

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

(as last amended by Law 50/1998, of December 30, 1998, on Tax, Administrative and Social Policy Measures)

TABLE OF CONTENTS**

	<i>Articles</i>
Title I: General Provisions	1-3
Title II: Patentability	4-9
Title III: Right to a Patent and Indication of the Inventor.....	10-14
Title IV: Employee Inventions.....	15-20
Title V: Granting of Patents	
Chapter I: Filing and Requirements for Patent Applications.....	21-29
Chapter II: General Procedure for Granting Patents.....	30-38
Chapter III: Procedure for Granting Patents with Prior Examination.....	39-40
Chapter IV: General Provisions Concerning Procedure and Information for Third Parties.....	41-46
Chapter V: Appeal	47-48

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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.

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Title VI: Effects of Patents and Patent Applications.....	49-61
Title VII: Action for Infringement of Patent Rights	62-71
Title VIII: Patent Applications and Patents as Industrial Property	
Chapter I: Joint Ownership and Expropriation	72-73
Chapter II: Transfer and Contractual Licenses	74-80
Chapter III: <i>Ex-Officio</i> Licenses	81-82
Title IX: Obligation to Work and Compulsory Licenses	
Chapter I: Obligation to Work	83-85
Chapter II: Requirements for the Granting of Compulsory Licenses	86-90
Chapter III: Procedure for Granting Compulsory Licenses	91-100
Chapter IV: Compulsory License System.....	101-106
Chapter V: Promotion of Applications for Compulsory Licenses	107
Title X: Additions to Patents.....	108-111
Title XI: Invalidation and Forfeiture of Patents	
Chapter I: Invalidation	112-115
Chapter II: Forfeiture	116-118
Title XII: Secret Patents	119-122
Title XIII: Jurisdiction and Procedural Regulations	
Chapter I: General Provisions	123-128
Chapter II: Inquiries to Substantiate Facts.....	129-132
Chapter III: Preventive Measures	133-139
Chapter IV: Conciliation in the Field of Employees' Inventions	140-142
Title XIV: Utility Models.....	143-154
Title XV: Agents and Representatives	155-159
Title XVI: Taxes and Annual Fees.....	160-162

Additional Provisions

Transitional Provisions

Final Provisions

Repealing Provision

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 Property¹ [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 Property² [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.

3. 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.]

¹ See *Industrial Property Laws and Treaties*, MULTILATERAL TREATIES—Text 1-016 (*Editor’s note*).

² Founded by the Paris Convention, mentioned above (*Editor’s note*).

TITLE II PATENTABILITY

4.—(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.

5.—(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.

7. 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 Property³ 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 INDICATION 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.

³ Law 21/1992, of July 16, 1992, on Industry replaced the denomination “Registry of Industrial Property” by “Spanish Patent and Trademark Office”. Consequently, in this Law, references to the Registry of Industrial Property should be taken as references to the “Spanish Patent and Trademark Office” (*Editor’s note*).

(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 judicata* 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 rejected.

(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 judgement 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

15.—(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.

17.—(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's 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.

24.—(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.

25.—(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. Where multiple priorities are claimed, the periods to be calculated from the date of priority shall be computed from the earliest date of priority.

(3) Where 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) Where 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

30. Within eight days following their receipt in its office, the Registry of Industrial Property shall directly reject 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.]

31.—(1) Where 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 subject of verification.

(2) The Registry of Industrial Property shall also verify whether or not the subject 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 justified reasons, when the invention that is the subject matter of the application clearly and obviously lacks novelty.

(3) Where the result of the examination shows that the application has formal defects or that its object 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.

32.—(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.

33.—(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 Treaty⁴, 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.]

⁴ See *Industrial Property Laws and Treaties*, MULTILATERAL TREATIES—Text 2-006 (*Editor's note*).

34.—(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 seek 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.

35.—(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.]

37.—(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:

- 1º the number of the patent granted;
- 2º the class or classes to which the patent belongs;
- 3º a concise description of the invention that is the subject matter of the patent granted;
- 4º the first name and surname or the trade name of the applicant, together with his nationality and domicile;
- 5º an abstract of the invention;
- 6º 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;
- 7º the date on which the patent was granted;
- 8º 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.

38.—(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

39.—(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.]

40.—(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:

- 1º the number of the patent granted;
- 2º the class or classes to which the patent belongs;
- 3º a concise description of the invention that is the subject matter of the patent granted;
- 4º the first name and surname or the trade name of the applicant, together with his nationality and domicile;
- 5º an abstract of the invention;
- 6º 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;
- 7º the date on which the patent was granted;
- 8º 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;
- 9º 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 IV General Provisions Concerning Procedure and Information for Third Parties

41.—(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.

42.—(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.

43.—(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.

44.—(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.

45.—(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.

46.—(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 V Appeal

47.—(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.

48. 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

49. 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.

50. 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.

51.—(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.

52. 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.

53. 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's owner or with his consent.

54.—(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.

55. 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.

56. 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.

57. 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.

58.—(1) Where 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) Without 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, seek:

- (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.

64.—(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.

65. In order to fix the amount of the damage and prejudice suffered through unauthorized working 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 prejudice 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 injured party:

- (a) the profits the owner could foreseeably have earned from working the patented invention if there had been no competition from the person infringing his rights;
- (b) the profits earned by the latter party from working 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 work the 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) Where the judge considers that the owner does not fulfill the obligation to work the patent established in [Article 83](#) of the present Law, the profits lost shall be fixed in accordance with the provisions of [subparagraph \(c\)](#) above.

67.—(1) Where the injured 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 take into account, to the extent deemed reasonable by the judge, the profits obtained from working other objects 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 prejudice 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 injure 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.

73.—(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

74.—(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.

75.—(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.

76.—(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.

77.—(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.

78.—(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.

79.—(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 *Ex-Officio* Licenses

81.—(1) Where the owner of the patent offers *ex-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 *ex-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 *ex-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 *ex-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 IX OBLIGATION TO WORK AND COMPULSORY LICENSES

Chapter I Obligation to Work

83. 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.]

84.—(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.

85. 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 in the preceding paragraph have been met and that, under the circumstances, it is considered that the parties seriously wish to commence working the patented invention without delay. This suspension shall be entered in the Patent Register.

(4) The interested parties shall each month provide proof of the efforts being made to commence working and the Registry of Industrial Property shall order the inspections that it deems necessary.

(5) The Registry of Industrial Property may annul the suspension of submission of applications for compulsory licenses if it is proved that a serious error was committed when evaluating the circumstances justifying its decision or that the interested parties are not undertaking serious and continuous activity to commence working within the prescribed period.

(6) Where the licensee does not commence working within the prescribed period, the Registry of Industrial Property shall impose a fine on the interested parties the amount of which shall be calculated on the basis of the average sum to be paid by the licensee to the owner of the patent as royalties during the period of the contract's validity equivalent to the period of suspension.

