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# Barcelona court rules on need to prove patentability requirements of subsidiary patent claims

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## > Facts

## > Decision

On 10 November 2022, Barcelona Commercial Court No. 5 upheld a counterclaim for patent nullity. Among many other issues, this judgment specifically ruled on the need to prove that the subsidiary set of claims of a patent (filed in the context of patent litigation) complies with the patentability requirements. The judgment under analysis was handed down after the Patent Section of the Barcelona Commercial Court of First Instance had considered the merits of the case.

### Facts

In 2018, the holder of a European patent<sup>(1)</sup> filed a claim for infringement of its patent against a competitor company.

After being summoned, the defendant filed a defence and a counterclaim writ, alleging respectively that the patent at issue:

- had not been infringed; and
- was invalid on various grounds of invalidity, including:
  - lack of novelty; and
  - lack of inventive step.

In April 2019, the owner of the patent concerned filed a response to the counterclaim. Furthermore, making use of the provisions of article 120.3 of the Patent Act, it filed a subsidiary set of claims that would be effective in the event that the original set of claims of its patent were considered invalid.

### Decision

The Court started by analysing the validity of the patent. It declared it invalid for lack of inventive step in view of the combination of various earlier patents adduced in the counterclaim for invalidity.

With regard to the analysis of the invalidity of a patent for lack of inventive step, the Court recalled the usefulness of applying the problem-solution approach, used by the European Patent Office, in order to avoid an ex post facto assessment of the inventive step.

The Court stated that the application of the method involves three steps:

- the determination of the closest state of the art;
- the definition of the technical problem to be solved by the new invention; and
- on the basis of these two elements, an assessment of whether the claimed invention would have been obvious to a skilled person in the art.

This last step requires that:

- the skilled person in the art would have considered the problem that the invention seeks to solve; and
- the proposed solution would have seemed obvious to that person.

Once the patent in question had been declared invalid, the Court went on to analyse the admissibility of the subsidiary set of claims brought by the patentee and focused its analysis on the counterclaimant's attack on added matter.

The Court drew attention to the fact that, in patent litigation, when submitting a subsidiary set of claims, the patentee had failed to submit any expertise to:

- justify the concurrence of the patentability requirements of the subsidiary set of claims; and
- refute the arguments of the counterclaimant in its attack on the validity of the subsidiary set of claims on the basis of the alleged added matter.

With regard to the analysis of added matter, the Court pointed out that this was a ground for invalidity consisting precisely in the fact that the subject matter of the subsidiary set of claims filed exceeded the content of the patent application as filed.

In this context, the Court also accepted the arguments of invalidity on the grounds of added matter, declaring the subsidiary set of claims presented by the patentee to be invalid as well.

Finally, having found that both the main set of claims of the patent and the subsidiary set of claims were invalid, the Court dismissed the infringement action brought by the patentee, on both the main set of claims and the subsidiary set of claims.

This judgment is not final – an appeal is pending before the Barcelona Court of Appeal (15th section).

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## Endnotes

(1) No. 1462393, validated in Spain under No. 2270206.