

## If you get the technical problem wrong, you may have a problem

Kluwer Patent Blog  
April 9, 2018

Miquel Montañá (Clifford Chance)

Please refer to this post as: Miquel Montañá, 'If you get the technical problem wrong, you may have a problem', Kluwer Patent Blog, April 9, 2018, <http://patentblog.kluweriplaw.com/2018/04/09/get-technical-problem-wrong-may-problem/>

In one of the saga of cases that involved *Société des Produits Nestlé* and companies that are trying to market capsules compatible with Nescafé's Dolce Gusto system, the defendant alleged, among other arguments, that some of the patents asserted were null due to a lack of inventive step. The case was handled by Commercial Court number 5 of Barcelona which, following a long-standing Spanish tradition, decided to examine inventive activity following the "problem and solution approach" traditionally applied by the European Patent Office ("EPO"). Although Spanish Courts have highlighted in several cases that following this method is of course not compulsory, they find some comfort relying on a conceptual framework that allows them to make a more principled assessment of the technical arguments asserted by the parties.

As readers will no doubt be aware, this method requires identifying the "closest prior art", defining the "objective technical problem", and assessing whether the solution (i.e. the invention) would have been obvious to one of ordinary skill. This case provides a good illustration of the importance of getting the definition of the "objective technical problem" right. According to the expert used by the defendant, the technical problem that the patent was seeking to resolve was "to avoid that the user needs to mount or assemble the capsule and collector part 9, or avoid them being separated accidentally because these parts are already assembled at the factory. The solution to this problem, which involves adhering or joining the capsule to collector part 9, is obvious not just for a person skilled in the art, but for any average technician or for a person without technical knowledge, with just common sense".

In contrast, the Judge considered that:

"Contrary to what the defendant and expert Esteban allege, the fact is that the technical problem to be resolved is described in the patent itself (column 1, lines 17 to 25 and lines 62 to 68 and column 2, lines 1 to 3: *The problem with this cartridge is that the beverage extracted using the cartridge passes over this mounting and via means of channelling, which means that it is difficult, if not impossible, for reasons of contamination and taste, to contemplate the extraction with this system of cartridges containing substances other than roast ground coffee, due to the residue of the drink present on the mounting. [...] One of the principles of this invention rests on the fact that the capsule contains its own means of opening, activated by the increase in the pressure of the fluid introduced into the capsule at the moment of extraction. Another principle of the invention rests on the fact that the capsule has its own exit route with its own means of channelling that make it possible to avoid, or at least considerably reduce, contact with the elements of the system or the extraction device.* Therefore, the objective technical problem is the one offered by the patent itself: avoiding contact between the beverage and the machine, which makes it possible to use a single machine to prepare different beverages."

This led the Judge to the conclusion that "As the definition of the technical problem to be resolved is erroneous, we do not consider it necessary enter into the analysis of the other aspects or steps of the "problem-solution" method, that is, the determination of the state of the art and obviousness."

The teaching of this rather bold conclusion is clear: if you get the technical problem wrong, you may have a problem.