SPAIN

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This guide provides a basic profile of this jurisdiction’s trademark law and practice and is not intended to take the place of professional advice given with full knowledge of the specific circumstances of each case and proficiency in the law of this jurisdiction such as might be provided by a local trademark attorney.

For more information about particular areas of practice, please see INTA’s companion online publications: Trademark Cancellations.

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GEOGRAPHICAL INDICATIONS

I. PROTECTION AND DEFINITION

• Geographical indications are protected in this jurisdiction by way of:
  • specific laws or decrees that recognize geographical indications for individual types or categories of goods. The relevant law(s) and/or regulation(s) are: Spanish legislation: Law 6/2015 of 12 May on protected designations of origin and geographical indications whose territorial scope extends to more than one of Spain’s autonomous communities; Law 24/2003 of 10 July on vineyards and wines, which provides the basic regulation, conceived with reference to EU law, governing vineyards and wines, together with their designation, presentation, promotion and advertising; Law 25/1970 of 2 December on vineyards, wine and alcoholic beverages. This remains in force, but only from a formal standpoint. It has in practice been superseded by Community law and by Law 24/2003 on vineyards and wines; and Royal Decree 1335/2001 of 3 October regulating the procedure for the processing of applications for entry of protected designations of origin and protected geographical indications in the Community register and of...
opposition thereto. Also of relevance here is Royal Decree 149/2014 which amends Royal Decree 1335/2001.

- trademark laws in the form of collective marks and/or certification marks. The relevant law(s) and/or regulation(s) are: In Spain, collective and certification marks are regulated in Chapter VII of Law 17/2001 of 7 December on trademarks.
- trademark laws generally. The relevant law(s) and/or regulation(s) are: In Spain: Law 17/2001 of 7 December on trademarks. On the EU level: Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark.
- laws against unfair competition. The relevant law(s) and/or regulation(s) are: In Spain: Law 3/1991 of 10 January on unfair competition (Article 12, taking unfair advantage of another’s reputation: It is an unfair practice to misappropriate, for the benefit of oneself or a third party, the advantages attaching to the industrial, commercial, or professional reputation acquired by another party in the marketplace. In particular, it is an unfair practice to use the distinctive signs of others or false designations of origin accompanied by an indication as to the true origin of the product or by expressions such as “sort,” “system,” “type,” “kind” or the like.)

The infringement of a protected designation of origin or protected geographical indication is deemed an act of unfair competition and is actionable under article 15.2 of the law on unfair competition (breach of rules regulating competition), in that infringement of the Community Regulation entails the breach of a rule regulating competition. Unfair competition includes unlawful advertising, to which reference is made in article 18 of the Law on unfair competition. That article refers to unlawful advertising as defined in the General Law on advertising.

- consumer protection laws. The relevant law(s) and/or regulation(s) are: In Spain: Royal Legislative Decree 1/2007 of 16 November giving approval to the consolidated text of the General Law for the defence of consumers and users and other supplementary laws.
- criminal law. Article 275 of the Penal Code provides that corresponding sanctions shall be imposed on “whosoever, intentionally and without authorization, may use in the course of trade a protected designation of origin or protected geographical indication on goods covered thereby while being aware of that protection.”

- The categories of goods that are eligible for geographical indication protection under the means of protection listed above include the following: The goods protectable under geographical indications in Spain are those listed in the EU regulations. The Spanish law does not add further goods but only makes reference to those regulations: 1) agricultural products and foodstuffs (Regulation 1151/2012 (EC)); 2) wines (Regulation 1308/2013 (EC)); 3) aromatised wines (Regulation 251/2014 (EC)); 4) spirits (Regulation 110/2008 (EC)).
- The following types of sui generis protection are available in this jurisdiction:
  - Geographical Indications.
  - Protected Geographical Indications “PGIs” (“IGPs” in some languages).
  - Protected Designations of Origin “PDOs” (“DOPs” in some languages).

Geographical Indications are defined as follows: No precise definition of “geographical indication” is given in Spanish law. In Spain “geographical indication” is a broad concept, including both protected geographical indications and designations of origin.

Geographical Indications are defined as follows: At the EU level: For agricultural products and foodstuffs, ‘geographical indication’ is a name which identifies a product: (a) originating in a specific place, region or country; (b) whose given quality, reputation or other characteristic is essentially attributable to its geographical origin; and (c) at least one of the production steps of which take place in the defined geographical area. (Article 5, Regulation (EU) No 1151/2012 on quality schemes for agricultural products and foodstuffs).

For wines, "a geographical indication" means an indication referring to a region, a
specific place or, in exceptional and duly justifiable cases, a country, used to describe a product referred to in Article 92(1) fulfilling the following requirements: (i) it possesses a specific quality, reputation or other characteristics attributable to that geographical origin; (ii) at least 85 percent of the grapes used for its production come exclusively from that geographical area; (iii) its production takes place in that geographical area; and (iv) it is obtained from vine varieties belonging to Vitis vinifera or a cross between the Vitis vinifera species and other species of the genus Vitis. (Art. 93, Regulation (EU) No 1308/2013, establishing a common organisation of the markets in agricultural products and repealing Council Regulations (EEC) No 922/72, (EEC) No 234/79, (EC) No 1037/2001 and (EC) No 1234/2007).

For aromatised wines, ‘geographical indication’ means an indication that identifies an aromatised wine product as originating in a region, a specific place, or a country, where a given quality, reputation or other characteristics of that product is essentially attributable to its geographical origin. (Article 2, Regulation (EC) No 251/2014 on the definition, description, presentation, labelling and the protection of geographical indications of aromatised wine products and repealing Council Regulation (EEC) No 1601/91).

For spirit drinks, a geographical indication identifies a spirit drink as originating in the territory of a country, a region or locality in that territory, where a given quality, reputation or other characteristic of that spirit drink is essentially attributable to its geographical origin. (Article 15, Regulation (EC) No 110/2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks and repealing Council Regulation (EEC) No 1576/89).

- Protected Designations of Origin are defined as follows: On the EU level: For agricultural products and foodstuffs, “designations of origin” is a name that identifies a product: (a) originating in a specific place, region or, in exceptional cases, a country; (b) whose quality or characteristics are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors; and (c) the production steps of which all take place in the defined geographical area. Certain names shall be treated as designations of origin even though the raw materials for the products concerned come from a geographical area larger than, or different from, the defined geographical area, provided that: (a) the production area of the raw materials is defined; (b) special conditions for the production of the raw materials exist; (c) there are control arrangements to ensure that the conditions referred to in point (b) are adhered to; and (d) the designations of origin in question were recognized as designations of origin in the country of origin before 1 May 2004. Only live animals, meat and milk may be considered as raw materials for the purposes of this paragraph (Article 5, Regulation (EU) No 1151/2012 on quality schemes for agricultural products and foodstuffs).

For wines, a "designation of origin" means the name of a region, a specific place or, in exceptional and duly justifiable cases, a country used to describe a fulfilling the following requirements: (i) the quality and characteristics of the product are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors; (ii) the grapes from which the product is produced come exclusively from that geographical area; (iii) the production takes place in that geographical area; and (iv) the product is obtained from vine varieties belonging to Vitis vinifera (Art. 93, Regulation (EU) No 1308/2013, establishing a common organisation of the markets in agricultural products and repealing Council Regulations (EEC) No 922/72, (EEC) No 234/79, (EC) No 1037/2001 and (EC) No 1234/2007).

- To establish rights in a geographical indication, or any other related designation, a registration is mandatory.

