

Strategic Management and the Creation of Technology-Based Firms

Topic 3. Industrial property



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Table of contents

1. Introduction to industrial property.

2. Forms of protection.

3. Patents.

- **Characteristics.**
- **Applicants.**
- **Application procedure.**
- **Documentation.**

1. Introduction

Industrial property:

- This comprises a series of special rights within Civil and Commercial Law, framed within Competition Law, concerning:
 - Industrial inventions.
 - Industrial designs and models.
 - Distinguishing signs.
 - Repression of unfair competition.
- The rules of Civil and Commercial Law are applied unless otherwise provided for or in any matter not regulated by Industrial Property Law.

Intellectual property:

- This is more general and covers **industrial property** and **intellectual property** (copyright and related rights).

1. Modalities of industrial/intellectual property

Modality	What it protects	How this is achieved
Patents and Utility Models	New inventions.	Registration.
Registered designs	New inventions.	Registration.
Trademarks	Distinguishing identification of products or services.	Use and/or registration.
Copyright	Artistic, literary and scientific creations.	They are automatic.
Plant varieties	New varieties.	Registration.
Trade secret	Valuable information not known externally.	Establishing own measures to protect the secret. Does not grant exclusive rights.

Some intellectual and industrial property rights existing in a mobile telephone

Trademarks:

- Manufactured by “Nokia”.
- “NOKIA 3310” product.
- ...

Patents:

- Chemical compounds...
- Data processing methods.
- Semi-conductor circuits.
- ...

Copyrights:

- Software code.
- Instructions booklet.
- Ring tones.
- ...



Trade secrets: ?

Designs (some of them registered):

- Overall shape of the telephone.
- Key design (oval shape).
- ...

Importance of intellectual and industrial property

- **Vital business asset** in the knowledge economy.
- Increases **the financing of innovation projects**:
 - Without IP, many innovation projects would not be profitable because anyone could copy their results.
- Protects **innovative small businesses**:
 - Graphenea.
 - Das Photonics.
 - ARM Ltd...
- Need to disclose Industrial Property and make it enter **public domain** under certain **controlled conditions**:
 - Linux, Creative Commons...

Importance of intellectual and industrial property

- IP collections grow and grow...
- In just 2016*, 3,127,900 patent applications and 1,553,300 utility model applications were filed.

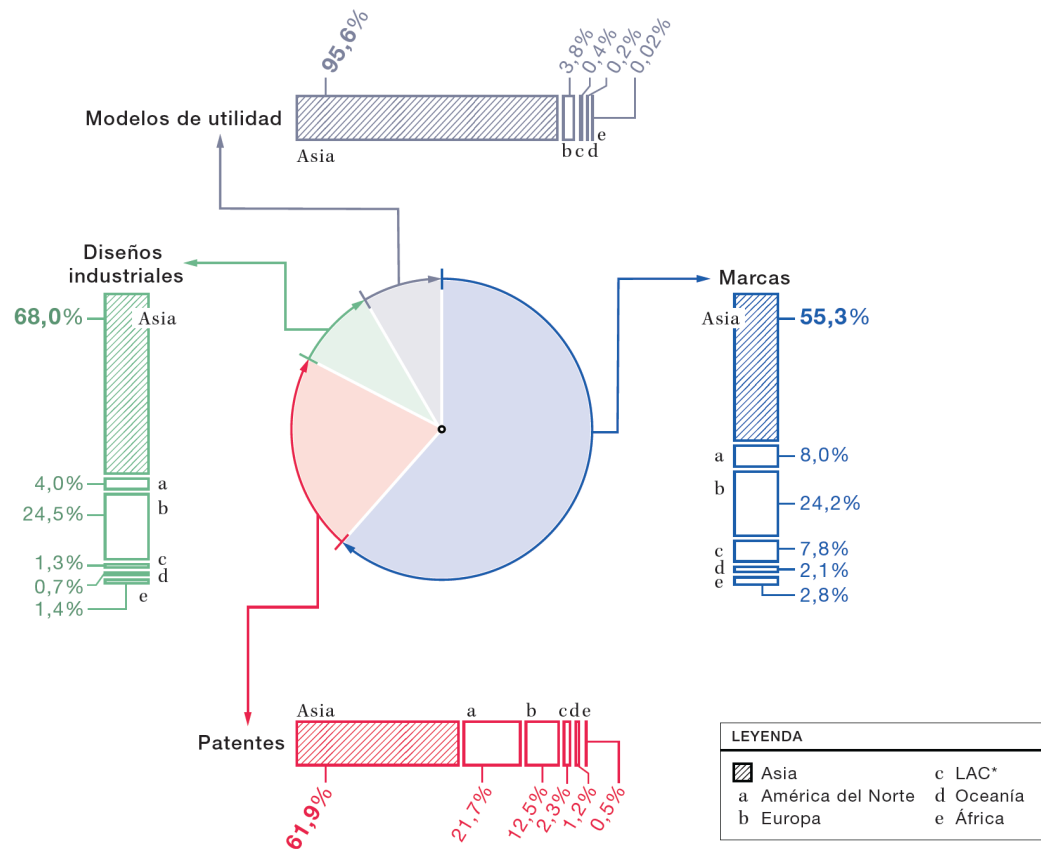
* *Wipo Statistics Database, March 2018.*



More than 534 applications per hour!!!!

Importance of intellectual and industrial property

- The majority of applications for IP titles were presented in Asia.



Distribution by region of the presentation of applications for IP titles.

* Latin America and the Caribbean (LAC).

