

Pérez-Llorca

YEAR IN REVIEW 2022

# Intellectual Property and Technology

**Image created by Stable Diffusion**

Prompt: A beautiful intricate 3 d abstract glass sculpture made of white pore fungi, morning glory flowers, boho floral vines, murano round colored glass vases, orange hibiscus flowers, top lit, octane render, soft lighting, ultra detailed, 8 k, trending in artstation, gallery piece by barbara hepworth



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**Editorial**

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## Technological Sovereignty

### Editorial

It is only by being self-sufficient that sovereignty can be achieved. The global crisis caused by COVID-19, and exacerbated by the war in Ukraine, has led to a profound distortion in the technology sector, especially due to the absence of medicines (especially vaccines), components, processors and integrated circuits, the manufacture of which had been offshored years ago to other parts of the world, mainly Asia. This strategic decision, which might have made sense in the Europe of the last forty years, has proven to be obsolete today, as the three major world areas (the US, China and the EU) seek to position themselves preferentially for the coming decades. These geopolitical movements are clearly being reflected in European rules.

In the digital sphere, 2022 saw the adoption of two pieces of European legislation that will undoubtedly shape the EU's online environment in the coming decades: the Digital Markets Act (**DMA**) and the Digital Services Act (DSA). As we said last year, the European Union, concerned about our disadvantaged position in relation to information and communication technologies, has established strict rules for search engines, marketplaces, social networks, app stores and virtual environments, with the aim of ensuring a more equal online environment that is competitive for European businesses and that safeguards citizens' rights. These intermediary service providers now have a few months to adapt and implement the obligations of transparency, fairness, proactive responsibility and moderation of illegal content set out in the two regulations.

Subjugation to third parties is also being experienced at an individual level. In the last year, there has been an increase in cases of business tension caused by technology providers who, in the face of legal uncertainties and taking advantage of their privileged position, try to improve their position. This situation tends to occur essentially in two scenarios: in complex software licensing schemes (enterprise resource management (ERP), customer relationship management (CRM), etc.) and in the hosting and maintenance of information systems. In short, when the company is inexorably dependent on the services or technologies of a third party.

Technological manumission should certainly not be achieved by giving up devices and systems that make the company more efficient and competitive, but rather by identifying the technologies that are essential to the company (i.e. those without which the organisation could not operate or would do so with great difficulty) and establishing continuity plans in the event of any contingency, intentional or otherwise. This is the approach of the NIS2 Directive, adopted this year by the EU Parliament and Council, which aims to improve the resilience and security incident response capabilities of our public and private entities. The regulation includes a new Cybersecurity Strategy and new obligations for critical operators of essential services, which aim to reduce physical threats to them.

Another moment of subjugation for companies is undoubtedly the security breaches that affect their information systems and, even worse, the personal data they process. According to data from the Spanish Data Protection Agency, each year it receives around 1,500 notifications of data breaches of different kinds, each of which causes organisational stress in different departments, but mainly information systems and legal departments. Technical and legal prevention remains the best solution when faced with such events, especially to protect against another trend coming from English-speaking countries, which is claims for damages in the event of security breaches affecting personal data. Article 82 of the General Data Protection Regulation ("**GDPR**") allows any data subject to claim damages for non-compliance with the GDPR; companies may find here an additional incentive to comply with the regulation strictly and avoid the damages claims that are already occurring in the US and the UK.

We also anticipate that 2023 will bring major developments in the field of intellectual property. The Unified Patent Court is expected to become operational in the first half of the year, although the exact date is not yet known. There are many unknowns about the unitary patent system and this new judicial body, and to what extent companies in the relevant sectors will decide to submit their patents to this system. In any case, although Spain is not part of this system, from the moment that a Spanish company can be a party to proceedings before this court, it will be necessary to closely follow its implementation and evolution.

The technologies related to technological sovereignty have not garnered the most media attention this year, especially compared to NFTs, web3 and the metaverse, which are more future than present. However, we believe that what are more representative are policies and technologies associated with ensuring the continuity of more revolutionary information systems or web services, such as the conversational assistant ChatGPT or the image generators MidJourney, DALL-E 2 and Stable Diffusion, all of which are based on artificial intelligence, which convey precisely what, until recently, many claimed would be reserved for human beings, namely our creative capacities. These technologies will bring about important ethical and intellectual property debates, such as the already frequent discussions concerning the protection of their outcomes, authorship or, in the absence of rights, whether the terms and conditions provided by the service provider can place them in a situation similar to that provided for by the law.

In this position in the technological race, Europe must compete with innovation and a cutting-edge legal system that allows individuals, public institutions and companies to guarantee individual, collective and corporate independence and sovereignty.



**Rais Amils**  
Partner



**Eduardo Castillo**  
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**Andy Ramos Gil de la Haza**  
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# Legislation

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Guide published by the European Network and Information Security Agency (“**ENISA**”) and the European Union Computer Emergency Response Team (“**CERT**”)

## Good practice guide to increase cyber resilience in organisations

On 14 February 2022, ENISA and CERT published a best practice guide (the “**Guide**”) for both public and private sector companies to provide them with certain guidelines and advice and to ensure a minimum standard of security in their networks and systems. In particular, the Guide sets out the minimum recommendations that every company should consistently and systematically implement to improve its cyber security and ensure a resilient response to a cyber-attack.

The recommendations provided in the Guide can be divided into technical recommendations (such as the implementation of multi-factor authentication through virtual private networks, regular software updates or network segmentation) and organisational recommendations (such as the review of internal policies, the establishment of a regular training plan or the organisation of regular events aimed at raising awareness among users about the most common cyber-attacks, such as phishing, and how to avoid them).

There is no doubt that cybersecurity is the order of the day, so it will be essential for any company, regardless of its size or activity, to protect its assets by observing the aforementioned recommendations, which must be adapted to the reality of the business.



**Alicia Maddio medina**  
Lawyer

Code developed by the Spanish Data Protection Agency (“**AEPD**”) and Farmaindustria

## Code of conduct in the field of clinical trials and pharmacovigilance

On 23 February 2022, the AEPD published the first sectoral code of conduct approved by the AEPD (the “**Code of Conduct**”). The Code of Conduct has been promoted by Farmaindustria and aims to facilitate and regulate the application of data protection regulations in clinical and biomedical research, as well as in relation to pharmacovigilance. Likewise, through this Code of Conduct, entities that are subject to it will be able to rely on a guide that will provide them with greater legal certainty when processing personal data within the framework of the aforementioned activities.

In particular, the Code of Conduct covers processing carried out in Spain and acts as a catalyst for compliance with data protection regulations, insofar as for a company to adhere to it, it will be necessary to certify full compliance with the provisions of Regulation (EU) 2016/679 of 27 April on the protection of natural persons with regard to the processing of personal data and on the free movement of such data (the “**GDPR**”).

While adherence to the Code of Conduct is voluntary, once companies operating in the sector have signed up, its provisions will be mandatory. One of the most significant aspects to be highlighted is that the Code of Conduct establishes its own disciplinary system. Although it does not entail financial penalties, it may deter breaches of data protection regulations insofar as the reputational risk for a company that the imposition of a penalty for breaching a commitment to privacy may, indirectly, entail very high losses. All of the above takes into special consideration the type of sensitive data often processed in the field of clinical trials and pharmacovigilance.



**Alicia Maddio Medina**  
Lawyer

## Royal Decree-law 7/2022 of 29 March on requirements to guarantee the security of fifth-generation electronic communications networks and services

### Network security. Royal Decree-law 7/2022

Over the last few decades, mobile networks have positioned themselves as the focal point of telecommunications and information technologies at all levels and in all areas of society. Evidence of this is how the most innovative technologies of recent years have been developed on the basis of these networks, with the aim of adapting technologies to them and not the other way around. The most recent mobile network is known as fifth generation or 5G, which, according to the initial declaration provided by the legislature in the preamble of the Royal Decree-law, *can give mobile and wireless communications a new dimension by integrating computing in the network, allowing the creation of virtual networks, offering low latency and providing services of enormous added value for society in areas such as medicine, transport and energy.*

Thus, as stated in its Article 1, the purpose of this Royal Decree-law is to establish security requirements for the installation, rollout and operation of electronic communications networks and the provision of electronic and wireless communications services based on fifth-generation (5G) technology.

As such, in accordance with the provisions of Article 2, this Royal Decree-law aims to achieve the following objectives:

- (i) Drive end-to-end security of the ecosystem created by 5G technology.
- (ii) Strengthen security in the installation and operation of 5G networks and in the provision of mobile and wireless communications services supported by 5G.
- (iii) Promote a sufficiently diversified supplier market in 5G electronic communications networks and services in order to guarantee security based on technical, strategic and operational reasons and to avoid, for these reasons, the presence of suppliers with a high risk or medium risk rating in certain network elements or areas.
- (iv) Strengthen the protection of national security.
- (v) Reinforce the industry and foster national R&D and innovation activities in cybersecurity related to 5G technology.

This Royal Decree-law will apply to (i) 5G operators; (ii) 5G suppliers; (iii) 5G corporate users that have been granted rights to use the public radio spectrum to install, roll out or operate a 5G private network or to provide 5G services for professional purposes or on a self-provision basis.

Likewise, one of the main developments introduced by this law is the establishment of a National Security Scheme for 5G networks and services, which will carry out a comprehensive and holistic assessment of the security of 5G networks and services, considering the contributions to the scope of each agent in the 5G value chain in order to guarantee the continued and secure operation of the 5G network and services. In addition, the National Security Scheme for 5G networks and services will entail the development of a national risk analysis on the security of 5G networks and services in order to identify, specify and develop measures at a national level to mitigate and manage the risks identified.

In short, the approval of this Royal Decree-law aims to regulate the installation, supply and provision of mobile and wireless communications services based on 5G, as well as to establish a basic cybersecurity framework to strengthen national security.



**Alicia Maddio Medina**  
Lawyer

## Law 8/2022, of 4 May, amending Law 23/2011, of 29 July, on the legal deposit

### Legal deposit reform

On 5 May 2022, Law 8/2022, of 4 May, amending Law 23/2011, of 29 July, on the legal deposit (the “Law”), was published. The purpose of the Law is to adapt the current regulation on the legal deposit to the changes in the publishing sector, to adjust the regulations to the reality of online publications, and to achieve a more complete deposit. The main developments arising from the Law are the following:

- the exclusion from the deposit of advertising publications, microforms, public examination syllabuses published by academies, computer applications, published photographs, puzzles, crosswords, Sudokus, wordsearch puzzles and similar, as well as health guides;
- the specific inclusion of video games, to be deposited with all additional digital content, excluding 3D objects.
- the recognition of the Filmoteca Española as a repository to make up for the lack of a repository for cinematographic films;
- the establishment of the irrevocable status of the legal deposit made in any of the repositories;
- the listing of the copies that the Spanish National Library is obliged to keep; or
- the obligation to deposit a digital copy of books, magazines and newspapers in the server of the Spanish National Library prior to the printing of the physical publications.

In addition, the Law includes new publications under the deposit obligation, such as print-on-demand publications, digital files prior to the printing of books and serial publications, commercial catalogues of bookshops, publishers and auctions, bookmarks, postcards of landscapes and cities and video games which, although they had been subject to deposit, receive their individualised identification to ensure that they are submitted in the quantities that the market for these products represents, which did not occur when they were deposited as audiovisual documents.



**Álvaro Martínez Crespo**  
Lawyer

Regulation (EU) 2022/850 of the European Parliament and of the Council of 30 May 2022 on a computerised system for the cross-border electronic exchange of data in the field of judicial cooperation in civil and criminal matters (e-CODEX system), and amending Regulation (EU) 2018/1726



**Silvia Bardají**  
Lawyer

## Entry into force of Regulation (EU) 2022/850 on the legal framework for the cross-border electronic exchange of data in the area of judicial cooperation in civil and criminal matters (e-CODEX system)

In June 2022, Regulation (EU) 2022/850 on the legal framework for the e-CODEX system for the cross-border electronic exchange of data in the area of judicial cooperation in civil and criminal matters entered into force, amending Regulation (EU) 2018/1726 (“**Regulation 2022/850**”). Regulation 2022/850 aims to address the delays and high costs of access to judicial systems by strengthening channels for cross-border cooperation in the digital environment, and in particular the e-CODEX system.

Although its use is not mandatory, e-CODEX aims to facilitate the secure communication and exchange of legal information in civil - including commercial - and criminal proceedings, fostering cooperation between judicial authorities in the European Union. The creation of this decentralised and interoperable system is thus intended to ensure that any citizen or legal professional in the Union can communicate electronically with any judicial authority.

The e-CODEX system will be composed of: (i) an access point; (ii) digital procedural standards; (iii) and software, documentation and other supporting resources. In particular, the access points will be composed of protocols that allow the secure exchange of information, as well as a connector to ensure the security of the information.

The Regulation stipulates that, before the end of 2022, the Commission would establish, by means of implementing acts: (i) the minimum technical specifications and standards for security and verification; (ii) the service level requirements for the activities of the European Union Agency for the Operational Management of Large-Scale IT Systems in the Area of Freedom, Security and Justice (“**eu-LISA**”); and (iii) the specific arrangements relating to the handover and takeover of control by eu-LISA.

Similarly, in order to ensure the sustainability and governance of e-CODEX, Regulation 2022/850 entrusts eu-LISA with its management, preserving above all the independence of eu-LISA from the judiciary. The creation of a specific e-CODEX Programme Management Board is also provided for to advise eu-LISA on matters of prioritisation of activities or the development of digital processing standards.

In this respect, Article 7 of Regulation 2022/850 established, inter alia, the following responsibilities for eu-LISA: (i) developing and updating the e-CODEX software; (ii) preparing e-CODEX technical

documentation; (iii) developing, maintaining, updating and distributing the exhaustive list of authorised e-CODEX access points; (iv) making technical changes and upgrades to e-CODEX, taking into account the principle of security by design as well as data protection by design and by default; (v) supporting and coordinating the testing of e-CODEX access points; and (vi) acting as a single point of contact for technical assistance for e-CODEX correspondents.

As part of the transfer of the e-CODEX system to eu-LISA, it is established that all intellectual property rights, as well as related rights of use, will be transferred to eu-LISA in order to ensure the proper performance of the responsibilities entrusted to eu-LISA. However, it is recognised that there will be no need for the e-CODEX software to be transferred on a contractual basis, as it is expected to be open source and covered by the European Union Public Licence.

At a national level, Member States will be responsible for authorising the operation of e-CODEX access points to certain public authorities or legal persons associated with the law, and for notifying eu-LISA of this. They must also maintain an up-to-date and publicly available list of such authorised access points, as well as the digital procedural standards applied by each authorised access point.

Lastly, it is established that by the end of 2022, eu-LISA’s Management Board would set up an e-CODEX Programme Management Board. The functions of this board will focus on advising on sustainability issues, optimising the management of the e-CODEX system and monitoring the independence of the judiciary. At the same time, it is established that the term of office of the members of the e-CODEX Programme Management Board should be renewable, ensuring the representation of the different Member States over time.

In short, as part of the digital modernisation of the European Union, the aim of creating the e-CODEX system is to ensure cross-border electronic data exchange and to facilitate judicial cooperation in civil and criminal matters.

IPN/CNMC/013/22:  
P.O. approving the  
methodology for  
determining the  
general tariffs of  
IP right collective  
management  
organisations for  
the use of their  
repertoire

## On the methodology for determining the general tariffs of IP right collective management organisations for the use of their repertoire

In March 2022, the Ministry of Culture and Sport submitted for public information the “Draft Order approving the methodology for determining general tariffs in relation to the remuneration payable for the use of the repertoire of intellectual property right collective management organisations”, the purpose of which was to establish a methodology for determining the general tariffs in relation to the remuneration payable for the use of the repertoire of works managed by intellectual property right collective management organisations. In this context, the CNMC has since made a decision and has issued some general recommendations, such as defining adequately and precisely the concepts of effective use of the repertoire, as well as the intensity and significance of the use, and taking into consideration some additional criteria such as previous tariffs. It also recommends that no distinction be made in tariffs between equivalent operators, in the interests of maintaining competition, although it considers that it is positive that collective management organisations and operators continue to be able to reach their own agreements.



**Diego de la Vega**  
Lawyer

General Law 11/2022, of 28 June, on Telecommunications (“**GLTC**”) and Organic Law 5/2022, of 28 June, complementary to General Law 11/2022, of 28 June, on Telecommunications, amending Organic Law 6/1985, of 1 July, on the Judiciary (“**OLTC**”)



**Alicia Maddio Medina**  
Lawyer

## Telecommunications Regulations. Law 11/2022 and Organic Law 5/2022

On 28 June, the GLTC, and the complementary OLTC, were published. This regulation belatedly transposes the 2018 European Electronic Communications Code and introduces a number of new developments in this area. However, the legislature focuses on two main pillars: investment incentives and consumer protection.

In terms of incentivising investment, the main objective of the GLTC is to incorporate a stable regulatory framework that allows investment in very high-capacity networks. To this end, it introduces concepts such as geographical studies (the Ministry of Economic Affairs and Digital Transformation will carry out an annual study on the scope and reach of broadband networks which will include sufficient information on service quality and parameters to measure this) and co-investment between operators.

With regard to consumer protection, the text strengthens consumer rights, imposes greater transparency obligations on operators, regulates legal relationships such as package contracts and incorporates a new regime aimed at facilitating contracting for people with sensory disabilities. In relation to the principle of transparency, operators of internet access services or interpersonal communications services will be obliged to provide more information to consumers about their contract and the specific services covered by the offer, so that end users can make an informed choice about which operator to contract with. In addition, where operators offer bundled services, they will have to comply with the many obligations set out in Article 71, including those concerning disclosure requirements and the consumer’s right to cancellation. As far as measures aimed at social inclusion are concerned, the GLTC delegates to the Ministry of Economic Affairs and Digital Transformation the power to adopt certain initiatives and establishes the obligation to provide consumers with disabilities access to the services included in the universal service at a level equivalent to that enjoyed by other consumers.

This regulation also incorporates very significant innovations in the field of the public radio spectrum. In this regard, it introduces measures that aim to facilitate and make more flexible the shared use of the radio spectrum by operators and to avoid undue restrictions on the roll-out of wireless access points for small areas. In this regard, public administrations have an obligation to encourage the conclusion of voluntary agreements between operators, particularly in cases where the purpose of the collaboration is to roll out elements of high-speed and very high-speed electronic communications networks.

In addition, through this legislative amendment, security measures are introduced, all with the aim of providing new tools in the face of the risks and threats to which telecommunications networks and services are subjected.

The GLTC also relaxes the regulation of relevant markets by introducing the concept of “dynamic markets”, which will be those where there are major technological developments and end-user demand patterns may evolve in such a way that market conditions change.

Finally, the Regulation establishes, for the first time, the obligation to notify the Ministry of Economic Affairs and Digital Transformation of the installation or operation of submarine cables which connect, access or are interconnected to electronic communications networks in Spanish territory.

The OLTC merely amends Article 58 of Organic Law 6/1985, of 1 July 1985, on the Judiciary, adding a new fourth section which states that the Administrative Chamber of the Spanish Supreme Court will have jurisdiction to hear the Government’s request provided for in Article 4 of the GLTC for the validation or revocation of agreements to take over or intervene in the direct management of the service or to intervene in or operate networks

## Guide for healthcare professionals, Spanish Data Protection Agency

### The AEPD publishes a guide for healthcare professionals

In June 2022, the Spanish Data Protection Agency (“**AEPD**”) published a Guide for healthcare professionals (the “**Guide**”), which is mainly aimed at healthcare professionals working in an individual capacity. The Guide discusses basic issues for the sector such as a brief analysis of personal health data, the legal position of professionals (i.e. processor or controller), and the legal basis for processing. At the same time, emphasis is placed on the right of access to medical records (“**MR**”), as well as measures aimed at the management of the rights of those affected in hospital environments, also targeting professionals who provide their services in hospitals or clinics.

Firstly, the Guide identifies the following as health data, regardless of its source: (i) any information that provides information on the patient’s health status at any time; (ii) the number assigned to a person for medical identification (e.g. MR number); (iii) information on tests or examinations; (iv) information provided by relatives in relation to minors or persons with limited cognitive capacity; and (v) information on family history.

It also establishes that patient data may be processed on the basis of both consent and any other legitimate basis provided for by law. A distinction is therefore made between mandatory “informed consent” for healthcare actions and “consent for the processing of personal data” which is usually unnecessary in the healthcare sector (e.g. processing necessary to protect the vital interests of the data subject). However, a duty of information on the part of professionals or hospitals is recognised, in accordance with Article 13 of the GDPR.

