Product-Marking System' (Freely translated: 'OGI Systems Ltd. announces a new Product Marking System'), stating that this system could be tested by the participants. The announced lecture of Mr. Benzano, CEO of OGI, on this

The study day was entitled 'Announcing the rough marking system as part of decision making'. Issue 160 of the magazine of the Israeli Diamond Institute, issued in January 2000, mentions that OGI introduced a 'Marking System' on October 25, as part of its 'Analyze System'.

Mr. Amidor Gabay, Director of Treasure Diamonds Pty Ltd, stated in a written statement signed by him that he had attended this lecture. He stated that Mr. Benzano proposed the 'OGIMARKER' system, which included a device for marking diamonds with a pen, for cutting and polishing, which is activated by a computer program. He then declares that he has ordered this system (document 4.14 OGI). Also Mr. Shimon Freud, a diamond producer who declares to be a customer (has been) from both OGI and Sarine, confirmed in a written statement signed by him that the new product presented at this lecture was "an automatic pen marking system for rough diamonds", which was demonstrated at this lecture by Mr. Benzano and Mr. Kapon, employee of OGI (document 4.28 OGI).

There is no reason to doubt the veracity of these statements. Sarine does not prove that these persons have a personal interest in the statements made by them.

These statements, read in conjunction with OGI exhibits 4.13 and 4.26, show that as early as October 25, 1999, OGI provided a demonstration to diamond industry professionals of the operation of an automatic pen marking system for marking rough diamonds prior to cutting and polishing, where the pen was activated by a computer program.

Mr. Kapon, an OGI employee, confirmed in an affidavit that he demonstrated the operation of the OGI Pen Marking System at this seminar, as recommended by the Mr. Freud was declared (Exhibit 4.27 OGI). He then describes in detail the operation of the OGI pen marker and its essential technical features. Since Mr. Kapon is an employee of OGI, the probative value of this statement in itself is limited. However, this statement is confirmed by Mr. Freud's statement.

42. Both Mr. Bhavin Kamdar of Fourcee Equipments & Services P.L. (document 4.20 OGI), Mr. Shah of M/S Twinkle Diamonds (document 4.21 OGI), Mr. Mehta of H. Dipak & Company (document 4.22 OGI) as Mr. Blom of Ernest Blom Diamand Cutting Works CC (document 4.16 OGI) stated in written statements signed by them that they purchased OGI's pen marking system in 1999. These statements are supported by invoices showing the purchase of a marking system or marking module (called "Rough Marking Module", "OGI Rough planner with marking module" or 'Megarough planner with marking module' (sections 4.4, 4.5, 4.6 and 4.7 OGI)). The authenticity of these invoices and their date is not disputed. The name used for this system for billing is not in itself determinative: the court must verify whether an OGI pen marking system was publicly used before the priority date, and what the characteristics of this system were, regardless of the name used for it.

Mr. Pratish Mehta of Diacentre, India (Document 4.23 OGI) and Mr. Miten Doshi of Akarsh Exports, India (Document 4.24 OGI) also declare to have purchased a pen marking machine from OGI prior to September 2000, albeit without an invoice confirming this purchase. confirms to add to their statement.

After the dispute arose, OGI made a film in which the composition and operation of its OGI pen marking system are extensively demonstrated. The aforementioned OGI customers, who stated that they purchased OGI's pen marking system in 1999, all expressly stated that the pen marking system they purchased was identical, both in composition and operation, to the pen marking system as demonstrated in the film made by OGI.

They confirmed, among other things, that the marking points, shown as a yellow line on the computer screen, are determined by the machine based on a 3D analysis of the stone, the marking of the rough diamond is done automatically without any manual intervention, the diamond rotates as the software commands scanning or marking, and the pen (which can be any pen, and must be replaced very often) is mounted on an X/Y axis, with motors controlled by the computer system. They also confirm the positioning of, among other things, the camera, light, motors and the pen (see also documents 4.20, 4.21, 4.22, 4.23 and 4.25 OGI).

These written and signed statements from OGI customers are credible.

The mere fact that these customers stated at a later date that they had also purchased the OGI laser marking system, which Sarine considers infringing, does not detract from this. There is no indication of any infringement proceedings by Sarine against any of OGI's clients. Sarine does not prove that OGI's Indian clients have a personal interest in having Sarine's Belgian patent invalidated. It appears from the documents submitted by Sarine that the OGI pen marker was not invoked in the Indian opposition proceedings, initiated by a third party, against the Indian (mother) patent, in which the validity of the patent was decided. Mr. Kharndar (document 4.20 OGI) also stated that he was no longer active within Fourcee Equipments & Services at the time of his statement, so that a fortiori he has no interest whatsoever in making a statement in favor of OGI.

Nor is the fact that OGI's customers also use the name 'OGI-Marker' in their statements, rather than 'Rough Analyzer' or 'OGI Pen Marker', to question the credibility of these witnesses. It is a generic name of the described system. OGI indicates that its pen marker had only its brand name 'OGI' affixed to it, which helps explain why this system is often referred to by customers as the 'OGI marker'.

Mr. Blom states that he is acting for Ernest Blom Diamond Cutting Works CC, based in South Africa, where Sarine states that he has only sought patent protection in Belgium, India, the United States and Israel. Sarine does not show that Mr. Blom has any personal interest in the invalidation of the Belgian or Israeli patent, in which the OGI pen marker was discussed, or the Indian patent. Mr. Blom is (or at least was) chairman of the World Federation of Diamond Bourses (loosely translated: World Federation of Diamond Bourses). There is no reason to question his independence and impartiality. He made a written statement under oath (Exhibit 4.16 OGI) in which he stated that he was aware that he was exposing himself to punishment by false statement, and later confirmed his statement in extensive cross-examination during the Israeli procedure (document 4.19 OGI). These statements by Mr Blom are credible.

In his witness statement, Mr. Blom gave a clear and detailed description of the pen marking system and its features. Sarine's claim that Mr Blom is in his testimony in the Israeli proceedings (her piece 1.18) would have described a manual system cannot be accepted, on the contrary. For example, Mr Blom states in this excerpt: "I only know that the machine would show the diamond on the screen, then you can put the pen in the machine and the pen will make a drawing" (exhibition 1.18 Sarine). From the more extensive excerpt from Mr Blom's testimony submitted by OGI it is clear that Mr Blom describes an automated pen marking system (see document 4.19 OGI, pp. 22-24). This description is consistent with the statements of other OGI customers and the factual findings of the panel of experts when demonstrating the penmarker at the installation meeting and viewing the video made by OGI of the penmarker in action. The mere fact that Mr. Blom could not answer all the technical questions asked by Sarine's counsel does not detract from the value of his testimony, especially since Mr. Blom, as a director of a diamond processing company and a customer of OGI, is not considered a 'skilled worker' within the meaning of the current patent procedure.

Sarine tries to sow doubt about the date on which this device was purchased by Mr Blom and the nature of the device purchased. For example, Mr Blom's request for delivery of a prototype, dated July 21, 1999, also contains an automatic fax entry with a different, earlier date (document 4.9 OGI), and this letter also refers to a 'laser machine'. However, in his written statement with an appendix (to which this fax date is not mentioned), Mr Blom explicitly confirmed that this order was dated 21 July 1999 and that it concerned a pen marking machine (Document 4.16 OGI). The invoice was sent by OGI on October 7, 1999 (document 4.7 OGI).

Mr. Blom confirmed that he had received a manual from OGI. However, there is no evidence that the undated manuals submitted by OGI in the current proceeding match the copy provided to Mr. Blom. Moreover, nothing can be derived from these manuals about the operation of the system, as these mainly describe the actions that the user still has to perform manually.

Sarine's contention that the pen marker shown in the film made by OGI and submitted by OGI to its clients, the panel of experts and the court was specifically constructed for the purposes of the present dispute is contradicted by Sarine's contention that these unambiguous testimonials. The alleged inconsistencies referred to by Sarine are not such as to affect the credibility of these testimonies. The use of a pen named 'OGIWRITER' in the demonstration in this movie, where the OGIWRITER was only developed after the priority date, can only be inferred that the movie was made after the priority date, as expressly acknowledged by OGI at all times. The pen is a replaceable part of the pen marker, which according to the OGI customers who have stated that they have purchased this pen marker, must be replaced every few days: the demonstration in the film was merely to demonstrate that any ink pen could be used in the machine. Nor can anything be inferred from the fact that the name 'Rough Analyser' is not visible on the pen marking machine in the film. The purpose of the film is to show how the machine works, so that it becomes working shown with the lid open so that mainly the inside of the device is visible. OGI also states that this pen marking machine did not list a type designation.

However, the Court disregards Mr. Ulchek's written statements (4.12 and 4.25 OGI), which are unclear, unsubstantiated by any record and lack credibility. The document 4.12 is only an unsigned translation, without the original document being submitted. Moreover, in his testimony in the Israeli proceedings, Mr. Ulchek did not state his statement (which it is not clear which statement it refers to). to have written it himself, but only to have "passed over" it, and to have "more or less" understood what it contained. He also indicated that he was not sure of the date of 'March 1999' mentioned in this statement and that he had no documents to verify, among other things, the date of his purchase or order (document 16 Sarine).

