

Informative Note

The Spanish Patent and Trademark Office (SPTO) specifies the procedures it will follow during the state of alert

25th March 2020

Regarding the SPTO Decision dated 25th March 2020 related to COVID-19

As defined in the Third Additional Provision of Royal Decree 463/2020 of 14 March, declaring the state of alert for the management of the health crisis situation caused by COVID-19, the administrative procedures managed by the Spanish Patent and Trademark Office (SPTO) were suspended by the Resolution of 16th March 2020.

However, this suspension of terms and the interruption of administrative deadlines does not imply an automatic suspension of all procedures.

Consequently, in order to avoid damage to interested parties and to speed up the processing of procedures that are under way or that are initiated during this period as much as possible, the SPTO will continue with all procedures, which, due to their bilateral nature between the SPTO and a single interested party, do not affect the rights or legitimate interests of third parties, (i) that do not require prior action by the interested parties, or (ii) those in which the interested parties express their agreement that the period should not be suspended and that administrative action may continue.

The agreement of the interested party, as an essential element for exempting these procedural steps from the general mandate of suspending terms and interrupting deadlines, will be understood to have been granted when, after the notifications or communications issued by the SPTO, the interested parties present the response or carry out the corresponding procedure, either within the legal period allowed for this purpose or at a later date.

The procedures that the SPTO will continue to process, provided that the interested party gives its consent, are as follows:

In relation to distinctive features

- Response to the agreement to suspend the form of trademarks and trade names (article 13 of the Implementing Regulations of the Trademark Law).
- Response to the agreement to suspend the form of trademarks and trade names in which no objections or observations from third parties have been made (art. 20.2 Regulations for the Execution of the Trademark Law).



- Response to the provisional refusal of protection of international registrations in which there has been no transfer of oppositions or observations by third parties (art. 20.2 Regulations for the Execution of the Trademark Law).
- Response to the agreement to suspend renewals (art. 28.1 Regulations for the Execution of the Trademark Law).
- Response to the agreement to suspend assignments (art. 34.4, Regulations for the Execution of the Trademark Law).
- Response to the agreement to suspend licenses (art. 34.4, Regulations for the Execution of the Trademark Law).
- Response to the agreement to suspend changes of name (art. 34.4, Regulations for the Execution of the Trademark Law).
- Response to the agreement to suspend waivers (art. 36.3 Regulations for the Execution of the Trademark Law).
- Response to the notification of defects in the presentation of any of the previous documents (art. 68.1 of Law 39/2015, of 1 October, on the Common Administrative Procedure of Public Administrations).

In relation to industrial designs

- Response to the suspension for irregularities observed in the examination of admissibility and form (Article 11 of the Regulations for the Implementation of the Law on the Legal Protection of Industrial Designs)
- Response to the suspension for defects observed in the officio examination (Article 15.1 of the Regulations for the Execution of the Law on the Legal Protection of Industrial Design).
- Correction of irregularities, in the formal requirements for publication of the design, before the end of the deferment of publication (Article 21.4 of the Regulations for the Execution of the Law on Legal Protection of the Industrial Design).
- Response to the correction of defects in the notice of opposition (Article 26.2 and 3 of the Regulations for the Execution of the Law on Legal Protection of Industrial Design).
- Response by the owner of the registration to the oppositions filed (Article 27.1 of the Regulations for the Execution of the Law on the Legal Protection of Industrial Design).
- Application for renewal of the registration of the design (Article 44.3 of the Law on Legal Protection of Industrial Design)
- Application for renewal of the registration of the design with surcharges of the fee (Article 44.3 of the Law on Legal Protection of the Industrial Design).
- Response to defects in the application for renewal (Article 34.2 of the Regulations for the Implementation of the Law on the Legal Protection of Industrial Designs).
- Response to the suspension of transfers, name changes and licenses (Article 41.3 of the Regulations for the Execution of the Law on the Legal Protection of Industrial Design).
- Reply to the suspension of waivers, corrections, proxies, changes of address and any other request made (Article 44.2 and 3 of the Regulations on the Execution of the Law on the Legal Protection of Industrial Designs).
- Submission of the restoration of rights (Article 39 of the Law on Legal Protection of Industrial Design).

- Response to the suspension of the restoration of rights (Article 49.2 of the Regulations on the Execution of the Law on Legal Protection of Industrial Designs).
- Application for a design claiming a priority right (Articles 24 and 25 of the Law on Legal Protection of Industrial Designs).

