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I am concerned that use of my registered trade marks in search terms seems to return competitors' websites prominently in internet search results. Can I do anything to stop this?

I assume that the writer is referring to a search engine's commercial practice, where, for example, it may operate a service such as Google's AdWords which sells keywords that trigger sponsored links to appear in a prominent position on the screen. The keywords which have been sold may include the writer's registered trade marks.

This is a very hot topic at the moment (see our previous column on 11 August 2009) and has been the subject of a recent ruling by the highest European Court.

Following a request from the French courts, the Court of Justice of the European Union recently issued a ruling as to whether the AdWords program run by Google may lead to trade mark infringement.

In short, the Court of Justice held that Google can take advantage of the safe harbour provisions of the E-commerce Directive and so is not directly liable for trade mark infringements as its AdWords program does not make use of keywords in a trade mark sense.

Therefore, it would seem as though the writer would not be able to take action for trade mark infringement directly against the internet search providers.

Nevertheless, there are some actions that the writer would be well advised to take.

First, the online advertisement generated by AdWords or the like may constitute trade mark infringement. Therefore, the writer may consider bringing an action against the operator(s) of the advertised website(s).

In addition, the writer should advise the search provider of likely trade mark infringements, since a failure by the search provider, once notified, to take action may mean that it is no longer sheltered from liability by the provisions of the E-commerce Directive.

From the point of view of an advertiser, e.g. someone who has purchased keywords, it remains to be seen whether if found to infringe a registered trade mark, the advertiser would be able to take action against the search provider for suggesting keywords or for allowing sponsored links containing advertisements subsequently found to infringe.

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