

# Basic Facts

## About Trademarks and Trade Names


If you have an invention, trademark or design, register it.



MINISTERIO  
DE INDUSTRIA, COMERCIO  
Y TURISMO



Oficina Española  
de Patentes y Marcas

A faint, white line drawing of a person's head in profile, facing right. The hand is raised to the chin, with fingers spread. The drawing is composed of simple, continuous lines.

The purpose of this brochure is to present frequently asked questions and their answers regarding Trademarks and Trade Names.

# 5 major areas

The questions have been grouped into five major areas:

- 01. Purpose and duration
- 02. Procedure
- 03. Ownership and transfer
- 04. Searches
- 05. Protection abroad

A trademark is a distinctive sign that allows business owners and entrepreneurs to distinguish their products or services from the competition.

# 01 Purpose and duration

## 1. What is a trademark? What is a trade name?

Trademarks and trade names are distinctive signs protected by certificates granted by the state, conferring upon the owner the exclusive right to use them in the course of business and preventing others from using such protected distinctive signs in Spain. A trademark is a sign that allows employers to distinguish their products or services from the goods or services of competitors. A trade name is a sign or name that identifies a company in commercial trade and serves to distinguish it from other companies that engage in identical or similar business activities.

## 2. What are the main obligations of an owner of a trademark or trade name?

To obtain protection, the trademark or trade name must be registered. The owner has the obligation to use the trademark or trade name, either by himself or through a person authorised by that owner. If these signs are not used, the courts may declare them expired.



### 3. **How does a trademark differ from a trade name and from a business or corporate name?**

A trademark serves to distinguish the goods or services of a business owner.

A trade name is a sign or name that identifies a company in commercial trade and serves to distinguish it from other companies that engage in identical or similar business activities.

A business name is a name that identifies a legal person as an entity capable of legal relationships, and therefore susceptible to rights and obligations.

It is not necessary for a trade name to match the business name, and therefore a trade name other than the business name may be chosen. If they so wish, a single natural or legal person may have several trade names to identify business activities belonging to different industries in the course of trade.

Thus, a manufacturer of trousers would register the name used in its manufacturing business activities as the trade name to distinguish itself from other business owners. Its business name is the one that it must use, for example, to sign contracts or to register employees with the social security system. The sign or name that the manufacturer uses to market those trousers will be the product's trademark. All these signs may be the same or different, at the business owner's discretion and as appropriate.

Similarly, in the case of a natural person, the business name would be the "civil name" of the natural person, while the trade name would be the "artistic name" used by that person to introduce himself to his clients in the market.



## 4. How does a trademark differ from a domain name?

A domain name is the Internet address that can be obtained from the *Public Entrepreneurial Body* Red.es (**www.dominios.es**). Whenever a name that conflicts with a trademark is registered, legal protection can be obtained either before the courts or through the arbitration system established by the World Intellectual Property Organization.

Second-tier domain names under '.es' will be assigned based on the order in which application was submitted. Domain names that have been previously assigned may not be applied for. They also have to comply with norms governing syntax and cannot include reserved terms included in a series of lists (Internet terms and terms related to national or international institutions), pursuant to the corresponding legislation.

At the third level, domain names can be assigned under the following designations: '.com.es', '.nom.es', '.org.es', '.gov.es' and '.edu.es'. These third-tier domain names will be assigned based on the order in which the application was submitted. Domain names that have been previously assigned cannot be applied for. When assigning domain names under the '.gov.es' and '.edu.es' designations, compliance with the legitimation requirements laid down in current legislation in force will be verified first, as well as compliance with syntax rules. Third-level domain names under the '.com.es', '.nom.es' and '.org.es' designations also have to comply with norms governing syntax and cannot include reserved terms included in a series of lists (Internet terms and terms related to national or international institutions), pursuant to the corresponding legislation.

Registration of first-tier domain names under the .com, .org and .net designations is not subject to any type of preliminary check. They are assigned on a "first come first served" basis, in this case by ICANN, based in California.

## 5. How does a trademark differ from an industrial design?

A trademark is a sign that serves to distinguish goods or services and may include two-dimensional and three-dimensional shapes. An industrial design is an exclusive right granted over the aesthetic appearance of a product, and it has requirements that are different to those of a trademark. Two-dimensional shapes (for example, the pattern on a tie) and three-dimensional shapes (for example, the shape of a suitcase, the body of a car) are susceptible to protection.

