

## **STATEMENT PURPOSE**

The Regulations governing application of the Trademark Law and the Law on Trademark Office Fees is a single piece of legislation that governs the application of two laws: the Trademark Law of May 11, 1995 and the Law on Trademark Office Fees of October 5, 1995.

These Regulations reflect the intent to harmonize with international trademark legislation which contains a number of new features in terms of form and content. It is divided into rules rather than articles so that references to the laws (Articles) can be easily differentiated from references to these Regulations (Rules). It acknowledges powers granted other than before a notary and enables representatives to act before the Trademark Office of the Principality of Andorra without having to present powers of attorney prior to each action, and in general lays down a clear and systematic set of rules and regulations.

OMPA's registration activity, especially as of the time at which the first and second transitory provisions of the Trademark Act ceased to be applicable, has conditioned the changes in these Regulations with the aim of simplifying and speeding up the administrative processes involved. Thus, the Regulations were first changed in order to adapt them to the Amendments to the Trademark Office Fees Act of December 19, 1998. Now, the procedure to be applied by OMPA when thoroughly examining the reasons for absolute nullity of applications for trademark registrations has been regulated as have been the procedures for waiving protection of non-distinctive features of a trademark and entering in the Trademark Register the assignment or concession of a license to use part of the products or services for which the trademark is registered.

At the proposal of the Minister of the Presidency, the cabinet meeting of May 10, 2000 approves the amendments to the Regulations Governing the Trademark Act and the Trademark Office Fees Act and, given the number of amendments made, agrees that it shall be published in its entirety with the following text:

## **Chapter I - General Provisions**

- Rule 1 Representation before the Trademark Office
- Rule 2 Communication with the Trademark Office

## **Chapter II - Application for Registration**

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- Rule 4 Application for registration: content related to the applicant and the representative
- Rule 5 Application for registration: content related to the products and/or services for which registration is sought
- Rule 5 -a Certificate of classification issued by the Trademark Office
- Rule 6 Application for registration: content related to a priority right claim as established in Article 6 of the Trademark Law
- Rule 7 Application for registration: content related to the protection of a trademark appearing at an international exhibition
- Rule 8 Application for registration: content related to a priority right claim derived from previous use in the Principality of Andorra
- Rule 9 Application for registration: content related to a priority right claim derived from trademark registration in a country that is party to the Paris Convention
- Rule 10 Application for registration: content related to the reproduction of a trademark
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- Rule 14 Receipt and examination of application for registration
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## **Chapter III –a Thorough Examination of Applications for Registration**

- Rule 17- a Thorough Examination of Applications for Registration

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- Rule 33 Format of the *Gaseta de Marques* (Trademark Gazette)
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## **Chapter VIII. Licensed representatives**

- Rule 34 Requisites for listing in the Register of Licensed Representatives
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- Rule 36 Entry in the Register of Licensed Representatives
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- Rule 38 Loss of condition of licensed representative
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## **Chapter IX. Forms of payment; signatures; searches in the file of a registered trademark; certified copies of registrations**

- Rule 40 Forms of payment
- Rule 41 Signatures
- Rule 42 Search in the file of a registered trademark; certified copies of registrations

## **Derogatory provision**

## **Final provision**

## **Chapter I**

### **General Provisions**

#### **Rule 1.- Representation before the Trademark Office**

1) The Trademark Office publishes the Register of Licensed Representatives in the *Gaseta de Marques* (Trademark Gazette). The requisites for accreditation as a representative before the Trademark Office are stipulated in Rule 34.

2) A licensed representative may only represent an applicant or owner if he is in possession of a power of attorney signed by the applicant or owner. The power of attorney need not be issued before a notary public.

3) The power of attorney must contain, as a minimum, the following information:

- a) the name and address of the applicant or owner;
- b) the name and address of the person the applicant or owner is appointing as his licensed representative;
- c) the actions the licensed representative is authorized to undertake;
- d) the applications for registration or the trademark registrations which the licensed representative is authorized to handle or a statement to the effect that the licensed representative is granted general powers of attorney to handle all applications for trademark registration and all current or future trademark registrations property of the person granting this power of attorney.

4) Except in the case established in Rule 28.1), a licensed representative may act before the Trademark Office without presenting this Office a power of attorney signed by the applicant or owner on whose behalf he is acting. However, when deemed necessary, the Trademark Office may request licensed representatives to submit the powers of attorney in virtue of which they are acting.

5) A licensed representative may authorize one or more of his employees, or one or more employees of the office to which the representative belongs, to act before the Trademark Office in his name and to sign on his behalf. This authorization shall be granted before the Trademark Office, in accordance with established Trademark Office procedure.

6) Should an application for registration be made in the name of various co-applicants or should a registered trademark become the property of various co-owners, these co-applicants or co-owners may only appoint a single licensed representative who shall represent all of them before the Trademark Office.

7) Should an application for registration be filed in the name of various co-applicants or should a registered trademark become the property of various co-owners, and when one or more of the aforementioned co-applicants or one or more of the aforementioned co-owners does not have his residence or headquarters or a real and effective industrial or commercial establishment in the Principality of Andorra, these co-applicants or co-owners shall appoint a single licensed representative who shall represent all of them before the Trademark Office.

#### **Rule 2.- Communication with the Trademark Office**

- 1) All applications for registration, renewal or entries in the Trademark Register shall be presented in the Catalan language, using the application forms stipulated by the Trademark Office.
- 2) Copies of the forms may be obtained from the Trademark Office upon payment of the fees established by the Law on Trademark Office Fees.
- 3) All applications for registration, renewal or entries in the Trademark Register shall be presented to the Trademark Office during the hours in which the office is open to the public. These hours shall be established by the Trademark Office and published in the *Gasetà de Marques* (Trademark Gazette).
- 4) Applications for registration, renewal or entries in the Trademark Register shall not be sent to the Trademark Office by mail, fax or electronic media.

## **Chapter II**

### **Application for Registration**

#### **Rule 3.- Application for registration**

- 1) Application for registration shall be made using the electronic application stipulated by the Trademark Office.
- 2) Application for registration shall be accompanied by payment of the fees established by the Law on Trademark Office Fees. The forms of payment are set out in Rule 40.

#### **Rule 4.- Application for registration: content related to the applicant and the representative**

- 1) Application for registration shall contain the information relative to the applicant stipulated in subparagraphs a) to e) of this paragraph. Should there be several co-applicants the application shall contain this information for each one of them.

- a) if the applicant is a natural person: first given name or first and second given names (when applicable), and first surname or first and second surnames (when applicable);
- b) if the applicant is a legal entity, the complete name of the entity and its legal form of constitution; notwithstanding the terms of Rule 2.1), should the legal form of constitution be other than one of the forms listed in the Catalan language in the electronic application form, the applicant shall list the legal form of constitution using the term employed in the original language;<sup>(1)</sup>
- c) the name of the State of which the applicant is a national, the State of which the applicant is a resident and the State in which the applicant has a real and effective industrial or commercial establishment. Should the applicant be a legal entity, the name of the State of which the applicant is a national shall be replaced by the name of the State and, if applicable, the name of the territorial division of this State -under the laws of which this legal entity was constituted;
- d) the complete address of the applicant or owner stated in the form customarily required for rapid postal delivery to the aforesaid address, including the house or building number , if any. Each applicant shall give only one address. When a single application is filed by various co-applicants with different addresses and no licensed representative has been appointed, the Trademark Office shall send its correspondence to only one of these addresses. Should the co-applicants not specify the address to which the Office should send all correspondence, the Office shall send the correspondence to the address of the co-applicant listed first on the application for registration;
- e) the name, address and license number of the applicant's licensed representative, if any.

- 2) All applications for registration may also contain the following information relative to the applicant:

- a) an identification number assigned to the natural person or legal entity under the terms of the legislation applicable to this person or entity;
- b) a telephone, fax and/or telex number;

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<sup>(1)</sup> Text modified on 13.01.99 (entry into force on 04.03.99)

c) an electronic mail address.

**Rule 5.- *Application for registration: content related to the products and/or services for which registration is sought***

1) All applications for registration shall include the name of the goods and/or services for which registration is sought, which shall be grouped according to the classes of the International Classification of Goods and Services established in the Nice Agreement of June 15, 1957, and its subsequent revisions and modifications (hereinafter, "the Nice classification"). Each group of goods or services shall be preceded by the number of the corresponding class and these groups shall be listed in the application for registration in the order of the classes of the Nice classification.

