

# Kluwer Patent Blog

## Lost in translation

Miquel Montaña (Clifford Chance) · Monday, November 23rd, 2020

Spain has a well-deserved reputation of being a rather formalistic country when it comes to litigation. For example, according to the Civil Procedure Act, a Spanish translation of documents written in languages other than Spanish must be attached to the initial complaint. Otherwise, the Court may simply ignore them. A judgment of 15 October 2019 from the Valencia Court of Appeal is a good example of the risks entailed when embarking on litigation without bringing onboard the required translations. The facts of the case, for the purpose of the theme discussed in this blog, can be summarised as follows:

A toy manufacturer filed a patent infringement action against another toy manufacturer based in Spain, alleging the infringement of a European patent. The latter filed a revocation counterclaim based on lack of novelty and lack of inventive step. For the purpose of questioning novelty, the defendant filed a video and a catalogue, which allegedly disclosed the invention. The inventive step attack was based on two French patents, a German patent, and a Spanish patent. No translations of the French or German patents were filed.

Valencia Commercial Court Number 2, in a judgment of 5 December 2018, dismissed both the infringement action and the revocation counterclaim. This judgment was entirely upheld by the Valencia Court of Appeal in the aforementioned judgment of 15 October 2019. Some of the highlights, dealing with the patent's validity, are briefly discussed below:

First, the Court of Appeal dismissed the novelty attack because, in its opinion, neither the video nor the catalogue invoked by the defendant disclosed all the features of the claims of the relevant patent. Therefore, it was not satisfied that the invention, as such, had been made accessible to the public at the priority date.

Second, in relation to inventive step, the Court noted that the expert opinion filed by the defendant contained two patents in French and one patent in German, which had not been translated. Against this background, the Court stated that, in light of the failure to file the translations required by law, those documents (not translated) could not be taken into account for the purpose of examining inventive step:

*“1- French patents D.1 and D.2 are introduced as instruments in the process in the expert opinion filed with the counterclaim in French, but the translation into Spanish required by Article 144 of the Spanish Civil Procedure Act is not attached thereto. This was denounced by the defendant in its reply, who alleged that this deprived it of its right to a proper defence. Although those two patents were indeed subsequently examined by the plaintiff's expert, Mr Cesareo, the latter stated in his*

*report (Document 16 of the claim) that he was issuing his opinion only on the basis of the patent's drawings, since no Spanish-language version was available. In other words, the counterclaimant breached the mandatory legal requirement set forth in Article 144 of the Civil Procedure Act in relation to clearly essential instruments, because (due to the prior art they describe) they are used as a basis for the patent's invalidity sought in the counterclaim, such that in no way (given the procedural legal requirement established in Article 265.1.1 of the Civil Procedure Act) can this be remedied by providing the translation at a later stage of the proceedings, such as the pre-trial hearing, when the defendant has already replied, without indeed, given that time limit, causing its defencelessness.*

*2- Therefore, this Court considers that such documents for which a translation is not provided, cannot be taken into account to help resolve the present dispute, which gives relevant importance to its resolution, because if the state of the art is to be established based on its description, since no translation is available, its contents is unknown, as the plaintiff's expert already brought to light. Therefore, the lack of inventive step based on these untranslated documents undermines the very conclusion of the expert opinion of Pedro Francisco. [...]"*

All in all, this teaching warns prospective complainants on the risks of getting lost in translation or, to be precise, failing to duly provide the translations required by law.

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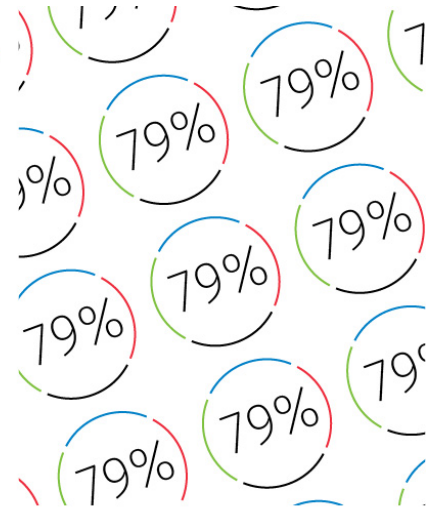
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