



GUIDE TO GOING GLOBAL

IPT

Spain



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INTRODUCTION

Welcome to the 2023 edition of DLA Piper's *Guide to Going Global – Intellectual Property and Technology*.

GUIDE TO GOING GLOBAL SERIES

Many companies today aim to scale their businesses globally and into multiple countries simultaneously. In order to help clients meet this challenge, we have created a handy set of global guides that cover the basics companies need to know. The *Guide to Going Global* series reviews business-relevant corporate, employment, equity compensation, intellectual property and technology, and tax laws in key jurisdictions around the world.

INTELLECTUAL PROPERTY AND TECHNOLOGY

Inside this guide, we outline crucial aspects of IPT laws in over 40 jurisdictions that are particularly relevant to businesses seeking to expand their operations globally. We also summarize some fundamental commercial terms that customarily appear in IPT-related agreements.

You will find answers to such common questions as:

- Which jurisdictions recognize moral rights?
- What does my business need to do to have an enforceable assignment of intellectual property from an employee, from a consultant?
- What kind of liability can be excluded from a commercial contract?

With this edition, we've also included a section for each country that discusses the enforceability of electronic signatures.

Our goal is to make the guide as readable and informative as possible, providing you just the background you need to get an overview of the IPT laws in the selected jurisdictions. This is not a substitute for professional legal advice. If you have questions regarding specific matters, we encourage you to contact one of our contributors listed in the contributors section of this guide. With nearly 500 dedicated IPT lawyers around the globe, DLA Piper's IPT group is ready to handle your legal needs wherever you do business.

Also, please note that the guide's use of the term "trademarks" also refers to service marks, unless specifically addressed separately. The summary of intellectual property covers only the most commonly used categories worldwide (for example, we have not addressed plant patents). We have also referred to international treaties and conventions with their most commonly used names and not their formal titles (such as the TRIPS Agreement, the Berne Convention, the Paris Convention and the Patent Cooperation Treaty).

We hope that you find this guide valuable and we welcome your feedback.

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This is a general reference document and should not be relied upon as legal advice. The application and effect of any law or regulation upon a particular situation can vary depending upon the specific facts and circumstances, and so you should consult with a lawyer regarding the impact of any of these regimes in any particular instance.

DLA Piper and any contributing law firms accept no liability for errors or omissions appearing in this publication and, in addition, DLA Piper accepts no liability at all for the content provided by the other contributing law firms. Please note that intellectual property and technology law is dynamic, and the legal regime in the countries surveyed could change.

SPAIN



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INTELLECTUAL PROPERTY FRAMEWORK

Overview

The Spanish Constitution establishes in the Article 149.1.9 that intellectual property rights shall be governed by Spanish National Statutes only. Self-Governing Regions (the Spanish equivalent of US states or German *Länder*) are not entitled to issue laws in this field.

COMMERCIAL CONTRACT FRAMEWORK

Overview

Although the Spanish Constitution establishes at Article 149.1.6 that commercial legislation is reserved to Spanish National Statutes, the powers of the Self-Governing Regions in the field of "trade" and "consumer protection" and the existence of regional limited Civil Codes cause interferences between different sources of legislation. In addition, Spanish National legislators have preferred over the last 5 decades to draft separate laws for each commercial contract/ commercial law issue, instead of merging them into the pre-existing Code of Commerce. As a result, commercial issues are considered under the light of the 2 old Codes but also of the new National laws (Agency Act, Unfair Competition Act, Franchising Royal Decree, Retail Trade Act, Consumer Protection Act, Mobile Property Pledge Act) and of the regional laws and regulations.

COPYRIGHTS

Nature of right

All original literary, artistic or scientific works are protected by copyright, in particular, books, music compositions, audiovisual works, projects, plans, graphics, and databases. Computer programs are also protected by copyright and with certain exceptions, are treated in the same way as literary works.

Registration is not required for valid copyright protection. However, works that qualify for copyright protection may be registered on the Copyright Register and/or filed with a Notary Public in order to serve as stronger evidence. Copyright protection is automatic and the rights arise at the time the work is created.