2) Designation of goods and services shall use the terminology established in the list of classes or the alphabetical list of the Nice classification in its translation to Catalan published by the Trademark Office.

3) The applicant may list in the Catalan language names of goods and/or services other than those provided for in paragraph 2) of this rule on condition that the applicant submit to the Trademark Office together with the application for registration, a copy of the certificate of classification issued by the Trade Mark Office for each one of these goods or services. Applications may be accompanied by a translation to Spanish, French or English of the name of the good or service involved.<sup>(1)</sup>

4) Should the applicant fail to deliver the copy of the certificate stipulated in paragraph 3) of this rule together with the application for registration, this copy may be delivered within a period of three months from the filing date.<sup>(2)</sup>

5) If, at the end of the three-month period stipulated in paragraph 4) of this rule, the applicant has not submitted the copy of the certificate stipulated in paragraph 3) of this rule, the Trademark Office shall consider that the application for registration of the goods and/or services other than those specified in the registration for application under the terms of paragraph 2) of this rule has been withdrawn and shall not refund any fee paid for this application for registration.<sup>(3)</sup>

**Rule 5 bis.- *Certificate of classification issued by the Trademark Office***<sup>(4)</sup>

1) Within three months the Trademark Office shall issue a certificate of classification in the Catalan language for a good or service not appearing in any of the lists mentioned in Rule 5.2) above, providing an application for a certificate of classification is filed using the form designated for this purpose by the Trademark Office and following advance payment of the fees established in accordance with the terms of Article 5.4)a) of the Law on Trademark Office Fees.

2) Applicants may file a single application requesting certificate of classification for several goods and/or services.

3) The application for a certificate of classification mentioned in Paragraph 1) of this rule may be accompanied by a classification proposal based on a classification of the good or service mentioned in Paragraph 1) above established by the International Office of the WIPO within the framework of the Madrid Arrangement and its Protocol. All proposals for classification shall include one of the following references:

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<sup>(1) (2) (3)</sup> Text modified on 13.01.99 (entry into force on 04.03.99)

<sup>(4)</sup> Rule added on 13.01.99 (entry into force on 04.03.99)



- a) the reference number of the list of goods and services classified by the WIPO International Office within the framework of the Madrid Arrangement and its Protocol which corresponds to the good or service for which a classification proposal is being submitted. Applicants shall use the latest edition of this list published by the Trademark Office, in its original French language version;
  - b) an international registration number whose date of registration is subsequent to December 31, 1991, stating the WIPO International Office classification for the good or service for which a classification proposal is being submitted.
- 4) Notwithstanding the terms of Paragraph 1) of this rule, should the Trademark Office be able to classify all the goods and services referred to in the application for classification in accordance with a classification proposal submitted in virtue of Paragraph 3) of this rule, the Trademark Office shall issue the certificate of classification within ten days and the amount of the classification fees shall be reduced as stipulated in Article 5.4)b) of the Law on Trademark Office Fees.<sup>(1)</sup>

**Rule 6. *Application for registration: content related to a priority right claim as established in Article 6 of the Trademark Law***

1) Any priority right by virtue of Article 6 of the Trademark Law shall be claimed in the form of a statement to that effect. This statement shall be made in the terms stipulated in the application form and shall contain the following information:

- a) the name of the State where the first application was filed or, if the first filing was a regional filing covering various states, the name of the trademark office where the first regional application was filed;
  - b) the date of the first filing;
  - c) the number of the first filing, should this number be available to the applicant;
  - d) if a priority right is not claimed for all the goods and services listed in the application, the name of those goods and/or services for which priority is claimed.
- 2) When a priority right is claimed on the grounds of various first filings, each of which corresponds to different goods and/or services, the application for registration shall include the information stipulated in paragraph 1) of this rule for each of these filings.
- 3) The applicant shall submit to the Trademark Office, together with the application for registration, a simple copy or photocopy of each filing on which the claim for priority right is based. If deemed necessary, the owner who has claimed a priority right in virtue of Article 6 of the Trademark Law shall submit to the competent legal authority a copy of each filing upon which the claim for priority is based, authenticated by the office where the filing took place.
- 4) Should the applicant fail to submit the copy stipulated in paragraph 3) of this rule together with the application for registration, this copy may be submitted within a period of three months from the filing date.
- 5) If, at the end of the three-month period stipulated in paragraph 4) of this rule, the applicant has not submitted the copy stipulated in paragraph 3) of this rule, the Trademark Office shall deny the priority claim and shall not refund any fee paid for this claim.

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<sup>(1)</sup> Text modified on 13.01.99 (entry into force on 04.03.99)

**Rule 7.- *Application for registration: content related to the protection of a mark appearing at an international exhibition***

1) Any protection derived from Article 7 of the Trademark Law shall be claimed in the form of a statement to this effect in the terms set out in the application form and shall contain the following information:

- a) the name of the international exhibition;
- b) the date on which the mark first appeared at this exhibition;
- c) the names of the goods and/or services in relation to which the mark appeared at the international exhibition and for which protection is sought under the terms of Article 7 of the Trademark Law.

2) The applicant shall submit to the Trademark Office, together with the application for registration, a document issued by the competent authorities of the aforementioned exhibition or by the competent authorities of the country in which the exhibition took place, confirming the information listed in paragraph 1) of this rule.

3) Should the applicant fail to submit the document stipulated in paragraph 2) of this rule together with the application for registration, this document may be submitted to the Trademark Office within a period of three months from the filing date.

4) If, at the end of the three-month period stipulated in paragraph 3) of this rule, the applicant has not submitted the document stipulated in paragraph 2) of this rule, the Trademark Office shall deny the claim for protection and shall not refund any fee paid for this claim.

**Rule 8.- *Application for registration: content related to a priority right claim derived from previous use in the Principality of Andorra*<sup>(1)</sup>**

1) Any right of priority by virtue of the first transitory provision of the Trademark Law shall be claimed in the form of a statement of prior use in accordance with the terms stipulated in the application for registration and shall contain the following information:

- a) the date on which the real and effective use of the trademark began in the Principality of Andorra;
- b) the names of the goods and/or services for which the real and effective use of the trademark was made in the Principality of Andorra.

2) When a priority right is claimed on the basis of various previous uses, each of which refers to different goods and/or services, the applicant shall provide the information stipulated in paragraph 1) of this rule for each of those previous uses.

3) The applicant is under no obligation to submit proof of the claimed use to the Trademark Office. Said proof, if necessary, shall be submitted to the competent legal authority.

**Rule 9.- *Application for registration: content related to a priority right claim derived from trademark registration in a country that is party to the Paris Convention*<sup>(2)</sup>**

<sup>(1)</sup> Rule expired according to Transitory Provision One (2) of the Trademark Act

<sup>(2)</sup> Rule expired according to Transitory Provision Two (2) of the Trademark Act

1) Any priority right in virtue of the second transitory provision of the Trademark Law shall be claimed in the form of a statement to this effect in accordance with the terms stipulated in the application for registration and shall contain the following information:

- a) the name of the country party to the Paris Convention for the Protection of Industrial Property in which the trademark was previously registered;
- b) the date and registration number of the trademark for which a priority right is claimed;
- c) should a priority right not be claimed for all the goods and services listed in the application for registration, the name of those goods and/or services for which priority is claimed.

2) When the claim for priority is based on various previous trademark registrations, each of which refers to different goods and/or services, the applicant shall provide the information stipulated in paragraph 1) of this rule for each of these trademark registrations.

3) The applicant shall submit to the Trademark Office, together with the application for registration, a simple copy or photocopy of each prior trademark registration on which the claim for priority is based. If deemed necessary, the owner who has claimed a priority right in virtue of the second transitory provision of the Trademark Law shall submit to the competent judicial authority a copy of each prior trademark registration on which the claim for priority is based, duly authenticated by the office where this trademark registration took place.<sup>(1)</sup>

4) Should the applicant fail to submit the copy stipulated in paragraph 3) of this rule together with the application for registration, this copy may be submitted within a period of three months from the filing date.

5) If, at the end of the three-month period stipulated in paragraph 4) of this rule, the applicant has not submitted the document stipulated in paragraph 3) of this rule, the Trademark Office shall deny the claim for priority and shall not refund any fee paid for this claim.

