

SUMMARY OF THE SPANISH TRADE MARK LAW

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I – DEFINITION OF TRADE MARK

A Trade mark is defined as any sign capable of being represented graphically useful to distinguish in the market the goods or services of an undertaking from goods or services of another undertaking; specially the following signs may become trade marks:

- a) Words or combinations of words, including those used to identify persons.
- b) Images, symbols, devices or sounds.
- c) Letters, numerals or combinations thereof.
- d) Three-dimensional forms, including the shape of goods or of their packaging .
- e) Any combination of the signs mentioned, as examples in a, b, c and d.

II- ACQUISITION OF RIGHTS

Registration confers proprietary rights and is therefore “attributif de propriété”. However a registration may be refused by the Trade Mark Office or invalidated by a Civil Court on grounds other than a prior registration, as referred to in paragraph 2d of chapter III (article 6 bis of the Paris Convention). Where the registration has been applied for with fraud of a third party’s rights or constitutes the breach of a contract or a legal obligation, the interested person shall be entitled to claim the ownership before a Civil Court. The action shall be brought before the registration is granted or within five years of the publication of the mention of grant or of the first use of the mark.

III SIGNS THAT ARE NOT REGISTRABLE AS TRADE MARKS

1. Absolute grounds for refusal

- a) Signs not in compliance with the definition of trade mark.
- b) Signs devoid of any distinctive character or consisting exclusively of words or signs used in trade to designate the price, the quantity, the value, the geographical origin, the production date or other characteristics of the goods or services. A distinctive sign may become non distinctive and vice-versa (see chapter VIII 2.a and chapter IX .1.a.)

- c) Signs which consist exclusively of shapes which are necessary to obtain a technical result or which result of the nature of the goods or which give substantive value to the goods.
- d) Marks contrary to the Law, public policy or morals.
- e) Marks liable to deceive the consumer as to the nature, the quality, the characteristics or the geographical origin of the goods and services.
- f) Marks for wines which contain or consist of a geographical indication identifying wines or for spirits which contain or consist of a geographical indication identifying spirits with respect to such wines or spirits not having that origin.
- g) Coats of arms, emblems, flags and denominations of the Spanish State or the Spanish regions, provinces or localities, as well as signs excluded from protection by virtue of art. 6 ter of the Paris convention or by public interest unless the applicant has been duly authorized by the respective Authorities to use and register them as a trade mark.

2. Relative Grounds for refusal

- a) Upon opposition, any sign that because of its identity with or similarity to a trade mark already protected in Spain (Spanish, CTM or international registrations or applications) to distinguish identical or similar goods or services may lead to confusion in the market; the likelihood of confusion includes the likelihood of association with the earlier trade mark.
- b) Upon opposition, any sign that because of its identity with or similarity to an earlier Spanish trade name (registration or application) covering activities identical with or similar to the goods or services to be distinguished by said sign may lead to confusion in the market; the likelihood of confusion includes the likelihood of association with the prior trade name.
- c) Upon opposition, any sign that is identical with a shop label (application or registration) for activities involving goods or services identical with those for which the new sign is intended to be registered as a trade mark.
- d) Upon opposition, any sign that because of its identity with or similarity to a non registered trade mark which on the date of application or of the priority claimed is well known in Spain in connection with identical or similar goods or services in the sense of Article 6 bis of the Paris Convention, may lead to confusion in the market; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

