



ENTITLEMENT TO ASSIGNMENT OF EU TRADEMARKS

Following a preliminary ruling of the ECJ, the Spanish Supreme Court (STS 417/2018) has recently recognized the possibility of requesting the assignment of a EUTM on the basis of the Spanish TM Law.

Our legal framework provides a wider scope for filing claims on ownership of TM rights than that of Art. 21 of the EUTM Regulation, which limits its effects to those cases where trademarks are registered in bad faith by the agent. Thus, Art. 2 of the Spanish Trademark Act expands the effects of this provision to the cases in which a trademark has been registered in fraud of a third party's rights or the legitimate title-holder has been deprived of this right in breach of a legal or contractual obligation.

Until now, this option had been limited by Spanish Courts to national marks or international designations with effects in Spain and giving rise, as a consequence, to an unequal degree of protection for these abusive conducts, depending on whether the case affected a national or an EU trademark.

ESSENTIAL PATENTS

The European Commission is taking steps in order to define the blurring boundaries of patents involved in technical standards, also called essential patents that claim inventions that must be used to comply with a technical standard.

By the end of last year, the EU issued the final Communication COM (2017) 712 "[Setting out the EU approach to Standard Essential Patents](#)", aimed at providing a certain degree of guidance and transparency in the exploitation of these patents and completing the set of principles derived from the ECJ ruling on the Huawei/ZTE case (C-170/13).

The severe distortion that these patents may cause in competition and technological progress has put in evidence over the last years the need to provide certain criteria on how they should be licensed or enforced.



PONTI WEBSITE

Our new website is already available, with much more information about us, our folder of services and an improved browsing experience.

If you haven't done it yet, we invite you to check it out on www.ponti.pro and get instant updates on IP news and information from Spain and Europe.

NEW EUROPEAN PATENT ATTORNEY

Minerva Rivero, European and US Patent Attorney, has joined our team. She holds a BSc in Electrical and Electronics Engineering from the University of Puerto Rico and a MSc in Entrepreneurship and Electrical/Electronics Engineering from the University of Nottingham (UK). Previously, she worked as a patent examiner at the USPTO in Washington and later on as an attorney in other European firms.

Minerva will increase our capacities in one of the emerging fields of the patent industry.

AGENDA / EVENTS:

19-23.05.2018 INTA. International Trademark Association. Seattle. USA.

05-09.06.2018 FICPI. Fédération Internationale des Conseils en Propriété Intellectuelle. Toronto. Canada

10-12.06.2018 IPBC GLOBAL. San Francisco. United States.

13-16.06.2018 ECTA. European Communities Trademark Association. Athens. Greece.

THE UDRP: CONSENSUS PANEL VIEWS

After almost twenty years of being available, it is a good time to evaluate the results following the implementation of the Uniform Domain-Name Dispute-Resolution Policy, also known as the UDRP.

Back to its origins, ICANN first commissioned WIPO to produce a report on the conflict between trademarks and domain names. In April 1999, WIPO recommended ICANN the establishment of a “mandatory administrative procedure concerning abusive registrations”. In other words, it should be a protection against Cybersquatting, which consists in registering, dealing in, or using an Internet domain name with bad faith with the aim of taking profit from the goodwill of a trademark belonging to someone else.

As a result, an arbitration system wherein a trademark holder can attempt to claim a squatted site was set on 1999.

One of the analysis that can be performed is the existence of consensus panel views on a range of common and important substantive and procedural issues, which can be summarized as a very helpful tool that increases predictability to any new case that should be foreseen by any potential or actual owner. As to the first element (the similarity or identity between a domain name and a trademark over which the complainant has rights), there follow some of the items where the existence of such consensus panel views can be definitely found:

As to the standing of the complaint:

The fact that a domain name may have been registered before a trademark rights does not by itself preclude its owner’s standing to file a UDRP case, nor a panel’s finding of identity or confusing similarity. On the other hand, a pending trademark application would not by itself establish trademark rights within the meaning of UDRP paragraph 4(a)(i).

Apart from registered trademarks, in order to establish unregistered or common law trademark rights for the purposes of the UDRP, the complainant must show that their mark has become a distinctive identifier which consumers associate with the complainant’s goods and/or services.

As to the domain name challenged:

The fact that a respondent is shown to have been targeting the complainant’s mark may support the complainant’s assertion that its mark has achieved significance as a source identifier.

In specific limited instances, while not a replacement as such for the typical side-by-side comparison, where a panel



Jaume Layola
Lawyer

would benefit from affirmation as to confusingly similarity with the complainant’s mark, the broader case context (such as website content trading off the complainant’s reputation) may support a finding of confusing similarity.

A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark.

To the extent that design elements would be incapable of representation in domain names, these elements are largely disregarded for the purposes of assessing identity or confusing similarity. Such elements may be taken into account in limited circumstances e.g., when the domain name comprises a spelled-out form of the relevant design element.

However, where design elements comprise the dominant portion of the relevant mark in such a way that they effectively overtake the textual elements in prominence, or where the trademark registration entirely disclaims the textual elements, panels may find that the complainant’s trademark registration is insufficient by itself to support standing under the UDRP.

The applicable Top Level Domain (“TLD”) in a domain name (e.g., “.com”, “.club”, “.nyc”) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. In other words, the similarity with a trademark in such a syllable like “com”, “club” or the like is not usually deemed as the basis to affirm a relevant similarity as to the accomplishment of the first element.

Where the complainant’s trademark is recognizable within the disputed domain name, the addition of other third-party marks (i.e., <mark1+mark2.tld>), is insufficient in itself to avoid a finding of confusing similarity to the complainant’s mark under the first element (without prejudice of said third party’s right).

A domain name that consists or is comprised of a translation or transliteration of a trademark will normally be found to be identical or confusingly similar to such trademark for the purposes of standing under the Policy, where the trademark- or its variant-is incorporated into or otherwise recognizable, through such translation/transliteration, in the domain name.

These are very useful guidelines in order to determine whether the first element requested by a complaint filed under UDRP rules is met. If the potential complainant deems it accomplished, further assessment must be conducted on the other elements.