Copyright owners have the exclusive right to reproduce, distribute, prepare derivative works, publicly perform and publicly display their works of authorship.

Legal framework

In Spain, copyright is governed by Legislative Royal Decree 1/1996 on Intellectual Property. This law implements the EU Copyright Directives (Directive 2001/29/EC on the harmonization of certain aspects of copyright and related rights in the information society, Directive 2004/48/EC on the enforcement of intellectual property rights); Directive 96/9/EC on the legal protection of databases; and in particular, Council Directive of May 14, 1991 on the Legal Protection of Computer Programs (91/250/EEC). New EU Directive 2019/730 on copyright and related rights in the Digital Single Market has not yet been implemented into Spanish national law.

In addition, Spain is party to the Berne Convention.

Duration of right

Copyright protection is generally granted for 70 years from the death of the author where the author is a natural person. In those cases in which the author is a legal person, the term of protection is 70 years from January 1 of the year following that in which the work was lawfully published, or following the year of its creation, if the work was not published. It should be noted that copyright of works owned by authors who died before 1988 may benefit from longer protection terms. Some types of works/rights do benefit from shorter terms only.

Ownership / licenses

The Legislative Royal Decree 1/1996 on Intellectual Property provides that copyrights in a work belong to the author, who is the person or group of persons who creates the work.

Economic rights of copyright owners may be transferred to third parties. All transfers must be formalized in writing. The transfer of rights is limited to the specific rights, use, term and geographic scope stated in the contract/license. Transfers of rights can be either exclusive or non-exclusive. Moral rights are protected and are not assignable.

Remedies for infringement

The owner of a copyright may bring civil and criminal actions against infringers before the corresponding courts.

Civil actions, governed by the Spanish Civil Procedure Law, should be exercised via an ordinary trial. The owner whose rights have been infringed may claim:

- The cessation of the infringing acts
- Damages
- Seizure of the infringing goods
- To be awarded the seized objects or their means of production
- All necessary steps to prevent the continuation of the infringement and

- Publication of the judgment against the infringer.

The Criminal Code also includes measures such as fines or penalties of prison depending on the seriousness of the harm. These measures have been modified and further strengthened, including prison sentences up to 6 years as set out in Articles 270 and 271.

According to the Royal Decree 1/1996 on Intellectual Property, a copyright holder may apply for precautionary measures against the unlawful activity of an infringer and claiming reparation for material and moral damages caused. They may also request the publication or dissemination, in part or in full, of the judicial resolution or arbitration award in the media at the infringer's expense. The copyright holder may likewise apply, on a prior basis, for the ordering of precautionary measures for immediate protection.

Administrative enforcement measures have been introduced over the last years to support right holders.

MASK WORKS / TOPOGRAPHIES

Nature of right

The topographies of semiconductor products, in other words the 3-dimensional design-layout and connections of integrated circuits, are protected by the grant of exclusive rights insofar as it is the result of its creator's own intellectual effort and is not commonplace in the semiconductor industry.

Legal framework

Protection of semiconductor topographies is governed by Spanish Law 11/1988 on the Legal Protection of Topographies of Semiconductor Products.

Duration of right

The exclusive rights shall expire 10 years from the earlier of the following 2 dates:

- The end of the calendar year in which the topography was first commercially exploited anywhere in the world or
- The end of the calendar year in which the application for registration was filed in due form.

However, any registration of a topography that has not been commercially exploited anywhere in the world within a period of 15 years from its first fixation or encoding shall lapse.

Ownership / licenses

The exclusive rights shall include the right to authorize or to prohibit any of the following acts:

- Reproduction of a topography with the exception of reproduction for private and non-profitmaking purposes or

- Commercial exploitation or importation for that purpose of a topography or of a semiconductor product manufactured by using the topography.

The exclusive rights may be the subject of compulsory licenses when the public interest dictates so.

Remedies for infringement

The owner of a topography may exercise its rights before the courts of ordinary jurisdiction.

