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Spanish Supreme Court calls for fine pencil when examining novelty

Miquel Montaña (Clifford Chance) · Tuesday, October 3rd, 2017

A judgment of 13 July 2017 from the Spanish Supreme Court (Civil Chamber) has highlighted the importance of taking the fine pencil when examining novelty.

The decision stemmed from a judgment of 12 September 2014 from the Barcelona Court of Appeal (Section 15), which had declared patent ES 2.344.241 invalid due to lack of novelty. The patent owner filed an appeal against this judgment before the Supreme Court, alleging, among other arguments, that the Court of Appeal had combined two documents of the prior art to reach the conclusion that all the elements of the claim were anticipated in the prior art. In particular, it alleged that the lower Court had taken some elements from document 1 and other elements from document 2. Also, the patent owner contended that the Court of Appeal had examined the novelty of the product, whereas the claims protected a specific use of such product.

In its judgment of 13 July 2017, the Supreme Court agreed with the appealing party that the lower Court had applied an incorrect methodology when examining novelty, because it had taken some elements from document 1 and other documents from document 2. In particular, it reproached the lower Court for having allegedly considered that the relevant point was whether all elements of the claim were anticipated by the prior art (no matter if some elements were disclosed in one document and the rest of the elements in another document), whereas the correct test for novelty requires all elements of the claim to be disclosed in one single piece of the prior art. Notwithstanding all of this, in the end the Supreme Court upheld the judgment, as it considered that the specific use claimed was allegedly disclosed in one single document of the prior art.

All in all, this recent judgment has further highlighted the importance of using a fine pencil when examining novelty.

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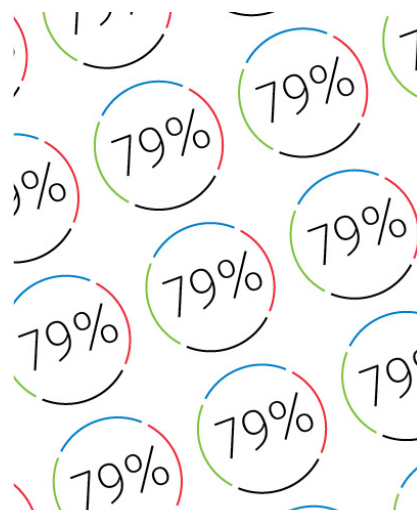
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