The Guide also recognises that in certain cases, data stored in the MR may be processed for purposes other than healthcare (e.g. research or epidemiological purposes), provided that identifying data is separated from clinical and healthcare data. It also recognises that the processing of minors’ data can only be based on consent when the minor is over 14 years of age; and mentions that it is advisable to separate the health consent form from the privacy information form.

With regard to access to the MR, the AEPD maintains that, due to its significance for health, access to it will not be limited under the data protection regulations; although it will be mandatory to implement policies and records that allow for the prevention, detection and correction of abuses of the MR. However, only healthcare professionals directly involved in the patient’s care functions will have access to the MR, safeguarding professional secrecy.

In turn, it acknowledges that, as part of the right of access in Article 15 of the GDPR, the patient will have the right to know how many times their MR have been accessed and for what purpose; although the AEPD acknowledges that the national regulations do not recognise that this right includes the express identification of the professionals who have accessed the patient’s MR.

On the other hand, the AEPD maintains that healthcare professionals who unjustifiably access the MR, in addition to the corresponding violations of the Codes of Ethics, may be subject to joint liability in the criminal, disciplinary and administrative spheres for data protection issues. In this respect, it will not be necessary for the professional to disclose the data consulted through this access to third parties, but the mere unjustified access to the MR will be punishable.

With regard to the obligation to designate a DPO, it establishes that public and private health centres must have one, while healthcare professionals carrying out this activity on a private or individual basis are exempted from this obligation. The AEPD recommends that the latter ask professional associations to assist them in DPO matters, in the interest of proactive responsibility.

Lastly, with regard to the liability regime for healthcare professionals in hospitals or clinics, the AEPD distinguishes between three situations: (i) healthcare professionals who lease a practice in a hospital or clinic and who retain full freedom over the patient’s care will be considered responsible for the treatment; (ii) healthcare professionals employed by hospitals or clinics to provide their services, while retaining independence with regard to the healthcare, in which case the hospital will be responsible for the treatment; and (iii) in rare exceptions, there are health professionals who treat their own patients in hospital practices, in combination with patients belonging to the health centre, in which case the particular relationship will be analysed to determine the means and purposes of treatment for each patient.



**Silvia Bardají**  
Lawyer

## Act 13/2022, of 7 July, on General Audiovisual Communication

# Highlights of the General Audiovisual Communication Law

On 8 July 2022, the General Audiovisual Communication Law (hereinafter referred to as the “GACL”) was published in the Official State Gazette (BOE). The GACL repeals the former General Law 7/2010, of 31 March, on Audiovisual Communication, and incorporates into the Spanish legal system –well after the deadline for transposition of 19 September 2020– the Directive on audiovisual media services. Highlights of the GACL:

### 1. New definition of “independent producer”

Independent producer: a natural or legal person who is not linked on a stable basis to a common business strategy with an audiovisual media service provider obliged to pre-finance European audiovisual works.

An independent producer is one who assumes the initiative, coordination and financial risk of the production of audiovisual programmes or content, on their own initiative or by commission, and in return for payment makes them available to the audiovisual media service provider.

### 2. Quota of audiovisual works in broadcast or catalogue

The new GACL includes quota obligations for the promotion of European audiovisual works by on-demand television services.

### 3. Particularly significant users who use video-sharing services via the platform

Influencers are considered to be audiovisual communication service providers and must therefore respect the obligations set out in the GACL when marketing, selling or organising the commercial communications that accompany or are inserted into their audiovisual content.

### 4. Pre-financing obligation for European audiovisual works and promotion of linguistic diversity

The obligation to pre-finance European audiovisual works is extended to on-demand platforms established in Spain (or those which are established in another Member State and direct their offering towards Spain) (Article 117).

**It will not apply:** to providers with a low volume of business or a small audience, or in cases where such an obligation would be impracticable or unjustified.

**Ways of complying with the obligation:** through direct participation, the acquisition of exploitation rights, contribution to the Film Protection Fund, or contribution to the Fund for the Promotion of Films and Audiovisuals in co-official languages other than Spanish.

#### Quota of audiovisual works for linear television audiovisual media services (art. 115)

##### 51% of the annual transmission time reserved for European audiovisual works:

- At least half of this quota will be allocated to works in the official language of the State or in one of the official languages of the Autonomous Regions.
- In relation to a public audiovisual media service provider at State level, at least **15%** will be reserved for audiovisual works in one of the official languages of the Autonomous Regions, taking into account their population size and reserving at least **10%** percent for each of them.

**10%** reserved for European works by independent producers (with half of this percentage going to works produced within the last five years).

#### Quota of audiovisual works in the catalogue of the television audiovisual media service at the request of platforms based in Spain (art. 116)

##### 30% of the catalogue will be reserved for European works:

- At least half of this quota will be reserved for works in the official language of the State or in one of the official languages of the Autonomous Regions.
- Of this sub-quota, **40%** will be reserved for audiovisual works in one of the official languages of the Autonomous Regions, taking into account their population size and reserving at least **10%** percent for each of them.

The Autonomous Regions with an official language may impose additional obligations on providers of television audiovisual communication services at a regional level.



**Diego de la Vega**  
Lawyer



**Isabel Iglesias**  
Knowledge Advisor

## Code of conduct regulating the processing of personal data in the common information systems of the insurance sector

# New code of conduct regulating the processing of personal data in the common information systems of the insurance sector

The Spanish Data Protection Agency (the “**AEPD**”) approved the “Code of Conduct Regulating the Processing of Personal Data in the Common Information Systems of the Insurance Sector” (the “**Code**”), promoted by the Spanish Union of Insurance Entities (“**UNESPA**”), the objective of which is to contribute to the correct application of the General Data Protection Regulation of the European Union (“**GDPR**”) in the Spanish insurance sector.

### What’s new in the Code

- The Code regulates the operation of the following information systems (“**Information Systems**”): (i) the Motor Insurance Historical Information System (“**SIHSA**”); (ii) the Total Loss, Theft and Fire Automobile Information System (“**SIAPTRI**”); and (iii) the General Insurance Fraud Prevention Information System (“**SIPFSRD**”).
- The companies to which the Code is applicable have the following status in relation to the regulated Information Systems: (i) The insurance companies adhering to the Code **are jointly responsible for the processing**; (ii) Sistemas de Información a Tecnologías de la Información y Redes para las Entidades Aseguradoras, S.A. (“**TIREA**”) will be the **data processor**; (iii) UNESPA is the promoter of the Code.
- With regard to the obligations of the insurance entities adhering to the Code, they must:
  - Sign the “Co-responsibility Agreement” included as “Appendix I” of the Code, setting out the responsibilities of each co-responsible party.
  - Appoint a Data Protection Officer (“**DPO**”).
  - Adopt the necessary measures to ensure that its personnel are aware of the rules that affect the performance of their jobs, as well as the liabilities they may face in the event of non-compliance.
  - Comply with the principles of confidentiality and secrecy with respect to the personal data to which they have access as a result of the use of the Information System or Systems to which they have adhered, avoiding the disclosure or inappropriate use of such data.
  - Use the information they access only for the purposes described in the Code, as well as for the fulfilment of the obligations included in the Information Systems described in the Purpose of the Code.
- Follow the Security Guidelines that will be sent by the TIREA, in relation to the procedures for data communication and access to the Information Systems, including, for example, data encryption and knowledge of the roles/obligations of each user accessing data, among others.
- Earmark a budget line item for the maintenance and upkeep of the Control Body of the Code of Conduct.
- The Code includes a series of obligations to be fulfilled by the TIREA as data processor, among which the following stand out:
  - Process the data included in the Information Systems in strict accordance with the instructions contained in the service provision contracts signed with the insurance companies adhering to the Code.
  - Maintain the strictest confidentiality of the data stored, exchanged or obtained as a result of its processing.
  - Designate a DPO.
  - Use the data included in the Information Systems for the purposes provided by the Code.
  - Include security controls to prevent misuse of information by any entity.
  - In the event of a security breach, it will collaborate with UNESPA, with the Control Body of the Code of Conduct, as well as with the adhering insurance companies.
- Lastly, the Code establishes a voluntary and free-of-charge procedure for the out-of-court settlement of data protection disputes relating to the processing carried out in the Information Systems environment regulated therein. Accordingly, Interested Parties who consider that there has been a breach of data protection rules by the adhering insurance entities or the adopted Code may report these facts by filing a complaint with the Control Body of the Code of Conduct, which will lead to the initiation of this procedure.



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Knowledge Advisor

## Organic Law 7/2022, amending Organic Law 6/1985, of 1 July 1985, on the Judiciary (OLJ), in relation to Commercial Courts (OL 7/2022)

# Reform of the objective jurisdiction of the Courts and Tribunals in relation to intellectual property matters

On 28 July 2022, Organic Law 7/2022, of 27 July, amending Organic Law 6/1985, of 1 July, on the Judiciary, in relation to Commercial Courts (“**OL 7/2022**”) was published in the Official State Gazette (“**BOE**”), and entered into force twenty days later, on 17 August 2022, except for those amendments relating to appeals against decisions of the Spanish Patent and Trade Mark Office (“**SPTO**”) that conclude administrative proceedings, which will enter into force on 14 January 2023<sup>1</sup>.

In addition to the reforms introduced in other areas<sup>2</sup>, the published legislation includes the attribution of appeals brought against decisions that exhaust the SPTO’s administrative remedies in intellectual property matters to the specialised sections of the Courts of Appeal, thereby reforming Articles 74(1) and 82(2)(3rd) of the OLJ and Article 52(1) of the Spanish Civil Procedure Act.

As indicated in the Preamble to the legislation, this attribution of jurisdiction to specialised sections of the Courts of Appeal is based on their high degree of experience in intellectual property matters, as well as on the convenience of avoiding different jurisprudential criteria in this area, as until now two jurisdictions have had competence in matters of the validity of intellectual property rights: the contentious-administrative (when the corresponding administrative decision issued by the SPTO was appealed) and the civil (when an action for nullity was brought when the administrative decision was already final). The unification of jurisdiction in favour of the civil courts would therefore promote the principle of legal certainty.

The legislature wanted the new distribution of powers in the courts to coincide with the date of entry into force of the empowerment of the SPTO to declare the invalidity and revocation of the distinctive signs regulated in the Trade Marks Act, in the wording provided by the seventh final provision of Royal Decree-law 23/2018. Thus, as of 14 January 2023, the SPTO, an administrative body, will see its competences strengthened when hearing direct actions for the nullity and revocation of trade marks, while the courts of the contentious-administrative jurisdiction (High Courts of Justice and the Third Chamber of the Supreme Court) will lose their competences to review the legality of administrative acts granting or refusing intellectual property rights to the civil courts (Courts of Appeal and the First Chamber of the Supreme Court<sup>3</sup>).

This sort of new “civil appeal” against administrative decisions will be processed according to the rules of the oral proceedings under the Civil Procedure Act, although the new Article 447 of the Civil Procedure Act provides for special features for the initial phase of written pleadings that in reality seek to mimic the structure of the contentious-administrative procedure that has been followed until now before the High Courts of Justice (appeal, referral of the administrative file, formalisation of the claim, statement of defence).

With regard to the jurisdiction of the Commercial Courts in intellectual property matters, the legal reform of OL 7/2022 removes from the Trade Marks Act and finally incorporates in the OLJ the designation of “European Union Trade Mark Courts” and “European Union Trade Mark Tribunals” for the Commercial Courts, and the Section of the Court of Appeal of Alicante, respectively, which had been hearing actions brought under Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark and Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community designs.

Last but not least, OL 7/2022 has brought about the explicit recognition of the absorbing objective jurisdiction of the Commercial Courts in cases of joinder of actions and proceedings, pleas of nullity and counterclaims formulated with respect to related actions for which the Courts of First Instance still have jurisdiction, which until now was prohibited in Articles 73(1), 77(2) and 406(2) of the Civil Procedure Act.



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<sup>1</sup> According to the Fifth Final Provision.

<sup>2</sup> We recommend consulting the Legal Briefing: [Reform of the Spanish Organic Law on the Judiciary: jurisdiction \*ratione materiae\* of the Commercial Courts](#).

<sup>3</sup> On the other hand, the legal reform paves the way for the High Courts of Justice to hear appeals of procedural infringement against the judgments of the Courts of Appeal in this area, if the transitional regime of the 16th final provision of the Civil Procedure Act, which is responsible for the fact that until now it has been the Supreme Court that hears these appeals, ever ceases to apply.

## IPN/CNMC/024/22: Draft Bill for the Amendment of Law 17/2001, of 7 December, on Trade Marks, Law 20/2003 on Industrial Designs and Law 24/2015 on Patents

# The CNMC issues its opinion on the Draft Bill for the Amendment of Intellectual Property Laws

The National Commission on Markets and Competition (*Comisión Nacional de los Mercados y la Competencia*, “**CNMC**”) has issued its opinion<sup>1</sup> on the draft bill (“**DB**”) amending Law 17/2001, of 7 December, on Trade Marks; Law 20/2003, of 7 July, on the Legal Protection of Industrial Designs; and Law 24/2015, of 24 July, on Patents, promoted by the Ministry of Industry, Trade and Tourism. The report on the DB sets out the objectives of reforming the substantive intellectual property laws to adapt them to the current reality, simplifying certain concepts and procedures and providing greater clarity and legal certainty for users of the intellectual property system.

The CNMC has made the following observations in relation to the DB:

### 1. General observations

- (i) Firstly, it highlights the fact that systems for the protection of intellectual property rights must be balanced not only against the interests of right holders, but also against the negative effects of excessive protection.
- (ii) Secondly, the CNMC welcomes the joint reform of the laws on trade marks, patents and industrial designs, which, in the CNMC’s opinion, will make the system for protecting intellectual property rights more coherent.
- (iii) Finally, it expresses regret that the powers of non-exclusive licensees (in whatever form) to defend the protected right have not been extended, essentially maintaining the right holder’s powers as having priority over those of the licensee and slowing down the defence.

### 2. Main specific observations

- (i) The CNMC welcomes the reconsideration, within the Patents Act, of the obligation to have Patent and Trade Mark Agents (“**PTAs**”) to represent applicants from outside the European Economic Area, but criticises the fact that their involvement in certain translation services has been maintained and that the requirements for access to the profession have not been reconsidered.

- (ii) One of the most significant observations is the CNMC’s criticism of the utility model system in general, as it is granted without prior examination and generates monopolies for inventions with a lower degree of inventive step than that required for a patent (which is why its duration is limited to 10 years). In this regard, the CNMC recommends that if utility models are maintained, they should at least be subject to the prior examination regime (currently, substantive examination prior to the application is only carried out when there is third party opposition to the application, and as an additional guarantee, the DB provides that a prior art report (“**PAR**”) must be obtained in order to be able to exercise the utility model against infringers).
- (iii) The CNMC warns of the negative consequences that the extension of utility models to pharmaceutical substances and compositions could have. The CNMC considers that the application of utility models to pharmaceutical substances and compositions could increase the problems in the field of competition law in the pharmaceutical sector that could already arise with the use of the patent system.
- (iv) With regard to provisional patent applications, with a 12-month duration, the CNMC considers that, if the objective pursued is to provide controlled spaces in which to experiment with potential regulatory improvements, there are alternative methods, such as the application of a regulatory sandbox, where they could be properly tested. In the CNMC’s view, the introduction of this figure, in a first phase only applicable to public universities, public research centres and bodies, and registered technology centres, could undermine the principle of competitive neutrality, and it is therefore recommended that it be extended to all economic operators.
- (v) Finally, the CNMC recommends a better justification of the amounts of the fees and their cost orientation, as well as a review of the subjective scope of the discounts to avoid favouring operators depending on whether they are publicly or privately owned.



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<sup>1</sup> Report accessible via [cnmc.es/expedientes/ipncnmco2422](https://cnmc.es/expedientes/ipncnmco2422), published on 23 August 2022.

## Law 17/2022, of 5 September, amending Law 14/2011, of 1 June, on Science, Technology and Innovation

# The impact of the reform of the Science Law on the ownership and exploitation of intellectual property rights

On 7 September, Law 17/2022, of 5 September, which amends Law 14/2011, of 1 June, on Science, Technology and Innovation, entered into force. As stated in its preamble, this legal amendment seeks to undertake an institutional reform aimed at strengthening the capacities of the Spanish Science, Technology and Innovation System in order to improve its efficiency, coordination, governance and knowledge transfer.

In addition to various other new features (which are not the subject of this briefing), this new legal text includes a recasting and updating of the system of ownership and exploitation of intellectual and intellectual property rights in the public sector (Articles 35 to 38 of the Science Law).

Until now, this regime was dispersed across a patchwork of rules. The law we are now analysing expressly cites the Science Law itself, the Sustainable Economy Law (“LES”, Articles 53 to 56 of which have now been expressly repealed and have been subsumed into the Science Law to avoid duplication), and the Organic Law on Universities. But it fails to mention perhaps the most relevant laws, such as the Patents Act, and the now outdated Royal Decree 55/2002. These specifically and comprehensively regulate the system for acquiring and exploiting the rights to inventions resulting from research activity in the public sector, and are not expressly repealed by this regulation (although they should be understood to be implicitly repealed in everything that conflicts with them, interpretative conflicts cannot be ruled out, particularly with the Patents Act, concerning the determination of which is the *lex specialis*, which should prevail over the more general legislation in cases of conflict).

The main practical innovations that this legislation introduces are the following:

- (i) The current regulation includes the **Autonomous Communities**, in some cases on a mandatory basis and in others on a supplementary basis, filling any regulatory gaps that may exist.
- (ii) **Ownership** remains with the entity or institution of the researcher who has produced the result in the exercise of his or her functions, although some new features have been included<sup>1</sup>.

- (iii) In relation to **contracts for the promotion, management and transfer of research activity, the previous wording of Article 36 of the Science Law** already provided that they are governed by private law and subject to the principle of freedom of contract. Company contracts, collaboration contracts and contracts for R&D services and technical assistance may be awarded directly (except for situations where the provisions of the Public Sector Contracts Law apply). The new wording of this article adds option contracts (to explore business viability) and financing contracts to this list of private contracts, and establishes the supplementary nature of this regulation for agents who work for the Autonomous Communities or local administrations.
- (iv) Regarding the rest of the **transfers to third parties** of the rights over the results, which were partially covered by Article 36 of the Science Law and Article 55 of the Sustainable Economy Law, the new Article 36 bis of the Science Law continues to recognise the application of private law to these contracts (applying the legislation governing the assets of Public Administrations to resolve doubts and loopholes), although it introduces some further amendments<sup>2</sup>.



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<sup>1</sup> To read more about these new features, you can consult our Legal Briefing on the topic by clicking on the following [link](#).

<sup>2</sup> See the following [link](#).

## Executive Order on Enhancing Safeguards for United States Signals Intelligence Activities, as well as the accompanying Regulations

# Another step towards the long-awaited US-EU data protection adequacy decision

On 7 October 2022, the President of the United States signed the Executive Order on Enhancing Safeguards for United States Signals Intelligence Activities, as well as the accompanying Regulations (collectively, the “**Executive Order**”).

The Executive Order is the latest step towards a future adequacy decision on data protection between the European Commission and the United States. At this point, the European Commission will have to evaluate this Executive Order, propose a draft adequacy decision and initiate its adoption procedure.

The future adequacy decision will replace the previous “Privacy Shield” decision which was invalidated by the Court of Justice of the European Union in case C-311/18, the case known as “Schrems II”, in July 2020, for failing to provide adequate protection of the data protection rights of European citizens as a result of the possible widespread disclosure of personal data to US intelligence services or public authorities and as a result of the fact that the ombudsperson that had been established under the Privacy Shield to deal with complaints from European citizens lacked independence and authority to make decisions that were binding on US intelligence services in relation to data protection.

On 13 December, the Commission submitted its draft adequacy decision to the European Data Protection Board. As a next step, the Commission will seek the approval of a committee composed of representatives of the EU Member States.



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## Proposal for a Directive on the adaptation of civil liability rules for artificial intelligence

### Proposal for an AI Civil Liability Directive

The European Commission published the Proposal for a Directive on the adaptation of the civil liability rules for artificial intelligence (the “**Directive**”), with the intention of addressing the current legislative difficulties regarding liability claims for damage arising from products and services based on Artificial Intelligence (“**AI**”) due to the so-called black box effect, and completes the regulation that the European Commission is preparing for the new challenges posed by the spread of AI.

The proposal for a Directive also follows the Report on the safety and civil liability implications of artificial intelligence, the internet of things and robotics presented on 19 February 2020, according to which “these civil liability challenges must be addressed to ensure the same level of protection as for victims of traditional technologies, while maintaining a balance with the needs of technological innovation. This will help to build confidence in these new emerging digital technologies and create investment stability”.

