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Enforcement of IPRs in the digital environment –Trademarks

Dr Galatea Kapellakou | Khaheti | 15.06.2021

IP enforcement forum

EU Georgia project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

www.eugipp.eu

Some Statistics – EUROSTAT, Internet uses

Internet use and online purchases, 2020

(% of individuals aged 16 to 74)

	Proportion of individuals who:	
	Used internet within the last 12 months	Purchased online within the last 12 months
EU-27 (*)	89	64

Internet use and online purchases, 2020

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EU-27 (*)	89	64
Belgium	92	73
Bulgaria	84	54
Czechia	89	72
Denmark	99	89
Germany	95	83
Estonia	90	68
France	88	74
Greece	86	46
Ireland	91	63
Italy	87	70
Lithuania	85	55
Latvia	88	38
Malta	97	47
Netherlands	96	56
Poland	87	54
Portugal	79	79
Romania	85	60
Slovenia	88	63
Slovakia	91	87
Finland	97	66
Sweden	97	81
Iceland	99	45
Norway	98	38
Switzerland (*)	97	62
United Kingdom	96	76
Montenegro	79	84
North Macedonia (*)	82	83
Serbia	79	85
Turkey	78	80
Bosnia and Herzegovina	74	90
Kosovo*	97	23
		29
		38
		33
		28
		46

89 % of individuals aged 16 to 74 in the EU had used the internet

(*) estimates

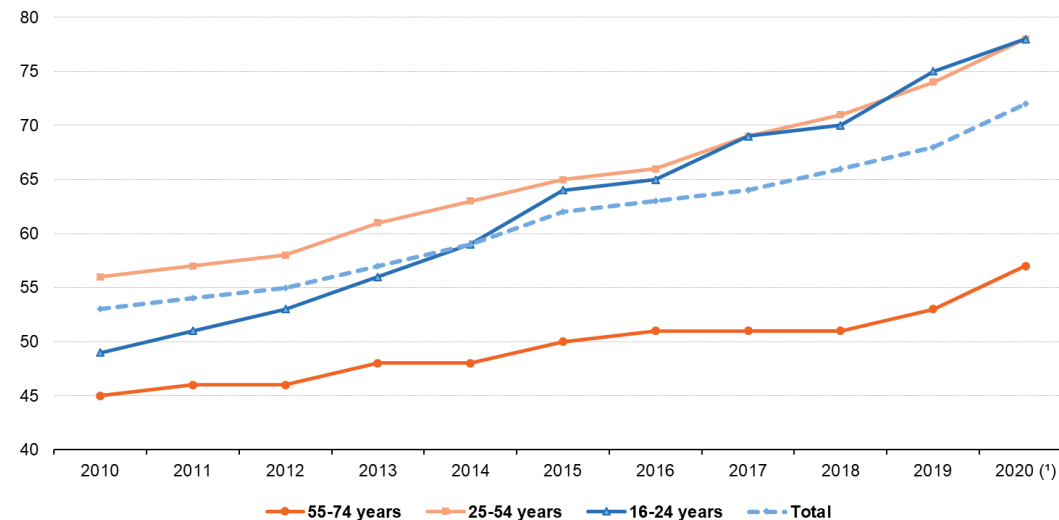
(*) 2019

(*) This designation is without prejudice to positions on status, and is in line with UNSCR 1244/99 and the ICJ Opinion on the Kosovo declaration of independence.

Source: Eurostat (online data codes: isoc_ei_ip_lu and isoc_ec_b20)

STATISTICS – EUROSTAT, Online purchases

Internet users who bought or ordered goods or services for private use in the previous 12 months by age group, EU-27, 2010-2020
(% of individuals who used internet in the previous 12 months)



(*) EU-27 estimates for 2020

Source: Eurostat (online data code: isoc_ec_ibuy and isoc_ec_ib20)

2020: more than 7 out of 10 internet users made online purchases in the same period.

