

New Spanish patent law 24/2015

The new Spanish patent law entered into force on April 1st, 2017, replacing the previous law of 1986 and also other provisions that were reflected in separate legal texts, such as those related to the application of the European Patent Convention and the Patent Cooperation Treaty in Spain. Likewise, on April 1st, 2017 the Council of Ministers approved the Regulation for the implementation of the new Patent Law by means of a Royal Decree. Thus, the new Patent Law and its Regulation entered into force on the same date.

The new law introduces substantial changes in the national patent system, both for patents and for utility models, and may affect the filing of European and PCT applications for inventions made in Spain.

In the following we summarize the main changes. However, this summary is not exhaustive and it should not be considered as legal advice. Don't hesitate to get in touch with us if you need any clarification, and especially if you need advice on a particular case.

Main changes introduced by the new law

Shift to a granting system with substantive examination and post-grant opposition, for all Spanish patent applications:

After the SPTO issues a Search Report the applicant has to request examination; in case of objections from the examiner, the claims may be amended and/or arguments filed, in a process leading to the grant or refusal of the application.

Third parties may file observations on the patentability, and the examiner may take them into account.

Oppositions may be filed within 6 months from the grant of the patent. Appeals at the SPTO are possible against a decision to refuse the application, and against the decision in an opposition.

Obligation of first filing a European or PCT application at the SPTO, for inventions made in Spain:

Patents derived from a PCT application or from a European application will have no effects in Spain unless such applications are filed at the SPTO, or claim priority from an earlier application filed at the SPTO.

In the absence of proof to the contrary, an invention will be deemed to be made in Spain if the applicant has its domicile, registered office or permanent address in Spain.

Possibility of limiting the scope of protection after grant/opposition:

Post-grant limitation or revocation of the patent may be requested by the owner at the SPTO.

The claims may be amended before the courts, during litigation, if the granted claims are found to be invalid.

Utility models:

New requirement of absolute (international) novelty, although the lower inventive step level with respect to patents is maintained.

Extension of the subject matter that may be protected to chemical (not pharmaceutical or biological) products.

The owner of a utility model must obtain a search report from the SPTO before bringing a lawsuit against an infringer.

Priority right:

Internal priority may now be claimed for a national application.

Copy of the priority application and its translation is no longer necessary provided that the claim is not considered relevant for the patentability or in case the priority application or its translation is in the possession of the SPTO or in any digital library.

Reestablishment of the priority right is possible if the deadline was missed in spite of all due care.

Patentability:

The list of elements or activities that are not considered inventions (e.g. computer programs) remains unchanged. However, the wording is adapted to article 52.3 of the EPC since the exclusion only applies to the extent that the patent application or patent relates exclusively to one of said elements or activities as such.

The exception to patentability related to surgical or therapeutic treatment methods of the human or animal body and to diagnostic methods applied to the human or animal body is no longer linked to the lack of industrial applicability.

First medical use of substances or compositions is now patentable as well as their second medical uses in the form of purpose-related product claims.

DNA with no indication of any biological function is explicitly added to the list of exceptions to patentability.

European patent applications and National Phase of a PCT in Spain that have an earlier filing date but are published later are explicitly added as prior art for novelty, provided they are published in Spanish initially or at a later stage.

Non-prejudicial disclosures:

Tests made by the applicant are no longer considered non-prejudicial disclosures similarly to article 55 of the EPC.

Non-prejudicial disclosures at exhibitions are now limited to those falling within the terms of the Convention on international exhibitions signed at Paris on 22 November 1928 and last revised on 30 November 1972.

Employees' inventions:

It applies to employees *stricto sensu* but now also to those inventors with a service contract with the employer.

Regarding the inventions that may be claimed by the employer, the new law sets forth a timeframe for the inventor to inform the employer that an invention has been obtained (1 month after completion of the invention). Additionally, an element for the calculation of the financial compensation is added: the compensation may consist in a share of the benefits obtained by the employer for the exploitation or the transfer of rights on the invention.

Rebuttable presumption: the inventions claimed in patent applications filed within 1 year from the end of the employment or service relationship are presumed to have been made under such relationship.

In case of inventions made by the research personnel of Public Universities and Public Research Centres, there is a limitation to the invention disclosure: results cannot be published 3 months before the inventor informs the University/Centre or once a patent application is filed.

Supplementary Protection Certificates and their procedure:

Regulation (EC) 1768/92 –amended by Regulation (EC) 469/2009– related to medicinal products and Regulation 1610/96 related to plant protection products have been incorporated to the text of the patent law.

Bolar Provision:

Studies and clinical testing directed to obtain the market authorization in Spain or abroad do not infringe the patent rights. This includes preparing, obtaining and using of the relevant active ingredient.

Official fees and renewals:

Refund, surcharge, maintenance and tax-exemption provisions are updated. A 50% reduction on filing, search and examination fees and three first renewals is set forth in favour of some entrepreneurs and small business.

Fee reduction (50-100%) of all official fees for Public Universities.

Renewal fees can no longer be paid in advance of the due date.

Rehabilitation and restoration of rights:

Rehabilitation request (force majeure as main requirement) is removed as a means for recovering a lapsed patent. However, restoration of rights is added as general and single measure to recover the rights that have been lost in spite of all due care.

Nullity:

Partial invalidity of a claim is now allowed.

Protective letters:

Any parties foreseeing the petition of an *ex parte* Preliminary Injunction against them by a patent owner may justify their position by filing protective letters before the courts.

Compulsory licenses:

Two scenarios are added: compulsory license to remedy anti-competitive practices and compulsory license to manufacture drugs to be exported to countries with public health problems.

Burden of proof and mediation: before applying for it, the applicant of a compulsory license must obtain evidence of the unsuccessful attempts for obtaining such license from the patent holder. Certificate issued by the SPTO is removed as necessary evidence to prove the exploitation of the invention. Likewise, mandatory mediation is also removed; although the Office may invite the parties to use mediation to reach a suitable agreement.

Jurisdiction and procedural provisions:

They are updated according to the latest reforms to the Civil Procedural Act as well as the Law 19/2006 extending means of enforcement of Intellectual Property rights. For instance, the deadline for replying to a patent infringement lawsuit is extended from 20 days to 2 months and, in case of orders to obtain and preserve evidence, they can be carried out without prior notification in order to assure the good purpose of them.