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## **Trademark Infringement, the Internet and Jurisdiction**

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## **Abstract**

The Internet raises many issues relating to jurisdiction. This is particularly so in respect of registrable intellectual property rights and there have been a number of cases, particularly in the United States and the United Kingdom where questions of jurisdiction have been addressed in relation to signs placed on websites identical to or similar to trademarks registered in other jurisdictions. Important factors are whether the use of the sign in question on a website is use in the course of trade and whether that commercial activity is targeted at the jurisdiction in which a claim of infringement is made. This article discusses those cases and suggests a test for determining whether infringement is a possibility in other jurisdictions, based on the requirements for revocability of trademarks for non-use or interrupted use for five years or more. The article also looks at threatened infringement and the thorny question of whether foreign judgements (that is, outside the European Economic Area and the Commonwealth) in trademark cases can be enforced in the United Kingdom. This is of particular importance in cases where an attempt to enforce a foreign judgement in a trademark action in the United Kingdom is met with a defence attacking the validity of the trademark's registration.

### **Keywords:**

Trademarks - Internet - webpages - jurisdiction - infringement of trademarks by signs on webpages outside jurisdiction - torts - delicts - threatened torts or delicts - test for infringement in other jurisdictions - enforceability foreign trademark judgements in the United Kingdom

## **1. Introduction**

Trademark rights are territorial. They are effective only in the country or territory where they are registered.

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When trademarks are applied to goods or services which are then supplied or provided under those trademarks, in a traditional sense, the territorial nature normally causes no problems. If an undertaking requires protection in other territories, it can apply to register the trademark elsewhere. Similarly, infringement involves use of a sign within a territory where the trademark in question is registered. Where signs identical to or similar to registered trademark are used, it is tolerably clear whether that use infringes or possibly infringes.

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However, in the context of using on the internet signs identical to or similar to registered trademarks, infringement is far less predictable. This is particularly so where the question is whether infringement has occurred in a jurisdiction other than that in which the server containing the website is located.

To take an example, say an English company, which makes and sells confectionery, has a website advertising its goods which is hosted on a web server located in the United Kingdom. If the company places on that website a sign which is identical or similar to a trademark registered in Australia for similar goods, does the English company infringe the Australian trademark?

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The implications of finding infringement in such a case are potentially very grave. The thought of defending litigation in an Australian State will frighten off many small and medium sized business, particularly if any judgement in favour of the proprietor of the trademark is likely to be able to enforce that judgement in England and Wales by application of the Foreign Judgements (Reciprocal Enforcement) Act 1933. This article looks at some of the issues relating to infringement of trademarks by the use of signs on websites located outside jurisdiction and the impacts of rules on jurisdiction and enforcement of foreign judgements and suggests the formulation of a test to be used to determine whether use on a website is use within a particular jurisdiction. First, it is important to determine whether use of a sign on a website can infringe trademarks registered in other countries.

## **2. What are the Physical Boundaries of Use of Signs on Websites?**

The rationale for trademarks is that they operate as badges of origin in that they indicate the source of goods or services to the consumer, 'enabling the consumer who acquired them to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent purchase'.

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The basic right given by registration of a trademark is to prevent the use in the course of trade of a sign that is identical to or similar to that mark in relation to identical or similar

goods or services. Where there is not complete identity of the sign or the goods or services, a likelihood of confusion on the part of the public must be shown. Furthermore, infringement may come about where a sign that is identical or similar to a registered trademark of repute is used in the course of trade in relation to non-similar goods or services.

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The right conferred by a Community trademark is equivalent though it extends to the entire territory of the European Community. However, the Court of Justice has ruled that, subject to the defences to infringement in Article 6, the scope of the right is limited so as to preserve its essential function of a trademark, being to act as a guarantee of origin.

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Thus, use that is purely descriptive does not infringe.

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Trademark law in jurisdictions outside Europe is broadly similar to European trademark law, certainly sufficiently so for the purposes of the discussion that follows.

The question to be determined then is whether placing a sign on a page on a website where that sign is identical to or similar to a registered trademark infringes that trademark. First, the sign must be used in connection with the same or similar goods or services for which the trademark is registered and that use must be in the course of trade.

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In the case where use is in the course of trade and is in relation to identical or similar goods (or, in some jurisdictions, non-similar goods where the trademark is one of repute), the sole issue to resolve to determine if infringement is a possibility is whether the use in question is use within the relevant jurisdiction.<sup>11</sup>

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In other words, does a person, by placing a sign on a webpage, use that sign in all territories in the world or is the geographical range of the use more limited than that?

There are a number of United States cases on trademark infringement on the Internet relating to whether a particular state has jurisdiction. The law as developed there is very instructive in deciding whether use is use for the purposes of infringement. The leading authority is Zippo Manufacturing Co v Zippo Dot Com Inc in which the claimant, a manufacturer of cigarette lighters and proprietor of the 'zippo' trademark with its principal place of business situated in Pennsylvania, sued the defendant which was an internet subscription news service based in California.<sup>12</sup>

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[&User.context=doqzPeiobjEq&Item.drn=4226z10z0>](#) The defendant had no physical presence in Pennsylvania but posted information about its services on its web pages, which were accessible through its 'zipo' domain names. The defendant had 3,000 subscriptions from residents of Pennsylvania who had completed the application form after accessing the defendant's website. Furthermore, the defendant had entered into agreements with Internet access providers, two of which were established in Pennsylvania, for the purpose of allowing their subscribers to access the news service. The claimant sued in Pennsylvania for trademark infringement and dilution of its trademark.

