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Information Technology and the Law - Trademarks in Cyberspace, Macerata 2015

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Information Technology and the Law

Trademarks in Cyberspace

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DIPARTIMENTO DI
GIURISPRUDENZA

Lezioni su

“INFORMATION TECHNOLOGY AND LAW”

di **Ulf MAUNSBACH**

Professore associato di diritto internazionale privato
/ Dipartimento di Giurisprudenza / Università di Lund / Svezia

Visiting Scholar presso l'Università di Macerata / Dipartimento di Giurisprudenza

mercoledì **25 febbraio** / ore 16.00 - 18.00

Information Technology and the Law – an Overview of Issues

mercoledì **11 marzo** / ore 16.00 - 18.00

Privacy and the Right to be Forgotten

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Trademarks in Cyberspace

mercoledì **8 aprile** / ore 16.00 - 18.00

Copyright in Cyberspace

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Private International Law and the Internet

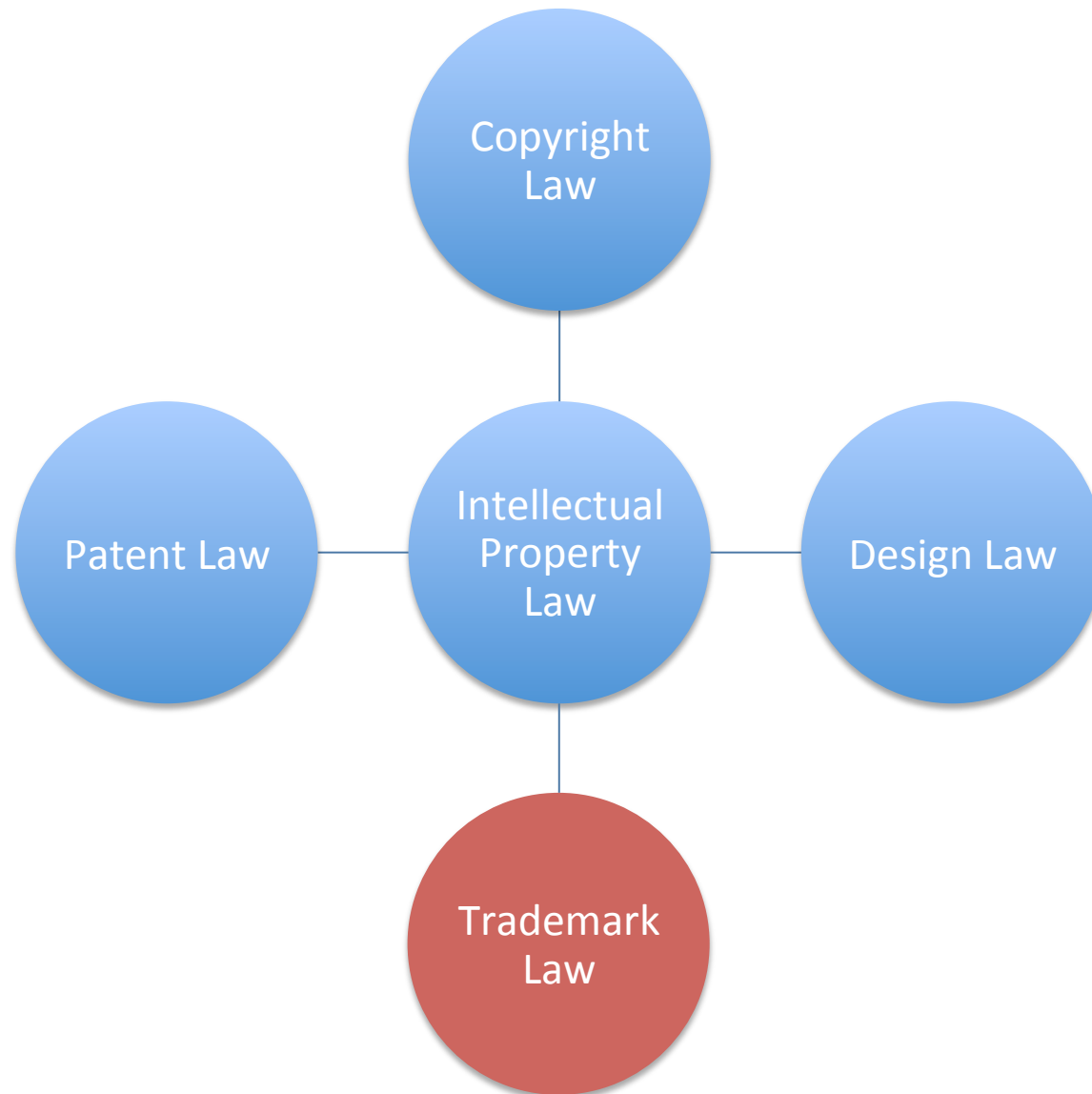
martedì **28 aprile** / ore 9.00 - 11.00