In short, following Recommendation 2020/2014(INL) of the European Parliament, the Directive aims to harmonise the rules on non-contractual liability in AI in the internal market in order to avoid regulatory fragmentation of civil liability, guaranteeing the legitimate compensation of injured parties, reducing legal uncertainty for companies and preventing Member States from adopting different standards.

Concerning the scope of application of the Directive, the Proposal states that it will apply to non-contractual civil claims for damage caused by AI systems, provided that liability arises from negligent or wilful acts or omissions. Consequently, consistency is sought between the provisions of the Directive and other Community or domestic legislation on the civil liability of other agents such as intermediary service providers, as well as with the provisions of the Digital Services Regulations (Digital Services Act). The Directive also distinguishes between claims brought against (i) providers of high-risk AI, and (ii) natural or legal persons using such systems.

Thus, firstly, a system of proof for high-risk AI (i.e. AI in robot-assisted surgeries) will be created to allow for the substantiation of civil claims for damages, consistent with the risk system provided for in the Regulation establishing harmonised rules on Artificial Intelligence (“Artificial Intelligence Regulation”). Secondly, the rules on the burden of proof in civil non-contractual claims for damage caused by AI will be relaxed.

Regarding the provision of evidence, the Proposal provides that courts may order high-risk AI providers to hand over relevant and proportionate evidence about the system suspected of causing harm, as well as requiring the preservation of such evidence. It also provides that claimants may request the production of evidence from suppliers that have not been sued as long as a proportionate effort is shown in trying to obtain it from the defendant supplier.

In order to address the black box effect, Article 4 provides for the creation of a rebuttable presumption of causality between the breach and the result produced by the AI in those cases in which the defendant’s fault can be proven on the basis of other rules, either EU or national (e.g. the rules governing the operation of unmanned aircraft).

Ultimately, the Directive will establish for the first time subjective liability rules in matters of AI damage, taking into account the risk system of the AI Regulation, and ensuring a simplification of the burden of proof in matters of non-contractual AI damage.



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**Silvia Bardají**  
Lawyer

YEAR IN REVIEW 2022

# Judgments

**Image created by Stable Diffusion**

Prompt: A beautiful intricate 3 d abstract glass sculpture made of white pore fungi, morning glory flowers, boho floral vines, murano round colored glass vases, orange hibiscus flowers, top lit, octane render, soft lighting, ultra detailed, 8 k, trending in artstation, gallery piece by barbara hepworth



Judgment of the CJEU of 3 March 2022, in Case C-421/20, reference for a preliminary ruling from the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany)



**Lucía Temboury**  
Lawyer



**Inés Molina**  
Lawyer

## CJEU/EGC

# Law applicable to supplementary claims in an action for infringement of a Community design

This request for a preliminary ruling concerns the interpretation of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (“**Regulation No. 6/2002**”) and Article 8(2) of Regulation (EC) No 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations (“**Regulation No. 864/2007**”), in the context of proceedings between Acacia Srl (“**Acacia**”) and Bayerische Motoren Werke AG (“**BMW**”).

BMW lodged a claim against Acacia before a German court for the distribution in Germany of wheel rims which infringe a registered Community design. In its application, BMW sought that the infringement be brought to an end, as well as that the infringer be ordered to pay damages, to submit information, documents and accounts and to hand over the infringing products for destruction. The defendant objected on the grounds that the wheel rims were not infringing since they were covered by the transitional provision of Article 110 of Regulation No. 6/2002.

The infringement action was upheld at first instance and the German court (i) ordered that the distribution of the wheel rims be brought to an end, on the basis of Regulation No. 6/2002; and (ii) upheld the other claims not covered by Regulation No. 6/2002 (so-called “supplementary claims”), applying German law in accordance with Article 8(2) of Regulation No. 864/2007. Acacia appealed against that decision, denying the infringement and arguing that the law applicable to the supplementary claims should be Italian law.

The Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany) confirmed that the distribution of the wheel rims in Germany constituted an infringement on the basis of Regulation No. 6/2002. However, it considered that the applicable law in relation to the supplementary claims must be Italian law since the infringing products were delivered to Germany from Italy, and in Germany they were only sold and advertised online to consumers in that territory. Therefore, in accordance with the case law of the CJEU, it considered that the event giving rise to the damage was situated in Italy and not in Germany.

In this context, the Higher Regional Court asked the CJEU to interpret Articles 88(2) and 89(1)(d) of Regulation No. 6/2002 to determine the law applicable to supplementary claims in an action for infringement of a Community design.

The CJEU began its analysis by recalling that a Community design court hearing a case under Article 82(5) of Regulation No. 6/2002 has jurisdiction only in respect of infringements committed within the territory of the Member State in which that court is situated. In this case:

- (i) The infringement action brought in Germany sought that the distribution of the infringing products in that Member State be brought to an end, so, pursuant to Article 89(1)(d) of Regulation No. 6/2002, the law of that Member State applied for the purposes of examining the substance of that claim.
- (ii) In relation to claims for damages and for the submission of information, documents and accounts, Article 88(2) of Regulation No. 6/2002 provides that the law of the Member State to which the court belongs applies.

Both regulations state that, in so far as the law of the Member State in question includes rules of private international law, they are to form part of the applicable law. These rules include Regulation 864/2007, which provides in Article 8(2) that for any question not governed by the respective Community instrument (such as supplementary claims) the law applicable is the law of the country where the act of infringement was committed.

Given that the infringement action was brought pursuant to Article 82(5) of Regulation No. 6/2002 and thus related to acts committed or threatened within a single Member State, the CJEU concluded by confirming that it was for the courts hearing this action to examine the supplementary claims. Therefore, the applicable law was the law of the territory where the infringing acts were committed or were threatened.

Judgment of the CJEU of 23 March 2021, in Case C-183/21, reference for a preliminary ruling from the Landgericht Saarbrücken (Regional Court, Saarbrücken, Germany) in the proceedings between Maxxus Group GmbH & Co KG and Globus Holding GmbH & Co KG



**Lucía Temboury**  
Lawyer



**Joaquín Rovira**  
Lawyer

## CJEU/EGC

# The burden of proof of genuine use of a trade mark rests exclusively on the proprietor

The judgment of the CJEU aims to resolve the question referred for a preliminary ruling by the Landgericht Saarbrücken (Regional Court, Saarbrücken, Germany), concerning the possible application of national procedural rules in civil proceedings aimed at revoking a trade mark for non-use on the basis of Article 19 of Directive 2015/2436 to approximate the laws of the Member States relating to trade marks (hereinafter the “Directive”).

The dispute which gave rise to the question referred for a preliminary ruling arose from the application for revocation on grounds of non-use brought by the company Maxxus against the MAXUS word mark and figurative mark owned by the company Globus. Maxxus claimed that Globus had not made use of the marks over the past five years in a way that would ensure that its rights over the marks were maintained. Globus, for its part, disputed that claim and maintained that it had made genuine use of the marks at issue.

In that context, the German court pointed out that, according to national case law, it is for the applicant in an application for revocation for non-use to set out the facts that demonstrate that the trade mark has not been used. This is what German case law defines as the burden of setting out the facts. The burden of setting out the facts differs from the burden of proof in that each party must present submissions concerning the facts that are known to it or can be researched with reasonable effort.

Given that in the judgment of 22 October 2020, *Ferrari* (C-720/18 and C-721/18), the CJEU ruled that the burden of proof that a trade mark has been put to genuine use rests on the proprietor of that mark, the referring court asked the CJEU if Article 19 of Directive 2015/2436, relating to absence of genuine use as a ground for revocation, must be interpreted as precluding a procedural rule of a Member State which, in proceedings concerning an application for revocation of a trade mark for non-use, required the applicant to carry out market research concerning the possible use of that mark by its proprietor and to make in that regard, to the extent possible, substantiated submissions in support of its application.

Firstly, the CJEU pointed out that the question of who bears the burden of proof is not a procedural question, the competence of which lies with the Member States. Otherwise, the result would be that the protection of proprietors of EU trade marks would vary according to the law applicable in each case, which would run counter to the objective of harmonisation pursued by the Directive.

This being the case, the CJEU recalled that it is the trade mark proprietor who is best placed to access and provide evidence that its mark has been put to genuine use, so the decision that the burden of proof should fall on the trade mark proprietor rather than the applicant is a matter of common sense and procedural efficacy. It follows that Article 19 of the Directive ‘must be interpreted as meaning

that the burden of proof that a trade mark has been put to “genuine use”, within the meaning of that provision, rests on the proprietor of that mark’. This was already pointed out in the judgment of 22 October 2022, *Ferrari*, C-720/18 and C-721/18.

It is true that the fact that the applicant does not have to bear the burden of proof does not necessarily release that party from the obligation to provide a full statement of the facts upon which it bases its claims. However, Article 19 of the Directive introduces absence of genuine use by the proprietor as a ground for revocation, so, by the very nature of the claim, it does not seem necessary to place any greater burden on the applicant than that of alleging the absence of use of the mark.

The German procedural rule obliged the applicant to go beyond the mere obligation to set out the facts and even obliged it to prove that it carried out market research before the application was lodged and that it had been unable to establish that the trade mark at issue was put to genuine use. The CJEU considered that this requirement placed the burden of proof at least partially on the applicant, which would be contrary to the case law of the CJEU, according to which the burden of proof rests exclusively on the proprietor of that mark.

As for the rest, the CJEU considered that the risk of a proliferation of abusive applications for revocation was not sufficient reason to change this criterion. Furthermore, the CJEU pointed out that there are procedural means of combating such proliferation, such as ordering the applicant to pay the costs of the proceedings.

Nor did the CJEU consider that there was a risk that the applicants would take advantage of the revocation action to force the mark proprietor to disclose trade secrets, since proof of genuine use relates to acts on the market which, by definition, cannot constitute trade secrets.

In conclusion, the CJEU answered the question referred for a preliminary ruling by ruling that Article 19 of the Directive must be interpreted as precluding the procedural rules of the Member States which impose on the applicant, even partially, the burden of proving the absence of genuine use of the mark. Thus, as the judgment of 22 October 2022, *Ferrari* (C-720/18, C-721/18), has already made clear, the burden of proof of genuine use of a trade mark rests exclusively with its proprietor.

## Judgment of the CJEU of 24 March 2022, in Case C-433/20, between Austro-Mechana Gesellschaft zur Wahrnehmung mechanisch-musikalischer Urheberrechte Gesellschaft mbH and Strato AG



**Álvaro Lobo**  
Lawyer

### CJEU/EGC

## The private copying exception applies to the cloud storage of a copy of a protected work for private purposes

The dispute stems from the lawsuit brought by Austro-Mechana<sup>1</sup>, an Austrian collecting society entrusted with the management of fair compensation for private copying, against Strato AG (“**Strato**”), a German company providing a service known as “HiDrive”, by which it makes cloud computing storage space available to its users.

Austro-Mechana claimed from Strato the payment of the remuneration provided for in Article 42(b)(1) of the Austrian Law on Copyright<sup>2</sup> - which regulates the limit and fair remuneration for private copying under Article 5(2)(b) of Directive 2001/29 (“**DCIS**”)<sup>3</sup>- for providing cloud storage services, on the grounds that the term “made available” in the Austrian provision does not refer to physical distribution, but deliberately leaves scope to include any process which results in the provision of storage space to users for reproduction for personal or private use.

Following the dismissal of the action at first instance on the grounds that *Strato does not make storage media available to its customers, but provides them with an online storage service*<sup>4</sup>, the Higher Regional Court decided to stay the proceedings and to refer the case to the Court of Justice of the European Union (“**CJEU**”).

### Application of the private copying limit to the cloud computing service

First, the appellate court asked the CJEU whether the expression “on any medium” in Art. 5(2)(b) of the DCIS should be interpreted as covering the making, for private purposes, of copies of protected works on a server on which the provider of a cloud computing service makes storage space available to users.

To address this question, the CJEU started with a broad interpretation of the concept of reproduction<sup>5</sup>, clarifying that the uploading of a work to a cloud storage space by a user from a device implies a reproduction of that work within the meaning of the DCIS, with the saving of a copy also constituting a reproduction in that regard.

As regards the concept of “any medium”, the CJEU noted that, in its broad sense, it includes servers used in cloud computing services. Furthermore, Art. 5(2)(b) of the DCIS does not specify the characteristics of the devices by means of which private copies are made, so it is not decisive whether the storage space is made available to a user on a third party’s server. Moreover, unlike the limit for reproductions on paper, which applies to reproductions on paper or any similar media, the private copying limit applies to reproductions on any medium.

For all these reasons, the CJEU considered that it was not appropriate to establish a distinction in relation to the medium for the purposes of the application of Article 5(2)(b) of the DCIS, and cloud computing services should be included within the scope of this provision.

### Equitable remuneration arising from cloud computing storage services

Secondly, the appellate court asked the CJEU whether Article 5(2)(b) of the DCIS precluded a national law which transposed the private copying limit but did not make cloud computing service providers subject to the payment of fair remuneration for the unauthorised saving of copies of protected works by natural persons, for private use and for no direct or indirect commercial purpose.

The CJEU responded by clarifying that those Member States that have decided to regulate the private copying limit in their national law are obliged to provide for the payment of fair compensation to rightholders, this being an obligation to achieve a certain result, in that the State will only be obliged to ensure the effective recovery of such compensation by rightholders. As regards the persons liable for such compensation, it should be the persons who make the private copies; however, the CJEU considered that, because it would be technically difficult to pass on this compensation to them, it is lawful to charge this compensation to those who make the digital reproduction equipment, devices and media available, who will end up passing on the payment of the compensation to the final purchasers of these instruments.

As regards the form, detailed arrangements for collection and the amount of the compensation, these should be directly related to the harm caused to rightholders. Member States can therefore establish a system whereby fair remuneration is passed on in the price of devices that are a necessary part of the private copying process via cloud computing services, provided that such compensation reflects the harm caused to rightholders and is not excessive.

Therefore, the CJEU does not oppose the inclusion of private copies made through cloud computing services within the fair remuneration of the limit, leaving it to the national courts to establish that such remuneration does not exceed the potential harm suffered by rightholders.

<sup>1</sup> Austro-Mechana Gesellschaft zur Wahrnehmung mechanisch-musikalischer mbH.

<sup>2</sup> Urheberrechtsgesetz of 9 April 1936 (BGBl. 111/1936).

<sup>3</sup> Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society.

<sup>4</sup> Paragraph 11 of the Judgment.

<sup>5</sup> In accordance with: (i) Recital 21 of the DCIS, to ensure greater legal certainty in the internal market; (ii) Article 2 of the DCIS, which uses expressions such as “direct or indirect”, “temporary or permanent”, “by any means” and “in any form”; and, (iii) the main objective of the DCIS, which is to introduce a high level of protection, in particular for authors (paragraph 16 of the Judgment).

## Judgment of the CJEU of 5 April 2022, in Case C-140/20, between G.D. and Commissioner of An Garda Síochána, Minister for Communications, Energy and Natural Resources, Attorney General



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### CJEU/EGC

## The CJEU confirms that EU law precludes the generalised and indiscriminate retention of traffic and location data for the purposes of combating serious crime

The Irish Supreme Court referred for a preliminary ruling a question concerning the admissibility of evidence consisting of traffic and location data relating to telephone calls in criminal proceedings in which the defendant was sentenced to life imprisonment for murder. The Irish Supreme Court asked the CJEU for clarification of the requirements under EU law for the retention of traffic and location data relating to telephone calls for the purposes of combating serious crime and also sought clarification of the safeguards necessary for access to such data.

The CJEU reiterated that EU law precludes Member States from providing in their national legislation, as a preventive measure, for the generalised and indiscriminate retention of traffic and location data for the purposes of combating serious crime. It established that the retention of such data implies an exception to the principle of prohibition on storage enshrined in the Directive on privacy and electronic communications, as well as an interference with the fundamental rights to respect for private life and data protection. Although certain limitations to rights and obligations for the purpose of combating serious crime are foreseen in the Directive itself, the principle of proportionality must always be respected. In this regard, the CJEU considered that an objective of general interest cannot be pursued without taking into account the reconciliation between this objective and the fundamental rights that would be affected. It therefore considered that particularly serious crime (as was the case here, since it involved the offence of murdering a woman) cannot be likened to a genuine or foreseeable threat to national security.

The CJEU also recalled that it does not preclude the following national legislative measures which are put in place for the purpose of combating serious crime and preventing serious threats to public security: (i) targeted retention of traffic and location data according to the categories of persons concerned or using a geographic criterion; (ii) generalised and indiscriminate retention of IP addresses assigned to the source of a connection; (iii) generalised and indiscriminate retention of data relating to the civil identity of users of electronic means of communication; and (iv) expedited retention of traffic and location data held by electronic communications services providers.

On the other hand, the CJEU considered that the competent national authorities do not have the authority to access, for the purposes of combating serious crime, traffic and location data which has been retained in a generalised and indiscriminate manner in order to counter a serious threat to national security which is genuine and present or foreseeable, since access could be justified by an objective of lesser importance than the objective that justified the retention of the data, which would run counter to the hierarchy of public interest objectives on the basis of which the proportionality of the retention measure must be assessed.

The judgment also states that EU law precludes national legislation in which centralised processing of a request for access to data retained by providers of electronic communications services from the police in the context of an investigation, since the police are not a judicial body and do not have all the guarantees of independence and impartiality of an independent body.

Furthermore, EU law also precludes a national court from limiting the temporal effects of a declaration of invalidity which it is required to make, on the basis of the incompatibility of that rule with the Directive on privacy and electronic communications. However, the CJEU recalled that the admissibility of the evidence obtained is governed by the national law of each Member State, although the procedural principles must be respected, including the principles of equivalence and effectiveness.

## Judgment of the CJEU of 26 April 2022, in Case C-401/19, between the Republic of Poland and the European Parliament and the Council of the European Union

### CJEU/EGC

# The CJEU confirms the validity of Article 17(4) of the Copyright Directive and its compatibility with the right to freedom of expression and information

On 26 April 2022, the Court of Justice of the European Union (“**CJEU**”) delivered its long-awaited judgment in Case C-401-19, the Republic of Poland v the European Parliament and the Council of the European Union, confirming the validity of Article 17(4) of the Directive on Copyright and Related Rights in the Digital Single Market (“**DCDSM**”) in light of the right to freedom of expression and information recognised in the Charter of Fundamental Rights of the European Union (“**ECFR**”).

In the proceedings, the Republic of Poland requested the annulment of Article 17(4) point (b) and point (c) *in fine* of the DCDSM or, if it was not possible to sever these provisions from the rest of the article, the annulment of the article in its entirety. According to the Republic of Poland, in order to benefit from the safe harbour under Article 17 of the DCDSM and to be exempted from liability for providing access to protected works and subject matter, providers of online content sharing services (“**OCSPs**”) are obliged to preventively monitor the content uploaded by users on their platforms by means of content filtering tools which, without adequate safeguards, can lead to a limitation of the right to freedom of expression and information under Article 11 of the ECFR.

According to the DCDSM, OCSPs perform an act of communication to the public or making available to the public when they offer access to protected works or subject matter uploaded by their users<sup>1</sup>. In order to meet the safe harbour requirements of Article 17(4) of the DCDSM<sup>2</sup>, the CJEU recognised that the OCSPs are obliged to use automatic recognition and filtering tools, with such a measure being a restriction of a means of disseminating content and thus a limitation of Article 11 of the ECFR.

However, the CJEU recalled that Article 52 of the ECFR allows any limitation of rights and freedoms provided that: (i) it is provided for by law and respects the essence of the rights; and (ii) respects the principle of proportionality<sup>3</sup>.

With regard to Article 17 of the DCDSM, the CJEU reached the following conclusions:

- (i) Principle of legality: this is fully guaranteed by the imposition of the limitation in Article 17(4) of the DCDSM itself, although the specific measures to be implemented by the OCSPs are not determined and an obligation of result is established.
- (ii) Respect for the essence of fundamental rights: is also guaranteed, as Article 17(7) and (9) of the DCDSM prohibit the unavailability of works and other subject matter which do not infringe rights or which are covered by a limitation or exception.
- (iii) The interference is proportionate: for the CJEU, the interference with the right to freedom of expression and information has a purpose, namely the protection of intellectual property rights, and the measures in Article 17(4)(b) and (c) *in fine* are effective to achieve this purpose. Furthermore, the monitoring obligation and liability can only arise if the rightholder has provided the OCSP with the relevant and necessary information on the content, and the measures of Article 17 of the DCDSM cannot give rise to a general monitoring obligation<sup>4</sup>. Finally, subsection 9 sets out the obligation for OCSPs to have in place effective and expeditious complaint and redress mechanisms to reinforce the proportionality of the measures in subsection 4.

