


Basic Questions

about Patents
and Utility Models

If you have an patents or utility models, register it.



The purpose of this brochure is to present frequently asked questions and their answers regarding Patents and Utility Models.

5 major areas

The topics have been grouped into five major areas: 01. Purpose and duration 02. Procedure 03. Ownership and transfer 04. Searches 05. Protection abroad

Patent owners must describe their inventions so that a normal expert in the field may process them.

01 Purpose and duration

1. What is a patent? What is a utility model?

Patent and the utility models are titles granted by the State that give inventors the exclusive right to temporarily prevent others from manufacturing, selling or making commercial use of the protected invention in Spain.

2. What are the main obligations of a patent or utility model rights holder?

In exchange for a monopoly over commercial use, rights holders are obliged to describe their inventions so that a normal expert in the field may duly process them. They have the further obligation to commercialize the patent or utility model, either directly or through a person they authorize to do so.

3. Is it compulsory to commercialize a patent or utility model?

Patent holders are obliged to commercialize inventions directly or through a person they authorize, commercializing them in Spain or in a member state of the World Trade Organization.

Such commercialization must be carried out within a period of four years from the date of submission of the patent application, or three years from the date of publication of its granting (whichever expires later).

If a patent is not commercialized, it may be subject to compulsory license applications and expire.

4. Once the patent or model is granted, what happens if the corresponding fee is not paid?

When the applicable annuities are not paid, the patents or models expire.

5. For how long is a patent and/or utility model granted?

Twenty years from the date of its filing in the case of patents, ten years for utility models. Once the period of validity has elapsed, the invention passes into the public domain and anyone can use it freely.

Only in the case of patents for pharmaceutical and phytosanitary products is it possible to request what is known as a Complementary Protection Certificate (CPC), which extends the protection conferred on the commercialized product once the patent has expired for a maximum period of five years. In addition, for paediatric pharmaceutical products, an extension of the CPC may be requested for an additional six months.

6. What is the cost for registering a patent or utility model?

For a patent, SPTO fees amount to roughly €1.200. In the case of a utility model, the registration fee is around € 100. These rates are independent of the area of technology or the complexity of the invention to be registered.

If the application is submitted electronically, a 15% discount on the deposit fee is applied.

The cost that applicants must bear in preparing the documentation to submit the application is in addition to this amount.

Furthermore, in order to retain these rights, annual maintenance fees must be paid. These fees progressively increase from around € 18.48 for the third annuity to € 490 for the twentieth (only applicable to patents). The amount of these fees is updated annually through the National Budget Act and are kept up-to-date on the SPTO website.

7. How do Patents and Utility Models differ?

A utility model protects an innovation having a lower inventive nature than a patent. Generally speaking, utility models are improvements to already-known devices or tools; that is, mechanical inventions, although they may also deal with formulated substances and chemical compositions.

Utility models are considered particularly suited to SMEs that make minor improvements to existing products or modify them in some way.

8. What requirements must patent or utility models meet to for the rights to be granted?

In the first place, the invention must not be included among the prohibited items established under Patent Law and, in addition, the invention must be novel, involve inventive activity, and have industrial application.

9. What kind of inventions can be protected by patents or utility models?

A procedure, method of manufacture, machine or device, or product can be patented. The law allows for products to be composed of or contain biological matter and can apply to the procedures with which biological matter is produced, transformed or used.

A utensil, instrument, tool, appliance, device or part thereof can be granted a utility model, as well as a chemical or food item, but a process can never be protected by a utility model, nor can biological matter, formulated substances or pharmaceutical compositions.

10. What kinds of inventions cannot be protected by patents or utility models?

The following cannot be protected by a patent or utility model: Discoveries; scientific theories and mathematical methods; literary, artistic and scientific works; financial and/or business methods; computer programs; forms for presenting information; animal breeds and plant varieties; inventions that are contrary to public order or good custom; the human body at any stage in its gestation and development; the essentially biological processes for obtaining plants and animals; and mere DNA sequences without indication of any biological function. As already indicated, process inventions cannot be protected as utility models.