Threats of TM rightholders in the Digital Environment

Sale & Distribution of IPR infringing goods

Cybersquatting and other TM infringing uses of DN

Fraud, extortion and other cybercrimes

Online infringement - types

Counterfeiters / Infringers
acting directly



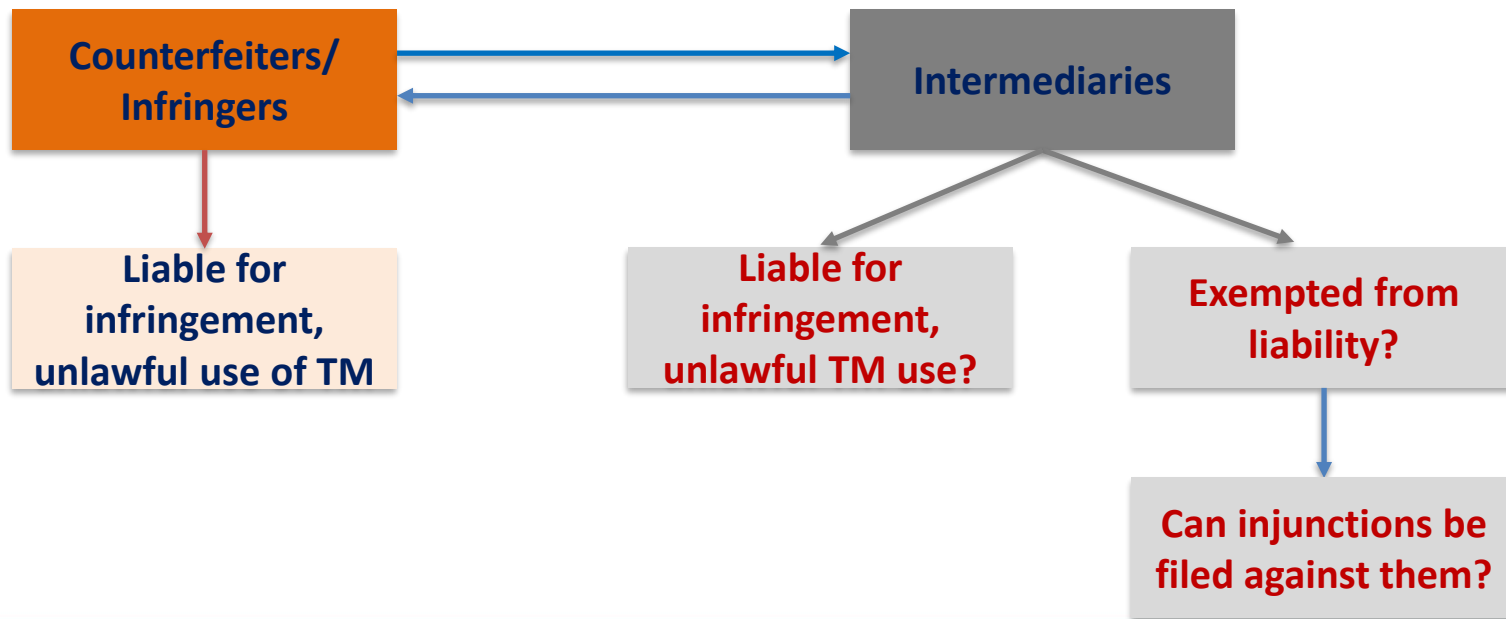
Suppliers' website

Counterfeiters/ Infringers
acting through
Intermediaries' platforms



- Search engines
- Online market places
- Social media
- Logistics Companies

Online infringement - types





Related EU legislation

E-commerce directive 2000/31/EC – Rules on liability of Information Society Service Providers

ACCESS PROVIDERS Art. 12

Mere conduit: mere transmission over a communication network of information provided by the recipient of the service, or access to a communication network

CACHING PROVIDERS Art. 13

Automatic, intermediate and temporary storage of information transmitted via the communication network, performed for the sole purpose of making more efficient the information's onward transmission to other recipients of the service upon their request

HOSTING PROVIDERS Art. 14

Hosting: storage of information provided by a recipient of the service

WEBSITE OWNERS/ CONTENT PROVIDERS

Content

E-commerce directive 2000/31/EC - Rules on liability of Information Society Service Providers

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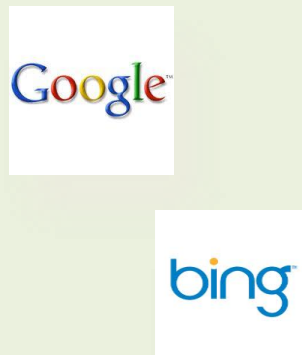
Content

E-commerce directive 2000/31/EC - Rules on liability of Information Society Service Providers

ACCESS PROVIDERS Art. 12



CACHING PROVIDERS Art. 13



HOSTING PROVIDERS Art. 14

Webservers
Blogs

WEBSITE OWNERS/ CONTENT PROVIDERS



E-commerce directive 2000/31/EC - Rules on liability of Information Society Service Providers

