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Supreme Court sheds light on "implicit" disclosure

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On 13 June 2001, the Supreme Court published a judgment dated 27 April 2011 by virtue of which the Court rejected an appeal against the judgment of 17 March 2008 from the Barcelona Court of Appeal (Section 15), whereby this Court had confirmed the novelty of calcium atorvastatin, protected in patent EP 409,281. The claimant had filed a revocation action alleging that this compound was implicitly disclosed in a prior document, which allegedly disclosed atorvastatin in a list of possible compounds and calcium in a list of possible salts. According to the claimant, according to the "2-list principle" enshrined in Decision T 12/81 from EPO's Boards of Appeal, calcium atorvastatin would have been implicitly disclosed in the prior document. The patentee relied on Decision T 12/81 to reach the opposite conclusion, alleging that the selection of calcium atorvastatin would have required making two selections from two lists of some length, which was ultimately the conclusion reached by the Barcelona Court of Appeal (Section 15).

In the recently published judgment, the Supreme Court has highlighted that legal certainty requires, for the purpose of destroying the novelty of a subsequent invention, that even an implicit disclosure must disclose the invention "clearly, directly and unequivocally". The judgment has shed some light on the concept of "implicit" disclosure, on which there was a dearth of case law in Spain to date.

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