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NEWSLETTER

New Developments in Internet Law — BGH-Judgement on Trademark Infringement in Meta Tags and AdWords

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New Developments in Internet Law

The internet is continually providing its users with new technical means of attaching their internet presence onto third party labels and trademarks. As a result, new questions are continually being posed – from a legal point of view too – which are to some extent the subject of heated discussion and controversy. The following aims to illustrate prevailing law on "meta tags" and so-called "AdWords" on the basis of two court judgments, without however entering into a discussion of Competition Law provisions.

I. Metatags

The issue as to whether the use of a third party's company sign, name or trademark in so-called meta tags represents a trademark infringement was for a long time controversial in German jurisprudence and literature.

Meta tags are information in the source code of an internet page. They cannot be distinguished by the user but are able to be detected by a search engine and lead to the display of a corresponding hit list.

<meta name="keywords" name=„content" ... >

The German Federal Court of Justice (BGH), the highest German civil instance, passed judgment on this issue for the first time on 18 May 2006. The subject of the BGH appeal proceedings was the plaintiff's application to bar the respondent from using the plaintiff's company name "Impuls" in the HTML code of internet pages on which specific insurance advice belonging to the plaintiff's array of services was offered.

The lower court had previously been of the opinion that the use of the word "Impuls" as a meta tag represented no use of the plaintiff's company name as such due to the lack of a "cognitive process" for the average internet user. This judgment could not withstand the appeal.

According to the BGH, the plaintiff is entitled to injunctive relief as the crucial point is not that the search word is visible to the user on the corresponding internet page, but rather that with the help of the search word the result of the search engine's selection process is influenced and the user thereby led to the appropriate internet page of the unau-

thorized person who uses the search word actively to draw attention to his offer. On this basis the BGH affirmed the existence of a trademark infringement.

II. Adwords

It is to be presumed that the above-mentioned BGH judgment will have an impact on marketing in the new media over and above the complex of problems involved with meta tags. In this respect the deliberations of the judgment can also be carried over to other newer technical means of attaching one's internet presence onto third-party signs, names and trademarks such, as in particular, the use of "Google AdWords". These are also a controversial issue in jurisprudence and literature.

The operator of the Google search engine enables the advertiser, at the latter's expense, to link personally chosen keywords (AdWords) to an advertisement appearing on the search engine platform. After entering the appropriate keyword as his search term, the user is in this manner automatically presented with advertisements, labeled as such, in addition to his hit list.

Neither AdWords nor meta tags are immediately visible to the internet user, their use within the search engine leads however to hits, i.e. advertisements. Against this background the Higher Regional Court (OLG) in Braunschweig decided on 11 December 2006 that the same rules must apply for AdWords as for meta tags

In the case underlying the judgment, the respondent had placed an AdWord in the Google search engine, i.e. an advertisement labeled as such which appeared beside the hit list for the search term "Jette Schmuck" (=Jette Jewellery) as well as for other terms.

The plaintiff was exclusive licensee of the word mark "JETTE" which was registered in the CEO's name and identical to the company name. The court explained that the use of the AdWord was to prompt the search engine to display the respondent's advertisement beside the hit list following entry of the word mark in dispute, even though the word mark was allocated both as a trademark and as a business label to another owner.

The respondent was seen to be making use in this manner of the attraction the plaintiff had built up in the word mark and to be using the pilot function specific in particular to word marks, which aims to guide the user through a wide range of goods and services directly to the goods or services of the word mark holder.

„***Keywords***" - specified by the owner of the homepage:
<meta name="keywords" content="[Schmuck]">

For the Adword-Search enter: Schmuck, Jette, etc.
„***Adword***" - submitted by the internet provider:
<meta name="keywords" content="[Jette Schmuck]"
The user may also choose another term!

The court explained further that the respondent is responsible for the trademark infringement even though he had not himself included the term "Jette Schmuck" as a keyword when designing his advertisement. Rather the term was added by the search engine as one of Google's offered AdWords under the standard option "mainly relevant keywords".

Indisputably the respondent could have prevented the appearance of his AdWord in connection with the search word "Jette" or "Jette Schmuck" by means of the function "excluded keywords".

The question as to whether the installation of the standard keyword option offered by search engine operators represents a trademark infringement by them was not a matter for decision in these proceedings.

III. Conclusion

The above judgments on meta tags and AdWords represent a strengthening of the rights of trademark holders and are therefore a positive move forward.

At the same time however the issue of how to assess the responsibility of operators of search engines – which are both useful to and problematic for trademark holders – becomes one of increasing importance and it is to be presumed that the future will bring a great deal of movement as far as the legal assessment of this issue is concerned

News at RSW ...

We are pleased to inform you that our team has grown again.

Patent Attorney Heike Friebe

Mechanical Engineering (Dipl.-Ing.)

Ms. Heike Friebe is now supporting our office with her main tasks in the fields of mechanical engineering, automotive engineering and aerospace technology.

... News at RSW

DR. PAMELA KOLB

PATENT ENGINEER, PHYSICIST

Ms. Dr. Pamela Kolb has special knowledge in the fields of the use of confocal-fluorescence-microscopy, fluorescence resonance energy transfer (FRET), binding behavior of mutated receptors, mutated immunoglobulins (Ig) and Ig-DNA-macromolecules.

HEINZ-PETER HOIER

ASSESSOR IUR.

Ass. iur. Heinz-Peter Hoier supports our trademark department as a specialist for European and International trademark protection: trademark registration, opposition and infringement proceedings of trademark rights.

The contents of this Newsletter are intended to inform on recent developments in national and international industrial property protection. We have taken considerable care in the preparation of the contents, cannot however assume responsibility for the correctness and completeness of the information given. Should you have any questions on the topics dealt with in the Newsletter, please contact us by email at the address given below.

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