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Spanish Supreme Court confirms that “ex post facto” mosaics will not do the trick

Miquel Montaña (Clifford Chance) · Monday, September 18th, 2017

When analysing inventive activity, one risk that appears to be here to stay is that of hindsight. As Richard Ebbink very aptly put it in a workshop held at the INGRES Institute in Zurich on 8 and 9 September 2017 in honour of Dr. Dieter Brändle – the first President of the Swiss Federal Patent Court, who will step down at the end of this year – “Hindsight is like original sin: it is impossible to get rid of.” The recipe traditionally used to try to reduce the risk of hindsight (try to imagine a world where an invention has not yet been published) increasingly appears to be impracticable, as it is simply impossible for both Judges and experts not to take into account knowledge acquired after the priority date, even if they endeavour to ignore it. There are various empirical studies illustrating this.

Another method followed by Spanish Courts for reducing the risk of hindsight as far as possible is to apply the EPO’s “problem & solution approach”. However, ironically, the first step of this method (determining the closest prior art) could not be more reliant upon hindsight, as it requires the interpreter to choose the closest prior art in view of the current invention. As readers familiar with the EPO’s methodology are aware, another of its approaches is to prohibit the combination of different prior art documents except when the combination was suggested by the prior art, and/or the combination would have been obvious to the person skilled in the art. Even those Courts which do not follow the “problem & solution approach” – such as the English Courts – are extremely cautious when allowing the combination of more than, say, two prior art documents.

The Spanish Supreme Court followed suit on 20 May 2016, when it declared for the first time that prior art documents may only be combined if such specific combination was suggested by the prior art, or if such combination would have been obvious to the person skilled in the art. In a more recent judgment issued on 18 May 2017, the Spanish Supreme Court confirmed that even if only two documents must be combined to show how easy it would have been to arrive at the invention, such combination is not admissible unless the party attacking the inventive activity of the patent proves that it was suggested by the prior art, or that such combination would have been obvious.

These two judgments have resulted in this doctrine becoming case law. The message is clear: “ex post facto” mosaics will not do the trick.

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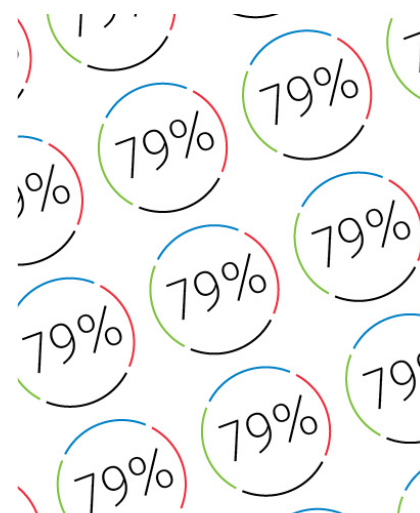
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