Kluwer Patent Blog

Will Father Christmas bring a new Spanish Patent Act for 2014?

Miquel Montañá (Clifford Chance) · Tuesday, December 24th, 2013

One of the “co-lateral” damages expected from the latest Pixar Films’ type of productions coming from the European Commission (the European patent with unitary effect and the Unified Patent Court (“UPC”) fostered by the Commission behind the scenes) is the increase of patent applications filed before national patent offices. Stakeholders are growing concerned that the final product looks more like “Monsters Inc.” (it may be an irony of destiny that the first known patent was granted to a boat called “The Monster”!) than like the expected promised land.

Against this background, the recent publication of a new draft of the “Patent Act” by the Spanish Patent and Trademark Office (“SPTO”) may be interpreted as a sign that the Spanish government is planning to put in place a more modern and robust patent law that may be used as an alternative to the European patent with unitary effect. Experience shows that in countries with robust patent laws, such as the United Kingdom, the national route is an attractive one.

Unfortunately, in a blog like this, life is too short to make detailed comments on the new draft, although some key points may be highlighted:

In a country that is seeking the excellence that may help us leave the economic downturn behind, it is a matter of regret to read that *the very first sentence* of the draft refers to the old law as “Law 11/1986, of 12 March, on Patents,” whereas Law 11/1986 was not approved on 12 March but on 20 March. The reader might wonder whether, in spite of this initial mistake, the draft gets any better as the reader moves on. It does not. Although the Recitals of the draft announce the intention to modernise the Spanish Patent Act to the requirements of the new times, in many aspects the draft is far from giving stakeholders a more robust platform.

For example, it continues to mix up the “Experimental Use Exception” and the “Bolar Exception”, ignoring the case law from the Supreme Court, which has stressed that they are two different exceptions with different histories and legal rationales. Even worse, the draft goes on to state that the “Bolar Exception” applies to acts related to generic medicines only, which is an unjustified discrimination against innovators.

Another example is that the new draft does not include, for Spanish patents, a provision

similar to article 138.2 of the European Patent Convention ("EPC"), which states that "if the grounds for revocation affect the European patent only in part, the patent shall be limited by a corresponding amendment of the claims and be revoked in part". And whereas it has included a provision similar to article 138.3 of the EPC, allowing patentees to amend the claims before the Court to overcome nullity objections, it would be desirable to provide additional guidance to stakeholders as to when and how these amendments should be sought.

Hopefully, tonight Father Christmas will bring the necessary inspiration so that when the works on the draft Patent Act resume in 2014, our government will take everyone's comments on board so that the final product is at the level of what inventors deserve.

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