

Spain

Administrative procedure

Opposition

In Spain, a post-grant opposition procedure is available. Any person may file notice of opposition against patents up to six months after publication of the mention that a patent has been granted in the Official Gazette.

In such cases, opposition may not be founded on the grounds of lack of right to apply for the patent, which constitutes an issue that would have to be settled by the Spanish civil courts.

The Spanish Patent and Trademark Office (OEPM; hereinafter the “Patent Office”) informs patent proprietors of any oppositions it receives and sets a three-month time limit for them to reply or to make appropriate amendments to the patent.

The Patent Office forwards the observations and amendments filed by the proprietor to opponents, who in turn can file new observations within a period of two months.

If the patent proprietor files additional comments or makes amendments to the application, these are once again subject to re-examination by the Patent Office, which in addition informs the proprietor of the existence of any possible objection that might prevent the (amended) patent from being granted. A supplementary one-month period is then provided for the proprietor to make additional comments or amendments to the application.

Appeal

The Appeals Unit is a section within the Patent Office which deals with administrative appeals. Appeals may be filed against final decisions of the Patents department. An appeal must be filed within one month, and a fee must be paid. The appeals procedure is based on general administrative law with a few particularities specific to industrial property.

An administrative appeal against the grant of a patent may only be lodged by a person who has been a party to opposition proceedings. Third parties may not do so.



If the appeal is not settled within the three-month period from the date on which it was lodged, the request to overturn the decision may be presumed to have been dismissed. Therefore, the lack of an administrative decision within the legal term will not prevent the appellant from pursuing his legal claims.

The petitioner may appeal the decision of the Appeals Unit before the administrative chamber of a High Court of Justice within a period of two months from publication of the decision. The petitioner may choose between the High Court of Madrid or the High Court of the Autonomous Region where he lives. This may be followed by a final appeal to the Supreme Court.

The lodging of this appeal does not have suspensive effect for the Patent Office's decision.

Revocation and limitation

A patent proprietor may request the revocation or limitation of his own patent at any time after grant is confirmed, i.e. the request cannot be filed:

- during the time limit to give notice to the opposition of a patent;
- while opposition proceedings in respect of the patent are pending; or
- while a previous limitation proceeding in respect of the patent is pending.

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The request is deemed to be filed only when the limitation or revocation fee is paid.

A request for revocation or limitation will not be admissible when there are legal interests, seizure orders or licences registered at the Patent Registry without consent of the title holders or when there are pending judicial proceedings regarding patent ownership without the claimant's consent.

Revocation actions may be brought by anyone except in cases of lack of right to the patent, where only the person who claims a better right to the invention would be entitled to act. A verdict declaring the revocation of a patent may not affect agreements already enforced.

The Spanish courts may declare partial revocation of the patent. In Spain, civil or administrative courts may declare the partial revocation of a patent; but in practice this happens only after administrative resolution.

Re-establishment of rights

A patent applicant or owner, or any other party to proceedings before the Patent Office, who, despite taking all due care required by the circumstances, has not been able to observe a time limit in relation to the Office will upon request have his rights re-established if the non-observance in question has the direct consequence of causing the loss of a right.

The request for re-establishment must be filed within two months from the date of removal of the cause of the failure to meet the applicable time limit, provided that the request is filed within twelve months from the date of expiry of the applicable time limit. In case of failure to pay an annual fee the request has to be filed within two months of removal of the obstacle, provided that the request is filed within 12 months from the date of expiry of the applicable time limit to pay with surcharge.

The omitted time limit must be fulfilled and the fee for the re-establishment of rights must be paid when re-establishment of rights is requested.

The request must state the reasons for failure to comply with the time limit in spite of due care, and must be accompanied by any declaration or other evidence in support of this statement.

Civil procedure

Infringement

As provided for in the Spanish Patent Act, only the commercial courts of Barcelona, Madrid, Valencia, Granada, Las Palmas, A Coruña and Bilbao have exclusive jurisdiction to hear patent cases of a civil nature.

The owner of a granted patent and exclusive licensee may lodge civil and criminal actions for infringement. Civil actions are aimed at preventing or redressing damages, whilst criminal actions seek punishment of the person held responsible for the crime.

Spanish public security forces may proceed against crimes against IP rights, acting on the basis of their own investigations. Such crimes may also be prosecuted as a result of the crime being reported by any third party to the public security forces, which then conduct the necessary investigations to seek evidence of the reported crime.

Nullity/counterclaim for revocation

It is frequent that infringement actions are in joint proceedings with revocation actions brought by the defendant as counterclaims. During both civil and criminal proceedings, the court may request expert evidence from public bodies and institutions, possibly with the collaboration of Patent Office experts.

Remedies

In civil proceedings, the patent holder may resort to the following remedies: injunction, compensation for damages, seizure and destruction of infringing goods or the filing of notices in public registries.

Other actions

Other actions are declaration of non-infringement and right of prior use (Arts. 70-78 and 63 Spanish Patent Act).

Appeal

Appeals from the Commercial Court are made to the Court of Appeal (Audiencia Provincial).

Parallel proceedings

In Spain, administrative proceedings prevail over civil ones when they relate to administrative resolutions. Criminal proceedings prevail over all types of judicial proceedings.

EPO decisions are considered of great importance, but they have a non-binding effect and the courts may adjudicate without taking EPO proceedings into account. Where there are parallel EPO proceedings, it is at the court's discretion as to whether to stay national proceedings.

Arbitration/mediation

The Spanish Patent Act expressly mentions the possibility of arbitration or mediation for patent matters and gives powers to the Patent Office to create an arbitration and mediation service. However, it expressly provides that the following are excluded from arbitration or mediation: matters related to the grant, opposition or appeal procedures as far as those matters relate to patentability requirements, maintenance or validity.

Enforcement

Judicial authorities are responsible for ordering the implementation of the Court decision. The Ministry of

Justice must ensure such implementation. For that purpose there are bailiffs with special functions. The police are also involved in actions ensuring global respect for the judicial mandate of the Court in accordance with the rule of law.

Calculation of damages is postponed until the so-called "execution phase." This avoids the time and cost involved in the calculation of damages in the "declaratory phase" i.e. before infringement has been declared.

The term for filing a statement of defence has been extended to two months. Previously, it was 20 working days.

Compulsory licence

The Spanish Patent Act provides for compulsory licences. Depending on the justification on which to grant a compulsory licence, different authorities are competent: the SPTO, the National Commission on Markets and Competition (CNMC in Spanish), a judge/court or even the Spanish Government (see Arts. 92 to 96 Spanish Patent Act).

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Relevant national law

Spanish Patent Act – Ley 24/2015, de 24 de julio, de Patentes

Competent authorities or courts