- e) Upon opposition, any sign identical with or similar to a trade mark or trade name already protected in Spain (Spanish, CTM or international registration or applications) to distinguish different goods or services, where the earlier trade mark or trade name is well known or has a reputation in Spain and where the use of the sign may lead to an association between its goods or services and the proprietor of the trade mark or trade name or where said use without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark or trade name. The protection of a well known trade mark or trade name will increase with the degree of knowledge of the mark in the interested or related circles and will be extended to all goods and services where the trade mark or trade name is well known by the public in general and therefore considered as reputed.
- f) Upon opposition, the legal name or an image identifying an individual, other than the applicant. The name or image of the applicant may be registered, unless it falls under prohibitions a, b or c.
- g) A name or any other sign that is generally used by the public to identify a person other than the applicant, unless the applicant is duly authorized. The objection may be raised ex-officio by the Examiner.
- h) Upon opposition, any sign that reproduces, imitates or transforms a creation that is already protected by any intellectual or industrial property right.
- i) Upon opposition, and according to article 8 of the Paris Convention, any sign that because of its identity with or similarity to an earlier non-registered trade name covering activities identical with or similar to the goods or services to be distinguished by said sign, may lead to confusion in the market. The opponent shall provide proof of use of the trade name in Spain or, as an alternative, evidence showing that the trade name is well known throughout the Spanish territory. However the case Law has laid down that proof of previous use in the country of origin should be sufficient.
- j) According to article 6 septies of the Paris Convention, where a trade mark is applied for in the name of the agent or representative of a person who is the proprietor of that trade mark without the proprietor's authorisation, the latter shall be entitled to oppose the application unless the agent or representative justifies his action. The proprietor shall also be entitled to oppose the use of the trade mark, to claim the ownership of its registration or to apply for the cancellation of same.

IV. DOCUMENTS REQUIRED FOR A TRADE MARK APPLICATION

1. Application form

The application includes printed forms facilitated by the Patent Office, that must be filled in and signed by a Trade Mark Agent with the following particulars:

- a) Name, address and nationality of the applicant.
- b) A representation and optionally a short description of the trade mark. The description may include a disclaimer regarding the non distinctive elements. Representations in colours are admitted.
- c) A list of the goods or services. A single application may relate to goods or services included in several classes of the international classification.
- d) Claim of priority rights, if any.
- e) If applicable, particulars about the use of the trade mark in official or officially recognized Exhibitions. The priority date of the admission of the goods in the Exhibition may be claimed if the application is filed within six months and the applicant proves that the goods have been exhibited under the mark.

2. Accompanying documents

The following documents may be filed later:

- a) Power of Attorney (no legalization required) the document must be filed within one month. There is the possibility of filing a General Power of Attorney by which the representative will be entitled to act in connection with any of the applications or registrations of the applicant.
- b) When the application is filed under article 4 of the International Convention, or under any treaty with Spain including similar clauses, a non-legalized certified copy of the registration in the country of origin must be filed, together with translation thereof into Spanish language. This document must be filed within three months of the application date.

- c) For collective and guarantee trade marks: copy of the regulations governing the use of the trade mark.

3. Official fees

A single official fee (including filing fee and registration fee for ten years) must be paid per class when filing the application . The total amount to be paid will be the result of multiplying the fee by the number of classes involved. There is no provision regarding reimbursement in case of partial or total refusal.

V. PROCEDURE – EXAMINATION – OPPOSITIONS

1. Registration procedure

It comprises the following steps:

- a) Examination as to formal requirements and as to compliance of the applicant with the conditions laid down to be entitled to obtain a trade mark registration in Spain (term for replying to formal objections: 1 month)
- b) Search in respect of earlier rights which may be invoked against the registration of the Spanish trade mark applied for. Before publication of the application the Office shall announce such publication to the proprietors of any earlier rights appearing as a result of the search, inviting them to file opposition within two months of the publication. This search shall be made in respect of Spanish trade mark applications or registrations and international trade mark applications or registrations with effects in Spain. It shall not extend to Community Trade Marks. The information regarding a conflicting new application will be only forwarded if the e-mail address of a Spanish representative has been communicated to the Office.
- c) Publication for opposition purposes (term 2 months) only if the application satisfies the formal requirements or the deficiencies have been remedied within the legal term
- d) Substantial examination as to the absolute grounds for refusal or as to the prohibition regarding the name generally used by the public to identify a

person other than the applicant (term for filing a response to the Examiner's objections: 1 month)

In the reply to the objections, the applicant may restrict the list of goods or services and/or delete the parts of the mark that have been objected to by the Examiner provided that the deletion does not imply a substantial alteration of the mark.