**Rule 10.- *Application for registration: content related to the reproduction of a trademark***

1) All applications for registration shall contain a sufficiently clear reproduction of the trademark for which registration is sought.

2) All verbal trademarks shall be reproduced on the electronic application, using the Latin letters and Roman or Arabic numerals that constitute the Trademark Office's standard typographic characters.

3) Should registration be sought for a trademark that cannot be reproduced using the Trademark Office's standard typographic characters or for a figurative mark, the application for registration shall contain a graphic reproduction of this mark:

- a) Should no color be specified the reproduction of the trademark shall be in black and white or a range of greys and shall be in the form of a computerized document in 8 x 8 format with a resolution of 300 dpi in accordance with the data processing standards accepted by the Trademark

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<sup>(1)</sup> Erratum corrected on 21.02.96

Office. The Trademark Office publishes the list of its accepted data processing standards in the *Gaseta de Marques* ( Trademark Gazette);

- b) Should the applicant stipulate color, the reproduction of the trademark shall be in color and shall be in the form of a computerized document in 8 x 8 format with a resolution of 300 dpi in accordance with the data processing standards accepted by the Trademark Office. The Trademark Office publishes in the *Gaseta de Marques* (Trademark Gazette) the list of color data processing standards accepted by the Trademark Office. The applicant may more precisely define each shade of color by using four-color separations (to indicate the percentages of cyan, magenta, yellow and black). Moreover, the applicant may define the texture or finish of each shade of color ( for example, giving the description "metallic "). Should there be any difference between a color appearing in the computerized document and a color resulting from the four-color separation , the color resulting from the four-color separation shall prevail;
- c) Should the trademark consist solely of one shade of color or a combination of colors, the application for registration shall contain a definition of the shade of color or of each of the colors that make up the color combination, using four-color separations (to indicate the percentage of cyan, magenta, yellow and black). Moreover, the applicant may define the texture or finish of each of the shades of color (for example, giving the description "metallic").

4) When the application for registration is relative to a three-dimensional trademark, the indication "three-dimensional trademark" must be included. In this case, reproduction of the trademark in accordance with paragraphs 3)a) or b) above may consist of several views of the trademark seen from different angles. The number of these views may not exceed six.

5) Should all or part of the trademark consist of one or more non-Catalan words which have a particular meaning in some other language and which meaning is known by the applicant, the applicant shall provide a Catalan translation of this word or words as well as specifying the original language.

6) Should all or part of the trademark consist of characters other than Latin or numerals other than Roman or Arabic, the applicant shall include their transliteration to Arabic numbers or Latin characters. The transliteration shall adhere to the rules of Catalan pronunciation.

#### **Rule 11.- *Application for registration: content related to registration of collective trademarks***

1) The applicant applying for registration of a collective mark shall specify "collective trademark" in the application.

2) The applicant applying for registration of a collective mark shall submit to the Trademark Office, together with the application for registration, the regulations governing the use of the collective trademark, which shall include the following information as a minimum:

- a) the legal nature of the owner of the collective trademark;
- b) the terms of use for the collective trademark;
- c) the grounds on which authorization to use the collective trademark may be extinguished.

3) Should the applicant fail to submit the regulations governing the use of the collective mark stipulated in paragraph 2) of this rule together with the application for registration, the applicant may submit these regulations governing use of the collective trademark within three months from the filing date.

4) If, at the end of the three-month period stipulated in paragraph 3) of this rule, the applicant has not submitted the regulations for use, the Trademark Office shall deny the application for registration of the collective trademark and shall not refund any fee paid for this application.

### **Chapter III**

#### **Receipt and examination of the form of application for registration**

##### **Rule 12.- *Verification of the right to acquire trademarks***

1) Should the Government of the Principality of Andorra find that a particular State does not grant nationals of the Principality of Andorra the same trademark protection as is granted to nationals of that State, the Government may instruct the Trademark Office to deny all applications for registration presented by any applicant who is a national of that State and does not meet any of the conditions established in Article 5.b) of the Trademark Law.

2) The Trademark Office maintains an up-to-date list of the States referred to in paragraph 1) of this rule and publishes it in the *Gaseta de Marques* (Trademark Gazette).

##### **Rule 13.- *Verification of the right to claim priority deriving from first filing***

1) Should the Government of the Principality of Andorra find that a particular State does not grant nationals of the Principality of Andorra a right of priority subject to conditions and having effects equivalent to those of the right of priority set out in Article 6 2) to 5) of the Trademark Law, the Government may instruct the Trademark Office to deny any claims for right of priority derived from a first filing in accordance with Article 6 of the Trademark Law which are filed by applicants who are nationals of that State and also deny any priority right claims derived from a first filing made in that State.

2) The Trademark Office maintains an up-to-date list of the States referred to in paragraph 1) of this rule and publishes it in the *Gaseta de Marques* (Trademark Gazette).

##### **Rule 14.- *Receipt and examination of form of application for registration***

1) The Trademark Office shall examine the form of application in order to determine whether the application for registration contains all the material and information required in each of the sections contained in the electronic application. However, during this examination of form, OMPA is under no obligation to verify the accuracy of the material and information contained in the application.

2) The applicant shall be held responsible under the terms of civil and/or criminal law for any inaccuracy found by the legal authorities in an application for registration.

3) In the hypotheses set forth in Rules 16 and 17.2)a), the Trademark Office shall print out on paper and in two copies the content of the application for registration.

4) The two copies mentioned in paragraph 3) of this rule shall be signed at the time the application is filed by the applicant or, in the event the application is presented by a licensed representative, by this licensed representative.

5) The Trademark Office shall keep the electronic application filed and one of the two signed copies specified in paragraph 4) of this rule and deliver the other copy to the applicant or his licensed representative, if any.

### **Rule 15.- Examination of documents accompanying application for registration**

1) The Trademark Office is under no obligation to examine whether:

- a) any copy of an application submitted under the terms of Rule 6.3) conforms to the information provided according to Rule 6.1);
- b) any documentary proof submitted under the terms of Rule 7.2) conforms to the information provided according to Rule 7.1);
- c) any statement as well as any information submitted under the terms of Rule 8.1) corresponds to a real and effective use of the trademark in the Principality of Andorra as of the alleged date and for the alleged goods and/or services;
- d) any copy of a trademark registration submitted under the terms of Rule 9.3) conforms to the instructions given in Rule 9.1);
- e) the regulations governing use submitted under the terms of Rule 11.2) contain the instructions prescribed by this rule;
- f) the translations into Spanish, English or French that may be attached according to Rule 5.3) are correct.

2) The applicant shall be held responsible under the terms of civil and/or criminal law for any falsification or inaccuracy found by the legal authority in any information, report, copy, documentary proof, statement or regulation governing use accompanying an application for registration.<sup>(1)</sup>

### **Rule 16.- Correct application**

Should the application for registration conform to Rules 3, 4.1), 5 and 10 or, if applicable, to Rules 6, 7, 8, 9 and 11, or, if applicable, the certificate of classification submitted under the terms of Rule 5.3) conforms to the indications given in Rule 5.1), the Trademark Office shall proceed to thoroughly examine the application in accordance with the provisions of Rule 17 a.

### **Rule 17.- Incorrect application**

1).The Trademark Office shall deny all applications for registration that do not conform to Rule 3.

