



EXCO MEETING, CAPE TOWN 13 & 18 APRIL 2015

COUNTRY REPORT	
TITLE:	Country report for <i>SPAIN</i>
DRAWN UP BY:	<i>ANTONIO TAVIRA</i>
TABLED TO:	FICPI delegates
PURPOSE:	For information and consideration
SNIPPET:	News from and activities of the FICPI national group in <i>SPAIN</i> since the Barcelona ExCo in November 2014.

SECTION A: ACTIVITIES OF FICPI ASSOCIATION/SECTION

The information supplied in Section A will remain confidential on FICPI's website after the ExCo (will require a password).

SECTION B: CHANGES IN LAW

Information supplied under Sections B and C will be published on FICPI's website after the ExCo and will be available to the public.

B1. LEGISLATION

1. Please provide details of any changes to IP legislation (patent, trade mark, design and other) in your country implemented or due to be implemented since you reported last in October 2014. *Spain's Congress of Deputies' decision to refer the draft Parliamentary Bill for a new Patent Act to its Committee on Industry for approval was published on 28 November 2014. The deadline for submitting amendment proposals expired on 18 December 2014.*

The draft bill stipulates that the new Act will not take effect until 1 December 2016. That date has been chosen because the Implementing Regulations to the Act have not yet been drafted or opened to public consultation, and the Ministry of Industry wants both the Act and the Implementing Regulations to come into force at the same time.

In undertaking this revision to the Patent Act Spain's Government has a number of goals in mind. For one, it wants to simplify administrative procedures by creating a single, fast-track patent granting proceedings (10 months) that includes a patentability examination; for another, it wants to avoid the unwarranted exclusive rights that are currently conferred by patents granted without a substantive examination.

B2. MAJOR CASES

2. Please provide brief details of any new case law in the field of patents, trademarks, design or other IP of general interest.



- On 24 November 2014 Chamber 3 of the Contentious-Administrative Appeal Division of Spain's Supreme Court overturned the grant of registration for utility model no. 200701042 on grounds that it was devoid of novelty and inventive step. This judgment reversed the earlier judgment by Chamber 2 of the Contentious-Administrative Appeal Division of the High Court of Justice of Valencia.
- On 15 December 2014 Spain's Supreme Court dismissed the cassation appeal lodged by the relevant administrative body of the Central Government, thereby allowing the grant of a supplementary protection certificate. The Supreme Court held that granting a supplementary protection certificate for a combination of various active ingredients covered by Merck's basic patent no. 93306114.5 relating to Benzoxazinones did not exceed the scope of protection accorded by the basic patent.

B3. OFFICIAL PRACTICE

3. Please provide details of any changes in official patent and trade mark office practice which would be of general interest to other members.

B4. PROPOSALS FOR CHANGES

4. Please provide details of any proposed changes in IP laws or practice and indicate if your National Association/Section is involved in providing comments to such changes. Would it be of assistance to have input from the CET on any proposed changes?

- Case law by the Court of Justice of the European Union relating to Articles 27 and 70 TRIPS Agreement

In a case involving Daiichi Sankyo Co. Ltd. (owners) and Sanofi-Aventis Deutschland GmbH (licensees), a Greek court of first instance in Athens referred a request for a preliminary ruling to the Court of Justice of the European Union concerning interpretation of Articles 27 and 70 TRIPS, and by its judgment of 18 July 2013 the Court ruled that a patent obtained following an application claiming the invention both of the process of manufacture of a pharmaceutical product and of the pharmaceutical product as such, but granted solely in relation to the process of manufacture, does not, by reason of the rules set out in Articles 27 and 70 of the Agreement on Trade-Related Aspects of Intellectual Property Rights, have to be regarded from the entry into force of that agreement as covering the invention of that pharmaceutical product.

This judgment would appear to be at odds with previous case law handed down by Spain's Supreme Court, which had ruled that, from entry into force of the TRIPS Agreement in Spain, the Government of Spain was compelled to recognize the effects of pharmaceutical product claims in patents filed or granted under the previous legislation and still in force which had been denied pursuant to the reservation in Spain's Patent Act.

This has given rise to considerable debate in Spain concerning the intangibility nature of judgments that are final in Spain and concerning the competence of the CJEU to interpret the TRIPS Agreement and its position.

