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Jack Daniel's Props. v. VIP Prods.
Page 8

An interview with ŌURA
Page 13

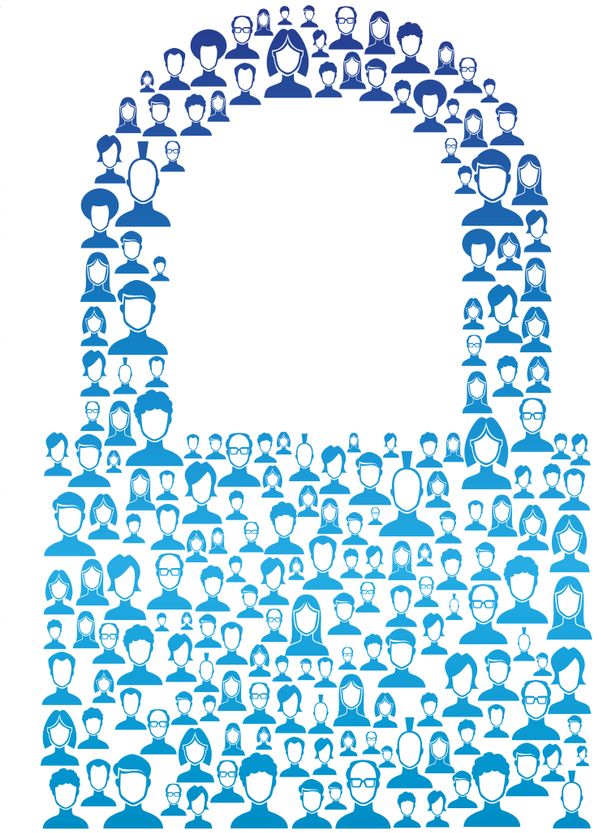
A comparative view: shape and design
Page 47

CTC Legal Media

German Federal Court of Justice on third-party information from Google

Detlef von Ahsen, Partner at KUHNEN & WACKER, discusses claims concerning the provision of information against infringers of property rights and platform operators.

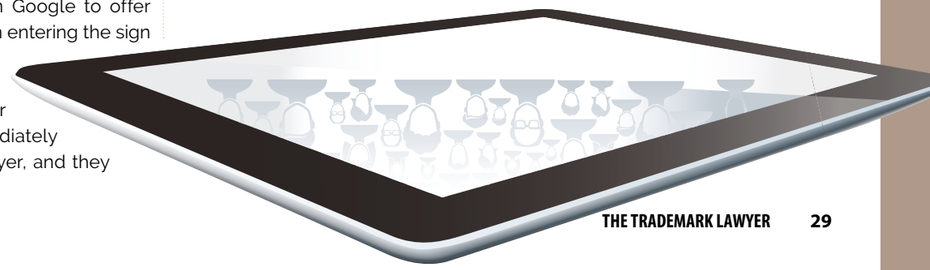
Time and time again, providers of goods and services that infringe on property rights make use of internet marketplaces and paid adverts on internet search engines to distribute the same. While the operators of the marketplaces and search engines have meanwhile introduced well-attuned processes to remove such offers from the marketplace or the search engine, at the latest upon the proprietor's request (so-called take-down procedures), oftentimes the question arises in how far the operator of the marketplace and/or the search engine is liable to the proprietor. Among other things, this concerns the information to be provided by the operator to the proprietor, so that the proprietor may calculate and claim damages from the provider of the goods or services infringing their rights, i.e., from the buyer of the advert (in the following shortened to buyer). The German Federal Court of Justice (BGH) had to rule in such a case this July (BGH I ZR 121/21 – Google-Drittauskunft; Third-Party Information from Google).



Underlying facts of the ruling

The complainant is the proprietor of a German word mark registered, among other things, for the services of disposing of waste and utilizing it by means of recycling. The word sign is further used by the complainant as a company sign for their sphere of business.

Using this sign, a buyer ran an AdWords advertisement campaign on Google to offer disposal services. Thus, when entering the sign in question into the search engine by Google, the attention of the person searching for this search term was immediately called to the offer of the buyer, and they



Detlef von Ahsen

Résumé

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could access the landing page of the buyer via a link. Following a take-down request by the complainant, Google immediately removed the advertisement. However, the right to information remained contested, so that the complainant took legal action against Google regarding the provision of information about the following:

a) the name and the address of the buyer,

b) the time from which the advert was visible on Google,

c) the number of clicks made to view websites accessible via the advert, and

d) the price the buyer paid to Google for this advert.

After Google provided the information on the name and the address of the buyer as requested under a) during the ongoing proceedings, the parties have concurrently declared this prayer for relief to be settled. However, the prayers under b) to d), as set out above, remained contested.

Ruling of the German Federal Court of Justice

While the complainant had been partially successful in the first-instance proceedings and the appeal proceedings, the German Federal Court of Justice overturned the ruling of the court of appeal, which had been in favor of the complainant, and dismissed the case overall. The court held that the complainant was not entitled to the contested information.