With regard to inventions

A. Invention patents

- Response to defects in the admission for processing or in the national phase. (sections 20.2, 21 and 101.4 of the Regulations for the Execution of the Patent Law).
- Response to the suspension for defects in ex officio examination (art. 24 of the Regulations for the Execution of the Patent Law).
- Response to the intention to refuse the correction or addition of priority. priority (Article 14.5 of the Regulations for the Execution of the Patent Law).
- Response to the defect of lack of clarity or coherence or due to defects in the case of irregularities in multiple independent claims (Articles 27.1 and 28.1 of the Regulations for the Execution of the Patent Law).
- Response to the objection of lack of unity of invention (art. 29.1 of the Regulations for the Execution of the Law on Patents).
- Request and payment of the substantive examination and/or reply to the objections to the written opinion (art. 33.1 of the Regulations for the Execution of the Patent Law).
- Response to the various communications during the substantive examination (Article 34.6 of the Regulations for the Execution of the Patent Act).
- Opposition to the granting of the patent (Article 43.1 of the Patent Act).
- Response to irregularities in the opposition (Article 36.5 of the Regulations for the Execution of the Patent Law).
- Response to the notice of opposition (Article 38.1 of the Regulations implementing the Patent Act).
- Response to the reply of the owner of the patent (Article 38.2 of the Regulations for the Execution of the Law on Patents).
- Response to new allegations made by the owner during the opposition (Article 39.4 of the Regulations for the Execution of the Patent Act).

B. Certificados complementarios de protección

- Response to defects in the examination of formalities (art. 55.1 of the Regulations for the Execution of the Patent Law).
- Response to defects detected in the examination of the application (art. 56.1 of the Regulations for the Execution of the Patent Law).

C. Utility models

- Response to defects in the application process (art. 59.1 of the Regulations for the Execution of the Patent Law).

- Response to the suspension for defects in ex officio examination (art. 59.2 of the Regulations for the Execution of the Patent Law).
- Response to the intention to refuse the correction or addition of priority (art. 14.5 of the Regulations for the Execution of the Patent Law).
- Response to irregularities in the notice of opposition (Article 61.4 of the Regulations for the Execution of the Patent Law).
- Response to the notice of opposition (Article 61(6) of the Implementing Regulations to the Patent Act)
- Response to the report on the provisional state of the art (supplementary application of Article 68.1 of Law 39/2015, of 1 October, on the Common Administrative Procedure of Public Administrations).

D. Common procedures of Law 24/2015 of 24 July on Patents

D.1) General

- Request and formalisation of a divisional application (Article 44 of the Regulations on the Execution of the Patent Act).
- Payment of the fee for the report on the state of the art or to complete the payment in divisional applications after a request from the Office (Article 45.4 of the Regulations on the Execution of the Patent Act).
- Request for change of type (Article 46.1 of the Patent Act Execution Regulations).
- Payment of the fee for the change of type or completion of the payment after a request from the Office (Article 46.3 of the Regulations on the Execution of the Patent Act).
- Provision of the documentation corresponding to the new type (art. 46.3 of the Regulations for the Execution of the Patent Law).
- Correction of defects in the case of a request for authorisation of first deposit abroad (art. 68.1 of Law 39/2015, of 1 October, on the Common Administrative Procedure of Public Administrations).

D.2) Restoration of rights

- Filing of restoration of rights (Article 53 of the Patent Act).
- Response to the suspension or intention to reject a reinstatement of rights (art. 71.3 and 5 of the Regulations for the Execution of the Patent Act).

D.3) Request for limitation or revocation

- Response to defects in the limitation or revocation of the patent or utility model (Article 42.1 of the Regulations for the Execution of the Law on Patents)

D.4) Transfers, name changes and licenses (contractual or full)

- Response to the suspension (art. 82.2 and 83.3 of the Regulations for the Execution of the Patent Law).
- Response to defects in the withdrawal of the offer of a full license (art. 84.2 of the Regulations for the Execution of the Patent Law).

D.5) Priority claim

- Application claiming the right of priority (Section 30 of the Patent Act)

D.6) Others

- Payment of annuities, including reductions of annuities after withdrawal of the offer of fully fledged licences, or maintenance fees (Section 184 of the Patent Act)
- Reply to the suspension of waivers, corrections, proxies, changes of address and any other request made (section 66 and following of the Patent Act Enforcement Regulations).

E. In relation to European patents

- Application for definitive protection of a European patent in Spain (art. 155.2 of the Patent Act).
- Response to defects in the petition for definitive or provisional protection (art. 94.4 and 95.4 of the Regulations for the Execution of the Patent Law).
- Response to the requirement to provide a Spanish translation of a European patent application (art. 93.2 of the Regulations for the Execution of the Patent Act).

F. In relation to PCT international applications

- Response to an invitation to correct irregularities in a PCT international application (Rules 20 and 26 of the PCT Regulations)
- Response to any other communication made on a PCT form (the one indicated on the form itself issued by the SPTO as a receiving Office).

In relation to administrative appeals

- Lodging of appeals (Article 122 of Law 39/2015 of 1 October on the Common Administrative Procedure of Public Administrations)
- Response to the hearing of appeals (Article 118 of Law 39/2015, of 1 October, on the Common Administrative Procedure of Public Administrations).
- Response to the procedure for rectifying defects in any of the above documents (article 68.1 of Law 39/2015, of 1 October, on the Common Administrative Procedure of Public Administrations).

Similarly, the SPTO reports that the technological information services provided by the Office, both those subject to public rates and those free of charge, will continue to be provided normally and may be requested by users who require them.

We hope that the information is useful and of interest to you. At Andersen Tax & Legal we have created a multidisciplinary team to attend to all the questions that may arise on this aspect or in relation to the COVID-19 and all the professionals of the firm are at your disposal.

For more information please contact:

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