

Kluwer Patent Blog

Draft implementing regulations of new Spanish Patents Act published: Form obsession!

Miquel Montaña (Clifford Chance) · Tuesday, March 29th, 2016

The Spanish Patents and Trademarks Office (“SPTO”) has submitted the draft of the Implementing Regulations of the new Spanish Patents Act, which is due to come into force on 1 April 2017, for public consultation. In general, anybody familiar with the Implementing Regulations to the European Patent Convention (“EPC”) would not have great difficulty navigating the waters of its draft Spanish counterpart. However, there is a handful of points that certainly raise one’s eyebrows, two of which will be briefly discussed in this blog.

The first is the obsession for forms. Reading the draft, one has the impression that the applicants’ representatives will not be able to say “Good morning!” upon entering the SPTO’s premises, let alone go to the toilet, without having previously filled in the corresponding form. It would be desirable for the SPTO to take a more flexible approach when the final version of the Implementing Regulations is approved. For although forms should certainly be available to applicants for reasons of convenience, their use should not be mandatory.

The second is a very striking provision whereby if the validity of a patent has been challenged before a Spanish court, the SPTO will only be able to deal with any parallel oppositions filed against the same patent if the judge so authorizes. In particular, Article 40 of the draft Implementing Regulations reads as follows:

“Article 40. Judicial authorisation for processing opposition procedures

- 1. When judicial proceedings in relation to the patent recorded in the Patent Register are in progress, the SPTO will notify the court that the writ of opposition has been admitted, so that the latter sends authorisation for the procedure to go ahead. Authorisation will be considered granted if the court fails to reply within said term.*

The court order authorising the continuation of the procedure will be reasoned and must necessarily contain:

– the grounds for the authorisation

– a copy of the ruling ordering the stay of the judicial proceedings in accordance with the provisions of Article 42 of the Civil Procedure Act until a final administrative decision is handed down and, if applicable, until the subsequent judicial review avenue is exhausted.

2. *If, after an opposition procedure has begun, judicial proceedings regarding the patent are notified and registered in the Patent Register, the SPTO will notify the judicial authority so that it authorises the continuation of the procedure within one month. Authorisation will be considered granted if the Court fails to reply within said term.*

The court order authorising the continuation of the administrative procedure will contain a copy of the ruling ordering the stay of the judicial proceedings in accordance with the provisions of Article 42 of the Civil Procedure Act.

3. *In both cases, either of the parties to the judicial proceedings may intervene in the opposition procedure, provided they file the writ of opposition in the manner envisaged in Article 36 of these regulations and within two months of when the judge or court authorises the processing of the opposition procedure and notifies the litigants of the existence thereof.*
4. *Upon conclusion of the opposition procedure, the SPTO will notify the court of the decision, providing it with a copy of the patent as amended, if applicable.”*

As readers will have noticed, the draft assumes that if the court authorizes the continuance of the opposition procedure, it will have to stay the court proceedings until the opposition has been resolved by a final decision. This is of course very odd, as it would cause a granted patent to become dead wood for years. This astonishing provision would cause Spain to become the world *torpedo* capital. So, hopefully, it will be removed from the final draft.

In conclusion, subject to some fine-tuning, these Implementing Regulations should guarantee the success of the brand new Patents Act, which, in turn, is expected to raise the prestige of Spanish patents dramatically.

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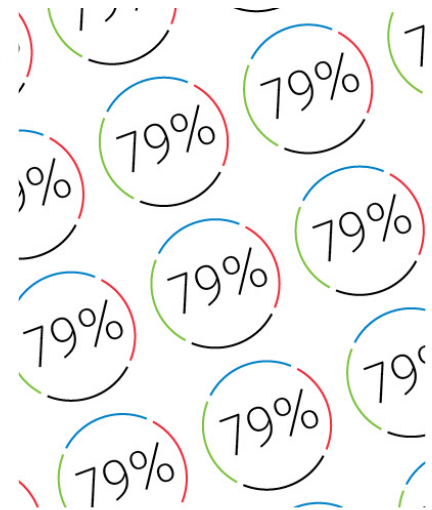
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