43. The court considers it proven that the OGI pen marker with the characteristics and operation as demonstrated in the film made by OGI was publicly available before the priority date.

The Board of Experts determined that the demonstration of OGI's automatic pen-marking system at the installation meeting was consistent with the demonstration in the film made by OGI, which OGI's customers confirmed to be consistent with the operation of the device they purchased from 1999 onwards (p.59 panel of experts report).

The panel of experts determined that this film shows that:

- the cutting line is determined by 3D cartography software, using the 3D coordinates of the stone;
- the movement in X and Y direction and the rotational movement are controlled on the basis of cutting line coordinates determined by the 3D cartography software (p. 59 report of the panel of experts).

The court may take these findings by the panel of experts into account as a factual presumption.

These findings of the experts are confirmed by the content of the film provided by OGI as a piece (piece 4.15 OGI).

Information is available to the public if only a single member of the public is in a position to access and understand it, and there is no obligation of confidentiality. A single sale may suffice to make the product publicly accessible (see also Article 7.2.1 EPO Guidelines). Sarine does not argue, and does not prove that one or more of the aforementioned purchasers would be bound by any confidentiality obligation with regard to the OGI pen marker. The information is publicly available, even if the sale was made to a person other than a professional (see also to that effect T 953/90 and T 969/90, Boards of Appeal of the EPO, www.epo.org/law-practice/case-law-appeals/recent/t900953fu_1.html and [www.epo.org/lawpractice/case-law-appeals/recent/t900953f u 1.html](http://www.epo.org/lawpractice/case-law-appeals/recent/t900953f_u_1.html)).

It was possible for the skilled person on the priority date to identify the technical features and functions of this OGI pen marker, and reproduce them without undue effort.

The court considers it proven that the OGI pen marker, with the above-mentioned features and operation, was state of the art on the priority date.

Troubleshooting method

44. To assess the inventive step is usually used

the problem-solution approach as also applied by the EPO. This consists of several steps, including:

- determining the closest state of the art,
- determining the objective technical problem to be solved based on the differences between the closest prior art and the invention,
- determining the professional,
- the investigation of whether or not the claimed invention, taking into account the closest state of the art and the objective technical problem, was obvious to the skilled person.

Closest state of the art

45. OGI supports its plea of nullity for lack of inventive step, initially on the OGI pen marker.

The court considers the OGI pen marker for rough diamonds to be the closest state of the art.

This OGI pen marker has the same purpose as the invention, in particular the automatic marking of, among other things, cutting lines on rough diamonds, has most of the relevant features in common with the invention, and forms the most promising starting point.

- objective technical problem

46. The objective technical problem to be solved is determined by the differences between the closest prior art and the invention.

The objective technical problem is the one that was actually solved, taking into account the closest prior art, which may differ from the prior art available to the inventor (see also T 576/95 EPO, par. 3.2, <https://www.epo.org/law-practice/case-law-appeals/recent/t950576eu.1.htm/>).

The objective technical problem must be determined according to objective criteria, which can be specifically defined by evaluating technical progress against the closest prior art. It is irrelevant here how the invention actually came about, and what steps the inventor actually took, for example because the inventor did not assume the closest state of the art.

The court assumes the characteristics of the OGI pen marker as they appear from the documents discussed above, including the technical drawings, source code, customer statements about the composition and operation of the OGI pen marker and the film created by OGI demonstrating the use and operation of the OGI pen marker.

The panel of experts determined, from the demonstrations of the OGI pen marker given at the installation meeting and in the film submitted by OGI, the technical drawings submitted and the source code, that the OGI pen marker exhibited the following characteristics:

- it is a diamond marking device that works in conjunction with a three-dimensional diamond cartography device, capable of creating a map of a diamond whose surface must be marked according to a predetermined motif;
- it includes a marker, the tip of which can be brought into contact with the surface of the diamond in order to make a mark on the surface of the diamond;
- it includes a marking position determination system to move the marker in relation to the diamond, thus placing both in a marking position.

- it includes computer means for handling the aforementioned marking position determination system and for moving the marker in relation to the diamond.

The panel of experts determined that it is clear that the OGI pen-marker contains all the means to allow the pen-marker to interact with a three-dimensional cartography device when it is displaying a sequence of markers representing the motif, and the motors for moving the marker pen are controlled by the three-dimensional cartography device (pp. 77 and 78 panel of experts report).

The court agrees with the technical findings of the panel of experts. They are confirmed by, among other things, the OGI film and customer statements.

The OGI pen marker differs from the diamond marker attachment of claim 1 of patent BE '912 in the presence of a marker pen and a system for moving this marker in relation to the diamond to bring both into a marking position, whereas the diamond marker attachment of claim 1 of the patent BE '912 has a laser source with associated focalization optics and a system to move the optical path with respect to the diamond.

47. The objective technical problem can be formulated as providing a diamond marker attachment for a 3D diamond cartography device, which is more accurate than a pen marker, i.e. it can be marked with smaller line widths, and the mark applied is not erasable.

The thickness of the line marked by the pen marker is determined by the thickness of the tip of the stylus or pen. The testimony of Mr. Blom during the Israeli proceedings shows that the thickness of the line drawn by the pen marker was a disadvantage of the system and could be improved (p. 27, lines 25-27 and p. 28, line 1-3, item 4.19 OGI, translated):

"Q: Now coming back to the line that was drawn with a pen, wasn't it too thick to allow exact sawing and entry?

B: Let's put it this way. At this most extraordinary point in the history of diamond polishing, this was the most accurate you had. Now as technology improves we have a more accurate system, but at the time that system was the most accurate.

Q: So it can be said that the thickness of the line was a disadvantage of the system.

A. Yes(...)"

The marking applied by a marker was also erasable, which can lead to this marking being lost during the editing process, which is not always desirable.

48. Sarine's assertion that these are artificial problems formulated with 'hindsight', with knowledge of the solution, cannot be accepted.

Sarine argues that the problems raised by OGI are all issues typically associated with pen marking, these problems have existed for a long time, but were not considered problems at all. However, this is contradicted by Mr Blom's statement and the report by Sarine's own technical adviser, Mr Claus. Sarine's own technical counsel confirms that the erasability of a pen mark on the priority date was a problem: 'Pen mark is not permanent as the ink cannot withstand the temperatures generated during many of the processing steps such as sawing, cutting and s/ yip. In addition, the marking is also removed by the cleaning methods, such as boil down in acids, used to rid the surface of contamination. Because the marker is gone after the processing step, the decision maker has only limited resources to check the accuracy of the processing' (p. 4.35 piece 1.21 Sarine).

Mr. Claus also confirmed that the marking should be thin (15.35, item 1.21 Sarine). Some markings are not suitable to be made with a pen: for example, according to Mr. Claus, it would not make sense to use a pen width of 0.5 mm to

wish to mark the upper and lower girdle boundary for a 1 carat (ct) stone with 3% girdle, as the girdle thickness is less than 0.2 mm. Mr. Claus further describes the disadvantages of pen marking for diamonds as follows:

- marking is lost during the editing process;
- the pen wears out quickly due to abrasion on the diamond surface and draws thicker lines;
- the pen dries out when left open;
- it is obvious that dot pen marking has limited use, if any, for marking purposes as security for polished diamonds (identification marking) as the marking can be easily removed without affecting the diamond: a permanent marking is necessary for this application.

Sarine herself draws conclusions on this point: "However, the fact that dot markings were not indelible was also a disadvantage (lines could be accidentally removed during transport). In addition, ink markings were not always sufficiently accurate" (p. 3). She states that the device according to the invention under review was "capable of performing automated, accurate and indelible laser markings (as opposed to ink pen markings)" (p. 4).

Claim 1 provides a diamond marker attachment where the pen has been replaced by a laser with associated focusing points and displacement means, and computer means are provided which sequentially position the laser beam and the diamond in said position for each of the markers determined by the 3D cartography device.

49. Sarine argues that this formulation of the objective technical problem wrongly ignores a number of differences between the pen marker and the invention of claim 1 of BE '912.

It argues that OGI does not prove that in the OGI Pen Marker the 3D Cartography System defines a sequence of markers and the marker is placed in each of the markers. She disputes that the OGI pen marker determines a z-coordinate of the pen and argues that the pen in the OGI pen marker moves along the Z axis until it touches the diamond, for example by a spring system. Consequently, according to Sarine, the following differences between her invention BE '912 and the OGI pen marker must be taken into account:

- that the 3D cartography device determines a sequence of markers by calculating the 3D coordinates;
- that the marker is placed in each of the marker points of a sequence of such points determined by the 3D cartography system.

The panel of experts stated that no definitive answer could be given as to whether the 3D cartography device in the OGI pen marker indeed determined a sequence of marking points (p. 78 report of the panel of experts).