- e) Opposition proceedings; if oppositions have been filed they shall be notified to the applicant together with the examiner's objections in respect of the absolute grounds for refusal, if any. The applicant's response shall be filed within one month of the date of the notification.
- f) Decision, to be rendered within 12 months of the application date where no objections or oppositions have been raised; otherwise 20 months. Where the grounds for refusal only apply to some of the goods or services mentioned in the application, the refusal shall be confined to said goods or services.

An appeal against the decision may be filed before the Appeal Department of the Spanish Trade Mark Office within one month of the publication in the Industrial Property Bulletin of the mention of the decision. Should this appeal be dismissed, it will be possible to file a contentious administrative appeal before the Madrid Court of Justice within two months of the publication of the mention of the decision rendered by the Appeal Department of the Office.

2. Oppositions.

Within a period of two months following the publication of a trade mark application, oppositions may be filed on the basis of any of the absolute or relative grounds for refusal (chapter III).

The applicant is not entitled to request proof of use of the trade mark being the ground of the opposition.

As a consequence of the abolition of substantive examination against earlier rights, an earlier right will become an obstacle to a new application only if it has been the basis of an opposition. A good watching service becomes essential as well as to ensure that the proprietor of a Spanish trade mark right domiciled abroad has provided the Office with the e-mail address of a Spanish representative for reception of information regarding new conflicting applications (paragraph 1.b) of this chapter).

Oppositions based on article 8 of the Paris Convention must be supported by certificates of the Register of Commerce attesting the date at which the trade name was adopted and the activities in connection with which the firm was inscribed, as well as by evidence of the use of the trade name in Spain or evidence showing that the trade name is well known throughout the Spanish Territory.

3. Advisability of providing the Office with an address in Spain where the trade mark right consist in an international registration.

Since the only address available to the Spanish Patent and Trade Mark Office in connection with an international trade mark is that of the proprietor abroad, it becomes essential that the e-mail address of a Spanish representative be communicated to the Spanish Office by the proprietor in order to ensure the forwarding of the notifications regarding conflicting applications against which opposition could be filed on the basis of the international trade mark (paragraph 1.b) of this chapter).

Should you wish to use our e-mail for receiving such notifications, we suggest that you forward to us by e-mail a list of the international trade marks. It will be sufficient to mention the number of each mark. On reception we shall proceed to ensure that the notifications are addressed to us.

4. Suspension of the proceedings.

Suspension is possible where the opposition is based on a pending application or on a right that is the subject of revocation or invalidity proceedings or a claim of title, where a divisional application has been filed and, finally, where all interested parties file a joint application for suspension for a period not exceeding six months.

5. Division of the application

It is possible to divide the application or the registration into two or more independent applications or registrations, following a partial assignment or in order to confine the delay in registration proceedings due to oppositions, examiner's objections or appeals to one of the divisional applications, allowing the other one to mature into a granted registration without delay or, in the event of an appeal, to be free of same.

6. Amendment of errors

Material errors may be amended at any time before grant, provided neither the applicant's name, nor any of the essential features of the mark, are altered. However, an amendment concerning the trade mark itself shall be admitted, but it must be filed before publication of the application in the Industrial Property Bulletin and it entails a shift of the priority to the date at which the amendment is filed.

7. Restitutio in integrum

According to the new Trade Mark Act the restitutio in integrum (re-establishment of rights) is possible under conditions quite similar to those established in the CTM Regulation and the Munich Convention. Its application is not confined to trade marks proceedings, but extended to patents, utility models and designs.

8. Provisional protection

The trade mark is provisionally protected as from the date the application is published. The provisional protection is giving right to a reasonable indemnity.