## **6. For how long is a trademark or trade name granted?**

Ten years from the application date. At ten years, the trademark and/or trade name must be renewed. A trademark and/or trade name may be renewed indefinitely. The SPTO will notify you sufficiently in advance of the deadline expiry. It is important that you notify the SPTO of any change of address. We recommend that you provide an e-mail address as the preferred method of notification, given the immediacy with which you will be notified.

## **7 How much does it cost to obtain a trademark or trade name in Spain?**

The cost for registration is updated annually through the National Budget Act and the amount can be found on the SPTO website ([http://www.oepm.es/en/propiedad\\_industrial/tasas/](http://www.oepm.es/en/propiedad_industrial/tasas/)), so it is advisable to consult the website for confirmation of the correct fee amount. As a reference, in 2019, the application fee for a national trademark was set at roughly € 150.

Applying online for registration or renewal of trademarks or trade names, as well other fees related to the distinctive signs that are processed on the SPTO website (<https://sede.oepm.gob.es/eSede/es/index.html>) provides applicants with a 15% reduction in the corresponding fees. Some may also be paid by credit card.

## **8. What are the requirements to obtain a trademark or trade name?**

A sign that is intended to be registered must be lawful; that is, it may not violate any prevailing legal norms, and it must also be available, meaning that it does not conflict with any prior rights, whether as a trademark or other proprietary rights, such as the right to a name, copyright, etc.

Information on the interpretation of the legal requirements for the registration of trademarks by the SPTO may be found on its website ([http://www.oepm.es/es/signos\\_distintivos/marcas\\_nacionales/Guia\\_examen\\_prohibiciones\\_registro/](http://www.oepm.es/es/signos_distintivos/marcas_nacionales/Guia_examen_prohibiciones_registro/)): Absolute Grounds Examination Guidelines.

## **9. Will the existence of prior rights always be grounds for refusal of a trademark or trade name?**

In some cases, the registration of a trademark or trade name similar to existing ones may also be obtained when the goods, services or activities they distinguish are sufficiently dissimilar, such that they would not lead to error or create the risk of mistaken association. For example, if “DULCILIA” was granted as a trademark for, say, blankets in class 24, this would not prevent registration of the same name for “a periodical publication” in class 16. This so-

called “specialty principle” does not apply in the case of trademarks that have a reputation in Spain. These trademarks enjoy legally reinforced protection. For example, “CAMPOFRIO” could not be granted for any alcoholic beverages in class 32, given the name’s notoriety in the food industry, even if that trademark did not concern beverages.

In line with the technical and material resources available to them, the SPTO conducts a computer search of prior marks with respect to each new application and sends a notice to the applicant or rights holder if such prior registrations are detected. This is done solely for informational purposes so that the rights holder may file a notice of opposition if so desired. If such a challenge is not filed, the SPTO cannot of its own accord automatically refuse the new application because it resembles an earlier right.

## 10. What can be trademarked?

In particular, the following signs or means may constitute a trademark:

- a) Words or combinations of words, including those used to identify people (for example, “DULCILIA,” to distinguish goods or services, or “El Juli” as a stage name).
- b) Images, figures, symbols and graphics; for example, the representation of a rampant horse that distinguishes Ferrari cars, or the crocodile on Lacoste clothing.
- c) Letters, figures and combinations thereof; for example, BBVA, Liquor 43 or S-3.
- d) Three-dimensional shapes, which would include wrappers, packages and the shape of a product or its presentation.
- e) Sounds.
- f) Colours
- g) Any combination of the signs or means mentioned as examples in the preceding sections.

These signs, no matter its type, must be as well capable of:

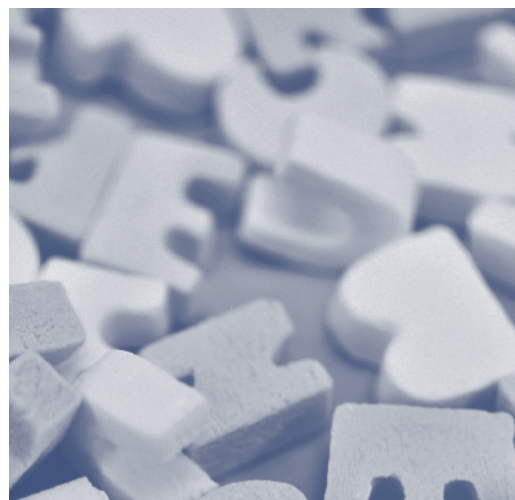
- a) Distinguishing the goods or services of one undertaking from those of other undertakings; and
- b) Being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.



