

Spain



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1. What are the most effective ways for a European patent holder whose rights cover your jurisdiction to enforce its rights in your jurisdiction?

In Spain, European patent holders may bring civil court actions against potential infringers through the relevant legal proceedings. In exceptional circumstances, if a crime has been committed a criminal action may be brought. The administrative courts cannot revoke a patent, since the civil courts have jurisdiction for all proceedings related to patents. The Spanish courts also have exclusive jurisdiction to hear cases related to the validity of patent rights granted for Spain. An action may be brought either in the court with jurisdiction in the territory where the defendant is resident or in the competent court in the territory where the infringement was committed.

2. What level of expertise can a patent owner expect from the courts of your jurisdiction?

Specific courts (*tribunals mercantiles* or commercial courts) specialise in commercial cases, including IP rights and unfair competition. Most of these cases are heard in Barcelona and Madrid, where there are 10 and 12 commercial courts, respectively. The appeal courts of these cities also have specialised sections.

Since January 2012 all patent cases in Barcelona are handled by Commercial Courts Nos 1, 4 or 5. Under an agreement of the Spanish Council of Judicial Power (November 23 2011) these three courts were designated specialists in patent cases. At present, no other

commercial courts have such specialisation.

There is no body of judicial technical experts; nor are judges technical specialists or supported by judicial technical specialists. It is normal practice for the judge to agree to a party's petition for the appointment of an independent expert in order to issue an opinion on the technical aspects involved in the case.

3. How do your country's courts deal with validity and infringement? Are they handled together or separately?

The commercial courts have jurisdiction to hear cases on both infringement and nullity. A common defence in infringement cases is the invalidity of the patent. This is often useful to show where the invention stands in the state of the art, while also presenting the technical contribution that it has made in order to defend the infringement. Invalidity may be alleged either as an objection in order to petition for the claim to be dismissed or by bringing a counterclaim. If this is accepted by the court, the Spanish part of the patent will be declared null and void and the patent's registration at the Spanish Patent and Trademark Office will be cancelled, with the resulting effects for third parties.

4. To what extent is cross-examination of witnesses permitted during proceedings?

Spanish procedural law allows witnesses, the parties or court-appointed experts to be cross-examined at the request of the parties where deemed appropriate. During the hearing, the parties, witnesses and experts are cross-examined and questioned. The judge may intervene when he or she considers it necessary. If the judge is not familiar with

patent issues, he or she will be receptive to explanations beyond the specific technical issues from the experts.

5. What role can and do expert witnesses play in proceedings?

The expert's duty is to act as an expert on the matter concerned. However, this does not mean that he or she must adopt a decision on the legal issues raised, since this duty rests solely with the court. The expert's duty is merely to inform the court and the parties in regard to the technical elements of which they may be unaware; the conclusions reached by the expert are not determining factors, but merely his or her explanations.

6. Is pre-trial discovery permitted? If so, to what extent?

In Spain, there is a specific court examination procedure to determine whether infringement could have been committed – *diligencias de comprobación de hechos*. The procedure is carried out at the premises of the allegedly infringing party to ascertain whether the latter has infringed a patent right or is about to do so. If so, the necessary documents are drawn up and a copy is provided to the petitioner so that it can bring the appropriate patent infringement claim.

Another way to obtain evidence related to the case is through preliminary proceedings specifically designed for IP cases. Provided that there is enough evidence of the infringement, the court may be petitioned to allow the infringing party to be cross-examined before bringing an infringement case regarding its suppliers, customers and distribution channels, as well as the product quantities, sales and the reference of the product in the market. A petition may also be made for commercial, customs, accounting and financial documents to be provided in order to prepare the case.

7. Do the courts in your jurisdiction apply a doctrine of equivalents?

The doctrine of equivalents is now beginning to be routinely accepted by specialised Spanish courts. Some judgments have also taken into account the patent's registration background in order to determine the specific scope of

a particular patent right. Specifically, the Madrid and Barcelona appeal courts apply the protocol set out in Article 69 of the European Patent Convention, particularly Article 69(2), which state that claims must be interpreted according to the description and that the description cannot substitute the claims and effects of certain assertions and limitations made during the prosecution background.

In recent years the doctrine of equivalents has begun to replace the traditional approach adopted by the Supreme Court, which is based on the essential nature of a patent's elements. This has given rise to the possibility of disregarding the elements of the claim considered secondary by the (generally court-appointed) expert.

8. Are certain patent rights (eg, those relating to business methods, software and biotechnology) more difficult to enforce than others?

There are no previous cases in Spain from which statistics can be obtained. Although the Spanish courts have not yet ruled on certain issues that are currently 'hot topics' in some European countries and the United States, a recent Madrid Appeal Court judgment held that a computer program was an invention subject to protection when, according to European Patent Office case law, the European patent could be considered not to refer to a computer program "as such".

9. How far are courts bound by previous decisions in cases that have covered similar issues?

Both Section 28 of the Madrid Provincial Court and Section 15 of the Barcelona Provincial Court sometimes resort to their own precedents when they issue judgments. Under the Civil Procedures Act, not all patent cases can be appealed to the Supreme Court; thus, there is little case law and what exists is quite old.

10. Are there any restrictions on who parties can select to represent them in a dispute?

There are no restrictions. However, in Spain a party must be represented by legal counsel, who is responsible for the client's legal defence, and a court liaison, who is the client's representative in the legal proceedings and is responsible for

providing all judicial notifications between the court and the legal counsel.

11. Are the courts willing to consider the reasoning of courts in other jurisdictions that have dealt with similar cases?

