

# Kluwer Patent Blog

## New Spanish Patents Act coming into force on 1 April 2017

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On 25 July 2015, the Spanish Official State Gazette published the text of Act 24/2015, of 24 July 2015, on Patents (“New Patents Act” or “the new Law”), which is due to come into force on 1 April 2017. Although a blog is too short a place to discuss a law that has 186 articles, 10 “additional provisions”, 6 “transitory provisions”, 1 “derogatory provision”, and 9 “final provisions”, what follows is a short account of the aspects that the author finds of particular interest:

The first aspect deals with the examination and granting procedure, which has been changed completely. The New Patents Act has abandoned the “à la carte” examination procedure, whereby applicants were free to choose whether or not their application should be subjected to substantive examination. In practice, more than 90 % of applicants opted not to have their applications subjected to substantive examination, which resulted in the granting of very weak patents. As explained in the Recitals of the New Patents Act, this transferred the burden and cost of invalidating patents that should not have been granted in the first place to third parties. To correct this anomaly, as mentioned, the New Patents Act only envisages one granting procedure which has been modeled on the standards of the most modern patent systems. Although according to the Recitals of the new Law, the objective of this reform is “to facilitate the rapid grant of strong titles by Spanish inventors, the main users of the system, as more than 95 % of the patents granted via the national route are of Spanish origin”, this dramatic change may also be appealing to foreign applicants, who may find the new and robust national patent a suitable alternative to the European patent with unitary effect, taking into account the uncertainties that will surround the latter, at least during the first few years. For example, due to their quality, English patents have traditionally been a robust alternative to European patents.

Second, to counterbalance the “loss” of “non-examined” patents, the new Law has improved the legal regime of utility models, which will become the natural substitute for “non-examined” patents. Although during the discussions that led to the approval of the new Law some sectors advocated for the elimination of utility models, Parliament felt that suppressing “non-examined” patents without giving applicants a back-up alternative (i.e. “utility models”) would have been too much of a change. One of the main modifications to the legal regime of utility models is that the new Law has broadened the array of inventions that may be protected via a utility model. However, the new Law has specifically excluded pharmaceutical substances and compositions, an unjustified discrimination that will no doubt be tested at Court at some point. Another important change is that for the purpose of examining the novelty and inventive activity of utility models, the state of the art that must be taken into account will be the same as in the case of patents (until now it was limited

to what had been divulged in Spain). However, an invention will be deemed to imply inventive activity if it does not result from the state of the art “in a very obvious” way for the person skilled in the art. So the threshold of inventive activity continues to be lower than in the case of patents.

Third, following in the footsteps of EPC 2000, the new Law has introduced new provisions dealing explicitly with the patentability of second medical uses of already known chemical compounds. This change must be welcome, taking into account the increasing importance of this type of invention, as discussed in the last annual meeting of the AIPPI which took place in Toronto on 15-17 September 2014.

Fourth, the new Law deals for the first time with the legal regime of Supplementary Protection Certificates (“SPC”). However, this is less relevant than would appear at first glance, as the substantive provisions are a copy-paste from the SPC Regulation.

Fifth, the new Law has fine-tuned the legal regime of other miscellaneous aspects, such as the scope of the “Bolar” provision. In particular, it has made it clear, following the case law from the Supreme Court, that the “experimental use” exception and the “Bolar” exception are two different and independent exceptions, with different origins and contents. In addition, following EPC 2000, it has introduced a provision stating that for the purpose of determining the scope of protection of the patent, one must take into account all elements equivalent to an element included in the claims.

Sixth, other important changes affect the enforcement of patents. For example, the new Law has incorporated the legal regime dealing with “post-grant” amendments contained in EPC 2000. Another significant change is that the calculation of damages will be postponed until the so-called “execution phase.” This will avoid the time and cost involved in the calculation of damages in the “declaratory phase”, that is, before it has been established whether or not the patent has been infringed. Another change is that the term to file a statement of defense has been extended to two months. Until now it was just 20 working days.

Seventh, another remarkable change is that the new Law limits the competence to deal with patent cases to Commercial Courts specifically specialized to deal with patent cases. Prior to this, the only specialized Courts were Commercial Courts 1, 4 and 5 in Barcelona. One of the “collateral effects” of the new Law is that it has prompted Commercial Courts in Madrid to also designate a few Courts to specialize in patent cases. Otherwise, the Madrid Commercial Courts would not have had jurisdiction to deal with patent cases under the new Law. Unless Courts from other Spanish Autonomous Communities follow suit, under the new Law only Commercial Courts of Barcelona and Madrid will be competent to deal with patent cases.

All in all, the new Law should place the grant and enforcement of Spanish patents on the same level as the countries of the world with the most advanced patent systems. Let’s hope that the economic upturn prompts the Spanish Government to provide the Spanish Patents and Trademarks Office and the Courts with the resources that they need to make the list of good intentions that transpires from the new Law a reality.

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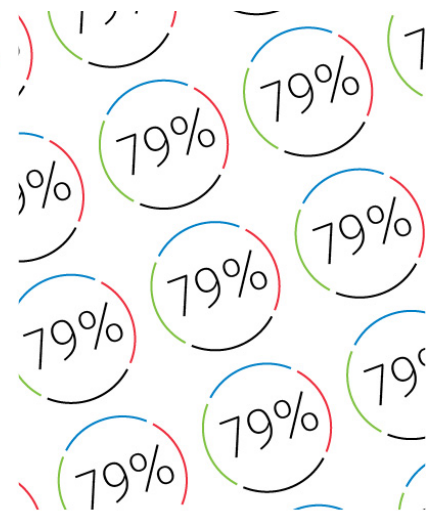
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