Section 19 para. 1 sentence 1 of the German Act on the Protection of Trade Marks and other Signs (Trade Mark Act) allows for the proprietor of a trademark or a commercial designation to sue an infringer for provision of information regarding the origin and the channel of commerce of unlawfully identified goods or services. In cases of an obvious legal infringement, the claim according to section 19 para. 2 sentence 1 No. 3 of the Trade Mark Act may also be asserted against a person who, on a commercial scale, provided services used for infringing activities, as Google did in the present case. In this case, the German Federal Court of Justice was convinced of the obviousness of the legal infringement (undisputed by the parties of the judicial proceedings), so that the complainant is, in principle, entitled to claim the provision of information from Google. In conclusion, the German Federal Court of Justice nevertheless also finds that these claims are delimited to the scope defined in section 19 para. 3 of the Trade Mark Act, namely:

- according to section 19, para. 3 No. 1 of the Trade Mark Act, the name and address of the manufacturers, suppliers and other previous holders of the goods or services as well as of the intended wholesalers and retailers, and

- according to section 19, para. 3 No. 2 of the Trade Mark Act, the quantity of the goods manufactured, delivered, received or ordered as well as the prices paid for the goods or services concerned.

Regarding the individual pieces of information requested, the German Federal Court of Justice argued, in essence, as follows:

Information requested regarding the time from which the advert was visible on Google:

The court of appeal had assumed that placing an advert on the internet also opened up a channel of commerce, so that, in accordance with section 19 para. 1 of the Trade Mark Act, the provision of information regarding the channel of commerce would be owed. The court held that the claim concerning the provision of information was not limited to the mere notification of the fact that there had been a channel of commerce, but that it also included the time when the channel of commerce was opened. The German Federal Court of Justice did not agree with this view. After carefully analyzing the history of section 19 of the Trade Mark Act, as well as the regulation of Art. 8(2) of the so-called Trade Mark Directive (Directive 2004/48/EG), which the aforementioned section is based on, it arrived at the conclusion that the claim concerning the provision of information is not described clearly. Therefore it was not possible to infer from section 19 para. 1 of the Trade Mark Act any obligations to provide information beyond the information set out in section 19 para. 3 of the Trade Mark Act. An analogical application of section 19 of the Trade Mark Act did not come into consideration either, because there were no unintended gaps in the regulation.

Information requested regarding the number of clicks

The wording of section 19, para. 3 No. 2 of the Trade Mark Act – as well as the German-language version of Art. 8(2)(b) of the Trade Mark Directive – directly justifies only an obligation to provide information concerning "the quantity of the goods manufactured, delivered, received or ordered" as well as "the prices paid for the goods or services concerned". Hence, there is no explicit reference to services as regards the information on the quantity. With reference to other language versions of the Trade Mark Directive, such as the English, French or Spanish version, however, the German Federal Court of Justice arrives at the conclusion that the provision of information concerning the quantity of the services provided, received or ordered may also be required. But even under this assumption in favor of the complainant, they would not be entitled to the requested information regarding the number of clicks, seeing as the trademark is not registered to the incriminated services, but was merely the subject of an AdWords advert. Again, an analogous application of section 19 para. 3 of the Trade Mark Act did not come into consideration.

Information requested regarding the price of the AdWords advert

In this regard, the German Federal Court of Justice agrees with the opinion of the court of appeal that the "services" in the sense of section 19 para. 3 No. 2 of the Trade Mark Act are not the services used for the infringing activity by the infringer, but the unlawfully identified services in the sense of section 19 para. 1 of the Trade Mark Act. The court held that an analogous application of section 19 para. 3 No. 2 of the Trade Mark Act was out of the question. Further, the price paid by the buyer to the respondent for the AdWords advert was not a price "paid for the goods or services concerned" in the sense of section 19 para. 3 No. 2 of the Trade Mark Act.

No further claims based on good faith (section 242 of the German Civil Code) either

Even in view of good faith (section 242 of the German Civil Code), this information cannot be required from Google. In accordance with this regulation, the proprietor has, in addition to the claim according to section 19 of the Trade Mark Act, a non-independent claim concerning the provision of information in order to prepare and enforce a claim for damages against the infringer. However, there was no special legal relationship between the parties in the present case, which would be required for the application of section 242 of the German Civil Code.

Conclusion

The claims concerning the provision of information from infringers and platform operators serve the preparation of claims for damages against the infringer, and therefore constitute an important part of the process that enables the proprietor to calculate and consequently enforce the claim for damages. Even though this is not significant for the decision in the current dispute, the author deducts from the ruling that the German Federal Court of Justice principally confirms the claims concerning the provision of information against the platform operator in the ruling "Third-Party Information from Google" set out hereinabove. However, the German Federal Court of Justice clarifies that a proprietor of a trademark or a commercial designation is only entitled to the claims concerning the provision of information explicitly set out in section 19 para. 3 of the Trade Mark Act against an operator of a platform where buyers may place an AdWords advert. Thus, the limits of the claim concerning the provision of information are further clarified.

Even though the decision was made with respect to trademark law, it should also cover other property rights, seeing as substantially the same regulations for the claim concerning the provision of information are applicable.

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"The German Federal Court of Justice came to the conclusion that proprietor of a trademark or a commercial designation is only entitled to the claims concerning the provision of information explicitly set out in section 19 para. 3 of the Trade Mark Act."