



Daudén

A B O G A D O S

*When trade marks overlap
with other IP rights...*

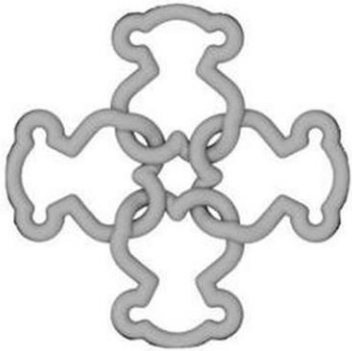
Milan, 22 November 2016

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What can be protected through trade mark law in Spain?

- ✓ Distinctive signs capable of being represented graphically
- ✓ Words, designs, shape of goods or of their packaging...
- ✓ 3D or 2D

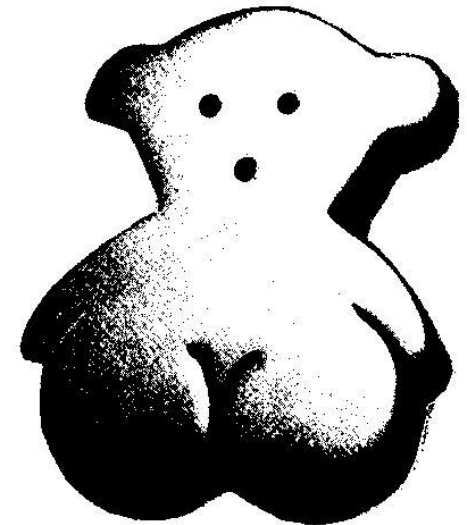
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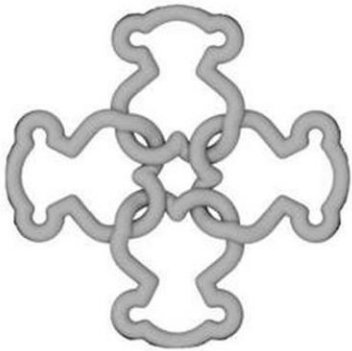


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What can be protected through design law in Spain?

- ✓ Ornamental or aesthetic aspect of a product or part of a product
- ✓ Defined by its features: lines, contours, colours, shape, texture and materials, ...
- ✓ 3D or 2D



Differences between trademark and design protection in Spain

➤ Requirements for protection

- **TM:** distinctive; not deceptive, or contrary to law or morality; not interfere with earlier rights of third parties
- **D:** novelty & individual character; not contrary to law or morality

➤ Scope of protection

- **TM:** distinctive character / indication of origin
 - ↳ may grow according to use on the market (dynamic right)
- **D:** the individual character of the appearance of a product
 - ↳ does not depend on use (static right)

➤ Term of protection

- **TM:** no time limit (it can be renewed indefinitely by periods of 10 years)
- **D:** 25 years maximum

Overlap between trademark and design protection

The definition of 'design' is wide enough to embrace signs that also fall right within the definition of 'trademark'

The definition of 'trademark' it is also remarkably wide and embraces drawings, product shapes and product packaging, that may also be protected as 'design'

Design protection is likely to overlap with trademark protection

when a design can be conceived as both an original work of authorship and as a source-identifying feature

Judgment AP Alicante n. 506/2012

Earlier TM



Earlier Design



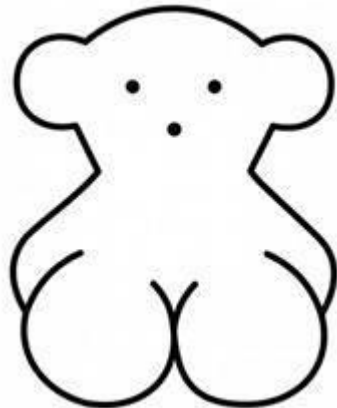
Contested sign



- ✓ Trade mark and design protection were invoked by Carolina Herrera
- ✓ It was held that the defendant infringed the two sets of rights

What can be protected through copyright law in Spain?

- ✓ All original literary, artistic or scientific works expressed in any mode or form
- ✓ Drawings, works of three-dimensional art, whether applied or not...
- ✓ 3D or 2D



In theory...

- ✓ In Spain, fashion articles can be protected both by design rights and copyright, provided that they meet the necessary conditions in order to be respectively protected by the different laws.
- ✓ Both forms of protection are independent, cumulative and compatible.
 - Spanish Copyright Law → Art. 10(1)(e)
 - Spanish Design Law → Explanatory Memorandum and 10th Additional Provision

...but in practice

Leading scholars and case law normally require a certain degree of artistic creativity in order to obtain copyright protection for industrial products

↳ Judgment of the Spanish Supreme Court n. 561/2012 of 27 September 2012 → “a plus of creativity is needed”.

- ✓ The problem is to determine when the product shape has such a medium-high artistic level (quantitative criteria)
- ✓ The threshold for “artistic level” requirement is relatively high
- ✓ Fashion designs in general not protected by copyright

Judgment AP Bilbao n. 516/2002



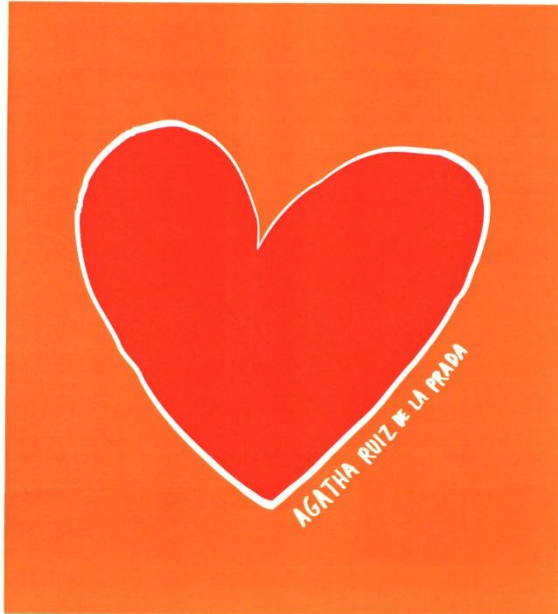
- ✓ Trade mark and copyright protection were invoked by Camper
- ✓ Copyright protection denied in general terms to shoes
- ✓ In any case, lack of originality (design inspired by old football shoes)

Judgment AP Las Palmas n. 191/2012 and 201/2012



- ✓ Design and copyright protection were invoked by Crocs
- ✓ Copyright protection denied → Little artistic value

Judgment AP Murcia n. 114/2016



✓ Design, TM and copyright protection were invoked by the well known Spanish designer Agatha Ruiz de la Prada

✓ It was held that the defendant infringed the three sets of rights, including copyright



Thank you for your attention!
Спасибо за внимание!

Sergio Rizzo

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