However, based on the technical findings of the experts, the statements of the customers and the demonstration of the OGI pen marker in the OGI made movie, it is established that:

- the cutting line marked by the pen marker is determined by the 3D cartography software, using the 3D coordinates of the stone (see also p. 59 report of the board of experts);
- the movement of the pen in the X and Y direction and the rotational movement (of the diamond) are controlled on the basis of the cutting line coordinates determined by the 3D cartography software (p. 59 report of the panel of experts);
- the motors for moving the marking pen are controlled by the 3D cartography device (see also p. 78 report of the board of experts); all means are in place to allow the pen-marker to interact with a 3D cartography device, which defines a sequence of markers (p. 78 report);
- the pen-marker is able to apply the sequence of marking points representing the motif on the surface of the diamond using the marker (see also p. 77 report of the panel of experts).

The three-dimensional diamond cartography device, which can create a map of a diamond whose surface is to be marked according to a predetermined pattern, already existed on the priority date.

When the three-dimensional cartography device determines a sequence of markers representing the design, the pen-marker is able to apply this sequence of markers to the surface of the diamond using the marker pen.

Claim 1 of patent BE '912 claims a diamond marking attachment suitable for cooperating with such a 3D cartography device (see marginal 20 above). This is already the case for the OGI pen marker.

Sarine's claim that the pen marker would use a feedback mechanism or spring mechanism is not substantiated or made plausible in any way, and is not supported by any finding of the panel of experts, nor by Sarine's technical counsel's own report. Mr. Claus (piece 1.20 Sarine), or in the film in which the operation of the pen marker is demonstrated.

The differences put forward by Sarine, if proven, are therefore not such as to lead to a different formulation of the objective technical problem.

Sarine's statement that the objective problem to be solved is the safe application of any marking (safety indicia or decision mark) to any diamond (finished or rough) by a laser cannot be accepted.

The field of the invention is not limited to marking rough stones.

The OGI pen marker already allowed a mark to be applied to any diamond (finished or rough) in a safe manner, albeit that the mark was erasable and it drew relatively thick lines.

There is no dispute that on the Priority Date devices already existed that allowed laser inscriptions (as well as safety indicia) to be safely applied to the surface of a finished, cut diamond.

50. Sarine argues that the film submitted by OGI reveals several other conceptual differences between the OGI pen marker and the laser marking by OGI's Multiscope system.

However, this comparison is not relevant in the present dispute: it is not a matter of comparing the OGI pen marker with the laser marking device marketed by OGI,

but with the patent as claimed by Sarine. The panel of experts found no other differences between the OGI pen marker and the confirmation of claim 1 according to the patent.

Sarine argues that the stone in the pen marker should be held firmly between two anvils, given the force exerted by the pen on the stone, whereas this is not the case with the laser marker. However, claim 1 of the BE '912 patent does not indicate that the stone must be marked in 'every place', but only in the marking points determined by the 3D cartography device.

Sarine also argues that the stone "stands still during the marking with the pen marker, whereas it would move in the laser marking system". However, it follows from conclusion 1 of BE '912 not that it would be a feature of the invention for the stone to move during marking. It is merely stated that the device comprises a marking position determination system for moving the optical path relative to the diamond and thus placing both in a marking position, as well as computer means for operating this system to sequentially direct the laser beam and the diamond into the said position for each of the said markers.

Sarine's technical counsel recognizes that after each contact with the stone, the pen retracts, after which the stone becomes rotated to the next position to mark the next segment (piece 21, p. 18 Sarine).

There is no reason to formulate the objective technical problem differently.

The craftsman

51. The craftsman can be described as a producer or manufacturer of machines/tools for marking diamonds, including planning support tools (see above, marginal 29).

Is the claimed invention obvious?

52. It must now be ascertained whether the solution offered by the invention to be assessed to the problem was obvious to the average person skilled in the art.

There is a lack of inventive step when the prior art would lead the skilled person, faced with the objective technical problem, to adapt the closest prior art, expecting that this would lead to

to a solution of the objective technical problem, in order to arrive at the invention to be assessed as claimed.

When assessing the inventive step, it is permitted to combine several documents, provided that this combination would have been obvious to the skilled person on the priority date.

53. The solution offered by claim 1 of BE '912 to the objective technical problem consists in replacing the pen with a laser with associated focusing optics and displacement means, computer means being provided that successively bring the laser beam and the diamond into said position for each of the markers determined by the three-dimensional cartography device.

It was known to those skilled in the art on the priority date that markings could be applied to a diamond using a laser. The use of laser devices to inscribe a finished diamond has been known to the craftsman since at least the 1980s, as Sarine expressly acknowledges.

The skilled person also knows that laser marking is permanent and cannot be erased. This is part of his general expertise on the priority date.

In a January 2000 issue of the magazine 'Antwerp facets' of the Diamond High Council, it was explicitly stated, among other things, that marking diamonds is an asset of laser processing, and that laser marking is very accurate, especially when used with 3D data (chapter 5.1.n OGI, freely translated):

"Advantages of laser processing:

{ . . .)

- Adds the following very important assets:

- (...)

- marking of the table, 'bezel' facets, pavilions and/or girdle

- easy modification of existing markings

- very accurate through the use of 3D data (...)".

Various other prior knowledge also point to the use of a laser for marking the surface of diamonds.

For example, the following prior knowledge can be pointed out:

DI (US '119, or 'Kaplan') (section 3.D.1 OGI) teaches that a laser can be used to mark a design on the surface of a diamond without cutting it: "Domain of Invention : The present invention relates to the field of engraving indicia on the surface of gemstones, and more specifically a system using a high power pu/s laser ('Q-switched pulse laser') to create markings on part of a gem" (column 1, lines 7-10). Sarine's statement that this prior knowledge leads away from the invention is not accepted.

D1 refers to U.S. Patent No. 3,537,198, which relates to a method of processing diamonds using laser energy, and to U.S. Patent No. 5,190,024, which relates to a method of sawing by diamonds: a laser can be used to mark and cut the diamond in one movement. See also U.S. Patent Nos. 671,830, 671,831, 694,215, 732,118, 732,119, 3,527,198 and 4,392,476, as well as British Foreign Reference 122,470.

Also D2 (US 4,392,476) describes the use of a laser for marking indicia on the surface of a gemstone, including diamonds: "a source of laser energy is directed at the surface of the stone and controlled to engrave the surface with the desired indicia".

D6 (US 5,190,024), filed November 14, 1989, suggests the use of a laser, among other things, to mark the diamond, replacing the marking pen:

- "A marking pen or equivalent is held parallel to the center line of the diamond (300), and adjusted so that its point (330) touches the shortest side of the diamond; when the diamond is rotated with respect to this point, marked with a circle representing the maximum round diameter that can be cut for the diamond (...) Preferably, a laser is used to both mark and cut the diamond in one motion, saving time and potential distress for adjusting or replacing the diamond on its equipment" (p. 1 Summary of the Invention);
- "In this embodiment, the pin 329 has been removed and replaced with a saw; but in an alternate embodiment, a laser is used instead of a pin so that the decision regarding the cut start point and the cutting itself can be a single operation." (column 4, lines 46-51);
- "Once the required height has been so determined, the pen marker point 330 (or the laser or equivalent) is adjusted (. . .)" (column 5, line 1-2) (own underlining).

D4 (US 5,410,125, item 3.D.4 OGI, free translation) and D5 (US 5,573,684, item 3.D.S OGI, free translation) stipulate: "the portion of the surface to be marked is irradiated with an ArF excimer laser whose output beam passes through a mask defining the marker" (Summary of the Invention).

The court concludes that it was obvious for a craftsman on the priority date to use a laser to mark a diamond, as an alternative to marking with a pen.

Sarine's assertion that there is a mosaic of prior knowledge cannot be accepted. The analysis of the inventive step is based on the combination of the OGI pen marker with the general knowledge of the person skilled in the art at the priority date, with at most a prior knowledge of marking diamonds with a laser.

The court concludes that the solution offered by claim 1 of BE '912 to the objective technical problem was obvious to the skilled person, taking into account the state of the art.

54. Sarine disputes that a combination of the OGI pen marker with the laser inscription devices described in D1 (US '119) or D2 would be obvious to the skilled person.

Sarine first argues that the pen marker contains no indication of such a combination.

However, the use of laser devices for inscribing diamonds has been known by the craftsman since at least the 1980s, as Sarine expressly acknowledges.

The artisan would have combined the pen marker with D1, who teaches that a laser can be used to permanently mark a diamond, and this marking is accomplished by placing the laser beam and the diamond zone by zone, or point by point, in a marking position. in order to solve the objective technical problem.

Sarine argues that a combination of D1 with the pen marker would not lead to the invention, since the inscriptions in D1 and D2 are not done on the basis of the coordinates of markers determined by a 3D cartography system as in BE '912. Also, the pen marker's 3D cartography system would not be suitable for determining the sequence of the marking points for the focused laser beam.

This position cannot be accepted.

