

A “cover” utility model might still do the trick

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When the Kingdom of Spain joined what were then called the European Communities (the “EC”) in 1986, it had to approve a new Patents Act which sought to adapt Spain’s patent law to the standards required by the EC. For example, for the purpose of avoiding that an infringer could invoke a “cover” patent or utility model as a defence in an infringement action based on an earlier patent, Article 55 of the 1986 Patents Act stated that *“the holder of a patent will not be entitled to invoke the patent as a defence in actions brought against it for infringement of other patents with an earlier priority date.”* However, notwithstanding this provision, a recent judgment issued by the Burgos Court of Appeal illustrates that “cover” patents (in this case, a utility model) might still do the trick in Spain. The main aspects of the case may be summarised as follows:

An Italian company filed an infringement action against a Spanish company based on patent EP 2.189.573 (“EP’ 573”), which protects an artificial turf structure and a method of manufacturing the same, and whose priority date is 21 July 2005. The application was published on 26 May 2010. In its defence, the defendant invoked utility model 1.074.013, which had resulted from an application filed on 26 October 2010. The Court of First Instance dismissed the infringement action on the grounds that for the infringement action to succeed, the owner of patent EP’ 573 should have first obtained the revocation of the utility model invoked by the defendant.

The owner of patent EP’ 573 filed an appeal before the Burgos Court of Appeal whereby, quite understandably, it alleged that the first instance judgment breached Article 55 of the 1986 Patents Act, cited above. However, in a judgment handed down on 27 July 2017, the Burgos Court of Appeal upheld the decision. According to this Court, the fact that the application for the utility model was filed before the owner of the European patent obtained provisional protection in Spain pursuant to Article 67 of the European Patent Convention, would confer immunity from infringement actions based on such European patent.

All in all, the lesson to be learnt from this judgment is that, no matter how clear the wording of Article 55 of the 1986 Patents Act may be, a “cover” utility model might still do the trick in Spain.