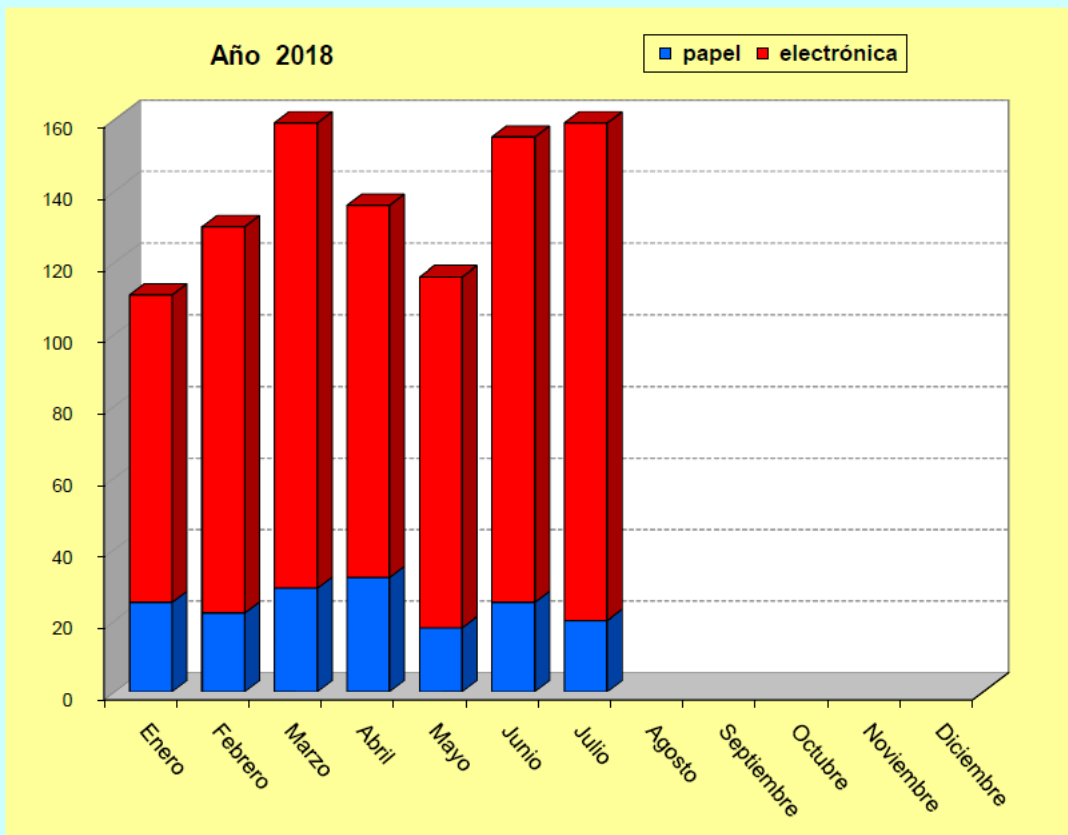
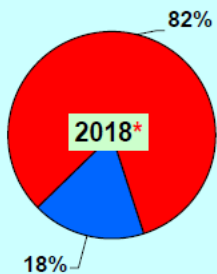
Source: WIPO statistics database, October 2016.

Importance of intellectual and industrial property

SOLICITUDES DE PATENTES NACIONALES POR MESES, 2018

* Son datos provisionales

Meses/Años	2017	2018 *
Enero	175	111
Febrero	240	130
Marzo	688	159
Abril	80	136
Mayo	155	116
Junio	151	155
Julio	156	159
Agosto	80	
Septiembre	130	
Octubre	131	
Noviembre	138	
Diciembre	162	
Total	2.286	966



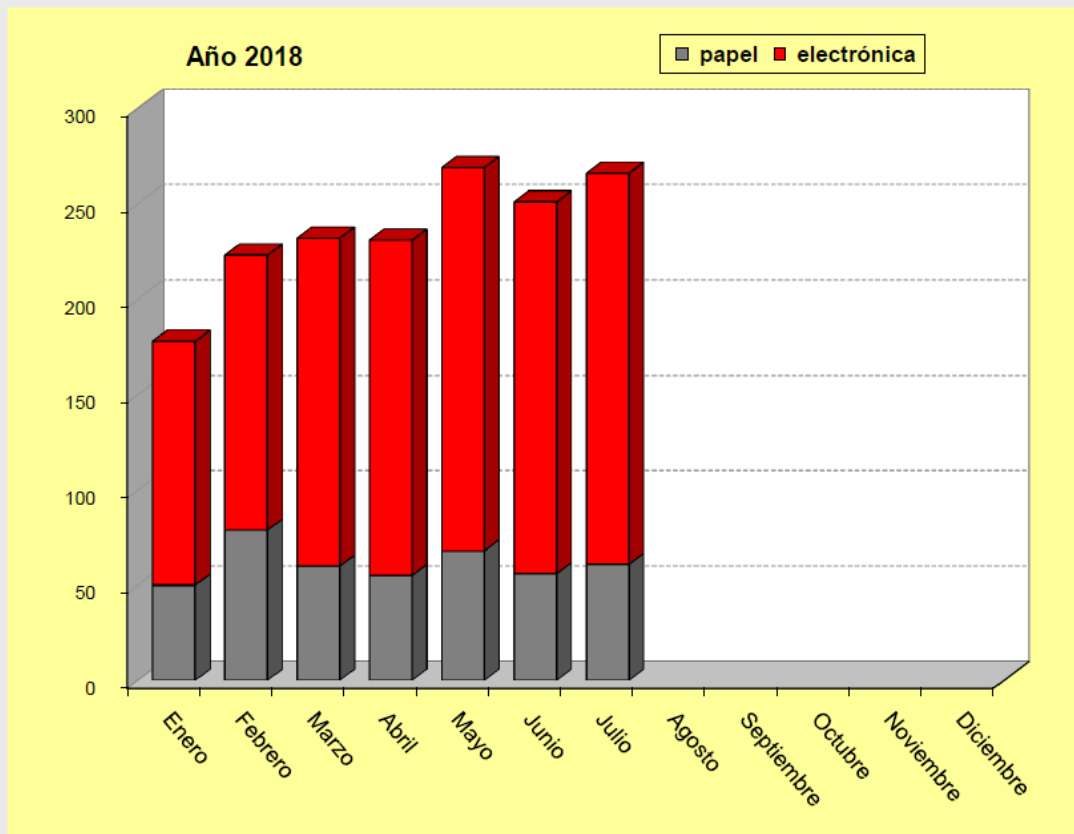
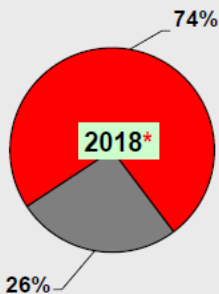
Nota : El 1 de abril de 2017 entró en vigor la Nueva Ley de Patentes de 24/2015

Importance of intellectual and industrial property

SOLICITUDES DE MODELOS DE UTILIDAD POR MESES, 2018

* Son datos provisionales

Meses/Años	2017	2018 *
Enero	139	178
Febrero	192	223
Marzo	421	232
Abril	130	231
Mayo	194	269
Junio	215	251
Julio	191	266
Agosto	141	
Septiembre	177	
Octubre	228	
Noviembre	215	
Diciembre	195	
Total	2.438	1.650



