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I.- JURISPRUDENCIA

I. 1. INTERNET. Facebook. Derecho al honor.

En *"B F y otros c/ Facebook s/ Medida Autosatisfactiva"* el Juzgado de Primera Instancia en lo Civil y Comercial de la 12 Nominación de Rosario ***ordenó a FACEBOOK***, el 13.97.12, ***la inmediata eliminación de los sitios individualizados en la demanda*** por entender que o hay duda que el Derecho al Honor es uno de los principales bienes espirituales que el hombre siente, valora y sublima colocándolo dentro de sus más preciadas dotes. Es una cualidad moral del ánimo, que puede ser herida, sufrir menoscabo, y que suele ser defendida con el mismo ahínco, con la misma fuerza

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de quien se afana entre la vida y la muerte. **El honor es un bien personalísimo, innato del hombre, nace con él**, puesto que lo lleva formando parte elemental de su naturaleza. Y agregó que de la publicación mencionada ***se desprende una afectación del Derecho a la Intimidad que comprende el derecho de controlar la información relativa a ciertos aspectos de la vida entre ellos, los datos verídicos pero reservados al conocimiento del sujeto o de un grupo reducido de ellos***, cuya divulgación o conocimiento por otros apareja algún daño. En virtud de tal derecho, el sujeto tiene la potestad de oponerse a toda investigación de su vida privada por terceros y a la divulgación de datos que, por su naturaleza, estén destinados a ser preservados de la curiosidad pública. Así, quedan comprendidos en el ámbito del derecho a la intimidad aspectos relacionados con la vida familiar, afectiva o íntima. **También el derecho a la propia imagen es un derecho personalísimo, autónomo**, como emanación de la personalidad, contenido en los límites de la voluntad y de la autonomía privada del sujeto al que pertenece. Por ello, toda persona tiene sobre su imagen un derecho exclusivo que se extiende a su utilización, de modo de poder oponerse a su difusión cuando ésta sea hecha sin su autorización. ***Nuestro derecho positivo regula el derecho a la propia imagen en el art. 31 de la ley de propiedad intelectual 11.723*** norma en la cual el legislador ha prohibido, como regla, la reproducción de la imagen en resguardo del correlativo derecho a ella, que sólo cede si se dan circunstancias que tengan en mira un interés general que aconseje hacerlas prevalecer por sobre aquel derecho. Y concluyó que ***si existen violaciones a alguna norma laboral o de conducta por parte de la empresa L. o de los aquí actores debe recurrirse a su remedio por el uso de las vías legales pertinentes***. Lo contrario significa entrar en un camino sin retorno que implica la creencia de que se hace "justicia" por mano propia, lo cual no es más que el regreso a etapas que el hombre recorrió hace miles de años en la búsqueda de sustituir

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la razón de la fuerza por la fuerza de la razón. Fuente: www.eldial.com.ar

I. 2. VIOLACION DE SECRETOS. COMPETENCIA.

En *"N.N. Damnificada RH S/ Competencia"* la CamNacCrimCorr resolvió el 13.02.12 que ***corresponde la competencia del fuero federal*** ante llamadas recibidas por una persona en su celular, que le ofreciéndole sexo a raíz de unas fotos publicadas en internet que habían sido enviadas por la demandante a una amiga que vive hace años en los EEUU. Para así decir, recordó el tribunal que el magistrado de instrucción declinó su competencia a favor del fuero federal ***por considerar que la naturaleza de los hechos denunciados se subsumen en los artículos 153 y 153 bis del Código Penal de la Nación***. Por su parte, el juez federal, no la aceptó por considerar que la decisión resulta prematura. ***En el mismo sentido que el Juez de instrucción se expidió el Sr. Fiscal General***, criterio **que compartimos** y en consecuencia consideramos que corresponde que continúe la investigación la Justicia de excepción. Fuente: www.eldial.com.ar

II.- *International IP Law Section in English*

II. 1. LEGAL NEWS
Argentina issues new examiner instructions on trademark applications

The National Institute of Industrial Property of Argentine (INPI) has issued new instructions to its examiners relating to the procedures for objections based on the classification of goods and services in trademark applications.
Historically, if the applicant's response to an objection

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regarding the classification of goods or services was not accepted, the entire trademark application would be rejected even if the objection applied only to specific goods and services. Under the new instructions, (1) if the examiner objects to the entire description of goods or services of a trademark application and the applicant's response does not meet the examiner's criterion, the application will be rejected; and (2) if the examiner's objections relate only to some goods or services of an application and the applicant's response to the objection does not satisfy the examiner's criterion, the application will continue its prosecution but the goods or services objected to will be excluded.
Source: WOLTERS KLUWER IP Law. Kluwer Manual IP Law News Alert N° 18, August 21, 2012.

