ES – GRUPO ALVIC FR MOBILIARIO, S.L. v. GRUPO CORNAVIN 234 2009, S.L.

Court of Appeals, Section 28, Madrid, Spain, 13 July 2018, Case Docket no. 49/2017.

Section 28 of the Court of Appeals of Madrid reviews the requirement of sufficient disclosure.

GRUPO ALVIC FR MOBILIARIO, S.L. (hereinafter "ALVIC") filed a patent infringement complaint in October 2013 against GRUPO CORNAVIN 234 2009, S.L. (hereinafter "CORNAVIN") based on its Spanish patent ES 2.378.679 B2 (ES 679). Patent ES 679 protected a process for the manufacturing of elements with a shiny finish for the production of furniture and other objects, as well as the product thus obtained. The patent comprised an independent claim and four dependent claims. ALVIC considered that CORNAVIN infringed product claim number 5. In turn, CORNAVIN replied to the complaint and filed a counterclaim seeking the nullity of the patent at stake on the grounds of lack of novelty, lack of inventive step and insufficient disclosure.

The first instance Court, Commercial Court No. 11 of Madrid, issued a decision in May 2016 upholding the defendant's position, finding that claim 5 of patent ES 679 partially lacked inventive step. Therefore, the Court found the product claim null and accordingly dismissed the infringement actions brought by the plaintiff.

In view of the first instance judgment, ALVIC filed an appeal requesting the revocation of the declaration of nullity of claim 5 and the granting of its patent infringement petitions. CORNAVIN filed a counter-appeal seeking to obtain a ruling in favor of its counterclaim: nullity due to lack of novelty and inventive step, as well as insufficient disclosure.

The Court of Appeals began its analysis by studying the objections to the validity of the plaintiff's patent. In particular, the Court analyzed the insufficient disclosure of the patent, given that if this argument succeeded, it would not be necessary to assess the other nullity grounds raised by CORNAVIN.

In its appeal decision, the Court recalled the basis of the patent system, in which publicity constitutes the general rule. This publicity implies that the invention shall be described in a document accessible to the public where the technical problem to be solved, the solution proposed by the invention, the advantages provided by the invention in relation to the existing prior art and the specific technical features of the invention shall be disclosed. The monopoly that the State confers to the patent holder as a reward for his efforts comes from his invention's

contribution to advancement by its disclosure. Therefore, it is imperative for the patent to disclose the invention in a manner sufficiently clear and comprehensive for it to be implemented by a person skilled in the art. According to the provisions of the Law, if a patent does not meet the sufficient disclosure requirement, it shall be declared null and void.

The patent in question contained in claim 1 a reference to the need to use two layers of varnish, without specifying the thickness of same, simply stating that the first layer should have " *low grammage*" and the second one should have "*higher grammage*". In this case, the patent does not provide any information about what should be considered “low” and “higher”. This imprecision was also present in claim 2 in relation to the grammage of the melaminic paper, where patent ES 679 merely stated that it should have "*such a grammage that allows a sanding sub-step on that main side, without appreciating transparencies of the board and granting flatness and adherence for the application of the second stage varnish*".

In support of its patent’s validity, the plaintiff submitted an expert report consisting of assertions and arguments levelled by the expert without any supporting evidence. The expert’s most relevant argument was that, in his opinion, any expert in the field would know what grammage the patent referred to. However, the expert did not explain why, or what criteria an expert should use as a reference, or from what protocol an expert could deduce this grammage, which in the Court of Appeals’ opinion did not seem to be particularly rigorous from a scientific or technical point of view.

In turn, CORNAVIN’s expert sustained that in the patent’s relevant sector, it is customary to indicate the grams of varnish that must be applied per square meter of board. Additionally, he highlighted the fact that the omission of this data would necessitate an investigation by an expert who would seek to implement the invention, to the point of requiring reverse engineering.

In light of the argument posed by both parties, the Court of Appeals sided with the defendant’s position, basing its argument on the allegations made by the witnesses who testified at trial. One of the witnesses was ALVIC’s former employee, who was notably specific when indicating the measurements that the varnish layers should have. Thus, he explained that the first layer should be between 8 and 16 grams per square meter, and the second layer should measure above 100 grams but no more than 150 grams, because exceeding that range poses problems. Additionally, the second witness, the commercial director of a varnish company, explained that the varnish of melanin is a complex process that poses lack of adherence and shine problems.

The Court of Appeals upheld the insufficient disclosure argument alleged by CORNAVIN based on the following conclusions: first, the Court considered that the information regarding

the measurements of the densities of the varnish layers is highly relevant, since obtaining a product with a specific varnish adherence and final resistance will depend on that data.

The Court's second conclusion, based on CORNAVIN's expert report, stated that the application of successive layers of varnish having certain characteristics is an essential step in the patented process which has a fundamental impact on procuring a product with certain technical characteristics. The Court considered that the vagueness of the patent claims was inexcusable, taking into account that the lack of information is related to a magnitude such as grammage, which is the measurement of the surface density of a material and can be quantified with a measurement.

Finally, having reached the conclusion that the information related to the grammage of varnish is essential to implementing the invention, the Court evaluated whether or not this data is thought to be part of the skilled person's common general knowledge. In light of the examined evidence, the Court considered unproven that the adequate grammage for implementing the patent should be deemed, at the time of the patent's filing, part of the common general knowledge of the expert in the field. This would imply that any skilled person who tried to implement the invention would not be able to overcome the patent's omissions by using his general knowledge, meaning he would have to resort to experimentation to try to reach the same patented result.

In other words, the expert would have to exert undue effort, and an excessive burden would be added to the process of implementing the patent. The Court considered that the expert would have to carry out almost the same research as the patent inventor in order to figure out the appropriate grammage for each of the different varnish layers to be applied, resulting precisely from the patent's inconsistency and insufficient description.

Therefore, the Court of Appeals upheld CORNAVIN's arguments of insufficient description of patent ES 679, declaring the nullity of the patent.