

2022 - Study Question Q281

Name of contributing National/Regional Group or Independent Member

Dutch Group

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Trade Marks and the Internet and Social Media (2022 – Study Question Q281)

Questions

I. Current law and practice

Please answer the below questions with regard to your Group's current law and practice.

- 1) In your Group's current laws or regulations, are there any provisions that specifically concern trade mark protection on the internet or social media?
Please answer YES or NO. If YES, please list these.

NO

- 2) Is there any authority in the country or region of your Group which deals with trade mark infringement matters on the internet or social media, which is different from the authority for traditional off-line trade mark infringement matters? Please answer YES or NO. If YES, please specify which.

NO

- 3) Is there any special mechanism/procedure available in the country or region of your Group to handle trade mark infringement matters on the internet or social media?
Please answer YES or NO. If YES, please clarify which.

NO

- 4) What ways of use of a trade mark on the internet and social media might constitute trade mark infringement if there is no permission from the trade mark owner? Please choose one or more answers from the following choices:

- a) use to sell a product or service online; **YES**
- b) use as a keyword (in a search engine or ranking at a platform); **YES**
- c) use as a metatag; **YES**
- d) use as a hashtag; **YES**
- e) use in a review posting; **YES**
- f) use as the name of a social media account or an online shop name; **YES**
- g) use for a comparison; **YES**
- h) use to endorse or promote another party's product or service; **YES**
- i) other, namely

Names of software applications ('apps'); Use of trade marks in online games or VR environment. This is a non-exhaustive list. In general, all ways of use can constitute an infringement of trade mark rights, under the same conditions (and restrictions) that apply to offline cases.

- 5) Are there any different tests applying to online trade mark infringement compared with traditional off-line trade mark infringement? Please answer YES or NO. If YES, please state which.

NO

- 6) What factors are taken into account when assessing whether there is jurisdiction regarding the use of a trade mark online (on a website or app)? Please choose one or more answers from the following choices:
- a) whether the consumers in your country or region can access the website or app; **YES**
 - b) whether the server of the website or app is located in your country or region; **YES**
 - c) whether the website or app uses a local language of your country or region; **YES**
 - d) whether the website or app allows to pay in the local currency of your country or region; **YES**
 - e) whether goods/services are delivered to consumers in your country or region by the user of the trade mark on that website or app; **YES**
 - f) whether there is any business facility of the user of the trade mark in your country or region; **YES**
 - g) whether there are any promotional activities targeting consumers in your country or region by the user of the trade mark; **YES**
 - h) other, namely

Country code top level domains referring to a specific country; the availability of a local contact for sales or post sale services

It is important to note that, according to case law of the European Court of Justice (judgment of 5 September 2019, ECLI:EU:C:2019:674 (AMS Neve)), it is decisive where the public targeted by the advertising or by the offers for sale is located. This needs to be established on the basis of all circumstances of the case that can be deducted from the content of the website. All criteria listed under (a) to (h) are relevant factors to be taken into account. Factors (e) and (f) and (g) in itself create competence for the court.

- 7) a) Can the use of another party's trade mark as a keyword in keyword search advertisement services¹ without the trade mark owner's permission infringe that trade mark? Please answer YES or NO.

YES

- b) If YES, under which conditions is trade mark infringement established?

¹ Keyword search advertisement refers to such an advertisement wherein the information about the keyword buyer or any party the buyer appoints appears alone in the search result or in the front or at a prominent position of the search results when one conducts the search with such keyword.

According to the ECJ Judgment of 22 September 2011, ECLI:EU:C:2011:604 (Interflora), the proprietor of a trade mark is entitled to prevent a competitor from advertising – on the basis of a keyword which is identical with the trade mark and which has been selected in an internet referencing service by the competitor without the proprietor’s consent – goods or services identical with those for which that mark is registered, where that use is liable to have an adverse effect on one of the functions of the trade mark. Such use:

- adversely affects the trade mark’s function of indicating origin where the advertising displayed on the basis of that keyword does not enable reasonably well-informed and reasonably observant internet users, or enables them only with difficulty, to ascertain whether the goods or services concerned by the advertisement originate from the proprietor of the trade mark or an undertaking economically linked to that proprietor or, on the contrary, originate from a third party;
- does not adversely affect, in the context of an internet referencing service having the characteristics of the service at issue in the main proceedings, the trade mark’s advertising function; and
- adversely affects the trade mark’s investment function if it substantially interferes with the proprietor’s use of its trade mark to acquire or preserve a reputation capable of attracting consumers and retaining their loyalty.