The diamond marking confirmation claimed in claim 1 of BE '912 does not itself perform 3D cartography, but is suitable for use with a device for 3D cartography (see marginal 20 above). This is already the case for the OGI pen marker (see also the considerations above marginals 46 and 49, which are repeated here). The technical determinations made by the panel of experts, which joins the court, show that the cutting line marked by the OGI pen marker is determined by the 3D cartography software, using the 3D coordinates of the stone, and the movement in X and X. Y-direction and the rotational movement are controlled on the basis of cutting line coordinates determined by the 3D cartography software (report of the panel of experts p. 59).

The panel of experts determined that the OGI pen marker works in conjunction with a three-dimensional diamond cartography device capable of creating a map of the diamond whose surface is to be marked according to a particular motif. The panel of experts determined that it is clear that all means are present that allow the pen marker to cooperate with a three-dimensional cartography device. When this device for three-dimensional cartography a succession of

determines markers representing the motif, the pen-marker is able to apply this sequence of markers to the surface of the diamond using the marker (see p. 77 and 78 panel of experts report).

The skilled person learns from D1 (US '119) that the marking of a particular motif on the surface of a diamond is achieved by placing the laser beam in a marking position zone by zone or point by point (see also column 2, lines 36-39 and column 19, lines 41-42 US

'119). OGI rightly states that it is irrelevant whether or not the OGI pen marker applies a saw line dot by dot, since the skilled person learns from D1 that laser markings are applied dot by dot. Those skilled in the art who wish to solve the problems associated with using a pen in the OGI pen marker will learn that the laser mentioned in US '119, which marks point by point, can be used for this purpose. Point-by-point focusing does not differ essentially from zone-wise focusing of a laser beam (see the report of the panel of experts, p. 84), and is an obvious way for the skilled person to apply a motif.

Sarine argues that US '119 only deals with the marking of polished and burnished diamonds, and infers that US '119 speaks against the use of a laser for rough diamonds. Although US '119 relates specifically to the marking of polished and bruted diamonds, it can be assumed that those skilled in the art will assume that a laser suitable for marking a buffed diamond is also suitable for marking on a diamond in the rough.

Laser marking requires the laser beam to be focused on the surface of the diamond. The special feature of a rough diamond is that its surface is uneven, so that the distance between the laser and the surface of the diamond must be precisely determined for each point individually. This is obvious to the skilled person. Point-by-point laser marking is possible on both polished and rough diamonds. In the latter case, the focal distance can be calculated point by point based on the 3D map of the diamond.

Sarine's claim that the domain of indicia marking on polished diamonds would be distinct from the domain of saw-line marking on rough diamonds is not substantiated. Moreover, this statement is already contradicted by its own patent, since the invention under assessment can be used both for the application of sawing lines (claim 12), and for the application of identification codes or arbitrary inscriptions (claims 13 to 15). At least it should be assumed that the

relevant professional has knowledge of the state of the art in both domains.

Dr. Kinarot, technical counsel for OGI, confirmed during cross-examination as a witness in the Israeli proceedings that he did not state that Kaplan {US '119} teaches cartography, but stated that Kaplan teaches that you would have no problem marking if you learned about cartography. has (section 4.35 OGI, p. 8-10).

Mr. Ze'ev Lashem, General Manager of Sarine, stated in a witness interview from Kaplan that he learned how to focus (the laser) on a single point {'I know how to focus on one point only. That's what Kaplan does'}). However, he disputed that this could be done for the entire length, as Kaplan does not move the diamond. However, this could be possible if the diamond is moved and cartography is incorporated, with an X-Y-Z calculation to find the place to mark with a laser (piece 5.1 m OGI).

55. Sarine does not prove that the prior art diverted from the invention by working with a pen marking despite the existence of laser marking of finished stones.

After all, it does not prove that the use of a pen was the result of any technical prejudice against the use of laser markings for rough diamonds (see marginals 26 to 32 above).

56. Sarine's claim that D6 (US 5,190,024) leads away from the invention cannot be accepted either.

In D6 it is explicitly stated that a laser can be used, "both for marking and for cutting the diamond in one operation". Sarine's statement that the skilled person learns from this to skip the individual step of marking is not consistent with the wording of this document. In this case, the marking is formed by making a saw cut.

Sarine's argument that D6 leads away from invention, since D6 relates to saw lasers, and everyone knows that saw lasers have too great a depth of field, cannot be accepted either. Cutting or sawing also starts with the application of a marking line. Processing a diamond with a laser beam by cutting the diamond also means that this laser beam is suitable for marking the diamond. The removal of material from the diamond can be regarded as a form of marking,

and this happens at the start of cutting the diamond. After all, laser processing also requires that the laser be focused on the diamond (see also the technical advice of the panel of experts, p. 68). Expert Callewaert added that the fact that a system is set up for sawing or cutting and has a large depth of focus for this purpose does not prevent a marking from being made with this laser.

It was also evident on the priority date for the craftsman who wanted to mark with a laser on the surface of the diamond that the laser should not be too strong to avoid damaging the diamond, as explicitly confirmed by Sarine (p. 100 conclusions).

OGI argues that this problem can be easily solved by those skilled in the art with a basic understanding of lasers.

This is confirmed by the converging statements of various experts experienced in the application of laser technology in the diamond sector, submitted by OGI, who state, among other things, that:

- the "(...) "marking of diamonds is a special form of surface circular sawing" (section 5.1 h OGI);
- "it was already possible in 1999, to also mark diamonds by changing the power of the laser. Moreover, the difference between cutting with a laser and marking with a laser is in a different frequency and a different level of energy from the laser and that is the only difference; therefore it is possible - with a simple and banal stop and without making any significant change - to give the machine that cuts with a laser the characteristic of marking with a laser This provision is empirical (...)" (section 5.1.i OGI);
- "a machine whose main purpose is to cut or saw diamonds with a laser (...) is of course also capable of marking a diamond with a laser, among other things since every cutting or sawing process starts with marking, like when the laser passes over the diamond first, it inevitably creates a marking line.

Moreover, when the end goal is to saw or cut a diamond with a laser, it is evident that the operator will always, on his own initiative and deliberately, first and foremost, mark a line on the surface of the diamond, at which point the operation of the machine will stop, then check said mark, while it cutting result is irreversible. (...)" (documents 5.1 j and 5.1 h OGI);

- "A machine whose main purpose is to cut or saw diamonds with a laser is also capable of marking a diamond with a laser, among other things since any cutting or sawing process inevitably and naturally starts with marking. In addition, I have did the marking on a regular basis even in the early 1980s with a machine mainly created for cutting or sawing" (piece 5.1 h OGI);

- "Furthermore, I declare that as a general rule by a simple and trivial step and without making any substantial change the laser marking feature can be added to the laser cutting machine. Moreover, where a laser cutting feature exists in the machine also possible to at least do a marking with that. In the company I ran we just routinely did a diamond marking with a machine designed to cut with a laser" (section 5.1.1 OGI).

The mere fact that these statements were made in the course of the dispute is no reason to set them aside, as they expressly state that they describe the knowledge of the practitioner in 1999. These identical statements appear credible and convincing.

57. Sarine's assertion that OGI document 5.1.n and the references in this document to the 'SOLID' system led away from the invention cannot be accepted either.

Among other things, this piece 5.1.n relates to SOLID: "Solid is an extension of the traditional 2D laser machine for diamond processing to a revolutionary 3D machine tool.

With Solid a stone can be measured (scanner), an optimal one yield can be calculated {Optimiser}, the operation can be simulated and then performed fully automatically in three dimensions {Laser}. All this is integrated in one machine (Integrated Device). Solid works by adding a measuring and positioning device to a laser processing machine. Three axes (index, inclination and height) provide the required positions for positioning. The index axis is also used to rotate the stone during editing. The classic X, Y and Z moves are retained in order to move when editing".

The parties do not agree on the features of the SOLID system that were part of the state of the art on the priority date. While OGI argues that SOLID combines all the features of claim 1, Sarine argues that SOLID is a laser processing system (sawing and cutting system) developed by WTOCD, with an integrated 2D cutting/saw laser with six degrees of freedom used for positioning the diamond relative to of the laser beam and a certain form of 3D measurements, which cannot be equated with 3D cartography, at least it states that no public pre-use of a SOLID system that combines all the features of BE '912 has been proven.

Sarine's statement that the SOLID system, as she describes this system, leads away from the invention, as it relates to saw lasers, cannot be accepted for the reasons already stated above under marginal number 56 with regard to D6.

Also the claim that SOLID leads away from invention because it eliminates the need for separate markings on the stone cannot be accepted. After all, the question at issue is whether, based on the OGI pen marker as the closest state of the art, and in view of the objective technical problem as formulated above, it is obvious for the skilled person to use the pen when marking with a laser, and whether SOLID could mark with a laser. In addition, it is not disputed that cutting line markings on rough stones were and continue to be applied in full, both before and after the Priority Date, including by Sarine's devices - which, according to Sarine's own claim, are a major commercial success - and OGI.

58. Decision.

Assuming the OGI pen marker as the closest state of the art, taking into account the general professional knowledge of the skilled person, combined with D1, or with D2, or with D4, or with D6 or with piece 5.1 n of OGI, the solution was the claim 1 of BE '912 offers, obvious to the skilled person on the priority date.

