

Garrigues

Portugal

Although a number of non-traditional signs are protectable as trademarks under EU law, Portuguese law and practice are rather more restrictive

Before the entry into force of the Industrial Property Code of 1995, only words and logos, or combinations of both elements, were accepted as national trademarks in Portugal. However, even then three-dimensional trademarks could be admitted for registration if they:

- were free or arbitrary;
- had a distinctive character; and
- displayed novelty.

Thus, the shape of the Mercedes grill and the Ungaro perfume bottle were registered as trademarks following judicial decisions (in 1991 and 1993 respectively).

The entry into force of Decree-Law 16/95 marked the official recognition as potential trademarks of three-dimensional shapes and other non-traditional signs such as sounds and colours (for the latter, only in combination with other colours, or with words or logos).

Nevertheless, the protection of non-traditional signs is still dependent on their capacity:

- to be represented graphically; and
- to distinguish the goods or services of one company from those of others.

The Industrial Property Code of 2003 and the amendments introduced in 2008 did not alter the existing law with regard to non-traditional signs.

Legal requirements

Article 222(1) of the code provides that a trademark may consist of a sign or set of signs which is capable of being represented graphically – namely, words (including personal names), designs, letters, numerals, sounds, the shapes of products or of their packaging – provided that these signs are capable of distinguishing the products or services of one company from those of others.

Three-dimensional marks

The requirements applicable to three-dimensional trademarks in Portugal are

identical to those set out in the EU First Trademarks Directive (89/104/EEC), which precludes from registration trademarks that consist exclusively of:

- a shape which results from the nature of the product or its packaging (natural shape);
- a product shape which is necessary to obtain a technical result (technically functional shape); and
- a shape which gives substantial value to the product (aesthetically functional shape).

These prohibitions are absolute and cannot be overcome by acquired distinctiveness obtained through use.

However, even in the case of signs composed of arbitrary shapes (ie, shapes which are not the natural, technically functional or aesthetically functional shapes of the products or their packaging), the law stipulates that only three-dimensional signs that have distinctive character can be granted registration.

Therefore, generic, customary or descriptive three-dimensional signs cannot be protected as trademarks, unless they have acquired secondary meaning through use in commerce.

From a formal point of view, in order validly to file an application for a three-dimensional trademark, it is necessary to submit a graphical representation of the sign and the express indication of the type of trademark at issue. Should the Industrial Property Office (IPO) hold that the reproduction submitted is not sufficient, it will request that the applicant file additional elements within a specific term.

Sound marks

Similarly to three-dimensional marks, sounds can be registered under Portuguese law only if they are distinctive. Such distinctiveness can be acquired through use.

Sounds that do not have an original, distinctive character include signs that merely reproduce the sounds which designate the type or quality of a product or which are generic and customary.

Applications should indicate that the mark applied for is a sound mark and the application should be submitted in the

form of a musical notation. Although the latest practice of the IPO seems to indicate that sound recordings are acceptable, this practice should not be understood as a waiver of the legal requirement for a graphical representation of the sign.

Other signs

Trademarks consisting exclusively of a single colour cannot be registered. As previously mentioned in respect of three-dimensional marks, this prohibition cannot be remedied by a finding of secondary meaning acquired through use.

Applications for a combination of colours must indicate which colours are claimed.

Current practice

Three-dimensional trademarks

The authors are aware of the existence of a number of Portuguese three-dimensional trademark registrations. However, the classification system used in the IPO database makes it impossible to ascertain the exact number of such registrations in Portugal.

What is certain is that the criterion adopted by the IPO for the examination of three-dimensional trademarks tends to be restrictive. Examiners will assess the novel, inventive or creative character of the sign – an assessment that does not take place for ordinary marks.

In fact, the IPO has been cautious in its examination of three-dimensional signs, considering the restrictions to registration already applicable to such signs. The IPO has thus held that alleging that the shape for which registration is sought is a variation of one of the usual shapes of a type of product is not sufficient to confer distinctive character on the sign. Further, IPO practice aims to guarantee that the averagely informed and careful consumer can distinguish a product or packaging from the products or packaging of other companies:

- without making a comparative analysis; and
- without paying special attention to the sign in question.

