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Spanish Court clarifies that "restitutio in integrum" applies to SPCs

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The legendary deficient regulation of supplementary protection certificates ("SPCs") has caused the Spanish Patent and Trademark Office (the "SPTO") and Spanish Courts to struggle as to whether or not the "restitutio in integrum" procedure available to patents is also applicable to SPCs. The High Court of Justice of Madrid, in a recent Judgment of 22 April 2015, has reached an affirmative conclusion, thus revoking a decision of the SPTO that had rejected the applicability of "restitutio in integrum" to SPCs. The facts of the case may be summarised as follows.

A U.S. company filed an application for an SPC before the SPTO after the deadline established in Article 7 of Regulation 2009/469/EC (the "SPC Regulation") alleging that the Judgment of the Court of Justice of the European Union (the "CJEU") in Case C-130/11 ("Neurim Pharmaceuticals") had changed the test applicable to the admissibility of SPCs based on marketing authorisations for second medical uses. According to the applicant, it would not have been able to file the application within the deadline, as at that time the test formerly applied by the CJEU would have led to the rejection of the application. The applicant added that these circumstances would justify the restoration of its right to file an application for an SPC under the new test ("restitutio in integrum").

On 24 June 2013 the SPTO rejected the application on the grounds that the "restitutio in integrum" procedure was not applicable to patents in the first place. In particular, the SPTO came to the conclusion that:

"An SPC is a "sui generis" form that is governed by Council Regulation (EEC) No. 1768/92 of 18 June 1992, concerning the creation of an SPC for medicinal products, Article 18 of which establishes that, "In the absence of procedural provisions in this Regulation, the procedural provisions applicable under national law to the corresponding basic patent shall apply to the certificate ...". This Article defers to the provisions of national law governing the basic patent in the event that Regulation (EEC) 1,768/92 does not contain procedural provisions, which cannot be regarded as including the restitution of rights. Indeed, the restitution of rights is an exceptional legal form, insofar as it affects legal security, operating independently of a procedure such as the grant of an SPC, and it is therefore not a procedural provision but rather a matter of substantive law. Furthermore, the restitution of rights is governed, as far as the issue in this present case is concerned, under Article 25 of Spanish Trademark Act 17 of 7 December 2001. This Act postdates Regulation (EEC) No. 1768/92, and Article 25 applies to other categories of intellectual property, pursuant to the Seventh Additional Provision of the Act, which expressly lists the various

categories (“... patents, utility models, topography of semiconductor products and industrial and artistic models and drawings.”). These do not include the SPC, which would seem to suggest that the lawmakers wanted to exclude this particular item from application of the rules governing the restitution of rights. We should therefore understand that a request for the restitution of rights is not applicable in this case.”

Article 25 of the Spanish Trademark Act of 7 December 2001 establishes that, “an applicant for or holder of a trademark, or any other party involved in proceedings with the Spanish Patent and Trademark Office, who has shown all the due diligence required in the circumstances but has nevertheless been unable to respect a deadline set by the said Office shall, upon request, have his or her rights re-established if the inability to meet the deadline directly results, under the terms of this Act or its regulations, in the loss of a right”. Section 2 establishes that, “such requests must be submitted in writing from the moment that the obstacle is removed, in the manner and within the term set out in the regulations. The breached process must be completed within this term. The request shall only be admissible within a period of one year following the expiry of the unmet deadline”. The seventh additional provision of the said Spanish Trademark Act establishes that, “1. The rules contained in Article 25 of this Act shall apply, in all cases that are not incompatible with the nature of the Article itself, to patents, utility models, the topography of semiconductor products and industrial and artistic models and drawings. 2. In addition to the exceptions provided for in section 5 of Article 25, the terms set out in sections 1 and 2 of Article 33 or section 2 of Article 39 of Spanish Patent Act 11 of 20 March 1986 shall not apply to the restitution of rights.”

Taking into account that the above provision does not explicitly refer to SPCs, the SPTO took the narrow view that SPCs are not included within the group of intellectual property titles that may benefit from the “restitution in integrum” procedure.

This narrow interpretation has now been rejected by virtue of the Judgment of 22 April 2015 from the High Court of Justice of Madrid which, after making a less literal and more purposive interpretation of the relevant norms, has reached the conclusion that:

“There is no objective justification whatsoever for excluding supplementary protection certificates from this rule when it applies to patents, even though the Judgment by the European Court of Justice of 11 December 2003 (Case C-127/00, Håssle AB v. Ratiopharm GmbH) established the preclusive nature of the deadline for requesting an SPC [...]”

After having reversed the SPTO’s decision on this count, the Court then moved on to consider whether the substantive requirements for accepting the “restitutio in integrum” were met in this case. In this regard, the Court came to the conclusion that, in the case at hand, these requirements were not met, as – according to the Court – the applicant should have filed the application within the deadline in the expectation that the CJEU case law might have changed in due course, or requested the Courts to refer the case to the CJEU, as the referring Court did in the Neurim case.

In conclusion, the lesson stemming from this case is that although – contrary to the SPTO’s view – “restitution in integrum” does apply to SPCs, applicants should not miss the deadline, just in case.

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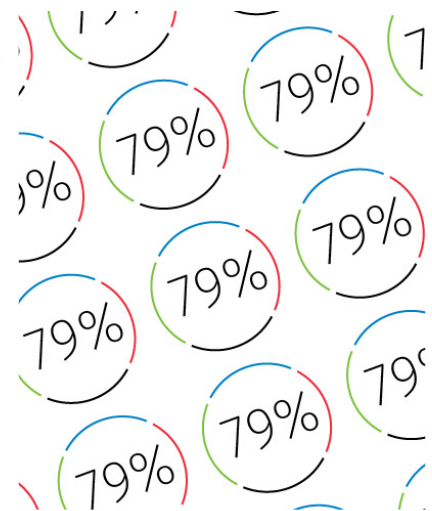
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