

Domain name infringement of a subsequently registered trade mark

In Judgment no. 1341/2025 of 30 September (ECLI:ES:TS:2025:4206), the Civil Division of the Supreme Court ruled that there is no limitation requiring a trade mark owner to acquiesce to the existence of confusingly similar domain names that were registered earlier than the trade mark.

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1. Introduction

It is a well-known fact that domain names may clash with the trade mark rights of third parties and that there are many such cases in practice due to the oft-speculative nature of domain name registrations, where one or more domain names that are identical or similar to generally well-known third party trade marks or distinguishing marks

are registered with the intention of subsequently selling the domain names to these third parties at high prices. This practice is very common because domain names are generally registered without the registration authority checking whether the applicant has any rights or interests in the mark applied for as a domain name and without examining whether the domain name may infringe a third party's rights.

Although conflicts between domain names and trade marks can be resolved at the competent courts, the slowness of court proceedings has led to the creation of alternative dispute resolution (ADR) procedures. Among these, the most prominent — resolving the most cases and serving as a model for other ADR procedures — is the so-called ICANN (Internet Corporation for Assigned Names and Numbers) administrative procedure, governed by the ‘Uniform Domain Name Dispute Resolution Policy’ (the ‘Policy’) and the ‘Rules for the Uniform Domain Name Dispute Resolution Policy’, both initially approved in 1999 and subject to later amendments.

The ICANN procedure applies to disputes between a trade mark owner and a domain name holder, provided that the domain name includes a top-level domain that falls within the scope of the Policy. On that basis, the trade mark owner, who always acts as the complainant in the procedure and chooses the ‘dispute resolution service provider’ that will resolve the dispute, must prove the following:

- a) that the domain name in dispute is identical or confusingly similar to a trade mark (or service mark) in which the complainant has rights;
- b) that the respondent has no rights or legitimate interests in the domain name;
- c) that the respondent has registered and used the domain name in bad faith.

These requirements are therefore different from those that must be met for a trade mark infringement to be established in a court of law, so it is entirely possible for

one and the same case to be decided for the trade mark owner in out-of-court proceedings, but against him in court proceedings.

It is therefore particularly important that the ICANN Policy establishes that the party that has not obtained a satisfactory resolution may submit the dispute to a competent court in order to obtain an independent resolution. Thus, when the ICANN procedure is resolved in favour of the trade mark owner, the domain name registrar must enforce it (by transferring the domain name to the complainant or cancelling it), unless, within the stipulated period, the respondent domain name holder has submitted documentation proving that a legal action has been brought against the complainant in a jurisdiction to which the complainant has submitted at the start of the procedure; that is, either at the place of registration of the domain name or at the domicile of the domain name holder.

The Civil Division of the Supreme Court has recently handed down an interesting ruling in relation to a case in which a domain name holder went to the Spanish courts after losing in the ICANN procedure.

2. Supreme Court (Civil Division) Judgment no. 1341/2025 of 30 September

2.1. The dispute resolved by the judgment pits a company (which in 2007 registered the domain name ‘mezquita-decordoba.org’ and used it to offer a website providing guided tours of the Mosque of Córdoba, as well as other tourism services) and the Cordoba Cathedral Chapter of Canons, owner

of the ‘Mezquita de Córdoba’ word marks, granted in 2012 for numerous classes of the international nomenclature.

On the basis of said trade marks, the Cordoba Cathedral Chapter of Canons resorted to the ICANN procedure, choosing the World Intellectual Property Organisation as the dispute resolution service provider and obtaining an order for the transfer of the disputed domain name.

In response, the company that owned the domain name brought an action for quiet title, seeking a ruling that the use of that domain did not constitute an infringement of the ‘Mezquita de Córdoba’ trade marks, so that it would not have to transfer the domain name to the Cathedral Chapter.

The courts of first and second instance, Madrid Companies Court No. 11 and the Madrid Provincial Court (28th Chamber), dismissed the action for quiet title on the grounds that the domain name in question did infringe the defendant’s trade marks. For its part, the point-of-law appeals on the grounds of a breach of the provisions or procedures governing the determination of a dispute against the judgment of the Madrid Provincial Court were rejected by the Supreme Court.

2.2. The Supreme Court, summarising the facts, states that “the Chapter resorted to the WIPO [World Intellectual Property Organisation] arbitration procedure on conflicts between domain names and trade mark rights

and obtained a decision ordering the transfer of the aforementioned domain name”. However, this statement is not correct, because decisions issued under ICANN’s dispute resolution procedure are not equivalent to an arbitration award, as the parties do not agree to a binding or final nature of the dispute resolution centre’s decision. Consequently, recourse to the courts is always available.

2.3. Furthermore, the content of the Supreme Court’s judgment is particularly interesting in terms of its analysis of the possibility that a domain name may infringe a trade mark, even where the domain name is registered before the trade mark (it should be noted that in this case the domain name predates the trade marks by five years).

According to the Supreme Court, *ius prohibendi* limitations are mainly regulated in Article 37 of the Trade Marks Act, and in that provision “there is no limitation requiring a trade mark owner to acquiesce to the existence of confusingly similar domain names that were registered earlier than the trade mark. If the domain name holder does not successfully bring an action for recovery of ownership or an action for declaration of invalidity (fundamentally, for registration in bad faith) against the trade mark owner, the latter may exercise the *ius prohibendi* with respect to the domain name.”

2.4. Furthermore, the Supreme Court also rejects the application of the limitation in consequence of acquiescence, because “what Article 54(2) provides

for as limitation in consequence of acquiescence is an obstacle to the proprietor of the earlier right being able to apply for a declaration that the later trade mark is invalid or to oppose” its use. “But in this case, it was the owner of a trade mark reg-

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istered subsequently who opposed the use of the domain name, so the situation would, in any case, be the reverse”. Furthermore, the “earlier right” referred to in the provision must be one of those provided for in Articles 6, 7, 8 or 9(1) of the Trade Marks Act, and the ownership of a domain name is not among them.

- 2.5. Finally, with regard to the infringement of the trade mark through the domain name, the Supreme Court considers that there is a likelihood of confusion,

since “the claimant has used as a domain name a mark that is identical or practically identical (the domain name omits capital letters and the separation between words) to the defendant’s trade marks. And some of the services offered on the website corresponding to the domain name (guided tours of the Mosque of Córdoba) not only match some of those for which the trade mark is registered, but are also closely related to those actually offered under the Chapter’s trade mark (sale of tickets to the Mosque of Córdoba), so that there is a risk of confusion or, at the very least, of association, because the public may believe that the services offered on the website are provided by the trade mark owner or by a company linked to it. In this regard, the fact that the domain name holder includes a warning notice on its website stating that it is not the official website of the Mosque-Cathedral of Córdoba and has no connection with any official body linked to it does not eliminate this risk of confusion.