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Limiting your European Patent nationally

Miquel Montaña (Clifford Chance) · Tuesday, May 8th, 2018

The new Spanish Patent Act, which came into force on 1 April 2017, introduced numerous improvements aimed at modernising an old and archaic patent system that needed a total reform. One of the aspects introduced by the new Act is the possibility of limiting the patent before the Spanish Patent and Trademark Office, after it has been granted. In particular, Article 105 of the new Patent Act reads as follows:

Revocation or limitation at the request of the patent holder

Article 105. *Application to revoke or limit a patent.*

- 1. At the request of the patent holder, any patent definitively granted may be revoked or limited by modifying the claims at any time during the patent's legal lifespan, including the period when supplementary protection certificates are in force, as the case may be.*
- 2. Applications to revoke or limit a patent addressed to the Spanish Patent and Trademark Office must be made using the official form established for this purpose and will only be deemed valid if the corresponding fee is paid.*
- 3. The revocation or limitation of a patent will not be permitted if in rem rights, purchase options, embargos or licences recorded at the Patent Registry exist over it, with there being no record of the consent of the holders of those rights. Nor will an application to revoke or limit a patent be permitted if a court claim for the patent's ownership or the acknowledgement of other asset rights over it has been recorded at the Patent Registry, if the claimant has not provided its consent.*
- 4. When legal proceedings are underway regarding the patent's validity and notwithstanding the provisions of Article 120, the application to limit the patent, addressed to the Spanish Patent and Trademark Office, must be authorised by the Judge or Court hearing the proceedings.*

According to the Implementing Regulation of the new Act, in the absence of defects, a decision on the limitation request must be made within 3 months.

In addition, as in other European countries such as Germany, this procedure may be used to limit all types of patents, regardless of whether they were granted by the European Patent Office or by the Spanish Patent and Trademark Office.

So, owners of European patents, please be aware of the possibility of limiting your

European patent nationally.

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