The CJEU therefore concluded that the interference with the right to freedom of expression and information derived from Article 17(4)(b) and (c) *in fine* of the DCDSM is accompanied by sufficient mechanisms to guarantee the appropriate balance of rights, thus respecting the provisions of Article 52 of the ECFR.

<sup>1</sup> The CJEU held that these providers are not covered by the safe harbour regulated in Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the internal market, for infringements of copyright and related rights, and that the special regime regulated in Article 17 of the DCDSM is applicable to the activity of the OCSPs.

<sup>2</sup> (i) have made best efforts to obtain an authorisation; (ii) have made best efforts, in accordance with high industry standards of professional diligence, to ensure the unavailability of specific works and other subject matter for which the rightholders have provided the service providers with the relevant and necessary information; and in any event, (iii) have acted expeditiously, upon receiving a sufficiently substantiated notice from the rightholders, to disable access to, or to remove from their websites, the notified works or other subject matter, and made best efforts to prevent their future uploads in accordance with point (b).

<sup>3</sup> The CJEU recalled that respect for the principle of proportionality requires that the limits of what is appropriate and necessary to meet the legitimate objectives pursued or the need to protect the rights and freedoms of others should not be exceeded, and that the least onerous means must be used, avoiding any disadvantages that are disproportionate to the fundamental right in question [paragraph 65], in accordance with the judgments of the CJEU of 13 March 2019, *Poland v Parliament and Council*, C-128/17, EU:C:2019:194, paragraph 94, and of 17 December 2020, *Centraal Israëlitisch Consistorie van België and Others*, C-336/19, EU:C:2020:1031, paragraph 64.

<sup>4</sup> Pursuant to Article 17(8) of the DCDSM and in line with the reasoning of the CJEU judgment of 3 October 2019, in Case C-18/18, *Glawischnig Piesczek*, [EU:C:2019:821, paragraphs 41 to 46] on Directive 2000/31, according to which the establishment of due diligence measures cannot entail an obligation on OCSPs to prevent content from being uploaded and made available to the public which would require them to make an independent assessment in light of the information provided by rightholders and any exceptions or limitations to intellectual property rights.



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Judgment of the CJEU of 28 April 2022, in Case C-44/21, reference for a preliminary ruling from the Landgericht München I (Regional Court, Munich I, Germany)



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## Precautionary protection of a patent whose validity has not been confirmed

The reference for a preliminary ruling concerned the interpretation of Article 9(1) of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (“**Directive 2004/48/EC**”) as regards provisional and protective measures in the context of a dispute between Phoenix Contact GmbH & Co. KG (“**Phoenix Contact**”), and HARTING Deutschland GmbH & Co. KG and Harting Electric GmbH & Co. KG (together, “**Harting**”).

Phoenix Contact holds a patent which was granted on 26 November 2020 by the European Patent Office (“**EPO**”), which published its grant in the European Patent Bulletin on 23 December 2020. On 15 January 2021, within the third-party opposition period, Harting filed an opposition against the patent.

In parallel, on 14 December 2020, Phoenix Contact filed an application for interim relief against Harting before the Regional Court, Munich I, seeking an injunction prohibiting the infringement of the patent in Germany.

In deciding on the application for interim measures, the Regional Court referred to the binding case law of the Munich Higher Regional Court, which provides that interim measures may only be ordered where the validity of the patent has previously been confirmed by a first instance decision in opposition or invalidity proceedings. Therefore, in accordance with this case law criterion, the application should not be upheld since it was filed prior to the filing of the opposition. However, the Regional Court’s preliminary view was that the patent was valid and was being infringed, and therefore, in order to avoid irreparable harm to the proprietor, it considered that it would be appropriate to grant the interim measures.

In this context, the Regional Court asked the CJEU for an interpretation of Article 9(1) of Directive 2004/48/EC and the possible incompatibility of German national case law with this provision. In order to analyse the question, the CJEU began by considering the following provisions:

- (i) Article 9(1) of Directive 2004/48/EC **obliges** Member States to provide, in their national law, for the possibility for national judicial authorities to grant interim measures to prevent any imminent infringement of an intellectual property right; and
- (ii) Recital 22 of Directive 2004/48/EC provides that interim measures must enable the infringement to be **immediately terminated**, without the need for a decision on the merits, precisely because of the purpose of these measures where the “time” factor is crucial.

The CJEU also recalled that filed European patents enjoy a presumption of validity from the date of publication of their grant, so as from that day, they enjoy the full scope of the protection guaranteed, in particular, by Directive 2004/48/EC.

Based on the foregoing, the CJEU considered that the national case law rendered Article 9(1) of Directive 2004/48/EC ineffective, as it required a prerequisite - the confirmation of the validity of the patent - which prevented the adoption of an interim measure when the national court had taken the preliminary view that the patent was valid and being infringed. Furthermore, the CJEU warned that accepting this requirement may lead to the initiation of strategic opposition proceedings in order to prevent the exercise of rightholders’ rights before the courts.

As a counterpart to the guarantee of rapid and effective provisional measures, Directive 2004/48/EC provides in Article 9(5) to (7) for a number of legal instruments to be offered by national courts as safeguards for the defendant in order to mitigate the risk that they will be prejudiced by the provisional measures.

As regards the binding nature of national case law, the CJEU recalled that, although the Directive must be applied “without prejudice to” the means provided for in national legislation, this will only be the case where those means are more favourable for rightholders (Article 2(1) of Directive 2004/48/EC). Moreover, in this case, German law did not contain any provision making the interim protection of a patent subject to confirmation of validity in prior proceedings, so it was up to the national courts to change the case law if it was based on an interpretation that was incompatible (and less favourable) with the provisions of a directive.

The CJEU therefore concluded by confirming that the German national case law was incompatible with the terms of Article 9 of Directive 2004/48/EC.

## Judgment of the CJEU of 2 June 2022, in Case C 112/21, between X BV and CLASSIC Coach Company vof, Y, Z



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### CJEU/EGC

## The right to prohibit the use of the later trade mark is not necessary to establish the existence of an earlier right

The CJEU judgment addressed an interesting question raised by the Supreme Court of the Netherlands about the requirements for determining the existence of an “earlier right” for the purposes of Article 6(2) of the Trade Marks Directive 2008/95 (the “**Directive**”).

The main proceedings concerned a conflict between a number of identical or similar trade names, all recognised under national law, one of which was subsequently registered as a trade mark by the claimant. At first instance, the infringement claim was upheld, but the Court of Appeal in The Hague ultimately set aside the judgment and dismissed the claim on the grounds that, although the claimant did have earlier rights under national law, their right to prohibit the use of the trade name was time-barred by acquiescence.

In response to the rejection, the applicant appealed to the Supreme Court of the Netherlands, which expressed doubts regarding when an “earlier right” within the meaning of Article 6(2) of the Directive was admissible. In order to recognise such an earlier right, was it necessary that the trade mark proprietor may be prohibited from using the trade mark?

In this context, the Supreme Court of the Netherlands decided to stay the proceedings and to ask the CJEU whether Article 6(2) of the Directive must be interpreted as meaning that, in order to establish the existence of an earlier right, for the purposes of this provision, it is necessary that the proprietor of that right is able to prohibit the proprietor of the later trade mark from using it.

The CJEU pointed out that, apart from the relative requirements which follow from the wording of Article 6(2) of the Directive, namely (i) use of the right in the course of trade, (ii) the priority of that right, (iii) its applicability in a particular locality and (iv) recognition of the right by the laws of the Member State concerned, that provision did not in any way provide that, in order to be able to enforce that right against the proprietor of a later trade mark, the third party must be able to prohibit the use of that trade mark.

Furthermore, the CJEU added that it cannot be inferred that the European legislature intended to limit the scope of application of Article 6(2) of the Directive to earlier rights which enable their proprietor to prohibit the use of the subsequent trade mark. Such a condition would, in the view of the CJEU, deprive that provision of all practical effect, since it would treat the conditions for the application of that provision in the same way as the conditions for the application of the further grounds for refusal or invalidity of trade marks provided for in Article 4(4) of the Directive.

In conclusion, the CJEU held that Article 6(2) of the Directive must be interpreted as meaning that, when establishing the existence of an earlier right, for the purposes of this provision, it is not necessary that the proprietor of that right is able to prohibit the proprietor of the later trade mark from using it.

## Judgment of the CJEU (Grand Chamber) of 21 June 2022, in Case C-817/19, between the *Ligue des droits humains* and the Belgian Council of Ministers



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### CJEU/EGC

## The PNR Directive in light of the Charter of Fundamental Rights of the European Union: the processing of air passengers' personal data

On 21 June 2022, the Court of Justice of the European Union (“**CJEU**”) ruled in the case of *Ligue des droits humains* and the Belgian Council of Ministers on the conformity of Directive 2016/681 on the use of passenger name record (PNR) data for the prevention, detection, investigation and prosecution of terrorist offences and serious crime (the “PNR Directive”) with the Charter of Fundamental Rights of the European Union (the “**Charter**”).

In this regard, given the questions referred for a preliminary ruling by the Belgian Constitutional Court, the judgment assessed the validity of the PNR Directive and, in particular, the introduction of the system for the collection, transfer and generalised processing of airline reservation data, in light of the fundamental right to free movement of persons, respect for private and family life (Article 7 of the Charter), the fundamental right to the protection of personal data (Article 8 of the Charter), and, among others, the principle of proportionality with regard to the limitation of fundamental rights (Article 52(1) of the Charter).

The PNR Directive was adopted in 2016 with the aim of creating a European legal framework for the collection and processing of passengers' personal data on flights to and from a third country for the purpose of preventing terrorism. In accordance with the provisions of the PNR Directive, Member States must designate a competent authority to act as a Passenger Information Unit (“**PIU**”) to which PNR data will be submitted for assessment. In addition, Member States should impose an obligation on airlines to electronically transfer passengers' personal data in order to prevent, detect, investigate and prosecute serious crime.

The Grand Chamber recalled that any act of the European Union must, as far as possible, be interpreted in such a way as not to call into question its validity in the context of Union law and, in particular, that of the Charter. It recognised the interference of the PNR Directive with the fundamental right to respect for private and family life, as well as with the right to the protection of personal data enshrined in the Charter, as the PNR Directive “seeks to introduce a surveillance regime that is continuous, untargeted and systematic, including the automated assessment of the personal data of everyone using air transport services”. However, it argues that such interference would be justified in the general interest and in the fight against serious crime in the common area.

The Court argued that the PNR Directive interprets the limitation of rights restrictively and is in line with the principle of minimisation in the GDPR, by providing that the transfer, processing and retention of data are limited to what is strictly necessary to combat serious crime and terrorist offences which have an objective (at least indirect) link with the carriage of passengers by air.

Moreover, given that the PNR Directive provides for the possibility of Member States unilaterally choosing to apply the PNR Directive to all (or part) of flights within the European Union, the Grand Chamber reiterated that this should be limited to what is strictly necessary and subject to judicial review (or review by an administrative body whose decisions have a binding effect). That is, Member States must establish the objective existence of actual, present or foreseeable terrorist threats and may only impose such measures for a limited period of time and restricted to what is absolutely necessary.

Furthermore, the Court clarified that the PIU may only carry out a more detailed examination of the data of certain persons by means of automated processing in cases where they are to be compared exclusively with databases relating to persons under alert or being sought. It stressed the need for these databases to be non-discriminatory and to be used exclusively by the competent authorities in the fight against serious crime and terrorism. Any further automated processing of the data is prohibited, in order to prevent “false positives”, and in defence of the principle of non-discrimination.

Finally, it is recognised that the general retention period for PNR data should be a maximum of six months, after which retention would not be limited to what is strictly necessary. It may only be retained for a longer period in cases where a link to or risk of serious crime or terrorism can be established.

## Judgment of the CJEU of 14 July 2022, in Case C-159/20, between the European Commission and the Kingdom of Denmark



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### CJEU/EGC

## The obligation to protect PDOs even for products intended for export

Regulation (EU) No 1151/2012 of 21 November 2012 on quality schemes for agricultural products and foodstuffs (the “**Regulation**”) has very clear objectives in introducing PDOs and PGIs: to help producers of agricultural products and foodstuffs to inform consumers about the characteristics and qualities of their products, thereby ensuring fair competition for producers whose products have value-added characteristics and attributes, consumer accessibility to reliable information, respect for intellectual property rights and the integrity of the internal market.

It is these objectives that largely contributed to the CJEU judgment of 14 July 2022, in which the Kingdom of Denmark was found to have failed to stop the use of the PDO “Feta” for cheeses produced in Denmark and exported to third countries.

The facts at the root of these proceedings were the Danish State’s failure to act following repeated notifications by Greece of infringing conduct on its territory in respect of the PDO “Feta”. Following two letters from the European Commission that the Kingdom of Denmark opposed, the Commission decided to bring an action before the CJEU.

There was no disagreement between the parties on the most relevant facts, as Denmark neither denied its inactivity nor denied the conduct of the Danish companies. The action was therefore focused entirely on a discordant interpretative analysis of the Regulation.

The first complaint in the action was that the Kingdom of Denmark was in breach of Article 13(3) of the Regulation by failing to take measures to prevent or stop the unlawful use of the PDO “Feta” in its territory. The Kingdom of Denmark defended itself by arguing that such an obligation only applied when the products were intended to be marketed and consumed in the internal market, but not when they were intended to be exported to a third country.

However, the CJEU did not accept the Kingdom of Denmark’s argument and concluded that the obligations under Article 13(3) of the Regulation apply not only to products manufactured and marketed within the Member State concerned, but also to those manufactured in that Member State. The conjunction “or” used in the Regulation when referring to any illegal use of PDOs and PGIs “produced or marketed” was clearly indicative of the fact that further marketing on the internal market is not necessary for the protection to apply.

The CJEU also noted that the unlawful use of the PDO “Feta” undermined two of the objectives pursued by the Regulation, namely to protect producers of agricultural products who have made real efforts in terms of quality, ensuring fair remuneration, and to guarantee respect for intellectual property rights. The CJEU considered that the acts committed by the Danish companies undermined both objectives and, therefore, by failing to put an end to such conduct, the Kingdom of Denmark infringed the obligation under Article 13(3) of the Regulation.

On the other hand, the CJEU found that the Kingdom of Denmark did not infringe the principle of legal cooperation. Although it considered that the facts described weakened the EU’s position, they related to the same conduct, which was already subject to sanctions. Therefore, by virtue of the principle non bis in idem, this second complaint was rejected.

With this decision, the CJEU adopted an extensive interpretation of the protection conferred by Article 13 of the Regulation, considering that the latter obliges Member States to take appropriate administrative and judicial measures to prevent or stop any unlawful use of PDOs and PGIs in their territory, even when these products are manufactured for the purpose of being exported to third countries.

Judgment of the CJEU of 8 September 2022, in Case C-263/21, between the *Asociación Multisectorial de Empresas de la Electrónica, las Tecnologías de la Información y la Comunicación, de las Telecomunicaciones y de los Contenidos Digitales* (AMETIC) and *Ventanilla Única Digital*, the State Administration and various collective management organisations (EGEDA, ADEPI, AIE, AISGE, DAMA, CEDRO, AGEDI and SGAE)



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## CJEU/EGC

## The legitimacy of joint bodies for the collection of the amounts due for private copying

This recent ruling by the CJEU brings greater legal certainty to the already consolidated Spanish private copying system. Specifically, it refers to two specific aspects: the absence of bodies outside the collective management organisations within *Ventanilla Única Digital*, as well as the possibility that both this body and the collective management organisations may request certain commercial data from the persons obliged to pay compensation for private copying.

AMETIC, which had brought the main proceedings in Spain, is an association of manufacturers, traders and distributors in the information and communications technology sector whose activity includes trade in reproduction equipment, devices and media subject to compensation for private copying. By means of the appeal filed before the Supreme Court, AMETIC essentially requested the annulment of certain provisions of Royal Decree 1398/2018 of 23 November, which implements Article 25 of the consolidated text of the Law on Intellectual Property, approved by Royal Legislative Decree 1/1996, of 12 April, with respect to the system of fair compensation for private copying. In this regard, purchases of reproduction equipment, devices and media made by natural or legal persons acting as final consumers and who can prove that the equipment, devices or media purchased are exclusively for professional use, provided that they have not in law or in fact been made available to private users and that they are clearly reserved for uses other than private copying, are exempted from the payment of compensation for private copying. This must be certified by a certificate issued by the corresponding body, such as *Ventanilla Única Digital*. However, the persons concerned who do not hold such a certificate must bear the burden of compensation for private copying at the time of purchase. However, if they can prove the exclusively professional use of the reproduction equipment, devices or media purchased, and provided that they have not been made available to private users and that they are clearly reserved for uses other than the making of private copies, they may apply to the *Ventanilla Única Digital* for reimbursement of the compensation they have previously paid.

The Supreme Court questioned whether *Ventanilla Única Digital*, as a body created exclusively by the collective management organisations for the collection of compensation for private copying, and issuer of such certificates, could generate “imbalance or asymmetry” in the system by violating the principle of equality before the law, due to its extraordinary powers.

In this regard, the CJEU considered that the establishment of a legal entity, such as *Ventanilla Única Digital*, for the purposes of managing exemptions from payment and reimbursement of private copying charges, may meet the objective of simplicity and efficiency, from which debtors also benefit, which the CJEU held was not undermined by the fact that the body was made up of collective management organisations. It also examined more specific issues such as the process for issuing exemption certificates and the deadlines provided in the Royal Decree, and concluded that they were in line with European standards. It concluded, in short, that it is not contrary to European law for a body made up of collective management organisations to be responsible for the collection of private copying charges.

Furthermore, it noted that, in the context of a system which relies on unilateral declarations by operators to determine both the amounts due in respect of private copying charges and the sales to be exempted, authorising the entity responsible for the management of such charges (*Ventanilla Única Digital*) to check the veracity of the declarations in question is a necessary condition for ensuring the effective collection of such compensation. This means that *Ventanilla Única Digital* has the power to request certain accounting documents without this being considered a violation of the secrecy of company accounts.

## Judgment of the CJEU of 8 September 2022, in Case C-716/20, between RTL Television GmbH and Grupo Pestana S.G.P.S. SA and SALVOR - Sociedade de Investimento Hoteleiro, SA

### CJEU/EGC

## On the right to authorise or prohibit cable distribution by broadcasters

The case, which pitted the German broadcaster RTL, one of the leading German-speaking audio-visual groups, against a group of Portuguese hotels, revives the debate on the interpretation of the long-standing Council Directive 93/83/EEC of 27 September 1993 on the coordination of certain rules concerning copyright and rights related to copyright applicable to satellite broadcasting and cable retransmission, which was born out of the (then) nascent satellite and cable market, now in force but overtaken by a different market landscape.

The hotel group Grupo Pestana had refused to pay a fee to the RTL group for making RTL-owned channels available to the public in the rooms of its establishments. RTL considered that it had the right to authorise or refuse the reception and making available of its channels' broadcasts, but the Portuguese courts held that no such retransmission took place since hotels are not broadcasters, as required by the wording of the Directive. In effect, Article 8 provides that "Member States shall ensure that when programmes from other Member States are retransmitted by cable in their territory the applicable copyright and related rights are observed and that such retransmission takes place on the basis of individual or collective contractual agreements between copyright owners, holders of related rights and cable operators". In this context, the issue was the applicability of the Directive and the Portuguese law arising from it to the dispute between RTL and Grupo Pestana, as the latter would not be a broadcasting entity and would therefore fall outside the objective scope of the Directive. Consequently, RTL would not be entitled to charge any licence fee.

The judgment noted, in a purely teleological interpretation, that the purpose of the Directive was to promote contractual agreements between rightholders and specifically cable operators, but not to establish an exclusive right as such (authorise-prohibit) and that, moreover, it had no intention of extending any legal concept. It also noted that, according to the Rome Convention, "broadcasting organisation" status is required for retransmission to exist.

The abovementioned provision must therefore be understood literally, and hotels cannot be considered to fall within the definition of a "cable operator", an activity which, in any event, is merely ancillary. Furthermore, it noted that, under the Directive, retransmissions are understood to be simultaneous, unaltered and unabridged, excluding those that are deferred, altered or incomplete, but also those which take place within a single Member State.

The conclusions reached by the judgment are therefore twofold. Firstly, the Directive does not establish any exclusive right in favour of broadcasters to authorise or prohibit cable retransmission. Secondly, the simultaneous, unaltered and unabridged retransmission of television or radio broadcasts transmitted by satellite and intended for reception by the public does not constitute cable retransmission where such retransmission is made by a person other than a cable operator such as a hotel.



