

## **Law 11/1986, of March 20, 1986, on Patents**

Law 11/1986, of March 20, 1986, on Patents, amended by Law 21/1992, of July 16, 1992, on Industry; affected by Royal Decree 441/1994, of March 11, 1994, approving the Regulations for the Adaptation of Procedures Relating to the Grant, Maintenance and Amendment of Industrial Property Rights to Law 30/1992, of November 26, 1992, on the Legal Regime of Public Administrations and Common Administrative Procedure; amended by Law 66/1997, of December 30, 1997, on Tax, Administrative and Social Policy Measures; amended by Decree-Law 8/1998, of July 31, 1998, on Urgent Industrial Property Measures; amended by Law 50/1998, of December 30, 1998, on Tax, Administrative and Social Policy Measures; and affected by the Budget Laws for the years 1989 and 1998.

### **TITLE I - GENERAL PROVISIONS**

1. The following industrial property titles shall be granted, in accordance with the provisions of the present Law, for the protection of industrial inventions:

(a) patents for inventions; and

(b) certificates of protection for utility models.

2.-(1) Any Spanish natural person or legal entity or any foreign natural person or legal entity ordinarily resident or having a concrete and effective industrial or commercial establishment on Spanish territory, or benefiting from the Paris Convention for the Protection of Industrial Property [hereinafter "Paris Convention"], may be granted the industrial property titles regulated in the present Law.

(2) Any foreign natural person or legal entity not mentioned in the previous paragraph may also be granted the industrial property titles regulated by the present Law, provided that the State of which he is a citizen allows natural persons or legal entities of Spanish nationality to be granted equivalent titles.

(3) Any Spanish natural person or legal entity and any foreign natural person or legal entity who is a citizen of one of the countries of the Paris Union for the Protection of Industrial Property [hereinafter "Paris Union"] or who is domiciled or has an effective

and proper industrial or commercial establishment in one of the countries of the Union may claim the advantages of the provisions contained in the text of the Paris Convention, which is in force in Spain, in those cases where its provisions are more favorable to him than the provisions of the present Law.

□ The Law on Administrative Procedure [*Ley de Procedimiento Administrativo*] shall also apply to the administrative acts regulated under the present Law, and appeals may be lodged in accordance with the provisions of the Law Governing Contentious Administrative Jurisdiction [*Ley reguladora de la Jurisdicción Contencioso Administrativa*].

[Art. 3 affected by Royal Decree 441/1994.]

## TITLE II □ PATENTABILITY □

□-(1) Inventions which are susceptible of industrial application, which are new and which involve an inventive step shall be patentable.

(2) The following, in particular, shall not be regarded as inventions within the meaning of the previous paragraph:

(a) discoveries, scientific theories and mathematical methods;

(b) literary or artistic works or any other aesthetic creation, as well as scientific works;

(c) schemes, rules and methods for performing mental acts, playing games or doing business and programs for computers;

(d) presentations of information.

(3) The provisions of the preceding paragraph shall exclude patentability of the inventions mentioned therein only to the extent that the subject matter of the patent applied for includes one of them.

(4) Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practiced on the human or animal body shall not be regarded as inventions which are susceptible of industrial application within the meaning of paragraph (1), above. This provision shall not apply to products, in particular, substances or compositions, nor to inventions of apparatus or instruments for use in any of these methods.

□-(1) The following may not be the subject matter of a patent:

- (a) inventions whose publication or working would be contrary to public order or morality;
- (b) plant varieties coming under the protection of the Law of March 12, 1975, on the Protection of Plant Varieties [*Ley de 12 de marzo de 1975 sobre protección de las obtenciones vegetales*];
- (c) animal varieties;
- (d) essentially biological processes for the production of plants or animals.

(2) The provisions of subparagraphs (b)□(c) and (d), above, shall not, however, apply to microbiological processes or to the products thereof.

**6.**-(1) An invention shall be considered to be new if it does not form part of the state of the art.

(2) The state of the art shall be held to comprise everything made available to the public in Spain or abroad by means of a written or oral description, by use, or by any other way, before the date of filing of the patent application.

(3) Additionally, the content of Spanish patent or utility model applications as filed, of which the dates of filing are prior to the date referred to in the preceding paragraph and which were published on or after that date, shall be considered as comprised in the state of the art.

□ A disclosure of an invention shall not be taken into consideration in determining the state of the art if it occurred during the six months preceding the filing of the application with the Registry of Industrial Property and if it was due to, or in consequence of

- (a) an evident abuse in relation to the applicant or his legal predecessor;
- (b) the fact that the applicant or his legal predecessor has displayed the invention at an official or officially recognized exhibition.

□ When filing his application, the applicant shall declare that the invention has in fact been exhibited and, in support of his statement, he shall submit the corresponding certificate within the period and under the conditions laid down in the regulations;

(c) tests carried out by the applicant or by his legal predecessor, provided that they do not imply working the invention or offering it for sale.

8.-(1) An invention shall be regarded as involving an inventive step when it does not result from the state of the art in a manner obvious to a person skilled in the art.

(2) Where the state of the art includes documents such as those mentioned in Article 6(3), above, they shall not be taken into consideration when deciding upon the existence of an inventive step.

9. An invention shall be regarded as susceptible of industrial application when its object can be manufactured or used in any form of industry, including agriculture.

### **TITLE III - RIGHT TO A PATENT AND INVIOLATION OF THE INVENTOR**

10.-(1) The right to a patent shall belong to the inventor or to his successors in title and it shall be transferable by any of the means recognized in the Law.

(2) Where an invention has been made jointly by a number of persons, the right to obtain a patent shall belong to them jointly.

(3) Where the same invention has been made independently by various persons, the right to a patent shall belong to the person whose application bears the first date of registration in Spain, provided that the application has been published in accordance with the provisions of Article 32 hereunder.

(4) For the purposes of the procedure before the Registry of Industrial Property, it shall be assumed that the applicant is authorized to exercise the right to a patent.

11.-(1) Where, on the basis of the provisions of paragraph (1) of the preceding Article, a final judgment has recognized the right to obtain a patent to a person other than the applicant and provided that the patent has not been granted within a period of three months after the judgment has become *res iudicata*, the person concerned may

(a) continue the application procedure, substituting himself for the applicant;

(b) file a new patent application for the same invention, benefiting from the same priority; or

(c) request that the application be refiled.

(2) The provisions of Article 24 (3) shall apply to any new application filed under the provisions of the preceding paragraph.

(3) Where a request for the judgment referred to in paragraph (1), above, has been made, the patent application may not be withdrawn without the consent of the plaintiff. After the application has been published, the judge shall decree the patent procedure suspended until the final judgment has been duly notified if the plaintiff's claim has been rejected, or until three months after such notification if the plaintiff's claim is accepted.

**12.-**(1) Where a patent has been granted to a person not authorized to obtain it according to the provisions of Article 10(1), above, the person authorized in accordance with the said Article may claim transfer of ownership of the patent, without prejudice to any other corresponding rights or action.

(2) Where a person has the right to part of a patent only, he may claim co-ownership of the patent in accordance with the provisions of the preceding paragraph.

(3) The rights mentioned in the preceding paragraph may only be exercised within a period of two years from the date of publication of the grant of the patent in the Official Bulletin of Industrial Property [*Boletín Oficial de la Propiedad Industrial*]. This period shall not apply where, at the time the patent was granted or acquired, the owner knew that he did not have the relevant right.