Claim 1 of BE '912 is null and void due to lack of inventive activity.

There is no reason to further investigate the other grounds for nullity.

8.2. Conclusions 2 to 15

59. OGI decides to declare claims 2 to 15 null and void.

It states that it will not comment further on claims 16 to 27 of BE '912 since these claims (nor the dependent claims 8, 9 and 10) are not invoked as grounds for the infringement action. There is no dispute between the parties that OGI does not use any coating or coating on the diamond when marking it.

These claims are dependent claims relating to specific features and/or components of the diamond marking attachment. These conclusions should be read in conjunction with independent claim 1.

Sarine argues that OGI fails in its burden of proof that the dependent claims are invalid, and that OGI erroneously divides these dependent claims into the individual components of these dependent claims, and then leads to the invalidity of these separate claims. It further limits its substantive defense mainly to the defense that the independent claim 1 is valid and satisfies inventive step, so that the invention set out in the dependent claims 2 to 15 are also characterized by inventive step with respect to these anteriorities. However, for the reasons stated above, claim 1 was declared null and void due to lack of inventive activity.

However, the invalidity of an independent claim does not necessarily invalidate the dependent claims. The novelty or inventive step of a specific variation of the invention should be judged in conjunction with all the features of the claim or claims upon which it depends.

Sarine further only puts forward a substantive defense with regard to the inventive step of claims 2 to 6 and of claim 12, based on D1 (US '119) and D2, separately or in combination, as the closest prior art. However, it cannot be inferred from this that it recognizes the other characteristics of the dependent claims of the claimed invention, whether the features of the dependent claims 2 to 15 would be obvious from the OGI pen marker.

60. Claim 2 relates to an "apparatus according to claim 1, wherein said marking position determining system includes means for orienting the diamond and for orienting the beam".

The OGI pen marker is already equipped with a turntable for the diamond.

It is self-evident to those skilled in the art based on their general professional knowledge that when using a laser instead of a pen, this laser beam should be focused on the surface of the diamond where a marking point is to be made, and therefore a laser beam orientation means must necessarily be provided for the laser beam.

Consequently, the subject matter of claim 2, in combination with all the features of the claim on which it depends, does not exhibit the required inventive step.

Insofar as necessary, the Court of Appeal addresses Sarine's argument that D1 leads (US '119) away from the invention. This position cannot be accepted. The system for determining the marker positions in D1 {US '119) included:

- a means of orientation of the diamond, namely a translatable stage 50 and drivers 51 in figure 9, and
- means for orienting the laser beam, namely a filter 3, beam expander 5), filter 7 and mirror 8 in figure 1 and figure 9.

This also appears from the description of the invention. The positioning system for moving the workpiece relative to the focus of the laser may also include beam steering devices, such as mirrors (column 4, lines 61-64). Sarine's statement that D1 would not disclose diamond orientations or jet orientations is inconsistent with the contents of this patent.

D1 is the Updated version of D2. There is no dispute between the parties that D2 already contained means for orienting the diamond and means for orienting the laser beam by means of deflectors.

Claim 2 does not show the required inventive step starting from the pen marker, combined with the general professional knowledge, whether or not in combination with D1 and/or D2.

61. Claim 3 relates to an apparatus according to claim 2, wherein said cartography device includes a turntable having a central axis of rotation and an upper surface on which the diamond can be fixed, and said turntable forms intended means of orientation of the diamond".

Claim 3 specifies the moving means in that the diamond orientation means is a turntable. This embodiment is shown in figure 1, where a turntable 4 for the diamond is rotatable about a vertical axis X.

The OGI pen marker is provided with a turntable with a central axis of rotation and a top surface on which the diamond can be mounted, so that the subject matter of claim 3, in combination with the features of the claims on which it depends, is also not an inventive step.

62. Claim 4 relates to an "apparatus according to claim 2, wherein said street orientation system is capable of correcting the length of said optical path and moving said path along the center axis".

The central axis referred to is not defined in claim 1 and claim 2, but only in claim 3. However, it will be clear to those skilled in the art that claim 4 should refer to claim 3.

It follows from reading this conclusion that it only claims that the length of the optical path can be corrected, without this being required along the central axis, and that the path or optical path can be moved via the central axis. This is also evident from the description and the drawings (page 3, line 30 to page 4, line 24 and figure 2 BE '912).

The OGI pen marker already includes means for moving the marker in a direction perpendicular to the axis, and for moving it in the direction of the central axis.

In addition, it is obvious to the skilled person that a focusing lens is present between the laser source and the surface of the diamond in order to focus the laser beam on the surface of the diamond. It is also obvious to a person skilled in the art that it can be moved according to the direction of the optical path in order to focus the laser beam on the surface of the diamond.

Needless to say, the documents show that other anteriorities already describe the additional features of claim 4. US '119 describes a positioning system provided with beam steering systems that allow the focus of the laser to be moved relative to the diamond along a central axis, so that, consequently, the length of the optical path is controlled and the optical path is moved along this central axis. US '119 describes a displacement of the diamond in a direction perpendicular to the lens, thus controlling the length of the optical path along a central axis by moving the diamond closer or further away from the lens. This positioning system may include or be constituted by beam steering systems such as mirrors (description column 4, lines 41-67 and Figures 5 and 9). D2 also contained a system that can correct the length of the optical path and move the optical path ('translational movement in y-direction').

Consequently, the object of claim 4, in combination with all the features of the claims on which it depends, does not show the required inventive step.

63. Claim 5 relates to an "Apparatus according to claim 4,

- further comprising a pedestal on which said laser source and said beam control system are mounted,
- the pedestal having supporting surfaces on which to mount said diamond cartography device and
- said computer means being able to monitor both said device and said device".

The Board of Experts determined that the OGI pen marker has a base that forms a pedestal on which its components, namely the marker pen orientation system and a camera of the cartography device are mounted. This is also confirmed by the content of the demonstration film filed by OGI.

Furthermore, the computer means are present at the OGI pen-marker to operate both the pen-marker and the cartography device (p. 85 report of the panel of experts).

When the skilled person replaces the marker with a laser source with focusing optics, no inventive step is required to mount this laser source and the focusing optics on this base.

Claim 5 in combination with all the features of the claims on which it depends does not involve any inventive step.

64. Claim 6 relates to an apparatus according to claim 5, wherein said beam orientation system includes means for moving the laser for computer-controlled linear displacement of said laser source with associated focusing optics along a leading portion of the optical trajectory, so as to correct the length of the optical path.

This dependent conclusion is not based on any inventive step based on the combination of the pen marker and US '119 (D1), and on the general knowledge of those skilled in the art who are familiar with the application of laser technology in the diamond industry.

In the system described in US '119, the length of the optical path can be adjusted by moving the table (SO) in the direction of the central axis.

The fact that this feature would not have been disclosed as part of a system for determining the marking position for bringing the laser beam to any point determined by a 3D cartography device, as Sarine argues, leads to the conclusion that the invention under assessment is dependent claim is new, but it does not follow that this indicates inventive step.

It is obvious to those skilled in the art that the length of the optical path can be adjusted by moving the laser, namely the laser source with the associated focusing optics. When the laser beam is not focused on the diamond, the distance between the focusing optics and the surface of the diamond should be adjusted according to the direction of the optical path. This can be done by moving the laser source with associated focusing optics, or by moving the diamond, following the direction of the optical path, until the laser is focused on the surface of the diamond.

The fact that this movement is computer-controlled, and therefore automated, is not an inventive step.

Claim 6 in combination with all the features of the claims on which it depends does not involve any inventive step.

65. Claim 7 relates to an "apparatus according to claim 6, wherein said base has guides and said device for moving the laser is in the form of a cartridge capable of being moved along said guides and around the said laser with its focusing optics.

Making the laser movable via guides on the pedestal is merely an implementation choice that would have been obvious to any craftsman in the field of mechanical design. This belongs to the general knowledge of the skilled person.

If one wishes to move the optical system in order to have the focal point of the laser beam fall on a diamond, it goes without saying that this is done in a controlled manner. The provision of guides and a sliding carriage or cartridge for carrying the laser with its focusing optics is a possible embodiment, which does not, however, involve any operational work.

Claim 7 in combination with all the features of the claims on which it depends does not involve any inventive step.

66. Claims 8 to 10 read as follows:

8. Apparatus according to claim 7, wherein said pedestal is in the form of a base with a concave zone between said support surfaces, for positioning said laser source in such a manner as to ensure that said front part of the optical path extends into said concave zone on a first plane perpendicular to the central axis and located below said top surface of the turntable;

9. The apparatus of claim 8, wherein said laser orientation system further includes optical components mounted on said pedestal for guiding the optical path from said front portion to said rear portion located on a second plane parallel to said base. said top surface of the of the turntable, and located above it.

10. Apparatus according to claim 9, wherein at least one of the optical components can be moved along an axis parallel to said central axis.

