

**THE SPANISH  
PATENT AND  
UTILITY MODEL LAW**

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## **PATENTABILITY**

Provisions concerning patentability, exceptions to patentability, novelty, non-prejudicial disclosures, inventive step and industrial application are identical to the ones contained in Chapter I, part II of the European Patent Convention. However the patentability of chemical and pharmaceutical substances as such did not enter into force until October 7, 1992. Before this date it was not possible to file patent applications containing claims relating to chemical and pharmaceutical substances as such. This applied as well to the European patents where Spain had been designated.

Furthermore the Spanish law has been adapted to the provisions of the Directive 98/44 EC of the European Parliament and the Council of 6 July 1998 on the legal protection of biotechnological inventions.

Microbiologic processes are patentable provided that the deposit of the microorganism has been effected in accordance with the International Conventions (Spain is a Member State of the Budapest Treaty concerning the deposit of microorganisms).

## **APPLICATION**

### **Contents of a Patent application.**

- a) A request for the grant of a Patent or a Utility Model comprising an identification of the applicant,
- b) a description of the invention in Spanish,
- c) one or more claims in Spanish,
- d) any drawings referred to in the description or the claims,
- e) an abstract (not necessary for Utility Models), and
- f) if the priority of a foreign application is claimed, a declaration of priority, a certified copy of the foreign application and a Spanish translation thereof.

In order to obtain the date of filing, it is indispensable to pay the tax and to file documents in Spanish corresponding to points a), b) and c), even though the description and the claims do not comply with the formal requirements established in the Implementing Regulations.

## **UNITY OF INVENTION**

The Patent application shall relate to one invention only or to a group of inventions forming a single general inventive concept. Divisional applications with the date of filing of the original one shall be allowed.

## **GRANTING PROCEDURE**

The Law establishes a general granting procedure with formal examination and novelty search report and, optionally, a granting procedure comprising additionally a substantial examination and opposition proceedings

### **General granting procedure**

It comprises the following steps:

1. Examination as to the requirements for the accordane of a date of filing.
2. Examination as to formal requirements and patentability requirements, except novelty and inventive step. Although novelty is not examined, the Patent office may refuse the patent on the grounds of notorious lack of novelty.
3. Where no deficiencies are noted or the deficiencies are corrected within the legal term, the Patent Office shall request the applicant to pay within one month the tax for the drawing up of a novelty search report. The request to pay such tax will never be addressed before 15 months have passed since the date of filing or the date of priority.
4. Publication, comprising the description, the claims and any drawing as filed, shall take place within eighteen months from the date of filing or from the date of priority, if a priority has been claimed.
5. The novelty search report shall be notified to the applicant and laid open to public inspection.
6. A two-month delay shall be provided within which any person may file remarks to the report. The applicant shall have the opportunity to file its comments to the report and to the remarks filed by third parties and to amend the claims if he deems it convenient.
7. The Patent shall be granted whatever the contents of the novelty search report or the remarks filed by third parties, but the documents concerning the novelty search report and the remarks shall remain open to public inspection. The specification and claims shall be printed.

## **Granting procedure with substantial examination**

On reception of the novelty search report (step 5 of the General Procedure), the applicant may choose to abandon the General Procedure and to submit the application to a substantial examination, including publication for oppositions. In this case the procedure shall comprise the following steps to be accomplished after step 5 of the General Procedure:

1. Filing a request for substantive examination, including payment of the corresponding tax;
2. A two-month term will be opened for filing oppositions;
3. Substantial examination shall be performed with reference to the novelty, inventive step, industrial applicability and sufficiency of the description;
4. The examination report and the oppositions, if any, shall be notified to the applicant, who will be able to file its comments and amendments within a term to be established;
4. The Patent shall be granted or refused (partial refusal is allowed).

## **Provisional protection**

After its publication, a patent application shall confer a provisional protection and the applicant shall be entitled to obtain a reasonable indemnity from the infringers, if the patent is eventually granted. The same applies before the publication if the alleged infringer has received a notification of the date of filing and the contents of the application.

## **TRANSFORMATION INTO UTILITY MODEL**

The transformation is allowed at any moment before expiration of the delay for filing comments to the novelty search report or for filing the response to the examination report. Transformation may also be requested by the examiner when performing the examination as to formal requirements.

## **VALIDATION OF EUROPEAN PATENTS**

Patents granted by the European Patent Office with designation of Spain shall be effective in this country only if a translation of the specification and claims into Spanish has been filed with the Spanish Patent Office within three months of the

publication of the mention of grant in the European Patent Bulletin. If the text has been amended following an opposition, it will be necessary to file a translation of the new text within three months of the publication of the mention of the opposition decision.

