



CLASS 9

14 APRIL 2020







INFORMATION TECHNOLOGY
LAW IN THE GLOBAL SOCIETY

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14. Branding, trademarks, and domain names

Forbes The World's Most Valuable Brands

	Rank	Brand	Brand Value
	#1	Apple	\$205.5 B
	#2	Google	\$167.7 B
	#3	Microsoft	\$125.3 B
	#4	Amazon	\$97 B
	#5	Facebook	\$88.9 B
	#6	Coca-Cola	\$59.2 B

Forbes 2019 List

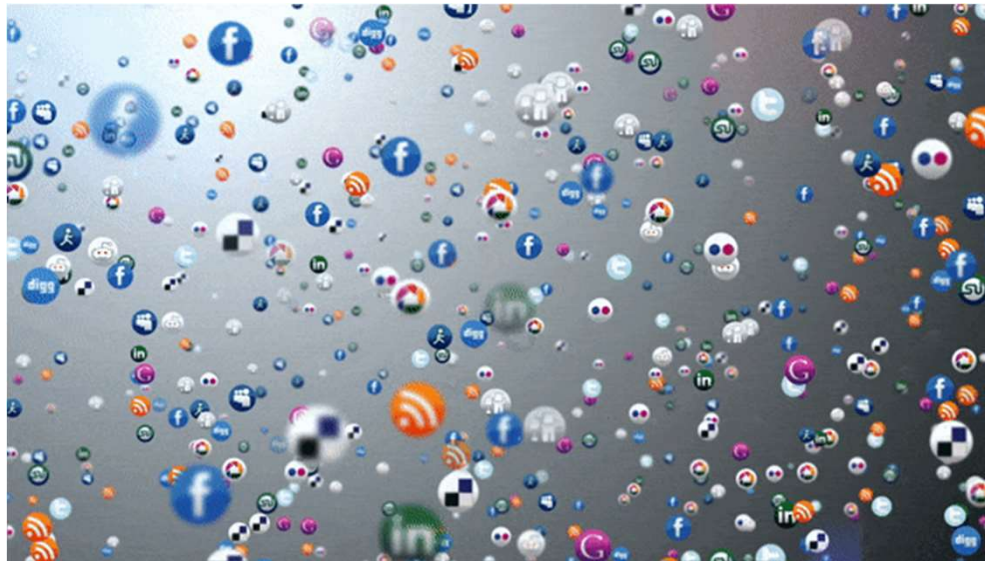
Difference between a Brand and a Trademark

Brand: the image and reputation of the business in the public eye.

Trademark: a right that provides legal protection for of the brand that are unique and specific to the company.



14.1 Trademarks in the global business environment





Trademarks: A Definition

A trademark is a distinctive sign or indicator used by an individual, business organisation, or other legal entity to identify that the products or services to consumers with which the trademark appears originate from a unique source, and to distinguish the products or services in question from those of other entities.

A trademark is a type of intellectual property, and typically a name, word, phrase, logo, symbol, design, image, or a combination of these elements



Registered and unregistered trademarks

- The laws of most countries do not afford legal protection for unregistered trademarks.
- However, the laws of the United Kingdom, the United States, and many countries that inherited legal systems from England do provide some protection for unregistered marks.
- In the United Kingdom: the tort of “passing off” protects the goodwill of a business against deceptive practices.
- In the USA, passing off under state law or under the federal Lanham Act.

Registration of Trademarks

In the European Union, a business may register a trademark under

- Under national law (which is harmonized by Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks).
 - Valid only within national territory.
- Under the EU law (Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark).
 - Valid throughout the EU.



Saeima ir pieņēmusi un Valsts
prezidents izsludina šādu likumu:

Preču zīmju likums

I nodaļa Vispārīgie noteikumi

1. pants. Likumā lietotie termini

Likumā ir lietoti šādi termini:

1) **Eiropas Savienības Intelektuālā īpašuma birojs, Eiropas Savienības birojs** — Eiropas Savienības aģentūra, kas veic Eiropas Savienības preču zīmju un Kopienas dizainparaugu reģistrāciju, kā arī pilda citas ar intelektuālā īpašuma aizsardzību saistītas funkcijas Eiropas Savienībā atbilstoši Eiropas Parlamenta un Padomes 2017. gada 14. jūnija regulai (ES) [2017/1001](#) par Eiropas Savienības preču zīmi (turpmāk — regula (ES) [2017/1001](#)) un citiem Eiropas Savienības normatīvajiem aktiem;

2) **Eiropas Savienības preču zīme** — preču zīme, kas reģistrēta attiecībā uz Eiropas Savienību saskaņā ar regulu (ES) [2017/1001](#) vai saskaņā ar agrāk spēkā bijušo Eiropas Savienības regulējumu par Kopienas preču zīmēm;

A New Latvian National Trademark Law

Entered into
force 6 March
2020

Incorporates norms from Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks.

