

Garrigues

Spain

Spanish trademark law and practice are bound by EU regulations and case law. However, the Spanish Patent and Trademark Office is even more reluctant than the EU trademark bodies to register unconventional marks

Traditionally, trademarks have consisted of words, logos, letters or numbers, or combinations thereof. However, the ever-evolving trends to identify the commercial origin of goods and services have progressively led businesses to use new types of sign that do not fall into the traditional trademark categories. These unconventional marks include colours, shapes, sounds, holograms and scents.

Article 2 of the EU Trademarks Directive (2008/95/EC) (which replaced the First Trademarks Directive (89/104/EEC)) was implemented in Spain by Article 4 of the Law on Trademarks (17/2001).

The development of, among other things, product differentiation methods called for the update of the Trademark Law Treaty of 1994 (TLT). The Singapore Treaty is the World Intellectual Property Organization's response to this need. Although the Singapore Treaty does not replace the TLT, it introduces significant changes to the latter, having a wider scope of application. One of the main innovations of the Singapore Treaty is that it explicitly recognizes non-traditional marks.

The Singapore Treaty entered into force in Spain on May 18 2009. However, while the protection of non-traditional marks is accepted in principle, the registration of such marks in Spain continues to be exceptional.

General requirements

Article 4 of the Spanish Trademarks Law requires that the mark applied for be capable of indicating trade origin and of being represented graphically.

While the first requirement is common to all marks irrespective of their nature, the requirement of graphical representation often constitutes a serious obstacle for non-conventional marks – particularly non-visible signs (eg, scents, tastes and textures).

In the absence of case law relating to

the protection of non-conventional trademarks at national level, the Spanish Patent and Trademark Office (PTO) has to follow the relevant leading decisions of the European Court of Justice (ECJ).

According to the ECJ decision in the *Sieckmann Case* (C-273/00), which concerned an olfactory sign, “a trademark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective”.

As argued by ECJ Advocate General Ruiz-Jarabo, the question under discussion was not whether a certain smell possessed distinctive character (ie, whether it constituted an indication of trade origin), but whether it was capable of being represented graphically and was thus eligible for registration as a trademark.

The official application form for a Spanish trademark requires the applicant to tick the appropriate box indicating the type of trademark applied for (ie, ‘word’, ‘exclusively figurative’, ‘figurative’, ‘three-dimensional’, ‘sound’ and ‘others’). However, few signs falling into the ‘others’ category have been registered so far in Spain.

Colour marks

Single colours and colour combinations are acknowledged as trademarks in Spain even though they are not expressively recognized by the Trademarks Law.

Before the enactment of the 2001 law, colours *per se* were expressly excluded from registration. The absolute grounds for refusal contained in the 1988 Trademarks Law expressly mentioned that a “colour in itself ... may, however, be registered provided it is defined by a given form” (Article 11(1)(g)).

None of the absolute grounds for refusal contained in the current Trademarks Law excludes the registration of colours *per se*. This is in accordance with:

- Article 3(3) of the First Trademarks Directive mentioned above; and
- the ECJ decision in *Libertel* (Case C-

104/01), which held that “a colour *per se* ... may, in respect of certain goods and services, have a distinctive character ..., provided that ... it may be represented graphically in a way that is clear, precise, self-contained, easily accessible, intelligible, durable and objective ...”

As the spectrum of colours is limited, the concrete shade claimed in an application should be clearly specified. The most common way to do so is to indicate the corresponding Pantone colour or the specific CMYK (cyan [blue], magenta, yellow and key [black]) combination of which the mark consists. Where such specification requirement has not been met, the burden of proving that the colour claimed has acquired distinctive character as a consequence of its use rests with the applicant.

According to the foregoing, colours *per se* are registrable if duly represented. However, the approach of the Spanish PTO to colour marks is still quite stringent. For instance, Applications 2683700 and 2683701 for a shade of green and a shade of blue were filed in 2005 in connection with goods in Class 5 of the Nice Classification, respectively claiming the priority of two German marks.