The translation must be effected by a Spanish Patent Attorney or a Spanish sworn translator.

The Spanish text shall be regarded as authentic if according to this text the protection is narrower than the one conferred in the language of the proceedings. The filing of an accurate translation is therefore important.

The European Patent application shall benefit from a provisional protection in Spain after publication provided a translation of the claims into Spanish be filed with the Spanish Patent Office.

### **DURATION**

The term of a Spanish patent is 20 years as from the date of filing of the application, provided an annual tax be paid.

### **EFFECTIVE RIGHTS CONFERRED BY A PATENT - INFRINGEMENT**

#### **Extent of protection**

Shall be determined by the terms of the claims, but the description and drawings shall be used to interpret the claims.

#### **What constitutes an infringement**

The following acts are deemed to constitute infringement:

- a) The manufacture, the offer for sale, the putting on the market, the use or the possession, for any one of these purposes, of the patented article without the patentee's consent.
- b) The use of a process protected by a patent or the offer of same, when the offering party knows or the circumstances make it evident that the use of such process is not allowed without the consent of the patentee.
- c) The offer for sale, the bringing into the market, the use, the importation or the possession for any of these purposes of a product directly obtained by a patented process.
- d) The delivery or offer for delivery to any third party non authorized to exploit the invention, of means that are essential for putting into

practice the invention, when the offering party knows or the circumstances make it evident that such means are for and destined for such putting into practice.

The protection conferred by a patent on a biological material possessing specific characteristics as a result of the invention shall extend to any biological material derived from that biological material through propagation or multiplication in an identical or divergent form and possessing those same characteristics.

The protection conferred by a patent on a process that enables a biological material to be produced possessing specific characteristics as a result of the invention shall extend to biological material directly obtained through that process and to any other biological material derived from the directly obtained biological material through propagation or multiplication in an identical or divergent form and possessing those same characteristics.

The protection conferred by a patent on a product containing or consisting of genetic information shall extend to all material, in which the product is incorporated and in which the genetic information is contained and performs its function.

### **What does not constitute an infringement**

The following acts are not deemed to constitute infringement:

- a) Acts effected in private for non-commercial purposes.
- b) Acts effected with a strictly experimental purpose.
- c) The preparation of medicaments in pharmacies on a non-industrial scale on individual prescription and acts with regard to the medicaments so prepared.
- d) Use of a patented invention in the body, engines, tackles, apparatus and further accessories of a vessel from another country being a member of the Paris Union, if such vessel enters the territorial waters of Spain only temporarily or incidentally and provided that such use is exclusively for the needs of the vessel.
- e) Use of a patented invention in the body or accessories of, or for the operation of land vehicles or aircrafts from another country being a member of the Paris Union, if such vehicles or aircrafts enter the territory of Spain only temporarily or incidentally.
- f) Import and use in Spain of spare parts and accessories for the purpose of repairing foreign aircrafts only.



## **Prescription of rights**

The deadline for commencing infringement proceedings is of 5 years from the date the action could be exercised.

### **The plaintiff may request:**

- a) the prohibition of the infringing acts,
- b) an award of damages,
- c) the seizure of the infringing products and of the means exclusively used for the manufacture of same,
- d) confiscation, in favour of the plaintiff, of the seized products and means (the value of thus confiscated goods shall be taken into account when calculating the damages awarded to the plaintiff),
- e) to adopt measures securing that the infringement is really discontinued, if necessary the destruction of the infringing articles,
- f) publication of the decision, at the expense of the losing party.

## **Damages**

The plaintiff may claim damages as well as a compensation for the profits non-gained as a consequence of the infringement, or alternatively refund of profits illegally gained by the infringer or payment of an amount equivalent to the royalties the infringer would have paid if he acted as a licensee.

## **Exhaustion of rights**

Patent rights shall not be effective against facts accomplished in connection with a patent protected product after same has been brought into the market within a member state of the European Union is the owner of the patent or with his explicit approval.

## **Reversal of the burden of proof**

If a patent relates to a process for manufacturing a new product or a new substance, it shall be presumed that any product or substance having the same characteristics has been obtained by the process claimed in the patent. The infringer will have to prove that the process is different, unless he is the owner of a patent claiming a process for the obtention of the same product, which has been granted before January 1, 1986 (the date Spain adhered to the EU). The importance of this exception to the reversal of the burden of proof is only relative

because the Law provides judicial "saissie-description" proceedings that will help to determine which is the method really used for manufacturing the product.