11. What support do small inventors have?

The SPTO grants a reduction of 50 percent on the fees paid per application, on the completion of the report on the state of the art and examination, as well as on the first three annuities (third, fourth and fifth) for entrepreneurs who are acting as individuals or represent small and medium-sized enterprises (SMEs).

To secure this discount, a request for a reduction of fees must be submitted together with the national patent application or utility model and must prove that the applicant(s) meet the definition of an entrepreneur and/or of a small or medium-sized enterprise (SME).

The SPTO also has a subsidy program to assist with the expenses incurred by applicants for national patents and utility models, as well as European or international patents, as long as they meet the requirements established in the call that is published annually in the Official State Gazette (BOE). On the SPTO website, interested parties may consult all the information related to this aid programme, as well as others sponsored by various Public Bodies and Autonomous Communities.

02 Procedure

12. How do you obtain a patent that is valid in Spain?

Applicants have recourse to three methods for obtaining a patent that is valid in Spain:

- At the national level. The application is prepared following the requirements established by the Spanish Patent Law of June 24, 2015.
- At the European level. Since 1986, Spain is party to the European Patent Convention, which allows for obtaining a series of national patents by means of a single application filed with the European Patent Office (EPO).
- At the international level, or PCT. Since 1989, Spain has been party to the Patent Cooperation Treaty (PCT). This system allows for requesting protection of an invention in each of the states signatory to the PCT by means of a single application. It is not a procedure for granting patents, nor does it replace national grants, but it does unify the processing of international protections.

13. What is the procedure for applying for a patent in Spain under national legislation?

Patent Law 24/2015, of June 24, establishes a single granting procedure, in which a Report on the State of the Art (RSA) is prepared. This report contains a list of previous disclosures of elements equal or similar to the invention and which are considered relevant to assess the novelty and inventive nature thereof and is accompanied by a preliminary and nonbinding written opinion (WO) regarding whether or not the invention concerned in the patent application meets the patentability requirements established by law, specifically with reference to the search results. Subsequently, upon request by the applicant, a substantive examination is carried out to determine whether the patent application and the invention in question meet formal, technical and other patentability requirements. Finally, the Office resolves to grant or deny the patent.

Within six months following publication of the grant, any individual may object to it. After such an opposition proceeding, the SPTO may decide to revoke the patent grant, confirm its granting, or reissue the patent in a modified form.

14. Does the patent application process take long?

Between submission of a patent application and its granting, a maximum period of 36 months may transpire. The processing of an opposition proceeding may take a maximum of 24 months.

15. What is the accelerated process for granting patents?

The SPTO has approved a process whereby the duration of the grant process can be considerably reduced if the following requirements are met:

1. The application does not claim priority.
2. The time savings will be even greater if the applicant does not exhaust legally established deadlines.
3. The applicant explicitly accepts the accelerated grant process.

16. How does one apply for a patent or utility model?

An application may be submitted to the SPTO while acting in person, through a representative, or through an Industrial Property Agent. It may also be submitted to the offices of any administrative body belonging to the National State Administration or Autonomous Community administrations, or at a Post Office.

Applications may also be submitted electronically through the SPTO's virtual online headquarters, requiring an electronic certificate.

17. What role does an Industrial Property Agent play with respect to Patents and Utility Models?

The Agent is a liberal professional who, in exchange for a fee, offers his services to advise, assist or represent applicants in obtaining patents or utility models, as well as in the defence and preservation of the rights derived therefrom.

It may be advisable to consult with an Agent when, due to the complexity of a patent or lack of technical means, an owner cannot submit an application on their own.

18. Is it mandatory to deal with the SPTO through an Agent?

It is only mandatory for those who do not reside or have a reliable and effective presence in any country of the European Union.

19. In case of doubt, how can one know if an invention is viable for being granted a patent or utility model?

Prior consultation can be made with the Information Office of the SPTO. However, if the application is not submitted in a modality appropriate to the invention, the SPTO will invite the applicant to request a change to the most appropriate modality for protecting the invention.

