

**SPAIN**

**Trademark Regulations**

Royal Decree No. 687 of July 12, 2002

ENTRY INTO FORCE: July 31, 2002

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## TITLE I APPLICATIONS FOR REGISTRATION

### Article 1. Content of an application for registration.

1. An application to register a trademark shall contain:

- a) A request to register the trademark.
- b) The applicant's name, address, and nationality and the State in which he has his domicile, headquarters, or real and effective industrial or commercial establishment. Where the application is filed in an Autonomous Community other than the one in which the applicant has his domicile, an indication of the real and effective industrial or commercial establishment owned in the territory of the Autonomous Community in which the application is being filed; the said indication shall not be required where the application is filed on behalf of the applicant by a representative who has his domicile or a real and effective branch office in the territory of the Autonomous Community in which the application is being filed. Where the applicant is a natural person, his name and surnames shall be specified, where he is a legal person, the full corporate name. A different postal address may be listed for notification purposes. Additionally, the telephone number, facsimile number, e-mail address, or other means of communication may be listed with an indication of the preferred means of notification. Where there is more than one applicant, the address or means of communication of one of them shall be specified for purposes of notification; where this is not done, notifications shall be addressed to the first applicant listed on the application form.
- c) Where the applicant's address is located outside the territory of Spain, an indication of an address in Spain for notification purposes, unless the applicant has appointed a representative domiciled in Spain.
- d) A reproduction of the trademark pursuant to Article 2 of this Regulation.
- e) A list of goods or services for which registration of the trademark is sought pursuant to Article 3 in this Regulation.
- f) Where the applicant has appointed a representative, the representative's name and address in accordance with subparagraph b), where appropriate with an indication of the real and effective branch office in the territory of the Autonomous Community in which the application is being filed pursuant to Article 11.4 of the Trademark Act, Law No. 17/2001 of 7 December 2001. No such indication shall be necessary where the applicant has his domicile, headquarters, or real and effective industrial or commercial establishment in the territory of the Autonomous Community in which the application is being filed.
- g) Where the applicant desires to claim priority from an earlier filing pursuant to Article 14 in the Trademark Act, Law No. 17/2001, a declaration

to that effect which shall list the country of filing and filing date of the said earlier application and, where available, the filing number thereof; and where the priority claim does not extend to all the goods or services listed in the application, an indication of the goods or services coming under the said claim.

h) Where the applicant desires to claim exhibition priority pursuant to Article 15 in the Trademark Act, Law No. 17/2001, a declaration to that effect which shall list the name of the exhibition and the date of the first display of the goods or services, and where the priority claim does not extend to all the goods or services listed in the application, an indication of the goods or services coming under the said claim.

i) Where appropriate, a mention that the application is for registration of a collective or certification mark pursuant to Articles 62 or 68 of the Trademark Act, Law No. 17/2001, respectively.

j) Where the application is for registration of a trademark subsequent to transformation of an international mark, a mention to that effect, with an indication of the number and date of the international mark and whether it has been granted or is pending grant of protection in Spain, pursuant to Article 83 the Trademark Act, Law No. 17/2001.

k) The signature of the applicant or his representative.

2. An application for a collective or certification mark shall include the relevant regulations governing use.

## **Article 2. Reproduction of the mark.**

1. Where the applicant does not wish to claim any specific graphic representation, sound, shape, or colour, the mark shall be reproduced on the application form in normal script using upper-case letters, numerals, and punctuation marks, typed or printed by any other suitable means. In this case, the applicant shall make a declaration to this effect on the application form, and the mark will be published and registered in the standard character set used by the Spanish Patent and Trademark Office. The standard character set used by the Office shall be published in the Official Industrial Property Gazette.

2. In all other cases not coming under paragraph 1 above, a reproduction of the mark shall be affixed to or printed in the appropriate section on the application form. The size of the reproduction shall not be larger than 8 centimetres by 12 centimetres and shall have sufficient contrast and definition to allow a clear reproduction to be made. Four additional reproductions of the mark identical to the one on the application form shall be submitted on separate sheets, size DIN A4. Where it is not obvious, the correct position of the mark shall be indicated by adding the word

"top" to each reproduction. The separate sheets shall also indicate the applicant's name and address.

3. In cases to which the preceding paragraph applies, the application shall contain an indication that the trademark filed is graphic, three-dimensional, sound, or composite in nature or a wordmark represented in non-standard characters. The application may optionally contain a written description of the mark.

4. Where registration of a three-dimensional mark is applied for, the reproduction of the mark shall consist of a two-dimensional graphic or photographic reproduction of the mark with up to six different perspectives, provided that they are grouped together to form a single reproduction which does not exceed the dimensions prescribed in paragraph 2. If the reproduction does not depict the trademark in sufficient detail, the applicant may be required to submit up to six different views and a written description of the mark.

5. Where registration of a trademark in colour is applied for, the application shall contain an indication to that effect and the colours featured in the mark shall be indicated. The reproduction under paragraph 2 shall be a colour reproduction of the mark.

6. Where registration of a sound mark is applied for, the reproduction of the mark shall necessarily be graphic in nature and may take the form of a representation on a musical staff.

7. Where the applicant wishes to exclude any of the elements making up the mark from protection as provided under Article 21.2 of the Trademark Act, Law No. 17/2001, he shall submit a disclaimer to that effect and shall indicate the elements for which no exclusive right to use is claimed.

8. The Director of the Spanish Patent and Trademark Office may direct that the mark may be reproduced in another size or format and that the number of copies of the reproduction of the mark may be fewer than four.

### **Article 3. List of goods and services.**

1. The list of goods and services shall conform to the common classification referred to in Article 1 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957 as revised and amended in the version in force for Spain.

2. The list of goods and services shall be worded clearly and precisely in the application, to the extent possible using the same terms and expressions employed in the alphabetical listing of the Nice Classification so as to allow them to be classified unmistakably in only one class of the said Classification. The nature of the goods or services on which

the mark is to be used shall in no case be an obstacle to registration of the mark. Inclusion of goods or services shall not be refused solely on the ground that they are not expressly specified in the Nice Classification.

3. The goods and services in the application shall be grouped by class according to the relevant classes in the Nice Classification. Each group shall be preceded by the number of the class of the Nice Classification to which that group of goods or services belongs in the order followed in the Nice Classification.

4. The classification of goods and services shall be exclusively administrative in scope, such that different goods and services may not be regarded as being similar to each other on the ground that they appear in the same class of the Nice Classification or as being unlike each other on the ground that they appear in different classes.

**Article 4. Voucher for payment of the application fee.**

1. The voucher attesting to payment of the application fee shall be submitted together with the application for a trademark registration. The voucher shall consist of a form to be furnished for the purpose by the Spanish Patent and Trademark Office, which shall list the fee and the amount paid together with the applicant's name, the representative where there is one, and the number(s) of the class(es) for which the fee has been paid.

2. Where the fee has been paid by computerized, electronic, or IT means, the payment voucher shall be the receipt issued consistent with the characteristics of the medium employed and shall satisfy the requirements set out above.

**Article 5. Filing of the application.**

1. Application for a trademark registration shall be filed at the venues specified in Article 11 of the Trademark Act, Law No. 17/2001, and as prescribed in that Article.

2. The application shall be submitted using the standard forms to be furnished for the purpose by the Spanish Patent and Trademark Office. However, the application shall not be refused admission if it is filed using the model international form provided in the Regulations under the Trademark Law Treaty of 27 October 1994.

3. At the request of the Spanish Patent and Trademark Office, the Ministry of Science and Technology may direct that the filing of trademark registrations may or, if appropriate, shall be carried out using magnetic media or by electronic or IT means.

4. The body competent to receive the application shall mark the documents

making up the application with the corresponding file number and the place, date, hour, and minute of filing. The Spanish Patent and Trademark Office shall devise standard systems for numbering and dating trademark applications for general use by the different competent bodies.

5. On receiving the application, the competent body shall issue the applicant with a receipt attesting to the filing. If a copy of the application is submitted, it shall be checked to ascertain that it is true to the original, and the receipt shall take the form of return of the copy, marked with the file number and the place, date, hour, and minute of filing. Where no copy is submitted, the competent body may choose to make one at its own expense and to deliver it to the applicant in accordance with the requirements just mentioned above or to issue a receipt bearing the file number, a reproduction, description, or other form of identification of the mark, the type and number of documents submitted, and the place, date, hour, and minute of filing. Where an applicant simultaneously files more than 10 applications without copies, the filing receipt may be issued within the following two working days, issuing upon receipt a voucher listing the applications received, the file numbers assigned, and the date, hour, and minute of filing.

6. Where the application is filed using the media or means specified in paragraph 3, the receipt shall be issued in consonance with the said media or means and shall satisfy the requirements stipulated in the preceding paragraph.

7. The competent body of the Autonomous Community shall forward a copy of the application marked with the file number and the place, date, hour, and minute of filing to the Spanish Patent and Trademark Office within five days of receipt of the application. The Spanish Patent and Trademark Office may set up computer, electronic, or IT means for immediately transmitting the copy of the application or the information items it contains.

#### **Article 6. Claiming Convention priority.**

1. Where the trademark application claims priority from one or more earlier applications, if he has not already done so previously the applicant shall submit the application number(s) and a copy of each duly certified by the home office within three months of the date of filing of the trademark application. Such copies shall include a certification of the filing date of the earlier application by the said receiving authority and a translation into Spanish if the earlier application was not filed in Spanish.

2. The Spanish Patent and Trademark Office may determine that the evidence in support of the priority claim may consist of fewer items than required



in the preceding paragraph, provided that the information required is available from other sources.

**Article 7. Claiming exhibition priority.**

Where a trademark application claims exhibition priority, the applicant shall, within three months from the filing date, submit a certificate issued by the exhibition authority responsible for the protection of industrial property. The certificate shall state that the mark was in fact used at the exhibition, the name of the owner of the mark, the specific goods or services on which it was used, the opening date of the exhibition, and the date of the first public use of the mark at the exhibition. The certificate shall be submitted with a means of identifying the trademark as it was actually used at the exhibition, duly certified by the above-mentioned authority.