## **LICENCES AND ASSIGNMENTS**

Unless specific stipulation to the contrary the licence shall be deemed non exclusive and the licensee shall not be entitled to assign the licence or to grant underlicences. It will also be presumed that, if there is no stipulation to the contrary in the agreement, the assignor of a patent or the licensor shall have to transmit to the assignee or the licensee the know-how necessary for an adequate working of the invention. The compulsory licences are not excluded from this provision.

Assignments and licences shall not be effective against third parties if they are not registered with the Patent Office.

## **WORKING-LICENCES OF RIGHT-COMPULSORY LICENCE**

### **Working**

Patents should be worked in Spain by the patentee or an authorized person, in a commercial scale deemed sufficient to satisfy the demand in the Spanish market, within three years of the date the grant was published in the Patent Gazette or within four years of the date of filing of the relative patent application, whichever of these periods expires last. The sale in Spain of the patented article manufactured in any country of the WTO shall be considered as a real working in Spain. Working shall not be discontinued during more than three years. The lack of working entails the submission of the patent to the compulsory licences provisions.

Proof of real working will only be necessary if a third party applies for a compulsory licence, but if a certificate of real working has been filed less than three years before the licence is applied for, it will be presumed that the invention is worked in the way established by the Law. In this case the petitioner of a compulsory licence will have to bring evidence to the contrary. The filing of a certificate of real working every three years is therefore advisable.

### **Licences of Right**

If no exclusive licence is recorded, the patentee may at any time after grant notify by writing to the Patent Office his willingness to authorize to any interested party the exploitation of the patented invention . In this case the annual fees will be reduced to one-half and any interested party will be entitled to obtain a non-exclusive licence on terms to be agreed with the patentee or, if no agreement is reached, to be settled by the Patent Office.

The petitioner of the Licence of Right will be entitled to commence the exploitation

within one week of the date he receives from the Patent Office the copy of the notification sent to the patentee informing him of the petition of the Licence of Right.

Both parties may request the amendment of the terms within one year of the date same have been established.

### **Compulsory licences**

A request for a compulsory licence may be made on one of the following grounds:

a) Non-working, insufficient working or interruption of working for a period longer than three years. Sufficient working will be presumed if a certificate of real working is filed every three years.

b) If exportation is not meeting the demand in the foreign market. (In this case the compulsory licence will be granted only to satisfy the exportation needs.)

c) Dependant patents. The owner of a junior patent that cannot be exploited without infringing a senior patent may obtain at any time a non-exclusive licence thereof if the invention of the junior patent aims a different industrial area or represents a remarkable improvement over the invention of a senior patent. If both inventions aim the same industrial area, the senior patentee may obtain a cross-licence. If the senior patent relates to a chemical or pharmaceutical substance and the junior patent to a remarkable improvement in the process for its obtention both patentees will be entitled to a licence from the other one.

d) Public interest. The Government may declare at any moment that compulsory licences should be granted if the exploitation is highly important for the public health or the national defence or if the non-working or the non-sufficient working is causing a serious damage to the economic or technological development of the country.

The compulsory licence shall be granted against payment of a reasonable royalty, after the applicant has proved that he is able to work the invention in a serious and effective way.

A compulsory licence is always a non-exclusive licence.

### **PATENTS OF ADDITION**

Patents of addition may be granted during the whole duration of the main Patent, if

the respective subject-matters are linked to form an inventive unity.

The duration is limited to that of the main patent and no annual fees are due.

An application for a Patent of Addition may be converted into an application for an independent patent and a Patent of Addition already granted may be converted into an independent patent upon having previously renounced to the main patent.

## **UTILITY MODELS**

May be granted for new inventions consisting of bringing to an object a configuration, structure or conformation serving to improve the manufacture or use thereof.

Processes cannot be covered by a Utility Model registration.

### **Novelty and inventive step**

The existence of inventive step is required for the validity of a Utility Model, but it is sufficient that the invention is not "clearly" obvious for a man of the art.

Novelty in Spain is sufficient. The state of the art comprises disclosure disseminated within Spain by oral or written description, by use or by any other means.

Regarding written disclosures the condition required for patents is that there has not been any disclosure accessible to the public anywhere in the world and a parallel condition for Utility Models should have been that there has not been any disclosure accessible to the public within Spain. But what our Law requests to destroy the novelty of a Utility Model is not the public accessibility in Spain, but the divulgation in Spain, which means that the mere existence in the Spanish Patent Office of the copy of a foreign patent specification regarding the same subject matter could be deemed insufficient to destroy novelty in Spain, because the mere existence of the document in a library does not imply divulgation, a concept that requires a certain degree of dissemination among the public.

