

# A word of warning for patent revocation seafarers: if you do not set the first stone of the “problem-solution” approach correctly, you may sink

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On 28 December 2020, the Barcelona Court of Appeal (Section 15), one of Spain's most experienced courts on patent matters, handed down a judgment which is interesting from a wide array of perspectives (how to assess inventive step, novelty, infringement, etc.). This blog will focus on the first aspect (i.e. inventive step) and, more specifically, on the dangers of combating inventive step applying the “problem-solution” approach if the court ultimately finds that the first step of that method has not been correctly addressed. The facts of the case can be summarized as follows:

The claimants, a French manufacturer of automotive parts and its Spanish subsidiary, were the holder and licensee of the Spanish validations of European patents EP 764.811 (“EP ’811”) and EP 933.254 (“EP ’254”), which protect vehicle lighting or signaling devices having specific features. They filed a patent infringement action against the defendant, a Spanish supplier of spare auto parts, which had sold spare headlamps and signal lights for cars that allegedly infringed the claimants’ patents. By way of counterclaim, the defendant filed a revocation action against various claims of the patents in suit, namely Claims 1-6 of EP ’811 and Claims 1 and 18 and their respective dependent claims of EP ’254. In a judgment dated 6 March 2019, Barcelona Commercial Court No. 1 dismissed the infringement action and partially upheld the revocation counterclaim, revoking certain claims of EP ’254 on grounds of lack of novelty. However, the Court confirmed the validity (in particular, inventive step) of patent EP ’811. The claimants lodged an appeal before the Barcelona Court of Appeal. They argued that the defendant’s spare parts did indeed infringe Claim 1 of EP ’811 and disagreed with the first instance decision’s finding on the novelty requirement. The defendant, in turn, lodged a cross-appeal, disagreeing with the first instance findings on the validity (in particular, inventive step, of EP ’811).

With regard to the topic of this blog (inventive step), in the judgment of 28 December 2020, the Barcelona Court of Appeal (Section 15) noted that Claim 1 of patent EP ’811 could be defined by the following technical elements: C1.- Apparatus for lighting, indicating or signalling purposes in a motor vehicle, C2. - Including a ventilating device which consists of first ventilating means carried by a housing (100) of the unit, in combination with second ventilating means carried by a cover member, (200) mounted on the housing of the unit, C3.- So as to define together a sinuous path to the interior of the unit comprising a double air inlet in a lower part of the ventilating device, C4.- The sinuous ventilation path is defined partly by the housing or body of the apparatus and partly by a cover member which is carried on this housing or body, C5.- The double air inlet in a lower part of the ventilating device comprising two inlet apertures facing each other (216a, 216b), C6.- Together with an inlet passage (T1) which extends substantially transversely to the general direction defined from one said air inlet aperture to the other. C7.- The sinuous ventilation path constitutes a labyrinth comprising two chicanes giving two changes of direction (T1, T2, T3). C8.- The two changes of direction extend substantially upwards from the double air inlet, C9.- A passage of communication (T3, 1201) between the labyrinth and the interior of the unit C10. The passage being defined at least partially between lugs (210a, 210b) by which the cover member is fitted resiliently on the housing.

According to the defendant, the only difference between Claim 1 and the document asserted as the “closest prior art” (patent application WO 95/02783, “WO ’783”) was C10. Therefore, the defendant defined the “objective technical problem” taking into account this difference only. In contrast, the patent owner alleged that, in addition to C10, WO ’783 did not disclose characteristics C3 or C5-C9 either. This opinion was shared by the Court of Appeal, which highlighted that one could only read characteristics C3 and C5-C9 assessing WO ’783 with hindsight. In this regard, in paragraph 19 of the section of the judgment dealing with inventive step, the Court noted that:

*“19. In order for a document on the state of the art to disclose these characteristics, it must describe them, directly and unambiguously, so that a person skilled in the art who reads such documents on the application (or priority) date, with the necessary common general knowledge but without knowing the patented technical solution, could recognize those technical teachings. The skilled person should not seek in the state of the art the solution claimed, but seek there the solution that was offered at that time for the technical problem that the invention solves, so as to compare it to the one claimed. The skilled person, who the courts build, necessarily knows the claimed technical solution; but in analyzing the prior art and comparing it with the claim at issue, he must be able to justify the identification of the elements of the claim challenged in the teachings of the document itself, not in the teachings of the patent at issue. In other words, the skilled person must justify his arguments on prior art; otherwise, he would be making an ex post facto judgment and not analyzing what was known before the application (or priority) date.”*

Building upon this premise, the Court arrived at the conclusion that, having failed to correctly establish the differences between claim 1 and the document alleged as the “closest prior art” by the party seeking the revocation of the patent, caused the inventive step attack to fail, making it unnecessary to consider the subsequent steps of the “problem-solution” approach. In particular, in paragraph 32 of the section addressing inventive step, the Court reached the following conclusion:

*“32. Consequently, the differences between D1 and the claim at issue are not limited to C10, not even to C5, but comprise technical characteristics C3 and C5 to C10. Therefore, we can no longer share the first step of the method followed by the defendant to assess the lack of inventive step. If we cannot start from that first stage in the application of the method followed to analyze inventiveness, we will also not be able to share its conclusions. Which leads us to the rejection of that claim of invalidity, without having to look at the following reasoning.”*

All in all, this very interesting judgment contains a clear word of warning for patent revocation seafarers: if you do not set the first stone of the “problem-solution” approach in a way that the Court finds to be correct, you may sink.