



ONLINE TRADE MARK INFRINGEMENT

Carlos Manuel Gonçalves de Melo Marinho

Judge of the Intellectual Property Chamber of the Lisbon Court of Appeal

Senior Expert in EU Law, Judicial Cooperation and e-Justice



Internet vs Physical World

- Similar needs for regulatory intervention and surveillance;
- Identical risks and opportunities;
- Loss of a cross-border hiding effect;
- Global monitoring.



Emerging Effects

- (a) A more rigorous management and protection;
- (b) The need for permanent watching;
- (c) A potentially exponential increase of litigiousness due to:
 - (c.1) cybersquatting;
 - (c.2) no control like for trade mark grounds of refusal;
 - (c.3) increase of undue evocations of infringements.



Domain names disputes

- Conflicts move to the digital field;
- A crossroad between trade mark and domain name protection;
- Complex legal analysis vs simple guidelines control;
- Asymmetric protection;
- Difficulty to deal with accomplished facts;
- Huge commercial relevance.



Domain names disputes' approaches

- Outside the classical trade mark approach;
- Need for public policy;
- Need for prevention – the *sunrise period*;
- General rejection of the bad faith;
- Similarity of marks/names is only a factor.



Evaluation

- (a) Ownership;
- (b) Previous use;
- (c) Prior attempt to sell;
- (d) Lack of intention to use;
- (e) Preceding history;
- (f) Use of forged and false information;
- (g) Strong public knowledge.



EU Public policy rules

(a) Phased registration

(b) Revocation;

(c) Objective unlawfulness:

(c.1) Identity or confusing character;

(c.2) Previous recognition of the challenged right;

(d) Subjective elements:

(d.1) Lack of legitimate interest;

(d.2) Bad faith.



Legitimate interest

- (a) Prior use or preparation;
- (b) Common knowledge;
- (c) Legitimate, non-commercial or fair use.



Bad faith

- (a) Purpose of selling, renting, or otherwise transferring the domain name; or
- (b) Purpose of preventing the reflection of a name in a domain name, provided that:
 - (i) a pattern of such conduct can be demonstrated;or
 - (ii) the domain name has not been used; or
 - (iii) failure to use the domain name within six months;
- (c) Purpose of disrupting the professional activities of a competitor; or
- (d) Purpose of attracting Internet users, for commercial gain;
- (e) Non demonstrable link.



Key Changes in .eu Domain Regulation (EU) 2019/517

- Expanded Eligibility
EU citizens worldwide can register, not limited to EU residents.
- Stronger Abuse Prevention
Enhanced mechanisms against cybersquatting and bad-faith registrations.
Cooperation with law enforcement and cybersecurity authorities.
- Improved Dispute Resolution
Streamlined, transparent, and faster Alternative Dispute Resolution (ADR) processes.
- Data Verification & Accuracy
Stricter verification of registrant identity and data accuracy.
Procedures for correction or revocation if non-compliance detected.



Governance, Rights Protection & Future-Proofing

- Transparency & Governance
Clearer rules for Registry accountability and reporting to the European Commission.
- Protection of Rights & Public Interest
Maintains sunrise periods for trade mark holders.
Allows revocation/blocking of domains found defamatory, racist, or illegal by courts.
- Adaptation to Technological Changes
Flexible framework to respond to future market and tech developments.



ICANN Rules – administrative proceeding

- (a) Selection of a Provider;
- (b) Submission of a complaint;
- (c) Absence of discovery or witness confrontation.



Demonstration (Applicant)

- (a) Trade mark “*identical or confusingly similar*”;
- (b) Party that registered has “*no rights or legitimate interests*”;
- (c) Domain name registered and used in bad faith.

Demonstration (Defendant)

- (a) *Bona fide*; or
- (b) Commonly knowledge by the domain name; or
- (c) Legitimate non-commercial or fair use.



Remedies

- (a) Request for cancellation;
- (b) Request for transfer.

Access to court

- (a) Before the mandatory administrative proceeding is commenced; or
- (b) After such proceeding is concluded.



Case Law

EU

- ECJ Case C-657/11, Belgian Electronic;
- ECJ Case C-569/08, Internetportal.

WIPO

- Case No. D2009-0976, Su Kutusu;
- Case No. D2009-0913, Grey-Hen;
- Case No. D2009-0767, Horoz;
- Case No. D2009-0865, Société des Produits Nestlé S.A.



e-Commerce liability

- Need: stop unjustified geo-blocking.
- Tension between:
 1. Recognition of the value of e-commerce; and
 2. Fight against the violation of rights and consumer protection.
- Legal approach: e-Commerce Directive 2000/31/EC.



Secondary liability (cont.)

Major differences:

- (a) Taking of evidence;
- (b) Dealing with the acts of the intermediaries.

Requisites of the secondary liability:

- Joined Cases C-236/08 to C-238/08, Google France SARL;
- Case C-324/09, L'Oréal SA.



Key Case Law on trade marks and the Internet

- European Union
 1. Google France SARL and Google Inc. v Louis Vuitton Malletier SA (C-236/08, C-237/08, C-238/08, CJEU, 2010)
 2. Interflora Inc. v Marks & Spencer plc (C-323/09, CJEU, 2011)
 3. L'Oréal SA v eBay International AG (C-324/09, CJEU, 2011)
 4. Arsenal Football Club plc v Reed (C-206/01, CJEU, 2002)
 5. Coty Germany GmbH v Amazon (C-567/18, CJEU, 2020)



Key Case Law on trade marks and the Internet

- United States
 1. Brookfield Communications, Inc. v. West Coast Entertainment Corp., 174 F.3d 1036 (9th Cir. 1999)
 2. Playboy Enterprises, Inc. v. Netscape Communications Corp., 354 F.3d 1020 (9th Cir. 2004)
 3. Rescuecom Corp. v. Google Inc., 562 F.3d 123 (2d Cir. 2009)
 4. Tiffany (NJ) Inc. v. eBay Inc., 600 F.3d 93 (2d Cir. 2010)
- United Kingdom

Argos Ltd v Argos Systems Inc [2018] EWCA Civ 2211
- Germany

Bananabay II (BGH, I ZR 125/07, 2011)