- Geographical indication protection may be obtained from the following competent authority or authorities:

At the national level two circumstances may arise: the PDO/PGI may affect just one of Spain’s autonomous communities or more than one.

Where it affects only one, the application for protection should be addressed to the
competent authority of that community. That is, in each case, the relevant department of the regional government, as shown below with the Community name followed by the name of the regional government (capitalized) and relevant department:

Andalusia: JUNTA DE ANDALUCÍA. Consejería de Agricultura y Pesca;
Aragon: DIPUTACIÓN GENERAL DE ARAGÓN. Departamento de Agricultura y Alimentación;
Asturias: PRINCIPADO DE ASTURIAS. Consejería de Medio Rural y Pesca;
Balearic Islands: COMUNIDAD AUTÓNOMA DE LAS ISLAS BALEARES. Consejería de Agricultura y Pesca;
Canary Islands: GOBIERNO DE CANARIAS. Consejería de Agricultura, Ganadería, Pesca y Alimentación;
Cantabria: GOBIERNO DE CANTABRIA. Oficina de Calidad Alimentaria (ODECA);
Castile-La Mancha: JUNTA DE COMUNIDADES DE CASTILLA-LA MANCHA. Consejería de Agricultura;
Castile and León: JUNTA DE CASTILLA Y LEÓN. Instituto Tecnológico Agrario de Castilla y León;
Catalonia: GENERALIDAD DE CATALUÑA. Secretaria de la Direcció Generalde Producció, Innovació i Industries Agroalimentàries; Extremadura: JUNTA DE EXTREMADURA. Consejería de Economía y Trabajo Dirección General de Comercio;
Galicia: XUNTA DE GALICIA. Consellería del Medio Rural;
La Rioja: GOBIERNO DE LA RIOJA. Consejería de Agricultura y Desarrollo Económico;
Madrid: COMUNIDAD DE MADRID. Consejería de Economía e Innovación Tecnológica;
Murcia: COMUNIDAD AUTÓNOMA DE LA REGIÓN DE MURCIA. Consejería de Agricultura y Agua;
Navarre: GOBIERNO DE NAVARRA. Departamento de Agricultura, Ganadería y Alimentación;
Basque Country: GOBIERNO VASCO. Departamento de Agricultura, Pesca y Alimentación Dirección de Calidad Alimentaria;
Valencian Community: GENERALIDAD VALENCIANA. Instituto Valenciano de Calidad Agroalimentaria Consejería de Agricultura, Pesca y Alimentación.

Where the PDO/PGI affects more than one of Spain's autonomous communities, the application for protection should be addressed to the Ministerio de Agricultura, Alimentación y Medio Ambiente, Direcció General de la Industria Alimentaria.

At the EU level the competent authority is the European Commission’s Directorate General for Agriculture and Rural Development.
- The following competent authority, listed above, is a governmental body that has multiple responsibilities, including geographical indication protection: all.

II. RIGHTS

- The following rights are conferred on the controlling body of a geographical indication:
  - the right to sue for infringement;
  - the right to bring a dilution action;
  - the right to bring an unfair competition action;
  - the right to claim damages;
  - the right to oppose or invalidate conflicting marks. A geographical indication may be relied on in an opposition to an application for a distinctive sign that conflicts with that GI. It may similarly be used in proceedings for the invalidation of a mark.
- The following rights are conferred on the user of a geographical indication:
  - the right to sue for infringement;
  - the right to bring a dilution action;
the right to bring an unfair competition action;
the right to claim damages.

Non-registered geographical indicators confer the following rights: Spanish law does not provide protection for non-registered geographical indications.

The law prescribes the following requirements or restrictions on the use of a Geographical Indication: Any use of a Geographical Indication (including by an entity entitled to use the Geographical Indication) for identical or similar products other than those covered by the Geographical Indication (as set forth in the specifications) is absolutely prohibited. Any use of a Geographical Indication (including by an entity entitled to use the Geographical Indication) for products different from those covered by the Geographical Indication (as set forth in the specifications) and susceptible to divert or diminish the reputation of a Geographical Indication, is prohibited. Furthermore, the name constituting a Geographical Indication may not, per se, be registered as a trademark (unless it is included in a whole, such as in a label).

The law prescribes the following requirements or restrictions on the use of a Protected Geographical Indication: Any use of a Protected Geographical Indication (including by an entity entitled to use the Protected Geographical Indication) for identical or similar products other than those covered by the Protected Geographical Indication (as set forth in the specifications) is absolutely prohibited. Any use of a Protected Geographical Indication (including by an entity entitled to use the Protected Geographical Indication) for products different from those covered by the Protected Geographical Indication (as set forth in the specifications) and susceptible to divert or diminish the reputation of a Protected Geographical Indication, is prohibited. Furthermore, the name constituting a Protected Geographical Indication may not, per se, be registered as a trademark (unless it is included in a whole, such as in a label).

The law prescribes the following requirements or restrictions on the use of a Protected Designation of Origin: Any use of a Protected Designation of Origin (including by an entity entitled to use the PDO) for identical or similar products other than those covered by the Protected Designation of Origin (as set forth in the specifications) is absolutely prohibited. Any use of a Protected Designation of Origin (including by an entity entitled to use the PDO) for products different from those covered by the Protected Designation of Origin (as set forth in the specifications) and susceptible to divert or diminish the reputation of a Protected Designation of Origin, is prohibited. Furthermore, the name constituting a Protected Designation of Origin may not, per se, be registered as a trademark (unless it is included in a whole, such as in a label).

III. APPLICATION

A. Applicant

The following parties may apply for a geographical indication registration:

- a natural person (A single natural or legal person may be treated as a group where it is shown that both of the following conditions are fulfilled: (a) the person concerned is the only producer willing to submit an application; (b) with regard to protected designations of origin and protected geographical indications, the defined geographical area possesses characteristics that differ appreciably from those of neighboring areas or the characteristics of the product are different from those produced in neighboring areas.);
- a juridical person (The same requirements mentioned above for a natural person.);
- an association of producers;
- any producer of the good;
- a group of operators. Applications may be filed by a “group of operators,” which is defined as follows: Any association, irrespective of its composition, of producers or processors working with the same agricultural product or foodstuff, including wines and spirits. Other interested parties may participate in the group. This means that, aside from producers and processors, an organization formed by
distributors, for example, may be considered a "group of operators," as it would constitute another interested party.

- The following parties are prohibited from applying for a geographical indication registration in this jurisdiction: Any parties not falling within any of the categories noted above may not apply for registration of a geographical indication.
- There are no additional requirements with regard to the parties who may apply for geographical indication registration.

B. Classification

- For geographical indications, this jurisdiction uses neither the Nice Classification System nor any other classification system for GIs.
- This jurisdiction is a member of the Lisbon Union.

The requirements for describing the goods in a geographical indication application are as follows: Please note these requirements apply on the EU level. While there is a national/Spanish phase and a European phase to a registration proceeding, the ultimate protection is provided at the EU level, not the national/Spanish level.

