

Trademarks in Spain

Distinctive signs are principally governed by the Trademark Act (17/2001), which replaced the former Trademark Act (32/1988) and was complemented by Royal Decree 687/2002. In 2006 the Trademark Act was further amended by Act 19/2006, which implemented the EU IP Enforcement Directive (2004/48/EC).

Civil actions for trademark infringement are comprehensively covered in the Trademark Act, while criminal actions for infringement are defined in Book II, Title 13, Section 11 of the Criminal Code (10/1995), as amended by Act 15/2003, Act 5/2010, Act 1/2015 and Act 2/2015.

Acquisition of rights

The Trademark Act follows the principle that trademark rights come into existence upon valid registration under the Trademarks Act.

However, the owner of an unregistered well-known mark has the right to:

- file an opposition to an application for registration of a sign that is identical or confusingly similar to its own, for identical or similar goods;
- file a civil action to invalidate an identical or similar trademark registered for identical or similar goods; and
- file a civil action against the unauthorised use of the unregistered mark for identical or similar goods.

Who can be the owner of a Trademark

The Trademark Act identifies the following categories of person who can legitimately obtain a Spanish trademark or trade name:

- Spanish natural or legal persons, and foreign natural or legal persons who have their habitual residence or a serious and effective industrial or commercial establishment in Spain;
- foreign natural or legal persons who enjoy the benefits of the Paris Convention or who are nationals of a World Trade Organisation (WTO) member state; and
- foreign natural or legal persons whose home state recognises the right of Spanish nationals to register such rights (mutual recognition principle).

Signs which may constitute a trademark

A trademark may be any sign that is capable both of being represented graphically and of distinguishing in the market the goods or services of one undertaking from those of others undertakings. The TM Act also provides an inclusive list of signs that may constitute trademarks:

- words or combinations of words, including those capable of identifying persons;
- figures, symbols and drawings;
- letters, numerals and combinations thereof;

- three-dimensional shapes, including wrappers, containers and the shape of goods or their packaging;
- sounds; and
- any combination of the above, without limitation.

Absolute grounds for refusal

The following signs may not be registered as a trademark:

- signs that are not registrable because they do not fulfil the requirements set out in Article 4 of the Trademark Act;
- signs that lack distinctive character;
- signs that comprise exclusively signs that serve in trade to designate the characteristics of the relevant goods or services;
- signs that consist exclusively of signs or indications that have become customary to designate the relevant goods or services in the current language, or in the good-faith and established practices of the trade;
- signs that consist exclusively of a shape which results from the nature of the goods themselves, which is needed to obtain a technical result or which gives substantial value to the goods;
- signs that are contrary to law, public policy or accepted principles of morality;
- signs that may deceive the public – for instance, as to the nature, quality or geographical origin of the relevant goods or services;
- signs identifying wines or spirits that contain a geographical indication, where those wines or spirits did not originate in that geographical area, even if the true origin of the goods is indicated or if the geographical indication is translated or used along with expressions such as ‘kind’, ‘type’, ‘style’ or ‘imitation’;
- signs that include or imitate the coats of arms, flags, decorations or other emblems of Spain, its autonomous communities, its towns, provinces or other local entities, unless the appropriate consent has been given;
- signs that have not been authorised for use by the competent authorities and that are to be refused pursuant to Article 6ter of the Paris Convention; and
- signs that include badges, emblems or coats of arms other than those covered by Article 6ter of the Paris Convention, which are of particular public interest, unless the appropriate authorities have granted consent to the registration.

Relative grounds for refusal: relative grounds may serve as the basis for an opposition or an invalidation in case of conflicts with identical or similar earlier rights:

The following signs may not be registered as a trademark:

- signs that are identical to an earlier trademark, where registration is sought for identical goods or services; and
- signs that are identical or similar to an earlier trademark, where registration is sought for identical or similar goods or services and there is a likelihood of confusion on the part of the public, including the likelihood of association with the earlier trademark.

- signs that are identical to an earlier trade name designating activities which are identical to the goods or services for which registration is sought; and
- signs that are identical or similar to an earlier trade name, where registration is sought for goods or services identical or similar to the designated activities and there is a likelihood of confusion on the part of the public, including the likelihood of association with the earlier trade name.
- The Trademark Act sets out relative grounds for refusal or invalidation in case of a conflict with identical or similar earlier registered trademarks and trade names that are famous or well known in Spain.

The protection afforded to such marks is extended beyond the principle of speciality: a trademark application will be refused even if the goods or services for which registration is sought are dissimilar to those for which an identical or similar well-known or famous mark is registered. This reinforced protection applies if the use of the later mark might suggest a connection between the goods or services covered and the owner of the well-known or famous mark, or in general where such use, without due cause, would take unfair advantage of, or be detrimental to, the distinctive or well-known character or reputation of the earlier mark.

- Further grounds for refusal or invalidation are provided in case of rights related to the name or surname of a person, copyright and unauthorized registration by an agent or representative.

The registration procedure

The trademark registration system is established in Articles 11 to 30 of the Trademark Act and in the complementary regulation (Royal Decree 687/2002).

Examination

The application to register a trademark must be filed before the Spanish Patent and Trademark Office (SPTO).

Once an application is filed, the SPTO will examine it for compliance with the formal requirements. If the application is admissible, the SPTO will conduct an electronic search of earlier rights that may be incompatible with the application, based on relative grounds for refusal.

The SPTO will notify the owners of any potentially incompatible earlier rights that have been detected so that they may file an opposition if they consider it appropriate; however, the SPTO will not refuse an application *ex officio* due to the existence of an incompatible earlier right. At the same time as notifying the owners, the SPTO will publish the application in the *Industrial Property Official Gazette*.

Following publication, the SPTO will conduct an *ex officio* substantial examination of the application to determine whether:

- there are absolute grounds for refusal; or
- the application includes or comprises a name, surname, pseudonym or any other sign identifying a person other than the applicant to the general public.

- If no oppositions are filed and the *ex officio* examination raises no objections, the trademark will be registered.
- The grant or refusal of registration will then be published in the *Industrial Property Official Gazette*.
- The applicant can contest the SPTO's decision through an administrative appeal procedure "recurso de alzada" within one month of its publication. In such case the SPTO will review its decision to determine whether the administrative acts granting or refusing registration were performed in accordance with the law.

Opposition

Publication of the trademark application triggers a two-month period during which any third party can file an opposition to the registration based on absolute or relative grounds for refusal.

The applicant will be notified of the opposition and given the opportunity to respond, and the SPTO will then decide whether to grant or refuse registration and publish its decision in the *Industrial Property Official Gazette*.

The decision may be appealed through an administrative appeal procedure within one month of publication.