8) a) Do one or more online market platforms in the country or region of your Group² provide services to stop trade mark infringement on their platform? Please answer YES or NO.

YES

b) If YES, what services are provided? Please tick the below boxes that apply (in the comment box you may specify if these differ for different platforms):

- notice and take-down (**Bol.com, Marktplaats**)
- shop-shut down (**the Dutch Group understands this as ‘seller-shut down’; Bol.com + Amazon; often this measure is only a temporary suspension, and Bol.com requires that the trademark holder first sends a CD letter to the infringer**)
- initiative policing and investigation of trade mark infringement (**The Dutch Group understands this to mean that the platform proactively searches for and investigates infringements, without a prior notification or request of the right holder): Amazon, eBay removes content and confirms this to the right holder**)
- authentic products verification: **Amazon provides a service named ‘Transparency’. This is a product serialization service that helps consumers to identify individual units offered on the platform and verify whether it is a genuine product. It requires that right holders include unique codes on the product**

² Herein "online market platforms in the country or region of your Group" refers to those local online market platforms or those international ones that operate in your country or region.

packaging, which can be scanned by the consumer. Product verification remains something that most of the time is performed by the right holder itself.

□ trade mark recording system (Bol.com operates such a system, however this system is designed for the benefit of sellers who sell their own brands on the platform and protects their product descriptions from being changed by third parties; Amazon operates a trade mark recording system)

□ other, namely

- On the platform 'Marktplaats' right holders have the option to publish so-called 'About me'-pages that it can use to inform consumers about the brand and the identification of genuine and fake products)

- On its website Amazon publishes guidelines for sellers of certain groups of products with rules on how to accurately advertise for these products and for products compatible with branded products. For instance, for 'Toothbrush Heads', Amazon provides the following information:

https://sellercentral.amazon.com/gp/help/external/G202017070?language=en_US

- 9) a) According to your Group's current laws and practice, can a social media influencer bear liability for his or her endorsement of a product or service infringing another party's trade mark? Please answer YES or NO.

YES

- b) If YES, under which conditions is trade mark infringement established?

Under the same conditions that apply to any other party.

II. Policy considerations and proposals for improvements of your Group's current law

- 10) Could your Group's current law or practice relating to the use by third parties of trade marks on the internet and social media be improved? If YES, please explain.

YES, for example:

It could be helpful if platforms have a greater responsibility in preventing and acting against online infringements, such as:

- the obligation to do what is reasonably possible to prevent infringements (i.e. use artificial intelligence, active seller profiles, verification of data provided by sellers (including its identity), etc);

- to provide trade mark holders with contact details and other relevant information with respect to the infringer – including the underlying intelligence (i.e. other nicknames, other shops of the infringer on the same platform) -, so that the trade mark holder can act against the infringer.

- 11) Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?

NO

III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

- 12) Do you believe that there should be harmonisation in relation to trade mark protection on the internet and social media? Please answer YES or NO.

YES

If YES, please respond to the following questions without regard to your Group's current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group's current law or practice could be improved.

- 13) Should there be any provisions that specifically concern trade mark protection on the internet or social media? Please answer YES or NO.

NO

- 14) Should there be any authority to deal with trade mark infringement matters on the internet or social media, which is different from the authority for traditional off-line trade mark infringement matters? Please answer YES or NO.

The Dutch Group considers the benefits of the complimentary domain name dispute resolution procedures, namely the Uniform Domain-Name Dispute-Resolution Policy (“UDRP”) and the Uniform Rapid Suspension System (“URS”), as established by the Internet Corporation for Assigned Names and Numbers (“ICANN”): These administrative procedures are simple, fast and cost-effective compared to court proceedings, procedures are more informal and decision-makers are legal experts, moreover, parties retain the option to go to the court of competent jurisdiction for independent resolution. The Dutch Group would support initiatives to study the feasibility of establishing such a single mechanism and setting such a legal framework in an international scope for resolving “clear” disputes (such as: counterfeit cases / (double) identical trade marks on online market platforms (for regular infringement cases, the court is still the best option, according to the Dutch Group) regardless where the parties are located. Platforms that would adopt the new policy would agree to abide by and implement the rules and any person or business wishing to use the platform would be required to consent the terms and conditions of the new policy.

- 15) Should there be any special mechanism/procedure to handle trade mark infringement matters on the internet or social media? Please answer YES or NO.