OGI concludes that claims 8, 9 and 10 are null and void for lack of inventive activity, stating that they are constructive details.

Sarine argues that OGI, with regard to the alleged invalidity of claims 8 up to and including 10, only makes a pro forma general statement without taking the trouble to identify the relevant grounds for invalidity, let alone substantiate its assertions in this regard.

The plea of nullity of these dependent claims formulated by OGI is very vague and general, and OGI does not indicate how these so-called 'constructive details' would follow in any obvious way from the state of the art, let alone that they provide the evidence.

OGI's claim for annulment of dependent claims 8 to 10 is unfounded.

67. Claim 11 relates to an "apparatus according to claim 1, wherein said computer means is capable of creating the appropriate position corrections whenever the diamond surface to be marked is not in the predetermined position."

Rightly, OGI argues that this conclusion is unclear, since it is not defined what should be understood by 'appropriate position corrections' or 'the predetermined position'.

Claim 11 does not mention structural elements that detect, for example, whether or not the surface of the diamond to be marked is in the predetermined position. It must thus be assumed that claim 11 only implies that said computer means allow to generate a displacement from an incorrect position to a correct position. It can also be assumed that this incorrect or correct position refers to the position of the surface of the diamond to be marked. The description states that "the computer is provided with adapted software to guide the movements of the turntable 4, the laser displacement device 20 and the device 28 in accordance with the marking motif, and possibly to activate the laser source 10 so that it would irradiate the surface of the diamond in the sequence of marking points according to the motif. It is preferable that the computer is also able to make the appropriate corrections when the diamond surface to be marked is not perpendicular to the back part T of the optical trail in each of these points" (p. 5, lines 12 to 20). The dependent claim 11 becomes however, not limited to this last hypothesis.

The court agrees with OGI in arguing that this claim thus adds nothing to claim 1, in particular the feature of claim 1 that the diamond mounting "(comprises) computer means for handling said system for determining the marking positions, for adjusting the laser beam and sequentially placing the diamond in said position for each of said marking points.

Claim 1, including the feature mentioned above, is void for lack of inventive step. This therefore also applies to dependent claim 11.

The motives that led the court to conclude that there was no inventive step for independent claim 1 are repeated with respect to dependent claim 11.

68. Dependent claim 12 relates to an "apparatus according to claim 1 wherein said motif is a saw line created by said mapping system."

Claim 12 specifies the motif to be applied to the diamond, without claiming explicit features of the attachment. Nor are certain characteristics of the confirmation claimed that would allow a distinction to be made between the application for marking rough or polished diamonds. Claim 12, which is dependent on claim 1, relates to a diamond marking attachment (product) and not to a method of marking diamond.

The scope of claim 12 is that the mark position determination system for displacing the optical track relative to the diamond and thus placing both in a mark position, and the computer means for operating said mark position determination system of the diamond marking attachment, must be able to sequentially move the laser beam and the diamond into the marking position according to the yellowed motif, which consists of a cutting line.

Since the OGI pen marker is already intended and suitable for applying sawing lines, the subject matter of this claim 12 does not involve any inventive step with respect to the OGI pen marker.

From the technical findings of the experts, as well as from the film submitted by OGI, supplemented by the statements and documents submitted by it (including manufacturing drawings and source code), it appears that in the OGI pen marker on the priority date the cutting line is determined by 3D cartography software, using the 3D coordinates of the stone, and the movement in X and Y direction and the rotational movement are controlled on the basis of cutting line coordinates determined by the 3D cartography software (p. 59 lecture report of experts).

Reference is made where necessary to what was considered above in connection with the application of laser markings to the surface of the diamond (see marginals 53 to 57 above). These motifs are reproduced here.

Those skilled in the art learn from US '119 that laser markings are applied point by point: US '119 provides a system with a pulse laser, such as a Nd:YLF pulsed laser with Q switching, which ablated or charred a series ('graphitic') specks on the surface of a workpiece as a diamond generates (column 2, lines 35-40). The inscribed characters should not be limited to alphanumeric symbols, and can actually be characters in any language, character line characters, custom characters (column 3, line 33-35 US '119).

When a laser beam is suitable for processing a diamond by cutting it, for example, this also means that this laser beam is suitable for marking the diamond. This finding is also confirmed by the concurrence statements submitted by OGI from industry experts on the expertise they possessed on the priority date.

Claim 12 is null and void due to lack of inventive step.

Dependent claim 13 relates to an apparatus according to claim 1 wherein said motif is of a nature to be entered into said cartography system by a user. Dependent claims 14 and 15 relate to devices according to claim 13 wherein said motif is an identification code (14), or an arbitrary inscription (15).

Claims 14 and 15 only specify the design to be applied to the diamond, without requiring explicit features of the confirmation, whereas claim 13 states that the design is entered by a user.

The scope of these claims is that the mark position determination system for displacing the optical track relative to the diamond and thus placing both in a mark position, and the computer means for operating said mark position determination system of the diamond marking attachment, must be able to sequentially move the laser beam and the diamond into the marking position according to the claimed motif.

The motifs mentioned in claims 13 to 15 are already mentioned in D1 (US '119), and the device of US '119 is clearly capable of applying such motifs (see column 3, lines 10-36).

The claimed inventions are obvious to those skilled in the art in light of the combination of the OGI pen marker, D1 and his general knowledge of the art.

These dependent claims are void for lack of inventive step.

70. Decision. The decision to invalidate claims 1 to 7 and 11 to 15 of patent BE '912, due to lack of inventive step.

c. Help requests

71. Extremely subordinately, Sarine requests this court, in case of a partial annulment of BE '912, for whatever arguments invoked by OGI, to allow Sarine to amend her patent in accordance with Article XI.57 WER in such a way that the ground for invalidity does not application anymore.

Article XI.57 WER stipulates that, if the grounds for invalidity only partially affect the patent, the patent is limited by a corresponding amendment of the claims and, where appropriate, of the description and the drawings, and partially invalidated. This change is entered in the register.

The fact that the term of validity of the patent has expired in the meantime does not affect Sarine's ability to defend itself against the counterclaim for invalidity, including via subordinate requests for help. Such a limitation of the patent has an ex tune effect.

72. OGI argues that Sarine is abusing the possibility to submit requests for assistance, by only making use of this possibility after more than 15 years of litigation in Belgium, at a late stage in the procedure, knowing that OGI has only a very short had time to respond.

Sarine confirmed these requests for help during oral argument. OGI was given the opportunity to respond to the requests for help as formulated both orally during pleadings and through modified conclusions.

Submitting requests for help by Sarine does not constitute an abuse of procedure. Nor were OGI's rights of defense violated.

C.1. First aid request

73. Sarine's first request for assistance seeks to amend claim 1 of BE '912 as follows, underlining the additions to these claims:

"Diamond marker attachment for a three-dimensional diamond cartography device capable of creating a map of a diamond the surface of which is to be marked according to a predetermined motif, and capable of determining the 3D coordinates of a sequence of the marker points aforesaid motif, where the cartography device and the confirmation form, at least during their operation, an integrated mapping and marking system, the intended confirmation comprising:

- a low power laser source with associated focusing optics, to emit a concentrated laser beam along an optical path;
- a marking position determination system to move the optical path relative to the diamond and thus place both in a marking position;

and

- computer means for said system for determining the

mark positions, to sequentially position the laser beam and the diamond in said position for each of said mark points based on the 3D coordinates of those points determined by the diamond mapping device."

74. Sarine does not provide any further explanation for the proposed request for help.

OGI first argues that this first request for help is not an appropriate limitation of the first patent claim, and these features do not address the lack of inventive step.

In addition, it argues that there is added matter, prohibited under Article XI.57 § 1, 3° ELC, to the extent that it is required that the cartography device and the mounting, at least during their operation, form an integrated cartography and marking system, the laser source is defined as a low power laser source and in the last sentence it is determined that the device comprises computer means for sequentially placing the laser beam and the diamond in said position for each of said marking points based on the 3D coordinates of those points determined by the 3D diamond cartography device.

Finally, OGI argues that this initial request for assistance is contrary to Article XI.57 § 1, 2° WER, which stipulates that a patent is invalidated if it does not contain a sufficiently clear and complete description of the invention for an expert to discover the invention. be able to because it is not clear what such a system will look like or will work as an "integrated system", and it is completely unclear how the calculation or determination of the coordinates is done by the 3D cartography system.

75. The first assistance request cannot be admitted, to the extent that the device is required to include computer means to sequentially position the laser beam and the diamond in said position for each of said marker points based on the 3D coordinates of those points determined by the 3D diamond cartography device, and this 3D cartography device and the confirmation form, at least during their operation, an integrated cartography and marking system.

There is no dispute that three-dimensional diamond cartography facilities existed at the Priority Date.

The patent as granted relates to a diamond marker attachment for a 3D cartography device. The patent claim 1 should be interpreted in the sense that it is sufficient that the disclosed diamond marking attachment is suitable for use with a 3D cartography device. The 3D cartography device itself is not claimed. Nor is an integral cartography and marking system claimed.