## **TITLE II REGISTRATION PROCEDURE**

### **CHAPTER I Formal examination**

#### **Article 8. Examination of the formal requirements of the application required for assignment of a filing date.**

1. The competent body shall examine whether the application contains:

- a) An express or implied request for registration of the trademark.
- b) Information identifying the applicant.
- c) A reproduction of the mark.
- d) A list of goods or services claimed by the application.

2. If upon examination the application fails to satisfy any of the requirements set out in the preceding paragraph, the competent body shall notify the applicant that a date of filing cannot be accorded and shall indicate the irregularities observed, pointing out that if they are not corrected, the application will be deemed to have been withdrawn. To remedy the irregularities the applicant shall be allowed one month if he has an address in Spain or two months if his address is located outside the territory of Spain.

3. If the irregularities are corrected within the specified time limit as per the preceding paragraph, the filing date of the application shall be the date on which the remedial brief is received by the competent body. If the irregularities are not corrected in due form within the specified time limit, the application shall be deemed to have been withdrawn. The applicant shall be notified of the decision concerning withdrawal.

#### **Article 9. Examination of the formal requirements of the application.**

1. Upon completion of the examination specified in the preceding Article, the competent body shall examine whether the application satisfies the requirements stipulated in Articles 1, 2, 3, 4, and 5.2 of this Regulation, as well as in Articles 6 and 7 where priority has been claimed.

2. If upon examination the application fails to satisfy any of the requirements set out in the preceding paragraph, the competent body shall notify the applicant of the deficiencies observed, allowing a time limit of one month for correction and indicating that otherwise the application will be deemed to have been withdrawn in whole or in part. On replying to the notification the applicant may withdraw, limit, amend, or divide the application.

3. If the deficiencies are not corrected within the specified time limit, the application will be deemed to have been withdrawn except as provided in the following paragraphs.

4. If the deficiency observed is non-payment or incomplete payment of the application fee and the irregularity is not remedied within the specified time limit, the application shall be deemed to have been withdrawn unless the amount paid covers the application fee for one or more classes. In that case the application shall be deemed to have been withdrawn solely in respect of those classes for which the application fee has not been paid or has not been paid in full. Unless otherwise indicated by the applicant, the classes shall be deemed to have been paid in the order in which they appear in the application.

5. If the deficiencies observed relate to a priority claim, failure to correct the deficiencies shall result in loss of the priority right for the application.

6. If the deficiencies observed relate to only some of the goods or services claimed, and the deficiencies go uncorrected, the application shall be deemed to have been withdrawn or the priority right shall be deemed to have been lost only in respect of the said goods or services. The applicant shall be notified of the decision deeming the application to have been withdrawn in whole or in part or the priority right to have been lost.

**Article 10. Examination of the applicant's entitlement.**

Where the applicant may not be the proprietor of a trademark in Spain pursuant to Articles 3.1 and 3.2 in the Trademark Act, Law No. 17/2001, the competent body shall so notify the applicant, allowing a time limit of one month in which the applicant may withdraw the application or submit any arguments he deems appropriate and indicating that otherwise the application will be deemed to have been withdrawn. If the applicant does not correct the deficiency, the application shall be deemed to have been withdrawn. The applicant shall be notified of the decision deeming the application to have been withdrawn.

**Article 11. Combined notification of deficiencies and the time limit for correction.**

1. All the deficiencies in the application ensuing from breach of the requirements laid down in Article 8.1 as well as from breach of the requirements laid down in Articles 9.1 and 10 in this Regulation may be communicated to the applicant together in a single notification.

2. To correct the deficiencies communicated, the competent body shall allow the applicant a time limit of one month if he has an address in Spain or two months if his address is located outside Spain and any of the deficiencies notified involve non-compliance with the requirements set out in Article 8.1 in this Regulation.

**Article 12. Forwarding of the application.**

1. Where so authorized by an Order issued by the Ministry of Science and Technology, applications, together with the record of the proceedings and the notifications prescribed in Article 17 in the Trademark Act, Law No. 17/2001, may be forwarded by the competent bodies of the Autonomous Communities using electronic or computerized means. The general conditions and technical requirements and specifications of such communications shall be established by decision of the Director of the Spanish Patent and Trademark Office.

2. Where applications have no deficiencies or the deficiencies have been corrected, they shall immediately be forwarded to the Spanish Patent and Trademark Office.

3. Where an application has been deemed to have been withdrawn in part, it shall be forwarded only after the decision has become final, unless that portion of the application devoid of deficiencies has been split off into a divisional application on division of the application in response to an official action or on appeal, in which case it shall be forwarded as a divisional application pursuant to Article 46.5 in this Regulation.

4. The decision concerning withdrawal, when final, shall be forwarded to the Spanish Patent and Trademark Office by the competent body of the corresponding Autonomous Community, unless the decision is appealed, in which case it shall be forwarded together with a report of the filing of the appeal, the decision in the appeal, and any appeals lodged against the said decision in the courts and the judgements issued.

**CHAPTER II Examination as to lawfulness**

**Article 13. Examination as to lawfulness.**

1. Upon receipt of the trademark application, the Spanish Patent and Trademark Office shall examine whether it is in breach of the prohibition laid down in Article 5.1.f) in the Trademark Act, Law No. 17/2001, and whether it has a deficiency that will prevent it from being published.

2. If upon examination the application is in breach of the prohibition or has any of the deficiencies referred to in paragraph 1 for all or some of the goods or services claimed, an official action shall be issued on the file and the deficiencies or grounds for refusal observed shall be communicated to the applicant, who shall be allowed a time limit of one month in which to correct same or respond thereto. Where the grounds for the official action is a formal deficiency, the applicant shall be notified that if it is left uncorrected, the application will be deemed to have been withdrawn in whole or in part.

3. On replying to the official action the applicant may withdraw, limit, amend, or divide the application.

4. If the applicant is unable to remedy the objections raised, the Spanish Patent and Trademark Office shall deem the application to have been withdrawn or shall refuse the application in whole or in part, and the applicant shall be notified of these decisions. Where withdrawal or refusal is for some of the goods/services only, the portion of the application not subject to any objection will not be published until the decision has become final, unless that portion of the application is split off into a divisional application on division of the application in response to the official action or on appeal, in which case it shall be published as a divisional application.

**Article 14. Combined examination as to lawfulness and formal examination.**

1. Where the Spanish Patent and Trademark Office is the body competent to receive the application and conduct the formal examination, it may perform the examination as to lawfulness concomitantly with the formal examination provided for in the preceding chapter, notifying the applicant of both any formal deficiencies and any deficiencies relating to lawfulness observed in a single communication.

2. Where a combined examination is carried out, Article 11.2 in this Regulation shall apply.

**CHAPTER III Search for anticipations and publication of the application**

**Article 15. Search for anticipations.**

1. Where the trademark application is not in breach of any ground for refusal and evinces none of the deficiencies considered in the preceding Article, or any deficiencies that may have been present have been corrected, the Spanish Patent and Trademark Office shall carry out a computerized search of anticipatory signs on the Register of Trademarks which, if disclosed, might be entitled to oppose registration of the trademark application filed pursuant to Articles 6 and 7 of the Trademark Act.

2. On ordering publication of the trademark application, the Spanish Patent and Trademark Office shall simultaneously report publication to the owners of any earlier signs revealed by the search. This information shall be communicated to the owners or their representatives, if any, pursuant to Article 49 in this Regulation.

**Article 16. Publication of the application.**

1. On successful completion of the examination laid down in Article 13

and conclusion of the search for anticipations stipulated in the preceding Article, the Spanish Patent and Trademark Office shall order publication of the trademark application in the Official Industrial Property Gazette.

2. The publication of the application shall contain:

a) The name and address of the applicant; where there is more than one applicant, mention of the name and address of the applicant designated as the recipient for notifications, or, failing that, of the first applicant listed on the application, followed by the phrase "and others".

b) Where applicable, the name and address of the representative, other than a representative falling under Article 56.3 in this Regulation.

c) The file number, filing date, and date of receipt of the application by the Spanish Patent and Trademark Office where the application has been forwarded pursuant to Article 12 in this Regulation.

d) The reproduction of the mark, where applicable together with indications bearing on the nature of the mark as a sound mark, a three-dimensional mark, or a word mark in block letters. If a description of the mark or the disclaimer described in Article 2.7 in this Regulation has been submitted, they shall also be included in the publication. Where the trademark is applied for in colour, the publication shall appear in colour and shall indicate the colours making up the mark.

e) The list of goods and services, grouped according to the classes of the Nice Classification. Each group shall be preceded by the number of the class to which it belongs and shall be presented in the same class order appearing in the Nice Classification.

f) Where Convention or exhibition priority has been claimed, the country, number, and date of filing of the application from which Convention priority is claimed or the name of the exhibition and the date of first display.

g) Where applicable, indication that the application is for a collective or a certification mark.

3. In addition to the items set out in the preceding paragraph, publication of a trademark application ensuing from transformation of an international registration or conversion of a Community trademark application shall also contain:

a) An indication that the application has arisen as a result of transformation or conversion.

b) The number of the international registration or of the Community trademark application on which the application is based.

c) The date of the international registration or of the date of filing of the Community trademark application.

d) Where the application is entitled to a right of priority, the indications specified in subparagraph 2.f) above.

e) Where seniority has been claimed based on a Spanish trademark or a trademark having effect in Spain, the number and the filing date, or if appropriate the priority date, of the registration from which seniority is claimed.

#### **CHAPTER IV Third-party oppositions and observations**

##### **Article 17. Filing and content of the opposition brief.**

1. Any party who deems an application prejudicial to his interests may file opposition to registration with the Spanish Patent and Trademark Office within a time limit of two months from the date of publication of the said trademark application in the Official Industrial Property Gazette.