Agriculture products and food stuff, Art. 7. Regulation 1151-2012: A protected designation of origin or a protected geographical indication shall comply with a specification which shall include at least: (a) the name to be protected as a designation of origin or geographical indication, as it is used, whether in trade or in common language, and only in the languages which are or were historically used to describe the specific product in the defined geographical area; (b) a description of the product, including the raw materials, if appropriate, as well as the principal physical, chemical, microbiological or organoleptic characteristics of the product; (c) the definition of the geographical area delimited with regard to the link referred to in point (f)(i) or (ii) of this paragraph, and, where appropriate, details indicating compliance with the requirements of Article 5(3); (d) evidence that the product originates in the defined geographical area referred to in Article 5(1) or (2); (e) a description of the method of obtaining the product and, where appropriate, the authentic and unvarying local methods as well as information concerning packaging, if the applicant group so determines and gives sufficient product-specific justification as to why the packaging must take place in the defined geographical area to safeguard quality, to ensure the origin or to ensure control, taking into account Union law, in particular that on the free movement of goods and the free provision of services; (f) details establishing the following: (i) the link between the quality or characteristics of the product and the geographical environment referred to in Article 5(1); or (ii) where appropriate, the link between a given quality, the reputation or other characteristic of the product and the geographical origin referred to in Article 5(2); (g) the name and address of the authorities or, if available, the name and address of bodies verifying compliance with the provisions of the product specification pursuant to Article 37 and their specific tasks; (h) any specific labelling rule for the product in question.

Wine, Art. 94.2 Regulation (EU) 1308/2013: The product specification shall enable interested parties to verify the relevant conditions of production relating to the designation of origin or geographical indication. The product specification shall at least consist of: (a) the name to be protected; (b) a description of the wine or wines: (i) in respect of a designation of origin, the principal analytical and organoleptic characteristics; (ii) in respect of a geographical indication, the principal analytical characteristics as well as an evaluation or indication of its organoleptic characteristics; (c) where applicable, the specific oenological practices used to make the wine or wines, as well as the relevant restrictions on making them; (d) the demarcation of the geographical area concerned; (e) the maximum yields per hectare; (f) an indication of the wine grape variety or varieties that the wine or wines are obtained from; (g) the details bearing out the link referred to in point (a)(i) or, as the case may be, in point (b)(i) of Article 93(1); (h) applicable requirements laid down in Union or national legislation or, where provided for by Member States, by an organisation which manages the protected designation of origin or the protected geographical indication, having regard to the fact that such requirements must be objective, non-discriminatory and
compatible with Union law; (i) the name and address of the authorities or bodies verifying compliance with the provisions of the product specification, and their specific tasks.

Aromatised wine, Art.10.2. Regulation (EU) 251/2014: To be eligible for a geographical indication protected under this Regulation a product shall comply with the corresponding product specification which shall include at least: (a) the name to be protected; (b) a description of the product, in particular its principal analytical characteristics as well as an indication of its organoleptic characteristics; (c) where applicable, the particular production processes and specifications as well as the relevant restrictions on making the product; (d) the demarcation of the geographical area concerned; (e) the details bearing out the link referred to in point (3) of Article 2; (f) the applicable requirements laid down in Union or national law or, where provided for by Member States, by an organisation which manages the protected geographical indication, having regard to the fact that such requirements shall be objective, and non-discriminatory and compatible with Union law; (g) an indication of the main raw material from which the aromatised wine product is obtained; (h) the name and address of the authorities or bodies verifying compliance with the provisions of the product specification and their specific tasks.

Spirit drinks, Art. 17.4. Regulation (EU) 110-2008: The technical file referred to in paragraph 1 shall include at least the following main specifications: (a) the name and category of the spirit drink including the geographical indication; (b) a description of the spirit drink including the principal physical, chemical and/or organoleptic characteristics of the product, as well as the specific characteristics of the spirit drink as compared to the relevant category; (c) the definition of the geographical area concerned; (d) a description of the method for obtaining the spirit drink and, if appropriate, the authentic and unvarying local methods; (e) the details bearing out the link with the geographical environment or the geographical origin; (f) any requirements laid down by Community and/or national and/or regional provisions; (g) the name and contact address of the applicant; (h) any supplement to the geographical indication and/or any specific labelling rule, according to the relevant technical file.

C. Standards

- The standards or regulations must be filed along with the application.
- For Geographical Indications, the following restrictions or requirements regarding the contents of the standards or regulations apply:
  - the uniqueness of the goods and the nexus of that uniqueness with the geographical region;
  - the natural, human and geographical factors contributing to the unique characteristics;
  - a map of the geographical region from where the goods originate;
  - a map of the geographical region in which the goods are produced;
  - historical, political, cultural, culinary records (such as cookbooks and other literature on food and cooking) referring to the geographical origin of the goods;
  - a list of the producers of the goods;
  - evidence of the reputation of the goods under the Geographical Indication.
- For Protected Geographical Indications (PGIs), the following restrictions or requirements regarding the contents of the standards or regulations apply:
  - the uniqueness of the goods and the nexus of that uniqueness with the geographical region;
  - the natural, human and geographical factors contributing to the unique characteristics;
  - a map of the geographical region from where the goods originate;
  - a map of the geographical region in which the goods are produced;
  - historical, political, cultural, culinary records (such as cookbooks and other literature on food and cooking) referring to the geographical origin of the goods;
a list of the producers of the goods;
evidence of the reputation of the goods under the PGI.

For Protected Designations of Origin (PDOs), the following restrictions or requirements regarding the contents of the standards or regulations apply:
- the uniqueness of the goods and the nexus of that uniqueness with the geographical region;
- the natural, human and geographical factors contributing to the unique characteristics;
- a map of the geographical region from where the goods originate;
- a map of the geographical region in which the goods are produced;
- historical, political, cultural, culinary records (such as cookbooks and other literature on food and cooking) referring to the geographical origin of the goods;
- a list of the producers of the goods;
evidence of the reputation of the goods under the PDO.

For the other category of geographical indication specified in Section I [Protection], above, the following restrictions or requirements regarding the contents of the standards or regulations apply:
- the uniqueness of the goods and the nexus of that uniqueness with the geographical region;
- the natural, human and geographical factors contributing to the unique characteristics;
- a map of the geographical region from where the goods originate;
- a map of the geographical region in which the goods are produced;
- historical, political, cultural, culinary records (such as cookbooks and other literature on food and cooking) referring to the geographical origin of the goods;
- a list of the producers of the goods;
evidence of the reputation of the goods under the other type of geographical indication.

Standards or regulations for a Geographical Indication may be amended once filed. The amended standards or regulations for a geographical indication must be filed with the competent authority at the following time: The standards can be amended at any time. The applicant must submit the new standard, a summary of such standard and a document indicating the differences from the previous standard.

Standards or regulations for a PGI may be amended once filed. The amended standards or regulations for a PGI must be filed with a competent authority at the following time: The standards can be amended at any time. The applicant must submit the new standard, a summary of such standard and a document indicating the differences from the previous standard.

Standards or regulations for a PDO may be amended once filed. The amended standards or regulations for a PDO must be filed with the competent authority at the following time: The standards can be amended at any time. The applicant must submit the new standard, a summary of such standard and a document indicating the differences from the previous standard.

D. Special Filing Requirements

Sample contracts, licenses, or other types of use authorization must be filed along with a Geographical Indication application. The application must be accompanied by a specification containing the following: (a) proof of the use and well-known character of the name in connection with the sale of the product; (b) verification that the name is sufficiently precise and is associated with the defined geographical area; and (c) a report from the Spanish Patent and Trademark Office (SPTO) and report drawn up on the basis of the registers kept by OHIM with respect to the existence or nonexistence of registered trademarks connected with the name of the geographical indication or designation of origin.
Sample contracts, licenses, or other types of use authorization must be filed along with a PGI application. The application must be accompanied by a specification containing the following: (a) proof of the use and well-known character of the name in connection with the sale of the product; (b) verification that the name is sufficiently precise and is associated with the defined geographical area; and (c) a report from the Spanish Patent and Trademark Office (SPTO) and report drawn up on the basis of the registers kept by OHIM with respect to the existence or nonexistence of registered trademarks connected with the name of the geographical indication or designation of origin.