95.—(1) Following a period of three months from the expiration of the period referred to in [Article 83](#), or from the refusal of the Registry to accept the proposed mediation, or from the expiration of the period established by mediation, without any agreement being reached between the parties, the interested party may apply to the Registry for the granting of a compulsory license for the patent.

(2) In the application for a compulsory license, which shall be subject to payment of the legally prescribed fee, the interested party shall, on the basis of the contents of the mediation documentation, where appropriate, and the documents he provides, explain his application and set out the circumstances justifying it, the interest on which it is based, the means by which he intends to achieve real and effective working of the patented invention and the guarantees he can offer if the license is granted.

(3) The application shall be accompanied by the following:

- (a) documents proving the claims made therein and which do not appear in the mediation documentation, where appropriate;
- (b) a document attesting to the constitution of a guarantee, the amount of which shall be fixed in general in the Regulations, to be used to meet the procedural costs payable by the applicant;
- (c) a complete copy of the application and the documents submitted.

96.—(1) Following application for a compulsory license and provided that the conditions mentioned in the preceding Article have been met, the Registry shall commence the relevant procedure, including therein the mediation documentation, where appropriate, and shall transmit a copy of the application and the accompanying documents to the owner of the patent so that he may contest it within a period not exceeding one month.

(2) Where an application for a compulsory license is accompanied by proof that the Registry refused to mediate, the period during which the owner of the patent may contest it shall be two months.

(3) Contestation shall take into account the contents of the mediation documentation, where appropriate, and shall be accompanied by evidence substantiating the claims made therein and which do not appear in the said documentation. It shall be accompanied by a complete copy for transmission to the applicant.

(4) Where satisfactory working of the patented invention is invoked, the owner of the patent shall include in his contestation information concerning the said working, together with evidence proving its exactitude.

97.—(1) Following receipt of the patent owners contestation, the Registry shall transmit it to the other party and, within a non-extendable period of one month, shall take a decision to grant or refuse a compulsory license.

(2) Where the owner of the patent does not contest the application within this period, the Registry shall immediately grant the license.

(3) The decision granting the license shall specify its contents. In particular, it shall determine the scope of the license, the royalties, the term, the guarantees to be provided by the licensee, the time at which working shall commence and any other clauses to ensure serious and effective working of the patented invention.

(4) The decision shall specify the costs to be paid by each party, which shall be those occasioned by the request. Common costs shall be divided in half.

Payment of all the costs may be imposed on one of the parties where he is declared to have acted imprudently or in bad faith.

(5) Contentious administrative appeals may be lodged against the Registry's decision. Lodging of an appeal shall not suspend execution of the act imposed; however, the Registry may authorize the licensee, following a substantiated request by him, to postpone commencement of working until the decision on the license becomes final.

98.—(1) Following the filing of an application for a compulsory license, the Registry may automatically take the necessary steps in order to reach a decision on granting the license.

(2) At the duly substantiated joint request of the applicant for a license and the owner of the patent, the Registry may, at any time, on one occasion only, suspend the procedure at the stage reached for a specified period not exceeding three months. Following expiration of the period of suspension, the Registry shall notify the parties and the procedure shall be resumed.

99.—(1) License contracts agreed with the mediation of the Registry that directly or indirectly involve payment in foreign currency shall be subject to the authorization provided for in the regulations governing transfer of foreign technology.

(2) Any decision by the Registry of Industrial Property on granting a compulsory license that directly or indirectly involves payment in foreign currency shall require the issuance of a prior favorable report by the body competent to authorize contractual licenses involving such forms of payment.

(3) The necessary coordination between the Registry of Industrial Property and the body authorizing licenses involving payment in foreign currency shall be established so as to harmonize criteria and simplify procedure for the purposes laid down in the present Article.

100. Where the owner of a patent does not have his legal domicile or usual residence in Spain, the communications provided for under the present Title shall be sent

to the representative, an industrial property attorney, who has previously been designated for this purpose.

Chapter IV Compulsory License System

101.—(1) Compulsory licenses shall not be exclusive.

(2) The license shall provide for adequate remuneration according to the particular circumstances of each case, due regard being had to the economic importance of the invention.

[[Art. 101](#) amended by Law 66/1997.]

102.—(1) Relations between the owner of the patent and the licensee who has been granted a compulsory license shall be governed by the principle of good faith.

(2) Where a legal decision declares that the owner of the patent has violated that principle, the licensee may request the Registry to reduce the royalties fixed for the license in proportion to the importance of the unfulfilled obligation for working the invention.

103.—(1) Compulsory licenses shall include additions to the relevant patent at the time of granting the license.

(2) Following the grant of a compulsory license, where new additions are made to the patent and their subject matter has the same industrial application as the patented invention that is the subject of the license, the licensee may request the Registry to include the new additions in the license. Where the interested parties do not reach agreement with the mediation of the Registry, the latter shall fix the royalties and the other conditions under which the scope of the license may be extended.

104.—(1) The transfer of a compulsory license shall only be valid where the license is transferred together with the enterprise or the part of the enterprise that works the patented invention and the transfer shall be noted specifically by the Registry of Industrial Property. In the case of licenses for dependent patents, the license shall be transferred with the dependent patent.

(2) Any sublicenses granted by the owner of a compulsory license shall be null and void.

105.—(1) Both the licensee and the owner of the patent may request the Registry to modify the royalties or other conditions of the compulsory license when new facts occur that justify such changes, in particular, where, after granting of the compulsory license, the owner of the patent grants contractual licenses under conditions that are unjustifiably more favorable.

(2) Where the licensee fails seriously or repeatedly to fulfill any of his obligations under the compulsory license, the Registry of Industrial Property may automatically or at the request of the interested party annul the license.

106. To the extent that they are not specifically contrary to the provisions of the present Title, the provisions governing contractual licenses in [Chapter II](#) of [Title VIII](#) of the present Law shall apply to compulsory licenses.

Chapter V Promotion of Applications for Compulsory Licenses

107.—(1) The Registry of Industrial Property shall make systematic efforts to promote effectively license applications for patents subject to the granting of compulsory licenses. The Registry of Industrial Property shall also publish periodically details of such patents.

(2) Where the importance of working patented inventions in Spain so warrants, the Government may institute financial and other incentives to encourage enterprises to apply for licenses for specific patents subject to the granting of compulsory licenses for reasons of public interest.

TITLE X ADDITIONS TO PATENTS

108.—(1) The owner of a patent in force may protect inventions that improve or further develop the invention that is the subject matter of the patent by applying for additions to the patent, provided that they can be combined with the subject matter of the principal patent to make a single inventive unit.

(2) Requests may also be made for additions to a patent application, although such additions may not be granted until the patent itself has been granted.

(3) The object of the addition shall not necessarily imply an inventive step in comparison with the subject matter of the principal patent.

109.—(1) Additions shall have the date of priority corresponding to their respective applications; their term shall be that of the patent and they shall not be subject to the payment of annual fees.

(2) Except for such purposes where the present Law specifies otherwise, additions shall be deemed to be an integral part of the principal patent.