20. Is there any risk that SPTO officials might give third parties information contained in an application that is being processed?

No. All requests are processed in the strictest secrecy until their time of publication.

Nevertheless, bear in mind that in any case, and as long as the applicant does not withdraw the application, the patent will be published and disclosed in the manner established by law.

21. What are the basic requirements for a patent or utility model application?

The application must consist of:

- An official statement requesting registration of the patent or model.
- A description of the invention.
- One or several claims.
- Drawings, mandatory in the case of utility models.
- A mandatory summary in the case of patents, optional for utility models.
- Application fees (and a request for a report on the state of the art, in the case of patents).

22. What mandatory documentation must be submitted for a patent or utility model application to obtain a filing date?

At minimum, according to the provisions of the Patent Law Treaty, it must consist of:

- A statement drafted in Spanish indicating that a patent or utility model is being applied for.
- An item that upon cursory examination appears to be a description, submitted in any language.
- Contact details, in Spanish, which identify or facilitate contacting the applicant. Subsequently, the application may be completed by providing the rest of the documentation, although in no case may the purpose of the invention be broadened after the date of submission of the patent or utility model.

23. What does a description consist of?

The description is a clear and complete explanation of the invention, expressed in such a way that an expert in the field may duly process it.

24. What are claims?

Claims define the purpose of the invention for which the patent or utility model is being requested; that is, the nature of what the protection is being sought for.

25. What kind of patents require the submission of drawings?

Any and all patents for which drawings are necessary for their understanding.

26. What is purpose of the summary?

The purpose of the summary is to provide a brief overview of the invention, allowing an easy understanding of the technical issue posed, the solution provided, and the main uses of the invention.



27. Is there a person at the SPTO who drafts the documents that make up the patent or utility model application that applicants must submit?

No. This task is not specific to the SPTO. The applicant must submit the documentation for the invention prepared through their own means, in line with the standards about which the SPTO does provide information.

28. Can the application and other documentation be submitted in languages other than Spanish?

To obtain a filing date, a statement drafted in Spanish indicating that a patent or utility model is being applied for, a condition which equally applies to the applicant's identifying information. As stated above, in order to obtain a filing date, an item that upon cursory examination appears to be a description may be submitted in any language. As far as the rest of the documentation is concerned, the submission of the documentation in any official language of an Autonomous Community is permitted, provided that its corresponding translation into Spanish is provided within the established timeframe, whose text will be considered the authoritative version in case of doubt.

29. Is it possible to request information from the SPTO about the status of a patent or a utility model application?

Yes. The SPTO will answer questions that are related to the applications handled by this office. It is also possible to check the status of a file through the online portal (website): www.oepm.es. In cases in which the process has been conducted by an Industrial Property Agent or representative, said agent or representative will act as the interlocutor before the SPTO.

30. In what order does the SPTO process patent or utility model applications?

The SPTO processes and examines applications strictly in order of their filing dates.

31. What is the “priority date”?

The so-called priority date is the date upon which a patent application or utility model was first filed in a country belonging to the Paris Convention (WIPO) or the World Trade Organization (WTO). The deadline for claiming priority as the first application filed, nationally or abroad, in order to request subsequent filings of the same invention is 12 months, non-extendable.

32. Can changes be made to a patent or a utility model application after it has been submitted?

Yes. During the granting process, modifications may be made providing they do not broaden the scope of the application initially submitted, and only using the opportunities to do so provided by law.

33. Can an invention be publicly disclosed before the filing of a patent or utility model application?

No, not if the owner wishes to obtain the legal protection granted by rights to a patent or utility model. Only new inventions may be protected; that is, those that have not been made known to the public either in Spain or abroad, either in writing, verbally, or by any other means; or, in simple terms, they may not form part of what is referred to as the “state of the art.”