Sample contracts, licenses, or other types of use authorization must be filed along with a PDO application. The application must be accompanied by a specification containing the following: (a) proof of the use and well-known character of the name in connection with the sale of the product; (b) verification that the name is sufficiently precise and is associated with the defined geographical area; and (c) a report from the Spanish Patent and Trademark Office (SPTO) and report drawn up on the basis of the registers kept by OHIM with respect to the existence or nonexistence of registered trademarks connected with the name of the geographical indication or designation of origin.

E. Use/Proof of Use

There is no prescribed minimum period of use that is prerequisite to securing registration of a Geographical Indication.

Proof of use must be filed with the application. There is no specific "proof of use" to be filed; however, the applicant must demonstrate the quality or reputation of the goods, and that the geographical indication is not generic.

Acceptable proof of use documents for a Geographical Indication are:

- declaration from proprietor;
- specimens or samples of geographical indication as used (A specimen is an actual article (or photograph of such article) showing the geographical indication as used on or in connection with the goods claimed in an application or registration.);
- sales figures;
- details of goods for which the geographical indication has been used;
- documents showing the territory in which the geographical has been used;
- documents showing use by licensee.

Please note that any means of proof may be used; there is no set list.

There is no prescribed minimum period of use that is prerequisite to securing registration of a PGI.

Proof of use must be filed with the application. There is no specific "proof of use" to be filed; however, the applicant must demonstrate the quality or reputation of the goods, and that the geographical indication is not generic.

Acceptable proof of use documents for a PGI are:

- declaration from proprietor;
- specimens or samples of trademark as used (A specimen is a an actual article (or photograph of such article) showing a mark as used on or in connection with the goods or services claimed in an application or registration.);
- sales figures;
- details of goods/services for which the trademark has been used;
- documents showing the territory in which the trademark has been used;
- documents showing use by licensee.

Please note that any means of proof may be used; there is no set list.

There is no prescribed minimum period of use that is prerequisite to securing registration of a PDO.

Proof of use must be filed with the application. There is no specific "proof of use" to be filed; however, the applicant must demonstrate the quality or reputation of the goods, and that the geographical indication is not generic.

Acceptable proof of use documents for a PDO are:

- declaration from proprietor;
- specimens or samples of geographical indication as used (A specimen is an actual article (or photograph of such article) showing the geographical indication as used on or in connection with the goods claimed in an application or registration.);
- sales figures;
- details of goods/services for which the geographical indication has been used;
- documents showing the territory in which the geographical indication has been used;
- documents showing use by licensee.

Please note that any means of proof may be used; there is no set list.
goods, and that the geographical indication is not generic.

- Acceptable proof of use documents for a PDO are:
  - declaration from proprietor;
  - specimens or samples of trademark as used (A specimen is an actual article (or photograph of such article) showing a mark as used on or in connection with the goods claimed in an application or registration.);
  - sales figures;
  - details of goods for which the trademark has been used;
  - documents showing the territory in which the trademark has been used;
  - documents showing use by licensee.
  - Please note that any means of proof may be used; there is no set list.

IV. OPPOSITION

- Opposition of a geographical indication is available.
- Opposition of a geographical indication is conducted prior to grant of registration.
- The following can be grounds for the opposition of a geographical indication:
  - the controlling body does not have the locus standi or eligibility to register the geographical indication;
  - the controlling body is applying to register a geographical indication that has become a generic or “common name” in the jurisdiction;
  - proprietary rights, such as an earlier conflicting registration;
  - the geographical indication is not distinctive;
  - the geographical indication is misleading, deceptive or disparaging;
  - rights under Article 6bis of the Paris Convention (notorious or well-known mark);
  - pre-existing rights. In the case of agricultural products and foodstuffs, opposition may be filed on the ground that registration of the name proposed would jeopardize the existence of products that have been legally on the market for at least five years preceding the date of publication of the application.
- The following parties have standing to file an opposition against the registration of a geographical indication:
  - only a party with legal interest. Legal interest is defined as: Any natural or legal person, having a legitimate interest, established or legally resident in Spain, may file opposition. The time limit for opposition to an application at the national level is two months from the date of publication of the application. The time limit for opposition to an application at the EU level is three months from the date of publication in the Official Journal of the European Union. The notice of opposition may be lodged with the Commission by the authorities of a Member State or of a third country, or by a natural or legal person having a legitimate interest and established in a third country. Any natural or legal person having a legitimate interest, established or resident in a Member State other than that from which the application was submitted, may lodge a notice of opposition with the Member State in which it is established within a time limit permitting an opposition to be lodged. There is no specific definition of what constitutes legal interest. However, in Spanish case law it has been described as follows: There is legal interest when it may be presumed that the declaration sought would place the person bringing the action in a position, both legal and natural, to achieve a given material, legal or even moral benefit – without it being necessary for it to have been shown, beforehand, that he had no option but to obtain that benefit, or for him to have the support of a specific legal provision upholding his rights – and when the persistence of a situation that has been created or could be created would cause him detriment.
  - There are no bars to the user of a geographical indication opposing the registration of that geographical indication.
V. CANCELLATION

- Cancellation of a geographical indication is available.
- The following can be grounds for cancellation of a geographical indication:
  - the controlling body does not have the locus standi or eligibility to register the geographical indication;
  - the controlling body does not control, or cannot legitimately exercise control over, the use of the geographical indication
  - the geographical indication is misleading and/or deceptive;
  - the geographical indication is lacks distinctiveness;
  - the geographical indication is used in a misleading and/or deceptive manner;
  - the geographical indication should not have been registered in this jurisdiction;
  - the application for or registration of the geographical indication was made in bad faith;
  - the geographical indication has not been used.
- The following parties have standing to file a geographical indication cancellation:
  - only a party with legal interest. Legal interest is defined as: The Commission may, on its own initiative or at the request of any natural or legal person having a legitimate interest, adopt implementing acts to cancel the registration. There is no specific definition of what constitutes legal interest. However, in Spanish case law it has been described as follows: There is legal interest when it may be presumed that the declaration sought would place the person bringing the action in a position, both legal and natural, to achieve a given material, legal or even moral benefit – without it being necessary for it to have been shown, beforehand, that he had no option but to obtain that benefit or for him to have the support of a specific legal provision upholding his rights – and when the persistence of a situation that has been created or could be created would cause him detriment.
  - There are no bars to a user of a geographical indication applying to cancel the registration of that geographical indication.

VI. ENFORCEMENT AND REMEDIES

- The following entities are eligible to initiate legal action to enforce rights in a geographical indication:
  - the controlling body that certifies or otherwise controls the geographical indication.
- The following entities are eligible to initiate legal action to enforce geographical indication rights under trademark laws:
  - users of that geographical indication as protected by trademark law;
  - the controlling body that certifies or otherwise controls the geographical indication under trademark law.
- The following entities are eligible to initiate legal action to enforce geographical indication rights under unfair competition, consumer protection, or other administrative laws:
  - users of that geographical indication that is protected by unfair competition, consumer protection, or other administrative laws;
  - the controlling body that certifies or otherwise controls the geographical indication under unfair competition, consumer protection, or other administrative laws;
  - any natural or legal person operating in the marketplace whose economic interests are directly harmed or threatened by unfair conduct;
  - consumer associations, the National Institute of Consumer Affairs and other regional (autonomous) and Community entities in defense of consumers and users;
  - the Public Prosecutor's Office (only in the case of actions for injunctions).
Procedures for enforcement of a geographical indication under the sui generis law are as follows: Enforcement of geographical indications in Spain is, firstly, laid down by European Union legislation (basically Regulation (EU) No. 1151/2012) and secondarily by the Protected Designations of Origin and Geographical Indications Act, Act No. 6/2015 of 12 May 2015, which is national (supra-regional) in scope. Enforcement takes the form of legal proceedings with the Mercantile Courts in accordance with ordinary civil procedure as laid down in the Code of Civil Procedure, Act No. 1/2000. Trademark infringement proceedings follow the same procedure.

