

# Introduction

Jeremy Blum  
Theo Savvides  
Bristows LLP

---

It is an understatement to say that the internet has changed the world in which we live. The change is apparent not only in the way humans interact but also in the way businesses conduct commerce. There are approximately three billion internet users in the world. Facebook alone has approximately 1.8 billion active users. Conducting business online, and indeed developing a brand online, is fundamental to any successful business. In the internet age, developing, maintaining and protecting an online brand and presence will be determinative of the prospects of most businesses.

Although the internet presents significant potential for a brand to develop its business and indeed to develop into a global presence, it also presents massive challenges. With the ability for content to be duplicated, amended and parodied at an exponential rate, brand owners need to make informed and correct decisions in dealing with threats. Moreover, a brand can be undermined by poor choices the owner makes and how it is presented online. Over-aggressive enforcement of rights can be as detrimental to a brand as under-enforcement of rights and allowing a proliferation of infringements online to go unchecked.

In editing this textbook, we have endeavoured to pull together the most beneficial and up to date analysis of the legal tools available around the world for brand owners to ensure they can be successful with their brand(s) online and better informed to make the correct choices.

Although the internet does present a new environment, the fundamental principles regarding trademarks remain the same. The strategies employed to build a brand presence follow the same fundamentals, but different approaches are required because of the overwhelming amount of information an internet user might absorb on a web page without even realising a brand is being displayed. The same principles may apply, but there can also be different outcomes.

On that very point about different outcomes ... a few days before writing this Introduction, a UK case<sup>1</sup> was decided which demonstrates the online/offline dichotomy. An entity called Victorian Plumbing had co-existed in the online plumbing retail space for over 15 years with the claimant Victoria Plumb. After years of co-existence online and offline, however, Victorian Plumbing started to purchase the claimant's trade mark 'Victoria Plumb' and other variations as keywords for pay per click advertising. Upon searching for these keywords, an advertisement would appear, displaying Victoria Plumb's website. The defendants failed with their defence

---

1 *Victoria Plumb v Victorian Plumbing & others* [2016] EWHC 2911 (Ch).

of honest concurrent use because they were purchasing the claimant's trade mark as opposed to their own trade mark as keywords and, in any event, their use was not honest because they had exacerbated confusion through their competitor search marketing strategy. The defendants were free to market their goods under their confusingly similar name, but not beyond that. The confusion was tolerated to a point, but the court held that the defendants had overstepped the mark by the purchase of the keywords, resulting in AdWords that did not allow the average internet user to understand clearly the origin of those advertisements. How the brand is presented in the paid advertisement is of critical importance if the search is based on another's (usually a claimant's) trade mark. In the context of online key word advertising, brands with confusingly similar names may need to be more cautious than they otherwise would in the offline world.

We have attempted to bring together a range of the most critical issues a brand owner and practitioner will face. The first section of this book covers core topics that will be applicable to brand owners around the world and is designed to draw on the principles that govern trade marks around the globe. The second section specifically addresses the key jurisdictions around the world and delves into the detail of how a brand owner might go about protecting and enforcing the brand against not only infringers but also third party intermediaries in those jurisdictions.

The first chapter of this book, *How online businesses can get protection and what can be protected*, looks at issues faced by businesses everywhere. A case study which references Microsoft's experience in creating and maintaining a variety of its brands online is useful reference for readers. As a truly global brand, Microsoft has had to ensure it created an online brand strategy that covers the world and prioritises the most important aspects of the brand that it needs to protect. What is apparent from that chapter is that in a world where a vast amount of content is generated every day by businesses, brand owners need to be clear what they are protecting and what they leave unprotected as marketing collateral which assists and supports the brand but which is not protectable in and of itself. There are a number of different tools that a brand owner might use to promote its brand online. Some of those tools may not be part of every brand owner's toolkit and the authors of the Microsoft chapter delve into the different options by which a brand owner might possibly cement its brand in the consciousness of internet users. Of course, a fundamental part of any brand protection programme is to consider where to ensure the brand is protected. Obviously, this is also an issue that is relevant to brands offline, but ensuring that adequate protection is granted in the key jurisdictions around the world is fundamental to any online brand.

A domain name is the identifier of a website by which a user can connect through the internet. There are a number of ways in which an internet user may reach a website:

- by searching, in which case a particular domain name will appear in the search results; or
- by simply clicking a link combining the domain name; or
- by typing the domain name directly into the address box of the internet browser.

In all of these situations, the brand owner has the opportunity to present its brand. The identifying feature of that domain name is the brand. The domain name gives reassurance to internet users that they have reached the appropriate website of the entity they are seeking. A domain name can easily be registered by a rogue registrant and a key aspect of brand strategy for any brand owner is to ensure that it has a domain name strategy covering key jurisdictions and key top level domains (eg, '.com', '.org' '.co.uk'). A more nebulous question is how far to take that strategy, the answer to which will be determined by the budget. In the era of the 'app', undoubtedly a lower volume of users rely on domain names. When they do rely on a domain name to find the desired site, however, the brand owner can capitalise on this by cementing branding in the domain name. To do this, it needs to ensure both that it has adequate protection and that it has enforced its rights in the appropriate situation to prevent parasitic domain names being registered. Helpfully, the chapter entitled *Domain names* also considers the various 'ecosystems' that are available for making a complaint around the world.

