

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

Can be requested

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graph LR; A[Can be requested] --- B[Main proceedings]; A --- C["Preliminary Injunction Proceedings:  
- Ex parte or contradictory  
- Jointly filed with the main proceedings  
- Before/After the main proceedings"]; A --- D["Provisional Enforcement of the first  
instance judgment"]
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Main proceedings

Preliminary Injunction Proceedings:

- Ex parte or contradictory
- Jointly filed with the main proceedings
- Before/After the main proceedings

**Provisional Enforcement of the first
instance judgment**

II. REMOVAL

Not frequently applied

- Practical problems: 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).

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

Rarely used

To impede the continuation of the infringing acts

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

Preparatory proceedings

Article 256 LEC

Obtaining information regarding the origin of the infringing goods and those responsible for the infringement (potential defendant)

Exhibition of accounting information

(During the main proceedings or during the enforcement of the judgment)

Articles 328.3 LEC

43.4 LM, 55.4 LD

- Lack of transparency/collaboration from the defendant → consequences

(Supreme Court 05.02.2013 "Levi's vs. Industrias Textiles Richard Davis")

Quantification of damages

VI. COMPENSATION FOR DAMAGES

Minimum compensation → 1% of the infringer's turnover

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

+

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 → 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 → 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 → Doubts about facts or Law

Quantification → Bar Association criteria.

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

Thank you for your attention!

GRAU & ANGULO

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