(4) For the purposes of notifying third parties, the filing of a judicial claim to exercise the actions mentioned in this Article shall be recorded in the Patent Register, together with the final judgment or any other form of termination of the procedure initiated as a result of the said claim, at the request of the interested party.

**13.-**(1) Where a change in ownership of a patent takes place as a result of a judgment as provided for in the preceding Article, any license and other rights of third parties in the patent shall be cancelled when the person authorized is registered in the Patent Register.

(2) Both the owner of a patent and the holder of a license obtained before registration of the filing of a judicial claim who, prior to its registration, have worked the invention or have taken effective and concrete steps for that purpose, may continue or commence working it, provided that they request the new owner entered in the Patent Register to grant a non-exclusive license within a period of two months, in the case of the former owner of the patent, or, in the case of licenses, within a period of four months after receiving notification of the registration of the new owner from the Registry of Industrial Property. The license shall be granted for an appropriate period and under

reasonable conditions which, where appropriate, shall be fixed through the procedure laid down in the present Law with regard to compulsory licenses.

(3) The provisions set out in the preceding paragraph shall not apply where the owner of the patent or the licensee acted in bad faith at the time they commenced working the invention or taking steps to do so.

14. As far as the owner of the patent application or of the patent is concerned, the inventor shall have the right to be mentioned in the patent as being the inventor.

#### **TITLE IV - EMPLOYEE INVENTIONS**

14-(1) Inventions made by an employee during the term of his contract, work or service with a company, and which are the result of research that is explicitly or implicitly the object of his contract, shall belong to the employer.

(2) An employee responsible as an inventor shall have no right to additional remuneration for his achievement, except where his personal contribution to the invention and its importance to the company obviously go beyond the explicit or implicit terms of his contract or work.

16. Inventions that do not fulfill the conditions provided for in Article 15(1), above, shall belong to the employee who is their author.

14-(1) Notwithstanding the provisions of Article 16, above, where the employee makes an invention related to his professional activity and the knowledge gained within the company has had a decisive influence thereon or he has used means provided by the company, the employer shall have the right to claim ownership of the invention or to reserve a right to its use.

(2) Where the employer claims ownership of an invention or reserves a right to its use, the employee shall have the right to equitable financial remuneration fixed in relation to the invention's industrial and commercial importance and taking into account the value of the means or knowledge provided by the company and the contribution made by the employee himself.

**18.**-(1) An employee who makes any of the inventions mentioned in Articles 15 and 17, above, shall duly inform the employer in writing, setting out the necessary data and information so that the latter may, within a period of three months, exercise the relevant rights. Failure to fulfill this obligation shall lead to loss of the rights recognized to the employee under this Title.

(2) Both the employer and the employee shall collaborate to the extent necessary for the rights recognized under the present Title to have effect and shall abstain from any act that might be prejudicial to those rights.

**19.**-(1) Inventions for which a patent application or other title of exclusive protection has been filed within a year following expiry of the work or service relationship may be claimed by the employer.

(2) Any advance renunciation of the rights granted to the employee by the Law under this Title shall be null and void.

**20.**-(1) The provisions of the present Title shall apply to civil servants, employees and workers of the State, Autonomous Communities, provinces, municipalities and other public bodies, without prejudice to the provisions of the following paragraphs.

(2) Ownership of inventions made by a professor as a result of his research responsibilities in a university and which come within the scope of his teaching and research functions shall belong to the university, without prejudice to the provisions laid down in Article 11 of the Institutional Act on University Reform [*Ley Orgánica de Reforma Universitaria*].

(3) Any invention under the terms of paragraph (2), above, shall immediately be notified to the university by the professor who is its author.

(4) The professor shall nevertheless have the right to participate in the benefits gained by the university from working or assigning its rights in an invention under the terms of paragraph (2), above. The university statutes shall define the terms and amount of such participation.

(5) The university may assign ownership of an invention under the terms of paragraph (2), above, to the professor who is its author, in which case it may keep a non-exclusive, untransferable and gratuitous license.

- (6) Where a professor derives benefits from working an invention under the terms of paragraph (5), above, the university shall have the right to participate therein to an extent defined by the university statutes.
- (7) Where a professor makes an invention as a result of a contract with a State or private body, the contract shall specify which of the contracting parties owns the invention.
- (8) The regulations laid down in paragraphs (2) and (7) of the present Article may also be applicable to inventions by research staff in public research bodies.
- (9) The terms and amount of participation by research staff of public research bodies in the benefits derived from working or assigning their rights in inventions under the terms of paragraph (8) of the present Article shall be fixed by the Government, taking into account the specific characteristics of each research body.

## **TITLE V - GRANTING OF PATENTS**

### Chapter I. Filing and Requirements for Patent Applications

- 21.-**(1) In order to obtain a patent, it shall be necessary to file an application comprising
- (a) an application addressed to the Director of the Registry of Industrial Property;
  - (b) a description of the invention for which the patent application is made;
  - (c) one or several claims;
  - (d) the designs to which the description or claims refer; and
  - (e) an abstract of the invention.
- (2) Where an addition is being applied for, this should be stated clearly in the application together with an indication of the number of the patent or patent application to which the addition refers.
- (3) Filing of a patent application shall be subject to payment of the fees laid down in the present Law.
- (4) The application and all other documentation filed with the Registry of Industrial Property shall be written in Spanish and shall meet the legally established requirements.
- (5) In the Autonomous Communities, the documents referred to in paragraph (4), above, may be filed with the offices of the Autonomous Administration where the latter has been given the necessary competence. The documents may be written in the official



language of the Autonomous Community and shall be accompanied by the corresponding translation in Spanish; where there are discrepancies, the latter shall be deemed to be the authentic text.

[Par. (5) affected by Royal Decree 441/1994.]

**22.-(1)** The date of filing shall be that upon which the applicant hands over to the Spanish offices authorized to accept patent applications the following documents drawn up in the form specified in Article 21, above:

- (a) a declaration of the patent subject matter;
- (b) designation of the applicant; and
- (c) a description and one or several claims, even if they do not meet the formal requirements laid down in the present Law.

(2) Where during the patent procedure, the subject matter of the application is either totally or partly changed, the date of filing shall be deemed to be that on which the change to the part concerned was introduced.

**23.** Patent applications shall indicate the inventor. Where the applicant is not the inventor or is not the sole inventor, this indication shall be accompanied by a declaration stating how the applicant acquired the right to the patent.

**23.-(1)** Patent applications may not cover more than one invention or a series of inventions so related one to the other that they form a single overall inventive concept.

(2) Applications that are not in accordance with the provisions laid down in the preceding paragraph shall be divided in accordance with the prescribed provisions.

(3) Divided applications shall have the same date of filing as the original application from which they derive, provided that their subject matter was already contained therein.

**23.-(1)** The invention shall be described in the patent application in a sufficiently clear and comprehensive manner to enable a person skilled in the art to carry it out.

(2) Where the invention refers to a microbiological process for which the microorganism is not available to the public, the description shall only be deemed to fulfill the requirements specified in the preceding paragraph if the following conditions are met:

- (a) the description contains the information the applicant possesses regarding the characteristics of the microorganism;

(b) the applicant has deposited, no later than the date of filing the application, a culture of the microorganism with an authorized institution in accordance with the relevant international conventions in force in Spain; and

(c) the public has access to the culture of the microorganism in the aforementioned institution as from the date of publication of the patent application and under the prescribed conditions.

**26.** Claims shall define the object for which protection is sought. They shall be clear and concise and shall be based on the description.