Any person entitled to protection who can prove that another person has fraudulently reproduced or commercially exploited or imported for that purpose a topography created by them during the period between its first fixation or encoding and the coming into existence of the exclusive rights may exercise before the courts the appropriate action for unfair competition.

PATENTS

Nature of right

In Spain, both inventions and procedures are patentable. The 3 main requirements to obtain a patent are that the invention must:

- Be new (ie, novel)
- Involve an inventive step and
- Be capable of industrial application.

Scientific discoveries or theories, mathematical methods, literary, scientific, artistic works and any other aesthetic creations, among others, are not considered patentable. Neither is it possible to obtain a patent for an invention if it is a new animal or plant variety, a method of medical treatment or diagnosis, a software item or inventions whose commercial exploitation is contrary to public order or morality.

Legal framework

In Spain, the Spanish Patents and Trade Marks Office (*Oficina Española de Patentes y Marcas*) has the authority to grant patents and trademarks.

The new Spanish Patents Act 24/2015 (New Patents Act) entered into force on April 1, 2017. One of the most significant changes brought by the New Patents Act is related to the procedure for the granting of patents. The previous "à la carte" examination procedure - whereby applicants are free to choose whether or not their application should be submitted to substantive examination - was substituted by the granting procedure involving a prior examination of the merits of the patent. Another important change is in the field of patent litigation. In accordance with the New Patents Act, the patent holder will be able to limit the scope of their patents by amending the claims at any time during the life of the patent. Finally, among other changes of the New Patents Act are provisions relating to Supplementary Protection Certificates (SPCs), which introduces protective letters and patent specialist judges.

In addition to the national patent application system, regional registration systems are also available. Such systems allow the applicant to obtain protection for the invention in one or more countries; however each country determines whether or not to protect the patent in its territory pursuant to the applicable legislation. Since Spain's ratification of the European Patent Convention (EPC) in 1973, Spain may be designated in a European patent application. The EPC system allows the registration of a bundle of national patents enforceable in the countries designated by the applicant.

Additionally, there have been significant developments with regard to the creation of a unitary patent protection within the European Union. Such a unitary patent protection is expected to be available in 2020, although Spain has initially decided not to join these efforts due to linguistic issues.

Duration of right

Patents are granted for a period of 20 years from the date on which the application was filed. A maintenance fee, which is subject to a gradual annual increase, is due yearly. Once the 20-year period has lapsed, anyone may make, use, offer for sale, or sell or import the invention without permission of the patentee, provided that matter covered by other unexpired patents is not used.

Ownership / licenses

Both patent applications and patents shall be transferable and may be the subject of licenses. They may also be used as security for personal loans, which shall be governed by the relevant provisions, and such use shall be notified to the Security Rights section of the Registry of Movable Goods. To be valid, these acts shall be in writing when performed *inter vivos* (between the living).

Both patent applications and patents may be the subject of licenses covering the whole or part of the elements constituting the exclusive rights, for all or part of the Spanish territory. Licenses may be exclusive or non-exclusive. Unless otherwise agreed, a license shall not be deemed to be exclusive and the licensor may grant licenses to other persons and work the invention themselves.

Remedies for infringement

According to the Spanish Law 24/2015 on Patents, the owner of a patent may bring appropriate action of any type or nature before the ordinary courts against any person who infringes their rights and they may demand the necessary measures to safeguard those rights.

The owner whose patent rights have been infringed may, in particular, seek:

- Cessation of the acts that infringe their rights
- Compensation for the damages suffered
- Seizure of the objects produced or imported in infringement of their rights, as well as the means used for such production or for carrying out the patented process
- Whenever possible, attribution of the ownership of the objects and means seized. In such cases, the value of the goods concerned shall be deducted from the compensation for damages. Where that value exceeds that of the compensation granted, the owner of the patent shall pay the excess to the other party

- The adoption of the necessary measures to prevent continued infringement of the patent, in particular, the transformation of the objects or means seized, or their destruction when such is indispensable in order to prevent infringement of the patent and
- Publication of the judgment against the person infringing the patent, at their cost, by means of announcements and notification to the persons concerned.