2. The opposition brief shall be filed in duplicate and shall contain the following details:

a) The file number, date of filing, and name of applicant for the trademark being opposed.

b) A clear and unmistakable indication of the goods or services listed in the trademark application against which the opposition is directed, with an indication of the class to which they belong.

c) The name and address of the person filing the opposition pursuant to Articles 1.1.b) and 1.1.c) in this Regulation.

d) Where a representative has been appointed, the representative's name and address pursuant to Article 1.1.f) in this Regulation.

e) Where the opposition is based on any of the grounds specified in Article 5.1 in the Trademark Act, Law No. 17/2001, an indication to that effect, specifying the absolute prohibition on which the opposition is based.

f) Where the opposition is based on an earlier mark, the number and the filing or priority date of that mark and whether it is a pending application or a granted registration.

g) Where the opposition is based on an earlier well-known mark within the meaning of Article 6.2.d) in the Trademark Act, Law No. 17/2001, an indication to that effect.

h) Where the opposition is based on an earlier well-known or reputed mark within the meaning of Article 8 in the Trademark Act, Law No. 17/2001, an indication to that effect.

i) Where the opposition is based on any of the prior rights specified in Articles 9 and 10 in the Trademark Act, Law No. 17/2001, an indication to that effect.

j) Where applicable, a representation and description of the prior right or mark not registered with the Spanish Patent and Trademark Office.

k) The goods and services for which the earlier trademark has been registered or applied for or for which the earlier trademark is well-known within the meaning of Article 6.2.d) in the Trademark Act, Law No. 17/2001, or has a well-known or reputed nature as laid down in Article 8 of the said Act. The opposing party should only include the goods or services covered by the earlier mark on which the opposition is based.

l) The reasons, grounds, or basis for the opposition.

m) The signature of the opposing party or his representative.

n) The voucher attesting to payment of the opposition fee.

3. The provisions of this Chapter shall also apply, as applicable, to the submission of third-party observations pursuant to Article 19.3 in the Trademark Act, Law No. 17/2001.

#### **Article 18. Filing of evidence and documents.**

1. Any other documents and evidence deemed relevant may be submitted with the opposition brief.

2. Where the opposition is based on a Community trademark, the opposition brief shall preferably be submitted with evidence of the registration or filing of the said Community trademark, such as a certificate of registration or of filing. Where the opposition is based on an unregistered well-known mark under Article 6.2.d) in the Trademark Act, Law No. 17/2001, or a registered well-known or reputed mark under Article 8 in the said Act, the opposition brief shall preferably be submitted with evidence attesting to the well-known or reputed character of the earlier mark. Where the opposition is based on any of the prior rights under Articles 9 and 10 in the said Act, the opposition brief shall be submitted with suitable evidence attesting to ownership and the scope of protection of such prior rights.

3. The documentary evidence referred to in the preceding paragraphs and any other documents or proof shall be submitted together with the opposition brief or subsequent to filing thereof, but at all events before the date on which the opposition is forwarded to the applicant.

#### **Article 19. Inadmissibility or dismissal of the opposition.**

1. The Spanish Patent and Trademark Office shall not admit the opposition where the opposition brief is not filed within the time limit provided for in Article 17.1 in this Regulation; where the opposition fee has not been paid; or where the brief does not unmistakably identify the application being opposed or the trademark or prior right on which the opposition is based.

2. Where the opposition brief does not satisfy all the other requirements



set forth in the Trademark Act, Law No. 17/2001, or in this Regulation, the Spanish Patent and Trademark Office shall report the irregularities observed to the opposing party for correction within 10 days. If the said irregularities are not corrected within the specified time limit, the opposition shall be deemed to have been withdrawn.

## **CHAPTER V Substantive examination and decision**

### **Article 20. Official examination and official action.**

1. On conclusion of the time limit for filing opposition, the Spanish Patent and Trademark Office shall conduct the substantive examination stipulated in Article 20.1 in the Trademark Act, Law No. 17/2001, regardless of whether or not any oppositions have been filed.

2. Where the substantive examination reveals the application to be in breach of any prohibition or to have any deficiency pursuant to Article 20.1 in the Trademark Act, Law No. 17/2001, or where third-party oppositions or observations have been filed and have not been deemed to be inadmissible or to have been withdrawn pursuant to the preceding Article, the Spanish Patent and Trademark Office shall issue an official action on the file and shall notify the applicant of the official objections raised and the oppositions or observations filed so that arguments in response to the official action may be submitted within a time limit of one month from publication of notice of the official action in the Official Industrial Property Gazette.

### **Article 21. Reply to the official action.**

1. The brief of reply to the official action shall specify the identifying particulars of the trademark application, the date of publication of the notice of the official action, the grounds for the official action, and any arguments or evidence deemed relevant to the defence of registration of the trademark.

2. In reply to the official action the applicant may withdraw, limit, amend, or divide the application pursuant to Articles 23 and 24 in the Trademark Act, Law No. 17/2001, or, where applicable, he may submit the disclaimer as per Article 21.2 in the said Act.

3. Requests for alteration or division of the application shall be submitted with the documents provided for in Articles 43 or 46 in this Regulation, respectively.

### **Article 22. Decision on the file.**

1. Irrespective of whether or not the applicant has filed a reply to the

official action, when the specified time limit for replying has expired, the Spanish Patent and Trademark Office shall issue a decision in the matter, granting or refusing the trademark registration in whole or in part, concisely stating the grounds and the earlier rights responsible for the refusal.

2. If pursuant to the reply to the official action the application has been divided, splitting the goods or services against which the official action is directed off from those not affected, on admitting the division the Spanish Patent and Trademark Office shall grant registration to the divisional application unaffected by the official action and shall take a decision on the divisional application to which the official action applies pursuant to the preceding paragraph.

3. Publication of the notice of refusal of registration for a trademark for all goods/services claimed shall be published in the Official Industrial Property Gazette and shall contain:

a) The file number.

b) The applicant's name.

c) The date of the decision refusing registration.

d) The date of publication of the application and the number of the Official Industrial Property Gazette and the page carrying publication of the application.

e) The numbers of the classes in which the trademark has been refused registration.

f) In the event of partial withdrawal, limitation, or amendment after publication of the application, the numbers of the classes waived, limited, or amended, in the two last-mentioned cases followed by the goods or services as limited or amended.

4. Where registration is granted for some of the goods/services only, publication of the notice concerning the portion of the application for which registration has been refused shall be effected pursuant to subparagraph 2.f) in the following Article.

## **CHAPTER VI Registration of the trademark**

### **Article 23. Publication of the trademark registration.**

1. Where the official examination reveals the application not to be in breach of any prohibition and not to contain any of the deficiencies mentioned in Article 20.1 in the Trademark Act, Law No. 17/2001, and where no oppositions have been lodged against the application or any oppositions filed were deemed inadmissible, withdrawn, or dismissed in whole or in part, or where the deficiencies officially cited have been deemed to have

been overcome following the official action issued, the Spanish Patent and Trademark Office shall grant registration of the mark in whole or in part, as appropriate, and shall order notice to be published in the Official Industrial Property Gazette.

2. Publication of the notice of grant of registration for the trademark in the Official Industrial Property Gazette shall contain:

- a) The registration number.
- b) The name of the owner of the registration.
- c) The registration date.
- d) The date of the Official Industrial Property Gazette which published notice of the application.
- e) The numbers of the classes in which registration has been granted and an indication as to whether registration has been granted for all or only for some of the goods/services claimed by the application as published. Where registration has been granted for only some of the goods or services listed in any of the classes claimed and published, the goods or services for which the trademark has finally been registered shall be indicated next to the number of each such class.
- f) Where registration has been granted only in part, the numbers of those classes for which registration of the trademark has been refused.
- g) Where the application has been partially withdrawn, limited, or amended by the applicant following publication, the numbers of the classes waived, limited, or amended, in the two last-mentioned cases followed by the goods or services as limited or amended.
- h) Where after publication of the application the trademark has been amended as provided in Article 23.2 in the Trademark Act, Law No. 17/2001, or the disclaimer referred to in Article 21.2 in the said Act has been submitted, the new trademark as amended and the content of the disclaimer.
- i) Where after publication of the application the Convention or exhibition priority or seniority claimed has been refused or any of the details of these rights amended, an indication to that effect or mention of the new details as amended.

3. Where a trademark has proceeded directly to registration subsequent to transformation of an international registration or conversion of a Community trademark, in addition to the items set out in Articles 16.2 and 16.3 in this Regulation, the publication of the notice of grant shall contain:

- a) A mention that the mark has proceeded directly to grant subsequent to transformation or conversion.
- b) The date of the decision granting registration.
- c) As appropriate, the date of grant of protection in Spain for the

transformed international registration or the date of registration accorded by the Office for Harmonization in the Internal Market for the converted Community trademark.

**Article 24. Issuance of the certificate of registration for the trademark.**

1. Upon ordering publication of the trademark registration, the Spanish Patent and Trademark Office shall issue the certificate of registration therefor, which shall contain the following items:

- a) The number of the trademark.
- b) The owner's name.
- c) The reproduction of the mark.
- d) The date of filing of the application, of the grant of registration, and, where applicable, of the priority accorded.
- e) Where applicable, the description of the trademark and the indication of any elements disclaimed.
- f) The list of goods or services covered by the registration, together with the number of the Nice Class in which they belong.

2. In the case of trademarks ensuing from transformation or conversion, in addition to the items set out in the preceding paragraph, the certificate of registration shall also contain the source mark and number thereof, the date of filing with the home office, and, where applicable, information concerning any seniority claimed.

### **TITLE III RENEWAL OF THE TRADEMARK**

#### **Article 25. Notice of expiry of the trademark registration.**

Within the eight months preceding expiry of a trademark registration, the Spanish Patent and Trademark Office may, solely for purposes of information, notify the trademark owner of the forthcoming expiry of the registration. Failure to give such notice shall not affect expiry of the registration, nor shall it constitute grounds for extending the legally established time limit for effecting renewal.

#### **Article 26. Filing and content of the renewal application.**

1. Renewal applications shall be filed with the Spanish Patent and Trademark Office or with the competent body of the corresponding Autonomous Community within the time period specified in Article 32.3 in the Trademark Act, Law No. 17/2001. The application shall be filed using the standard forms to be furnished by the Spanish Patent and Trademark Office. However, the application shall not be refused admission if it is filed using the model international form provided in the Regulations under the Trademark Law Treaty of 27 October 1994.

