Over the last year or so there have been a number of critical European Court of Justice (ECJ) decisions affecting trade marks. In the wake of those decisions, this article gives an overview of:

- The scope of trade mark rights and infringement actions, focusing on the enhanced protection now available to strong brands.
- The ability of brand owners to enforce their marks in the context of comparative advertising and online use.
- Practical steps that could be taken in light of the risks for brand owners (see box “Practical protection”).

INFRINGEMENT ACTIONS

The Trade Marks Directive (2008/95/EC) (TMD) and section 10 of the Trade Marks Act 1994 (TMA) set out the infringement actions that may be available to a trade mark owner.

In all cases, the infringer must be using its sign or mark in the course of trade. There is some uncertainty as to whether there is a requirement to show that it is “use as a trade mark”, but on balance that is probably necessary. The use must “affect the functions of the trade mark”, although the full scope of that requirement is open to debate.

There are three kinds of trade mark infringement action:

Double identity infringement

Marks are generally protected against use of an identical mark for identical goods or services, without the need to prove more (double identity infringement) (Article 5(1)(a), TMD; section 10(1), TMA). Marks will be regarded as identical if the differences between them are “so insignificant that they may go unnoticed by an average consumer” (LTJ Diffusion v Sadas (“Arthur et Félicie”), Case C-291/00; www.practicallaw.com/2-102-3165).

Confusion infringement

Where a competitor uses a mark that is either identical or merely similar to the registered mark on goods or services that are identical or similar to those covered
by a trade mark registration, the trade mark owner must do more to protect the mark: it must prove that there is a risk of confusion between the two marks (confusion-based infringement) (Article 5(1)(b), TMD; section 10(2), TMA).

The likelihood of confusion is to be assessed through the eyes of an average consumer for the relevant goods, taking into account all the circumstances.

**Reputation-based infringement**

Marks with an established reputation attract a further level of protection. Where a third party uses an identical or similar mark without justification (“due cause”), the trade mark owner may be able to take action where there is a risk of detriment to the mark or unfair advantage taken of it, even if there is no confusion (reputation-based infringement) (Article 5(2), TMD; section 10(3), TMA).

This action is available whether or not the goods or services are similar to those for which the mark is registered, although any similarity will affect the likelihood of the other elements being established.

Recent cases have particularly focused on reputation-based infringement (see below).

**Reputation-based infringement**

Reputation-based infringement is a potentially powerful weapon for brand owners since it can expand the scope of protection for a mark far beyond the remit of the registration. For example, a well-known brand owner that produces pens and only has trade mark registrations for its mark for pens, may be able to stop an infringer producing handbags that display the brand owner’s mark or a similar mark.

Although this form of action was introduced a number of years ago, there have been few cases until recently, and its scope had been very unclear.

**ECJ guidance**

The following are the elements needed to establish reputation-based infringement in the light of recent ECJ decisions:

**Identical or similar marks.** The infringer must use a sign which is identical or similar to the registered mark. In contrast with confusion infringement, there is no need for similarity between the goods or services (Adidas-Salomon AG v Fitnessworld, Case C-408/01; www.practicallaw.com/6-102-5474).

**A link.** Although confusion is not required to show this type of infringement, the ECJ has recently held that the sign used must at least “call to mind” the registered mark, despite the difference in the goods or services on which it is used (Intel Corporation Inc. v CPM UK Limited, Case C-252/07; www.practicallaw.com/2-384-7957). The link is a somewhat odd factor as it was not enshrined in legislation but is a creation of the ECJ.

Whether there is a link will be judged on the basis of a global assessment: that is, balancing the net effect of all the circumstances in which the marks are used and, in particular, the similarity between the mark and sign, how distinctive the mark is and the nature of the goods in question.

This is a low hurdle: the English courts had favoured a stricter test for “link”, requiring that there be some substantial sort of association with the mark suggested by the sign (Intel Corporation Inc. v CPM UK Limited [2007] EWCA Civ 431; www.practicallaw.com/0-369-8072; L’Oréal SA and others v Bellure NV and others [2007] EWCA Civ 936; www.practicallaw.com/7-378-7729).

The link might also be said to be a measure of causation. The legislation requires that there be unfair advantage or detriment (Article 5(2), TMD; section 10(3), TMA). Logically, this must result from the use of the sign. At a minimum, the sign must call to mind the mark for it to be said that it is the use of the sign, rather than some other competitive activity, that has resulted in the detriment or unfair advantage. The emphasis has therefore shifted to the need to prove advantage or detriment.