Any person who, without the consent of the owner of the patent, manufactures or imports items protected by the patent or uses the patented process, shall be liable for the damages.

Compensation for damages due to the owner of the patent shall not only include the amount of the loss that they have suffered, but also the profits lost through infringement of their rights.

The owner of the patent may also require compensation for the damage suffered as a result of the loss of reputation of the patented invention caused by the person infringing their rights through defective manufacture or unsatisfactory presentation of the invention on the market.

TRADEMARKS

Nature of right

Words or combinations of words, names, figures, symbols and drawings, letters, numerals and combinations, 3-dimensional shapes, including wrappers, containers and the shape of goods or their packaging, colors, numbers, sounds and any combination of these elements, may constitute trademarks under Spanish law.

The procedures through which a registration having effect in Spain can be obtained are:

- National system
- International system and
- European Union Trademark.

Legal framework

In Spain, the main law regulating trademark protection is the Law 17/2001 on Trademarks, modified by Royal Decree-Law 23/2018 (changes effective from January 14, 2019). Spanish Patents and Trademarks Office (*Oficina Española de Patentes y Marcas*) has the authority to grant trademarks as well as patents.

The "International System" comprises the Madrid Agreement of 1891 and the Protocol to the Madrid Agreement of 1989 administered by the World Intellectual Property Organization (WIPO). Since it is not, strictly speaking, an international registration, the applicant must designate the countries in which they wish to obtain protection.

The European Union Trademark system provides a single registration which confers direct protection in all the Member countries of the European Union through a single application and a unitary procedure.

Duration of right

National trademark registration is valid for 10 years and can be renewed indefinitely for further 10-year periods subject to the payment of the appropriate fees. However, the registration may lapse or be revoked, among other reasons, if:

- The trademark is not renewed
- It is not effectively used during an uninterrupted 5-year period or
- It becomes generic or deceptive in connection with the goods or services it covers.

European Union Trademark registration is valid for 10 years. This period can be renewed for further 10-year terms subject to payment of the appropriate fees.

Ownership / licenses

The registration of a trademark confers on its owner the exclusive right to use it in economic transactions.

Both an application and a trademark may be licensed for all or some of the goods and services for which the trademark is registered and for all or part of Spanish territory. The licenses may be exclusive or non-exclusive.

Remedies for infringement

The owner of a registered trademark may, before the jurisdictional authorities, take appropriate civil, criminal or administrative actions against those infringing their right and request the measures necessary for protection of the trademark, without any prejudice to submission of the case to arbitration, where possible.

In particular, an owner whose right to a trademark is infringed may in a civil action claim:

- The cessation of the acts infringing their right
- The compensation for the damage suffered
- The adoption of the measures necessary to avoid the continuation of an infringement and in particular, the withdrawal from economic circulation of the goods, packaging, wrappers, advertising material, labels or other documents in which the infringement of a trademark has been manifested
- The destruction or transfer for humanitarian purposes, where possible, as chosen by the party concerned and always at the expense of the guilty party, of the goods unlawfully identified with the trademark which are in the possession of the infringing party, except where the nature of the good allows the distinctive sign to be removed without affecting the good itself, or where destruction of the good would do disproportionate harm to the infringing party or owner, according to the specific circumstances of each case as determined by the court and
- The publication of a decision at the expense of the guilty party by means of announcements and notifications to the parties concerned.

TRADE SECRETS

Nature of right

Trade secrets are protected by restricting any unauthorized use and access thereto, both through civil proceedings under the Trade Secrets Act 1/2019, the Unfair Competition Act as well as criminal proceedings under the Criminal Code.

Legal framework

Trade secrets are mainly protected in Spain under the Trade Secrets Act 1/2019, the Unfair Competition Act, the Criminal Code and TRIPS Agreement (Spain being signatory since 1995) contain also provisions specifically aimed at trade secrets.

There are also other laws which deal with trade secret protection, such as the employment laws establishing secrecy obligations of directors/employees or the Patents Act 24/2015.

