



INFORMATION ABOUT THE RE-ESTABLISHMENT OF RIGHTS

I.- Definition and applicability.

The re-establishment of rights or “*restitutio in integrum*” is regulated in Spain in article 25 of Law 17/2001, on Trademarks, article 39 of Law 20/2003 on Industrial Design Legal Protection and article 53 of Law 24/2015 on Patents. All these articles provide that *“An applicant for or holder of a patent/design/trademark or any other party to a procedure who, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit for any of the procedures provided for in this Law shall have his rights re-established upon request if the non-observance of this time limit has led directly, by virtue of the provisions of this Law or its regulations, to the loss of a right.”*

Article 25 of the Spanish Law 17/2001, on Trademarks applies to patents by express referral to the additional provision number 7 of the above mentioned law, in everything which is not incompatible with the nature of patents and with the exception of certain time limits within the national patent granting procedure provided in article 53 of Law 24/2015 on Patents (i.e. to the time limits referred to in paragraph 2 of article 53 and in articles 43.1 and 144 of the Law 24/2015 on Patents. Nor shall they apply to the time limit for lodging an administrative appeal against an act declaring rights).

Accordingly in the case of designs, article 39 of the Spanish Law 20/2003 on Industrial Design Legal Protection provides that the provisions of such article will not be applicable to the deadlines contemplated in section 2 of such article, to those for claiming priority provided for in sections 1 and 2 of article 24 and 1 of article 25, and to the deadline for oppositions to the concession established in section 1 of article 33. Nor shall they apply to the time limit for lodging an administrative appeal against an act declaring rights.

II.- Formal requirements.

The **requirements** to admit the request for the re-establishment of rights are as follows:

1. The omitted time limit must be fulfilled when the re-establishment of rights is requested.
2. The request shall be submitted in writing by the end of whichever of the following periods expires first:
 3. i) two months from removal of the cause of non-observance;
 4. ii) twelve months from the date of expiry of the omitted procedure or, where a request relates to non-payment of a maintenance fee, twelve months from the date of expiry of the six-month payment-with-surcharge period referred to in Article 185.
- 5.
6. The omitted procedure must be carried out within that time limit. Nonetheless, in the event that the re-establishment of rights is requested for the period provided for in Article 30, the request must be submitted within two months of its expiry or before



the technical preparations for the publication of the subsequent application are concluded, whichever takes place sooner

7. The request must be supported by reasons, with an indication of the events or facts and justifications adduced in support thereof. The request shall not be considered to have been filed until the fee for the re-establishment of rights has been paid.
8. The body competent to decide on the request shall be the body competent to decide on the omitted act.
9. A holder of an application or registration whose rights have been re-established may not invoke said rights against a third party who, in good faith, in the period between the loss of the right and the publication of its re-establishment has started to work the invention constituting the subject matter of the application or of the patent, or has made serious and effective preparations to do so, provided that the third party confines himself to commencing or continuing said exploitation in his company or for the needs of his company.
10. If the Office refuses the re-establishment of rights, an administrative appeal may be lodged within one month after the publication of the final decision of the Office in the Industrial Property Gazette.
11. The decision on the re-establishment of rights shall be entered in the Patent Register and published in the Official Industrial Property Gazette.
12. Payment of the fee for the re-establishment of rights: The request shall not be deemed to be filed until the fee for re-establishment of rights has been paid.

III.- Definition of “due care”.

The due care is an indeterminate legal concept to be considered in a case by case basis. Therefore, it is not possible to formulate generic rules. The OEPM interprets that legal concept under the light of Article 1104 of the Spanish Civil Code and taking into account the decisions of the Board of Appeals of the European Patent Office.

Under that Article, the concept of “due care” should be understood, in the matter of observing obligations, in the sense of “*the indispensable diligence of a good family man*”. On the other hand, the case law of the Board of Appeals of the European Patent Office has indicated multiple criteria about the due care that can be used in the decision following a joint criterion of interpretation.

INFORMATION ABOUT EXTENSION OF DEADLINES

I.- Definition and applicability.



Article 69 of the Royal Decree 316/2017, of March 31, which approves the Regulation for the execution of Law 24/2015, of July 24, on Patents provides the **possibility to extend the deadlines established in Law 24/2015 on Patents** and in such regulation for a period of **two months** with the **exception** of deadlines that affect interested third parties, and in particular those expressly provided in section 3 of such article:

- a) The extension of a deadline already extended.
- b) The deadline to request the extension or to request the restoration of rights.
- c) The term to pay the annual maintenance fees.
- d) The period to claim priority, as well as the period for correction, addition or reestablishment of the right of priority.
- e) The deadline to file an opposition and to file an administrative appeal.
- f) The deadline to respond to a communication from the Spanish Patent and Trademark Office within a contradictory procedure

II.- Formal requirements.

The **requirements** to admit the request for an extension of a deadline and the procedure are the following:

- 13. The extension of a period must be requested in writing **before the expiration of the period** for which the extension is requested and the Spanish Patent and Trademark Office must decide on the same within said period.
- 14. The Spanish Patent and Trademark Office will examine whether the extension request is admissible and will decide whether to grant or deny it, indicating the reasons.
- 15. The resolution will be communicated to the applicant and a notice of the resolution will be published in the "Official Industrial Property Gazette."

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