

### **Statement of purpose**

Protection of the marks used to differentiate goods and services, defined in this law as product or service trademarks, is not only one of the most valuable assets of any company or individual, but also guarantees those distinguishing qualities which are of particular interest to their creator, owner and, increasingly, to consumers themselves. Because a considerable number of goods and services are marketed in the Principality of Andorra, it is imperative that a law be enacted in order to assure sufficient legal protection of the rights of both Andorran and foreign nationals to own and use industrial, commercial and other types of trademarks.

The law set out on the following pages stipulates the terms of protection and acquisition of trademark rights as well as procedures governing trademark registration, renewal, renunciation, termination and expiration. Moreover, it establishes the legal actions which may be taken in defense of the legitimate holders of trademarks, rejecting special procedures which do not always provide the necessary legal guarantees. The law therefore stipulates that all litigation shall be handled according to abridge procedure.

The law also includes a transitory right intended to prevent third parties from taking advantage of a new national trademark register in order to register trademarks whose legitimate owners/users are legally entitled to use them in Andorra or abroad by virtue of prior rights. Chapter II, Rule IX therefore regulates the “prior rights” of owners/users who have previously made real and effective use in Andorran territory of trademarks registered in a country belonging to the Paris Convention.

The international use of trademarks and the need to ensure that the protection they are given in Andorra is the equivalent of that given in other countries has led the authors to adjust the content of this trademark law as closely as possible to the basic principles included in international treaties and conventions in order that the State may adhere thereto, if judged advisable, without having to substantially alter its internal legislation.

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## **Chapter I**

### **Conditions Governing Protection and acquisition of Trademark Rights**

#### **Art. 1. Signs That May Constitute a Trademark**

1) Any sign that serves to distinguish the goods or services of one enterprise from those of other enterprises and is capable of being represented graphically may constitute a trademark or service mark hereinafter referred to in general as "trademarks").

2) The following signs in particular may constitute trademarks:

- a) words, including personal names, letters, acronyms and numerals;
- b) figurative signs such as designs, logos, seals or the shape or packaging;
- c) combinations or shades of colors;
- d) any combination of the signs referred to in subparagraphs a), b) and c).

#### **Art. 2. Grounds for Absolute Invalidity**

1) A sign may not constitute a trademark:

- a) if it is devoid of distinctive character, notably if it consists solely of information capable of serving, in trade, to designate a characteristic of the product or service, including the kind, quality, quantity, purpose, value or geographical source thereof, or the time of production;
- b) if it consists solely of terms that have become customary in everyday language or form part of the bona fide and established practices of trade in the Principality of Andorra;
- c) if it consists solely of the form dictated by the actual nature of the product or service or by the shape of the product that is necessary for a technical result to be achieved;
- d) if it is contrary to public policy or morality;
- e) if it is liable to mislead the public, notably as to the nature, quality or geographical source of the product or service;
- f) without authorization from the competent authority, it reproduces or imitates, even partly but enough to create a risk of confusion or association in the mind of the public.
  - i) the name (including the abbreviated name), armorial bearings, flags and other emblems of the Principality of Andorra, its parishes, its "quarts" or its other administrative areas, or the official hallmarks of the Principality of Andorra indicating control and warranty;
  - ii) the name of a State (including its abbreviated name), the armorial bearings, flags and other emblems of a State or the official signs and hallmarks adopted by a State to indicate control and warranty;

- iii) the name, acronyms, armorial bearings, flag or other emblems of an intergovernmental organization.
- 2)
  - a) The distinctive character of a sign shall be assessed in conjunction with the goods and services that it is intended to distinguish.
  - b) The distinctive character of a sign may be acquired through use.
- 3) The provisions of paragraph 1) f) ii) above shall be applicable only to those States that afford equivalent protection on their territories to the name including the abbreviated name armorial bearings, flag or other emblems of the Principality of Andorra and to its official signs and hallmarks indicating control and warranty.

