



*Unauthorised Use of Trade Marks on the Internet:
How can trade mark law help?*
The UK Perspective

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Options

Civil proceedings:

- primary infringers
- intermediaries

Domain Name Complaints

(UDRP, Nominet, etc.)

Law enforcement agencies:
inc. **criminal proceedings**

Self-regulatory

mechanisms: search engine de-indexing, abuse report systems, etc.

**Private criminal
prosecution**

Interception of goods sold online by
Customs Authorities: e.g.
small consignments procedure

Payment Disruption

ISPs - Takedown letters / possible
leverage on ISP's T&Cs / **blocking
injunctions**

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What are we going to cover?

The UK perspective:

1. Direct liability - keyword advertising and website uses
2. Indirect liability - blocking injunctions against ISPs
 1. Domain names – passing off?

Legal Framework

EU law:

- ❑ **Trade Mark Regulation** 207/2009/EC
(as amended by EU Regulation 2015/2424)
- ❑ **Enforcement Directive** 2004/48/EC
- ❑ **e-Commerce Directive** 2000/31/EC

UK specific law:

- ❑ **Trade Marks Act 1994**
(implementing EU Directive 2008/95/EC)
- ❑ Common law: **passing off** action

Case law

Direct Liability

Direct liability

Google France cases

(Joined CJEU cases C-236/08, C-237/08 and C-238/08, 23 March 2010)

- ❑ Adword = 'trade mark use'
- ❑ An advertiser who bought a keyword the same or similar to a trade mark could be liable for infringement if the advertisement did not enable an average internet user to ascertain whether the goods or services referred to originated from the owner of the trade mark or an undertaking economically connected to it

Cosmetic Warriors Ltd -v- Amazon.co.uk Ltd
[2014] EWHC 181 (Ch)



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Cosmetic Warriors -v- Amazon.co.uk Ltd

Advertisement Type #1

Lush Soap at Amazon.co.uk
www.amazon.co.uk/lush+soap
amazon.co.uk is rated *****
Low prices on Lush Soap
Free UK Delivery on Amazon Orders.



Cosmetic Warriors -v- Amazon.co.uk Ltd

Advertisement Type #2

[Bomb Bath at Amazon.co.uk](#)

www.amazon.co.uk/bomb+bath

amazon.co.uk is **rated *******

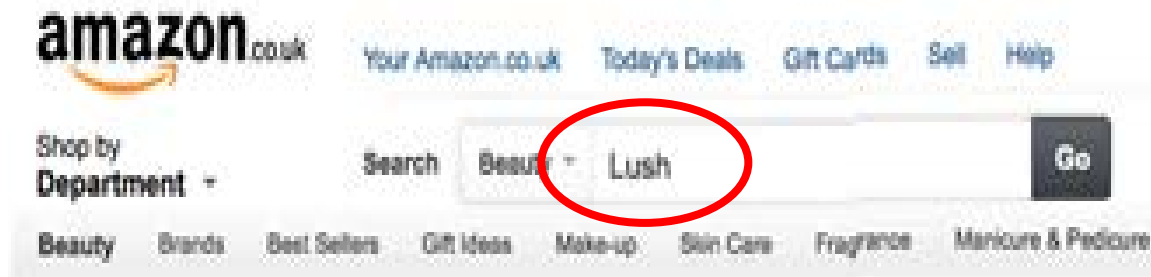
Low prices on Bomb Bath

Free UK Delivery on Amazon Orders.



Cosmetic Warriors -v- Amazon.co.uk Ltd

Website Use #1: Drop down menu



Cosmetic Warriors -v- Amazon.co.uk Ltd

Website Use #2:

Repeat of consumer request and related searches



Cosmetic Warriors -v- Amazon.co.uk Ltd

Website Use #3:
Brands List



A screenshot of the Amazon.co.uk website's navigation menu. The 'Brands' filter is active, showing a list of brands. The 'Lush' brand is circled in red. The menu also shows 'Beauty' and 'Best Sellers' filters, and a list of departments under 'Beauty' including 'Bath Bombs (29)', 'Bath & Body (109)', 'Skin Care Gift Sets (27)', 'Sets (52)', 'Skin Care (79)', 'Soaps & Hand Wash (7)', 'Bubble Bath (22)', 'Hand & Nail Creams (1)', 'Hair Extensions (208)', and 'Polish (8)'. There is also a 'Delivery Option' section with 'FREE Super Saver Delivery' and a 'Brand' section with 'Bomb Cosmetics' and 'Lush' circled in red.

