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Spanish Supreme Court draws the fine line between factual and legal assessments in the context of inventive step

Miquel Montañá (Clifford Chance) · Monday, January 25th, 2016

As readers well know, according to article 56 of the European Patent Convention "an invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art." In practice, the application of this article requires factual and legal assessments and it is not always easy to determine where the fine line between the two types of assessment lies. A judgment from the Spanish Supreme Court dated 18 June 2015 sought to shed some light on where this line should be drawn.

The judgment stemmed from an "appeal for breach of process" where the appealing party had argued that, for the purpose of examining inventive activity, the lower level Court had made an assessment of evidence that was illogical, absurd and arbitrary. The Supreme Court rejected this appeal on the following grounds:

> "*The grounds for this decision refer to the assessment of the expert evidence which provides technical information allowing the court to determine whether, when analysing novelty, the invention was envisaged, and in the case of inventive step, whether the invention was obvious to a person skilled in the art, based on his knowledge and the state of the art on the priority date. This consists of a legal assessment.*
>
> *As was already established in Judgment 182/2015 handed down on 14 April (RJ 2015, 2692), if the assessment of the evidence referred to the elements comprising part of the state of the art and its contents, then it could have been subject to the extraordinary appeal for breach of process, provided that the prerequisites established by this Court had been met.*
>
> *The identification of the elements comprising the state of art and its contents are not being challenged in the case at hand, but rather the judgment of obviousness in light of such state of the art and, to a lesser extent, if the disclosures the existence of which are not discussed anticipated the invention. Given its nature as a legal assessment, the extraordinary appeal for breach of process does not apply to the case at hand.*"

Interestingly, after having rejected the "appeal for breach of process", the Supreme Court upheld an "appeal for breach of law" (i.e. "cassational appeal") filed by the same party in the same writ, considering that the lower level Court had applied a wrong legal test for the purpose of examining whether or not the invention would have been obvious to a person skilled in the art. In particular, based on the evidence on record, the Court found that a person skilled in the art would have tried

the solution proposed by the patent because on the priority date there were clinical trials involving some 4,200 people almost completed and, therefore, according to the Court, the skilled person would have had a reasonable expectation of success.

This judgment, which follows the path of a previous judgment of 14 April 2015, is likely to make it easier for the Supreme Court to take "cassational appeals" based on a wrong assessment of inventive step.

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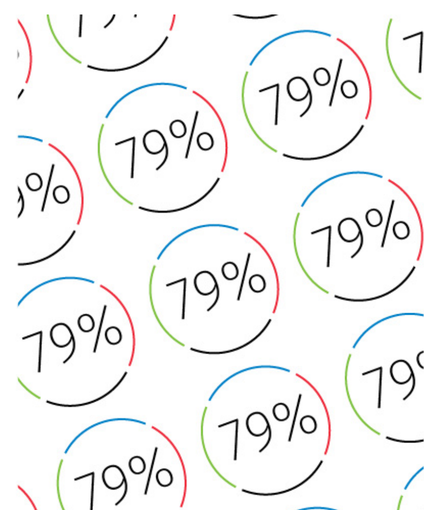

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