### **Art. 3. Conflict with Prior Rights**

- 1) A sign may not be adopted as a trademark or element thereof if it violates prior rights.
- 2) The following shall be regarded as constituting prior rights:
  - a) an identical or similar trademark registered for identical or similar goods or services if the registration date of that trademark, or its priority date under Articles 6 or 7 or the first or second transitional provision, is earlier;
  - b) an identical or similar trademark regarded by the judicial authorities as being well known in the territory of the Principality of Andorra for identical or similar goods or services;
  - c) a registered trade name or corporate designation, if there is a risk of confusion or association in the mind of the public; copyright;
  - e) personal rights of a third party, including his surname, pseudonym or likeness.
- 3) For the purposes of paragraph 2) a) and b) above, the concept of similarity shall be interpreted in terms of the risk of confusion or association in the mind of the public.

### **Art. 4. Manner of Obtaining the Mark**

- 1) The trademark shall be obtained by registration at the Trademark Office.
- 2) The trademark may be held in joint ownership.
- 3) Notwithstanding paragraph 1) above, the owner of a trademark considered by the judicial authorities to be well known in the Principality of Andorra may, even if the trademark is not registered with the Trademark Office, file a request for invalidation under Article 26.2) or request the judicial authorities to prohibit the use of an identical or similar trademark for identical or similar goods or services, provided that an application for registration of his trademark is filed at the same time according to the conditions laid down in Article 9. The

Trademark Office shall not proceed with registration unless the judicial authorities find for the invalidation request or the request for prohibition of use.<sup>1</sup>

***Art. 5. Owners of the registration***

The following persons, whether natural persons or legal entities, including entities under public law, may be owners of the registration of a mark:

- a) those who are nationals of the Principality of Andorra;
- b) those who are nationals of another State but reside or have a real and effective industrial or commercial establishment in the Principality of Andorra;
- c) those who are nationals of another State and do not reside or do not have a real and effective industrial or commercial establishment in the Principality of Andorra, provided that the State in question grants the same protection to nationals of the Principality of Andorra as it does to its own nationals with respect to trademarks.

<sup>1</sup> Text modified on 16.10.96 (entered into force on 20.11.96)

**Chapter II**  
**Priority Deriving from First Filing and**  
**Protection of Marks Appearing at an International Exhibition**

***Art. 6. Priority Deriving from First Filing***

1) Provided that a State grants nationals of the Principality of Andorra a priority right subject to conditions and having effects equivalent to those of the right of priority provided for in paragraphs 2) to 5) below, nationals of that State may claim in the Principality of Andorra the right of priority which is provided for in said paragraphs.

2) A person who has duly filed an application for registration of a trademark in a State referred to in paragraph 1) above, or his successor in title, shall enjoy a right of priority for the filing of an application for registration of the same trademark in the Principality of Andorra for a period of six months from the filing date of his application in that State, provided that the said filing is the first filing of the trademark effected by the applicant.

3) Any filing that is equivalent to a regular national filing in the State in which it is effected by virtue of the national legislation of that State or bilateral or multilateral agreements entered into by that State shall be recognized as giving rise to a right of priority.

4) Regular national filing shall be construed as meaning any filing that is sufficient to establish the date on which the application was filed, regardless of the eventual fate of that application.

5) A subsequent application having the same subject matter as an earlier application filed in the same State shall be considered a first application the date of which determines the start of the priority period, on condition that the said earlier application, on the filing date of the subsequent application, has been withdrawn, abandoned or rejected without any residual rights remaining, and that it has not yet served as a basis for claiming the right of priority. The earlier application may then no longer serve as a basis for claiming the right of priority.

***Art. 7. Protection of Trademarks Appearing at an International Exhibition***

1) Where the applicant has displayed goods or services at an official or officially recognized international exhibition, within the meaning of the Convention on International Exhibitions signed at Paris on November 22, 1928, and last revised on November 30, 1972, and where an application for registration of the trademark under which the goods or services were displayed is filed within a period of six months following the date of first display of the said goods or services, the registration of that trademark shall at the request of the applicant, be regarded as having effect as from that date.

2) The protection granted under paragraph 1) above does not extend to the priority period provided for in Article 6.