**27.**(1) The abstract of the invention shall be exclusively used for technical information purposes. It may not be taken into account for any other purpose; in particular, it may not be used to define the scope of the protection sought nor to delimit the state of the art for the purposes of the provisions of Article 6 (3), above.

(2) The Registry of Industrial Property may modify the abstract of the invention where it considers it necessary in order to provide better information to third parties. Such modification shall be notified to the applicant.

**28.**(1) Any person who has duly filed an application for a patent, a utility model, a utility certificate or an inventor's certificate in any of the countries members of the Paris Union, as well as their successors in title, shall, when filing a patent application in Spain for the same invention, enjoy the right of priority laid down in the Paris Convention.

(2) The right of priority mentioned in the preceding paragraph shall also be enjoyed by any person who has filed an original application for protection in a country which, although it does not belong to the Paris Union, recognizes for applications filed in Spain a right of priority with the same effects as those laid down in the Union's Convention.

(3) As a result of the exercise of the right of priority, for the purposes of the provisions set out in Articles 6(2) and (3), 10(3), 109, and 145(1) and (2), the date of filing the patent application shall be deemed to be the date of filing of the earlier application whose priority has been rightfully claimed.

**29.**(1) Any applicant wishing to claim priority for a previous application shall submit, in the form and within the period laid down, a declaration of priority and a copy of the earlier application certified by the office of origin, accompanied by a translation in Spanish where the application has been made in another language.

- (2) Multiple priorities may be claimed for the same application and, where appropriate, for the same claim, even though they may originate in a number of States. □ here multiple priorities are claimed, the periods to be calculated from the date of priority shall be computed from the earliest date of priority.
- (3) □ here one or several priorities are claimed, the right of priority shall only protect those aspects of the application that are contained in the application or applications whose priority has been claimed.
- (4) □ here certain aspects of the invention for which priority is claimed do not appear in the claims set out in the earlier application, priority for those aspects may still be granted if they are shown in a sufficiently clear and detailed manner in the ensemble of the documents comprising the previous application.

#### Chapter II. General Procedure for Granting Patents

□0. □ ithin eight days following their receipt in its office, the Registry of Industrial Property shall directly reēct applications that do not fulfill the necessary requirements to obtain a date of filing in accordance with Article 22(1), above, or for which the corresponding fee has not been paid, and it shall inform the interested party accordingly. [Art. 30 affected by Royal Decree 441/1994.]

□1.-(1) □ here an application has been accepted for consideration, the Registry of Industrial Property shall verify whether it meets all the formal requirements laid down in the preceding Chapter and whether they have been fulfilled in the prescribed form. The adequacy of the description shall not be the subēct of verification.

(2) The Registry of Industrial Property shall also verify whether or not the subēct matter of the application meets the requirements of patentability laid down in Title II of the present Law, except those of novelty and inventive step. After hearing the interested party, the Registry of Industrial Property shall, however, refuse the grant of a patent, giving ūstified reasons, when the invention that is the subēct matter of the application clearly and obviously lacē novelty.

(3) □ here the result of the examination shows that the application has formal defects or that its obēct is not patentable, the patent procedure shall be declared suspended and, where appropriate, the applicant shall be allowed the prescribed period to rectify the

defects indicated and to put forward his relevant arguments. For that purpose, the applicant may modify his claims or divide the application.

(4) The Registry of Industrial Property shall totally or partly reject any application when it deems that its subject matter is not patentable or that it contains defects that have not been duly rectified.

(5) Where examination by the Registry of Industrial Property shows that there is no impairment to granting a patent or when any defects have been duly rectified, the Registry shall inform the applicant that, for the patent procedure to continue, he should request the establishment of a report on the state of the art within the period laid down in the present Law, if this has not already been done.

22.-(1) Eighteen months after the date of filing the application or the date of priority claimed, when verification has been carried out and the applicant has requested the report on the state of the art referred to in Article 33, below, the Registry shall proceed to make the patent application available to the public by publishing in the Official Bulletin of Industrial Property those elements that are specified in the regulations.

(2) At the same time, a pamphlet of the patent application shall be published containing the description, the claims, and, where appropriate, the drawings and other elements specified in the regulations.

(3) At the request of the applicant, the patent application may be published, in accordance with the provisions of this Article, before the expiration of the period of 18 months referred to in paragraph (1), above.

23.-(1) Within 15 months of the date of filing, the applicant shall request the Registry to establish a report on the state of the art and shall pay the relevant fee. Where priority has been claimed, the period of 15 months shall be calculated from the date of priority.

(2) Where the period established in the preceding paragraph has already expired at the time of making the notification referred to in Article 31(5), above, the applicant may request the establishment of a report on the state of the art during the month following such notification.

(3) Where the applicant does not fulfill the conditions laid down in the present Article, his application shall be deemed to have been withdrawn.

(4) The establishment of a report on the state of the art may not be requested for an addition unless a report has been requested previously or simultaneously for the principal patent and, where appropriate, for earlier additions.

(5) Where it is possible to base the report on the state of the art either partly or entirely on the international search report drawn up under the Patent Cooperation Treaty<sup>4</sup>, the applicant shall have 25%, 50%, 75% or 100% of the fee refunded, depending on the scope of the said report.

(6) There shall be no report on the state of the art for applications in respect of which the international search report has been drawn up by the Spanish Patent and Trademark Office acting as International Searching Authority.

[Par. (5) and (6) added by Law 50/1998.]

11-(1) When verification of the application provided for in Article 31 has been carried out and the applicant's request for a report on the state of the art has been received, the Registry shall proceed to establish the said report on the subject matter of the patent application within the prescribed period.

(2) The establishment of the report may not be commenced until, within the framework of the patent procedure, the date of filing has been finally fixed.

(3) The report on the state of the art shall mention those elements of the state of the art that should be taken into consideration in order to assess the novelty and inventive step of the invention that is the subject matter of the application

The report shall be based on the claims in the application and shall take into account the description and, where appropriate, the drawings submitted.

(4) For the purpose of establishing the report, the Registry may not only see information from its own sources, but may also use the services of national and international bodies whose collaboration has previously been approved in general by means of a Royal Decree.

(5) After the report on the state of the art has been established, the Registry shall transmit it to the patent applicant. It shall also publish a pamphlet containing the said report and shall insert the relevant announcement in the Official Bulletin of Industrial Property.

(6) Unless it has already been published, the patent application shall be published at the same time as the report on the state of the art.

33-(1) Where lack of clarity in the description or claims wholly or partly prevents establishment of the report on the state of the art, the Registry shall refuse to grant the patent for the corresponding part.

(2) Before making a final decision on refusal to grant the patent, the Registry shall inform the applicant accordingly, allowing him the prescribed period to put forward the arguments he deems relevant.

36-(1) Any person may formulate duly substantiated and documented comments on the report on the state of the art in the form and within the period specified in the Regulations.

(2) When the period allowed for third parties to submit comments on the report on the state of the art has expired, the comments submitted shall be transmitted to the applicant so that, within the relevant prescribed period, he may make the observations he deems relevant to the report on the state of the art, respond to the comments submitted by third parties and, if he deems it necessary, modify the claims.

(3) In patent grant procedures relating to technological sectors for which the grant procedure with prior examination under the Royal Decree referred to in the fifth Transitional Provision is applicable, once publication of the report on the state of the art has taken place, the period provided for in Article 39(2) shall start, suspending the proceedings, during which time the applicant may file the request for prior examination or express his desire to continue with the general grant procedure. Where that period expires without the applicant having made a statement on the subject, the procedure shall resume in accordance with the provisions of the foregoing paragraphs, with the provisions on the general grant procedure laid down in this Chapter being applicable. Resumption shall be announced in the Official Bulletin of Industrial Property.

