

Garrigues

Spain

Selecting the goods and/or services to be applied for in a trademark application is a more complex task than meets the eye. This is particularly true in Spain where the trademark office's practice differs from that of other EU IP offices

One of the main issues to consider before filing a Spanish trademark is choosing the correct specification of goods and services to be covered by the application. From a practical point of view, the wording should be analyzed carefully, taking into account:

- the needs of the applicant; and
- the impact such wording may have on the registration process or on the subsequent enforcement of the mark.

The following should be considered when determining the list of goods and/or services claimed in a Spanish application:

- The use of the Nice Classification is mandatory in Spain. The specification of goods and services must be clear, understandable and in accordance with the international class or classes claimed. Also, whenever possible, it is preferable to use the expressions provided in the international classification.
- The Spanish Patent and Trademark Office (SPTO) accepts specifications of goods and/or services consisting of complete class headings or specific indications contained in the alphabetical list of the Nice Classification.

Upon payment of the relevant official fees, the applicant may during the registration procedure amend the specification of goods and/or services initially claimed in the trademark application, provided that the amendments are aimed at:

- clarifying terms deemed too broad or vague; and/or
- limiting the scope of protection of the application.

Under no circumstances may the amendments extend the application's scope of protection. Additionally, should certain

goods and/or services be included in a class which has not been claimed in the application, such goods and/or services should be either deleted or reclassified in the appropriate class, which will entail payment of extra fees.

Applicants must be aware that Spanish examiners:

- are prone to object specifications of goods and/or services which are not listed word for word in the Nice Classification; and
- do not always suggest an alternative acceptable wording.

Moreover, there is no classification tool – similar to the Office for Harmonization in the Internal Market's (OHIM) EUROACE, for instance – available to the public that would allow applicants to search for specifications which will be immediately accepted by the SPTO. In addition, the interpretation of the international classification made by the SPTO does not always coincide with those of other IP offices in the European Union. The absence of harmonized standards of interpretation may lead to some difficulties during the registration process of a trademark, particularly when protection of such mark has been sought in more than one territory. This is the case when a Spanish trademark application claims the priority, for instance, of an earlier UK or Community trademark which specifies goods and/or services in a way not acceptable to the SPTO. Likewise, when an international registration designating one or more countries is based on a Spanish mark, the IP office of the designated country may not accept the specification of goods and/or services as originally filed. This is frequently the case when designating the United States with an international registration based on a Spanish mark.

The above remarks show the importance of finding an appropriate wording for the list of goods and/or services to be covered by a Spanish trademark application. This is not always an easy task: an incorrect choice of words will not only have immediate negative effects during the registration procedure (eg, formal objections which entail delays in the registration of the mark,

as well as additional costs associated to the amendment of the appropriate list of goods and/or services), but also after the mark has been successfully registered. Thus, the SPTO often rejects claims for goods and services in Classes 9 and 41. For instance, the SPTO would reject a claim for “production and preparation of documentary programmes” in Class 41, unless the terms ‘and preparation’ were deleted. Further, “computer games and videogames played via computer networks” and “broadband games” would not be accepted unless the specification “electronically downloadable” were added. From the SPTO's point of view, a claim for “interactive voice recognition games and competitions” is not acceptable unless followed by the specification “via global computer networks”. Unlike other EU IP offices, the SPTO generally refuses additional expressions such as “digital sound, digital music, digital images, digital pictures, digital films, digital data, digital information, digital publications, digital interactive games, including provided via wireless or non-wireless telegraphy”. Bearing in mind the foregoing, Spanish trademark applicants are frequently advised to opt for the safety of claiming the general class headings of the Nice Classification rather than the specific goods and/or services in connection to which the trademark is to be used. This is common practice as the SPTO, unlike some other European IP offices, does not require the trademark proprietor to furnish proof of use – neither in opposition proceedings nor upon renewing the mark. In other words, the use of class headings is quite attractive for applicants as it saves time and money during the registration procedure. In addition, the use of such broad specifications does not prejudice the applicant's position when filing an opposition before the SPTO based on its Spanish trademark, as the mark owner will not be required to provide evidence of use of the said mark.

However, whereas claiming class headings may be a safe and easy choice from a Spanish prosecution perspective, the trademark proprietor may find at a later stage, particularly in opposition proceedings before OHIM or in litigation

proceedings, that a broad specification of goods and/or services does not always provide the best protection.

