

Kluwer Patent Blog

Barcelona Patent Court judgment on claims comprising technical and non-technical features

Miquel Montaña (Clifford Chance) · Thursday, November 24th, 2022

The judgment of 17 October 2022 recently handed down by the Patents Section of Barcelona Commercial Court of First Instance no. 4 is most interesting, for a variety of reasons.

First, because the hearing of the case lasted for five days (2-5 May and 15 June), a length which is rather unusual in Spanish patent litigation, where hearings normally last for one or two days at the most. Second, because the case dealt with two tech patents, an area where case law is still relatively scarce in Spain. And third, because of the number of interesting legal issues raised by the case (scope of protection, claims allegedly comprising technical and non-technical features, novelty, inventive, step, added matter, etc).

In this blog, we will briefly discuss one of the issues raised (claims comprising technical and non-technical features), a topic on which there is a dearth of case law in Spain. The facts of the case can be summarised as follows:

A U.S. company filed a patent infringement action against a Spanish company, alleging the infringement of two European patents: EP 2.278.775 (EP ‘775) and EP 2.323.333 (EP ‘333). For the purpose of this blog, it will be sufficient to reproduce claim 1 of EP ‘775:

“1. A computer-implemented method for playing a media stream, the method comprising, on a client computer:

- *displaying a list of user-selectable media streams available for playing, wherein the list is obtained via a communications network from a source remote from the client computer;*
- *detecting a selection of a media stream from the displayed list of user-selectable media streams; and*
- *in response to detecting the selection of the selected media stream:*
 - *transmitting to a server information that enables remote logging of information related to the selection;*
 - *requesting delivery of the selected media stream to the client computer,*
 - *receiving the selected media stream via a communications network;*
 - *transmitting to a server information related to delivery of the selected media stream to the client computer*

so as to enable remote logging of information related to delivery of the selected

media stream to the client computer; and

- *playing the selected media stream at the client computer.*“

The defendant challenged the validity of the two patents, alleging: lack of novelty, inventive step, added matter and lack of technical contribution. In relation to the latter aspect, the defendant alleged that the only feature that distinguished EP ‘775 from the prior art would be that it includes a transmission stage to a server and its possible registration of information on the selection and delivery of the media stream. Following up on this argument, the defendant added that EP ‘775 did not contribute in any way to improving the techniques for streaming or transmitting an existing media stream, nor improving the transmission of information between client and server. According to the judgment, the defendant added that *“the patent simply provides abstract and vague ideas that could define any known audio or video streaming system, and is limited to including a stage which simply involves the transmission of information on the delivery of the selected content (media stream) from the client’s computer to the information server. This stage does not make any technical contribution, as it does not improve any technical aspect of the streaming or envisage any application of the information (about the delivery of the selected content) transmitted to the server for the solution of a technical problem.”* In view of this, according to the judgment, the defendant concluded that the claims *“are devoid of technical content because they lack any teaching on how to modify or create a state of affairs with the use of forces of nature or other means of a technical nature“*. In a nutshell, the defendant alleged that the claims only contain vague and abstract ideas that would be comparable to *“schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers”* mentioned in Article 52 of the European Patent Convention (“EPC”). Based on these arguments, the defendant requested the revocation of the patent, relying on Article 138.1 a) of the EPC (non-patentable subject matter).

The Court rejected this line of argument, relying on the case law from the EPO’s Technical Boards of Appeal (“TBAs”), as codified in the EPO’s Guidelines for Examination, on claims comprising technical and non-technical features. The following paragraphs best encapsulate the line of thinking that led the Court to reject that nullity ground:

“3.4 We cannot take a single characteristic of a claim and consider it in isolation in order to maintain that such claim is null and void because it is not of a technical nature. And, far less, starting from that single characteristic, consider that the whole patent (which has forty claims) is null and void for the same reason. Nor can we consider that the aforementioned characteristic is a cluster of abstract and vague ideas and consider them the same as the schemes, rules and methods of art. 52(c) EPC.

3.5 And we say that we cannot do it, because it openly contradicts the doctrine set forth by the EPO in its Guidelines and in its Case Law. We will move on to expose the doctrine that entails the rejection of this first nullity ground.

3.6 The concept of invention for the EPO and its relationship with art. 52 EPC, is set out by the Guidelines (Part G – Chapter II-1 and 2, Edition 2022) as follows: [...]”

After reciting the relevant part of the Guidelines, the Court came to the conclusion that since, in the Court’s opinion, claim 1 comprised both technical and non-technical features, it did not fall within Article 138.1 a) of the EPC. A similar invalidity argument directed against the second patent (EP

'333) was likewise rejected for similar reasons.

No doubt, this judgment will be the source of additional blogs since, as mentioned at the outset, the case is of interest from many different angles. In the meantime, the opinion of the Barcelona Court of Appeal will be eagerly awaited.

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