**Reputation.** The mark must be known to a significant proportion of the public concerned with the products or services (either the public at large or a more narrow group, depending on the particular goods or services) covered by the registered mark which is alleged to be infringed (in a significant part of the EU for Community trade marks (CTM) or in the UK for UK marks) (General Motors Corp v Yplon SA, Case C-373/97; www.practicallaw.com/9-101-0796).

So far as a CTM is concerned, a reputation in a substantial part of the Community is required, and the ECJ has recently indicated that a reputation in one EU member state may be sufficient (depending on the facts) (PAGO International v Tiromilch, Case C-301/07; see “Trade marks: reputation in the Community”, Bulletin, Intellectual property and information technology, this issue). It remains unclear, however, to what extent the protection for that CTM is limited to that member state. This question was left unanswered by the ECJ in PAGO.

In addition, the ECJ has given no clear guidance on how to prove a reputation and is likely to regard this as a matter within the competence of the national courts. As a result, there could be some interesting decisions in this area, particularly where there is variation between the language and customs of member states. A number of national courts are used to measuring a trade mark’s reputation on the basis of consumer surveys. However, English courts have histori-
cally been very sceptical of surveys and the huge variation in answers that results from slightly differently phrased questions; the ECJ has also not been particularly encouraging.

**Detriment.** The ECJ in *Intel* recently addressed the meaning of detriment and the level of evidence required to establish it. It indicated that what is required is a change in the economic behaviour of consumers, but did not elaborate on what that might involve.

We suggest that one way of interpreting this is as a change in the consumer’s “willingness to buy”. If there are other products with similar marks about, the mark loses its exclusive caché and the consumer is less likely to buy the original version. Alternatively, the availability of rather ordinary or unsavoury products under a similar name may deter consumers from buying the original product and reduce the attractive force of the mark.

This requirement gives rise to a new dilemma: how does a brand owner prove a change in economic behaviour? It is open, of course, to the courts to form their own view of a change in consumers’ perception, and a reduced desire to buy, but there will clearly be a strong temptation to canvas the views of consumers and marketing experts.

However, the view of the English courts is that evidence of branding experts is of little value and that the use of surveys should be tightly controlled (*Whirlpool and others v Kenwood Limited* [2008] EWHC 1930 (Ch); *esure Insurance Ltd v Direct Line Insurance Plc* [2008] EWCA Civ 842, www.practicallaw.com/9-383-1298). Instead, the courts tend to prefer to rely on the evidence of consumers who give oral evidence and are subjected to cross-examination to investigate their motivations for buying a product.

Fortunately, the threat of having to show that there has already been actual damage to prove reputation-based infringement as a result of detriment was removed by the ECJ in *Intel*: a serious risk of damage is enough. A brand owner will not have to wait for the damage to be done before taking action. However, there still remains a practical challenge in establishing the necessary detriment or unfair advantage, whether through showing a change in the economic behaviour of consumers or otherwise. This element raises the spectre of market or customer behaviour surveys, with all their forensic difficulties.

### Unfair advantage

Unfair advantage. After *Intel*, it seemed likely that the ECJ would take a similar approach to the unfair advantage limb of reputation-based infringement as it did to detriment, by applying a change in economic behaviour test (see above). Again, this can be analysed in terms of impact on the consumer’s willingness to buy.

Unfair advantage is not necessarily accompanied by harm, so there may not be a reduced willingness on the part of the consumers to buy the established brand.

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**Practical protection**

Brand owners seeking to enforce and protect their marks should:

- Consider the possibility of reputation-based infringement for both major and secondary brands.
- Keep records of analysis of brand recognition and consider their potential worth (and potential to cause damage) in infringement proceedings when designing them in terms of showing:
  - detriment (reduced willingness to buy);
  - unfair advantage (increased willingness to buy); and/or
  - impact on the ability of a mark to convey various messages.
- Take special care when creating surveys in the context of infringement proceedings and, in particular, bear in mind that all surveys (not just those that are relied on) will be disclosable.
- Keep contact details for potential consumer witnesses (including customer complaints) who can speak about confusion or a change in shopping habits (for example, change in economic behaviour or willingness to buy).
- Be on the look out for evidence of the intentions of an infringer.
- In comparative advertising, take care that any data relied on can be supported and meets the conditions under the Comparative Advertising Directive (2006/114/EC) (see box “Comparative advertising conditions”).
- Be aware of the ability to play around with others’ marks (and the limits on this) in comparative advertising.
- Watch for references to imitations or replicas: it may be that action is available where it was not previously.
- Look out for further European Court of Justice guidance on use of marks on the internet, which may have a significant impact on the use of metatags and search optimisation techniques and brand owners’ ability to control use of their marks on the internet.
Nonetheless, in an analogous way, use of the sign by the infringer can result in an increased willingness to buy the infringer’s goods because the sign is reminiscent of the established mark.