The Future of Information Technology – Multiplication or Simplification

25 FEBBRAIO - 28 APRILE 2015

AULA VIOLA 2 / POLO DIDATTICO DIOMEDE PANTALEONI

VIA PESCHERIA VECCHIA / MACERATA



European (full)harmonisation

- The Trademark Directive; First Council Directive 89/104/EEC to approximate the laws of the Member States relating to trade marks -> **Directive 2008/95/EC** (Codified version).
 - Harmonisation on a national level
- The Trademark Regulation; Council Regulation 40/94 on the Community Trade Mark -> **Regulation 207/2009** on the Community trade mark (codified version).
 - Harmonisation within EU – one Union, one Right

Related legislation

- Council Directive 84/450/EEC concerning misleading and comparative advertising -> **Directive 2006/114/EC**
- Directive 2004/48/EC of 29 April 2004, on the enforcement of intellectual property rights



WHAT IS A TRADEMARK?



...anything with distinctive character!



Trademarks are signals...loaded with
commercial information.

Trademarks communicates...
...and communication is crucial in the
Information Society

Trademarks in Cyberspace

Structure:

- 1 - General aspects
- 2 - The Domain Name System (DNS)
- 3 - Alternative (On-Line) Dispute Resolution
- 4 - Internet related infringements

1 - General aspects

- IT – A new legal perspective?
- The technical environment implies new solutions
 - Trademarks - an increasingly important signal in a world of information!
 - Digitalisation
 - Convergence
 - Globalisation

1 - General aspects

- Problems with Domain Names
- Internet related infringements; Use on the Internet - dilution, generic use and competition between proprietors
- Infringement (cross-border)
- Jurisdiction and Choice of Law (lecture 5)

Structure

- 1 - General aspects
- 2 - The Domain Name System (DNS)
- 3 - Alternative (On-Line) Dispute Resolution
- 4 - Internet related infringements