[Par. (3) added by Royal Decree-Law 8/1998.]

33-(1) Independently of the content of the report on the state of the art and the comments made by third parties, when the period allowed for the applicant's observations has expired, the Registry shall grant the patent applied for, announcing the fact in the Official Bulletin of Industrial Property, and it shall make available to the public the documents concerning the patent granted, together with the report on the state of the art and all the observations and comments made thereon. Where the claims have

been modified, it shall make available to the public the various versions thereof showing their respective dates.

(2) Grant of the patent shall be without prejudice to third parties and with no guarantee by the State as to its validity or the utility of the object to which it refers.

(3) Announcement of the grant of a patent to be published in the Official Bulletin of Industrial Property shall include the following indications:

1° the number of the patent granted;

2° the class or classes to which the patent belongs;

3° a concise description of the invention that is the subject matter of the patent granted;

4° the first name and surname or the trade name of the applicant, together with his nationality and domicile;

5° an abstract of the invention;

6° the number of the issue of the [Official] Bulletin [of Industrial Property] in which the patent application and, where appropriate, the modifications made to the claims, were published;

7° the date on which the patent was granted;

8° the possibility of consulting the documentation concerning the patent granted, as well as the relevant report on the state of the art and the observations and comments made thereon.

8.-(1) A pamphlet concerning each patent granted shall be published for sale to the public.

(2) In addition to the indications mentioned in Article 37(3), above, the pamphlet shall contain the full text of the description, together with the claims and designs, as well as the full text of the report on the state of the art. It shall also mention the issue of the Official Bulletin of Industrial Property in which grant of the patent was announced.

### Chapter III. Procedure for Granting Patents with Prior Examination

9.-(1) In those cases where it is applicable, in accordance with the Fifth Transitional Provision, the procedure shall be the same as the general procedure described in the preceding Chapter of the present Law until such time as the request for examination referred to in the following paragraph is made.

- (2) During the six months following the publication of the report on the state of the art, the applicant may ask for the examination of the adequacy of the description, the novelty and the inventive step of the subject matter of the patent application to proceed. The request for prior examination shall only be considered validly filed after payment of the examination fee; it shall be irrevocable and shall be published in the Official Bulletin of Industrial Property.
- (3) Where it is possible to base the prior examination either partly or entirely on the international preliminary examination undertaken by the competent International Preliminary Examining Authority, the applicant shall have 25%, 50%, 75% or 100% of the said fee refunded, depending on the scope of the said report.
- (4) During the two months following the publication of the examination request, any interested party may oppose the grant of the patent, citing the absence of any of the requirements laid down for such grant. The opposition document shall be accompanied by the appropriate supporting documents.
- (5) Any allegation that the applicant has no right to apply for a patent shall not be allowed, however, since this is a matter for the ordinary courts.
- (6) When it has completed its verification, the Registry shall notify the applicant of the result and shall transmit to him any opposition submitted.
- (7) Where no opposition has been received and the verification has shown that no requirement has been omitted, the Registry shall grant the patent applied for.
- (8) Where the provisions of the preceding paragraph do not apply, the applicant may rectify defects of form in the application, modify the claims if he deems it necessary, and contest opposition, putting forward the arguments he deems appropriate.
- (9) Where the applicant does not act in response to the objections put forward by the Registry or by third parties, the patent shall be totally or partly refused. In other cases, the Registry shall decide, giving its reasons, whether or not to grant the patent in full or in part after having received the arguments of the applicant.
- (10) Where the reasons given by the Registry specify that one of the formal conditions has not been met or that the invention is not patentable, the Registry shall allow the applicant another period to make good the defect or to put forward the arguments he deems appropriate and shall then take a final decision on granting the patent.



(11) The periods referred to in respect of the procedure outlined in the present Article shall be fixed in the Regulations.

[Par. (1) to (5) amended by Royal Decree-Law 8/1998.]

0.-(1) The grant of a patent through a procedure with prior examination shall be without prejudice to third parties and with no guarantee by the State as to its validity or the utility of the object to which it refers.

(2) Announcement of the grant of a patent to be published in the Official Bulletin of Industrial Property shall include the following indications:

1° the number of the patent granted;

2° the class or classes to which the patent belongs;

3° a concise description of the invention that is the subject matter of the patent granted;

4° the first name and surname or the trade name of the applicant, together with his nationality and domicile;

5° an abstract of the invention;

6° the number or numbers of the issue or issues of the [Official] Bulletin [of Industrial Property] in which the patent application and, where appropriate, the modifications made, were published;

7° the date on which the patent was granted;

8° the possibility of consulting the documentation concerning the patent granted, as well as the relevant report on the state of the art, the document showing the result of the Registry's verification of the novelty and inventive step, the adequacy of the description, and the petitions submitted opposing grant of the patent;

9° a separate statement specifying that the patent has been granted after prior examination as to the novelty and inventive step of the invention that is its subject matter.

(3) For each patent granted, a pamphlet shall be published for sale to the public. In addition to the indications mentioned in the preceding paragraph, the pamphlet shall contain the full text of the description, together with the claims and drawings, as well as the full text of the report on the state of the art. It shall also mention individually petitions submitted opposing grant of the patent and the issue of the Official Bulletin of Industrial Property in which grant of the patent was announced.

## Chapter I. General Provisions Concerning Procedure and Information for Third Parties

1.- (1) With the exception of those cases involving rectification of obvious errors, the applicant may modify the claims in his application at any stage of the grant procedure where it is specifically permitted under the present Law.

(2) The applicant may modify the claims in accordance with the preceding paragraph without having to obtain the consent of those possessing rights in his application recorded in the Patent Register.

(3) Modification of the claims may not imply widening of the scope of the application.

2.- (1) The applicant may at any time transform his patent application into an application for the protection of the subject matter under another form of industrial property until expiration of the period allowed for submitting comments on the report on the state of the art or, in the case of procedure with prior examination, until expiration of the period for responding to opposition and objections resulting from the prior examination carried out by the Registry.

(2) Following verification carried out in accordance with the provisions of Article 31, above, the Registry may propose to the applicant that he change the form of his application. The applicant may accept or reject this proposal and shall be deemed to have rejected it if he does not specifically request a change in the form of his application.

Where the proposal is rejected, the procedure shall continue in the form applied for.

(3) Where the applicant requests a change in form, the Registry shall accept the change and shall inform the interested party of the documents he should submit within the prescribed period for the new procedure to be followed for his application. Failure to submit the new documentation within the prescribed period shall lead to annulment of the procedure.

(4) Where the decision allowing a change in form is taken after publication of the patent application, it shall be published in the Official Bulletin of Industrial Property.

3.- (1) The applicant may withdraw his patent application at any time before the patent is granted.

(2) Where the Patent Register shows that third parties have rights in the application, the latter may only be withdrawn with the consent of the owners of those rights.

11-(1) Documentation concerning patent applications not yet published may only be consulted with the consent of the applicant.

(2) Any person who proves that a patent applicant has tried to make use in his regard of the rights derived from the application, may consult the documentation before publication and without the applicant's consent.

(3) Where a divided application, a new patent application filed in accordance with the provisions of Article 11(1), or an application following a change in the form of protection under the terms of Article 42 is published, any person may consult the documentation regarding the original application before its publication and without the applicant's consent.

(4) Following publication of the patent application, the documentation concerning the application and, where appropriate, the relevant patent, may be consulted subject to the appropriate request and the prescribed restrictions.