How is a Trademark Infringed? (simplified)

Use of the same or a similar mark on same or similar goods or services for which the mark is registered in a way that is likely to confuse consumers.

In the case of well-known marks, by dilution of the mark even when the mark isn't used in a confusing manner.

Some Potential Defenses to Trademark Infringement

Exhaustion: Genuine goods placed on market in European Economic Area (EEA) by or with consent of trademark owner.

Articles 12-14 of the E-commerce Directive contain protection from liability for those acting as "mere conduits"

14.2 Domain names as badges of identity



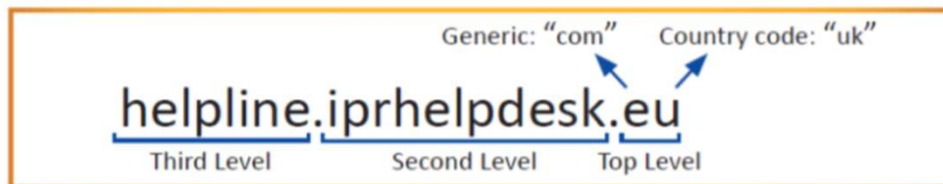
Domain Name Definition

“Domain names are the human-friendly forms of Internet addresses and are commonly used to find web sites.”

1.1. Domain name levels

Domain names are classified in three hierarchical levels:

- **Top level:** The top level of a domain name is located after the last dot ("."). For example, in "iprhelpdesk.eu", the top level domain is "eu". There are two types of top-level domains:
 - generic Top Level Domain (gTLD): indicates the area of activity (e.g. ".com" for any purposes or ".biz", restricted to businesses);
 - country code Top Level Domain (ccTLD): indicates the country or territory in which the domain owner intends to operate (e.g. ".uk" for the UK or ".eu"³ for the European Economic Area).
- **Second level:** The second level of a domain name is located directly to the left of the top-level domain. For example, in "iprhelpdesk.eu", the second level domain would be "iprhelpdesk". Most domain name disputes concern this type of domain.
- **Third level:** The third level of a domain name, also known as a subdomain, is located directly to the left of the second-level domain. For example, in "helpline.iprhelpdesk.eu", the third level domain would be "helpline". Not every address has this level as it is often used to identify the different sections of a website, usually corresponding to different departments in large organisations.



Domain Name Levels

Expansion of gTLDs since 2008

More than 1,000 new generic Top Level Domains (gTLDs)

.academy .feedback
.app .gallery
.book .healthcare
.catering
.dating
.exchange



**This expansion
opened new
possibilities for
cybersquatting**



Cybersquatting & Typosquatting

Cybersquatting: practice of registering names, especially well-known company or brand names, as Internet domains, in the hope of reselling them at a profit.

Typosquatting: a form of cybersquatting (sitting on sites under someone else's brand or copyright) that targets Internet users who incorrectly type a website address into their web browser (e.g., "Gooogle.com" instead of "Google.com")

Reasons for Cybersquatting

Cybersquatters target distinctive marks for a variety of reasons. Some register well-known brand names as Internet domain names in order to extract payment from the rightful owners of the marks, who find their trademarks "locked up" and are forced to pay for the right to engage in electronic commerce under their own brand name.

* * *

Others register well-known marks as domain names and warehouse those marks with the hope of selling them to the highest bidder, whether it be the trademark owner or someone else.

* * *

In addition, cybersquatters often register well-known marks to prey on consumer confusion by misusing the domain name to divert customers from the mark owner's site to the cybersquatter's own site, many of which are pornography sites that derive advertising revenue based on the number of visits, or "hits," the site receives.