Duration of right

No specific duration of trade secret right is set forth under Spanish law. They are protected as long as they are considered trade secrets and protected as such. Claims for infringement of Trade Secrets Act do elapse, however, after 3 years

Ownership / licenses

Trade secrets are, from March 2019, subject to specific property rights. Rules on joint ownership of trade secrets are provided by the Trade Secrets Act.

Remedies for infringement

There is also specific regulation for the license agreements on trade secrets. They can be exclusive and nonexclusive. Sublicensing requires the prior approval from the owner/s. Exclusive licenses prevents the owner from granting further licenses (and even to use the trade secrets licensed by the owner, except if the parties do allow it by means of an explicit agreement). By default, licenses should be deemed to be non-exclusive. The specific civil and criminal law measures are available for protection of trade secrets in Spain. A wide criminal framework is dedicated to trade secrets infringements, including against disclosure, misappropriation, use or other infringement. Criminal liability for trade secret violation under the Criminal Code, punishable by imprisonment of up to 7 years in most serious cases and fines of up to 24 months.

OTHER KEY IP RIGHTS

Nature of right

Not applicable.

Legal framework

Not applicable.

Duration of right

Not applicable.

Ownership / licenses

Not applicable.

Remedies for infringement

Not applicable.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

Employees

Generally speaking, intellectual property rights (inventions, topographies of semiconductor products, industrial designs, copyright works and computer programs) created by employees within the scope of their employment relationship in principle belong to the employer.

In particular, Law 24/2015 on Patents sets forth that inventions made by an employee during the term of their contract, work or service with a company, and which are the result of research that is explicitly or implicitly the object of their contract, shall belong to the employer. The employee will have the right to an additional remuneration in case that their personal contribution to the invention and the relevance for the company exceeds the scope of the tasks regulated in their employment agreement. Furthermore, the employee shall have the right to a reasonable remuneration in relation to the use of the technical improvements developed by the employee which offer a competitive advantage to the employer.

If inventions do not fulfill the aforementioned conditions, they shall belong to the employee who is the author. Nonetheless, if the employee makes an invention "related" to their professional activity and the knowledge gained within the company has had a decisive influence thereon or they have used means provided by the company, the employer shall have the right to claim ownership of the invention or to reserve a right to its use. The employee has a month to give the communication to the employer, who will have 3 months to exercise its rights. In the event that the employer does not communicate to the employee its willingness to assume the ownership of the invention within the aforementioned 3 months period, its rights shall expire, enabling the employee to proceed to the solicitation of the patent for itself. If the employer, having communicated the employee its willingness to assume the ownership of the invention, does not claim in front of the authorities, within a reasonable and pre-agreed term, the industrial property rights, the employee shall claim those on behalf of the employer.

In the event that the employer assumes the ownership of the invention or reserves a right to its use, the employee shall have the rights to a fair (economic) compensation/remuneration proportional to the industrial and commercial importance of the invention as well as considering the value of the resources or know-how given by the employer and the contributions made by the employee. The aforementioned remuneration may consist of a share on the profits made by the employer from the exploitation of the rights over the invention.

Regarding copyright works, according to the Legislative Royal Decree 1/1996 on Intellectual Property, the transfer of the exploitation rights of a work created by virtue of employment relations to the employer is governed by the terms agreed upon in the contract in writing. In the absence of such an agreement in writing, it is presumed that the exploitation rights have been granted exclusively and with the scope necessary for exercising the usual activity of the employer at the time the work is delivered. Similarly, where a computer program is created by an employee in the course of their duties or following instructions given by their employer, the ownership of the exploitation rights on the computer program created, including both the source program and the object program, belong exclusively to the employer, unless otherwise agreed in writing.

Consultants / contractors

It is customary for consultants and contractors to sign written agreements. Absent a written assignment of developments, consultants and contractors will retain ownership of the intellectual property developed by them, even if contracted and paid for by another party.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

Registration of commercial agreements

There is no general registration requirement for commercial agreements.

Registration of licenses for patents, registered copyrights and trademarks is possible but not required (only to have effect in front of third parties).