VI. DURATION-RENEWAL

1. Duration

Registration is valid for a period of ten years from the date of filing and may be renewed for further periods of ten years an unlimited number of times. The registrations issuing from applications filed before the entry into force of the previous Act, i.e., before 12th May 1989, have a duration of 20 years from the date of grant (instead of 10 years from the application date) and are subject to the payment of quinquennial taxes until the first renewal for ten years.

2. Renewal

Application for renewal of the registration must be filed within the last six months of each ten-year period. Grace: 6 months upon payment of extra fees. The application shall be filed in the name of the registrant or its legal successor provided that an application for recording the assignment is filed simultaneously. A declaration regarding the goods or services in connection with which the trade mark has been used is no longer requested. This applies also to the renewal of registrations granted or applied for under previous trade mark Acts. A renewal fee (including filing fee and renewal fee for ten years) must be paid per class when filing the application for renewal . If several uni-class registrations of the same mark fall due for renewal at the same date it will be possible to request their renewal and simultaneously the merging of them into a single multi-class registration.

VII TRANSFER –RIGHTS IN REM- LICENSING

1. Transfer- rights in rem

The trade mark may be assigned, given as security or be the subject of other types of rights in rem independently of the undertaking. However, the forceful statement contained in the former Act regarding the trade mark's independence from the undertaking has been diluted in the new Act, and we now have what might be termed an eclectic system, in that restrictions upon this basic principle are introduced in the defence of the interest of consumers, allowing refusal of the recordal where it is clear from the documents that because of the transfer the trade mark is likely to mislead the public, particularly as to the nature, quality or geographical origin of the goods or services in respect of which it is registered or has been applied for. In such cases the recordal will be only allowed if the

assignee agrees to restrict the registration of the trade mark to goods or services in respect of which it is not likely to mislead.

Without prejudice to the provisions of the contract, a transfer of the whole of the undertaking shall include the transfer of its trade marks, unless the circumstances clearly show the contrary,

2. Licensing

Without prejudice to the provisions of the licensing contract, it will be presumed that the licence is granted for all the goods or services and for the whole of Spain, and that it is a non-exclusive licence granted without time limit.

Without prejudice to the provisions of the licensing contract, it will be prohibited to transfer the licence or to grant sub-licences.

Without prejudice to the provisions of the licensing contract, the proprietor of the trade mark shall not be entitled to use the trade mark if he has given an exclusive licence .

3. Recordal

Legal acts referred to in paragraphs 1 and 2 of this chapter shall only have effects vis-à-vis third parties after entry in the Register.

In accordance with the TLT provisions the application for recordal shall be accompanied by any of the following documents:

- a) a notarized assignment document legalized by the Spanish Consul or provided with the Apostille;
- b) a copy of the original contract certified by a Notary Public or by any other competent public authority and provided with the Apostille (or legalized by the Spanish Consul);
- c) an extract of the contract certified by a Notary Public or by any other competent public authority and provided with the Apostille (or legalized by the Spanish Consul);

- d) an uncertified certificate of transfer signed by both the assignor and the assignee (no legalisation required);
- e) an uncertified transfer document, signed by both the assignor and the assignee (no legalization required);
- f) where the change in ownership results from a merger, a copy of the Register of Commerce, certified by the authority which issued the document or by a notary public or by any other competent public authority and provided with the Apostille;
- g) where the change of ownership does not result from a contract or a merger but from another ground, such as operation of law or a court decision, a copy of the document evidencing the change, certified by the authority which issued the document or by a notary public or by any other competent public authority and provided with the Apostille.
- h) an uncertified certificate of licence, signed by both the licensor and the licensee (no legalization required)
- i) an uncertified document of licence signed by both the licensor and the licensee (no legalization required)

Where the assignment derives from a contract, for reasons of legal security it is advisable to apply for the recordal on the basis of a notarized contract.