Remedies for infringement of a geographical indication under the sui generis law are as follows: Remedies for infringement of geographical indications under Spanish law are the same as the remedies generally available for infringements of intellectual property rights and include cessation of the infringing acts, relief from the effects, and compensation for damages sustained.

Procedures for enforcement of a geographical indication under unfair competition law, consumer protection laws, administrative product approval schemes, or other laws are as follows: Protection against acts of unfair competition in Spain is provided under the Unfair Competition Act, Act No. 3/1991 of 10 January 1991. As in the case of sui generis law, enforcement takes the form of legal proceedings with the Mercantile Courts in accordance with ordinary civil procedure. Consumer protection is addressed under Royal Legislative Decree No. 1/2007 of 16 November 2007 approving the consolidated text of the General Consumer and User Protection Act. This Act defines infringement of consumer and user rights and empowers the competent administrative bodies to levy fines against the parties responsible. Additionally, consumer associations, the National Institute of Consumer Affairs and other regional (autonomous) and Community entities; and the Public Prosecutor's Office may institute proceedings in the civil courts seeking cessation and prohibition of conduct infringing the regulations protecting consumer and user rights.

There is no remedy for dilution of a geographical indication under the sui generis geographical indication law.

The remedy for dilution of a geographical indication under trademark law is as follows: Spain's Trademark Act only accords protection against dilution to reputed trademarks. Geographical indications that are reputed are entitled to that same protection, which enables trademark owners to institute trademark infringement proceedings against dilution of the reputed sign.

The remedy for dilution of a geographical indication under unfair competition, consumer protection, or other administrative laws is as follows: File legal action seeking cessation and prohibition of the conduct responsible for dilution.

There are exceptions to the general restrictions on the use of a geographical indication in this jurisdiction. These exceptions are: On the EU level, for agricultural products and foodstuffs, Regulation (EU) No 1151/2012, states the following exceptions for certain prior uses: Article 42 (Plant varieties and animal breeds): (1) This Regulation shall not prevent the placing on the market of products the labelling of which includes a name or term protected or reserved under a quality scheme described in Title II, Title III, or Title IV that contains or comprises the name of a plant variety or animal breed, provided that the following conditions are met: (a) the product in question comprises or is derived from the variety or breed indicated; (b) consumers are not misled; (c) the usage of the name of the variety or breed name constitutes fair competition; (d) the usage does not exploit the reputation of the protected term; and (e) in the case of the quality scheme described in Title II, production and marketing of the product had spread beyond its area of origin prior to the date of application for registration of the geographical indication. (2) In order to further clarify the extent of rights and freedoms of food business operators to use the name of a plant variety or of an animal breed referred to in paragraph 1 of this Article, the Commission shall be empowered to adopt delegated acts, in accordance with Article 56, concerning rules for determining the use of such names.

There is no judicial, administrative or dispute resolution procedure for dealing with disputes between controlling body and users of geographical indications.

The following border enforcement measures are available for geographical indications: Goods that infringe a geographical indication are considered counterfeit in
according with Regulation (EU) n° 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights. The measures for which provision is made in that Regulation are applicable. Consequently, the customs authorities may be requested to take action with respect to goods suspected of infringing the rights of the owner.

VII. POST-REGISTRATION USE/PROOF OF USE

- Use after registration is not required to maintain a geographical indication or prevent it from becoming vulnerable to cancellation for non-use.
- A geographical indication registered in this jurisdiction cannot become generic.
- An established Geographical Indication may be invoked as a basis for opposing or canceling a later trademark application/registration.
- An established PGI may be invoked as a basis for opposing or canceling a later trademark application/registration.
- An established PDO may be invoked as a basis for opposing or canceling a later trademark application/registration.

VIII. MAINTENANCE AND RENEWAL

- There are no renewal requirements for geographical indications; they are protected indefinitely.

IX. LICENSING

- Any user who complies with the specifications is automatically entitled to use a Geographical Indication, without the need to acquire a license or further authorization from the controlling body.
- Any user who complies with the specifications is automatically entitled to use a PGI, without the need to acquire a license or further authorization from the controlling body.
- Any user who complies with the specifications is automatically entitled to use a PDO, without the need to acquire a license or further authorization from the controlling body.

X. INSPECTION, VERIFICATION, AND QUALITY CONTROL

- The controlling body is required to exercise quality control or otherwise verify the goods covered by the Geographical Indication.
- Compliance with verification or quality control schemes is controlled by:
  - the controlling body for the Geographical Indication in question (Please note, however, that the controlling body must comply with the ISO 75065 certification. In Spain, ENAC (Entidad Nacional de Acreditación) is in charge of the controlling body.)
- The controlling body is required to exercise quality control or otherwise verify the goods covered by the PGI.
- Compliance with verification or quality control schemes is controlled by:
  - the controlling body for the PGI in question (Please note, however, that the controlling body must comply with the ISO 75065 certification. In Spain, ENAC (Entidad Nacional de Acreditación) is in charge of the controlling body.)
- The controlling body is required to exercise quality control or otherwise verify the goods covered by the PDO.
- Compliance with verification or quality control schemes is controlled by:
  - the controlling body for the PDO in question (Please note, however, that the controlling body must comply with the ISO 75065 certification. In Spain, ENAC (Entidad Nacional de Acreditación) is in charge of the controlling body.)
XI. ASSIGNMENT

- A geographical indication cannot be assigned.

XII. ADVERTISING RESTRICTIONS

- When advertising a geographical indication, the controlling body has the following restrictions: On the EU level: Currently and up to 4 January 2016 the applicable rule is that laid down in Council Regulation (EC) 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, to the effect that when a product has been entered in the Community PDO/PGI register the labelling should display the expression ‘protected designation of origin’ or ‘protected geographical indication’ or an established Community symbol. Beginning on 4 January 2016, Regulation (EC) 1151/2012 will be applicable. There it is specified that when products originating in the Union have been entered in the Community PDO/PGI register the Union symbols (yet to be determined) associated with them shall appear on the labelling. In addition, the registered name of the product should appear in the same field of vision. The indications ‘protected designation of origin’ or ‘protected geographical indication’ or the corresponding abbreviations ‘PDO’ or ‘PGI’ may also appear on the labelling.

In addition, the following may also appear on the labelling: depictions of the geographical area of origin and text, graphics or symbols referring to the Member State and/or region within that geographical area of origin is located. In the case of products originating in third countries marketed under a name entered in the register, the indications or symbols mentioned above may appear on the labelling.

- When advertising a geographical indication, a user is limited by the following restrictions: The first legal framework for the protection of Spanish designations of origin dates from 1932, when the Wine Statue was adopted and made law on 26 May 1933. As the name implies, the statute related solely to wine. The scope was subsequently extended upon the enactment on 12 December 1970 of the Law on vineyards, wine and alcoholic beverages. In 2003, the most national regulation relating specifically to wine was enacted: Law 24/2003 of 10 July on vineyards and wines. European Union legislation relating to geographical indications and designations of origin has been in constant and progressive development since the 1990s and provides a legal framework taking in the recognition, protection and control of PGIs and PDOs from a harmonized perspective and with common elements for all the Member States. The EU regime supersedes national laws.