The Federal District Court of Pennsylvania developed a sliding scale for determining whether a court would have personal jurisdiction in a case of Internet contacts. At one end of the scale, a defendant is clearly doing business over the internet in jurisdiction by having an interactive website and making contracts with residents in that jurisdiction, involving the deliberate and repeated transmission of computer files over the internet.<sup>13</sup>

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[&User.context=doqzPeiobjEq&Item.drn=4226z10z0>](#) At the other end, the website is passive, such as where a person has simply posted information on a website which is accessible by persons in other jurisdictions. In such a case, where the person posting the information does little more than to make the information available to those who might be interested in it, there are no grounds for exercising personal jurisdiction.<sup>14</sup>

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[&User.context=doqzPeiobjEq&Item.drn=4226z10z0>](#) There is, however, a middle ground, where the website is interactive and where the user can exchange information with the host computer. In this case, it is a question of looking at the level of interactivity and the commercial nature of the exchange of information to determine whether a court in a state has personal jurisdiction.<sup>15</sup>

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From the United States' approach to jurisdiction for trademark infringement, it is reasonable to conclude that use of a sign to infringe a trademark must be real commercial use and that there must be actual sale of goods or supply of services to persons within the jurisdiction concerned. Simply placing a sign on a webpage that can be and is accessed by persons in a particular jurisdiction is not sufficient, per se, to form the basis of a trademark action. But how does this equate to the approach of the courts in the United Kingdom?

The first case to address the issue was 800-FLOWERS Trademark.<sup>16</sup>

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[&User.context=doqzPeiobjEq&Item.drn=4226z10z0>](#) An American company applied to register 800-FLOWERS as a service mark for receiving and transferring to florists orders for flowers. At first instance, Jacob J rejected counsel's submission that placing a trademark on a website was potentially a trademark infringement anywhere in the world

because this website use was use in an 'omnipresent cyberspace' and placing a trademark on a website was 'putting a tentacle' into the computer of each and every person who accessed the website. Jacob J gave an example of a fishmonger from Bootle in Lancashire who advertised on his own website for local delivery. The fishmonger could hardly be said to be trying to sell his fish all over the world, or even the whole of the United Kingdom. Jacob J made the point that anyone 'surfing the web' will retrieve numerous irrelevant hits and someone who accessed such a website from another country would immediately realise 'this is not for me' and take no further interest in it. Of course, in practice it will depend on the circumstances. The website owner's intention and the impact on persons accessing the website will be important, especially what a person accessing the website would understand. The basic question as set out in the Zippo case, is whether the website owner targets a particular country or state for commercial purposes.

Jacob J had another opportunity to consider the matter in *Euromarket Designs Inc v Peters and Crate & Barrel*.<sup>17</sup>

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[User.context=doqzPeiobjEq&Item.drn=4226z10z0](https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq&Item.drn=4226z10z0)> The claimant was an American company which had a chain of stores there under the name 'Crate and Barrel' which it had registered as a trademark in the United Kingdom and as a Community trademark. The defendant had a shop in Dublin also called Crate and Barrel and sold household items and furniture. The defendant advertised in a magazine (*Home & Garden*) and had a website and had, in both cases, used the Crate and Barrel name. The defendant had never sold any goods in the United Kingdom. When the claimant sought summary judgement for infringement of the United Kingdom trademark, the defendant argued that its advertisements were not directed to the United Kingdom market and it had no intention of trading there.<sup>18</sup>

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As regards the advertisement in *Home & Garden*, Jacob J noted that it had a circulation in Eire and in the United Kingdom but he accepted that the defendant had no trade in the United Kingdom and had no intention of trading there. The advertisement was for the shop and not for supplying goods by mail order. Counsel for the claimant pointed out that section 9(1) of the Trade Marks Act 1994 stated that the proprietor of a trademark has '... exclusive rights in the trade mark which are infringed by use of the trade mark in the United Kingdom without his consent' (emphasis added). Section 9(1) has no equivalent in the trademarks Directive and if it really did mean that mere use of a trademark without consent would infringe, whether or not that use was in the course of trade, that would extend trademark rights in the United Kingdom beyond that permitted in the Directive. As Jacob J previously said in *British Sugar plc v James Robertson & Sons Ltd*, section 9 (1) itself adds nothing to the infringing acts in section 10 except for the fact that the use must be without the proprietor's consent.<sup>19</sup>

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<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq&Item.drn=4226z10z0>> To interpret the provision otherwise would mean that placing an advertisement in a magazine or on a website would be to use the trademark in any jurisdiction where copies of the magazine found their way or from which the website had been accessed.

In relation to the website, persons could visit the site by entering the address or through a search.<sup>20</sup>

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<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq&Item.drn=4226z10z0>> Jacob J once again made the point that carrying out a search on the Internet almost always throws up lots of irrelevant hits.

In whatever way a person got to the site, the question was whether the defendant was using Crate & Barrel in the United Kingdom in the course of trade. If the defendant was, bearing in mind there was no proof of actual trade or an intention to carry out trade in the United Kingdom, potentially it was using the name in every country in the world.