## 11. What cannot be registered as a trademark?

A number of prohibitions are set by law:

- Signs that do not have sufficient capacity to distinguish themselves, for example, a point or a line without any other distinguishing element.
- Generic signs: For example, “chocolate” to trademark chocolate. This includes those that consist exclusively of signs that in trade or in everyday language have come to constitute a necessary or common product or service denomination; for example, “spring rolls” as a product trademark for foods.
- Descriptive signs: Those that consist exclusively of signs or markings that serve in trade to designate the type, quality, quantity, destination, value, geographical origin, time of production of the good or service provision, or other characteristics common to a product or service, such as “Special edition” or “May strawberries.”
- Misleading signs, such as “Oleoliva” to distinguish any type of edible oil or fat.
- Signs contravening Law or harmful to public order, such as a xenophobic or sexist trademark.
- Signs that consist exclusively of the shape, or another feature, which are imposed for technical reasons or due to the nature of the products themselves, or which affect their intrinsic value. For example, the representation of a satellite dish to distinguish parabolic antennas, or that of a windshield wiper for that type of good, or that of a pencil holder lacking any novel or unique design element.
- Designations of origin, geographical indications, traditional terms for wine and traditional specialities guaranteed, which are excluded from registration pursuant to Union legislation or the national law of Spain, or to international agreements to which the Union or Spain is party.
- Signs that consist of, or contain, an earlier registered plant variety denomination in respect of plant varieties of the same or closely related species.
- Certain legally-protected signs, such as national flags and emblems, or those pertaining to similar geopolitical designations, such as Spanish Autonomous Communities, as well as those which are considered to be of general public interest.





## 02 Procedure

### 12. How do you apply for a trademark or trade name?

An application is submitted in person, through a representative, or through an Industrial Property Agent at the Spanish Patent and Trademark Office (SPTO) or at the corresponding service centres of the Autonomous Communities, at Regional Industrial Property Information Centres, at Post Offices (in an open envelope, by certified mail and with acknowledgment of receipt), at government offices and bureaux, at industry and energy agencies, or via on-line application, accessed through the SPTO website ([www.oepm.es](http://www.oepm.es)).

### 13. What role does an Industrial Property Agent play with respect to trademarks and trade names?

In exchange for professional fees, the agent offers his services to advise, assist or represent an applicant in obtaining trademarks or trade names and in defending and retaining the rights resulting from them.

### 14. Is it mandatory to act at the SPTO through an Agent?

It is only mandatory for those who do not have a legal residence or a reliable and effective presence in any country of the Economic European Area.

### 15. What does an application for a trademark or trade name require?

The request must consist of:

- An official statement requesting registration of the mark or name.
- A representation of the sign in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor. The SPTO has established a thorough list of formats accepted, as well as the maximum size of each file type. ([http://www.oepm.es/export/sites/oepm/comun/documentos\\_relacionados/varios\\_todas\\_modalidades/RESOLUCION\\_DIRECTOR\\_NLM.pdf](http://www.oepm.es/export/sites/oepm/comun/documentos_relacionados/varios_todas_modalidades/RESOLUCION_DIRECTOR_NLM.pdf)).
- Optionally, when the representation does not sufficiently illustrate its detail, a textual description may be attached.
- The application fees.

**16. What are the essential elements that a trademark or trade name application must include in order to obtain a filing date?**

The request must at least include:

- An official statement requesting registration of the trademark.
- The applicant's official identification.
- A representation of the sign, in one of the accepted file formats.
- The goods or services to which the trademark will apply, or the business activities in the case of a trade name.
- The application may be completed at a later date, but the filing date will be the date on which the above minimum required elements were submitted.

**17. Can the application and other documents be submitted in languages other than Spanish?**

Yes. Those submitted at the offices of the Autonomous Communities may be written in their respective official languages other than Spanish, but they must be accompanied by a corresponding translation into Spanish which will be considered definitive in case of doubt between the two texts.

