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Inventive activity: Spanish Supreme Court confirms that documents may only be combined when such combination is suggested or obvious

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Although the title of this blog will sound trite to many friends accustomed to arguing patent cases before the European Patent Office, it does not sound so trite when read against the background of Spanish case law. For years it was relatively rare for the Spanish Supreme Court to accept appeals in patent matters, which prevented the Court from developing case law that could enlighten the path of lower level Courts. This changed a few years ago, when the Supreme Court, in part due to the arrival of new Judges, identified the need to develop clear and updated case law on patent cases.

This explains, for example, that it was not until a judgment handed down on 20 May of 2016 that the Supreme Court declared that when examining inventive activity, one may only combine different documents if it is shown that the combination was suggested by the prior art or that for a person of ordinary skill it would have been obvious to combine such documents. This line of interpretation has now been confirmed in a recent judgment of 18 May 2017, which will result in this doctrine technically becoming case law (i.e. two judgments in the same direction). In particular, in this recent case the Supreme Court reached the following conclusion:

"*According to Article 4.1 of the Spanish Patent Act (Ley de Patentes, "LP"), "Inventions which are susceptible of industrial application, which are new and which involve an inventive step shall be patentable". Thus, the lack of inventive step justifies the invalidity of the patent [Article 112.1.c) LP]. Article 8.1 LP, which corresponds to Article 56 of the European Patent Convention (EPC), states that "An invention shall be regarded as involving an inventive step when it does not result from the state of the art in a manner obvious to a person skilled in the art".*

"The criteria for judging this requirement is if the person skilled in the art, starting from what has been described above (state of the art) and depending on such person's own knowledge, is able to obtain the same result in an obvious manner, without applying his or her talent, in which case inventive step is lacking. As the European Patent Office's Board of Appeal claims: "in order to (judge) inventive step, the proper criteria to apply is not whether the subject matter claimed would have been obvious to an inventive person, besides the inventor him or herself, but if it would have been obvious to a competent but unimaginative person who still meets the criteria for being considered a person skilled in the art" (T 39/93, OJ 1997, 134)".

It is true that in the above-mentioned judgments 182/2015, of 14 April, and 325/2015, of 18 June,

we also stated as follows:

"When analysing whether or not an invention is obvious, a person skilled in the art does not consider the precedent documents or background information in isolation -as should however be done in the case of novelty-, but instead he or she combines them in order to determine, from them as a whole, whether there is sufficient information that would allow him or her to assert whether a skilled person would have reached the same conclusions without having needed the information disclosed by the inventor".

But as we later clarify, in judgment 334/2016, of 20 May, "this latter reference made to the combination of precedent documents or background information when judging obviousness is still only generic wording, the only aim of which is to inform that said combination is possible, in contrast to a judgment on novelty, which is not possible in any case. But logically, the appropriateness of any particular combination is subject to noticing that it was suggested or was clear to a person skilled in the art. This notwithstanding the fact that determining which specific pieces of background information, when combined, show that the invention was obvious to an ordinary skilled person with his or her knowledge at the priority date, is often intrinsic to the judgment of obviousness".

All in all, this recent judgment is yet another example of the extraordinary progress made by Spanish Judges over the last few years to align their case law to the standards of other European jurisdictions with more experience in patent matters.

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