APRIL 2017 / No.14

NEWSLETTER

www.ponti.pro

Patents, Trademarks, Utility Models,
Domain Names and Designs
Intellectual Property and Legal Defense.

THE SPANISH PATENT SYSTEM ON THE MOVE

Our patent system is facing two milestones this early spring. The first, as we have already informed on our last issues, is the entry into force of the long awaited new Spanish Patent Law 24/2015 last April 1st, after one year and half of *vacatio legis*.

This exceptional long period gone by between the passing of the law and its coming into force has been due to the need to adapt the technical resources and staff of the SPTO to the new substantive examination procedure, and also to the complexity that this new law represents to many other private and public actors involved in the patent framework.

The second (and so far of much lower profile) is the non-legislative initiative recently approved by the Commission for Economy, Industry and Competitiveness of the Spanish Parliament requesting the Government to take all necessary steps for the accession of Spain to the Unitary Patent System.

Although this initiative has no binding effects and the success of the motion still requires by constitutional mandate the participation of the Government later on, it shows a clear turning point on the position held by Spain with regard to the Unitary Patent. Last but not least, it has to be pointed out that the current balance of political forces in the Parliament favors the adhesion of Spain to the enhanced cooperation mechanism of the EU that adopted the Unitary Patent.

PATENT COURTS

On the 2nd of February, the General Council of the Judiciary vested the exclusive competence to hear patent infringement cases to the Commercial Courts of Barcelona, Madrid and Valencia.

This decision aims to provide more consistency and specialization to the activity of our courts as a result of the new Patent Law and the increasing complexity of the cases that are expected to be heard.

Barcelona was the first city in Spain to host a specialized section on IP matters in the Local Courts on the turn of the last century.

WE ARE BIGGER

With the start of the year the firm Morgades del Rio Renter, SLP has joined forces with Ponti. A team of 3 Industrial Engineers, 2 Lawyers and supporting staff will contribute to expanding our professional expertise and capacities.

The firm Morgades del Rio was set up 80 years ago and has a solid reputation in the IP sector, namely in the mechanical and electronical areas.

MORGADES
PASTELLS & ARAGONES

NEW CORPORATE IMAGE

New times, new challenges and a new image. As you may have already noticed, we have reshaped and stylized our trademark.

Shorter than we used to be but more precise with our essence.

PONTI SINCE 1935
STRATEGIC INTELLECTUAL PROPERTY SERVICES

FOLLOW US ON TWITTER

Our twitter account is up and running. If you want to be up to date on European and Spanish IP developments, changes and news feel free to follow us.

@Ponti_IP

AGENDA / EVENTS:

20-24.05.2017 INTA International Trademark Association. Barcelona, Spain.

28.06-01.07.2017 ECTA. European Communities Trademark Association. Budapest, Hungary.

LEGAL DISPUTE BETWEEN THE MARKS "TORO" (OSBORNE GROUP) AND "BADTORO" (JORDI NOGUÉS)

Cristina Margalef
Lawyer

The confrontation between the TORO and BADTORO brands began in April 2011, when the Spanish wine and liquor group OSBORNE opposed the trademark "BADTORO" and device , filed by the designer Jordi Nogués before the European Trademark Office (EUIPO, before OHIM) to distinguish clothing, tobacco and the sale, import and export of such products (classes 25, 34 and 35). Osborne based the opposition on three Spanish trademarks and two European trademarks: "TORO", "EL TORO" and the mark formed by the silhouette of his well-known bull TORO. The EUIPO allowed the opposition filed and rejected the application of the mark on the grounds of similarity with the Osborne brands. Mr. Jordi Nogués appealed the decision but did not succeed in his claim, so he brought the case before the European Court of Justice, the judgment of which is still pending.

In parallel to this case, another dispute was started and resolved with the decision by the Spanish Supreme Court on 18.01.17. OSBORNE filed a lawsuit against Jordi Nogués before the Commercial Court No. 1 of Alicante, requesting the invalidity of the Spanish word trademark BADTORO in classes 25 and 35, on the grounds of likelihood of confusion with two EU trademarks "TORO" in classes 18, 25, 35 and 39 and claiming infringement of the TORO marks as a result of the use of the BADTORO mark.

Jordi Nogués opposed the claim and made a counterclaim requesting the absolute invalidity of the Community trademarks "TORO" for having been registered in violation of several of the absolute prohibitions of registration established in the Community Regulation and, subsidiarily, that they be declared cancelled due to non-use.

The Court dismissed on 15.05.14 the claims of both parties, a decision which was later confirmed by the Provincial Court of Alicante on 15.01.2015.

With the recent ruling, the Supreme Court has resolved the appeals in cassation and the preliminary questions raised by both parties in the following terms:

It dismisses the preliminary questions and the suspension of the case for civil preliminary judgment, and refuses to await the decision of the General Court as it considers that there was no risk of contradictory decisions when confronting other marks made up of Osborne's bull and Jordi Nogués' BADTORO designs.

It dismisses the claims of Jordi Nogués regarding the cancellation for non-use and the invalidity of the "TORO" marks, as it considered in essence that:

- the bull doesn't constitute any official symbol or icon of Spain;

- the mark "TORO" is distinctive in relation to the products to which it is applied;

- granting a monopoly on the mark "TORO" in favour of Osborne does not affect public order;

- Osborne did not act in bad faith when registering the mark.

It also dismissed the claim by OSBORNE that originated the lawsuit:

- By confirming the refusal of a request for invalidation of the BADTORO mark and of infringement of the TORO marks, considering that the addition of the English term "BAD" creates a neologism that differentiates it and prevents its confusion or association with Osborne's "TORO" trademarks.

- Rejected the cassation after a detailed analysis of the main jurisprudential guidelines in order to decide on the similarity between the marks, reiterating that the appreciation of similarity is a value judgment that corresponds to the lower court, that the "confusing similarity" is a matter of judgment and that it must be assessed according to the circumstances of each case and to common sense.

This sentence comes in addition to other in which the Supreme Court ruled on Osborne's "Toro". Thus, in its decision of 21.05.09, the court noted that the registration of the Osborne bull "cannot prevent other shapes of bulls, with their own distinctive features, from being incorporated into trademarks of third parties". Also, with its decision of 30.10.2014, it confirmed the grant of the mark "Toro Negro".

We are now awaiting the judgment by the General Court on the likelihood of confusion in a case where, in addition to the TORO-BADTORO signs, the different graphic representations of the bull by both litigating firms are confronted: TORO. vs. . Here we open the debate of the extent to which a confirmatory ruling on the decisions taken so far by the EUIPO could show a different approach by the two courts when interpreting one of the most controversial and indeterminate legal concepts as is the "existence of a level of similarity likely to cause "association" or "confusion" among consumers".

SINCE 1935
PONTI STRATEGIC INTELLECTUAL PROPERTY SERVICES

Suggestions and subscriptions: newsletter@ponti.pro
Barcelona: +34 93 487 49 36 / ponti@ponti.pro
Madrid: +34 91 457 93 11 / madrid@ponti.pro
Alicante: +34 96 520 26 95 / alicante@ponti.pro