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Is a non-translated European patent enforceable in Spain?

Miquel Montaña (Clifford Chance) · Monday, June 7th, 2010

The possibility of enforcing, in Spain, the non-translated claims of a European patent is one of the issues dealt with by the Barcelona Court of Appeal in its recent Ruling dated 15 April 2010.

In that particular court case, a European patent holder applied for interim injunctions on the basis of a revised translation of its patent claims which had been filed before the Spanish Trademark and Patent Office but which had not yet been published in the Spanish Official Intellectual Property Gazette. According to the patent holder, the claims included in the revised translation should be enforceable even if the publication of the same had not yet taken place.

This argument was based on Article 64.1 EPC. Although the Spanish version of this Article 64.1 EPC is not clear as to whether or not the publication in the European Patent Gazette is sufficient for the patent to produce effects, or whether its publication in each Contracting State's Gazettes is also requested, the original EPC texts (in English, French and German) suggest that the protection conferred by the European patent begins on the date on which the mention of its grant is published in the European Patent Gazette, regardless of when it is published in the rest of the Contracting State's Gazettes.

The Barcelona Court of Appeal ultimately rejected the patent holder's application, on the basis that Article 65.3 EPC expressly confers upon the Contracting States the possibility of prescribing that, in the event of the failure to observe the additional translation requisites adopted in accordance with paragraphs 1 and 2 of Article 65 EPC, the European patent will be deemed to be void ab initio in that State. In this respect, Spanish Royal Decree 2424/86, dated 10 October 1986, which implements the EPC, expressly sets forth the obligation to publish a Spanish translation of the European patent in the Spanish Official Intellectual Property Gazette within the three months after the mention of its grant has been published in the European Patent Gazette.

Thus, the Barcelona Court of Appeal, in line with its former Judgment dated 2 October 2008, considered that the publication of the Spanish translation was "constitutive" in nature (i.e. not merely "declaratory"). Consequently, if this requisite is not fulfilled and the European patent translation has not been accepted and published by the Spanish Trademark and Patent Office in the corresponding Gazette, it will not be possible to enforce the European patent before the Spanish Courts.

This conclusion has been criticized on the grounds that the EPC only requires the "deposit" of the translation, and that it would not be fair to make the enforceability of a translation dependent on the time it takes for the Patent Office to publish the translation (or on the translation being

published at all), a fact which is beyond the patentee's control.

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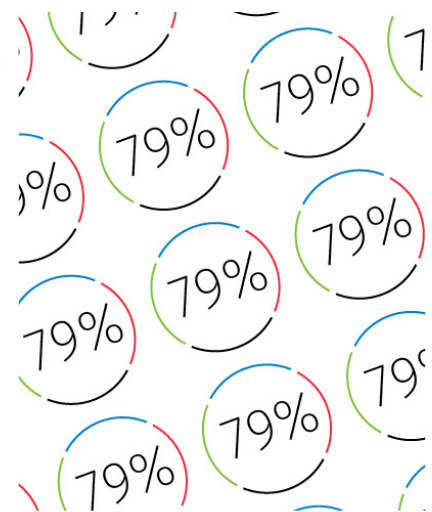
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