VIII . REVOCATION

1. Non-use as a ground for revocation

The rights of the proprietor of the trade mark registration shall be declared to be revoked on request to a Civil Court or on the basis of a counterclaim in infringement proceedings if within a period of five years following publication of the mention of grant, the proprietor has not put the trade mark to genuine use in Spain in connection with the goods and services in respect of which it is registered or if such use has been suspended during an uninterrupted period of five years, unless there are proper reasons for non use.

The following shall also constitute use of the trade mark by the proprietor:

- a) Use of the trade mark in a form differing in elements which do not alter in a significant way the distinctive character of the trade mark in the form in which it was registered.
- b) Use of the trade mark in Spain in connection with goods or the packaging thereof or with services, solely for export purposes.
- c) Use of the trade mark by a third party with the consent of the proprietor.

In legal proceedings for revocation on the grounds of non use the burden of proof is on the proprietor of the trade mark who shall be requested to bring evidence of genuine use.

No person may claim that the proprietor's rights in a trade mark registration should be revoked where, during the interval between expiry of the five-year period and filing of the petition writ with the Court, genuine use of the trade mark has been started or resumed; the commencement or resumption of use within a period of three months preceding the filing of the petition writ or the counterclaim which began at the earliest on expiry of the continuous period of five years of non-use shall however be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the petition writ or the counterclaim may be filed.

2. Other grounds for revocation

Besides non-use, the following shall be grounds for revocation of a trade mark registration on request to a Civil Court.

- a) If in consequence of acts or inactivity of the proprietor the trade mark has become the common name in the trade for a product or a service in respect of which it is registered;
- b) If in consequence of the use made of it by the proprietor of the trade mark or with his consent the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of the goods or services;
- c) If in consequence of an assignment the proprietor of the trade mark no longer satisfies the conditions laid down to be entitled to obtain a Spanish trade mark registration.

Invalidation or revocation proceedings shall lie with a First Instance Civil Court located in the capital city of the Autonomous region where the defendant is domiciled. If the

defendant is not residing in Spain the action shall be brought before a Madrid First Instance Civil Court.

IX INVALIDITY

1. Grounds for invalidity

A Spanish trade mark registration shall be declared invalid on request to a Civil Court or on the basis of a counterclaim in infringement proceedings,

- a) Where the trade mark has been registered in breach of the prohibitions referred to in chapter III (absolute and relative grounds for refusal)
- b) Where the proprietor does not satisfy the conditions laid down to be entitled to obtain a Spanish trade mark registration.

A trade mark registration shall not be cancelled on the grounds of being non-distinctive if the sign has acquired distinctiveness following the use which has been made of it by the proprietor or his licensee.

2. Prescription

There is no time limit for starting invalidity proceedings where the applicant was acting in bad faith when he filed the application or where the registration was granted despite falling under an absolute ground for refusal.

Where the proprietor of a trade mark has acquiesced for a period of five successive years, in the use of a later registered trade mark while being aware of such use, he shall no longer be entitled on the basis of the earlier mark either to request a declaration of invalidity of the later trade mark or to oppose the use of same, unless its registration was obtained in bad faith.

3. Invalidity proceedings

They shall be carried out according to the ordinary declaratory judgement. The action shall be brought before a First Instance Civil Court in the Capital city of the Autonomous Region where the defendant is domiciled. If the defendant is not domiciled in Spain, the action shall be brought before a Madrid First Instance Civil court.

It is no possible to request from a civil Court a declaration of invalidity for a trade mark on the basis of a ground for invalidity about which a decision has already been rendered on a Contentious administrative appeal.

If the defendant in invalidity proceedings so requests, the proprietor of the earlier trade mark being the basis of the action shall furnish proof that during the period of five years preceding the date of the petition the earlier trade mark has been used, provided it has at that date been registered for not less than five years.

