

# SPANISH TRADEMARK LAW REFORM

## The Spanish Patent and Trademark Office's new role in invalidity and revocation proceedings: Trademark Law Reform

The Spanish Trademark Law, and its implementing regulations, have been amended and change how trademark invalidity and revocation proceedings are processed, giving the Spanish Patent and Trademark Office authority over them as of 14 January 2023.

### 1. INTRODUCTION

The reform of Trademark Law 17/2001 of 7 December ("**Trademark Law**") and its implementing regulations ("**Implementing Regulations**")<sup>1</sup>, which was introduced by Royal Decree Law 23/2018 of 21 December<sup>2</sup> and Royal Decree 306/2019 of 26 April<sup>3</sup>, respectively, both of which transposed Directive (EU) 2015/2436 on the approximation of the laws of the Member States relating to trademarks<sup>4</sup> ("**Directive**"), will enter into force on 14 January 2023.

This reform aims to (i) align the Spanish and EU trademark systems for their balanced coexistence and (ii) make registration simpler and swifter.

Its main new features are the following:

1. From 14 January, invalidity and revocation proceedings of Spanish distinctive signs must be filed with the Spanish Patent and Trademark Office ("**SPTO**") rather than with the courts. Commercial courts will nevertheless continue to have jurisdiction to declare the invalidity or revocation of a Spanish trademark when requested in a counterclaim in trademark infringement proceedings.
2. Also from 14 January, some sections of the provincial courts that specialise in commercial matters will hear appeals against SPTO decisions that end the administrative phase in industrial property matters (and will no longer be limited to hearing revocation or invalidity matters), for which purpose the corresponding procedural rules have also been modified.

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<sup>1</sup> Implementing Regulations of Trademark Law 17/2001 of 7 December approved by Royal Decree 687/2002 of 12 July.

<sup>2</sup> Royal Decree-Law 23/2018 of 21 December on transposing directives on trademarks, rail transport and package travel and related travel services.

<sup>3</sup> Royal Decree 306/2019 of 26 April amending the Implementing Regulations for Trademark Law 17/2001 of 7 December.

<sup>4</sup> Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December to approximate the laws of the Member States relating to trademarks.

The reform aims to apply to Spanish trademarks the scheme that already applies to requests seeking the invalidity or revocation of EU trademarks.<sup>5</sup>

The SPTO has published its “Guidelines on Administrative Invalidity and Revocation” (“Guidelines”) with practical information on the processing of invalidity and revocation proceedings and coordination between the SPTO and the courts. Similarly, the SPTO has created new electronic forms for invalidity and revocation proceedings, which will also be available as from 14 January. The Guidelines are available at the following [link](#).

We now take a look at the main aspects of the Guidelines.

## **2. PROCESSING**

### **2.1 FILING APPLICATIONS FOR INVALIDITY OR REVOCATION AND ADMISSION**

Invalidity or revocation applications must at least identify (i) the applicant; (ii) the trademark (i.e. its registration number); (iii) the grounds for the application; (iv) the specific goods or services for which invalidity or revocation is sought<sup>6</sup>; and, if applicable, (v) the prior rights on which the application for a trademark’s relative invalidity is based.

Applicants must also pay the filing fee set out in article 58 of the Trademark Law.

If the application for invalidity or revocation meets the applicable requirements, the SPTO will admit it for processing and notify the trademark owner. This initiates the opposition (or response) phase.

### **2.2 ANSWERING THE APPLICATION AND SUMMONSING THE PARTIES**

The trademark owner has two months to reply to the application from the date it is published in the SPTO’s Official Industrial Property Gazette (“OGIP”).

During this time, the trademark owner can assert its arguments and, in cases in which the applicant seeks relative invalidity, may request proof that the trademark remains in use if it was registered within the previous five years. It can request this evidence separately or in its response to the application. In either case, the SPTO will grant the applicant one month to prove that the trademark has been used during two separate periods: (i) the five-year period preceding the filing of the application for invalidity and (ii) the five-year period preceding the challenged trademark’s application or priority date.

With regard to revocation applications for lack of use, the trademark’s owner must provide, together with its response, sufficient proof that the trademark has been used. Then, prior to the SPTO’s decision, it will send that proof to the applicant in order for the latter to put forward any additional arguments.

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<sup>5</sup> In EU trademark cases, the European Union Intellectual Property Office hears these cases, except where invalidity or revocation is sought in a counterclaim, in which case the European Union Trademark Court (in Alicante) hears them. The European Union Trademark Court’s decision can be appealed to the General Court of Justice, whose decision can in turn be appealed to the Court of Justice of the European Union.