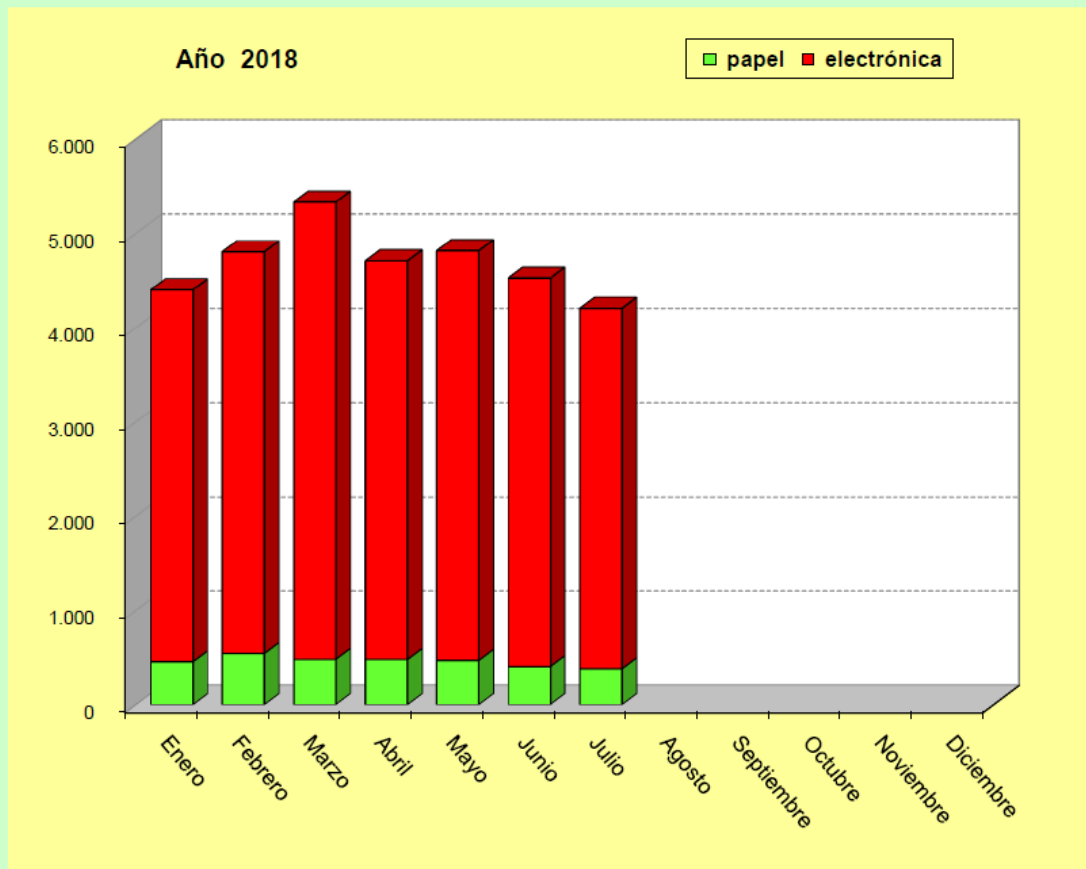
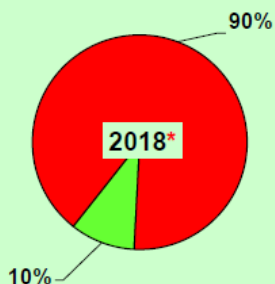
Nota : El 1 de abril de 2017 entró en vigor la Nueva Ley de Patentes de 24/2015

Importance of intellectual and industrial property

SOLICITUDES DE MARCAS NACIONALES POR MESES, 2018

* Son datos provisionales

Meses/Años	2017	2018 *
Enero	4.070	4.400
Febrero	4.902	4.802
Marzo	4.718	5.329
Abril	4.718	4.706
Mayo	4.984	4.814
Junio	4.738	4.524
Julio	4.450	4.202
Agosto	2.804	
Septiembre	3.947	
Octubre	4.194	
Noviembre	4.873	
Diciembre	3.643	
Total	52.041	32.777

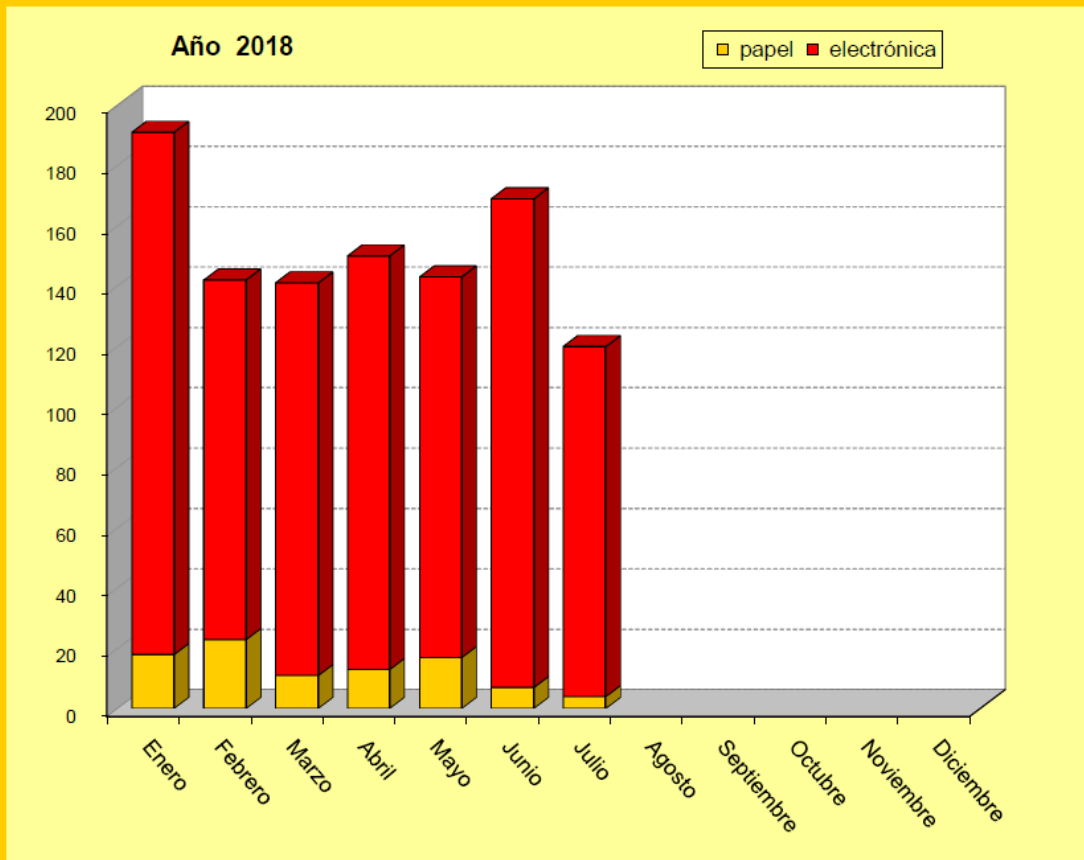
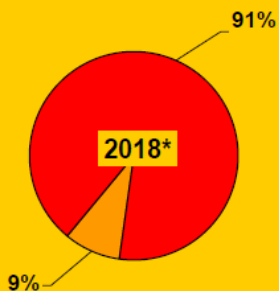


Importance of intellectual and industrial property

SOLICITUDES DE DISEÑO INDUSTRIAL POR MESES, 2018

* Son datos provisionales

Meses/Años	2017	2018 *
Enero	171	191
Febrero	162	142
Marzo	120	141
Abril	193	150
Mayo	233	143
Junio	162	169
Julio	193	120
Agosto	101	
Septiembre	133	
Octubre	146	
Noviembre	136	
Diciembre	140	
Total	1.890	1.056



1. Introduction

Patent law:

- Branch of industrial property that deals with **product** or **process** inventions, works of human ingenuity, that belong to the field of **industry** (any physical activity of technical nature).
- Subject matter in **Patent Law** must be of **technical** nature and the invention must be aimed at solving a technical problem.

2. Forms of protection

Patent Law 24/2015 of July 24: (Entry into force: 01/04/2017)

- **Main changes:**

- Modification in the granting system, prior examination procedure.
- Scope of protection of utility models (title XIII).
- Reduction in fees for certain sectors.
- Regime for employee inventions (title IV, arts. 18 and 19).
- Compulsory licences.
- Supplementary protection certificates (Bolar clause).