However, the ECJ adopted a different approach for unfair advantage in L’Oréal SA and others v Bellure NV and others (Case C-487/07; see Briefing “Smell-alikes: a rose by any other name”, www.practicallaw.com/4-386/7893). The ECJ indicated that unfair advantage amounts to “riding on the coat-tails” of the established mark; that is, “the infringing mark is exploiting the marketing effort of the owner of the established mark to create and maintain its image, without paying any compensation”. Nevertheless, if an increased willingness to buy the infringer’s goods can be shown, this would seem to be good evidence of “riding on the coat-tails”.

As with other aspects of the infringement test, there must be a global assessment of whether there has been unfair advantage taken of the mark in all the circumstances. This means balancing the usual factors: the strength of the mark’s reputation, the extent to which it is distinctive, the degree of similarity between the marks, the type of goods sold under the marks and the degree of similarity (or otherwise) between the goods.

In addition, the ECJ has identified two further and rather surprising factors that can affect whether or not unfair advantage has been taken of a mark:

- The likelihood of detriment; that is, dilution (where the mark is made less distinctive by use by others) or tarnishment (where use, particularly on cheaper goods or goods of a very different character to those for which a mark is known, results in an unfavourable comparison with the known mark).
- An intention to take advantage of (or free ride on) the mark.

The first is surprising because the two limbs of reputation-based infringement seemed quite distinct and it is not clear why detriment should be any indication of unfair advantage. However, since the ECJ has also confirmed that it is not necessary to prove detriment, this may not matter.

The second factor is more puzzling. It is not necessary to show an intention to take advantage, but it helps if it can be shown. The Court of Appeal has subsequently suggested that it is necessary to establish either an intention to take unfair advantage or some other factor which makes the advantage unfair (Whirlpool).

In practice, it seems that it may be difficult to identify another distinct factor since many potential infringements (for example, a lookalike design) will of necessity be accompanied by an intention to take advantage. The introduction of an entirely new and subjective investigation into the intention of the infringer is not an attractive prospect in civil trade mark disputes.

Interestingly, it seems that where the alleged infringer also has a strong brand (in contrast with a cheap imitation), it may be considerably more difficult to establish infringement, since there is no need for a strong brand to ride on the coat-tails of another (see box “Whirlpool v Kenwood”).

**Impact**

As a result of the ECJ’s guidance in L’Oréal v Bellure, the limb of reputation-based infringement requiring unfair advantage appears to provide more protection than might be expected (at least in relation to counterfeits or lookalike products) and may be easier to establish than detriment. However, the Court of Appeal decision in Whirlpool demonstrates how significantly the outcome is affected by the particular facts of the case, leaving plenty of scope for national courts to introduce their own standards.

In the cases referred by the English courts to the ECJ, there has been something of a trend towards the ECJ taking a broader, more generous approach to infringement actions in comparison with the views expressed by the English courts referring the cases. It will be interesting to see how other national courts approach the issue of proving a change in economic behaviour or free-riding.

It is also unclear which marks will attract this extended protection; this will depend on the facts in each case.

A reputation in only one member state may now give rise to protection, but whether that protection extends to a larger part of the EU is uncertain: further guidance is needed from the ECJ on this point.

One promising angle of defence for an alleged infringer is to attack the reputation of the mark as being insufficient to give rise to the link, detriment or damage. In reputation-based infringement, the greater the distinctiveness of the known mark, the greater the likelihood of a link and consequential detriment or unfair advantage (Premier Brands v Typhoon [2000] FSR 767, www.practicallaw.com/1-101-1380; General Motors v Yplon).

It will be interesting to see whether the courts are prepared to push the boundaries of the action still further. For example, to what extent will it be possible to establish these elements in relation to subsidiary or sub-brands rather than leading brands?