110.—(1) At the request of the applicant, an application for an addition may be transformed into an application for a patent at any time during the procedure or within three months following the date on which the Registry of Industrial Property has communicated the inadmissibility of the application for an addition because its subject matter is not sufficiently related to the invention protected by the principal patent.

(2) Additions already granted may be transformed into separate patents at the request of their owner provided that he renounces the principal patent.

(3) Following an application to transform one of the additions into a patent, subsequent additions may remain as additions to the patent applied for, provided that there is still the necessary unity of the subject matter.

(4) Separate patents resulting from the transformation of additions shall be subject to the payment of the relevant annual fees and their term shall be that of the principal patent.

111. Unless otherwise specified and for all purposes that are compatible with the nature of the additions, the provisions laid down in the present Law concerning patents shall apply to additions.

TITLE XI

INVALIDATION AND FORFEITURE OF PATENTS

Chapter I Invalidation

112.—(1) A patent shall be declared invalid in the following cases:

- (a) when it is proved that, in respect of the subject matter of the patent, one of the conditions of patentability contained in [Title II](#) of the present Law has not been met;
- (b) when the invention is not described in a sufficiently clear and comprehensive manner to allow a person skilled in the art to carry it out;
- (c) when the subject matter goes beyond the content of the patent application as filed or, where the patent has been granted as a result of a divided application or of an application based on the provisions of [Article 11](#), when the subject matter of the patent goes beyond the content of the original application as filed;
- (d) when the owner of the patent had no right to obtain the patent in conformity with the provisions of [Article 10\(1\)](#).

(2) Where the causes of invalidation only affect part of the patent, partial invalidation shall be declared through annulment of the claim or claims affected by those causes. Partial invalidation of a claim may not be declared.

(3) Where invalidation is partial, the patent shall continue in force for the claims that have not been annulled, provided that it can constitute the subject matter of a separate patent.

113.—(1) Any person who considers that he has suffered prejudice, as well as the Public Administration [*Administración Pública*], may request a declaration of invalidation. In the case provided for in **paragraph (1)(d)** of the preceding Article, however, only the person authorized to obtain the patent may seek a declaration of invalidation.

(2) An action for invalidation may be brought during the legal term of a patent and during the five years after its forfeiture.

(3) An action shall be brought solely against the registered owner of the patent at the time of submitting the request and it must be communicated to all the persons owning

rights in the patent and duly entered in the Register so that they may appear and take part in the hearing.

(4) The invalidation of a patent may not be sought before the civil jurisdiction on the same grounds as those that have already been the subject of a judgment on its substance through contentious administrative channels.

114.—(1) A declaration of invalidation shall imply that the patent has never been valid and that neither the patent nor its original application have had any of the effects provided for in [Title VI](#) of the present Law, to the extent to which invalidation has been declared.

(2) Without prejudice to compensation for damage and prejudice that may be due when the owner of the patent has acted in bad faith, the retroactive effect of invalidation shall not affect the following:

- (a) decisions on infringement of the patent that have become *res judicata* and have taken place prior to the declaration of invalidation;
- (b) contracts concluded before the declaration of invalidation, to the extent that they were executed prior to the declaration. However, for reasons of equity and to the extent justified by the circumstances, restitution of the amounts paid under the contract may be claimed.

(3) Once it has become final, the declaration of invalidation of a patent shall become *res judicata* in respect of all persons.

115. The declaration of invalidation of a patent shall not necessarily imply the annulment of the additions thereto, provided that an application is made to transform them into separate patents within three months following notification of the declaration of invalidation.

Chapter II Forfeiture

116.—(1) Patents shall be forfeited in the following cases:

- (a) at the expiration of the period for which they were granted;
- (b) renunciation by the owner;
- (c) failure to pay a fee within the time limit and, where appropriate, failure to pay the corresponding surcharge;
- (d) failure to work the invention within two years following the grant of the first compulsory license;
- (e) failure to fulfill the obligation to work the invention as specified in [Chapter I](#) of [Title IX](#) when the owner of the patent does not benefit from the provisions of the Paris Convention and is usually domiciled or has his industrial or commercial establishment in a country the legislation of which permits the adoption of such a measure. In such cases, the provisions concerning the granting of licenses contained in [Chapter III](#) of [Title VIII](#) and in [Chapters II, III](#) and [IV](#) of [Title IX](#) shall not apply.

(2) Without prejudice to its declaration by the Registry of Industrial Property and its publication in the Official Bulletin of Industrial Property, forfeiture of a patent shall mean that the patented object falls within the public domain from the time at which the facts or omissions causing its forfeiture occurred, with the exception of those parts where this object is protected by an earlier patent still in force.

(3) Where there is failure to pay an annual fee, it shall be understood that the omission giving rise to the patent's forfeiture occurred at the beginning of the year for which the annual fee was not paid.

(4) In the case specified in [paragraph \(1\)\(d\)](#), above, the forfeiture of the patent shall be declared following examination by the Registry of Industrial Property of the corresponding administrative documentation.

117.—(1) A patent the forfeiture of which is due to failure to pay an annual fee may be restored if the owner proves that failure to pay was due to reasons of *force majeure*.

(2) The claim of *force majeure* may only be brought during the six months following the publication of the forfeiture of the patent in the Official Bulletin of Industrial Property and it shall be published in the said Bulletin within a period of one month so as to allow any interested party to formulate observations thereon.

(3) Where appropriate, restoration shall be granted by the Registry of Industrial Property, without prejudice to the rights of third parties arising from the patent's forfeiture. The recognition and scope of such rights shall be within the competence of the ordinary courts.

(4) For restoration to take effect, the owner of the patent shall pay the annual fee remaining unpaid and the corresponding surcharge.

118.—(1) The owner may renounce the patent as a whole or one or various claims therein.

(2) Where the patent is partly renounced, it shall continue in force in respect of those claims not included in the renunciation, provided that they constitute the subject matter of a separate patent and that renunciation does not involve extending the scope of the object of the patent.

(3) Renunciation shall be communicated in writing to the Registry of Industrial Property and shall be deemed to have effect from the date of its entry in the Patent Register.

(4) The owner may not renounce a patent for which effective rights or licenses are recorded in the Patent Register without the consent of the owners of the said rights.

(5) A patent the ownership of which has been claimed by a third party may not be renounced without the latter's consent.

TITLE XII

SECRET PATENTS

119.—(1) The content of all patent applications shall be kept secret during two months following their date of filing, unless the Registry of Industrial Property authorizes their prior disclosure.

(2) Before expiration of the period mentioned in the preceding paragraph, the Registry of Industrial Property shall extend the period to five months from the date of filing of the application when it considers that the invention concerned may be of interest for national defense. The Registry shall inform the applicant of the extension and shall immediately place at the disposal of the Ministry of Defense a copy of the patent application filed.

(3) For the purposes mentioned in the two preceding paragraphs, the necessary coordination between the Ministry of Defense and the Registry of Industrial Property shall be established so as to determine whether or not an invention might be of interest for national defense. Observing the necessary secrecy, the Ministry of Defense may also be acquainted with all applications filed.