X- INFRINGEMENT

1. What is considered as infringement

An infringement action may be started by the proprietor of the trade mark against any third party using in the course of trade, without his consent, a trade mark identical or confusingly similar to the registered trade mark in relation to goods or services identical or similar to the ones covered by the trade mark registration or in relation to goods and services which are not similar to those covered by the registered trade mark, where the latter has a reputation in Spain and where the use of the sign would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the registered trade mark.

It is particularly considered as an infringement:

- a) Affixing the sign to the goods, to the packaging thereof or to the labels or any other means of identification or ornamentation of the goods or services.
- b) Offering the goods or putting them on the market or stocking them for these purposes under the registered sign or offering or supplying services thereunder.

- c) Importing, exporting of keeping in transit or deposit within the customs area goods under the sign.
- d) Using the sign on business papers or in advertising.
- e) Using the sign in telematic communication nets or as a domain name.
- f) Manufacturing, commercialising, offering, importing, exporting, providing or stocking packagings, labels or any means for identification or ornamentation of goods or services intended to be used in acts described under b) through e).

The above mentioned provisions also apply to the owners of the non-registered trade marks referred to in article 6 bis of the Paris Convention.

2. Exhaustion of rights

Trade mark rights shall not be effective against facts accomplished in connection with a trade mark after the goods or services have been put on the market in the European Economic Area by the owner of the trade mark or with his explicit consent, unless there exist legitimate reasons to oppose further commercialisation specially where the conditions of the goods are changed or impaired after they have been put on the market.

3. Infringement actions

The deadline for commencing infringement proceedings is of 5 years from the date the action could be brought.

Actions for infringement may be brought before the Courts of First Instance of the capital city of the Autonomous Community in which the infringement occurred or in which the defendant has his place of domicile.

The plaintiff may request:

- a) The prohibitions of the infringing acts,
- b) An award of damages,

- c) The adoption of measures to secure that the use of the infringing trade mark is discontinued and that the goods, packaging thereof, labels or other means to which the mark has been affixed are withdrawn from the market,
- d) The publication of the decision, at the expenses of the losing party,
- e) The destruction or use for humanitarian purposes of the infringing goods, unless the removal of the sign is possible without detriment of same, or such destruction would cause the infringer a disproportionate damage.

If the defendant being a party in infringement proceedings so requests, the proprietor of the earlier trade mark being the basis of the action shall furnish proof that during the period of five years preceding the date of the petition the earlier trade mark has been used, provided it has at that date been registered for not less than five years.

4. Damages

The plaintiff may claim damages as well as compensation for the profits non gained as a consequence of the infringement, or alternatively refund of profits illegally gained by the infringer or payment of an amount equivalent to the royalties the infringer would have paid if he had acted as a licensee. Damages may be claimed only in connection with the infringing acts effected during the period of 5 years preceding the legal action.

Where in consequence of a decision rendered by a Court a third party is ordered to desist from use of a trade mark, the Act recognizes the right of the proprietor of that mark to claim, as a minimum and by way of compensation for damage and prejudice suffered, 1% of the infringer's turnover corresponding to the goods or services involved in the infringement. Moreover, the Act provides that the infringer shall pay "coercive damages", amounting to not less than 600 € for each day of delay before the unlawful act is effectively discontinued.

5. Judicial search to ascertain the facts

Before bringing an infringement action the plaintiff may request the Court to investigate and describe the facts supposed to constitute the infringement. The Court shall make sure that it is reasonable to presume the existence of an infringement and that there is not any other way to ascertain the real nature of the facts.

6. Injunction to secure the effectiveness of an action

An injunction may be granted to the plaintiff only if he proves that the trade mark is really used.

The Court may order:

- a) The prohibition of the infringing acts,
- b) The seizure of the infringing goods,
- c) Any measure to secure the effectiveness of an eventual award of damages.

An injunction may be requested when bringing the action before the court, and also before or after it has been brought before the Court.

