

Kluwer Trademark Blog

Amendment of the Spanish Trademark Law: A more European Law

Carolina Pina (Garrigues) · Wednesday, January 9th, 2019

The Royal Decree-Law ([link](#)) implementing the European Trade Marks Directive 2015/2436 was published in the Official State Gazette on December 27. The main part of this legislation amending the Spanish Trade Mark Law will come into force on January 14, 2019.

The main points to be highlighted are as follows:

- **Competence of the Spanish Patent and Trademark Office (SPTO) for invalidity and revocation-related proceedings:** The courts will only have jurisdiction in counterclaims brought in infringement proceedings. This provision will not be applicable until January 14, 2023.
- **Elimination of the graphic representation requirement from the concept of trademark:** In practice, this entails opening the Registry to “non-conventional” signs, such as smell marks.
- **Clarification of the concept of trademarks with reputation:** the law clarifies the concept of trademarks *which have a reputation*, eliminating the reference to “well-known” marks from Article 8. This reference gave rise to legal uncertainty and did not comply with the wording of the Trademarks Directive. It is further clarified that these trademarks are also protected from detriment to their distinctive character or “dilution”.
- **Use of the trademark:** Various provisions relating to the obligation to use the trademark are included:
 - In opposition proceedings the applicant will be able to request evidence that the opposing trademark has been put to genuine use, provided that on that date, the earlier trademark has been registered for at least five years, in line with EUIPO proceedings.
 - The specific date from which the five-year period must be calculated is clarified as being *the date on which the registration of the trademark has become final*.
 - Finally, the same provision is included in revocation and invalidity proceedings, thereby allowing the owner of the contested trademark to request that the proprietor of the earlier trademark furnishes proof of the genuine use of the latter.
- **Scope of the right to prevent third-party use:** The list of specific cases in which the holder of the right can prohibit its use by third parties has been extended to include the use of the sign in comparative advertising in a manner which violates the provisions of Directive 2006/114/EC on misleading and comparative advertising.
- **Goods in transit:** The holder of a registered trademark may seek an injunction against goods from third countries which are brought into Spain, even where they are not released for free circulation. However, this will not apply where the owner of the goods or the declarant proves that the registered trademark owner is not entitled to stop the marketing of the goods in the final

destination country.

- **Registration of a trademark does not confer its owner immunity from an infringement action:** Pursuant to EU and Spanish case law, the amended Trade Mark Law expressly provides that the ‘doctrine of immunity’ is not applicable. In other words, it will not be necessary to first cancel a trade mark registration that infringes upon third party rights in order to bring infringement proceedings against such trade mark.
- **The intervening right as defense in trademark infringement proceedings:** As already included in the European Union Trademarks Regulation (Article 16) and the Directive itself, the so-called “intervening right” has been incorporated as a means of defense for the proprietor of a later registered trademark in infringement proceedings. In this respect, the proprietor of a trademark shall not be entitled to prohibit the use of a registered trademark where the junior trademark would not be declared invalid as a result of:
 - limitation in consequence of acquiescence;
 - the earlier trademark not being distinctive or not having a reputation; or
 - the earlier trademark being subject to revocation due to non-use

Since this defense would require the parties to revert to a point in time which may long predate the date of filing of the claim, it will be necessary to assess both whether it is possible for the defendant to use this defense, and the evidence that it will be able to produce in order to support it.

- **Lack of distinctive character or reputation of an earlier trademark will preclude a declaration of invalidity of a registered trademark:** In other words, an application for a declaration of invalidity on the basis of an earlier trademark will not succeed if the earlier trademark, on the filing date or priority date of the contested trademark:
 - may be declared invalid due to lack of distinctive character, due to it being descriptive or generic, unless it has acquired distinctive character as a consequence of its use.
 - is not sufficiently distinctive to support a finding of a likelihood of confusion where the declaration of invalidity is based on Article 6.1 b)
 - had not yet acquired a reputation where the declaration of invalidity was based on a trademark with a reputation

This mechanism forces the parties to place themselves at the time in which the application for the contested trademark was filed or to its priority date

- **Filing of infringement proceedings by the licensee:** Following the existing provisions of the Patents Law, the new legislation expressly provides that the licensee may only bring action for trademark infringement with the consent of the licensed trademark’s proprietor. However, an exclusive licensee may bring action if the trademark proprietor fails to do so, after having been so requested.

In addition, it is provided that any licensee may intervene in proceedings brought by the proprietor in order to seek compensation for any damage incurred.

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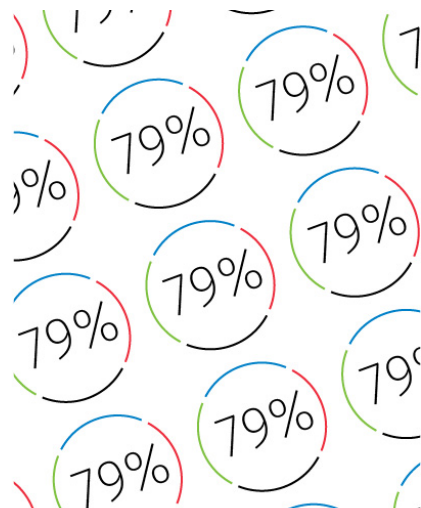
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