

SPAIN

How the new Spanish Patent Law affects your filings and rights

Changes in Spain's new Patent Law affect patentable subject matter, filing and litigation.

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On April 1 2017, a new Patent Law entered into force in Spain. The new Law aims to raise patent quality in Spain and changes the provisions for patent eligibility, patent prosecution, patent litigation and even for what constitutes prior art. Right holders with an interest in Spain are well advised to take note of these changes and consider adapting their filing, prosecution and litigation strategies.

Patentable subject matter

Perhaps the most important change in patent eligibility is that the first medical use of substances or compositions is now patentable, and so are second medical uses in the form of purpose-related product claims.

The list of elements and activities that are not considered inventions (such as computer programs) now specifies that the provision only applies to the extent that the patent relates



exclusively to one of these elements or activities as such, bringing the practice into line with that of the European Patent Office (EPO).

DNA with no indication of a biological function is explicitly excluded from patentability, and so are surgical or therapeutic treatment methods and diagnostic methods, which in the previous law were linked to a lack of industrial applicability.

The new law also opens up the possibility to obtain utility models for chemical products, which was not possible before. What has not changed is that methods, biological matter and pharmaceutical products cannot be protected by a utility model.

Filing

The new law prescribes that patent applications concerning inventions made in Spain must be filed first at the Spanish Patents and Trade Marks Office (SPTO). Even if the old law already had a similar provision, it is now more important than before to abide by the law and

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applicants having R&D facilities in Spain may want to take note.

The first filing requirement

In a nutshell: for an invention that was made in Spain, a PCT application or a European patent application *will have no effects in Spain*, unless it is filed at the SPTO, or claims priority from an earlier application filed at the SPTO.

This applies to PCT applications having an international filing date on or after April 1 2017 that choose the national phase route for Spain, and to European applications having a filing date on or after April 1 2017 that are validated in Spain.

Before, it was not uncommon for applicants to file PCT or European patent applications directly at the EPO for inventions made in Spain, since the previous law did not tie any specific consequence to these filings. These applicants may want to reconsider.

Made in Spain

There is no definition in the new law of what is meant by *realizado en España*, which may be translated as made, done or carried out in Spain: the law does specify that an invention is *deemed* to be made in Spain if the applicant has its domicile, registered office or permanent address in Spain, but this is merely an assumption.

If the invention *is* made in Spain, for example because a foreign applicant has research facilities in Spain and an invention is developed there, then the first filing should be made at the SPTO, and the fact that the applicant is a foreign company merely shifts the initial burden of proof to a third party challenging the effect of the patent in Spain.

What about multiple inventors working in several countries? Unfortunately (but not surprisingly, taking into account this issue remains unsolved in most countries with first filing requirements), the new Spanish law does not

specifically address the situation. Under the new law it is now possible to request clearance at the SPTO to first file abroad.

What kind of application can be filed at the SPTO, and what are the formal requirements in each case?

PCT, European and national applications may be filed at the SPTO under the new law. A PCT application must be filed in Spanish, and this will be the language of the PCT and the authentic text for all intents and purposes. The EPO may be designated as International Searching Authority if desired, but an English translation is needed in this case.

A European patent application may be filed with the SPTO in any language, for example in English, and will be forwarded to the EPO. A translation of the title and abstract into Spanish must also be filed. A full translation may be requested by the Office, but this is unlikely at least for inventions that are clearly not related to national security.

Spanish patent or utility model applications may be filed in any language, for example in English. A translation into Spanish has to be provided; however, if the application is only filed to establish a priority date and is then abandoned, a decent machine translation would probably be sufficient. Indeed, a translation does not seem to be necessary for establishing a date of filing and obtaining a priority right. However, this is against the spirit of the law, which clearly intends to allow a national security check.

In case it is not clear from the above summary, let us state explicitly that it is not possible to file a PCT application at the SPTO in English.