2. The application for renewal of a trademark registration shall contain:

- a) A request for renewal of the trademark;
- b) Where the application is filed by the trademark owner, the owner's name and address pursuant to Article 1.1.b) in this Regulation.
- c) Where the application is filed by a successor in title to the trademark owner, the successor in title's name and address pursuant to Article 1.1.b) in this Regulation.
- d) Where a representative has been appointed, the representative's name and address pursuant to Article 1.1.f) in this Regulation.
- e) The number of the registration for which renewal is sought.
- f) The filing date of the trademark application which resulted in the registration for which renewal is sought.
- g) An indication that renewal is requested for all the goods and services covered by the registration or for some only. In the latter case, the goods and services for which renewal is requested are to be indicated, grouped according to the Nice Class to which they belong, each group being preceded by the number of the class.
- h) The signature of the applicant for the renewal or his representative.

3. The request for renewal is to be submitted together with a voucher attesting to payment of the renewal fee for the classes covered and, where applicable, of any surcharges that apply pursuant to Articles 32.2 and 32.3 in the Trademark Act, Law No. 17/2001.

**Article 27. Renewals filed by successors in title.**

1. Where renewal of the registration is requested by a successor in title of the owner, this circumstance shall be indicated on the application, and the successor's status shall be demonstrated in the proceedings concerning the corresponding request for recordal of the change of ownership. The renewal application may be filed before, together with, or after the request for recordal of the change of ownership. The file number of the recordal proceedings, or where the number is not known the date of filing of the request for recordal, or the intent to file the request shortly, shall be indicated on the renewal application.

2. Renewal proceedings shall be suspended pending action on the request for recordal of the change of ownership. If the request for recordal of the change of ownership is not filed before the end of the time periods stipulated in Article 32.3 in the Trademark Act, Law No. 17/2001, at the latest, the application for renewal shall be refused.

**Article 28. Renewal procedure.**

1. Where the renewal application is submitted within the time periods established in Article 32.3 in the Trademark Act, Law No. 17/2001, but does not fulfil another of the requirements laid down in the Trademark Act or in the present Regulation, the Spanish Patent and Trademark Office shall issue an official action and shall notify the applicant of the irregularities observed, so that they may be corrected within a time limit of one month from publication of notice of the official action in the Official Industrial Property Gazette.

2. If there are no irregularities in the application or any irregularities that did exist were corrected within the specified time limit, the trademark registration shall be granted renewal and the corresponding certificate of renewal shall be issued. Notice of the grant of renewal shall be published in the Official Industrial Property Gazette.

3. If the irregularities are not corrected within the specified time limit, the renewal application shall be refused. Nevertheless, where the irregularity is insufficient payment of the renewal fee or the corresponding surcharges but the amount paid suffices to cover one or more of the classes for which the renewal has been requested, the Spanish Patent and Trademark Office shall grant renewal of the registration only for those classes whose fee has been paid in full, including the portion of the corresponding surcharge. Unless the applicant indicates otherwise, the fee shall be deemed paid for the classes in the order in which they are listed in the application for renewal.

4. Refund of the renewal fee as stipulated in Article 32.7 in the Trademark

Act, Law No. 17/2001, shall be authorized in the decision refusing renewal, but the refund shall be made only when the decision has become final and at the request of the interested party.

**Article 29. Lapse as a consequence of non-renewal.**

1. Where no request for renewal of the trademark registration is filed or the request was filed after expiry of the time periods specified in Article 32.3 in the Trademark Act, Law No. 17/2001, the Spanish Patent and Trademark Office shall declare the trademark to have lapsed.

2. The trademark shall also be declared to have lapsed where the renewal is refused and the time periods referred to in the preceding paragraph conclude without submission of a new renewal application in due form by the interested party.

3. The Spanish Patent and Trademark Office shall publish notice of the declaration of lapse in the Official Industrial Property Gazette and shall cancel the trademark registration.

## **TITLE IV CONVEYANCE OF TITLE, LICENSES, AND OTHER MODIFICATIONS AFFECTING RIGHTS**

### **Article 30. Content of the application to record a transfer.**

1. Recordal of the transfer of a trademark or a trademark application shall be requested using the standard forms to be issued by the Spanish Patent and Trademark Office. However, the request shall not be refused admission if it is filed using the model international form provided in the Regulations under the Trademark Law Treaty of 27 October 1994.

2. The application to record the transfer shall contain:

- a) The name and address of the applicant or trademark owner (transferor).
- b) The name and address of the new owner (transferee) pursuant to Articles 1.1.b) and 1.1.c) in this Regulation.
- c) Where a representative is acting on behalf of the applicant for recordal of the transfer, the representative's name and address pursuant to Article 1.1.f) in this Regulation.
- d) An indication of the document or instrument establishing the transfer.
- e) The number of the trademark registration or application transferred.
- f) The signature of the applicant or his representative.

3. The application to record the transfer shall be submitted with the following documents:

- a) The document establishing the transfer pursuant to Articles 49.2 and 49.3 in the Trademark Act, Law No. 17/2001.
- b) The voucher attesting to payment of the corresponding fee.

4. The application to record the transfer may concern multiple trademark registrations and applications, provided that the current owner of record and the new owner are the same for each of the registrations or applications concerned.

5. Where the document establishing the transfer is one of those specified in Article 49.2.c) in the Trademark Act, Law No. 17/2001, the standard forms to be issued by the Spanish Patent and Trademark Office shall be used, without prejudice to possible use of the model international forms referred to in paragraph 1 in the present Article instead.

### **Article 31. Partial transfer.**

1. Where the transfer does not concern all of the goods and services for which the mark has been filed or registered, the application to record the transfer shall so indicate and shall specify the individual goods and services transferred. However, where the partial transfer concerns all the goods or services in a class, it shall suffice to indicate the number or numbers of the corresponding Nice Class or Classes transferred.



2. The application to record a partial transfer shall be submitted with the documents specified in Article 46.2 in this Regulation, and the other paragraphs in the said Article shall likewise apply as appropriate.

3. The application to record a partial transfer shall satisfy the stipulations contained in Article 30 in this Regulation.

**Article 32. Content of the application to record a licence.**

1. Recordal of a licence for a trademark or a trademark application shall be requested using the standard forms to be issued by the Spanish Patent and Trademark Office.

2. The application to record a licence shall contain the indications specified in Article 30.2 in this Regulation and shall be filed with the documents specified in paragraph 3 in the said Article, though in this case in reference to the licensor and licensee, the registrations or applications licensed, and the document establishing the licence.

3. Where the document establishing the licence is one of those specified in Article 49.2.c) in the Trademark Act, Law No. 17/2001, the standard forms to be issued for that purpose by the Spanish Patent and Trademark Office shall be used.

4. The application to record a licence shall state whether it is exclusive or non-exclusive; inclusive or partial, according to whether it relates to all or to part of the goods for which the trademark has been registered or filed; unlimited or limited, according to whether it is issued for all or for part of the territory of Spain; and indefinite or temporary, according to whether it is issued for the entire duration of the trademark or for a predetermined length of time. It shall also state whether the licensee may transfer the licence to third parties or issue sublicenses.

5. Where the application for recordal does not specify one or more of the details stipulated in the preceding paragraph, the licence shall be recorded in accordance with the legal presumptions laid down in Article 48 in the Trademark Act, Law No. 17/2001.

**Article 33. Recordal of other rights.**

1. Application to record the other transactions and rights registrable on the Register of Trademarks pursuant to Article 46.2 in the Trademark Act, Law No. 17/2001, shall fulfil the conditions and requirements set out in Articles 30 and 31 in this Regulation, duly adapted to the nature of the transaction or right to be recorded, exception made of security interests, which shall be governed by their specific provisions. The application to record a purchase option or the establishment of rights in rem shall, in addition, be submitted with a public document pursuant

to Article 49.4 in the Trademark Act, Law No. 17/2001.

2. In the case of the recordal of liens or other encumbrances resulting from execution proceedings, or where the trademark is involved in bankruptcy or like proceedings, applications for recordal on the Register of Trademarks made by the competent authority shall not be subject to payment of fees.

**Article 34. Recordal procedure.**

1. On receipt of the application to record a change in ownership or any other modification affecting rights, the competent body shall proceed according to Article 50.2 in the Trademark Act, Law No. 17/2001, and shall issue the applicant a receipt attesting to the filing pursuant to Article 5.5 or Article 5.6 in the present Regulation. Where the competent body chooses to issue a receipt, it shall state the file number, the registration or registrations concerned, the nature of the transaction to be recorded, the number of documents submitted, and the place, date, hour, and minute of filing.

2. The competent body of the Autonomous Community that receives the application shall proceed according to Article 5.7 in this Regulation, and on receipt of the particulars of the application, the Spanish Patent and Trademark Office shall make the relevant entries on the Register.

3. The competent body of the corresponding Autonomous Community shall examine the documents submitted pursuant to Article 50.3 in the Trademark Act, Law No. 17/2001, and if any irregularity is observed, it shall issue an official action and notify the applicant, who shall be allowed a time limit of one month from publication of the notice of the official action in the Official Industrial Property Gazette in which to correct same. Where application to record a partial transfer is submitted, the competent body of the Autonomous Community shall also examine whether the documents specified in Article 31.2 in this Regulation have been filed with the application without undertaking any consideration as to the lawfulness and validity thereof.

4. On receipt of the application for recordal, the Spanish Patent and Trademark Office shall examine it pursuant to Article 50.5 in the Trademark Act, Law No. 17/2001, and if any deficiency is observed, it shall issue an official action and communicate the deficiencies observed to the applicant, who shall be allowed a time limit of one month from publication of notice of the official action in the Official Industrial Property Gazette in which to submit arguments.

5. Where the Spanish Patent and Trademark Office is the competent receiving body for the application, the examinations referred to in Articles 50.3

and 50.5 in the Trademark Act, Law No. 17/2001, may be performed together, and if any irregularities or deficiencies are observed, they may be reported to the applicant in a single notice of official action for correction or submission of arguments within a time limit of one month.