- **Reasons:** to reduce administrative burden, to improve legal certainty for Spanish inventors (faster acquisition of solid titles), to incorporate and group regulations into one single legal text, to adapt the law to the current context.

2. Forms of protection

In Spain, Patent Law 24/2015:

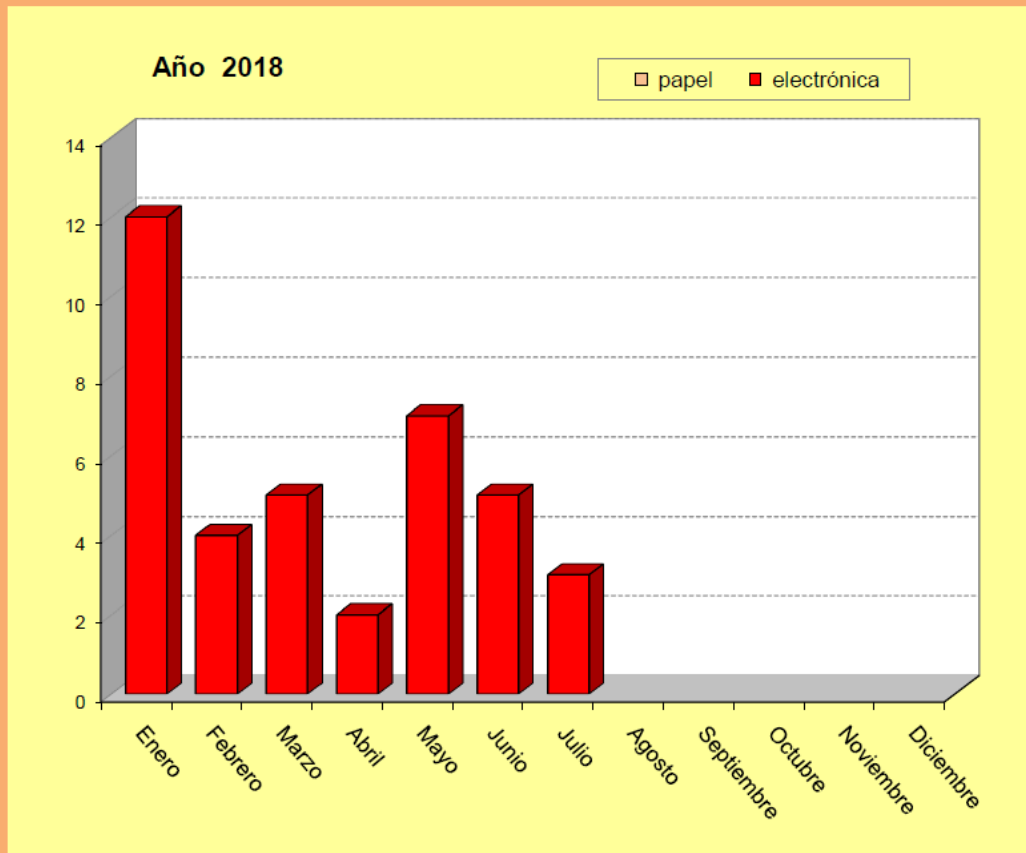
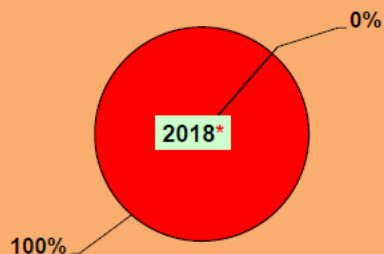
- **Art. 1:** *«For the protection of **industrial inventions**, the following industrial property titles will be granted, in accordance with the provisions of this Law»:*
 - A.** Invention **patents** (major inventions).
 - B.** **Utility model** protection certificates (minor inventions).
 - C.** **Supplementary certificates** for the protection of medicinal and phytosanitary products.

2. Forms of protection

SOLICITUDES DE CERTIFICADOS COMPLEMENTARIOS DE PROTECCION POR MESES, 2018

* Son datos provisionales

Meses/Años	2017	2018 *
Enero	5	12
Febrero	1	4
Marzo	6	5
Abril	3	2
Mayo	3	7
Junio	6	5
Julio	7	3
Agosto	3	
Septiembre	4	
Octubre	8	
Noviembre	12	
Diciembre	6	
Total	64	38



2. Forms of protection

In Spain, Patent Law 24/2015:

- **Art. 4.1:** «*Patents can be granted for inventions which are new, involve an inventive step and are susceptible of industrial application...».*
- **Art. 52 (1) EPC (European Patent Convention):** «*European Patents shall be granted for any inventions which are susceptible of industrial application, which are new and which involve an inventive step».*

2. Forms of protection

In Spain, Patent Law 24/2015:

- **Art. 137.1:** «*Utility models shall protect **industrially applicable** inventions which, being novel and involving an inventive step, consist in giving form, structure or constitution to an object that results in some kind of **advantage which is appreciable in practice for its use or manufacturing***».

2. Forms of protection

In Spain, Patent Law 24/2015:

- Art. 137.2: «*Utility models shall **not** protect **process inventions**, **those concerned with biological matter and pharmaceutical substances and compositions**».*
- Their duration is reduced from 20 to **10 years**, owing to the fact that they only require **relative or national novelty** and a **lesser** degree of inventive step than for invention patents.

2. Forms of protection

In Spain, Patent Law 24/2015:

<https://www.boe.es/boe/dias/2015/07/25/pdfs/BOE-A-2015-8328.pdf>

- **Art. 6.2, on the State of the Art.**
- **Art. 6.3, on the State of the Art**
- **Art. 139, on the State of the Art**

2. Forms of protection

Industrial design:

- *«The appearance of a whole product or part of a product, resulting from the characteristics, in particular the lines, contours, colours, shape, texture or materials, of the product itself or its ornamentation».*
- The ornamental or aesthetic appearance of an article, not functional.
- Law 20/2003, on the Legal Protection of Industrial Design.
- Duration of 5 years, extendable to 25 years.

2. Forms of protection

Requirements according to Law 20/2003:

- **Novelty:** no other identical design must have been made available to the public before the date of filing of the application for registration or the priority date.
- **Unique nature:** the overall impression it produces on the informed user must differ from the overall impression produced by any other design.
- **Visibility:** if the design corresponds to a particular component of a complex product, it must be visible in normal use, and also comply with the previous requirements.

2. Forms of protection

Distinguishing signs: trademarks, brand names (which can be registered in the Spanish Patent and Trademark Office) and establishment signs (which can be registered in town councils).

- **Trademark:** identification of a product or service in the market (serves to distinguish products and to differentiate them from those of competitors).
- **Brand name:** identification of a natural or legal person in the fulfilment of their business activity.

2. Forms of protection

What is a Trademark?:

- It is something complex, which involves several elements:
 1. A physical or material part, which is tangible (the name, registration, graphic image).
 2. An immaterial aspect, which is intangible (status), subjective, psychological and emotional (customer service, after-sales service).