(4) Where the national defense interests so require, the Ministry of Defense shall contact the Registry of Industrial Property so that before expiration of the period of five months provided for in the preceding paragraph the latter may order that the patent procedure be kept secret and inform the applicant accordingly.

(5) While the patent application or patent is subject to secrecy, the applicant or the owner shall refrain from any act that might enable the invention to become known to unauthorized persons.

(6) At the request of the owner, the Ministry of Defense may authorize acts leading to the total or partial working of the subject matter of the application or patent, specifying the conditions under which such acts may be carried out.

120.—(1) Patents that are granted following the procedure of secrecy shall be entered in a secret register and shall remain secret for one year from the date of being granted. This period may be extended annually and the owner of the patent shall be informed accordingly.

(2) Annual renewal of the secret status shall not apply in time of war until one year after the cessation of hostilities.

(3) Following a favorable report by the Ministry of Defense, the Registry of Industrial Property may at any time remove the obligation of secrecy imposed on an application or a specific patent.

121.—(1) Secret patents shall not be subject to the payment of annual fees.

(2) The owner of a patent may claim compensation from the State for the time during which the patent remains secret. Such compensation may be claimed for each succeeding year and shall be agreed between the parties. Where no agreement can be reached, compensation shall be fixed judicially taking into account the importance of the invention and the profits the owner could have expected to obtain from its free working.

(3) Where the invention that is the subject matter of the patent is disclosed through the fault or negligence of its owner, the latter shall lose the right to compensation.

122.—(1) For the purposes of the provisions laid down in the preceding Articles, in the case of inventions made in Spain, patents may not be applied for in any foreign country until two months have elapsed after the patent has been applied for at the Spanish Registry of Industrial Property, unless the Registry specifically authorizes otherwise. Such authorization may not under any circumstances be given for inventions that are of interest for national defense, unless the Ministry of National Defense gives special authorization.

(2) Where the inventor is usually resident in Spain, unless there is proof to the contrary, the invention shall be deemed to be have been made in Spain.

TITLE XIII

JURISDICTION AND PROCEDURAL REGULATIONS

Chapter I General Provisions

123. Bodies of the ordinary jurisdiction shall be competent to hear cases arising from the exercise of actions of any class or nature resulting from the application of the provisions of the present Law.

124.—(1) Unless otherwise agreed, the holder of an exclusive license may, in his own name, exercise any action recognized in the present Law that may be exercised by the owner of a patent in respect of third parties who infringe his rights; however, the holder of a non-exclusive license may not exercise such actions.

(2) A licensee who, according to the provisions of the preceding paragraph, is not entitled to bring an action for infringement of a patent may notarially request the owner of the patent to commence the relevant legal action. Where the owner refuses to do so or does not bring the appropriate action within a period of three months, the licensee may do so in his own name, annexing the request made. Prior to expiration of the aforementioned period, the licensee, submitting the request referred to above, may request a judge to adopt preventive measures when they are justified in order to avoid serious damage.

(3) A licensee who brings an action in accordance with the provisions of the preceding paragraphs shall inform the owner of the patent accordingly so that he may appear and take part in the hearing.

125.—(1) All civil cases under the provisions of the present Law shall be dealt with by means of the ordinary procedure for minor [*de menor cuantía*] claims.

(2) The judge of first instance in the seat of the Higher Court of Justice of the Autonomous Community corresponding to the domicile of the plaintiff shall be competent and, where there are several, one may be permanently designated by the competent legal body.

(3) The decisions of judges of first instance shall be subject to appeal before the relevant provincial court [*Audiencia Provincial*] and the latter's decisions may be subject to appeal for annulment. In both cases, the relevant provisions of the Law on Civil Procedure shall apply [*Ley de Enjuiciamiento Civil*].

(4) The Law on Civil Procedure shall apply to all aspects not provided for under the present Title.

126. The person against whom an action is brought for infringement of rights derived from a patent may, in all forms of procedure, invoke, by means of a countercharge or by means of defense, the total or partial invalidation of the plaintiff's patent, in accordance with the provisions of common procedural law. For those purposes, the provisions of [Article 113](#) shall be taken into account.

127.—(1) Any interested party may bring an action against the owner of the patent so that the competent judge may declare that a particular act does not constitute infringement of the patent.

(2) Before bringing his action, the interested party shall, through notarial channels, ask the owner of the patent to make known his views on the opposition between the patent and the industrial working carried out in Spain by the plaintiff or the serious and effective preparations being made for that purpose. At the expiration of a period of one month from the date of such request, if the owner of the patent has not replied or if the plaintiff does not agree with his reply, he may bring the action specified in the preceding paragraph.

(3) The action specified in [paragraph \(1\)](#), above, may not be brought by any person against whom a claim for infringement of the said patent has been made.

(4) Where the defendant proves that the act referred to in the claim does not constitute infringement of the patent, the judge shall make the necessary declaration.

(5) The claim shall be communicated to all persons owning rights in the patent and duly entered in the Register so that they may appear and take part in the hearing. Holders of contractual licenses may not, however, appear in proceedings when their license contracts so specify.

(6) The action referred to in the present Article may be brought jointly with an action to declare the invalidation of the patent.

128.—(1) Where a patent is contested, the judge shall transmit the proceedings to the Registry of Industrial Property for a report within 30 days. After the report has been received or the said period has expired, the judge shall lift the suspension and shall deal with the proceedings.

(2) Where an action distinct from that specified in [paragraph \(1\)](#), above, is brought, the judge may request a report from the Registry of Industrial Property in the form provided for in the preceding paragraph. He may also request the Registry to designate any of its experts in order to advise him. Both the Registry of Industrial Property and its experts shall have the quality of experts for proceedings in the patent field.

Chapter II Inquiries to Substantiate Facts

129.—(1) The person authorized to bring actions derived from the patent may request the judge urgently to agree to inquiries to substantiate facts that might constitute an infringement of the exclusive right granted by the patent.

(2) Before deciding upon the request made, the judge may require the reports and order the investigations he deems necessary.

(3) Inquiries may only be agreed upon when, given the circumstances of the case, it may be presumed that there has been infringement of the patent and that it is not possible to prove the facts without carrying out the inquiries requested.

(4) When agreeing to any inquiry requested, the judge shall fix the deposit to be made by the plaintiff to meet any damages or prejudice that might be caused.

(5) Where the judge does not consider the request to be well founded, he shall reject it by means of an order that is subject to appeal in both its effects.

130.—(1) During the inquiry to substantiate the facts, the judge, with the assistance of the expert or experts designated for the purpose, and after having heard the arguments of the person requesting the inquiry, shall determine whether the machines, apparatus or equipment inspected could be used to carry out the alleged infringement of the patent.

(2) Where the judge deems that the means inspected cannot be presumed to have been used to carry out the infringement of the patent, he shall terminate the inquiry and shall order a separate record to be made showing the action taken, which shall be kept secret, and shall notify the applicant that he will not be informed of the result of the inquiries carried out.