However, the language of the Internet gives a clue as when a person accesses a website, he is said to go to the site or visit the site. Jacob J favoured the argument that using the Internet was like the user focusing a super-telescope on the site concerned, for example, where a user had the telescope on a hill in Wales to look at the defendant's shop in Dublin. Without evidence of commercial activity in another country the website owner can hardly be said to be using a trademark in the course of trade in that other country. Of course, some websites deliberately target other countries or even the whole world. An example favoured by Jacob J was Amazon.com, which actively seeks business on a world-wide scale.

In Scotland, Lord Drummond Young followed this approach in *Bonnier Media Ltd v Greg Lloyd Smith and Kestrel Trading Corp* in which the defender had registered domain names including variations of the names used by the pursuer.<sup>21</sup>

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<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq&Item.drn=4226z10z0>> He accepted that, potentially, operating a website can result in a delict (tort) being committed in every country in the world from where the website can be seen but it does not follow that a delict is committed in every country in the world. He said that the website should not be regarded as having delictual consequences if the impact of a website in a particular country is unlikely to be of significant interest, considering the content of the website and the commercial or other context in which it operates.<sup>22</sup>

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<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq&Item.drn=4226z10z0>> In the context of the present case, especially as the defenders had announced an intention to offer on-line services similar to those offered by the pursuer, the impact of the defenders' planned activities would have their main impact in Scotland and that impact would be commercially significant.

In the absence of commercial activity in other countries, there can be no use in the course of trade in those other countries. If it were otherwise, the possibility of conflicting rights would arise. To take an example, imagine that a company in England has a United Kingdom registration for the trademark 'Psorolene' for skin care creams and an Australian

company had an Australian registration for 'Psorolens' for a cream used to treat eczema. Neither trade in the other's country. If both have websites and use those names on the websites, the English company would infringe the Australian trademark in Australia and the Australian company would infringe the United Kingdom trademark. That cannot be rational. It would also have the effect of disrupting the single European market by causing conflicts between identical or similar trademarks registered in different Member States by different proprietors who used their respective trademarks on their websites.

The 800-FLOWERS case was appealed to the Court of Appeal, where the correctness of the approach of Jacob J was confirmed. In terms of a submission that 'publication' of statements in a particular jurisdiction by downloading from the internet according to the rules of the law of defamation or of misrepresentation was of at least strong analogical relevance to whether a trademark downloaded from the internet had been 'used' in the jurisdiction to which it was downloaded. Buxton LJ said (at paras 137 to 139):

'There is something inherently unrealistic in saying that A "uses" his mark in the United Kingdom when all that he does is to place the mark on the internet, from a location outside the United Kingdom, and simply wait in the hope that someone from the United Kingdom will download it and thereby create use on the part of A \* the very idea of "use" within a certain area would seem to require some active step in that area on the part of the user that goes beyond providing facilities that enable others to bring the mark into the area. Of course, if persons in the United Kingdom seek the mark on the internet in response to direct encouragement or advertisement by the owner of the mark, the position may be different; but in such a case the advertisement or encouragement in itself is likely to suffice to establish the necessary use'. [23](#)

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Thus, to infringe a trademark, it must be placed on a website by someone who actively pursues a commercial activity in the country concerned. To that extent, law in the United Kingdom is of approximate effect to that in the United States. However, the courts in the United Kingdom have not yet had an opportunity to develop an equivalent of the 'Zippo sliding scale', which has come about as a result of the nature of the United States Constitution and issues of State jurisdiction. Where a website goes beyond being merely passive, the question as to whether the owner seeks business in a particular jurisdiction probably will be treated by the courts in the United Kingdom as a question of fact, to be determined in accordance with the circumstances of the case. This may involve further development of Lord Drummond Young's test of significance. However, there is already a useful body of case law available in relation to the grounds of revocation of trademarks for non-use under section 46(1) of the Trade Marks Act 1994. This can provide a litmus test for whether the use complained of is use within jurisdiction. The reason this is so is that, if the use in question is insufficient to save a trademark in an action for revocation, then it can hardly be said to have been used, in a trademark sense, within the relevant jurisdiction. Logically, the concept of use must be the same in both cases. If the offending sign, had it been registered as a trademark within jurisdiction, would be susceptible to revocation on the grounds of non-use, how it could be said to infringe an identical or similar trademark validly registered in that jurisdiction. That there is already a significant



body of law on revocation on the grounds of non-use, this would bring more certainty to the enquiry than trying to draw a line in the intermediate area in Zippo.

The grounds of revocation based on non-use or suspended use for five or more years are in terms of the sign not being put to genuine use for the relevant five year period. 'Genuine use' is not the opposite of 'fake' or 'sham' use and advertisements in magazines published in the United States, which readers in the United Kingdom knew had come from the United States, and a small handful of sales to customers who were citizens of the United States but resident in the United Kingdom and posted to their United Kingdom addresses was not sufficient for genuine use. So held Jacob J in *Euromarket Designs Inc v Peters and Crate & Barrel* where he said (at 304) that "'genuine use" must involve that which a trader or consumer would regard as a real or genuine trade in this country'. [24](https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq/GWAP/AREF/1?action=Attachment.View&Item.Attachment.id=1&User.context=doqzPeiobjEq&Item.drn=4226z10z0)  
<<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq/GWAP/AREF/1?action=Attachment.View&Item.Attachment.id=1&User.context=doqzPeiobjEq&Item.drn=4226z10z0>> The required use must be genuine use judged by commercial standards. However, it could be established in circumstances where no actual sales of the goods had taken place. [25](https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq/GWAP/AREF/1?action=Attachment.View&Item.Attachment.id=1&User.context=doqzPeiobjEq&Item.drn=4226z10z0)  
<<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq/GWAP/AREF/1?action=Attachment.View&Item.Attachment.id=1&User.context=doqzPeiobjEq&Item.drn=4226z10z0>> An example could be where targeted promotional literature had been distributed in a country. This would only apply, however, where it was clear from the circumstances that the undertaking responsible was actively pursuing commercial sales in that country. This is not the same as a passive website lacking such intention.

