

FC Barcelona prevents registering of industrial design featuring image of Camp Nou

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Facts

Decision

In *Futbol Club Barcelona v Spanish Patent and Trademark Office* (Judgment 132/2017, February 17 2017), the Catalonia High Court of Justice revoked a Spanish Patent and Trademark Office (SPTO) decision which had granted the registration of an industrial design featuring an image of the Camp Nou stadium.

Facts

A private individual filed an application to register a calendar comprising seven pictures of popular sightseeing spots in Barcelona as a Spanish industrial design. One of the pictures was of Camp Nou, in which the word 'Barça' could be read.

The SPTO granted the design's registration, which Futbol Club (FC) Barcelona opposed.

The opposition was dismissed as, according to the SPTO, the protected image in the industrial design at issue was different from the protected image in the figurative trademark invoked and owned by FC Barcelona.

FC Barcelona filed a writ of claim before the Catalonia High Court of Justice, asking it to:

- revoke the SPTO's decision; and
- order the refusal of the abovementioned industrial design.

To support its writ of claim, FC Barcelona claimed:

- lack of novelty, as the pictures included in the design were already accessible to the public;
- the incorporation of prior well-known trademarks, as the protected image in the design had led to confusion with the figurative trademark that bears the image of Camp Nou and the word trademarks FC BARCELONA and BARÇA, which were owned by FC Barcelona; and
- copyright infringement, as the copyrighted image included in the disputed industrial design was taken from FC Barcelona's website.

Decision

On February 17 2017 the Catalonia High Court of Justice rendered its judgment, revoking the SPTO resolution and refusing registration of the disputed industrial design.

The court considered that the alleged ground for refusal to be assessed was whether the design included the prior trademarks owned by FC Barcelona. In this regard, it deemed that the protected image in the industrial design at issue was not same as the protected image that featured in the invoked trademark.

Nonetheless, the court stated that an exact match between the design and the prior trademark was

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unnecessary, as the likelihood of confusion among consumers was sufficient to refuse the industrial design's registration.

The extent of such assessment depends on the well-known character of a prior trademark; in this case, the court had to consider not only the likelihood of confusion, but also whether the design had an unfair advantage over, or would be detrimental to, the prior trademarks' distinctive character or repute.

Notwithstanding the above, in revoking the SPTO's decision, the court considered:

- the well-known character of FC Barcelona, as well as its trademarks and identifying symbols;
- the prominent position of the image of Camp Nou in the industrial design; and
- the fact that the disputed image had been taken from the FC Barcelona website and prominently displayed the word '*Barça*'.

The court concluded that the design's registration would lead to a paradox, as the owner could contest FC Barcelona's use of its own image. As a result, the court refused the design's registration.

The court's decision is final.

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