2. Forms of protection

European Trademark Law Reform:

- Modification of the Trademark Directive (**EU Directive 2015/2436 of the European Parliament and of the Council of 16 December 2015**) which affects both national rights and the very functioning and procedures of National Organisations (Spanish Patent and Trademark Office).
Member state adaptation → Until **14 January 2019**.
- **Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015**.
Entry into force → 23 March 2016.
- **Terminological novelties:**
 - The “Community trade mark” changes its name to: **European Union trade mark (Union trade mark)**.
 - The official agency (OHIM) is renamed the **European Union Intellectual Property Office (EUIPO)**.
 - The terms «Community», «European Community» and «European Communities» are replaced by **“UNION”**.

2. Forms of protection

New Trade Mark concept:

- The “graphic representability” requirement disappears.
- **Art. 4 amended, Regulation (EC) 207/2009:** *«An EU trade mark may consist of any signs, in particular words, including personal names, designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of»:*
 - A. Distinguishing the goods or services of one undertaking from those of other undertakings.
 - B. Being represented on the Register of European Union Trade Marks, in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

2. Forms of protection

Classes of Trade Marks:

- Names.
- Sounds.
- Graphics.
- Mixed.
- Tri-dimensional.
- Non-conventional.



ZARA



**N°5
CHANEL**

2. Forms of protection

Rights conferred by Trademark registration:

- Monopoly for using the trademark in relation to the goods and services and in the geographical area for which the trademark is registered.
- Granting or licensing the trademark.
- Objecting to signs being registered that could be confused with theirs.
- Requesting before the courts the invalidation of other subsequent trademarks that could be confused with theirs as well as civil and criminal action considered to be necessary to safeguard their rights (importing, exporting products with the sign, using the sign on business papers and in advertising, affixing the sign to products or to their packaging, etc., (art. 9 amended, Regulation EC 207/2009)).

2. Forms of protection

Registration System:

- **National Trade Mark:** Trade Mark Law 17/2001. Registration through the Spanish Patent and Trademark Office. 10-year duration, indefinitely renewable.
- **Community Trade Mark:** Regulation 2015/2424. Registration through EUIPO (**European Union Intellectual Property Office**). 10-year duration, indefinitely renewable.
- **International Trade Mark:** Madrid system concerning international trade mark registration (Registered trade mark), 1989 Protocol (application through National WIPO office). 10-year duration.



2. Forms of protection

Repression of unfair competition:

- **Acts of unfair competition (Chapter II, Law 3/1991):**
 - Any act objectively contrary to goodwill.
 - Misleading acts: the use or dissemination of incorrect or false indications and any other kind of practice that is liable to mislead the public.
 - Any act of such a nature as to create confusion with another's activity, supplies or establishment.
 - Omitting or concealing information that the public needs to make or be able to make a decision.
 - Aggressive practices (harassment, coercion, use of force...).
 - Acts of denigration.
 - Acts of comparison when not carried out in an objective manner between essential and verifiable features of products intended for the same purpose or satisfying the same needs.

2. Forms of protection

Repression of unfair competition:

- **Acts of unfair competition (Chapter II, Law 3/1991):**

- Acts of imitation in which undue advantage is taken of another's reputation or efforts.
- Exploitation of another's industrial, commercial or professional reputation.
- Violation of secrets.
- Inducing a breach of contract.
- Violation of norms: enjoying competitive advantage in the marketplace which has been acquired by violating the law.
- Discrimination: discriminatory treatment of consumers with regard to prices and other conditions of sale or a company taking advantage of the economic dependence of its client companies or suppliers which have no equivalent alternative.
- Selling below cost.
- Illegal advertising.

3. Patents: characteristics

- A patent is a **right** granted to an inventor by a State (or regional office that operates in several states) which allows the inventor/proprietor **to exclude third parties from taking commercial advantage** of their invention in that territory for a specific period of time (normally 20 years –art. 63 EPC, European Patent Convention–).
- In exchange for this **exclusive right**, the inventor must disclose the invention in a manner sufficiently clear and complete for an expert to put it into practice.

3. Patents: characteristics

Patent Law 24/2015:

<https://www.boe.es/boe/dias/2015/07/25/pdfs/BOE-A-2015-8328.pdf>

- **Art. 59.1, on the Rights Conferred on the Proprietor of a Patent.**

What rights does a patent confer?

- Right to **exclude third parties** from manufacturing, using, offering for sale, selling or importing infringing products **in the country in which the patent has been granted**.
- **It is not a right of use.** The patent protects the invention, granting its proprietor the right to prevent others from reproducing or using the invention without their consent.
- A European patent shall confer, in each Contracting State in respect of which it is granted, the same rights as would be conferred by a national patent granted in that State (art. 64 EPC).
- The right to cede or transfer the ownership of a patent and formalise licensing contracts (arts. 71-73 EPC).

Could trade secrets be an alternative to patents?

- When the invention consists of a process (for example, in manufacturing) “trade secrets” could be a viable alternative (it is possible that nobody could find out the manufacturing process by simply examining the final product sold).
- However, trade secrets can be leaked and if this happens, the law provides no protection measures.
- Once the invention has been disclosed, it can not be patented.
- In other cases, it may be preferable to continue inventing without patenting, and to just keep ahead of competitors by introducing new products into the market faster than them.

3. Patents: requirements

The legal basis for granting European patents is in:

- The **EPC** (European Patent Convention) articles.
- EPC Implementing Regulations.
- Interpretation of the articles and rules through the decisions (Case Law) of the Boards of Appeal of the EPO (European Patent Office).

Patentability requirements:

- Novelty.
- Inventive step.
- Industrial applicability.
- Inventions, in all fields of technology.

3. Patents: requirements

Absolute novelty:

- **Art. 54.1 EPC:** *«An invention shall be considered to be new if it does not form part of the state of the art».*
- **Art. 54.2 EPC:** *«The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application».*
- **¡WATCH OUT!** You must file the patent application before publishing your own work, it does not matter if you were the one who publicly disclosed the invention.



What to avoid while studying the possibility of filing a patent application

- **Do not publish any information before filing the application:** articles, press releases, presentations/posters/debates in conferences, blog posts.
- **Do not give courses or presentations with customers or potential investors before filing the application, unless a confidentiality agreement is signed (look for advice).**
- **Do not sell** products that incorporate the invention before filling the application.
- File the application before anyone else does!

3. Patents: requirements

Inventive step:

- **Art. 56 EPC:** *«An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art».*
- **New invention:** if there is at least one difference between the invention and the state of the art.
- **Inventive step:** depending on the extent or relevance of this difference.

3. Patents: requirements

Industrial application:

- **Art. 57 EPC:** *«An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture».*
- **Invention, in all fields of technology:** the EPC does not provide a positive definition of an invention, but the invention must have a technical nature, and it does provide a non-exhaustive list of exclusions.

3. Patents: requirements

Art. 52.2 EPC:

- **The following in particular shall not be regarded as inventions:**
 - A.** Discoveries, scientific theories and mathematical methods.
 - B.** Aesthetic creations.
 - C.** Schemes, rules and methods for doing business, and programmes for computers.
 - D.** Presentations of information.