Section 46(2) is also helpful in that it defines use, for the purposes of whether a mark should be revoked for non-use as including use in a different form provided this does not alter its distinctive character. Again there is case law here that could be helpful where the sign used on a website is not identical to the registered trademark and the use in question has not been to such an extent to be able to prove a likelihood of confusion. [26](https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq/GWAP/AREF/1?action=Attachment.View&Item.Attachment.id=1&User.context=doqzPeiobjEq&Item.drn=4226z10z0)  
<<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq/GWAP/AREF/1?action=Attachment.View&Item.Attachment.id=1&User.context=doqzPeiobjEq&Item.drn=4226z10z0>>

It is likely that other countries in Europe will follow the approach thus far in the United Kingdom if the question of infringement of a trademark by use of an identical or similar sign arises and it is almost certain that the Court of Justice will come to similar conclusions as the Chancery Division and Court of Appeal in England because any other view would lead to conflict and distortion in the internal market.

Outside the United States and the United Kingdom, there is little case law on trademark infringement on the Internet. [27](https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq/GWAP/AREF/1?action=Attachment.View&Item.Attachment.id=1&User.context=doqzPeiobjEq&Item.drn=4226z10z0)  
<<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq/GWAP/AREF/1?action=Attachment.View&Item.Attachment.id=1&User.context=doqzPeiobjEq&Item.drn=4226z10z0>> In Australia, before the Australian Trade Marks Office, in *Torrag Pty Ltd v Lydboots Pty Ltd and Petcure Pty Ltd*, the Office accepted that an opponent to an application to register a trademark containing the words 'Pet Vet' had established prior use of the name, inter alia, by use on its website. [28](https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq/GWAP/AREF/1?action=Attachment.View&Item.Attachment.id=1&User.context=doqzPeiobjEq&Item.drn=4226z10z0)

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<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq&Item.drn=4226z10z0>> There was evidence that the website had regularly generated enquiries about the opponent's veterinary practice.

The scope and effect of injunctions on websites can be unpredictable and this could make judges wary of granting interim injunctions in particular. In *Speechworks Ltd v Speechworks International Inc*, the difficulty of deciding whether to impose an interim interdict in the context of a website arose. [29](#)

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<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq&Item.drn=4226z10z0>> The pursuer had a United Kingdom registered trademark 'SPEECHWORKS'. The defender was a substantial company incorporated in Delaware in 1994 and had registered 'SpeechWorks' in the United States as a trademark and dealt in speech recognition software. It had a domain name <[www.speechworks.com](http://www.speechworks.com) <<http://www.speechworks.com/>>> in respect of which it had made substantial use since 1997. Before the defender knew of the pursuer's trademark, it had applied for registration of 'SpeechWorks' in France and Germany and, at the time of the trial, these were expected to be granted shortly. In 1999, the defender established a European headquarters in Staines, Middlesex.

The judge, Lord Nimmo Smith, noted the consequences of granting an interdict. As it would apply to the defender's website, it could have world-wide effect, leading to closure of the website. Even if limited to the United Kingdom, this would cause immense problems for the defender, as it would have to use a different name in the United Kingdom. The application for an interim interdict was refused. The pursuer was only recently established and it would be easier for it to change its name. Furthermore, the balance of convenience favoured the defender, as it would be able to pay damages should the pursuer be successful at full trial and it was unlikely that the pursuer would be able to do so if it lost.[30](#)

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### **3. Threatened Infringement of a United Kingdom Trademark by a Person Resident Outside the United Kingdom**

If we accept that use of a trademark on a website will only infringe if there is evidence of commercial activity within the relevant jurisdiction, what is the position where there is no evidence of such activity, only the threat that there might be some commercial activity? For example, will the courts in the United Kingdom have jurisdiction in respect of someone outside the United Kingdom who threatens to infringe a United Kingdom trademark? The rules on jurisdiction are fairly complex and there are different rules depending on where the defendant is domiciled or has a presence. In Europe, there is the Convention on Jurisdiction and Enforcement of Judgements in Civil and Commercial Matters (the 'Brussels' Convention), now largely replaced by Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of

judgements in civil and commercial matters.<sup>31</sup>

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[User.context=doqzPeiobjEq&Item.drn=4226z10z0](https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq&Item.drn=4226z10z0)> For persons outside Europe and certain Commonwealth countries, jurisdiction can only be claimed by the courts in England if the defendant is present in the United Kingdom when served with the claim form, submits to the jurisdiction of the English courts or where the courts exercise their discretion to permit service in a foreign country. In the case of a company, it must carry on business in England.<sup>32</sup>

<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq/GWAP/AREF/1?action=Attachment.View&Item.Attachment.id=1>

[User.context=doqzPeiobjEq&Item.drn=4226z10z0](https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq&Item.drn=4226z10z0)>

Infringement of a trademark is a tort. The basic rule governing jurisdiction in Europe is set out in the Civil Jurisdiction and Judgements Act 1982, as amended, which is that defendants are sued in the Member State in which they are domiciled.<sup>33</sup>