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## Judgment of the EGC of 16 September 2022, in Case T-604/18, between Google LLC and Alphabet vs. the European Commission



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**Jorge Masía**  
Counsel

## Dominance and portfolio revenue sharing arrangements

On 14 September 2022, the General Court of the European Union issued its judgment in Case T-604/18, which saw Google LLC and Alphabet, Inc. pitted against the European Commission in relation to the action brought by the applicants against the European Commission under Article 263 of the TFEU, seeking the annulment of Decision C(2018) 4761 final of 18 July 2018 relating to the opening of proceedings under Article 102 of the TFEU and Article 54 of the EEA Agreement (AT.40099 - Google Android) and, in the alternative, the cancellation or reduction of the fine imposed on them in that decision.

In its decision, the Commission penalised Google for having imposed restrictions that it sought to protect and strengthen: (i) its dominant position in the area of general search services, and (ii) the revenues obtained from the advertisements associated with those services. Thus, the abuse materialised through the use of anti-competitive contractual practices against mobile device manufacturers and mobile network operators, such as restrictions relating to: (i) distribution agreements, which oblige mobile device manufacturers to pre-install the general search (Google Search) and browser (Chrome) applications in order for Google to grant them a licence to operate its app shop (Play Store); (ii) anti-fragmentation agreements, which make the obtaining of the operating licences necessary for the pre-installation of the Google Search and Play Store apps by mobile device manufacturers conditional on the latter's commitment to refrain from selling devices equipped with versions of the Android operating system not authorised by Google; and (iii) revenue-sharing agreements, which make the payment of a share of Google's advertising revenues to the mobile device manufacturers and mobile network operators concerned conditional on their commitment to refrain from pre-installing a competing general search service on a pre-determined portfolio of devices.

The Decision, which established the Commission's finding of a single and continuous infringement of Article 102 of the TFEU and Article 54 of the EEA, was partially annulled by the General Court insofar as the portfolio revenue sharing arrangements constituted an abuse, since:

- for the assessment of the single pre-installation condition included in the portfolio revenue sharing arrangements, the Commission considered that the arrangements covered a significant part of the national markets for general search services, irrespective of the type of device used, without this finding being corroborated by the elements provided by the Commission in the Decision;

- the Commission's reasoning in relation to the assessment of essential variables of the so-called "Equally Efficient Competitor" or "EEC" test applied by the Commission, namely: (i) the estimate of the costs attributable to the competitor; (ii) the assessment of its ability to achieve pre-installation of its application; and (iii) the estimate of the revenue that could be earned based on the age of mobile devices in circulation, was flawed, as there was no corroboration of a finding of abuse resulting per se from the portfolio revenue sharing arrangements; and
- Google's right to be heard was breached by the failure to issue an additional Statement of Objections followed by a hearing to allow Google to present its arguments in relation to the inadequacies of the EEC test.

Consequently, the General Court largely upheld the Commission's decision, finding that Google had imposed unlawful restrictions on Android mobile device manufacturers and mobile network operators, quashing the abusive nature of the portfolio revenue sharing agreements and setting the largest fine imposed in Europe by a competition authority at €4.12 billion.

Judgment of the CJEU of 20 September 2022, in joined cases C-793/19 and C-794/19, between Bundesrepublik Deutschland, SpaceNet AG and Telekom Deutschland GmbH



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## CJEU/EGC

## Union law precludes the generalised and undifferentiated retention of traffic and location data, except in the case of an actual or foreseeable serious threat to national security

SpaceNet and Telekom Deutschland are Internet service providers in Germany and, in addition, Telekom Deutschland provides telephony services. The German Telecommunications Law imposes the obligation to retain telecommunications traffic and location data of its customers, as well as the generalised and undifferentiated retention of traffic and location data of end-users for several weeks for the purpose of prosecution of criminal offences and the prevention of a specific risk to national security. Consequently, SpaceNet and Telekom Deutschland challenged this obligation imposed on them by the German Telecommunications Law in court.

In this regard, the Federal Administrative Court referred the question of whether EU law conflicts with national law for a preliminary ruling, on the grounds that the obligation to retain data provided for in German law refers to a smaller amount of data and a shorter retention period than that provided for in other precedents decided by the CJEU on similar issues.

The CJEU held that EU law precludes the generalised and undifferentiated retention of traffic and location data for the purposes of combating serious crime and the prevention of serious threats to public security on a preventive basis.

However, the CJEU does allow an instruction to electronic communications service providers to carry out data retention in situations where the Member State in question is faced with a serious threat to national security that is “genuine and present or foreseeable”. Such instruction must be reviewed either by a court or by an independent administrative body. In this regard and provided that it is ensured that the retention of data is subject to compliance with the relevant material and procedural elements, as well as guarantees for data subjects against abuse and for the protection of national security, providers of electronic communications services may be required to carry out a general and indiscriminate retention of traffic and location data in cases where the Member State concerned faces a serious threat to its national security. However, this data retention may only be issued for a limited period of time and to the extent strictly necessary.

Nor does the CJEU oppose legislation which, on the basis of the above grounds, requires the selective storage of traffic data and location data, as well as, for the same purposes, the general and indiscriminate storage of IP addresses attributed to the origin of a connection, for a period limited to what is strictly necessary, and of data relating to the civil identity of users of electronic communications media. In addition, also in pursuit of the same aims, the CJEU allows national legislation that makes use of an instruction to providers of electronic communications services to ensure the rapid retention of traffic and location data held by them for a specified period of time.

The CJEU held that the set of traffic and location data retained for ten to four weeks made it possible to draw precise conclusions about the private life of the data subjects whose data was retained and to establish a profile of those persons. In relation to the safeguards aimed at protecting the retained data against the risks of misuse and unlawful access, the CJEU held that the retention of and access to this data constituted interferences with the fundamental rights of the data subjects which required a different justification.

## Judgment of the CJEU of 13 October 2022, in Case C-256/21, between KP and TV and Gemeinde Bodman-Ludwigshafen



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### CJEU/EGC

## Jurisdiction to rule on a counterclaim for EU trade mark invalidity after the main action has been withdrawn

The nature of the counterclaim has always been debated, as it is an effective defensive tool, but at the same time, it entails the creation of an autonomous claim that is independent of the original claim. This legal instrument is of particular interest and usefulness in the area of intellectual property, which has led to special attention being paid to it in regulations such as Law 17/2001 on trade marks and Law 24/2015 on patents. This is not just a national phenomenon, as the same is true at a European level with Regulation 2017/1001 of 14 June 2017 on the European Union trade mark.

One of the specific features of the counterclaim is that, although as a general rule, a national court cannot annul acts performed by EU bodies, those that have been designated as EU trade mark courts have the capacity to annul a registration made by EUIPO. Regulation 2017/1001 recognises in Article 124 the exclusive jurisdiction of the EU trade mark courts to decide actions for infringement of an EU trade mark and for counterclaims for revocation or trade mark invalidity. As a result of this regulation, the Higher Regional Court, Munich, found itself doubting its own jurisdiction after receiving an appeal lodged by the municipality of Bodman-Ludwigshafen.

The claimant had brought an infringement action before the Munich Regional Court against a German company and the municipality of Bodman-Ludwigshafen, and the latter responded to the action by filing a counterclaim seeking the invalidity of the claimant's trade mark registration. However, during the hearing, the claimant withdrew its trade mark infringement action and the defendants maintained their counterclaims, so the actions proceeded and resulted in a declaration of partial invalidity of the claimant's trade mark.

On appeal against the judgment of first instance, the Higher Regional Court, Munich, expressed doubts as to whether it could still retain jurisdiction as an EU trade mark court to hear the trade mark invalidity action brought by way of counterclaim where the claimant had already withdrawn the infringement action.

Therefore, the Court put the following question to the CJEU "Must Article 124(d) and Article 128 of Regulation 2017/1001 be interpreted as meaning that the EU trade mark court has jurisdiction to rule on the invalidity of an EU trade mark asserted by a counterclaim within the meaning of Article 128 of Regulation 2017/1001 even after the action for infringement based on that EU trade mark for the purposes of Article 124(a) [of that regulation] has been validly withdrawn?"

To answer this question, the CJEU held that it was first necessary to clarify the meaning and scope to be attributed to the concept of 'counterclaim'.

Firstly, in the absence of a definition of the concept of 'counterclaim' in the Regulation, the CJEU considered that the usual meaning given to this concept, as the Advocate General pointed out and as is clear from the different language versions of the Regulation, is that of a claim brought by the defendant in proceedings brought against him by the claimant.

Secondly, the CJEU also noted that, as is clear from European case law on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, a counterclaim must not be confused with a mere defence. Although it is filed in proceedings initiated through another legal channel, it is a distinct and autonomous claim, the procedural treatment of which is independent of the main claim and which can thus be substantiated even if the claims of the main claimant are withdrawn.

Finally, the Court interpreted the rule in a purposeful manner, considering that the case law of the CJEU states that the purpose of the counterclaim is to allow the parties to resolve, in the same proceedings and before the same judge, all their reciprocal claims that have a common origin, and thus avoid a multiplication of superfluous proceedings, which entails a risk of contradictory judgments. Therefore, in the view of the CJEU, forcing a new procedure to be initiated before the EUIPO in the event of withdrawal by the applicant would be contrary to that objective.

On the basis of the above arguments, the CJEU answered the question posed by stating that the EU trade mark court remains competent to decide on a counterclaim for invalidity even if the claimant withdraws from the main action.

This judgment further strengthens the autonomous nature of the counterclaim.

## Judgment of the CJEU of 20 October 2022, in Case C 77/21, between Digi Távközlési és Szolgáltató Kft. and Nemzeti Adatvédelmi és Információszabadság Hatóság



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### CJEU/EGC

## On the principle of limiting the retention period for personal data stored in a database created for the purpose of testing and error correction

The Court of Justice of the European Union (“**CJEU**”) issued this judgment on 20 October 2022 in Case C-77/21 from the General Court of the Hungarian Capital. The referral for a preliminary ruling was made in proceedings between Digi Távközlési és Szolgáltató Kft. (“**Digi**”), and the Hungarian National Authority for Data Protection and Freedom of Information (“**National Authority**”), regarding a breach of security of personal data stored in a Digi database.

### Main Dispute

Digi, one of the leading providers of internet and TV services in Hungary, experienced a technical failure in early 2018 that affected the operation of a server. To remedy the flaw, it created a test database, into which it copied the personal data of a third of its customers, for the purpose of testing and error correction.

Subsequently, on 23 September 2019, Digi became aware that an ethical hacker had gained access to the personal data of over 300,000 individuals whose data was stored in the Test Database. On 25 September 2019, after having deleted the Test Database, Digi informed the National Authority of the security breach, which then opened an investigation.

In its decision of 18 May 2020, the National Authority found that Digi had infringed Article 5(1)(b) and (e) of the GDPR, relating to the principles of *purpose limitation and limitation of the retention period*, as it had failed to delete the Test Database immediately after the necessary tests had been carried out and the fault had been corrected, thus retaining the Test Database for longer than necessary without any legitimate purpose, and retaining such data without any purpose, for 18 months. The National Authority imposed a fine of approximately EUR 248,000. This decision was challenged by Digi and in that case, the questions referred for a preliminary ruling, which are the subject of the present commentary, were raised.

In this context, the Fővárosi Törvényszék (Budapest High Court), the court with the jurisdiction to hear Digi’s appeal against the decision of the National Authority, referred the following questions for a preliminary ruling:

- (i) Is the concept of *purpose limitation* to be interpreted as meaning that it is consistent with that concept for the controller to store personal data which was collected and stored for a limited legitimate purpose simultaneously in another database?

- (ii) Is the fact that personal data which was collected and stored for a limited legitimate purpose may be retained by the controller simultaneously in another database compatible with the principle of the *limitation of the retention period*?

Regarding the first question, it was not disputed that Digi, as the controller, initially collected personal data for the purpose of concluding and performing subscription contracts with its private customers. In this respect, the correction of errors affecting the subscriber database specifically related to the execution of subscriber contracts for individual customers, insofar as such errors may be detrimental to the provision of the contractually intended service for which the data was originally collected.

In light of the above, the CJEU stated that Article 5(1)(b) of the GDPR must be interpreted as meaning that the *purpose limitation* principle does not preclude the controller from recording and retaining, in a database created for testing and error correction purposes, personal data previously collected and retained in another database, provided that the further processing is compatible with the specific purposes for which the personal data was originally collected.

Regarding the second question, the CJEU noted that the *principle of limitation of the retention period* requires the controller to be able to demonstrate, by virtue of the principle of *proactive accountability*, that personal data is retained only for the time necessary for the purposes for which it was collected or for which it has been further processed. In this regard, the CJEU concluded that Article 5(1)(e) of the GDPR must be interpreted as meaning that the principle of *limitation of the retention period* precludes the controller from retaining, in a database created for testing and error correction purposes, personal data previously collected for other purposes, for a longer period than is necessary for the testing and correction of the errors.

## Judgment of the CJEU dated 17 November 2022, in Case C-224/20, between Merck Sharp & Dohme and others



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## Requirements for the repackaging of medicinal products subject to parallel imports

This ruling by the CJEU follows twelve legal claims heard by the Danish Maritime and Commercial Court. In these claims, manufacturers of medicinal products and proprietors of trade marks were pitted against companies involved in the importation of medicines into Denmark.

Manufacturers complained that the original packaging of medicines was replaced without any real need to do so. This would run counter to good practice on parallel importation of medicines, which sets strict requirements on when such substitution of packaging is permissible, and always gives preference to less intrusive behaviour, such as re-labelling and replacement of internal leaflets.

On the other hand, the parallel importers argued that the replacement of the packaging was the only way to comply with the Falsified Medicines Directive since the replacement of the leaflets involves the opening of the packaging, which is evidenced by the anti-tampering device and makes it impossible to effectively market the product. This position is supported by the Danish Medicines Agency guidelines, which allow the replacement of the original packaging without the need for further justification.

As a result, the Danish court referred a number of questions for a preliminary ruling, which in essence related to the following doubts:

- If repackaging in new packaging is objectively necessary, where it is not possible for the parallel importer to affix additional labelling and reseal the original packaging, without the packaging of the medicinal products showing visible signs that the original anti-tampering device has been tampered with.
- Whether a Member State is entitled to establish guidelines according to which repackaging in a new outer packaging must be carried out and, only in exceptional cases, the reuse of the original packaging and the fitting of a new security device is permitted.

The CJEU departed from the interpretation proposed by the importers, noting that Directive 2001/83 expressly provides for the replacement of anti-tampering measures by equally effective measures. Therefore, these measures must be able to verify that the outer packaging has not been opened since repackaging. The CJEU also stated that the existence of signs of previous opening does not undermine the effectiveness of the replacement measures where those signs are clearly attributable

to the repackaging process. Therefore, the said directive would not go so far as to amend the case law of the Court established by the CJEU in Case C-143/00 *Boehringer Ingelheim and Others* (23 April 2002). And as a consequence, re-labelling of the product together with the inclusion of a new anti-tampering measure will still be preferable to the use of new outer packaging. Thus, the trade mark proprietor will still be able to oppose the marketing of a medicinal product packaged in new packaging where, despite the opening marks, the outer packaging could be reused.

Next, after interpreting the measures introduced by Directive 2001/83, the CJEU had to decide whether Directive 2001/83 authorises Member States to impose repackaging in new packaging as a general rule. In this regard, the Court rejected the idea that Member States have the power to establish additional rules to those contained in the directive, as these could constitute an obstacle to the free movement of medicinal products within the Union. The Court thus found that the guidelines issued by the Danish Medicines Agency could not be regarded as conforming with EU law.

This declaration eliminates the possibility for a parallel importer to justify the use of packaging other than the original packaging on the grounds of the need to comply with national regulations. The CJEU judgment of 26 April 2007 in *Boehringer Ingelheim and others*, C-348/04 established that the requirement of necessity is fulfilled when it relates to a regulation of the country of importation which prevents the marketing of a medicinal product in its original packaging. However, necessity cannot be considered to be justified where the legislation in question infringes Union law.

With this ruling, the CJEU restores the *status quo* with regard to the repackaging requirements for parallel imported medicinal products. In doing so, it defends the free movement of medicinal products against possible shortcomings that could be caused by a lax interpretation of the Falsified Medicines Directive.

## Judgment of the CJEU (Grand Chamber) of 8 December 2022, in Case C-460/20, between TU, RE and Google LLC



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## Search engines should remove links to inaccurate information

Two individuals filed proceedings against Google LLC requesting, firstly, the removal of links to articles published by a third party in which they were identified, as, in their opinion, they contained defamatory information based on false facts; and, secondly, that photographs accompanying one of those articles in the form of thumbnail images no longer be displayed.

The Federal Court of Justice referred two questions for a preliminary ruling. The first of these arose in relation to the specific nature of the function of search engines and the conflict that this generates with the fundamental rights provided for in the Charter of Fundamental Rights of the European Union, in a case in which the interested party denied the veracity of the data and in which it was requested that the links to content with allegedly false information be removed. The second of the questions referred for a preliminary ruling concerned the need to take into account the content of the web page on which the thumbnail images of the results of an image search were inserted in order to examine a request for their removal.

Advocate General Pitruzzella considered that the operator of the search engine could not be obliged to carry out a general check of the content hosted on the search engine, nor could it be obliged to check that the content is true. However, the Advocate General considered that content containing false personal data should be removed, although a link should not be removed on the basis of a unilateral request by the data subject, and ruled out the possibility of requiring the data subject to contact the editor of the website in order for the editor to remove the content.

In this regard, the CJEU also ruled that search engine operators must remove links to the information contained in the indexed content when the applicant for such removal proves that it is manifestly inaccurate and that such proof must not result from a judicial decision against the editor of the web page.

Also consistent with what was previously established by the Advocate General, the CJEU held that the right to data protection is not an absolute right, but must be weighed against other fundamental rights, in accordance with the principle of proportionality. In this regard, the right to erasure under the GDPR would be ineffective when the processing of such data is necessary to exercise the right to freedom of information. The CJEU held that the rights to inform and to be informed may not be taken into consideration where some of the information contained in the indexed content is found to be inaccurate.

The proof that some of the information contained in the indexed content is inaccurate must be provided by the applicant for the removal of links, but the CJEU considered that only reasonable means of proof can be required of the applicant, so that, in principle, he or she will not be obliged to produce a previous court decision against the publisher of the website.

For its part, the search engine must comply with the applicant's request on the basis of all the rights and interests, as well as the circumstances of the specific case and, if the request is not justified, the search engine must not comply with the request without a court decision.

Regarding the images displayed in the search engine as previews, the CJEU stated that, if the photos of the data subject appear in a search by name, this may constitute a greater interference with the data subject's rights to protection of privacy and personal data and that a differentiated balancing of the conflicting rights and interests must be carried out, and the CJEU considered that their informative value must be taken into account without regard to the context of their publication on the website from which they are taken.

## Judgment of the SC, of 15 February 2022, Appeal No. 7359/2020, Decision No. 188/2022

### Supreme Court

## Data protection security measures, obligations of means or of results?

The Spanish Data Protection Agency, in a resolution of 27 November 2018, imposed an administrative sanction of €40,001.00 on a company engaged in the purchase and sale of mobile devices because the financing applications for telephone products contained emails that did not correspond to those of the applicants, thereby allowing unauthorised third parties to access 14 financing applications with customers' personal data. In particular, their names and surnames were accessed, as well as financial data, direct debit details and signatures.

The company was sanctioned on the basis of Article 9(1) of the now repealed Organic Law 15/1999, of 13 December, on the Protection of Personal Data (using the Spanish acronym, "**LOPD**"). This provision imposed the obligation on data controllers to adopt "the necessary technical and organisational measures to guarantee the security of personal data and prevent its alteration, loss, processing or unauthorised access", taking into account the state of technology and the nature and risk of the data.

The judgment sought to clarify whether this obligation, now present in Article 32 of General Data Protection Regulation (EU) 2016/679 ("**GDPR**"), is an obligation of means or an obligation of result, where security measures are implemented by employees of a legal person. That is, in the case of an obligation of result, controllers should ensure that security measures are effectively implemented to ensure that no personal data processed by them ever reaches unauthorised third parties, is lost or misplaced.

The National High Court ruled in favour of considering this obligation as one of result. In turn, based on Recital 74 of the GDPR, the State Attorney defended this position, since those entities that carry out business activities involving personal data would be assuming the risk that their processing is contrary to the regulation, and therefore they would have to bear the consequences when the results are detrimental to the data subjects.

The appellant submitted that the obligation to adopt technical and organisational security measures is an obligation of means, without it being possible to assess strict liability or liability without fault in the case. Otherwise, any security breach would automatically amount to a liability under data protection law on the part of the controller, regardless of the measures implemented.

