

# AMAT I VIDAL-QUADRAS

## advocats

### REPORT ON IP-RELATED MATTERS IN SPAIN Issue 1 Summer 2004

#### CONTENTS:

1. An important decision on claim construction.
2. Which jurisdiction may the plaintiff choose in a case of infringement in Spain?
3. New rules for registering industrial designs in Spain from 8 July 2004.

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#### AN IMPORTANT DECISION ON CLAIM CONSTRUCTION

Interpreting patent claims has been one of the most important issues discussed in recent years in Spain. The traditional approach of “essentiality”, akin to the longstanding “inventive idea” in the German tradition, is no longer useful and may give rise to major problems in the construction of the extent of a certain patent.

A recent judgement of 14 October 2003, pronounced by the Provincial High Court of Barcelona, one of the very few semi-specialist courts in Spain and the most reputable and recognised court in the country on IP matters, has clarified certain questions that may help define a proper doctrine about the extent and infringement of a patent close to the current criteria followed by the most important European courts, particularly in Great Britain and Germany.

#### **Interpretation of the extent of a patent**

One prior issue generally accepted by specialists but not yet decided on by the Spanish case law is that Spanish and European patent law are identical in terms of defining the extent of a patent. Concerning this the judgement states: “In order to determine the extent of patent protection, according to article 60.1 of the

*Patent Act 11/1986, of 20 March, the Spanish system has substantially incorporated Article 69.1 of the aforementioned European Patent Convention (EPC)”. The tribunal concludes that “this is the subject of a Protocol on the Interpretation of the Convention, which is part of the convention (Official State Gazette 24 September 1988), in order to provide a little more precision in interpreting the extent that claims should be regarded as having”.*

By applying these principles to a case of infringement, the court drew the following conclusions:

*“a) The object of the interpretation is the contents of the claims (Articles 26 and 60.1 of the Spanish Patent Act) or, which amounts to the same thing, the terms thereof (Article 69.1 of the EPC), because they define the subject matter of the invention and the extent of the protection.*

*b) Nevertheless, the description and drawings must be taken into account in the interpretation in order to define their essence; this amounts to saying that interpretation is necessary in all cases.*

*c) A merely literal or strictly literalist interpretation is excluded (as stated in the first*

sentence of the protocol). The accepted criterion is an interpretation that follows the spirit of the claim, seeking the true meaning of the claim's contents, beyond merely the words used, but this must not prevent a stricter result being reached than provided by the words used.

d) There must therefore be a corrective interpretation of the claims. However, this does not mean following a voluntary or subjective criterion because, when ascertaining the technically and legally relevant meaning of claims one must avoid seeing them as a mere guideline and that the relevant aspect is what the patent holder intended to protect. Hence, according to the protocol, the person skilled in the art (the judge in this case) must not focus on a subjective interpretation that takes the applicant's intentions into account. The interpretation must basically be objective, since the aim is to pinpoint and identify an invention in the state of the art, and this must be carried out based on the statement of science contained in the claims”.

The court's conclusion regarding the rules of interpretation set out in article 69 EPC is that it is “a happy medium that reconciles legal security (since third parties must be certain as to what is protected and what is not) with fair or just protection of the applicant in order to prevent misappropriation”.

The premises established by the court led to the reversal of the judgement pronounced in the court of first instance in which “the experts and the

judge all reached this conclusion based on the “description” (legal ground VI of the judgement; clarification 1 of expert C - page 226 - and clarification 5 of expert V - page 275). In other words, they interpreted the text of the “description” and so concluded such extent of protection”. By applying the aforementioned premises, the court stressed that “it is the claim that must be interpreted (because it defines the subject matter for which protection is sought). The “description” and the drawings are only instrumental means for such purpose”.

### **The important role of the file history**

In its new approach to infringement the court stated that: “when interpreting claims one may also refer to the file history (the historical element) when it is relevant in order to find out the true meaning and extent thereof”. In this specific case “there are significant details ... since the application for the European patent ... claimed a mesh network characterised in that said mesh rows are slanted in relation to the longitudinal axis of the hose (i.e. with no further details), but the claim finally recognised contains further details, as already described, that in fact restrict the scope of the terms of the application insofar as they more specifically define the subject matter of the protection”. Thus, the file history – in the case of the European patent – was considered relevant in order to construe the extent of protection of the claim.

The court even referred to the

precedent of what happened during the registration of the US patent to back its opinion of the real extent of the patent: “In addition, US patent number 5,477,888 (page 112, the text of which was also acknowledged in court by the aforementioned legal counsel), also held by the plaintiff, obtained the priority of the European patent, and clearly specifies the angle of inclination of the mesh rows and lines relative to the longitudinal axis (slanted in directions substantially perpendicular to each other such that the angle of inclination of the mesh rows relative to the longitudinal axis of the hose is substantially equal to the angle of inclination of the mesh lines relative to the longitudinal axis of the hose...)”.

