



SCP/34

7. Confidentiality of communications
between clients and their patent advisors



Proposals for the amendment of the Spanish Patent Law

BACKGROUND

Law 24/2015 of 24 July on Patents

Article 176. Industrial Property Agents. (\approx R.153 EPC)

5. Industrial Property Agents shall be obliged to keep the matters in which they are involved confidential and shall be entitled to refuse to disclose communications exchanged with their clients or with third parties relating to the procedures followed before the Spanish Patent and Trademark Office.

Matters subject to said conditions shall include, without limitation, any communication or document relating to:

- a) Assessment of the patentability of an invention, the registrability of an industrial design, trademark or trade name;
- b) Preparation or prosecution of a patent application, utility model, industrial design, trademark or trade name;
- c) Any opinion relating to the validity, scope of protection or infringement of the subject matter of a patent, utility model, industrial design, trademark or trade name, as well as of an application for any of the above.

Proposal for amendment

Current wording

Article 176. Industrial Property Agents

1. Industrial Property Agents are the legally authorised persons who, as members of a liberal profession, habitually offer and provide their services in the form of advice, assistance and representation to third parties in obtaining various kinds of industrial property and in the defense of the rights deriving from same before the Spanish Patent and Trademark Office.

Proposal of wording

Article 176. Industrial Property Agents

1. Industrial Property Agents are the legally authorised persons who, as members of a liberal profession, habitually offer and provide their services in the form of advice, assistance and representation to third parties in obtaining various kinds of industrial property and in the in the maintenance, exploitation and defense of the rights derived from them of the rights deriving from same before the Spanish Patent and Trademark Office and other international organizations competent in matters of Industrial Property in which they have been recognized, due to their status as Agents, the capacity to act before them.

Proposal for amendment

Current wording

5. Industrial Property Agents shall be obliged to keep the matters in which they are involved confidential and shall be entitled to refuse to disclose communications exchanged with their clients or with third parties relating to the procedures followed before the Spanish Patent and Trademark Office.

Matters subject to said conditions shall include, without limitation, any communication or document relating to:

- a) Assessment of the patentability of an invention, the registrability of an industrial design, trademark or trade name;
- b) Preparation or prosecution of a patent application, utility model, industrial design, trademark or trade name;
- c) Any opinion relating to the validity, scope of protection or infringement of the subject matter of a patent, utility model, industrial design, trademark or trade name, as well as of an application for any of the above.

Proposal of wording

5. Industrial Property Agents must carry out the duties of the profession faithfully, loyally and legally, keep professional secrecy, not represent conflicting interests and display due diligence in the exercise of professional functions. In particular, they shall be obliged to keep the matters in which they are involved confidential and shall be entitled to refuse to disclose communications and information exchanged with their clients or with third parties in the exercise of the profession, unless he has been expressly relieved of this obligation by the client. ~~relating to the procedures followed before the Spanish Patent and Trademark Office.~~

Matters subject to said conditions shall include, without limitation, any communication or document relating to:

- a) Assessment of the patentability of an invention, the registrability of an industrial design, trademark or trade name;
- b) Preparation or prosecution of a patent application, utility model, industrial design, trademark or trade name;
- c) Any opinion relating to the validity, scope of protection or infringement of the subject matter of a patent, utility model, industrial design, trademark or trade name, as well as of an application for any of the above.



**THANK YOU VERY MUCH FOR YOUR
ATTENTION**

Oficina Española de Patentes y Marcas, O.A. (OEPM)