- 2) a) Should the application for registration fail to conform to Rules 4.1), 5 or 10 or, if applicable, to Rules 6, 7, 8, 9 or 11 or, if applicable, the certificate of classification submitted under the terms of Rule 5.3) fails to conform to the indications given in Rule 5.1), but does conform to Rule 3 and contains:
- i) information serving to establish the identity of the applicant in accordance with Rule 4.1)a) or b);
  - ii) sufficient information for correspondence to be exchanged with the applicant as established in the first sentence of Rule 4.1)d) or with his licensed representative, if any, as established in Rule 4.1)e);
  - iii) a reproduction of the trademark for which registration is sought in accordance with Rule 10.2) or 3);
  - iv) a list of the goods and/or services for which trademark registration is sought, in accordance with Rule 5.1);

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<sup>(1)</sup> Text modified on 13.01.99 (entry into force on 04.03.99)

The Trademark Office shall assign the application for registration a filing date, return the electronic application to the applicant and ask him to remedy the defects therein by completing the electronic application with all the information required under the terms of Rule 16 other than that specified in points *i)*, *iii)*, *iii)*, *iv)* and *v)* of this sub-paragraph. The deadline for presentation of the completed form is three months from the filing date. The Trademark Office shall return the electronic application to the applicant for completion upon receipt of advance payment of the fees established by the Government of Andorra.<sup>(2) (3)</sup>

- b)* Should the applicant remedy the defects of his application for registration within the three-month period stipulated in sub-paragraph *a)* of this paragraph, the Trademark Office shall proceed to thoroughly examine the application as stipulated in Rule 17 a.
  - c)* Should the applicant fail to remedy the defects of his application for registration within the three-month period stipulated in sub-paragraph *a)* of this paragraph, the Trademark Office shall deny the application for registration and refund the fees paid for this application for registration.
- 3) Should the application for registration conform to Rule 3 but not contain, as a minimum, all the material and information stipulated in paragraph 2)*a)i)*, *iii)*, *iiii)* and *iv)* of this rule, the Trademark Office shall return the application and propose that it be re-submitted at any time together with the information stipulated in Rule 16. The fees paid for this application for registration shall be refunded to the applicant.

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<sup>(2)</sup> Text modified on 14.08.96 (entry into force on 11.09.96)

<sup>(3)</sup> Text modified on 13.01.99 (entry into force on 04.03.99)



### **Chapter IIIa**

#### **Thorough Examination of the Application for Registration**

##### **Rule 17-a. - *Thorough examination of the application for registration***

1) Within two months from the date the application for trademark registration and in accordance with available information the Trademark Office shall determine whether a symbol does not constitute a trademark under the terms of Article 2 of the Trademark Act. Should the Trademark Office request additional material in accordance with Paragraph 3 of this rule, the two-month period shall begin as of the date on which the material requested is submitted or, should the material fail to be delivered, on the date of expiry of the two-month period referred to in Paragraph 3 of this rule.

2) In order to carry out the examination referred to in Paragraph 1 of this rule, the Trademark Office may address a written request to the applicant within one month of the date on which application is filed, requesting delivery of additional material which the Trademark Office judges necessary in order to make the examination or which may constitute grounds for considering that a symbol may constitute a trademark.

3) The applicant shall have two months in which to submit the material requested under the terms of Paragraph 2 of this rule. Should this material fail to be delivered the Trademark Office shall proceed to thoroughly examine the application without the aforementioned material.

4) The Trademark Office shall carry out the examination referred to in Paragraph 1) of this rule on the basis of the material available and if, in accordance with the information at its disposal, the Trademark Office decides that a symbol does not constitute a trademark under the terms of Article 2 of the Trademark Act, the application shall be denied and the Trademark Office shall issue a resolution of denial which shall be sent to the applicant within 15 days of expiry of the period established in Paragraph 1 of this rule.

5) Should the application for registration be denied under the terms of Paragraph 4 of this rule, the applicant shall have two months from the date of receipt of the resolution of denial in which to present an application for review of the examination, to which the following material may be attached:

- a) Additional information referring to compliance with the terms of Article 2 of the Trademark Act;
- b) A waiver of protection of non-distinctive features of the trademark;
- c) Any other material which the applicant feels should be taken into consideration when the examination is reviewed.

6) Upon receipt of an application for review, the Trademark Office shall assign the examination review to a new examiner, who shall review the examination within two months from the date on which the application for review was received. Should the new examiner judge that a symbol does not constitute a trademark under the terms of Article 2 of the Trademark Act, the Trademark Office shall issue a resolution of denial which shall be sent to the applicant within two months following the date on which the application for review was received.

7) Should the application for registration finally be denied, the Trademark Office shall return the fee paid for application for the registration which was denied, less 50% to cover the cost of processing the application.

## **Chapter IV**

### **Registering trademarks in the Trademark Register: certificate of registration; conservation of information**

#### **Rule 17-b. Trademark Registration**

- 1) If the application for registration is not denied under the terms of Rule 17-a, the Trademark Office shall register the trademark.
- 2) The date of registration shall be the date on which the Trademark Office registered the application.
- 3) Notwithstanding Paragraph 1 of this rule, when an application is filed in accordance with Article 4.3) of the Trademark Act, the Trademark Office shall only proceed to register the application if the applicant presents proof that the legal authorities have ruled in favor of his/ her request for invalidation or prohibition of use.

#### **Rule 18.- Content of Trademark Registration and Certificate of Registration**

Registration of a trademark consists of the Trademark Office entering the following information in the Trademark Register:

- a) the registration number;
- b) date of registration, indicating the hour and the minute;
- c) date of expiration of registration;
- d) particulars of the owner, as per Rule 4.1)a) or b);
- e) the State of which the owner is a national, the State of which the owner is a resident and the State in which the owner has a real and effective industrial or commercial establishment, as per Rule 4.1)c);
- f) the address of the owner, as per Rule 4.1)d);
- g) the license number of the licensed representative, if any, as per Rule 4.1)e);
- h) the identification number, if any, of the natural person or legal entity owning the trademark registration, as per Rule 4.2)a);
- i) the telephone, fax and/or telex number, if any, of the owner of the trademark registration, in accordance with Rule 4.2)b);
- j) the electronic mail address, if any, of the owner of the trademark registration, as per Rule 4.2)c);
- k) a list of the goods and/or services for which the trademark is registered, grouped according to the classes established by the Nice Agreement, as per Rule 5;
- l) should a priority right be claimed by virtue of Article 6 of the Trademark Law, the information specified in Rule 6;
- m) should protection of a trademark appearing in an international exhibition be claimed by virtue of Article 7 of the Trademark Law, the information specified in Rule 7;
- n) should a priority right be claimed by virtue of prior use in the Principality of Andorra under the terms of the first transitory provision of Article 7 of the Trademark Law, the information specified in Rule 9;
- o) should a right of priority be claimed by virtue of trademark registration in a country party to the Paris Convention under the terms of the second transitory provision of the Trademark Law, the information specified in Rule 9;
- p) the reproduction of the trademark;

- q) the notation that the trademark is three-dimensional, if applicable;
  - r) the translation to Catalan of all or part of the trademark and the original language as specified in Rule 10.5), if applicable;
  - s) the transliteration of all or part of the trademark as per Rule 10.6, if applicable;
  - t) the notation that the mark is a collective trademark, if applicable;
  - u) the waiver of protection of non-distinctive features of the trademark, in accordance with Rule 28-a, if applicable;
  - v) the amount of the registration fees received.
- 2) The Trademark Office shall issue a certificate of registration which contains the material and information established in paragraph 1.a) to d), f),g), and k) to t) of this rule and shall send it by regular mail to the owner of the trademark or, in the event there are various co-owners, to the co-owner whose name appears first, or to their licensed representative, if any.

**Rule 19.- *Trademark Register and conservation of documents***

- 1) The Trademark Office shall conserve all entries in the Trademark Register.
- 2) The Trademark Office shall conserve all documents accompanying applications for registration or applications for entries in the Trademark Register, except when these applications are denied.

## **Chapter V**

### **Renewal and Expiration**

#### **Rule 20.- *Non-binding notifications of expiration***

Six months prior to expiration of the 10-year registration period in effect, the Trademark Office shall send the owner of the trademark or his licensed representative, if any, a non-binding notification of the date of expiration. The Trademark Office shall send the aforementioned notification by regular mail to the address of the owner or his licensed representative, if any, as listed in the Trademark Register.

#### **Rule 21.- *Deadlines for filing applications and paying fees for renewal***

1) The period during which application for renewal may be made and the corresponding renewal fees paid shall begin six months prior to the date of expiration of the 10-year registration period in effect and shall end six months after this date. Should the application for renewal be presented or the renewal fees paid during the six months following the date of expiration of the 10-year period in effect, renewal shall be subject to payment of the additional fee stipulated in Article 5.1)d) of the Law on Trademark Office Fees.

2) Should the Trademark Office not have received application for renewal and the corresponding renewal fees by the end of the six-month period following the date of expiration of the 10-year period in effect, the Trademark Office shall enter in the Trademark Register the date on which the trademark registration expired, in accordance with Article 28 of the Trademark Law.