### **Conclusions**

The judgement's lesson is summarised as follows: “if the claim clearly restricts the extent of the description, the literal interpretation of the former must prevail insofar as it expresses the true spirit of the invention, preventing insecurity for third parties that would result from doing away with or removing the technical features from the claim, which is what defines the extent of the protection and, therefore, must be interpreted. One must indeed refer to the “description”, but without making it the object of the interpretation, since it is merely a means, as mentioned above, for interpreting the claim, so it cannot be considered on its own, unconnected to the claim”.

Otherwise it would go against legal certainty: *"In fact, doing away with these claimed technical characteristics would provide greater protection, which the plaintiff applied for but was not granted. Therefore, in order to guarantee legal security, one must accept that*

*the claim prevails over any greater extent or aspect that contradicts it in the "description", when the text of the claim precisely and specifically states the extent of the protection"*.

This judgement is very

important not only because of its well-founded legal grounds, but also because it is the first judgement to deal with some of the most relevant aspects in the construction of a doctrine of European equivalence.

### **WHICH JURISDICTION MAY THE PLAINTIFF CHOOSE IN A CASE OF INFRINGEMENT IN SPAIN?**

Plaintiffs sometimes wonder which jurisdiction they may choose in a case of patent or trademark infringement. Traditionally, the Spanish courts have deemed the defendant's domicile to be the competent jurisdiction. This was stated in the common procedural rules for cases of industrial property law laid down in the Patents Act of 1986. Article 125.2 of that Act states that *"the court of first instance of the city in which the High Court of Justice of the Autonomous Community in which the defendant is domiciled shall be competent"*. This means that the plaintiff cannot choose the jurisdiction.

The Spanish Trademark Act, passed in 2001, provided a second possible choice in a new article 125.3 of the Spanish Patent Act: *"In the event of action concerning the infringement of a patent right, the same court as referred to in the last paragraph in the autonomous community where the infringement was carried out or its effects took place shall also be competent, at the*

*plaintiff's choice"*. Specialists have commented that this provision would open up the possibility of the plaintiff choosing the jurisdiction (forum shopping).

In two recent cases the courts of first instance have interpreted that article 125.3 could not be invoked when the product was sold in different parts of Spain or nationwide. This was the case in a judgement of a court of first instance in Barcelona on 23 April 2004. In his judgement, the judge explained that: *"Firstly, we should point out that article 125.3 speaks of the autonomous community where the infringement took place. In other words, it put a certain geographical precision on the patent infringement. This is logical if one thinks that in all cases such as this, the plaintiff's interpretation would imply that all Spanish courts in cities that contain an autonomous community's High Court of Justice would in principle be competent to hear this kind of action (which would undoubtedly be very*

*common since all large companies carry out nationwide distribution), which would have two harmful effects: on the one hand, it would be the plaintiff that would freely choose the court in which the proceedings would be carried out with no territorial restriction, thus infringing the principle of the predetermined judge in article 24 of the Spanish Constitution. And, on the other hand, in these cases the legal regulation (article 125.3) would cease to be a criterion for determining competence, attributing it to some bodies and removing it from others, but would rather become (along with point 2 of the same article) devoid of meaning since any plaintiff could choose any court it wanted (in cities that contain an autonomous community's High Court of Justice)"*.

So it is not clear whether the plaintiff can freely choose the jurisdiction when an infringement is carried out throughout Spain, even though the law at first appears to allow it.

### **NEW RULES FOR REGISTERING INDUSTRIAL DESIGNS IN SPAIN FROM 8 JULY 2004**

The Industrial Design Act 20/2003, which replaces the former Industrial Property Act

of 1929 with regards to the protection of industrial models and drawings was published in

the Official State Gazette on 8 July 2003. Although the new act adopts a new common

name for both concepts, industrial design, it nevertheless distinguishes between models and drawings.

The recent approval of new EU regulations on the protection of industrial property rights, especially industrial design rights, has clearly influenced the updating of Spanish law in this area. The Industrial Design Act 20/2003 is the result of the harmonisation of Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs. The entry into force of EU Regulation 6/2002 on industrial

design also influenced the passing of a new Spanish regulation adapted to the new legal status of European designs, which also covers Spain.

Even though almost all of the act came into force on the day it was published (i.e. on 9 July 2003), Final Provision Three stipulated that Title IV on *application registration and opposition*, Title VII chapter III on *application and the process for amending rights*, and the Additional Provision Five on *terms for issuing and notifying decisions* would come into force one year after

publication.

This means that from 9 July 2004 all Spanish applications for industrial designs will be registered in accordance with the new Industrial Design Act.

One of the most relevant changes brought about by this act is the new opposition system which will take place two months after the publication of the grant of the design. Up until now, based on the former act, the opposition period took place before the grant of the design application.

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