11-(1) Documentation concerning applications that have been rejected or withdrawn before publication shall not be made available to the public.

(2) Where an application as mentioned in the preceding paragraph is renewed, it shall be considered to be a new application and may not benefit from the date of filing of the previous application.

16-(1) Any person who, in respect of a third party, invokes rights derived from a patent application or a patent already granted shall inform the latter of the relevant number.

(2) Any person who uses on a product, labels or packaging, or in any form of announcement or printed matter, any mention giving the impression that protection under a patent application or a patent already granted exists, shall indicate the relevant number, without prejudice to the provisions of Article 44(2).

#### Chapter 11. Appeal

11-(1) In accordance with the provisions of the Law Governing Contentious Administrative Jurisdiction, any interested party shall be entitled to lodge a contentious administrative appeal against the grant of a patent without having been obliged to submit comments on the report on the state of the art or to state opposition during the grant procedure with prior examination.

(2) Contentious administrative appeals may only concern the omission of essential steps during the procedure or other questions decided upon by the Administration during the grant procedure, with the exception of the question of unity of invention.

(3) Under no circumstance may an appeal be made against the grant of a patent alleging lack of novelty or an inventive step in the application's subject matter when the grant procedure took place without prior examination.

8. A judgment admitting the appeal, based on the grant of a patent when the Registry of Industrial Property had failed to verify one of the formal requirements, with the exception of the requirement of unity of invention, or when essential steps in the procedure had been omitted, shall lead to annulment of the administrative action concerned and retroactivity of the procedure to the point at which the defects mentioned in the judgment occurred.

#### **TITLE VI - EFFECTS OF PATENTS AND PATENT APPLICATIONS**

9. The term of a patent shall be a non-extendable period of 20 years from the date of filing the application and it shall have effect from the date on which the grant of the patent was published.

10. A patent shall give its owner the right to prevent any third party from undertaking the following acts without his consent:

(a) manufacturing, offering for sale, putting on the market or using the product that is the subject matter of the patent or importing or possessing the product for one of the above-mentioned purposes;

(b) making use of a process that is the subject matter of a patent or offering such use when the third party is aware, or the circumstances make it obvious, that use of the process without the consent of the patent's owner is prohibited;

(c) offering for sale, putting on the market or using the product directly obtained by the process that is the subject matter of the patent or importing or possessing the said product for any of the above-mentioned purposes.

11.- (1) A patent shall also entitle its owner to prevent a third party from handing over or offering to hand over to unauthorized persons without his consent elements related to an essential part of the invention to be used for putting the invention into effect, when the

third party knows, or the circumstances make it obvious, that such elements are capable of putting the invention into effect and are to be used for that purpose.

(2) The provisions set out in the preceding paragraph shall not apply when the elements referred to are products commonly to be found on the market, unless the third party incites the person concerned to commit acts prohibited in the preceding paragraph.

(3) Persons committing the acts specified in subparagraphs (a) to (c) of the following Article shall not be considered to be persons authorized to work the invention within the meaning of paragraph (1), above.

2. The rights conferred by the patent shall not extend to

(a) acts carried out in private and not for any commercial purpose;

(b) acts carried out for experimental purposes related to the subject matter of the patented invention;

(c) the extemporaneous preparation of medicines in pharmacies carried out singly in making up a prescription and acts related to the medicines thus prepared;

(d) use of the subject matter of the patented invention on board vessels of countries of the Paris Union, in the body of the vessel, in the machinery, tackle, gear and other accessories, when such vessels temporarily or accidentally enter Spanish waters, provided that the subject matter of the patent is used exclusively for the needs of the vessel;

(e) use of the subject matter of the patented invention in the construction or operation of aircraft or land vehicles of countries members of the Paris Union, or of accessories of such aircraft or land vehicles, when those aircraft or land vehicles temporarily or accidentally enter Spanish territory;

(f) acts provided for in Article 27 of the Convention of December 7, 1944, on international civil aviation, when such acts relate to aircraft of a State to which the provisions of the said Article apply.

3. The rights conferred by a patent shall not extend to acts committed in Spain with regard to a product protected by the patent after the said product has been put on the market in Spain by the patent owner or with his consent.

4.-(1) The owner of a patent shall not have the right to prevent persons who, in good faith, prior to the date of priority of the patent, had worked the patented invention in Spain or had made serious and concrete preparations to work the said invention, from

continuing or commencing working it or from making preparations in the same manner as before in such a way as to meet the reasonable needs of their enterprises. This right to work the invention shall only be transferable with the enterprise.

(2) The rights conferred by the patent shall not extend to acts related to a product protected by it after the product has been put on the market by the person who enjoys the right to work the invention mentioned in the preceding paragraph.

□□ The owner of a patent may not invoke the latter in his defense in actions against him for infringement of other patents that have an earlier date of priority.

□6. The fact that a patented invention cannot be worked without using an invention protected by an earlier patent belonging to another owner shall not be an obstacle to its validity. In such cases, the owner of the earlier patent may not work the later patent during its period of validity without the consent of its owner, nor may the owner of the later patent work either of the two patents during the period of validity of the earlier patent, unless he has the consent of the latter's owner or has obtained a compulsory license.

□□ A patented invention may not be worked in any form contrary to the Law, morality, public order or public health, and its working shall be subject to the prohibitions and restrictions, whether temporary or permanent, established or to be established by the legal provisions.

□8.-(1) □ here a patent is granted for an invention that comes under a legal monopoly, the monopolist may only use the invention with the consent of the patentee; however, in his industry, he shall be obliged to use those inventions that involve notable technical progress for the industry, obtaining the corresponding right of working.

(2) The monopolist shall have the right to request that he be authorized to work the patented invention and he may require the patentee, in exercise of this right, to allow him to acquire the patent. The amount to be paid by the monopolist for the right to work the patented invention or for acquisition of the patent shall be fixed by agreement between the parties, or, in the absence of agreement, by legal decision.

(3) □ ithout prejudice to implementation of the provisions laid down in the preceding paragraphs, where a monopoly has been established after a patent has been granted, the patentee shall also have the right to require the monopolist to acquire the enterprise or the equipment with which he has worked the patented invention, upon payment of an

amount to be fixed between the parties or, in the absence of agreement, by legal decision.

(4) Patented inventions that cannot be worked because of the existence of a legal monopoly shall not be subject to annual fees.

**59.**(1) A patent application shall, from the date of its publication, confer on its owner provisional protection consisting of the right to require reasonable remuneration appropriate to the circumstances from any third party who, between the date of that publication and that of the announcement that the patent has been granted, has made use of the invention in a manner that would have been prohibited had the patent already been granted.

(2) That provisional protection shall also apply before the application's publication to any person informed of the filing of the application and its contents.

(3) Where the subject matter of the patent application consists of a process concerning a microorganism, provisional protection shall only commence when the microorganism has been made available to the public.

(4) Patent applications shall have none of the effects provided for in the preceding paragraphs when they have been or are considered to have been withdrawn or when they have been rejected as a result of a final decision.

**60.**(1) The scope of protection conferred by a patent or patent application shall be determined by the content of the claims. The description and drawings shall, however, be used to interpret the claims.

(2) For the period preceding the grant of a patent, the scope of protection shall be determined by the claims in the application, just as if these had been made public. The patent as granted shall, however, determine the protection retroactively, provided that its scope has not been extended.

**61.**(1) Where a product for which there is already a corresponding patent for its manufacturing process is introduced into Spain, the owner of the patent shall, in respect of the product introduced, have the same rights as those granted under the present Law for products manufactured in Spain.

