

## Registration of Trade Marks

### **REGISTRATION OF TRADE MARKS IN SPAIN**

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#### Preliminary Note

The following is related to the Registration of national trade marks in Spain.

The Spanish Patents and Trademarks Office awards trade marks for products and services and trade names that provide legal protection for distinctive signs.

A Trade Mark is a sign used to distinguish a firm's products or services on the market, whether it be an individual concern or a company. Is a distinctive sign. Its purpose is to differentiate between and distinguish certain products and services on the market and also to identify the company producing them.

A Trade Name is a sign or a name identifying a company involved in trading activity and which is used to distinguish it from other companies carrying out identical or similar activities.

A trade name, therefore, distinguishes companies manufacturing or marketing products or providing services. In contrast, a trade mark distinguishes the services or products it manufactures, markets or supplies.

The Trade Mark Act also provides for the Collective Mark and Certification Mark;

A Collective Mark is used to distinguish the products and services supplied to the market by the members of a manufacturers', traders' or service providers' association. The association holds the rights to this kind of mark.

A Certification Mark guarantees or certifies that the products or services it applies to meet standard requirements, particularly those regarding quality, components, production methods, technical conditions, etc. This mark can not be used by the right holder but by the third parties authorised by the right holder once checks have been made to ensure that the third party's products and services meet the requirements guaranteed or certified by this mark.

#### WHAT CAN BE REGISTERED AS A TRADE MARK?

According to article 4.1 of the Trade Mark Act: "A trade mark is understood to be any sign that can be graphically represented and used to distinguish the products or services of one company from those of another on the market."

The following can be all trade marks:

- words and combinations of words
- images, figures, symbols and drawings

- letters, numbers and combinations of the two
- three-dimensional forms including packaging, containers and product formats
- sounds, provided that they can be graphically represented.
- Any combination of the aforementioned marks

## LEGAL REGISTRATION RESTRICTIONS

A) Total Restrictions: the following can not be registered as trade marks:

- a.1) Marks that can not be represented graphically
- a.2) Generic and specific marks when they make up the name given to the type of products of services the trade mark is assigned to and marks consisting solely of references or signs which are used in trade or everyday speech as the name usually applied to the product or service in question
- a.3) Descriptive marks consisting only of marks that are used or may be used in trade to refer to the quality, quantity, destination, value, source, production period and other features of the products and services
- a.4) Three-dimensional forms imposed by the characteristics of the product itself or which provide a technical result or give an essential value to the product.
- a.5) Any mark that contravenes the Act, public or decency.
- a.6) Any mark that may mislead or confuse the public.
- a.7) Any marks copying or imitating the coats of arms, flags and emblems of municipal, provincial and regional authorities, the Spanish state and any other states without due authorisation.
- a.8) Marks incorporating insignia, emblems or coats of arms other than those listed in the Act (article 5 in Annex C).

B) Partial Restrictions: the following can not be registered as trade marks:

- b.1) Signs that are identical or similar to trade marks
- b.2) Trade names where the application relates to products, services or activities that are identical or similar to those protected by previously registered signs and where there is a danger of consumers being misled or confused by their use.
- b.3) When the selected sign is identical or similar to a well-known trade mark or trade name, registration of the sign is prohibited for products, services or activities other than those protected by the well-known mark if there is a possibility of the mark in question being improperly used or of distinctive character of renown being affected as a result.

## PROCESS OF APPLICATION

a) **PRESENTATION:** The application can be presented to the relevant regional government bodies or to the SPTO if these bodies have yet to set up registration systems. Also at post office branches and any other places authorised by the Public Administration Legal System Act and the Joint Administrative Procedure.

b) **INSPECTION OF THE APPLICATION:** The relevant regional body will check the application in order to ensure that the information necessary to obtain a presentation date has been provided, that the correct forms have been presented and are properly completed and that the applicant is entitled to be the holder of a Spanish trade mark.

c) **SUBMITTING THE APPLICATION TO THE SPTO:** Failure to rectify any irregularities or to respond to notification of them (one month for residents and two months for residents abroad) will result in the application being rejected although if the irregularities that have not been rectified only affect part of the application, the application may be rejected in part.

d) **ASSESSING THE LEGALITY OF THE APPLICATION:** The SPTO will notify applicants of any infringement of the law detected and shall give them a period of a month in which to respond. Applications failing to pass this assessment will be rejected.

e) **PUBLICATION OF THE APPLICATION AND NOTIFYING PREVIOUS RIGHT HOLDERS:** If the application passes the assessment phase, it will be published in the Official Industry Property Gazette for a time period of two months in order to give anyone who considers their rights to be infringed by it the opportunity to present a written objection to the award of the trade mark applied for.

f) **IN-DEPTH EXAMINATION:** When the objection period expires the application will be examined to check whether it falls within any of the aforementioned total restrictions and whether it consists of a name, surname, pseudonym, image or any other mark that the general public would identify with someone other than the applicant. If an objection has been raised or the application falls within any of the aforementioned restrictions, processing of the application shall be suspended and the applicant notified of the objections raised so that he/she can present counterclaims and forward any relevant documents within a period of one month starting from the date the suspension was published in the OIPG.

g) **AWARD-REFUSAL:** If the trade mark applied for does not fall within any of the restrictions and if no objections have been raised to it, the SPTO shall then proceed with its award. In addition, at the end of the period given to the applicant to respond to the suspension of the application, the registration shall either be awarded or rejected, totally or in part, regardless of whether a response has been received or not. This decision, which the applicant will be notified of, does not mark the end of the administrative process. An appeal can be lodged to the tribunal within one month of the decision being published in the OIPG. This appeal must be lodged before the case can be brought before a court.

If the trademark is awarded, the right holder must collect the registration certificate and is not liable for the payment of any fees until such time as the trade mark needs to be renewed, once then years have elapsed since the application date.

h) **DURATION OF THE PROCESS:** In accordance with the Trade Mark Act (additional provision no.5) the SPTO must resolve a trade mark application within the following periods:

- 12 months if the application have not been suspended and no objections are raised.
- 20 months in the event of suspensions or objections.

## SCOPE AND DURATION OF PROTECTION

Trade marks are awarded for a period of ten years starting from the application date and can be renewed indefinitely for successive ten-year periods.

The protection obtained as a result of registering the trade mark applies for the whole of Spain. Trade marks can also be protected internationally.

## RIGHT HOLDER'S OBLIGATIONS

In order to retain the registration rights to the trade mark, the holder must fulfil the following obligations:

1. Request a renewal every ten years and pay the renewal fees
2. Use the trade mark.

## OTHER FEATURES OF CORPORATE IDENTITY: COMPANY NAMES AND DOMAIN NAMES

As regards the comprehensive protection of corporate identity users should be aware that trade marks only protects products and services.

Trade names are a means of distinguishing one company from another when they undertake trading activity. Company names are awarded by the Mercantile Register and identify trading companies as legally recognised entities.

Domain names are used to identify a specific network location on the Internet. Indirectly and as a result of legal procedures, domain names have acquired a virtual character and can be used to differentiate between companies. Firms often use their company name or distinctive trade mark or trade name as their domain name. In order to register a domain name in one of the `.es`, `.com.es`, `.nom.es`, `.org.es`, `.gob.es` and `.edu.es` domains you should visit the public business organisation, Red.es, at [www.red.es](http://www.red.es). To register your domain name in one of the `.com`, `.net` or `.org` domains, etc., you should contact one of the ICANN Accredited Registrars at [www.icann.org](http://www.icann.org).

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Food and beverage

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OthersÖ.

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