

# NEW SPANISH PATENTS ACT - HERRERO & ASSOCIADOS

*Posted on 14/10/2015*



Category: [lp](#)



**The Boletín Oficial del Estado (Official State Gazette) – published on 25 July, 2015 – contains the new Patent Law (Law 24/2015), which introduced significant changes to the Spanish patent protection system. Of these changes, we feel the need to highlight the following, given their importance**

- The establishment of a single granting system with prior examination of novelty

- The modification of procedural aspects, such as simplifying the requirements to obtain a filing date, recognising internal priority and regulating the written opinion of the examiner, establishing up-front payment of the search fee, and moving directly into the search phase for all applications
- The substitution of prior opposition with a post-grant opposition system and the modification of the framework of administrative appeals against the granting of a patent
- The modification of some jurisdiction rules and procedural rules and, in particular, the periods to answer claims and raise counterclaims have been expanded, invalidity as an exception may be turned into a counterclaim and precautionary documents have been introduced as a procedural tool to be used as a defense against the possibility of ex parte cautionary measures
- The modification of the rules regarding compensation for damages, adding coercive compensation and postponing calculation till the execution phase
- The modification of the framework for employee inventions and inventions by government-employed research staff
- The new law does away with certificates of addition
- It reorganises and simplifies the regulation of compulsory licenses
- The modification of certain principles regarding invalidity and extension of the effects of invalidity to the corresponding SPCs, as well as establishing a procedure for patent holders to request revocation or limitation before the Spanish Patent and Trademark Office
- The modification of the utility model: determining the state of the relevant art; broadening the type of inventions that can be protected under this category, excluding only those which relate to methods, biological material, and pharmaceutical substances and compositions; along with the conditions to exercise actions in defense of the right deriving from this certificate
- The new law regulates representation and does away with setting up security deposits or taking out liability insurance for industrial property agents
- The modification of the periods to pay maintenance fees

The government has provided a number of diverse reasons for these changes, the most important among them being the need to update a law that has been touched up on several occasions in the past, and which is currently slightly out of touch with new methods in disclosure and research. The most important legal reason is the shift from national to international granting procedures, especially regarding European patents and patents applied for via the Patent Cooperation Treaty (PCT). This is clearly a response to the globalisation of the economy and has provided a degree of international harmonisation in patent protection through various treaties and agreements. The reform aims to adapt to this new reality and legal situation, and to simplify and streamline patent granting procedures.

**[Joaquín Ramón Lopez Bravo](mailto:jlbravo@herrero.es) is a lawyer at Herrero & Asociados. He can be contacted at [jlbravo@herrero.es](mailto:jlbravo@herrero.es)**