2 - Internet Communication

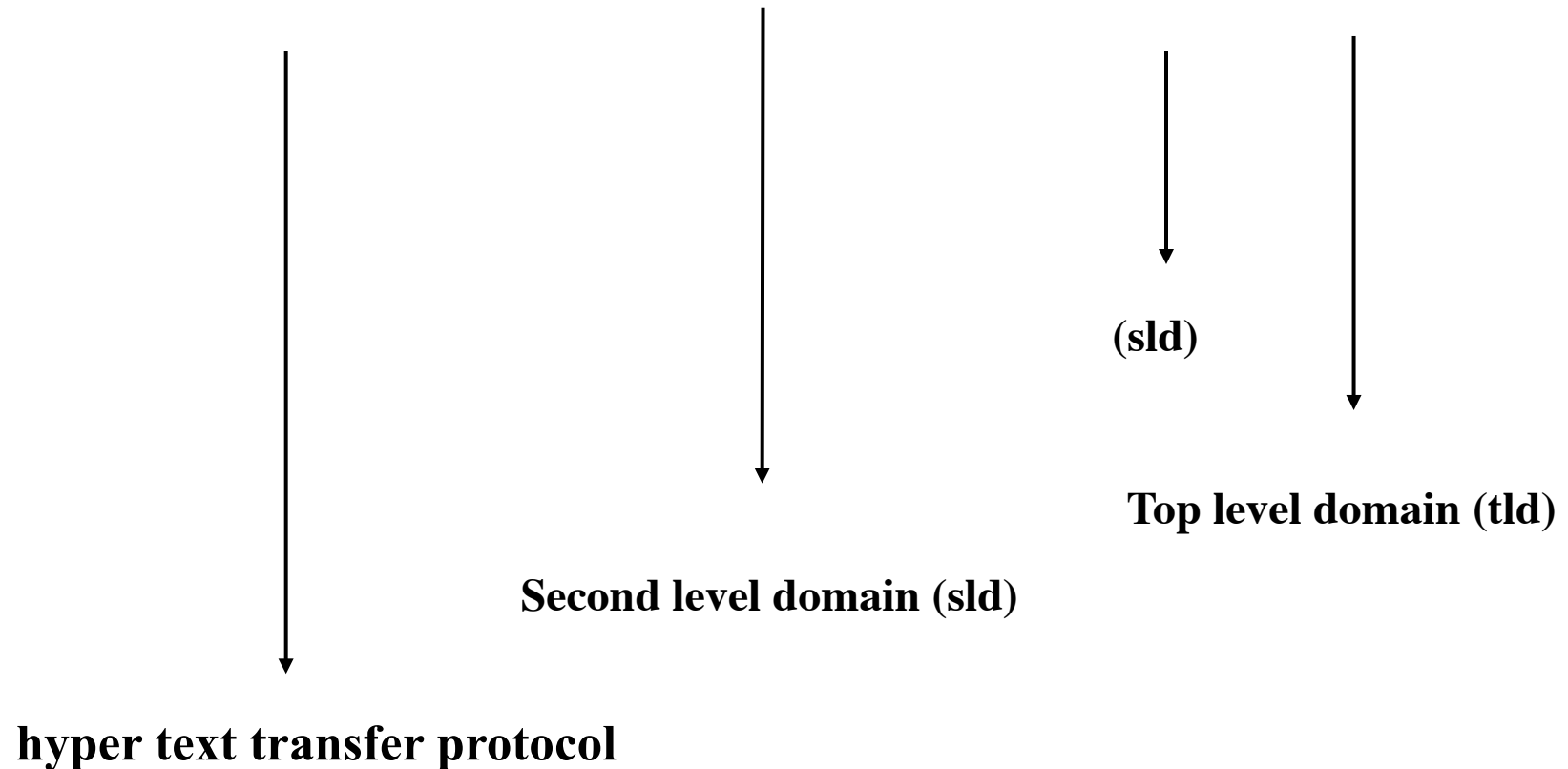
- Protocols and packages – TCP/IP
- Information is:
 - divided in packages
 - sent through the Internet and
 - reconstructed at the final designation
- Unique addresses – IP-numbers
123.123.123.123...
- In order to communicate you/the computer need to know the final destination – An “easy to find” address is needed

2 - The Domain Name System

- Primarily a genius technical development that facilitates Internet communication
- The Domain Name System (DNS) is a distributed internet directory service used mostly to translate between domain names and IP addresses

What's in a Domain Name?

http://giurisprudenza.unimc.it



2 - DNS

- What's in a Domain Name?
 - An Address?
 - A Trademark?
 - A Trademark-address?
- Top-level domains
 - ccTLD: Country Code Top-Level Domains
 - .au, .se, .uk ...
 - gTLD: Generic Top-Level Domains
 - .com, .org, .net ...

2 - DNS – A problem on its own?

- Is a Domain name Property?
 - <http://www.theregister.co.uk/2014/07/31/terrorismiraninterneticann/>
- Top Level Domains – New tLD's - recent developments:
 - <http://newgtlds.icann.org/en/>
 - <http://newgtlds.icann.org/en/program-status/delegated-strings>

2 - DNS – Who's in Charge?

