

# Kluwer Patent Blog

## Spanish Supreme Court clarifies that “problem & solution approach” is not legal doctrine

Miquel Montaña (Clifford Chance) · Monday, October 16th, 2017

For many years, Spanish Courts have considered the “problem & solution approach” developed by the European Patent Office (“EPO”) to be a very useful tool for the purpose of trying to make an objective assessment of inventive activity. Unlike in other jurisdictions such as Germany, in Spain this method has become the natural instrument used by the Courts to examine inventive activity. Its use in judicial decisions, including those emanating from the Supreme Court, is so frequent that in a recent case, one of the parties alleged that it had become legal doctrine. In particular, that party, in an appeal filed before the Supreme Court, alleged that in its judgment of 29 December 2014, the Court of Appeal of Navarre had infringed this legal doctrine because it had failed to apply the “problem & solution approach.”

In its recent judgment of 2 October 2017 (*Eli Lilly v. Laboratorios Cinfa et altri*), the Spanish Supreme Court (Civil Chamber) has rejected this view. In particular, the Court has explicitly stated that the “problem & solution approach” is not legal doctrine and that, therefore, for the purpose of analysing inventive activity, Courts need not necessarily apply this method. The Court added that, in any event, the Court of Appeal of Navarre did apply this method in its judgment.

The judgment contains other interesting aspects, such as confirmation that the answer to the third question (Obvious to a person of ordinary skill?) of the method requires a legal assessment rather than an assessment of fact. Also, the judgment appears to accept that an expert with experience in the technical field of the invention is better placed to illustrate whether or not the invention would have been obvious to the hypothetical person skilled in the art, than other experts with no experience. This line of reasoning, if followed in future cases, will align the case law of the Spanish Supreme Court with the case law of other European jurisdictions, such as the UK.

All in all, the main teaching of this judgment is that although the “problem & solution approach” is a very valuable method, other methodologies may be used.

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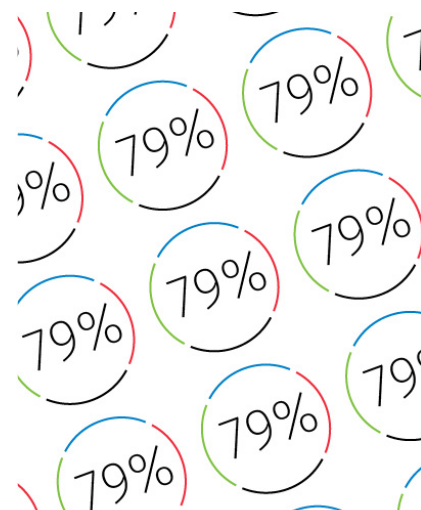
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