

# Kluwer Patent Blog

## Supreme Court Spain warns against superficial inventive step analysis

Miquel Montaña (Clifford Chance) · Tuesday, June 27th, 2017

No doubt, one of the patentability requirements which is more difficult to examine is inventive step. Unlike other requirements, which call for a more objective analysis, inventive activity requires a subjective judgment, that is, whether the invention would have been obvious to a person skilled in the art. Taking into account that, inevitably, inventive activity must be examined after having gained knowledge of the invention, usually it is possible to show “*ex post facto*” how one could have arrived at the invention. For this purpose, a retrospective mosaic of a few documents of the prior art will normally do the trick.

A judgment of 3 May 2017 from the Supreme Court has sent a message of caution against this type of analysis, both in the context of novelty and in the field of inventive activity. In particular, the Supreme Court has revoked a judgment of 27 May 2014 handed down by the Court of Appeal of Murcia, which had found that patent EP 1.380.513 B1 did not fulfil the novelty and inventive activity requirements.

As regards novelty, the Supreme Court recalled something which may sound trite to patent *aficionados*, which is that for the purpose of examining novelty, only one document at a time may be considered (i.e. documents cannot be “combined”).

Moving on to inventive activity, in the appeal, the patent owner had alleged that the second instance judgment breached the case law of the Supreme Court, as it had not applied the “problem and solution approach”, which is the method normally used by the Supreme Court to examine inventive activity. In this regard, the Court noted that this is only one of the possible methods for examining inventive activity. Other methods may be used, provided that “the decisive factors” are taken into account. According to the Court, the second instance judgment did take into account such factors. It placed the invention in the context of the state of the art and it identified the problem to be solved. However, the Court considered that the judgment erred when applying the last part of the method, that is, the “obviousness” judgment. In particular, the Supreme Court reached the following conclusion:

*“The appealed judgment does not justify why, for a person skilled in the art, starting from a state of the art in which the insulation of the raw edge with respect to the conserving liquid inside the can (so as to prevent its corrosion) is obtained by means of a double seal (EP 957 and EP 268), another alternative solution consisting of filling the groove with the plastic coating of the lamina, should have been obvious.*”

*It is true that the expert, Mr Alberto, when referring to the workings called into question which do not use the double seal system, noticed that “since the interior coating of the cover is made of a plastic material, upon being closed, it is logical to think that the plastic material flows and fills the perimetric groove, since it deforms during the closing process”. But if we take into account that in the closest prior art (EP 957 and EP 268), the double seal system used precisely prevented this filling from occurring, it should not have been so obvious that the double seal could be substituted by the system taught in ES 219. It is true that EP 268 already used a stratified lamina with an internal plastic layer, but achieving the effect of obtaining the filling of the perimetric groove by heat-welding was not the aim of this, since the double seal prevented it.*

*Although the solution of the filling of the groove with the plastic coating is simple, it should not be considered obvious to a skilled person for this reason; otherwise we may fall into making an ex post facto judgment. There is no evidence that the teaching contained in invention Claim 1 of ES 219 was obvious to a person skilled in the art, and the closest precedents, when choosing the double seal, were not conducive to the skilled person realising that he/she could choose to use the solution proposed by ES 219. As we recall in judgment 182/2015, of 14 April, “it does not suffice that the person skilled in the art could have chosen to use the solution proposed by the patent’s applicant, but instead, such skilled person must actually have made such choice”. In our case, in view of the precedents indicated, an ordinary skilled person lacking inventiveness would not have chosen to substitute the double seal for the filling of the perimetric groove, regardless of how simple this solution seems now.”*

In short, the message that transpires from this interesting judgment is that the interpreter should be wary of the risks inherent to “*ex post facto*” inventive activity analyses.

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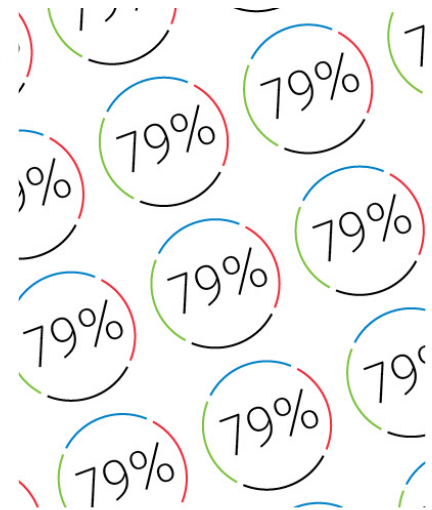
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