XIII. OTHER ISSUES AND ANTICIPATED CHANGES TO THE LAW

- The following changes to the law are anticipated in the near future: The creation of geographical indications for manufactured products at the European level.

CERTIFICATION MARKS

XIV. REGISTRABILITY

- “Certification marks” (or their equivalent) are registrable in this jurisdiction.
- To establish rights in a certification mark, a registration is mandatory.
- Services are registrable as certification marks.
- A mark may be used/registered both as a trademark and as a certification mark for the same goods or services.
- A mark may be used/registered both as a trademark and as a certification mark for different goods or services.
- A proprietor may register a certification mark and another kind of mark for the same goods or services.
XV. DEFINITION

- The definition of a “certification mark” (or its equivalent) is: A certification mark shall be any sign, capable of being represented graphically, used by a number of undertakings under the control and authorization of its owner, certifying that the goods or services to which the mark is applied fulfill a set of shared requirements, in particular with respect to the quality, materials, geographical origin, technical conditions, or method of manufacturing the goods or supplying the services (Article 68 of the Spanish Trademark Act).

- A certification mark may be used to signify:
  - geographic origin of goods;
  - material in which goods are comprised;
  - mode of manufacture or goods;
  - mode of performance of services;
  - quality or accuracy of goods or services;
  - other characteristics certified by the proprietor;
  - that the work or labor on the goods or services was performed by members of a union or other organization;
  - that the party under whose labor, direction, or supervision the goods were made meets certain standards or has taken and passed certain tests.

XVI. RIGHTS

- A certification mark registration confers the following rights on the proprietor:
  - the same rights conferred by a trademark registration.

For a listing of rights conferred on the proprietor of a trademark in this jurisdiction, see Country Guides: VI. Registration: B. Rights.

XVII. APPLICATION

A. Applicant

- The following parties may apply for a certification mark (or its equivalent):
  - natural person;
  - juridical person (a corporation, nonprofit organization, etc.);
  - government body or public authority;
  - an association of producers;
  - non-governmental organizations.

- The applicant/proprietor of a certification mark may not trade in the goods or services being certified.

- The following additional requirements apply with regard to the parties who may file an application for a certification mark: An application for a certification mark must include regulations governing the use of the mark, accompanied by a report issued by the competent administrative body approving those regulations.

- The application is not required to contain a statement that the applicant does not use the mark and/or does not market the goods or services to which the mark is applied.

B. Classification

- This jurisdiction classifies certification marks according to the Nice Classification System.

- There are no requirements for describing the goods/services in the application.
C. Standards

- The standards or regulations with which the certification mark is associated must be filed along with the application.
- The standards or regulations are not published by the competent authority.
- The following must be included in the standards or regulations:
  - the characteristics or qualities that are assured by the certification;
  - an explanation of how the applicant will test the presence of the characteristics or qualities to be certified;
  - the fees to be charged to those applying for certification;
  - who is authorized to use the mark;
  - a statement that the applicant will not discriminate in the issuance of a license to a party who meets all the requirements set down in the regulation. Such a statement is required only when the certification mark consists of an indication of geographical origin. In that event it must be stipulated that any person whose goods or services originate in the geographical region concerned and who fulfills the conditions set out in the regulations shall be authorized to use the mark;
  - a listing of sanctions for non-compliance by users;
  - written approval from the administrative body that may be competent depending on the nature of the goods or services to which the certification mark refers.
- The standards or regulations may be amended once filed. The timeframe for making such amendments is as follows: none specified; the regulations governing use may be amended at any time. All proposed amendments to the regulations governing use must be referred to the Spanish Patent and Trademark Office and must comply with the conditions for acceptance to which the original regulations were subject at the time the application was filed. Amendments to the regulations governing use take effect upon entry on the Register at the Spanish Patent and Trademark Office.
- The amended standards or regulations must be filed with the competent authority at the following time: at any time; there is no timeframe specified. The procedure and requirements for filing an amendment are the same as for an application. However, the applicant is required to file the new standards and a document indicating the differences between the new version and the previous version.

D. Special Filing Requirements

- The applicant/proprietor is not required to file samples of potential contracts or license agreements (between the proprietor and a party being certified).
- The applicant is not required to file a statement describing the characteristics or qualities that the mark certifies or is intended to certify. The shared characteristics of the goods or services to be certified must be specified in the regulations governing use of the mark. It is not necessary to file an additional statement with the application.

E. Use/Proof of Use

- The applicant is not required to file a statement of either current or intended use of the certification mark at any time.
- Proof of use is not required to be filed at any time.
- The following rules or exceptions pertain to fair use of certification marks: When a certification mark serves as an indication of geographical origin, the right conferred thereby shall not enable the owner to prohibit a third party from using the sign or indication in the course of trade, provided that such use is made in accordance with honest practices in industrial or commercial matters; in particular, such a mark may not be relied on as against a third party authorized to use a geographical indication.
- No other use requirements apply to certification mark applications.
F. Examination

- The distinctions between trademarks and certification marks with regard to absolute grounds for refusal and/or exceptions from prohibition from registration that apply to certification marks are:
  - an application for a certification mark registration that certifies geographic origin may not be refused on grounds of geographic descriptiveness;
  - an application for a certification mark registration can be refused because the applicant lacks authority to control a geographic term;
  - an application for a certification mark registration can be refused because the mark fails to perform a certification function, i.e., to have certification significance;
  - an application for a certification mark registration can be refused because the standards are unacceptable for the following reasons: where the regulations governing use are contrary to law, to public policy, or to accepted principles of morality, or when they do not have the minimum required content (In this last regard they must include, at least, the following: a) the name and office address of the applicant for the mark; b) a list of the requirements, components, elements, conditions, origin, or any other characteristics which the owner is to certify are fulfilled by the goods or services on which the mark is to be applied; c) a description of the measures to be taken to test these characteristics; d) a description of the systems for controlling and overseeing the use of the mark; e) an indication of the liabilities and penalties ensuing from improper use of the mark; f) an indication of the fee payable by those who use the mark; g) where the certification mark consists of an indication of geographical origin, a stipulation to the effect that any person whose goods or services originate in the geographical region concerned and who fulfills the conditions set out in the regulations shall be authorized to use the mark; h) written approval from the administrative body which may be competent depending on the nature of the goods or services to which the certification mark refers);
  - an application for a certification mark shall be refused registration where the public is liable to be misled with regard to the character or significance of the mark, in particular where it is likely to be taken to be something other than a certification mark.
- There are no distinctions between trademarks and certification marks with regard to relative grounds for refusal and/or exceptions from prohibition from registration that apply to certification marks.
- Certification marks are published or advertised after examination.

XVIII. OPPOSITION

- Certification marks can be opposed.
- Grounds for the opposition of a certification mark are the same as those for a trademark.

For a list of trademark opposition grounds in this jurisdiction, see International Opposition Guide: III. Grounds.

- The following parties have standing to file an opposition against the registration of a certification mark:
  - only a party with legal interest. Legal interest is defined as: Any person who feels aggrieved may file an opposition.
  - There is no bar that would prevent a licensee from opposing or applying to cancel a certification mark.

XIX. CANCELLATION

- The registration of a certification mark can be cancelled.
- Grounds for the cancellation of a certification mark are the same as those for a trademark, with the exceptions noted below.
For a list of trademark cancellation grounds in this jurisdiction, see Cancellations: II. Grounds.

