

Kluwer Patent Blog

An expert must be an expert

Miquel Montaña (Clifford Chance) · Thursday, March 20th, 2014

On 22 October 2013 the Provincial Court of Barcelona (Section 15) handed down a controversial judgment revoking a patent due to lack of inventive activity relying on a technical report prepared by an expert acknowledged not to be an expert in the technical field of the invention. According to the judgment “[...] for an expert to be able to provide the point of view of the person skilled in the art – necessary in this case to assess the inventive activity -, it is not essential for the expert to be an expert but that, due to his training and experience, he is capable of putting himself in the position of the «person skilled in the art».”

This point of view is at odds with the conclusion reached by the Supreme Court in another case and, more recently, by the Court of Appeal of Navarre in its very recent judgment of 11 February 2014, whereby this Court reversed a judgment of 5 July 2012 from the Commercial Court of Pamplona which had revoked another patent due to lack of inventive activity. The Judge relied on the opinion of another expert who was not an expert in the technical field of the patent at hand either. After noting that the expert was not really an expert, the Judge concluded that “In spite of the above observations, one may say that, with the limitations of this lack of expertise, the statements of Mr. X are not devoid of logic.”

In the aforementioned judgment of 11 February 2014 the Court of Appeal of Navarre disagreed with this point of view on the following grounds:

“The appealed judgment takes as a reference, to reach its logical inference regarding the non-existence of inventive step, the criteria of a person who is not skilled in the art. It accepts the criteria set forth in the expert report submitted by the plaintiff, despite the fact that, as the judgment itself indicates, the person is “not an expert in pain relief therapy” but instead a chemical engineer and expert in patents.

The appellant submitted not one (as incorrectly indicated in the appealed judgment) but two expert reports on the questioned inventive step. The first was written by a person who can indeed be considered a person skilled in the art (professor of pharmacology, “expert in analgesia” according to the judgment), but whose impartiality was challenged by the opposing party, leading to the judgment assessing said expert report “with due precaution”. The second was issued by a doctor in biochemistry, specialised in patents, who cannot be considered an expert in analgesics either. Both concluded that inventive step did exist in the examined patent.

Therefore there is no expert report in the proceedings that includes the criteria of a true person skilled in the art (an expert in combinative analgesia) whose impartiality has not been

questioned and that indicates the reasons which, once sieved using the rules of logic and experience, may infer that in fact, said expert, on the patent's priority date, confronted with the technical problem of obtaining a combination such as tramadol and paracetamol to be administered orally that maintains its analgesic effects but with a decrease in side effects, would have obviously or evidently reached the solution included in the invention patented by the appellant.

And the burden of proving this corresponded to the plaintiff (Article 217.2 of the Spanish Civil Procedure Act), who failed to do so, since its expert report did not provide the criteria of a true person skilled in the art, which would have been sufficient to uphold the appeal.”

In view of the conflicting views expressed by the Court of Appeal of Barcelona and the Court of Appeal of Navarre in the two judgments discussed, it will be for the Supreme Court to confirm whether or not, as already announced in a judgment of 8 April 2013, the expert must be an expert. The judgment of 22 October 2013 is not final and, therefore, there is a possibility that it may end-up having the same fate as the judgment of 5 July 2012 now revoked.

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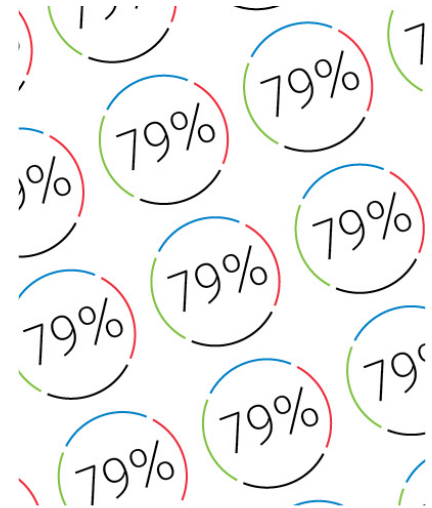
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