3. Patents: requirements

What can not be patented?:

- Inventions the commercial exploitation of which would be contrary to **ordre public** or **morality** (article 53 (a) EPC) (cloning, uses of human embryos for commercial purposes...).
- **Plant or animal varieties** or essentially biological processes for the production of plants or animals (article 53 (b) EPC) (this provision shall not apply to microbiological processes).
- Methods for **treatment of the human or animal body by surgery or therapy** and **diagnostic methods** practised on the human or animal body (article 53 (c) and articles 54.4-5 EPC) (this provision shall not apply to products for use in any of these methods).

3. Patents: exception to the exception

- **Methods outside** the human or animal body (in vitro) are patentable. E.g.: method for serum diagnosis of disease X.
- **Products**, in particular **substances** or **compositions**, and inventions of **equipment or tools for implementing these methods**, are patentable.
- **Cosmetic methods** are patentable.
- **Treatments of animals for agro-farming purposes** are patentable. E.g.: increase in meat, milk production...
- Element **isolated from the body** or **otherwise obtained by means of a technical process**, including the total or partial sequence of a gene, even if its structure is identical to that of a natural element (as long as it has an industrial application).
- Processes for **modifying the genetic identity of animals** with substantial medical benefit to man or animal, and also animals resulting from such processes.
- **Non-human embryonic stem cells** obtained by any method.
- Human embryonic stem cells obtained by any method that does not affect the embryo's viability. **Adult stem cells**.
- **Computer-implemented inventions**. (Process which describes the sequence of the different steps of programme/machine interaction).

3. Patents: requirements

- A patent claim which refers **only** to one of the elements listed in article 52.2 EPC, will not be considered an invention and will therefore not be patentable, but... this principle only applies when the patent claim refers to nothing more than just one of those elements or activities considered “as such” (article 52.3 EPC).
- A patent application which includes a mix of technically patentable elements and non-technical excluded elements, can be considered an invention and, after all, be patentable.

3. Patents: applicants

Who can apply for a patent?:

- Title III, Law 24/2015.

<https://www.boe.es/boe/dias/2015/07/25/pdfs/BOE-A-2015-8328.pdf>

The Right to the Patent and Designation of the Inventor.

- Art. 10.1
- Art. 10.2
- Art. 14

3. Patents: applicants

Who can apply for a patent?:

- Title IV, Law 24/2015.

<https://www.boe.es/boe/dias/2015/07/25/pdfs/BOE-A-2015-8328.pdf>

Work-Related Inventions.

- Art. 15.1
- Art. 15.2

3. Patents: applicants

- **Title IV, Law 24/2015.**

<https://www.boe.es/boe/dias/2015/07/25/pdfs/BOE-A-2015-8328.pdf>

Work-Related Inventions.

- **Art. 21.1**
- **Art. 21.2**
- **Art. 21.3**
- **Art. 21.4**
- **Art. 21.6**

Who can apply for and get a patent?

- The right to a European patent shall belong to the inventor or his successor in title (article 60.1 EPC).
- If the inventor is an employee, the right to a European patent shall be determined in accordance with the law of the State in which the employee is mainly employed; if the State in which the employee is mainly employed cannot be determined, the law to be applied shall be that of the State in which the employer has the place of business to which the employee is attached (article 60.1 EPC).
- As a general rule, any invention relating to the usual work environment of an employee will belong to the employer.
- The employee may receive an additional financial reward, depending on the EPC Contracting State concerned.
- The inventor shall have the right to be mentioned as such before the EPO (article 62 EPC).

3. Patents: how to get one

How to get a patent:

- First of all, **file a patent application.**
- **When?** In principle, as soon as possible. Always before the invention is disclosed in any way.
- **Where?** In the states where protection is required.
 One possibility: apply in all relevant states at the same time.
 Problem: this is expensive, if protection is required in a lot of countries; and uncertain, as it may still not be clear whether it is worth investing in all states.
- Can the costs associated with the patent be deferred?

3. Patents: how to get one

Priority right (Paris Convention):

- To put it simply:

- A patent application is filed in one country first.
- Within a 12-month period, applications can be filed for the same invention in other countries (members of the Paris Convention or the World Trade Organisation).
- Subsequent applications can claim the “priority” of the **first** application: **the application date of the first application** will be the date for determining the novelty and inventive step of **subsequent** applications.

3. Patents: how to get one

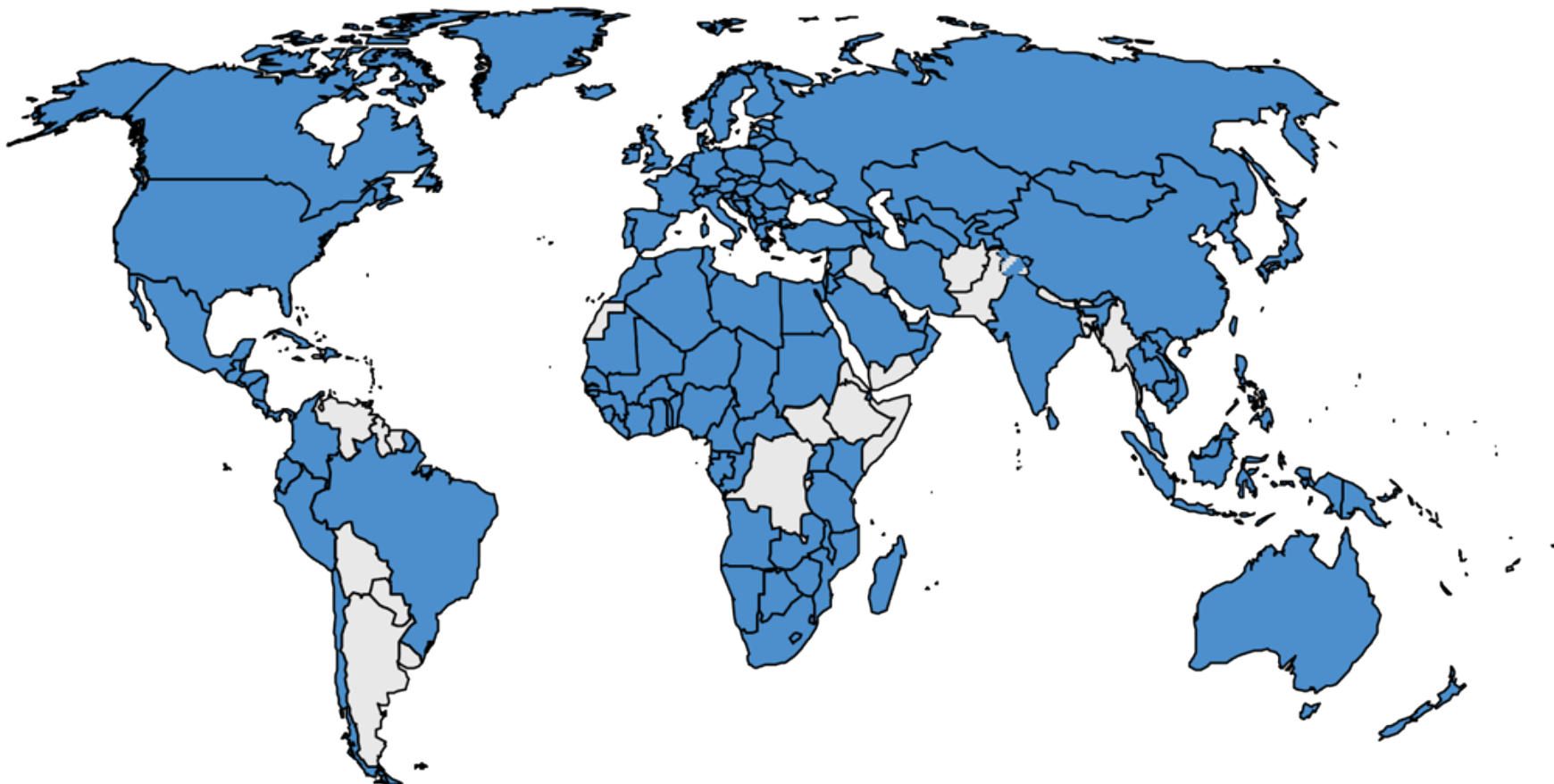
Patent Cooperation Treaty (PCT):