(2) Where a patent concerns a process for the manufacture of new products or substances, unless there is proof to the contrary, it shall be presumed that any product or substance with the same characteristics has been obtained by using the patented process.

(3) During proceedings to prove the contrary, as provided for in the preceding paragraph, the legitimate interests of the plaintiff shall be taken into account so as to protect his manufacturing or trade secrets.

#### **TITLE VII - ACTION FOR INFRINGEMENT OF PATENT RIGHTS**

**62.** The owner of a patent may bring appropriate action of any type or nature before the ordinary courts against any person who infringes his rights and he may demand the necessary measures to safeguard those rights.

**63.** The owner whose patent rights have been infringed may, in particular, see

(a) cessation of the acts that infringe his rights;

(b) compensation for the damage and prejudice suffered;

(c) seizure of the objects produced or imported in infringement of his rights, as well as the means exclusively used for such production or for carrying out the patented process;

(d) whenever possible, attribution of the ownership of the objects and means seized in accordance with the provisions of the preceding subparagraph. In such cases, the value of the goods concerned shall be deducted from the compensation for damage and prejudice. Where that value exceeds that of the compensation granted, the owner of the patent shall pay the excess amount to the other party;

(e) the adoption of the necessary measures to prevent continued infringement of the patent, in particular, the transformation of the objects or means seized in accordance with the provisions of subparagraph (c), above, or their destruction when such is indispensable in order to prevent infringement of the patent;

(f) publication of the judgment against the person infringing the patent, at his cost, by means of announcements and notification to the persons concerned. That measure shall only apply when the judgment so specifies.

**63-(1)** Any person who, without the consent of the owner of the patent, manufactures or imports objects protected by the patent or uses the patented process, shall be liable for the damage and prejudice caused.

(2) Persons who in any other way work the subject matter protected by the patent shall only be liable for compensation for the damage and prejudice caused if the owner of the patent has notified them of the existence of the patent in question and of their



infringement and has required them to cease such infringement, or their action has been culpable or negligent.

6□ In order to fix the amount of the damage and preñudice suffered through unauthorized worñing of an invention, the owner of the patent may require the submission of the documentation belonging to the person responsible.

**66.**-(1) Compensation for damage and preñudice due to the owner of the patent shall not only include the amount of the loss that he has suffered, but also the profits lost through infringement of his rights.

(2) The profits lost shall be calculated in accordance with one of the following criteria, at the choice of the inñured party:

(a) the profits the owner could foreseeably have earned from worñing the patented invention if there had been no competition from the person infringing his rights;

(b) the profits earned by the latter party from worñing the patented invention;

(c) the amount the person infringing the patent would have paid to the owner for granting a license that would have allowed him to worñthe patent legally.

In fixing the amount, special consideration shall be given, *inter alia*, to the economic importance of the patented invention, the term of the patent at the time infringement commenced and the number and class of the licenses granted at that time.

(3) □ here the ñudge considers that the owner does not fulfill the obligation to worñthe patent established in Article 83 of the present Law, the profits lost shall be fixed in accordance with the provisions of subparagraph (c), above.

6□-(1) □ here the inñured party has chosen one of the criteria laid down in subparagraphs (a) or (b) of paragraph (2), above, for fixing the amount of the profits lost, calculation of those profits may also tañe into account, to the extent deemed reasonable by the ñudge, the profits obtained from worñing other obñects of which the patented invention constitutes an essential part from the commercial point of view.

(2) The invention shall be deemed to be an essential part of goods from the commercial point of view when its incorporation constitutes a determinant factor in the demand for the said goods.

**68.** The owner of the patent may also require compensation for the preñudice suffered as a result of the loss of reputation of the patented invention caused by the person

infringing his rights through defective manufacture or unsatisfactory presentation of the invention on the market.

69. The remuneration the owner of the patent has received from other persons for working the same invention in any other manner shall be deducted from the compensation to be paid by the person who has produced or imported the invention without the owner's consent.

70. The owner of the patent may not bring any of the actions specified under this Title in respect of persons who work the objects presented on the market by persons who have paid appropriate compensation for the damage and prejudice caused.

71.-(1) The time limit for bringing a civil action for infringement of a patent shall be five years from the time that right could have been exercised.

(2) Compensation for damage and prejudice may only be claimed for acts that have taken place during the five years immediately preceding the date on which the action was brought.

## **TITLE VIII - PATENT APPLICATIONS AND PATENTS AS INDUSTRIAL PROPERTY**

### Chapter I. Joint Ownership and Expropriation

72.-(1) Where a patent application or patent already granted belongs to a number of persons in undivided parts, the resultant co-ownership shall be governed by agreement among the parties or, in its absence, by the provisions of the present Article, or, ultimately, by the common law provisions on joint ownership.

(2) However, any one of the parties alone may

(a) dispose of the part belonging to him, notifying the other parties that they may exercise their rights to trial and prior purchase. The time limit for exercising the right to trial shall be two months from the date of sending the notification, and for prior purchase it shall be one month from the date of recording the assignment in the Patent Register;

(b) work the invention following notification to the other joint owners;

(c) carry out the acts required to maintain the application or patent;

(d) bring civil or criminal action against third parties who in any way infringe the rights conferred by the joint application or patent. The party exercising such action shall be obliged to notify the other parties of the action taken so that they may also take part.

(3) A license to a third party to work the invention shall be granted by the parties jointly, unless the judge deems that, for reasons of equity given the particular circumstances, one of the parties should be authorized to grant the said license.

11-(1) Any patent application or patent already granted may be expropriated for reasons of public utility or public interest, subject to fair compensation.

(2) Expropriation may be for the purpose of placing the invention within the public domain so that it may be freely worked by any person without the need to apply for licenses, or it may be for the purpose of exclusive working by the State, which would then acquire ownership of the patent.

(3) Public utility or public interest shall be declared in the Law authorizing the expropriation [*ley que ordene la expropiación*], which shall also state whether the invention shall fall within the public domain or whether the State shall acquire ownership of the patent or application. The procedure to be followed shall conform in every aspect, including fixing of fair compensation, to the general procedure laid down in the Law on Compulsory Expropriation [*ley de expropiación forzosa*].

## Chapter II. Transfer and Contractual Licenses

11-(1) Both patent applications and patents shall be transferable and may be the subject of licenses and use. They may also be used as security for personal loans, which shall be governed by the relevant provisions, and such use shall be notified to the Registry of Industrial Property.

(2) To be valid, the acts mentioned in the preceding paragraph shall be in writing when performed *inter vivos*.

(3) For the purposes of assignment or transfer, patent applications and patents already granted shall be indivisible, even where they belong jointly to several persons.

11-(1) Both patent applications and patents may be the subject of licenses covering the whole or part of the element constituting the exclusive right, for all or part of the Spanish territory. Licenses may be exclusive or non-exclusive.

(2) The rights conferred by the patent or application may be exercised against a licensee who violates the restrictions placed on the license in accordance with the provisions of the preceding paragraph.

(3) Unless otherwise agreed, holders of contractual licenses may not transfer them to third parties nor grant sub-licenses.

(4) Unless otherwise agreed, holders of contractual licenses shall have the right to carry out all the acts comprised in working the patented invention, for all applications, on the whole of the Spanish territory and for the whole term of the patent.

(5) Unless otherwise agreed, a license shall not be deemed to be exclusive and the licensor may grant licenses to other persons and work the invention himself

(6) Exclusive licenses shall prevent the granting of other licenses and the licensor may only work the invention if he has specifically reserved this right in the contract.

