Kluwer Patent Blog

Spanish Supreme Court clarifies the bar for sufficiency of disclosure

Miquel Montañá (Clifford Chance) · Thursday, October 28th, 2021

A judgment of 7 July 2021 from the Spanish Supreme Court has been published, which, as discussed below, following the case law from the EPO's Boards of Appeal, introduces certain guidelines for assessing whether or not an invention is sufficiently described.

The background of the case can be summarized as follows:

The complainant filed a patent infringement action based on patent ES 2378679 B2, alleging that some panels marketed by the defendant fell within the scope of protection of that patent. The patent had four process claims (1–4) and one product claim (5), which, in brief, claimed a product obtainable by any of the processes protected in claims 1–4 or any other process. For the purpose of this blog, it is sufficient to transcribe claim 1:

> "*1.- PROCEDURE FOR MANUFACTURING ELEMENTS WITH A GLOSSY FINISH FOR BUILDING FURNITURE OR OTHER OBJECTS, particularly applicable to so-called "non-useful" surfaces of kitchen, bathroom and office fittings for making parts such as door panels, fronts of draws and decorative elements, being generally applicable to crafting other objects that require a highly glossy finish and comprising:*
>
> *– a first stage for applying and conditioning low-pressure melamine paper (2) to a part (1), including pressing, cutting and sanding sub-stages;*
>
> *– a second lacquering stage in which varnish (3) is applied to the melamine-impregnated part deriving from the first stage, including treatment and protective-film-application stages (6); and*
>
> *– a third stage for adjusting the size, shape and conditioning for storage and use of the component deriving from the second stage, including cutting and edge-finishing operations, characterised by the fact that in the second stage, at least two coats of varnish (3) are applied to each main melamine-impregnated and sanded face of the pressed and cut panel or part (1), the initial coat being a low grammage adhesive coat applied with a roller that prepares that main face's surface for the following coat(s) of varnish (3), which provide a glossy finish and are applied by means of a stream of lacquer at higher grammages than the initial coat; proceeding, between the coats of varnish (3), to treat and dry them using aeration, infrared radiation or ultraviolet radiation methods or a combination thereof,*

depending on the chemical composition of the varnish or varnishes used and on the optimisation of their treatment and drying; placing, after the treatment and drying of the last coat of varnish (3), a plastic or protective film (6) such that it adjoins that last coat of varnish (3)."

In the statement of defence, the defendant filed a revocation counterclaim challenging the validity of the patent on three grounds (novelty, inventive step and insufficiency). Madrid Commercial Court number 11 handed down a judgment dismissing the infringement action and partially upholding the revocation counterclaim (only in relation to claim 5).

The complainant filed an appeal, in response to which the defendant also appealed the judgment insofar as it had not fully upheld the revocation counterclaim. In a judgment of 13 July 2018, the Madrid Court of Appeal (Section 28) dismissed the appealed filed by the complainant and upheld the appeal filed by the defendant. The patent was thus fully revoked for not fulfilling the sufficiency requirement.

The Court of Appeal sided with the defendant, which had questioned the sufficiency requirement on the grounds that claim 1 mentioned as a characterising element that the first coat of varnish be "low grammage" and that the following coat(s) of varnish have "higher grammages than the initial coat". The defendant held that the precise grammage had to be specified, i.e. the grams of varnish per square meter of surface of the panel, the reference contained in the claim therefore being insufficient.

Based on the evidence examined, the court of first instance concluded that the invention only worked, i.e. only reached the solution to the proposed technical problem, when the first coat had between 8 and 16 grams per square meter and the second between 100 and 150 grams and that problems arose if that range was exceeded.

The complainant then filed an "extraordinary appeal for breach of process" (i.e breach of due process) and a "cassation appeal" (i.e. breach of law) before the Spanish Supreme Court. In the first appeal, it alleged that the Court of Appeal's assessment of the evidence had been arbitrary. The Supreme Court dismissed this appeal, noting that, though in exceptional circumstances the Supreme Court may quash decisions when the assessment of the facts has been arbitrary, the assessment of sufficiency is a legal assessment (not a factual assessment) and, as such, must be challenged via a "cassation appeal", which the complainant also did. It should be noted in passing that Spanish civil procedure law is extraordinarily formalistic. Consequently, choosing the wrong framing can result in the automatic dismissal of the appeal.

The most interesting aspect of the case lies in the Supreme Court's finding when deciding the "cassation appeal". The most relevant paragraphs are set out below:

"*In the case at hand, the appealed judgment stated that the description was insufficient because the first claim specifies as a characterising element that the first coat of varnish be of "low grammage" and that the following coat(s) of varnish have "higher grammages than the initial coat". The reasoning was that a skilled person cannot reproduce the invention if the weight is not specified in each case.*

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According to the legislation invoked (Articles 25 and 112.1.b) of the Spanish Patent Act of 1986), for the non-specification of such values to constitute insufficiency in the description, the skilled person would have to be incapable of reproducing the patented invention with the information disclosed in the patent.

Without overlooking the fact that this assessment is very dependent on the specifics of each case, we can glean certain assessment parameters from the case law of the Boards of Appeal of the European Patent Office, particularly the decisions that apply legislation equivalent to that invoked in the appeal (Article 83 EPC), insofar as they can shed light on this procedure without creating any binding effect. We could bring up three considerations of the Boards of Appeal:

i) For one, that the occasional failure of a process as claimed does not impair its reproducibility if only a few attempts are required to transform failure into success, provided that these attempts are kept within reasonable bounds and do not require an inventive step (T 931/91).

ii) Second, that reproducibility is not impaired if the selection of the values for various parameters is a matter of routine and/or if further information is supplied by examples in the description (T 107/91). The board in T 764/14 concluded that the skilled person was able, based on common general knowledge and corresponding routine variation of experimental conditions, to complement the information contained in paragraph [0031] of the patent in suit and, thus, to determine (possibly with some slight uncertainty but without undue burden) the […] baseline value […].

iii) And, moreover, "There is no requirement in the EPC that the claimed invention may be carried out with the aid of only a few additional non-disclosed steps. The only essential requirement is that each of those additional steps be so apparent to the skilled person that, in the light of his common general knowledge, a detailed description of them is superfluous (T 721/89)."

After presenting these guidelines taken from the case law of the EPO Boards of Appeal, the Supreme Court reached the conclusion that, although the assessment of the sufficiency requirement by the Court of Appeal was "debatable", in the framework of a "cassation" appeal, there was no serious mistake or clear arbitrary assessment that could entail a breach of law and thus the quashing of the judgment. The Court added that the "interpretation" of a patent falls to the courts of first and second instance and that it may only be reviewed by the Supreme Court when it deviates from the law and the case law, when it is arbitrary or when it makes a glaring mistake.

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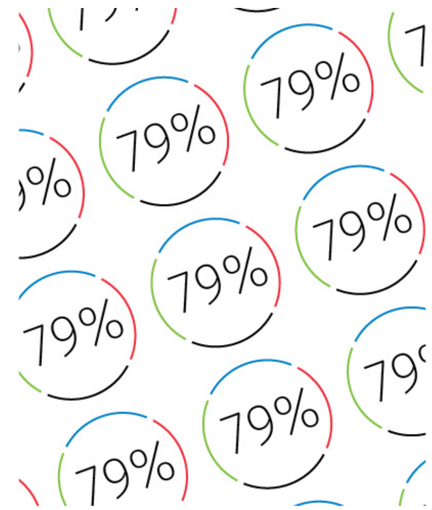

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