From Senate Report 106-140 on the Anticybersquatting Consumer Protection Act (August 5, 1999)



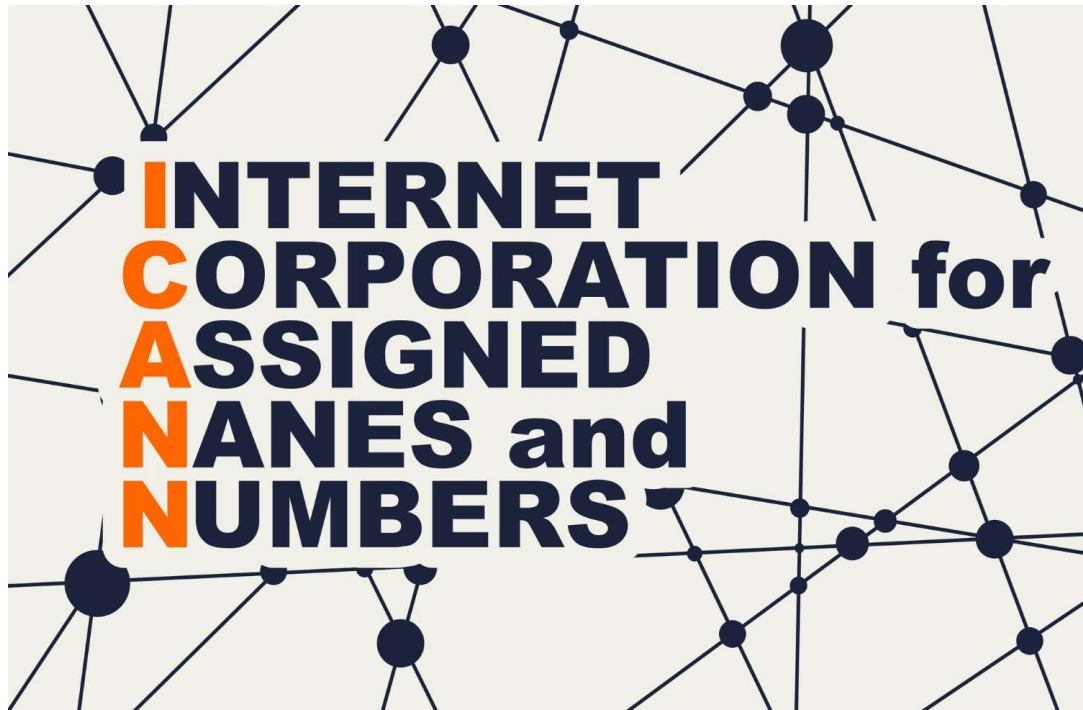
Cybersquatting
before the UK
courts

US Law: Anticybersquatting Consumer Protection Act 15 U.S.C. § 1125(d)

Established a cause of action for registering, trafficking in, or using a domain name confusingly similar to, or dilutive of, a trademark or personal name.

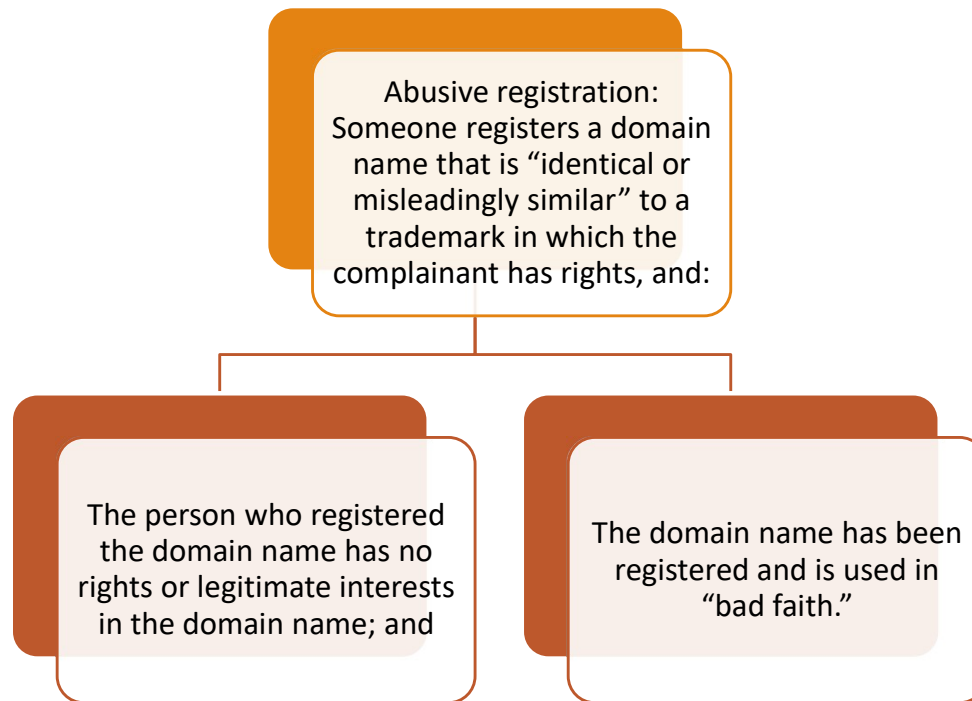
Makes it illegal for a person to register an internet domain name that is “identical or confusingly similar” to the trademark of another person or company, with the “bad faith” intent to profit from that mark.





