

Supreme Court confirms revocation of collective trademark BARCELONA

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On March 7 2018 the Supreme Court confirmed the revocation of the collective trademark BARCELONA – whose registration had been sought in all classes of the Nice Classification – due to its lack of distinctiveness.

Facts

On December 30 2011 the Barcelona City Council applied for the collective trademark BARCELONA for goods and services in Classes 1 to 45. Peritos Judiciales de Barcelona SL filed an opposition based on Article 5.1(b) of the Trademark Act (17/2001), citing the trademark's lack of distinctiveness. On July 11 2012 the Spanish Patent and Trademark Office (SPTO) dismissed the opposition, granting the collective trademark. Peritos Judiciales de Barcelona filed an appeal against this decision, which was resolved with the trademark's revocation on March 5 2013. The Barcelona City Council subsequently filed a contentious administrative appeal against this revocation with the Catalonia High Court of Justice.

Catalonia High Court of Justice judgment

The Catalonia High Court of Justice's judgment distinguished between collective trademarks applied for by:

- associations, in which case a collective trademark carries out the regular function of identifying the goods or services of the association's members (as regulated in Article 62.1 of the Trademark Act); and
- legal entities in public administration (eg, the Barcelona City Council), in which case a collective trademark's function is more like that of a guarantee trademark (as regulated in Article 68.1 of the Trademark Act), which certifies that the goods or services to which it applies comply with common requirements, especially regarding:
 - quality;
 - components;
 - geographical origin;
 - technical conditions; and
 - the way in which the product is made or the service is delivered.

On December 29 2016 the court confirmed the revocation of the collective trademark, as its lack of distinctiveness meant that it fell under the explicit prohibition provided for in Article 5.1(b) of the Trademark Act. Further, the court concluded that the trademark contravened:

- the required function of a collective trademark (given that its registration was sought in all classes of the Nice Classification); or
- the protected goods' guarantee function.

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Cassation appeal

The Barcelona City Council appealed this judgment before the Supreme Court, challenging the application of Article 5.1(b) (lack of distinctiveness) based on two main arguments:

- Collective trademarks are not restricted to identifying the business origin of goods or services; rather, they allow the registration of signs or indications which may serve to identify their geographical origins.
- The collective trademark BARCELONA complied with the law, as its registration was sought by a legal entity of public administration. Further, the fact that its registration was sought in all classes of the Nice Classification was no obstacle to its registration, as there is no legal limit in this regard.

Supreme Court judgment

On March 7 2017 the Supreme Court considered that in order to establish case law in this regard, it had to clarify its stance regarding the scope of the explicit prohibition based on a lack of distinctiveness (Article 5.1(b)) regarding the collective trademarks registry and guarantee trademarks.

In this regard, the Supreme Court confirmed the Catalonia High Court of Justice's judgment and held that the collective trademark BARCELONA could not be included in the trademark registry as it lacked distinctiveness. This judgment was based on the fact that the trademark contravened:

- its required function as a collective trademark – namely, the identification of the business origin of goods and services (as an integrated member of an association); and
- the guarantee function of the designated goods or services, since its registration had indiscriminately been sought in all classes of the Nice Classification (ie, Classes 1 to 45).

In addition, the Supreme Court referred to a European Court of Justice judgment of July 20 2016 (T-11/15), in which it had stated that geographical terms that assign well-known places to the relevant goods or services and present a link for the sectors concerned must be excluded from registration as trademarks.

Consequently, the Supreme Court confirmed the revocation of the collective trademark BARCELONA for goods and services in Classes 1 to 45 of the Nice Classification, stating that the fact that the applicant was a legal entity in public administration did not authorise the exemption of the requisite that the sign be distinctive.

The Supreme Court's judgment is final.

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