XI – MARKING

There is no provision requiring indication that a Trade mark is registered. The usual marking is: “marca registrada”. The letter “R” in a circle is also used.

XII – COLLECTIVE AND CERTIFICATION TRADE MARKS

The trade mark Act also contains provisions concerning collective and certification marks.

A collective trade mark may be registered in the name of an association of undertakings, manufacturers or merchants whose members use the mark to distinguish their goods or services from the goods or services offered by those not belonging to the association.

A collective trade mark application shall contain a copy of the regulations governing the use of the trade mark. The regulations shall contain the conditions to be fulfilled by the persons authorized to use the mark as members of the association and the sanctions to be imposed to the infringers of the regulation.

A certification trade mark is a sign used to show that the registrant thereof certifies that the goods or services so identified have certain characteristics or qualities, the user being duly authorized to use the mark under the control of the proprietor.

An application for registration of a certification trade mark shall contain a copy of the regulations governing the use of the trade mark. These regulations shall include a specification of the requirements (quality, components, origins, etc.) to be fulfilled by the goods or services identified by the certification mark, as well as the measures to be established by the proprietor to control compliance with the conditions for use and the sanctions to be imposed to the infringers of the regulations. The regulations or the amendments thereof have to be approved by the Administration, and made available for public inspection.

The provisions established for normal trade marks also apply to collective and certification marks; however they shall not be subject to the prohibition to register geographical names and they shall be cancelled on the following grounds (besides the grounds applicable to normal trade marks):

- a) the proprietor has authorized or tolerated the use of the trade mark under conditions that infringe the regulations,
- b) the membership to an association owning a collective or a certification mark that is formed by a geographical name has arbitrarily refused to a person fulfilling the requirement set for membership,
- c) the use of a collective or a certification mark has arbitrarily refused to a person having proved that he has the capacity to comply with the requirements established in the regulations.

XIII TRADE NAMES

Trade names may be registered under the Trade Mark Act. A trade name is any appellation or signed used to identify the business activities of an individual or a juridical person. Family names, company names, fancy names, names evoking the activities of the firm, logos, anagrams or combinations thereof may be registered as trade names.

The aforementioned regulations concerning application, grounds for refusal, granting procedure, renewal, use, revocation, invalidity, infringement and jurisdiction apply also to the trade names.

XIV - UNFAIR COMPETITION

The Spanish Unfair Competition Act of 10 January 1991, provides means to protect the use of unregistered trade marks in our country or to reinforce the protection of registered trade marks. It is specially applicable to reinforce the protection granted by the Trade Mark Act to non registered well known or reputed trade marks. Where the non-registered trade mark cannot be considered well known or reputed, the unfair competition act in some cases together with the Advertising General Act, will be the only legal means available to protect such trade marks.

Obviously, the unfair competition Act is also useful to combat unfair behaviours not involving the use of trade marks. Under the Spanish Unfair competition Act, any behaviour being objectively contrary to the requirements of good faith is deemed unfair competition. The Act mentions as examples of unfair competition, the acts misleading or causing confusion, the acts of imitation and the acts aiming to take unfair advantage or other's reputation.

In principle comparative advertising is also prohibited, however it is exceptionally allowed if it fulfills certain requirements.

The following actions are available under this Act:

- Actions requesting to declare that a particular act or behavior is unfair.
- Actions requesting the cessation of a particular act or behaviour or the prohibition of same where it is being prepared but not yet performed.
- Actions requesting the rectification of misleading, erroneous or false information.
- Actions claiming damages in cases where the unfair competition act was intentional.

- Unjust enrichment action where the enrichment derives from acts infringing an exclusive right

Under the Spanish Unfair Competition Act, on the plaintiff's petition the Courts are entitled to order the execution of an interlocutory injunction in order to ascertain facts, where the knowledge of such facts is deemed indispensable to start an action, or to order the adoption of precautionary measures in exceptional cases within a very short time and without the audience of the defendant.