- The following additional grounds of cancellation for certification marks are possible:
  - the proprietor does not control, or cannot legitimately exercise control over, the use of the mark;
  - the proprietor engages in the production or marketing of any goods or services to which the mark is applied;
  - the proprietor is no longer competent to certify the goods or services for which it is registered;
  - the proprietor has failed to observe or secure the observance of the regulations;
  - the public is liable to be misled as to the character or significance of the mark;
  - the regulations did not contain the required information or should not have been approved;
  - the proprietor permits the use of the mark for purposes other than to certify;
  - the proprietor discriminately refuses to certify or continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies;
  - the regulations are no longer acceptable, due to amendment or otherwise.

- Non-distinctiveness is a ground for cancelling a certification mark.

- The following parties have standing to file a cancellation against the registration of a certification mark:
  - only a party with legal interest. Legal interest is defined as: To invalidate or revoke a mark it is necessary to bring a legal action before the Spanish courts. Only a party with legal interest has standing to bring that action. There is no specific definition of legal interest; however, in Spanish case law it has been described as follows: There is legal interest when it may be presumed that the declaration sought would place the person bringing the action in a position, both legal and natural, to achieve a given material, legal or even moral benefit – without it being necessary for it to have been shown, beforehand, that he had no option but to obtain that benefit, or for him to have the support of a specific legal provision upholding his rights – and when the persistence of a situation that has been created or could be created would cause him detriment.

XX. ENFORCEMENT AND REMEDIES

- Procedures for enforcement of rights in a certification mark are the same as for those for a trademark.
- Remedies for infringement of certification mark rights are the same as those available for trademarks.
- The remedy against dilution of a certification mark is the same as those available for trademarks.
- There is no judicial, administrative or dispute resolution procedure for dealing with disputes between proprietors and users of certification marks.
- The following border enforcement measures are available for certification marks: Goods that infringe a certification mark are considered counterfeit in accordance with Regulation (EU) n° 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights. Customs authorities may be requested to take action with respect to goods suspected of infringing the rights of the certification mark owner.

XXI. MAINTENANCE AND RENEWAL

- The renewal requirements for a certification mark registration are the same as for a trademark registration.

For information regarding the maintenance and renewal of trademarks in this jurisdiction, see Country Guides: VIII. Post-Registration.
XXII. POST-REGISTRATION USE/PROOF OF USE

- Use after registration within the following timeframe is required to maintain a certification mark or to prevent it from becoming vulnerable to cancellation for non-use: Where there has been no effective and real use of the mark on the goods or services for which it was registered within a period of five years from the date of publication of the notice of registration, or where such use has been suspended for an uninterrupted period of five years, the mark may be revoked for non-use.

- Proof of use after registration is required to be filed to maintain a certification mark or to prevent it from becoming vulnerable to cancellation for non-use at the following time(s): In the event that a third party brings a non-use revocation action before the Spanish courts, proof of use would have to be submitted to avoid revocation of the registration.

- The following amount or level of use is sufficient to meet the use requirement mentioned above: The use must be "effective and real." There is no legal definition of these qualities. In light of the relevant case law, it could be outlined as: a) use, of a public and external nature, of the sign as a trademark, consisting of the marketing of goods and services, or subject to certain conditions the advertising thereof, with a certain degree of intensity and in good faith; b) use of the mark as registered (Use in a somewhat different form is acceptable, however, provided that it does not give rise to any significant alteration of the distinctive character of the sign.); c) the use must relate to the goods or services covered by the registration; d) the use may be made by the owner or by a third party acting with the owner's authorization; e) the use must be made on national territory, although affixing the mark in Spain to goods solely for export purposes also counts as use; f) the required intensity and breadth of use will depend on the specific circumstances of the case.

- Proof of use can be shown by:
  - a list of licensees;
  - license agreements;
  - the same types of specimens (a specimen is an actual article (or photograph of such article) showing a mark as used on or in connection with the goods or services claimed in an application or registration), documentation or other supporting elements that are acceptable for a trademark or service mark, as used by persons authorized to use the certification mark;
  - almost any documentation. As in the case of trademarks, there is no set list of means for proving use of a certification mark. Invoices, catalogues, brochures, advertisements, etc., may all be submitted.

- The following requirements or restrictions apply with regard to acceptable use or manner of use of a certification mark:
  - use must be through a licensee only (In principle, the proprietor is not barred from using the mark in the course of trade. But the proprietor could be barred through the regulation of certification);
  - the licensee may only use the certification mark in accordance with the regulations of certification.

XXIII. LICENSING

- The certification mark owner must allow use of the mark on all goods or services that meet the standards or conditions stipulated in the regulations.
- There are no requirements with regard to the content of certification mark licenses.

XXIV. ASSIGNMENT

- A certification mark may be assigned without the approval of any government office/authority.
The conditions and limitations applicable to the assignment of a certification mark are the same as those for trademarks and service marks.

XXV. ADVERTISING RESTRICTIONS

- The proprietor has no restrictions on advertising a certification mark.
- When advertising a certification mark, a licensee has the following restrictions:
  - the certification mark must be used in the advertisement only in the manner permitted by statute or regulation.

XXVI. OTHER ISSUES AND ANTICIPATED CHANGES TO THE LAW

- The following additional provisions, issues or considerations regarding certification marks should be mentioned: Where the registration of a certification mark has been cancelled, the mark may not be re-registered in respect of identical or similar goods or services for a period of three years from the date of publication of the notice of cancellation of the registration, or, where the registration has been revoked as a consequence of non-renewal, from the end of the grace period for renewing the registration.
- No changes to the law are anticipated in the near future.

COLLECTIVE MARKS

XXVII. Registrability

- Collective marks (or their equivalent) are registrable in this jurisdiction.
- To establish rights in a collective mark registration is mandatory.
- Services are registrable as collective marks.
- A mark may be used/registered both as a trademark and as a collective mark for the same goods or services.
- A mark may be used/registered both as a trademark and as a collective mark for different goods or services.

XXVIII. Definition and Scope

- The definition of a “collective mark” (or its equivalent) is: A collective mark shall be any sign, capable of being represented graphically, with the capacity to distinguish in the marketplace the goods or services of the members of the association that owns the mark from the goods or services of other undertakings (Article 62 of the Spanish Trademark Act).
- A collective mark may be used to signify:
  - membership in a union, association or other organization;
  - origin of the goods/services;
  - geographical origin.
- The following type(s) of collective mark can be owned by a collective group or organization and used by its members:
  - collective mark.
- The following parties may use a collective mark:
  - an association or other collective group;
  - members of an association or other collective group.

XXIX. RIGHTS

- A collective mark registration confers the following rights on the proprietor:
XXX. APPLICATION

A. Applicant

- The following parties may apply for a collective mark:
  - an organization of producers (producer associations, manufacturers, retailers or services providers with legal capacity);
  - a government body or public authority.
- There are no other additional requirements or restrictions with regard to the parties who may file an application for a collective mark.

B. Classification

- This jurisdiction classifies collective marks according to the Nice Classification System.
- There are no requirements for describing the goods/services in the application.

C. Standards

- The standards or regulations with which the collective mark is associated must be filed with the application.
- Such standards or regulations are not published.
- The standards or regulations should include the following:
  - category of persons authorized to use the mark;
  - conditions of membership;
  - conditions governing use of the collective mark;
  - sanctions against misuse of the mark;
  - the duly established and registered by-laws of the applicant association or entity. Where a collective mark consists of an indication of geographical origin, the regulations governing use shall authorize any person whose goods or services originate in the geographical area concerned and who fulfills the conditions set out in the regulations to become a member of the association.
- The standards or regulations may be amended once filed. The timeframe for making such amendment is as follows: The regulations governing use may be amended at any time. All proposed amendments to the regulations governing use must be referred to the Spanish Patent and Trademark Office and must comply with the conditions for acceptance to which the original regulations were subject at the time the application was filed. Amendments to the regulations governing use take effect upon entry on the Register at the Spanish Patent and Trademark Office.
- The amended standards or regulations must be filed with the trademark office at the following time: Amendments may be requested at any time but must be requested before the Spanish Patent and Trademark Office by the registered owner.

