

# Protecting Slogans In Spain

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## 1.- Introduction

Slogans are increasingly used not only to promote goods and services but also to identify the source of these goods and services. Witty expressions, plays on words, generally speaking, phonetic features are easier to remember than a graphic or a logo from which the targeted public only keeps a visual image.

**To achieve the identification of the slogan with products or services, it is necessary to invest a considerable amount of money and effort in its creation and promotion. This investment can be protected in Spain** under trademark's regulation (protection of a subjective right) and under unfair competition's regulation (protection of the market in behalf of consumers and businesses).

## 2.- Trademark's regulation

**A slogan can be a registered as a word mark** if it fulfills the conditions required to all trademarks, specifically if it is capable of distinguishing the goods or services in question from that of another. No specific or additional requirements can be stipulated. Elements of imagination or a play on words are not required to consider that a slogan has distinctive character, even though these elements can assess its distinctiveness to the slogans because they are easy to be recall by consumers (Judgment of the Court of Justice of the European Union, 21 October 2004, Case OHIM) /Erpo Möbelwerk). It is not necessary that the consumer identifies the actual provider, it is enough that the trademark enables the targeted public to distinguish these products or services from those of another trade origin.

**The registration of a slogan as a word mark does not exclude neither its descriptive character nor its advertising function, it adds a second function: distinguish the trade origin.** The Judgment of the Court of Justice of the European Union, 21 January 2010 (Case Audi AG /OHIM) sums up previous judgments establishing that: *“The mere fact that a mark can be regarded as an advertising slogan, or that a sign is laudatory in nature, does not therefore preclude such a mark or sign from having sufficient distinctive character. (...) However simple such a message may be, it cannot be categorised as ordinary to the point of excluding, from the outset and without any further analysis, the possibility that that mark is capable of indicating to the consumer the commercial origin of the goods or services in question.”*

In fact, because the slogan-word mark keeps its initial function (promotion) it is more difficult that it gets distinctive character and, once obtained, that administrative or jurisdictional authorities recognize this distinctive character.

**Nevertheless, it is not enough to register an advertising slogan as a trademark for its effective protection against competitors.** The slogan must be used to identify the source of the goods or services, so that the average consumer associates the slogan with the provider, and this linking would be tighter if the slogan is used without other of his distinctive signs. Therefore, it is advisable to use the slogan-trademark without other provider's trademarks to prevent future conflicts with competitors, although it is most common practice to use them together. In that way it could be prevented that the distinctive function of the slogan-trademark could be judged as secondary regarding its promotional function (as in Judgment Nr. 569/2009, 22 July, of the Spanish Supreme Court, Civil Chamber, Section 1<sup>a</sup>, see under). On the contrary, to register the slogan as word mark in lots of classes, even though it is not used to all the products and services included in them, does not provide greater protection.

### **3.- Unfair Competition's regulation**

**The register as a word mark of a slogan do not preclude its protection according to Spanish Unfair Competition Law.** Whether it is or not registered as trademark, the use

of the slogan by a competitor to promote and distinguish its own products or services could be considered an act of unfair competition.

According to the Spanish Unfair Competition Law, all practices objectively against *bona fide* are unfair, specifically those which can create confusion about others activities, capabilities or businesses (“*actos de confusión*”) and those which take advantage, on behalf of oneself or a third party, of others reputation in the market (“*explotación de la reputación ajena*”). But it also establishes the general principle of free imitation of others capabilities and initiatives (if they are not protected by exclusive rights such as trademarks or patents) and precludes the unfairness of the imitation if the risk of confusion or the profit from others reputation can not be prevented. The free imitation of capabilities or initiatives has two limits: i) that the imitation can produce an avoidable risk of confusion or an avoidable unfair profit from others reputation or efforts; ii) when the constant imitation of a competitor’s capabilities and initiatives is directed to prevent its positioning in the market beyond the usual market’s reaction (“*actos de imitación*”).

**The line between fair and unfair competition is always imprecise and depends on the particular circumstances of each case** and their evaluation by the Judge. For slogans the line is still more difficult to establish due to its nature. Because the slogans refer to or describe the qualities of a product or service to promote its acquisition by consumers, it is difficult to forbid its use by competitors, even in cases such as the one decided in Judgment Nr. 569/2009, 22 July, of the Spanish Supreme Court (“*el turrón más caro del mundo*”/“*el turrón más famoso del mundo*”). Although the slogans’ construction is the same (changing just a word) and its aim (to emphasize each one’s characteristic feature), the Spanish Supreme Court judges that there is no risk of confusion because the emphasized feature is the peculiar attribute in the **market** of each nougat (“1880” the price, “La Fama” the fame).