Cosmetic Warriors -v- Amazon.co.uk Ltd

Key Points

Sponsored ads without third party mark

Generally not a problem:

- consumers familiar with sponsored ads
- used to seeing ads from competitors

≠ *Interflora –v- M&S?*

- 'the network effect'
- retrial

Website uses: search function

Free competition and access to technological developments

vs

IP rights

Relevance of unavailability of LUSH goods: LUSH as generic indicator

What if goods were available?

Trade Mark Functions

Infringing uses affected following functions:

- Origin
- Advertising
- investment

Case Law

Indirect Liability

Indirect liability

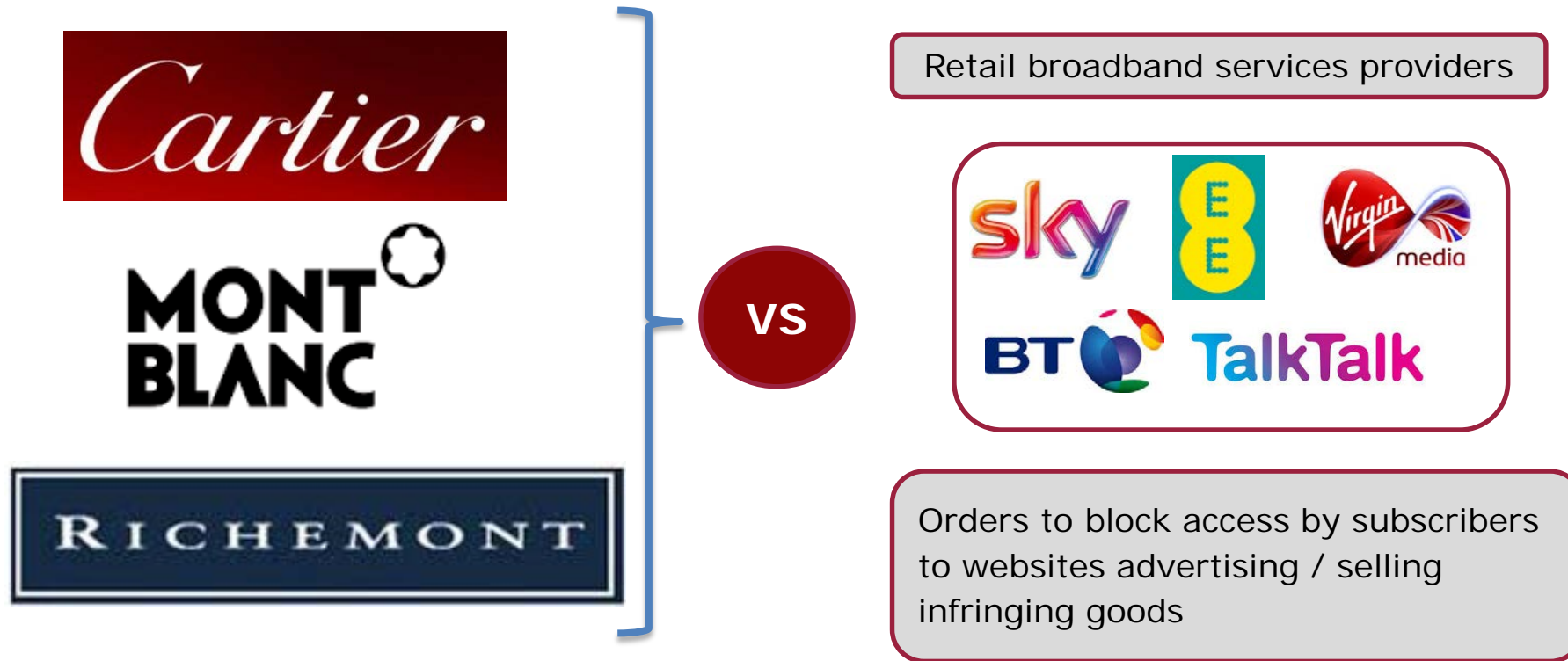
Google France cases

(Joined CJEU cases C-236/08, C-237/08 and C-238/08, 23 March 2010)