ACCESS PROVIDERS Art. 12

do not initiate the transmission; do not select the receiver of it; not select or modify its content;

CACHING PROVIDERS Art. 13

do not modify the information; comply with conditions on the access to the information; do not interfere with the lawful use of the technology; expeditiously

**Exempted from liability
(under specific circumstances)**

the initial source has been removed from the network, or access to it has been disabled, or that a court or an administrative authority has ordered such removal or disablement;

HOSTING PROVIDERS Art. 14

do not have actual knowledge of illegal information; expeditiously to remove or to disable the access to the information

WEBSITE OWNERS/ CONTENT PROVIDERS

Liable

E-commerce directive 2000/31/EC - Rules on Liability of Information Society Service Providers

ACCESS
PROVIDERS
Art. 12

CACHING
PROVIDERS
Art. 13

HOSTING
PROVIDERS
Art. 14

WEBSITE
OWNERS/
CONTENT
PROVIDERS



E-commerce directive 2000/31/EC - Rules on Liability of Information Society Service Providers

ACCESS
PROVIDERS
Art. 12

CACHING
PROVIDERS
Art. 13

HOSTING
PROVIDERS
Art. 14

WEBSITE
OWNERS/
CONTENT
PROVIDERS



Online market players' liability


Such providers have become important players in the online environment with significant market share.

Mismatch between the profit received by online intermediaries that permit advertisement and selling of infringing products and the damage suffered by the trademark owners when permitting or facilitating selling of counterfeits.

Contradictory application of the rules on operators' liability: are they using the trademark, directly infringing Trademarks Law or are they hosting illegal activities violating E-commerce directive? Or none of the above?




E-Commerce Directive 2000/31/EC




The exemptions only cover cases in which the intermediaries carry out **activities that are passive in nature**, limited to the technical process of operating and giving access to a communication network over which information made available by third parties is transmitted or temporarily stored, for the sole purpose of making the transmission more efficient (Recital 42)



The fact that intermediaries can be exempted from liability **does not affect the possibility of injunctions of different kinds** (Recital 45)



Article 15 E-Commerce Directive expressly forbids the Member States from imposing on the providers of such services a general obligation to monitor the information transmitted, or a general obligation to actively seek facts or circumstances indicating illegal activity.



Member States have the possibility to apply duties of care that can be reasonably expected from service providers in order to detect and prevent certain types of illegal activities (Recital 48).