Some exceptions apply to the above, such as the presentation of an invention in an officially recognized exhibition falling under the scope of the Convention on International Exhibitions, signed in Paris on December 22, 1928, last revised on November 30, 1972.

34. What happens if two individuals file separate applications for the same invention?

The right to obtain protection either through a patent or a utility model corresponds to the person who first filed the application, as long as the filing is subsequently published.

35. What happens if the deficiencies in an application are not corrected within the timeframe established by the SPTO?

The application will be denied, depending on the nature of the deficiencies in question.

36. Once you have decided to protect your invention, is it important to submit the application as soon as possible?

Yes. In this way, you receive an official application submission date, which acts to prevent the state of the art from incorporating your invention, meaning you also will not be affected by any subsequent applications. Even if you have not completed all the formal requirements, and once having submitted only the mandatory minimum documentation, it is advisable to subsequently submit the full application and thus comply with all the requirements.

37. What is a Report on the State of the Art?

A Report on the State of the Art of a patent is a document that includes all the documentation (patent or technical literature) that may be taken into consideration when assessing the novelty and inventive nature of the invention applying for protection.

The report is elaborated as part of the process of granting a patent and is accompanied by a written opinion about whether or not the invention appears to be novel and involve inventive activity.

38. If the Report on the State of the Art (RSA) finds that the patent application is not novel or involves no inventive activity, is the patent denied?

If the RSA finds that the patent application is not new or lacks inventive activity, the applicant may opt to:

- Decide not to continue with the process and withdraw the application.
- Ask for an in-depth review and thus be able to make the modifications allowed by law to try to improve the patent application.

39. Can I patent an invention in Spain that is already patented abroad?

In order for an invention to comply with the novelty requirement, it cannot be form part of the state of the art.

In the case in point, given that the invention is patented in another country, said invention belongs to the state of the art and therefore cannot be patented.

03 Ownership and transfer

40. If two people or more work together in developing an invention, who has the right to it?

The right to the patent or utility model belongs in common to all of them. When an invention arises from the collaboration among groups of researchers from different countries, its ownership will be shared by all the participating entities in the proportion that corresponds to them according to the contributions made by the researchers.

41. Can new inventors be added to a patent?

New inventors may only be added to a patent or utility model application or registration in those cases when, in view of the application and documentation submitted at the beginning of application processing, it is evident that there had been an error. In addition, both the applicants and the rest of the inventors must declare that it was indeed an error, and that the new inventor(s) must be added.

42. Can a patent or a utility model be requested in the name of a company?

Yes. The applicant can be a company, but the application must include the name of the inventor or inventors and, if applicable, be accompanied by a statement indicating how the right to apply for the patent or utility model was acquired.

43. What is an employee invention, and who is entitled to it?

In this case, the invention is developed by a person who works on behalf of a company or organization under contract, employment, or service relationship.

As a general rule, the right to an invention made by an employee hired by a company to perform an inventive activity belongs, unless otherwise agreed, to the employer for whom they work.

Only when a worker's contribution to the invention clearly exceeds their contract or service relationship will they be entitled to additional compensation.

If the worker is not hired to conduct research, but nevertheless produces an invention thanks to means or knowledge acquired from the company, the employer can opt to claim ownership or reserve the right to use the invention, in either case obligatorily providing financial compensation to the worker.

44. Can a worker from one company who leaves to work for another company apply for a patent?

The law establishes that inventions for which a patent application is filed within the year following termination of the work or service relationship may be claimed by the former employer.

45. Can a patent or utility model be granted if the inventor dies before submitting the application?

Yes. The application may be submitted by their heirs.

46. Can a patent or utility model application, or an already granted patent or utility model be ceded or transferred?

Yes. The rights to an application or a patent or a utility model are transferable by all means recognized by law. To be effective before third parties, acts of transmission must be registered with the SPTO.

47. What are non-exclusive patent licenses?

A patent owner may notify the Spanish Patent and Trademark Office in writing that they are willing to authorize the use of the invention by any interested party, as a non-exclusive licensee, in exchange for compensation.