(3) In other cases, the judge, with the assistance of the expert or experts designated for the purpose, shall make a detailed description of the machines, apparatus, processes or equipment by means of which the alleged infringement was presumably carried out.

(4) The judge shall ensure that the inquiry to substantiate the facts shall not be used to violate trade secrets or to carry out acts of unfair competition.

(5) No appeal may be lodged against the judge's decision on the result of the inquiry.

131.—(1) No other certificates or copies of the inquiries to substantiate the facts may be sent other than the copy sent to the party concerned and the information to enable the applicant to bring the corresponding legal action. The applicant may only use such documentation to bring the said action and he may not disclose or communicate it to third parties.

(2) Where no request for legal action has been made within two months from the date of carrying out the inquiries to substantiate the facts, the latter shall have no effect and they may not be used for any other legal action.

132. The party concerned by the inquiries to substantiate the facts may claim from the person who requested them the costs and damages they have caused, including loss of profits, without prejudice to general liability for any damages and prejudice that the applicant may have caused.

Chapter III Preventive Measures

133.—(1) Any person bringing or about to bring any action of the type provided for in the present Law may request the judicial body hearing the case to adopt preventive

measures to ensure the effectiveness of the said action, provided that it is proved that the patent that is the object of the action is being worked within the meaning of [Article 83](#) of this Law or that serious and effective preparations have been undertaken to that end.

(2) Preventive measures may be requested before the action is brought, together with the action, or after it, and they shall be dealt with separately.

[[Par. \(1\)](#) amended by Law 66/1997.]

134. The preventive measures to be adopted shall be those that duly ensure total effectiveness of the judgment to be pronounced, in particular, the following:

- (1) cessation of acts that infringe the plaintiff's rights;
- (2) withholding and storing of the objects produced or imported in infringement of rights and the means exclusively used for such production or for carrying out the patented process;
- (3) security for any compensation for damage and prejudice;
- (4) relevant provisional notations.

135.—(1) A request for preventive measures shall be made in writing. In that written request, the plaintiff shall specify the measures he seeks in relation to the acts concerned and shall provide the evidence he deems necessary, accompanied by the relevant documents.

(2) Within a period of five days, after having examined the declarations and documents submitted by the parties, the judge may decide to carry out the inquiries and investigations he deems necessary to reach a conclusion on the justification for the preventive measures sought.

(3) The realization and carrying out of the inquiries and investigations decided upon, where appropriate, shall be effected within a non-extendable period of 20 days.

(4) The judge's decisions on whether to accept or refuse to carry out investigations shall not be subject to appeal.

(5) Within six days following the decision referred to in [paragraph \(2\)](#), above, or at the end of the period for carrying out the investigations and inquiries decided upon, where appropriate, the parties shall appear before the judge.

136.—(1) Within six days following the appearance referred to in the preceding Article, the judge shall issue a decision on the request for preventive measures and on the relevant costs.

(2) The decision on the request for preventive measures shall in no way prejudice any decision arising from action related to the corresponding substantive procedure.

(3) Preventive measures shall not be adopted when it is shown that the defendant is protected by rights based on prior utilization according to the terms of [Article 54](#).

137.—(1) Where the judge agrees to the preventive measures requested, he shall fix the security to be provided by the plaintiff to cover any damage or prejudice that might arise.

(2) Where the measures requested involve restrictions on the defendant's industrial or commercial activity, the judge shall, when deciding with respect thereto, fix the amount of the guarantee by which the said defendant may at any time substitute the effectiveness of the said restrictive measures agreed upon.

(3) The guarantees, whether principal or substitutionary, declared for the defendant shall consist of a fixed sum for a fixed period of time when they are related to acts of industrial or commercial working that may continue indefinitely.

(4) The guarantee may consist of a bank draft. Guarantees in kind shall not be permitted.

(5) In fixing the amount of the guarantees, the judge shall hear both parties.

138.—(1) Where a decision at first instance in the substantive civil procedure pronounces judgment against one of the parties and is the subject of appeal, an account of the appeal shall be given to the appellee so that, within a period of three days, he may request the judge to adopt the relevant preventive measures or to call for the appropriate substitutionary guarantee ensuring the effectiveness of the judgment reached, provided that those measures have not been adopted previously or were not insufficient.

(2) The judge of first instance shall have competence to hear and decide upon anything relevant to such assurance, independently of the admissibility of the appeal and the transmission of the principal decisions to the court hearing appeals.

139.—(1) Where the request for preventive measures is made before the principal action is brought, such measures shall be wholly without effect if the principal action is not brought within a period of two months following the decision authorizing preventive measures.

(2) In the case provided for in the preceding paragraph, when ordering the lifting of the preventive measures, the judge shall fix the amount of the damage and prejudice to be paid to the defendant from the guarantee provided by the plaintiff. Where the amount of the guarantee is not sufficient to cover the compensation for damage and prejudice, the defendant may bring a corresponding action for liability to recover the sum remaining.

(3) Any preventive measures authorized shall be without effect if the judgment of first instance was not favorable to the petition to ensure effectiveness for which the measures were sought, or the judgment of first instance shall be annulled if the judgment was favorable to the said petition.

Chapter IV Conciliation in the Field of Employees' Inventions

140. Before bringing any judicial action based on application of the principles of [Title IV](#) of the present Law dealing with employees' inventions, the dispute shall be brought before the Registry of Industrial Property for conciliation.

141.—(1) For the purpose of conciliation mentioned in the preceding paragraph, a Commission shall be set up chaired by an expert from the Registry of Industrial Property designated by the Director thereof, and consisting of an expert designated by the workers in the enterprise to which the inventor belongs and another expert designated by the employer.

(2) Where the inventor is an employee of a public administration, the Conciliation Commission shall be chaired by an expert from the Registry of Industrial Property designated by the Director thereof and shall include those members specified by Royal Decree in accordance with the legislation on civil servants.

142.—(1) A draft agreement shall be proposed by the Conciliation Commission within a period not exceeding two months following the request for conciliation and, within a period not exceeding 15 days, the parties shall state whether or not they accept the proposal. Silence on their part shall be deemed to constitute acceptance.

(2) Judges shall not accept petitions concerning rights under [Title IV](#) of the present Law unless they are accompanied by a certificate from the Director of the Registry of Industrial Property stating that one of the parties did not accept the agreement proposed under the terms of the preceding Articles.

(3) [Articles 460](#) and [480](#) of the Law on Civil Procedure shall also apply where appropriate.

TITLE XIV UTILITY MODELS

143.—(1) In conformity with the provisions of the present Title, inventions that are new and involve an inventive step, and that confer on an object a form, structure or constitution that results in an appreciable improvement in its use or manufacture, may be protected as utility models.

(2) In particular, the following may be protected as utility models: utensils, instruments, tools, apparatus, devices or parts thereof that meet the conditions laid down in the preceding paragraph.

