



**Marta Gimeno**

***Herrero***

# PTMG - Spring conference 2024

## Implementation of the Trademark Directive in Spain



**BOOSTING YOUR IDEAS.**

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# The Directive 2015/2436 in Spain

## 🚩 Why? Purpose of the transposition

- Necessary harmonization – coexistence of a dual system ↪ ES  
UE
- Easing the registration of Trademarks
- Aiming a stable, predictable, integrated and clear regulatory framework with minimum possible reform

## ⌚ Timing and legal instrument

- Compulsory transposition due by January 14th, 2019
- Approval in Spain: Royal Decree 23/2018 of December 2018, not by Law
- In force: December 28th 2018



➤ *NOT* cancellation and invalidation actions



Urgency





# Most significant changes (I)

➤ **TRADEMARK CONCEPT:** any sign capable of

- Distinguish goods and services of one undertaking from those of others
- Being represented on the Register enabling authorities and the public to determine the subject of the protection

The requirement for graphical representation is suppressed

➤ **WELL-KNOWN TRADEMARK:** Spanish Law does no longer differentiate between

- “Notorious” brand: the one which is generally known to the relevant sector of the public for which the goods, services or activities distinguishing the trademark are intended.
- Well-Known brand: those that are known by the general public.

Only the category of well-known trademark - known to a significant part of the public interested in the goods or services - is maintained.

Denominative

Figurative

Mixed

Sound

Three-dimensional

Position

Pattern

Colour

Motion

Multimedia

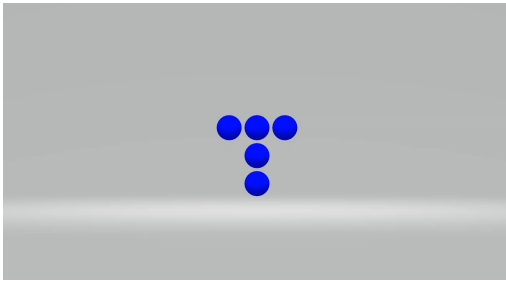
Hologram

Other



# Some examples

➤ **Motion** M4160365



➤ **Multimedia**

M4116867



➤ **Hologram** M4245598



➤ **Sound** 4232285



➤ **Notorious**



TODAY?

➤ **Well-known**



[Fontaneda La Buena Maria Spot TV 2018 \(youtube.com\)](https://www.youtube.com/watch?v=Fontaneda-La-Buena-Maria-Spot-TV-2018)



# — Most significant changes (II)

**OPPOSITION PROCEEDING:** the applicant of the TM might request proof of use to the opponent.

**RENEWAL:** streamlining the process through payment of the fee.

Elimination of the mention to **IUS UTENDI** and end of the “coverage trademarks” except for: 

**Prior discussions  
concerning the “right  
to use”**

- Tolerance prescription
- Lack of distinctiveness of the earlier trademark
- Lack of use of the earlier trademark

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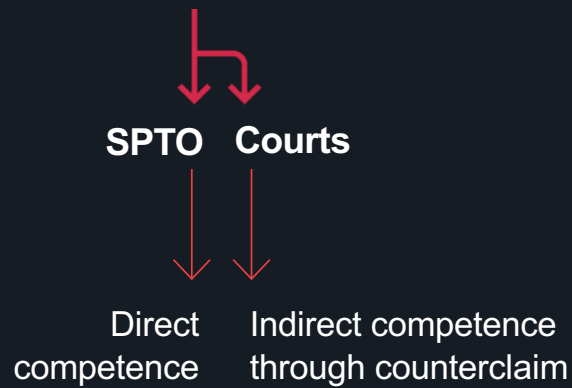
The **EXCLUSIVE LICENSEE** might initiate infringement action if requested to do so to the licensor and the later fails to take action

 License recordal compulsory when filing the action



# Administrative proceedings for revocation and invalidity of trademarks

From January 2023, invalidity and cancellation actions based on non use are handled by the SPTO



## ➤ Applicable system BEFORE January 2023:

Ordinary proceeding before the Mercantile Courts  
Process

- Suit
- Two-month term for the defendant to file its response or counterclaim
- Two-month term for the claimant's response to counterclaim
- Preliminary hearing
- Trial

Possible appeal before the Provincial Court

## ➤ Competent Mercantile Courts? →

- Defendant's legal address
- Residence
- *Forum shopping*





# New administrative proceeding. Absolute grounds

FILING of the invalidation request by the applicant



COMMUNICATION of the invalidation request to the trademark holder



Two-month term to RESPOND

## ➤ Some things to bear in mind

**Flexibility of the process:** terms to respond between 10 days and a month

**Lack of response:** closure of the contradictory stage

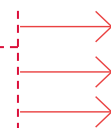
The SPTO has the right to fulfill as many **requests** as deemed appropriate

## ➤ Absolute grounds of invalidity

- Registration contrary to provision 5 of the Spanish TM – Exception: Secondary meaning

- Bad faith

### ➤ Persons entitled to file the action



Any natural or legal person

Any group or body representing manufacturers, producers, suppliers of service /traders

Any group or body representing consumers

**Spanish Trademark Law Articles 61, 51, 58**





# Invalidation proceeding based on a prior trademark



## ↗ Relative grounds of invalidity

- Existence of prior rights – *Exception*: express consent given by the proprietor of the prior right
- Limitation of acquiescence – five years

- ↗ Persons entitled to file the action
- Holders of prior rights
  - Authorised licensees
  - Persons authorized by DOs and GIs regulations

Spanish Trademark Law Articles 58, 63, 54



# Cancellation action based on non use



## ➤ Grounds for cancellation

- Non-use for five years
- Trademark dilution
- Whenever the trademark misleads the consumers regarding its nature, quality or geographical origin.