6. The Spanish Patent and Trademark Office shall not record transfers to natural or legal persons who are not entitled to own trademarks under Article 3 in the Trademark Act, Law No. 17/2001.

**Article 35. Cancellation and modification of entries in respect of licences and other rights.**

1. An entry recording a licence or a transaction or right specified in Article 33 in this Regulation shall be cancelled at the request of one of the parties.

2. The application for cancelled shall contain the following indications:

- a) The applicant's identity.
- b) The file number of the recordal of the right to be cancelled.
- c) The number of the trademark application or registration affected by the right to be cancelled.
- d) An indication of the right to be cancelled.
- e) The signature of the applicant or his representative.

3. The application for cancellation shall be filed together with the following documents:

- a) The public document showing the right to have been extinguished or a declaration authorizing cancellation of the entry signed by the licensee or trademark owner.
- b) The voucher attesting to payment of the corresponding fee.

4. The application for cancellation shall be filed and prosecuted pursuant to Article 50 in the Trademark Act, Law No. 17/2001, and Article 34 in this Regulation.

5. The four preceding paragraphs shall also apply to requests for modification of the entries for the transactions and rights referred to in paragraph 1 above, making the appropriate adjustments inherent to their differing natures. The application to modify the entry for any of these transactions or rights shall be submitted with the public document attesting to the said modification or by a statement authorizing modification signed by the licensee or right holder.

## TITLE V SURRENDER OF THE MARK

### **Article 36. Surrender of the mark in whole or in part.**

1. Pursuant to Article 57 in the Trademark Act, Law No. 17/2001, the application to surrender a trademark shall be filed with the Spanish Patent and Trademark Office or the competent body of the corresponding Autonomous Community and shall contain:

- a) A request for surrender in whole or in part.
- b) The name and address of the trademark owner pursuant to Article 1.1.b) in this Regulation.
- c) The number of the trademark registration for which surrender is requested.
- d) Where a representative has been appointed, the representative's name and address pursuant to Article 1.1.f) in this Regulation.
- e) Where surrender is requested only for some of the goods and services for which the mark is registered, the goods and services for which the surrender is effective, arranged by class according to the Nice Classification, with each group being preceded by the number of the class. Where the surrender is for all the goods or services in a class, an indication of the class number shall suffice.
- f) The signature of the trademark owner or his representative.

2. Where consent from the holder of a registered right that has been entered against the trademark pursuant to Article 57 in the Trademark Act, Law No. 17/2001, is required for acceptance of the surrender, it shall suffice to submit with the application a declaration agreeing to the surrender signed by the holder of the said right or by his representative.

3. The Spanish Patent and Trademark Office shall examine whether the application for surrender fulfils the requirements and conditions laid down in the Trademark Act, Law No. 17/2001, and in this Regulation. If irregularities exist, an official action shall be issued and the interested party shall be notified so that he may reply thereto within a time limit of one month from publication of notice of the official action in the Official Industrial Property Gazette. If the deficiencies indicated have not been corrected within the specified time limit, entry of the surrender requested shall be refused.

4. The Spanish Patent and Trademark Office shall publish notice of the decision accepting entry of the surrender in the Official Industrial Property Gazette, where surrender is partial specifying the goods and services for which the surrender has been entered and the goods and services for which the trademark remains registered. Where surrender is for the trademark in its entirety, the trademark registration shall be cancelled.

## **TITLE VI COLLECTIVE AND CERTIFICATION MARKS AND TRADENAMES**

### **Article 37. Applicable provisions.**

Without prejudice to the stipulations laid down here in Title VI, the provisions of the present Regulation shall apply to collective and certification marks and to tradenames to the extent they are not at variance with the very nature thereof.

### **Article 38. Regulations governing the use of collective and certification marks.**

1. The Regulations governing the use of collective marks shall contain at least the following details:

- a) The name and office address of the association or public law entity filing application.
- b) The object of the association or public law entity.
- c) The bodies authorized to represent the association or public law entity.
- d) The conditions for membership in the association.
- e) The persons authorized to use the mark.
- f) Where appropriate, the conditions governing use of the mark, including sanctions.
- g) Where appropriate, the authorization referred to in Article 63.2 in the Trademark Act, Law No. 17/2001.

2. The Regulations governing the use of certification marks shall contain at least the following details:

- a) The name and office address of the applicant for the mark.
- b) The requirements, components, elements, conditions, origin, or any other characteristics which the trademark owner is to certify are fulfilled by the goods or services on which the trademark is to be applied.
- c) The measures to be taken to test these characteristics.
- d) The systems for checking and overseeing trademark use.
- e) The liabilities and penalties ensuing from improper use of the mark.
- f) The fee payable by those who use the mark.
- g) Where appropriate, the authorization referred to in Article 69.3 in the Trademark Act, Law No. 17/2001.

3. The regulations governing use shall, in the case of collective marks, be submitted together with the duly established and registered by-laws of the applicant association or entity and, in the case of certification marks, the report recommending approval issued by the competent administrative body according to the nature of the goods or services on which the mark is to be used. Where pursuant to administrative silence the report is to be deemed to recommend approval pursuant to Article 69.2

in the Trademark Act, Law No. 17/2001, proof of the act in question and of the competence of the body which was asked to issue the report shall be submitted.

4. Amendments to the regulations governing use shall be submitted to the Spanish Patent and Trademark Office for approval. In the case of certification marks, the amendments are to be submitted together with the corresponding report recommending approval issued by the competent administrative body according to the nature of the goods or services on which the mark is to be used. The Spanish Patent and Trademark Office shall examine whether the amendments requested fulfil the conditions and requirements stipulated in the Trademark Act, Law No. 17/2001, and in this Regulation and where appropriate shall notify the applicant of any irregularities or deficiencies observed, allowing a time limit of one month for correction or submission of arguments in reply.

5. Notice of the decision to effect or refuse entry of amendments to the regulations governing use shall be published in the Official Industrial Property Gazette.

**Article 39. Tradenames.**

1. The application to register a tradename shall expressly state that this type of distinctive sign is requested. Any other requests filed in reference to a tradename shall contain an identical statement.

2. Pursuant to the conditions laid down in Article 30.4 in this Regulation, entry of a transfer may be requested against tradenames or tradename applications and trademark applications or registrations together.

## **TITLE VII INTERNATIONAL MARKS AND COMMUNITY TRADEMARKS**

### **Article 40. Preliminary examination of the application for an international mark.**

1. The competent body receiving the application for an international registration shall examine the documents submitted pursuant to Article 82.1 in the Trademark Act, Law No. 17/2001, and if any irregularity is observed, shall notify the applicant, allowing a time limit of 10 days for correction.

2. Upon receipt of the application forwarded by the competent body of the corresponding Autonomous Community, the Spanish Patent and Trademark Office shall conduct an examination pursuant to Article 82.3 in the Trademark Act, Law No. 17/2001, and if any irregularity is observed, shall notify the applicant, allowing a time limit of 10 days for correction.

3. Where the body competent to receive the application is the Spanish Patent and Trademark Office, it may perform the examinations specified in Articles 82.1 and 82.3 in the Trademark Act, Law No. 17/2001, concomitantly; and if any irregularities or deficiencies are observed, it shall issue the applicant a single notification, allowing a time limit of 10 days for correction.

### **Article 41. Application for transformation of an international registration.**

1. Upon receipt of the application for transformation, the Spanish Patent and Trademark Office shall examine:

a) Whether the international registration concerned has been cancelled as provided in Article 6.4 in the Protocol Relating to the Madrid Agreement of 27 June 1989.

b) Whether the documents specified in Article 83.2 in the Trademark Act, Law No. 17/2001, have been filed within the time limit stipulated in Article 83.1 in the said Act.

c) Whether the goods and services claimed by the application for transformation were covered by the international registration concerned with respect to Spain.

2. Where the aforesaid examination reveals non-compliance with any of the requirements specified in the preceding paragraph, the deficiencies observed shall be reported to the applicant for submission of arguments within a time limit of one month. The Spanish Patent and Trademark Office shall deem the application for transformation to have been withdrawn if the response submitted by the applicant fails to account for the non-compliance with the said requirements or does not submit the

corresponding limitation or amendment of the goods and services so that they match those actually covered by the international registration.

3. On successful completion of the examination, the application for transformation shall be prosecuted as a national trademark application, except where the transformation concerns an international registration already granted protection in Spain, in which case Article 83.3 in the Trademark Act, Law No. 17/2001, shall apply, and the notice published shall be for grant of the registration pursuant to Article 23.3 in this Regulation rather than for filing as an application.

**Article 42. Request for conversion of a Community trademark.**

1. The request for conversion of a Community trademark need not be submitted with the form requesting registration specified in Article 1, but the applicant shall submit the documents and satisfy the requirements prescribed in Article 86.2 in the Trademark Act, Law No. 17/2001, within a time limit of two months from receipt of the request for conversion by the Spanish Patent and Trademark Office.

2. Where, pursuant to Article 86.3 in the Trademark Act, Law No. 17/2001, the Spanish Patent and Trademark Office deems the request for conversion not to be admissible on grounds of one of the causes laid down in Article 108.2 in Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community trade mark, it shall notify the applicant, allowing a time limit of one month for submission of arguments. The applicant will be accorded the same time limit where it is deemed that the Community trademark may not proceed directly to grant pursuant to Article 86.4 in the Trademark Act. Following receipt of the applicant's response, the Spanish Patent and Trademark Office shall issue its decision.

3. Where the conversion concerns an already registered Community trademark, Article 86.4 in the Trademark Act, Law No. 17/2001, shall apply, and the notice published shall be for grant of the registration pursuant to Article 23.3 in this Regulation rather than for filing as an application.