#### **Rule 22.- *Application for renewal of trademark registration***

1) Application for renewal of a trademark registration shall be made on the form stipulated by the Trademark Office. This application shall be signed by the owner of the trademark registration or his licensed representative, if any.

2) The application for renewal shall contain the following information:

- a) a statement that renewal of a trademark registration is being sought;
- b) the number and date of the trademark registration for which renewal is sought;
- c) should renewal be applied for by a licensed representative other than the licensed representative listed in the Trademark Register, the name, address and license number of the new licensed representative;
- d) if renewal is not sought for all the goods and services for which the trademark is registered, the names of the goods and/or services for which the trademark is registered and for which renewal is not being sought.

3) The application for renewal shall be accompanied by payment of the renewal fees prescribed in the Law on Trademark Office Fees.

#### **Rule 23.- *Correct application***

1) Should the application for renewal comply with the conditions established in Rules 21.1) and 22, the Trademark Office shall enter the renewal in the Trademark Register, indicating the next expiration date and the number of the new licensed representative, if any, in accordance with the terms of Rule 22.2)c).

2) Should registration for all the goods and services covered by the registered trademark not be renewed, the Trademark Office shall enter in the Trademark Register the names of the goods and/or services for which registration has been renewed, in accordance with Rule 22.2)d).

**Rule 24.- *Incorrect application***

Should the application for renewal fail to comply with the conditions established in Rules 21.1) or 22), the Trademark Office shall deny the application for renewal and refund the renewal fees paid for this application. The owner may present a new application for renewal so long as the period prescribed in Rule 21.1) has not expired.

**Rule 25.- *Certificate of renewal***

The Trademark Office shall send a certificate of renewal by regular mail to the owner of the trademark or, if there are various co-owners, to the co-owner whose name appears first on the list, or to their licensed representative, if any. This certificate shall contain the information and material prescribed in Rule 18.2), updated as at the date of renewal and shall also state the next expiration date.

## **Chapter VI**

### **Modification, transfer, renunciation, issuance of licenses pledges and registration of judicial decisions**

#### **Rule 26.- *Application for changes in the name or address of the owner; change of licensed representative***

1) Application for registration of changes in the name (that do not entail a change of owner) or address of the owner of a trademark registration shall be submitted on the form stipulated by the Trademark Office. This application shall be signed by the owner of the trademark registration or his licensed representative, if any.<sup>(1)</sup>

2) Application for registration of changes in the name or address of the owner of a trademark registration shall be accompanied by payment of the fees prescribed in the Law on Trademark Office Fees and shall contain the following information:

- a) a statement that application is being made to register a change in the name or address of the owner of a trademark registration;
- b) the number of the trademark registration which is to be modified;
- c) the name and address of the owner of the trademark registration as listed in the Trademark Register;
- d) the name or address of the owner which is to be entered in the Trademark Register.

3) When the same modification affects several trademark registrations belonging to a single owner, it shall suffice to present a single application, providing the application lists the numbers of all the trademark registrations affected.

4) The Trademark Office shall deny any application for changes that do not comply with the conditions established in paragraphs 1) or 2) of this rule and shall refund the fees paid for these applications.

5) Should the application comply with the conditions established in paragraphs 1) and 2) of this rule, the Trademark Office shall enter the change in the Trademark Register, noting the information described in paragraph 2.d) of this rule.

6) The change entered in the Trademark Register shall bear the date on which the Trademark Office received the application for change in accordance with paragraphs 1) and 2) of this rule.

7) Application to register the change of the licensed representative shall be submitted on the form stipulated by the Trademark Office. This application shall be signed by the owner of the trademark registration or his new licensed representative, if any. When the change of licensed representative affects several trademark registrations belonging to the same owner, it shall suffice to present a single application, providing the application lists the numbers of all the trademark registrations affected. The Trademark Office shall enter changes in licensed representatives automatically and without charge.

#### **Rule 27.- *Application to enter a trademark assignment***

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<sup>(1)</sup> Text modified on 13.01.99 (entry into force on 04.03.99)

1) Application to enter a trademark assignment shall be presented on the form stipulated by the Trademark Office. This application shall be signed by the owner listed in the Trademark Register, or the assignee, or the licensed representative of the owner or the assignee, if any. Application to enter a trademark assignment shall be accompanied by one of the following documents:

- a) copy of the assignment contract, authenticated by a notary public or other competent public authority of the State in which the assignment took place. Should the copy of the contract not be in the Catalan language, a translation to Catalan shall be submitted together with the application;
- b) an excerpt from the assignment contract which contains the information prescribed in paragraph 2.b) to f) of this rule as well as the names of the signers of this contract. This excerpt shall be certified by a notary public or other competent public authority of the State in which assignment took place. Should the extract of the assignment contract not be in the Catalan language, a translation to Catalan shall be submitted together with the application;
- c) a certificate of assignment presented on the form stipulated by the Trademark Office. The certificate of assignment shall contain the information prescribed in paragraph 2.b) to f) of this rule and shall be signed by the owner listed in the Trademark Register and by the assignee.

2) Application to enter an assignment of a trademark registration shall be accompanied by payment of the fees prescribed in the Law on Trademark Office Fees and shall contain the following information:

- a) a statement that application is being made to enter an assignment;
- b) the number of the trademark registration being assigned;
- c) the name and address of the owner of the trademark registration listed in the Trademark Register;
- d) the name and address of the assignee in the form established in Rule 4 for applicants filing for registration, as well as all other information about the assignee which may or shall be provided by the applicant in the application for registration;
- e) if the assignment is for only one part of the goods and services for which the trademark is registered, the names of those goods and services which are to be assigned, classified in accordance with the Nice Classification;
- f) should only a part of the product or service for which the trademark is registered be assigned, the name of the product or service registered, the name of the product or service being assigned, and the name of the remaining products or services which are not being assigned, classified in accordance with the Nice classification. Should the applicant use a name of the product or service in the Catalan language and this product or service does not appear in any of the lists referred to in Rule 5.2) the application shall be accompanied by a classification certificate as stipulated by the Trademark Office for each of these products or services or by an application for classification of these products or services in accordance with the provisions of Rule 5 a). A translation to Spanish, French or English of the name of this product or service may be attached to the application

3) When the same assignment affects several trademark registrations belonging to a single owner, it shall suffice to present a single application, providing the application lists the numbers of all the trademark registrations affected.

4) The Trademark Office shall deny any application to register a trademark assignment that does not comply with the conditions established in paragraphs 1) or 2) of this rule and refund the fees paid for these applications.

5) Should the application comply with the conditions established in paragraphs 1) and 2) of this rule, the Trademark Office shall enter the assignment in the Trademark Register with the following indications:

- a) the part assigned shall be entered as a new trademark registration with a new registration number and the same information relative to priority and expiry of registration as appears in the trademark register for the products or services from which the assignment has been made. The new registration shall contain the information stipulated in Paragraph 2.d) of this rule and, if applicable, the information stipulated in Paragraph 2.e) and/or f) of this rule.
- b) in the event that part of the trademark registration is not being assigned, this part shall continue to be registered with the number it had before and the Trademark Office shall make the annotations stipulated in Rule 2)e) and/or, if applicable, 2)f) of this rule.

6) The assignment entered in the Trademark Register shall bear the date on which the Trademark Office received the application for entry in accordance with paragraphs 1) and 2) of this rule.

#### **Rule 28.- Application for registration of a trademark waiver**

1) Application to register a trademark waiver shall be presented on the form stipulated by the Trademark Office. This application shall be signed by the owner listed in the Trademark Register or his licensed representative, if any. When application to register a trademark waiver is signed by a licensed representative, the licensed representative shall submit to the Trademark Office a power of attorney signed by the owner listed in the Trademark Register, which power of attorney shall expressly grant the licensed representative the right to register a trademark waiver.

