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The “problem and solution approach” is here to stay

Miquel Montaña (Clifford Chance) · Sunday, August 21st, 2016

One of the possible methods to examine inventive activity is what is known as the “problem and solution approach” usually applied by the European Patent Office (“EPO”). Spanish Courts like this methodology, as it allows the Judge to subject the opinions expressed by the experts to an objective test. For example, in a judgment of 3 October 2011, the Madrid Court of Appeal (Section 28) disregarded the opinion of one of the experts because he had made a retrospective assessment of inventive activity instead of following the “problem and solution approach”, which normally results in a more objective examination.

The three Judges who form the Patent Court of Barcelona have recently followed a similar line in a decision of 28 July 2016, where they dismissed an opposition based on the alleged lack of inventive activity of the patent at hand filed against a previous decision of 20 January 2016 which had ordered an “ex parte” preliminary injunction. Likewise, in the judgment of 20 May 2016, briefly discussed in our previous blog, the Supreme Court sought to apply the “problem and solution approach” to examine the inventive activity of the patent discussed in that case. One of the positive aspects of this judgment is that it clarified that when assessing inventive activity, the interpreter may only combine different documents if the combination was suggested by the prior art or would have been obvious to the person skilled in the art. In particular, the Supreme Court noted that: *“For this reason we believe it appropriate to make the clarification suggested by the appellant according to which, in the assessment of inventive activity, the specific combination of documents must be suggested by the state of the art or be obvious to a person skilled in the art”*.

Although this might sound trite to readers familiar with the practice of the EPO, in the past it has not always been clear in the mind of some Spanish Courts that retrospective “mosaics” are not a fair way of making justice for an invention that might look obvious retrospectively once you are given all the pieces needed to form the “mosaic.”

After all, the “problem and solution approach” was developed to try to encourage a more objective examination. This recent decision confirms that in Spain the “problem and solution approach” is here to stay.

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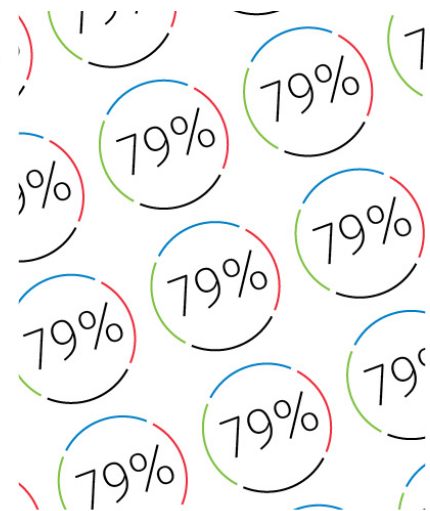
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