<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq/GWAP/AREF/1?action=Attachment.View&Item.Attachment.id=1>

[User.context=doqzPeiobjEq&Item.drn=4226z10z0](https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq&Item.drn=4226z10z0)> However, in relation to a tort (or delict or quasi-delict in Scotland), the defendant can be sued '... in the courts in the place where the harmful event occurred or may occur' (emphasis added); Article 5(3) of the Council Regulation. This seems fairly clear that a court in the relevant part of the United Kingdom can have jurisdiction not just in terms of an act infringing a United Kingdom trademark but also to a threat to carry out such an act. However, Article 5(3) of the Brussels and Lugano Conventions do not have the additional words 'or may occur', or an equivalent form of words. Whether those Conventions extended to threatened torts or delicts was considered in the Scots case of *Bonnier Media Ltd v Greg Lloyd Smith and Kestrel Trading Corp.*<sup>34</sup>

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[User.context=doqzPeiobjEq&Item.drn=4226z10z0](https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq&Item.drn=4226z10z0)>

The pursuer in *Bonnier* had a newspaper business called 'business a.m.'. It had a registered trademark, being the words 'business a.m.' set on a rectangular background. Along the top of the rectangle were the words 'Scotland's Business, Financial & Political Daily'.<sup>35</sup>

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[User.context=doqzPeiobjEq&Item.drn=4226z10z0](https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq&Item.drn=4226z10z0)> The areas covered by the pursuer's newspapers were business, politics and finance. The pursuer also operated a website and provided an online service to supplement its publishing activities and it was claimed that the pursuer had substantial goodwill in its online service. The pursuer owned a number of Internet domain names, including 'business.co.uk'.

The first defender was domiciled in Greece and was the managing director of the second defender, a company incorporated in Mauritius. The pursuer published articles in *business a.m.* about the first defender alleging that he had registered domain names, such as 'amazon.gr'. Consequently, the first defender commenced defamation proceedings against

the pursuer in the High Court in England. At the time of the Scots trial these proceedings were still on going.

During 2001, the pursuer received an email from one Mr Gregory A Lindstron purporting to be from a firm known as LJ & Co. The email confirmed that LJ & Co had acquired the domain name 'businessam.com' and would agree to sell it to the pursuer for \$25,000. On the same day, the second defender published on its website a statement to the effect that it had agreed to acquire 'businessam.com' from LJ & Co and that it intended to launch an online business advisory service. The first defender's name was given as a contact name. The pursuer alleged that a further 22 domain names had been registered by the first defender which included forms of 'businessam', 'business-am' and 'businesspm'.

The pursuer brought the proceedings on the basis that it feared that the defenders had set up or would set up websites which would be used in breach of section 10(2) or (3) of the Trade Marks Act 1994 and sought an interdict to prevent this and to prevent the defenders passing themselves off as the pursuer. An interim interdict was granted and the defenders now applied for it to be recalled or restricted. They based their application on grounds relating to jurisdiction, title to sue and that the pursuer had not established a prima facie case of trademark infringement nor of passing off.<sup>36</sup>

<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq/GWAP/AREF/1?action=Attachment.View&Item.Attachment.id=1&User.context=doqzPeiobjEq&Item.drn=4226z10z0>

Article 5(3) of the Brussels Convention does not expressly mention threatened wrongs. Some of the provisions in the Civil Jurisdiction and Judgements Act 1982 deal with jurisdiction as between parts of the United Kingdom and the equivalent rule, in Schedule 4 of that Act, stated that '[a] person domiciled in a part of the United Kingdom may, in another part of the United Kingdom, be sued ... in matters relating to tort, delict or quasi-delict, in the courts for the place where the harmful event occurred or in the case of a threatened wrong is likely to occur'.<sup>37</sup>

<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq/GWAP/AREF/1?action=Attachment.View&Item.Attachment.id=1&User.context=doqzPeiobjEq&Item.drn=4226z10z0>

It was argued that this strongly supported the view that threatened torts did not bestow jurisdiction as between European Member States and that the words in Article 5(3) of the Brussels Convention should be restricted to their literal meaning.

Lord Drummond Young rejected this submission for two reasons, saying that Article 5(3) also applies to threatened wrongs. The first reason was based on maintaining the rule of law. If a person domiciled in one Member State had no option but to commence proceedings in another Member State to prevent a wrong threatened in the first Member State, that would threaten the rule of law, as it was often vitally important for the courts in the first Member State to take effective action against any wrong of a delictual or tortious nature threatened there. The second reason was that it is not always easy to draw a distinction between a completed delict and a threatened delict. He gave an example of a discharge of effluent from a factory, the owner of which is domiciled in another country, which causes damage to another person's land downstream. That person could sue in the courts in his own country for damages but would have to bring an action in the factory

owner's country for an injunction to prevent further discharges. In support of his finding that Article 5(3) of the Brussels Convention extended to threatened wrongs, Lord Drummond Young noted that the European Court of Justice has held that the phrase 'tort, delict or quasi-delict' in Article 5(3) must be given an autonomous meaning and that its construction must be determined without reference to domestic legislation. <sup>38</sup> <https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq/GWAP/AREF/1?action=Attachment.View&Item.Attachment.id=1&User.context=doqzPeiobjEq&Item.drn=4226z10z0>