**Overarching test for infringement**

Some years ago, the ECJ apparently added a further test for trade mark infringement: that the infringer’s activities must have an effect on the functions of the mark (Arsenal Football Club Plc v Matthew Reed, Case C-206/01). As with the notion of a link, this is an odd test as it is not reflected in the legislation (see “ECJ guidance” above). Over recent years, its importance seemed to be decreasing. However, the ECJ recently revived the concept in L’Oréal v Bellure.
Whirlpool v Kenwood


Whirlpool’s KitchenAid “Artisan” mixer had an unusual shape, which was registered as a trade mark, and an established reputation. Kenwood sought to enter into the same market, appealing to design-conscious consumers, with a mixer that was held to be similar.

The Court of Appeal:

• Rejected the suggestion that any advantage flowing from the use of the mark would be unfair, concluding that there must be an “added factor of some kind”, such as intention, for the advantage to be classified as unfair. No other relevant factor had been suggested.

• Found that no advantage had been taken of the mark and certainly no unfair advantage, even though the Kenwood mixer had been designed with reference to the KitchenAid Artisan, which had a monopoly in its market.

• Distinguished the case from L’Oréal v Bellure, noting that Kenwood had its own established goodwill and did not need to ride on KitchenAid’s coat-tails to save itself from making promotional efforts in relation to its own product (L’Oréal SA and others v Bellure NV and others, Case C-487/0; see Briefing “Smell-alikes: a rose by any other name”, www.practicallaw.com/4-386-7893). On the contrary, it aimed to use and develop its own goodwill and reputation to promote its new product.

FURTHER PROTECTION

It is worth remembering that, in addition to the three major categories of infringement and outside the TMD, further protection is available to particularly well-known marks (Article 6bis, Paris Convention and Article 16, TRIPS (Trade-related aspects of Intellectual Property Rights Agreement)).

This protection extends beyond the scope of a trade mark registration and outside the country of registration, but only applies to marks with a significantly greater reputation than that required for reputation-based infringement (section 56, TMA).

To benefit from this protection, the mark must be:

• Well-known to the interested public (in other words, famous).

• Known to belong to a person that has the requisite connection with the jurisdiction (section 56(1), TMA).

The owner of a well-known mark can seek an injunction (but not damages) to stop use of another mark where it can be shown that use of that third party mark is identical or confusingly similar and is being used in relation to identical or similar goods or services in the UK (section 56(2), TMA).

Although the mark must be famous, in contrast to a passing off action (which also gives protection to unregistered marks or beyond the scope of a registration), it is not necessary for the holder of a well-known mark to have any goodwill in the UK or for the owner of the well-known mark to have suffered loss.

COMPARATIVE ADVERTISING

A trade mark owner’s infringement rights are cut back somewhat in the context of comparative advertising. The scope of this reduction in rights, and the way in which a competitor’s marks can show detriment in the form of economic behaviour (a reduced willingness to buy) or riding on the coat-tails (increased willingness to buy).
be used in comparative advertising, has recently been clarified by the courts.

Trade marks clearly have a fundamental role in much comparative advertising. A comparative advertisement is one which expressly or impliedly identifies a competitor. Until relatively recently, comparative advertising was regarded as bad practice. However, various directives (most recently, the Comparative Advertising Directive (2006/114/EC) (CAD)) have introduced the concept into English law (The Control of Misleading Advertisements (Amendment) Regulations 2000 (SI 2000/914)). The ECJ and the English courts have seized on the principle with some enthusiasm.

This area is complex because trade marks are governed by two parallel regimes:

- CAD, which specifically prescribes what sort of advertising is acceptable (see box “Comparative advertising conditions”).
- The TMD, which provides that certain uses amount to infringement and imposes limits on the way that marks can be used.

The distinction is particularly significant in the UK (although less so in other member states), because the comparative advertising regime is enforced by public agencies: there is no private right of action. It is therefore important for brand owners to be clear in what circumstances they are still entitled to sue for infringement where their marks are used in comparative advertising.

Helpfully, the ECJ has indicated that the phrases used in CAD that also appear in the TMD (confusion and unfair advantage) mean the same thing in both contexts.

**CAD defence**

If a competitor uses the mark of another trader in a comparative advertisement in a way that would normally amount to infringement through use of an identical mark for identical goods (that is, double identity infringement), the comparative advertising regime provides a new defence: provided that the advertisement is otherwise acceptable (that is, it complies with the CAD conditions (see box “Comparative advertising conditions”)), there will be no infringement.