- 3) The application referred to in paragraph 1) above shall be recorded in the Trademark Register.



### **Chapter III**

#### **Registration and Renewal Procedure**

##### **Art. 8. Representation before the Trademark Office**

- 1) The applicant or owner who does not have either residence or headquarters or a real and effective industrial or commercial establishment in the Principality of Andorra shall be represented before the Trademark Office by a licensed representative.
- 2) The applicant or owner who does have his residence or headquarters or a real and effective industrial or commercial establishment in the Principality of Andorra may be represented by a licensed representative in dealings with the Trademark Office.
- 3) The conditions to be met for recognition as a licensed representative, and also the formalities relating to the appointment of a representative and the recording of changes concerning him, shall be laid down in the regulations.
- 4) The applicant or owner of a registration who is required by Article 8.1) to be represented by a licensed representative can only terminate that representation by appointing a new licensed representative according to the conditions laid down in the Regulations.<sup>2</sup>

##### **Art. 9. Application for Registration**

- 1) The application for registration shall be filed with the Trademark Office according to the conditions laid down in the regulations.
- 2) The application shall contain the following:
  - a) the particulars of the applicant;
  - b) where applicable, the particulars of the representative;
  - c) a reproduction of the trademark;
  - d) the names of the goods and services for which registration of the trademark is sought, which shall be grouped according to the classes of the International Classification of Goods and Services established by the Nice Agreement of June 15, 1957, each group of goods and services being preceded by the number of the corresponding class;
  - e) where the priority referred to in Article 6 is claimed in the application for registration, a statement to that effect, including the identity of the trademark office with which the claimed priority application was filed, the date of the claimed priority application and the number of the said application if known;
  - f) where the applicant applies under Article 7 for the protection of a mark displayed at an international exhibition, a statement to that effect; and proof that the goods or services for which the trademark registration is sought were displayed at the exhibition under the trademark that is the subject of the application for registration shall be provided in the manner specified in the Regulations,

<sup>2</sup> Text added on 16.10.96 (entered into force on 20.11.96)

- g) the signature of the applicant.
- 3) The application for registration shall be accompanied by payment of the prescribed fees.

#### **Art. 10. Examination as to Form**

- 1) The Trademark Office shall examine whether the application for registration conforms to the provisions of Article 9.2) and 3) and to the provisions of the Regulations concerning the filing of the application.
- 2) If the application for registration does not conform to the provisions of Article 9.2) and 3) or to the provisions of the Regulations, the Trademark Office shall request the applicant to remedy the defects noted within the period prescribed by the Regulations. Where the applicant fails to remedy the said defects within the prescribed period, the Trademark Office shall reject the application for registration and shall repay any fees charged to the applicant.

#### **Art. 11. Registration of the Mark**

Where the application for Registration meets the conditions of Article 9.2) and 3) and the provisions of the Regulations or where, in the case referred to in the first sentence of Article 10 2), the applicant has remedied the defect within the prescribed period, the Trademark Office shall register the trademark with the particulars prescribed by the Regulations and shall send a certificate of registration to the owner of the registration.

#### **Art. 12. Registration Date of the Trademark**

- 1) The registration date of the trademark shall be that on which the Trademark Office receives the application for registration if the said application conforms to the provisions of Article 9.2) and 3).
- 2) Where the application for registration does not conform to the provisions of Article 9.2) and 3) and the applicant remedies the defects within the period referred to in the first sentence of Article 10.2), the trademark shall be registered on the date on which the Trademark Office received the application for registration, provided that, on that date, the application for registration already contained or was accompanied by:
  - information serving to establish the identity of the applicant;
  - sufficient information for correspondence to be exchanged with the applicant or his representative, if any;
  - a sufficiently clear reproduction of the trademark filed for registration;
  - a list of the goods and services for which the registration is sought;
  - full payment of the prescribed fees.
- 3) Where the conditions laid down in paragraph 2) above are not met, the trademark shall be registered on the date on which the defect is remedied, provided that the said date is within the period referred to in the first sentence of Article 10.2).

