



Protection of vignerons and  
distributors names and  
trademarks:  
Spain

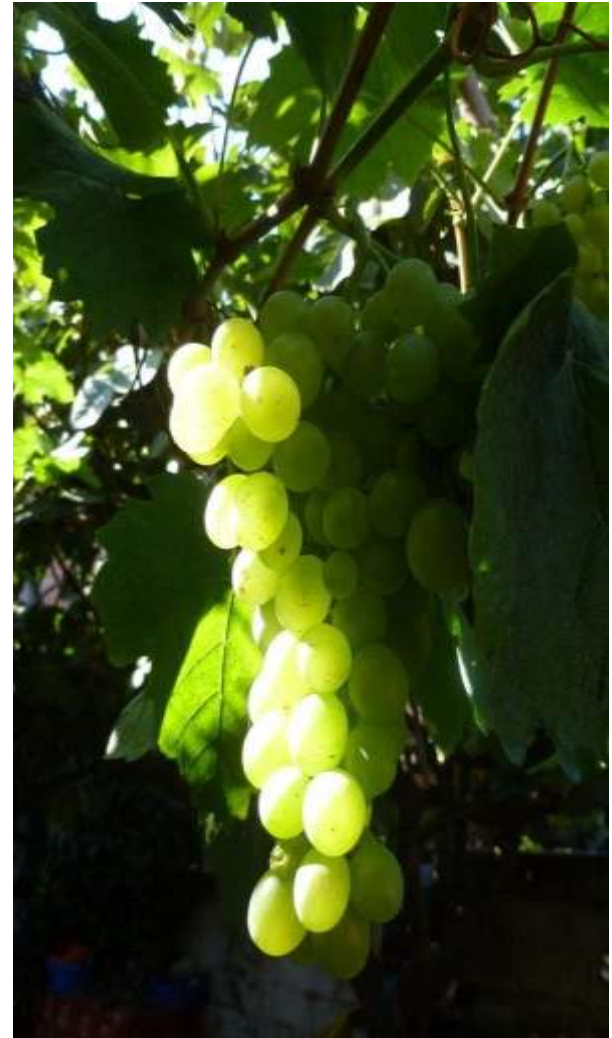
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# SUMMARY

- ▶ HOW TO PROTECT AND DEFEND FOREIGN WINE-GROWERS TRADEMARKS IN SPAIN; PARTICULAR MENTION TO THE USE OF UNREGISTERED DESIGNATIONS AGAINST THIRD PARTIES' ATTACKS
- ▶ SPECIFIC PROTECTION OF TRADEMARKS IN THE WINE INDUSTRY

# A twin track approach; protection of:

- Trade names
- Trade marks



# TRADE NAMES

- ▶ Is it necessary to register a trade name in order to obtain protection?
- ▶ The general principle is to record the Trade Name in Spain before the STPO.
- ▶ If unregistered, the tradename may be granted protection if PRIOR use in Spain exists or if the trade name enjoys notoriety.

- ▶ **Is it possible for foreigners to profit from unregistered tradename protection?**
- ▶ Yes; citizens from member countries of the Paris Convention or citizens from countries which apply the principle of reciprocity can challenge fresh registrations that may be detrimental to their trade names.

# Protection requirements

- ▶ Identity or similarity of new application and prior tradename.
- ▶ Identity or similarity of goods or services.
- ▶ Likelihood of confusion.
- ▶ Evidence of its **use** or **notoriety** in Spain must be provided.



# Regarding the use 'or' notoriety

- ▶ These elements are independent from each other and can be used alternatively; evidence of any of the two can be provided.
- ▶ There is an ongoing argument on whether notoriety refers to “use” or “public awareness”: according to doctrine, it is public awareness, and not use, which needs to be notorious. Use within Spanish territory will suffice.

- ▶ The significance of this principle lies in the fact that it allows to contest an application that infringes our non-registered rights, without the need of filing an nullity action once the registration has been granted.
- ▶ It is time-and-costs saving.



# TRADE MARKS

- ▶ According to the Spanish Law, trademark rights are acquired through its registration before the SPTO.
- ▶ However, this ‘first to file’ system has been made more flexible as a significant exception on the subject of renowned trademarks has been entered, as previously explained for trade names.

