

31 May 2019

Sara Nazaré | ssn@vda.pt

INTELLECTUAL PROPERTY

THE PORTUGUESE IP CODE REVISION – PATENTS AND SUPPLEMENTARY PROTECTION CERTIFICATES

The new Industrial Property (IP) code revision, brought by Decree-Law no. 110/2018 (DL 110/2018), was prepared following the consultation of a large number of bodies and entities, *e.g.* the Portuguese Intellectual Law Association, the Portuguese Group of AIPPI, Apifarma – the Portuguese Association of the Pharmaceutical Industry and Apogen – the Portuguese Association for Generic and Biosimilar Medicines.

The provisions of DL 110/2018 that amended the regime of enforcement of industrial property rights concerning medicines, enacted by Law no. 62/2011, already entered into force on 9 January 2019 (the relevant summary can be found [here](#)).

We highlight below the most relevant revisions to the IP regime carried out by DL 110/2018 in what concerns the enforceability of European patents validated in Portugal and the application and enforceability of supplementary protection certificates (SPC), as well as the general provisions applicable thereto. The remaining IP rights and the protection of trade secrets will be dealt in separate flashes. The articles indicated in brackets are of the new Code.

General provisions

- The **administrative request for the modification of a decision** of the Portuguese patent office (PPO), relevant for the application of SPC, was further regulated (art. 22):
 - Facts that ground such request no longer need to be supervening;
 - The request can be contradicted by the counterparty and the patent office can accept further clarifications.
- **Facts to be recorded before the PPO** now include not only the fact that a revocation action was brought against an IP right, but also that a revocation claim was made as a counterclaim (art. 29(1)(d)).
- The **request for annulment** of any IP right must now be filed within 5 years as from the decision of grant (the declaration of nullity, which has different grounds, can still be requested at any time) (art. 34(7)).

- An IP right can be **revalidated** subject to the payment of a fine for unpaid due fees. Art. 369(3) now clarifies that the proprietor can not invoke its IP right against a third party that, in good faith, exploited or seriously prepared the exploitation of the subject of the IP right during the period between the loss of the right and its revalidation.

Patents

- There are now specific rules about **patent ownership in public legal entities** that develop research and development activities (art. 59).
- The **double patenting is no longer prohibited**.
- Some important amendments are included in the provisions relating to the **rights arising from patents**. It is now specifically listed as prohibited conducts (art. 102):
 - the use of a protected process (or the offer to use such process, if the third party knew or should know that the unauthorized use is prohibited);
 - the offer, stockpiling, marketing, use and the importation for any of the previous conducts, of the products directly obtained by the process that is the subject of the patent;
 - the indirect infringement (very similar to Article 26 of the Agreement on a Unified Patent Court).

Supplementary Protection Certificates

- The SPC application and the application for a paediatric extension are now **subject to publication in the IP Bulletin**; this amendment clarifies that third parties are entitled to react through the formal available means, by filing a complaint (arts. 116(4)and(5) and 117(6)).
- It is now expressly provided that the **expiry date of SPC can be amended**, at the request of the “interested party” (*i.e.* not just the proprietor) and *ex officio* by the PPO (art. 118(9)and(10)).
- The **PPO can now declare *ex officio* the nullity of SPC** if the basic patent lapsed before its expiry date or if it was annulled (art. 118(11)).

Criminal and civil remedies

- The **criminal and prosecution bodies should inform the IP right holder and the licensee(s)**, within 10 days, of any facts that they become aware of that may constitute a crime (art. 328(2)and(3)).
- The equivalent of Article 9(7) of the Enforcement Directive (the **applicant’s liability in provisional and precautionary measures**) now includes, as a ground for possible damages, the measure being “abusively applied for or in bad faith”; it also provides that the damages can be claimed by the defendant as well as by “any injured third party” (art. 343(3)).