#### **Art. 13. Term of Registration and Renewal**

- 1) Registration shall be for ten years counted from the date of registration. It may be renewed indefinitely for successive ten year periods for all or some of the goods and services covered by the registration.
- 2) The request for renewal shall be made in the manner specified in the Regulations and be accompanied by payment of the prescribed fees.
- 3) If the registration has not been renewed by its expiration date, it may yet be renewed within a six month period of grace against payment of the prescribed surcharge.
- 4) The renewal shall be recorded in the Trademark Register.

## **Chapter IV**

### **Effects of Registration of a Trademark**

#### **Art. 14. *Rights Conferred by Registration***

- 1) The owner of a registration acquires a property right in the trademark registered for the goods and services that he has designated.
- 2) The following shall be prohibited except where authorized by the owner;
  - a) reproduction or any use of a registered trademark, even with the addition of words such as "formula," "fashion," "system," "imitation", "type" or "method," for goods or services identical to those designated in the registration;
  - b) deletion or alteration of a trademark affixed by the owner of the registration or with his authorization.
- 3) The following shall be prohibited, except where authorized by the owner if they are liable to cause a risk of confusion in the mind of the public:
  - a) reproduction or any use of a registered trademark for goods or services similar to those designated in the registration;
  - b) imitation of a registered trademark, and also any use of an imitated trademark, for goods or services identical or similar to those designated in the registration.
- 4) It shall be prohibited, unless the owner gives express permissive to reproduce or make any use of a registered mark, to imitate a registered mark or to make any use of an imitated mark for goods or services that are not similar to those for which the mark is registered where the registered mark is renowned in the Principality of Andorra and where the use made of it without just reason would unduly exploit the distinctiveness or renown of the registered mark or would prejudice it.

#### **Art. 15. *Limitation of the Rights Conferred by Registration***

The rights conferred by registration of the mark do not allow the owner thereof to prohibit a third party from using, in his day-to-day business,

- a) his surname, where the use is made in good faith;
- b) his registered corporate designation or trade name, where the registration thereof precedes the registration of the mark;
- c) a reference necessary to identify the destination or purpose of a product or service, notably in the form of an accessory or spare part, provided that there is no confusion as to their origin.
- d) however, If the use infringes his rights, the owner of the registration of the mark may apply to the judicial authority for the limitation or prohibition thereof.

**Art 16. *Exhaustion of the Rights Conferred by Registration***

1) With respect to goods subject to the customs union established by the agreement signed between the Principality of Andorra and the European Community, the right conferred by registration shall not allow the owner thereof to prohibit the use of the trademark in the Principality of Andorra for goods that have been placed on the market under the said trademark in the territory of the European Community, either by the owner or with his consent.

2) Paragraph 1) above shall not be applicable where the owner has legitimate grounds for opposing the eventual marketing of the goods, notably where the state of the goods is modified or altered after they have been placed on the market.

## **Chapter V**

### **Assignment, Transfer, Licensing and Pledging**

#### **Art. 17. Assignment**

The registration of a trademark may be assigned, either in its entirety or for some of the goods or services, independently of the enterprise that is exploiting them or causing them to be exploited.

#### **Art. 18. Transfer of the Trademark Registration by an Agent or Representative**

If the agent or representative in the Principality of Andorra of a person who is the owner of a trademark in another country has, without permission from that owner, effected the registration of the trademark in the Principality of Andorra in his own name, the owner may apply to the judicial authorities for the transfer of the said registration to him.

#### **Art 19. Licensing**

A trademark registration may be the subject of an exclusive or non-exclusive exploitation license for all or some of the goods and services.

#### **Art. 20. Invalidity of the License Contract**

The license contract shall not be valid if it does not place the licensor under the obligation to exercise quality control over the goods and services in relation to which the registered trademark is used.

#### **Art. 21. Pledging**

A trademark registration may be pledged.