- An “International Phase” which includes: an international search report (ISR), international publication and, optionally, an international preliminary examination.
- 30/31 months from the date of application or priority: entry into the national phase (similar to national patent application).
- PCT does not give the applicant an “international patent”, it gives them more time to decide.

¿Dónde se puede solicitar una patente?

- **National patent offices (In Spain: Oficina Española de Patentes y Marcas [*Spanish Patent and Trademark Office*]):**
 - National patents **are only valid in the country in which they are granted.**
 - Non-residents can also file patent applications.
 - “Priority” right of one year for subsequent applications referring to the same invention, in other patent offices.
- **European Patent Office:**
 - A European patent **is equivalent to national patents** in the countries in which it is granted (the applicant chooses the countries).
- **Under the protection of the Patent Cooperation Treaty (PCT):**
 - One single application serves for up to 148 countries.
 - Following the initial application phase, international application gives rise to multiple national patent examination procedures.
 - **Decisions involving costs may take** up to 30-31 months after filing the application (for example, choosing the countries where you need to file the application).
- **International patents don’t exist, only an international application procedure!**

3. PCT (152 states in September 2018)



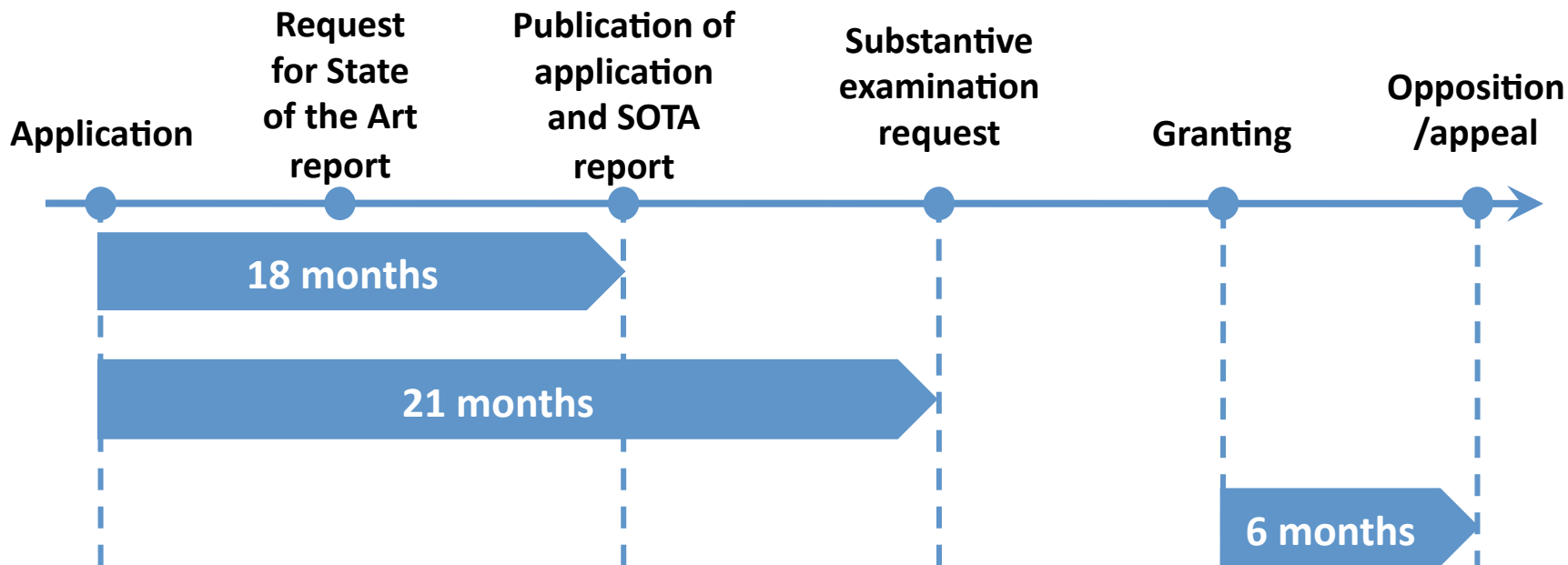
Source: OMPI (2018).

3. Patents: how to get one

Processing and granting of a Spanish application at the Spanish Patent and Trademark Office

	Law 11/1986	New law 24/2015
Patent granting system	2 routes: <ul style="list-style-type: none"> • General granting procedure. • Procedure with prior examination. 	SINGLE granting system with prior examination of novelty and inventive step.
State of the art report	Request and payment of fees: <ul style="list-style-type: none"> • 15 months from application or priority. 	Request and payment of fees: <ul style="list-style-type: none"> • Upon application. The report is also initiated with the application.
Appeal/opposition	Only in procedure with prior examination and prior to granting	Post-grant opposition: <ul style="list-style-type: none"> • 6 months from the date of publication of the granting in the Spanish Official Industrial Property Gazette.

Patent granting procedure under the Spanish Patent and Trademark Office



Title V (Application and granting procedure).
Chapter II (Granting procedure).
Chapter III (Opposition and appeal).

3. Patents: how to get one

Fast patent granting process:

1. When filing the patent application, the state of the art report and early publication (within 18 months) is requested.
2. The fee for requesting the state of the art report must be paid together with the filing fee.
3. If the Spanish Patent and Trademark Office suspends the application (form defects), the application is automatically removed from this fast procedure.
4. If not, it is granted in a period of 10-12 months.

3. Patents: how to get one

State of the Art Report:

1. To inform about the elements of the state of the art that must be taken into consideration in order to assess the novelty and inventive step of the patent application.
2. To make it easier to recognise the real value of the patent both for the applicant and for third parties.

