

# New developments in IP legislation for 2023 in Spain

Grau & Angulo | Intellectual Property - Spain



DALIA  
FERRANDO

## ► Introduction

## ► SPTO

## ► Specialised sections of civil courts of appeal

## ► Comment

### Introduction

2023 brings two very important legislative changes in Spain, relating respectively to:

- the competence of the Spanish Patent and Trademark Office (SPTO) for the revocation and the declaration of invalidity of registered trademarks; and
- the competence of the specialised sections of the civil courts of appeal to be aware of reviews of all SPTO decisions in IP matters that have exhausted the administrative route.

This article sets out the status of each of these changes.

### SPTO

The EU Trademarks Directive<sup>(1)</sup> required member states to make several changes to harmonise national trademark systems. Many of these changes have already been made and are in full force in Spain, given that the EU Trademarks Directive ruled that it should have been transposed in a general way by 14 January 2019.

However, the EU Trademarks Directive granted a longer term for the transposition of the changes of competences, setting 14 January 2023 as the deadline instead. For many states, including Spain, these changes meant that the resolution of procedures for the invalidity and revocation of trademarks would become the responsibility of the national trademark offices instead of being decided on under the ordinary jurisdiction, as had been the case previously.

Indeed, article 45 of the EU Trademarks Directive required member states to have an efficient and expeditious administrative procedure that would enable parties to request invalidity declarations and revocations at national offices. Article 54 of the EU Trademarks Directive required member states to put this system into force on 14 January 2023.

Spain adapted its system to the new requirements of the EU Trademarks Directive by Royal Decree Law 23/2018 of 21 December 2018, which modified Law of Trademarks,<sup>(2)</sup> including in this law the establishment of an administrative procedure to request the revocation and declaration of invalidity of trademarks.

However, taking advantage of the moratorium established by the EU Trademarks Directive, the entry into force of this change was postponed to 14 January 2023. New administrative procedures of revocation and declaration of invalidity have now been established in the Trademark Law (articles 51 et seq) as set out below:

- The competence to declare the revocation or invalidity of Spanish trademarks by direct action in the first instance, which had previously been brought before the commercial courts, has been transferred to the SPTO.
- The Spanish civil courts (the specialised commercial courts) continues to have jurisdiction to hear the revocation or declaration of invalidity of Spanish trademarks when these actions are brought in counterclaim by the defendant in an infringement litigation.
- This double competence (administrative and judicial) has made it necessary to establish the consequent rules on connection of causes in the Trademark Law.

### Specialised sections of civil courts of appeal

The other change of competences in IP matters affects all modalities of this specialty (ie, trademarks, trade names, designs, utility models and patents). Previously in Spain, the contentious-administrative jurisdiction was in charge of reviewing administrative acts of the SPTO through contentious-administrative appeals.

However, the Organic Law on the Commercial Courts,<sup>(3)</sup> which amended the Organic Law on Judicial Power (OLJP),<sup>(4)</sup> establishes important changes with regard to the competence to be aware of any reviews of SPTO decisions in IP matters, which will now become the responsibility of the civil courts of appeal (article 74.1 and 82.2.3 of the OLJP), with the following regulation:

- Any appeals against SPTO resolutions in IP matters that have exhausted the administrative route will be under the competence of the sections of the civil courts specialised in commercial matters of the courts of appeal in the constituency of the superior court of justice of the autonomous community of the domicile of the plaintiff or, failing that, of the plaintiff's authorised representative. This is the case provided that the General Council of the Judicial Power has agreed to attribute knowledge of IP matters exclusively to the commercial courts of that city. If the plaintiff so chooses, the specialised sections of the court of appeal in the constituency of the headquarters of the SPTO will also be competent (article 52.1 13 bis of the Spanish Procedural Law (SPL)).
- Appeals against resolutions of the SPTO in IP matters that have exhausted the administrative route will be processed by the procedural rules relevant to oral trials (article 250.13 of the SPL).
- The specific procedure for the processing of appeals against SPTO resolutions in IP matters that have exhausted the administrative

route will be processed by the procedural rules relevant to oral trials but with certain procedural specialties (article 477 bis of the SPL).

#### **Comment**

The important modification of articles 74.1 and 82.2.3 of the OLJP in relation to appeals against SPTO resolutions in IP matters that have exhausted the administrative route entered into force on 14 January 2023, the same date on which the SPTO assumed jurisdiction of revocations and declarations of invalidity. Therefore, on this date, a new stage began in Spain with regard to the resolution of certain conflicts in the field of industrial property.

*For further information on this topic please contact [Dalia Ferrando](mailto:d.ferrando@ga-ip.com) at Grau & Angulo by telephone (+34 93 202 34 56) or email ([d.ferrando@ga-ip.com](mailto:d.ferrando@ga-ip.com)). The Grau & Angulo website can be accessed at [www.ga-ip.com](http://www.ga-ip.com).*

#### **Endnotes**

(1) 2015/2436.

(2) 17/2001 of 7 December 2001.

(3) 7/2022 of 27 July 2022.

(4) 6/1985 of 1 July 1985.