

### REPORT ON IP-RELATED MATTERS IN SPAIN

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#### PARTIAL REVOCATION OF A CLAIM IS NOT POSSIBLE

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#### A recent case: “*improved roller skate*”

A judgement on 8 October 2004, laid down by the Provincial High Court of Barcelona, confirmed that partial revocation is not possible under Spanish patent law.

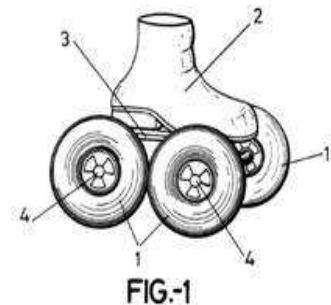
The utility model affected by the decision claimed the following invention: “*An improved roller skate, which is of the kind used to slide along the ground, and may be of the “classic” sort or the “in-line” type, and may be jointly or independently connected to a boot, which is characterised by its wheels being pneumatic and of considerable size, in terms of both diameter and thickness. This makes it possible for them to elastically deform, which allows them to be used on any kind of surface, including earth, as well as to descend slopes and mountain sides*”.

The court of first instance decided to partially revoke that claim since it considered that the invention could only cover classic roller skates with pneumatic wheels. So the court declared the part of the claim referring to the inclusion of pneumatic wheels in “*in-line skates*”

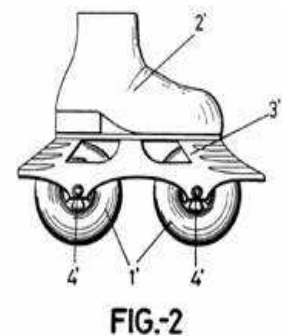
invalid, since that use was already known in the prior art.

The roller skates claimed in the patent are shown in the figures below:

“*Classic skate*”:



“*In-line skate*”:



The invention was granted as a utility model (the main difference to patents is that novelty is restricted to national disclosure). The ground for revocation in this case was solely the alleged lack of novelty.

Barcelona appeal court reversed the judgement laid down in the first instance

since it considered that the application of pneumatic wheels to both kinds of skates had already been disclosed in the prior art. In a previous legal ground, the decision also rejected the possibility of partial revocation of a claim based on article 112(2)(3) of the Spanish Patent Act.

### **Partial revocation is not allowed by the Spanish Patent Act**

Article 112(2)(3) of the Spanish Patent Act states: “2. If the reasons for revocation only affect part of the patent, it shall be declared partially revoked by means of the claim or claims affected by them being revoked. A claim may not be declared partially revoked. 3. When it is partially invalid, the patent shall remain in force concerning the claims that were not revoked, provided there is the subject matter for an independent patent.” This is directly connected to the principle that each of a patent’s claims may cover just one invention. A claim may be revoked without affecting the other claims, provided the other claims are patentable, but it cannot be partly revoked.

In line with this argument, the decision stated that in any case “*each claim defines the subject matter for which protection is requested and granted (articles 26 and 60.1 of the Spanish Patent Act), so a patent seeks to protect as many inventions as it has claims, and it is not possible, by legal mandate, to*

*partially revoke a claim (article 112.2 of the Spanish Patent Act)”. The court remarked that “Article 112.2 of the Patent Act allows partial revocation of a patent due to the reasons for revocation affecting one or several claims, allowing the rest of them to stand, provided there is the subject matter for an independent patent. In other words, if the rest of the claims may be taken as a new invention, an inventive step is involved and it has an industrial application. That does not mean breaking the principle of the unity of the invention, according to which a patent cannot protect more than one single invention or group of inventions related to one another that include a single general inventive concept (article 24 of the Spanish Patent Act), which allows the divisibility of the subject matter and partial revocation insofar as the claims unaffected by the revocation may stand alone as a patent, if they meet the legal requirements”.*

### **The EPC 2000 and the possibility of court approval of claim limitation**

The impossibility of modifying claims may change in the future for EP patents, once the modification brought in by new article 138(3) of the EPC comes into force.

The modification of the European Patent Convention, as adopted by the decision of the administrative council on 28 June 2001 (2003 Special Edition

no. 1 OJ EPO), introduces a new paragraph to article 138 EPC, which will allow patentees to amend the claims of European patents in proceedings concerning their validity. So, as stated in article 138(3) “*In proceedings before the competent court or authority relating to the validity of the European patent, the proprietor of the patent shall have the right to limit the patent by amending the claims. The patent as thus limited shall form the basis for the proceedings*”.

This new regulation will change the current framework for revoking patents as regards the possibility of partially revoking a claim. In any case, the new regulation only entitles the patentee to amend patent claims in court in such a manner that the new wording limits the contents of the claim.

