

The Internet: Can Concealing Your Competitor's Trade Mark Be an Infringement?

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As anyone who regularly uses the world-wide web will know, typing a given term into an Internet search engine can all too easily lead to a strange website which appears to have nothing to do with what you were looking for. There are many reasons why this happens, as the different search engines use a variety of techniques to produce their searches. One reason however could come to be of concern to brand owners.

All Internet websites are written in a programming code called Hypertext Mark-Up Language (HTML). Not everything written in the code appears on the screen. The search engines, however, nearly all read at least the initial part of the code for "keywords" to see what the site is about. This characteristic provides an opportunity for a new form of "covert" trade mark infringement.

Imagine Company X sells lawnmowers. It knows the market-leader uses the trade mark "SPEEDY-CUT". The company decides to start up an Internet-based selling operation. They include in the hidden coding at the start of their web-page the keywords "lawn, mower, grass cutting, speedy-cut". These words, including the competitor's trade mark, are not displayed on the screen. A customer wishing to look for a lawnmower on the Internet, thinks of the best-known brand and types "speedy-cut" into his search engine. As well as showing any genuine SPEEDY-CUT website, the search engine will throw up Company X's site. If the customer happens to jump to that site first they will have been taken there solely because of the use of the trademark, despite the fact that it appears nowhere on the screen.

Whether this hidden use amounts to trademark infringement has yet to be considered by the UK courts, although in the US there have been several cases which found it was. A recent Danish case (and Danish trade mark law is now based on the same EU Directive as that in the UK) also found infringement in the hidden use of the "Melitta" trade mark by a company selling competing coffee filters. Interestingly in that case the infringer lost the right to claim it was using the mark to indicate it was selling compatible parts (which can excuse of another's mark) because of its underhand behaviour.

In the UK, historically trade mark law required marks to be used in a "trademark sense" (rather than in some descriptive sense) before there was any infringement. Since the 1994 Trade Mark Act the point has been raised in several cases and generated much debated. A recent Court of Appeal ruling (*Philips v. Remington*) however appears to have finally laid the point to rest; holding that there is no requirement of "trade mark use", and that any use of a mark in the course of trade which is not specifically exempted by the Act may

constitute infringement. Given this ruling, it may only be a question of time before the UK Courts are considering the point expressly.

In the meantime, brand owners should further investigate any seemingly unconnected sites which search engines jump to when fed with their brand, and ask whether their Internet watch service picks up on these kind of infringements.