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What can be protected as a “utility model” in Spain after 1 April 2017?

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The new Spanish Patent Act, which will come into force on 1 April 2017, will introduce a modernised “utility model” that is expected to become the natural alternative for “non-examined” patents, which the new law has put at bay.

One of the most controversial provisions dealing with utility models is Article 137, which reads as follows:

“*Article 137. Inventions that can be protected as utility models.*

1. Pursuant to the provisions of this Title, inventions that are susceptible of industrial application, that are new and involve an inventive step, and that confer upon an object or product a form, structure or composition resulting in a practically discernible advantage for their use or manufacture, can be protected as utility models.

2. In addition to the matters and inventions that cannot be patented in application of Articles 4 and 5 of this Act, process inventions and those redounding upon biological matter and pharmaceutical substances and compositions, cannot be protected as utility models.“

The first interpretative problem raised by this article is: what does “process” invention mean? As our German colleagues are well aware, in Germany, the notion of “process” has been interpreted very restrictively, which is the type of interpretation that is expected for a provision that contains an exception to the general rule (“*exception est estrictissimae interpretationis*“). For the purpose of aligning our utility model with the standards of the cradle for utility models, it would be desirable for the Spanish Patent and Trademark Office (“SPTO”) to restrict the applicability of this prohibition to classical industrial processes.

The second interpretative conundrum relates to the meaning of “*inventions redounding upon biological matter*“. The Spanish text uses the expression “*recaigan sobre*” (literally, “*falling on*“), which is a bit odd, although its translation here would be “*redounding upon.*” It is not clear whether the prohibition affects inventions consisting of biological matter or also inventions comprising biological matter. To make things worse, Article 4 of the new law distinguishes between “*a product composed of biological matter*” and a product “*that contains biological matter*.” Apparently, they are not the same thing, although their respective contours are difficult to see.

Finally, the meaning of "*pharmaceutical substances*" is not clear either. Does the prohibition only affect substances having pharmacological properties, as the recitals of the law seem to suggest, or does it also comprise substances used in pharmacy (for example, inert excipients)? The answer, my friend, is blowing in the wind.

All in all, readers should be carefully watching for any potential opportunities arising in relation to the re-defined Spanish utility model. If our courts end up interpreting the aforementioned prohibitions restrictively, the new utility model, like in Germany, may become a major player of the intellectual property landscape.

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This entry was posted on Tuesday, February 21st, 2017 at 10:11 am and is filed under Spain, Utility model
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