<sup>6</sup> If the applicant does not specify the goods or services for which invalidity or revocation is sought, the application will be deemed to include all goods or services falling within the trademark’s scope of protection.

To avoid the trademark being declared invalid, its owner may waive all or some of the goods or services falling within the trademark's scope of protection. In this scenario, the proceedings would continue with respect to the other goods or services for which protection has not been waived.

Another novelty is that the SPTO may request— as many times as necessary – that the parties respond to evidence or allegations raised by the other party. When doing so, it must give the parties between ten days and a month to respond. If the party in question does not respond, the SPTO will close the opposition phase and decide on the invalidity or revocation requested.

### 2.3 RESOLVING APPLICATIONS

The SPTO must resolve invalidity and revocation proceedings, respectively, within 24 or 20 months as from receiving the application (rather than from the date on which it is admitted).

If the SPTO does not issue a decision within the above periods, the application should be deemed rejected.

Within one month of the SPTO publishing its decision in the OGIP, the parties can appeal the decision (by *recurso de alzada*) to the SPTO Directorate, which is entitled to review the case on the merits.

### 2.4 POST-ADMINISTRATIVE PROCEDURE APPEALS

Prior to the reform, the contentious-administrative courts would hear appeals against SPTO decisions ending the administrative phase.

Basic Law 7/2022 of 27 July<sup>7</sup> nevertheless amended the Basic Law on the judiciary (“LOPJ” – Spanish acronym) and the Civil Procedure Law (“LEC” – Spanish acronym) to grant specialist commercial courts at the provincial level appellate jurisdiction over SPTO decisions (articles 82.2.3 and 82 *bis* of the LOPJ, among others). And this applies not only for SPTO decisions regarding invalidity and revocation, but also industrial property (e.g. trademark, opposition and patent registration or refusal).

Territorial jurisdiction, in turn, is granted to specialist commercial sections of courts at the provincial level of the city where the High Court of Justice of the applicant's autonomous region is located or, failing that, the domicile of the applicant's duly authorised representative in Spain, provided the General Judicial Council has granted the commercial courts of that city exclusive jurisdiction over industrial property matters (the provincial courts of Barcelona, Madrid, Valencia, Granada, Las Palmas de Gran Canaria, A Coruña and Bilbao<sup>8</sup>), or, alternatively, the Provincial Court of Madrid, as the SPTO is located there.

Provincial court decisions can be appealed to the Supreme Court (*casación*) if the requirements are met.

## 3. COURT COORDINATION

The Directive also amends article 61 of the Trademark Law and introduces two new articles (61 *bis* and 61 *ter*) to regulate how the administrative and judicial proceedings are to function.

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<sup>7</sup> Basic Law 7/2022 of 27 July amending the role of the commercial courts under Basic Law 6/1985 of 1 July on the judiciary.

<sup>8</sup> By resolutions of 18 October 2018 and 24 April 2019, the Standing Committee of the General Judicial Council granted provincial courts exclusive jurisdiction over civil cases arising under Patent Law 24/2015 of 24 July; Trademark Law 17/2001 of 7 December; and Law 20/2003, of 7 July on the legal protection of industrial design.

As a result,

- (i) the courts must reject an invalidity or revocation counterclaim (*demanda reconvenicional*) if the SPTO has issued a final and binding decision on an application involving the same subject matter, cause of action and parties; and
- (ii) the SPTO must reject an invalidity or revocation application if a court has handed down a final and binding judgment on a counterclaim involving the same subject matter, cause of action and parties.

The principle of priority applies, meaning that the SPTO must suspend *ex officio* the processing of an application if a court is already hearing a case (as a counterclaim) involving the same subject matter and vice versa. But if a court is already hearing a trademark infringement action and is aware that proceedings are underway before the SPTO on the invalidity or revocation of the allegedly infringed trademark, the court can decide – depending on how the SPTO’s decision could affect its judgment – whether or not to suspend the administrative proceedings.

On the other hand, if trademark infringement proceedings have been initiated, the defendant cannot file an invalidity or revocation petition with the SPTO but can file the corresponding counterclaim before the same court.

This dual method requires effective communication between the courts and the SPTO. To this end, the courts must notify the SPTO *ex officio* of the date on which any counterclaim for invalidity or revocation of a trademark is filed. Once notified, the SPTO must inform the court whether there exists an earlier trademark invalidity or revocation procedure involving the same subject matter as the civil proceedings. If there is, the court will suspend the proceedings until the SPTO issues a final and binding decision on the case.

Invalidity or revocation applications, or claims – as well as final decisions or judgments – will be recorded in the SPTO’s trademark register. Once a decision or judgment revoking a trademark or declaring it invalid becomes final, the SPTO will immediately cancel its registration and publish its decision in the OGIP.

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