

Royal Legislative Decree 1431/2008, of August 29, by means of which certain regulations concerning Industrial Property are amended Official Bulletin of the State BOE 223/2008 of September 15

On September 16 have entered into force some regulatory amendments in the field of patents, trademarks and industrial designs that even if they affect the filing and granting administrative proceedings, eliminate a number of merely formal hindrances though facilitate the formalities for the registration.

As a general rule (according to the 2nd additional provision of the Law 20/2003 that makes reference to article 56 of the Law 17/2001 of December 7, 2001, on Trademarks) fortunately it has been suppressed the requisite of the indication of an address in Spain for notification purposes since such requirement was contrary to the Community Law due restriction of freedom to provide services and establishment within any EU country. From now on it will only be required to appoint an e-mail address in order to be maintained the communication with the Spanish PTMO.

Concerning the other –more specific- amendments are the following:

Implementing regulation for the enforcement of the Law 11/1986 of March 20th on Patents (RD 2245/1986 of October 10th):

- ◆ The description of the invention (art. 14.1 b) can be free (*“even if does not comply with the formal requisites established”*)
- ◆ The Spanish PTMO will formally examine the application in the following ten days (not eight, art. 15) starting from the reception of said application and **will grant a one-month term for possible amendments**. The delay in the payment of taxes does not imply the loss of the application date, provided that said payment is effected within the following month granted for amendments.
- ◆ The report on the state of the art (art.29) must differentiate the documents issued prior to the priority date, those issued in between the priority date and the filing date and those issued simultaneously or subsequently.
- ◆ **The report on the state of the art will include a written opinion, preliminary and without prejudice, regarding the patentability of the invention, including the novelty and the inventive step**
- ◆ Admission of opposition requirements have been soften, expressly allowing the overcoming of formal defects within ten days (art. 45)

Royal Legislative Decree 2424/1986 of October 10 regarding the application of the European Patent Convention on the grant of European patents of October 5, 1973.

- ◆ It has been established the obligation of providing the Spanish PTMO (art. 7), a translation to Spanish of the amendment of the Patent (either after the opposition or as per limitation by la EPO) under penalty of this not having effect in Spain

This requirement must be accomplished in the following three months after the grant publication in the EPO bulletin (art. 8).

Royal Legislative Decree 812/2000 of May 19 by means of which it is established the applicability of the grant proceeding with preliminary examination for patents in the alimentary field.

- ◆ Admission of opposition requirements have been soften, expressly allowing the overcoming of formal defects within ten days (art. 3)

Implementing regulation for the enforcement of the Law 17/2001 of December 7 on Trademarks , approved by Royal Legislative Decree 687/2002 of July 12.

- ◆ It have been harden the requisites for opposition (art. 19) denying the possibility of overcoming errors in the term of ten days. The non-provision of the power of attorney within one month is a non-admission cause.
- ◆ It is expressly detailed (art. 20.2 *in fine*) the term for replying to the provisional refusals issued in International Trademark applications (from two to four months, decided by the director of the Office).
- ◆ It could be filed the Power of attorney in electronic format (art. 57.6) except for withdrawal or limitation purposes in which cases the original document should follow and reach to the Office in the term of ten days (57.7).

Amendment of the Implementing Regulation for the law 20/2003 of July 7 on Industrial Designs approved by Royal Legislative Decree 1937/2004 of September 27

- ◆ Admission of opposition requirements have been soften, expressly allowing the overcoming of formal defects within ten days (art. 26).

As a comment it is surprising the Office persist in restricting more and more the admissibility requirements for opposition in the trademarks proceedings when they are soften regarding other secondary rights as patents in the alimentary field. We should be thankful for the flexibility in the representation, even if, as it has become a common situation in the government administration, the full reserve of powers' authority “when the Spanish PTMO requires so” still subsists, becoming a hindrance due to the legal uncertainty that this kind of expressions bring to the parties.

In any case, the amendments conducted (specially the one referred to the non-binding opinion regarding the report on the state of the art, similar to the one issued for the European Patents) confer dynamism to the current implementing regulation that we hope will be reflected in an increase of the number of applications.

MAIN NOVELTIES

It is sufficient to appoint an e-mail address for notification purposes

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It has been softened the admissibility of opposition (except for trademarks) granting a period for amending formal defects

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The Report on the state of the art will include a non-binding opinion regarding patentability (including novelty and inventive steps) issued by the Spanish PTMO

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The Power of Attorney can be submitted electronically.