3. Patents: how to get one

State of the Art Report:

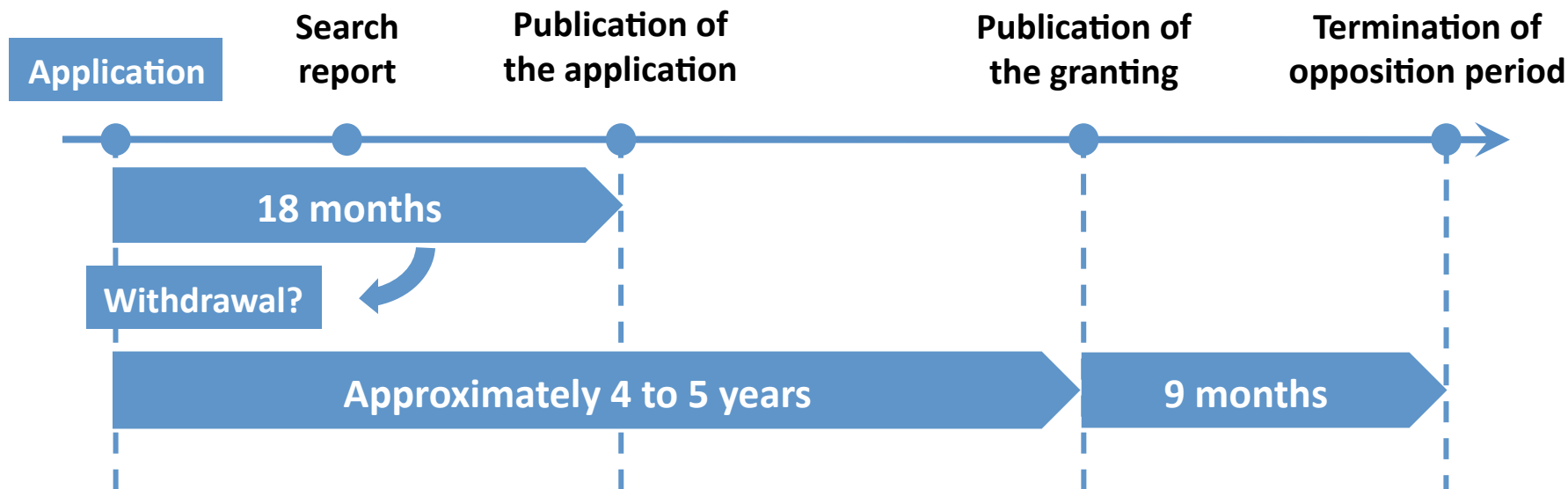
- To determine the state of the art, the Patent Office performs a search and the documents considered by the examiner to be most closely related to the invention are recorded in a report.
- Informe sobre el **Estado de la Técnica (IET)** [*State of the Art Report*] for the Spanish Patent and Trademark Office.
- Or a **European Search Report (ESR)** for the European Patent Office.
- Or an **ISR** International Search Report for the WIPO.

3. Patents: how to get one

Prior examination (content examination):

1. The granting procedure with prior examination grants only those patents that meet the requirements of novelty, inventive step and sufficiency of disclosure (single route since entry into force of Law 24/2015).

Patent granting procedure under the EPO



3. Patents: how to get one

Patent Cooperation Treaty (PCT):

- **Where can a Spanish inventor file a patent application?:**
 - At the Spanish Patent and Trademark Office.
 - At the European Patent Office (EPO).
 - At the World Intellectual Property Organisation (WIPO).
- **In which language?:**
 - In Spanish, at any of the three Receiving Offices.
 - If the Spanish Patent and Trademark Office is the authority chosen for the International Search, no translation is required.
 - If the EPO is the authority chosen for the International Search, it must be translated into one of the three official languages (English, French or German).

PCT procedure

Possible previous patent application (priority)

PCT patent application

**Publication:
18 months after the priority date**

**The applicant decides: preliminary examination?
22 months after the priority date**

No



**Proceeds directly with the
national/regional phase**

Si



Preliminary examination

**National phase:
30-31 months after filing the first application**

3. Patents: documentation

- How does the patent drafter (e.g.: a patent agent or industrial property agent) prepare the **description**?
- **The inventor must provide the patent drafter with:**
 - An indication of the **technical field**.
 - The **state of the art** known to him/her that he/she believes may be of interest.
 - A **technical problem**/disadvantage resulting from the state of the art.
 - The invention's **solution** to that problem, in **technical** terms (in accordance with article 83 EPC, there is the obligation to describe it in order to obtain an **exclusive right**).

3. Patents: documentation

A European patent application shall contain (art. 78.1 EPC):

- A request for the grant of a patent.
- Una description of the invention (rule 42 EPC) (summary of the state of the art, description of the invention and the problem that it claims to resolve).
- One or more claims (art. 69 and art. 84 EPC and rule 43 EPC) (they determine the European patent's extent of protection).
- Any drawings referred to in the description or claims (the description and drawings are used for interpreting the claims).
- An abstract (art. 85 EPC, rule 47 EPC) (of about 150 words that can be used as a search tool for other patent applications).

3. Patents: documentation

CLAIMS:

- **The terms of the claims are vital:** a patent is a contract between the inventor/applicant and the State; the claims can be considered the clauses of that contract.
- **Art. 69 EPC:** *«The extent of the protection conferred by a European patent or a European patent application shall be determined by the claims. Nevertheless, the description and drawings shall be used to interpret the claims».*
- **Therefore:**
 - Poor claims imply poor protection.
 - A good patent professional is recommended!

3. Patents: documentation

CLAIMS:

- **Art. 84 EPC:** *«The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description».*
- Clarity is one of the main sources of problems if claims are not written carefully before filing the patent application. **Why?:**
 1. Because third parties must be capable of understanding what is protected by the patent.
 2. If claims are not clear, it may be impossible to compare the claimed invention with the state of the art (and then it is not possible to check whether the claimed invention is new and involves an inventive step).
 3. It may be difficult, and sometimes even impossible, to translate a claim that is not clear.

Key figures in the patent application procedure

- **Patent examiner.**
- **Applicant**
- **Representative:**
 - An authorised agent registered on a list held by the EPO (article 134.1 EPC).
 - A lawyer authorised to act as a patent agent (article 134.8 EPC).

In what ways can patents be used as a commercial tool?

- For marketing and exploiting the invention.
- For blocking other patents.
- For granting and exchanging licences (*“cross-licensing”*).
- Online databases:
 - These are valuable commercial tools and are usually open access.

Reference list

- EU Directive 2015/2436 of the European Parliament and of the Council of 16 December 2015.
- Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015.
- Spanish Trade Mark Law 17/2001, of 7 December.
- Spanish Law 20/2003, of 7 July, on the Legal Protection of Industrial Design.
- Spanish Patent Law 24/2015, of 24 July.
- Munich Convention on the Grant of European Patents, of 5 October 1973 (consolidated version following entry into force of the Revision Act of 29 November 2000).
- Implementing Regulation of the European Patent Convention. Official Spanish Gazette of 13 February 2017.
- [Wipo Statistics Database](#).
- [Spanish Patent and Trademark Office](#).