D. Special Filing Requirements

- It is not necessary to file samples of contracts or licenses with members.
- The applicant is not required to file a statement describing the class of persons entitled to use the mark; conditions of membership; the relationship of authorized users to the applicant; terms of use of the mark; or the nature of the applicant's control over the use of the mark.
E. Use/Proof of Use

- The applicant is not required to file a statement of either current or intended use of the collective mark at any time.
- Proof of use is not required in order to obtain registration.
- There are no use requirements that are unique to collective marks.
- The law does not prescribe requirements or restrictions on acceptable use or manner of use of a collective mark by members.
- The following rules or exceptions apply to fair use of collective marks: The right conferred by a collective mark shall not enable the owner to prohibit a third party from using the sign or indication in the course of trade, provided that such use is made in accordance with honest practices in industrial or commercial matters; in particular, such a mark may not be relied on as against a third party authorized to use a geographical indication.

F. Examination

- The competent authority has no special rules for examination collective marks.
- The distinctions between trademarks and collective marks with regard to absolute grounds for refusal and/or exceptions from prohibition from registration that apply to collective marks are:
  - the collective mark fails to perform the function of a collective mark, namely, denoting membership/certification;
  - the standards are unacceptable for reasons other than failure to comply with the application requirements mentioned above;
- Collective marks are published or advertised after examination.

XXXI. OPPOSITION

- A collective mark can be opposed.
- Grounds for the opposition of a collective mark are the same as those for a trademark.
- The following parties have standing to file an opposition against the registration of a collective mark:
  - only a party with legal interest. Legal interest is defined as: Any person who feels aggrieved may file an opposition.
  - There is no bar that would prevent a member/licensee from opposing or applying to cancel a collective mark.

XXXII. CANCELLATION

- The registration of a collective mark can be cancelled.
- Grounds for the cancellation of a collective mark are the same as those for a trademark, except in the ways described below.
- The following additional grounds for cancellation of a collective mark are possible:
  - the proprietor does not control, or cannot legitimately exercise control over, use of the mark;
  - the proprietor has failed to observe or secure the observance of the regulations;
  - the public may be misled as to the character or significance of the mark;
  - the regulations did not contain the required information or should not have been approved;
  - the regulations are no longer acceptable, due to amendment or otherwise;
  - the proprietor has arbitrarily refused admission to the association to a competent person;
the proprietor has breached any essential provision of the regulations.

Non-distinctiveness is a ground for cancellation of a collective mark.

The following parties have standing to file a cancellation against the registration of a collective mark:

- only a party with legal interest. Legal interest is defined as: To invalidate or revoke a mark it is necessary to bring a legal action before the Spanish courts. Only a party with legal interest has standing to bring that action. There is no specific definition of legal interest; however, in Spanish case law it has been described as follows: There is legal interest when it may be presumed that the declaration sought would place the person bringing the action in a position, both legal and natural, to achieve a given material, legal or even moral benefit – without it being necessary for it to have been shown, beforehand, that he had no option but to obtain that benefit, or for him to have the support of a specific legal provision upholding his rights – and when the persistence of a situation that has been created or could be created would cause him detriment.

XXXIII. ENFORCEMENT AND REMEDIES

- Procedures for enforcement of rights in a collective mark are the same as those for a trademark.
- Remedies for infringement of collective mark rights are the same as those available for trademarks.
- The remedy against dilution of a collective mark is as follows: the same as for a trademark.
- The following border enforcement mechanisms are available for collective marks: Goods that infringe a collective mark are considered counterfeit in accordance with Regulation (EU) n° 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights. The measures in that Regulation are applicable. Consequently, customs authorities may be requested to take action with respect to goods suspected of infringing the rights of the owner.
- There is no judicial, administrative or dispute resolution procedure for dealing with disputes between proprietors and users of collective marks.

XXXIV. MAINTENANCE AND RENEWAL

- The renewal requirements for a collective mark registration are the same as for a trademark registration.

XXXV. POST-REGISTRATION USE/PROOF OF USE

- Use after registration within the following timeframe is required to maintain the collective mark or to prevent it from becoming vulnerable to cancellation for non-use: Where there has been no effective and real use of the mark on the goods or services for which it was registered within a period of five years from the date of publication of the notice of registration, or where such use has been suspended for an uninterrupted period of five years, the mark may be revoked for non-use.
- Proof of use after registration is required to maintain the collective mark or to prevent it from becoming vulnerable to cancellation for non-use at the following time(s): In the event that a third party were to bring a non-use revocation action before the Spanish courts, proof of use would have to be submitted to avoid revocation of the registration.
- The following amount or level of use is sufficient to meet the use requirement mentioned above: The use must be "effective and real." There is no legal definition of this concept. In light of the relevant case law, it could be outlined as: (a) use, of a public and external nature, of the sign as a trademark, consisting of the marketing of goods and services, or subject to certain conditions the advertising thereof, with a certain degree of intensity and in good faith; (b) use should be of the mark as registered. Use
thereof in a somewhat different form is acceptable, however, provided that it does not give rise to any significant alteration of the distinctive character of the sign; (c) use must relate to the goods or services covered by the registration; (d) use may be made by the owner or by a third party acting with the owner’s authorization; (e) use must be made on national territory, although affixing the mark in Spain to goods solely for export purposes also counts as use; and (f) the required intensity of use will depend on the specific circumstances of the case.

- Proof of use can be shown by:
  - a list of the members;
  - use of the mark by members;
  - the same types of specimens (a specimen is an actual article (or photograph of such article) showing a mark as used on or in connection with the goods or services claimed in an application or registration), documents, or other elements that are acceptable for a trademark or service mark, as used by persons authorized to use the collective mark;
  - no restriction exists. As in the case of trademarks, there is no set list of means for proving use of a collective mark. Invoices, catalogs, brochures, advertisements, etc., may all be submitted.

XXXVI. LICENSING

- A collective mark owner must ensure that the goods or services in respect of which a member is using the mark comply with all conditions of membership or the license under which it is being used.
- The following requirements or restrictions apply with regard to acceptable use or manner of use of a collective mark by members/licensees:
  - the use must be through a member/license only.
  - the use must be according to the terms of membership/license.
- The following requirements apply with regard to the content of collective mark licenses:
  - requirement of local or other specialized membership.

XXXVII. ASSIGNMENT

- A collective mark may be assigned without the approval of any government office/authority.
- The conditions and limitations for assignment of a collective mark are different from those for trademarks and service marks as follows: Collective marks may only be transferred to third parties who are officially recognized by the association.

XXXVIII. ADVERTISING RESTRICTIONS

- A proprietor has no restrictions on advertising a collective mark.
- A member or licensee has no restrictions on advertising of a collective mark.

XXXIX. OTHER ISSUES AND ANTICIPATED CHANGES TO THE LAW

- The following additional special provisions, issues or considerations regarding collective marks should be mentioned: Where the registration of a collective mark has been cancelled, the mark may not be re-registered in respect of identical or similar goods or services for a period of three years from the date of publication of the notice of cancellation of the registration, or, where the registration has been revoked as a consequence of non-renewal, from the end of the grace period for renewing the registration.
- No changes to the law are anticipated in the near future.
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