## TITLE VIII GENERAL PROVISIONS ON PROCEDURE

### CHAPTER I Alteration of the application or registration and correction of errors

#### Article 43. Alteration of the trademark application or registration.

1. Pursuant to, respectively, Articles 23 and 33 in the Trademark Act, Law No. 17/2001, the request for alteration of a trademark application or registration shall contain:

- a) The number of the trademark application or registration.
- b) The name and address of the applicant or trademark owner pursuant to Article 1.1.b) in this Regulation.
- c) Where a representative has been appointed, the representative's name and address pursuant to Article 1.1.f) in this Regulation.
- d) Where the alteration is to an application, an indication of the element that is to be altered and the version of the said element as altered.
- e) Where the alteration is to a registration, an indication of the element of the owner's name or address in the representation of the trademark which is to be altered and the version of the element as altered.
- f) Where the alteration affects the representation of the trademark, a reproduction of the trademark as altered pursuant to Article 2 in this Regulation.
- g) The signature of the interested party or his representative.
- h) The voucher attesting to payment of the alteration fee.

2. The request for alteration shall be filed with the body that is prosecuting the application for registration of the trademark at the time the request is filed. Where the request for alteration concerns an already registered trademark, it shall be filed with the Spanish Patent and Trademark Office or the competent body of the corresponding Autonomous Community, which shall forward it to the Office as provided in Article 33.2 in the Trademark Act, Law No. 17/2001.

3. Where the requirements for altering the trademark application or registration stipulated in the Trademark Act, Law No. 17/2001, and in this Regulation are not fulfilled, the applicant shall be notified of the irregularities observed or the objections raised, and if they are not corrected within a time limit of 10 days, the request for alteration shall be refused, and prosecution shall proceed where the alteration requested was for a trademark application. Where the alteration concerns a registered trademark, the petitioner shall be notified of the refusal.

4. The competent body of an Autonomous Community which has granted a request for alteration shall, within five days of issuance of the decision, notify

the Spanish Patent and Trademark Office of the particulars of the application as altered. The Office shall enter the relevant alterations on the Register.

5. Where the alteration of a trademark application concerns the representation of the mark or the list of goods or services after the application has been published, the publication of the notice of the decision on the request shall contain a reproduction of the mark or the list of goods and services as altered. Notice of alteration of a trademark registration shall also be published as provided in Article 33.2 in the Trademark Act, Law No. 17/2001.

**Article 44. Correction of errors.**

1. Mistakes in wording or in copying and material errors contained in a trademark application or registration or in any other document submitted to the Spanish Patent and Trademark Office or the competent body of the corresponding Autonomous Community may be corrected at the request of the interested party. Nevertheless, where the request for correction concerns the distinctive sign, the description of the sign, the components claimed, or the list of goods or services, the nature of the correction shall be such that the correction is obviously the sole content that the interested party could have intended, and the correction shall not substantially change either the identity of the mark or the scope of protection. Where there is reasonable doubt as to whether the correction requested actually ensued from a mistake, the Spanish Patent and Trademark Office or the competent body shall be entitled to require additional proof.

2. Where a decision, entry in the records, or publication of the application or registration contains a mistake attributable to the Spanish Patent and Trademark Office, the Office shall correct the mistake either ex officio or at the request of the interested party. If at the request of the interested party, the request for correction shall not be subject to payment of a fee.

3. The stipulations established in Article 43 in this Regulation shall apply to the corrections regulated in the preceding paragraphs in all respects not at variance with their very natures or contrary to the present Article.

4. The request for correction of errors may concern various applications or registrations in the name of the same person, provided that the error and the correction requested are the same. In such event the numbers of all the applications or registrations to be corrected shall be indicated, and the corresponding fee shall be paid for each application or registration concerned.

**Article 45. Changes to the name or address of the interested party or the representative.**

1. Where there has been no change in the person of the owner of or applicant for a trademark but there has been a change in the name or address, the said change shall be entered on the Register of Trademarks at the request of the said owner or applicant.

2. The request for a change of name or address shall contain:

a) The number of the trademark application or registration.

b) The name and address of the applicant or the trademark owner as entered on the Register of Trademarks.

c) Where a representative has been appointed, the representative's name and address pursuant to Article 1.1.f) in this Regulation.

d) An indication of the applicant's or trademark owner's new name or address as it is to be entered on the Register of Trademarks subsequent to the change that has taken place.

e) The signature of the interested party or his representative.

f) Where appropriate, the voucher attesting to payment of the corresponding fee prescribed in Fee 2.2 in Fee Schedule Two in the Annex to the Trademark Act, Law No. 17/2001.

3. A single request for entry of a change of name or address may cover all the registrations or applications in the name of the interested party. In that event, the numbers of all the applications or registrations concerned shall be listed and the corresponding fee paid for each one.

4. Where the Spanish Patent and Trademark Office has reasonable doubts as to the veracity of the change of name or address requested, the Office may require the applicant to file proof of the said change.

5. The preceding paragraphs shall also apply to a change of name or address of the representative.

6. Changes in the address of the applicant or trademark owner shall not be subject to payment of a fee.

7. The stipulations established in Article 43 in this Regulation shall apply to the changes of name and changes of address regulated in the preceding paragraphs in all respects not at variance with their very natures or contrary to the present Article.

8. The stipulations contained in the preceding paragraphs shall apply to changes in the applicant's or the trademark owner's nationality or in the State in which he has his domicile, headquarters, or establishment, as befits their natures.

## **CHAPTER II Division of the application**

### **Article 46. Division of the trademark application or registration.**

1. The applicant may divide the trademark application into two or more divisional applications on replying to an official action due to formal deficiencies, substantive objections, or oppositions. He may also divide the application on filing an administrative appeal against refusal of the mark or on requesting recordal of partial transfer pursuant to Article 31.2 in the present Regulation. The request for division shall be filed with the body which is prosecuting the trademark application at the time the request is filed or which is competent to decide on the appeal or to receive the application to record a transfer, as the case may be.
2. A separate request shall be filed for each divisional application, stating the goods and services split off from the parent application in the corresponding divisional application. The corresponding individual application for registration containing the indications, requirements, and documents specified in Articles 1 to 4 in the present Regulation shall be filed with each request for division. The said individual applications for registration shall also indicate that they are divisional in nature and shall state the number, filing date, and classes of the parent application from which they ensue. For divisional applications the voucher attesting to payment of the application fee referred to in Article 4 shall be replaced by the voucher attesting to payment of the fee for division.
3. The lists of goods and services in the divisional applications shall not exceed the total goods and services making up the parent application being divided. Where a general concept has been used in the parent application, the divisional applications shall use that same general concept, which may, however, be restricted by additional wording more narrowly specifying the goods or services covered by each divisional application, overlap among the divisional applications in no case being permissible.
4. On receipt of the divisional application, the competent body shall examine whether it complies with Article 24 in the Trademark Act, Law No. 17/2001, and whether it satisfies the requirements specified in the preceding paragraphs. Where deficiencies or irregularities are observed, the applicant shall be notified and allowed a time limit of one month for correction or submission of arguments. If the deficiencies are not corrected, the request for division shall be deemed to have been withdrawn, and prosecution of the original file shall be continued. The registration or appeal proceedings shall be suspended during the division procedure pursuant to Article 26.c) in the Trademark Act, Law No. 17/2001.

5. Where division of the application is allowed, the Spanish Patent and Trademark Office or the competent body shall open a new file for each divisional application submitted and shall include in each divisional application a full copy of the file for the parent application and in the file for the said original application copies of all the divisional applications requested. The competent body of the Autonomous Community shall immediately forward the file for the parent application and any divisional applications unaffected by the official action to the Spanish Patent and Trademark Office and shall continue prosecution of the divisional application affected by the official action. The Spanish Patent and Trademark Office shall assign each divisional application a new number and shall make the relevant entries on the Register. The competent body of the Autonomous Community shall be notified of the new number of the divisional application.

6. All requests, petitions, or statements made by the applicant in respect of the parent application shall be valid and shall hold for the divisional applications.

7. The preceding paragraphs shall also apply, as appropriate, to division of a trademark registration. Except as provided in Article 31 in this Regulation, division of a trademark registration may be requested only in appeal proceedings against the grant of the mark. In this case the request for division shall be filed with the Spanish Patent and Trademark Office no later than on filing the reply to the appeal that has been lodged.

### **CHAPTER III Restoration of rights**

#### **Article 47. Application for restoration of rights.**

1. The application for restoration of a right shall be filed within a time limit of two months from removal of the cause of non-observance. The application shall be filed with the Spanish Patent and Trademark Office or with the competent body of the corresponding Autonomous Community where the time limit that resulted in the loss of the right was missed.

2. The application for restoration shall contain:

- a) The name and address of the applicant or owner of the trademark for which restoration is sought.
- b) Where appropriate, the representative's name and address.
- c) The time limit or procedure which was not observed.
- d) Where appropriate, the decision and the dates of loss of the right and of the publication or notification thereof.
- e) The date on which the cause of non-observance ceased to exist.
- f) The causes of non-observance, an explanation, proof, and arguments

in support of the application.

g) The signature of the interested party or his representative.

h) The voucher attesting to payment of the fee for restoration of rights.

3. The act or the request, submission, or documentation previously omitted in the proceedings from which loss of the right ensued subsequent to non-observance shall be completed with the application for restoration of the right.

**Article 48. Examination of the application and issuance of the decision.**

1. The competent body shall examine whether the application for restoration of the right satisfies the requirements prescribed in the preceding Article and in Article 25.2 in the Trademark Act, Law No. 17/2001, and whether all formalities of the omitted act or procedure have been duly fulfilled in full on submission of the application for restoration of rights.

2. Where any irregularity or deficiency is observed in the documents filed in respect of either the application for restoration of rights or fulfilment of the omitted procedure, the applicant shall be notified and allowed a time limit of 10 days for correction. If the irregularities or deficiencies observed are not corrected within that time limit, the application for restoration of rights shall be deemed to have been withdrawn.

3. Where no irregularities or deficiencies are observed in the documents submitted or where any irregularities or deficiencies have been corrected, the competent body shall examine whether, pursuant to Articles 25.1, 25.5, and 25.7 in the Trademark Act, Law No. 17/2001:

a) Proof that due care was taken in the circumstances of the case has been submitted.

b) The unobserved time limit is amenable to restoration.

c) There is no third-party right that stands in the way of restoration as requested.