The Supreme Court established that it cannot be considered to be an obligation of result understood as that "commitment consisting of the fulfilment of a certain objective, ensuring the proposed achievement or result", regardless of the measures adopted and deployed. Thus, it was held to be an obligation of "diligence" or "behaviour", obliging the controller to "exercise diligence in its implementation and use", always aiming at the achievement of a result.

For practical purposes, the mere design and planning of security measures would be considered insufficient, but their implementation would also be necessary. Thus, companies would be liable for the lack of reasonable care in implementing and enforcing the measures.

The Supreme Court dismissed the appeal, considering that in the case in question there were security measures in place that would have prevented the leakage of personal data to unauthorised third parties and that these were not effectively applied. Therefore, the Court concluded that the obligation of Article 9(1) of the LOPD was breached by keeping the files without the proper security conditions.



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Data and privacy

## Judgment of the SC, of 30 March 2022, Appeal No. 1288/2020, Decision No. 285/202.2

### Supreme Court

# Appeal for the unification of doctrine analysing the validity of video surveillance evidence as evidence to justify dismissal

It was not disputed that, in the present case, the applicant worked for the company in the cafeteria and catering service and was dismissed for having committed various thefts. The company installed fixed cameras in selected retail outlets to try to reduce and prevent the problem of retail shrinkage. The recording was continuous and aimed at measuring the quality of the product, the service and the control of the cash register procedure in sales. Workers' representatives were informed of the changes in the location of these cameras, as well as of the installation of new cameras. It is also important to note that the complainant was not informed of the recording of his image in the course of his work or of the use of his image for disciplinary purposes. The recordings were random, and there were signs on the premises informing staff of their existence.

The judgment under appeal held that it was not proven that the company had suspicions or indications of the existence of conduct by any employee that would have led to the installation of video surveillance systems, as it was proven that the video surveillance activity was continuous, with random checks being carried out, which would have required adequate information that was not produced.

The Supreme Court (“**SC**”) noted the reiterated doctrine that has been applied regarding this issue<sup>1</sup>. This doctrine, applied to the present case, led the SC to reach the following conclusions:

- (i) The processing of the employee's personal data as a result of video surveillance did not require the consent under Article 6 of Organic Law 15/1999, of 13 December, on the Protection of Personal Data<sup>2</sup> (“**LOPD**”), as it was a measure aimed at controlling the fulfilment of the employment relationship. It was only necessary to comply with the duty to inform.
- (ii) In the case in question, the cameras were marked with informative signs so that both workers and customers were aware of their presence, and the workers' legal representatives (using the Spanish acronym, “**RLT**”) had been informed of this means of surveillance. The installation of the video surveillance cameras was justified for security reasons, in a broad sense, i.e. to prevent theft, in a measure that can be described as necessary, due to the lack of other less intrusive means, as well as proportionate to the aims pursued, the data obtained having been used for the purpose of workplace monitoring. Thus, it was a measure which satisfied the requirements of proportionality applicable to this type of means of control of labour activity and the limitation of the fundamental rights at stake was therefore justified.

In such circumstances, it is worth mentioning the ruling of the CC, No. 160/2021, of 4 October 2021 (Appeal No. 3884/2017), in which it declared that it does not violate the right to the protection of personal data (Article 18(4) of the Spanish Constitution) to use known and consented recordings, even if the commitment not to use them as a disciplinary mechanism is breached.

The CC considered that it did not violate the right to the protection of personal data (Article 18(4) of the Spanish Constitution) for the company to use the sound recordings of business advisors, known and consented to by them, in breach of the commitment made with the RLT not to use them as a disciplinary mechanism. This is because the recordings were initially used for quality of service purposes, which is what the company committed itself to with the workers' representatives. Thus, the CC considered that the right to data protection had not been violated, and that the question of the possibility of sanctioning the worker for his persistence in not following the company's instructions was a matter for the judicial bodies, outside the content of Article 18(4) of the Spanish Constitution.

In view of the above considerations, and in conclusion, our jurisprudence has permitted, from the perspective of the right to data protection (Article 18(4) of the Spanish Constitution), the use of video surveillance cameras in two cases:

- (i) For monitoring employees, even if the employee is not informed that the recordings will be used for disciplinary purposes.
- (ii) For quality of service purposes, even if there is a commitment not to use them for disciplinary purposes, if the employee is warned about his or her conduct and persists with a recalcitrant attitude.

<sup>1</sup> This doctrine emanates from the Constitutional Court (“**CC**”) (STC 39/2016, 3 March 2016, RTC 2016,39).

<sup>2</sup> In the case at issue in the judgment, the dismissal took place on 9 May 2018, prior to the entry into force of Organic Law 3/2018, of 5 December, on the Protection of Personal Data and Guarantee of Digital Rights, while the LOPD was in force.



**Álvaro Arbolea**  
Lawyer

## Judgment of the SC, of 20 April 2022, Appeal No. 4415/2018, Decision No. 320/2022



**Joaquín Rovira**  
Lawyer



**Carlos Miró León**  
Legal advisor

### Supreme Court

## The use of other people's trade marks as a keyword in the Google search engine

The creation of new forms of advertising via the Internet has opened the door to new legal conflicts relating to the protection of intellectual property rights. One such dispute is addressed in the SCJ of 20 April 2022. Is it lawful to use someone else's trade mark as a keyword in Google AdWords to reference a website?

The case in question arose from a trade mark infringement action brought by Grupo Ilusión de Ortodoncistas, S.L. against Laboratorio Lucas Nicolas, S.L., the former franchisor of the Vital Dent network of clinics. The defendant was found to have registered search terms identical to the claimant's trade mark "Clínicas Ortodoncis" in Google AdWords to promote its website [www.clinicasvitaldent.info](http://www.clinicasvitaldent.info). This resulted in the defendant's website appearing in a Google search under those terms, which also offered services identical to those covered by the claimant's trade mark registration.

In the first and second instances, trade mark infringement was declared for the use of the trade mark "Clínicas Ortodoncis" in the Google AdWords referencing service. In response to both decisions, the defendant brought an extraordinary appeal for breach of procedure and an appeal before the Supreme Court.

Regarding the appeal, the first ground of appeal stated that the judgment under appeal had infringed the case law doctrine established by SCJs 105/2016 and 94/2017, which applied the doctrine established in the CJEU judgment of 22 September 2011 (C-323/09), and in which "the use by a third party of the name of a registered trade mark in the keywords in the Google AdWords search advertising service is admissible since the distinctive sign of the trade mark is not used in that act but only the name, and this involves an attenuated distinctiveness whose use cannot be prohibited without infringing free competition".

To resolve this question, the SC referred to the judgments of the CJEU of 23 March 2010, the Google France Case (joined cases C-236/08 to C-238/08) and the *Interflora* Case (C-323/09) of 22 September 2011, where two requirements were provided: (i) that the product or service is identical to that provided by the trade mark proprietor; and (ii) that the advertising displayed through the use of the keyword does not enable the average internet user to determine whether the product or service is offered by the trade mark proprietor, or whether, on the contrary, it comes from a third party.

In the present case, both requirements were met. Firstly, both parties offered the same services. And, secondly, the SC also noted that the use of the trade mark registered in Google AdWords to refer to its services was sufficiently confusing, even though the defendant's website did not display the trade mark "Clínicas Ortodoncis".

The second plea alleged the infringement of Article 43(5) of the Trade Mark Act by awarding compensation for trade mark infringement in the amount of 1% of the defendant's total turnover instead of setting the compensation at 1% of the sales obtained through the use of the applicant's trade mark.

The second question was resolved by the SC using the criterion established in SCJ 516/2019, of 3 October. It confirmed that Article 43(5) of the Trade Mark Act entitled the applicant to claim 1% of the turnover obtained using the services associated with the infringed trade mark without the need to quantify the damage suffered. This rule addresses the evidentiary difficulty in proving which services actually provided correspond to the infringement. This does not deprive the compensation of subjectivity, as higher compensation can be claimed if greater damage can be proven. Similarly, an infringement that could not cause harm would not merit compensation. Therefore, the SC upheld the appeal judgment and set the damages at 1% of the total turnover of all the services unlawfully trademarked, i.e. all those that were advertised through infringement of the claimant's trade mark.

This judgment reaffirms the already established case law of the CJEU, according to which the proprietor of a trade mark may prohibit an advertiser from using its registered trade mark as a keyword in Google AdWords if such use impairs one of the functions of the trade mark, without it being necessary for the other party's trade mark to appear on the web page.

## Judgment of the SC, of 2 June 2022, Appeal No. 4192/2021, Decision No. 546/2022



**Álvaro Lobo**  
Lawyer

### Supreme Court

## The broadcasting of football matches in establishments without authorisation is an offence against the market, but not against intellectual property

The judgment of the Supreme Court (“**SC**”), Criminal Division, of 2 June 2022 relates to a complaint filed by the National Professional Football League (“**LaLiga**”) against the owner of several public establishments in Valencia for the unauthorised broadcasting of football matches whose rights were held exclusively by La Liga.

Court of Preliminary Investigation No. 11 of Valencia found the owner guilty of a minor offence relating to the market and consumers of a continuous nature, with the mitigating circumstance of repairing the damage (having deposited a sum of money as compensation for the damage caused) and ordered him to pay a fine and the corresponding civil liability compensation to LaLiga for the damage caused.

An appeal was lodged against that judgment by the Public Prosecutor’s Office, which was joined by LaLiga. The Valencia Court of Appeal issued a judgment on 7 June 2021, which dismissed the appeal and upheld the decision of the lower court in its entirety. Subsequently, the Public Prosecutor’s Office (again joined by LaLiga) lodged an appeal before the SC for infringement of the law, under Article 849(1) of the Criminal Procedure Act, for improper failure to apply Article 270(1) and 270(4)(1) of the Criminal Code (“**CC**”). The appellants argued that the facts in question should have been considered under those provisions as football matches are protectable performances under Royal Legislative Decree 1/1996, of 12 April, approving the Consolidated Text of the Law on Intellectual Property (using the Spanish acronym, “**TRLPI**”).

In its judgment, the SC did not question the classification of the football matches or audiovisual recordings as services under the TRLPI. The Court held that the central issue was whether the conduct in question was to be sanctioned under Article 270(1) of the CC.

This provision penalises anyone who *with the intention of obtaining a direct or indirect economic benefit and to the detriment of a third party, reproduces, plagiarises, distributes, publicly communicates or in any other way economically exploits, in whole or in part, a literary, artistic or scientific work or performance.*

According to the SC, in the case in question, the question to be determined was whether the broadcasting of a football match fell, for the purposes of the aforementioned provision, within the scope of “literary, artistic or scientific work or performance”. In further elaborating on the issue, the SC stated that: *football, of course, is not literature. Nor is it science. It is true that in a football match, there may be some moments of undeniable aesthetic value, but to interpret these moments or sequences of technical perfection as defining features of an artistic spectacle may lead to transgressing the limits of the principle of typicality. A football match is a sporting spectacle, not an artistic one [...] in the quest for victory, actions take place that are significantly distanced from any canon of artistic beauty, no matter which one subscribes to.*

Therefore, the SC dismissed the classification of football matches as “literary, artistic or scientific works or performances”. The SC added that if it had been the legislature’s intention to include football matches within the scope of Article 270(1) of the CC, it would have been sufficient to add the qualifier “sporting” to the term “literary, artistic or scientific performances” in order to avoid doubts and not to breach the requirements of the principle of legality. Moreover, citizens should not be subjected to such interpretative exercises in relation to a criminal penalty. Such exercises would require them to consider legislative history and parliamentary interventions. Rather, this is a task for the legislature at the time of drafting the provision, which must take into account all relevant elements.

Based on the foregoing, the SC rejected the appellants’ grounds for appeal, upholding the judgment of first instance and appeal and the conviction of the facts prosecuted as an offence against the market and consumers under Article 286(4) of the CC.

## Judgment of the SC, of 5 July 2022, Appeal No. 2066/2019, Decision No. 528/2022



**Rais Amils**  
Partner



**Lucía Temboury**  
Lawyer

## Supreme Court

### Invalidity of Spanish figurative marks for university-related services (1/2)

The Universidad de La Rioja issued proceedings before Alicante Commercial Court No. 2 against Proeduca Summa S.L. and the Universidad Internacional de la Rioja S.A. in which it sought, inter alia, (i) a declaration that it had a preferential and exclusive right over the distinctive signs “Universidad de La Rioja” and “Unirioja”, derived from the registrations of Community figurative trade mark No. 5.231.873 “UR Universidad de La Rioja U.R.” and word mark No. 8.594.624 “UNIRIOJA”, of which the applicant was the owner, (ii) a declaration that national trade marks M3052025(8) “Unir Universidad Internacional de La Rioja”, M3078203 “Unir La Universidad en Internet” and M3504313 “Unir La Universidad Online” were invalid, and (iii) a declaration that the defendants had infringed its trade mark rights, causing it damage for which it should receive compensation.

In the first instance, in a judgment of 21 June 2018, Alicante Commercial Court No. 2 partially upheld the claim and, among other findings, declared (i) the defendants’ trade marks to be invalid on the grounds of relative invalidity as set out in the claim with respect to the claimant’s trade mark rights; and (ii) that the defendants had infringed those trade mark rights, for which it ordered them to pay damages, to be determined upon enforcement of the judgment.

That decision was appealed and in a judgment of 19 February 2019, the 8th Section of the Alicante Court of Appeal, European Union Trade Mark Court, overturned it and dismissed the claim brought against the defendants. The Court of Appeal noted that the defendants’ trade marks whose invalidity was sought were derived from the word mark “UNIR”, No. 2.842.811, registered by the defendants prior to the claimant’s trade mark “UNIRIOJA”, and that it had not been proven that the trade mark “UNIR” had been applied for in bad faith. Furthermore, the Court considered that the defendants’ marks were not caught by the relative prohibition in respect of the word mark “UNIRIOJA” as there was no likelihood of confusion since the relevant audience would not consider that the defendants’ goods would have the same trade origin as those of the applicant. Although the sign used by the co-defendants was aimed at the same Spanish audience, they used it without concealing the fact that they were dealing with a different university, the Universidad Internacional de la Rioja. The Court concluded that the introduction of the word “international” made an important difference. This meant that there was no confusion on the part of the public.

The claimant, the University of La Rioja, brought an extraordinary appeal for breach of procedure and a cassation appeal before the Civil Division of the Supreme Court.

The extraordinary appeal for breach of procedure was based on an arbitrary or illogical assessment of the evidence regarding whether the registration of the marks was carried out in bad faith. However, the Supreme Court dismissed it on the grounds that the appellant was not challenging the

assessment of the evidence used to determine the facts, on which the legal assessment was based, but, rather, was challenging the legal assessment, a challenge that should have been made, if appropriate, through a cassation appeal.

The first ground of cassation appeal analysed by the Supreme Court in the judgment was based on the fact that the appeal judgment had infringed Article 51(1)(b) of the Trade Marks Act, relating to distinctive character and the case law interpreting it, in that in order to assess whether the trade marks were applied for in bad faith, it was necessary to assess the circumstances at the time of the application and, specifically, it should have been taken into account that the defendants knew at that time that the claimant was using an identical or similar sign for an identical or similar product that could give rise to confusion with those whose registration they were applying for. That ground was also rejected on the basis that the Court of First Instance, in ruling on the bad faith of the registration of the marks at issue, did take into account the circumstances existing at the time of the application. In that regard, the Supreme Court pointed to the fact that the dominant element of those marks was the name “UNIR” (a trade mark that had been applied for even before the trade mark “UNIRIOJA” relied on by the claimant and against which the claimant did not file any opposition or request its invalidity within five years of its registration). Moreover, the name “UNIR” already appeared in the 2008 Law that approved the creation of the Universidad Internacional de la Rioja and the Decree that authorised the commencement of its university activities. Furthermore, at the time the marks at issue were applied for, there had been peaceful coexistence from the outset between the defendants’ sign “UNIR” and the applicant’s sign “UNIRIOJA”.

Among the grounds of cassation appeal submitted by the claimant, it was also alleged that the Court of Appeal, in concluding that there was no likelihood of confusion between the marks at issue and the claimant’s trade mark “UNIRIOJA”, had breached the provisions of Article 9 of the Community Trade Mark Regulation and Article 52(1) of the Trade Marks Act, as well as the case law which had interpreted them. In that regard, the applicant based its grounds of appeal on the final judgment of the General Court of 1 December 2016 (T-561/15), confirmed by order of the Court of Justice of 1 June 2017 (C-50/17), under which the mixed Community trade mark similar to the Spanish trade mark 3.052.025 “Unir Universidad Internacional de La Rioja” at issue was refused on the ground that there was a likelihood of confusion with the applicant’s priority trade mark “UNIRIOJA”.

These grounds of appeal were also rejected by the Supreme Court on the following grounds: (i) firstly, and as noted above, the defendants’ trade marks derived from the word mark “UNIR”, which predated the trade mark “UNIRIOJA” and would have been used in peaceful coexistence with the defendants’ trade marks, a sign that there would be no likelihood of confusion between them; (ii)

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**Rais Amils**  
Partner



**Lucía Temboury**  
Lawyer

## Supreme Court

### Invalidity of Spanish figurative marks for university-related services (2/2)

secondly, although there would be a certain visual similarity, derived from the identity of the first four letters (U-N-I-R), which were identical in both names (UNIRIOJA and UNIR), there would be hardly any phonetic similarity and the sound perception would be different; and (iii) thirdly, given the relevance of the overall assessment of the conflicting signs, it was noted that in Spain the average consumer of goods relating to university education services is used to the fact that in the same geographical area there may be several universities that include in their names a reference to a specific geographical area, and that it is another element of the name that distinguishes one university centre from another. All this led the Supreme Court to conclude that the limited similarity between the signs would not be enough to give rise to a likelihood of confusion, since it would be difficult for the average consumer to think that the goods and services associated with either sign had the same business origin or came from related undertakings.

Finally, the Supreme Court noted that its conclusion would not contradict the position of the General Court of the European Union in the aforementioned final decision, since in the present case, the appeal judgment declared the peaceful coexistence of the word marks “UNIR” and “UNIRIOJA” to be proven, which would demonstrate the lack of likelihood of confusion, a fact that was not assessed by the General Court. Furthermore, in the present case, the relevant audience of the three Spanish trade marks at issue owned by the defendants would essentially be Spanish, for whom, partly because of that peaceful coexistence, the overall assessment of those signs would not give rise to confusion in relation to the applicant’s trade mark “UNIRIOJA”.

## Judgment of the SC, of 19 July 2022, Appeal No. 2394/2021, Decision No. 1032/2022



**Inés Molina**  
Lawyer



**Lucía Temboury**  
Lawyer

## Supreme Court

### The suffix “.es” and its registration as a trade mark

The German company “L&L Auto Info GMBH” (“**L&L**”) brought an administrative appeal against the decision of the Spanish Patent and Trade Mark Office (“**SPTO**”) refusing registration of the trade mark “VENDERCOCHE.ES” for goods in Class 12 and for certain services in Classes 35 and 36 of the International Nomenclature.

This appeal was upheld by the Administrative Chamber of the High Court of Justice of Madrid, in its judgment of 29 January 2021, which granted the trade mark. The State Attorney appealed against that judgment on the ground of infringement of Article 5(1)(b), (c) and (g) of Law 17/2001 of 7 December 2001 on Trade Marks (the “**Trade Marks Act**”).

In particular, the appellant submitted that the trade mark was caught by an absolute prohibition under Article 5(1)(b) and (c) of the Trade Marks Act, since the suffix “.es” has a specific legal configuration as a top-level domain name which is recognised by the public as an internet address with Spanish origin and therefore lacked distinctive character unrelated to its meaning. Similarly, the appellant argued that if the goods or services offered were not of Spanish origin, the trade mark would be caught by the absolute prohibition in section g) of the same provision, as it would mislead the public as to the nature, quality or geographical origin of the goods or service.

Therefore, it concluded that the inclusion of the word “.es” in a generic and descriptive name did not endow the sign with sufficient distinctive character to enable it to be registered as a trade mark and requested that the judgment under appeal be set aside and the decision of the SPTO refusing registration of the trade mark be upheld.

L&L opposed the appeal on the following grounds:

- (i) Firstly, it submitted that the trade mark consisted of a mixed sign with a sufficiently distinctive graphic element, and furthermore, identified goods and services not related to telecommunications. Therefore, under the principle of speciality, the graphic element was relevant and distinctive.
- (ii) Secondly, it argued that the sign had the minimum degree of uniqueness and distinctiveness required by the legislation for it to be eligible for registration, meaning that the refusal of registration on the basis of the absolute prohibition in Article 5(1)(c) of the Trade Marks Act did not apply in this case, since the elements of the mixed sign requested had to be taken into account for the specific goods and services refused.