Enforcement Directive 2004/48, - measures, procedures, remedies

Evidence

Right of
information

Provisional and
precautionary
measures

Measures
resulting from a
decision on the
merits of a case

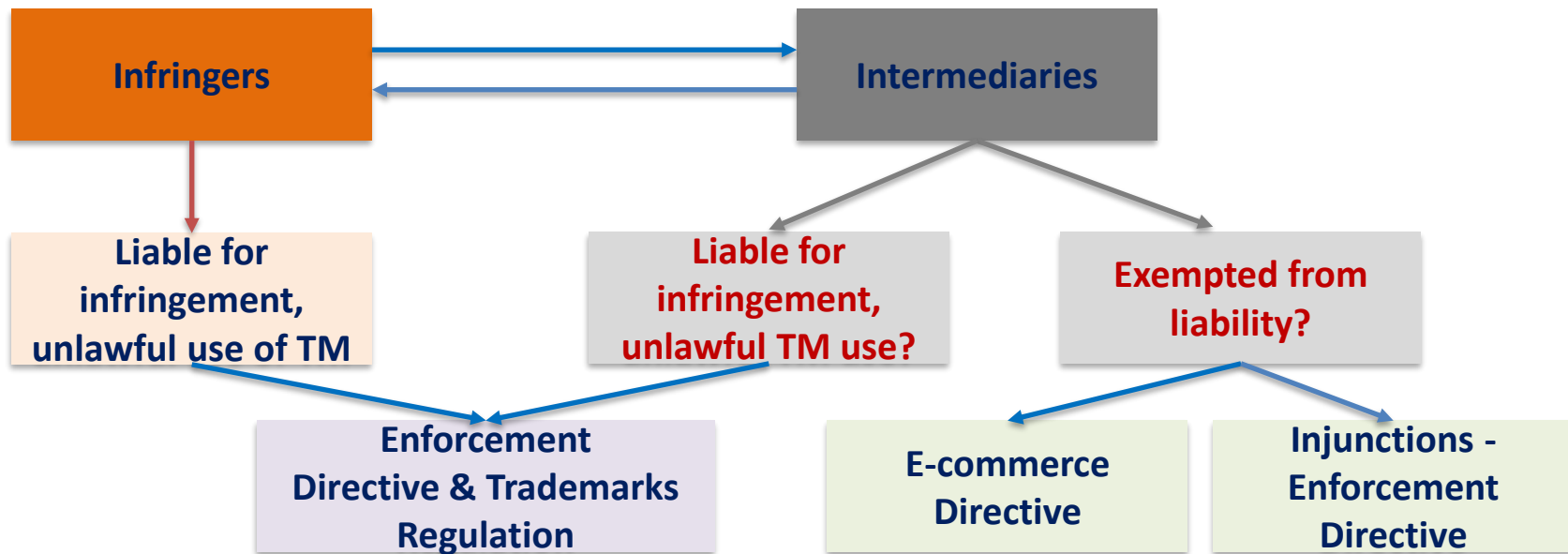
Damages and legal
costs

Publicity measures

Enforcement Directive, 2004/48, article 11

Member States shall ensure that, where a judicial decision is taken finding an infringement of an intellectual property right, the judicial authorities may issue against the infringer an injunction aimed at prohibiting the continuation of the infringement. Where provided for by national law, non-compliance with an injunction shall, where appropriate, be subject to a recurring penalty payment, with a view to ensuring compliance. **Member States shall also ensure that rightholders are in a position to apply for an injunction against intermediaries whose services are used by a third party to infringe an intellectual property right**, without prejudice to Article 8(3) of Directive [2001/29].

Online infringement - types



EUGIPP

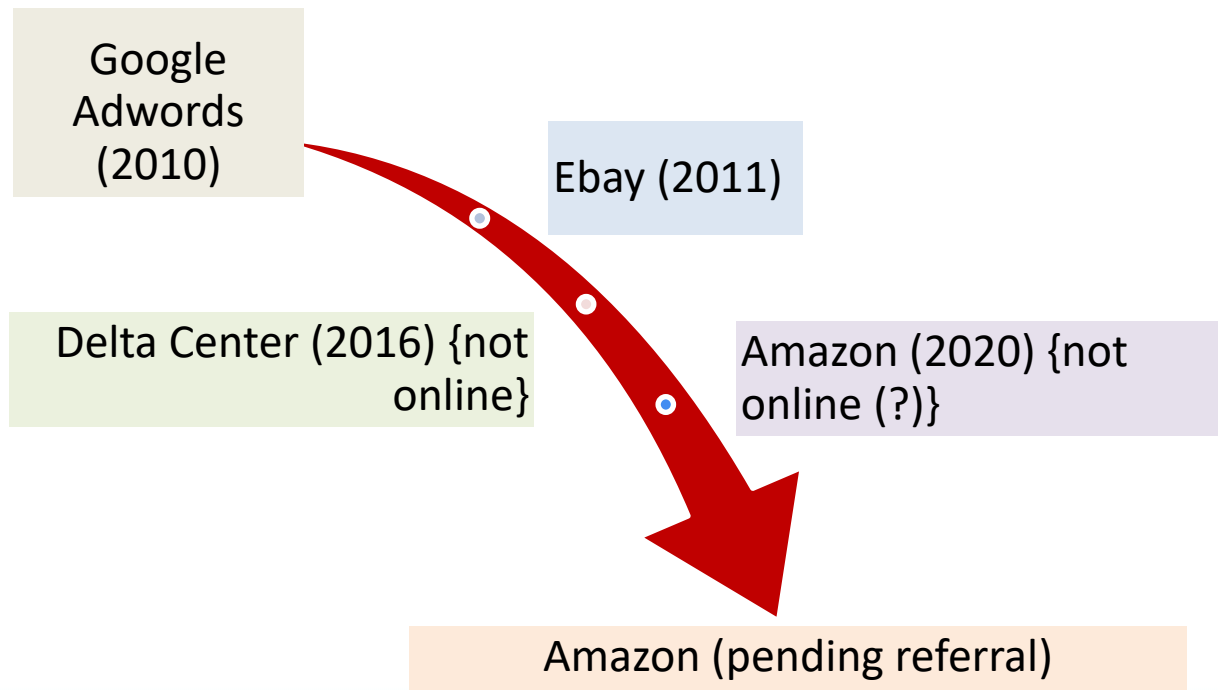
EU Georgia Intellectual Property Project

EUCJ Cases



EU GEORGIA project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

EUCJ cases related to intermediaries



Case Google, AdWords, / Luis Vuitton Joined Cases C-236/08 to C-238/08 and Case C-278/08 – Trademark infringement / Liability

Trademark infringement

- Google has not infringed. It is the advertisers who are using the trademark.
- The advertisers may have infringed because they were arranging for Google to display ads in a way that it was impossible for internet users to establish from what undertaking the goods or services of the ad originate.

