

## Beware of “added matter” in Spain

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On 13 April 2018, the Barcelona Court of Appeal (Section 15) wrote a decision highly illustrative of the challenges that an “added matter” objection may raise in Spain, particularly in the context of preliminary injunction proceedings. The decision confirmed a ruling of 18 July 2017 from Barcelona Commercial Court number 4, which had lifted a preliminary injunction ordered against a manufacturer of generic medicaments, for considering that the patent was unlikely to overcome an “added matter” objection in the main proceedings.

The first question addressed by the Barcelona Court of Appeal (Section 15) was to what extent “nullity” may be raised as a defence in preliminary injunction proceedings, where life is very short. The Court reiterated, citing the case law stemming from its decisions of 4 January 2006 (amlodipine), that in the context of preliminary injunction proceedings the validity of a patent cannot be examined in depth. The patent will be deemed to be valid unless the defendant alleges “very clear and evident indicia” supporting nullity. After clarifying that the burden of proving these “very clear and evident indicia” lies with the defendant, the Court examined whether or not the arguments alleged to found the “added matter” objection in the case at hand were sufficiently robust as to lift the preliminary injunction, as the Court of First Instance had done.

In this regard, the Court wrote that “we cannot rule out that the allegation of added matter can be, at least in line of principle, a good reason to justify the assessment of nullity in the context of preliminary injunction proceedings, to the extent that its examination could raise issues less complex than those typical of patent law, such as the examination of novelty or inventive step” (paragraphs 12 to 17). It is fair to say that examining “added matter” is probably less complex than examining inventive step and, perhaps, novelty (although the “test” applied is normally similar) in the sense that it “only” requires comparing the claim with one document (i.e. the application as filed). However, as readers familiar with discussing “added matter” before the EPO’s Board of Appeal may attest, the examination of “added matter” is one of the most “technical” and, therefore, difficult aspects of patent law, in part due to the diversity of criteria and thresholds applied by various Boards of Appeal.

The case reported in this blog is a good example of this complexity. The Court of Appeal found that the specific grounds on which the Court of First Instance had founded the “added matter” objection were too complex to be discussed within the narrow contours of preliminary injunction proceedings. However, the Court of Appeal, following a precedent from the Munich Regional Court in a parallel case, came to the conclusion that there was a less complex argument that also led to the conclusion that the patent had an “added matter” problem. So, in the end, the Court confirmed the first instance decision that had lifted the preliminary injunction.

The teaching from this decision is clear: patentees should be aware of the risks raised by “added matter”, a relatively new actress on the Spanish litigation scene.