#### **Art. 22. Conditions of Form; Entry in the Trademark Register**

- 1) Any assignment, licensing or pledging shall be made in writing and signed by the contracting parties.
- 2) Any assignment, licensing, transfer or pledging must be entered in the Trademark Register to be enforceable against third parties.
- 3) The registration of an assignment, transfer, license or pledge shall be subject to payment of the prescribed fee.

## **Chapter VI Modifications**

### **Art. 23. *Unauthorized Modifications***

- 1) No modification of a trademark that has been registered may be entered in the Trademark Register. Modification of the trademark may only be effected by means of a new registration.
- 2) No extension of the list of goods and services of a registration may be entered in the Trademark Register. Extension of the list of goods and services may only be effected by means of a new registration.

### **Art. 24. *Changes in the Name and Address of the Owner***

Changes affecting the name or address of the owner of the registration shall be entered in the Trademark Register at the owner's request. The entry shall be subject to payment of the prescribed fees and shall take place according to the procedure laid down in the Regulations.

## **Chapter VII**

### **Renunciation, Invalidity, Revocation, Lapse**

#### **Art. 25. Renunciation**

- 1) The owner of a registration may at any time renounce his registration of mark in respect of all or some of the goods and services. However, if a registration is the subject of a pledge entered in the Trademark Register, the pledgee must agree to any renunciation.
- 2) Renunciation is effected by means of a written communication addressed to the Trademark Office.
- 3) The Trademark Office shall enter the renunciation in the Trademark Register with a mention that the registration is devoid of effect as from the date on which the Trademark Office received the written communication mentioned in paragraph 2) above. The entry of the renunciation shall be subject to the payment of the prescribed fees and shall take place according to the procedure laid down in the Regulations.

#### **Art. 26. Invalidity**

- 1) The civil court may, at the request of any person providing evidence of a legitimate interest, declare a registration invalid on the grounds that it fails to meet one of the conditions specified in Articles 1, 2 and 5.
- 2) The civil court may, at the request of the owner of a prior right provided for in Article 3, declare a registration invalid.
- 3) A registration that is declared invalid shall be regarded as having been null and void since the registration date.
- 4) Where the decision of a judicial authority invalidating a registration has become final, the said authority shall notify the Trademark Office thereof. The Trademark Office shall enter the decision in the Trademark Register with a mention that the registration has been null and void since the registration date.
- 5) The invalidation action provided for in paragraphs 1) to 4) above shall not be subject to a statute of limitations; however, the owner of prior rights under Article 3 who, for a period of five consecutive years, has known of and tolerated the use in the Principality of Andorra of a trademark that has been subsequently registered, may no longer claim a prior right under Article 3 to bring an invalidation action or oppose the use of the trademark subsequently registered, for the goods or services for which the trademark subsequently registered has been used, except where the subsequent registration was applied for in bad faith.

#### **Art. 27. Revocation**



1) The civil court may, at the request of any person providing evidence of a legitimate interest, revoke a registration in respect of all or some of the goods and services covered by the said registration:

- a) if the owner of the registration has failed, without valid reason, to put the registered trademark to real and effective use in the Principality of Andorra in relation to all or some of the goods and services covered by the registration during the five years preceding the date of the request.
- b) where, as a result of acts or inaction on the part of the owner of the registration, the registered trademark has become known in trade as the usual name of a product or service.
- c) where, for whatever reason, the owner of the registration no longer meets the conditions specified in Article 5.

2) A registration may not be revoked under paragraph 1)a) above where the registered trademark has been used in the following manner in relation to the goods and services covered by the said registration:

- a) under a license contract entered in the Trademark Register.
- b) in an altered form that does not affect its distinctive character.

3) The owner of the registration referred to in paragraph 1)a) above shall be responsible for providing proof of use of his trademark.

4) Where the agent or representative in the Principality of Andorra of a person who is the owner of a trademark in another country has, without permission from the said owner, had the trademark registered in his own name in the Principality of Andorra the owner may apply to the judicial authorities for the revocation of the said registration:

5) A registration that has been revoked shall cease to have effect in relation to all or some of the goods and services on the date on which the revocation decision of the judicial authority becomes final.

