

Barcelona Court rejects nullity attack based on “AgrEvo”

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As readers know well, AgrEvo (T 939/92) is a landmark case in the history of European patent law. In this case, an EPO’s Board of Appeal found the patent to meet the “sufficiency” requirement because all the compounds could be made. On the contrary, it found the patent to lack inventive step. The reason was that the description did not make it plausible that all the compounds claimed would have herbicidal properties. Since then, the debate around “plausibility” has become a popular theme in appeals filed before the EPO’s Boards of Appeals.

In a recent case, Jushi Group filed a revocation action against a patent owned by a subsidiary of Owens Corning alleging, among other grounds, lack of inventive step. In particular, it alleged that the technical effect mentioned in the patent was not credible.

In its judgment of 12 September 2017, Barcelona Commercial Court number 4 rejected the nullity attack on two grounds. First, the Court considered that the complainant had not followed the “problem-solution approach” or a similar method that may allow the Court to subject its arguments to judicial scrutiny. In particular, the Court highlighted that:

“Both this Patents Section and Section 15 of the Barcelona Court of Appeal have already criticised this kind of omission as this systematic failure prevents us from exercising judicial control over the requirement of inventive step, via any of the three conventionally accepted methods and, moreover, it points to the conclusion that the disputed patent meets the requirement of inventive step. Its validity is

assumed and it is the party that questions it, be it due to novelty or lack of inventive step, that bears the burden of proving (correctly) that said patentability requirements are not met. Thus, the Judgment of 12 November 2010 of Section 15 of the Barcelona Court of Appeal:

"It is worth noting that it is one method [the problem-solution approach], but not the only one, and as such others can be used, but in any event we must demand a minimum of analysis assessing the closest state of the art, the technical problem that is sought to be solved and whether the proposed solution would have been obvious for a person skilled in the art. Neither the counterclaim or the expert opinion on which it is based do this; they fail to offer any assessment of the possible obviousness of the solution in question, and this defect cannot be remedied in the appeal."

Second, the Court highlighted that unlike during prosecution, where the applicant has the burden of proof, once the patent has already been granted, the burden of proving that the relevant compounds do not have the alleged technical effect lies with the party who has filed the revocation action.

All in all, the teaching of this judgment, if it becomes final, will be clear: if you embark into AgrEvo, make sure that you are able to prove.