- Internet Corporation for Assigned Names and Numbers: www.ICANN.org

Structure

- 1 - General aspects
- 2 - The Domain Name System (DNS)
- 3 - Alternative (On-Line) Dispute Resolution
- 4 - Internet related infringements

3- Alternative (On-line) Dispute Resolution

- ADR/ODR - Global
 - UDRP: Uniform Domain Name Dispute Resolution Policy;
 - <https://www.icann.org/resources/pages/udrp-2012-02-25-en>
 - <http://www.wipo.int/amc/en/domains/guide/>
 - <http://www.wipo.int/amc/en/domains/>

3- Alternative (On-line) Dispute Resolution

- ADR/ODR – ccTLD:s
 - .se:
 - www.iis.se
 - <https://www.iis.se/english/>
 - https://www.iis.se/english/dispute_resolution/
 - .it
 - <http://www.nic.it>
 - <http://www.nic.it/legal-issues/regulation-disputes-and-legal-guidelines>

Structure

- 1 - General aspects
- 2 - The Domain Name System (DNS)
- 3 - Alternative (On-Line) Dispute Resolution
- 4 - Internet related infringements

4 - Internet related trademark infringements

Some examples...

- Us of Meta-tags:
 - Case C-657/11 (Belgian Electronic)
- Keyword Advertising:
 - C-236/08 to C-238/08 (Google France)
 - C 324-09 (L'óreal v ebay)

Case C-657/11 (Belgian Electronic)



Case C-657/11 (Belgian Electronic)

- Prior relationship, former employee...
- Claims and counter claims...
- Use of meta-tags and
- Domain names: www.bestlasersorter.com

What is a meta-tag?

```
<!DOCTYPE HTML PUBLIC "-//W3C//DTD HTML 4.0  
Transitional//EN">
```

```
<html>
```

```
<head>
```

```
<title>We offer the Best Laser Sorter .</title>
```

```
<meta name="keywords" content="Helius sorter, LS9000,  
Genius sorter, Best+Helius, Best+Genius, Best NV">
```

```
</head>
```

```
<body>
```

Case C-657/11 (Belgian Electronic)

Legal background

- Council Directive 84/450/EEC concerning misleading and comparative advertising, and
- Directive 2006/114/EC concerning misleading and comparative advertising

Case C-657/11 (Belgian Electronic)

Question

- Is the term 'advertising' in the EU-directives to be interpreted as encompassing, on the one hand, the registration and use of a domain name and, on the other, the use of meta-tags in a website's metadata?

Case C-657/11 (Belgian Electronic)

Answer:

- Yes, but the registration of a domain name, as such, is not encompassed by that term.

C-236/08 to C-238/08 (Google France)

- Three cases
 1. Google France v Louis Vuitton (C-236/08),
 2. Google France v Viaticum (C-237/08),
 3. Google France v CNRRH SARL, Pierre-Alexis Thonet, Bruno Raboin, Tiger SARL (C-238/08), Eurochallenges, registered for, inter alia, matrimonial agency services, Mr Raboin, Tiger and Google were found guilty of infringement, only Google appealed...
- Use of trademarks as keywords in the 'AdWords' referencing service provided by Google
- Case started 2003 - Judgement from the ECJ, 23 March 2010

C-236/08 to C-238/08 (Google France)

Legal Background;

- The trademark Directive 89/104/EEC → Directive 2008/95/EC
- The Trademark Regulation; 40/94 → Regulation 207/2009
- Directive 2000/31/EC (electronic commerce)

C-236/08 to C-238/08 (Google France)

Questions:

- Is the provider of a paid referencing service (e.g. Google) (also) using trademarks that advertisers are using as keywords in a manner which the trademark proprietors are entitled to prevent? Case 1+2+3
- Is the e-commerce directive and the liability rule in article 14 applicable in relation to the provider of a paid referencing service, so that the provider cannot incur liability until it has been notified by the trade mark proprietor of the unlawful use of the sign by the advertiser? Case 1+2+3

