

Kluwer Patent Blog

Nullity of mother patent does not prejudice validity of divisionals

Miquel Montaña (Clifford Chance) · Monday, March 21st, 2022

Although the title of this blog may sound trite to most readers, it may still be of interest to briefly discuss a recent case where this topic was discussed before the Spanish courts in the context of a judicial patent dispute between Erasmus Universiteit Medisch Centrum Rotterdam (“Erasmus”) and its licensee, on the one hand, and two companies named Vitro S.A. (“Vitro”) and Direccion000 CB (“Direccion000”), on the other.

The ultimate origin of the dispute can be found in a revocation action that Vitro filed in 2013 before the Commercial Courts of Granada seeking the revocation of a patent that protected nucleic acid amplification primers for PCR-based clonality studies of BCL2-IGH rearrangements used in a diagnosis method. This patent was revoked by the Commercial Court of Granada in a judgment dated 15 January 2018, which was confirmed by the Granada Appeal Court in a judgment dated 18 December 2018.

In parallel, Erasmus and its licensee filed an infringement action against Vitro and Direccion000 before the Commercial Courts of Barcelona, alleging the infringement of patents EP 2.460.889 B1 and EP 2.418.287 B1, which were divisionals of the patent that the Granada Courts had found to be invalid. In their statement of defence, the defendants deployed a wide array of defensive arguments which included the lack of inventive step of the two divisionals and the prejudicial nature of the judgment that had found the mother patent to be invalid. According to the defendants, the overlap between the claims of the divisionals and the claims of the mother patent was such that the nullity of the latter should predetermine the nullity of the divisionals as well.

On 17 September 2019, Commercial Court number 5 of Barcelona handed down a judgment upholding the infringement action and dismissing the arguments based on lack of inventive step and the alleged prejudicial nature of the Granada judgment. The defendants filed an appeal, which was partially upheld by the Barcelona Appeal Court (Section 15) in a judgment dated 8 April 2021, albeit in relation to a point outside the scope of this blog. As far as the arguments based on lack of inventive step of the divisionals and the alleged prejudicial nature of the Granada judgment are concerned, these were rejected by the Barcelona Appeal Court (Section 15) as well.

In a nutshell, the Court, relying on G 1/05, highlighted that, since divisionals are separate and independent patents, any finding regarding the validity of the mother patent cannot be extrapolated to the divisionals. In particular, the Court highlighted that “a divisional patent application gives rise to an independent patent procedure, therefore, what may happen to the procedure dealing with the

mother is irrelevant.” Interestingly, the Court noted that the Granada decisions had understood that, having found claim 1 of the mother patent to be invalid, there was no need to examine the validity of the dependent claims because, according to the Granada Appeal Court, the invalidity of the main claim must automatically result in the invalidity of the dependent claims. The Barcelona Appeal Court, without criticizing its Granada counterpart, simply noted elegantly that “26. Notwithstanding what it is indicated in the judgments discussed, it is a consolidated rule that the nullity of the first independent claim does not predetermine per se the validity of the dependent claims.”

All in all, the main teaching of this interesting judgment, as far as the point discussed in this blog is concerned, is that a third party wishing to revoke a divisional of a mother patent that has been revoked must go the extra mile in explaining and justifying the specific reasons why the divisional should allegedly be revoked as well.

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