

Clarity on Google AdWords and Trade Mark Infringement

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Google's AdWords service is a helpful tool in getting your business name to the top of the Google listings when the search facility is used. However there is uncertainty regarding to what extent one business can use another business's name or trade mark as an AdWord.

We are often faced with the following questions:

- Can I use other companies' trade marks as Google AdWords to attract business to my site?
- How can I stop others from using my company's trade mark as a Google AdWord to attract people to their site?

Google's AdWords service allows a party to purchase a word or series of words (an "AdWord") which, when typed into Google's search facility, results in the purchaser's advert appearing at the top or on the right hand side of the results page under the "Sponsored Links" section. Google does not prevent parties from purchasing AdWords which are registered trade marks of other businesses.

The European Court of Justice (ECJ) has provided guidance on the use of Adwords and whether their use by a party other than the trade mark owner, constitutes trade mark infringement. This article gives practical guidance following the ECJ's rulings.

THE LEGAL POSITION

Following the ruling by the European Court of Justice ("ECJ") in *Portakabin Limited and Portakabin BV v Primakabin BV*, a company can prevent another company from using its trade mark as an "AdWord", where the advert in question does not allow an ordinary internet user to identify whether the goods being provided through the advert originate from the original trade mark owner or a third party.

Plainly speaking, this means that where one company uses another company's name or mark as an AdWord, the advert shown in the Google listing must make it clear that the advert does originate from the company that owns the trade mark. Where the advert does not allow an ordinary internet user to make such a distinction, the use of the AdWord may amount to trade mark infringement.

The *Portakabin* case referred to above is a dispute regarding the use of the trade mark "Portakabin". The registered owners of the trade mark raised an action for trade mark infringement against "Primakabin". Primakabin had purchased from Google the word "Portakabin" as an AdWord together with some common mis-spellings of the word so that when these words were typed into Google by an internet user, Primakabin's advert would appear as a "sponsored link" at the very top of the Google listing for the search.

Portakabin argued that this use of their mark was an infringement of their trade mark by Primakabin.

Although no decision has been reached in the case, the ECJ has clarified that in order to avoid an infringement, the advert must make it clear that there is no commercial connection between the advertiser and the trade mark owner whose mark has used as an AdWord.

MIS-SPELLINGS

The *Portakabin* judgement also clarified that the same rule will apply where a mis-spelling of a trade mark has been purchased. In the *Portakabin* case, Primakabin purchased not only the word

“Portakabin” to use as an AdWord, but also the word misspelt in various different ways. The reason being that many internet users will spell the word incorrectly and any mis-spelling will be caught with the use of the AdWord. In such cases, the same rule applies and the advertiser is at risk of trade mark infringement in the same way as detailed above.

LIABILITY OF GOOGLE

It is also worth pointing out that the ECJ in a previous decision (*Google France v Louis Vuitton*) held that where an AdWord is used in a way that is likely to constitute trade mark infringement then Google will not, in principle, be held liable for this.

If a competitor is using an AdWord in a way that represents an infringement of your company's trade mark, then although you will have a right to sue the competitor, you will not be able to sue Google unless you have clearly notified Google of the infringement and Google have failed to take action to remove the advert.

PRACTICAL GUIDANCE

Tips for Advertisers

- The use of an AdWord that is also a registered trade mark is not in itself an infringement of that trade mark.
- Use of an AdWord that is also a registered trade mark will only be an infringement of that trade mark where an ordinary internet user is led to believe, by the advert, that there is a link between the advertiser and the trade mark owner.
- Where the advert does nothing to distinguish the advertiser and the trade mark owner, resulting in a likelihood of confusion as to the origin of the goods, then this may amount to a trade mark infringement.
- Advertisers using AdWords that are also registered trade marks must make it clear that there is no commercial connection between it and the trade mark owner whose mark it has used as an AdWord.

Tips for Trade Mark Owners

- Trade mark owners should be vigilant when it comes to monitoring use of their trade mark. Should a search of the trade mark in Google result in the advert of a competitor appearing in the “Sponsored Links” section, the advert must make it clear that the goods or services being advertised are NOT those of the trade mark owner.
- Should a trade mark owner consider there to be a risk of confusion as a result of the advert, then the trade mark owner should take legal advice on taking steps to remove the advert.
- Trade mark owners may wish to purchase their mark as an AdWord in order that their advert appears alongside the rival advert in the “Sponsored Links” section. This will give the consumer a direct choice between your company and the rival company, without the rival having any sort of an advantage.

If you would like further information on this matter please contact [Craig Smith](#)

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