



FICPI SWEDEN

Current IP related issues

Utility Models in Spain

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Current Spanish Patent Law

- Law 24/2015 that entered into force on April 1, 2017 contemplates two modalities for protecting inventions:

Patents

Utility Models

- Both titles can be obtained through

Direct filing

PCT national phases

European
Patents

Direct

EURO PCT

- Utility Models were not available under the Spanish Industrial Property Law of May 16, 1902.
- They were introduced by the Spanish Statute of Industrial Property on July 26, 1929 and maintained in the Patent Law 11/1986.

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Spanish Concept of Utility Model

- Non unanimity in the concept worldwide.
- In Spain is defined making reference to patents i.e.:

They can be protected (as utility models) any kind of innovations then can be protected as patents with exception of:

- **Processes**
 - **Biologic subject matter**
 - **Pharmaceutical products**
- **Duranton 10 years as from filing (Patents 20 years).**

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Requirements

- Novelty: worldwide, like for patents.
- Inventive step: lower than in patents i.e.:

Inventions must not be very obvious for a person skilled in the art.

- Industrial applicability: like in patents.

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Prosecution

- No substantive examination (only formal and on exceptions to patentability).
- Immediate publication (not 18 months after priority as in patents).
- 2 months period open for opposition by third parties after publication (can be based on lack of novelty and / or inventive step).
- Decision on opposition.
- Possibility of an administrative appeal (before the Patent Office).
- Decision on administrative appeal can be appealed before administrative courts (different than civil specialized courts that decide on invalidations and infringements).

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Infringements

- Before filing and infringement action the Utility Model owner must obtain a Search Report with a written opinion from the Spanish Patent and Trade Mark Office.
- Infringement proceedings follow the same system that patents, with the possibility for the defendant to counterclaim the invalidity of the utility model.

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FILING STATISTICS

MODALITY	2016	2017 ¹	2018	2019 ²	SAME PERIOD 2018
Patents	2.849	2.286	1.578	889	1.052
Utility Models	2.427	2.438	2.700	1.805	1.801
Total	5.276	4.724	4.278	2.694	2.853
¹ Change of Law as per 1/4/2017					
² Until August 2019					

PATENTS

Meses/Años	2016	2017
Enero	179	175
Febrero	205	240
Marzo	244	688
Abril	272	80
Mayo	248	155
Junio	272	151
Julio	252	156
Agosto	181	80
Septiembre	222	130
Octubre	219	131
Noviembre	246	138
Diciembre	309	162
Total	2.849	2.286

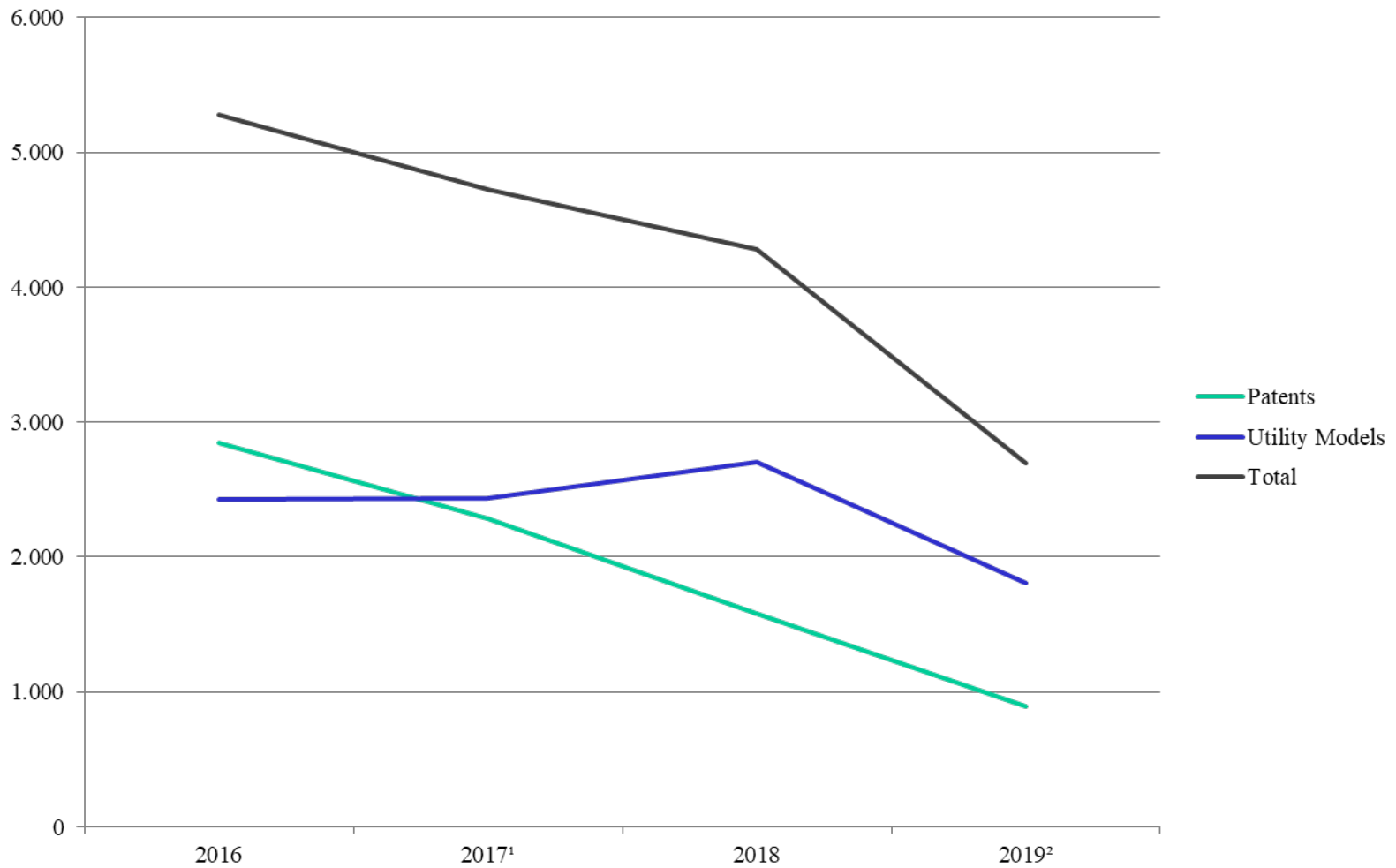
CHANGE OF LAW

UTILITY MODELS

Meses/Años	2016	2017
Enero	159	139
Febrero	230	192
Marzo	224	421
Abril	222	130
Mayo	238	194
Junio	229	215
Julio	216	191
Agosto	141	141
Septiembre	193	177
Octubre	174	228
Noviembre	187	215
Diciembre	214	195
Total	2.427	2.438

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FILING STATISTICS



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European patent filings

- European patents of Spanish origin have grown (105 new applications 6,3%) in 2018 with respect to 2017, while the average of EPO members state grew 3,8%.

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Advantages of Utility Models for Spanish Applicants

- Alternative way to protect inventions in addition to patents.
- Cheaper than patents (no compulsory search report, until enforcement, and no examination).
- Avoids duplication of search and examination and save costs when the applicant wishes to extend the protection to the EPO.
- Quick prosecution versus patents (1-6 months if no opposition, 14 months with opposition) / Patents (3 years without opposition and 5 years if there is opposition).

Disadvantages

- Publication takes place in a couple of months after filing.

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THANK YOU FOR YOUR ATTENTION!



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