



COMMENTS FROM SPAIN IN REPLY TO CIRCULAR C. 8343 FROM THE SECRETARIAT OF WIPO'S STANDING COMMITTEE ON THE LAW OF PATENTS (SCP)

EXCEPTIONS AND LIMITATIONS TO PATENT RIGHTS.

In Circular C. 8343 Member States are requested to submit information on the application of the following five exceptions:

- i) Acts for obtaining regulatory approval from authorities;
- ii) Exhaustion of patent rights;
- iii) Compulsory licensing and/or government use; and
- iv) Farmers' and/or breeders' use of patented inventions.

Acts for obtaining regulatory approval from authorities

We simply wish to clarify in this regard that the comments of Spain in response to Circular C. 8261 provided additional information regarding "experimental use and/or scientific research". Nonetheless, that information should be transposed to this exception "Acts for obtaining regulatory approval from authorities".

Accordingly, the information provided in Circular C. 8216 should be transferred to the corresponding point in Circular C. 8343.

Regarding other exceptions, there have been no legal or jurisprudential developments since Spain replied to the Questionnaire on Limitations and exceptions to the rights conferred by patents.

Technology Transfer

In Circular C. 8343 Member States and regional offices are invited to present practical examples and experiences on incentives and barriers that patents pose to technology transfer.

Patents as incentives to technology transfer

In Spain, there are many examples of patents as incentives to technology transfer. The most common and best known case is that in which the research in a university or public research center is protected by patent and on that basis a company is created. This is commonly known as "spin-off".

In these cases, the existence of a patent is a very important incentive for technology transfer from the university or public research center to a company that will try to transform it into a commercial product.



Examples of Spanish companies that emerged from patents generated in university or public research centers and were transferred to technology-based companies, mostly biotech, include the following:

Advancell (http://www.advancell.net/?page_id=243)

Advancell is a Spanish biotechnology company. It emerged as the union of two spin-offs in 2001, one from the University of Barcelona and one from the University of Valencia.

In 2004, it released a portfolio of patents from the University of Santiago which gave rise to the nanoparticles unit and a patent portfolio from the University of Barcelona in relation to the molecule “Acadesina” for the treatment of cancer. It has various drugs in phase I/II for the treatment of various forms of cancer.

Fractus (<http://www.fractus.com/index.php/fractus/corporate/>)

Fractus is specialized in the generation of technology related to antennas optimized for wireless devices (phones, tablets, short-range wireless, automotive and infrastructure). It exploits its technology in two ways: by direct licensing of its patents to large technology multinational and by marketing its products through major international distributors. The company was created in 1999 as a spin-off of the Technical University of Catalonia, from a first patent application filed in 1995. Since then, it has become a world leader in the utilization of antennas on small multiband devices.

Venter-pharma (<http://www.venterpharma.com/es/empresa.html>)

This is a pharmaceutical company founded in 2003 from [patents](#) developed by the Autonomous University of Madrid and CSIC (Higher Scientific Research Center – a public research center) on the active ingredient gaxilosa that is used under the trade name Lactest for diagnosing lactose intolerance.

Nanoimmunotech (<http://www.nanoimmunotech.eu/es/>)

This is a biotechnology company founded in 2009 as a spin-off from a series University of Zaragoza patents. It is a leader in the characterization and functionalization of nanoscale systems.

Ingeniatics (<http://www.ingeniatics.com/es/ingeniatics-compania-microencapsulacion-biotecnologia-nebulizadores.html>)

This is a company founded as a spin-off in 2001 by a research group at the University of Seville, based on a patent portfolio held by the university. Currently, Ingeniatics is a leader in micro- and nanoscale technology for handling fluids to yield aerosols, suspensions, emulsions and foams.



Patents as an obstacle to technology transfer

Information has been received about a case in which it is believed that the existence of a patent obtained by a public research center was a barrier to technology transfer. The researchers concluded that it would have been better to keep the research secret, as, although potential buyers of the patent initially showed some interest, they actually intended that the research center should abandon the patent so that it could be exploited freely, and so they did not acquire it for this reason. However, it is considered a very exceptional case.

National/regional laws and practices relating to the confidentiality of communications between patent advisors and their clients

According to information provided by the Spanish Group of AIPPI, the situation in Spain on this issue is as follows:

- Spanish lawyers have the right to the confidentiality of their communications with Spanish and foreign customers.
- Spanish industrial property agents who are not lawyers have a commitment to confidentiality in dealing with their customers but it is not recognized in legal proceedings.
- Foreign industrial property professionals, save for those foreign lawyers authorized to practice before Spanish courts, do not enjoy confidentiality of communications with their clients.