The PTO rejected the applications in 2006 (ie, over four years after the current Trademarks Law had entered into force) on absolute grounds. Although the applicant had indicated the specific Pantone colours claimed, the PTO found the signs devoid of any distinctive character, arguing that “a colour in itself is not considered to possess the capacity to distinguish goods and services”.

Fortunately, applications to register colour combinations do not encounter as many difficulties as those for single colours.

Shape marks

Three-dimensional shapes, including wrappings, containers and the shape of goods or their packaging, may constitute trademarks pursuant to Article 4(2)(d) of the Trademarks Law.

However, Article 5(1)(e) excludes from registration “those [signs] consisting exclusively of the form imposed by the

nature of the good itself or by the form of the good necessary to obtain a technical result, or by the form which gives substantial value to the good”.

In general, shapes are admitted for registration provided that there is no need for such shapes to be freely used by competitors in the relevant commercial sector. Three-dimensional signs are most commonly rejected on the grounds that:

- they lack distinctive character;
- they consist of shapes which have become customary; or
- they consist of shapes which are necessary in connection with the goods and/or services that they designate.

Additionally, upon assessing the registrability of these marks, the examiner should bear in mind whether the shapes in question possess inherent value. This is because, contrary to patent and design rights, trademark protection is granted for a potentially unlimited period of time.

Three-dimensional shapes that have been accepted for registration include a computer mouse on wheels and a face-shaped biscuit. Shapes for which registration was rejected on absolute grounds include a mustard jar and a green bottle.

Sound marks

Article 4(e) of the Trademarks Law expressly contemplates the registration of sound marks.

Title 1(2)(6) of Royal Decree 687/2002 implementing the Trademarks Law further provides that “when applying for the registration of a sound mark, the sign has to be graphically represented, or it can also consist of a musical stave”.

This is in line with EU case law. The leading case on this issue (*Shield Mark*, Case C-283/01) clarified what could constitute an acceptable graphical representation of a sound mark – namely, “a stave divided into measures and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals”.

The few examples of registered Spanish sound marks which the authors have found consist of melodies represented in standard notations (eg, Trademark 2427263 in the name of MasterCard International Inc for goods in Class 9 and Trademark 2539332 in the name of Orbitel SA ESP for services in Class 38).

Olfactory marks

The Trademarks Law does not specifically mention scents among the signs that may



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constitute trademarks. However, it is generally accepted that an olfactory mark may possess distinctive character.

No olfactory marks have yet been registered in Spain. (Unfortunately, searches of this kind are currently unavailable at the PTO.) Consequently, the Community trademark consisting of “the smell of freshly cut grass” – the registration of which has now lapsed – continues to be the most cited example of an olfactory mark in the European Union. However, this mark was registered long before the ECJ issued its ruling in *Sieckmann* (C-273/00). In that case, the ECJ held that a non-visible sign could constitute a trademark “provided that it can be represented graphically, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective”. However, referring specifically to the requirement of graphical representation of olfactory signs, the ECJ found that such requirement was not satisfied “by a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements”.

In light of this jurisprudence, it is highly unlikely that any olfactory marks will be registered in Spain or elsewhere in the European Union in the near future – or at least until alternative means of graphically representing scents are devised.

Conclusion

The main obstacle to the registration of non-conventional marks in Spain – as in the European Union in general – is the requirement of graphical representation.

At the time of writing, Spain was one of only seven EU member states to have ratified the Singapore Treaty. On account of the foreseeable ratification of the treaty by additional member states and increasing technological advancements, it is reasonable to anticipate that EU law and the national laws of EU member states will evolve rapidly as regards the protection of non-conventional marks and the requirements for their registration.

The changes brought by the implementation of the Singapore Treaty throughout the European Union will not be apparent for some time. Meanwhile, the authors consider the decision of the President of the Office for Harmonization in the Internal Market (EX-05-3, October 10 2005) to allow the filing of a sound file in mp3 format in connection with sound mark applications as evidence of a trend to simplify the process to register non-conventional trademarks. **WTR**