## ➤ Persons entitled to file such request

- Any natural or legal person
- Any group or body representing manufacturers, producers, suppliers of services /traders
- Any group or body representing consumers

**Spanish Trademark Law Articles 63, 58**



# Content of the application



- **Number** of the trademark(s) which invalidity or revocation is sought (contested registrations) and the name of its owner;
- **Grounds** on which the application for invalidity or revocation is based;
- **Goods or services** in respect of which invalidity or revocation of the trademark is sought.
- If the application is based on relative grounds, **prior right(s)** on which the application is based. —→ If not identified – total
- Payment of the **official fee** 10-day term to *remedy*





# — Proof of use on administrative proceedings

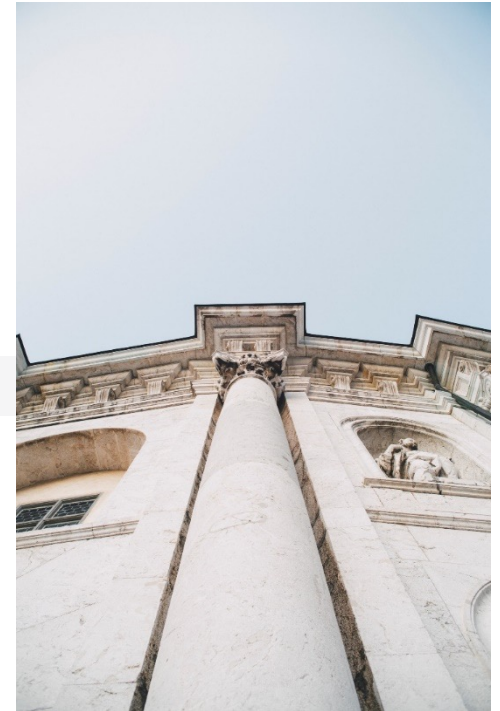
## **Evidence that might be filed**

- Invoices
- Packaging
- Brochures
- Ads
- Labels
- Photographs
- Sworn declarations
- Price list

## **Causes that justify the lack of use**

– those under no control of the holder and that absolutely prevent any use, such as:

- Import restrictions and official requirements imposed on the products and/or services;
- Ban of sales by the government due to health or national defense reasons
- State monopolies; and
- Force majeure.





# Effects of the invalidation

**Invalidation actions** (absolute and relative grounds)

*Ex tunc*

**Cancellation actions based on non-use**

*Ex nunc* – filing of the cancellation action OR earlier upon request

## Exceptions

- Final infringement decisions
- Contracts concluded and performed before the decision



# Common rules

- Inadmissibility of actions in respect of which there is a **final** administrative or judicial decision.
- Possibility to totally or partially **withdraw** the Trademark within the proceeding.
- **Rules on related actions:** the body that first knew about the action takes precedence. *Strategic defense?*
- Optional **suspension** of infringement actions.
- **Appeal?** YES before the SPTO (one month) and, afterwards, before the Mercantile Courts (two months)



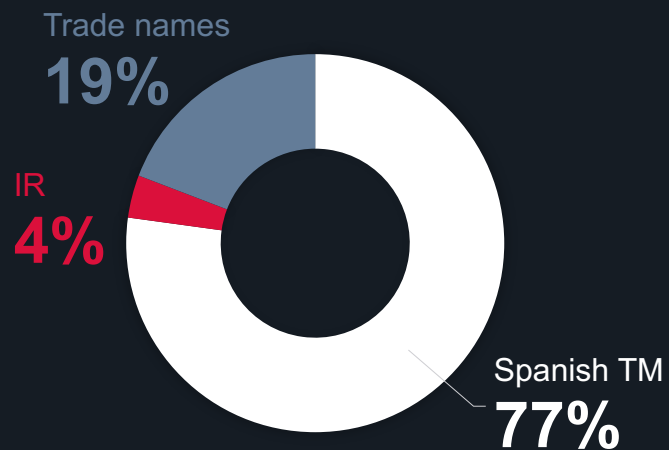


# Some figures

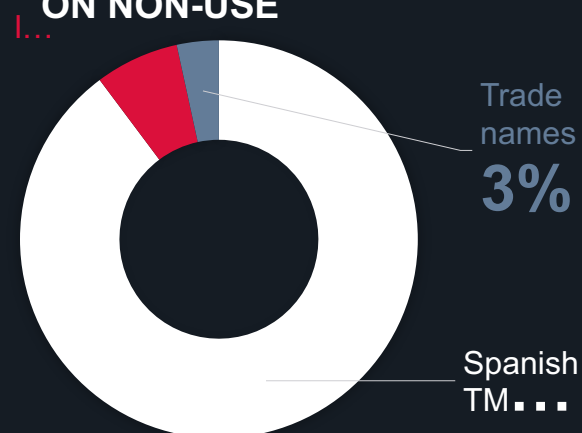
Until December 28th according to the Official Bulletin publication:

Invalidation actions			Cancellation actions based on non-use		
Spanish TM	IR designations	Trade names	Spanish TM	IR Designations	Trade Names
169	8	42	158	12	6
219			176		

## INVALIDATION ACTIONS



## CANCELLATION ACTIONS BASED ON NON-USE





# Advantages and disadvantages. Our experience

## **Simplification** and expediting process

- Administrative proceeding vs. Judicial – no foreseen hearings
- Simpler writs

## **Costs**

- No Court Attorney
- Lower legal fees (but similar official fees)
- No need to translate the request (SPA)

## **Timing (?)**

- Up to a maximum of 20/24 months
- Fast communication/publication of requests (approx. 10/15 days)
- Proof of use eased in approx. three weeks

## **Accessibility**

- No lawyer needed



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