6) Where the revocation decision has become final, the judicial authority shall notify the Trademark Office thereof. The Trademark Office shall enter the revocation in the Trademark Register with a mention that the registration is devoid of effect in relation to all or some of the goods and services as from the date on which the revocation decision became final.

## **Art. 28. Lapse**

Where a trademark registration is not renewed on expiration of the period of grace specified in Article 13.3), the Trademark Office shall record in the Trademark Register that the said registration is devoid of effect as from the expiration date of the latest ten-year period.

## **Chapter VIII**

### **Actions for Infringement of the Rights of the Owner of a Registration**

#### **Art. 29. *Right to Bring Action, Procedure***

- 1) Any infringement of the rights of the owner of a trademark registration shall render the infringer liable to civil and criminal prosecution. Violation of any prohibition provided for in Article 14.2), 3) and 4) constitutes an infringement of the rights of the owner of a trademark registration.
- 2) The owner of a trademark registration may institute the appropriate civil or criminal proceedings before the judicial authorities against any person who infringes his rights. Such proceedings may also be instituted by the holder of an exclusive license for use unless otherwise provided in the license contract, if the owner fails to exercise his rights after having been formally called upon to do so.
- 3) Any holder of a license for use shall be entitled to intervene, with a view to securing reparation for the prejudice specific to him, in any action brought by the owner.
- 4) All civil actions brought under this Law shall be prosecuted according to "el procediment abreuja" summary procedure).

#### **Art. 30. *Loss of the Right to Bring Action***

The owner of a trademark registration or the holder of an exclusive license for use who, for a period of five consecutive years, has known of and tolerated the use in the Principality of Andorra of a trademark that has been subsequently registered may no longer bring the actions referred to in Article 29 against that registration with respect to the goods or services for which the trademark so registered has been used, except where the registration was applied for in bad faith.

#### **Art. 31. *Provisional Measures***

- 1) The judicial authority may, as a provisional measure, prohibit by injunction the continuing infringement of the rights of the owner of a trademark registration or order the provision of guarantees to ensure, where appropriate, compensation for the owner of the registration or for the holder of the exclusive license for use.
- 2) The application for an injunction or for the ordering of guarantees shall be accepted only where the action on the merits appears to be founded and is brought within a short time following the date on which the owner of the registration or the holder of an exclusive license for use became aware of the circumstances that gave rise to said application. The judicial authority may grant the injunction subject to the provision by the plaintiff of such guarantees as will compensate the defendant for any damage suffered by him if the action is eventually judged unfounded.

### **Art. 32. Seizure**

- 1) The owner of a trademark registration or the holder of an exclusive license for use shall be entitled to cause the judicial authority, assisted by its selected experts, to carry out in any place either a detailed description, with or without the taking of samples, or the actual seizure of the goods that he alleges have been marked, offered for sale, delivered or supplied in a manner detrimental to him and in violation of his rights, or again, where the mark is used for services, the seizure of the materials used for the rendering of the service.
- 2) Actual seizure may be made subject by the judicial authority to the provision of such guarantees by the plaintiff as will compensate the defendant for any damage suffered by him where the action is eventually judged unfounded.
- 3) Where the plaintiff has failed to bring action in either the civil or the criminal courts within ten days, the seizure shall be null and void as of right, without prejudice to any damages that may be claimed.

### **Art. 33. Withholding at Customs**

- 1) Without prejudice to the provisions of Article 16.1), the customs administration shall, at the direction of the judicial authority acting at the request of the owner of a trademark registration or the holder of an exclusive license for use of the registered trademark, withhold merchandise, even in transit, that bears a trademark regarded by the said owner or the licensee as infringing the rights conferred by the trademark registration.
- 2) The judicial authority, the person having made the request referred to in paragraph 1) above and the party declaring the merchandise shall be informed without delay, by the customs administration, of the withholding measure that it has implemented.
- 3) The withholding measure shall be lifted as of right where, within ten working days following the date on which the merchandise was withheld, the person who filed the request referred to in paragraph 1) above has not brought a civil or criminal action against the party declaring the merchandise that purportedly infringes the rights conferred by the trademark registration, and has not provided the guarantees required to cover his liability in the event of an eventual finding against infringement of his rights.
- 4) The person who filed the request referred to in paragraph 1) above may, with the permission of the judicial authority, prevail on the customs administration to communicate the names and addresses of the sender, the importer and the consignee of the merchandise withheld, and also its quantity.