YES, as alternative administrative mechanism (see under 14), provided that the types of disputes covered by this policy would be clearly defined and parties would retain the option to go to court.

16) What ways of use of a trade mark on the internet and social media should constitute trade mark infringement if there is no permission from the trade mark owner? Please choose one or more answers from the following choices:

- a) use to sell a product or service online; **YES**
- b) use as a keyword (in a search engine or ranking at a platform); **YES**
- c) use as a metatag; **YES**
- d) use as a hashtag; **YES**
- e) use in a review posting; **YES**
- f) use as the name of a social media account or an online shop name; **YES**
- g) use for a comparison; **YES**
- h) use to endorse or promote another party's product or service; **YES**
- i) other, namely

Use of a trademark on the internet and social media can constitute an infringement of rights, under the same conditions (and restrictions) that apply to offline cases, and always depending on the circumstances of the specific case.

17) Should there be any different tests applying to online trade mark infringement compared with traditional off-line trade mark infringement? Please answer YES or NO. If YES, please state which.

The Dutch Group is of the opinion that it is not necessary to apply a different test to online trade mark infringements, compared with traditional off-line infringements. However, it could well be that the perception of the relevant public is different on-line than off-line. For example: it is not clear yet whether a virtual product (e.g. a virtual shoe) could still be regarded as an identical product to a 'real life' product (e.g. an actual shoe).

18) What factors should be taken into account when assessing whether there is jurisdiction regarding the use of a trade mark online (on a website or app)? Please choose one or more answers from the following choices:

- a) whether the consumers in the country or region can access the website or app; **YES**
- b) whether the server of the website or app is located in the country or region; **YES**
- c) whether the website or app uses a local language of the country or region; **YES**
- d) whether the website or app allows to pay in the local currency of the country or region; **YES**
- e) whether goods/services are delivered to consumers in the country or region by the user of the trade mark on that website or app; **YES**

- f) whether there is any business facility of the user of the trade mark in the country or region; **YES**
- g) whether there are any promotional activities targeting consumers in the country or region by the user of the trade mark; **YES**
- h) other, namely

All listed factors could be relevant. We propose that factors e) and f) and g) are individually sufficient to accept jurisdiction. We propose that factor c) could be individually sufficient to accept jurisdiction if the language is specific for one particular country.

- 19) a) Should the use of another party's trade mark as a keyword in keyword search advertisement services³ without the trade mark owner's permission infringe that trade mark? Please answer YES or NO.

Depending on the circumstances: YES.

- b) If YES, under which conditions should trade mark infringement be established?

The criteria listed under 7(b) should be applied.

- 20) a) Should online market platforms provide services to stop trade mark infringement on their platform? Please answer YES or NO.

YES

- b) If YES, what services should be provided? Please tick the below boxes that apply:

- notice and take-down **YES**
- shop-shut down **YES**
- initiative policing and investigation of trade mark infringement **YES**
- authentic products verification **YES**
- trade mark recording system **YES**
- other, namely

All of the listed services. In addition, the Dutch Group is in favour of:

- **An obligation for the platform to accurately identify sellers before allowing these parties to sell/offer the products on the platform;**
- **A mandatory disclosure of information about the identity of the infringing party and other infringing activities of this party to the right holder and/or law enforcement.**

³ Keyword search advertisement refers to such an advertisement wherein the information about the keyword buyer or any party the buyer appoints appears alone in the search result or in the front or at a prominent position of the search results when one conducts the search with such keyword.

- **An obligation for the platform to use “seller-shut down” policies rather than shop-shut down policies.**
- **An obligation for the platform to remove reviews regarding counterfeit products, and to remove a link to the infringing seller.**

21) a) Should a social media influencer bear liability for his or her endorsement of a product or service infringing another party’s trade mark? Please answer YES or NO.

YES

b) If YES, under which conditions should trade mark infringement be established?

The use of a trade mark by an influencer can constitute an infringement of trade mark rights, under the same conditions (and restrictions) that apply to other parties.

The influencer is a professional party that is expected to know the applicable law (even if and when he/she is in fact unaware of its legal obligations). This brings a certain obligation to examine the advertisement/product that it intends to endorse in order to avoid clear trade mark infringements. In addition, the influencer should comply with take-down requests.

Other

22) Please comment on any additional issues concerning any aspect of trade marks and the internet and social media you consider relevant to this Study Question.

23) Please indicate which industry/cultural sector views provided by in-house counsel are included in your Group's answers to Part III.

Consumer goods, Health Technology