Exemption from liability?

- The national court to examine whether the role played by Google is neutral, i.e. merely technical, automatic and passive or active.
- If not an active role there is no liability, unless, having obtained knowledge of the unlawful nature of the ads or of the advertiser's activities, it failed to act expeditiously to remove or to disable access to the data concerned.

Case L’Oreal v. Ebay, C-324/09, Trademark infringement / Liability

Trademark infringement

An online marketplace is not ‘using’ a trademark in circumstances where an end user has placed an offer for sale on the marketplace and that offer includes the rights holder’s trademarks. It was the seller who was ‘using’ those trademarks, rather than the website operator.

E-commerce directive – Exemption from liability

The operator of an online marketplace is not an intermediary **if it optimizes the presentation of the offers for sale or promoting such offers**. In this case the operator plays **an active role** of such a kind as to give it knowledge of, or control over, those data.

Injunctions

Member States must ensure effective protection of intellectual property. To do so, the national courts **must be allowed to order the operator of an online marketplace to take measures that contribute effectively** to the ending IPR infringements committed through that marketplace and **to preventing further infringements**.

Case Daimler AG v. Együd Garage, C-179/15 – Trademark infringement / Liability

- The trademark owner is not entitled to take legal action against the advertiser, when the advertiser has requested the operator to remove the advertisement but the operator disregarded the request.
- The rightholder may bring proceedings against operators for TM infringement, as it is the operator who is in this case "using" the TM.
- Reimbursement is possible.

Case Tommy Hilfinger v. Delta center A.S., C-494/15 — Market tenant (off line), injunctions

- Tenant of market halls who sublets sales points to third parties, some of whom are infringing IP rights.
- The Court clarified that such tenant falls within the concept of ‘an intermediary’.
- The conditions for injunctions against an intermediary in a physical marketplace are identical to those injunctions which may be addressed to intermediaries in an online marketplace as set out in L’Oréal-eBay.

Case Coty v. Amazon C-567/18, Trademark infringement / Liability

- Amazon's storage of the infringing Davidoff perfume bottles is not infringing Coty's TM as it does not make "use" of the TM.
- Amazon itself is not offering the goods for sale or putting them on the market.

Louboutin v Amazon C-148/21 & C- 184/21 – referral (pending)

Louboutin claims that Amazon is using unlawfully its TM.

The national court is asking EUCJ if Amazon could be found liable for infringement when displaying advertisements on its website because a) in the eyes of the well informed internet user the operator has played an active part in the preparation of the advertisement or b) that the advertisement is perceived by the well informed internet user as forming part of that operator's own commercial communication.

In addition, it claims that the shipment of infringing goods without the consent of the TM owner constitutes is an unlawful use of the TM.



EU actions

EU GEORGIA project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

EU actions

Follow the
money
approach

MoU

Digital
Services Act

Know your
Business
Customer

ODR

EU actions - follow the money approach, 2014

In 2014 the EU Commission issues the follow the money approach which complements the Enforcement Directive, aiming to stop the profit-making potential of IPR-infringing activities.

The “follow the money” approach translates into voluntary agreements between industry players, it strengthens the cooperation between the industry representatives.



IP Package, 2017

In November 2017, the European Commission confirmed the “follow the money” approach and presented a comprehensive package of measures to reduce counterfeiting and piracy.

In this context two Memoranda were concluded.

Voluntary cooperation schemes among intermediaries

**Memorandum of
understanding on the sale
of counterfeit goods on the
internet**

**Memorandum of
understanding on online
advertising and IPR**

MoU on the sale of counterfeit goods on the internet

Voluntary agreement bringing together major internet platforms and rightholders who suffer from frequent online sales of counterfeit and pirated goods.

The Internet platforms commit themselves not only to notice-and-take-down procedures but also to taking pro-active and preventive measures, such as the use of monitoring tools allowing detection of illegal content even before the offer of this product's sale is published online.

