

Arctic times for trademarks infringers (2) - But for CTM infringers only?

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Inmaculada González López (Bomhard IP)

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The CJEU in its decision of 4 February 2016 in the ARKTIS case (C-163/15) followed the opinion of Advocate General Wathelet and confirmed that recordal of a license is not a necessary condition for the licensee to be able to bring an infringement action based on a CTM.

In our last post ([here](#)) we commented the opinion of Advocate General of 17 December 2015 (**Case C-163/15**) concerning the trade mark ARKTIS. As expected, the CJEU has confirmed the proposed interpretation of Article 23 (1) CTMR and ruled that this provision must be interpreted as meaning that the licensee may bring proceedings alleging infringement of a CTM which is the subject of the license, despite the fact that license has not been entered in the Register of Community trademarks.

This outcome would be of great importance in particular in those jurisdictions whose national trademark laws explicitly foresee the requirement of recordal of licenses and where the national Courts have interpreted this provision as confirming the compulsory character of the license recordal for the licensee to bring an infringement action.

This is the case in Spain. Although there have been decisions in line with the new

CJEU ruling, we also mentioned in our last post other decisions denying licensees the capacity to act as plaintiff in infringement proceedings in the absence of a recorded license.

Now, since the approval of the new Spanish Patent Act of 25 July 2015, which will enter in force on 1 April 2017, the situation can become more challenging. The provisions of the Patent Law regarding jurisdiction and procedural rules are applicable to trademark proceedings. According to that, the new Article 117 of the Spanish Patent Act, which explicitly provides that licensees have capacity to act in infringement proceedings only if they can prove the recordal of the license in the Register, will apply in trademark infringement proceedings as well.

The clarification of the meaning of Article 23 (1) CTMR is welcomed. However, Spanish trademark owners, licensees and practitioners also have to understand the situation in Spain. As things stand, the different regulation of this matter at national and community level leads to the paradoxical situation that while licensees of a CTM are able to act against infringers without license recordal, licensees of Spanish marks may well not have the same capacity to act. If that is, the “Arctic times” would be only for infringers of CTMs.