As to the second defender, a Mauritian company, the Brussels Convention did not apply but Schedule 8 of the Civil Jurisdiction and Judgements Act applied instead. Rule 2(1) of the Schedule was the equivalent rule and that was expressly stated to apply also to threatened wrongs. Therefore, the Scots court had jurisdiction over the second defender also.<sup>39</sup> <https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq/GWAP/AREF/1?action=Attachment.View&Item.Attachment.id=1&User.context=doqzPeiobjEq&Item.drn=4226z10z0>

#### **4. Enforcement of Judgements in Foreign Trademark Infringement Cases**

If a company based in the United Kingdom is found to have infringed a foreign trademark, the question is whether the foreign judgement can be enforced in the relevant part of the United Kingdom. There are no real problems in Europe as the Brussels or Lugano Conventions or the Council Regulation on jurisdiction and judgements in civil and commercial matters applies.<sup>40</sup>

<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq/GWAP/AREF/1?action=Attachment.View&Item.Attachment.id=1&User.context=doqzPeiobjEq&Item.drn=4226z10z0> Judgements obtained in other Member States are enforceable in another Member State. The only point to note is that if there is any question about the validity of the trademark, the proceedings must take part in the place where the trademark is registered; see Article 22(4) of the Council Regulation. However, that will normally be the case anyway. For some Commonwealth countries enforcement by registration with the relevant court is possible under the Administration of Justice Act 1920 or the Foreign Judgements (Reciprocal Enforcement) Act 1933.

For other countries, enforcement of a foreign judgement is possible at common law, where it is for a fixed sum in damages. However, an injunction imposed by a foreign court is not enforceable at common law.<sup>41</sup>

<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq/GWAP/AREF/1?action=Attachment.View&Item.Attachment.id=1&User.context=doqzPeiobjEq&Item.drn=4226z10z0> To be recognised and enforced by a court in England, however, the English court must recognise the jurisdiction of the foreign court. This requires that the defendant is a subject of that foreign state, was resident there when the action began, where he chose the forum by suing as claimant or counterclaimant and the judgement is in relation to the counterclaim, if he voluntarily appears or where he has contracted to submit to the forum in which judgement was given.<sup>42</sup> <https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq/GWAP/AREF/1?action=Attachment.View&Item.Attachment.id=1>

<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq&Item.drn=4226z10z0>-43  
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To take an example, say that an English company operates a website located on a host computer situated in England. The company has started offering goods for sale by mail order and has placed information about the goods and prices in sterling and in US dollars and the amount to be added for post and packing for delivery to either the United Kingdom or the United States, as appropriate. Imagine that some orders to the State of Florida have been fulfilled. A company in Florida, having the same name as the English company, has a registered trademark in which the name is a prominent part. It sells similar goods. Say that the Florida company sued the English company in Florida for trademark infringement. The English company decided to defend the action and appeared before the court. Substantial damages were awarded against the English Company and injunctive relief granted.<sup>44</sup>

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<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq&Item.drn=4226z10z0> The judgement, if final, can be registered in and enforced by an appropriate court in the United Kingdom. However, only the award of damages can be enforced and the injunctive part of the relief will not be enforced. This is in contrast with the effects of the Brussels and Lugano Conventions and Council Regulation.

A problem for the Florida company would be if the English company did not submit to the jurisdiction of the Florida court by failing to enter a defence. At common law, there seems to be some doubt whether the English courts will recognise and enforce any subsequent judgement. One way of overcoming this problem would be for the Florida company to initiate proceedings in England on the basis of the Florida judgement and apply for summary judgement in England on the basis that the defendant has no real prospect of defending the case. However, if the judgement in Florida was entered in default and the defendant appears before the English court and puts forward a defence, the English court may be reluctant to grant summary judgement. The court will have an even greater dilemma if the defendant then challenges the validity of the claimant's trademark registration. As regards registered intellectual property rights in Europe, if there is a challenge to the validity of the registration, that can only be determined in the courts in the Member State where the right is registered.<sup>45</sup>

<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq/GWAP/AREF/1?action=Attachment.View&Item.Attachment.id=1>

<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq&Item.drn=4226z10z0> If an English court declined jurisdiction where the validity of a United States registered trademark is in issue on an analogous basis, this could leave the trademark proprietor with no effective remedy. However, where the issue is clear-cut and there is no real question of the trademark being invalid, it is possible that the English court would grant summary judgement to the Florida company.<sup>46</sup>

<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq/GWAP/AREF/1?action=Attachment.View&Item.Attachment.id=1>

<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq/GWAP/AREF/1?action=Attachment.View&Item.Attachment.id=1> <https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq&Item.drn=4226z10z0>> There is at present, a draft Convention on Jurisdiction and Foreign Judgements in Civil and Commercial Matters which, if finally agreed and in force, will extend the enforceability of foreign judgements to a number of other countries including the United States.<sup>47</sup>

<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq/GWAP/AREF/1?action=Attachment.View&Item.Attachment.id=1>

<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq&Item.drn=4226z10z0>> The draft Convention has a number of similarities with the Brussels and Lugano Conventions and the Brussels Regulation.