- No official comment by the Government of Spain concerning the Opinion of 18 November



2014 by the Advocate General, Yves Bot, on the appeals brought by Spain seeking annulment of Regulations Nos. 1257/2012 and 1260/2012 implementing enhanced cooperation in the area of the creation of unitary patent protection holding that the appeals should be dismissed.

However, the Advocate General's opinion in case C-147/13 relating to the translation arrangements applicable to the said Regulations Nos. 1257/2012 and 1260/2012 has been much discussed in Spanish legal circles. The Advocate General's opinion is that the linguistic discrimination ensuing from application of the said Registrations does not infringe the EU Treaties, because in those Treaties there is no principle of equality of languages.

SECTION C: OTHER INFORMATION

Please provide details of any other information pertaining to your country or region that would be of general interest to FICPI members and other IP practitioners browsing FICPI's website.

C1. QUALIFICATION AND THE RIGHT TO REPRESENT CLIENTS BEFORE A COURT

- 1.1 Please describe the qualification process for becoming a patent attorney in your country/region.

Candidates (both Spanish nationals and nationals of other Member States of the European Union) seeking to qualify as an "Agente de la Propiedad Industrial" [Official Industrial Property Agent] must be in possession of an official academic degree and must pass a certifying examination consisting of three written papers:

- one on Spanish patent and trademark legislation and regional or worldwide international IP conventions;
- one posing two practical cases, one for trademarks and one for patents;
- translation (no dictionaries allowed) of two texts relating to industrial property, testing knowledge of vocabulary, grammar structures, and comprehension; one translation is from English into Spanish, the other from Spanish into English.

- 1.2 Has the patent attorney qualification process changed in any way in the past 5 years?

The qualifying procedure has not changed in the past five years.

- 1.3 Does qualification as a patent attorney permit you any right of representation before any Court in your country?

Certification as an Official Industrial Property Agent confers no entitlement to practice before our country's courts.

- 1.4 If so are there any special requirements or restrictions?

- 1.5 Are qualified lawyers in your country permitted to work in the patent field without any further qualification?

Spanish and EU natural and legal persons (the latter through their legal representatives [qualified lawyers]) may both act directly before the Spanish Patent and Trademark Office.

However, persons applying to the Spanish Patent and Trademark Office for industrial property rights who are not EU nationals must be represented by an Official Industrial Property Agent.

If so are there any restrictions on what they may do?

Yes

If so, please describe those restrictions.

Validation in Spain of European patents granted by the European Patent Office requires submitting a translation of the text as granted into Spanish, prepared either by an Official Industrial Property Agent or by an official sworn translator appointed by the Spanish Ministry of



Foreign Affairs.

- 1.6 Please describe what privilege attaches to patent attorney communications including any restrictions.

The Spanish Patent Office has opened a consultation to enable interested Spanish parties to give their opinion to the Group B+, which is considering the issue of "client privilege" in the framework of the draft Patent Law Harmonization Treaty within WIPO.

When it has compiled the opinions of the various parties, the Spanish Patent Office will issue its response to the questionnaire from the Group B+.

The Spanish Patent Office has let it be known that this question is not being addressed in the proposed new Spanish Patent Act, currently in the drafting stage, pending the final conclusions of the Group B+ on this issue.

- 1.7 Please describe the qualification process for becoming a trade mark attorney in your country/region.

The same as 1.1

- 1.8 Has the trade mark attorney qualification process changed in any way in the past 5 years?

The same as 1.2

- 1.9 Does qualification as a trade mark attorney permit you any right of representation before any Court in your country?

The same as 1.3

If so are there any special requirements or restrictions?

- 1.10 Are qualified lawyers in your country permitted to work in the trade mark field without any further qualification?

The same as 1.5

If so are there any restrictions on what they may do?

If so, please describe those restrictions.

- 1.11 Please describe what privilege attaches to trade mark attorney client communications including any restrictions.

The same as 1.6

C.2 CET AND PEC SPEAKERS

- 2.1 Would your National Section/Association be interested in obtaining assistance from FICPI, through either the CET Work and Study Group or the Professional Excellence Commission (PEC), in providing speakers for seminars organized by your national group in your country?

Under study if we organize any seminar.

- 2.2 If your group does, or in the future might, require such assistance, please identify topics that might be of interest to your members, with a view to raising FICPI's profile and providing added value from membership of FICPI in your country.

N/A

C.3 TOPICS OF INTEREST

- 3.1 Please list three IP topics that are of particular interest to you and/or your national section members.

N/A

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