



Royal Decree-Law 23/2018, of December 21, on the transposition of directives related to trademarks, rail transport and travel packages and related travel services was published in the Official State Gazette (BOE) of December 27.

This Royal Decree-Law, in its Title I, amends the current Trademark Law, Law 17/2001, of December 7.

This amendment to the Law will become effective on January 14, 2019 in nearly all of the articles thereof, with one exception, which we will discuss, which has an effective date that is delayed until January 14, 2023.

This law entails the nearly literal transposition of the content of the Directive (EU) 2015/2436 of the European Parliament and of the Council, of December 16, 2015 related to the approximation of the laws of the Member States relating to trademarks. The enactment of a new Trademark Law has been discarded upon considering that the content of said Directive did not affect the entire Law in force, thus opting for an amended law.

The amendments made refer to fundamental questions relating to trademark law and especially procedural questions relating to the registration procedure, being those that we consider to be of greater interest to you and which we discuss below.

## CONCEPT OF TRADEMARK

It is of interest to note an important amendment that affects, more than the concept of a trademark, the **way of presenting** the distinctive sign which consists the trademark and focuses on current and future technological advances.

Indeed, the signs that are submitted to the registry are admitted, such that it enables the competent authorities and the public in general to determine the clear and precise object of the protection conferred to its holder. The representation must be clear and precise.

## ABSOLUTE GROUNDS OF REFUSAL

The main amendments were made by systemizing the references to the designations of origin and geographical indications, traditional designations of wine and traditional specialities guaranteed. Moreover, a new prohibition is introduced referring to those signs that consist of or reproduce, in their essential elements, the designation of a plant variety.

## WELL-KNOWN TRADEMARKS AND TRADE NAMES

In the current regulation, the prior distinction between well-known trademarks and trade names disappears, providing a single category of notoriety in Spain -national trademarks- or in the European Union - European Union trademarks-.

On the other hand, adapting to the current jurisprudential interpretation of the Spanish and European trademark legislation, it is stated that **it will not be necessary that there is a likelihood of confusion between the conflicting trademarks in order to result in registration incompatibility when the previous one is renowned**, provided that it exists identity or similarity between the signs and is intended to obtain unfair advantage from the distinctive character or reputation of the prior trademark, or when the use of the new sign may be detrimental to said distinctive character or reputation.



## APPLICATION AND REGISTRATION PROCEDURE AND SUSPENSION OF THE APPLICATION AND EXAMINATION OF THE OPPOSITION

It is worth highlighting how **the new regulation establishes the power of the applicant to require the opponent to prove the use of his registered trademarks that served as the basis of his opposition, whether that use was already enforceable in accordance to the provisions of the law or, failing that, proving the existence of justifying causes for the lack of use.**

Thus, the lack of proof of use or the proof thereof only for part of the goods or services on which the opposition is based will lead to the total or partial rejection of said opposition.

This amendment is particularly important. This rule will be applicable once the timely regulatory development of these provisions take place, which we believe will occur shortly.

## OTHER MATTERS OF INTEREST RELATED TO THE CONTENT OF THE TRADEMARK LAW

Likewise, substantial amendments are contained in the new regulation related to the content and scope of the Trademark Law, the legal provision being an amendment of interest according to which, as occurs in Patent Law, **a trademark right could not be invoked to exempt its holder from responding to the actions carried out against him/her due to the infringement of other industrial or intellectual property rights that have a prior priority date.**

It is also of interest to recognize the right of the holder of the trademark in order to prohibit the use thereof as a trade name or corporate name or as part of a trade name or corporate name, which leads to the possibility of actions, which certainly existed before, although based on other legal provisions.

**Regarding the limitations of the Trademark Law, it is worth mentioning the amendment referring to the impossibility of the holder of the trademark to prevent, only with respect to natural persons, the use of its name and address,** demanding that said use is in accordance with the honest practices related to industrial or commercial matters.

Concerning the **use of the registered trademark**, the day from which the period of time would start counting is amended, once the trademark is registered. During this period, the trademark must be put to genuine and effective use, which **will now take place for five years from the date on which the registration of the trademark is made**, date which will be noted in the registry.

The legitimacy of the licensee to carry out actions related to the infringement of a trademark is recognized. To the non-exclusive licensee only with the consent of the holder of the trademark. To the non-exclusive licensee if the holder, previously required by the latter, has not carried out the action.

In any case, the licensees may intervene in the actions involving trademark infringement initiated by the holder, with the purpose of obtaining the corresponding compensation for damages.

## NOVELTY AND REGISTERED TRADEMARK REVOCATION

This matter involves **a substantial amendment**, since **the competence to understand these actions, notwithstanding the possible approach thereof via counterclaim, will correspond to the Spanish Patent and Trademark Office.**

However, this legally established provision does not immediately become effective; instead, it will do so on December 14, 2023.

As a result, the main changes that can be noted in the amendments to the current Trademark Law are disclosed, the majority of which will immediately become effective on January 14, notwithstanding the necessary regulatory development for applying the provisions related to the procedure for opposing a trademark application when the holder of the contested trademark requires from the opponent the proof of use of the trademark that served as the basis of his opposition.

If you have any questions or comments, please do not hesitate to contact us.