4. On completion of the examination prescribed in the preceding paragraph, the competent body shall issue a decision, granting or refusing restoration of the right. Nevertheless, where the obstacle specified in subparagraph c) of the preceding paragraph arises, before taking a decision the competent body shall notify the applicant and the holder of the presumed obstacle sign, allowing them a time limit of one month in which to file arguments. The competent body shall then take a decision in light of these arguments. A third party entitled to rely on the provisions of Articles 25.6 and 25.7 in the Trademark Act, Law No. 17/2001, may appeal a decision to restore the applicant's rights.

5. The Spanish Patent and Trademark Office shall publish notice of the decision in the Official Industrial Property Gazette.

6. Where the body competent to decide on the application for restoration of rights is a body of an Autonomous Community, it shall notify the Spanish Patent and Trademark Office of the filing of the application and the final decision issued.

#### **CHAPTER IV Notifications and communications**

##### **Article 49. Notifications and communications from the Spanish Patent and Trademark Office.**

1. Notifications and communications to be made by the Spanish Patent and Trademark Office shall be performed by delivery or remittal of the original document, a signed or sealed copy thereof, or a computer printout bearing a printed version of the seal.

2. In addition to the means of notification set out in Article 29 in the Trademark Act, Law No. 17/2001, notifications may be performed on the premises of the Spanish Patent and Trademark Office by personal delivery to the addressee, who shall acknowledge receipt of the notification.

3. Where notification is performed by deposit of the document in the interested party's box at the Spanish Patent and Trademark Office, the date of deposit shall be noted on the document notified and on the copy kept in the file.

4. Notifications effected by facsimile or other technical or electronic means of communication shall be performed by transmitting the original or a copy of the document as specified in paragraph 1. Pursuant to the Eighth Additional Provision in the Trademark Act, Law No. 17/2001, the Director of the Spanish Patent and Trademark Office shall establish the specifications for such transmissions within the framework for security, standardization, and storage prescribed in Royal Decree No. 263/1996 of 16 February 1996 regulating the use of electronic, computer, and IT technology by the General Government Administration. Notifications performed via IT shall be deemed to have been delivered pursuant to Article 59.3 in the Law on the Legal System of the Public Administration and Common Administrative Procedure, Law No. 30/1992.

5. Communications to be issued by the Spanish Patent and Trademark Office which are of a merely informative nature may be effected by ordinary post, e-mail, or any other technical means available to the Office.

##### **Article 50. Communications from interested parties.**

1. Applications for trademark registrations and any other applications provided for in the Trademark Act, Law No. 17/2001, or in this Regulation and all other communications addressed by an interested party to the Spanish

Patent and Trademark Office or to the competent bodies of the Autonomous Communities shall be effected by filing a signed original of the document in question at the said Office, at the competent bodies, or at the venues stipulated in Article 38.4 in the Law on the Legal System of the Public Administration and Common Administrative Procedure, Law No. 30/1992, of 26 November 1992.

2. Where so provided, the said applications and communications may also be effected by filing the document on magnetic or electronic media or by transmission by facsimile or other electronic means. The Director of the Spanish Patent and Trademark Office shall determine the conditions, requirements, and features of these means of filing or transmission, such as the equipment or material to be used; the technical details of communication; and the methods of identifying the sender within the framework for security, standardization, and storage referred to in Article 49.4 in this Regulation. An IT Register for receiving applications transmitted by means of IT shall be established as prescribed in Article 38.9 of the above-mentioned Law No. 30/1992.

#### **Article 51. Standard forms.**

1. In addition to the standard forms specified in this Regulation, the Spanish Patent and Trademark Office may establish others for the filing of other applications and communications by the interested parties. All forms shall be approved by decision of the Director General of the Spanish Patent and Trademark Office.

2. Parties to proceedings before the Spanish Patent and Trademark Office shall use the said standard forms, copies of those forms, or printouts having the same content and format, such as forms generated by means of electronic data processing.

3. Forms shall be completed in such a manner as to permit automated input of the content into a computer, such as character recognition or optical scanning.

4. The Spanish Patent and Trademark Office shall make the standard forms referred to in paragraph 1 in this Article available to the public on computer communications networks.

### **CHAPTER V The Register of Trademarks and public information**

#### **Article 52. Form and content of the Register of Trademarks.**

1. The Register of Trademarks referred to in Article 1 in the Trademark Act, Law No. 17/2001, may be maintained in the form of an electronic database.



2. The Register of Trademarks shall contain the following entries in respect of national trademarks, international marks, and tradenames:

- a) The file number of the registration.
- b) The date of filing of the application.
- c) The name, address, and nationality of the applicant or registrant and the State in which he has his domicile, headquarters, or establishment.
- d) The name and business address of the representative, unless the representative comes under Article 56.3 in this Regulation.
- e) The reproduction of the mark or tradename, with indications as to its nature, unless it is a mark or tradename coming under Article 2.1 in this Regulations. Where the registration is in colour, the indication "in colour" and mention of the colours making up the sign. Where applicable, a description of the sign.
- f) The list of goods and services, grouped according to the classes of the Nice Classification. Each group shall be preceded by the number of the class to which it belongs and shall be listed in the order followed by the said Nice Classification.
- g) The indications relating to claims of Paris Convention priority.
- h) The indications relating to claims of exhibition priority.
- i) The indications relating to claims of seniority.
- j) The declaration by the applicant disclaiming exclusive rights in any element of the trademark or tradename.
- k) The indication that it is a collective, certification, or international mark.
- l) The indication that it is a national trademark ensuing from transformation of an international mark or conversion of a Community trademark and the particulars relating to that application or registration (filing date and application or registration number).
- m) The indication that it is a divisional application and the date of filing and the number of the parent application or registration.
- n) The indication that it is a consolidated registration and the filing date and number of each parent registration.
- o) The dates of the decision deeming the application to be withdrawn and, where applicable, of publication of the notice of the decision.
- p) The date of the publication of the application.
- q) The earlier signs, identified by file number, whose owners were notified of publication of the application pursuant to Article 15.2 in this Regulation.
- r) The dates of any official action and of publication of the notice of the official action.
- s) The dates of the decision to refuse or grant the registration and of

publication of the notice of the decision.

t) The particulars relating to the filing of and decisions in any administrative appeals or court appeals.

u) The particulars relating to any arbitration agreement, the arbitration decision, and, where applicable, any appeals lodged against the said decision and the decisions dealing therewith.

3. The Register of Trademarks shall also contain the following entries:

a) Any changes to the name, address, or nationality of the applicant or registrant and the State in which he has his domicile, headquarters, or establishment.

b) Any changes to the name and business address of the representative, unless the representative comes under Article 56.3 in this Regulation.

c) When a new representative is appointed, the name and business address of that representative.

d) Any alterations to the trademark or tradename pursuant to Article 33 in the Trademark Act, Law No. 17/2001.

e) Mention of any amendments to the regulations governing the use of collective or certification marks pursuant to, respectively, Articles 65 and 71 in the Trademark Act, Law No. 17/2001.

f) Requests for entry of any transfers, in whole or in part, of the application or registration and the date of refusal or acceptance of recordal thereof.

g) The establishment, amendment, or transfer of a right in rem and the date of refusal or acceptance of recordal thereof. For security interests, the date of registration on the Movable Property Registry shall be entered.

h) Any encumbrances and bankruptcy or like proceedings.

i) Applications for recordal, modification, or transfer of any licences and the date of refusal or acceptance of recordal thereof.

j) Requests for cancellation of the entries referred to in subparagraphs g), h), and i) and the date on which cancellation is entered.

k) Applications for renewal of the registration and the date of grant or refusal of renewal and of publication of the notice thereof.

l) Any application for surrender of the registration and cancellation thereof.

m) The dates of the decision declaring lapse due to non-renewal and of publication of the notice thereof.

n) Actions claiming ownership, invalidity, or revocation, and the judgements and other court decisions, pursuant to Articles 2 and 61 in the Trademark Act, Law No. 17/2001.

4. The Spanish Patent and Trademark Office may enter on the Register of Trademarks mentions other than those specified in the preceding paragraphs.

**Article 53. Public accessibility.**

1. The Register of Trademarks shall be a public register. Public access shall be by database query, ordering of computer listings, or certifications issued by the competent official.
2. The Spanish Patent and Trademark Office may make the database available for public inspection over computer communications networks, free of charge.
3. Certification shall be the sole means of reliably attesting to the content of the entries on the Register.
4. Interested parties shall request certification by submitting to the Spanish Patent and Trademark Office the corresponding standard form with the particulars to be certified filled in. Where the request is for a general certification of the entries on the Register for a trademark or a tradename, the certification may take the form of the corresponding computer listing from the database certified by the competent official. The request for certification shall be submitted together with the voucher attesting to payment of the corresponding fee.

**Article 54. Public inspection of files.**

1. Public inspection of files shall be of the original documents or of copies thereof. Where the files are stored on technical means of storage, inspection shall be of the said technical means. The Spanish Patent and Trademark Office shall determine the manner and means of inspection. The request for inspection of files shall not be deemed to have been made until the corresponding fee has been paid.
2. The parts of the file which the party concerned has asked to be kept confidential before the application for inspection of the file was made shall be excluded from inspection, unless inspection of such parts of the file is justified by overriding legitimate interests of the party who has requested inspection.
3. Where inspection of the file is requested for an unpublished application, the party making the request shall indicate and show that the applicant for the file:
  - a) Has given his consent, or
  - b) Has sought to enforce rights emanating from the application against the said party.
4. Inspection of files shall take place on the premises of the Office.
5. On request, inspection of files shall be performed by issuing copies of file documents. A fee shall be payable for such copies.