The MoU has its limits, such as the involvement of a limited group of stakeholders.

Rights owners

- 1) Adidas International Marketing BV
- 2) Apple
- 3) Duracell
- 4) Hermès
- 5) Lexmark
- 6) Luxottica Group Spa
- 7) Moncler Spa
- 8) Nike Inc.
- 9) Philip Morris International
- 10) Philipp Plein
- 11) Procter & Gamble
- 12) Royal Philips
- 13) Signify
- 14) Zanellato

Online platforms

- 15) Alibaba Group Inc.
- 16) Amazon Services Europe Sarl.
- 17) bol.com
- 18) eBay
- 19) Facebook Marketplace
- 20) Grupa Allegro sp. z o.o
- 21) OLX
- 22) Rakuten France

Business associations

- 23) Anti-Counterfeiting Group (ACG)
- 24) AIM European Brands Association
- 25) Business Action to Stop Counterfeiting and Piracy (BASCAP)
- 26) European Federation of Pharmaceutical Industries and Associations (EFPIA)
- 27) Federation of the European Sporting Goods Industry (FESI)
- 28) International Video Federation (IVF)
- 29) Motion Picture Association (MPA)
- 30) Toy Industries of Europe (TIE)

MoU on online advertising and IPR

Voluntary agreement bringing together major online platforms and rightholders for goods for which counterfeit and pirated versions are sold online.

The signatories of this MoU commit to minimise the placement of advertising on websites and mobile applications that infringe copyright or disseminate counterfeit goods. They also agree to measure the effectiveness of the MoU.

The MoU has its limits, such as the involvement of a limited group of stakeholders.

- 1) Adform
- 2) Amobee
- 3) Associação Portuguesa de Anunciantes (APAN)
- 4) Associazione Italiana Commercio Estero (Aice)
- 5) comScore
- 6) Hrvatsko udruženje društava za tržišno komuniciranje - Croatian Association of Communications Agencies (HURA)
- 7) DoubleVerify
- 8) European Association of Communications Agencies (EACA)
- 9) European Gaming and Betting Association (EGBA)
- 10) Google
- 11) GroupM
- 12) Havas Media Group
- 13) Integral Ad Science (IAS)
- 14) Internet Advertising Bureau Europe (IAB Europe)
- 15) Internet Advertising Bureau Italy
- 16) Związek Pracodawców Branży Internetowej IAB Poland
- 17) Internet Advertising Bureau Slovakia
- 18) Internet Advertising Bureau UK (IAB UK)
- 19) ISBA
- 20) OpenX
- 21) Publicis Groupe
- 22) Sovrn
- 23) SpotX
- 24) Sports rights owners coalition (SROC)
- 25) Trustworthy Accountability Group (TAG)
- 26) Uniunea Agentiilor de Publicitate din Romania (UAPR, Romanian Association of Communications Agencies)
- 27) Utenti Pubblicità Associati (UPA)
- 28) whiteBULLET
- 29) World Federation of Advertisers (WFA)

EU actions – Communication, An IP action plan to support the EU's recovery and resilience, 2020

Fighting IPR Infringements

*The Commission will **reinforce cooperation between all involved players** – right holders, suppliers, various sets of intermediaries (e.g. online platforms, social media, the advertising industry, payment services, domain name registrars/registries, and transport and logistics companies) **and public enforcement authorities** (including administrative bodies, customs, police, market surveillance authorities and public prosecutors) **to curb piracy and counterfeiting**. To this end, it will establish an **EU Toolbox** against counterfeiting, based among others **on reported practices and principles** developed in the context of various industry-led initiatives. The Toolbox will clarify roles and responsibilities and identify ways to work together. A fundamental element is the **sharing of relevant data on products and traders**, in compliance with EU data protection law, for which further guidance may be necessary. The Toolbox will also promote the use of new technologies such as image recognition, artificial intelligence and blockchain. Where appropriate, the Toolbox will be accompanied by benchmarks to make it possible to measure progress.*



Online Dispute Resolution

EU GEORGIA project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

Dispute Resolution

Alternative Dispute Resolution (ADR)

is an out-of-court process for solving disputes between business and customers, with the assistance of an ADR body

Types: Mediation, Arbitration
Mixed Methods

Obligatory for: financial services consumers,
estate agents and telecommunications
businesses traders

Online Dispute Resolution (ODR)

ADR that happens online

The European Commission platform provided on the EU web portal to facilitate ODR between you and your online customers.