II. 2. Selecting Another's Trade Mark as a Keyword: Lawful or Infringing? Recent Case Law from Europe

by

Nicole van der Laan

Ph.D. candidate at LMU Munich and
VU University Amsterdam

The use of trade marks in keyword advertising on Internet search engines has been a highly debated issue among legal practitioners, courts, and commentators since several years. It has been very much contested whether one is allowed to choose someone else's trade mark as an internal keyword in order to have an advertisement (ad) displayed when an Internet user searches for that trade mark on Google, Yahoo!, or another search engine. If this practice is considered legitimate, an Internet user searching for a certain brand may be confronted not only with search results originating from that brand owner or authorized companies, but also with ads of competitors,

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resellers, and so on. After years of discussion and a substantial number of law suits concerning keyword use, some issues seem to have been resolved, but many others remain. This comment will briefly point out several recent court decisions in keyword disputes from the Court of Justice of the European Union (ECJ) and national courts in Europe. The initial phase of the debate was characterized by the question whether the use of a trade mark keyword by an advertiser or search engine constituted a use falling under trade mark law. The ECJ decided in the case *Google v. Louis Vuitton* that Google does not "use" the trade mark in its "own commercial communication" and can therefore not be held primarily liable under trade mark law. The search engine can still be liable as a secondary infringer, but this has to be decided on the basis of the national law of the particular member state in conjunction with the liability exemptions in the European E-Commerce Directive. In the same case, the ECJ qualified the selection of the trade mark keyword by the advertiser as a "use in the course of trade" and "in relation to goods or services", so that it falls within harmonized European trade mark law. The ECJ determined that such keyword use is infringing where the ad "does not enable normally informed and reasonably attentive internet users, or enables them only with difficulty, to ascertain whether the goods or services referred to by the ad originate from the proprietor of the trade mark or an undertaking economically connected to it or, on the contrary, originate from a third party". The ECJ requires the advertiser to clearly identify himself in the text of the ad. If the is vague about the identity of the advertiser, the origin function of the trade mark is considered to be adversely affected, and a likelihood of confusion is assumed to exist (decided in *Bergspechte v. trekking.at*).

The case *Portakabin v. Primakabin* was concerned with the limitations to trade mark law. The ECJ determined that keyword use cannot generally

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be regarded as a lawful descriptive use, and that the limitations do not apply if the ad is vague with regard to the origin.

Under Art 5(1)(a) of the European Trade Mark Directive, the ECJ requires an adverse effect on one of the functions of the trade mark for finding an infringement. In *Google v. Louis Vuitton*, the ECJ surprisingly regarded the use of another's trade mark as a keyword as not having an adverse effect on the advertising function. In *Interflora v. M&S*, the ECJ stressed that the purpose of a trade mark is not to protect its proprietor against practices inherent in competition, such as offering alternatives by the use of trade mark keywords.

With regard to the investment function, the ECJ determined in *Interflora v. M&S* that it is adversely affected where the third party's use of the sign "substantially" interferes with the proprietor's use of its trade mark to acquire or preserve a reputation capable of attracting consumers and retaining their loyalty. The mere fact that the trade mark proprietor feels obliged to invest more, or that consumers are diverted to the advertiser, does not suffice. The ECJ left the factual assessment in this respect to the national courts.

These ECJ decisions have not brought the desired harmonization among national courts in Europe. There still exist enormous divergences between various courts. For instance, the German Federal Supreme Court in the case *Bananabay II*, decided that there is no infringement where the ad itself neither contains the sign, nor a reference to the trade mark holder or its products, but the indicated domain name in fact points to a different commercial origin. In contrast, some German Courts of Appeal have found trade mark infringements in those circumstances (e.g., Court of Appeal Braunschweig in *Most*). In France, the Supreme Court found an infringement by the advertiser in the case *Google v. CNRRH*. The Paris Court of Appeal in *Google v. Auto IES*, however, denied trade mark infringements by the advertisers in dispute. The