If you would like to have a PCT application in English for an invention made in Spain, there are a few options to consider. We would like to point out that the wording of some provisions of the new law may give rise to interpretations that would allow further strategies. However, such interpretations appear to contravene the spirit of the law, and we would therefore advise applicants to remain on the safe side.

Here are the main options that we consider safe when you want to draft in English:

First filing of a European patent application

If your current strategy involves using a European application as first filing, then there is no problem: you simply file your first application under Article 75(1)(b) EPC at the SPTO, including a translation of the title and abstract into Spanish. Unless the invention is deemed of interest to national security and the application is declared secret by the SPTO, it will be forwarded to the EPO very quickly, and you can pick up your usual PCT extension strategy and procedure from there.

However, if in the past you used a PCT application as the priority filing, at the EPO or at an-



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Her professional experience includes drafting and prosecuting patent applications worldwide in a wide range of engineering fields. Her work also involves advising clients on substantive aspects of the patent system, from detecting valuable inventions and building an efficient portfolio to dealing with infringement, freedom to operate and due diligence. She often acts as a technical patent expert in validity and infringement proceedings before the Spanish courts, and has been involved in several pan-European cases in fields ranging from medical devices to elevators.

other foreign office, then you may need to make some changes. Your best option may be to first file a European application, and use the priority right to file a PCT at the EPO, either at the end of the priority year, or as early as one month from the first filing. When filing the European patent application, an applicant can make a strategic choice as to whether or not to pay the official fees.

If you are only interested in the priority right, you may file the European application without paying official fees, and let it be deemed withdrawn after filing. The extra cost with respect to your current strategy of filing a PCT application as first filing would be quite small. If you then file the PCT right away, one month after filing the European application, you should still receive the International Search Report from the EPO in about six months, under the Early Certainty From Search scheme of the European Patent Office.



Yahel Contreras

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She worked as a lawyer and as a consultant in IP matters for several years both in Venezuela and Barcelona prior to joining ZBM in 2005. At ZBM, Yahel is the head of both the international department and the legal department, coordinating IP filings and prosecution worldwide, as well as providing legal advice in-house and to clients including the drafting and analysis of IP contracts.

However, for the same cost, you might also benefit from the possibility of adding developments to the PCT, by filing it at the end of the priority year. The downside here is that you will not receive the International Search Report in the priority year.

Applicants may also file the European application paying the official fees: the EPO will provide the European Search Report in six months, and applicants can file the PCT at the end of the priority year, adding new subject matter and/or using the PCT Direct service to amend/defend the claims. The cost of this option is of course higher, but it may be very good value for money depending on the circumstances.

As a side note, if a positive opinion from the EPO during the PCT phase is important to you, this might be the best strategy: if the first opinion is not what you hoped for, you have the chance of



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Mathieu de Rooij started his career in patents in 2002 at the European Patent Office. During five years he worked as an examiner in diverse technical fields. His tasks involved search and substantive examination as well as document classification. He was also involved in the training of newcomers at the EPO.

While at the EPO, Mathieu passed the European Qualifying Examination in 2007. In 2008, he moved to Barcelona to join ZBM Patents & Trademarks. He became a partner of ZBM in 2011. In the same year, he obtained the European patent litigation certificate, which will allow him to represent clients before the Unified Patent Court. His practice focuses on European patent prosecution including oppositions and appeals, as well as patentability and freedom-to-operate studies. He also regularly acts as a technical expert in Spanish court cases.

defending your claims for free with PCT Direct, instead of paying the rather high fee in International Preliminary Examination (which will still be available if you fail in your first attempt at convincing the examiner). You may also recover at least part of the European search fee.

First filing of a Spanish patent application

Another possibility is first filing a national Spanish application in English, with a translation into Spanish. You are then free to file the PCT at the receiving office of your choice, and you get an additional Search Report from the SPTO in about six months, which can be useful at least as additional information. The priority document is issued by the SPTO in English.

It should also be possible to file the application without paying any fees, just for obtaining a date of filing, but in the first days of application of

the new law this is proving more complex than it should be. In any case it does not appear to have any significant advantage over filing a European application without paying fees.

