



Trademarks on the Internet

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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 trademark grounds of refusal;
 - (c.3) increase of undue evocations of infringements.



Domain names disputes

- Conflicts move to the digital field;
- A crossroad between trademark 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 trademark 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 – Regulation (EU) 2019/517

- (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.



ICANN Rules – administrative proceeding

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



Demonstration (Applicant)

- (a) Trademark “*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

- ISPs: no general obligation to monitor...
 - Restriction – obligation *‘to inform ... or communicate ...’*
- Secondary liability – against registrars and administrative contacts.
- To hear a case:
 - is similar to evaluating any trademark infringement without digital content.



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.