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Beware the rigidity of Spanish patent litigation

Miquel Montaña (Clifford Chance) · Monday, February 5th, 2018

Anyone who ends up litigating in Spain, be it as complainant or as a defendant, should be wary of the rigidity of Spanish patent litigation. Unlike in other jurisdictions, where the parties enjoy leeway to fine-tune their initial positions down the road, according to Spain's Civil Procedure Act, the initial statements made by the parties are etched in stone.

A relatively recent example of this can be found in the judgment of 22 December 2017 from the Court of Appeal of Barcelona (Section 15), which dismissed an appeal filed against a judgment of 20 April 2016 from Commercial Court number 4 of Barcelona. This judgment, among other aspects, had rejected an infringement action based on a utility model on the grounds that it lacked inventive activity. To put the discussion into context, it will be of help to transcribe claim 1, which was drafted as follows:

“1. An extendable artificial hedge, in particular an artificial hedge created using numerous plant rods (1, 2) constituting a lattice grid with diamond-shaped spaces, in which the rods (2) situated on the outside bear numerous artificial leaves (4) attached to the rods by plastic-coated wire (5),

characterized by

The rods (1, 2) of the hedge are distributed on two adjacent, superimposed planes or layers, connected by joining elements (3) such as screws, nails or similar elements, applied in a variety of crossing points between the rods (1, 2) of both layers, thus providing pivot points between the rods enabling the hedge to be extended lengthways to a greater or lesser extent in order adapt it to the space available.”

It turned out that at the main trial the patent owner modified the “claim construction” that it had made in the statement of defense. In the judgment of 22 December 2017, the Court rejected this change of direction on the grounds that article 412.1 of the Civil Procedure Act prevents the parties from introducing substantial modifications to their initial allegations. In particular, the Court held that:

“16. In view of the wording of R1, we believe it is easy to understand that the disputed utility model protects an artificial hedge that is characterized by the rods comprising it forming diamond-shaped spaces distributed on two planes or layers that are connected to each other by screws, nails or similar elements that provide pivot points between the rods, enabling the hedge to be extended lengthways.

17. We also interpret the scope of protection in the same way as the appealed decision and as Catral itself did when replying to the counterclaim. And we believe that the subsequent change of tack in the counterclaim, during the trial, in which it interpreted that the presence of leaves attached to the rods also formed part of the protection granted by the patent, as it also maintains in the appeal, is inadmissible.

18. We find it inadmissible from a procedural perspective because it is contrary to what Article 412.1 LEC stipulates, as this rule prohibits any substantive change of the complaint or the reply. In doing so, the legislator wants the debate to be orderly, which is incompatible with the parties' positions varying in the course of the proceedings.

19. We also find it inadmissible from a substantive perspective. The fact that the reference to the leaves is contained in the preamble, instead of in the characterizing part, indicates that what the invention is protecting does not really include that element, it merely refers to it. That is, it was the party itself, when registering it in the manner it did, who told us that its invention should be understood as referring to an extendable artificial hedge consisting of plant rods that bear numerous leaves, although what it wanted to protect is what it included in the characterizing part, which is condensed in the idea that the rods are affixed by elements such as screws or nails that provide pivot points and enable the hedge to be extended lengthways as appropriate.

20. Summing up, we believe, like the appealed decision, that we must deem the scope of protection as essentially comprising the characterizing part, which is not contrary to the idea that it must be understood as referring to the product described in the preamble.”

The teaching of the judgment is very clear: patent owners should carefully consider not only how to “construe” their claims before embarking on litigation but also how to draft them before filing the patent application, so that a clear distinction is made between what was known and what was not. Having said this, there is a question mark as to whether the finding that the scope of protection of a claim is limited to the “characterizing” part would obtain ample support from the Courts of other countries.

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