

Changes to Spanish EU trademark and Community design litigation

January 29 2018 | Contributed by [Grau & Angulo](#)

Introduction

Key changes

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In 2017 the EU Trademark Regulation (2017/1001) and the Spanish Patents Act (24/2015) entered into force. Both pieces of legislation have affected EU trademark and Community design litigation in Spain.

The EU Trademark Regulation is a codified version of the previous EU Community Trademark Regulation (207/2009), taking into account the modifications made by EU Regulation 2015/2424.

Some of the changes introduced in the new regulation are substantive. Although many of them were already in force before the regulation took effect on October 1 2017, they have now been fully adopted into law.

The Spanish Patents Act, which has had a direct impact on trademark and design litigation, took effect on April 1 2017.

Key changes

The Patents Act modified the Trademarks Act (17/2001) and the Designs Act (20/2003) by establishing that Title XII of the Patents Act (jurisdiction and procedural rules) applies to the litigation of distinctive signs and designs "in everything that is not incompatible with its own legal identity". This means that these procedural rules also apply to the aspects of Spanish litigation regarding Community registries that are not covered by their regulations (ie, Article 129.3 of the EU Trademark Regulation 2017/1001 and Article 88.3 of the EU Community Designs Regulation (6/2002)).

The Patents Act also added a new Section 2 to the Trademarks Act and the Designs Act, which determines when the EU trademark courts (ie, EU Trademark Courts 1 and 2 of Alicante) will have extended competence over other claims. Thus, the EU trademark courts will also be competent over claims under the Trademarks Act and the Designs Act where:

- the claims are exercised cumulatively or there is "any other connection"; and,
- at least one of the claims is based on a Community registration or application.

The most practical changes concerning Community registries litigation are as follows.

Extension of deadline to respond to EU trademark and Community design claims

In Spain, the deadline for a defendant to submit allegations in ordinary civil proceedings is 20 days (Article 404.1 of the Civil Procedure Act).

However, Article 119 of the Patents Act determines that defendants have two months to submit allegations in civil patent litigations.

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Although the Patent Act's statement of motives establishes that this deadline extension was based on the complexity of patent litigation, the EU trademark courts are finally granting defendants a two-month deadline to submit allegations.

Extension of exclusive competence of EU trademark courts

The Patents Act's modification of the Trademarks Act and the Designs Act has clarified and consolidated the exclusive competence of the EU trademark courts when they resolve claims based on Community regulations together with other claims that are founded on identical or similar national or international trademarks.

In practice, the EU trademark courts were already adopting this solution by applying the principle of more specialised jurisdiction.

The fact that the Patents Act has extended the competence of the EU trademark courts to cover claims with "any other connection" has been seen as a way of increasing the scope of matters that can be heard by them.

Deferred enforcement of judgments

Article 219 of the Civil Procedure Act limits the possibility of obtaining a sentence of liquidation reservation in enforcement proceedings, which has been seen as a serious inconvenience for the owners of infringed rights in IP litigation.

In a decisive ruling in an IP litigation of October 24 2012, the Supreme Court clarified that Article 219 should be interpreted flexibly.

Article 74.5 of the Patents Act establishes that the procedures for calculating or quantifying and settling damages will be carried out during enforcement proceedings based on the grounds established in the relevant judgment. According to the act's statement of motives, this is mainly because:

- when filing a claim, plaintiffs may lack the necessary information to specify a claim for compensation; and
- considerable effort by the parties may be unjustified if the judgment is one of absolution.

The reasons justifying the introduction of this regulation specifically for patent litigation also apply to trademark and design litigation. Therefore, although this article is not contained in the title of the Patents Act applicable to trademarks and designs, in a November 13 2017 judgment concerning a Community model matter, the Alicante Court of Appeal acknowledged taking into account the Patents Act to interpret Article 219 of the Civil Procedure Act.

Extension of national provision to EU trademarks

Another change to Spanish EU trademark and Community design litigation stems from the recent European Court of Justice (ECJ) judgment which responded to Preliminary Ruling C-381/16 of the Spanish Supreme Court.

On November 23 2017 the ECJ replied to the Supreme Court, holding that Article 2.2 of the Trademarks Act – which entitles a person harmed when a trademark is applied for with fraudulent rights or in violation of a legal or contractual obligation to claim ownership of it – can be applied to an EU trademark as if it were a national trademark registered in Spain (Article 16 of the EU Trademark Regulation (207/2009)).

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