(3) Inventions for processes and plant varieties coming under Law No. 12/1975 of March 12, 1975, on the Protection of Plant Varieties shall not be protected as utility models.

144.—(1) The right to protection of utility models shall belong to the inventor or his successor in title and shall be transferable by all means recognized by law.

(2) The provisions of [Article 10\(2\) to \(4\)](#) shall apply to the protection of utility models.

145.—(1) The state of the art according to which the novelty and inventive step in respect of inventions protected as utility models is to be judged shall consist of that which, prior to the date of filing the application for protection as a utility model, has been disclosed in Spain by a written or oral description or by any other means.

(2) The content of Spanish applications for patents or utility models as they were originally filed, the date of filing of which is prior to the date mentioned in the preceding paragraph and which have been published on that date or later, shall also be deemed to be comprised in the state of the art.

146.—(1) For protection as a utility model, an invention shall be deemed to involve an inventive step if it does not obviously result from the state of the art for a person skilled in the art.

(2) Where the state of the art includes the documents mentioned in [Article 145\(2\)](#), above, they shall not be taken into consideration when deciding upon the existence of an inventive step.

147.—(1) In order to obtain a certificate of protection for a utility model, an application containing the documentation referred to in [Article 21](#), above, shall be filed. It shall not be necessary to include an abstract of the invention that is its subject matter.

(2) In the application for protection of a utility model, it shall be stated that this is the form of protection sought.

148.—(1) When the application made in accordance with the provisions of [Article 30](#) of the present Law has been accepted for filing, the Registry shall verify whether it fulfills the formal conditions laid down in the preceding Article and in [Chapter I](#) of [Title V](#), above. It shall also verify that the subject matter is entitled to be protected as a utility model in conformity with the provisions of the present Title.

The Registry shall neither verify the novelty, the inventive step nor the adequacy of the description, nor shall it ask for the report on the state of the art as provided for patents of invention.

(2) Where that verification shows that the form of the application is defective or that the object may not be protected as a utility model, the application procedure shall be suspended and the applicant shall be allowed the prescribed period to rectify the defects notified, where appropriate, and to put forward the arguments he deems relevant. For the purpose of rectifying the defects, the applicant may modify the claims or divide up the application.

(3) Having examined the arguments put forward by the applicant, the Registry shall take a decision within the period laid down in the regulations on rejection of the application or continuation of the procedure. It shall reject the application when it deems that its object cannot be protected as a utility model or that it still contains defects that have not been satisfactorily rectified.

(4) Where the Registry's verification shows that no defects prevent the granting of protection or where such defects have been satisfactorily rectified, the Registry shall notify the interested party of the favorable decision on continuation of the procedure and shall make the application for protection of the utility model available to the public, inserting the corresponding announcement in the Official Bulletin of Industrial Property, together with the claims for the utility model applied for and copies of the drawings.

149.—(1) Within two months following publication of the application, any person with a legitimate interest may oppose the protection sought for the utility model, citing the failure to fulfill any of the requirements for its grant, including lack of novelty or inventive step or the inadequacy of the description.

(2) The fact that the applicant is not entitled to apply for protection of the utility model may not, however, be cited since it is a matter that must be brought before the ordinary courts.

(3) The brief of opposition shall be accompanied by the relevant documentary evidence.

(4) At the expiration of the period for opposition, the Registry shall transmit to the applicant the oppositions received.

(5) Where no opposition has been received, the Registry shall grant protection for the utility model.

(6) Where opposition has been received, the applicant shall be allowed a period specified in the Regulations to remedy any defects of form in the application, to modify the claims if he deems it appropriate, and to contest the opposition by putting forward the arguments he deems relevant.

(7) Within one month following the expiration of the period allowed to the applicant to contest opposition, the Registry shall take a decision on whether or not to grant protection.

(8) Where the decision declares the absence of one of the requirements to be met for granting protection as a utility model, as stated in a brief of opposition, the Registry shall allow the applicant a further period to be determined in the Regulations to rectify the defect or to put forward the arguments he deems relevant.

(9) Subsequently, the Registry shall take a final decision regarding the protection sought.

150.—(1) The provisions of [Article 37](#) above, as well as all other provisions that are not contrary to those of the present Title, shall apply to granting protection for utility models.

(2) The pamphlets referred to in [Article 38](#) above, shall not be published for utility models.

151.—(1) In addition to the applicant, any other interested party, in accordance with the provisions of the Law Governing Contentious Administrative Jurisdiction, shall be entitled to lodge a contentious administrative appeal, provided that the appeal is not based on absence of novelty or inventive step or on the inadequacy of the description.

(2) Notwithstanding the provisions of the preceding paragraph, any interested party who has formulated the relevant opposition in the documentation based precisely on such defects shall be entitled to lodge a contentious administrative appeal based on absence of novelty or inventive step or on inadequacy of the description.

152.—(1) The protection of a utility model shall confer on its owner the same rights as a patent.

(2) The non-extendable term of protection for utility models shall be 10 years from the date of filing the application.

(3) Additions to utility models shall not be granted.

153.—(1) Protection of a utility model shall be declared invalid in the following cases:

- (a) where the subject matter is not entitled to protection in accordance with the provisions of [Articles 143, 145 and 146](#) and [Title II](#) of the present Law, to the extent that it is not contrary to the provisions thereof;
- (b) where the invention is not described in a sufficiently clear and comprehensive manner to enable it to be carried out by a person skilled in the art;
- (c) where the subject matter goes beyond the content of the application for a utility model as filed or, where the utility model has been granted as a result of a divided application or of a new application filed on the basis of the provisions of [Article 11](#), above, when the subject matter of the utility model goes beyond the content of the original application as filed;
- (d) where the owner of the utility model is not entitled to protection in accordance with the provisions of [Article 144](#), above.

(2) Where the reasons for invalidation only affect part of the utility model, partial invalidation shall be declared through the annulment of the claim or claims affected. Partial invalidation of a claim may not be declared.

(3) Where invalidation is partial, the utility model shall continue in force in respect of the claims not annulled, provided that they constitute the subject matter of a separate utility model.

154. In the absence of provisions specifically applicable to utility models, the provisions laid down in the present Law for patents shall apply, provided that they are not incompatible with the specificity of utility models. The provisions contained in [Title IV](#) on employees' inventions, *inter alia*, shall apply.

TITLE XV AGENTS AND REPRESENTATIVES

155.—(1) The following persons may act before the Registry of Industrial Property:

- (a) persons entitled to act, that is to say, where the applicants are legal entities, those who, in accordance with the constitution, the Statutes or the Laws, act as representatives of the enterprise in question;
- (b) industrial property attorneys.

(2) Persons not resident in a Member State of the European Community shall always act through an industrial property attorney.

[[Par. \(2\)](#) amended by Royal Decree-Law 8/1998.]

156. Industrial property attorneys shall be those natural persons registered as such with the Registry of Industrial Property who, as professional people, usually offer their services to advise, assist or represent third parties in obtaining the various forms of

industrial property and in the defense, before the Registry, of the rights deriving therefrom.

