



## SPANISH TM's: NEXT IN LINE

After the completion of the changes on the Amending Regulation of the European Union Trademark, it is time now to look at some of the national jurisdictions that will also require further changes to comply with the provisions of the other arm of the European Trademark System reform, the EU Directive 2015/2436.

Among this group is Spain, where the SPTO has made public the draft bill to transpose and homogenize the national system with that of the EUIPO. The proposal also includes some additional regulatory improvements, as a result of the latest Case Law and the legal practice of the Office under the current TM Law.

The two milestones of the upcoming national reform will be with no doubt the introduction of the examination of the requirement of use in opposition proceedings and the attribution to the SPTO of the competence on nullity or cancellation actions, be it as direct claims before the same Office or be it as counter claims before the courts.

It is expected that the national package reform will come into effect in two stages: the first one will take place in 2019 and the implementation of the nullity and cancellation actions before the SPTO will be postponed until 2023.

## ASSIGNING YOUR IP RIGHTS IN SPAIN

The simplification of the administrative steps to record assignments of IP rights before patent offices is an international trend that dates back to 1994 with the Trademark Law Treaty (TLT).

Nevertheless, in the case of Spain, IP holders should be well aware that there is a clear line between recording the assignment and the existence of the legal transaction as such.

The Register of the SPTO publishes these transactions only for informative purposes. The official forms or certificates used to record these changes do not have any constitutive or binding effect, so the validity of these assignments could be challenged if the parties have not taken the appropriate measures to draw up the corresponding deed of assignment or private contract between the parties.

### "PONTI & PARTNERS, SLP" NEW COMPANY NAME.

As part of our rebranding process started earlier this year, we are in the process of renaming our firm to PONTI & PARTNERS, SLP. When the change becomes effective we will duly inform all our clients, associates and suppliers in order to facilitate their administrative update.

### CEIPI/EPI SESSION IN BARCELONA



Last 14th September, Ms. María Mercè Vidal, European Patent Attorney at Ponti, imparted a session at the CEIPI/eipi, a two-year basic training course on European Patent Law.

This course provides a systematic and comprehensive introduction to the law and practice of the European patent system. It is also intended to help candidates prepare for the European qualifying examination.

## AGENDA / EVENTS:

**04 - 07.11.2017** APAA. Asian Patent Attorneys Association. Auckland. New Zealand

**26 - 29.11.2017** ASIPI. Interamerican Association of Intellectual Property. Panama City. Panamá.

## THE NEW PATENT LAW

On April 1st, the long-awaited new Spanish Patent Law (Law 24/2015) came into force. It adapts the current standard to international standards and incorporates different relevant developments, among which we can highlight the implementation of a single system of patent grant procedure with a mandatory substantive examination.

This renovation of the current patent system, which took a long time to be developed, was indispensable, among other reasons, to amend several aspects of the former Patent Law dated 1986 which had become obsolete, and to adapt it to the several agreements that have been signed, such as the ratification of Spain of the Patent Law Treaty (PLT) or the amendment of the European Patent Convention (EPC 2000).

Its main objectives are strengthening the Spanish patent system, reducing the administrative responsibilities, providing a greater support to the entrepreneur, and updating the Spanish patent regulations in order to adjust them to the international and European context.

According to the new Law, the most significant change is the establishment of a single procedure for the granting of patents, which requires overcoming a substantive examination. Here, among other patentability criteria, the novelty and inventive step of the invention are assessed. Therefore, the former and widespread option based on obtaining a Spanish patent without being subject to any examination of patentability, has now disappeared.

Although it is true that the mandatory substantive examination is a really major step forward, as it strengthens patent granting and makes the patent system more rigorous and secure, it cannot be denied that it will imply an additional cost for the applicants. Hence, it is foreseeable that they may opt for protecting new inventions through utility models instead of patents.

Other important developments of the New Law related to patents are:

- Simplification of the requirements to obtain a filing date for a new application, which aims at speeding up the initial procedure.
- The submission of the search fee has been moved forward and now it must be satisfied at the filing stage. This means an increase in the initial costs of the procedure, but advantageously it allows to advance the prior art search, and at the same



Diana Mariné  
Mechanical Engineer  
Spanish Patent and Trademark Attorney

time allows applicants to have access to relevant information related to the closest background of their invention. Thus, they are able to make better strategic decisions on the possibility of extending their patents abroad within the priority term.

- Filing, search, examination, and the first three annuity fees are reduced by 50%, but only for individuals and SMEs which have proved their status of entrepreneurs. This key aspect may slightly counteract the increasing costs of a new application due to the obligation of satisfying both the SR fee at the beginning and the examination fee afterwards.
- Replacement of the former pre-grant opposition system by a post-grant system within six months from the publication of the grant. Thus, the new patent opposition procedure is equated to that used in the European system, and it also helps accelerate the granting process.
- Admission of internal priority, which will certainly favour those who are interested in submitting a first application in Spain.
- Suppression of patents of addition, because they were hardly used in the former Law.
- An express inclusion of the supplementary protection certificate (SPC) among Industrial Property titles.

With respect to utility models, the substantial amendments deserving special mention are:

- Broadening of the subject-matter susceptible to be covered by a utility model to compositions of chemical products or substances, with the exception of those relating to pharmaceutical substances and compositions.
- Establishment of the requirement of absolute novelty for new utility models, thereby replacing the relative novelty requirement (i.e. only national) foreseen in the previous Law.
- In order to exercise actions against third parties aimed at defending the exclusive rights of a utility model, it is mandatory to obtain a report on the state of the art referred to the subject-matter of the invention.

This new legal scene will entail very positive changes for the Spanish patent system. We are totally convinced that we will adapt to it and will know how to take advantage of it in order to provide the best advice to applicants according to their particular needs.