THE SPANISH DOCTRINE OF EQUIVALENTS AFTER ALIMTA®
WHAT EFFECT WILL THE UK CASE HAVE ON SPANISH PATENT LAW AND THE UPC?

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I DO NOT KNOW
The Dawn of a Spanish Doctrine of Equivalents

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However, we consider that both proposed interpretations are inexact. For a start, the judgment delivered on 2 May 2005 referred, in the third question, to the subject-matter of “the” invention, which, due to a mere material error, does not appear in the judgment delivered on 7 June. However, one easily observes that, when the three aforementioned questions, regarding equivalents in pharmaceutical patents, were asked in both, the British doctrine was applied, based on the Catnic/Improver questions, which in turn have influenced the doctrine established by the German Federal Court from the 1986 Formstein Judgment and the test of obviousness, approaching both theories and making them compatible with Article 69 of the EPC Protocol. We recall, therefore, that in order to know whether a variant of one element is really an equivalent element, it is necessary to reply in the following order to these questions:

1) Does the variant alter the functioning of the invention? If the answer is affirmative, equivalence does not exist; if it is negative, i.e. no, the functioning is not altered, it is necessary to answer the next question.

2) Would the variant have been obvious to a person skilled in the art who read the patent on the date on which it was published? If the variant was not obvious, i.e. it is inventive, equivalence would not exist; but if the answer is affirmative, it is still necessary to ask:

3) Would the person skilled in the art who read the patent have understood, given the terms used in the claim, that the patent holder intended, as an essential prerequisite of the invention, that it be subject to the strict wording of the same? If affirmative, equivalence would not exist; but if the strict subjection to the literal wording were not essential in the invention, the variant could be equivalent.

It is true that the English Courts do not always take recourse to these three questions: in fact, in the judgment delivered on 21 October 2004, the House of Lords abandoned that system, not because it was incorrect, but because of the practical difficulty sometimes encountered in applying the same, and opted for a more casuistic system.

But a variation of the British and German theories should not affect this Court’s doctrine.
WHERE ARE WE COMING FROM?

SLIDE SUBTITLE

What the Court of Appeal required was that the alternative used in the disputed embodiment in order to replace the element used in the original invention, though not used identically, must be easy to see or comprehend, and must be predictable, an argument that this Division considers to be correct.
97. As far as Spanish law is concerned, it is common ground that the Spanish courts have followed the United Kingdom approach, which leads to the difficult question of whether one should assume that they would follow this decision in modifying the Improver questions and in particular the second question. I am inclined to believe that judicial comity would tend to suggest that the Spanish courts would follow this court in modifying the Improver questions, not least because this appears to render the UK courts and therefore the Spanish courts more consistent with the German and Dutch courts, and not more inconsistent with the French and Italian courts.

101. It is right to add that I am by no means convinced that, even if we had permitted Actavis to re-argue their case in relation to Spain, on the basis of the Lundbeck decision, I would have reached a different conclusion from that expressed in para. 97 above. Quite what constitutes “a degree of predictability” or “a high probability” when it comes to assessing whether the notional addressee would expect the variant to work must be fact-sensitive. Further, if, as seems likely but not, I accept, certain, the German, Dutch, French and Italian courts would all hold that Actavis’ products infringed, there would have been much to be said for the view, which I have already expressed, that the Spanish courts would follow suit.
WILL SPANISH COURTS ADAPT THEIR DOCTRINE TO THE NEW UK TEST?

SLIDE SUBTITLE

Judgment of January 17th, 2008 Court of Appeal of Barcelona

“But a variation of the British and German theories should not affect this Court’s doctrine”
We do not accept this argument in the appeal. Firstly, the fact that the Court of Appeal may have distanced itself from the literal wording of the judgment in the “Improver” case does not mean that it is guilty of the legal infringement being reported, the only one on which the upholding of the appeal could be based. The doctrine of the foreign courts may be useful in certain cases, as may some other doctrinal elements. However, an appeal in cassation cannot be based on the fact that there is a divergence between the findings of the Spanish and the British courts, since it can only be based on an infringement of the law applicable to the case, which in this instance is the European Patent Convention and the Spanish Patent Act. Furthermore, the English courts themselves adjust the application of the different rules or tests applied in earlier cases, adapting them to the requirements of the circumstances involved in each case, meaning that there is no point in focusing on this divergence.
The acts against which the patent provides protection referred to in paragraph 1 and the applicable limitations shall be those defined by the law applied to European patents with unitary effect in the participating Member State whose national law is applicable to the European patent with unitary effect as an object of property in accordance with Article 7."
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1. I am currently a University Emeritus Professor of Commercial Law at the Spanish National University – UNED – and Permanent Member and President of the Commercial Law Section of the General Coordination Commission (Spanish Ministry of Justice).

2. I have a particular interest in Patent Law and in Intellectual Property law in general.

3. I retain this Report on behalf of the defendant, Eli Lilly & Company ("Eli Lilly"), the proprietor of the patent which is the subject-matter of these proceedings. Eli Lilly & Company are the Spanish-controlled Joint Venture "AHIVAMEDI".

INTRODUCTION

For this case I drafted the first draft Report dated 30 January 2014 (my "First Report") and 4 March 2014 (my "Second Report"). The terms I used in this Report have the same meaning as those I used in my First Report and Second Reports, unless otherwise stated.

To prepare this Report I have reviewed the Expert Report of Professor Manuel Desantes Real dated 5 March 2014 ("Professor Desantes Real Report").
THANK YOU!