157. The number of industrial property attorneys shall be limited and, in order to be registered as such in the Special Register of Industrial Property Attorneys, the applicant must fulfill the following conditions:

- (1) be an adult Spaniard or national of a Member State of the European Community and have business premises in Spain or in a Member State of the European Community;
- (2) not have been tried or convicted for fraud, unless rehabilitated;
- (3) have official degrees in architecture or engineering issued by the governing bodies of universities, or other official titles legally equivalent to the same;
- (4) successfully undergo a proficiency examination attesting the necessary skills for the professional activity specified in the foregoing Article, in such form as shall be laid down by regulation;
- (5) deposit a guarantee with the Spanish Patent and Trademark Office and contract a civil liability insurance to the amount determined by the Regulations.
[[Art. 157](#) amended by Law 21/1992; [par. \(1\)](#) amended by Royal Decree-Law 8/1998.]

158. The quality of industrial property attorney shall be lost as a result of any of the following:

- (a) death;
- (b) renunciation;
- (c) incompatibility;
- (d) a decision following a reprimand;
- (e) a judicial decision.

159. The exercise of the profession of industrial property attorney shall be incompatible with active employment of the interested party in the Ministry of Industry and Energy and its bodies, industrial councils in the Autonomous Communities or in international organizations dealing with industrial property.

TITLE XVI TAXES AND ANNUAL FEES

160.—(1) An applicant or owner of a patent shall pay the taxes set out in the Annex⁵ to the present Law and forming an integral part thereof. The Regulations shall be subject to the provisions of Law No. 17/1975 of May 2, 1975, the Law on Taxes and Extrabudgetary Payments of December 26, 1958 [*Ley de Tasas y Exacciones*

⁵ This Annex is not reproduced (*Editor's note*).

Parafiscales], the General Tax Law [*Ley General Tributaria*] and complementary provisions.

(2) Failure to pay within the prescribed period fixed from the date on which the Registry informed the applicant of the omission shall deprive the act payable of all its effects.

(3) Where the fee prescribed for dealing with a patent application has not been paid, the application shall be deemed to have been withdrawn.

161.—(1) To keep a patent in force, the owner shall pay the annual fees specified in the Annex mentioned in [Article 160](#).

(2) The annual fees shall be paid one year in advance during the term of the patent. The date on which the annual fees are due shall be the last day of the month in which the application was filed and the relevant payment shall be made within the prescribed period.

(3) Where the annual fee has not been paid at the expiration of the period allowed for payment, the owner may pay the fee and the relevant surcharge within the following six months.

(4) The fee to be paid for filing a patent application shall exonerate the applicant from paying the first two installments of the annual fees.

162.—(1) Any person who wishes to obtain a patent for his own invention and does not possess the necessary economic means may request that the patent be granted without having to pay fees of any nature. In order to do so, he shall submit, together with his patent application, a declaration stating that the economic means are lacking, supported by the prescribed documentation.

(2) Where the possibility offered by the preceding paragraph is allowed, the owner shall not pay any fee during the first three years. During subsequent years, he shall reimburse the amounts remaining unpaid in the prescribed form. The postponement shall be noted in the Patent Register and the responsibility for paying the fees in arrears shall be incumbent on whoever owns the patent.

ADDITIONAL PROVISIONS

First

First. The Special Register of Enterprises for the administration of industrial property matters, referred to in [Article 296 et seq.](#) of the Industrial Property Code [*Estatuto de la Propiedad Industrial*] of July 26, 1929⁶, is hereby closed.

[First Additional Provision, previously “Sole Additional Provision”, renumbered by Law 50/1998.]

⁶ See *Industrial Property Laws and Treaties*, SPAIN—Text 1-002 (*Editor’s note*).

Second. (1) The maximum periods for the completion of the procedures listed in this provision shall be counted from the date on which the Spanish Patent and Trademark Office receives the applications concerned, and shall be the following:

- A. grant of patents and additions: if processed according to the general grant procedure, the period resulting from the addition of 14 months to the time that has elapsed between the date of receipt of the application and the publication thereof in the Official Bulletin of Industrial Property, and, if processed according to the grant procedure with prior examination, that resulting from the addition of 24 months to the said time;
- B. grant of utility models and industrial and artistic designs: 12 months where there has been no suspension of the application and no opposition, and 20 months if either of the said events has occurred;
- C. grant of topographies of semiconductor products: 12 months;
- D. grant of complementary protection certificates for drugs and phytosanitary goods: 12 months if there has been no suspension of the application and 20 months if the said event has occurred;
- E. renewal of industrial and artistic designs: eight months if there has been no suspension and 12 months in the opposite case;
- F. grant of compulsory licenses and licenses of right: eight months;
- G. registration of assignments, real rights, contractual licenses and other modifications of rights: six months if there has been no suspension and eight months in the opposite case;
- H. reinstatement of patents and utility models: six months.

(2) In the event of a change of industrial property title, the maximum period for completion shall be counted as from the filing date of the new documentation.

(3) When the proceedings are suspended by virtue of the provisions of [Article 36\(3\)](#) of this Law, the completion period shall likewise be suspended until the examination request is received and, if it is not, as provided in that provision, the proceedings shall resume.

[Second Additional Provision added by Law 50/1998.]

TRANSITIONAL PROVISIONS

First. (1) Inventions concerning chemical and pharmaceutical products shall not be patentable before October 7, 1992.

(2) Until that date, none of the Articles contained in the present Law dealing with the patentability of inventions of chemical and pharmaceutical products nor other Regulations indissolubly linked to their patentability shall be in force.

(3) The provisions of the preceding paragraphs shall not affect inventions of processes or apparatus for obtaining chemical or pharmaceutical products nor processes

for the utilization of chemical processes, all of which may be patented in accordance with the provisions of the present Law as soon as it enters into force.

(4) Inventions of products obtained by microbiological processes, as referred to in [Article 5\(2\)](#) of the present Law, shall not be patentable until October 7, 1992.

Second. As from October 7, 1992, owners of patents applied for before January 1, 1986, may use of the provisions of [Article 61\(2\)](#), above, unless action for infringement of the patent has been brought against the owner of a patent for a process granted before that latter date.

Third. The provisions contained in [Chapter II](#) of [Title XIII](#) shall enter into force as from October 7, 1992.

Fourth. (1) The Government shall specify by Royal Decree the dates on which the provisions concerning the report on the state of the art contained in [Chapter II](#) of [Title V](#) shall be applicable to patent applications.

(2) The Government shall be responsible for establishing the schedule for application of the Regulations concerning the report on the state of the art in the technical sectors corresponding to the International Patent Classification established by the Strasbourg Convention of December 19, 1954⁷, taking into account the capacity of the Registry of Industrial Property for action.

(3) Application of the Regulations concerning the report on the state of the art may only be decreed for patent applications filed as from the day following the expiration of a period of three years from the date of promulgation of the present Law. Application shall in any case be decreed before the expiration of a period of four years from the date of promulgation of the present Law.

