

Spain

The duty of the Spanish Industrial Property Agents to keep confidential the communications with their clients and the right to refuse to disclose said communications is recognized in Article 176(5) of the Spanish Patent Law 24/2015 (entry into force on April 1, 2017): “Industrial Property Agents are required to keep the confidentiality on the issues they are involved in and have the right to refuse to disclose communications with customers or third parties relating to proceedings before the Spanish Patent and Trademark Office.”

Origin of the professional secrecy obligation and privilege and its coverage

Spanish lawyers have always enjoyed the right to refuse testimony concerning their communications with clients. The Spanish legal system admits the existence of a duty of confidentiality regarding certain professions or when agreed in a contract. Professions with a duty of confidentiality, as noted by case law, would be those in which the author is a professional who performs a public and legally regulated activity with a specific legal provision regarding the duty of professional secrecy.

Spanish Industrial Property Agents (a category that includes both Patent and Trade Mark Attorneys) are professionals that perform a public and legally regulated activity but whose professional secrecy obligation was, prior to the introduction of Article 176 of Law 24/2015, only regulated in the Code of Ethics of the Spanish Association of Industrial Property Agents (without normative nature), which provides that “collegiate members shall be obliged to not disclose the confidential information received during the exercise of their profession” (General Provision 1c).

Therefore, until the adoption of Article 176, the professional secrecy obligation and the consequent right to refuse testimony could not be awarded to those Industrial Property Agents who were not lawyers.

Professionals covered by the secrecy obligation and privilege

Article 176(1) of Law 24/2015 defines Spanish Industrial Property Agents as “professionals that regularly offer and provide their services to advise, assist and represent third parties in obtaining the different categories of Industrial Property and in defending their subsequent rights before the Spanish Patent and Trademark Office.” Article 176(2) further provides that the “Agents may exercise the activity individually or through juridical persons validly incorporated under the law of a Member State of the European Union and whose headquarters or principal activity is in the Community. The Agents as well as the juridical persons through which they exercise their activity may enroll in the Special Register of Agents of the Spanish Patent and Trademark Office.”

With regard to the execution of the activities of Industrial Property Agents through juridical persons, Articles 176(3) and (4) of Law 24/2015 clarify that “[i]n order for a juridical person to obtain registration in the Special Register of Agents of the Spanish Patent and Trademark Office, at least one partner or associate members of the entity

shall certify the condition of Agent as provided in the following article. The juridical person registered will lose the authorization for the exercise of this professional activity at any time if such a requirement is no longer met.” Furthermore, “[t]he juridical person as well as the Agent that acts through it shall be liable for the professional management that is developed under the partnership or association form.”

Finally, Article 176(6) of Law 24/2015 states that Article 176(5) also applies to the representatives referred to in Article 175(1) that are not Industrial Property Agents.” Article 175(1) of Law 24/2015, in relation to capacity and representation, provides that in addition to Industrial Property Agents, interested parties with capacity to act pursuant to Title III of Law 30/1992, of November 26 on the Legal Regime of Public Administration and Administrative Procedure may also act before the Spanish Patent and Trademark Office. In other words, such interested parties who are entitled to represent their clients before the Office also have the right to refuse to disclose certain communications with their customers or third parties.

Kind of information/communication covered by the secrecy obligation and privilege

Pursuant to Article 176(5) of Law 24/2015, among others, any communication or any document relating to the following shall be subject to the secrecy obligation and confidentiality privilege:

- “a) Assessing the patentability of an invention, the registrability of the industrial design, trademark or trade name;
- b) Preparation or processing of a patent application, utility model, industrial design, trademark or trade name;
- c) Any opinions regarding the validity, scope of protection or infringement of the object of a patent, utility model, industrial design, trademark or trade name, as well as an application for any of these modalities of Industrial Property protection.”

Requirements/qualifications for industrial property agents

Pursuant to Article 177 of Law 24/2015, all Industrial Property Agents must: (i) have a professional office in a Member State of the European Union (EU); (ii) possess the official titles of degree, graduate, architect or engineer issued by the university dean, or other equivalent official titles; and (iii) pass the government examination. Further, the execution of activities in Spain by agents who acquired their professional qualification of Industrial Property Agent in another Member State of the EU shall be regulated by Community law as well as by the internal provisions on implementation of those norms under Royal Decree 1837/2008 of November 8, 2008.

In order to be able to act as an Industrial Property Agent, directly or through a juridical person, a Responsible Declaration shall previously be presented to the Spanish Patent and Trademark Office in which, according to the Implementing Regulation of Law 24/2015, the party concerned declares under its responsibility that it meets all

requirements of Articles 176 and 177, is not subject to the incompatibilities referred to in Article 178, possesses the relevant documentation to prove it and commits to maintain compliance with those provisions. The Industrial Property Agent shall then be registered in the Special Register of Industrial Property Agents of the Spanish Patent and Trademark Office (Article 179 of Law 24/2015).

Summary

Following the introduction of Article 176 of Law 24/2015, an Industrial Property Agent could be regarded as one of the professions that perform a public and legally regulated activity, and could, to a certain extent, enjoy secrecy privilege with respect to the communications in relation to certain information/advice relating to proceedings before the Spanish Patent and Trademark Office between an Industrial Property Agent and his/her clients/third parties. There is a view that, *lex ferenda*, secrecy obligation of Industrial Property Agents should be regulated in a Code of ethics with normative nature. The Spanish Patent Act 24/2015 does not provide for penalties for breach of such a secrecy obligation. Further, as the Patent Act provides for specific secrecy obligations and privileges of non-disclosure in relation to Industrial Property Agents of Spain and other Member States of the EU if the relevant conditions are met, and, in certain cases, Spanish or EU interested parties with capacity to act, it is not clear to what extent the law would apply to industrial property agents registered in non-EU countries.