The ICANN Uniform Dispute Resolution Procedure (UDRP)

The UDPR Remedy for Abusive Registration of a Domain Name



What is “Bad Faith?”

The UDRP gives examples of bad faith:

- Registration was primarily for purpose of selling/renting/assigning the domain name, for a profit, to the person who owns the trademark or that person’s competitor; or
- Registration was done to prevent the trademark owner from using the mark as a domain name, when the person doing the registration has engaged in a pattern of such conduct; or
- Registration was primarily for purpose of disrupting business of a competitor; or
- Use of the domain name was for the purpose of attracting traffic to one’s own website for commercial gain, by creating a likelihood of confusion about the source/sponsorship/affiliation/endorsement of the website or of a product or service on the website.



dishonest



DOMAIN
FOR SALE!

Defenses in a Domain Dispute

Without prior notice, the registrant used or prepared to use the domain name in connection with a bona fide offering of goods or services.

The registrant is commonly known by the domain name.

The registrant makes a legitimate noncommercial or fair use of the domain name without intending commercial gain to misleadingly divert consumers or tarnish the trademark.

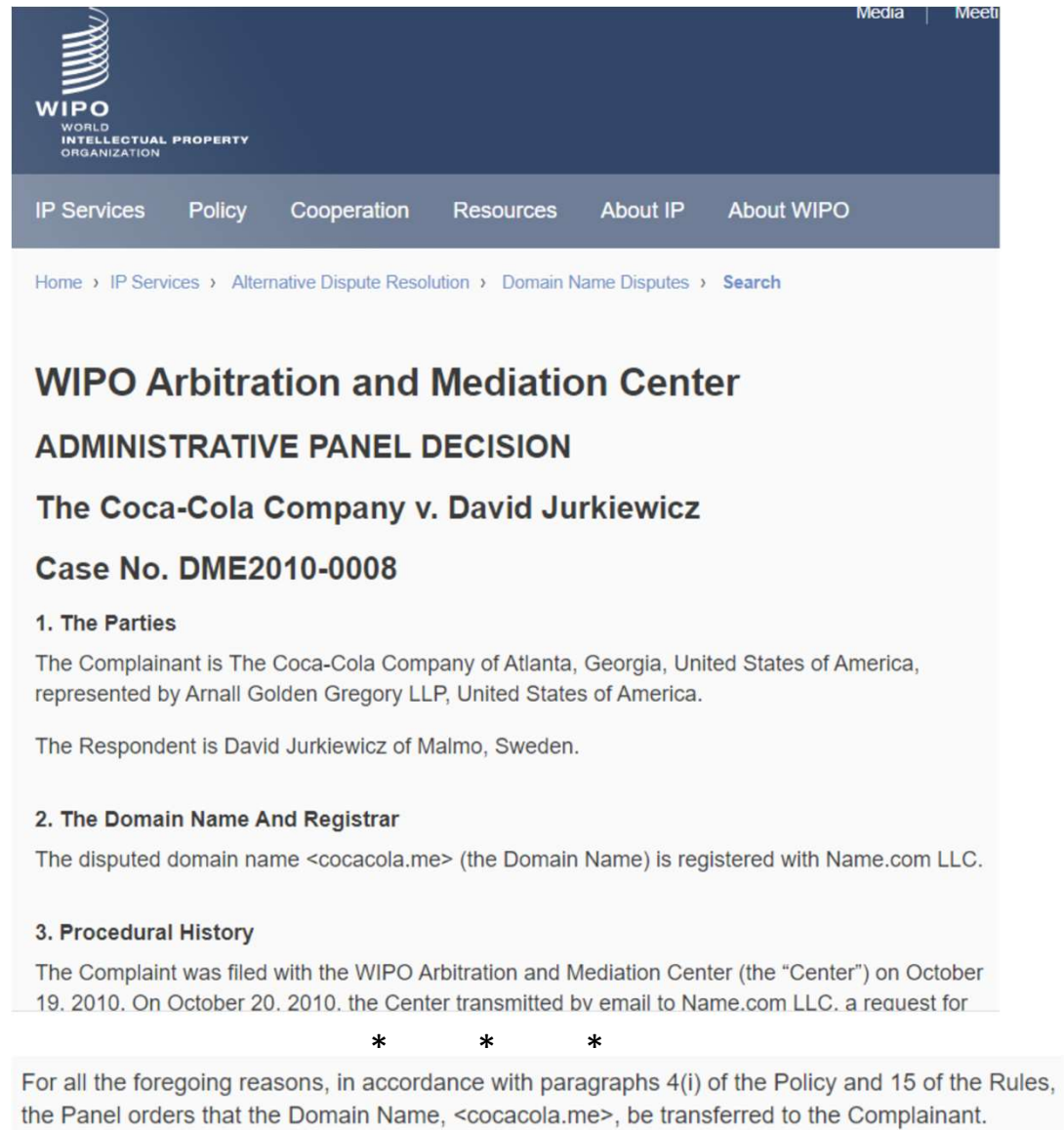
An Example of a UDRP Dispute

Swedish man registers the domain name cocacola.me and “points” it to www.pepsi.com.

The Coca-Cola Company files a complaint with the WIPO Arbitration & Mediation Center.

Evidence of bad faith:

The Complainant’s COCA-COLA mark is one of the most famous trademarks in the world, and it is inconceivable that the Respondent could have been unaware of it when he registered the Domain Name. “COCA-COLA” is also a sufficiently distinctive expression that any registration of a domain name substantially similar to it immediately suggests opportunistic bad faith on the part of the registrant.