There is, however, no defence to confusion infringement or reputation-based infringement because key elements of those causes of action are also offensive under CAD. Use of a trade mark in an advertisement that does not comply with the CAD conditions may therefore also amount to infringement.

Case law has made clear that not only is it possible to use a competitor’s word mark (provided the CAD conditions are met), but that a comparative advertiser may also use a logo. It is not necessary to show that the comparative advertiser “needs” to use a mark for a comparison:

### Comparative advertising conditions

A comparative advertisement is acceptable under the Comparative Advertising Directive (2006/114/EC) if, in general terms, it:

- Is not misleading.
- Compares substitutable goods.
- Compares material, relevant and verifiable features.
- Does not result in confusion.
- Does not discredit or denigrate the use of a trade mark, trade name or other distinguishing mark of a competitor.
- Does not take unfair advantage of the reputation of a trade mark, trade name or other distinguishing mark of a competitor or of the designation of origin of competing products.
- Does not present goods or services as imitations or replicas.

As a result, Hutchison 3G was allowed to produce an advertisement using bubbles similar (but not identical) to the bubbles that O₂ uses and had registered as a trade mark. In the advertisement, the bubbles moved slowly and were drained of colour to convey an impression of a slow, old organisation in contrast with 3G’s colourful dynamic logo whizzing around. The advertisement did not cause confusion or detriment, nor did it take unfair advantage of the mark (see also News briefs “Trade marks and comparative advertising: burst bubbles”, www.practicallaw.com/6-202-2945 and “Comparative advertising: trade marks hold their own”, www.practicallaw.com/2-382-2645).

**Imitations and replicas**

CAD prohibits advertisements which present goods as imitations or replicas (Article 4(g)). This is highly relevant to trade marks, since many imitations or replicas will bear infringing trade marks. In particular, advertisements will be caught if they either:

- Explicitly evoke the idea of imitation or reproduction.
- Implicitly communicate such an idea to the public.

Whether either of these is the case is to be judged by looking at the overall presentation of the advertisement and its economic context.

The ECJ has confirmed that this condition is not limited to counterfeits, but also applies to any imitation or replica (or anything presented as a replica, whether or not it is actually a replica) and there is no need for the advertisement to be misleading or confusing (L’Oréal v Bellure).
Keywords and metatags

Keyword advertising is a practice offered by internet search engines, the most well-known of which is Google’s “AdWords” service (one of Google’s main sources of revenue). Keywords or adwords are words chosen and paid for by advertisers in order to trigger the display of a sponsored link when the relevant term is used in a search engine query. For example, if “home insurance” is entered into Google, links to certain sponsored links will appear separately from the “pure” search results.

The advertiser pays Google for each “click-through” to its website from the sponsored link and can specify how much it is willing to spend per click. The sponsored links typically consist of a hyperlink to the advertiser’s website and a short description (which is provided by the advertiser) of the goods or services offered through that site. In some cases, the description includes the trade mark of a third party (which is, of course, not “invisible” use).

Metatags are tags which appear in the source code of a webpage but not in the visual appearance of that page. Their principal purpose is to increase the appearance of the webpage in search results.

Seeking judicial guidance

To date, there has been little guidance from the courts on whether use of a trade mark as a keyword or metatag constitutes infringement. Jacob LJ in Reed Executive v Reed Business Information Ltd described (obiter) the use of metatags and keywords as “invisible use”, stating that “uses made only by computers may not count – they never convey their message to anyone” ([2004] RPC 40; www.practicallaw.com/6-102-7543).

There has been a series of cases in the EU in which keyword advertising has been challenged by trade mark owners. Even though trade mark law is harmonised under the Trade Marks Directive (2008/95/EC), the various national courts have reached different results. For that reason, a series of references (including two from the High Court) have been made to the European Court of Justice (ECJ) for a preliminary ruling (Google France & Google Inc. v Louis Vuitton Malletier, Google France v Viaticum and Google France v CMRRH & ors, Cases C-236 to 238/08).

The ECJ has been asked to determine, among other things, whether:

- Google AdWords involves “use” of the trade mark by Google within the meaning of the TMD and involves such “use” by a competitor.
- It makes a difference if the trade mark appears in the text of the sponsored link.
- It is relevant that a sponsored link is displayed separately from the “pure” search results.

