

AdWords and well-known mark: GOOGLE is still not responsible

By Frank Soutoul & Jean-Philippe Bresson, INLEX IP EXPERTISE, Paris, France

Summary: The Paris Court of Appeal has now affirmed that even trademark with reputation can not engage GOOGLE liability for sponsored links reproducing the mark in the context of its AdWords system.

Further to the decisions of the CJEU of March 2010 and of French High Court of July 13, 2010, the Court of Appeal of Paris has considered last November that GOOGLE could not be liable for trademark infringement in the context of its AdWords system even though the reputation attached to a mark (the mark in concerns was “Belle Literie”) was this time particularly involved.

The analyse made is quite identical to the earlier decisions above: the internet search engine which suggests and stores as a keyword a sign identical to a mark and organizes the posting of advertisements, does not make use of this sign in the course of trade.

This decision further confirms the fear of some trademark holders and the need for setting up watches as in France Google does not block any more keyword on the basis of the sole presentation of a mark and has even cancelled some keywords previously blocked.

On another note, this decision of November relates to Google’s possible limited responsibility under the status of the technical providers and in particular as a hosting company. The Court considered that Google through its AdWords service played a purely technical role and did not intervene in the drafting of the contents of the advertisements so that the limited liability was applicable.

Google’s responsibility was not established as the trademark holder did not prove that the advertisements were obviously illicit and that Google would not have acted promptly while being informed of this illicit situation.

If Google cannot be considered as a counterfeiter or responsible for the sell of keywords, the advertiser which bought the keyword can certainly be pursued successfully and implementing specific watches remains again the most efficient tool for this purpose.

*Franck SOUTOUL and Jean-Philippe BRESSON
Supervisors of PHARMINLEX and LEXVALUE Departments
Reporters for IP TALK newsletter and blogs
INLEX IP EXPERTISE, www.inlex.com*