The Spanish courts and parties in litigation increasingly refer to judgments laid down by other European courts concerning the infringement or invalidity of the same patent. Such background tends to be accepted as a relevant exhibit by the courts. However, the parties must prove to the Spanish court that the facts put before it are the same as those on which the foreign court based its decision. In some recent cases the Barcelona Appeal Court has decided not to follow decisions adopted in other EU countries.

12. How easy is it for defendants to delay proceedings and how can plaintiffs prevent them from doing so?

The time limits within which documents must be filed in Spain cannot be extended; Spanish procedural law is very strict in this regard. A hearing can be adjourned in certain situations stated in the law, where this can be sufficiently justified. Groundless delays may be considered as claims filed in abuse of the law or breaches of procedural good faith, and the courts can impose fines in such cases.

13. Is it possible to obtain preliminary injunctions? If so, under what circumstances?

Preliminary injunctions may be requested for urgent reasons. There must be *prima facie* justification that an infringement has been committed in a plausible manner and that there will be costly consequences for the plaintiff if an injunction is not ordered. The rights holder must also prove that it uses the patent or that serious and effective preparations are being made for such use. The parties are usually summoned to a hearing, although such an injunction may be granted *ex parte*. In view of the arguments put forward by the parties, the judge will decide whether the injunction should be granted.

14. How much should a litigant plan to pay to take a case through to a decision at first instance?

Although the cost of court proceedings depends on the complexity of the case, on average a decision costs between €50,000 and €150,000.

15. Is it possible for the successful party in a case to obtain costs from the losing party?

The court can order the losing party to pay the legal costs. In such cases, the lawyers' fees are calculated according to the official rates and added to the expenses incurred to translate documents or obtain expert opinions, and any other costs that the successful party can demonstrate that it incurred.

16. What are the typical remedies granted to a successful plaintiff by the courts?

Legal actions may be brought to stop the infringement, seize or destroy the infringing products or machinery and moulds exclusively used for such purpose, and prohibit the infringing actions from being recommenced. In addition, compensation may be imposed for damages and loss.

In addition, in Spain, as in other European countries, a claim may be brought against actions that have contributed to the infringement, provided that those who contributed to the infringement were aware that the elements provided to the infringing party were to be used to manufacture the infringing products.

17. How are damages awards calculated? Is it possible to obtain punitive damages?

Damages are determined according to the economic criteria established by the EU directives by calculating the negative economic consequences, which should take into account the profits obtained by the defendant as a result of the infringement as well as the plaintiff's loss of profits, or the cost of a possible licence to use the patent. Compensation can also be given for the harm caused to the prestige of the invention, if this can be proven, as well as compensation for moral damages.

18. How common is it for courts to grant permanent injunctions to successful plaintiffs and under what circumstances will they do this?

Permanent injunctions can be granted after a

full trial on the merits of a patent infringement action. The plaintiff bears the burden of proof; if the court considers the facts of the claim to be doubtful at the end of the proceedings, it must reject the action. Permanent injunctions related to the exploitation of the patent are bound to the validity or the expiry date of the exclusive right, so if the patent is declared invalid or the registration lapses, the injunctions related to exploitation of the product will become ineffective.

19. How long does it take to obtain a decision at first instance and is it possible to expedite this process?

Depending on the courts involved and their workload, first instance proceedings usually take between six and 12 months in Barcelona and between 20 and 30 months in Madrid. The main circumstances that may delay a case are bringing a claim against a party which is resident abroad, needing to provide technical expert evidence, the complexity of certain evidence (eg, carrying out trials, analyses and reproductions or plant inspections in Spain or abroad) and the number of experts or witnesses and their nationality.

20. Under what circumstances will the losing party in a first instance case be granted the right to appeal? How long does an appeal typically take?

An appeal before the second instance court is common in patent cases and there are no special requirements. The losing party must merely submit the grounds for its appeal within 20 days after notification of the judgment. The appeal court will review the judgment and rule on the assessment of the facts by the first instance court, and whether its judgment was in accordance with the law. The appeal ruling may take one to two years to be laid down (12 to 16 months in appeals against judgments ruled on interim injunctions), depending on the court hearing the appeal and its workload and whether the court decides, exceptionally, to allow evidence that was denied by the first instance court.

21. Are parties obliged to undertake any type of mediation/arbitration prior to bringing a case before the courts? Is

alternative dispute resolution a realistic alternative to litigation?

There is no obligation to undertake mediation or arbitration before bringing a case before the courts. Alternative dispute resolution may occur in infringement or technology transfer agreement cases if the parties agree to go to arbitration or mediation. Arbitration clauses are commonly included in technology transfer agreements.

22. In broad terms, how pro-patentee are the courts in your jurisdiction?

Some judges known to be pro-patentee have recently been hired by law firms as lawyers. The 1995 establishment by the General Council of Judicial Power of a private foundation, controlled by the main pharmaceutical companies, to train judges in patent matters has resulted in some judges becoming more likely to favour patent holders. Actually, the Supreme Court in the past four years has experienced a swift to pro-patentee approach.

23. Has your jurisdiction signed up to the London Agreement on Translations? If not, how likely is it to do so?

Spain has not yet signed up to the London Agreement of Translations and is not expected to do so in the near future.

24. Are there any other issues relating to the enforcement system in your country that you would like to raise?

In a widely discussed 2012 decision, the Supreme Court accepted the extension of protection of a European patent by means of revising the translation of the Spanish validation which accepted the inclusion of claims granted not for Spain but for other countries designated by the applicant. In addition, in a heavily criticised 2012 decision the Supreme Court established that a patentee could claim damages not from the date of publication in the Spanish *IP Bulletin* but from the date of publication in the European *Patent Bulletin*. *iam*

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