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Austrian Supreme Court has been particularly strict towards keyword advertisers. In the case *Bergspechte*, the court found the use of the trade marks in question to be infringing, although they did not appear in the ad and the name of the advertising company was indicated in the URL. The court required the advertiser to counteract the risk of confusion, for instance, by a clarifying indication that no economic connection exists between the advertiser and the trade mark owner. The same conclusion was reached in the case *Wintersteiger*, in which the advertiser offered accessories for the trade marked products.
As a consequence of these divergent national decisions, the legal situation concerning the use of trade mark keywords is very uncertain for both trade mark owners and advertisers. The former are encouraged to go forum shopping, whereas the latter are recommended to either abstain from selecting trade mark keywords, or to be specifically clear about the origin of the ads.

© Nicole van der Laan, Ph.D. candidate at LMU Munich and VU University Amsterdam.

See for a more detailed analysis the author's article "The Use of Trade Marks in Keyword Advertising - Developments in ECJ and National Jurisprudence", available here: http://ssrn.com/abstract=2041936

Estudio Villano gratefully acknowledges **Nicole van der Laan** the permission granted to include this excellent article in the Firm's Newsletter.

II. 3. France: Google can be ordered to filter words linking to online piracy websites

By
Catherine Jasserand, Institute for Information Law (IViR)

According to the Supreme Court, through its service of Google Suggest, Google had not infringed any copyright but had provided the means to

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infringe copyright.' In 2010 Google was sued by the French recording industry trade association (SNEP) for copyright and neighbouring right infringements via its service Google Suggest. The Court of First Instance and the Court of Appeal both rejected the claims. They found that Google had not infringed any copyright by suggesting websites to Internet users when they were typing their requests. Only the use of the files available on the suggested websites could have been infringing. The plaintiff had originally requested the Court of First Instance to issue an order against Google to stop and prevent further copyright infringements by filtering key words such as « Torrent », « Megaupload » and « Rapidshare ». On 12 July 2012, the Court of Cassation overruled the decision of the Court of Appeal and sent back the case to a different Court of Appeal (Versailles) to issue a new judgment in conformity with its ruling. The Court of Cassation grounded its decision on Articles L. 335-4 andL. 336-2 of the French Intellectual Property Code (IPC). The first article defines the criminal offence of copyright infringement and the applicable penalties; the second article provides copyright holders with the possibility to request an injunction from the Court of First Instance to stop or prevent any copyright infringement. The injunction can be addressed against anyone (person, entity) likely to contribute to remedy it. The Court of Cassation considered that the Court of Appeal had not properly applied the provisions to the case. According to the Supreme Court, through its service of Google Suggest, Google had not infringed any copyright but had provided the means to infringe copyright. The Court also considered that the injunction was intended to avoid or put an end to the infringements by deletion of the automatic association of keywords with the words of a request. Google was able to contribute to solve the issue by making it more difficult for Internet users to find infringing websites. The ruling of the

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Court stands in the last paragraph of the decision: it is concise but rather surprising. The Court first assesses the involvement of Google regarding copyright infringements: logically and as the Court of Appeal had already established it, Google did not infringe copyright. However the Court of Cassation goes a step further in its reasoning and states that Google was offering the means to infringe copyright (implying that Google was facilitating copyright infringement). It is hard to understand how the Court of Cassation can base its ruling on Article L. 335-4 of the IPC. That article only covers cases of copyright infringement and not other situations such as the provisions of means that can be used to commit copyright infringement. The Court of Cassation then considers that the request of injunction against Google was justified since Google was able to contribute to stop or prevent the infringements by filtering litigious words. The Court adds that the system of filtering does not need to be completely efficient! It is worthwhile to remind here (and again) that Article L. 336-5 has been highly criticized for being too imprecise. The provision is not only badly written (what does the expression "someone likely to contribute to remedy" mean?) but also potentially dangerous (because of its large spectrum). Last but not least, since the Court of Cassation recognized on the same day that online providers could not be subject to a general obligation of monitoring (and thus filtering) on the basis of the law implementing the e-commerce Directive, there is a risk that copyright holders will try to obtain broad filtering orders on the ground of copyright infringement. In any event, it will be interesting to see which consequences the Versailles Court of Appeal will draw from the Court of Cassation's ruling and especially whether the judges will sentence Google for the provision of means to infringe copyright on the basis of Article L. 335-4 and if so, which reasoning they will follow…

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