The screenshot displays the WIPO Arbitration and Mediation Center website. The header features the WIPO logo and navigation links for Media, Meetings, IP Services, Policy, Cooperation, Resources, About IP, and About WIPO. The breadcrumb trail indicates the path: Home > IP Services > Alternative Dispute Resolution > Domain Name Disputes > Search. The main heading is "WIPO Arbitration and Mediation Center ADMINISTRATIVE PANEL DECISION". The case title is "The Coca-Cola Company v. David Jurkiewicz" with Case No. DME2010-0008. The decision is structured into three sections: 1. The Parties, 2. The Domain Name And Registrar, and 3. Procedural History. The first section identifies the Complainant as The Coca-Cola Company of Atlanta, Georgia, United States of America, represented by Arnall Golden Gregory LLP, and the Respondent as David Jurkiewicz of Malmö, Sweden. The second section states that the disputed domain name <cocacola.me> is registered with Name.com LLC. The third section notes that the complaint was filed on October 19, 2010, and the Center transmitted it by email to Name.com LLC on October 20, 2010. The decision concludes with three asterisks and a final paragraph stating that the Panel orders the domain name <cocacola.me> to be transferred to the Complainant.

Media | Meetings

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

IP Services Policy Cooperation Resources About IP About WIPO

Home > IP Services > Alternative Dispute Resolution > Domain Name Disputes > Search

WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

The Coca-Cola Company v. David Jurkiewicz

Case No. DME2010-0008

1. The Parties

The Complainant is The Coca-Cola Company of Atlanta, Georgia, United States of America, represented by Arnall Golden Gregory LLP, United States of America.

The Respondent is David Jurkiewicz of Malmö, Sweden.

2. The Domain Name And Registrar

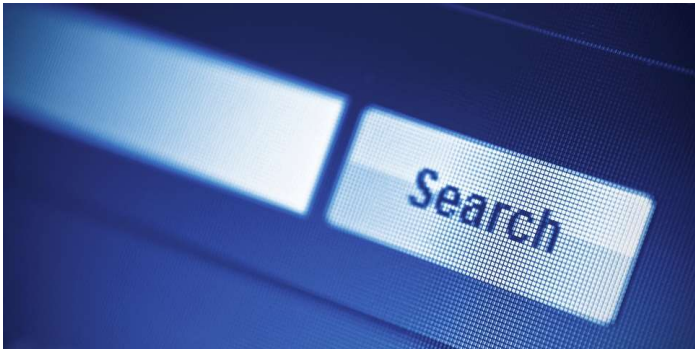
The disputed domain name <cocacola.me> (the Domain Name) is registered with Name.com LLC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 19, 2010. On October 20, 2010, the Center transmitted by email to Name.com LLC, a request for

* * *

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name, <cocacola.me>, be transferred to the Complainant.