When an opposition filed before OHIM is based on a Spanish trademark which has been registered for five or more years, the opponent could be requested to provide proof of genuine use of the mark that forms the basis of the opposition. In such a case, the goods and/or services in respect of which proof of use is not furnished will not be taken into account when comparing the conflicting marks. Therefore, the opponent should carefully assess the goods and/or services on which it bases its opposition, relying only on those which have been genuinely used in the course of trade.

With regard to litigation proceedings, the Spanish courts now accept that similarity between goods and/or services does not follow from the simple fact that they belong to the same international class. However, experience has shown that Spanish judges grant a different scope of protection to conflicting marks, depending on whether the goods and/or services at issue are:

- class headings or general terms used therein; or
- specific indications comprised in that same class.

In some cases the courts have found marks to be dissimilar on the grounds that the specific description of the relevant goods or services excluded similarity to goods and/or services described in broader terms. However, in other cases the courts have found specific indications to be included in a broader category of goods and/or services comprised in the same class and, consequently, to be similar.

Examples of both judicial criteria are contained in the following judgments.

In a decision of May 23 2001 the Madrid High Court found the services claimed for the marks at issue to be dissimilar. This was even though the earlier mark, K, covered “advertising, business management, business administration, office functions” and the later mark, K KONDIA, claimed, among other things, “import and export, promotion, of all kinds of machines, tool-machines in general, as well as spare parts and auxiliary elements”, both in Class 35. The Supreme Court affirmed this decision on October 22 2004. In a decision of July 24 2002 the Madrid High Court found that the differences between the earlier Spanish trademark CAPOTA, registered for “chemical products in general” in Class 1 and a Spanish application for CAPOTE in relation to, among other goods, “chemical goods used for



Natalia González-Alberto
Senior associate
natalia.gonzalez-alberto@garrigues.com

Natalia González-Alberto graduated from the Complutense University in Madrid in 1998 and obtained a master's degree in intellectual property from the University of Alicante in 1999. She joined Garrigues's IP practice in 2002. Her work includes prosecution, advice and litigation relating to trademarks, domain names and designs.



Celia Sueiras Villalobos
Senior associate
celia.sueiras.villalobos@garrigues.com

After graduating from the Complutense University in Madrid, Celia Sueiras Villalobos obtained a master's degree in intellectual property from the University of Alicante. Ms Sueiras Villalobos's practice covers all aspects of trademark law matters, both contentious and non-contentious. She is responsible for the worldwide trademark portfolios of several domestic and international companies

industry, science (excluding those to be applied for medical science), photography, agriculture, horticulture, forestry ... and adhesives used in industry” in the same class were sufficient to exclude a likelihood of confusion. On November 23 2007 the Supreme Court found that the services covered by the marks CONSEJO REGULADOR PARA LA DENOMINACIÓN DE ORIGEN RIBERA DEL DUERO and WWW.MERCARIBERA.COM EL PORTAL DE LA RIBERA were dissimilar, despite the fact that the earlier mark covered, among other services, “import-export services relating to wine” in Class 35 and the later mark claimed the complete class heading “advertising, business management, business administration, office functions”. The uncertainty that derives from the different judicial interpretations of the scope of protection conferred to trademarks covering generic or very broad lists of goods and/or services may not be the only negative consequence for Spanish trademark owners. Claiming general indications or complete class headings could also prove to be an inadequate choice during litigation proceedings where the Spanish trademark owner may be compelled to bring evidence of genuine use of its marks (eg, in infringement or revocation proceedings). Under Spanish law, the Spanish trademark will be considered used exclusively in connection with those goods and/or services for which genuine use has been duly proved.

In conclusion, and contrary to general belief, the choice of the specification of goods and/or services to be claimed when filing a trademark application is of the utmost importance. Further, the international classification is not merely an administrative tool for registries to classify goods and services. It is vital to choose the appropriate wording for the goods and services in relation to which the mark is to be genuinely used in the course of trade.

Spanish trademark applicants should bear the foregoing circumstances in mind before filing. They should also seek advice from qualified IP professionals who will assist them in identifying their needs and choosing the list of goods and/or services to be applied for in each particular case. [WTR](#)