### **Application**

Same as patents

### **Granting procedure - Oppositions**

The application shall be examined as to formal requirements and as to compliance with unity of invention requirements and with requirements for protection as a

Utility Model. No novelty search report is drawn up but any person may file opposition within two months of the publication of the claims and the drawings in the Spanish Industrial Property Bulletin.

In support of an opposition which is not based on prior patent or Utility Model rights in Spain, it is necessary to bring documentary evidence proving that, before the application date, the subject matter has been sold in Spain or offered in the Spanish market or described in a document that has undergone a certain degree of divulgation or dissemination in Spain, for example a magazine, a catalogue or any other kind of printed publicity or information distributed in Spain. In order to be able to bring irrefutable evidence regarding the date of issue of a catalogue or a leaflet in Spanish with information about the subject matter, it is advisable that the Spanish printer proceeds to file a copy with the copyright Register in order to obtain a number and a date that can be printed on the publication. That is what we call the “*depósito legal*”. It is a very easy measure, practically free of charge, that can be very useful in opposition proceedings.

### **Duration**

Ten years from the filing date of the application, provided an annual tax be paid.

### **Effective rights conferred by a Utility Model**

Same as patents

### **Assignments – Licences – Compulsory licences**

Same as patents

### **APPEALS**

An appeal may be filed before the Patent Office’s Board of Appeals against any decision granting or refusing patent or Utility Model rights. The appeal must be filed within one month of the publication in the Spanish Industrial Property Bulletin of the mention of the decision against which the appeal is directed.

Against a decision of the Board of Appeals it is possible to file a Contentious Administrative before the Madrid Appeal Court, within to months of the publication in the Spanish Industrial Property Bulletin of the mention of the decision.

### **GROUNDS FOR CANCELLATION OF PATENTS AND UTILITY MODELS**

A Patent or a Utility Model may be totally or partially cancelled if it is proved that:

- a) any of the patentability requirements is not fulfilled,
- b) the description is not sufficiently detailed and clear to allow a man of the art to work the invention,
- c) the subject matter of the granted Patent or Utility Model exceeds the contents of the application as filed or, in case of a divisional application, the contents of the initial application as filed,
- d) the patentee was not entitled to obtain Patent or Utility Model rights on the invention.

### **LEGAL PROCEEDINGS CONCERNING PATENTS AND UTILITY MODELS**

All actions (infringement as well as nullity actions) shall be brought before the Civil Courts, where they shall be prosecuted according to the ordinary declaratory judgement, but the Court shall request the Patent Office to render its opinion on the case.

The competent Court is any 1st Instance Civil Court of the capital city of the Autonomous Region where the defendant is domiciled. According to the Law, in each of the 17 capital cities of the Autonomous Regions a 1st. Instance Civil Court should be selected to deal with Industrial Property cases, so that a certain degree of specialization could be achieved. Unfortunately this selection has not been carried out as yet. In infringement cases any 1<sup>st</sup> Instance Civil Court of the capital city of the Autonomus region where the infringement took place is also competent.

By way of defence to an infringement action a defendant may counterclaim that the patent involved is invalid on any of the grounds on which a nullity action may be brought. If this happens the Court dealing with the infringement action shall be entitled to cancel the patent.

When deciding on a nullity action the Court may cancel only one or several claims.

Any party may request a Court to declare that the manufacture of a particular product or the performance of a particular procedure does not infringe upon a certain patent, provided he has previously requested the patentee, through a Notary Public, to declare whether he considers such activity as an infringement of his patent.

### **Judicial description proceedings to ascertain the facts**

Before bringing an infringement action the plaintiff may request the Court to investigate and describe the facts supposed to constitute the infringement. The Court shall make sure that it is reasonable to presume the existence of an infringement and that there is no other way to ascertain the real nature of the facts. Then the Court, with the help of experts, shall examine the alleged infringing

products or procedure and shall draw up a description of same and of the means used for the manufacture of the products, should it appear that they may constitute an infringement.

### **Injunction to secure the effectiveness of an action**

An injunction may be granted to the plaintiff only if he proves that the patented invention is really worked in Spain or at least that serious and effective measures are being taken to commence the commercial exploitation in Spain.

The Court may order:

- a) the prohibition of the infringing acts,
- b) the seizure of the infringing products and of the means exclusively used for the manufacture of same,
- c) any measure to secure the effectiveness of a possible award of damages.

An injunction may be requested when bringing the action before the Court, and also before or after it has been brought before the Court.

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