These licenses are considered full-fledged and allow the applicant to reduce their annual fees, which are reduced by half while also exempting the rights holder from the obligation to commercialize the invention.

04 Searches

48. Is it advisable to conduct a search for patents and/or utility models prior to submitting an application?

Yes, it is a good idea to conduct a search in order to uncover previously published documents that describe an identical or similar invention. In this way, it is possible to better gauge the degree of novelty of an invention.

49. What kinds of searches can be performed?

You can conduct and filter searches in quite diverse ways: by applicant, by patent family, by document number, by technical domain, by keywords, by priority number, or by other filters set by the applicant.

50. If no similar patent or utility model is found during the search, can one be assured that the application will be granted, or that other patents or utility models will not be violated if it is commercialized?

No. The search for previously-granted similar or equivalent patents can serve to provide fairly comprehensive knowledge of what has been protected, but it cannot guarantee that the invention will be granted, nor that any third-party rights will not be damaged once it is commercialized.

51. What facilities do the SPTO offer users for conducting searches and obtaining information?

The SPTO offer users a wide variety of services which may be grouped as follows:

- Publications accessible on its website. Each day, the SPTO publish the Official Bulletin of Industrial Property (BOPI) and other specialized publications (Technological Surveillance Bulletins) and monographs on the Internet.
- Databases created by the SPTO which the user can access for free on the Internet or in person at the Agency's headquarters.
- The Technology Information Services of the SPTO. These are for-pay services that include retrospective searches in national and international databases, as well as the preparation of technological patent reports and customized technology monitoring reports. These reports do not prejudice the resolutions that the SPTO or a foreign Patent Office may adopt if a patent application is filed to protect the invention in question, or whether or not a court of law will have to decide on the matter.

Information about these services can be obtained from the SPTO's Public Information Office: http://www.oepm.es/es/informacion_tecnologica/index.html.

05 Protection abroad

52. Do patent or utility model rights granted in Spain protect an invention abroad?

No. The invention is only protected in Spain.

In countries where the invention is not protected, the technology is considered public domain and anyone can exploit it freely, hence the importance of filing for patents in all the countries where an invention is to be marketed.

53. How does one protect research abroad?

Protection abroad may be obtained in several ways:

- By submitting an application in each country in which you wish to obtain protection.
- By submitting an application in compliance with the European Patent Convention through the SPTO. Once a European patent has been granted, it will have to be validated in the states in which protection is sought by paying the corresponding fees and submitting a translation of the patent in the official language of that state.
- By submitting an international application in compliance with the Patent Cooperation Treaty (PCT) through the SPTO. Under Article 22 of the PCT, the applicant has to submit a translation of the international application and pay the filing fee within a period of thirty months from the priority date. In this regard, some States are bound by the previous wording of Article 22, in which cases the period is 20 months. These States are: Luxembourg, Uganda, and Tanzania. However, other States have established a term longer than 30 months. For more information, please consult the different deadlines on the WIPO website at the following address:
http://www.wipo.int/pct/es/texts/time_limits.html.

54. Which countries are members of the aforementioned European Patent Convention and PCT?

As of 2014, there are 38 member countries signatory to the European Patent Convention: Albania, Germany, Austria, Belgium, Bulgaria, Cyprus, Croatia, Denmark, Spain, Slovakia, Slovenia, Estonia, Finland, France, Greece, Hungary, Ireland, Iceland, Italy, Latvia, Liechtenstein, Lithuania, Luxembourg, Malta, Monaco, Norway, Netherlands, Poland, Portugal, United Kingdom, Czech Republic, Yugoslav Republic of Macedonia, Romania, San Marino, Serbia, Sweden, Switzerland, and Turkey. In addition, Bosnia-Herzegovina and Montenegro recognize these applications, meaning that protection may be obtained in 40 countries. Source: <http://www.epo.org/about-us/organisation/member-states.html>.