2) Application for registration of a trademark waiver shall be accompanied by payment of the fees stipulated in the Law on Trademark Office Fees and shall contain the following information:

- a) a statement that application is being made to enter a renunciation;
- b) the number of the trademark registration being renounced;
- c) the name and address of the owner of the trademark registration listed in the Trademark Register;
- d) if all the goods and/or services for which the trademark is registered are to be renounced, a statement to the effect that the application is for registration of full renunciation;<sup>(1)</sup>
- e) if not all the goods and/or services for which the trademark is registered are to be assigned a statement to the effect that the application is for registration of partial assignment. In this case, the names of those goods and/or services which are not assigned must be given, classified in accordance with the Nice classification. Should the applicant use a name of a product or service which is in the Catalan language and does not appear on any of the lists referred to in Rule 5.2) the application shall be accompanied by a classification certificate as stipulated by the Trademark Office for each of these products or services or by an application for classification of these products or

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<sup>(1)</sup> <sup>(2)</sup> Text modified on 13.01.99 (entry into force on 04.03.99)



services in accordance with the provisions of Rule 5 a). A translation to Spanish, French or English of the name of this product or service may be attached to the application.

3) If the trademark registration affected by application for registration of a waiver has been pledged and this has been duly entered in the Trademark Register, the Trademark Office shall deny the application to register the waiver unless the owner of the trademark registration submits to the Trademark Office, together with this application for entry, the consent of the pledgee. This consent shall be in writing and shall be signed by the pledgee.

4) When the waiver affects several trademark registrations belonging to a single owner, it shall suffice to present a single application, providing the application lists the numbers of all the trademark registrations affected.

5) The Trademark Office shall deny any application for changes that do not comply with the conditions established in paragraphs 1), 2) or 3) of this rule and shall refund the fees paid for these applications.

6) Should the application comply with the conditions established in paragraphs 1) to 3) of this rule, the Trademark Office shall enter the waiver in the Trademark Register, noting the information described in paragraph 2.d) and e) of this rule, if applicable.<sup>(2)</sup>

7) The renunciation entered in the Trademark Register shall bear the date on which the Trademark Office received the application for entry in accordance with paragraphs 1) to 3) of this rule.

8) The Trademark Office shall reject all applications for partial waiver and return the fees paid for these applications should it transpire that any of the goods and/or services listed in accordance with Paragraph 2.e) of this rule are not included among the goods and/or services included in the registration for which application for partial waiver is being filed.<sup>(1)</sup>

#### **Rule 28-a- Application for registration of waiver of protection of non-distinctive trademark features**

1) Application to register a waiver of protection of non-distinctive trademark features for all or part of the products and/or services included in the application for registration or, if applicable, in the trademark registration shall be presented in the form stipulated by the Trademark Office and at the same time as filing the application for registration or at any other time so long as the trademark registration continues to be in force.

2) Application to register waiver of protection of non-distinctive trademark features shall be accompanied by payment of the fees stipulated in the Trademark Office Fees Act and shall contain the following information:

- a) a statement to the effect that registration of waiver of protection of non-distinctive trademark features is being applied for;
- b) the number of the application for registration or, if applicable, the registration number of the trademark which is to be affected by this waiver;
- c) the name and address of the applicant as shown on the application or, if applicable, the owner of the trademark registration listed in the Trademark Register;

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<sup>(1)</sup> Text modified on 13.01.99 (entry into force on 04.03.99)

- d) a reproduction of the verbal features for which protection is to be waived, using the characters referred to in Rule 10.2);
  - e) a reproduction of the non-verbal features for which protection is to be waived, using an electronic document in 8 x 8 format and with a resolution of 300 dpi in accordance with the software standards accepted by the Trademark Office,. This reproduction may be presented in color, in black and white or in shades of grey, depending on how the application for registration was presented in accordance with Rule 10.2; the document shall not contain reproductions of more than 6 of these features, and as many electronic documents as necessary may be presented with the same application;
  - f) if the waiver does not affect all the goods and/or services for which the trademark is registered, either the names of the goods and/or services for which protection is not to be waived or the names of those which are to be waived shall be listed in accordance with the categories in the Nice Classification. Should the applicant use a name of a product or good in the Catalan language and which does not appear in any of the lists referred to in Rule 5.2) a statement to the effect that protection of non-distinctive trademark features is to be waived shall be submitted to the Trademark Office together with the application for registration of waiver of protection of non-distinctive trademark features, a copy of a classification certificate specified by the Trademark Office for each one of these goods or services or else an application for classification of these goods and services in accordance with the terms of Rule 5-a. A translation of the name of these goods and services to Spanish, French or English may be attached to the application.
- 3) a) Should the application for registration of waiver of protection of non-distinctive trademark features comply with the terms of Paragraphs 1) and 2) of this rule and be presented prior to expiry of the period established in Rule 17-a.1), the Trademark Office shall take this waiver into account when carrying out a thorough examination of the application.
- b) Should the application for registration of waiver of protection of non-distinctive trademark features comply with the terms of Paragraphs 1) and 2) of this rule and be presented under the terms of Rule 17-a 5)b), the Trademark Office shall take this waiver into account when reviewing the thorough examination of the application.
- c) Should the application for registration of waiver of protection of non-distinctive trademark features comply with the terms of Paragraphs 1) and 2) of this rule and be presented after the trademark is registered, the Trademark Office shall enter this waiver in the Trademark Register with the notations specified in Paragraphs 2.d) and/or e) and, if applicable, f) of this rule.

#### **Rule 29.- Application for registration of a license contract**

1) Application to register a license contract for a trademark registration shall be presented on the form stipulated by the Trademark Office. This application shall be signed by the owner listed in the Trademark Register or the licensee, or the licensed representative, if any, of the owner or the licensee. Application for registration of a license contract shall be accompanied by one of the following documents:

- a) a copy of the license contract, authenticated by a notary public or other competent public authority of the country in which the license contract was issued. If the copy of the contract is not in the Catalan language a translation

of the copy of the contract to this language shall be submitted together with the application for registration;

- b) an excerpt from the license contract which contains the following information:
  - i) the information stipulated in paragraph 2.b) to e) of this rule;
  - ii) the name of the signers of this contract;
  - iii) the information relative to quality control established in Article 20 of the Trademark Law.

The excerpt from the license contract shall be certified by a notary public or other competent authority of the country in which the license contract was issued. If the excerpt from the license contract is not in the Catalan language a translation of the excerpt to this language shall be submitted together with the application for registration.

- c) a certificate to the effect that a license contract has been issued, presented on the form stipulated by the Trademark Office. The certificate to the effect that a license contract has been issued shall contain the information stipulated in paragraph 2.b) to e) of this rule and the information relative to quality control established in Article 20 of the Trademark Law. This certificate shall be signed by the owner listed in the Trademark Register and by the licensee.

2) Application for registration of a license contract shall be accompanied by payment of the fees stipulated by the Law on Trademark Office fees and shall contain the following information:

- a) a statement that application to register a license contract is being filed;
- b) the number of the trademark registration for which the license contract has been issued;
- c) the name and address of the owner of the trademark registration listed in the Trademark Register;
- d) the name and address of the licensee in the form established for applicants filing an application for registration in Rule 4.1) a), b) and d);
- e) if the license contract is not for all the goods and services for which the trademark is registered, the names of those goods and services for which the license contract is issued. Should the applicant use a name of a product or service which is in the Catalan language and does not appear on any of the lists referred to in Rule 5.2) the application for registration of a license contract shall be accompanied by a classification certificate as stipulated by the Trademark Office for each of these products or services or by an application for classification of these products or services in accordance with the provisions of Rule 5 a). A translation to Spanish, French or English of the name of these products or services may be attached to the application.

3) When the same license contract covers various trademark registrations belonging to the same owner, it shall suffice to present a single application, providing the application lists the numbers of all the trademark registrations affected.

4) The Trademark Office shall deny any application for registration that does not comply with the conditions established in paragraphs 1) or 2) of this rule and shall refund the fees paid for this application.

5) Should the application comply with the conditions established in paragraphs 1) and 2) of this rule, the Trademark Office shall register the license contract in the Trademark

Register, noting the information described in paragraph 2.d) of this rule and, if applicable, the information described in paragraph 2.e) of this rule.

6) The license contract registered in the Trademark Register shall bear the date on which the Trademark Office received the application for registration in accordance with paragraphs 1) and 2) of this rule.

7) The conditions established in this rule for an application to register a license contract and for registration in the Trademark Register and publication of registration of a license contract shall apply *mutatis mutandis* to applications to cancel the registration of a license and to register such cancellation in the Trademark Register and publication of the cancellation of the registration of a license.

### **Rule 30.- *Application to register a trademark pledge***

1) Application to register a trademark pledge shall be presented on the form established by the Trademark Office. It shall be signed by the owner listed in the Trademark Register, or by the pledgee, or by the licensed representative, if any, of the owner or the pledgee.

