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Utility models: What does "divulged" mean?

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As in some other jurisdictions, under Spanish law so-called “mini-inventions” may be protected by a utility model (called “petty” patents in some countries). The two main differences between a patent and a Spanish utility model are: (i) in the case of utility models, the state of the art includes everything “divulged” in Spain before the priority date, whereas in the case of patents it includes everything “accessible to the public” in Spain before said date; (ii) a utility model meets the inventive activity requirement if the invention “is not very evident” to the person skilled in the art, whereas for patents the law uses the “evident” (as opposed to “very evident”) requirement. If one may borrow the expression coined by the Court of Appeal of Barcelona (Section 15) in its judgment of 26 September 2012, for a lack of inventive activity attack against a utility model to succeed, the invention must be “super-evident.”

So far, so good. The analysis becomes more complicated when one seeks to interpret what “divulged” means. In a controversial judgment of 23 October 1996, the Supreme Court (Administrative Chamber) considered that foreign patents included in the documentary fund of the Spanish Patent and Trademarks Office (“SPTO”) had been “divulged” and, therefore, form part of the state of the art relevant for utility models. However, in a later judgment dated 13 May 2004, the Supreme Court (Administrative Chamber) revisited its position and held that, in contrast to the term “accessible” (i.e. the relevant threshold for patents), the term “divulged” requires a positive act of “divulgation.” Under this light, based on the facts of the case at hand the Supreme Court reached the conclusion that the foreign patents included in the SPTO’s documentary fund that had been invoked to question the validity of the utility model did not form part of the state of the art because they had not been “divulged”. According to the Supreme Court, the inclusion of foreign patents in such documentary fund makes them accessible to the public, but not “divulged.”

Against this background, on 11 November 2011 the Court of Appeal of Madrid (Section 28), which has exclusive jurisdiction to decide appeals against judgments on patent cases from Madrid Commercial Courts, handed down a judgment that brought the debate to the fore again. The Court found a very smart way of not contradicting the judgment of 13 May 2004 by establishing that technological progress has made it possible to “divulge” patents included in the SPTO’s documentary fund which one could not possibly have considered to be “divulged” a few years ago. Therefore, in this case the Court considered that the foreign patents invoked to challenge the validity of the utility model were part of the state of the art.

Time will tell whether or not technological progress has caused “divulged” to mean “accessible”. Until the Civil Chamber of the Supreme Court hands down two judgments shedding light on lower

level Courts, intellectual property owners will run the risk of their utility models being cast adrift.

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