The member countries of the PCT are: Albania, Germany, Angola, Antigua and Barbuda, Saudi Arabia, Algeria, Armenia, Australia, Austria, Azerbaijan, Bahrain, Barbados, Belarus, Belgium, Belize, Benin, Bosnia and Herzegovina, Botswana, Brazil, Brunei Darussalam, Bulgaria, Burkina Faso, Cambodia, Cameroon, Canada, Chad, Chile, China, Cyprus, Colombia, Comoros, Congo, Cote d'Ivoire, Costa Rica, Croatia, Cuba, Denmark, Djibouti, Dominica, Ecuador, Egypt, El Salvador, United Arab Emirates, Slovakia, Slovenia, Spain, United States of America, Estonia, The Former Yugoslav Republic of Macedonia, Russian Federation, Philippines, Finland, France, Gabon, Gambia, Georgia, Ghana, Grenada, Greece, Guatemala, Guinea, Equatorial Guinea, Guinea-Bissau, Honduras, Hungary, India, Indonesia, Ireland, Iceland, Israel, Italy, Japan, Kazakhstan, Kenya, Kyrgyzstan, Kuwait, Lesotho, Latvia, Liberia, Libya, Liechtenstein, Lithuania, Luxembourg, Madagascar, Malaysia, Malawi, Mali, Malta, Morocco, Mauritania, Mexico, Monaco, Mongolia, Montenegro, Mozambique, Namibia, Nicaragua, Niger, Nigeria, Norway, New Zealand, Oman, Netherlands, Panama, Papua New Guinea, Peru, Poland, Portugal, Qatar, United Kingdom, Republic Arab of Syria, Central African Republic, Czech Republic, Republic of Korea, Republic of Moldova, Lao People's Democratic Republic, Dominican Republic, Islamic Republic of Iran, Democratic People's Republic of Korea, United Republic of Tanzania, Romania, Rwanda, Saint Kitts and Nevis, San Marino, Saint Vincent and the Grenadines, Saint Lucia, Sao Tome and Principe, Senegal, Serbia, Seychelles, Sierra Leone, Singapore, Sri Lanka, South Africa, Sudan, Sweden, Switzerland, Swaziland, Thailand, Tajikistan, Togo, Trinidad and Tobago, Tunisia, Turkmenistan, Turkey, Ukraine, Uganda, Uzbekistan, Vietnam, Zambia, and Zimbabwe. (Totalling 152 countries as of 2017). Source: http://www.wipo.int/pct/en/pct_contracting_states.html.

Basic Facts about Patents and Utility Models

SPANISH PATENT AND TRADEMARK OFFICE, OA

ADDRESS

Paseo de la Castellana, 75
28071 Madrid. SPAIN

METRO/UNDERGROUND

Nuevos Ministerios

BUSES

5-7-14-16-19-27-37-40-43-45-126-147-150-C1 and C2 lines.

EMAIL ADDRESSES

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If you have an invention, trademark or design, register it.

INFORMATION

Tel: 902 157 530 (Open to public: Monday to Friday from 9:00 a.m. to 6:00 p.m.)
(9:00 a.m. to 3:00 p.m. from July 1 to August 31) Fax: 91 349 55 97

GENERAL PUBLIC

Tel.: 91 349 53 35 - 91 349 53 97 - Fax: 91 457 25 86

SME SUPPORT SERVICE: Tel. 91 349 55 48 - 91 349 68 22

OPENING HOURS

Registry service hours:

Monday to Friday from 9:00 a.m. to 2:30 p.m. and 4:00 p.m. to 6:00 p.m. Saturdays 9:00 a.m. to 1:00 p.m.

Registry services hours (from July 1 to August 31):

Monday to Friday from 9:00 a.m. to 2:30 p.m. Saturdays 9:00 a.m. to 1:00 p.m.

Cashier service hours: Monday to Friday from 9:00 a.m. to 2:30 p.m.

Thursday from 9:00 a.m. to 2:30 p.m. and from 4:00 p.m. to 6:00 p.m. (Closed evenings from May to September, inclusive)

WEBSITE

www.oepm.es

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