



POLITECNICO
MILANO 1863

DIPARTIMENTO DI ENERGIA

ADMINISTRATIVE PROCEDURE FOR INVALIDATION AND REVOCATION OF TRADEMARKS BEFORE THE SPANISH PATENT AND TRADEMARK OFFICE

Entry into force: 14th of January 2023

Bird & Bird

Manuela Mendigutía Gómez

manuela.mendigutia@twobirds.com

INVALIDITY AND REVOCATION PRE-REFORM

Direct Action

- Claim

Indirect
Action

- Counterclaim in
infringement procedures

**CIVIL
JURISDICTION**

INVALIDATION AND REVOCATION PRE-REFORM

Procedure before Courts is long... and costly

- Procedural fees
- Court Liaison needed (extra expense).
- Notification of proceedings to Foreign defendants can be both expensive and uncertain
- First instance takes an average of three years to resolve.
- Spanish Court procedures are unflexible, all arguments and evidence must be submitted at the beginning of the procedure.
- Legalized Power of Attorney necessary.

INVALIDATION AND REVOCATION PRE-REFORM

However it had its benefits

- Expertise of Commercial Courts.
- Opportunity to defend the case in Oral Hearing.
- Opportunity to examine witnesses.

INVALIDATION AND REVOCATION POST-REFORM (General proceedings)



INVALIDITY GROUNDS FOR ABSOLUTE NULLITY

ARTICLE 51 SPANISH
TRADEMARK LAW (LM):
GROUNDS FOR ABSOLUTE
INVALIDATION

Infringement of the article 5 LM:
Absolute grounds for refusal.

Badfaith in the applicant's conduct when filing the trademark application.

ARTICLE 51.3 LM:
SECONDARY MEANING

When causes 5.1.b), c) or d) have disappeared at the time of submission of the application of invalidity.

b) devoid of any distinctive character

c) Descriptive signs.

d) signs which have become customary

INVALIDITY GROUNDS FOR RELATIVE NULLITY

Infringement of articles 6 to 10 LM:
Relative grounds for refusal

*ARTICLE 52 LM:
RELATIVE GROUNDS
FOR INVALIDATION
(ARTICLE 52 LM)*

Effects of consent on registration (article 52.3 LM): A trade mark may not be declared invalid if, before the filing of the application for declaration of invalidity or the counterclaim, the proprietor of one of the rights referred to in the Articles referred to in paragraph 1 has expressly consented to the registration of that trade mark.

INVALIDITY RELATIVE GROUNDS FOR NULLITY

ARTICLE 52.2 LM: ACQUIESCENCE

- Where the proprietor of Spanish prior right has acquiesced, for a period of five successive years, in the use of a later registered trademark in Spain, being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark to apply for a declaration that the later trade mark is invalid in respect of the goods or services for which the later trade mark has been used, unless bad faith or representative mark are alleged.
- The proprietor of a later trademark shall not be entitled to oppose the use of the earlier right, even though that right may no longer be invoked against him.

INVALIDITY GROUNDS FOR RELATIVE NULLITY

ARTICLE 52.4 LM: PRECLUSION

- Where the proprietor of a prior right has previously applied for a declaration that a Spanish trademark is invalid or made a counterclaim in infringement proceedings, he may not submit a new application for a declaration of invalidity or lodge a counterclaim on the basis of another of the said rights which he could have invoked in support of his first application or counterclaim.
- ART 53 LM: RETRO-ACTION EXAM
- Taking into account the distinctive character and reputation of the earlier mark at the date of filing or priority of the contested mark

INVALIDITY

INVALIDITY BASED ON EARLIER TRADE MARK

ART 59 LM: INTRODUCTION PROOF OF USE - *Prior application by the proprietor of the contested trade mark*

- Obligation to prove prior trademark use when register > 5 years
- 5 years preceding the application for a declaration of invalidity
- 5 years prior to the filing or priority date of the contested trade mark

INVALIDITY AND EXPIRY

INVALIDITY BASED ON EARLIER TRADE MARK



INVALIDITY

EFFECTS OF THE DECLARATION OF INVALIDITY (60LM)

The declaration of invalidity implies that the registration of the trade mark was never valid (ex tunc effects).