C-236/08 to C-238/08 (Google France)

Questions:

- May the use of trademarks registered by a third party as a keywords referencing service, in itself be regarded as an infringement of the exclusive right guaranteed to the trademark? Case 3
- Does it matter if the trademark used as a keyword has a reputation? Case 1

C-236/08 to C-238/08 (Google France)

Answers:

- The advertiser (user) may be an infringer
- The service provider (e.g. Goggle) does not use signs/trademarks within the meaning of European trademark law.
- The Liability rule in article 14 (e-commerce directive) applies to an internet referencing service provider in the case where that service provider has not played an active role of such a kind as to give it knowledge of, or control over, the data stored.

C 324-09 (L'Oréal v ebay)

- Case started 22 May 2007 - Judgement from the ECJ, 12 July 2011
- L'Oréal operates a closed selective distribution network
- L'Oréal claims that eBay and the individual defendants are liable for infringements due to the sales of 17 items with the use of www.ebay.co.uk
- Both counterfeits and goods that were not intended for sale (in Europe)
- A lot of claims...
- eBay has developed a notice and take-down system (VeRO - *Verified Rights Owner*)

C 324-09 (L'oreal v ebay)

Legal Background

- The trademark Directive 89/104/EEC → Directive 2008/95/EC
- The Trademark Regulation; 40/94 → Regulation 207/2009
- Directive 2000/31/EC (electronic commerce)
- [Directive 2004/48/EC (Enforcement)]

C 324-09 (Lóreal v ebay)

Questions

- Detailed questions as to the use of products not intended for sale in Europe = substantive trademark law
- Is ebay using trademarks when they purchases the use of a sign which is identical to a registered trade mark as a keyword from a search engine operator, and does it matter if the goods advertised are counterfeits?
- Is the e-commerce directive applicable in relation to ebay?

C 324-09 (Lóreal v ebay)

Answers:

- Goods not offered for sales (including testers and free samples) may be infringing...
- The proprietor may oppose reselling of goods with removed packaging.
- Keyword advertising may be prevented where the advertising does not enable reasonably well-informed and reasonably observant internet users to ascertain whether the goods concerned originate from the proprietor of the trademark.

C 324-09 (Lóreal v ebay)

Answers:

- ebay is not “using” trademarks which appear in offers for sale displayed on its site.
- Article 14 of the e-commerce directive may be applicable to the operator of an online marketplace (ebay) where that operator has not played an active role allowing it to have knowledge or control of the data stored, but the operator must act on knowledge.

4 – Infringements and its prerequisites

- Likelihood of confusion...
- Use (in the protecting country)
- In the course of trade

4 – Use in general

- Domain Names, Links, use of keywords and meta tags.
- All relevant aspects...
- Dilution and generic use
- Multiple proprietors – competition between proprietors

4 – Bad Faith Infringement and Good Faith use...

- Bad Faith; unfair business practice or trademark infringement?
- Good Faith – dilution?

4 - Use - in the protecting country

- Several proprietors – a global market
 - Early examples: “Global injunctions”
 - Coexistence?
 - WIPO: Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet

4 - Use - in the protecting country

Cases from the Court of Justice of the European Union

- C-509/09 and C-161/10 (eDate v X and Martinez v MGN)
- C-585/08 and C-144/09 (Pammer v. Reederei Karl Schlüter and Hotel Alpenhof v. Heller)
- C 173-11 (Dataco)

4 - In the course of trade

- How to define - Conducting business on the Internet?
- Possibilities and problems?

References

- World Intellectual Property Organisation; www.wipo.org
- Office for Harmonisation in the Internal Market;
www.ohim.eu
- WIPO: Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet:
<http://www.wipo.int/edocs/pubdocs/en/marks/845/pub845.pdf>
- Maunsbach, Ulf, *Domain Names as Jurisdiction-Creating Property in Sweden* (with Michael Bogdan), Masaryk University Journal of Law and Technology, 2009:
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