15. Brand identities, search engines, and secondary markets

Jurisdiction and online trademark disputes

Wintersteiger AG case on page 391 of
textbook.



Search engines

A Louis Vuitton Handbag

From the Forbes 2019 List of Top
Brands



#12 Louis Vuitton

\$39.3 B



Use of Trademarks as Keywords in Internet Advertising

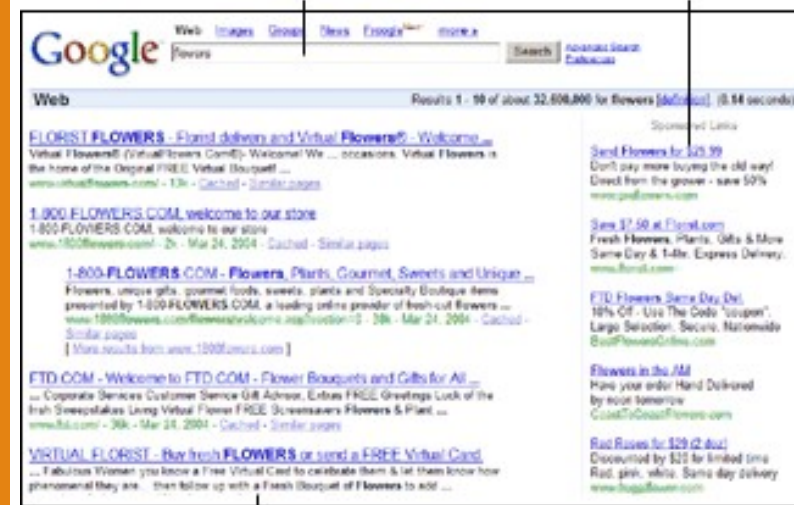
Google France SARL and Google Inc. v Louis Vuitton Malletier SA (C-236/08)

Vuitton sought to stop its competitors buying its trademarks as keywords.

Held that Google itself was not using the mark within the meaning of the case law. Rather, Google was selling advertising space.

However, companies that advertise are using the mark within the meaning of case law when purchasing keywords. Can incur liability if use interferes with function of mark.

“The function of indicating origin of the mark is adversely affected if the ad does not enable normally informed and reasonable attentive internet users, or enables them only with difficulty, to ascertain whether the goods or services referred to by the ad originate from the proprietor of the trade mark or a third party.”

Search Term	AdWords Ads
	

Search Results



Use of Trademarks as Keywords in Internet Advertising

Interflora v Marks & Spencer, Case C-323/09 (22 September 2011)

- Use of a trademark by an advertiser as keyword to produce a sponsored link is a “trademark use” – use in the course of trade in relation to the advertiser’s goods or services – even if the keyword does not appear in the advertisement.
- The advertiser can incur liability if use interferes with function of mark.



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<https://commons.wikimedia.org/w/index.php?curid=41968128>

Secondary markets

3 eBay cases mentioned on pages 403-04 of Textbook.

Auction site eBay was sued for trademark infringement because sellers listed—

- Counterfeit goods and
- Genuine but unlicensed goods in which trademark owner's rights weren't exhausted because goods had not been introduced within the European Economic Area by or with consent of the trademark owner.
- eBay tried to defend under Article 14 of E-Commerce Directive.
 - Art. 14: 1. Where an information society service is provided that consists of the storage of information provided by a recipient of the service, Member States shall ensure that the service provider is not liable for the information stored at the request of a recipient of the service, on condition that:
 - (a) the provider does not have actual knowledge of illegal activity or information and, as regards claims for damages, is not aware of facts or circumstances from which the illegal activity or information is apparent; or
 - (b) the provider, upon obtaining such knowledge or awareness, acts expeditiously to remove or to disable access to the information.
 - 2. Paragraph 1 shall not apply when the recipient of the service is acting under the authority or the control of the provider.



For Next Week

PLEASE READ
CHAPTERS 16
(ELECTRONIC
CONTRACTS) AND 17
(ELECTRONIC
PAYMENTS &
CRYPTOCURRENCY)