First filing of a PCT application

You may of course translate your draft into Spanish and first file a PCT application at the SPTO; you may obtain the international search from the European Patent Office by filing also your English text.

However, aside from the cost and delay for translating the draft, there is another drawback in this strategy: your authentic PCT text is a translation, and there is no possibility of correcting translation errors based on your original draft.

Do you really want to first file a PCT application outside of Spain? Well, don't despair: there is a way! All you need to do is request an authorisation from the SPTO. The procedure is simple: you file the request, attaching the text you intend to file abroad and a full translation into Spanish. There is no official fee involved, and the Office will issue a reply within one month.

The PCT in English may then be the first filing. The drawback is obvious: once your draft is ready, you will have a delay of up to one month before you can get your priority application filed. Logically it should be possible to use an early draft of the application to file the request, so as to minimise the delay, but this is not what the law says.

Prosecution

The most significant change in prosecution is that substantive examination became obligatory for all patent applications filed on or after April 1 2017. Before the new law, substantive examination was optional, at the request of the applicant. Many applicants avoided substantive examination and obtained granted patents with possibly broad, and often too broad, scope of protection. Now, all Spanish patent applications but also PCT applications entering the national phase in Spain will have to go through examination. If protection is desired for a PCT application in Spain and one or more additional countries in Europe, the option of going through the EPO might be even more attractive than opting for various national applications, since the automatic grant in Spain is not available anymore.

Moreover, third parties will have the possibility to file observations regarding pending patent applications and examiners can take these observations into account. Additionally, a new procedure is created to oppose the grant of a Spanish patent at the SPTO within six months from grant. The opposition procedure appears to be mirrored to the procedure before the EPO. Similarly to the EPO, patent proprietors now have the possibility to limit claims in a procedure at the PTO after they have been granted.

These changes regarding Spanish patent applications may make the option of obtaining a utility model more attractive. Utility models in Spain

have a maximum life of 10 years and are granted without substantive examination.

There is however a significant change in the definition of prior art when it comes to utility models and now it includes disclosures anywhere in the world, as was already the case for patent applications. Before, only national disclosures were considered to form part of the prior art for utility models, which in some cases made it very hard for alleged infringers to have a utility model invalidated. In this sense, the value of utility models may have decreased a little bit, although they still have the advantage of requiring a lower level of inventive step.

Also, when it comes to litigating a utility model, a right holder must request a prior art search and accompanying written opinion from the SPTO before bringing charges. It is likely that the opinion expressed by the examiner in such a search report will carry significant weight in a lawsuit.

Litigation

The new Spanish patent law also brings about significant changes in litigation. First, a small number of specialised courts to hear IP cases are established. In Barcelona, Madrid and Valencia, specific commercial courts will have exclusive jurisdiction for patent, design and trade mark cases. Concentration of hearings in these courts should lead to further judicial specialisation.

A further change in the law that should help patent owners is that the possibility of amending the claims in a lawsuit is now formally recognised. Moreover, a court can now recognise partial validity of a claim. These two changes can help patent owners to enforce their patents against infringers.

The possibility of filing of protective letters before the courts to reduce the risk of receiving an *ex parte* preliminary injunction is now formally laid down in the law. According to the Law, the protective letters will however be communicated to the patent proprietor, which may be considered as a downside. On the other hand, in recent years, the courts in Barcelona have adopted rapid actuation protocols in order to quickly institute proceedings in relation with renowned trade fairs such as the Mobile World Congress. These protocols have led to preliminary injunctions being handed down even on the first day of the Mobile World Congress. Protective letters might therefore be an interesting defence in relation to these trade fairs.

New threats and opportunities

The new Spanish patent law brings about changes in prosecution and litigation in Spain that represent new threats and opportunities. It will probably also affect filing behaviour for inventions made in Spain and applicants have various possibilities, each with advantages and disadvantages. Stakeholders are well advised to take note of the significant changes.



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