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Incyte judgment prompts change of direction of the Spanish Patent Office in pending appeals

Miquel Montaña (Clifford Chance) · Tuesday, July 3rd, 2018

Historically, the Spanish Patents and Trademarks Office (“SPTO”) has rejected the correction of the registered term of supplementary protection certificates (“SPCs”), even in cases where such term has had to be recalculated due to the new case law emanating from the Court of Justice of the European Union (“CJEU”). As reported in our posts of January 2018, following the judgment of 20 December 2017 of the CJEU in case C-492/16 (“*Incyte*”), the SPTO modified its historical position. In particular, it published a “Notice to Applicants” informing that it would now allow the modification of entries registered in the SPTO so that the published term of protection may be recalculated, pursuant to the case law of the CJEU. So far, so good.

However, this did not help the owners of SPCs who had been denied the possibility of recalculating their term before the *Incyte* judgment was published. In some cases, such decisions were appealed by the owners of such SPCs before the so-called “contentious-administrative courts.” Although in those cases the SPTO initially filed a statement of defence requesting the dismissal of such appeals, after the *Incyte* judgment was published, the “state attorney” representing the SPTO filed a writ accepting the appeal. As a result, the High Court of Justice of Madrid (“Tribunal Superior de Justicia de Madrid”) issued two judgments on 3 April 2018 upholding the appeals and ordering the SPTO to recalculate the term of the SPCs, taking into account the date on which the SPC owner was notified of the decision granting the marketing authorisation (i.e. the criteria laid down by the CJEU in *Incyte*).

All in all, these judgments will further align Spain’s administrative and judicial decisions with the interpretations laid down by the CJEU.

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