However, any applications submitted directly to SPTO headquarters must be drafted in Spanish.

**18. Can information about the status or processing stage of a trademark or trade name be requested from the SPTO?**

Yes. The SPTO will respond to questions that are related directly to the applications. It is also possible to check the status of an application through the official website: <http://consultas2.oepm.es/ceo/> "CEO". In the case of applications filed by an Industrial Property Agent, said agent will act as the liaison before the SPTO.

**19. In what order does the SPTO handle applications for trademarks or trade names?**

The SPTO processes and examines applications strictly in order of their filing dates.

**20. What is the “priority date”?**

The priority date is the date on which a trademark application was filed for the first time in any country in the world, in adherence to the Paris Convention for the Protection of Industrial Property (WIPO).

In accordance therewith, the priority date refers to the period extending six months following the filing date of a valid application.

**21. Can the SPTO provide guidance on the registrability of a trademark or trade name?**

Yes. The SPTO has a search service through which pertinent information regarding the registrability of a sign may be obtained. However, the resulting report does not presuppose the nature of the decision that the SPTO may adopt if a trademark application is filed to protect the sign in question, or if a court of law will need decide in this respect.

In addition, there is a trademark locator on the SPTO website (<http://consultas2.oepm.es/LocalizadorWeb/>) which may be accessed free of charge.

**22. Can changes be made to the application for a trademark or trade name on a later date after filing the application?**

At the applicant's request, the trademark application may only be amended to correct their name and address, errors in wording or copying or other obvious mistakes, provided that such correction does not substantially change the trademark or extend the list of goods or services.

**23. Can a trademark be publicly disclosed before the application is submitted?**

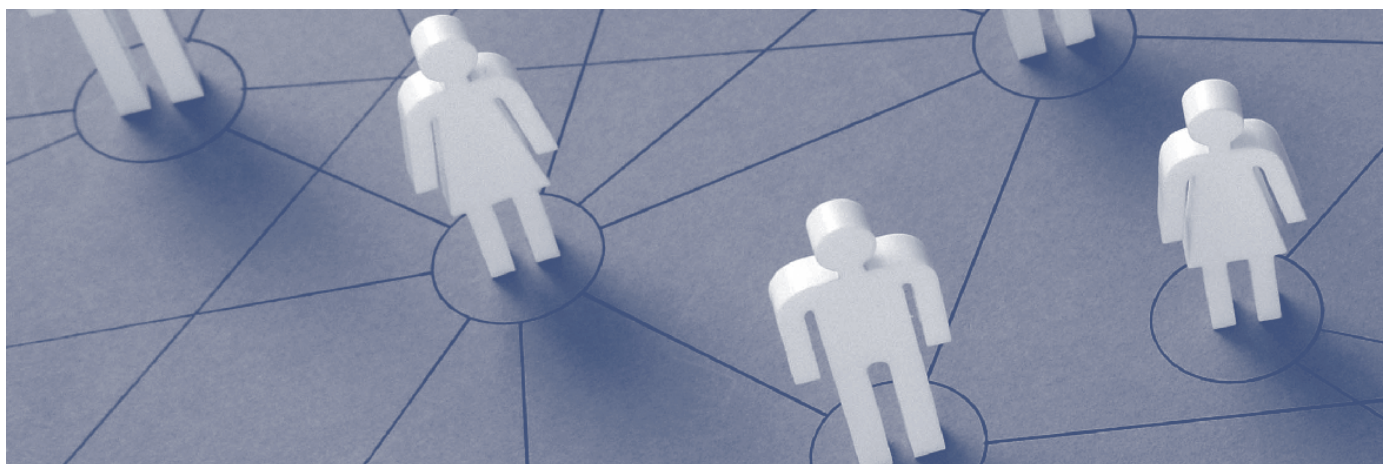
Yes, but it is advisable to apply for the trademark before publicly disclosing it in order to prevent a third party from filing an identical or similar application beforehand.

**24. What happens when any deficiencies in an application are not corrected within the timeframe set by the SPTO?**

The application will be considered as totally or partially withdrawn, depending on the nature of the deficiencies in question.

**25. Once you have decided to protect your trademark, is it important to submit the application as soon as possible?**

Yes. An application filing date is thus obtained that is prior to that of any other application that might be subsequently submitted.