Without prejudice to the compensation for damages if the trade mark owner has acted in bad faith, the retroactive effect of the invalidity does not affect the validity of the trade mark:

- Judgements on infringement of the trade mark which have been enforced
- Contracts concluded and performed prior to the declaration of invalidity

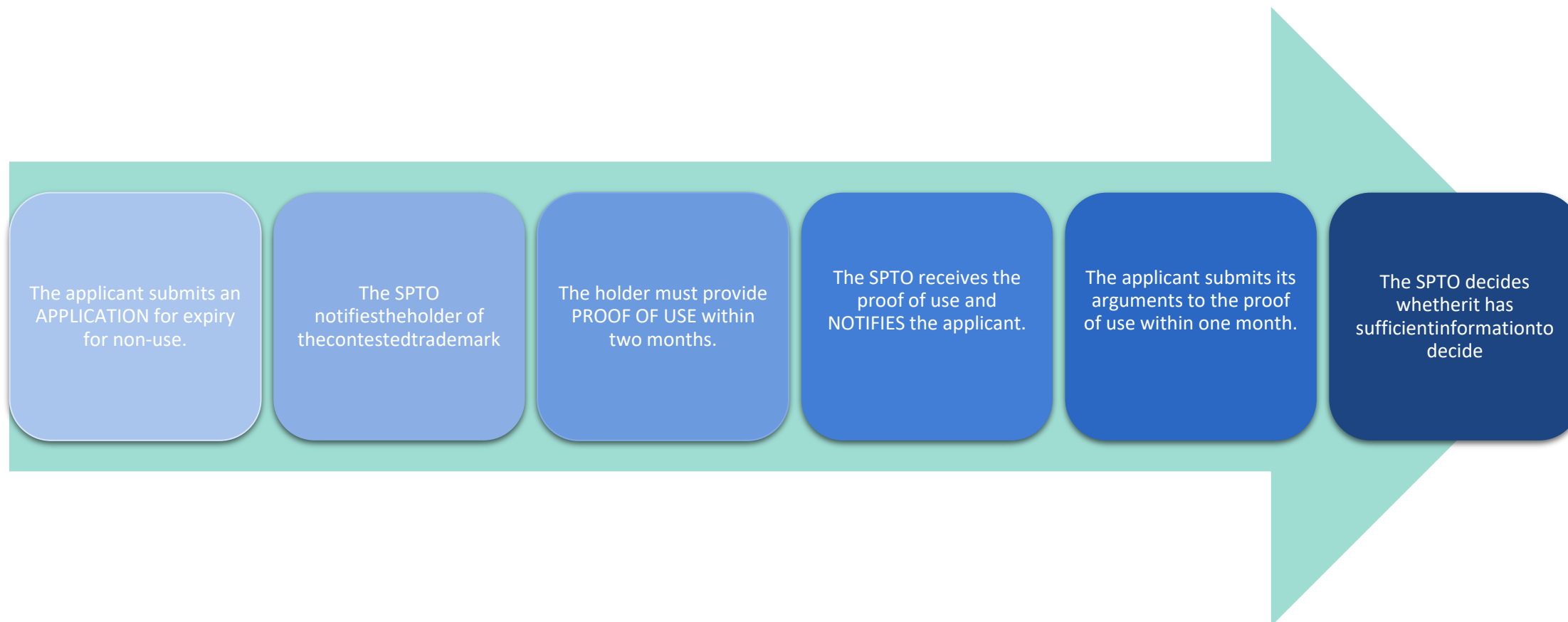
REVOCAZIONE CAUSES

01 ART 54.1.a): EXPIRY DUE TO LACK OF USE

02 ART 54.1.b): EXPIRY DUE TO BECOME A GENERIC
TRADEMARK

03 ART 54.1.c): EXPIRY FOR MISLEADING NATURE

EXPIRY CAUSES



EXPIRY

EFFECTS OF THE DECLARATION OF EXPIRY (60 LM)

Cessation of legal effects

- By default: from the date of filing of the application or counterclaim (ex nunc effects)
- At the request of one of the parties: earlier date = cause of expiry

The retroactive effect of the revocation shall not affect:

- Trade mark infringement decisions enforced
- Contracts concluded and executed before the declaration of expiry

COMMON RULES

FINALITY OF JUDGMENTS (61 LM)

Inadmissibility of actions in respect of which there is a final decision on merits and, where there is a threefold

Same object

Same cause

Same parties

COMMON RULES LINKING OF PROCEDURES (61*bis* LM)

The nullity or revocation proceedings initiated in the first place shall prevail

Optionalsuspension in infringement actions, at party/iesrequest

Invalidation as a counterclaim in infringement procedures must be filed before Civil Courts

ADVANTAGES

Cost would be reduced

Less rigid and burdensome procedure

Quicker decisions

Still appealable to Civil Courts



POLITECNICO
MILANO 1863

DIPARTIMENTO DI ENERGIA

Thanks for your attention!

Bird & Bird

Manuela Mendigutía Gómez

manuela.mendigutia@twobirds.com