2) Application for registration of a trademark pledge shall be accompanied by payment of the fees prescribed by the Law on Trademark Office Fees and a copy of the pledge or an excerpt from this pledge which contains the information described in subparagraphs *b)* to *d)* of this paragraph as well as the names of the signers of this pledge. The copy of the pledge or the excerpt from this pledge shall be certified by a notary public or other competent public authority of the country in which the pledge was made. If the copy of the pledge or the extract thereof is not in the Catalan language a translation to this language of the copy or the excerpt shall be submitted together with the application for registration. Application for registration shall contain the following information:

- a)* a statement that application is being made to register a pledge;
- b)* the registration number of the trademark being pledged;
- c)* the name and address of the owner of the trademark registration listed in the Trademark Register;
- d)* the name and address of the pledgee in the form established for applicants for registration in Rule 4.1)a), *b)* and *d)*.

3) When the same pledge covers various trademark registrations belonging to the same owner, it shall suffice to present a single application, providing the application lists the numbers of all the trademark registrations affected.

4) The Trademark Office shall deny any application that does not comply with the conditions established in paragraphs 1) or 2) of this rule and shall refund the fees paid for this application.

5) Should the application comply with the conditions established in paragraphs 1) and 2) of this rule, the Trademark Office shall register the pledge in the Trademark Register, noting the information described in paragraph 2.d) of this rule.

6) The pledge registered in the Trademark Register shall bear the date on which the Trademark Office received the application for registration in accordance with paragraphs 1) and 2) of this rule.

7) The conditions established in this rule for an application to register a pledge and for registration in the Trademark Register and publication of registration of a pledge shall apply *mutatis mutandis* to applications to cancel the registration of a pledge and to register such cancellation in the Trademark Register and the publication of the cancellation of a pledge.

### **Rule 31.- Registration of judicial decisions**

1) The Trademark Office shall enter in the Trademark Register all judicial decisions that affect a trademark registration, when so required by the judicial or administrative authorities or any interested party.

2) Registration of transfer of a trademark registration in virtue of a decision taken under the terms of Article 18 of the Trademark Law is contingent upon payment by the new owner of the fee prescribed in the Law on Trademark Office Fees for registration of a transfer.

### **Rule 31 –a .- Application for correction of error<sup>(1)</sup>**

1) Applications for correction of error shall be submitted on the form designated for this purpose by the Trademark Office. This application shall be signed by the applicant or owner of the trademark registration or, if applicable, his licensed representative.

2) Applications for correction of error shall be accompanied by payment of the fees established in the Law on Trademark Office Fees and shall contain the following information :

- a) a statement that application is being made for correction of an error;
- b) the number of the trademark registration or the application for registration which is to be corrected;
- c) the correction desired.

3) The Trademark Office shall not correct any error made by the applicant or the owner of the trademark registration should this correction involve modifying the trademark in such a way as to alter the symbol, the goods or services, or the owner of the registration, or should the correction involve changing a priority.  
The Trademark Office may specifically accept application for correction of one of the following errors:

- a) errors related to submission of a document accompanying an application for trademark registration, providing that the correct document is submitted to the Trademark Office within three months from the date on which the application was filed;
- b) errors made by the applicant when transcribing the following information contained in the documents accompanying an application for trademark registration:
  - i) the name of one of the goods and/or services listed under the terms of Rule 5.3);
  - ii) the name of the state in which the first application was filed, as specified in Rule 6;

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<sup>(1)</sup> Rule added on 13.01.99 (entry into force on 04.03.99)

- iii) the name of the international exhibition, as specified in Rule 7;
  - iv) the name of the member country of the Paris Convention for the Protection of Industrial Property in which the trademark was previously registered, as specified in Rule 9;
  - v) the date of the first filing, as specified in Rule 6;
  - vi) the date of the first presentation of the mark at an international exhibition, as specified in Rule 7;
  - vii) the date of previous registration of a mark for which a priority right is claimed, as specified in Rule 9;
  - viii) the number of the first application filed, as specified in Rule 6;
  - ix) the number of the previous trademark registration for which a priority right is claimed, as specified in Rule 9;
- c) errors made by the applicant in translating or transcribing the name of a good and/or service for which a priority right is being claimed under the terms of Rules 6, 7 or 9, if this name appears in the document accompanying the claim;
- d) error relative to the following information, providing that the correct information can be proved by means of an official document recognized by the Trademark Office and that the correction does not affect the rights or obligations of the applicant or owner of the registration:
- i) the legal form of constitution of the applicant or owner of the trademark registration, as specified in Rule 4.1) b);
  - ii) the name of the state in which the applicant or the owner of the trademark registration is a national, as specified in Rule 4.1)c);
  - iii) the name of the state in which the applicant or the owner of the trademark registration is a resident, as specified in Rule 4.1)c);
  - iv) the name of the state in which the applicant or the owner of the trademark registration has a real and effective industrial or commercial establishment, as specified in Rule 4.1)c);
  - v) the identification number of the natural person or legal entity, as specified in Rule 4.2)a);
  - vi) the telephone, fax and/or telex number, as specified in Rule 4.2)b);
  - vii) the electronic mail address, as specified in Rule 4.2)c);
- 4) When the same correction affects various applications for registration and/or various trademark registrations pertaining to the same applicant or owner, it is sufficient to present a single application for correction of error providing that the numbers of all the registrations and/or applications affected are listed therein.
- 5) The Trademark Office shall reject all applications for correction of error which do not fulfil the conditions stipulated in Paragraphs 2) and 3) of this rule and shall return the fees paid for these applications.
- 6) Should the application for correction of error fulfil the conditions stipulated in Paragraph 1) of this rule, the Trademark Office shall make the requested correction in the Trademark Register.

## **Chapter VII**

### **Publication of the *Gaseta de Marques*(Trademark Gazette)**

#### **Rule 32.- *Frequency of publication***

The Trademark Office shall publish the *Gaseta de Marques* (Trademark Gazette) at least once every three months.

#### **Rule 33.- *Format of the Trademark Gazette***

1) The Trademark Office shall publish the *Gaseta de Marques* (Trademark Gazette) on a Cd-Rom or other similar digital medium.

2) The publication shall contain the following information and material:

- a) trademark registrations, listing the information and material described in Rule 18.1)a) to d), f), g) and k) to t);
- b) registration numbers of trademark registration renewals, listing the information described in Rule 23.1) and, if applicable, the information described in Rule 23.2);
- c) changes in the name and address of owners, listing the information described in rule 26.5) and the date established in Rule 26.6);
- d) changes of licensed representative in accordance with Rule 26.7, listing the name of the new licensed representative and the numbers of the trademark registrations affected by a change of licensed representative;
- e) assignments, listing the name and address of the assignee and the number of his licensed representative, if any; the information described in Rule 27.5) and, the date stipulated in Rule 27.6);
- f) waivers, listing the information described in Rule 28.6 and the date established in Rule 28.7);
- g) waivers of protection of non-distinctive trademark features, listing the features for which protection is waived in accordance with Rule 28-a 2)d and/or e).
- h) license contracts, listing the information described in Rule 29.5 and the date established in Rule 29.6);
- i) pledges, listing the information described in Rule 30.5) and the date established in Rule 30.6);
- j) summary of the judicial decisions registered by virtue of Rule 31.1) as well as transfers described in Rule 31.2).

3) The Trademark Office shall supply the *Gaseta de Marques* (Trademark Gazette) on a CD-Rom or a paper copy of all or part of the *Gaseta de Marques* (Trademark Gazette) to all interested parties upon request and after due payment of the fee established by the Government of Andorra.<sup>(1)</sup>

4) The Trademark Office shall make one copy of the *Gaseta de Marques* (Trademark Gazette) available for free public consultation in the Trademark Office.

#### **Rule 33 bis.- *Language of the Gaseta de Marques (Trademark Gazette)*<sup>(2)</sup>**

<sup>(1)</sup> Text modified on 13.01.99(entry into force on 04.03.99)

<sup>(2)</sup> Rule added on 13.01.99 (entry into force on 04.03.99)

The Trademark Office shall publish the *Gaseta de Marques* (Trademark Gazette) in the Catalan language. It may also be published in other languages should the Trademark Office consider it advisable.