Article 138.3 will not enable the court to decide whether a certain claim is partially invalid (or valid), change a patent’s claims or declare a claim partially invalid, but will merely permit a particular claim to be amended by the patentee. In that case, the right to amend a claim and the proposed new wording will have to be expressly invoked and proposed by the patentee in the lawsuit.

How the amending right will be recognised in Spanish civil procedural law and how it will be interpreted by the Spanish courts remains to be seen.

## COMPANY NAME VERSUS PRIOR DISTINCTIVE SIGN

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The Spanish Supreme Court, in its judgement on 14 July 2004, dealt with the dispute between a company name, “ROSCOLINA, S.L.”, recorded in the companies’ registry in 1990, and a prior trade mark, “ROSCOLINES”, which has been in force since 1989. The holder of the trade mark initiated court proceedings for infringement of trade mark rights on 3 March 1996 and requested that *“the company be ordered to change its company name and take the labelled vehicles off the road, [...]”*.

This judgement stands out not just for the arguments that led the Supreme Court to reject the appeal for annulment brought by the company “ROSCOLINA S.L.”, but also for the interesting legal arguments put forward by the defendant company that had brought the appeal for annulment.

“ROSCOLINA S.L.” claimed that the statute of limitations for action under article 39 of the Spanish Trade Mark Act had elapsed, in view of the presumption of legality in article 2 of the Companies Registry Regulations concerning the contents of the companies registry’s books, since what they contain is known to everyone and no-one can claim ignorance of it. On the other hand, documents subject to registration according to paragraph two of such

precept, which have not been registered, have no effect on third parties.

Article 39 of the Trade Mark Act stipulates that *“Civil legal action resulting from trade mark rights has a statute of limitations of five years from the day on which it may be exercised.”* Therefore, taking into account the principle of public announcement and effectiveness regarding third parties laid down in the Companies Registry Regulations, the appellant argued that the statute of limitations for the action had expired, since it could have been brought, considering publication in the companies registry, since 1990, and more than 5 years had elapsed by the time the action had been brought in 1996.

The Supreme Court rejected the appellant’s arguments and laid down that the start date for calculating the period of a statute of limitations for legal action did not start on the day on which a company was registered in the companies registry *“[...] but rather on the date it began commercial business,[...], since in a dispute between the registration of a name or company or trade name and a trade mark, one must take into account, as far as the latter is concerned, the date on which the former started to be used and was known in*

*commercial business, which was when competition first took place, so the provincial high court’s view must be upheld and the ground for appeal rejected, as must the second, which is based on the same principle.”*

The court’s view is therefore that the time when there is a conflict in commercial trade between the company name and the previously registered distinctive sign is when the term of the statute of limitations must start to be counted. This line of argument could lead us to reflect on the problem underlying the ongoing conflict between distinctive signs and later company names.

If what one wishes is to prevent competition between company names and distinctive signs, then the use of company names as trade names should be avoided, since in principle the purpose of the two signs is very different and if they are used properly, there should be no conflict between them.

The legal framework for company names, even when there is a similarity between them and registered trade marks, is no obstacle to coexistence in principle, since the purpose of a company name is not to distinguish a business in the market, but to identify who is responsible for it.

## **STUDY ON THE PATENTABILITY REQUIREMENTS, SCOPE AND INFRINGEMENT OF PATENTS**

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This April, the publishing house Editorial J.M. Bosch published “*Estudio sobre los requisitos de patentabilidad, el alcance y la violación del derecho de patente*” [“Study on the patentability requirements, scope and infringement of patents”], 282 pages, by Miguel Vidal-Quadras Trias de Bes, a member of the Amat i Vidal-Quadras firm. It is a rigorous, exhaustive study of aspects at the very heart of patents: the requirements for them to be recognised, the interpretation of their scope and infringement of them. Due to the ambivalence of the work in a legal institution in which technical aspects play a fundamental role, the book includes a prologue by the Head of the

Patent Centre of Barcelona University, one of the most renowned experts in patent matters, Pascual Segura Cámara, and the Professor of Commercial Law from the same university, Antoni Font Ribas.



In this book readers will find one of the most profound analyses of the subject carried out in Spain. The

study also contains a wealth of up-to-date quotes, translated into Spanish, about the doctrine and case law from the main countries for the subject: including the United States, the United Kingdom, Germany and Italy. The increasingly international scope of industrial property rights requires those who work in this area to know what is going on in other countries. Especially when one considers that the law analysed brings legal aspects developed in other countries and by the European Patent Office into Spanish national regulations.

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