

I. TRADE MARKS

Spain incorporated the provisions of the First Trade Mark Directive (89/104/EEC) in Law 32/1988 of Trade marks. The provisions of this Directive have been fully incorporated into current law 17/2001 of 7 December. The rules incorporate a new concept of trade mark, a reformulation of the grounds for revocation and an extension to the Community scope for the exhaustion of trade mark rights and of the sanctions for infringement.

Spanish law provides protection for notorious trade marks known within the specialised fields in each of the sectors of the market. They enjoy a particular regime in which the speciality principle is weakened and the classes in which such “notorious” trade marks are included are not only those for which they were applied for, but also the adjacent ones. On the contrary, “renowned” trade marks are those which have been intensively used – for example through sales or advertising – that they become known to all consumers. The speciality principle does not play any part in these trade marks and the same trade mark cannot be registered for any other kind of product or service at all.

There are notable differences between the procedure for opposing a trade mark application under Spanish law and that under the European Community Trade Mark Regulation (Regulation 40/94). Under Spanish law, there is a two month period within which a prior trade mark holder can oppose the registration of the newer mark. By contrast, the Regulation grants a three-month term.

2. PATENTS

2.1 INTRODUCTION

Patents are regulated by Law 11/1986. Spain is awaiting uniform legislation through Regulations and therefore the European Patent Convention is the only manner of internationalising and harmonising the laws of the different Member States of the European Union.

Law 11/1986 protects two kinds of inventions, depending primarily on the extent to which there is an inventive step.

The “major” and more complex inventions are protected under the title of “patent”, which requires, in addition to an inventive step and industrial application, novelty on a world-wide level. The second kind of invention is the so-called “utility model”, which requires a lesser inventive step, and can consist of improvements or accessory inventions to patents which already exist (although it should be noted that process patents and plant varieties cannot be protected under this model).

The ownership of patents is governed by articles 15 to 20 of Law 11/1986, which provides that:

- (a) inventions created by an employee during their employment contract and which result from the activity which constitutes the object of their contract belong to their employer;
- (b) free inventions belong to their creator; and
- (c) where an invention relates to its inventor's profession and is the result of knowledge acquired in the course of their employment ("experience inventions"), ownership may be assumed by the entrepreneur, provided a fair monetary compensation is paid to the employee.

2.2 REGISTERED DESIGNS

Law 20/2003 establishes that industrial drawings and models may be protected under international and domestic laws and shall be referred to as "designs".

The protection for industrial designs shall be independent, in addition to and compatible with that afforded by intellectual property, provided the design satisfies the requirements of creativity and originality for obtaining protection as an art work according to the rules of intellectual property.

In respect of the procedure for registering designs, an essential difference between Spanish Law and Regulation 6/2002 on Community Drawings and Models is that the Spanish procedure allows for opposition proceedings to be issued after the design has been registered, whilst, under the Community procedure, a nullity action is only possible if brought after the publication of the design.

Under Spanish law, only registered designs are protected. Unregistered designs are protected by Community law, but this only protects against the copying of the design.

The Spanish system is otherwise consistent with Community legislation and the most important point of both legal systems is the protection of the design both in its registered and unregistered versions which is set out in the paragraph related to the protection of registered and unregistered rights below.

2.3 COPYRIGHT

The main Spanish law regarding author's rights, or *copyright*, is the Adapted Text of Intellectual Property Law 1/1996. At a European level, Directive 93/98/EEC harmonised the term of protection for author's rights and certain related rights, and this has been complemented by the more recent Directive 2004/48/EC.

Copyright protection arises automatically when a work is created. No registration is necessary. Copyright lasts for 70 years from the year of the author's death. In the case of co-authorship, this term starts from the year of death of the last co-author.

Article 8 of Directive 2004/48/EC introduces a right to certain information when copyright is infringed. For example, information, regarding the origin of infringing merchandise or services,

the distribution channels and the identity of any person involved in the infringement may be obtained.

2.4 UNFAIR COMPETITION

Law 3/1991 of Unfair Competition finalises the protection of IP rights in Spain. It complements the related laws and rules regarding acts of imitating another's services and the comparison and exploitation of a third party's reputation, for example.

Furthermore, and in order to avoid future new cases which are not included in this Law, article 5 contains a general clause which deems unfair acts contrary to good faith. This applies provided the unfair acts take place in the market with the purpose of spreading the infringing party's own services or those of a third party. The existence of direct competition between the parties is not necessary. The law applies provided the infringing acts have an effect within the Spanish territory.

3. PROTECTION OF RIGHTS

The laws governing different forms of intellectual property right each contain provisions relating to the protection and enforcement of rights. These provisions are supported by the 1995 Criminal Code and Spanish Civil Procedural Law 1/2000. In addition, *Law 19/2006 of 5 June* adopts Directive 2004/48/EC and fully harmonises the Spanish system for enforcing intellectual property rights with the Community system.

It is possible for rights holders to obtain from an infringing party details of the origin and distribution channels of the infringing goods or services (such as the names and addresses of the producers, manufacturers, wholesalers and retailers and the number of units produced, manufactured, or delivered) as well as access to financial or commercial documents under the control of the alleged infringer. It is also possible to secure evidence before proceedings are initiated without it being necessary for the defendant to be heard.

Reforms to Spanish Intellectual Property law have increased the availability of remedies to a rights holder. Remedies which can be sought include an order for the total or partial reproduction of the Judgement at the infringer's costs and an order for the suspension of any activity infringing an IP right (even when such activity has not yet commenced). It is also possible to obtain a precautionary order restraining infringing acts upon knowledge of an imminent infringement.

The Patent Law and the Trade mark and Designs Laws have been modified by Law 19/2006 so that proceedings may be taken against intermediaries to prevent current and future infringing activities by a third party, even where the acts of the intermediary do not in themselves constitute an infringement.

Law 19/2006 also provides that the damages available to a right holder as a consequence of an infringement shall be based not only on the value of the loss suffered, but also the benefit obtained by the infringing party as a result of his actions. In addition, the indemnity award can include investigation expenses incurred in obtaining evidence of the infringement.

Finally, it is worth noting that all intellectual property matters are heard by the new Mercantile Courts, allowing proceedings to be conducted by specialised judges.

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