



KEEP IT SECRET

Spain has a new Trade Secrets Act enacted. This law reinforces the patrimonial and confidential nature of all the sensitive information for the company at a competitive level which is not protected by some form of registry protection (patents, trademarks or designs). With this provision, our system complies with the mandate of EU Directive 2016/943 on Trade Secrets and outlines in a much clearer way what can be considered confidential, how this character is instrumentalised internally and externally, as well as the mechanisms of its legal protection.

Until now, this asset of vital importance for business competitiveness was subject to scattered, if not deficit treatment. In many cases, tutelage actions entailed a serious risk of disclosure of secrecy in court and this generated a deterrent effect on those affected by a violation of this type. The new regulation reinforces, in judicial headquarters and beyond the conclusion of the procedure, the access that third parties may have to that information and at the same time it endows our Intellectual Property system with a complementary instrument of high value in the prosecution of copying or infringement of rights.

EPO 2018 REPORT

The European Patent Office has published its latest report on the statistics results of European Patent applications in 2018, which shows an upward trend in the registration of European Patents by Spanish applicants.

This increase in European Patent applications by Spanish applicants stands at 6.3%, being considerably higher than the average increase of the rest of the 38 member states of the European Patent Convention, which has been about 3.8%. In global figures, Spain has marked an own record of 1,776 European Patent applications in 2018.

By Autonomous Communities, Catalonia continues to be the first applicant for European Patents in the Spanish territory with more than a third of the total number of applications, followed by the Community of Madrid with 21.1% and the Basque Country with 12.5%.

This upward trend, which has been repeated for four years, is positive news for the growth of the national R & D model, which establishes the necessary basis for the country's technological growth, but anyway with still a long way to go since when compared to other countries.



WORLD IP DAY

The Agency for Business Competitiveness of the Catalonia Government organized a special event for the IP Day. Diana Marine, Patent Attorney (Msc. Industrial Engineer) brought some sound arguments backing the vital role that IP plays as a competitiveness tool for business and innovators.

IP INSURANCE

The awareness of business operators of their potential liability to IP related risks is still very low in the Spanish market.

To put our modest bit on it, we are launching, in cooperation with a specialized insurance brokerage agency, a tailored scheme for small and medium-size companies.

In an everyday more export-driven economy, businesses should bear in mind that their exposition to IP related risks is not limited to the boundaries of their home country, at least not to the extent that used to be not long ago.

AGENDA / EVENTS:

18-22.05.2019 INTA. International Trademark Association. Boston. USA

16-18.06.2019 IPBC. Intellectual Property Business Conference. Boston. USA

ENTRY INTO FORCE OF THE SPANISH TRADEMARK LAW REFORM.

Directive 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks introduced several amendments to Trademark Law which, by means of Royal Decree-Law 23 / 2018 of 21 December, on the transposition of directives regarding trademarks, rail transport and travel packages, and related travel services, have been incorporated into the regulation of Spanish Trademark Law by means of the amendment of Law 17/2001 on Trademarks which came into force on 14 January 2019.

The following are some of the amendments that trademark owners will have to take into account from now on.

Firstly, Article 4 of the Law has been amended and the requirement of "graphic representation" has been removed. By doing so, the application for non-conventional trademarks, e.g. multimedia, olfactory, sound marks, etc. is accepted.

A second very important modification is the obligation to submit evidence of use of the earlier opposing trademark, at the request of the applicant and if the opposing trademark is under an obligation of use (Article 21A of Law 17/2001, on Trademarks).

This request for proof of use, however, can only be exercised in opposition proceedings initiated against trademarks and trade names applied for as of 1 May 2019, date of entry into force of the amendments to the Regulations for the implementation of the Law 17/2001, of 7 December on Trademarks that regulate, among others, the procedure and requirements related to such proof of use.

These requirements are similar to those already required by EUIPO in opposition proceedings against European Union trademarks, except for the deadlines for submission by the opponent and response by the applicant:

- Make the request, expressly and unconditionally, in separate document.
- The opponent will have a period of one month to submit the corresponding proof of use.
- If the opponent does not provide any evidence, it is insufficient or there is no justifiable ground for the non-use, the opposition will be rejected.



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- The content of the proof of use will be related to indications about the place, time, scope and nature of the use of the opposing trademark in relation to the goods or services for which it is registered and the opposition is based.

- Proofs of use will be limited to the submission of documents and supporting evidence such as invoices, catalogues, price lists, advertisements, packaging, labels, photographs and relevant written statements.

- The applicant will have a period of one month to submit arguments and observations as it deems appropriate to the proof of use submitted.

A third important amendment is the attribution of new competences to the Spanish Patent and Trademark Office regarding nullity and revocation proceedings, about which, as of 14 January 2023, the Office will have direct knowledge, without prejudice to the fact that the commercial courts may still hear counterclaims.

On the other hand, in practice, this change will mean that the Superior Courts of Justice will review the decisions that the Trademark Office adopts in this matter and that may end up in the Supreme Court.

Finally, other important novelties are:

- The disappearance of the distinction between notorious and well-known trademarks, unifying both types under well-known trademarks, as trademarks that have reached a high degree of knowledge and dissemination among the general public.

- Trademark holders have been given the right to prevent the introduction into Spain of goods from third countries, with an identical sign or one that cannot be distinguished from the registered trademark, even if said goods are not going to be marketed in Spain.

However, this prohibition cannot be applied if it is proved that the trademark owner is unable to prohibit the commercialization of the products under said trademark in the destination country.

In short, all the amendments made entail substantial changes in the procedure for processing and defending trademarks that must be assessed in detail by applicants and record owners before undertaking any action based on them.