An English court might accept jurisdiction in relation to a finding in a foreign court in respect of infringement of an informal foreign intellectual property right such as a copyright. Alternatively, an English court might accept jurisdiction outright in relation to a foreign intellectual property right, if there was a contract between the claimant and defendant which expressly conferred jurisdiction on the English courts. In *Celltech Chiroscience Limited v MedImmune Inc*,<sup>48</sup>

<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq/GWAP/AREF/1?action=Attachment.View&Item.Attachment.id=1>

<https://webmail.warwick.ac.uk/servlet/webacc/doqzPeiobjEq&Item.drn=4226z10z0>> Jacob J heard a case on the alleged infringement of a United States patent by a licensee of the proprietor where the licence conferred jurisdiction on the English courts. In that case there had been no counterclaim for revocation of the patent. If there had been, it would have been difficult to decide whether jurisdiction could be accepted or whether the English court would have little option but to apply the principle *forum non conveniens*.

## 5. Summary

The application of trademark law to websites increases opportunities to carry out commercial activity in countries where the person carrying out the activity has no physical presence. This could be an attractive aspect of carrying out e-business as it may make it difficult for owners of foreign intellectual property rights to enforce those rights effectively. On the other hand, another feature of the Internet is that someone operating a website could be too easily accused of infringing a foreign intellectual property right. Clearly a balance has to be struck that results in reasonable certainty for persons operating websites and the effective enforcement of foreign intellectual property rights.

It appears that the courts in the United States and the United Kingdom have come some way towards achieving a reasonable approach to trademark infringement and that simply placing a sign identical to or similar to a foreign trademark on a webpage will not necessarily infringe that trademark. It is a question of determining the existence and degree of commercial activity in the place where the trademark is registered. It is to be hoped that other countries follow suit. Nevertheless, any person operating a website that has any content that could possibly be seen as an infringement of a trademark would be best advised to include a disclaimer, particularly when engaged in a commercial activity. For example, if a trader advertises his goods on a webpage for sale and delivery in the United Kingdom only, he should make that clear.

The United Kingdom has moved somewhat to taking a sensible approach but the

jurisprudence has not yet developed to such an extent that a predictable and workable test yet exists. It is submitted that a test based on principles derived from the case law surrounding the grounds of revocation of trademarks on the basis of non-use or interrupted use for five or more years could provide that test. A real and effective use for a commercial purpose of the trademark in relation to appropriate goods or services must be present for infringement in a particular territory should be a precursor before a court in that territory and should accept jurisdiction. Even where national laws provide for protection of trademarks for non-similar goods or services in cases of unfair advantage, detriment or dilution, a real and effective commercial use must be shown.

The difficulty of enforcement of foreign trademarks is still an important issue, especially in respect of trademarks registered outside Europe or the Commonwealth. There may be real problems in recognition of judgements in foreign countries outside Europe or not within the Commonwealth countries having reciprocal enforcement provisions. Enforcement will be an issue in respect of small and medium enterprises which have a presence in a European country only but which are carrying on commercial activities outside Europe by means of the Internet. Such companies or firms are unlikely to submit to the jurisdiction of a court outside Europe, which could make recognition and enforcement in Europe difficult. With large corporations the problem is less likely to exist, as they tend to have subsidiary companies or agents in numerous other countries.

One way to improve the situation is to develop more provisions for reciprocal enforcement, as may hopefully be provided for by the Hague Conference. However, this could trigger other problems, particularly where there are national disparities in the registrability of trademarks and examination of applications for conformity with the domestic requirements for registration. Providing improved mechanisms on a wider international scale for the recognition and enforcement of trademarks rights must be balanced with such disparities and the further international harmonisation of domestic trademark laws beyond the European arena is most desirable and a timely response to the emerging global trading world we are all part of.

## **Notes and References**

1 Of course, the Community trademark applies to the whole of the European Community but the rights afforded by registration apply only within the Community.

2 Though in many cases, the presence of a likelihood of confusion is required to be shown or, where goods or services are neither identical nor similar, unfair advantage of or detriment to the registered trademark must be proved.

3 In Australia, a person infringes a registered trademark, inter alia, if the person uses as a trademark a sign that is substantially identical with, or deceptively similar to, the trademark in relation to goods or services in respect of which the trademark is registered; section 120(1) Australian Trade Marks Act 1995.

4 Case T-79/00 Rewe-Zentral v OHIM (LITE) [2002] ECR II-705, para 26 and Case T-128/01 Daimler-



Chrysler Corp v OHIM, 6 March 2003, para 31.

5 However, not all forms of infringement require confusion to be proved, for example, where the use objected to takes unfair advantage of or is detrimental to, the repute of a well-known trademark, sometimes referred to as blurring and tarnishing.

6 Case 102/77 Hoffmann-La Roche [1978] ECR 1139, para 9 and Case C-299/99 Koninklijke Philips Electronics NV v Remington Consumer Products Ltd [2002] IPLR 7, as approved by the Court of Appeal in Arsenal Football Club plc v Matthew Reed [2003] EWCA Civ 96.

7 See section 10(1) - (3) of the Trade Marks Act 1994 and Article 5(1) and (2) of the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trademarks (OJ L40, 11.2.1989, p.1). The latter right applies only if the use complained of would take unfair advantage of or would be detrimental to the distinctive character or repute of the trademark. In the United States, the Trademark Dilution Act 1995 could apply in similar circumstances; see §43 Trademarks Act 1946, 15 USC 1125 as amended.

8 Case C-206/01 Arsenal Football Club plc v Matthew Reed [2002] IPLR 32 and T-130/01 Sykes Enterprises Inc v OHIM [2003] IPLR 1.

9 C-2/00 Hölterhoff, Michael v Ulrich Freiesleben [2002] FSR 52, [2002] IPLR 9.

10 Although, as noted above, use in relation to non-similar goods can infringe in some jurisdictions if harmful to the trademark. An example is afforded by Baywatch Production Co Inc v Home Video Channel [1997] FSR 22 and by General Motors Corp v Yplon SA [2000] RPC 572.