(4) From the day following the expiration of a period of five years from the date of promulgation of the present Law, all patent applications, no matter to what technical sector they belong, shall be dealt with under the general procedure for granting patents provided for in the present Law.

(5) Patent applications filed after the entry into force of the present Law and to which the Regulations governing the report on the state of the art do not apply shall be dealt with under the procedure for granting patents provided for in the present Law, with the exception of all the provisions referring to the said report.

Fifth. Following the introduction of the report on the state of the art for all patent applications referred to in Transitional Provision Four, the Government, taking into account priorities fixed for the State's technological and industrial development, may by Royal Decree establish progressively those technical sectors in which patent applications shall be subject to the procedure with prior examination laid down in [Chapter III](#) of

⁷ The European Convention on the International Classification of Patents for Inventions ceased effect for member States on their accession to the Strasbourg Agreement Concerning the International Patent Classification of March 24, 1971, as amended on September 28, 1979; for the text of the Strasbourg Agreement, see *Industrial Property Laws and Treaties*, MULTILATERAL TREATIES—Text 2-011 (*Editor's note*).

[Title V](#) of the present Law, provided that, for at least six months, the Regulations on the report on the state of the art have been applied.

Sixth. (1) Applications for patents and utility models filed before the entry into force of the present Law shall be dealt with and resolved according to the legal regulations in force on the date they were filed.

(2) For the purpose of the preceding paragraph, in the case of applications following division, change of form or transformation of an application, the date of filing of the original application shall prevail.

Seventh. Patents and utility models granted in accordance with the provisions of the Industrial Property Code shall be governed by the provisions of the said Code. The provisions contained in the following Titles and Chapters of the present Law shall, however, apply:

- (a) [Title VI](#) on effects of patents and patent applications, with the exception of [Articles 49, 59, 60\(2\)](#) and [61\(2\)](#), in accordance with the provisions of the Second Transitional Provision;
- (b) [Title VII](#) on actions for infringement of patent rights;
- (c) [Title VIII](#) on patent applications and patents as objects of property rights;
- (d) [Title IX](#) on the obligation to work and compulsory licenses;
- (e) [Title XI](#) on invalidation and forfeiture of patents, with the exception of [Article 112\(1\)](#);
- (f) [Title XIII](#) on jurisdiction and procedural regulations.

Eighth. Legal action commenced before the entry into force of the present Law shall be continued under the same procedure under which it was initiated.

Ninth. Until the Higher Courts of Justice are constituted and operative, competence for hearing civil cases related to rights conferred under the present Law shall belong to the judges of first instance in the cities where territorial courts have their seats.

Tenth. (1) In order to bring actions for the purpose of giving effect to exclusive rights under a patent applied for after entry into force of the present Law, it shall be necessary first to obtain or request the report on the state of the art, provided that the said report has been implemented for the technical sector to which the patent belongs, in conformity with the provisions of the Fourth Transitional Provision.

(2) For the purpose referred to in the preceding paragraph, at the request of the owner of the patent and subject to payment of the relevant fee, the Registry of Industrial Property shall undertake to draw up the report on the state of the art concerning the subject matter of the patent granted, under the terms of [Article 34](#) of the present Law. After it has been drawn up, the report shall be communicated to the applicant and made available to the public together with the patent documentation.

(3) Where the action mentioned in [paragraph \(1\)](#), above, is brought without first having obtained the report requested, the defendant may ask for suspension of the period for contestation until the said report is produced or it is proved that six months have

elapsed since the request was made without the Registry of Industrial Property having issued it.

(4) After the report on the state of the art has been requested and although it has not yet been obtained, proceedings to substantiate the facts may commence, as well as the adoption of preventive measures, provided that those measures do not consist of immobilization or cessation of the defendant's industrial or commercial activity related to the subject matter of the patent and that the procedure is in conformity with the provisions of the present Law.

Eleventh. (1) Assistant industrial property attorneys, as referred to in [Article 284](#) of the Industrial Property Code, who at the time of entry into force of the present Law have completed five years in this capacity may be registered in the Special Register of Industrial Property Attorneys with equal rights to those who possess one of the official titles referred to in [Article 157\(c\)](#) of the present Law.

(2) Assistants and deputies registered with the Registry of Industrial Property, under the terms of the Article cited in [paragraph \(1\)](#), above, may continue to act on behalf of attorneys as long as the latter have not revoked the corresponding authorization and registration with the Registry.

(3) Those who, at the time of entry into force of the present Law, are registered as candidate attorneys and who cannot be appointed industrial property attorneys because there is no vacancy in accordance with the provisions of [Articles 277](#) and [287](#) of the Industrial Property Code, shall be designated industrial property attorneys at the entry into force of the present Law without the need to fulfill the requirement laid down in [Article 157\(c\)](#) of the present Law.

Twelfth. Enterprises which, at the time of entry into force of the present Law, are entered in the Special Register of Enterprises referred to in [Article 296](#) of the Industrial Property Code may avail themselves once only, with respect to their present partners, of the right recognized in [Article 297\(1\)](#); thereafter, the general regulations for entering and retiring from the profession in the Special Register mentioned shall apply.

FINAL PROVISIONS

First. At the proposal of the Ministry of Industry and Energy, the Government shall issue the Regulations for the present Law within a period not exceeding three months after its promulgation.

Second. The Regulations shall define the conditions to be fulfilled by industrial property attorneys in exercising their profession and in their relations with the Registry of Industrial Property.

Third. Changes in the fees for the services and activities of the Registry of Industrial Property shall be effected through the Budget Laws [*Leyes de Presupuestos*].

Fourth. The present Law shall enter into force three months after its publication.

REPEALING PROVISION

All provisions that are contrary to the present Law, except for the content of the Transitional Provisions, shall be repealed, in particular, the following:

1. In the Industrial Property Code, approved by the Royal Decree-Law of July 26, 1929, revised text approved by the Royal Order of April 30, 1930, and ratified as Law on September 16, 1931:

- (a) the provisions laid down in [Titles I, II, IV, VIII and XII](#) (**Chapter II**) insofar as they affect patents and utility models, and [Title IX](#) with regard to patents, utility models, and all other industrial property forms, which shall be subject to the provisions of the present Law as far as jurisdiction, competence and procedure are concerned;
- (b) all regulations governing the profession of industrial property attorney contained in [Title X](#) and the corresponding Articles in the Industrial Property Code.

2. The Order of the Ministry of Industry and Commerce of January 30, 1934, on claims of *force majeure*, insofar as it affects patents and utility models.

3. [Articles 29](#) and [30](#) of the Law on Employment Contracts [*Ley de Contrato de Trabajo*], approved by the Decree of January 26, 1944.

4. The Decree of December 26, 1947, insofar as it concerns patents and utility models and industrial property agents.

5. [Article 99](#) of the Law on Compulsory Expropriation of December 16, 1954, and [Articles 21](#) and [122](#) of its Regulations, approved by the Decree of April 26, 1957.

(This text replaces the one previously published under the same code number.)