6.-(1) Unless otherwise agreed, any person who transfers a patent application, a patent already granted or who grants a corresponding license, shall be obliged to make available to the transferee or licensee the technical data he possesses that is necessary to work the invention satisfactorily.

(2) The transferee or licensee to whom secret data has been communicated shall be obliged to take the necessary measures to prevent its disclosure.

6.-(1) Unless otherwise agreed, any person who transfers a patent application or a patent already granted or who grants a corresponding license against payment shall be responsible if subsequently it is declared that ownership or the means necessary for completing the business in hand are lacking. Where an application is withdrawn or refused or a patent is invalidated, the provisions of Article 114(2), below, shall apply, unless there is agreement on the increased liability of the transferor or licensor.

(2) The transferor or licensor shall be liable when he has acted in bad faith. Unless there is proof to the contrary, bad faith shall mean that the other party has not been informed, by means of specific mention of each document in the contract, of the Spanish or foreign reports or decisions available or known to the transferor or licensor concerning the patentability of the invention that is the subject matter of the application or patent.

(3) The time limit for the action referred to in the preceding paragraphs shall be six months from the date of the final decision or judgment on which it is based. The provisions of the Civil Code [*Código Civil*] on compensation for eviction shall apply.

8.-(1) Any person who transfers a patent application or a patent already granted or who grants a corresponding license shall be liable jointly with the transferee or licensee for compensation due as a result of damage or prejudice caused to third persons by defects inherent in the invention that is the subject matter of the application or patent.

(2) The transferor or licensor who has assumed the liability mentioned in the preceding paragraph may claim from the transferee or licensee the amounts paid, unless it has been otherwise agreed, he has acted in bad faith or, given the circumstances of the case and for reasons of equity, he should bear all or part of the compensation due to third parties.

9.-(1) Patent applications and patents already granted shall be recorded in the Patent Register in the prescribed form.

(2) With the exception of the case provided for in Article 13(1), above, any transfer, license or other act, whether voluntary or compulsory, affecting patent applications or patents already granted shall only have effect against third parties of good faith when it has been recorded in the Patent Register.

(3) Rights in patent applications or patents may not be invoked against third parties unless they are duly recorded in the Register. Neither may products mention a patent application or a patent unless an appropriate right has been recorded. Acts carried out in violation of the provisions of the present paragraph shall be punished as acts of unfair competition.

(4) No authorization shall be given for payment in foreign currency in fulfillment of obligations under contracts that are subject to recording in the Patent Register when such has not been done.

(5) The Registry of Industrial Property shall assess the legality, validity and effects of the acts to be recorded in the Patent Register and they shall be contained in a public document. The Register shall be public.

80. Where a patent owner has been convicted of serious violation of the provisions of Law 110/1963 of July 20, 1963, concerning the suppression of restrictive competitive practices [Ley 110/1963 de 20 de julio sobre represión de las prácticas restrictivas de la competencia], the judgment may compulsorily place the patent under the regime of *ex officio* licenses. In such cases, there shall be no reduction in the amount of the annual fees to be paid by the patent owner.

### Chapter III. *e*-*officio* Licenses

**81.-(1)** Where the owner of the patent offers *e*-*officio* licenses, informing the Registry of Industrial Property in writing that he is willing to authorize the use of the invention by any interested party in the capacity of licensee, the annual fees to be paid for the patent shall be reduced by half following receipt of his declaration. Where there is a total change in ownership of a patent as a result of the exercise of the legal action provided for in Article 12, above, the offer shall be considered to have been withdrawn when the new owner is entered in the Patent Register.

The Registry shall enter in the Patent Register and shall give appropriate publicity to offers of *e*-*officio* licenses.

(2) The offer may be withdrawn at any time through notification in writing addressed to the Registry of industrial Property, provided that no person has informed the owner of the patent of his intention to use the invention. Withdrawal of the offer shall take effect from the time of notification. The amount of the corresponding reduction in fees shall be paid within the month following withdrawal of the offer, the provisions of Article 161(3), below, shall apply in such cases and the period of six months provided for therein shall be calculated from the end of the period previously specified.

(3) Licenses may not be offered when the Patent Register shows that there is an exclusive license or that an application for an exclusive license has been made.

(4) Following the offer of *e*-*officio* licenses, any person shall be entitled to use the invention in the capacity of a non-exclusive licensee. A license obtained in conformity with the provisions of the present Article shall be deemed to be a contractual license.

(5) When a license offer has been made, no application to enter an exclusive license in the Patent Register shall be permitted unless the offer has been withdrawn or is deemed to have been withdrawn.

**82.-(1)** Any person who wishes to use the invention on the basis of an offer of an *e*-*officio* license shall notify the Registry of Industrial Property accordingly in triplicate, indicating the use he intends to make of the invention. The Registry shall send to the owner of the patent by registered post one copy of the notification and shall send another copy back to the applicant. Both copies shall bear the stamp of the Registry and the same date of dispatch.

(2) The applicant for a license shall be entitled to use the invention in the form indicated one week after the date of dispatch of the notification by the Registry.

(3) In the absence of agreement between the parties, the Registry of Industrial Property, at the written request of one of the parties and after having heard both parties, shall fix a reasonable amount for the remuneration to be paid by the licensee or shall modify it if subsequent facts have occurred or have become known which show that the amount fixed is obviously insufficient. Requests for modification of the remuneration fixed by the Registry of Industrial Property may only be made after a period of one year has elapsed since it was previously fixed. Any request to fix or modify the remuneration shall only be taken into consideration if the corresponding fee has been paid.

(4) At the expiration of each quarter of the calendar year, the licensee shall inform the owner of the patent of the use he has made of the invention and shall pay the corresponding remuneration. Where he does not fulfill those obligations, the owner of the patent may grant him an additional period that will reasonably allow him to do so. If he has not done so at the expiration of that period, the license shall be annulled.

## TITLE I - OBLIGATION TO WORK OR AN OBLIGATORY LICENSE

### Chapter I. Obligation to work

8. The owner of a patent shall be obliged to work the patented invention either himself or through a person authorized by him, by implementing it in Spain or on the territory of a Member of the World Trade Organization in such a manner that the working is sufficient to satisfy demand on the national market.

Working must take place within a period of four years from the date of filing the patent application or three years from the date on which grant of the patent was published in the Official Bulletin of Industrial Property, the period which expires latest being automatically applied.

[Art. 83 amended by Law 66/1997.]

8-(1) The owner of the patent shall prove its working before the Registry of Industrial Property by means of an official certificate issued by the relevant body and corresponding to the prescribed criteria and general regulations.

(2) The certificate of working shall be based on inspection of the manufacturing process in the industrial establishment where the invention is being worked and on proof that the object of the invention is effectively being marketed.

(3) The said certificate shall be issued within three months following the date on which it was requested and shall state specifically that the patented invention is being worked, setting out the information substantiating that statement.

(4) The certificate of working shall be recorded at the Registry of Industrial Property.

**87.** When working has been proved before the Registry of Industrial Property by means of the relevant certificate, unless there is proof to the contrary, it shall be presumed that the patented invention is being worked in the form required by Article 84 of the present Law.

#### Chapter II. Requirements for the Granting of Compulsory Licenses

**86.** Where a particular patent is not the subject of the offer of *ex officio* licenses and where one of the following situations exists, a compulsory license may be granted:

- (a) failure or insufficiency of working of the patented invention;
- (b) export necessities;
- (c) dependency of patents;
- (d) existence of reasons of public interest.