The patent merely specifies that the diamond mark attachment includes computer means for operating said mark position determination system to sequentially position the laser beam and diamond in said position for each of the "said" mark points. Claim 1 of the patent is to be interpreted in the sense that it concerns computer means suitable for cooperating with a device for three-dimensional diamond cartography, which itself does not form part of the claimed invention. The description on page 2, line 18 of BE '912 only states that the coordinates of each point of the mark are calculated by computer. The calculation or determination of 3D coordinates by the 3D cartography device is not the object of the invention. The patent application as a whole does not specify how the 3D coordinates for a sequence of markers are calculated and determined.

Matter is added by adding the characteristics described by Sarine in her first request for help. These characteristics cannot be determined directly and unequivocally by the skilled person, using his general professional knowledge objectively and on the date of the patent application, are derived from the patent application filed in its entirety.

Pursuant to Article XI.57 § 1, 3° WER, a patent is declared invalid if the subject matter of the patent is not covered by the contents of the patent application as filed.

These additions from the first request for help are inadmissible.

Moreover, the provision that the 3D cartography device and the diamond marking fixture constitute an integrated mapping and marking system 'at least during their operation' is not such as to meet the invalidity of independent claim 1 for lack of inventive step, assuming the OGI pen marker as the closest state of the art (article XI.57 § 1, 1° WER juncto XI.7 WER). The OGI pen marker also worked together with a 3D cartography device that is able to generate a map of a to create a diamond whose surface must be marked according to a predetermined motif.

76. The provision in the first request for help that use is made of a "low power laser source with associated focusing optics, to emit a concentrated laser beam along an optical path" is also not of a nature to meet the invalidity objections to claim 1 as granted .

First of all, the term "low power laser source" is vague. OGI rightly points out that it is common knowledge of those skilled in the art that the power and intensity of the laser must be adjusted when proceeding to marking rather than other operations such as cutting. This is also confirmed by the statement of Mr. Noam Shapria, developer and manufacturer of laser machines in the diamond industry, among others (document 5.1.i OGI). The addition that a "low power laser source" is used was evident to those skilled in the art on the priority date, and does not affect the invalidity of independent claim 1 of BE '912 for lack of inventive step.

In addition, in the description of the patent BE '912 it is expressly stated that any laser can be used whose power is sufficient to make permanent marks in each of the marking points (p. 5, lines 29-31 BE '912).

The specification further states that preference is given to a low-power laser source, an example of which is given. However, it is added that in order to use this laser source in general, and with the marking system of BE '912 in particular, it is proposed to coat the diamond in such a way that it is marked by a solvent of a copolymer in a solution of hydrocarbon. The laser power required to plasma form the coating material is said to be lower than the power required to engrave directly into the diamond itself. Independent claim 15 claims a precedent of laser marking the surface of a diamond consisting of coating the

surface of the diamond, followed by marking the surface of the coated diamond with a concentrated laser beam of power E1, with a power much lower than that which would have been required to apply this marking directly to the surface of the diamond without cladding ("une puissance E 1 beaucoup plus foible", incorrectly translated in the submitted sworn translation of the patent as "a laser strength E1 which is much higher than"). By stating in claim 1 that a low power laser can be used as detailed in the description, without the requirement to use a cladding, the request for assistance adds matter, in violation of Article XI.57 § 1.3 ° WER.

The first help request cannot be allowed.

C.2. Second help request

77. Sarine's second relief request is that the features of independent claim 1 and dependent claims 2, 3 and 4 be combined into a single claim. The other claims are retained, but renumbered.

Sarine thus claims to satisfy the pleas of nullity, based on a lack of novelty of the claimed invention in relation to the SOLID system, as judged in Israel.

It appears from the foregoing that both the independent claim 1 and the dependent claims 2, 3 and 4 are invalid for lack of inventive step, based on the OGIpen marker as the closest prior art.

The mere combination of the features of these claims in a single claim does not meet these invalidity objections.

Sarine's second request for help must be rejected.

C.3. Additional help requests

78. Sarine requests the court to be given the opportunity to submit additional requests for assistance that meet any nullity objection that the court would deter. To this end, she requests the court to reopen the bats and to determine a conclusion calendar.

OGI opposes this.

The claims of the parties must contain the pleas invoked in support of the claim or defense {Article 744 of the Judicial Code}.

The case was allowed to run over a very long period of time, giving the parties the opportunity to repeatedly update their conclusions in light of the evolution of the dispute.

Finally, they were given the opportunity to submit final substitute synthesis conclusions after the first hearings. After extensive pleadings, the case was taken up for public deliberation. The closure of the debates can take place even if one of the parties only incompletely responds to the claim of the other party.

has answered, or has reserved the right to conclude (Cass. May 12, 1978, AC 1978, 1070 and Cass. January 3, 1980, AC 1978-80, 510).

The pleas of nullity raised by OGI were known to Sarine, and Sarine was able, in the course of the very long procedure, to submit the requests for assistance she deemed necessary, in the light of the pleas of nullity developed by OGI and the anteriors invoked. The mere fact that several pleas of nullity were invoked does not detract from this.

There is no question of a new document or fact of major importance, discovered during the deliberations. The current judgment is pronounced taking into account the means developed by the parties in their submissions, and the documents submitted by them prior to the conclusion of the debates.

There is no reason to reopen the debates to allow Sarine to submit additional requests for help.

D. Main Infringement Claim

79. Sarine argues that OGI infringed claims 1 to 7 and 11 to 15 of patent BE '912 as granted, at least claim 1 as modified based on its first or second request for assistance.

In view of the nullity of claims 1 to 7 and claims 11 to 15 of patent BE '912 as granted, and the rejection of the requests for assistance, Sarine's main claim for infringement must be dismissed.

E. Counterclaim to Lift the Injunction

80. OGI claims that the lifting of the provisional prohibition with regard to the BV OGI Systems Europe on handing over, selling or otherwise disposing of objects suspected of counterfeiting, as imposed by the order of the attachment judge at the court of first instance in Antwerp of 23 March 2005 would be ordered.

In view of the annulment of the claims of patent BE '912 on which the seizure measures were based, these should be lifted.

Since the term of validity of the BE '912 patent expired in its entirety on 14 June 2021, this patent could in any event not form the basis for any prohibition measure after that date.

F. Counterclaim for Misleading Advertising

81. By way of counterclaim, OGI is filing an injunction seeking to order Sarine to be prohibited from making any misleading statement to third parties in any country and in any form whatsoever regarding the order of the attachment judge in Antwerp of March 23, 2005, or any other decision rendered in the context of the dispute between the parties, subject to penalty. She also claims Sarine's order to pay provisional compensation of 100,000 euros for disseminating misleading advertising, and the publication of the current judgment in application of article XI.334 § 4 WER.

OGI argues that Sarine misleadingly led the global diamond industry to believe that OGI was convicted of patent infringement by failing to specify in its May 5, 2005 communication that the court decision in the counterfeit seizure proceedings she communicated was unilateral and provisional, thus giving the industry the impression that purchasing OGI's products could lead to problems. It argues that this communication, on the part of Sarine, constitutes misleading comparative advertising and violates OGI's good name.

Sarine first of all disputes the international territorial jurisdiction of the court to rule on this claim, in the absence of any evidence that the contested publication was distributed in Belgium. Secondly, it denies having committed any error, and it denies the existence of any damage on the part of OGI.

82. Sarine, the counterclaim defendant, is a foreign company with its registered office in Israel, outside the European Union.

The international jurisdiction of the Belgian courts and tribunals must therefore be assessed by applying the provisions of the Belgian Code of International Private Law, hereinafter WIPR.

Since Sarine's registered office is located outside Belgium, OGI cannot rely on Article 5 WIPR.

OGI bases its claim against Sarine on Article 1382 of the Old Civil Code and on Article VI.104 WER, so that the rules regarding international jurisdiction for extra-contractual obligations apply.

OGI invokes Article 96, 2° WIPR, which stipulates that Belgian courts have jurisdiction to hear claims regarding an obligation arising from an unlawful act (a) if the harmful act has occurred or is imminent in Belgium to occur; or (b) if and insofar as the damage has occurred or threatens to occur in Belgium.

OGI argues that the advertising in question was distributed in Antwerp, where both OGI and Sarine have a shop, and that this advertising reached players and customers in the diamond industry in Antwerp. Sarine denies that the publication in question was distributed in Belgium.

The dispute between the parties relates to an English letter dated 5 May 2005 from Sarine entitled 'Belgian Court Acts against OGI Systems Europe' ('Belgian Court Acts against OGI Systems Europe') (OGI document 2).

Since the letter in question was sent by Sarine, whose registered office is in Israel, OGI cannot rely on Article 96, 2°, a WIPR, in the absence of evidence that the harmful act has occurred or is likely to occur in whole or in part in Belgium .

Document 2 as submitted by OGI contains a fax number of the addressee (from ... to 0097(..)" with country code '0097' (and not 0032 for Belgium), so this document does not constitute evidence that this letter was also addressed to recipients in Belgium.