The question was therefore whether the absolute prohibition provided for in Article 5(1)(c) of the Trade Marks Act applied, and, specifically, whether the addition of the suffix “.es” to a generic name with no specific meaning could give it sufficient identifying force.

Contrary to the opinion of the High Court of Justice of Madrid, which granted the trade mark on finding that the suffix “.es” has identifying force when incorporated into a generic word combination, the Supreme Court (“**SC**”) considered that adding this suffix to certain words does not give them any identifying force, given that the suffix “.es” constitutes a country domain corresponding to Spain which: (i) may be used by any person or entity on the Internet; (ii) does not grant a preferential right to obtain or use it, under the Sixth Additional Provision of Law 34/2002, of 11 July, on information society services and electronic commerce; and (iii) does not grant exclusive rights with respect to other trade marks.

In this regard, the SC referred to case law precedents in this area which have held that the “.es” element constitutes a common addition to the name of web pages of Spanish origin, and is therefore linked to the geographical origin of a domain, without giving distinctive force to the name that accompanies it. Similarly, it mentioned the case law of the European courts, which state that the existence of a right over a domain name does not mean that it can be registered as a trade mark, precisely because it lacks distinctive and identifying force.

Regarding the identifying power of the graphic element incorporated in the applicant’s trade mark, the SC concluded that it did not constitute a relevant differentiating element necessary to avoid the application of the absolute prohibitions of Article 5(1) of the Trade Marks Act, since they did not confer distinctive force on the trade mark and also made explicit reference to the refused goods and services.

Consequently, the SC upheld the appeal and thus confirmed the contested decision of the SPTO.

Judgment of the SC, of 26 October 2022, Appeal No. 2913/2019, Decision No. 714/2022



**Andy Ramos Gil de la Haza**  
Partner

## Supreme Court

### Secondary liability for intellectual property

Despite its potential, Article 138(2) of the Intellectual Property Act (“**IPA**”) has been applied in a very limited manner by the judiciary. In fact, the introduction of theories of secondary liability from English-speaking jurisdictions (*vicarious liability and contributory infringement*) was, in my opinion, one of the main new features of Law 21/2014, which went almost unnoticed at the time.

This provision allows actions for infringement of intellectual property rights to be brought, not against the person who directly exploits a work or other subject matter without authorisation, but against the person who: (i) knowingly induces the infringing conduct; (ii) cooperates with the infringing conduct, knowing of the infringing conduct or having prima facie knowledge of it; or (iii) by having a direct economic interest in the results of the infringing conduct, has the ability to control the infringer’s conduct. In other words, even if the acts are committed by third parties, under this Article, an intermediary can be considered an infringer when, due to their knowledge and involvement, their conduct has been decisive in the infringement of rights, making them directly liable to the aggrieved party.

The Civil Chamber of the Supreme Court, in its judgment of 26 October 2022, applied this Article in a case brought by Mediaproducción, S.L.U. against Puerto 80 Projects, S.L.U., the owner of the well-known website, *Rojadirecta.com*, which has links to illegal content, and against its administrator and sole shareholder, which is relevant for these purposes, with the aim of charging him with liability for the infringement, preventing him from protecting himself behind the safeguard offered by the co-defendant company.

The Court of Justice of the European Union, in various rulings over the past decade (notably the well-known *Svensson -C-466/12*, ECLI:EU:C:2014:76 - and *GS Media - C-160/15*, ECLI:EU:C:2016:644), has had the opportunity to determine under what circumstances the establishment of links to works and other subject matter constituted acts of communication to the public and, consequently, infringed the rights of the right holders concerned. The existence of a “new audience” accessing the linked work or other subject matter, different from the one initially intended by the right holder, is the essential element to establish the existence of an act of communication to the public, a circumstance which was present in *Rojadirecta.com*.

Having established the existence of the direct infringement by the company that owned the website, and unable to apply the exemption from liability established by the Law on Information Society Services, the claimant sought to lift the veil (a company law remedy) of the legal entity, so that its sole shareholder and administrator would assume the consequences in a personal capacity. This claim was rejected by the court of first instance, although the Supreme Court accepted the personal liability of the co-defendant precisely on the basis of Article 138(2) of the IPA, as it held that the co-defendant had been indirectly or secondarily liable for the infringement in the terms set out in this provision.

Thus, the Supreme Court considered that the fact that the person who was to be held vicariously liable for the infringement was the sole shareholder and director of the company had an impact “on the assessment of the direct economic interest that he could have had in the result of the infringement carried out by the company, as well as his capacity to control. As the sole shareholder of the company, whose most significant income came from carrying out the infringing conduct, his economic interest was undeniable, especially when it had been established that the amount of profits earned was between one and two million euros per year. Moreover, the status of sole director, in a company that has no employees, and having the access codes is a clear manifestation of his ability to control the infringing conduct.”

The co-defendant’s defence sought to downplay the value of the powers of control he had over the company and over the actions of the users of the website in question, as well as other ancillary facts, such as the fact that the trade mark associated with the website was registered by that natural person. The Supreme Court considered these questions to be irrelevant, as well as the analysis of the other circumstances in which the co-defendant could be indirectly liable (inducement or cooperation in the infringement) to be unnecessary, as it was clear that the sole administrator and shareholder of Puerto 80 could prevent the infringements from being carried out and, furthermore, that he benefited economically from them.

Article 138(2) of the IPA seems to follow the same fate as the last paragraph of the same provision, which allows right holders to impose injunctions on Information Society intermediaries whose services are used by a third party to infringe intellectual property rights (e.g. Internet access or data hosting providers). Despite its inclusion in the IPA by virtue of Law 23/2006, its application has not been widespread until very recently, a fact that seems to be repeated with these doctrines of vicarious liability that have existed in Spanish law for almost a decade. We have no doubt that, in the coming years, both will be essential tools for intellectual property right holders to prevent infringement by third parties and to obtain fair compensation for the damage caused.

## Judgment of the Barcelona Court of Appeal (Section 15), of 13 January 2022, Appeal No. 880/2021, Decision No. 14/2022



**Inés Molina**  
Lawyer

## Court of Appeal

### Addition of matter. Implicit disclosure and intermediate generalisation

The German company Vorwerk & Co. Interholding Gmbh (“**Vorwerk**”) brought an action for patent infringement against Lidl Supermercados S.A. (“**Lidl**”) for selling and marketing the Monsieur Cuisine Connect food processor. The applicant, for its part, manufactures and markets the cooking machine known commercially as Thermomix®, which incorporates the invention claimed by the patent in question.

Lidl opposed the application and counterclaimed for invalidity of the patent on three grounds: (i) addition of matter; (ii) lack of novelty; and (iii) lack of inventive step. The infringement claim was upheld at first instance by Barcelona Commercial Court No. 5 (judgment of 19 January), which declared the patent valid and infringed. Lidl appealed against that judgment on the same grounds.

In relation to the addition of matter, Lidl based this ground for invalidity on the fact that two of the features of claim 1 of the patent (“**R1**”) could not be deduced from the original patent application by a person skilled in the art. These claims consist of: “Cooking machine (...) (**R1.4.**) characterised because the control board has at least one control circuit which affects the stirring or mixing mechanism and a control circuit which affects a weighing device, (**R1.5.**) and because, in addition, the control circuit which affects the stirring mechanism is released as a result of the operation of the switch (...)”.

Firstly, Lidl submitted that R1.4 was not included in the original description, since nowhere did it state, either explicitly or implicitly, that the weighing device was controlled by a control circuit, or that the control circuit was part of a control board. The court of first instance concluded that a person skilled in the art would unequivocally understand that when the description refers to the functions of a weighing mechanism, it implicitly presupposes the existence of a control circuit linked to a control card, and therefore held that there is an implied disclosure of this feature.

On the contrary, the Court of Appeal considered that this feature was not implicitly disclosed, since the initial description separately mentioned two functions of the control board (stirring and heating) and did not refer to a weighing device controlled by a stand-alone circuit of the same control board as the stirring and heating device. In this regard, the Court of Appeal noted that the term “implied disclosure” implies clarity and unambiguity in relation to what is expressly mentioned in the application as filed, so an amendment of the application is admissible when the resulting subject matter directly and unequivocally derives from the original application.

For the analysis of implicit disclosure, the Court of Appeal distinguished between two relevant ideas: (i) firstly, that the existence of a weighing device required the existence of a circuit on a control board; and (ii) secondly, that such a control circuit would be on the same control board as the one containing the other circuits. The Court of Appeal concluded that a person skilled in the art could not clearly and unequivocally deduce from the original description that a weighing device controlled by a self-contained circuit on the same control board as the mixing and heating device was disclosed. Therefore, it considered that there was no implied disclosure and upheld the plea for annulment.

Secondly, the defendant claimed that there had been an addition of matter in the form of an intermediate generalisation by omitting in R1.5 a feature that was included in the application (“at least for certain functions of the control card”). The contested decision considered that this was a restriction of the subject matter of the protection since it was within the possibilities provided for in the original description that only the switch activated the stirring function.

The Court of Appeal noted that, according to the EPO Boards of Appeal (T 219/09 and T 1944710), there is “intermediate generalisation” when a relationship described in the original application is “generalised”, albeit in a more specific way than originally described, which in practice means that there can be no selection regarding the set of features originally disclosed in a combination. However, a selection may be admissible if it comes from unambiguous information that the person skilled in the art can extract from the content of the application as filed.

Thus, an isolated feature may be extracted from an originally disclosed combination and used to define the claimed subject matter, provided that the feature is not inseparably linked to the other additional features of that combination. The Court of Appeal concluded that there was no generalisation when comparing the function of the switch as described in the application and the feature of the claim as amended.

## Judgment of the Seville Court of Appeal, of 31 January 2022, Appeal No. 8318/2019, Decision No. 49/2022



**Diego de la Vega**  
Lawyer

### Court of Appeal

## On the need for expert evidence of plagiarism in copyright law

The judgment of the Seville Court of Appeal notes the importance of proving, using the relevant evidence, the certainty of the facts from which the legal effect corresponding to the claims in the application can be deduced. This is provided for in Article 217 of the Civil Procedure Act, and this must also be the case, as noted by the Seville Court of Appeal, in the most obvious cases of copyright.

The claimant had brought an action based on Articles 138 and 140 of the Intellectual Property Act (cessation of unlawful activity and compensation) against a number of animation production companies which, in his view, were exploiting a work (“El Lince Perdido”) which was merely a copy of another animated film for which the claimant held the exploitation rights.

The substantive decision reiterated the case law of the Supreme Court, which is based fundamentally on the 1995 judgment according to which “plagiarism must be understood, in its most simplistic meaning, as anything that involves copying other people’s works in substance. It appears more like a mechanical material activity with very little intellectual or creative input, lacking any originality or involvement of human genius or talent, even if it brings a certain manifestation of ingenuity”. In this case, the Court noted some similarities, but a multitude of differences, both in the approach, plot and development, as well as the fact that the characters were treated very differently in the script.

However, the value of the judgment lies in the fact that it confirms the dismissal of the claim by the original court on the grounds that, as the claimant had not provided an expert report establishing the alleged plagiarism, the mere comparison of the two works by the Court (“the mere viewing of the works”) was not sufficient to establish substantial coincidences along the lines of the aforementioned judgment of the Supreme Court. On the other hand, it supports the confirmation of the rejection on the basis of the expert evidence provided by the claimant, of which it emphasises the accuracy (“detailed, thorough and reasoned report”) and from which it is clear that there was an insufficient resemblance between the two works examined. Thus, it concluded that “the fundamental fact on which the claim for protection of the intellectual property rights set out in the application is based is not at any time proven”.

## Judgment of the Valencia Court of Appeal (9th Section), of 3 May 2022, Appeal No. 1605/2021, Decision No. 411/2022



**Inés Molina**  
Lawyer

## Court of Appeal

### The prohibition of double protection

The Spanish company Excellent Cork, S.L. (“**Excellent Cork**”) brought an action for utility model infringement against Aratap Spain, S.L. (“**Aratap**”), for the manufacture and marketing of a bottle cap. The defendant objected on the grounds that the claimant’s utility model infringed the prohibition against double protection under Article 160 of the Patents Act (“**PA**”), as there would be a European patent registration protecting the same invention. It also filed a counterclaim seeking the invalidity of all the claims of the claimant’s utility model on the grounds that the requirements of novelty and inventive step were not met.

The infringement claim was upheld at first instance by Valencia Commercial Court No. 4, which declared the utility model valid and rejected the prohibition against double protection, on the basis that it was not the same invention. The defendant appealed against that decision, submitting three grounds of appeal: (i) the invalidity of the utility model due to the lack of patentability requirements; (ii) the invalidity of the utility model on the grounds of the prohibition against double protection; and (iii) the non-infringement of the claimant’s utility model, given that its product was manufactured and marketed on the basis of a utility model owned by the claimant.

The Court of Appeal, after concluding that the invalidity of the claimant’s utility model had not been established, devoted a large part of its judgment to the analysis of the prohibition against double protection in Article 160 of the PA. This prohibition applies to cases in which the holder of a patent or utility model applies, on his own behalf or on behalf of his successor in title, for a European patent for the same invention and with the same filing or priority date. In such cases, the national patent or utility model would cease to have any effect in order to avoid the invention being “double protected” within the same territory.

Although the Court of Appeal concluded that the drawings of the patent and the utility model were identical, it noted that the scope of protection conferred by a patent must be determined by the claims and that the description and drawings must be used to interpret the claims (Article 68 of the PA). Based on the claims, the following differences were identified from the expert reports:

- (i) The utility model included a bottle cap comprising “(...) **at least one transition** (5) located at at least one end of said central body (2), and **at least one side body** (3, 4) starting from the transition (5) and coaxial with the central body (2) and of smaller cross-section than the central body (2)”.
- (ii) The European patent included a bottle cap comprising “(...) **two transitions** (5) located respectively at the ends of the central body (2), said transitions (5) being **flat forming a 45° chamfer angle** with the longitudinal axis of the central body (2), **or rounded**; and **two side bodies** (...)”.

The defendant interpreted these differences as mere adaptations of wording or style, required by the search and examination processes - in other words, they would, in the defendant’s view, be mere clarifications, but would in no way alter the subject matter of the invention. On the contrary, the Court of Appeal considered that these differences led to a different subject matter, the subject matter of the invention protected by the utility model being broader than the subject matter of the European patent.

Although with the publication of the European patent, the scope of protection of the utility model was reduced to single-sided, single-transition bottle caps of any shape, the Court of Appeal concluded that the utility model did not fall under the prohibition of double protection.

Finally, the Court of Appeal upheld the infringement on the grounds that the defendant’s bottle cap was not covered by the utility model of which it was the holder, given that it protected a bottle cap with different characteristics. However, the Court of Appeal concluded that the defendant’s bottle cap did fall within the scope of protection of the claimant’s utility model, since it was a bottle cap containing a single side body and a single transition, as claimed in the claimant’s utility model.

## Judgment of the Barcelona Court of Appeal of 13 July 2022, Appeal No. 2212/2022, Decision No. 1186/2022



**Diego de la Vega**  
Lawyer

## Court of Appeal

### On the formalisation of assignments of intellectual property rights

The Barcelona Court of Appeal resolved, for the second time in two years, a case of defective transfer of intellectual property rights or, at least, without following the canon established in Royal Legislative Decree 1/1996, of 12 April, approving the revised text of the Intellectual Property Law (using the Spanish acronym, “TRLPI”), regularising, clarifying and harmonising the legal provisions in force on the subject. At the centre of the legal dispute was the interpretation of Article 45, which provides that “any transfer must be in writing”.

The circumstances that gave rise to the following case consist of a company, Nikkidom, S.L., that commissioned Factor Comercial, a cooperative, to design certain drawings that the former would incorporate into certain products such as backpacks. Nikkidom, S.L. provided all the guidelines on how the designs should look and even provided models to inspire Factor Comercial. As a result, over the five years of the business relationship, the procedure consisted of an order, the preparation of a quote, the acceptance of the quote, the execution, the delivery and the payment. When the commercial relationship ended in 2016, Nikkidom, S.L. asked Factor Comercial to sign a document acknowledging that it was up to date with payments and that the rights to the work carried out and completed up to that point were the property of Nikkidom as the rights had been assigned. This document was never signed.

On one hand, the judgment recognises the originality of the works carried out by Factor Comercial, even though they were clearly inspired by the models provided by Nikkidom, S.L. However, the value of the judgment lies in the reinterpretation of the formalities necessary for the assignment of intellectual property rights. The judgment is somewhat odd because at no point does it cite the aforementioned Article 45, which seems clear, and rejects the argument of the appellant, Factor Comercial. Factor Comercial considered that the applicable regime did not consist, as the judge of first instance believed, of a juxtaposition of Article 1542 of the Civil Code (leasing of works and services) and Article 43 of the TRLPI (*inter vivos* transfers of intellectual property rights) when there is no written contract.

Thus, the Court of Appeal took the view that the relationship between the two parties was that of a lease of a work, noted that Factor Comercial never claimed any amount of royalties and also noted that Factor Comercial was fully aware of the destination of its work. In this regard, it established that the price, even if it did not include the remuneration for the transfer of copyright as an item, remunerated the implicit transfer of rights.

What it did not resolve was how to reconcile the above situation with Article 45 of the TRLPI or, in other words, how the facts of the case (an unwritten contract consisting of the assignment of intellectual property rights) could deviate from the formal requirement established in the TRLPI, which it did not cite throughout its arguments. For this purpose, it also referred generically to a previous 2020 judgment of the same court, from which it may have wished to incorporate the reasoning that the assignment that occurred in that case, whether express or not, was in any case effective. This meant putting the literal interpretation of Article 45 on the back burner.

## Judgment of the Barcelona Court of Appeal of 27 July 2022, Appeal No. 2419/2022, Decision No. 1270/2022



**Inés Molina**  
Lawyer



**Carlos Miró León**  
Legal advisor

## Court of Appeal

### The limit to the protection for well-known trade marks

Metropolitan Spain, S.L. (the “claimant”) brought an action for invalidity and infringement of trade marks against Palma Inversiones y Restauración, S.L.U. (the “defendant”) for the use and registration of the Spanish trade mark “METROPOLITÁN CAFÉ” in relation to restaurant and hotel services. The claimant is a well-known Spanish chain of sports centres and claimed that its trade mark was well-known in Spain and should therefore be protected against goods or services which were not identical or similar.

The complaint was upheld at first instance by Barcelona Commercial Court No. 6, which declared, firstly, the invalidity of the Spanish trade mark “METROPOLITÁN CAFÉ” and, secondly, that the trade marks and trade name of the claimant “METROPOLITÁN” had been infringed due to the use of the sign in the defendant’s domain name and website, on the basis of the renown of the claimant’s trade marks.

The defendant appealed against the first instance judgment on the following grounds: (i) revocation for non-use of one of the claimant’s trade marks; (ii) validity of the trade mark “METROPOLITÁN CAFÉ”; and (iii) non-infringement, challenging the well-known nature of the claimant’s “METROPOLITÁN” trade marks.

The question was therefore whether the claimant’s trade mark “METROPOLITÁN” should be classified as being well-known and, if so, whether the conditions for extending trade mark protection beyond the rule of speciality were met.

In this regard, the Court of Appeal used the case law of the CJEU to define the concept of a well-known trade mark, the nature of which is established when the trade mark is known by a significant part of the public interested in the goods or services covered by the well-known trade mark. To assess this degree of awareness, the court can use data such as the market share of the trade mark, the intensity, geographical coverage, duration of its use, or the investment made by the company to promote it.

Following the aforementioned criteria, in its judgment, the Court of Appeal analysed the data provided by the claimant and concluded by confirming the renown of the trade mark in the sports sector. Therefore, a priori, the applicant would be fully entitled to apply for a declaration of invalidity of a subsequent trade mark without the need for the conflicting trade marks to be registered for the same goods or services, or for there to be a likelihood of confusion between the signs. However, the Court of Appeal noted that in order for this to be the case, the following conditions must be met:

- (i) The consumer, even if he/she does not confuse the marks, must establish a minimum link between the earlier and well-known trade mark and the later trade mark; and
- (ii) The proprietor of the later trade mark must have an unfair advantage or cause damage to the reputation of the earlier trade mark.

Regarding the first condition, the Court of Appeal considered that, given the similarity of the word elements of the signs (“METROPOLITÁN” and “METROPOLITÁN CAFÉ”), an average consumer, reasonably well-informed and reasonably observant and circumspect, would be able to establish a link between the marks.