11 Assuming the proprietor of the trademark is able to show a likelihood of confusion or deceptive use or unfair advantage or damage to repute or dilution or tarnishing, etc. depending on the precise nature of trademark rights in that jurisdiction.

12 952 F Supp 1119 (WD Pa 1997).

13 See, for example, Intercon Inc v Bell Atlantic Internet Solutions Inc, 205 F 3d 1244 (10th Cir 2000) and Tech Heads Inc v Desktop Service Center Inc, 105 F Supp 2d 1142 (D Or 2000).

14 See, for example, Mink v AAAA Development LLC, 190 F 3d (5th Cir 1999) and Neogen Corp v Neo Gen Screening Inc, 109 F Supp 2d 724 (WD Mich 2000).

15 See Alitalia-Linee Aeree Italiane SpA v Casionalitalia.com, 2001 US Dist LEXIS 535 (ED Va 2001), jurisdiction found, and GTE New Media Services Inc v Bellsouth Corp, 199 F 3d 1343 (DC Cir 2000), jurisdiction lacking.

16 [2000] FSR 697.

17 [2001] FSR 288.

18 A bizarre aspect of this case was that neither party had any real trade in the United Kingdom. The legal costs of the action were in excess of £100,000 and the judge considered that the trademark registration in the United Kingdom was probably invalid for lack of use under section 46(1) of the Trade Marks Act 1994.

19 [1996] RPC 281, in which Jacob J described section 9(1) as a 'chatty introduction' to section 10.

20 The address contained the letters 'ie' making it clear to most people that it referred to Eire.

21 [2002] IPLR 13, Court of Session Outer House, 1 July 2002.

22 An application of the maxim de minimis non curat praetor.

23 800 FLOWERS Inc v Phonenames Ltd [2002] FSR 191, paras 136-139.

24 [2001] FSR 288.

25 FLORIS Trade Mark [2001] RPC 329.

26 For example, ELLE Trade Mark [1997] FSR 529 and United Biscuits (UK) Ltd v Asda Stores Ltd [1997] RPC 513.

27 There are, however, a large number of cases involving domain name disputes settled by dispute resolution services.

28 [2002] ATMO 6, 21 January 2002.

29 [2000] ScotCS 200.

30 The judge said that, had he been minded to grant an interim interdict, he would have restricted it to Scotland as that was the only place the pursuer had any business.

31 OJ L 12, 16.1.2001, p.1. This Regulation does not apply to Denmark. There is a parallel Lugano Convention covering the EFTA countries. The provisions of interest here are effectively the same as in the Brussels Convention. The necessary changes were made to the Civil Jurisdiction and Judgements Act 1982 by the Civil Jurisdiction and Judgements Order 2001, SI 2001/3929.

32 Different rules apply to actions in rem.

33 Or, in terms of EFTA countries, the Civil Jurisdiction and Judgements Act 1991.

34 [2002] IPLR 13, Court of Session Outer House, 1 July 2002.

35 The mark was registered in Class 16 for printed matter, etc., Class 35 (advertising, business management, etc.) and Class 41 (education and the provision of training, etc.).

36 Lord Drummond Young found that the pursuer had made out a prima facie case of trademark infringement and passing off. He also held that the pursuer had established title to sue.

37 Therefore, in terms of internal jurisdiction in the United Kingdom, anticipatory torts were catered for as in the Council Regulation on jurisdiction.

38 Case 189/87, *Kalfelis v Schroeder, Muenchmeyer, Hengst & Co* [1988] ECR 5565

39 It had been argued that the company was domiciled in England or Greece. If it was domiciled in Greece it would be in exactly the same position as the first defender and, if domiciled in England jurisdiction would result from Schedule 4.

40 With respect to the Community trademark, the Member States have designated courts for the Community trademark and any infringement action would take place in the Member State in which the infringing act was performed. If infringement took place in a number of Member States, courts in the other Member States would decline jurisdiction in favour of the court first seized.

41 *Airbus Industrie GIE v Patel* [1996] ILPr 465. For a description of the position at common law, see Collier J G (2001) *Conflict of Laws*, 3rd edition, Cambridge University Press, pp.123-127 and McClean, D (2000) *Morris: The Conflict of Laws*, 5th edition, Sweet & Maxwell, pp.138-159.

42 This is now doubted; see Collier, *ibid*.

43 Per Buckley LJ in *Emanuel v Symon* [1908] 1 KB 302.

44 Assuming that the Florida courts would be willing to accept jurisdiction after applying the Zippo test.

45 Article 22(4) of Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, OJ L12, 16.1.2001, p.1.

46 For a discussion of the difficulties in determining jurisdiction in intellectual property cases see Dutson, S. (1998) "The Infringement of Foreign Intellectual Property Rights - A Restatement of the Terms of

Engagement", 47 *The International and Comparative Law Quarterly*, pp.659-679.

47 Hague Conference on Private International Law. The draft Convention was adopted by the Special Committee on 30 October 1999 but still awaits final agreement. There are currently 62 Member States of the Hague Conference.

48 [2002] *IPLR* 30, Patents Court, 28 October 2002.

Note: *IPLR* refers to the series of law reports *Intellectual Property Law Reports* published electronically by EMIS Professional Publishing <<<http://www.emispp.com/>>>