There will be no reliable guidance from the ECJ on these issues until early 2010. In the meantime, the Advocate General has issued an opinion that is fairly controversial, if arguably pragmatic, (although it will not necessarily be followed by the ECJ) because it adopts a narrow approach to infringement in relation to keywords, suggesting that neither the selection nor display of keywords comprising trade marks of other parties amounts to infringement (for a full summary, see Exclusively online article “Trouble ahead for brand owners? European Court of Justice holds key to fate of Google AdWords”, www.practicallaw.com/5-500-2930).

Further questions relating to whether the use of sponsored links (in response to a keyword comprising a registered mark) amounts to infringement will also be referred to the ECJ following two High Court decisions (L’Oréal and others v eBay International AG and others [2009] EWHC 1094 (Ch); see News brief “Protecting trade marks: because they’re worth it”, www.practicallaw.com/4-386-3102; and Interflora v M&S [2009] EWHC 1095 (Ch)).

It has also indicated that the concept of an imitation or a replica is a broad one: it may be an imitation of the whole product, or merely an imitation of an essential characteristic of that product. In L’Oréal v Bellure, the ECJ indicated that the smell of a perfume could be an essential characteristic of that product.

It seems clear that describing a product as X style or X type (where X is a trade mark) will fall foul of CAD. It may be that something which bears different marks but is equivalent in certain features and compared to a brand leader will be seen to be “presented as a replica”, for example, a generic pharmaceutical.

Presumably, spares for another product which are described as X-compatible will not be regarded as replicas (otherwise CAD conflicts with Article 6(1)(c) of the TMD, which allows use of a mark to indicate the purpose of a product; in particular, as an accessory or spare part).  

What is unfair? Significantly, the ECJ has also expanded on the concept of “unfair” in the context of comparative advertising. In addition to indicating that the meaning of unfair advantage should be the same for CAD and the TMD, the ECJ has said that where a product is presented as an imitation or replica in comparative advertising, that is inconsistent with fair competition and is unlawful (L’Oréal v Bellure). So, it follows, any advantage gained is unfair.

On the same basis, it would seem that evoking or communicating the idea of a replica or imitation by reference to a competitor’s brand will be unfair for the purposes of the unfair advantage limb.
required to prove reputation-based infringement (see “Reputation-based infringement” above). If that is so, there may now be greater opportunities to take action against imitations.

CYBERSPACE
Control of the use of trade marks in electronic communication is critical to brand owners. The internet has created a much greater exposure to potential trade mark infringements for trade mark owners. These can range from “traditional” type infringements, such as the unauthorised use of a trade mark on a third party’s website, to internet-specific issues, such as the use of trade marks as keywords and in metatags (see box “Keywords and metatags”).

Given the global reach, fast pace and relative anonymity of the internet, brand owners are also faced with much greater practical difficulties in policing infringements and taking action against infringers.

The basic starting point is that trade mark rights are still enforceable online. However, jurisdiction must first be determined. For example, does a US website promoting goods and services in the US infringe a UK registered trade mark? Can it be argued that the use of a trade mark online constitutes worldwide use because the website can be accessed anywhere in the world?

The English courts will take jurisdiction where a website is directed at customers in its jurisdiction (Euromarket Designs Inc v Peters and Crate & Barrel [2001] FSR 20). The mere fact that a website is globally accessible is not sufficient (1-800 Flowers Inc v Phonenames Ltd [2002] FSR 191; www.practicallaw.com/4-101-5107).

The intention of the website owner and what the user would understand the owner’s intentions to be when accessing the site (that is, an objective inquiry) are important factors in determining jurisdiction. So, a website which has a “.co.uk” address, quotes prices in pounds sterling and has English contact details, would certainly be considered to be directed at the UK market.

However, it is unclear where the line is to be drawn. For example, would advertising and promotion which are directed to the UK be sufficient if the UK consumer could not buy the goods online for the UK? We suggest that they might be if the consumer could buy the goods when abroad or even by phone.

If jurisdiction is established, then, broadly speaking, the same three infringement tests will apply (see “Infringement actions” above). However, issues relating to the “use of a trade mark” (in particular, whether this constitutes “use” for the purposes of the infringement provisions) arise, notably in connection with keywords and metatags or so-called “invisible use”, and have been the subject of recent judicial scrutiny (see box “Keywords and metatags”). Further guidance on this topic is due from the ECJ in 2010.

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