## **Chapter VIII**

### **Licensed representatives**

#### **Rule 34.- *Requisites for listing in the Register of Licensed Representatives***

- 1) Only natural persons shall be listed in the Register of Licensed Representatives.
- 2) The requisites for listing in the Register of License Representatives are as follows:
  - a) comply with the conditions established by current legislation for ownership of economic activities in the Principality of Andorra;
  - b) be a resident of the Principality of Andorra;
  - c) have a real and effective establishment in the Principality of Andorra equipped with data processing material compatible with the requisites of the computer programs stipulated by the Trademark Office for the elaboration of electronic applications and for searching for and reading information from the *Gasete de Marques* (Trademark Gazette) on the medium described in Rule 33.1);
  - d) have no criminal record;
  - e) hold an official university degree recognized by the Government of the Principality of Andorra (a "maîtrise ") or its equivalent if it is a degree awarded or validated in France or a "licenciatura " or its equivalent if it is a degree awarded or validated in Spain;
  - f) pass the test on Trademark Office proceedings established by said Office;
  - g) pay the fees prescribed by the Law on Trademark Office Fees.
- 3) The functions of a licensed representative are incompatible with positions as a civil servant or salaried employee of any of the following entities:
  - a) Administració de Justícia, Tribunal Constitucional, Consell Superior de la Justícia, Consell General or any organism of the public administration of the Principality of Andorra as defined in Article 13 of the *Codi de l'Administració* (Administrative Code).
  - b) Embassies, consulates, diplomatic missions accredited in Andorra or any other organism reporting to a foreign government.
- 4) The Trademark Office shall administer the test stipulated in paragraph 2.f) of this rule at least once a year.
- 5) Payment of the fee prescribed in Article 5.5) of the Law on Trademark Office Fees shall entitle applicants to take the test stipulated in paragraph 2.f) of this rule at any or all times it is given during a three-year period.<sup>(1)</sup>

#### **Rule 35.- *Application for registration as a licensed representative***

- 1) All licensed representatives shall be registered in the Trademark Office Register of Licensed Representatives in order to exercise their profession. There is no limit on the number of licensed representatives.
- 2) Application for registration as a licensed representative in the Trademark Office Register of Licensed Representatives shall be presented to this Office on the form

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<sup>(1)</sup> Text added on 14.08.96 (entry into force on 11.09.96)

stipulated by this Office and shall include a statement to this effect in the terms stipulated in said form, and shall further include the following information:

- a) the surname or two surnames (if applicable) and given name or two given names (if applicable) of the applicant;
- b) the applicant's place of residence;
- c) if the applicant is an Andorran national, his passport number;
- d) if the applicant is not an Andorran national, his nationality, passport number and the date on which he began residing continuously in the Principality of Andorra;
- e) the address of his real and effective establishment as prescribed in Rule 34.2)c).

3) The application stipulated in paragraph 2) of this rule shall be accompanied by payment of the fees prescribed by the Law on Trademark Office Fees and the following documents:

- a) a sworn statement that the applicant has no criminal record in any country;
- b) an authenticated copy of one of the degrees required under the terms of Rule 34.2)e);
- c) a certificate issued by the Trademark Office stating that the applicant has passed the test described in Rule 34.2)f);
- d) a sworn statement that the status of the applicant is not incompatible with the terms of Rule 34.3);
- e) a copy of the applicant's Andorran passport or a certificate issued by the offices of the Government of the Principality of Andorra stating that the applicant complies with the residence requirements derived from Rule 34.2)a).

4) Applicants belonging to a professional association recognized by the Government of the Principality of Andorra, members of which are required to hold the degrees established in Rule 34.2)e) and comply with the terms of Rule 34.2)a) may, in lieu of the documents stipulated in paragraph 3)b) and e) of this rule, submit a certificate issued by this professional association attesting that they hold said degree and comply with said conditions.

### **Rule 36.- *Entry in the Register of Licensed Representatives***

1) The Trademark Office shall deny any application for entry in the Register of Licensed Representatives that does not comply with the conditions established in rule 35.2), 3) or 4).

2) Should the application for entry in the Register of Licensed Representatives comply with the conditions established in Rule 35.2) to 4) the Trademark Office shall register the licensed representative in the Register of Licensed Representatives, with the following information:

- a) the surname or two surnames (if applicable) and given name or two given names (if applicable) of the licensed representative;
- b) the licensed representative's place of residence;
- c) the address of his establishment as prescribed in Rule 34.2)c);
- d) the license number of the licensed representative;
- e) the date on which he has become a licensed representative;
- f) if the licensed representative is an Andorran national, his passport number;

- g) if the applicant is not an Andorran national, his nationality, passport number and the date on which he began residing continuously in the Principality of Andorra.

**Rule 37.- *Changes in the name, place of residence or address of the licensed representative. Non-transferability of licensed representation***

1) All licensed representatives shall inform the Trademark Office of any changes in name, place of residence or address of the establishment prescribed in Rule 34.2)c) and shall apply for registration of these changes in the Trademark Office Register of Licensed Representatives, using the form stipulated by the Trademark Office. The Trademark Office shall register this change automatically and without charge.

2) The condition of licensed representative is non-transferrable.

**Rule 38.- *Loss of condition of licensed representative***

The Trademark Office shall strike from the Register of Licensed Representatives:

- a) any deceased licensed representative;
- b) any licensed representative who no longer complies with the conditions established in Rule 34.2);
- c) any licensed representative whose status is incompatible with the terms of Rule 34.3);
- d) any licensed representative who renounces his condition of licensed representative;
- e) any licensed representative who forfeits the right to exercise the functions of a licensed representative in consequence of a judicial decision or of an administrative resolution issued by the Government of the Principality of Andorra at the proposal of the director of the Trademark Office, based on repeated failure to comply with the trademark regulations in effect or based on repeated practices contrary to the correct professional behavior expected of a licensed representative.

**Rule 39.- *Publication of entries in the Register of Licensed Representatives***

The Trademark Office shall publish in the *Gasete de Marques* (Trademark Gazette) all the entries made in the Register of Licensed Representatives.

## **Chapter IX**

### **Forms of payment; signatures; searches in the file of a registered trademark; certified copies of registrations**

#### **Rule 40.- *Forms of payment***

The Trademark Office shall accept payment of fees by debit or credit cards on the premises of the Trademark Office as well as payment made at the central cashier's office of the Government of the Principality of Andorra in cash or by any other means of payment accepted by said cashier's office. The Trademark Office shall publish in the *Gaseta de Marques* (Trademark Gazette) the names of the debit and credit cards accepted by the Trademark Office.<sup>(1)</sup>

#### **Rule 41.- *Signatures***

1) Any form or document which shall be signed by the owner or applicant shall be signed by each and every one of the co-owners or co-applicants, if any.

2) When the owner, the applicant, co-owner or co-applicant is a legal entity, the signature of the natural person signing on behalf of the legal entity shall be accompanied by the indication in capital letters of the surname or two surnames (if applicable) as well as the given name or two given names (if applicable) of this natural person and the title by virtue of which he is authorized to sign on behalf of this legal entity.

#### **Rule 42.- *Search in the file of a registered trademark; certified copies of registrations***

Anyone with a justified legitimate interest may apply to the Trademark Office for a search in the file of a registered trademark and/or a certified copy of an entry in the Trademark Register and of any document stipulated in Rule 19.2), using the form stipulated by the Trademark Office and following payment of the fees established by the Government of Andorra.

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<sup>(1)</sup> <sup>(2)</sup> Text modified on 13.01.99 (entry into force on 04.03.99)

### **DEROGATORY PROVISION**

The following Regulations Governing the Trademark Act and the Trademark Office Fees Act of January 1995 are hereby repealed: 14.1), 15.1), 16, 17.2)a) Paragraph 1, 17.2b), 18.1)u) and v), 18.2), 27.2)e) and f), 27.5) and 7), 28.2)e), 29.2)e), 33.2)e), g), h), i) and j) and any other provisions that contradict the terms of this amended version of the Regulations.

### **FINAL PROVISION**

These Regulations shall go into effect fifteen days from the date of their publication in the Butlletí Oficial (Official Bulletin) of the Principality of Andorra.<sup>(1)</sup>

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<sup>(1)</sup> Entry into force on 04.03.99