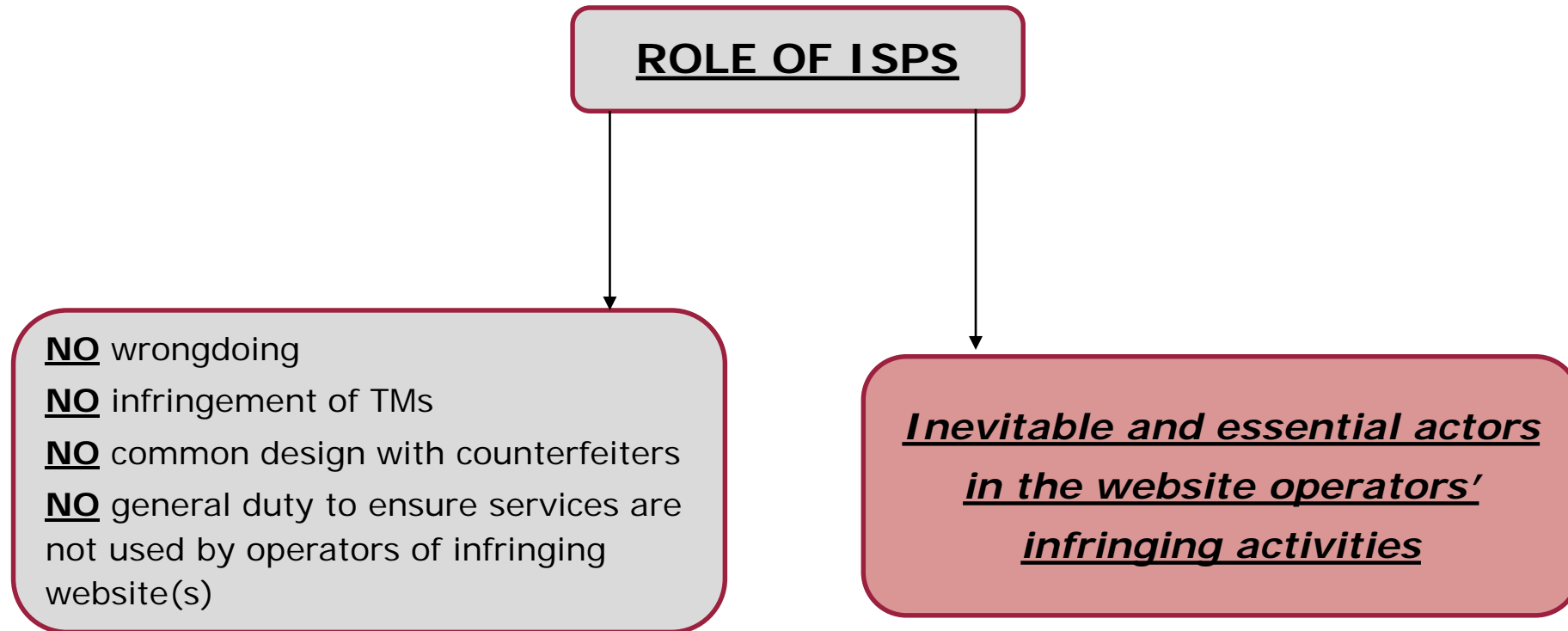
- No trade mark use by Google
- An ISP not liable for infringement merely because it stored the keyword and used it to organise the display of advertisements
- Unless it played an active role (= had knowledge of or control over what the advertiser was doing)
- Or unless it had failed to act expeditiously once aware of infringing activity

Blocking injunctions against ISPs

- *Cartier & Ors -v- BSkyB Ltd & Ors* [2016] EWCA Civ 658
- *Cartier & Anor -v- BT Plc & Ors* [2016] EWHC 339 (Ch)



Blocking injunctions against ISPs



Blocking injunctions against ISPs

THRESHOLD CONDITIONS FOR GRANT OF ORDER



1. Is the ISP an 'intermediary'?
2. Are the operators of the target website infringing the trade marks?
3. Do the operators use the ISP's services to infringe the trade marks?
4. Does the ISP have actual knowledge of this?

Blocking injunctions against ISPs

IS IT JUST AND CONVENIENT TO DO SO?



Relief must

1. Be **necessary**
2. Be **effective**
3. Be **dissuasive**
4. **Not** be **unnecessarily complicated or costly**
5. Avoid barriers to legitimate trade
6. Be fair and equitable and strike a fair balance between fundamental rights
7. Be proportionate

Cosmetic Warriors -v- Amazon.co.uk Ltd

Open Issues

Expensive remedy

Availability of pan-EU orders?

Who pays for implementing order?