- ▶ **Article no. 6 of the Spanish Trade Mark Act establishes that signs may not be registered as trademarks if they are identical or similar to an unregistered trademark which is ‘well-known’ in Spain, according to article 6 bis of the Paris Convention.**

# Scope of the Protection

- ▶ Users of unregistered trademarks or trade names may :
  - ▶ 1.- File an administrative opposition to applications.
  - ▶ 2.- File invalidity actions if the application has been already granted.
  - ▶ 3.- The filing of infringement actions is a debatable question; therefore, **REGISTRATION IS ALWAYS ADVISABLE**

# SPECIFIC PROTECTION OF WINE INDUSTRY TRADE MARKS

- ▶ There are some interesting examples of prohibition of registration in the wine-making field.



- ▶ Prohibition of registration of trade marks whose exclusive purpose is to designate the geographical origin of the goods.
- ▶ Prohibition of registration of trade marks that may lead to confusion with regards to the geographical origin of the good or service.

# Specific to wine: article 5.h) of the Spanish Trademark Law

- ▶ *5.1) The following signs may not be registered as a trademark...: h) those used to identify wines or spirits and which contain or consist of indications of geographical origin which identify wines or spirits that do not have such an origin, including when the true origin of the good is indicated or the geographical indication is used in translation or accompanied by expressions such as “class,” “type,” “style,” “imitation” or other similar expressions.*





- ▶ Unlike the aforementioned prohibition for registration of signs that may be misleading with regards to the geographical origin of the good, this provision does not require that the trademark misleads consumers.

- ▶ In the case of wine products, prohibition will apply to any trademarks containing an **uncertain indication of geographical origin even if its true origin is inferred from the sum of the elements composing the sign.**

# EXAMPLES

- ▶ Registration would be refused to any of the following wine trademarks from origins different from than La Rioja (fictitious trademarks) :
  - Wine Ochoa Rioja (*misleading with regards to the origin*)
  - Wine Ochoa Variety Rioja (*even if it is not misleading*)
  - Rioja Ochoa manufactured in Madrid (it indicates its true origin)

# Protection is granted to:

- ▶ Wines and spirits
- ▶ Spanish or foreign
- ▶ Not exclusively Designation of Origin, but all protected origin designations (DO, Collective Trade Marks, IG)

# Real examples of trade marks for which registration has been denied

- ▶ Trademark no. 2.809.439 “**DOS RUEDAS**”, for wine, in absence of authorisation from the Regulatory Board of the Rueda D.O.
- ▶ Trademark no. 2.733.733 “**CLOS DEL SILENCIO NEGRO SELECCIO PENEDES DENOMINACION D’ORIGEN**”, for wine, in absence of authorisation from the Regulatory Board of the Penedés D.O.
- ▶ Trademark no. 2.733.635 “**COVIJEREZ**” for wine in absence of authorisation from the Regulatory Board of the Jeréz D.O.

- ▶ The aforementioned are examples of absolute prohibitions of registration; thus the SPTO denies registration ex officio.
- ▶ To these effects, the Ministry of Agriculture, Fisheries and Food provides the SPTO with a list of protected Designations of Origin, although indications of origin are not presently required to be Designations of Origin.



# OTHER PROHIBITIONS WHICH AFFECT THE WINE INDUSTRY

- ▶ Signs reproducing the armorial bearings or flags of Spain and its Autonomous Communities may not be registered as trademarks.
- ▶ Unless previously authorised, the first name or surnames which in the eyes of the general public identifies a person other than the applicant may not be registered as a trademark.

- ▶ Signs protected by copyrights may not be registered as trademarks, if unauthorised.
- ▶ General criteria for registration of wine-related trademarks :
  - Agreement of Regulatory Boards
  - If reproducing titles of nobility, authorisation of the title holders.
  - If including landmark names, authorisation of the National Trust Authorities.
  - If including Estate names, evidence of its ownership.

# DESIGNATION OF ORIGIN

- ▶ Reinforced protection of Designation of Origin and Geographical Indication is provided in Spain against trademark applications.
- ▶ Article 9.1 of our Law provides that signs which imitate creations protected by copyright or by another industrial property right (such as Designations of Origin) may not be registered as trademark.

# CONCLUSION

- ▶ Wide protection offered to unregistered users in Spain, although registration is advisable.
- ▶ The Spanish legislation provides reinforced protection for trademarks/tradenames operating in the wine industry.
- ▶ Firm grounds for protection which allows safe development of business.

