

PATENT PROTECTION FOR CHEMICAL AND PHARMACEUTICAL PRODUCTS IN SPAIN

There has recently been some speculation that it may be possible to add claims to the Spanish parts of European patents to cover chemical or pharmaceutical products.

Background

Pharmaceutical and chemical products were not patentable in Spain prior to 7 October 1992. Consequently, the Spanish parts of many European patents involving chemical and pharmaceutical products that were filed before 7 October 1992 contain only process claims.

A proposed amendment to Spanish law, based on the TRIPS agreement, attempted to allow patent protection for product claims in chemical and pharmaceutical cases filed prior to 7 October 1992. Although the amendment was later withdrawn, it has given rise to speculation that extension of the Spanish parts of European patents to include these products might be possible under the TRIPS agreement. This idea has been reinforced by a first instance decision of a court in Madrid, particularly for patents filed before 7 October 1992 and granted after 1 January 1996 (i.e., the date when TRIPS came into force in Spain).

EPC's advice

There remains a considerable degree of uncertainty about whether adding product claims to the Spanish parts of European patents would be legally effective. However, the cost of adding claims is not large.

In view of the moderate costs involved, we recommend that consideration is given to amending the Spanish parts of European patents by adding claims to chemical and pharmaceutical products, particularly where there is any reasonable likelihood of wishing to assert the patent against a third party in Spain. Of course, this only applies to those patents having a filing date prior to 7 October 1992.

Please contact Ian Stevens for further information.

The information in this Newsletter was correct at the date of release. More up to date information is available by contacting Eric Potter Clarkson LLP. All comments contained here are of a general nature and full professional advice should be sought on any specific problem.

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