**87-(1)** Following expiration of the period laid down in Article 83 for working the invention protected by the patent, any person may request the granting of a compulsory license for the patent provided that, at the time of the request, unless there are legitimate excuses, working of the patent has not commenced or effective and concrete preparations have not been made to work the invention that is the subject matter of the patent, or working has been suspended for more than three years.

(2) Legitimate excuses shall be deemed to be objective difficulties of a legal technical nature, independent of the will and circumstances of the owner of the patent, which make working of the patent impossible or prevent its working from being more extensive than it is.

**88.** Where the export market cannot be satisfactorily supplied due to insufficient production of the subject matter of the patent, thus creating serious prejudice for Spain's economic and technological progress, the Government may, by Royal Decree, make the



said patent subject to a regime of compulsory licenses the objective of which shall cover exclusively the unsatisfied needs of the export market.

**89.**-(1) Where it is not possible to work the invention protected by a patent without harming the rights conferred by an earlier patent, the owner of the subsequent patent may at any time require the granting of a compulsory license for the earlier patent provided that his invention has distinctive industrial objectives or represents considerable technical progress in comparison with the earlier patent.

(2) Where inventions used for the same industrial purpose are protected by patents that are dependent one upon another and a compulsory license has been granted to the owner of the dependent patent, the owner of the earlier patent may also apply for the grant of a license for the later patent.

(3) Where the subject matter of a patent is a process to obtain a chemical or pharmaceutical substance protected by a patent in force and provided that the patent for the process represents considerable technical progress in comparison with the earlier patent, both the owner of the patent for the process and the owner of the patent for the product shall have the right to obtain a compulsory license for the patent of the other party.

(4) The content of a compulsory license granted for reasons of dependency of patents shall only be sufficient to allow working of the invention protected by the patent concerned and it shall no longer have effect after invalidation or forfeiture of any of the patents on which it is dependent.

**90.**-(1) For reasons of public interest, the Government may at any time make a patent application or a patent already granted subject to the grant of compulsory licenses, acting in that respect by Royal Decree.

(2) Reasons of public interest shall be deemed to exist when the initiation, increase or generalization of working of the invention, or improvement of the conditions in which it is being worked, are of paramount importance for public health or national defense.

Reasons of public interest shall also be deemed to exist when failure to work or the insufficient quality or quantity of working leads to serious prejudice for Spain's economic or technological development.

(3) A Royal Decree on the granting of compulsory licenses shall be drawn up at the proposal of the Ministry of Industry and Energy. In cases where the importance of

working the invention concerns public health or national defense, the proposal shall be formulated jointly with the competent Minister for health or defense, respectively.

(4) A Royal Decree making a patent subject to the granting of compulsory licenses because of its importance for national defense may reserve the possibility of soliciting one or several specific enterprises for such licenses.

(5) Where public interest can be met without the need to generalize working of the invention or entrusting its working to a person other than the owner of the patent, the Royal Decree may conditionally make the patent subject to the granting of compulsory licenses, authorizing the Minister of Industry and Energy to allow the owner a period not exceeding one year to initiate, increase or improve working of the invention to the extent necessary to meet the public interest. In such cases, the Minister of Industry and Energy, having heard the owner of the patent, may allow the period he deems appropriate or may immediately make the patent subject to the granting of licenses. Following expiration of the period which has been fixed, where appropriate, the Minister of Industry and Energy shall decide whether the public interest has been met and, if such is not the case, shall make the patent subject to the granting of compulsory licenses.

### Chapter III. Procedure for Granting Compulsory Licenses

**91.**-(1) Before applying for a compulsory license, the interested party may request the mediation of the Registry of Industrial Property in order to obtain a contractual license for the same patent.

(2) The request for mediation shall be subject to payment of a fee and shall contain the following:

- (a) full indications concerning the applicant;
- (b) the patent to which the request refers, together with an indication of its owner;
- (c) the relevant circumstances that may justify the granting of compulsory licenses;
- (d) the scope of the license sought and the reasons substantiating that claim;
- (e) information permitting a decision on whether or not the applicant can effect real and effective working of the patented invention and can offer the guarantees reasonably required by the owner of the patent for granting a license.

(3) The request for mediation shall be accompanied by

- (a) documents supporting the claims made therein;
- (b) a document attesting to constitution of a guarantee, the amount of which shall be prescribed in the Regulations, to be used to meet the costs of the procedure to be paid by the applicant;
- (c) a complete copy of the application and the accompanying documents.

**92.-(1)** Following submission of the request for mediation, within the non-extendable period of one month, the Registry of Industrial Property shall decide whether to agree to mediate.

(2) The Registry shall agree to mediate when the interested party's request and the accompanying documents, as well as the investigations carried out by the Registry itself, reasonably show that there are circumstances that could lead to the granting of compulsory licenses for the patent, that the applicant is solvent and that he has at his disposal the necessary means to achieve serious working of the patented invention.

(3) The Registry shall notify its decision to the interested party and to the owner of the patent, and at the same time shall transmit a copy of the request for mediation to the latter.

(4) No appeal may be made against the Registry's decision.

**93.-(1)** Where the Registry of Industrial Property agrees to mediate, it shall immediately notify the interested parties accordingly and shall invite them to commence negotiations on the granting of a contractual license, with the Registry participating as mediator. The negotiations shall last a maximum of two months.

(2) In its role as mediator, the Registry shall take an active part in bringing together the positions of the interested parties and facilitating the granting of a contractual license.

(3) When it has agreed to mediate and during the period provided for negotiations, the Registry shall carry out the necessary inquiries to acquaint itself with the specificities of the case and evaluate satisfactorily the positions of the interested parties, in particular, by ascertaining whether circumstances justify the granting of a compulsory license. This investigative work shall be carried out whatever the progress of the negotiations and whether or not they have broken down or not yet begun.

(4) At the expiration of a period of two months after notification to the interested parties of its agreement to mediate, if no agreement has been reached on the granting of a

contractual license, the Registry shall declare its mediation and investigation terminated and shall inform the interested parties accordingly.

This period of two months may be extended for a specified period at the joint request of the two parties, provided that the Registry deems that such an extension will effectively serve to achieve the granting of the license. Where the Registry considers that no possibility of reaching agreement exists, it may terminate its mediation even though the specified period of extension has not expired.

(5) Both before and after the final decision, the documentation on mediation may only be consulted by the parties, who may have copies made of all the documents at their own expense. The parties and the Registry staff who have access to the documentation shall respect the secrecy of the contents.

94-(1) Where, as a result of the negotiations carried out with the mediation of the Registry of Industrial Property, the parties agree to a license for the patent, they may request that no applications for compulsory licenses for the patent be permitted during the period necessary for the licensee to start working the invention. This period may under no circumstances exceed one year.

(2) For the Registry of Industrial Property to respond favorably to the request, the following conditions shall be met:

(a) the license agreed upon is exclusive and its exclusivity is not contrary to the objective that could be pursued by making the patent subject to the granting of compulsory licenses;

(b) the interested parties provide documentary proof that the licensee has at his disposal the means necessary to work the invention and the period requested is indispensable for commencement of working;

(c) the interested parties provide what the Registry of Industrial Property considers to be a sufficient guarantee to meet any liabilities incurred if working of the invention does not commence within the prescribed period;

(d) the legally prescribed fee has been paid.

(3) Having examined the documentation submitted by the interested parties and having carried out the investigations and consultations it deems necessary, the Registry of Industrial Property may suspend the submission of applications for compulsory licenses for the patent in question for a specified period, provided that the conditions laid down