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Alimta® – The Spanish angle: English Supreme Court clarifies Spanish doctrine of equivalents

Miquel Montaña (Clifford Chance) · Wednesday, July 12th, 2017

When this author published his blog of 27 June 2017, a reader kindly sent in a comment pointing out that as this author had not inserted the word “Spanish” before “Supreme Court”, and the blog was written in English, the reader had been misled; he initially thought that the judgment discussed had been issued by the U.S. Supreme Court. Being based in Spain, that day this author felt that it should be natural for readers to assume that the “Supreme Court” mentioned in the blog’s heading was the “Spanish” Supreme Court.

This author was totally wrong, for this morning the English Supreme Court has demonstrated that a judgment interpreting Spanish patent law does not necessarily have to come from the Spanish Supreme Court. No doubt readers will be familiar with the background of the *Alimta*® case, as it has been discussed extensively during the last few years. It will suffice to recall that the case stemmed from a complaint filed by Actavis against Eli Lilly in England seeking a declaration of non-infringement affecting not only England but also France, Italy and Spain. The English Court of First Instance accepted jurisdiction and this point was not appealed by the defendant. As a result, in the subsequent instances the Courts had to decide on the merits of the case applying English, French, Italian and Spanish law respectively. Of course, a huge number of legal opinions from learned academic authorities from each of these four jurisdictions stretched the case file.

As mentioned at the beginning of this blog post, this morning the English Supreme Court published a ground-breaking judgment, the conclusion of which had already been announced last Friday. In a nutshell, it has fine-tuned the rusty test that the English Courts had devised in *Catnic*, which had been imported to Spain some years later by the Barcelona Court of Appeal (Section 15), whose conclusions were endorsed by the Spanish Supreme Court. The leading authority was the judgment of 10 May 2011 from the Spanish Supreme Court (*en banc*) on *Olanzapine*.

From a Spanish perspective, the most interesting parts of today’s judgment are paragraphs 49-50 and paragraphs 97-101. In particular, at paragraph 97 the Court wrote that:

“So far as Spanish law is concerned, it is common ground that the Spanish courts have followed the United Kingdom approach, which leads to the difficult question whether one should assume that they would follow this decision in modifying the Improver questions and in particular the second question. I incline to the view that judicial comity would tend to suggest that the Spanish courts would follow this court in modifying the Improver questions, not least because this appears to render the UK courts and therefore the Spanish courts more consistent with the German and

Dutch courts, and no more inconsistent with the French and Italian courts.”

In short, the Court applied an argument based both on logic and comity: if the *Improver* questions had been “imported” by the Spanish Supreme Court, it would appear to be illogical to assume that the Spanish Courts would not also follow the now fine-tuned version of the questions. In other words, it would not be logical to assume that Spanish Courts would stick to the old English law now that it has been amended by the English Supreme Court.

As explained at paragraphs 98-101, after the draft judgment was circulated to the parties, Actavis sought to persuade the Court to follow a different course of action, alleging that in a more recent judgment (*Lundbeck*) the Spanish Supreme Court had applied a test that would supposedly be different to the one applied in *Olanzapine*. It is fair to say that, although the wording of the test applied in this new case was not totally identical, in essence it was the same test. In addition, now that the English Supreme Court has modified these questions, as noted by the Court itself, it would be a little odd for the Spanish Supreme Court not to follow suit, especially taking into account that, as hinted at in this morning’s judgment, one of the reasons for fine-tuning the old *Improver* questions was the need to harmonise the doctrine of equivalents in Europe.

All in all, a desirable co-lateral effect of this morning’s judgment is that it will hopefully contribute to aligning the doctrine of equivalents throughout Europe, something that the countries that negotiated EPC 2000 were not able to do.

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