The courts tend to be less restrictive. Some have held that a sign can consist of

the shape of a product without being innovative, as long as the shape possesses a differentiating capacity.

Thus, on October 19 2004 the Lisbon Court of Commerce held that a “translucent bottle in blue, with a grip incorporated to the right, crossed by a large blue strip which covers the respective grip” had enough distinctive character to be granted registration as a three-dimensional trademark.

On January 24 2005 the same court held that Application 790272 for a guitar head could be protected as a trademark. The court reasoned that the shapes of guitar heads are generally very similar, while the shape for which application was sought diverged from these usual shapes in some details that rendered the shape protectable.

Legal commentators argue that the assessment of the distinctive character of three-dimensional trademarks should follow the criteria applicable to conventional trademarks. However, the greater complexity of this type of sign has led some authors to consider that the average consumer in these cases should be more diligent than the averagely aware and careful consumer considered in the context of traditional trademark applications.

Sound marks

There appear to be no national sound marks registered in Portugal. However, the World Intellectual Property Organization database shows that four sound marks are protected in Portugal through international registrations. To put this seemingly small number in perspective, altogether there are only 100 Community trademark applications and registrations for sound marks.

Other signs

The decision of the European Court of Justice (ECJ) in *Sieckmann* (Case C-273/00, December 12 2002) has established that the following are not acceptable (on their own or in combination) as graphical representations for olfactory marks:

- a chemical formula;
- written descriptions; and
- odour samples.

Most Portuguese commentators agree with this restrictive interpretation of the requirement of graphical representation.

Prior to *Sieckmann*, the Office for Harmonization in the Internal Market (OHIM) had interpreted the criterion of graphical representation generously. Thus, it had admitted for registration a mark described as “the smell of freshly cut grass” (OHIM Second Board of Appeal, February 11 1999).



Gonçalo da Cunha Ferreira

Partner

goncalo.cunha.ferreira@garrigues.com

Gonçalo da Cunha Ferreira holds a law degree from the *Universidade Moderna* and has completed further training in strategic management, and mediation and arbitration. Mr Ferreira has been a consultant in industrial and intellectual property since 1985. He founded Cabral, Cunha Ferreira & Associados in 1988 and joined Garrigues in 2006.



Isabel Bairrão

Senior associate

isabel.bairrao@garrigues.com

Isabel Bairrão obtained her law degree from the University of Coimbra and a post-graduate diploma in industrial property law from the University of Lisbon. She undertook further training in IP law under the supervision of the World Intellectual Property Organization and is a qualified European trademark and design attorney. Ms Bairrão's main areas of practice are IP law and issues relating to new technologies.

Conclusion

Portuguese law follows the Community Trademark Regulation (40/94) in that it does not typify signs that are acceptable as trademarks; neither does it comment on the possibility of accepting hologram, smell, taste, touch, motion or multimedia marks.

As mentioned above, the classification used in the Portuguese IPO database makes it impossible to list non-conventional marks exhaustively. However, besides the Coca-Cola bottle, the BIC pen and the Toblerone packaging, the authors know of a number of other three-dimensional marks that have been registered in Portugal. Likewise, some sound marks are protected in Portugal through international registrations (but there is no local case law in respect of this category of distinctive signs).

Although olfactory, tactile and taste marks are not currently accepted for registration due to the difficulties inherent in their graphical representation, holograms and motion marks (ie, marks made up of image sequences) could meet the legal requirements for graphical representation by reproducing the various successive images making up the mark and describing these images. A sample in a multimedia carrier may also be required.

As regards colours, although the ECJ ruling in *Libertel* (Case C-104/01, May 6 2003) admitted the existence of situations in which a colour *per se* can constitute an indication of the origin of the products or services of one company, Portuguese law expressly states that single colours are excluded from registration as trademarks.

The Portuguese legal system could be considered ideal for testing the admissibility of non-conventional trademarks because:

- the schedule of fees for these types of mark is identical to that for ordinary marks; and
- the IPO allows for the subsequent alteration of applications should a mark be initially rejected on absolute grounds. This represents a distinct advantage over the Community trademark system, for instance, where alterations are not allowed. [WTR](#)