However, in relation to the second condition, the Court of Appeal considered that, although both may provide identical services, the defendant would not be gaining an unfair advantage because the trade mark “METROPOLITÁN” was well known in the sports sector and not in the catering sector where the defendant operated. In this regard, the judgment stated that the aim was to protect the reputation of a trade mark against possible use or harm by a subsequent trade mark in the provision of services for which the well-known trade mark was renowned. Thus, the Court concluded that the marks could coexist despite the link that may exist between the services of the two, as it considered that the consumer would not be affected by such a link when choosing between one restaurant or the other.

In the alternative, the claimant argued that the defendant’s trade mark fell under the absolute prohibition of Article 6(1)(b) of the Trade Marks Act, since a sign was registered as a trade mark which was identical or similar to an earlier trade mark for a service supplementary to a sports service. However, the Court rejected the supplementary nature of the activities, considering that catering is neither indispensable nor important for the provision of sporting activities.

Therefore, although the trade mark “METROPOLITÁN” was accepted as having a reputation, the Court upheld the defendant’s appeal and set aside the judgment of the court of first instance in its entirety.

In short, although the well-known trade mark was granted protection beyond the rule of speciality, it can be deduced from this judgment that this reinforced protection may be limited to those cases in which the reputation of the well-known trade mark is not going to contribute to or have an impact on the final choice of consumers.

Orders of Barcelona Commercial Court No. 10 dated 7 and 22 March 2022 (preliminary injunctions 259/2022 and 339/2022 respectively)



**Álvaro de Castro**  
Counsel



**Carlos Miró León**  
Legal advisor

## Other courts

# Granting of interim measures before the publication of the notice of grant of a patent (*Fingolimod* case)

The orders in question are significant in the area of patent law as they were granted on the basis of the Unfair Competition Law as injunctions for (future) patent infringement before the patent had entered into force. The facts that led to this situation can be summarised as follows:

The applicants, Novartis group companies, market the fingolimod medicinal product Gilenya® in Spain. This medicine was in a period of data exclusivity (Article 18 of Royal Decree-law 1/2015) until 22 March 2022. After that date, regulatory market exclusivity ceased, and the incumbent could no longer prevent the presence of generic medicines on the market unless there were still patent rights in force covering the launch of such generic medicines on the market.

In this regard, the applicant had applied for patent EP 2 959 894 to protect a dosage regimen of 0.5 mg fingolimod per day orally. Although the grant of this patent had initially been refused by the European Patent Office by decision of 19 November 2022, on 8 February 2022 the EPO Board of Appeal issued a decision (T0108/21) ordering the Examination Division to grant the patent. From that moment on, it was known that the patent would be granted, although the Examination Division had to implement the decision of the Board of Appeal, and this entailed an inevitable time lag. Under Article 64(1) of the European Patent Convention, the rights conferred by the European patent did not come into existence until the publication of the grant notice, which was expected to take several months.

In this situation, the claimants requested that the Court grant ex parte injunctive relief in view of the finding that various generic laboratories had made the so-called “Declaration of Effective Commercialisation” during the first two weeks of February, which showed that products that would breach the scope of protection of the EP 894 patent were about to be launched, before the decision to grant could foreseeably be issued by the Examination Division and the decision to grant could be published. Given that, at the date of filing the application, the claimants did not yet have a patent title exercisable in Spain, the application was based (and therein lies the significance of this decision) on the Unfair Competition Act, on the grounds “that the launch by the defendants of their generic medicines, after the period of data exclusivity of the claimant, was carried out with the knowledge that a European patent had been granted to the claimant which protects the form of administration of fingolimod as prescribed by the defendants in their generic medicines, but which has not yet been published, constitutes an act of obstruction within the meaning of Article 4 of the Law on Unfair Competition”.

In this regard, the claimants argued that, if the interim measures were not adopted, they would suffer damage which would be difficult to repair, since:

- “Sixty-eight percent of Gilenya® sales are made in the framework of public procedures with the Administration, with 36 contracts worth more than 100 million euros currently under public

tender, and the fact that the active ingredient loses its exclusive status is established as a termination clause of these contracts, without the right to compensation”.

- “The inclusion of generics, which the defendants intend to market, in the pharmaceutical provision of the National Health System, by including all fingolimod-based medicines in the Reference Price Order, would mean the necessary reduction in the price of Gilenya® to the marketing price of generics, without the possibility of subsequently increasing the price when the patent is published”.

The Court, by order of 7 March (followed by another order of 22 March extending the decision to another generic company in the same situation), declared itself competent to hear this application under the Unfair Competition Act, and, considering the reasons put forward by the claimants, granted the interim measures of cessation and notification to the health authorities, which had been requested by the claimants.

These interim measures were granted without the defendant being heard, as the court considered that the ordinary procedure would result in a late decision that would not prevent the harmful effects for the claimant, as the period of data exclusivity for Gilenya® had expired on 23 March and generic drugs were about to be launched on the market.

The measure was considered appropriate and congruent with the announced injunctive relief, and also given the temporary nature of the measure requested. Similarly, the risk of procedural delay was considered to be proven, since delaying the obtaining of effective judicial protection until the publication of the judgment would have caused damage that would be difficult for the claimant to repair, as it would have had to reduce the price of the drug without being able to correct this at a later date. Regarding the appearance of a prima facie case, it was held that the defendants’ conduct of filing the “Declaration of Effective Commercialisation” with knowledge of the decision of the EPO’s Board of Appeal fell within the category of acts of obstruction, “in that it would seek to cause disproportionate damage to the competitor (in this case the claimant) without the action being to its benefit insofar as the granting of the patent would be imminent.”

Finally, a related issue is the possibility of admitting pre-emptive pleadings in order to avoid this type of decision relating to European patents that have not yet been granted and validated in Spain. The majority view in the Barcelona courts is in favour of such admission, as can be seen from the order of 25 March 2022 issued by Barcelona Commercial Court No. 5 (which upheld a pre-emptive pleading presented by one of the generic laboratories involved in this case, although this writ was submitted when the interim measures had already been agreed by Court No. 10). This order reflects the dissenting opinion expressed by Commercial Court No. 4 in this respect.

## Judgment of the Barcelona Commercial Court, No. 9, of 25 July 2022, Appeal No. 362/2022, Resolution No. 719/2022



**Álvaro Martínez Crespo**  
Lawyer

### Other courts

## Enforcement of dynamic blocking measures for infringement of IP rights

On 25 July 2022, Barcelona Commercial Court No. 9 issued judgment no. 719/2022, which pitted Telefónica Audiovisual Digital, S.L.U. and the Liga Nacional De Fútbol (as holders of intellectual property rights) against Orange Espagne, S.A.U., Vodafone Ono, S.A.U., Digi Spain Telecom, S.L.U., Telefónica de España, S.A.U., Telefónica Móviles España, S.A.U., Masmovil Ibercom, S.A. and Vodafone España, S.A.U. (in their capacity as Internet access providers) for infringement of their intellectual property rights by different pirate websites. The network providers were requested to block access to the aforementioned websites from Spanish territory and, in particular, that the blocking be extended to the platforms, websites and mirror domains that were created or had connection points/links to circumvent the blocking orders; the defendants agreed to this.

The capacity to sue information service providers is based on Articles 138 and 139(1) of the Consolidated Text of the Intellectual Property Law and on the interpretation given to them, among others, in the Judgment of the Barcelona Court of Appeal of 20 February 2018 and the CJEU judgment of 27 March 2014 (*UPC Telekabel* case), which establish the possibility of direct action against information service providers without the need to sue the infringer in order to block infringing websites quickly and effectively.

The measure was considered by the Court to be effective, proportionate, a deterrent and justified in pursuing a lawful objective, namely, to prevent large-scale infringement of the claimant's copyrights, and was not substitutable, since there are no less burdensome and equally effective alternatives for combating the copyright infringement caused. Thus, the blocking was set up as “dynamic”, as the blocking had not been ordered against individual pirate websites, but against the infrastructure (e.g. URLs, domains or IP addresses of pirate websites) created by the infringers, even if they had modified it.

Consequently, for the execution of the measures, the Court provided for their implementation in three distinct phases: (i) the blocking of the infringing websites in their different forms of recognition on the Internet; (ii) the monitoring of the blocked web resources during the 2022/2023, 2023/2024 and 2024/2025 sports seasons in order to identify the modifications to their forms of recognition; and (iii) the communications by the claimants (indistinctly) and on a weekly basis to the different Internet access providers of the details of the pirate web resources that are subject to blocking, in order to update the enforcement of the blocking, in accordance with the judgment.

YEAR IN REVIEW 2022

# What's in store for 2023?

**Image created by Stable Diffusion**

Prompt: A beautiful intricate 3 d abstract glass sculpture made of white pore fungi, morning glory flowers, boho floral vines, murano round colored glass vases, orange hibiscus flowers, top lit, octane render, soft lighting, ultra detailed, 8 k, trending in artstation, gallery piece by barbara hepworth

To find out what will happen on the legal front in 2023, we will still have to look to Europe. The renewal of Internet regulation under the Digital Agenda plan will continue to be very active, as will the activity of the Court of Justice of the European Union (“CJEU”), which over the last decade has largely shaped the law in our Community environment



**Andy Ramos Gil de la Haza**  
Partner

## What's in store for 2023?

- **Artificial Intelligence [Regulation] Law:** (Regulation of the European Parliament and of the Council laying down harmonised rules on artificial intelligence (Artificial Intelligence Act) and amending certain Union legislative acts): with a people-centred approach to technology, the European Union aims to ensure that any AI development respects the principles and values of the Treaty on the Functioning of the European Union. When the Artificial Intelligence Regulation is implemented, the use of these technologies will be prohibited in certain areas (for example, regarding subliminal techniques that transcend a person's consciousness), there will also be a system for classifying these techniques according to their use, with certain information and risk analysis obligations, among others, that their promoters will have to comply with.
- **AI Liability Directive:** (Directive of the European Parliament and of the Council on adapting non-contractual civil liability rules to artificial intelligence): in order to prevent each EU Member State from legislating inconsistently on the issue of liability for damage caused by Artificial Intelligence, the European institutions want to establish common standards that all countries will have to respect. The opacity (perceived as a black box), autonomous behaviour and complexity of AI systems can make it extremely difficult, if not impossible, for an injured party to prove fault in relation to such technology. This is a proposal that, once adopted, will apply in court, in relation to the production of evidence and a rebuttable presumption of causality in the event of negligence when an AI-based technological system is involved.
- **eIDAS 2:** (Regulation of the European Parliament and of the Council amending Regulation (EU) No. 910/2014 as regards establishing a framework for a European Digital Identity): concerned with having a more secure online environment, after several years in the pipeline, it is foreseeable that the update of the eIDAS regulation will finally be approved to extend the use of digital certificates that facilitate the remote identification and execution of legal transactions. eIDAS2 aims for all EU citizens to have a wallet or digital identity wallet with which to control the amount of data provided in each transaction.
- **Intellectual Property Laws:** at the national level, although with a significant delay, we should not lose sight of the Draft Bill to amend Law 17/2001, of 7 December, on Trade Marks, Law 20/2003, of 7 July, on the Legal Protection of Industrial Designs and Law 24/2015, of 24 July, on Patents, which is awaiting publication by the Council of Ministers, after a preliminary study in early October 2021, and on which the Economic and Social Council and the National Commission for Markets and Competition have had the opportunity to express their opinions.
- **Nice Classification for the registration of marks:** on 1 January 2023, the 12th edition of the Nice Classification entered into force. One of the new features is the addition of the term “downloadable digital files authenticated by non-fungible tokens” (NFTs) in class 9. However, in the guidelines published by the European Union Intellectual Property Office (EUIPO) in this regard, it is noted that the term NFT is imprecise and, on its own, will not be acceptable, so the trade mark applicant must specify the type of digital article authenticated by NFT technology.
- **Castorama Polska and Knor, Case C-628/21:** (ECLI:EU:C:2022:905) the CJEU will have to interpret the so-called Enforcement Directive (Directive 2004/48/EC) in order to determine to what extent a claimant in IP proceedings must prove that it is the proprietor of the right in question, or whether it is sufficient for it to prove that it is the proprietor with a reasonable probability. The Advocate General has recommended that the answer should be that the claimant should reasonably establish, with sufficient evidence, that he is the proprietor of the intellectual property right in question, without being required to prove it, in particular where the request for information pre-dates the filing of a claim for damages for infringement of an intellectual property right.
- **Grand Production, Case C-423/21 (ECLI:EU:C:2022:818):** public communication will still be subject to interpretation by the CJEU in 2023, this time regarding the use of a Virtual Private Network (“VPN”) for geo-blocked content. The Advocate General recommends interpreting Directive 2001/29/EC as meaning that an operator of a streaming platform which broadcasts a television programme on the internet will not infringe the exclusive right of communication to the public of works, that is provided in that provision, where users circumvent the geo-blocking of access through a virtual private network (VPN) service. On the contrary, it understandably considers that such an operator will infringe that right when protected works are made available without restriction on its platform for the territory of the European Union without the authorisation of the copyright holder.
- **Österreichische Post, Case C-300/21 (ECLI:EU:C:2022:756):** Liability for damage caused by non-compliance with data protection regulations (essentially, the GDPR) is a clear trend within the European Union. The CJEU must interpret Article 82 of the GDPR, in particular on how to quantify the damage caused in such circumstances. The Advocate General has suggested that said Article should be interpreted as meaning that it is not sufficient that the Regulation has been infringed or that the injured party feels aggrieved by such circumstances, but that there must be actual material or non-material damage to the injured parties.

### A legal response to technological progress

Providing effective legal advice in a rapidly evolving world goes hand in hand with understanding the specific features of each technology, along with its potential and how it affects a company's business.

We approach transactions and litigation with a careful consideration of the cross-cutting impact technology has on all areas of business and legal advice.

10 feb 2022

#### TechLaw Podcast Ep.8

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▶ 42 min

11 apr 2022

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La ciberdelincuencia y su incidencia en el entorno laboral

▶ 13 min

10 may 2022

#### TechLaw Podcast Ep.10

La identidad digital, aspecto jurídico y de negocio

▶ 38 min

14 nov 2022

#### TechLaw Podcast Ep.11

Digital Services Act – DSA, nuevas obligaciones en Internet

▶ 28 min

27 dec 2022

#### TechLaw Podcast Ep.12

Resumen anual 2022

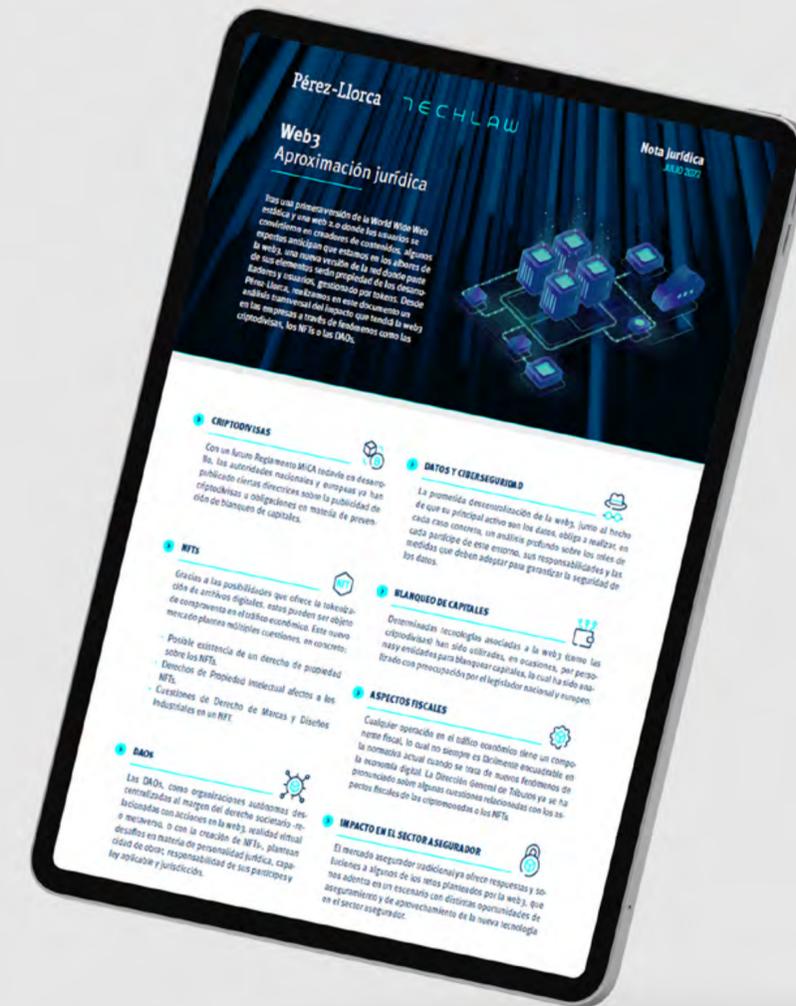
▶ 42 min

# Web3: legal approach

Following the first static version of the World Wide Web, and Web 2.0 where users became content creators, some experts anticipate that we are at the dawn of Web3, a new version of the web where some of its elements will be owned by developers and users, and managed by tokens. This document includes a multidisciplinary analysis of the impact that Web3 will have on companies through phenomena such as NFTs and DAOs

1. Introduction
2. Crypto-assets
3. NFTs
  - 1.1. NFT as an object subject to ownership
  - 1.2. Intellectual Property Rights
4. DAOs and Web3
5. Web3 data and cybersecurity
6. Money laundering on Web3
7. Tax aspects of Web3
8. Impact of Web3 on the insurance sector
  - 8.1. Advantages and challenges
  - 8.2. Securing against new risks inherent to Web3

Click to access the full briefing



## Penalties of the Spanish Data Protection Agency in 2022

As of mid-December 2022<sup>1</sup>, the AEPD had penalised 149 companies, through more than 200 resolutions. The information relating to these penalties, broken down by sector of activity and by the articles infringed, is shown graphically below.

	No. of penalties	Total	Average
Article 5(1)(f) (principle of integrity and confidentiality)	41	€6,535,500.00 €	€159,402.44 €
Article 6(1) (legitimising basis)	47	€3,263,800.00 €	€69,442.55 €
Article 32 (security of processing)	26	€372,000.00 €	€14,307.69 €
Article 13 (lack of information)	43	€186,650.00 €	€4,340.7 €
Article 5(1)(c) (minimisation principle)	31	€175,200.00 €	€5,651.61 €



Total value of penalties imposed:  
**€24,361,550**

Total number of penalties in 2022:  
**211**

Maximum penalty:  
**€10,000,000**

Average penalty:  
**€113,310 €**

	No. of penalties	Total	Average
Technology	4	€12,080,100.00	€3,020,025.00
Telecommunications	23	€6,671,000.00	€290,043.48
Banking and Finance	13	€2,752,000.00	€211,692.31
Miscellaneous services	20	€588,300.00	€29,415.00
Energy	9	€334,000.00	€37,111.11

<sup>1</sup> All the data reflected in this section was published by the AEPD during 2022, up to 14 December 2022.

## Intellectual Property and Technology team

Pérez-Llorca's Intellectual Property and Technology Law team provides multidisciplinary advice on the protection, defence of, and transactions involving all types of intangible assets, including artwork and creative services, trade marks, patents, trade secrets and data. Due to the nature of this area of law, our lawyers have in-depth knowledge of our clients' businesses and technology, in order to provide innovative advice and adapt to their needs, with an international outlook and the desire to offer the highest quality advice.

In a world increasingly dominated by technology, and where the value of a company's intangible assets is what differentiates it from its competitors, Pérez-Llorca's Intellectual Property and Technology Law team offers **all-encompassing, comprehensive advice**. Our clients include multinational technology companies, large entertainment companies, luxury brands, and, generally speaking, companies from a diverse range of sectors that use software and large volumes of data.

With the aim of offering bespoke advice to each client and proposing improvement initiatives, Pérez-Llorca's Intellectual Property and Technology Law team analyses the characteristics of each company, its asset portfolio and how to protect it. In addition to being legal experts, our lawyers are also knowledgeable and passionate about technology, and are capable of establishing direct communication with engineers and technicians. This allows them to have a complete understanding of each client's situation, enabling them to offer solutions tailored to every challenge that emerges. The team advises on a diverse range of matters, such as:

- Trade marks
- Patents
- Copyright
- Entertainment law (music, audiovisual, literature, art, video games, etc.)
- Internet law
- Advertising and marketing law
- Software and IT infrastructures
- Databases, data and privacy
- The right to honour, the right to privacy and the right to one's image
- Robotics and artificial intelligence

We also guide our clients through negotiating and completing transactions involving all kinds of intangible assets, defending their interests before the ordinary courts and in domestic and international arbitration proceedings.



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