[ES] Using a domain name for the purpose of selling it to the owner of a trademark is forbidden

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Several years ago, a person registered a domain name that included the name of a law firm, without using it. The law firm, incorporated as a company in 2015, was using the .eu country code Top Level Domain (ccTLD), but also wanted to register the .es ccTLD that was registered by that person.

The law firm contacted the domain owner in order to try to reach an agreement, but the domain owner instead asked for a high amount of money. The law firm filed a lawsuit against the domain owner.

The Commercial Court (*Juzgado de lo Mercantil*) nº 1 of Valencia ruled that the law firm was entitled to register and use a domain name that included its trademark. The court, in its judgement Nº 185/2019 of 22 May 2019, concluded that the owner of a trademark must be the rightful owner of the domain name that includes it and ordered its subrogation in the ownership of this domain name.

In 2003, the Spanish Supreme Court ruled that there is a subjective right of exclusive use of the trademark, which presents both a positive and a negative aspect. The positive aspect is that the owner of the trademark may use it for selling the trademark or for advertising purposes; the negative aspect is that the trademark owner may prohibit other people from using it.

Therefore, the law firm was able to use the .es ccTLD as it was the owner of the trademark included in the domain name.

Sentencia nº 185/2019, de 22 de Mayo de 2019, del Juzgado de lo Mercantil nº 1 de Valencia

http://diariolaley.laley.es/content/Documento.aspx?params=H4sIAAAAAAAAEAMtMSbH1CjUwMDAzMTQzMrNUK0stKs7Mz7Mty0xPzStJBfEz0ypd8pNDKgtSbdMSc4pT1RKTivNzSktSQ4sybUOKSlMBAh9L2UUAAAA=WKE

Judgment no. 185/2019 of 22 May 2019 of the Commercial Court no. 1 of Valencia

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