### **Art. 34. Damages**

- 1) Infringement of the rights accruing to the owner of the registration under Article 14.2), 3) and 4) shall entail the liability of the infringer thereof, who shall be bound to compensate the owner of the registration, and where appropriate, the holder of a license for use of the trademark, for damages.

2) The amount of damages shall reflect not only the losses suffered by the owner of the registration but also the profits that he has failed to realize.

3) Unrealized profits shall be determined by the judicial authority according to one of the following criteria at the discretion of the owner of the registration:

- a) the profits that the said owner would have earned from use of the trademark had the infringement of his rights not occurred,
- b) the profits that have been realized by the infringer of the rights of the said owner as a result of the infringement.

4) Damages may be sought only for infringements of the rights of the owner of the registration that occur in the course of the five years prior to the bringing of the action.

5) The judicial authority is empowered to order the infringer of the rights of the owner of the registration to pay the latter's legal costs, including the fees of counsel and of the Public Prosecutor, in the case of criminal as well as civil action.

6) Paragraphs 2) to 5) above shall apply *mutatis mutandis* to compensation for damages caused to the holder of a license for use of the trademark.

### **Art. 35. Criminal Sanctions**

1) The person responsible for an infringement of the rights of the owner of the registration that derive from Article 14.2), 3) and 4) who has acted in bad faith shall be punished according to the penalties provided for in the Criminal Code.

2) The judicial authority may order full or partial publication of the sentence in such journals as it may specify, at the expense of the condemned party.

3) The judicial authority may order the confiscation of the goods and of the instruments that served for the commission of the offense. It may also order their destruction at the expense of the offender.

## **Chapter IX Collective-Marks**

### **Art. 36. *Elements Constituting a Collective Mark***

- 1) A collective mark is a mark that may be used by any person who observes the regulations governing its use laid down by the owner of the registration.
- 2) Registration of a collective mark may be applied for by associations of manufacturers, producers, providers of services or traders who, according to the legislation applicable to them, are entitled, in their own names, to own rights and enter into obligations of all kinds, and also by legal entities under public law.
- 3) Notwithstanding Article 2.1)a), a collective mark may be constituted by a sign or designation capable of serving in trade to identify the geographical source of goods or where services are provided from. However, the collective mark does not authorize its owner to prohibit a third party from using the sign or designation in trade, provided that the use is made in a manner consistent with proper practice in industry or trade, in particular, it may not be invoked against a third party entitled to use a geographical denomination.<sup>3</sup>
- 4) The provisions of this Law, with the exception of Articles 19 and 20, shall apply to collective marks, subject to the additions specified in Articles 37 and 38.

### **Art. 37. *Registration of a Collective Mark***

- 1) The filing of an application for registration of a collective mark shall be accompanied by regulations governing its use.
- 2) If an application for registration of a collective mark is not accompanied by regulations governing its use, regulations may be submitted to the Trademark Office within the period prescribed by the Regulations.
- 3) If regulations governing use are not received by the Trademark Office within the prescribed period, the mark shall not be registered.

### **Art. 38. *Use of a Collective Mark***

For the purposes of Article 27.1)a), the use of a collective mark by any of the persons entitled to use it under the regulations governing its use shall be considered a valid use thereof.

<sup>3</sup> Text added on 16.10.96 (entered into force on 20.11.96)

## **Chapter X Miscellaneous Provisions**

### **Art. 39. *Publication***

1) The Trademark Office shall issue a periodical gazette (*Trademark Gazette*), which shall publish registrations, renewals, renunciations, invalidations, revocations, lapses and any other information specified by the Regulations.

2) The Regulations shall specify the frequency of issue of the Trademark Gazette.