The environment has changed but the legal principles have remained the same. When enforcing one's trade mark, this is still done within the confines of the legislation of the national jurisdiction at issue. The question of the jurisdiction of the court has, however, become more complex online. What is an act of infringement when a website is simply directed to cyberspace? The chapter entitled *Enforcement and the challenges online* explores the difficulties that every brand owner has in preserving its brand. More often than not, an illicit website owner may be anonymous and the identity of the defendant may be impossible to discover. Even if the offender's identity is uncovered and service of proceedings is effected, enforcing a successful judgment can be a costly and time-consuming exercise, assuming it can be enforced at all. The online world presents a maze of jurisdictions, necessitating consideration not only of what infringing acts occur but also where such acts occur. Simply because an infringing product may be available online on a website does not automatically mean it constitutes an infringement in a particular jurisdiction – different countries have different approaches to assessing jurisdiction. This issue is explored in this chapter, as well as in each of the country chapters in this book. In many jurisdictions, the law regarding acts of infringement has developed through the courts, as opposed to primary legislation, and most countries may have some requirement for a website to target consumers within its territory before jurisdiction is established. Of particular importance in the internet age is to recognise that commencing proceedings against the primary infringer is not the only way to preserve one's brand and that there may be other options, such as taking action against intermediaries. The existing framework does provide a range of options for a brand owner to preserve its brand, and this chapter is designed to provide an overview for brand owners of what may be possible in a particular situation.

Having a visible presence on the major internet platforms is crucial from a marketing and business perspective. The chapter entitled *Popular platforms* considers how a brand owner can go about ensuring its brand is maintained on the most popular platforms. Rather than making a volume-based effort by inundating users of popular platforms with targeted advertising, it is clear that the modern approach is

to create conversations with customers to make internet users feel engaged with a product. Users of social media platforms do not want to feel as though they are targets for commercial entities. Brand owners must therefore be attuned to ensuring that they can engage in such conversations while preserving and creating opportunities for their brands. The need to be seen as relevant on popular platforms often creates tensions which brand owners have to take into account when considering whether or not to take action for infringing acts on a platform. It is critical for brand owners to understand that an over-aggressive position prohibiting the use of their brand on social media may actually be more detrimental to the brand than the use complained of. Even if the use might be egregious, a risk-benefit analysis must be undertaken in deciding whether action is warranted. For less egregious offences, a brand owner may come across as a brand bully against social media users; there are many stories about unfortunate brand owners who have been branded as bullies, as well as mocked for their actions online.

The next chapter, entitled *Counterfeiting*, considers the problem that all brand owners face online from counterfeiting. The numbers are staggering. Whatever the statistical basis for those numbers, it is apparent that the global trade in counterfeit and pirate goods is well into the hundreds of millions of dollars. Not only luxury goods are counterfeited. Even the most unassuming product like toilet paper is at risk. The chapter provides brand owners with an overview of a practical approach to monitoring the internet in order to form a strategy of how best to identify both the products that are risk of being counterfeited and websites that are notorious for counterfeiting their goods.

Finally, we include the chapter *Deciphering the technical jargon of enforcing brands online* in an effort to ensure that all brand owners understand the applicable terminology and some of the basics of how a website is set up and hosted, as well as explaining the results of a WHOIS search.

In the second part of the book, we have attempted to provide a common structure for all jurisdictions so that a brand owner can understand the requirements in a particular jurisdiction regarding enforcement of its trademark, the approach to jurisdiction taken in that country and what constitutes an infringing act, as well as whether relief is available against intermediaries who are non-infringing. We would have liked to include all jurisdictions but were limited by space, so we have focused on the jurisdictions most likely to be of interest brand owners.

It is apparent that many jurisdictions, if not all, are developing jurisprudence in relation to issues about brands online. Many countries have considered the scope of their jurisdiction and what constitutes online infringement of trade marks. Some are still grappling with the liability of an advertiser for the use of trade marks as keywords. Some are still considering the possibility for a non-infringing intermediary to be enjoined. As demonstrated by these jurisdictional chapters, all of these issues are being explored around the world.

The book has been a fantastic collaboration of many talented and experienced practitioners around the globe. The chapters are not only topical but also present cutting-edge analyses of the law at a global as well as a country-specific level. We are delighted to be involved with such stellar contributors and privileged to be co-

editors. We hope you will enjoy the book and find it a handy resource for all of your trade mark issues online.

*This Introduction by Jeremy Blum and Theo Savvides is from the title Brand Protection Online: A Practical Guide to Protection from Online Infringement, published by Globe Law and Business.*