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Spanish amendments to the draft new Patents Act: will Spain have rickshaws instead of cars in the streets?

Miquel Montañá (Clifford Chance) · Thursday, April 30th, 2015

In September of 2013, the Spanish Patents and Trademarks Office ("SPTO") published a draft Patents Act aimed at modernising the old Act 11/1986, of 20 March, on Patents, which is close to celebrating its 30th anniversary. After hearing the stakeholders concerned, on 11 April 2014 the Council of Ministers approved the draft and sent it to Parliament, hoping that the new law could be approved before the next elections, which are expected to take place during the third or fourth quarter of 2015.

The forthcoming elections appear to be the only rational explanation for a few of the amendments proposed by some of the parliamentary groups, which were published on 13 April 2015. Rather surprisingly, according to one of the amendments proposed by the Parliamentary Group of "IU, ICV-EUiA, CHA: La Izquierda Plural" (a coalition of former communist and greenish political parties) "trivial improvements, crystalline forms, optical isomers or analogy processes" shall not be considered patentable inventions. Another amendment is aimed at excluding from patentability "the simple mixture of two or more products already patented before and the second uses or indications of a product already patented or the mere discovery of a new property."

These amendments, clearly inspired by Indian legislation, are surprising from at least two angles. First, the amendments clearly go against the mainstream, as it is becoming increasingly apparent that the future of the pharmaceutical industry lies, to some extent, in the invention of new medical uses for chemical compounds that are already known. For example, the AIPPI, in the last meeting held in Toronto on 15 September 2014, approved a Resolution on Question Q238 (Second medical use and other second indication claims) highlighting, among other aspects, that "second medical uses may provide solutions to unmet medical needs and significant benefits to patients. They may require significant investment in research and development and represent socially, medically and economically valuable inventions." Second, and perhaps even more importantly, they would be hamstringing Spanish small and medium-sized pharmaceutical companies, which are the main users of national patents. If these amendments were to pass muster, such companies would be prevented from using the national patent route to protect valuable inventions such as second medical uses of known compounds. By contrast, larger companies would of course be able to obtain this type of patents from the European Patent Office, as they have been accepted in the European patent system for

decades. In fact, one of the goals when amending the European Patent Convention in November of year 2000 (EPC 2000) was to further reinforce the protection of second indication claims.

All in all, reading this type of amendments leads one to wonder whether politicians really reflect on the practical consequences of the amendments that they draft before sending them to Parliament. Perhaps the next amendment will exclude car components from patentability with a view to having cars replaced by rickshaws in Spanish streets. Why should other industries be allowed to protect their incremental innovations, and the pharmaceutical industry not?

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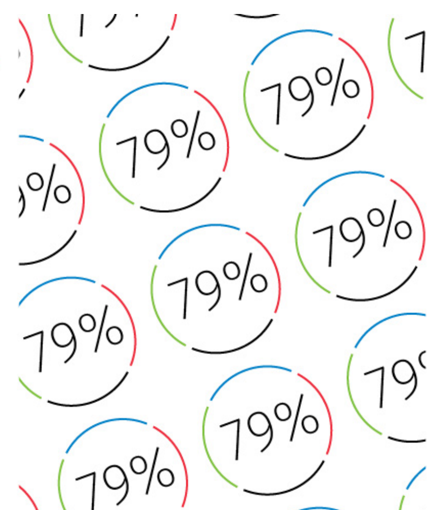

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This entry was posted on Thursday, April 30th, 2015 at 6:18 pm and is filed under G 1/93,

OJ 1994, 541) *The 'gold standard'* of the European Patent Office's Board of Appeal is that *any amendment can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed (G 3/89, OJ 1993,117; G 11/91, OJ 1993, 125).*">Amendments, Spain

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