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Trademark violations by Amazon's internal search engine

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Amazon's internal search engine has already been the subject of a decision by the High Court (England and Wales) made just over two years ago (2014, EWHC 181, ch). The claimant was the proprietor of the LUSH trademark, used (inter alia) for bath additives. After the trademark was entered as the search term, Amazon exclusively showed offers for competitor's products. An injunction was granted against Amazon for infringement of trademark pursuant to Art. 9 (1) a) EUTMR.

In the meantime, an injunction has likewise been granted pursuant to Art 9 (1) a) EUTMR in Germany against Amazon by reason of this search engine function (Higher Regional Court Köln, 6 U 40/15 dated 20.11.2015). The claimant was the proprietor of the trademark MAXNOMIC, which is used for office furniture. The court relied upon case law by the German Federal Supreme Court concerning Google-Adword advertisements. According to this case law, the indication-of-origin function of a trademark is affected if the advertisement complained of is so vague that a properly attentive internet user cannot immediately tell whether the advertisement is that of the trademark proprietor or of a third party with no connection to the trademark proprietor (see also Hildebrandt, Trade Mark Law in Europe, 3rd edition, page 261). These considerations can also be applied to the search results. Of course, every customer knows that Amazon offers products from a variety of manufacturers. However, if customers enter a particular trademark as a search term, they expect Amazon to present offers for products with this trademark. These customers would not imagine that they would only be offered the products of other manufacturers. A person, who asks for a particular branded product, would perhaps expect the seller to recommend other manufacturers' products as well. However, he would not expect the seller to tacitly hold out only competitors' products without at least pointing out that the branded product is not in stock. For the sake of completeness however, it should be mentioned that in a judgement dated 21.10.2015, the US Court of Appeals for the 9th Circuit (Case No. 13-55575) decided in favour of Amazon in relation to customers' expectations.

In Germany, the Munich Regional Court (33 O 22637/14) and the Frankfurt/Main Higher Regional Court (6 U 6/15) made decisions on 18.08.2015 and 11.02.2016 respectively, about a further variation of the case based on claims by the proprietor of the ORTLIEB (outdoor equipment) and FATBOY (beanbags) trademarks. The subjects of these proceedings were search results that included the trademark proprietor's products, as well as products of its competitors. An injunction was issued against Amazon pursuant to Art. 9 (1) a) in these cases as well. Where an Amazon customer enters a brand name in a search, he wishes to find offers relating to this brand. If the brand name is repeated above the search results, the user understands this as advice that the

branded products in the following list are available. However, if this list also includes competitor's products, there is a risk that the user makes a connection between these links and the branded product he searched for. This undermines the trademark's indication-of-origin function.

Amazon's appeal against the decision by the Munich Regional Court will be heard on 12.05.2016 before the Munich Higher Regional Court. There is much to indicate that the Munich Higher Regional Court will follow the decisions of the Cologne and Frankfurt/Main Higher Regional Courts in relation to this type of trademark use.

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