Impact of Brexit

Future effectiveness

Case law

Domain Names

Domain Names

RBS Group



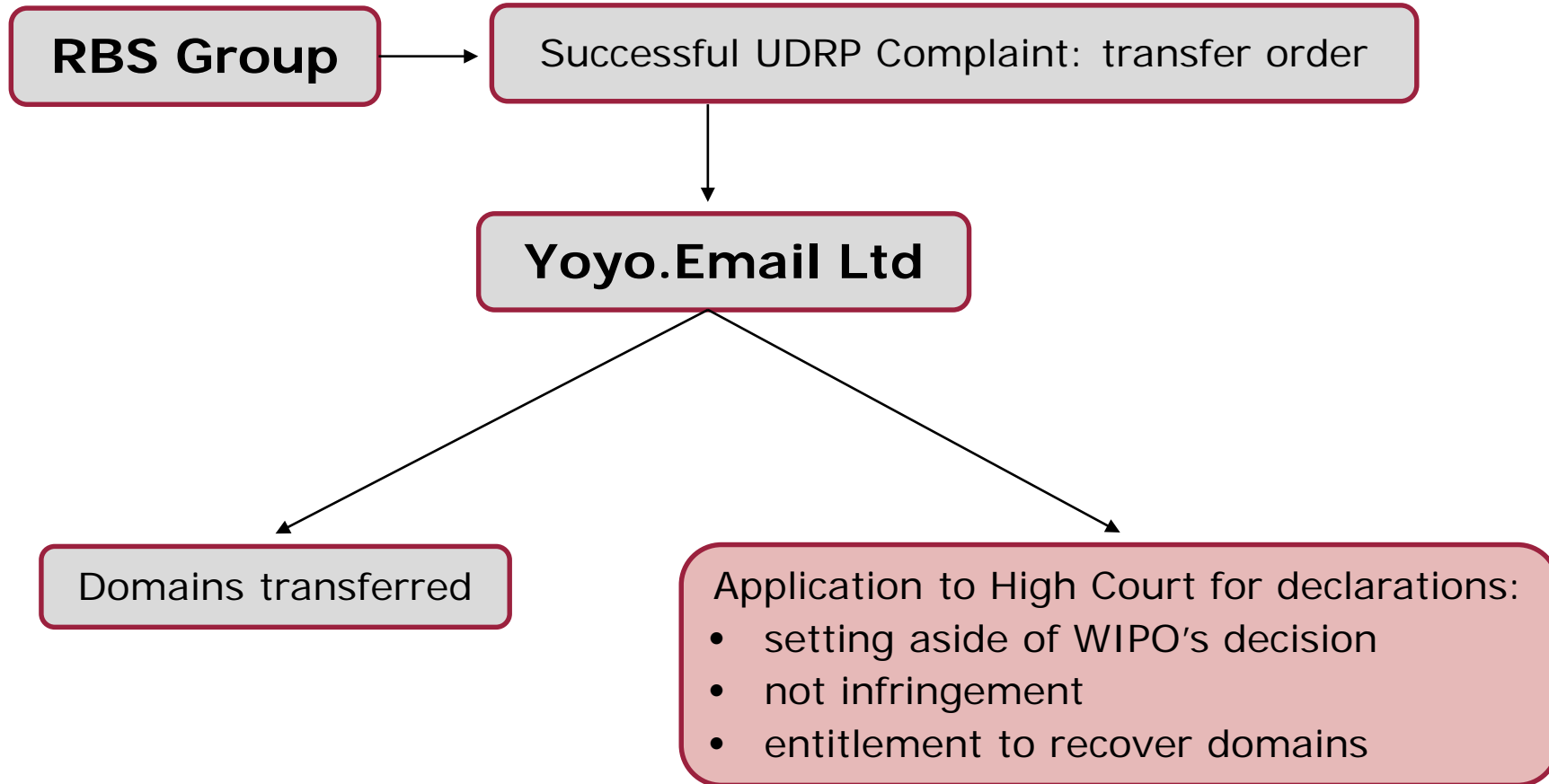
VS

Yoyo.Email Ltd



- rbsbank.email
- rbs.email
- natwest.email
- coutts.email

Domain Names



Domain Names

Can High Court set aside Panel's Decision?

Clause 4(k) UDRP – Availability of Court Proceedings

“The mandatory administrative proceeding requirements set forth in Paragraph 4 shall not prevent either you or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded [...]”

- Clause 4(k) does not give rise to a separate cause of action
- High Court not entitled to act as appeal or review body in relation to UDRP decisions

Domain Names

Does registration of domain name constitute passing off?

YES

- Mere registration makes a misrepresentation
- Passing off occurs at the point of registration
- Not necessary to consider registrant's intended use and steps it would take to avoid confusion
- Not necessary to conclude whether registration of domain names was, by itself, an instrument of fraud

Passing off claim or UDRP complaint?

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THANK YOU FOR LISTENING!

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