### **Art. 40. *Fees***

The fees payable for the registration and renewal of a trademark, and for any other entry provided for in this Law and for any services that may be rendered by the Trademark Office under the Regulations, shall be laid down in subsequent legislation.

### **Art. 41. *Appeals Against Decisions of the Trademark Office***

Any person directly affected by a decision of the Trademark Office may file an administrative appeal against that decision of the OMPA according to the provisions of the Administrative Code.

### **Art. 42. *Summons***<sup>4</sup>

Any administrative or judicial summons addressed to an applicant or owner of registration who is represented before the Trademark Office by a licensed representative according to Article 8.1), shall be sent to the address of said licensed representative. Said summons shall, for all purposes, be considered as received by the applicant or the owner after a term of not less than 30 calendar days from the date of reception by the licensed representative.

<sup>4</sup> Text added on 16.10.96 (entered into force on 20.11.96)

## **Chapter XI**

### **Transitional Provisions**

#### ***First. Priority Deriving From Prior Use in the Principality of Andorra***

- 1) Notwithstanding Article 4.1), any trademark that is being put to real and effective use in the territory of the Principality of Andorra on the date of entry into force of this Law shall enjoy a right of priority as from the date on which the said use began.
- 2) Paragraph 1) above shall be applicable only if an application for registration of the trademark referred to therein is filed with the Trademark Office within two years following the date as from which the said Office is in a position to receive applications for registration. The application for registration shall be accompanied, as stipulated in the Regulations, by priority claim under paragraph 1) above and by a declaration of prior use.
- 3) The trademark in respect of which an application has been filed under paragraph 2) above shall be registered if it meets the conditions specified in Article 11. The registration date shall be determined according to Article 12, and the entry in the Trademark Register concerning the trademark shall mention the priority claim and the declaration of prior use.
- 4) The owner of a trademark registration in respect of which a declaration of prior use as referred to in paragraph 2) above has been made shall be responsible for producing evidence of the prior use in order to assert the right of priority referred to in paragraph 1) in relations with third parties.

#### ***Second. Priority Deriving from Registration of a Mark in a Country Party to the Paris Convention***

- 1) Any trademark registered in a country party to the Paris Convention for the Protection of Industrial Property on the date of entry into force of this Law shall enjoy a right of priority in the territory of the Principality of Andorra which shall be effective as from the said date of entry into force.
- 2) Paragraph 1) above shall be applicable only if an application for registration of the trademark referred to therein is filed with the Trademark Office within a year following the date as from which the said Office is in a position to receive applications for registration. The application for registration shall be accompanied, as stipulated in the Regulations, by priority claim under paragraph 1) above and a copy of the registration on which it relies.
- 3) The trademark in respect of which an application for registration under paragraph 2) has been filed shall be registered if it meets the conditions of Article 11. The registration date shall be determined according to Article 12, and the entry in the Trademark Register concerning the trademark shall mention the priority claim.
- 4) Where trademarks that have been registered under paragraph 3) above are considered identical or similar by the judicial authorities, only the registration date determined according to Article 12 shall be taken into account to establish which of the registrations constitutes. for

the purposes of Article 3, a prior right that may be invoked against the other registrations effected under paragraph 3) of this Transitional Provision.



## **Chapter XII**

### **Final Provisions**

#### **First. *Trademark Office***

On a proposal by the Minister of the Economy, the Government shall, within a maximum of six months, draw up the Regulations creating the Trademark Office and enact such other provisions as may be necessary for the implementation and application of this Law.

#### **Second. *Regulations***

On a proposal by the Minister of the Economy, the Government shall, within a maximum of six months, draw up the Regulations for the implementation of this Law.

#### **Third. *Fees***

The legislation on fees referred to in Article 40 shall enter into force within a maximum of six months.

#### **Fourth. *Entry into Force***

This Law shall enter into force on the day of its publication in the *Butlletí Oficial del Principat d'Andorra*.<sup>5</sup>

<sup>5</sup> Text approved on 11.05.95 (entered into force on 24.05.95)