ODR - Description

The ODR platform is available to consumers living in the EU (including Norway, Iceland, Liechtenstein) and professionals established in the same area. The complaint should concern a good or service purchased/provided online.

The ODR can be used from consumers who wish to solve their problem directly with the trader. The ODR platform will notify the trader. Parties have a maximum of 90 days to reach an agreement. Both parties may withdraw from direct talks at any time.

Consumers can use the ODR platform to solve their problem with the help of an approved dispute resolution body, i.e. a neutral third party that helps consumers and traders solve disputes in a non-confrontational way. The ODR platform notifies the trader of the consumers' complaint. If the trader agrees to use the ODR process then parties will have to agree on a dispute resolution body to handle the case.

Advantages of ODR

- centralized access to all alternative dispute resolution mechanisms,
- integrated translation tool for overcoming language barriers,
- no costs (if the problem is resolved amicably)
- offers point of contact in all MS

Online Dispute Resolution

Home Start your case How it works Consumer rights Traders' section **Dispute resolution bodies** Help

Dispute resolution bodies

The dispute resolution bodies listed on this site all offer out-of-court settlement procedures. They have all been approved for quality standards relating to fairness, efficiency and accessibility.

Each dispute resolution body has its own rules and procedures. They're usually quicker and cheaper than going to court.

Which country is the trader based in?

Spain

Print complete list as PDF

What is my complaint about?

General Consumer Services

Legal services & accountancy

Clear search criteria

Search [Print results](#)

Name	Country		
ASOCIACIÓN DE MEDIACIÓN "MEDIATION QUALITY" <small>MEDIATION ASSOCIATION "MEDIATION QUALITY"</small>	Spain	More information	Spain
COMITÉ DE MEDIACIÓN DE LA ASOCIACIÓN CONFIANZA ONLINE <small>MEDIATION COMMITTEE FOR CONFIANZA ONLINE ASSOCIATION</small>	Spain	More information	Spain
JUNTA ARBITRAL DE CONSUMO DE CASTILLA LA MANCHA <small>CONSUMER ARBITRATION BOARD OF CASTILE-LA MANCHA</small>	Spain	More information	Spain
JUNTA ARBITRAL DE CONSUMO DE CASTILLA Y LEÓN <small>FORBRUGERVOLDGIFTSNÆVNET I CASTILLA Y LEÓN</small>	Spain	More information	Spain
JUNTA ARBITRAL DE CONSUMO DE CATALUÑA <small>CONSUMER ARBITRATION BOARD OF CATALONIA</small>	Spain	More information	Spain
JUNTA ARBITRAL DE CONSUMO DE EUSKADI <small>CONSUMER ARBITRATION BOARD OF EUSKADI</small>	Spain	More information	Spain
JUNTA ARBITRAL DE CONSUMO DE EXTREMADURA	Spain	More information	Spain



Expected legislation

Proposal for Regulation on Digital Services Act, 2020

The Digital Services Act (DSA) regulates the obligations of digital services that act as intermediaries in their role of connecting consumers with goods, services, and content. Such obligations include:

- **Measures to counter illegal content online, including goods and services**, such as a mechanism for users to flag such content, and for platforms to cooperate with “trusted flaggers”;
- **New rules on traceability of business users** in online market places, to help identify sellers of illegal goods;
- **Effective safeguards for users**, including the possibility to challenge platforms' content moderation decisions;
- **Transparency measures for online platforms** that are wide-ranging, including on the algorithms used for recommendations;
- **Obligations for very large online platforms** to prevent abuse of their systems by taking risk-based action, including oversight through independent audits of their risk management measures;
- **Researchers will have access to data** of key platforms, in order to scrutinise how platforms work and how online risks evolve;
- **Oversight structure to address the complexity of the online space**

DSA – Compliance of online market places with new rules

Very large online platforms will be subject to an audited risk assessment (vulnerability to illegal goods on their platforms, and mitigation measures)

Online marketplaces will be requested to trace their traders (“**know your business customer**”)

Mandatory procedures for removing illegal goods

New system of trusted flaggers, e.g. for brand owners fighting counterfeit goods, for faster and easier flagging and removal of counterfeit goods

Harmonisation of due diligence obligations for platforms and hosting services, and the conditions for liability exemptions for intermediaries

Public authorities will have new tools to order the removal of unsafe products directly



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