OGI is presently enclosing a letter from an Indian customer addressed to OGI Systems Ltd. in Israel, in which this customer OGI Systems Ltd. requested additional guarantees in Israel, having been made aware of a dispute between OGI Systems Ltd. and Sarine (item 2 ter OGI). OGI also refers to publications in the Indian press which refer to a document circulated from Sarine regarding her case against OGI Belgium (item 2 quater OGI). On July 14, 2005, OGI Systems Ltd. , with its registered office in Israel, place an advertisement in an Indian newspaper, stating that the OGI marker, OGI Writer and OGI Multiscope do not infringe any patent and that it can sell them worldwide, including Belgium (exhibit 1.11 Sarine In a later publication on her website, Sarine explicitly referred to rumors circulating in India that she had lost a patent case against OGI in Belgium, and she contradicted these rumors by confirming that this patent procedure is continuing (document 2 bis OGI Finally, OGI claims to have suffered damage consisting of a decline in OGI sales in the Indian market.

It can only be deduced from these documents that the communication based on Sarine (Israel), dated 5 May 2005, targeted the Indian diamond sector, without showing that the contested communication was also addressed to recipients in the Antwerp diamond sector. Such evidence can also be inferred from the fact that this letter was addressed to 'members of the diamond industry and trade', nor from Sarine's statement on her website to correct rumors in India in which she refers to an earlier communication to the international diamond sector.

OGI fails to demonstrate in concrete terms that the communication sent by Sarine has caused or threatens to cause damage in Belgium.

The place where the damage occurred cannot be construed comprehensively in the sense that it includes any place where the harmful consequences of an act which has actually caused damage elsewhere can be felt. This understanding cannot become so interpreted as referring to the place where the claimant claims to have suffered pecuniary damage as a result of an initial damage suffered by him that occurred in another country (see, by analogy, the case-law of the Court of Justice on the concept of "place where the harmful event occurred" CJEU, 19 September 1995, *Marinari*, C-364/93, op. 14-15; CJEU, 16 June 2016, *Universal Music International Holding*, C-12/15, op. 34; *Kronhofer* (CJEU 10 June 2004, C-168/02, www.curia.europa.eu).

The application conditions of Article 96, 2° WIPR are not fulfilled.

The counterclaim in question also does not arise from the fact or from the act on which the original claim is based, so that the Belgian courts and tribunals cannot draw international jurisdiction from Article 8, 2° WIPR.

The counterclaim in question is also not so closely connected with the main claim for patent infringement or the counterclaim for patent invalidity that it is desirable to consider and adjudicate them together, in order to prevent the decisions would be irreconcilable if the claims were adjudicated separately. There is no international cohesion within the meaning of Article 9 WIPR.

Sarine's objection of international lack of jurisdiction is well founded. The Belgian courts and tribunals have no international jurisdiction to take cognizance of this dispute.

G. Compensation due to incorrect attachment

83. OGI is filing a counterclaim seeking to hear Sarine be ordered to pay damages for the erroneous attachment of the suspected counterfeit goods, and to order the publication of the current judgment, in order to repair the reputational damage she has suffered as a result of these seizure measures.

In particular, OGI accuses Sarine of having committed an error, consisting in the restriction of the freedom of trade and industry, by seizing and continuing this attachment, despite the fact that she was aware of several anteriorities leading to the nullity of BE '912, and she thus abused her rights under the Enforcement Directive.

84. OGI did not file any third-party opposition against the decision made by the attachment judge in Antwerp on 23 March 2005.

The mere fact that seizure measures were requested and subsequently enforced on the basis of a patent that was subsequently invalidated, as in the present case, is not sufficient to prove any fault on the part of Sarine (see also Cass. 11 March 2005, /ROI, 2005, pp. 238). There is no question of any objective liability on the part of Sarine.

OGI must prove that Sarine knew or should have known at the time of filing and maintaining her claim for interim measures to be ordered, or when the order ordering attachment measures was executed, that the patent on which it relied did not meet the material requirements for patent grant and was void, and its act or omission was unlawful or abused its rights.

As the holder of a granted patent, Sarine had the right to oppose an alleged infringement or threatened infringement of her patent rights. She also had the right to enforce the title she had obtained from the attachment judge in Antwerp.

OGI does not show that Sarine abused her rights, or acted as a normally diligent patentee in the same circumstances.

OGI does not prove that Sarine knew or should have known that the BE '912 patent was invalid.

At the time of the filing of the unilateral application and the service and enforcement of the attachment judge's order, no action for annulment of the patent had yet been filed in Belgium. Sarine then argued in the proceedings on the basis of an extensive defense in which it contested the counterclaim for annulment in a substantiated manner. It could, in good faith, err in the scope of its rights.

OGI's claim against Sarine under Article 1382 of the Old Civil Code for unlawful attachment must be rejected as unfounded. There is no basis for ordering publication of the judgment.

H. Court Costs

85. Sarine, who has been unsuccessful, is ordered to pay the costs of the proceedings, including the costs of the counterfeit seizure proceedings, the costs of the expert's examination during the counterfeiting seizure, and the costs of the expert's examination in the proceedings on the merits, settled on the part of OGI at EUR 28,974.51, plus legal interest from today.

In view of the complexity of the dispute, the procedural indemnity is settled at the maximum amount in both instances. Both parties agree on this.

OGI estimates the procedural compensation claimed by it on the basis of the compensation claimed by Sarine, provisionally estimated at EUR 250,000, plus the compensation claimed by OGI itself by way of counterclaim. However, the amount of the procedural indemnity should be determined on the basis of the principal claim. Article 2 of the Royal Decree of 26 October 2007 does not refer to Article 620 Ger.W. so that counterclaims must be disregarded for the calculation of the basis on which the procedural indemnity is estimated (see also Cass. 24 March 2016, C140282N, www.juportal.be).

If the claim contains both a point of dispute that can be valued in money and money, as in this case, the procedural indemnity must be determined on the basis of the point of dispute for which the highest statutory procedural indemnity is owed (Cass., 11 May 2010, Pas., 2010, p. 1471 and www.juportal.be). In this case, the maximum legal indemnity for a claim up to and including EUR 250,000 and the maximum legal indemnity for claims that cannot be valued in money are identical, namely EUR 15,000.

FOR THESE REASONS

THE COURT, adjudicating after contradiction,

Having regard to Article 24 of the Law of 15 June 1935 on the use of languages in court cases;

Declares itself unauthorized to take cognizance of the counterclaim for injunction, publication and compensation of the BV OGI Systems Europe and the company under Israeli law OGI Systems Ltd. against Sarine Technologies Ltd for misleading advertising.

Declares itself competent for the rest.

Satisfying the other principal and counterclaims.

Declares the counterclaim of BV OGI Systems Europe and OGI Systems Ltd. unfounded due to unlawful seizure. Reject them.

Declares the counterclaim of BV OGI Systems Europe and OGI Systems Ltd. for the annulment of claims 1 to 15 of patent no. BE 1,014,912 admissible and partially well founded as determined below.

Explains claims 1 through 7 and 11 up to and including 15 of the Belgian patent no. BE 1,014,912 null and void.

Declares the counterclaim for annulment of claims 8, 9 and 10 of Belgian patent no. BE 1,014,912 to be unfounded.

Declines all requests for help submitted by Sarine Technologies Ltd.

Rejects Sarine Technologies Ltd's request to reopen the debates.

Orders that a copy of the current judgment be communicated by the Registry to the Belgian Intellectual Property Office.

Dismisses the main claim of Sarine Technologies Ltd for infringement of its patent BE 1,014,912, as well as the claim for infringement based on the requests for help it has filed, to be unfounded. Dismiss her.

Declares the counterclaim of BV OGI Systems Europe and OGI Systems Ltd. to lift the prohibition against the BV OGI Systems Europe on handing over, selling or otherwise disposing of objects suspected of counterfeiting, as imposed by the decision of 23 March 2005 of the attachment judge at the court of first instance in Antwerp as a result of the request for attachment regarding counterfeiting.

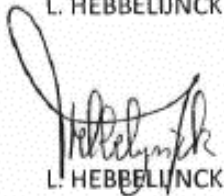
Orders the lifting of this prohibition.

Orders Sarine Technologies Ltd to pay the costs of the proceedings, including the costs of the counterfeiting attachment, the expert examination during the counterfeiting attachment, and the costs of the expert examination on the merits.

Settles these costs on behalf of the BV OGI Systems Europe and OGI Systems Ltd. on 15,000 euros procedural indemnity in first instance and on 15,000 euros procedural indemnity on appeal, and on 28,974.51 euros costs of the expert investigation advanced by BV OGI Systems Europe and OGI Systems Ltd., plus the judicial default interest at the legal interest rate from today.

This judgment was pronounced at the public hearing of May 30, 2023 by:

C. VAN SANTVLIET
H. VANPARYS
W. DAVID
L. HEBBELIJNCK



L. HEBBELIJNCK



H. VANPARYS

Voorzitter
Raadsheer
Raadsheer
Griffier



W. DAVID



C. VAN SANTVLIET