## 03 Searches

### 26. Is it advisable to request a priority search before submitting an application?

Yes. Before submitting an application, it is advisable to conduct a search for trademarks or trade names that have been applied for or registered earlier and which distinguish identical or similar goods or activities, deriving a clear notion thereby of the chances for successfully registering a trademark.

As a guide, you can use the free “trademark locator” available on the SPTO website: <http://consultas2.oepm.es/LocalizadorWeb/>

### 27. If no equivalent or similar trademark or trade name is found in the search, can one be sure that the application will be granted, or that other trademarks or trade names are not violated by it?

No. The search for trademarks and trade names that are the same or similar and which were requested or granted can serve to give a fairly broad idea of what has been granted protection previously, but it cannot guarantee that the trademark and/or trade name will be granted, nor that any third parties rights will not be harmed once it is used in the marketplace.



## 04 Protection Abroad

### 28. Is a trademark or trade name granted in Spain protected abroad?

No. The sign is only protected in Spain.

### 29. How can a trademark be protected abroad?

Protection abroad may be obtained in several ways:

1. **DIRECTLY**, filing the corresponding applications country-by-country in each of the places in which you wish to register the trademark.
2. Through an **INTERNATIONAL TRADEMARK**. Through this procedure, regulated by the Madrid Agreement and in the Protocol thereof, protection can be obtained in up to 121 countries by filing a single application with the SPTO for forwarding to the International Office of WIPO (Geneva), whereby registration will have the same effect as if the application had been presented in each of the designated countries. After the application is received at the WIPO, the request is forwarded to the designated countries, where national processing then begins. The application may be granted or denied independently in each national jurisdiction.

The duration of this registration is 10 years, renewable indefinitely.

3. Through an **EUROPEAN UNION TRADEMARK**

This procedure is regulated by the European Union Trademark Regulation, which establishes the possibility of obtaining protection in all EU countries through a single application which may be submitted before the Intellectual Property Office of the European Union (EUIPO) in Alicante.

The European Union Trademark is unitary in nature and offers the same legal protection throughout the territory of the Union.

The duration of this registration is 10 years, renewable indefinitely.

## 05 Ownership and transfer

### 30. Can a trademark or trade name be applied for on behalf of a company?

Yes. The applicant can be a natural or legal person, and rights may be assigned to more than one person or entity jointly.

### 31. Can a trademark or trade name application be sold or transferred?

Yes. The rights to an application, trademark, or trade name are transferable by any means recognized by law. To be valid before third parties, acts of transfer must be registered with the SPTO.



## Basic Facts about Trademarks and Trade Names

SPANISH PATENT AND TRADEMARK OFFICE, A. O.

### ADDRESS

Paseo de la Castellana, 75 - 28071 MADRID

### UNDERGROUND AND RENFE

Nuevos Ministerios

### BUSES

3 - 5 - 7 - 14 - 16 - 19 - 27 - 37 - 40 - 43 - 45 - 51 - 64 - 66 - 124 - 126 - 128 - 147 - 149 - 150 - C1 and C2 lines

If you have an invention, trademark or design, register it.

### INFORMATION

Tel.: 902 157 530 and 910 780 780 Fax: 914 572 586

Monday to Friday from 9:00 a.m. to 6:00 p.m. (9:00 a.m. to 3:00 p.m. from July to August)  
[informacion@oepm.es](mailto:informacion@oepm.es)

### SME SUPPORT SERVICE

[pyme@oepm.es](mailto:pyme@oepm.es)

### OPENING HOURS

Hours of Registration and General Information services (except July and August)

Monday to Friday from 9:00 a.m. to 2:30 p.m. and 4:00 p.m. to 6:00 p.m.

Summer schedule in General Registration and Information service (from July to August)

Monday to Friday from 9:00 a.m. to 2:30 p.m.

Cashier service hours

Monday to Friday from 9:00 a.m. to 2:30 p.m.

Thursday from 9:00 a.m. to 2:30 p.m. and from 4:00 p.m. to 6:00 p.m.

(Closed evenings from May to September, both inclusive)

[registro@oepm.es](mailto:registro@oepm.es)

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### WEBSITE

[www.oepm.es](http://www.oepm.es)

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