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## Civil remedies available for Trademark and Design infringement in Spain

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## **CIVIL REMEDIES**

- I. Cessation of the acts that constitute trademark and design infringement.
- II. Removal from the market of the infringing goods, packaging, advertising materials, etc.).
- III. Seizure or destruction of the infringing goods at the infringer's expense.
- IV. Seizure or destruction of the means principally intended to commit the infringement at the infringer's expense.
- V. Information regarding the distribution channels, suppliers, clients, accounting information, etc...
- VI. Compensation for damages.
- VII. Publication of the judgment at the infringer's expense.

VIII. Litigation fees.

## I. CESSATION

# Main proceedings **Preliminary Injunction Proceedings:** - Ex parte or contradictory Can be requested - Jointly filed with the main proceedings - Before/After the main proceedings **Provisional Enforcement of the first** instance judgment

## **II. REMOVAL**

### Not frequently applied

• <u>Practical problems</u>: when the product is already out of the infringer's control.

## It can be ordered for products in the hands of third parties

- Only if the measure is adequate and balancing the legitimate rights of third parties.
- Does not apply if the product is in the hands of the end consumer. (Madrid Court of Appeal 17.01.2012)

### If impossible to comply with it:

• Substituted by the compensation for damages.

### **III. SEIZURE OR DESTRUCTION OF PRODUCTS**

#### Usually demanded

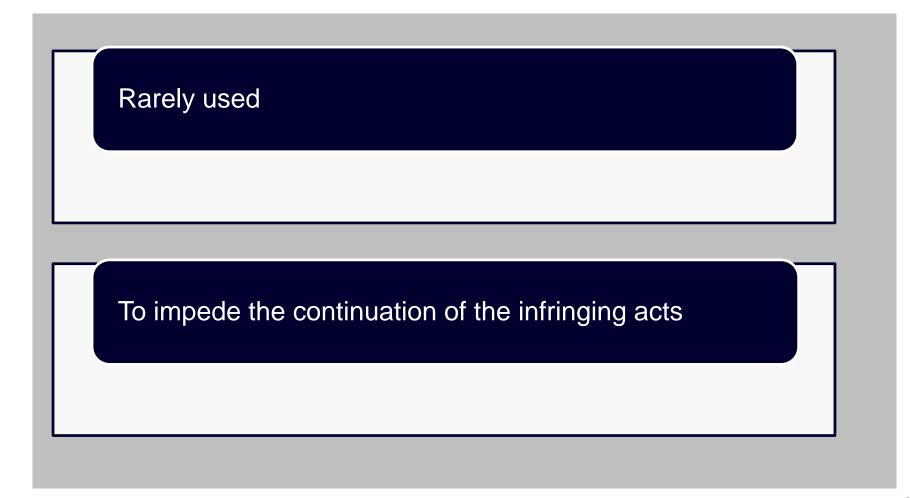
• Articles 41.1 d) LM and 53.1 d) LD

#### Other options

- Possibility of removing the infringing elements from the goods (not common).
- Transfer of ownership of products and means (deducted from damages).
- Delivery for humanitarian purposes (with the plaintiff's consent).

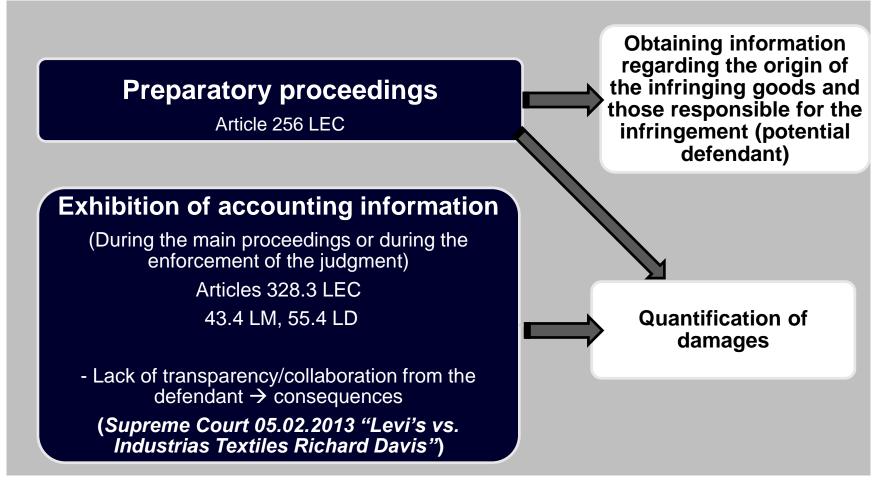
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## IV. SEIZURE OR DESTRUCTION OF MEANS PRINCIPALLY INTENDED TO COMMIT THE INFRINGEMENT



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## V. INFORMATION REGARDING THE DISTRIBUTION CHANNELS, SUPPLIERS, CLIENTS, ACCOUNTING INFORMATION, etc.



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### **VI. COMPENSATION FOR DAMAGES**

#### Minimum compensation $\rightarrow$ 1% of the infringer's turnover

Costs of investigations, C&D letters, preservation of evidence...

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## Three options at the plaintiff's choice

 Possibility of opting for the highest value once calculated, (EUTM Court Alicante, 23.01.2018 "Adidas vs. Carlite" (F.I.)) Profits obtained by the infringer: only direct expenses deductible (EUTM Court Alicante 21.01.10 "Apple vs. Saytes")

Profits that the right holder would have obtained if infringement had not occurred.

Hypothetical royalty:

 a) Based on previous license contracts from the right holder (EUTM Court Alicante 02.07.2009 "Ayuntamiento de Buñol vs. Adidas")

10% sanction *(Barcelona Court of Appeal 23.04.2001)* 

b) Including a minimum return guaranteed (EUTM Court Alicante 13.01.2012 "Adidas vs. Almonte") Obligation to calculate damages in the claim.

If not possible due to lack of information, at least set the basis for quantification.

## **VI. COMPENSATION FOR DAMAGES**

### Right holder can also request compensation for:

# Damages to the prestige of the trademark / design

- Due to faulty fabrication or an inadequate presentation of the infringing goods.
- Rarely awarded by Courts. (EUTM Court Alicante 18.06.2010 "BMW vs. Carelite") (EUTM Court Alicante 10.03.2015 "Hugo Boss vs. C Camal" (F.I.))

#### Moral damages:

Should not be confused with damages caused to the prestige of the trademark/design.

Rarely awarded by Courts.

## **VII. PUBLICATION OF THE JUDGEMENT**

#### Not automatic $\rightarrow$ It must be justified

Does not have a moralizing/exemplary purpose → works as means of compensation (EUTM Court Alicante 14.09.2015 "Puig vs. Saphir")

Advisable to specify publication means (media, time, size ...) Traditionally  $\rightarrow$  newspapers, magazines

More recently → infringer's website (EUTM Court Alicante, July 2018 (F.I.))

At the defendant's expense

## **VIII. LITIGATION FEES**

To be paid by the defeated party.

• Exception  $\rightarrow$  Doubts about facts or Law

Quantification  $\rightarrow$  Bar Association criteria.

 Inadequate and unsatisfactory (no recovery of substantial part of the fees).

## Thank you for your attention!

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