**Article 55. Keeping of files.**

1. The Spanish Patent and Trademark Office shall keep the files relating to applications and to registered trademarks and tradenames for at least five years from the end of the year in which:

a) The application has been refused or withdrawn or deemed to have been withdrawn.

b) The trademark or tradename registration has expired in its entirety pursuant to Article 55.1.a) in the Trademark Act, Law No. 17/2001.

c) The surrender of the trademark or tradename in its entirety pursuant to Article 55.1.b) in the Trademark Act, Law No. 17/2001, has been entered on the Register.

d) The trademark or tradename has been expunged from the Register in its entirety pursuant to Article 61.3. in the Trademark Act, Law No. 17/2001.

2. The Director of the Office shall decide how the files shall be kept.

3. The Spanish Patent and Trademark Office shall keep the files of all those registrations from which seniority for a Community trademark has been claimed as long as the said Community trademark remains in force, even where the said registrations have been surrendered or allowed to lapse by the owner subsequent to registration of the Community trademark.

**CHAPTER VI Representation**

**Article 56. Representation.**

1. Except as provided in the following paragraph, no-one shall be obliged to appoint a representative before the Spanish Patent and Trademark Office or the competent bodies of the Autonomous Communities. However, where the address of the party concerned is located outside the territory of Spain, an address within Spain shall be indicated for purposes of notification.

2. Without prejudice to the last sentence in the following paragraph, pursuant to Article 155.2 in the Patent Act, Law No. 11/1986, of 20 March 1986, natural or legal persons who do not have a domicile or an effective and real industrial or commercial establishment in the European Community shall be represented by an industrial property attorney in all proceedings laid down by the Trademark Act, Law No. 17/2001, or by the present Regulation.

3. Natural or legal persons having their domicile or an effective and real industrial or commercial establishment in the European Community may be represented by an employee, provided the said employee's authority to act as representative has been duly accredited with the Spanish Patent and Trademark Office or with the competent bodies of the corresponding Autonomous Community and an address in Spain is furnished for service

of notifications. The employee of a legal person to which this paragraph applies may also represent other legal persons having economic ties to the first-mentioned legal person, even where those other legal persons have neither their domicile nor an effective and real industrial or commercial establishment within the European Community.

4. For the purposes of Article 1.1.f) in the present Regulation, the representative shall be deemed to have a real and effective branch office in the territory of the Autonomous Community in which the application has been filed if he has entered into an agreement for cooperation with another representative or if he proceeds through an employee, assistant, or agent, any of whom has his domicile in the territory of the said Autonomous Community.

**Article 57. Accreditation of representation.**

1. The representative shall file with the Spanish Patent and Trademark Office or with the competent body of the Autonomous Community the corresponding power of attorney signed by the interested party for inclusion in the file. Powers may be issued for one or more applications or for one or more registrations identified thereon.

2. A general power of attorney authorizing the representative to act in respect of all of the maker's trademark or tradename transactions may be filed. The Spanish Patent and Trademark Office shall keep a register of general powers of attorney for this purpose.

3. Where the appointment of a representative is communicated to the Spanish Patent and Trademark Office or to the competent body of an Autonomous Community, the corresponding power shall be filed within a time limit of one month from receipt of the said communication if the maker's address is located within the territory of Spain or two months if the maker's address is located outside the territory of Spain. If the power is not filed within the aforesaid time limits, the proceedings shall be continued with the party represented. Any procedural steps other than the filing of the application for registration taken by the unaccredited representative shall be deemed not to have been performed unless ratified by the party represented within the aforesaid time limits. All the foregoing shall be without prejudice to the last sentence in Article 56.1 and Article 56.2 in this Regulation.

4. A representative who has ceased to be authorized shall continue to be regarded as the representative until termination of his authorization has been communicated to the Spanish Patent and Trademark Office or the competent body.

5. Unless the power itself provides otherwise, termination due to death

of the maker shall not prevent the holder from performing before the Spanish Patent and Trademark Office or the competent bodies of the Autonomous Communities any actions that may be necessary for the preservation, defence, and maintenance of the maker's applications and registrations pending appointment of a new authorized representative by the maker's heirs or the personal appearance by the heirs.

**First Additional Provision. Performance of procedures.**

For the purposes of the Fourth Additional Provision in the Trademark Act, Law No. 17/2001, procedures in industrial property proceedings shall mean any actions relating to filing, prosecution, opposition, renewal, claiming priority, paying fees, or even lodging appeals in respect of any and all types of industrial property. Accordingly, any such action or procedure having a time limit that expires on a Saturday may be validly performed on the next working day following that Saturday.

**Second Additional Provision. Restoration of rights for all other forms of industrial property.**

Articles 47 and 48 in the present Regulation shall apply to patents, utility models, semiconductor topographies, and industrial and artistic designs in all respects not at variance with their very natures or with the Seventh Additional Provision in the Trademark Act, Law No. 17/2001.

**Third Additional Provision. Calculation of time limits.**

Without prejudice to the stipulations laid down in the First Additional Provision, the time limits specified in this Regulation shall be calculated in accordance with Article 48 in the Law on the Legal System of the Public Administration and Common Administrative Procedure, Law No. 30/1992, of 26 November 1992.

**First Transitional Provision. Transitional regulations for titles of establishment.**

1. While their legal lifetimes last, titles of establishment shall be governed by the provisions of this Regulation in all respects not at variance with their very nature or contrary to the system set up by the transitional provisions in the Trademark Act, Law No. 17/2001. Specifically, Article 15.2; Title II, Chapter IV; and Title IV in this Regulation shall apply to titles of establishment.

2. Pursuant to the Third Transitional Provision, subparagraph 2.a), in the Trademark Act, Law No. 17/2001, where the renewal of a title of establishment extends only to municipalities located within a single Autonomous Community, application for renewal shall be filed with the competent bodies of that Autonomous Community. Where the renewal extends to the cities of Ceuta or Melilla or, for any other municipalities, where the competent bodies of the Autonomous Community concerned have not yet commenced their registration functions, application for renewal shall be filed with the Spanish Patent and Trademark Office, as provided in the Fifth Transitional Provision in the Trademark Act.

3. The renewal application and procedure shall be as prescribed in Articles 26, 27, and 28 in this Regulation in all respects not at variance with their very nature or contrary to the stipulations laid down in the Trademark Act, Law No. 17/2001, or this Provision. Specifically, neither the grace period established in Article 32.3 in the Trademark Act nor the indication of the goods or services prescribed in Article 26.2.g) in this Regulation shall apply to the renewal of titles of establishment, the latter to be replaced by an indication of the municipalities, branches, and specific activities for which renewal is requested.

4. Where competence to decide on renewal applications is vested in the bodies of the Autonomous Communities, the voucher attesting to payment of the corresponding fee shall fulfil the requirements specified thereby. The competent body shall forward the particulars of renewal applications to the Spanish Patent and Trademark Office in the manner prescribed in Article 5.7 in this Regulation within five days of receipt of the application. When a decision on the renewal application has issued, the decision taken and, where applicable, any administrative appeals and court appeals that may have been lodged against it and the decisions issued therein shall be reported to the said Office in the same manner and within the same time limit. At the request of the competent body, the Spanish Patent and



Trademark Office shall supply a copy of the file or whatever details may be requested from the file.

**Second Transitional Provision. Application of the Nice Classification to tradename renewals.**

1. Pursuant to the Sixth Transitional Provision in the Trademark Act, Law No. 17/2001, at the time of the first renewal filed after entry into force of the said Act, tradenames granted registration under the legislation formerly in effect shall be classified according to the International Classification of Goods and Services.

2. The said renewal application shall be as prescribed in Article 26 in this Regulation. Nevertheless, the renewal shall state that it is a first renewal requiring classification according to the Nice Classification and shall indicate the goods or services for which renewal is requested, grouped by International Class, each group being preceded by the class number. The list filed shall not contain goods or services differing from those encompassed by the list of activities for which the tradename is registered. Where the list of activities contains items that are overly general or unclear, these shall be deleted from the adaptation to the Nice Classification.

3. The renewal procedure shall be as prescribed in Article 28 in this Regulation. Pursuant to paragraph 1 in the said Article, the applicant shall be notified of any deficiencies observed in or objections raised against the classification proposal that he has submitted. Barring the presence of other uncorrected irregularities that prevent the requested renewal from being granted, the Spanish Patent and Trademark Office shall issue a decision granting renewal for the goods or services it deems properly classified subsequent to the applicant's response.

**Third Transitional Provision. Consolidation of registrations.**

1. Where consolidation of various granted trademarks into a single registration is requested on filing application for the first renewal after entry into force of the Trademark Act, Law No. 17/2001, pursuant to the Seventh Transitional Provision in the said Act, the applicant shall file the renewal application in accordance with the stipulations laid down in Article 26 in this Regulation. The renewal application shall also contain:

a) A request for consolidation of the various trademarks into a single

registration.

b) The numbers of the trademark registrations for which consolidation is requested.

c) An indication of the goods and services of the consolidated registrations for which renewal is requested, grouped by class of the Nice Classification, each group being preceded by the class number and arranged consecutively following the numerical order in the Classification. The goods and services shall be listed in this way even where renewal is requested for all the goods and services covered by the various registrations to be consolidated.

2. The renewal procedure shall be as prescribed in Article 28 in this Regulation. Additionally, however, the Spanish Patent and Trademark Office shall also examine whether the requested consolidation satisfies the requirements specified in the Seventh Transitional Provision in the Trademark Act and in the present Provision. The applicant shall be notified of any deficiencies observed or objections raised pursuant to Article 28.1.

3. If the deficiencies or objections in respect of the request for consolidation are not corrected within the specified time limit, consolidation shall be refused. However, renewal shall not be refused where the legal requirements for renewal are satisfied in respect of the registrations for which consolidation was requested. In this event, the Spanish Patent and Trademark Office shall notify the applicant of the refusal of consolidation together with the grant of renewal for those registrations properly renewed. A copy of the renewal application filed and a copy of the decision issued shall be included in the files for these registrations.

4. Where the renewal and the requested consolidation are both granted, a new file shall be opened, which file shall contain the files of the consolidated registrations, and the resulting consolidated registration shall be assigned a new number. The Spanish Patent and Trademark Office shall also make the relevant entries on the Register, cancelling each of the consolidated registrations and indicating the reason for cancellation and the number of the file in which they have been included.