TRADEMARK CASE LAW PUTS ‘EXTRAORDINARY BURDEN OF PROOF’ ON CLAIMANTS - LENER

Posted on 16/03/2016

Category: Uncategorized
Tag: cat-disputeresolution

Clients’ rights to brand exclusivity are being seriously threatened by “concessions and forced case-law constructions”

New concessions and case law concerning the unauthorised use of trademarks in internet search engines mean that, in any related litigation, there will be an “extraordinary burden of proof on claimants to provide evidence of the risk of confusion”.
This warning is issued by Javier Matanzo, partner in the litigation and arbitration department at Lener, who adds that such developments demonstrate that the rights of exclusivity inherent to brands are being greatly undermined.
Matanzo explains that clients’ rights to brand exclusivity are being seriously threatened by “concessions and forced case-law constructions which, on a European level, are being made to legitimise the use – unauthorised by their proprietor – of signs of registered trademarks in internet search engines or which, at least, make it difficult for the proprietor to protect its trade mark”.
Matanzo adds that he is referring, firstly, to services that some internet operators offer that allow any

company to select keywords – irrespective of whether they have been registered as a trade mark – so that "advertising linked to its website is shown and, if selected by several advertisers (including the proprietor of the trade mark), prominence is given to the link of the competitor that pays a higher price per click".

Secondly, Matanzo highlights rulings from the European Court of Justice, which, he claims, effectively mean the proprietor of a "trademark with a reputation is only entitled to prevent a competitor from advertising on the basis of the keyword corresponding to that trade mark, where the competitor thereby takes unfair advantage of the distinctive character or repute of the trademark (free-riding) or where the advertising is detrimental to that distinctive character (dilutions) or to that repute (tarnishment)". Jesús Giner, an associate at Lener, adds that, until the doctrine changes, the "growing use of internet referencing services imposes challenges for which procedural laws are not well prepared".