Recognized language of commercial agreements

Parties are in principle free to choose the language to govern their contract. In consumer-facing commercial agreements and terms, Spanish is mandatory (with a relevant role of regional languages).

Country-specific issues for online content

Directive 2000/31/EC on information society services was implemented in Spain by Law 34/2002 on information society services and electronic commerce (LSSI).

Service providers are required to fulfill certain legal requirements set forth by LSSI. In particular, they shall make available a number of items such as the name or corporate denomination, residence, domicile or address of a permanent establishment in Spain, e-mail details of registration in the Companies Register or any other Public Register.

Enforceability of online/clickwrap/shrinkwrap terms

Generally viewed as enforceable if conspicuous, users have an opportunity to review and indicate affirmative assent (eg, check a box).

The LSSI regulates electronic contracts, although the Spanish Civil Law must be also taken into account. The LSSI further obliges service providers to provide information in a clear, understandable and unambiguous way regarding the conclusion of the contract. Electronic contracts will have the same legal effects, provided that the

consent and other legal requirements that its object and cause have been satisfied.

Governing law

Under Regulation No. 593/2008 of the European Parliament and of the Council of June 17, 2008 on the law applicable to contractual obligations (Rome I), directly applicable in Spain, the parties to a contract are allowed to choose the law governing the contracts, whether or not it is the law of a EU member state. If the contracting parties do not make a choice (or if the choice is invalid), the law of the country of habitual residence of the characteristic performer when the contract is concluded, or in the case of a company, of its central administration, in principle applies.

Alongside this general rule, the EU Rome I regulation on the law applicable to contractual obligations establishes certain guarantees as to the requirements for the parties to be able to determine the applicable law in certain cases (consumer contracts and individual employment contracts) and if no choice is made, specific forms of jurisdiction that take precedence over the presumptions referred to above. Spanish laws (eg, Consumers and Users Protection Act RDL 1/2007) also do establish certain limitations on the choice of law of the parties when dealing with certain specially protected groups, like consumers.

KEY COMMERCIAL CONTRACT TERMS

Enforceability of warranty disclaimers

Disclaimers of warranties are usually enforceable in business to business deals unless they are unconscionable, unclear or not conspicuous. Disclaimers for gross negligence or willful behavior are void.

Warranty disclaimers against consumers are generally not allowed in most cases.

Enforceability of exclusions/limitations of liability indemnification

A cap on direct damages or aggregate liability is common.

Exclusions and limitation on liability are usually enforced unless they are unconscionable, unclear or not conspicuous. Exclusions of liability for fraud, personal injury, death, bad faith, gross negligence or willful behavior are not enforceable under Spanish law.

Exclusions and limitations of liability against consumers are generally not allowed.

Indemnification

Express indemnities stated in contracts are recognized and generally respected.

Indemnification provisions are generally enforceable unless they require indemnification of behavior that statutes or courts have held to be unenforceable (such as fraud, willful injury to person or property and other future unlawful acts).

Caps on liability under indemnification provisions can be enforceable.

Courts have the power to moderate indemnity payments agreed by the parties to a contract.

Electronic signatures

The use of electronic signatures is no longer governed by Electronic Signature Act 59/2003, which has been replaced by Law 6/2020 regulating some matters related to electronic trust services. EU Regulation (eIDAS) 910/2014 of the European Parliament and of the Council regulating e-signature matters applies within the EU territory from July 1, 2016.

There are different types of electronic signatures:

- Simple electronic signature (ie, data in electronic form which is attached to or associated with other electronic data and which serves as a method of authentication).
- Advanced electronic signature, which is:
 - Capable of identifying the signatory
 - Uniquely linked to the signatory
 - Linked to the data signed there with in such a way that any subsequent change in the data is detectable and
 - Created using electronic signature creation data that the signatory can use under their sole control.
- Qualified electronic signature (ie, an advanced electronic signature that is created by a qualified electronic signature creation device, and which is based on a qualified certificate for electronic signatures).
 - A qualified electronic signature has the equivalent legal effect of a handwritten signature.

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